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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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### 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. Amendments to the description and/or figures of the patent are possible pre-and post-grant, including when the patent's validity may be subject to national proceedings after grant. A number of statutory provisions govern the procedure for making amendments but whether the amendment is permissible as a matter of substance is governed by section 76 of the Patents Act 1977.

#### Pre-Grant

An application for a patent can amend the patent application under section 19 of the Patents Act 1977.

As set out in Rule 31 of the Patent Rules 2007, pre-grant amendments can be made from when the applicant is informed about the search report until the first substantive examination report is sent to the applicant. After this time, amendments can only be made with the consent of the Comptroller. Once the applicant is notified that the administrative grant of the patent has occurred, the applicant can amend patents only under section 27 or section 75 of the Patents Act 1977 (post-grant amendments).

The Comptroller (the head of the UK Intellectual Property Office – UKIPO) also has power to amend an application, but limited to amendments that acknowledge a registered trade mark (section 19(2)).

#### Post-Grant

Granted patents may be amended pursuant to section 27 and section 75 of the Patents Act 1977. Section 27 governs amendment where the patent is not subject to proceedings before the Court or Comptroller. Section 75 governs amendment where the validity of the patent may be at issue in proceedings pending before the Court or the Comptroller.

In both cases, third parties may oppose the patentee's application to amend. The Comptroller must take the opposition into account when deciding whether to allow the amendment (section 27(5)/section 75(2)). In the case of an amendment pursuant to section 75, the Court or Comptroller may (and usually will) order that the amendment is advertised, allowing a period after advertisements in which third parties may file an opposition.

Where the patentee applies to amend the patent before the Court, the patentee must notify the Comptroller who is entitled to appear in the proceedings. In practice, the Comptroller is seldom represented at the hearing of the application to amend the patent, but sends written submissions to the parties and the Court.

#### Amendment at the European Patent Office

In addition to the domestic mechanisms for amendment outlined above, a European Patent (UK) may also be amended in the European Patent Office under Art 101(3)(a) or Art 105b, as a consequence of respectively an Opposition or central limitation

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

Yes. Section 130(5A) Patents Act 1977 provides that the amendment of a patent or its specification includes the limitation of patent claims (as interpreted by the description and any drawings referred to in the description or claims). Amendments to drawings are treated in the same way as amendments to the claims and description (see T169/83).

The position in relation to the power to amend patent claims, either pre or post-grant is set out above.

#### 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 amendments are permissible is set out in section 76 Patents Act 1977. No amendment to a patent or a patent application is permitted if it adds matter as compared to the disclosure of the original application or, in the case of post grant amendments, if it extends the protection conferred by the patent.

#### Pre-Grant

The admissibility of pre-grant amendments are governed by section 76(2) which mirrors Article 123(2) European Patent Convention ("EPC"). This provision provides that amendments are not allowed if they add matter (i.e., "the application disclosing matter extending beyond that disclosed in the application as filed").

The test for added matter is the same pre- and post-grant and is discussed in more detail below in the post-grant section.

### Post-Grant

The admissibility of post-grant amendments is governed by section 76(3) which mirrors Article 123(3) EPC. An amendment will not be allowed if it results in the specification disclosing additional matter or extends the protection conferred by the patent. Post-grant amendments therefore have an additional requirement that the amendment must not extend the scope of protection.

Subject matter will be considered added matter unless it is “clearly and unambiguously disclosed in the application, either explicitly or implicitly”. In *Richardson-Vicks Inc’s Patent* [1995] RPC 568 Mr Justice Jacob (as he then was) summarized the question as “whether a skilled [person] would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.”

The English Courts apply the test for added matter as laid out by Mr Justice Aldous in *Bonzel v Intervention* [1991] RPC 553. This test has been subsequently supplemented by *European Central Bank v Document Security Systems* [2007] EWHC 600 (Pat), and can be summarized as follows:

1. Ascertain through the eyes of the skilled person, who has never seen the patent as amended, what is disclosed, explicitly and impliedly, in the original application. The skilled person is assisted by his or her common general knowledge.
2. Do the same with the patent as amended.
3. Compare the two disclosures. The comparison is strict.
4. Decide whether any subject-matter relevant to the invention has been added explicitly or implicitly – either by deletion or addition.
5. If an added feature provides a technical contribution, then matter will be added as it will provide the patentee with an unwarranted advantage.
6. If an added feature excludes protection for part of the subject matter of the claimed invention as covered by the application as filed, the added feature cannot provide an unwarranted advantage to the applicant.

