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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.

Title 35 U.S.C. § 132[<https://www.law.cornell.edu/uscode/text/35/132>] provides that "...no amendment shall introduce new matter into the disclosure of the invention..." Thus, there is a proscription against the introduction of new matter in a patent application, which proscription serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. This statute goes to the specification, abstract and drawings.

Title 35 U.S.C. § 112(a)[<https://www.law.cornell.edu/uscode/text/35/112>] , which sets forth the written description requirement, prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. This statute relates to amending the claims, and pertains to amendments made to pending applications and to amendments to claims made post-grant.

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

According to MPEP 2163[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] , there is no *in haec verba* requirement as between claims and the specification, but newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.

35 U.S.C. § 112(a) prohibits a claim, whether filed or amended, from reciting elements that are not supported by the application as filed, meaning the abstract, specification, or drawings. On the other hand, § 132 prohibits the addition of “new matter” to an original application disclosure. As such, § 132 is a basis for rejecting amendments to an abstract, specification, or drawings, not a basis for rejecting amendments to claims.

“The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is s 112(a), first paragraph, not s 132. The latter section [ (§132)] prohibits addition of new matter to the original disclosure. It is properly employed as a basis for objection to amendments to the abstract, specifications, or drawings attempting to add new disclosure to that originally presented.” *In re Rasmussen*, 650 F.2d 1212, 1214-15 (C.C.P.A. 1981).[<https://casetext.com/case/in-re-rasmussen-5>]

Taken together, §§ 112(a) and 132 ensure that only the invention disclosed on a filing date may be the subject of a granted patent.

“The written description requirement [35 U.S.C. §112(a)] and its corollary, the new matter prohibition of 35 U.S.C. § 132, both serve to ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date. When the applicant adds a claim or otherwise amends his specification after the original filing date, the new claims or other added material must find support in the original specification.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 981 (Fed. Cir. 2002)[<http://caselaw.findlaw.com/us-federal-circuit/1330083.html>] ).

“[The rule against adding new matter is] intended to prevent an applicant under the guise of an amendment from introducing into his application a wholly different invention or changing the construction of a fully disclosed invention or presenting a different or preferred form of the invention. The applicant must stand or fall on his original disclosure and all amendments must conform thereto.” *Application of Oda*, 443 F.2d 1200, 1204 (C.C.P.A. 1971)[<https://casetext.com/case/application-of-oda>] .

Amendments to patent claims are also permitted after grant in AIA trial proceedings. In inter partes review, post-grant review, and covered business method review proceedings, claims may be amended to either cancel any challenged claim or propose a reasonable number of substitute claims for each challenged claim. Claim amendments “may not enlarge the scope of the claims of the patent or introduce new matter.” 35 U.S.C. § 316(d)(3)[<https://www.law.cornell.edu/uscode/text/35/316>] and 35 U.S.C. § 326(d)(3)[<https://www.law.cornell.edu/uscode/text/35/326>]. Amendments are also permitted in *ex parte* reexamination proceedings. Such amendments may not enlarge the scope of a claim. 35 U.S.C. § 305[<https://www.law.cornell.edu/uscode/text/35/305>]. Amendments are also permitted in applications for reissue of a granted patent. Such amendments may enlarge the scope of a claim only if the application for reissue is filed within two years of the grant date. 35 U.S.C. § 251[<https://www.law.cornell.edu/uscode/text/35/251>] (d).

- 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.

#### **Pre-Grant Amendments:**

Under MPEP 714[<http://www.uspto.gov/web/offices/pac/mpep/s714.html>], an Applicant may amend any portion of the application (drawings, claims, specification, before or after the first Office Action and also after the second Office Action, as specified in 37 C.F.R. § 1.112(a). The Applicant may amend the application after final rejection, if the amendment meets the criteria of 37 C.F.R. § 1.116.

Title 37 C.F.R. § 1.116[<https://www.law.cornell.edu/cfr/text/37/1.116>] states that an amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office Action, an amendment presenting rejected claims in better form for consideration on appeal may be admitted, or an amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

An application may be amended after a final office action rejection under the After Final Consideration Pilot (AFCP 2.0[<http://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>]) Pilot Program. To be eligible for the After Final Consideration Pilot 2.0, an applicant must amend at least one independent in a non-broadening manner.

