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?

Amendments to the description and figures of a pending application are possible by way of voluntary amendment, amendment in response to an Examiner’s Requisition, or in limited circumstances after allowance (Canadian Patent Act, R.S.C., 1985, c. P-4, s. 38.2).

Amendments to the description and/or figures of an issued patent are possible within four (4) years of grant by way of reissue and at any time during its term via re-examination (Patent Act, ss. 47, 48.3 respectively). Amendments to the description and figures of an application or a patent are possible at any time by way of correction of clerical error (Patent Act, s. 8). Each of these mechanisms is discretionary, and is only available upon consent of the Commissioner.

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

Amendments to the claims of an application are possible by way of voluntary amendment, amendment in response to an Examiner’s Requisition, or in limited circumstances after allowance. Amendments to the claims of an issued patent are possible by way of reissue, disclaimer, and re-examination (Patent
Amendments to the claims of an application or a patent are also possible by way of correction of clerical error (Patent Act, s. 8).

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.

Amendments to the specification and drawings in an application are permissible unless they would add subject matter “not reasonably to be inferred” from the specification and the claims as originally filed, or drawings as originally filed. Not yet in force amendments to Canada’s Patent Act ratifying the Patent Law Treaty (PLT) will allow incorporation of subject matter from priority applications in certain circumstances. Although matter pertaining to prior art may be added to the specification, such matter must be identified as prior art. (Patent Act, subs. 38.2(2), 38.2(3); Manual of Patent Office Practice, s. 19.03).

This standard has not been explained in detail by the Canadian Intellectual Property Office (“CIPO”) or by Canadian courts. However, the jurisprudence provides some piecemeal guidance.

- The “reasonably inferable” standard will likely not accommodate amendments that seek to alter or expand upon the inventive concept in the original specification. However, the standard is likely more permissible regarding the expansion of ancillary description and technical matters relating to operation or use, and acknowledges that there is a difference between imperfection of draftsmanship and non-compliance with the statute (Application No. 139,256, Re (1977), 51 C.P.R. (2d) 95 at 100 (P.A.B.)).

- Matter need not be explicitly disclosed in the original specification to be reasonably inferable (Uni-Charm Corp., Re (2013), 119 C.P.R. (4th) 462 at para. 15 (P.A.B.)). For example, the Patent Appeal Board accepted that claims describing a capsule including a set of waves necessarily required a means for generating those waves. Such a generator was an “implicit feature” of the specification as originally filed. The addition of a “generator” to the specification, among other more specific phrases, was therefore reasonably inferable from the specification as originally filed (Stukanov, Re, 2015 CarswellNat 4951 at paras 46-50 (P.A.B.)). By way of further example, an amendment to a claim that specified aluminum as a possible component of an alloy was reasonably inferable from the original specification. The skilled person would understand that an aluminum alloy would be suitable to meet the necessary physical requirements in the context of a vehicle bumper (RWB Trust (Trustees of), Re (2009), 79 C.P.R. (4th) 125 at para 47 (P.A.B), rev’d though not on this point, 2011 FC 873. A subsequent letter by the Commissioner reiterating the decision to send the matter back to the Examiner was ultimately what was reversed in this matter.).

- When “specific, technical details” are introduced as added matter to a broad disclosure of a device, they will likely not be reasonably inferable from the originally-filed specification. The Patent Appeal Board rejected details such as “the lens of between 0.5 and 0.25 centimeters in thickness” where the original specification broadly disclosed glasses or a glasses attachment to protect computer users from glare and radiation without further technical details (Reesink, Re (2008), 68 C.P.R. (4th) 141 at para 28 (P.A.B.)).

- Support for added matter may be found in the original drawings in combination with the original specification (Uni-Charm Corp., Re (2013), 119 C.P.R. (4th) 462 at para. 28 (P.A.B.)). Post-grant amendment mechanisms (reissue, disclaimer, re-examination, correction of clerical errors) are discussed in response to Question 10.

