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2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

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National/Regional Group

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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 for patent applications:

According to Article 62 of the Decree Law (DL), it is possible to amend the application (and hence the description and/or figures) during substantial examination in the prosecution of the granting procedure.

Moreover according to Articles 62 DL, the applicant has the right to amend the description and/or figures after observations by third parties are received by the Patent Office.

No for granted patents:

No support could be found in the current law for amending the description or figures of a granted patent.

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

Yes for patent applications:

According to Article 54 DL, where the application suffers formal deficiencies, the applicant may amend the claim(s).

According to Article 62 and 64 DL and to Article 26 of the Implementing Regulations (IR), it is possible to amend the claims during substantial examination in the prosecution of the granting procedure.

Yes for granted patents:

The set of claims can be amended by deleting one or more claims, however no support could be found in the current law for amending a claim itself.

According to Article 129 DL, one or more claims of a granted patent could be canceled following partial invalidation of the patent.

According to Article 135 DL, the owner has the right to partially surrender his right to the patent by cancelling one or more claims.

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.

For patent applications:

According to Article 47 DL, the claim(s) may not extend beyond the subject matter of the invention as specified in the description. This requirement should be met also when amending the application.

According to Article 64 DL, the scope of the application may not be widened through the amendments in the claim(s). However no express provisions are given for possible added matter.

According to Article 43 DL, where during the (formal) examination of the application for patent, the subject matter of the invention for which patent is requested is amended/changed, whether in whole or in part, so as to expand out of the contents of the application as initially filed the date of application shall be deemed to be the date when the petition for such amendment/change is filed.

Therefore, prima facie, under the current law no amendments during the (formal) examination are impermissible. However in case of added subject matter the date of filing would be extended. In practice, applicants avoid to incur such risk.

There is no standard for determining whether the amendments are permissible.

For granted patents:

According to Article 129(c) DL, a patent shall be declared invalid by the court where evidence is brought in that the subject matter of the patent exceeds the scope of the application. However the interpretation of the expression "scope of the application" is not clear.

There is no standard for determining whether the amendments are permissible.

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

Not applicable.

- 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 applicable.

- 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.

There is not a clear definition of impermissible added matter.

According to Article 47 DL, the claims should be drafted or amended such that they don't extend beyond the subject matter of the invention as specified in the description.

According to Article 64 DL, the scope of the application may not be widened through the amendments in the claim(s).

- 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;

There is no explicit article or case law concerning the interpretation of the content of patent application as filed. The interpretation is likely to be relied on a hypothetical skilled person in the relevant art. Theoretically, we believe that the patent application as filed will be interpreted to include a description, claim(s) and the drawing(s) With the exception of an abstract serving the sole purpose to provide technical information and may not be used for other purposes as laid down in Article 48 of Decree law No. 551.

- 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?

Again, there is no explicit article or case law concerning the relevant date of knowledge of the notional skilled person but in theory it would be the filing date of the application.

- 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 no post-grant opposition in current decree law and pursuant to Art. 129(c) impermissible amendment could be a ground for nullity by court.

However, the patent proprietor may be allowed to cancel the claim(s) covering impermissible added matter based on a court decision.

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?

It is regulated in Article 47(2) that "The claim(s) may not extend beyond the subject matter of the invention as specified in the description." and in Article 64(3) that "The scope of the application may not be broadened through the amendments in the claim(s)." These can be accepted as general principles that shall be satisfied at the time of filing and when making amendment during the substantive examination process. Application of these principles, in theory, let the applicant make necessary amendments on his/her claims in order to get the patent granted while preventing him/her from adding impermissible matter to the claims.

Despite the existence of these principles, as there is no guideline about the assessment of impermissible added matter and there is no established practice (of either the TPI and courts) with respect of the same, it is not possible to say that current Turkish law strikes a balance between allowing an applicant to make appropriate amendments during the examination process and preventing him/her from adding impermissible matter.

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

yes

Please explain:

Even though there are principles in the Decree law No. 551 that may prevent the applicant from adding impermissible matter during the examination process, there is no guideline how to apply these principles. In other words it is not clear how one –most probably an examiner- can decide;

- i. whether an amendment of a claim extends beyond the subject matter of the invention specified in the description; and
- ii. whether through an amendment the scope of the application is broadened ('assessment of impermissible added matter').

Furthermore there is no established practice of the TPI about the assessment of impermissible added matter. Thus there is a need for a guideline to see how this assessment is made and this is also a requirement considering the legal certainty principle.

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, our Group's current law allow post-grant amendments for national patents by way of surrendering the patent right by removing a claim or claims as granted.

After grant, current Turkish Law allows the holder of a patent to surrender his right to the patent in part for one or more patent claim(s). According to Art. 135 of the Decree Law no 551, where the right to a patent is surrendered in part, the patent remains in force for the claim(s) which have not been surrendered, provided such claim(s) do not constitute the subject matter of another patent and the surrender of right does not result in extending the scope of the patent.