An amendment to the application may also be made after the date of filing a notice of appeal pursuant to 37 C.F.R. § 41.31(a)[<https://www.law.cornell.edu/cfr/text/37/41.31>], if the amendment meets the criteria of 37 C.F.R. § 41.33[<https://www.law.cornell.edu/cfr/text/37/41.33>]. Under 37 C.F.R. § 41.33, amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to 37 C.F.R. § 41.37[<https://www.law.cornell.edu/cfr/text/37/41.37>] may be admitted as provided in § 1.116.

Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted to cancel

claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form. All other amendments filed after the date of filing an appeal pursuant to §41.31[<https://www.law.cornell.edu/cfr/text/37/41.31>] (a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1)[<https://www.law.cornell.edu/cfr/text/37/41.39>] , 41.50(a)(2)(i)[<https://www.law.cornell.edu/cfr/text/37/41.50>] , and 41.50(b)(1)[<https://www.law.cornell.edu/cfr/text/37/41.50>] .

Amendments to the application may also be made when and as specifically required by the examiner.

Under 37 C.F.R. § 1.312[<https://www.law.cornell.edu/cfr/text/37/1.312>] , no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue. However, where amendments of the type noted are shown to be needed for proper disclosure or protection of the invention, and/or to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of 37 C.F.R. § 1.111(c)[<https://www.law.cornell.edu/cfr/text/37/1.111>] (MPEP 714.02[[http://www.bitlaw.com/source/mpep/714\\_02.html](http://www.bitlaw.com/source/mpep/714_02.html)] ) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment after Notice of Allowance under 37 C.F.R. § 1.312, as in ordinary amendments. See MPEP 713[<http://www.uspto.gov/web/offices/pac/mpep/s713.html>] paragraphs .04 and .10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or addition of a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show, why the amendment is needed, why the proposed amended or new claims require no additional search or examination, why the claims are patentable, and why they were not presented earlier.

After Allowance, an applicant may amend the claims by filing a Request for Continuing Examination (RCE) or a Continuation or Continuation-in-Part (CIP) application with new and/or amended claims. The Continuation-in-part (CIP) Application generally contains the original specification with added and/or deleted new matter. Claims having support in the original disclosure are accorded the original application's filing date, whereas claims supported by the added new matter will receive an effective filing date that is the filing date of the CIP that includes the new claim.

An applicant may be able to amend the specification to add inadvertently omitted portions of an application if the application made a claim for priority (see 37 C.F.R. §§ 1.55[<https://www.law.cornell.edu/cfr/text/37/1.55>] and 1.78[<https://www.law.cornell.edu/cfr/text/37/1.78>] ) to a patent that existed at the time of patent filing. Conditions and requirements for proper incorporation by reference are set forth in 37 C.F.R. § 1.57[<https://www.law.cornell.edu/cfr/text/37/1.57>] and MPEP 217[<http://www.uspto.gov/web/offices/pac/mpep/s217.html>] .

Though uncommon, a provisional application may be amended, but must still comply with 37 C.F.R. § 1.121[<https://www.law.cornell.edu/cfr/text/37/1.121>] . Such amendments will be placed in the provisional application file, but may not be entered. (MPEP 714[<http://www.uspto.gov/web/offices/pac/mpep/s714.html>] ).

**Post grant amendments:** The following options are available for making amendments to the claims or the specification of a U.S. Patent after the patent has granted:

1. a) Certificate of Correction (MPEP 1481[<http://www.uspto.gov/web/offices/pac/mpep/s1481.html>] )  
– There is no restriction on timing for making an amendment to a claim or patent via a Certificate of Correction (COC).

1. **i.** To correct a USPTO error – any error made by the USPTO in printing the patent may be corrected with a COC; and/or
2. **ii.** To correct Patent Owner errors – limited to correcting errors (1) of a clerical nature, (2) of a typographical nature, or (3) a mistake of minor character.

1. b) Reissue (MPEP 1401[<http://www.uspto.gov/web/offices/pac/mpep/s1401.html>] ) – A request to reissue a patent can be filed to correct errors in a granted patent. A reissue application to broaden the granted claims can only be filed within two years from patent issue. There is no presumption of validity with a reissue proceeding (the patent becomes an application again, which is fully examined). Amended claims can give rise to intervening rights.

