



Submission date: 25th April 2016

## 2016 – Study Question (Patents)

Sarah MATHESON, Reporter General

John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General

Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

Republic of Korea

Contributors name(s)

Kyu Whan OH

e-Mail contact

aokw@hotmail.com

Date

25-04-2016

### I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

Yes.

2) Under your Group's current law, are amendments to the claims of a patent possible?

Yes.

3) Further to your answers to questions 1) and 2), please indicate:

a) the standard for determining whether such amendments are permissible and indicate whether this standard exists in statutes, regulations, patent office guidelines, and/or in case law.

The standard for determining whether an amendment is permissible is provided in the Korean Patent Act (KPA).

According to Article 47 (2) of the KPA, an amendment to the specification or figures of a patent

application shall be made within the disclosure in the specification or drawings originally attached to the application.

According to Article 136 (3) of the KPA, a correction to the specification or figures of a granted patent shall be made within the disclosure in the specification or drawings of the patent. However, a correction of an erroneous description can be made within the disclosure in the specification or drawings originally attached to the relevant patent application.

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?

No. As far as only impermissible matter is concerned, there is no difference between the substantive standards for amendments under items 1) and 2).

4) To the extent your answer to question 3) depends on timing (e.g. after filing but before examination, after allowance but before grant, and after grant), please explain how the standard changes and during which time periods.

Not relevant.

5) Further to your answer to question 3), if impermissible added matter is a ground for refusing an amendment, please explain how impermissible added matter is defined.

The addition of new matter to either a specification or a drawing is not allowed. An abstract is not a subject to be reviewed in determining new matter.

Depending on timing, the addition of new matter is a ground for refusing an application, rejecting an amendment, or invalidating a patent.

‘New matter’ is matter that goes beyond the disclosure in the specification or drawing(s) originally attached to a patent application.

‘Disclosure in the specification or drawing(s) originally attached to an application’ means matter which is explicitly disclosed in the original specification or drawing(s), or matter which is not explicitly disclosed therein but which a person skilled in the art would regard as good as disclosed in the specification or drawing(s) in view of common technical knowledge at the time of filing the application (see Supreme Court Decision 2005 Hu 3130 rendered on Feb.8, 2007).

‘Originally attached to a patent application’ means ‘attached to a patent application on the filing date of the application.’ Anything added to the specification or drawing(s) through an amendment after the filing date of an application is not matter disclosed in the specification or drawing(s) originally attached to the application.

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

A patent application as filed is interpreted by a person skilled in the art in view of common technical knowledge at the time of filing the application.

b) if interpreted as the notional skilled person would understand the patent application as filed, what is the relevant date of knowledge of the notional skilled person?

The date of filing the application is the relevant date.

7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

yes

Please explain:

There is a mechanism for correcting a granted patent.

Such a correction is allowed only when it falls under the following cases of (i) narrowing a claim, (ii) correcting an erroneous description, or (iii) clarifying an ambiguous description. In addition, iv) the correction shall not result in broadening the scope or altering the gist of claims, and v) a correction made in accordance with item (i) or (ii) above is possible only if claims after the correction have been patentable at the time of filing of the patent application.

## II. Policy considerations and possible improvements to your current law

8) How does your Group's current law strike a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter?

An applicant may amend his application during an examination process. However, in any event, he may not add new matter to the application.

Depending on timing, the addition of new matter is a ground for refusing an application, rejecting an amendment, or invalidating a patent.

9) Are there aspects of these laws that could be improved?

no

Please explain:

10) Does your Group's current law allow amendments post grant? If so, how does your Group's current law

strike a balance between allowing a patentee to make appropriate amendments to a granted patent (such as amendments necessary to sustain its validity) and preventing the patentee adding impermissible matter?

Yes, Korean law allows a patentee to correct a granted patent. However, in any event, a patentee may not add new matter to a granted patent. New matter added to a granted patent through correction constitutes a ground for the invalidation of the correction.

11) Are there aspects of these laws that could be improved?

no

Please explain:

12) If your Group's current law uses, at least in part, the notional person skilled in the art to determine the permissibility of amendments, is this approach effective? Are there aspects of this that could be improved?

Our approach using the notional person skilled in the art seems effective.

### III. Proposals for harmonisation

13) Is harmonisation of the definition of impermissible added matter desirable?

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

yes

Please explain:

14) If yes, please propose a definition of impermissible added matter that you believe is appropriate.

As a definition of new matter, we would like to propose "matter that cannot be directly and unambiguously derived from the patent application as filed."

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

no

Please explain:

The definition should not depend on when an amendment is made.

16) Should rules against impermissible added matter prohibit the addition of claims per se, as opposed to adding limitations to claims?

No.

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to

removing limitations from claims?

no

Please explain:

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

yes

Please explain:

It should be the same (for legal stability).

19) If your proposed definition refers to the notional skilled person, what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?

The date of filing an application is the relevant date.

20) If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, how should the impermissible added matter defect be remedied in these circumstances?

Under such circumstance, it is not possible to remedy the defect of the impermissible added matter.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

No comments.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary

The definition of ‘new matter’ is the same regardless of when an amendment is made in Korea. ‘New matter’ is matter that goes beyond the disclosure in the specification or drawing(s) originally attached to a patent application. ‘Originally attached to a patent application’ means ‘attached to a patent application on the filing date of the application.’ Anything added to the specification or drawing(s) through an amendment after the filing date of an application is not matter disclosed in the specification or drawing(s) originally attached to the application. A patent application as filed is interpreted by a person skilled in the art in view of common technical knowledge at the time of filing the application. In any event, the addition of new matter to either a specification or a drawing is not allowed. Depending on timing, the addition of new matter is a ground for refusing an application, rejecting an amendment, or invalidating a patent.