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?
For pending applications (Patent Act s. 38.2) amendments to claims are subject to the same “reasonably to be inferred” standard as amendments to the description and figures.

However, one trial decision of the Federal Court has suggested that amendments to claims should be evaluated based on whether amended claims are broader than or adequately supported by the invention originally disclosed, rather than whether they introduce impermissible new matter. (Bartley v. Canada (Commissioner of Patents) (2011), 95 C.P.R. (4th) 210 at paras. 63-66 (F.C.); Patent Rules, SOR/96-423, s. 84).

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.

Generally, voluntary amendments to an application pursuant to s. 38.2 may be made at any time before allowance. The “not reasonably to be inferred” standard described in response to Question 3(a) applies.

Amendments after allowance are permissible, provided that they may only be made if they do not necessitate further search and do not make the allowed application non-compliant with the Patent Act and Rules (Patent Rules, subs. 32(b)). Amendment after payment of the final fee is generally not permitted (Patent Rules, subs. 33(1)).

Post grant, additional restrictions and time limitations will apply pursuant to the particular post-grant mechanism chosen. These are summarized in response to Question 10.

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 amendment under section 38.2 of the Patent Act may be objected to if it introduces impermissible added matter. In such circumstances, the Examiner will requisition that the matter be removed (Manual of Patent Office Practice, s. 19.03).

Impermissible added matter is defined as matter that is “not reasonably to be inferred” from the specification or drawings as originally filed. Although matter pertaining to prior art may be added to the specification, such matter must be identified as prior art. (Patent Act, subs. 38.2(2), 38.2(3)).

The assessment of added matter requires a comparison of the pending specification and drawings with those of the application as originally filed. The addition of matter is limited to that which is explicitly or implicitly disclosed, and does not extend to everything that is common general knowledge to the person ordinarily skilled in the art, or considered obvious by some mosaic of references (Re RWB Trust (Trustees of) Patent Appn. No. 2,159,968 (2009), 79 C.P.R. (4th) 125 at paras. 21, 26 (P.A.B.)). An inference can be derived by reasoning or implication from the specification as originally filed (Re Application No. 139,256 (Patent No. 1,029,723) (1977), 51 C.P.R. (2d) 95 at 100-101 (P.A.B.)).

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 application as filed is interpreted from the perspective of a person of ordinary skill in the art possessing the relevant common general knowledge (Reesink, Re (2008), 68 C.P.R. (4th) 141 at para 18 (P.A.B.)). The specification as originally filed is compared to the current specification (Reesink, Re (2008), 68 C.P.R. (4th) 141 at para 20 (P.A.B.)). This assessment does not consider further information known to the inventor that was not disclosed in the specification as originally filed (Reesink, Re (2008), 68 C.P.R. (4th) 141 at para 19 (P.A.B.)). Regard may be had to expert evidence to assist with understanding the meaning of terms (Allied Colloids Ltd. v. Alkaril Chemicals Ltd. (1990), 34 C.P.R. (3d) 426 at 429 (F.C.T.D.)).

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 is the date of filing (Re Uni-Charm Corp. (2013), 119 C.P.R. (4th) 462 at para. 14 (P.A.B.)).

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:

Amendment under section 38.2 of the Patent Act to an application prior to grant, which is determined to contain impermissible added matter, could be remedied after grant by way of reissue, disclaimer, re-examination, or correction of clerical error under sections 47, 48, 48.3, and 8 respectively of the Patent Act.


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?

Canadian practice is quite flexible in allowing an applicant to make amendments to an application at almost any time during the prosecution phase (i.e. prior to a Notice of Allowance being issued), either in response to Examiner Requisitions or by voluntary amendments.

Fairly, any such amendments may not introduce subject matter that cannot be reasonably inferred from the application as originally filed.
This provides an adequate balance by permitting an applicant to make amendments when desired or needed while preventing the introduction of impermissible subject matter. In practice, the standard may be somewhat lenient at times. Permitting amendment during prosecution allows a patent attorney to redirect the application with the hindsight of time which typically is not available when a case is drafted.

