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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

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

Yes

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.

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

The Law requires that no change can include any material which extends the scope of protection of the Patent.

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.

Prior to issue of the grant, the Law states as follows:

- No amendment or correction of the application may go beyond what has been disclosed in the application as filed.

After issue of the grant, the Law states as follows:

- The proprietor of a patent shall, ..., have the right to request the Comptroller to make changes in the patent in order to limit the extent of the protection conferred by it.
- The proprietor of a patent shall have the right to request the Comptroller to make changes in the patent in order to correct mistakes or clerical errors, made in good faith.
- No such change in the patent may go beyond what has been disclosed in the application 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.

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;

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?

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?

no

Please explain:

Although there are no local court pronouncements on this issue in our opinion it would be possible for the patentee to remedy the defect by applying to reduce the scope of protection accordingly, and such an application would likely be accepted.

## 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?

Please see reply to q. 4.

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

no

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Please explain:

We have no particular comment in this regard.

- 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?

Impermissible matter should be refused by the Examiner in terms of law, when an amendment application is filed at the Office of the Comptroller of Industrial Property.

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

no

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Please explain:

We have no particular comment in this regard.

- 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?

There are no local judicial pronouncements in this regards, and consequently we feel that we are not in a position to comment. Are there aspects of this that could be improved? We have no particular comment in this regard.

### 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.

no

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Please explain:

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

- 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)?

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

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

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

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?

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?

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

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

Summary