1. c) Reexamination (MPEP 2209[<http://www.uspto.gov/web/offices/pac/mpep/s2209.html>] ) – Non-broadening claim amendments may be made during a reexamination proceeding. Amended claims can give rise to intervening rights.

1. d) Post-Grant AIA Trial Proceedings – Non-broadening claim amendments may be made in post-grant AIA trial proceedings by way of a motion to cancel claims and replace the cancelled claims with substitute claims. In practice, these claim amendments are generally very difficult to do. See answer to Question 7.

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.

“New matter” (or *impermissible* added matter) is a term of art that is not defined by the governing statute and must be determined on a case by case basis. (*Application of Oda, supra.*)

“‘New Matter’ is a technical legal term in patent law— a term of art. Its meaning has never been clearly defined for it cannot be. The term is on a par with such terms as infringement, obviousness, priority, abandonment, and the like which express ultimate legal conclusions and are in the nature of labels attached to results after they have been reached by processes of reasoning grounded on analyses of factual situations. In other words, the statute gives us no help in determining what is or is not ‘new matter.’ We have to decide on a case-by-case basis what changes are prohibited as ‘new matter’ and

what changes are not.” *Application of Oda*, 443 F.2d 1200, 1203 (C.C.P.A. 1971)[<https://casetext.com/case/application-of-oda>] .

Whether an amendment constitutes new matter is a question only directed to changes to the abstract, specification, and drawings, as the claims may only recite elements supported in the disclosure under § 112.

The question of impermissible new/amended matter focuses on the impact of the new matter on the scope of the original disclosure. MPEP 2163.07[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] states: “Amendments to an application which are supported in the original description are NOT new matter.” An amendment is impermissible if it departs from the original disclosure or includes changes that would not be obvious to a person skilled in the art. Therefore, the proscription against adding impermissible new matter is effectively a limit on the applicant’s ability to correct and clarify a disclosure during the process of prosecuting the application.

“[A]mendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions” *Quigley v. Zimmerman*, 73 F.2d 499, 503 (C.C.P.A. 1934).[[http://www.leagle.com/decision/193457273F2d499\\_1396/QUIGLEY%20v.%20ZIMMERMAN](http://www.leagle.com/decision/193457273F2d499_1396/QUIGLEY%20v.%20ZIMMERMAN)]

“Amendments purporting to correct errors or to supply omissions in features which are essential to the operativeness of the invention or the completeness of the disclosure are permissible, if the errors are manifest and were caused by a clerical mistake of the draftsman or unfamiliarity of the inventor with official forms and the proposed corrections do not change the essence of the invention. ... If the changes necessary to make the disclosed device operative are radical in their nature and constitute a departure from the invention originally disclosed, they are not permissible.” *Application of Oda*, 443 F.2d 1200, 1204 (C.C.P.A. 1971)[<https://casetext.com/case/application-of-oda>] .

The Hay court summarized Oda’s holding that the new matter provisions of § 132 provide a limit on the correction of errors, even where those errors were made in good faith. *Application of Hay*, 534 F.2d 917, 919[<https://casetext.com/case/application-of-hay>] (C.C.P.A. 1976).

Specific examples of permissible amendments include:

1. a) Rephrasing original disclosure (MPEP 2163.07[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] );
1. b) Correcting obvious errors that a person skilled in the art “would not only recognize the existence of error . . . but also the appropriate correction.” (*Application of Oda*, 443 F.2d 1200 (C.C.P.A. 1971)[<https://casetext.com/case/application-of-oda>] , MPEP

2163.07[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] ).

1. c) Reciting inherent function, theory, or advantage of original disclosure (*In re Reynolds*, 443 F.2d 384[<http://www.plainsite.org/dockets/9s1ukteh/court-of-appeals-for-the-ninth-circuit/united-states-v-in-re-linda-marie-reynolds-witness-before-special-grand-jury/>] (C.C.P.A. 1971), MPEP 2163.07(a)[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html%22%20%5C%20%22d0e215172>] ).

1. d) Reciting text previously incorporated by reference in original disclosure (MPEP 2163.07(b)[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html%22%20%5C%20%22d0e215198>] ).