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

yes

Please explain:

Current Canadian law and practice provides an adequate balance between the applicant and the public.

Greater guidance on what is “reasonably inferable” might benefit applicants and the profession.

For example, when are broadening amendments to claims, or deletions from an application not reasonable inferable? Current “promise of the patent” doctrine may compel Applicants to remove matter, such as promises made as to the utility of the invention; it is unclear whether removal of such promises might be seen as a broadening of the invention.

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?

Granted patents may be amended by requesting reissue of the patent, requesting re-examination of the patent, requesting a disclaimer of the scope of all or part of one or more claims, or requesting correction of clerical errors. The choice of the amendment route depends upon the facts underlying the reasons for requesting the amendment.

Reissue, disclaimers and re-examinations are expected to have impermissible added matter as a ground for objecting to or invalidating an amendment. Accordingly, the above definition likely applies.

Correction of clerical errors generally may not be refused on the ground of impermissible added matter (Bayer Aktiengesellschaft v. Commissioner of Patents (1980), 53 C.P.R. (2d) 70 at 73 (F.C.T.D.)). However, some case law has suggested that the obviousness of the error is relevant to the determination of a clerical error (Pason Systems Corp. v. Canada (Commissioner of Patents) (2006), 54 C.P.R. (4th) 40 at para. 33 (F.C.)).

Post grant there is a public interest in ensuring that third party reliance on the granted patent is not undermined by allowing the patentee to make significant changes to the scope and/or contents of the patent.

The balance is further addressed by imposing additional restrictions on the availability of the mechanisms for post-grant changes aside from prohibiting added subject matter. See below a
summary of the restrictions for each mechanism.

Reissue of a patent is permissible if the patent is deemed defective or inoperative by reason of insufficient description and specification, or by reason of the patentee claiming more or less than he had a right to claim as new; and the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention; and the re-issued patent is for the same invention: (Patent Act, subs. 47(1)). The reissue must not allow the patentee to alter the subject matter of the patent, so that it is outside the limits of the invention that was intended (Mobil Oil Corp. v. Hercules Canada Inc. (1994), 57 C.P.R. (3d) 488 at 498 (F.C.T.D.), rev’d on other grounds (1995) 63 C.P.R. (3d) 473 (F.C.A.), leave to appeal ref’d (1995) S.C.C.A. No. 502 (S.C.C.)). However, reissue may allow the patentee to narrow or broaden the scope of the claims as issued to achieve what was intended (Hershkovitz v. Tyco Safety Products Canada Ltd. (2010), 89 C.P.R. (4th) 101 at para. 24 (F.C.A.) (obiter)). Reissue is permissible only within four years from the date of grant (Patent Act, subs. 47(1)).

Disclaimer to an issued patent is permissible if the specification was made “too broad”, claiming more than the inventor invented or subject matter to which the patentee had no lawful right; the error arose by mistake, accident or inadvertence, and without any willful intent to defraud or mislead the public; and the disclaimer disclaims parts of a claim (Patent Act, subs. 48(1)). The disclaimer must not broaden the scope of a claim. CIPO registers disclaimers that are in the prescribed form without substantive review, automatically narrowing the scope of the claims. The filing of a disclaimer is a concession that the claims as issued were overbroad and void, and thus cannot be asserted even if a court ultimately finds a disclaimer invalid (Hershkovitz v. Tyco Safety Products Canada Ltd. (2010), 89 C.P.R. (4th) 101 at paras. 3, 23, 25, 46-47 (F.C.A.)). There is no deadline for filing a disclaimer, but there is an obligation to file “promptly and diligently” when the patentee becomes aware of the mistake, accident or inadvertence. The validity of the patent will only be saved if the disclaimer is filed in a timely way (Hershkovitz v. Tyco Safety Products Canada Ltd., 2009 FC 256 at para 78 aff’d 2010 FCA 190).

