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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?

*In general, amendments to the description and/or figures are possible for both direct BE and EP-BE patent applications and patents.*

*The relevant provisions in the Code of Economic Law (CEL) are as follows:*

*For direct BE patent applications:*

*- Art. XI.23. §1 CEL make clear that the application can be amended before the Belgian Patent Office and the Courts. § 6 of that same provision states that if the claims are amended, the description shall be amended accordingly.*

*The provisions for making amendments are outlined in Art. 25 of the Royal Decree on Patents of December 2, 1986.*

*- Art. XI.55. §8 CEL states that it is possible to partially (or completely) abandon the patent application. A partial abandonment can only be achieved through a modification of the claims. If necessary, the description and figures can be modified to be brought in line with the claim amendment leading to the partial abandonment. Such a partial (or complete) abandonment has an ex nunc effect.*

- Art. XI.56. §7 CEL states that it is possible to partially (or completely) revoke the patent application. A partial revocation can only be achieved through a modification of the claims. If necessary, the description and figures can be modified to be brought in line with the claim amendment leading to the partial revocation. Such a partial revocation (limitation) or complete revocation has an ex tunc effect.

The provisions for making amendments under Art. XI.55. and XI.56. CEL are outlined in Art. 30 of the Royal Decree on Patents of December 2, 1986.

- In case the BPO finds that more than one invention is present in the claimed subject-matter and a lack of unity objection is raised, the protection will be deemed to be limited to the invention that was searched (Art. XI.19 CEL, §4 and 5). In principle, the application needs to be limited to the invention searched, but this is at present not examined by the BPO (Art. 19. Royal Decree of December 2, 1986).

For direct BE patents:

- Art. XI.55. §1 CEL states that it is possible to partially (or completely) abandon the patent. A partial abandonment can only be achieved through a modification of the claims. If necessary, the description and figures can be modified to be brought in line with the claim amendment leading to the partial abandonment. Such a partial (or complete) abandonment has an ex tunc effect.

- Art. XI.56. §1 CEL states that it is possible to partially (or completely) revoke the patent. A partial revocation can only be achieved through a modification of the claims. If necessary, the description and figures can be modified to be brought in line with the claim amendment leading to the partial revocation. The partial (or complete) revocation has an ex tunc effect in analogy with the central limitation and revocation procedure before the EPO.

- Art. XI.57. §1 CEL states that the Courts can declare a patent partially invalid. § 2 clarifies that in case of partial invalidity, the patent will be limited by amending the claims and if needed of the description and drawings. Such an amendment will be registered in the Patent register.

EP-BE patent applications:

- For European patent applications, pending before the EPO, the relevant provisions of the European Patent Convention (EPC) apply. These are stipulated in Art. 123 EPC and allow amendment of the application as a whole.

EP-BE patents:

- There is no specific provision in the CEL regarding amendment of Belgian chapters of European patents. According to Art. 2(2) EPC however, European patents shall in the contracting states have the effect of and be subjected to the same conditions as a national patent granted by that state, unless provided otherwise in the EPC. Hence such patents are deemed to be covered by Art. XI.55, XI.56, and XI.57 as indicated above for direct BE patents. We refer to the Laws of July 8, 1977 and of April 21, 2007, which state that European Patents validated in Belgium are considered as Belgian Patents.

- Art. 3. §3 of the Law of July 8, 1977 also provides the possibility of filing a translation of the pending claims of European Patent Applications to the BPO, which will enter those in the Patent register, allowing the possibility of seeking provisional protection. The provisions for filing such a translation are governed by Art. 4 of the Royal Decree of February 27, 1981.

- Finally, Art. 105 EPC provides a central limitation procedure before the EPO. The limitation of the claims will be effective in all designated states and has an ex tunc effect.

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

- Please see answer to question 1).

- Also Art. XI.55, XI.56, and XI.57 CEL explicitly require the amendment of 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 direct BE patents/applications:*

- Art. XI.23 §6, 3° CEL states that “the application cannot be amended such that its subject-matter extends beyond the content of the application as filed”. Courts largely refer to the case law of the Boards of Appeal of the European Patent Office (“EPO”) in applying this standard (cf. e.g. decision of the Court of Mons, January 12, 2012, IRDI 2012, p150).