This extended test was followed by Lord Justice Jacob in the Court of Appeal case of *Vector v Glatt* [2007] EWCA Civ 805. However, the Court of Appeal in the case of *AP Racing v Alcon* [2014] EWCA Civ 40 preferred the simple question posed in *Richardson-Vick’s Inc Patent* noted above.

Section 75 states that the Court or the Controller “may” amend a patent. An amendment that complies with the statutory conditions under section 76 as outlined above may therefore still be refused as a matter of discretion. In exercising its discretion, the Court and Comptroller apply the same principles as does the European Patent Office when considering post-grant amendment (*Zipher v Markem* [2008] EWHC 1379 (Pat)). In consequence, an amendment may be refused if it would offend Art 84 EPC (clarity) or if the application is made so late so as to be an abuse of process (*Nikken v Pioneer* [2005] EWCA Civ 906).

The objection of late filing in the UK does not apply in the case of an application for central limitation at the EPO (*Samsung v Apple* [2014] EWCA Civ 250).

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

No. There is no difference in the substantive standards for amendments as between a description and/or figures and the claims. All amendments to the application or patent are governed by the requirement that they must not add matter to the application as filed and are subject to the same test for whether or not an amendment adds matter.

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.

As noted above at Q3, no amendment to a patent or a patent application is permitted if it adds matter as compared to the disclosure of the original application. Post-grant amendments have an additional requirement that the amendment must not extend the scope of protection.

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.

### **English law**

There is no explicit definition of “impermissible added matter” as such under English law. However, as set out above, subject matter that has not been “clearly and unambiguously disclosed in the application, either explicitly or implicitly” will likely be deemed to be added matter.

It is important to emphasize that matter which has been added (by way of addition or deletion), may not necessarily be “impermissible added matter”. The English Court will look to whether the matter added provides a technical contribution not present in the application (impermissible) (see Kitchin J in *European Central Bank v Document Security Systems*).

Matter may also be added by way of an intermediate generalisation. This occurs where patentees adopt more general wording to describe something more specifically referred to in the claims, in the description or drawings, usually in order to claim a range or class containing the specific embodiments. Such amendments will be impermissible where the feature or embodiment selected gains a technical significance not present in the original disclosure.

It is commonly said that the English Courts are more generous in their approach to added matter than the EPO, and that this difference is particularly manifest in relation to intermediate generalization. By way of example, in *AC Edwards Ltd v Acme Signs & Displays Limited* [1992] RPC 131 the English courts permitted an amendment to claim “spring means” when the description of in the application was more specific, namely a specific embodiment using a coil spring and cotter arrangement. In this case the Court noted an important distinction between what the claims covered and what they disclosed (as explained further below). This has been followed in other cases, e.g. *AP Racing Ltd v Alcon Components Ltd* [2014] EWCA Civ 40. In this case, the Court of Appeal considered that the UK law on added matter was clear and that the law did not prohibit, per se, the addition of claim features that are more general than those described in the specification. However, the law did prohibit disclosure of new information about the invention.

In *Hospira UK Ltd v Genentech Inc* [2014] EWHC 3857 Mr Justice Birss said it not always easy to determine whether such an intermediate generalisation will add matter. However, the cases referred to above established that although the new descriptive language of the claim was not limited to the specific embodiment described in the application and was thus broader, the amendments did not add matter. This was further explained in *IPCom GmbH & Co KG v HTC Europe Co Ltd and others* [2015] EWHC 1034 (Pat) where Mr Justice Birss stated that English patent law draws a distinction between coverage and disclosure of a patent. To amount to added matter the intermediate generalisation must be a generalisation in terms of disclosure, not coverage.

In determining whether an amendment adds matter, the Court will have regard to the policy underlying the prohibition set out in Article 123(2) - namely that the applicant should not gain an unwarranted advantage that could also be damaging to the legal certainty of third parties relying on the content of the original application (see G 1/93 *Limiting Feature / ADVANCED SEMICONDUCTOR PRODUCTS* which was cited by Kitchin J in *European Central Bank*). In *Southco v Dzus* [1990] RPC 587, the Court summarized the underlying policy as preventing a patentee from “altering his claim in such a way as to

claim a different invention from that which was disclosed in the application”.

