Summary Report

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2016 – Study Question (Patents)

Added matter: the standard for determining adequate support for amendments

This Study Question concerns the role and effects of impermissible added matter in relation to amendments to patents and patent applications. Its primary objective is to define impermissible added matter. More specifically, this Study Question addresses the legal restrictions on amendments to the description, claims and figures of patents and patent applications, and in particular, requirements that amendments be supported by the first application as originally filed.

In this Study Question:

- The term ***patent*** refers to a granted patent or an application for a patent, or both, as the context requires. Where it is necessary to distinguish between the two, this Summary Report refers to granted patents and patent applications.
- The term ***impermissible added matter*** refers to a proposed amendment to a patent that is impermissible because it lacks support (often referred to as "basis") in the application as filed. This includes added matter as referred to in Article 123(2) of the European Patent Convention (***EPC***).
- The term ***amendment*** refers to any amendment of, deletion from or addition to a patent specification, including to the description, figures or claims.

This Study Question is not concerned as such with:

- extensions of the scope of protection caused by an amendment where the amendment does not otherwise comprise impermissible added matter, e.g. where a claim is added for a combination A+B disclosed in the specification, making the patent broader that an old claim A+B+C; or
- insufficiency where there is no impermissible added matter, e.g. adding a claim for an embodiment disclosed in the application as filed, but without full instructions being provided in the specification for putting that embodiment into full effect.

For patents granted by the European Patent Office (***EPO***), Article 123(2) of the EPC specifies that:

> *"The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application*

as filed."

Thus, the added matter is the "subject-matter which extends beyond the content of the application as filed." Under the EPO's Guidelines for Examination, H-IV 2.1:

> *"An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not* ***directly and unambiguously derivable from*** *that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art (see G 2/10). At least where the amendment is by way of addition, the test for its allowability normally corresponds to the test for novelty given in G-VI, 2 (see T 201/83)."*

According to some, the practice of the EPO when interpreting this requirement, especially "*directly and unambiguously derivable from*" has been relatively strict. The EPO/EPC approach is informally referred to as the "gold standard."

Other jurisdictions require that the patent have fair basis in, or be supported by the application as filed. In contrast to the EPO gold standard, it may be easier to justify support in situations where the application as filed does not literally disclose the amendment sought to be made.

It is an objective of this Study Question to investigate whether the EPO gold standard is perceived to be suitable as is, or whether there are improvements that could be made or whether there might be a better way to approach impermissible added matter.

The Reporter General has received reports from the following Groups and Independent Members in alphabetical order: Albania (Independent Member), Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Israel, Italy, Japan, Luxembourg, Malaysia, Malta (Independent Member), Mexico, the Netherlands, New Zealand, Norway, Paraguay, the Philippines, Poland, Portugal, Republic of Korea, Singapore, Slovenia, Spain, Sweden, Switzerland, Taiwan (Independent Member), Thailand, Turkey, United Kingdom (***UK***), United States of America (***US***), Uruguay, Venezuela and Vietnam

45 Reports were received in total. The Reporter General thanks all contributors for these helpful and informative Reports.

The Reports provide a comprehensive overview of national and regional laws and policies relating to the restrictions on impermissible added matter. This Summary Report cannot attempt to reproduce the detailed responses given in any given Report. If any question arises as to the exact position in a particular jurisdiction, or for a detailed account of any particular answer, reference should be made to the original Reports. See http://aippi.org/committee/?committee_type=11&status=Active

In this Summary Report:

- references to Reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are to the nearest 5%; and
- in Part IV below, some conclusions have been drawn in order to provide guidance to the Study Committee for this Question.

I. Current law and practice

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

This is possible in all of the Groups. For about 25% of those Groups[1], amendments are only possible prior to grant.

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

For around 95% of Groups, the answer is YES, although the type of amendment that may be made varies.

In a small number of Groups[2], it is only possible to make changes to claims prior to grant but not after grant.