Art. 129/c of the Decree Law no 551 regulates impermissible added subject matter as a ground for

invalidity. It provides that if the subject matter of the patent exceeds the scope of the application, the patent shall be deemed to be invalid.

In relation to Turkish validation of European Patents, post-grant amendments in proceedings before the competent court relating to the validity of the European patent is permissible.

Pursuant to Article 4 of the Decree Law, where International Agreements having entered into force according to the laws of the Republic of Turkey, contain provisions which are preferential/more favourable to those of this present Decree-Law, the persons entitled to protection may request to benefit from such preferential/more favourable provisions.

Since EPC is an international treaty and same has entered into force in Turkey, proprietors of the Turkish validations of granted European patents may benefit from preferential/more favourable provisions of EPC, such as Article 138(3) of EPC.

In practice however, we have not experienced any cases where the proprietors of the European Patents have requested to benefit from preferential/more favourable provisions of EPC.

It is not possible to say that current Turkish law strikes a balance between allowing a patentee to make appropriate post-grant amendments and preventing him/her from adding impermissible matter.

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

yes

Please explain:

We are of the opinion that the proprietor of a patent should be given an opportunity to make a post-grant amendment on the patent.

The national law should regulate provisions which permit the proprietor to make amendments in its patent by way of limitation. In addition, the criteria of permissible amendments should be defined clearly and should be in compliance with the provisions of the EPC and the practice and case-law of the EPO.

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?

Although no statutory reference is made in the Patent Law whether an amendment would introduce an impermissible added matter relative to a hypothetical person skilled in the art, we are of the opinion that such a notional reference is inevitable to be resorted either in the course of administrative or in judicial proceedings, since the addition of a matter is inherently a relative concept when assessed whether it is permissible or not. As far as the group is aware, there is no precedent addressing how the assessments of the skilled person should be on a dispute regarding impermissible added matter.

For this reason, the group abstains from commenting on the effectiveness of the role of a skilled person in this particular context. The law should clearly define the notional person skilled in the art in considerations resolved by the AIPPI under Q213; and moreover should clearly clarify whether the amendment will be considered by a notional person skilled in the art at the priority/filing date or at the date of amendment.

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.

Impermissible added matter can be defined as any amendment in the content of the patent/ patent application that results in the skilled person being presented with information which is not directly and unambiguously derivable from what is disclosed in the application as filed.

The application as filed should not be interpreted as being confined to their strict literal wording. However the application as filed should not be interpreted so as it also contains information that the inventor may have contemplated.

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 of impermissible added matter should not depend on the timing of the amendment. The patentee should not be allowed to amend its patent in a way that it contains subject-matter which extends beyond the content of the application as filed at any stage.

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

Rules against impermissible added matter should not prohibit addition of the claims per se, if it is not an unsearched subject matter and comply with other requirements of the Patent Law. Amendments will be allowed by the examiner or judge who will be responsible to check whether the conditions defined by the legislation are met. This would be an appropriate way to prevent a loophole in law against the patent proprietor where the removal of an added subject matter would result extending the scope of protection. However, extension of the scope of protection is required to be avoided.

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

no

Please explain:

Rules against impermissible added matter should not prohibit the removal of claims per se. Indeed it is already allowed in current DL and our group think that it may be unreasonable to prohibit it.

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:

- 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 relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment should be the filing date of the application in line with Article 123(2) of EPC and H-IV-2.1 of the Guidelines of Examination. In that respect any amendment changing the technical information in the application/the subject-matter of the application as filed shall not be allowable for legal certainty.

- 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?

The deletion of impermissible added matter could result in an impermissible extension of scope only in after grant procedures.

According to the current law, even in post grant proceedings the deletion of impermissible added matter could not result in an impermissible extension of the scope since, according to Art. 129 DL, last two paragraphs, it is not possible to amend an individual claim, but it is only possible to delete such claim in total.

Firstly, we are of the opinion that the proprietor should be allowed to make an amendment on a patent claim itself, in addition to removing it in its entirety. Such amendment however should not extend the scope of protection as granted. Whether the added matter is permissible can be questioned by the application of a three-point test as practiced by the EPO for the defect to be remedied.

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

It might be useful to address in the current law which could be the consequences and possible remedies for impermissible added matter introduced in the description.

A more clear distinction between the content of the application as filed and the scope of protection defined by the claims should be introduced in the current law.

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

Household appliances, pharmaceuticals.

Summary

The study question reveals several issues from both national and international perspectives in particular that the concept of impermissible added matter shall be defined precisely and there shall be a consensus on the same; some practical means including guidelines and tests as occasions would be necessary to prevent impermissible added matter; and post-grant amendment of claims, in any form, shall be possible in a way to serve a balance between the rights of a patentee and the legal security of 3rd parties.