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 as filed is interpreted in the U.S. to be the original, non-provisional application as filed with the USPTO, including PCT applications designating the United States. As discussed above in Question 3, U.S. law defines new/added matter as anything that departs from the original disclosure, including the specification, figures, and claims of the application. “The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.” MPEP 2163[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] (I)(B). The application as filed may include subject matter incorporated by reference at the time of filing and permitted corrections to obvious errors. Subject matter added after the date of filing is presumed to be “new matter” and must be shown to be supported in the original application as filed through express, implicit, or inherent disclosure.

Like originally filed claims, biologic deposits speak for themselves and are part of the specification when properly identified according to accession numbers. Such deposits can be useful to support of correction of errors, including sequencing errors. Amendment or replacement of a Sequence Listing is permitted under MPEP 2426[<http://www.uspto.gov/web/offices/pac/mpep/s2426.html%22%20%5C%20%22d0e246991>] (37 C.F.R. 1.825[<https://www.law.cornell.edu/cfr/text/37/1.825>] ), subject to submission of a statement attesting to the absence of new matter the replaced sequence. The required statement follows the same practice as is required for submission of a substitute specification.

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?

Under current U.S. law, a patent, including the patent claims, are interpreted from the reference point of “a person of ordinary skill in the relevant art”, as of the “effective filing date” of the application. For example, if the application is a continuation, divisional, or CIP that claims priority to a previous application, the filing date of the previous application would be considered the “effective filing date”

relevant to the new matter inquiry for any claims that are entitled to that earlier priority.

MPEP 2163[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>] states: “When an explicit limitation in a claim ‘is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.’”

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:

a) Reissue - The USPTO provides a reissue procedure which may be used to correct errors in a granted patent, such as removing impermissible new matter. A reissue patent that seeks to broaden the scope of the original patent is permitted, but only if the reissue application is filed within two years of the patent’s issue date. Where an amendment is made during a reissue proceeding more than two years after issue, adding or removing claims or features to the claims would be permitted only if the change does not broaden the scope of the claims. MPEP 1401  
Reissue[<http://www.uspto.gov/web/offices/pac/mpep/s1401.html>]

b) Post-Grant Review - Patent claims may be amended in a post-grant review (PGR) proceeding only if the Patent Trial and Appeal Board (PTAB) grants a Motion to Amend filed by the patent owner. Motions to Amend are discussed further below with respect to inter partes review. As with reissue applications after two years, only non-broadening amendments are permitted in post-grant review. Where removal of unsupported added matter would broaden the reasonable scope of the patent claim, the amendment would not be permitted.

c) Inter Partes Review - Impermissible added matter should not be an issue in an inter partes review (IPR) proceeding, because the IPR petitioner may only request cancellation of patent claims on prior art grounds under § 102 and § 103. 35 U.S.C. § 311[<https://www.law.cornell.edu/uscode/text/35/311>] . The USPTO may use a lack of written description under § 112(a) to terminate an IPR proceeding, for example, by finding that the challenged claims are not amenable to construction. *Universal Remote Control, Inc. v Universal Elec., Inc.*, IPR2013-00152, Paper 8, 20 (Aug. 19, 2013).[[http://www.uspto.gov/ip/boards/bpai/ipr2013\\_00152\\_denial\\_of\\_institution.pdf](http://www.uspto.gov/ip/boards/bpai/ipr2013_00152_denial_of_institution.pdf)]

As with PGRs, patent claims may be amended in an IPR only if the PTAB grants a patent owner’s Motion to Amend. A Motion to Amend must be filed no later than the filing of a patent owner’s Response to the AIA trial petition, unless a specific due date is provided in an order from the PTAB. 37 C.F.R. § 42.121(a)[<https://www.law.cornell.edu/cfr/text/37/42.121>] ; 37 C.F.R. § 42.221(a)[<https://www.law.cornell.edu/cfr/text/37/42.221>] . If a PTAB order does not provide a specific due date for filing the Response, the default date is three months from institution of the AIA trial. 37 C.F.R. § 42.120(b)[<https://www.law.cornell.edu/cfr/text/37/42.120>] ; 37 C.F.R. § 42.220(b)[<https://www.law.cornell.edu/cfr/text/37/42.220>] . But the Motion to Amend can be made only after conferring with the Board.