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.

About 40% of the Groups reported that the EPO standard or a standard very similar to the EPO standard is adopted[3]. In the jurisdictions of these Groups, it is not possible to make an amendment if it adds matter compared to the application as filed, or extends the scope of protection. An amendment adds matter unless it is clearly and unambiguously disclosed in the application, either explicitly or implicitly.

Equally, about another 40% of the Groups reported that a standard similar to the EPO standard is adopted, but without a requirement for "clear and unambiguous" disclosure[4]. In these Groups, an amendment is barred if it would extend or change the scope of the matter in the patent beyond what is disclosed in the application as filed. The practice in Australia, of barring amendments that would render infringing something that did not previously infringe, appears similar.

In the US, it is not permissible to add matter going beyond the subject matter originally filed, and it is not permitted to expand scope of claims by amendment except in certain cases e.g. an application for re-issue within 2 years. Somewhat similarly, in Canada, matter which cannot be "reasonably inferred" from the application as filed cannot be added.

In Portugal, added matter takes its own priority date but is not impermissible as such.

In Venezuela, the amendment must be in accordance with the description.

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[1] Albania (Independent Member), Brazil, China, Czech Republic, Hungary, Israel, Paraguay, Portugal, Thailand, Turkey, Vietnam, Switzerland. Post-grant amendments possible in some form in Argentina, Australia, Austria, Belgium, Bosnia, Bulgaria,Canada, Denmark, Estonia, Finland, France, Germany, Italy, Japan, Korea, Luxembourg, Malaysia, Malta, Mexico, New Zealand, the Netherlands, Norway, Philippines, Poland, Slovenia, Spain, Sweden, Taiwan, Uruguay, US, UK.

[2] Albania (Independent Member), Czech Republic, Vietnam.

[3] Austria, Bulgaria, China, Denmark, Germany, Hungary, Italy, Luxembourg, Malaysia, the Netherlands, Norway, Philippines, Poland, Singapore, Spain, Sweden, Taiwan, UK, Uruguay.

[4] Belgium, Bosnia Herzegovina (Independent Member), Brazil, Czech Republic, Estonia, France, Israel, Japan, Korea, Malta, Mexico, New Zealand, Paraguay, Switzerland, Taiwan (Independent Member), Thailand, Turkey, Vietnam.

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

For all the Groups that addressed this issue, there is no difference in the standard for impermissible added matter[5]. With the exception of a few Groups (such as the US and the Philippines Groups), there is an additional standard that applies in relation to post-grant amendments: any post-grant amendments should not extend the scope of protection of the patent beyond the scope absent such amendments.

Albania lacks a relevant defined standard but does include a requirement that claims must be supported by the description.

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 most significant and complex set of rules appear to be those in the US Group. After allowance, it may be possible to file a request to re-issue, continuations, continuations-in-part or a request for continuing examination, with new claims. New claims not supported by the original disclosure take priority from the new filing date, but critically the scope of protection may be extended in some cases.

With the exception of a few Groups, there are additional requirements not to extend the scope of protection beyond the scope absent such amendments when post-grant amendments are made[6].

In approximately 20% of the Groups, amendments are allowed only before grant, or post-grant to fix specific, limited problems or in limited circumstances[7].

The Venezuelan Group reported that the relevant standard may change "at any moment before allowance."

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.

An EPO-like standard is applied in close to half of the Groups[8]. This prohibits the addition of matter if information presented to the skilled person, which is not directly and unambiguously derivable from the disclosure in the specification absent the matter in question, taking into account what is implicit to the skilled person in the disclosure.

A similar standard, but without a "direct and unambigous" requirement, is also applied by over a third of the Groups[9]: matter which lacks support or is not disclosed in the relevant application as filed is barred.

[5] Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Israel, Italy, Japan, Korea, Malaysia, Mexico, the Netherlands, Norway, Philippines, Poland, Portugal, Singapore, Spain, Sweden, Switzerland, Taiwan (Independent Member), Thailand, UK, US, Uruguay, Venezuela, Vietnam.