- Art. XI.55, 56, and 57 CEL also state that “the patent cannot be amended such that its subject-matter extends beyond the content of the application as filed”, and that the patent cannot be amended such that the scope of protection is extended versus the previous version of the patent in force.

- Although there are no explicit provisions in the CEL regarding the standard to be applied for making such amendments, we do note that there has been a court case in Belgium where such a standard for allowing an amendment to the claims after grant has been explicitly mentioned:

“This reformulation (as a consequence of the partial revocation) is accepted by the court, considering that:

- It is clear, both on the basis of the patent specification as well as the state of the art, where the limits of the protection are. This is clear upon reading the description, where it is stated already on page 2 line 2 that the invention specifically relates to ‘resorcinol aldehyde resins’.

- From what was known from the state of the art, it was clear to the man skilled in the art that the specified limitation was in accordance with the state of the art on the priority date of EP’741.

- The reformulation does not give rise to a new invention, but rather a consequence of what was stated first and foremost in the description (and the examples given therein).” (cf. *Indspec Chemical Corporation v. N.V. Sumitomo Bakelite Europe*, Antwerp commercial court, Belgium, 2 July 2010, IRDI, 2012, p. 30).

*For EP-BE patents/applications:*

- The relevant provisions of the European Patent Convention (EPC) apply (governed by Art. 123 EPC for applications and Art. 100(b) for patents), as well as the Guidelines for Examination (GL Part H, Chapter IV, Allowability of amendments) and Case Law of the (Enlarged) Boards of Appeal (cf. Case Law Book 7th edition September 2013, pages 360 to 439).

- The general standard has been outlined in e.g. G 2/10 (OJ 2012, 376), G 3/89 and G 11/91, in that amendments are permitted within the limits of what the skilled person would derive directly and unambiguously, using common general knowledge from the application as filed (cf. also GL Part H, Chapter IV, 2.1).

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

*- In general there is no difference in standard regarding amendments of claims versus description or drawings, but after grant it is necessary to amend the claims in order to be able to amend the specification and drawings (i.e. to adapt the description and drawings to the claims).*

- 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.

*- In general there is no difference in the standard of making amendments before examination, during examination or after grant except for the fact that after grant an amendment cannot lead to an extension of the scope of protection (covered by Art. XI.55, XI.56, and XI.57 CEL as indicated above for direct BE patents and by Art. 123(3) and 100(b) EPC) for EP-BE patents.*

- 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.

*- Again, the CEL does not explicitly mention a standard and neither does the EPC.*

*- Case Law of the Boards of Appeal of the EPO however defines impermissible added matter as “any amendment that cannot be directly and unambiguously derived from the application documents (specification, claims and drawings) as filed taking into account the common general knowledge at the time of filing of the application. This standard is applied also by the Belgian courts as outlined above. In practice, we distinguish three main classes of amendments:*

*o When features are added, the so-called “novelty test” is often used to determine whether or not the amendment renders the claimed subject-matter new over the subject-matter as originally filed (cf. Case Law of the Boards of Appeal of the EPO (7th Edition, September 2013, II.E. 1.7.3; and Guidelines of Examination Part H, Chapter IV, 3.1). In Belgium, this approach has been followed e.g. in decision A/10/01876 Botania e.a. / Overstock Garden by the commercial Court of Ghent dated March 15, 2012.*

*o If intermediate generalization is pleaded, the assessment is made if the feature can be uncoupled from the remaining features with which it was accompanied in e.g. an embodiment or example. If there is no functional or structural relationship with those other features, introducing said feature could be allowed into a more general embodiment. If there is a functional or structural relationship, said feature cannot be taken out of its original embodiment or example and should only be introduced in combination with the other features it is interacting with (cf. Case Law of the Boards of Appeal of the EPO 7th Edition, September 2013, II.E.1.2; and Guidelines of Examination Part H, Chapter IV, 3.2.1). This approach has been confirmed e.g. by the commercial Court of Mons in a decision of January 12, 2012, IRDI 2012, p150.*

