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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, in grant proceedings. In post grant proceedings, only limitation of the patent is possible, which has been understood as preventing such amendments.

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

Yes, both in grant and post grant proceedings.

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.

There is no clear standard on the permissibility of amendments, as is further discussed.

#### **For pre-grant proceedings**

Art. 11 (7) of the Portuguese Industrial Property Code (IPC) provides that if an “invention, design or

model, trademark, logo, award, designation of origin or geographical indication is altered in relation to the initial publication, a new notice shall be published in the Industrial Property Bulletin and the priority shall be counted from the date on which it was requested". The wording and the whole provision may be considered quite inadequate, since not only does it bring together in a single legal provision "inventions" and trademarks or designations of origin, but it also mistakes the concept of priority with that of effective date of added subject matter. It also draws as reference point the application as published.

Rule 7 (1) of the "Implementation Manual of the IPC" (IM-IPC), through which the Portuguese Industrial Property Institute (INPI) implements Art. 11 of the IPC, defines that only the amendments are qualified as "substantial" have as consequence a new publication - therefore regarded as added subject matter.

In R. 7 (8) IM-IPC the INPI defines that a "substantial" amendment is that which "extends beyond the content of the application as filed" - not as published as Art. 11 (7) IPC provides.

R. 7 (10) IM-IPC further defines that "priority from a prior application is maintained in what regards subject matter of patents or utility models (...) as initially filed", assuming the amended subject matter and amended features the date of those amendments.

We find that this interpretation is mostly based on the EPC's Case Law and practice.

The IPC also provides the possibility of filing an application as a provisional patent application, through its Arts. 62-A and 62-B. This kind of application must be "converted" into a regular patent application within 12 months from filing, otherwise being considered abandoned, under Art. 62-B (1) and (6) IPC. This article, which relates to the conversion procedure, defines that if "If the claims in the definitive application are not based on the document submitted by the applicant under paragraph 2 (e) of the previous article, the priority of the application shall count from the date of submission of said claims and not that of the provisional application". Paragraph 2 (e) of "the previous article" regards the submission of a description of the invention, on filing of the provisional application.

This may be considered as the single explicit legal provision in the IPC that defines the application as filed as a reference point, to which amendments will be compared. However, it only refers directly to subject matter present on the claims.

R. 26 IM-IPC, through which the INPI implements Art. 62-B of the IPC, defines that "if, on conversion, subject matter not present on the provisional application is identified, the priority of that subject matter is considered from the date of its filing (priority of amendment). In contrast, in what regards subject matter present in whole in the provisional application, the date of priority will be maintained for the date of filing of that application". Here, the INPI applies a comparison not only to subject matter on the claims but also on the description or drawings.

Art. 25 IPC provides for the amendment of non-essential elements, defining that any amendment or correction that does not affect essential and characteristic features of the patent, utility model or register may be allowed, within the same process. Essential elements have been understood by the INPI and the CIP as those which are not the claims, description, drawings or abstract. Therefore, this provision lacks relevance for the present subject.

Further, Art. 62 (6) (b) IPC provides that the abstract has the mere purpose of technical information, and shall not be considered for any other purpose, such as to determine the extension of the intended scope of protection. Therefore, both the INPI and the Portuguese Court of Industrial Property (CIP) consider that amendments whose basis is merely the abstract shall be considered as added subject matter, and therefore have a different effective date.

In practice, the standard applied by the INPI is based on comparing amendments with the content of the application as filed, as it would be interpreted by the skilled person at the date of filing. Added subject matter identified through this test is allowed but will be given an effective date corresponding

to the date of its filing. This standard follows that of the EPO.

### **For post-grant proceedings**

After grant, amendments in essential elements are ruled by Art. 11 (10) IPC, which states that “after a decision has been issued, during the time limit for appeal or, if an appeal has been lodged, until the ruling has been confirmed, applicants may transfer the rights pertaining to an application, limit its object or add documents or statements to the case file”.

Therefore, after grant an owner may only limit the scope of protection.

Under Art. 101 (5) IPC, “A patentee may ask the National Industrial Property Institute, on payment of a fee, to limit the scope of protection of the invention by altering the claims”. Subsequently under Art. 101 (6) IPC, it is provided that “If the examination shows that the request for limitation can be granted, the National Industrial Property Institute shall promote the publication of a notice of the alteration of the claims, otherwise the request shall be denied and the decision communicated to the requester”. Therefore, the INPI examines whether the claims amendment is in fact a limitation.

Art. 114 IPC further provides in its first paragraph that “one or more claims may be declared null and void or annulled, but partial nullity may not be declared nor may a claim be partially invalidated”. Art. 114 (2) IPC specifies that “in court proceedings, a patentee may limit the scope of protection of an invention by altering the claims”. Therefore, and in case a judicial or administrative appeal is filed, the owner may also limit the scope of the claims.