### **EPO**

With regard to intermediate generalisation at the EPO, the Guidelines for Examination Part H, Chapter V, section 3.2.1 sets out the following test:

- *Extracting a specific feature in isolation from an originally disclosed combination of features and using it to delimit claimed subject-matter may be allowed only if there is no structural and functional relationship between the features.*

*When evaluating whether the limitation of a claim by a feature extracted from a combination of features fulfils the requirements of Art. 123(2), the content of the application as filed must not be considered to be a reservoir from which individual features pertaining to separate embodiments can be combined in order to artificially create a particular combination.*

*When a feature is taken from a particular embodiment and added to the claim, it has to be established that:*

*the feature is not related or inextricably linked to the other features of that embodiment and the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim.*

*These conditions should be understood as an aid to assessing, in the particular case of an intermediate generalisation, if the amendment fulfils the requirements of Art. 123(2). In any case it has to be ensured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using his common general knowledge. “*

When discussing the removal of a feature from a claim (which is effectively a form of intermediate generalisation), The EPO Guidelines Part H, Chapter V, Section 3.1 describes the circumstances in which a feature in a claim can be replaced or removed without adding matter:

*“The replacement or removal of a feature from a claim does not violate Art. 123(2) if the skilled person would directly and unambiguously recognise that:*

- i. the feature was not explained as essential in the disclosure;*
- ii. the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve; and*
- iii. the replacement or removal requires no real modification of other features to compensate for the change.*

*In case of a replacement by another feature, the replacing feature must of course find support in the original application documents, so as not to contravene Art. 123(2) (see T 331/87).”*

Our assessment is that although the EPO have historically tended to apply the test for added matter strictly when considering intermediate generalization, the formulation of the test in the EPO Guidelines does not require such a strict application. The “technical contribution” test applied by the English courts (*Richardson-Vick’s Inc’s Patent* discussed in Q3a above) is similar in effect to the EPO test set out above.

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;

It is interpreted through the eyes of the skilled person with the assistance of his or her common general knowledge. The skilled person is deemed not to have ever seen the patent as amended. This is important as it is crucial that that skilled person does not benefit from hindsight.

- 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 relevant date to consider is the filing date of the patent application (not the later date of grant). It is important that the skilled person does not take a hindsight approach and considers the disclosure of the application without seeing the amended specification (*European Central Bank v Document Security Systems* [2007] EWHC 600 (Pat)).

Case law does not provide a definitive answer on the relevant date for knowledge of the person skilled in the art but suggests that it is the filing date of the application. *G2/10 Disclaimer/SCRIPPS* states amendments can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (see paragraph 4.3 of that decision).

As a matter of policy, it seems right that the skilled person should have the patent application in his/her knowledge. The exercise of interpreting the patent application to derive its meaning must take place with the application in hand. Hence the identity of the skilled person may be different for the purpose of assessing whether matter has been added than for the exercise of assessing whether the application involves an inventive step, where knowledge of the invention is not permitted. This difference will only matter in situations such as in *Schlumberger v Electromagnetic Geoservices* [2010] EWCA Civ 819 at para 64, where the invention itself is art-changing (see also *Luminescent Security Fibres/Jalon* T422/93).

- 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:

If before the UK IPO, it is unlikely that the UKIPO will place any reliance on the fact that the amendment has previously been approved by an examiner. There is little judicial or statutory basis allowing them to do so.

If before the English Court, it is similarly unlikely that the Court (as a higher judicial body), will place any reliance on the fact that the amendment had been previously approved by the UK IPO.

Both the UK IPO and English Court will conduct the assessment of added matter afresh to determine if the amendment is permissible or not. Depending on the nature of the defect, the defect may or may not be easy to remedy.

However, as a matter of practice, the English Court can be reluctant to entertain post-judgment applications to amend (see for example the comments from the Court of Appeal in *Nikken v Pioneer*, [2005] EWCA Civ 906, and *Nokia v ICom* [2011] EWCA Civ 6). Applications to amend must be brought to the attention of the parties and the Court as early as possible before trial, so that all matters at issue can be dealt with efficiently in one hearing. Late amendments can be struck out for abuse of process (see *Mylan v Warner-Lambert* [2015] EWHC 3370. For this reason, it is generally advisable for a patentee to make conditional applications to amend their patent should the Court decide against them in respect of their main amendment application.