[6] For example, Austria, France, Germany, Hungary, Israel, Norway, Poland, Singapore, Vietnam.

[7] Bosnia Herzegovina (Independent Member), Bulgaria, Canada, China, Malta (Independent Member), Philippines, Sweden, Switzerland, Thailand.

[8] Austria, Belgium, China, Denmark, Finland, France, Germany, Hungary, Italy, Luxembourg, Malaysia, the Netherlands, Norway, Philippines, Poland, Singapore, Spain, Sweden, Taiwan (Independent Member), UK, Vietnam.

[9] Argentina, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Czech Republic, Estonia, Israel, Japan, Korea, Mexico, New Zealand, Paraguay, Thailand, Switzerland.

There appears to have been some slight variations in answers to questions 3) and 5) but, overall, the EPO-like approach and the approach of prohibiting matter that goes beyond the application as filed are the two main groupings amongst the responding Groups. In addition:

- Canada adopts the approach of barring matter which is "not reasonably to be inferred"; and
- in Australia, amendments are banned that would result in a patent that claims or discloses matter not in application as filed, or which would make something an infringement which did not previously infringe.

In Portugal, impermissible matter is not a ground for refusing an amendment, but the impermissible matter takes the priority from its own filing date.

In a small number of Groups[10], there is no statutory definition of "new matter." In Albania, there is no relevant defined standard but amendments to the subject matter are refused. In Venezuela, the standard applied is the Patent Office Examiners' own subjective opinion.

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;

Just over half of the Groups addressed this question. All save for the Estonian Group[11] reported that the test is how the skilled person would interpret the application[12]. Of these, a number of Groups[13] explicitly added that the skilled person's common general knowledge (***CGK***) should be taken into account.

Some Groups answers seem to be premised on an understanding that the question was more concerned with what documents the "application as filed" comprises.

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?

Save as noted below, all of the Groups[14] that responded to this question took the view that it should be the priority date or the "priority date/date of application as filed". No Groups distinguished substantively between the priority date and the date of the application as filed, presumably because matter in the application as filed may properly claim priority from an earlier filing or where matter in the application as filed cannot properly claim priority from an earlier document then its "priority date" is the date of the application as filed.

7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the

[10] Turkey, US, Uruguay.

[11] Please see the answer to Question 12 of the Report of the Estonian Group.

[12] Argentina, Austria, Bosnia Herzegovina (Independent Member), Canada, Finland, France, Germany, Hungary, Israel, Italy, Japan, Korea, Malaysia, the Netherlands, New Zealand, Norway, Paraguay, Philippines, Poland, Portugal, Singapore, Sweden, Taiwan (Independent Member), UK, Uruguay, Venezuela.

[13] Israel, Korea, the Netherlands, Norway, Philippines, Poland, Portugal, Sweden, UK, Venezuela.

[14] Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Korea, Luxembourg, Malaysia, the Netherlands, New Zealand, Norway, Paraguay, Philippines, Poland, Portugal, Singapore, Slovenia, Spain, Sweden, Switzerland, Taiwan (Independent Member), Thailand, UK, Uruguay, Vietnam.

patentee to remedy the defect, for example by removing portions of the amendment found to be impermissble?

The Groups reported various mechanisms as follows:

- the defect can be corrected during a cancellation/invalidation procedure by removing portions of the amendment found to be impermissible;[15]
- an opportunity is given to the patentee to propose another amendment;[16]
- an amendment to narrow the patent may be acceptable;[17]
- amendments to remove added matter may be acceptable if they do not lead to extension of scope of protection, but are prohibited if they do to such extension of scope;[18]

Together, these Groups represent just over 70% of all Groups.

