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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

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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?

After filing, the subject matter of the application cannot be extended beyond the subject matter of the initial application (Art. 65 of ZIL-1). The inclusion of patent subject matter is mandatory in relation to the claims (Par. 4, Art. 87. of ZIL-1). The description of the patent (Art. 87 of ZIL-1) must be concise and complete to the level that enables the skilled person in field to use the applied patent, meaning that it should naturally include the patent subject matter. The summary is required for the purposes of technical information, and should not be used in any other way, especially not in relation to substantiation of the patent scope (Art. 87 of ZIL-1).

Therefore, any amendments shall comply with the criteria described above, regardless if related to description or/and figures.

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

The contents and elements of the application (request for patent grant, description of invention, one ore multiple patent claims, invention summary, figure ore figures, if required) are regulated within Art. 86 and 87 of ZIL-1.

The regulation in force does not distinguish amendments per specific elements of patent application. The admissibility of amendments is judged by their contents (relying on criteria of Art. 65 of ZIL-1)

irrespective to which part of the application they relate (however not after the grant of the patent).

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 only regulatory standard applicable relates to the subject matter (predmet) criteria (Art. 65 of ZIL-1), which shall be demonstrated within the claim (Par. 4, Art. 87 of ZIL-1). This relates to the invention itself, the problem which is solved by the invention and the manner in which the problem solved. Together with criteria for patentability (novelty, inventive step, industrial applicability (Art. 10-15) this constitutes limits of patent subject matter in their contents. If any of those are altered the patent office may see such change as inadmissible in relation to the criteria explained above and common aliud rule.

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

Not applicable, see answer 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.

The statute does not specifically provide any signs of different assessments in relation to added subject matter due to the time of the change. However, due to the practice of the patent office any amendment after grant shall not be allowed except if the scope of the patent becomes narrower (partial limitation of the scope of the patent is allowed via special provision pursuant to Art. 77 ZIL-1; so called partial withdrawal).

Moreover, it should be noted that changes in patent application after the grant are subjected to special regime of convocations of patent office regarding amendments which are required for the avoidance of partially or fully negative final (declaratory) decision (Art. 93 of ZIL-1). Shall the changes be made in accordance with such convocation; they shall be seen as de lege permissible. In our opinion this should not restrict applicant to independently propose amendments (without convocation) if they comply with Art. 65 of ZIL-1 rule. However, until the final (declaratory) decision, the applicants enjoy the protection within the scope of patent deriving from the claims published before the grant (Par. 2, Art. 90. of ZIL-1).

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.

As amendment which changes or substantially differs the patent subject matter (Art. 65 of ZIL-1, see also answer under 3a).

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;

The patent application is either published (and granted) or refused, pursuant to rules of Art. 88-90 ZIL-1. Please note that according to our Group's current law the examination before grant is limited to extended formality check only (this was discussed in previous reports of our Group). The final (declaratory) decision is made on a basis of assessment if the patent applied for and the respective claims can be subject to patent (protection), taking into account all of the requirements and conditions, set by the law (Art. 93 of ZIL-1). Please also note again on the mechanisms of amendments prior to final decision (see 4., above).

- 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?

Date of application or date of prior use, if claimed.

- 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. See answer under 4).

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 general rule seems to provide appropriate balance in this relation. However, clearer and foreseeable operational rules would be beneficial for better implementation/assessment of subject matter rule. The rule of the patent protection in the period from the grant until the final decision (scope of patent protection according to the claims published at grant), may favour from certain changes that would enable confirmed amendments (from the side of the patent office) to be a part of the in-force patent claims in the period until the final decision is rendered. This also relates to the question of the translation of the claims that were changed within proceedings before third authorities (e.g. EPO).

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

yes

Please explain:

See under 8.

- 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?

The law does not provide any differences in relation to the time of the amendment. However, after

grant amendments, although not specifically prohibited pursuant to the legislation, are not in practice allowed by the patent office. Please see also Item 4.

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

yes

Please explain:

See under 8.

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?

Authorized persons at patent office decide on permissibility of amendments. They are skilled in different areas of expertise. Technically appointment of experts would be also possible pursuant to general administrative procedure rules which apply mutatis mutandis in patent procedures (Art. 6 of ZIL-1) however such an approach is not common in practice.

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 is any change in patent request, patent description, patent claims and/or figures, proposed in any stage of patent procedure, that would substantially change or alter the proposed patent in a way that would not relate to initial matter with regards to the identity of innovation proposed (including -cumulatively the problem description, proposed solution and a manner in which the solution solves the problem), taking into account all the criteria for patentability as prescribed by the law. Changes that are accepted as permissible by the competent authority bring legal consequences as they are set by the law.

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. Proposed definition is basically the same regardless the time of proposed amendment. Some changes and harmonization would be proposed, though, in relation to validity and enforceability of claims within the timeline of the patent procedure.

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

Yes. One could claim (as one a possible mean of argumentation) that any further claims automatically mean added matter. Should such argumentation not be accepted clear rules of cumulating patent claims (without changing a subject matter) may be considered as an option.

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. As long as the remainder of application (claims) meet the criteria for patent grant (protection) under the national laws.

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. However, the cases, when the court deliberates on added mater under the Group's national jurisdiction are very limited.

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?

In general, the application date (or prior use date) should be respected. However, should the change of the application influence the contents of the decision in relation to the basic conditions of patentability (or a contrario should the change try to avoid certain parts of assessment) later dates should be also considered.

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?

It may be considered as inadmissible change or a reason for refusal of the patent (irrespective of specific proceedings in which such consequence would be achieved).

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

We recognize the importance of the issues raised within this questionnaire. We would like to add however that patent related issues represent a small portion of legal activities in our country, albeit they are important for commercial flows in international perspective. The practices do not help much in this relation, either, since the number of decisions is relatively small and does not constitute a fully reliable case-law. The first goal for the national regulations would be thus to create a set of concise, foreseeable, coherent and enforceable rules which would enable fast, accurate and dispute free

activities in relation to patent procedures, irrespective of the contents of specific rules. In short, irrespective of concrete regulatory solutions, we are keen to adopt changes which will be simple enough and coherent in relation to other regulatory solutions to provide optimum outcomes, also in relation to international business activities.

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

Summary