*o When features are deleted, the “essentiality test” is often used, which intends to verify whether or not the deleted feature is essential to the embodiment claimed. If yes, it cannot be deleted, if not, it can be deleted (cf. Case Law of the Boards of Appeal of the EPO 7th Edition, September 2013, II.E. 1.7.2; and Guidelines of Examination Part H, Chapter IV, 3.1). This has e.g. been confirmed by the commercial Court of Antwerp in decision A/13/84 Friesland Brands / Incopack of October 15, 2013.*

*- It should be noted that in some cases the different tests can be used in combination. Especially in case of intermediate generalization, both the novelty test and essentiality test could be applied.*

- 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 Belgium, the application as filed is defined in accordance with EPO standards. It hence includes all parts of the application as filed including specification, claims and drawings.

- It however does not include the abstract (cf. e.g. T 606/06 and Decision of the Commercial Court of Mons, January 12, 2012, IRDI 2012, p150 and decision of the Commercial Court of Ghent of March 15 2012, case A/10/01876 Botania e.a. / Overstock Garden). This is also confirmed for EP-BE applications which are governed by Art. 85 EPC, indicating that the abstract can only be used for search purposes.

- In accordance with the Case Law of the Boards of Appeal of the EPO, also the priority document cannot form the basis for an amendment for the application claiming priority therefrom (cf. e.g. T 260/85).

- Of note, we refer to Rule 56 EPC indicating that the priority document can in certain cases be used to correct missing pages upon filing. We however feel this is beyond the scope of this question.

- Furthermore, we would like to mention that in case the European patent application has been filed in a non-admissible language (i.e. other than English, German or French), a translation needs to be filed in one of said three languages (Art. 14 EPC). The authentic text however, which will form the basis for judging admissibility of amendments will however be the text as originally filed in the non-admissible language (Art. 70 EPC).

- Art. XI. 17 §3 and 5 CEL also provides the possibility of filing a Belgian patent application in any language, where after a translation needs to be filed in one of the National languages (Dutch, French, or German). It is however important to note that no provision according to Art. 70 EPC exists in the CEL and that in case of directly filed Belgian patent applications the translation will likely figure as the reference text for judging admissibility of amendments, although this has not yet been discussed in any Belgian jurisprudence.

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 knowledge on the filing date applies for determining the knowledge of the notional skilled person. This is governed by the Case Law of the EPO cf. G 3/89 (OJ 1993, 117) and G 11/91 (OJ 1993, 125) which indicate clearly that the common general knowledge should be “seen objectively and relative to the date of filing, from the whole of these documents as originally filed”.

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:

- Yes it is possible to remedy in view of Art. XI.55-57 CEL, provided the scope of protection is not extended beyond the scope of protection of the claims as granted.

- This is in fact a reflection of the provisions of Art. 123(3) EPC for granted patents during e.g. Opposition or Limitation Proceedings before the EPO.

- We note that every amendment is subject to fulfilling the other criteria of allowability such as novelty, inventive step, industrial applicability, and enablement. The allowability of amendments is not

*assessed before the BPO and can only be assessed before the Court. Since lack of clarity is not a ground for revocation of a patent, clarity of amendments executed before the BPO is in general never assessed.*

*- To be complete we also refer to Art 138(2)(3) EPC which indicates that European patents validated in a contracting state can be limited and partially revoked in said contracting state.*

## 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?

*- Before the EPO there is a good balance in the law, but allowability of amendments is often examined in a rather strict manner (as compared to e.g. USPTO), leading to an over formalistic approach. The notion "directly and unambiguously derivable" is sometimes interpreted as requiring literal basis for the amendment, which was in our view not the purpose of the definition. Recently, the EPO examiners have embarked on a route towards a more relaxed approach regarding allowability of amendments, but it remains to be seen if this is followed by the (Enlarged) Boards of Appeal.*

*- For direct BE patents, the Belgian patent office in practice has a so-called registration procedure meaning there is no substantive examination as to whether or not the application fulfills the substantial requirements of the law. Only a formal examination is made to check whether e.g. all documents needed have been submitted. Only the court can decide on the permissibility of amendments.*

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

yes

Please explain:

*- There is a debate between the Group members as to whether or not it would be helpful to have the added-matter (and other substantive) issues examined by the Belgian Patent Office, rather than having a mere registration procedure where only formality checks are performed.*

*- There also is a need for improvement of publication of amendments made during the prosecution procedure and those accepted in decisions of the courts. The former is likely to occur, due to the recent introduction of the on-line filing system.*

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?