Re-examination of an issued patent is permissible if prior art affects the patentability of a claim, and the amendment or new claim proposed does not enlarge the scope of a claim: (Patent Act, subs. 48.2(2), 48.3(2)). Re-examination may be pursued at any time after issuance (Manual of Patent Office Practice, s. 23.02).

Correction of errors is permissible if an error is a “clerical error”; and in the exercise of discretion by the CIPO, the error should be corrected (Repligen Corp. v. Canada (A.G.) (2010), 90 C.P.R. (4th) 409 at para. 39 (F.C.)). Correction of clerical errors may be refused after publication, in case of prejudice to third parties who relied upon the errors (Bristol-Myers Squibb Co. v. Canada (Commissioner of Patents) (1997) 77 C.P.R. (3d) 300 at 303 (F.C.T.D.), aff’d (1998), 82 C.P.R. (3d) 192 at para. 25 (F.C.A.)). Correction may also be refused in cases of delay in seeking correction (Dow Chemical Co. v. Canada (A.G.) (2007), 63 C.P.R. (4th) 89 at para. 20 (F.C.)).

In practice, post-grant amendment mechanisms are rarely used to correct issued patents. See further discussion in response to Question 11.

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

Please explain:

Post-grant amendment procedure is somewhat restrictive, and therefore rarely used. The procedure potentially could be liberalized.

For example, the existing provisions of the Patent Act have been interpreted so as to make it very difficult to use the disclaimer and reissue provisions, skewing the balance against the interest of the patentee. Revision to rebalance the rights of the public and the patentee is desirable. The hurdle for the patentee should not be as high as it is.

In particular, if the validity of a disclaimer is challenged in court, the patentee must establish the particular mistake, accident or inadvertence that prompted the disclaimer. The disclaimer must also have been filed “promptly and diligently”. It cannot broaden the claims, add inventive elements, or clarify a vague claim. Finally, the filing of a disclaimer is a concession to the overbreadth of the issued claims. If the disclaimer is found invalid by a court, the patentee is unable to fall back on the claims as issued (Hershkovitz v. Tyco Safety Products Canada Ltd., 2009 FC 256 at paras. 76, 78, 84-92, aff'd 2010 FCA 190).

Reissue is only available for four years after grant. The patentee must surrender the issued patent in favour of a reissue application, which will be subject to substantive examination (Hershkovitz v. Tyco Safety Products Canada Ltd., 2009 FC 256 at para. 77, aff'd 2010 FCA 190).

As the law evolves, patent holders might be provided an opportunity to modify their patents to address requirements that did not exist when the patent was originally drafted. For example, it may be useful if reissue could be extended beyond cases where the error arose from inadvertence, accident or mistake; specifically, this could be extended to situations where disclosure requirements change significantly in law. For example, the introduction of the “promise of the patent” doctrine has made it reasonable to want to change a disclosure drafted before that doctrine was law; but that might not be considered inadvertence, accident or mistake.

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?

Canadian law does use the concept of a notional person of ordinary skill in the art in determining whether the subject matter of an amendment can be reasonably inferred from the originally filed application. However, accurately determining the knowledge and skill of the notional person of ordinary skill in the art often requires expert evidence. Accordingly, application of the knowledge of the notional skilled person by the patent office may lead to undesirable debate. More rigorous examination guidance may be desirable.

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, harmonization of what is deemed impermissible added subject matter would be desirable. It would ensure consistency in amendments made to corresponding applications or patents in other jurisdictions.

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

It is believed that the definition under Canadian law is appropriate. Namely, impermissible added matter is subject matter that cannot be reasonably inferred from the originally filed application from the viewpoint of a person having ordinary skill in the art. Permissible matter includes matter that is explicitly disclosed in the original filing and matter that is implicitly disclosed from the point of view of a person of ordinary skill in the art. Again, possible clarification on how to determine what is reasonably inferable may be desirable. This standard allows the right level of flexibility while maintaining a degree of certainty.

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

no
Please explain:

The definition of impermissible added matter should not depend on when an amendment is made. As indicated above, the definition of impermissible added matter should be based on the content of the originally filed application and should not vary depending upon the status of the application during prosecution.