Statistics indicate that patent owners are rarely successful in AIA trial proceedings in amending the claims, and Motions to Amend claims are regularly denied.

d) Certificate of Correction – Certificates of Correction are also available to correct mistakes that are clerical or typographical in nature, or of minor character. It is possible that some amendments made prior to grant may be considered sufficiently minor that they could be removed by filing a Certificate of Correction.

## 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?

In practice, it is the examiner at the USPTO that strikes such a balance by following examination guidelines and the case law. Generally, it is the USPTO's guidelines that provide a more detailed framework. MPEP 2163 Written Description Guidelines[<http://www.uspto.gov/web/offices/pac/mpep/s2163.html>]

With regard to the claims, during examination, the examiner is required to establish, by a preponderance of evidence, a *prima facie* case why a person skilled in the art at the time the application was filed would not have recognized that the applicant was in possession of the invention as claimed in view of the disclosure of the application as filed. Each claim must be expressly, implicitly or inherently supported in the originally filed disclosure. This requires one to look at the description in the original disclosure to determine whether the new or amended claim was literally or implicitly described with reasonable clarity.

Thus the examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claim. While it is not necessary for the examiner to present factual evidence, to make a *prima facie* case it is necessary to point out the claim limitations that are not adequately supported and explain any other reasons why the claim is not fully supported by the disclosure to show that the applicant did not have possession of the invention as claimed.

The examiner must determine, for each claim, what the claim as a whole covers; review the entire application to understand how the applicant provides support for the claimed invention, including each element and/or step and determine whether there is sufficient written description to inform a skilled artisan that the applicant was in possession of the claimed Invention as a whole at the time the application was filed.

Because, for the claims, the question is whether the applicant was in possession of the invention as claimed, the analysis does not require literal support in the specification in order to satisfy the

description requirement.

Amendments to the specification, including the abstract and drawings are permissible. Here again, the USPTO guidelines provide a detailed framework for amendments to the specification that are supported by the original description. It is up to the Examiner to review and determine whether subject matter added to the specification by amendment is new matter. The content of the amendment needs to be contained in one or more of the specification, claims or drawings of the application as filed. Examples of permissible amendments to the specification include:

- Amending the specification to include claimed subject matter that is not otherwise disclosed.
- Explaining the features shown in a drawing, where the descriptive matter would be recognized by one of skill in the art as necessarily present.
- Describing a function, theory or advantage of a device that inherently performs the function, operates according to a theory or has an advantage. The test is generally whether a person of skill in the art would so recognize the descriptive matter as necessarily present in the device described.
- Rephrasing of a passage, when the original meaning is retained.
- Replacing subject matter identified by “incorporation by reference” with the actual text.
- Obvious errors where one of skill in the art would not only recognize the error but also recognize the correction.

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

yes

Please explain:

Compliance with the written description requirement is essentially a fact-based inquiry that necessarily varies depending on the nature of the invention claimed and must be resolved based on the facts of each specific application. However, the U.S. approach—at least as to claim amendments—is a relatively liberal one in view of the statutory requirements.

A narrower approach could potentially lead to more certainty, but narrowness can lead to rigidity or inflexibility. It could be questioned whether a narrow approach is fair to the applicant, who often has to deal with new objections or prior art after the application has been filed.

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. All subject matter added must be supported by the originally filed specification, using the same standards as applied during examination of the application. However, post-grant, the US also balances the equities of the patent owner being able to correct errors (such as impermissibly added subject matter) in the patent with the rights of third parties to have appropriate notice as to the patent scope. This is achieved by permitting any broadening amendments to only be made in the context of a reissue proceeding, which is filed within two years of the patent grant. Equities are also preserved through the recapture doctrine, which prohibits subject matter that was surrendered during the original

examination from being reintroduced into the claims during a reissue proceeding. In addition, the equitable rights of a third party are protected by granting intervening rights with regard to amended claims in a reissued or re-examined patent.

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

yes

Please explain:

Two aspects that could be improved during AIA trial proceedings are the standard for claim interpretation used and the burden of proof required for claim amendments.

While a patent application is undergoing examination at the USPTO, the examiners use a “broadest reasonable interpretation” to interpret the claims. Under this inquiry, the examiner will determine the broadest reasonable interpretation that would be afforded to the claim terms by a person of ordinary skill in the art, and proceed on this basis. This broadest reasonable interpretation is applied to claims in situations where the Applicant still has an opportunity to amend the claims. MPEP 2111[<http://www.uspto.gov/web/offices/pac/mpep/s2111.html>] .