Other Groups reported that it is there is no opportunity to amend to correct after grant and the presence of added matter leads to invalidation (Uruguay), or that defective claims can only be surrendered (Thailand), or that no corrective measure is possible[19]. In Albania, a Court may order a limitation of the claims.

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?

Some Groups explained the competing policy arguments behind restrictions to amendments.

The Norwegian and Mexican Groups explained that the rationale for limiting amendments is so that legal certainty and the interest of society can be balanced against the applicant's right to amend the application. The German, Finnish and Bulgarian Groups pointed out that unrestricted amendments could give patentees an advantage over third parties and the public. The Venezuelan Group suggested that a re-examination should be conducted when an amendment is made.

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

Just under half of the Groups[20] indicated that there is no need for improvement.

Other Groups would like to see some improvements. The Portugese Group would like to prohibit the introduction of new matter extending beyond the scope of the application as filed, with dislcosures being interpreted as read by the skilled person with their CGK. The Groups from Uruguay, Hungary, Canada, Bulgaria, and Poland would like to clarify the definition of added matter.

The Norwegian Group suggested that "directly and unambiguously" be replaced with a novelty-type test.

[15] Bosnia Herzegovina (Independent Member), Philippines, Spain.
[16] Taiwan (Independent Member), US.
[17] Italy, Korea, Luxembourg, Malta (Independent Member), New Zealand, Portugal.
[18] Austria, Australia, Austria, Belgium, Canada, Denmark, Estonia, Finland, France, Germany, Hungary, Japan, Malaysia, the Netherlands, Norway, Paraguay, Singapore, Sweden, UK, Venezuela, Vietnam.
[19] Argentina, Bulgaria, China, Czech Republic, Poland.
[20] Australia, Austria, Bosnia Herzegovina (Independent Member), Czech Republic, Estonia, Italy, Korea, Malta (Independent Member), the Netherlands, Paraguay, Spain, Sweden, Switzerland, Thailand, Vietnam.

The Mexican Group suggested that rules on impermissible added matter be linked with rules prohibiting lack of clarity.

The German Group suggested that there be a greater emphasis on the skilled person, and a greater tolerance to "intermediate generalisations" (that is, taking a passage from the specification and generalising very slightly), together with flexibility for the deletion of non-essential features of claims. The Groups from Finland, Denmark and China also support greater flexibility.

The Argentinian and French Groups would like to see an express rule making it clear that added matter should be considered by the Court or Patent Office when considering the allowability of amendments.

The Venezuelan Group states that their law should include the prohibition of the introduction of new matter extending beyond the scope of the application as 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?

It is clear from all the Group Reports that the imposition of conditions on amendments is a measure designed to assist with achieving this balance.

In particular, all Groups reported that, if post grant amendments are allowed at all, they are subject to various conditions. Over 70% of the Groups reported that only very limited post-grant amendments are allowed under their law (eg correcting typographical errors, limitations, or amending to cure the specifically alleged invalidity). Only the jurisdictions of a handful of Groups allow more flexibility for amendments, e.g. introducing new claims provided that the scope of protection is not extended and no impermissible added matter is thereby introduced (UK), or merging an independent claim with a claim that is dependent on it to form a new claim (Germany). Most Groups reported that their laws include rules to prevent the introduction of impermissible added matter when making amendments.

Save for a few Groups, such as the US Group and the Philippines Group, Groups whose laws allow post-grant amendment impose an additional condition that there should be no extension of the scope of protection.

The Portuguese Group reported that post-grant amendments are permitted only during prosecution or any appeal of prosecution to a court.

The US and the Philippines Groups reported that broadening claim amendments are limited to re-issues within 2 years.

The Thai Group reported that after grant, it is only possible to surrender, not amend, claims. The Swiss and Hungarian Groups reported that only surrender and limitation of claims is possible. The Chinese Group and the Venezuelan Group reported that only claim limitation is possible. The Canadian Group reported that only very limited amendments are possible.

The Czech and Argentinian Groups reported that no amendments after grant are possible.

