



Submission date: 9th May 2016

2016 – Study Question (Patents)

Sarah MATHESON, Reporter General

John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General

Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

Norway

Contributors name(s)

Harald TAFJORD and Yngve ØYEHAUG OPSVIK

e-Mail contact

ht@baa.no

Date

02-05-2016

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, the description and/or the figures of a Norwegian patent application or Norwegian Patent may be amended in examination, opposition, re-examination and limitation proceedings.

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

Yes, amendments to the claims are possible before and during prosecution, in opposition proceedings, in administrative limitation and re-examination proceedings, and in invalidity proceedings before the courts. The scope of protection rendered by the claims cannot be extended after notice of grant is issued.

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 Norwegian Patents Act and the Regulations to the Norwegian Patents Act (Patent Regulations) have provisions relevant to added matter. The standard for determining whether amendments are

permissible is expressed in Part C, Chapter VII, item 1.1. of the Examiners' Guidelines, and mirrors the current case law of the EPO. The same standard applies to changes both in the description and the claims.

Before notice of grant: Amendments are dealt with in the Norwegian Patents Act section 13, Patent Regulation §§ 20 and 21 and further in Examiners Guidelines Part C, chapter VII.

Pursuant to Section 13 of the Norwegian Patents Act "A patent application must not be amended in such a way that protection is claimed for subject matter which was not disclosed in the application at the time it was filed."

As mentioned, the definition of what shall be considered amendments which go beyond subject matter as filed is given in item 1.1 of the Examiners' Guidelines. An amendment shall be regarded as introducing subject-matter not disclosed in the application as filed, and therefore impermissible, 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).

The standard is not further developed in Norwegian case law. As Norway is a member of the EPC, Decisions from the EPO will continue to influence the assessments of Norwegian courts and authorities.

Please note that the provisions in section 13 of the Patents Act, and the quoted standard, apply from the filing of the original application and throughout the life of the application and the patent.

Once the Patent Office has issued a notice of grant, any amendments should also comply with the provisions in Section 19 of the Norwegian Patents Act and further specified in Examiner Guidelines Part C, chapter VII, point 1.3. Section 19, second paragraph provides that subsequent to the applicant having been notified that a patent may be granted, the patent claims may not be amended so as to extend the scope of the patent protection.

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

The standard is the same, regardless of whether it is a matter of amendments to the description and figures or amendments to 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.

As mentioned in the answer to question 3, the standard does not change according to timing, however, additional limitations apply.

Before examination/search: Applicant may amend the application on his own volition taking into consideration that subject matter cannot extend beyond what was disclosed in the application as filed.

After receipt of search report: Applicant may amend the claims and the description, however according to patent regulations chapter 4, section 20, third paragraph applicant is restricted not only by the general principle according to section 13 of the Norwegian Patents Act but he is also limited to claims that don't describe an invention independent of the invention being searched by the Norwegian Industrial Property Office.

After notice of grant and post grant proceedings, the issue is regulated by the Norwegian Patents Act

Section 19 and further specified in Examiner Guidelines Part C, chapter VII, item 1.3. Section 19, second paragraph states that subsequent to the applicant having been notified that a patent may be granted, the patent claims may not be amended so as to extend the scope of the patent protection.

Item 1.3: After issuance of Notice of grant the patent claims cannot be amended so as to extend the scope of protection. This also includes the description and the drawings.

- 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.

Added matter which is considered not to be directly and unambiguously derivable from the basis documents is considered impermissible. Answering the question of whether information was directly and unambiguously derivable from the application as filed requires a concrete assessment and it is the notional person skilled in the art who carries out the assessment. According to the patent regulations the applicant shall indicate where in the application as filed one can find support for the requested amendments and the applicant may argue in favour of “unambiguously derivable”, i.e. there is implicitly room for interpretation of the phrase “unambiguously derivable”.

Intermediate generalisations are dealt with in Examiners Patent Guidelines part C, chapter VII, 3.3.1. When a specific feature is isolated from a specific embodiment in the description and introduced into a claim the amended claim is said to be intermediate the specific embodiment and the original claim, this is called intermediate generalisations.

The content of an application cannot be seen as a reservoir of individual features from different embodiments that can be freely combined with elements of the claim.

Therefore, when a feature is taken from one embodiment and introduced into a claim the following must be satisfied so as not to be in conflict with Patents Act section 13:

- (i) the feature must not be related to or inseparable from the other elements of its original embodiment, the feature cannot have a structural or functional connection with the remaining features, and
- (ii) the content of the application as filed must justify that the specific feature can be generalized and introduced to the claim.

This notwithstanding, it has to be ensured that the notional person skilled in the art is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using his common general knowledge. Specific examples of permissible and not permissible intermediate generalisations are given with reference to T300/06 (permissible) and T 1164/04 (impermissible).

- 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;

It is the person skilled in the art that defines the standard for interpreting the application as filed. The patent application as filed is interpreted as the literal disclosure of the application as a whole supplemented with all matters that the skilled person, using his common general knowledge, can derive directly and unambiguously, also taking into account any implicit features, from the application as filed.

- 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?

It is the same person skilled in the art who interprets the application as filed as it is for the patentability assessment and the relevant date is the priority date if priority is claimed or the filing date.