In AIA trial proceedings, claims are also given the “broadest reasonable interpretation” in light of the specification and prosecution history. 37 C.F.R. §

42.100(b)[<https://www.law.cornell.edu/cfr/text/37/42.100>] , 37 C.F.R. §

42.200(b)[<https://www.law.cornell.edu/cfr/text/37/42.200>] ; 35 C.F.R. §

300(b)[<https://www.law.cornell.edu/cfr/text/37/42.300>] ; *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1061-1062 (Fed. Cir.

2016)[[https://scholar.google.com/scholar\\_case?case=4782815626695587497&q=Trivascular,+Inc.+v.+Samuels&hl=en&as\\_sdt=2006&as\\_vis=1](https://scholar.google.com/scholar_case?case=4782815626695587497&q=Trivascular,+Inc.+v.+Samuels&hl=en&as_sdt=2006&as_vis=1)] ; *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir.

2015)[[https://scholar.google.com/scholar\\_case?case=2949506268853048888&q=Microsoft+Corp.+v.+Proxyconn,+Inc.,+789+F.3d+1292,+1298+%28Fed.+Cir.+2015%29&hl=en&as\\_sdt=2006&as\\_vis=1](https://scholar.google.com/scholar_case?case=2949506268853048888&q=Microsoft+Corp.+v.+Proxyconn,+Inc.,+789+F.3d+1292,+1298+%28Fed.+Cir.+2015%29&hl=en&as_sdt=2006&as_vis=1)] .

A current “hot topic” regarding claim amendments in the U.S. is the restricted ability to amend claims during an AIA trial proceeding, particularly in view of the broad interpretation of the claims used by the Patent Trial Appeal Board (PTAB) under the Broadest Reasonable Interpretation (BRI) standard.

Problems arise from the PTAB’s use of the BRI, in combination with a standard of proof for invalidating claims lower than that used in courts, while claim amendments can only be made through a motion to amend with rigorous requirements.

In the *Idle Free Systems v.*

*Bergstrom*

[[http://www.uspto.gov/sites/default/files/ip/boards/bpai/ipr201200027\\_decision\\_on\\_motion\\_to\\_amend\\_idle\\_free%29.pdf](http://www.uspto.gov/sites/default/files/ip/boards/bpai/ipr201200027_decision_on_motion_to_amend_idle_free%29.pdf)] , IPR2012-00027 (JL) decision published June 11, 2013, the PTAB held that the patent owner bears the burden of establishing that an amended claim provides a “patentable distinction over the prior art of record, and over prior art not of record but known to the patent owner.” The PTAB cautioned in *Idle Free* that general, conclusory assertions that the amended claims are patentable over the prior art were inadequate to satisfy the required showing. It has proven to be very difficult to obtain grant of a motion to amend from the PTAB, as evidenced by the low number of such motions

that were granted. This heightened burden in establishing the required showing of patentability over all art available in the prosecution history and otherwise known to the patent owner in combination with the very broad BRI standard of claim interpretation has resulted in a belief by many that AIA trial proceedings are procedurally skewed against the patent owner. As a result, we believe the BRI standard of claim interpretation should be revised to a more restrictive standard such as that used by the district courts, as described, for example, in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)[[https://scholar.google.com/scholar\\_case?case=2207195741320793153&q=Phillips+v.+AWH+Corp.,+415+F.3d+1303&hl=en&as\\_sdt=40000006&as\\_vis=1](https://scholar.google.com/scholar_case?case=2207195741320793153&q=Phillips+v.+AWH+Corp.,+415+F.3d+1303&hl=en&as_sdt=40000006&as_vis=1)]. An alternative would be for the PTAB to lower the threshold showing required to grant a motion to amend the claims in an AIA trial proceeding.

In January 2016, the U.S. Supreme Court granted *certiorari* in *Cuozzo Speed Technologies, LLC. v. Lee*. The Supreme Court is being asked to decide whether the PTAB may construe claims in an issued patent according to their broadest reasonable interpretation (the current USPTO standard) rather than their plain and ordinary meaning (the district court standard). Once the Supreme Court reaches its decision, further study of this issue may be warranted.