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

The Thai and Chinese Groups suggested that amendments immediately prior to grant (after notification that a patent will be granted, but before actual grant) should be allowed.

The UK Group suggested that national approaches and the EPO approach should be unified, especially with respect to intermediate generalisations.

The Philippines Group indicated that post-grant amendments should be allowed to take place more than 2 years after grant.

The Austrian Group suggested that it should be possible to request ab initio limitations on an ex parte basis.

The Swedish Group would like to limit the number of times amendments can be put forward, to balance third party interests against a patentee's right to a fair trial.

The Argentinian, Turkish, Hungarian, French, Cezch, Chinese and Swiss Groups would like to allow post-grant amendments including for not just claims.

The Group from Paraguay would like to introduce substantive examination for added matter if there is an amendment after grant.

The Canadian Group would like more flexibility on timing of re-issues, and greater flexibility for disclaimers.

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?

Just under half of Groups[21] consider that the approach under their current law is effective and that there is no clear need for improvement.

The UK Group considers that the notional person is less useful as a yardstick because added matter is frequently analysed in the UK as a matter of law, and therefore by the Judge without the assistance of experts.

The German and Dutch Groups consider that CGK should play a greater role in the assessment of whether a skilled person would recognise an amendment in the application as filed.

The Estonian Group reported that Estonian law does not use the standard of the skilled person for determing permissibility of amendments.

III. Proposals for harmonisation

13) Is harmonisation of the definition of impermissible added matter desirable?

The vast majority of Groups[22] support harmomisation.

The Groups from Taiwan, Malta, Thailand and Paraguay do not consider any harmonisation is necessary.

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

About 45% of the Groups[23] support the EPO standard, ie an amendment involves the impermissible addition of matter when it extends the subject matter of the patent beyond what

[21] Australia, Austria, China, Czech Republic, Denmark, Finland, Germany, Hungary, Italy, Japan, Korea, Malaysia, Mexico, Norway, Paraguay, Philippines, Poland, Singapore, Sweden, US.
[22] Albania (Independent Member), Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Israel, Italy, Japan, Korea, Luxembourg, Malaysia, Mexico, the Netherlands, Norway, Philippines, Poland, Portugal, Singapore, Slovenia, Spain, Sweden, Switzerland, Turkey, UK, US, Uruguay, Venezuela, Vietnam.
[23] Austria, Belgium, Brazil, Czech Republic, Denmark, Finland, Germany, Italy, Korea, Malaysia, Norway, Philippines, Portugal, Spain, Sweden, Switzerland, Turkey, Venezuela, Vietnam.

can be directly and unambigiously derived from the application as filed, as interpreted by the skilled person. A variation of the EPO standard, which focusses on what additional, new information is learned by the skilled person as a result of the amendment was proposed by the UK and Hungarian Groups.

About 20% of Groups[24] suggested that impermissible added matter should be defined as matter that extends beyond what the skilled person would understand the application as filed to disclose, explicitly, implicity or inherently. The Israeli Group suggested that this is one option but it could also be an option not include inherent/implicit disclosures.

The Chinese Group indicated amendments leading to a technical solution not supported by the disclosure of the application as filed should be impermissible.

The Canadian Group suggested that impermissible matter should be defined as matter that cannot be "reasonably inferred" from the application as filed.

The Argentinian Group suggested that impermissible matter should be defined as subject-matter that is non-obvious from the application as filed.

The Albanian Group proposed that impermissible matter should be any change to the subject matter of any part of the patent.

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)?

Approximately three quarters of the Groups[25] consider the definition should not depend on when an amendment is made. A number of Groups (e.g. Australia, Israel, Poland, US) observed that additional limitations on extending the scope of protection should be applied after grant.

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

Just under two thirds of the Groups[26] consider that added matter rules should not prevent the addition of claims.

The German and Portuguese Groups, and the Independent Members from Albania and Taiwan, consider that added matter rules should prevent the addition of claims after grant.