The EPO Enlarged Board of Appeal considered this in G1/93 and the EPO Guidelines for Examination (Part H, Chapter IV, Section 3.6) state:

“A possible conflict between the requirements of Art. 123(2) and (3) may occur where, in the procedure before grant, a feature was added to the application which is considered unallowable under Art. 123(2) in opposition proceedings. In that case, Art. 123(2) would require deletion of such a feature whereas Art. 123(3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100(c). However, where this feature can be replaced by a feature for which there is a basis in the application as filed and which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see G 1/93). The technical significance of a feature in a claim is governed by its contribution to the technical definition of the claimed subject-matter, and that contribution is to be assessed by the skilled person in the light of the original disclosure (see T 518/99).”

## 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?

Pre and post-grant amendments are dealt with similarly. We therefore deal with the law on pre-grant balance together with the law on post-grant balance below at Q10.

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

yes

Please explain:

Pre and post-grant amendments are dealt with similarly. We therefore deal with proposed improvements to the law on pre-grant balance together with the proposed improvements to the law on post-grant balance below at Q11.

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. The current law recognizes the importance of the safeguards in place on preventing additional matter being added, particularly after grant. It is recognized that this is to prevent an applicant from improving his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal certainty of third parties relying upon the content of the original application (see *Medimmune Ltd v Novartis Pharmaceuticals UK Ltd & Anor* [2011] EWHC 1669 (Pat) which cites the above passage from G1/93 *Advanced Semiconductor Products* [1995] EPOR 97).

The balance is brought about through using the tests laid down in the case law and keeping in mind the reasons for the safeguards.

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

yes

Please explain:

Yes. Presently, there is a difference in approach between the EPO and the English Courts on added matter which could be improved, in particular with respect to intermediate generalisations (see Q5).

The test for the permissibility of an amendment is set out in the EPO Guidelines which state:

"An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art."

Like the English test, the EPO also adopts the perspective of the skilled person using his or her common general knowledge. Despite new guidelines (updated Part H-IV, 2.3 in November 2014), the EPO has recently stated that it is not taking a more lenient approach to added matter (T 1363/12). The EPO's approach therefore often considers an amendment generalizing a feature will not meet the "directly and unambiguously derivable test".

Under English law, however, intermediate generalizations are more often permissible. As set out above there are several cases from the English Court which have permitted patentees to adopt a more general wording to describe something more specifically referred to in the claims, from the description or drawings e.g. *AC Edwards*.

Given this difference in approach, patentees are faced with uncertainty whereby amendments are disallowed by the EPO that would have been permitted under English law. Mr Justice Birss commented in *Hospira v Genentech* [2014] EWHC 3857 that in practice this makes the task of applying the law in this area is made more difficult by the fact that the EPO does not approach added matter in the same way.

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?

The approach is difficult in practice to use. The judge adopts the position of the person skilled in the art for the purpose of assessing added matter and usually does so without the assistance of expert witnesses. This is different to other aspects of the law where expert witnesses have a central role in assisting the court to don the mantle of the person skilled in the art (sufficiency, obviousness, novelty and construction).

There is also limited case law on the date at which the person skilled in the art should opine on whether matter is added. It would benefit from clarification.

### 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:

Yes

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

We suggest the following definition which is based on the definition of Mr Justice Jacob in *Richardson-Vick's Inc's Patent* discussed in Q3a above as set forth again below and application of the EPO Guidelines for Examination discussed in Q5 above (particularly the consideration of the removal of a feature from a claim):

“An amendment involves the impermissible addition of matter when the person skilled in the art would, upon looking at the amended specification, learn anything which provides a technical contribution to the invention (as defined in the claims) that was not contained in the application as filed”

We consider that this formulation strikes the correct balance in policy by providing flexibility for a patentee to amend its patent, while ensuring that legal certainty is maintained for third parties. In particular, by focusing on whether a new “technical contribution” is disclosed by the amendment, the definition ensures that a patentee is unable to obtain an unwarranted advantage as a result of claiming a wider monopoly for a previously undisclosed technical contribution.

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:

No

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:

No

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:

Yes.

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 filing date. The test is determining what material is added to the application as filed and we submit that an applicant or patentee should not be able to make an amendment which would not have been allowable if made on or shortly after filing, allowable at a later date because of, for example, general developments in the state of the art after the filing 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?

We believe that the EPO test set out in G1/93 and the EPO Guidelines for Examination (Part H, Chapter IV, Section 3.6) and discussed in Q7 above is a sensible compromise between the legitimate interest of both the patentee and third parties.

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

The UK IPO and EPO provide examples of amendments which are considered to add matter and of amendments which are considered to be allowable. Patent Offices around the world should be encouraged to follow this helpful practice.

AIPPI might wish to consider whether it is in a position to help produce such examples.

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

Summary