- 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 United States views the question of whether an amendment to the specification or the claims is “supported” by the original disclosure through the eyes of a person of ordinary skill in the art to which the invention pertains, at the time of the filing. The U.S. group is unaware of an aspect of the test that requires change.

### 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 harmonisation is desirable, as there appear to be significant differences throughout the world regarding how impermissible added matter is determined, and when and how amendments to the specification or claims can be made.

When seeking harmonisation of “impermissible added matter” or “new matter”, a topic that presents significant differences across the different countries of AIPPI, a comparison of each country’s practices in this area can permit an assessment of what the best practices and policies might be for harmonisation purposes.

U.S. practice prohibits the addition of “new matter” to the specification of a patent application and to the claims, if the subject matter is not disclosed in the application as filed. This prohibition applies to claim amendments made before examination, after allowance but pre-grant, or post-grant.

U.S. practice also allows subject matter to be “incorporated by reference” to particular publications, patents, and published patent applications. Correction of obvious errors in a patent application are also permitted, as well as post-grant corrections of such errors.

These practices relate to the topic of “added subject matter” and should be considered in harmonisation discussions of best practice worldwide.

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

Impermissible added matter should refer to a prohibition on adding subject matter to the specification or claims of a patent or patent application that extends beyond the scope of what a person having ordinary skill in the art would understand was described in the application (including the claims) as originally filed. A patent applicant should be able to rely on implicit or inherent disclosure in the specification, original claims, and drawings, so that amendments need not be found word-for-word in the original specification. This would include the ability to rely on subject matter inherently/implicitly disclosed in the original filing, incorporated by reference, and/or correctable as obvious errors, for example, translation errors.

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 not change depending on whether an amendment is made before examination, after allowance but before grant, or after grant. If the proposed added subject matter, from the perspective of a person having ordinary skill in the art at the time of the invention, is not described in the specification, not incorporated by reference, not implicit/inherent from the original disclosure, and/or not the correction of an obvious error, then it should always be impermissible, and timing should not matter.

However, whether amendments can be made to include permissible added matter should depend on timing. Before examination, amendments to the specification and/or claims to include permissible added matter should always be allowed. After allowance but before grant, it is appropriate to provide restrictions on the ability of the applicant to make amendments at that time, but there should also be mechanisms for an applicant to reopen prosecution should the applicant desire to do so. Post-grant correction of obvious errors (e.g., typographical errors) to the specification and/or claims should be permitted, as should narrowing amendments to the claims. With respect to broadening amendments post-grant, countries should consider whether to provide a limited ability to broaden claims, such as within two years of grant as provided in the United States. See answer to Question 20. Any amendments to granted claims should entitle an alleged infringer to intervening rights for activity prior to the date of the modified patent.

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

The rules against impermissible added matter should not prohibit the addition of claims *per se*, as long as the new claims are supported by the specification as originally filed. Even post-grant, the addition of claims should not necessarily be prohibited.

A limitation on the addition of new claims that broaden the scope of the granted claims such as the U.S. reissue practice, which permits post-grant amendment of claims to broaden the scope, provided the request to broaden is filed within two years of grant, giving adequate notice to the public and providing protection to those who relied on the granted claims prior to the Reissue filing. Claims amended by reissue more than two years after grant may not be any broader than the granted claims, and such amendments **should always be permitted** for reexamination. Countries should consider providing a limited ability to add broader claims, such as within two years of grant as provided in the United States. See answer to Question 20.

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 rules against impermissible added matter should not prohibit the removal of claims, *per se*. An applicant should be at liberty to decide if it wishes to cancel one or more claims from its patent, even if the patent has already granted.

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 same definition should be applied by the patent office and by the court to ensure consistency of results. Both should be considering whether a person having ordinary skill in the art would understand that the added matter is described in the specification as filed. A court may reach a different conclusion from the patent office if presented with evidence not considered by the patent office (*e.g.*, declarations from persons skilled in the art), or because of different claim construction standards utilized at the patent office versus the court. Despite these differences, the definition of impermissible new/added matter should be the same.

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?

Consistent with U.S. law, the relevant date of knowledge should be the earliest effective filing date of the subject matter relied upon to provide support or basis for the proposed 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?

When a patent application is still pending, the deletion of impermissible subject matter by amendment to a claim should have no consequence, because the broader claim can still be examined by the patent examiner.