In the view of the US Group, after grant there should be a limited opportunity to expand the scope of protection while safeguarding third party interests (e.g. by giving protection to third parties with intervening interests i.e. sales commenced after grant of the patent that do not infringe the claims as granted but which could infringe the claims as expanded); while for pre-grant, all requests to amend with permissible matter should be granted.

The Slovenian and Polish Groups indicated that added matter rules should prevent the addition of claims. The Norwegian and Hungarian Groups indicated that only new dependent claims should be allowed.

[24] Australia, Bosnia Herzegovina (Independent Member), Estonia, France, Japan, Mexico, Poland, Singapore, Slovenia, US.
[25] Albania (Independent Member), Argentina, Austria, Belgium, Bosnia Herzegovina (Independent Member), Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Korea, Luxembourg, Malaysia, Mexico, the Netherlands, Norway, Philippines, Portugal, Singapore, Slovenia, Spain, Switzerland, Taiwan (Independent Member), Thailand, Turkey, UK, Venezuela, Vietnam.
[26] Argentina, Australia, Austria, Bosnia Herzegovina (Independent Member), Brazil, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Italy, Japan, Korea, Malaysia, Mexico, the Netherlands, Philippines, Singapore, Spain, Sweden, Switzerland, Turkey, UK, Venezuela, Vietnam.

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

All bar one Group[27] felt that added matter rules should not prevent the removal of claims.

The Estonian Group and the Independent Member for Albania consider that added matter rules should prevent the removal of claims.

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

All Groups that responded to this question[28] indicated that the definition 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?

All Groups that responded to this question[29] felt the date should be the priority date/date of application as filed (save that the Independent Member for Albania took the view that the relevant date should be prior to the grant of the patent).

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?

There appears to be no majority view.

The Bosnian Group suggested rolling back amendments until there is no extension of scope left. A similar proposal was made by the Groups from Malaysia, Canada and Argentina, and a number of other Groups[30] felt that there is no solution except to find an amendment which eliminates the added matter. Overall, these Groups represent approximately 20% of the total.

The Groups from Taiwan, Finland and China suggested pre-grant extension of scope should be acceptable as long as such extension is supported by the matter in the specification i.e. does not result in impermissible added matter. The Groups from Poland and Estonia suggested that pre-grant extensions of scope are acceptable but should lead to invalidation if they are made after grant.

The US Group suggested pre-grant extensions of scope should be acceptable provided they are supported by the matter in the specification. Accorcing to the US and Japanese Groups, post-grant extensions of scope should be acceptable in limited circumstances e.g. for 2 years.

The Thai Group suggested introducing a re-examination system to allow the defect to be removed.

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[27] Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Finland, France, Germany, Hungary, Israel, Italy, Japan, Korea, Malaysia, Mexico, the Netherlands, Norway, Philippines, Poland, Portugal, Singapore, Slovenia, Spain, Sweden, Switzerland, Taiwan (Independent Member), Turkey, UK, US, Venezuela, Vietnam.

[28] Albania (Independent Member), Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Israel, Italy, Japan, Korea, Luxembourg, Malaysia, Mexico, the Netherlands, Norway, Philippines, Poland, Portugal, Singapore, Slovenia, Spain, Sweden, Switzerland, Taiwan (Independent Member), Thailand, Turkey, UK, US, Venezuela, Vietnam.

[29] Argentina, Australia, Austria, Belgium, Bosnia Herzegovina (Independent Member), Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Korea, Malaysia, Mexico, the Netherlands, Norway, Philippines, Poland, Portugal, Singapore, Slovenia, Spain, Sweden, Switzerland, Thailand, Turkey, UK, US, Venezuela.

[30] Belgium, Brazil, Israel, France, Italy, Mexico, Philippines, Spain, Sweden, Venezuela.

Approximately 25% of the Groups[31] indicated there should be no remedy.