- 7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

no

Please explain:

There is no special mechanism available to remedy such defects. Removal of (parts of) impermissible added matter post grant is possible by amendment. Amendments can be introduced by request to the Patent Office for an administrative limitation of the patent (see section 39 a of the Patents Act), or in an administrative re-examination (see section 52 d, second paragraph of the Patents Act) or by the courts in invalidation proceedings (see section 51, first paragraph of the Patents Act). Note that the limitation must be made before a decision to invalidate the patent becomes final.

Since amendments must not entail a broadening of the scope of protection, in most cases the patent holder will often be faced with a "catch 22" in cases such as the one described in question 7. Where added matter broadens the scope of protection the patent may be amended to limit the scope again. However, when a limitation contains impermissible added matter, this is often impossible. Since amending a patent by removing (parts of) a previous amendment often leads to an impermissible expansion of the scope of protection, this is not a practical remedy. On the other hand, leaving the patent as it is would expose it to invalidation for 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?

Legal certainty and the interest of society is weighted against applicants rights to amend the application. In principle the applicant can file as many amendments as he likes before and after grant provided that the amendments as such are permissible.

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

yes

Please explain:

In the Group's opinion the statutes, the regulations and the Examiners' guidelines strike a fair balance between applicants' interests and society/third parties interests. However, the interpretation of the standard "directly and unambiguously derivable as interpreted by the person skilled in the art" defines a somewhat unclear border of what shall be admissible and what shall be inadmissible, thus an additional test / additional clarification of the meaning of unambiguously derivable is welcome. The novelty test as previously applied by EPO for amendments by way of addition could possibly be a springboard for an admissibility/inadmissibility test, see EPO Examiners Guidelines Part H, chapter II,

2.1, Part G, VI, 2 and T 201/83.

- 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?

Post grant amendments are possible. Applicant may file amendments under opposition proceedings, during patent limitation proceedings or in administrative re-examination proceedings. The scope of the protection of the patent cannot be extended after grant of the patent, the standard "directly and unambiguously" applies post grant. The Examiners' Guidelines give some practical examples of what should be considered permissible or not, however the content of the patent is the responsibility of the patentee.

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

yes

Please explain:

Where a limitation of the scope of the patent contains impermissible added matter, a "catch 22" situation as described under question 7 arises. The case law from the EPO (see case G 1/93) suggests that there is no way to escape this situation. In Norwegian literature on the subject (see Stenvik, Patentrett 3rd edition, p. 271), it has been suggested that these situations may be remedied by reducing the scope of protection so that the impermissible addition is upheld, but not taken into account when assessing novelty or inventive step. However, the group is of the opinion that special rules for interpretation for certain patents would create an undesirable uncertainty, and that this unfortunate aspect of the current laws is therefore inevitable.

- 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?

While any approach based on a legal standard will inevitably lead to some uncertainty, the current solution is reasonably effective. It is difficult to point to more effective solutions that would not sacrifice the flexibility of the present system.

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:

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

The definition used by the EPO (see G 2/10 quoted above) is an appropriate definition on which

harmonisation could be based

The person skilled in the art shall be the same as the person skilled in the art carrying out the patentability assessment and the effective date shall be the filing date. It is important that the standard of permissibility is the same during the life span of a 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)?

no

Please explain:

To ensure predictability both for the patentee and for third parties the definition or test of impermissible added matter should be the same, regardless of when an amendment is made. However, additional conditions dealing with other aspects than added matter could apply during different stages of the application/patent.

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

No. The addition of dependent claims should be permissible during all stages of prosecution, provided that standard principles indicated in the answers to questions 15 and 16 are fulfilled.

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

no

Please explain:

It should be permitted to delete dependent and independent claims, as long as the general principles for added matter are not violated.

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 relevant date should be the filing date, i.e. the same date as applies for patentability assessment.

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?

"Catch 22" situations are a problem. When they occur, they represent a departure from the principle that an applicant should be granted a patent provided that the material patentability criteria are satisfied. This may call for special remedies being made available by legislation. However it is difficult

to see how this could be achieved without running counter to the interests of third parties. Mechanisms enabling the applicant to reverse an impermissible amendment to place the him/her in the same situation as before the impermissible amendments were introduced will reduce predictability to such third parties. In some cases it may be possible, even under current legislation, to introduce a limiting feature to "compensate" for the expansion of scope that follows from deletion of the impermissible added matter previously introduced. It is hard to imagine that this would be a viable approach in many cases. The "Catch 22" really appears to be an unescapable trap. The fact that it is a calamity that is always brought upon the applicant by himself may justify keeping things as they are.

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

The Norwegian group has no additional comment to offer at this time.

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

IP advisers views.

Summary

Amendments to the claims and description are permissible at all stages of the patent process, as well as after grant. Norwegian rules closely follow the EPC and are strongly influenced by case law from the EPO. Added matter which is considered not to be directly and unambiguously derivable by the person skilled in the art from the basis documents is considered impermissible.

Generally, the group is of the opinion that the current Norwegian rules function well. A problem arises when a patent's scope of protection is limited by an amendment which may contain impermissible added matter, since the change may not be reversed and as a consequence there is no remedy available for the right owner. The group sees no satisfactory solution to this problem and considers it an unavoidable consequence of the current system.

The group welcomes harmonisation of the rules on added matter. The current Norwegian (and European) rules are functional and would be a good basis for further harmonisation.