After a patent has granted, deleting impermissible added matter requires a balancing of equities between the patent owner, who should be required to provide notice of the scope of its patent within a reasonable period of time, and the third party possible infringer, who may be investing significant time and money based on a reasonable conclusion that it is not infringing the granted patent claims.

If deleting impermissible added matter results in an impermissible broadening of a granted patent, a patent owner should be able to remedy this situation if it has preserved its priority date with a divisional or continuation application that is still pending, or is within a limited period of time to seek a broader patent post grant (for example, a two year broadening reissue window as in the U.S.). Maintaining such an application provides notice to the third party that additional claims may be sought. Thus, the patent owner can pursue the broader claims in the divisional, continuation, or reissue application (or equivalent based on the country), subject to the same requirements that the claims in such a patent application cannot include impermissible added matter.

All countries should provide an ability to file a divisional or continuation application at least up until the date of grant, and should consider mechanisms that provide for a limited period of time (for example, two years) after grant of the patent during which amendments to obtain broader claims can still be pursued.

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

**a) Incorporation by Reference** - The U.S. group favors consistency throughout the world with respect to the extent incorporation by reference can be relied upon to make amendments to the specification. In particular, it should always be permissible to rely on the disclosure of a priority document that is incorporated by reference. It should also be permissible to include publically available subject matter disclosed in the specification and incorporated by reference in the application as filed. Such subject matter may include, for example, relevant technical literature, research papers, biological and/or sequence deposits, and the like. Such incorporation by reference can reduce the need to include the text of a reference describing the isolation of a material from a natural source, relevance of a particular machine, and tables showing results of studies used to compare against the currently claimed invention.

**b) Reliance on Abstract and Drawings** - As discussed above, the U.S. group favors consistency with respect to the use of the originally filed abstract and drawings as part of the written description available to demonstrate support for an original or amended claim.

**c) Deletions** - The U.S. group considered whether making certain deletions to the specification could also be considered to constitute impermissible added matter, because deleting subject matter from the specification might, in some circumstances, broaden the scope of the specification and add new matter. Such deletions should not be permitted.

**d) BRI** - As discussed above, the U.S. group also considered use by U.S. Patent Office of the “broadest reasonable interpretation” standard for interpreting claims that are able to be amended, while a narrower standard is utilized by the courts to interpret the same claims. Further study may be warranted to investigate what claim construction standards should be utilized, within the patent office, in the courts, and throughout the world.

**e) Translation Errors** - The U.S. group observed that some countries do not provide meaningful mechanisms to correct translation errors for specifications filed in one language (e.g., upon PCT filing) that are translated later (e.g., at national phase entry). We believe that all countries should provide an applicant the ability to correct translation errors and other obvious errors in a translated specification or claims. For Paris convention applications filed in a different language than the priority application filing, countries should allow the applicant to rely on its priority application to show and correct errors in translation and other obvious errors. Specifically, there should be an ability to correct a Paris convention filing if a person skilled in the art, upon reviewing both the Paris convention filing and the priority application, can readily determine that the change is an obvious error made in the process of Paris convention filing, recognizable as such by reference to the priority documents.

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

Chemical, high tech.

#### Summary

United States Patent Law forbids introduction of new matter by amendment into a patent application, and further prohibits claiming subject matter not adequately described in the application as filed. Limited amendments are permitted post-grant, but these may also not introduce new matter, and claim scope can only be enlarged in the case of reissue applications filed within two years of the original patent's grant date.

The U.S. group offers its practices for "added subject matter" for consideration in comparison with the practices of other countries. Such U.S. practices include prohibition of added subject matter to an application's specification or to claims of a granted patent or patent application that extend beyond the scope of what a person of ordinary skill in the art would understand was described in the application as originally filed.

In the U.S., a patent applicant is able to rely on implicit or inherent disclosure in the specification, original claims, and drawings, as well as in publications that are incorporated by reference, so that amendments need not be found word-for-word in the original specification. This includes correctable errors that are obvious, for example, translation errors. Prior to patent grant, U.S. practice provides adequate mechanisms to allow an applicant to make such amendments. Post-grant correction of



obvious errors (e.g., typographical errors) to the specification and/or claims is permitted, as are narrowing amendments to the claims. The U.S. also provides a limited ability to broaden claims, within two years of grant.