The German Group suggested allowing matter to be added that would otherwise be impermissible, and if added, would need to be considered for infringement. However, such matter should be ignored for assessing novelty and obviousness by the Patent Office or Court. The Dutch Group suggested either amending to remove impermissible matter, or adopting the German approach.

The Czech Republic indicated that the only solution is to revert to the application as originally filed.

The Singaporean Group suggested that one potential solution could be to give no retroactive effect to the amended but expanded claims, so that third parties not infringing prior to amendment are not taken to infringe after amendment.

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

The Hungarian Group commented that exactness should prevail over fairness/unclear definitions of added matter.

The Singaporean Group would wish to explore if added matter could be allowed prior to publication of the patent application.

Industry sector views included in these proposals for hamornisation

The following consultation with industry was reported:

- Chemical, high tech (US, Spain)
- Biotech (Sweden)
- Household appliances (Turkey)
- Pharmaceuticals (Turkey, Spain, Hungary)
- Machinery (Spain)

IV. Conclusions

There is nearly unanimous support for harmonisation, and specifically for a harmonised definition of impermissible added matter. The main question therefore becomes how impermissible added matter should be defined.

Although there was no clear majority across all Groups, the greatest support was received by the EPC approach to added matter, although not necessarily as strict or literal in its approach as is perceived to have been adopted on some occasions by the EPO. This approach was supported by 45% of all Groups (including six non-EPC Groups[32]; but not by all Groups from EPC contracting states), and is supported by about twice the number of Groups compared to the next most popular definition of impermissible matter. Some Groups (for example, Germany) support the EPC approach but have also stated that they would like to see a less literal application of that approach.

It is possible to see a number of themes/aspects of impermissible added matter that have been

[31] Australia, Austria, Bulgaria, Denmark, Hungary, Korea, Norway, Paraguay, Switzerland, Vietnam.
[32] Brazil, Korea, Malaysia, Philippines, Venezuela, Vietnam.

highlighted in the Group Reports as potentially relevant:

(1) whether the application as filed should be interpreted by the (notional) skilled person (supported by a majority of Groups addressing this question), and if so whether evidence as to the views of the notional skilled person should guide the Court and/or the Patent Office (supported by a small number of Groups; other Groups did not comment or oppose);

(2) whether only express disclosures in the application as filed should be regarded as having been disclosed, or whether implicit or inherent disclosed should also be regarded has having been disclosed (the latter is supported by a majority of Groups);

(3) whether the skilled person should use their CGK to interpret the application as filed (this appears to have good support from Groups, with other Groups not being opposed or commenting);

(4) what is the date of any CGK that is to be considered (nearly unanimously: the priority date).

European Groups report that the EPO has adopted a relatively strict approach to added matter, with the result that it has become difficult to add intermediate generalisations or anything close to an intermediate generalisation by amendment. Instead, the EPO has tended to require that if a passage is taken from the specification, it is added verbatim as a claim limitation, which can result in a very narrow claim despite even if the inventors had in mind a more general concept.

There appears to be support from a number of Groups for the EPO approach to be softened, but there are no concrete proposals on how this could be achieved. This softening could include a more flexible approach to intermediate generalisations.

A clear majority of Groups support applying the same test for impermissible added matter for Courts and for Patent Offices, and pre- and post-grant. The Groups support formalising requirements for impermissible added matter into relevant national legislation.

The Dutch Group's suggestion for harmonisation covers many of these issues:

(1) *Impermissible added matter is subject matter which extends beyond the content of the application as filed, being any subject-matter which the skilled person cannot derive directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document.*

(2) *The definition of impermissible added matter should not be interpreted as meaning that literal support is required. On the other hand, the overall change in the content of the application (whether by way of addition, alteration or excision) should also not result in the skilled person being presented with information that is not directly and unambiguously disclosed in the application as filed and that would improve applicant's or patentee's position and would be damaging to the legal certainty of third parties relying on the content of the original application.*