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2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

Vietnam

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Date

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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?

- For patent application: The Vietnam IP law and regulations allow the description and/or figures of a patent application to be amended, provided that the amendments shall neither enlarge the scope of the subject matter as disclosed in the description as filed nor alter the nature of subject matter claimed in the description and shall ensure the unity of the application.

- For granted patent: The Vietnam IP law and regulations do not say anything about the possibility of making amendments to the description and/or figures of a granted patent. In practice, however, it is possible to request for correction of certain minor errors, e.g., translation errors, typos, etc., in the description and/or figures of a granted patent.

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

Yes. However, there are some differences between the amendments to the claims of a patent application and of a granted patent.

- For patent application: The amendments to claims shall neither enlarge the scope of the subject matter as disclosed in the description as filed nor alter the nature of subject matter claimed in the description and shall ensure the unity of the application.

- For granted patent: the amendments to claims are to narrow the scope of protection, and as such the granted patent shall be re-examined.

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.

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For patent application: The National Office of Intellectual Property (NOIP) of Vietnam follows the NOIP's Guideline for Patent Examination when determining whether amendments to the description (including claims, drawings, and figures) and abstract of the patent application are permissible.

An amendment generally will be accepted if:

- not expand the protection coverage (or increase the protection volume) beyond the contents disclosed in the description and not alter the nature of the subject matter stated in the description, and
- the added matters are determined directly and unambiguously from the description as filed.

Furthermore, no objection will be raised if adding the following contents into the description:

- adding new effects of the invention that were not mentioned in the description as filed provided that the effects can be determined directly and unambiguously by the skilled person;

- adding the section of "Brief description of the drawings" provided that the originally filed application is accompanied by a set of drawings but the description of the drawings were not included in the application as filed; and

- adding contents relating to the prior arts of invention since these prior arts is the previously published technical solutions and are not the invention itself.

For granted patent: The amendments to granted patent are to narrow the scope of protection of claims. Such amendments must be determined directly and unambiguously from the description as filed.

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

No.

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.

For patent application: The standard mentioned in question 3) does not change in the period from application filing to patent granting.

For granted patent: After grant, the amendments are only to narrow the scope of protection of the claims. Of course, such amendments must be determined directly and unambiguously from the description as filed.

- 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 added matters shall be impermissible if they do not meet the conditions mentioned in the answer to question 3. In addition, the NOIP's Guidelines for Patent Examination specify some added matters will be rejected as follows:

- Subject matters after amendment are not disclosed in the description as filed;
- Subject matters claimed in the amended claims contains features that are not sufficiently supported by the description;
- Nature of subject matters after amendment are differ from one stated in the application as filed;
- The person skilled in the art consider that the information in the application after amendment are differ from the information expressed in the application as filed;
- The added features cannot be determined directly and unambiguously from the description as filed;
- Added information cannot be determined directly and unambiguously from the description as filed;
- Added detail/component that are not mentioned in the original documents

Adding effect of the invention that are not determined directly and unambiguously by skilled person.

- 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;

In Vietnam IP law and its regulations, there is no specific provision on the definition of the patent application as filed. In practice, however, it is generally interpreted as the application filed at the filing date. Please note that the filing date of a national phase application derived from a PCT application is the date of filing the PCT application. That is, in this case, the patent application as filed is the originally filed PCT 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?

For assessing inventive step, the NOIP's Guidelines for Patent Examination states that the person skilled in the art relies on the technical solution known prior to filing date or earliest priority date of the claimed subject matters, thus the relevant date of knowledge of the notional skilled person is the date right before the filing date or the earliest priority date of the invention. We believe that this understanding is also applied in assessment of impermissible added matter.

- 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:

The Vietnamese IP law and its regulations allow the patentee to amend the granted patent by narrowing the scope of protection of claims, such as by deleting some claims from the claim set. Thus, in order to remedy the defect in question, the patentee should remove the entire claims containing the impermissible added matter from the claim set. If the impermissible added matter constitutes an essential technical feature of a claim, then the removal of such impermissible added matter shall be considered as extending the scope of protection of the claim. The Vietnamese IP law and its regulations allow the patentee to amend the granted patent by narrowing the scope of protection of claims, such as by deleting some claims from the claim set. Thus, in order to remedy the defect in question, the patentee should remove the entire claims containing the impermissible added matter from the claim set. If the impermissible added matter constitutes an essential technical feature of a claim, then the removal of such impermissible added matter shall be considered as extending the scope of protection of the claim.

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?

The Vietnamese IP regulations stipulate that the application can be amended or supplemented but the amendment must not expand the protection coverage beyond the contents disclosed in the description and not alter the nature of subject matter claimed in the description.

- 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. The post-grant amendment is allowed provided that it must limit the scope of protection of the claims as originally granted. And, the patent with these amendments shall be re-examined as to whether it satisfies the criteria of protection and whether the amendments are permissible (we mentioned in our answer above). The claims after this amendment should be supported by the original description.

- 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?

The Vietnam IP law finds that the person skilled in the art would be the right standard to apply.

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, we believe that it is desirable to harmonise the definition of impermissible added matter. In practise, the NOIP often grants a patent based on the examination results of corresponding application filed in foreign country, e.g. EPO, USPTO, JPO, etc., therefore this harmonisation between Vietnam and other countries should be expressly mentioned in legal documents to provide a legal certainty for the patentee and the third parties.

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

We propose that a definition of impermissible added matter could be worded in accordance with the Art.123(2) of EPO Examination Guideline.

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, it is generally not desirable to have a definition with separate meanings depending on at what time the 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:

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?

We propose that the relevant date of knowledge, as a main rule, should be the effective filing date, i.e. the filing date or the earliest priority if the priority is claimed.

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?

No.

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

No additional comments.

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

Summary

Under the Intellectual Property Law and Regulation of Vietnam, it is possible to make amendment to both patent application and granted patent. However, there is quite different between the amendment to patent application and granted patent. The amendment to granted patent is restricted to narrow the scope of protection of the claims while the amendment to patent application is less strict. That is, the amendment of patent application just is generally accepted if it does not expand the scope of protection disclosed in the description and not alter the nature of subject matter claimed in the description.