



Submission date: 21st April 2016

2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

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Date	21-04-2016

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. However, amendments to the description and/or figures and photographs are limited to clarifications, corrections and adjustments in light of amendments to the patent claims.

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.

The Danish Patent and Trademark Office (DKPTO) and the Danish courts follow the practice from the

EPO, cf. the current EPO Guidelines, when determining whether amendments to the description, figures etc. and patent claims are permissible.

This means that the DKPTO and Danish courts generally will acknowledge a change to the description and claims if:

- the scope of the claims after the amendment is within the scope of the originally claimed invention
- the data on which the amended claims are based are specified in the basic documents, and
- the content of the claims after the amendment lacks novelty in relation to the content of the basic documents.

Normally no objection will be raised if an applicant/patent holder introduces further relevant information about prior art.

When an applicant introduces changes in the description such as:

- the introduction of new effects of the invention (that is, effects that were not mentioned in the basic documents), such as new technical advantages,
- a review of an alleged technical problem or
- introducing further examples,

the DKPTO examines whether the scope of the claims is within the scope of the originally claimed invention and whether the content of the claims is new in view of the basic documents.

Although the DKPTO (and Danish courts) will follow the practice from the EPO when determining whether amendments to the description, figures etc. and patent claims are permissible, it is, however, the Danish Group's experience that the DKPTO tends to interpret the EPO provisions for determining impermissible added matter somewhat liberally, e.g. in line with the recent EPO Guidelines for determining whether an amendment has verbatim basis in the application as filed.

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

No. The standard for determining whether an amendment is admissible as set out in the answer to question 3(a) is applicable to amendments of the description and drawings/figures as well as to amendments of the claims.

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.

No. The allowability of added matter will be examined in relation to the above irrespectively of when the amendment is made. After allowance and after grant the claims may not be amended in such a way as to extend the protection they confer.

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.

Impermissible added matter is a ground for refusal. Impermissible added matter will be at issue if the conditions as set out in the reply to question 3 and 4 are not met (we refer to our answers to these questions).

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;

In order to assess whether impermissible added matter has been added, the DKPTO will according to the DKPTO's Guidelines interpret the application as filed ("the basic documents") as the description and accompanying drawings, photographs and claims as submitted on the filing date. The application may be filed in any language, but the Danish Patent Office will usually require a translation into either Danish or English of the description. It is the Danish or English description as filed or as translated that is considered the "basic document" from which basis should be derived.

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?

In assessing inventive step, it is, according to the DKPTO's Guidelines, reasonable to construe any published document in the light of subsequent knowledge and in general to take into account all the knowledge that was widely available for those skilled in the art at the effective date of the patent claims. We believe the same point in time (i.e. the effective date of the patent claims) would apply for the skilled person when assessing what is directly and unambiguously disclosed – however, this is not explicitly stated in the DKPTO's Guidelines.

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:

Post-grant administrative proceedings

The patentee may voluntarily request an administrative re-examination of the patent (the option is also available for third parties), although not as long as any court proceedings concerning the patent are pending, for a limitation of the patent claims. It is a requirement that the amended patent claims still fulfill the patentability conditions, namely novelty, inventive step and the prohibition against impermissible added matter.

It is the Danish Group's view that this option would also be available in order to remedy a defect pertaining to impermissible added matter, although this view is not based on authority.

Post-grant court proceedings

Danish case law shows (and Danish patent theory suggests) that there is some access to limit the protective scope of a patent by amending the patent claims during court proceedings. The amendment may be initiated by either the patentee or the opponent. It is a requirement that the amended patent claims are still within the boundaries of what was originally disclosed in the claims as granted.

It is the Danish Group's view that this option would also be available in order to remedy a defect pertaining to impermissible added matter.

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?

The guidelines and case law of the Danish Patent and Trademark Office ("DKPTO") are generally harmonised with the guidelines and case law of the EPO.

The EPO guidelines (Part H, Chapter IV, 2.2) as of 2015 set out the following doctrine in relation to striking a balance:

"Under Art. 123(2), it is impermissible to add to a European application 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. Literal support is, however, not required by the wording of Art. 123(2)"

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

yes

Please explain:

The Danish Group finds the EPO guidelines to express a desirable standard. However, the Danish Group finds that particularly the standard "unambiguously" has in some cases been applied too rigorously at the EPO, and that the EPO has not accepted implicit features to be sufficient in cases where such features would nevertheless be derivable by the skilled person using common general knowledge from the application as filed as a whole. Thus, the Danish Group believes that the EPO has applied a too strict and literal approach which is not desirable to maintain.

The Danish Group believes that the application of a revised standard would be permissible under the existing legislation (i.e. the EPC and the Danish Patents Act).

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, Danish law allows certain post-grant amendments during opposition and appeal proceedings, during court proceedings and during administrative re-examination proceedings (we refer to our answers to questions 1-3).

Pursuant to Danish law, there is no difference between amendments made during examination or amendments made post grant, except that in opposition and appeal proceedings and court proceedings, the scope of protection of the claims as originally granted cannot be extended, whereas in administrative re-examination proceedings, amendments must limit the scope of protection of the claims as originally granted.

According to the EPC, Article 105a, a central limitation shall also be a true limitation.

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

yes

Please explain:

Please see our answer to question 9.

- 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 Danish Group finds that the person skilled in the art would be the right standard to apply. However, see reply to question 9. There is no Danish case law from the law courts.

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:

The Danish Group believes that it is desirable to harmonise the definition of impermissible added matter to ensure consistency between countries, provided this can be done in a way that secures the legitimate interests for both the patentee and third parties.

Under the current system, amendments which are acceptable in one country (e.g. USA) may not be acceptable in other countries (e.g. the EPO countries), to the detriment of foreign applicants.

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

The Danish Group proposes that a definition of impermissible added matter could be worded in accordance with the EPO guidelines as cited in our reply to question 8, as long as those are reasonably applied in practice (see our reply to question 9).

- 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:

It is generally not desirable to have a definition with separate meanings depending on at what time the amendment is made.

That being said, the Danish Group has considered if there should be some difference in terms of allowing amendments before or after grant because it could be argued that there should be a higher degree of legal certainty towards third parties when an amendment is made post grant. However, the Danish Group has not been able to identify any solutions to this potential discrepancy between the interests of the patentee and the interests of third parties.

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

No.

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

no

Please explain:

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:

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 Danish Group proposes that the relevant date of knowledge, should be the effective filing date, i.e. the date where earliest priority is claimed for the relevant subject-matter.

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?

The Danish Group understands the question as referring to post grant proceedings, including opposition and appeal proceedings.

The Danish Groups finds that the most straight-forward solution would be for the patent to be invalid ex tunc.

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

No additional comments.

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

No industry sector views are included.

Summary

In Denmark, amendments to both patent claims and the description are possible during prosecution and after grant, both administratively and at the courts. Generally, Danish case law follows the case law of the EPO and will allow an amendment, provided that there is no addition of subject-matter that could not be derived directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed. The Danish Group would favour international harmonisation in this field.