Neither Art. 101 IPC nor Art. 114 IPC provide for the considerations for allowing an amendment, if claims may be amended freely - even though with amendments based on the application as filed - or if claims may only be limited based on already claimed subject matter, i. e., merging dependent claims.

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

There are no differences on a possible standard.

- 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.

### **National procedure**

#### **Pre-grant procedure**

As referred in the answer to question 3 a), Art. 11 (7) IPC provides basis for the INPI to allow amendments in a patent application at any time from filing to the publication of the mention of grant, under the interpretation of this provision by the INPI.

Art. 65 IPC – related to formalities examination – provides that if formal objections identified by the INPI, the applicant is invited to correct to them within a two-month period. Therefore, there is clearly legal basis for amendments in this phase.

Correspondingly, Art. 68 IPC – related to substantive examination –, also provides that if objections identified by the INPI, the application is requested to respond to those objections. Although not explicit, it is understood that such responses may comprise amendment of claims, description or drawings.

This understanding finds basis on Art. 70 IPC, which provides that the application may be altered during examination. Therefore, there is clearly legal basis for amendments in this phase.

Under the INPI's interpretation of Art. 68, two communications may be issued in examination proceedings.

As referred in the answer to question 3 a), while considering a provisional application, at the time of its "conversion" into a regular patent application, the claims shall be based on the provisional application as filed, according to Art. 62-B (2) IPC. It is important to refer that a provisional application does not require the filing of claims. If the claims filed on conversion do not find basis on the provisional application as filed, "priority" is counted from the date of filing of the claims, and not that of the provisional application.

Under the provisions of the IPC, only in these phases there is explicit basis for the filing of amendments.

Despite the described differences, in practice, it is possible to file amendments at any time prior to the publication of the mention of grant, and the standard is that of considering added subject matter as that which extends beyond the content of the application as filed, as the skilled person - taking into consideration common general knowledge - would interpret it.

#### **Post-grant procedure**

As referred in the answer to question 3, after grant the owner may only limit the scope of protection of the patent, be it through a request filed before the INPI or - if appeal proceedings are in course - during these proceedings.

We believe the standard is maintained.

#### **European route**

##### **Post-grant procedure**

For an European patent validated in Portugal, after validation, only limitations are possible, as for national applications. A centralised limitation procedure before the EPO is also available.

- 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.

**Pre-grant procedure:** As previously referred, any sort added subject-matter is not impermissible, and therefore it is also not a ground for refusal. The relevant consequence is that if the claimed subject matter is conferred a different effective date - later than that of priority / of the application as filed -, than the relevant prior art will be considered that until the day before to the effective date, and may render the claimed subject matter not novel or not inventive.

- 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 non-written standard includes considering the application as filed as the skilled person would interpret it, regarding common general knowledge. The INPI, following EPO's practice, applies the same standard as that of the EPO.

The person skilled in the art concept is present in the IPC only with regard to the definition of inventive step, in Art. 55 (2) IPC, and the definition of sufficiency of disclosure, in Art. 62 (4) IPC, referring a "competent person in the art".

- 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 of knowledge of the notional skilled person is that of the priority date or of the date of filing, whichever applies.

- 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:

As mentioned above, after the grant of the patent and while an appeal (Court proceedings) is pending against the decision of the patent office to grant the patent, the patentee can only request the limitation of the patent as granted. If in such appeal it is found that contains impermissible added matter, the patentee can remedy such defect by requesting the removal of the parts that were deemed as impermissible added matter. However, this is the only and remote possibility of a post grant limitation procedure.

However, if in appeal proceedings is found that the previous decision was erroneous, then the appeal body (be it the Court of Intellectual Property or the administrative appeal department of the INPI) may send the patent/application back to examination proceedings, where the previously described practice applies.

## 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?

IP Portuguese law is omiss and doesn't mention/define impermissible matter.

According to Art. 11 (7) of the Portuguese Industrial Property Code (IPC) if an "invention ... is altered in relation to the initial publication, a new notice shall be published in the Industrial Property Bulletin and the priority of the amendments shall be counted from the date on which it was requested". Therefore, based in current law, a patentee is allowed to include in the application subject matter which clearly extends beyond the content of the application as filed.

Therefore, there is no balance between allowing a patent applicant to make appropriate amendments during the examination proceedings and preventing the applicant from adding impermissible matter, improving his position and reducing certainty of the public.

In practice, as mentioned before, Rule 7 (1) of the IM-IPC, defines that only the amendments are

qualified as “substantial” have as consequence a new publication – therefore regarded as added subject matter. In R. 7 (8) IM-IPC the INPI defines that a “substantial” amendment is that which “extends beyond the content of the application as filed”. And R. 7 (10) IM-IPC stipulates that “priority from a prior application is maintained in what regards subject matter of patents or utility models (...) initially filed, assuming the amended subject matter and amended features the date of those amendments.