However, post-grant amendments should be subject to additional restrictions. Prior to grant, the amendment may be made at any time before allowance. Post grant, a suitable test is required. Also, the interface with prior user rights should be considered. For example, if it is easy to amend a claim post grant, then there is a good argument that a third party who would infringe the amended claim should be entitled to a prior user right. However, if a more rigid test is applied, the merit for providing a prior user right is reduced.

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

No. The two issues are distinct and should not be linked. The addition of one or more claims per se would not necessarily involve the introduction of impermissible subject matter. An applicant or patentee should be permitted to add, cancel or amend claims as necessary, with the proviso that impermissible added matter (as defined above) cannot be introduced. Certain post-grant mechanisms for amendment may have additional restrictions that would prevent adding claims.
### 17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

**no**

**Please explain:**

No. As mentioned in the response to question 16, the cancellation of claims per se would not necessarily involve the introduction of impermissible subject matter and, therefore, the two issues should not be linked. Certain post-grant mechanisms for amendment may have additional restrictions that would prevent 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?

**yes**

**Please explain:**

Yes, the same definition and evidentiary burden should be applied equally for pending applications and granted patents, regardless of whether the definition is applied by the patent office or a court. This will ensure a consistent application of the definition and the associated principles of construction. Without such consistency, the scope of a patent or a pending application may be uncertain, which would not serve public policy needs.

### 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?

The appropriate date for evaluating the permissibility of added matter is the filing date of the application.

### 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?

During pendency, any impermissible added matter that has been introduced by amendment to the description should be rejected and the applicant should be permitted to delete such added matter.

During pendency, if an amendment to a claim is found to introduce impermissible added matter, such claim should be objected to on that basis and the applicant should have the right to cancel or amend the claim. If the claim is amended to delete the impermissible added matter, such claim should be examined according to the existing laws of patentability. If the removal of the impermissible added matter results in a broadening of the claim scope, such claim may be subject to further rejection for reasons of insufficient support in the application and/or lack of novelty or inventiveness etc. Once the patent is granted, any claim deemed by a court to include impermissible added matter (as defined above) should be found invalid for that reason.

It is unclear what fate the patent would suffer if the impermissible subject matter was added to the description. By way of example, if the description contains certain statements that may be construed to be a “promise” and these statements are removed or amended during prosecution, and that
amendment is found by a court to essentially be the addition of new subject matter, would the entire patent be held invalid? This may, of course, be a Canada-specific issue.

Possibly, if added matter was added to the description, then found impermissible, the patent should be read as if the matter had never been added. Validity of the claims should be analyzed on a claim-by-claim basis, to determine support for the claim without the added matter.

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

No additional issues were raised.

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

Unfortunately, no industry member participated in the preparation of the submission. However, the committee is of the opinion that all industry sectors would be in agreement with the proposals for harmonization listed above since the committee members represent a diverse set of clients.

Summary

Impermissible added matter is subject matter that cannot be reasonably inferred from the originally filed application from the viewpoint of a person having ordinary skill in the art. Permissible matter includes matter that is explicitly disclosed in the original filing and matter that is implicitly disclosed from the point of view of a person of ordinary skill in the art. The appropriate date for evaluating the permissibility of added matter is the filing date of the application. Possible clarification on how to determine what is reasonably inferable may be desirable. This standard allows the right level of flexibility while maintaining a degree of certainty.

The definition of impermissible added matter should not depend on when an amendment is made. However, post-grant amendments should be subject to additional restrictions. Prior to grant, the amendment may be made at any time before allowance. Post grant, a suitable test is required. Also, the interface with prior user rights should be considered.

The same definition and evidentiary burden should be applied equally for pending applications and granted patents, regardless of whether the definition is applied by the patent office or a court. This will ensure a consistent application of the definition and the associated principles of construction. Without such consistency, the scope of a patent or a pending application may be uncertain, which would not serve public policy needs.