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## 2016 – Study Question (Patents)

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**Added matter: the standard for determining adequate support for amendments**

Responsible Reporter: Ari LAAKKONEN

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Paraguay

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### I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

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

Yes, but only in reference to a Patent application not concerning a Patent already granted. The Paraguayan Patent Law in its Article 21 provides that a patent applicant could modify or correct his application prior to its publication.

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

Yes. The Paraguayan Patent Law in its Article 31 provides that a patent applicant or patentee could amend the claims of a patent to reduce or limit his scope.

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 standard for determining the permissibility of the amendments is that none of the amendments made to the description and/or figures or the claims will indicate an extension of what was already contained in the initial application. This is according to the Paraguayan Patent Law.

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

Yes, there are differences depending on the timing of the request and if is a patent application or a granted one

- 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.

In the event that the amendments are requested to modify the description and/or figures of a patent, they are only possible to a patent application and may be requested prior to its publication. After that, any amendments are only permitted if they are recommended by the Patent Office.

In the event that the amendments are requested to modify the claims of a patent, they are possible for a patent application as well as granted one. The timing to request the amendments, in the case of a patent application, is prior to its publication. After that, any amendments are only permitted if they are recommended by the Patent Office. The timing to request the amendments, in the case of a patent granted, is within two years from the date of grant.

- 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.

The impermissible added matter is defined as a proposed amendment which adds new subject matter or extends the limits or scope of what was already contained in the initial application.

- 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 interpretation of any document, in a patent application, in order to determine its true meaning and thus its content and disclosure, must be done considering that no part of the documents is construed in isolation from the remainder of the documents: on the contrary, each part of the documents is construed in the context of the contents of the document as a whole read with the common general knowledge of the skilled person.

- 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 of the notional skilled person is prior of the publication date of the application

- 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:

Yes, If is prior to its granting the Patent Office through an Substantive Examination could recommend that the impermissible added matter to be removed or limit. And If is court in a post-grant proceeding which in our country is through a nullity action could be ordered a limitation or removal of the 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 balance is made through the substantive examination of the Patent Office.

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

no

Please explain:

Our group believes that improvement will not be necessary.

- 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?

The Paraguayan Patent Law allows to modify the claims of a patent granted within two years from the date of grant. However, there is no indication that exist a specific procedure to prevent to the patentee adding impermissible matter only the expressed prohibition of adding new subject matter.

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

yes

Please explain:

In order to improve our current law, our group recommends adding the obligation to a supplementary substantive examination in relation to amendments to the claims on granted patent.

- 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?

Our group considers effective the approach of the notional person skilled in the art to determine the permissibility of amendments

### 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.

no

Please explain:

Our group believes that the harmonization of the definition of impermissible added matter is not necessary.

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

Our group believes that the definition should not depend on when an amendment is made. It should be the same definition in all cases.

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

yes

Please explain:

Our group believes that the Patent Office should create other convenient procedures to solve this issue instead of prohibit the addition of claims.

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

Our group believes that the definition should be the same in all cases.

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

no

Please explain:

Our group believes that the relevant date should be prior to the publication date of the patent application.

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

no

Please explain:

Our group believes that the defect could not be remedied in the mentioned circumstances.

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?

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?

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

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

Summary