Therefore if substantial amendments are made during the examination process, those will be allowed and the effective date of this subject matter will be the date filing of those amendments.

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

yes

Please explain:

The wording of Art. 11 may be amended in order to provide/define different provisions for the different IP rights. Also, and in order to harmonize, an approach more similar to what is done at European Patent Office could help to improve the understanding of impermissible added matter during the examination process.

We believe that subject matter which extends beyond the content of the application as filed, as it would be interpreted by the person skilled in the art, considering common general knowledge, would be a good standard, granting both the possibility of amending to the applicant and certainty to the public.

A general provision should govern amendments, and be applicable to all administrative phases: conversion of a provisional application, reply to communications in any stage of proceedings or amendments on the initiative of the applicant. This new provision would supersede those previously referred.

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 only and remote possibility of a post grant amendment is the request for a limitation of the patent as granted while an appeal is pending against the decision of the patent office to grant the patent. If no appeal is filed or after a decision being rendered in the appeal by the IP Court (meaning that the decision to grant becomes *res judicata*) it is no longer possible to request any amendment to the patent. Since in this post grant procedure, the patentee can only request the limitation of the patent as granted there are no questions on the adding of impermissible matter.

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

yes

Please explain:

The Portuguese law (IP Code) is pretty much aligned with the European Patent Convention and the Portuguese patent office and IP Court tend to follow the practice of the EPO.

Therefore, we believe an alignment for amendment of the application and patent is also desirable, as previously referred.

- 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?

As mentioned above impermissible matter is not contemplated in IPC. Therefore the notional person skilled in the art concept is not present in legal provisions to determine the permissibility of amendments made - although it is used in practice by the national office. The person skilled in the art is explicitly used in law and practice to assess the patentability requirements of the invention, namely the inventive step.

In terms of improvements, only after the definition of impermissible added matter is set up, the approach to determine the permissibility of amendments can be defined. We however agree that a provision to be created disallowing the addition of certain subject matter should take into consideration the notional person skilled in the art, specifically allowing only amendments which are explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

We support however a less strict criterion for the allowability of amendments than that of the EPO, as subsequently discussed.

### 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 agree with harmonisation on these matters over several jurisdictions.

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

The definition/approach could be the same used by European Patent Office, Art 123 (2) of EPC states that an amended can only be made if it contains subject-matter which do not extend beyond the content of the application as filed, although we have certain reservations on Art. 123 (3) EPC, as subsequently indicated.

Also, the EPO uses the disclosure test to determine if the amendment extends the subject-matter beyond the content of the application as filed or not. This test states that an amendment is not allowable if the overall change in content of the application results in the skilled person being presented with information which is not directly and unambiguously derivable, seen objectively and relative to the date of filing, from the whole content of the application as filed.

We believe that implicit disclosure in the application as filed as the skilled person would interpret should be taken into consideration, avoiding nearly literal interpretation.

- 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:

The definition of impermissible added matter should always be the same, irrespectively of the moment when 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?

We believe that both addition and limitation of claims should be allowed for pre-grant proceedings, if the subject matter of the added/limited claims is present in the application as filed.

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

no

Please explain:

What was referred in the previous answer is applicable to the present answer. If, for pre-grant proceedings, the subject matter of the new set of claims was present in the application as filed, then removal of claims should be allowed.

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:

The definition of impermissible added matter would desirably be the same irrespectively of being applied by the patent office or by the 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?

That of priority or of the application as filed, whichever is applicable.

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?

Considering that we find the provisions of the EPC regarding amendments as generally suitable to govern the addition of subject matter (see answer 14), we would like to avoid the “inescapable trap” caused by the current interpretation of Art. 123 (2) and (3) EPC.

Further, we believe that an overly strict standard on finding added subject matter as impermissible / extending beyond the application as filed causes most of the cases of the inescapable trap of Art. 123 (2) (3) EPC.

That said, we support that the general criterion of subject matter "explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as



filed" is more realistic, providing for a good balance between the certainty provided by the original disclosure provided to the public and the ability for the patentee to amend the application.

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

The present set of comments is applicable to both patents and utility models, under the Portuguese IP law and practice.

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

The present description and proposals consider views of IP consultants with both technical and legal backgrounds, patent attorneys and lawyers, as well as of IP professionals working in the Industry.

#### Summary

Summarising, we believe that the current law on amendments is not suitable for the prosecution of patent applications, and should be altered in order to provide a balance between the ability of the applicant to amend and certainty to the public on for which invention is protection being sought.

Although we find the current practice of the national IPO much more suitable, it lacks of basis in law, for an update is definitely needed in this area.

Therefore, we would support a standard which defines allowable amendments, be it in the description, claims or drawings, as those which find basis in the content of the application as filed, as it would be interpreted by the person skilled in the art taking into consideration common general knowledge.

Subject matter present in the application as filed would be regarded as that which is explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.