*- Art. XI. 55 and 56 CEL deal with making amendments after grant, which are not examined by the BPO.*

*- In case of the central limitation procedure before EPO, the amendments are checked by the Examiner and the balance is generally fine.*

*- Post grant procedures before the Belgian courts are generally also interpartes proceedings which implies that each amendment proposed can be contested by the other party in the proceedings. In result, such amendments should be appropriately assessed for fulfilling the standards as indicated above.*

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

yes

Please explain:

- *Centralization of jurisdiction over patent cases in the Brussels courts helps in streamlining the interpretation of the Law.*

- *A pure registration system as we have now in Belgium necessitates a full review body to assess if the requirements of patentability, clarity, unallowable amendments etc. are fulfilled.*

- *Another improvement would be to incorporate information regarding pending Court procedures and/or Court decisions into the patent register.*

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?

- *This is only assessed before the Belgian courts, and is used correctly in line with Case Law of the EPO. The cut-off date for said common general knowledge is the filing date of the application.*

- *Since said approach is deemed effective, we do not immediately see a reason for improvement.*

### 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.

- *The general definition used in the case law is clear: "directly and unambiguously derivable by the skilled person at the time of filing".*

- *The interpretation of said definition is of course more difficult to define, but in general we do believe that it does not mean that literal basis for the amendment needs to be present as long as said amendment can be clearly and unambiguously derived from the original text of the application.*

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)?

yes

Please explain:

- *Timing should not be important for the definition of an allowable amendment.*

- *Of course, extension of scope of claims after grant, which is not always resulting in an added matter*

*issue, should not be allowed.*

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

*- The type of amendment should not be relevant, as long as the standard is fulfilled.*

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

no

Please explain:

*- The type of amendment should not be relevant, as long as the standard is fulfilled.*

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 should be the filing date of the application.*

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?

*- This is the so-called "inescapable trap" governed by Art. 123(2) and 123(3) EPC.*

*- In principle, there are no remedies available after grant for such a situation, unless a further adequately supported amendment resulting in further limitation of the resulting scope of the claims versus the claims as granted could solve the problem.*

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

*- The definition as such of "directly and unambiguously derivable by the skilled person at the time of filing" as used in current Case Law is as such acceptable, but the execution and interpretation of said definition by the different patent offices and courts requires harmonization.*

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

Summary



*The Belgian Group of AIPPI hereby provides an answer to the questions posed regarding the standard for determining adequate support for amendments in patent applications and patents in Belgium. For all questions, the Belgian Group makes a distinction between directly filed Belgian patent applications/patents and granted European patents validated in Belgium. In summary, the Belgian Code of Economic Law (CEL) allows making amendments to the claims, description and drawings of both Belgian and European patent applications, either before or after grant. The standard applied for determining whether or not an amendment is allowed is, although not mentioned as such in the CEL, the same standard as the one used by the European Patent Office, i.e. the requirement that an amendment should be “directly and unambiguously derivable from the application (including claims, specification and drawings) as originally filed taking into account the common general knowledge of the skilled person at the time of filing”. There is hence a fair balance between the possibilities and restrictions towards making amendments in the CEL. However, for directly filed Belgian patents, said standard is only applied by the Courts (post-grant) and not by the Belgian Patent Office (prior to grant). Today, there is also no link between the Belgian patent Register and information on pending Court cases, which makes it difficult to evaluate the validity of a Belgian patent (or of a European patent validated in Belgium) for third parties during such proceedings. The relevant provisions in the law are outlined in the report.*