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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

National/Regional Group

Spain

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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, they are possible.

The LP does not literally provide a basis for amending the description or figures in a patent **application**. However, the Guidelines do provide indications:

- In order to correct obvious errors (section 4.1);
- Whenever it is possible to amend the claims, “...to maintain the congruence with the amended claims” (section 4.2); or to introduce “...additional information regarding the prior art” (Section on amendments to the description, section 4.2; section on amendments to the description or figures, section 5.2).

In relation to the **granted** patents, the LP does not provide the possibility to amend the description or the figures.

However, Art. 48.5 of the **new LP** does provide for the amendment of any part of the documents, both of the application as well as the patent:

«5. The patent application or patent cannot be amended in such a manner that its subject-matter extends beyond the content of the application as originally filed.»

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

Yes, they are possible.

Art.31 LP and Art. 42 RD do literally provide basis for amending the claims in a patent **application** in order to correct “formal defects”; and in Art. 41(1) LP “...in those acts in the grant procedure which are expressly permitted by the current Law.”. Reference is made for example:

- During the General Grant Procedure, Art. 36(2) LP provides for “once the period for presenting third party observations on the results of the search report expires ...”; and
- During the Grant Procedure with Examination, after Art. 39(8) LP, in case a requirement is not met impeding the grant, as a result of the examination, or oppositions. Likewise, according to section 5.2 of the Guidelines, also when requesting examination and while responding to the office action with the result of the examination.

In relation to the **granted** patents, and following current regulations, it is not possible to amend the claims of a Spanish patent. After Art. 112.2 LP “it is not possible to declare the partial nullity of a claim”. On the other hand, it is possible to declare the partial nullity of a patent, by means of the nullification of one or more claims.

On the other hand, in relation to **granted European patents**, Art. 138.3 CPE does provide for the possibility that a patent proprietor can limit the patent by amending its claims, in proceedings relating to the patent’s validity. In such cases, the patent so limited and published in the Spanish language in the Official Bulletin of Industrial Property will serve as a basis to any proceedings before the Courts. Since the entry into force of this Article, on December 13, 2007, the Spanish Courts have been accepting its application in the judicial proceedings relating to the nullity of European patents.

The **new LP** provides for the possibility that the patent proprietor can also limit the scope of protection of national patents, at any moment of its legal lifetime, by means of amendments of the claims. It will also be possible to formulate voluntary limitations before the Spanish Courts in the judicial proceedings relating to the validity of the Spanish patent by amending its claims.

In relation to the new LP, the examination of the application will be compulsory. It remains to be seen whether there will be more opportunities to amend the claims as compared to the current system.

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.

According to Art. 41(3) LP:

“Claim amendments may not result in an extension of the content of the application.”

The **Guidelines** contain some guidance regarding the application of this norm. In particular:

- Whenever it relates to the correction of errors, “the correction of the error must be unequivocally derivable for the patent application documents, as would be interpreted by a person skilled in the art at the filing date of the application” and “the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended by the applicant” (section 4.1);

- When it relates to other types of amendments, the Guidelines indicate (section 4.2, amendments to the description):
 - In case of doubt, the examiner should apply the “*novelty test*” in order to determine whether the amendment would destroy the novelty of the original invention;
 - “*By no means should amendments to the application be allowed which conform to arbitrary generalisations of specific examples*”;
 - “*It is also not possible to include new embodiments which result in an extension of the content of the application*”;
 - “*A clarification as to the effect of a technical feature may be allowed in the description if the technical feature was originally disclosed, however its effect was not mentioned, or not completely mentioned, in cases where a person skilled in the art would be able to easily derive it from the original application*”, thereby permitting to complement information by the skilled person using his common general knowledge;
 - “*The elimination of a feature from a claim may be considered admissible as long as the person skilled in the art would directly and unambiguously derive, as in the case of alternatives, that such feature was not considered as essential in the description, that it was not essential for the function reproduced by the invention in light of the technical problem being solved, and that such elimination would not require any modification of the remaining features*”;
 - “*Arbitrary selections of initial subject-matter that are not derivable from the content of the application as filed are also not admissible*”;
 - Disclaimers may be used to reestablish novelty of the invention in view of prior disclosures by expressly excluding from the scope of protection that subject-matter that destroys the novelty of the claim. They are only accepted in case the subject-matter cannot be defined in other terms or the use of positive features would unduly limit the scope of protection. Disclaimers are allowed in case they formed part of the content of the application as originally filed as well as in case the technical feature to be excluded was not explicitly disclosed in the application as originally filed. Nevertheless, its inclusion would not be acceptable in case it becomes relevant for assessing inventive step, or for assessing the extent the invention has been sufficiently disclosed as it would then be considered as added matter contrary to Art. 41.3 LP.

For now, the **Spanish Courts** have ruled in very few occasions in relation with the prohibition of added matter. Nevertheless, in the Decision dated May 3, 2013 of Section 28 of the Provincial Court of Madrid based its decision, following case law of the European Patent Office, in the following criteria to determine when an amendment introduces matter which extends beyond the content of the application as filed:

(i) The ‘content of the application as filed’ is determined by the information disclosed by the application as a whole, therefore not only should the claims be taken into consideration, but also the remaining parts of the application, that is, the description and figures;

(ii) It should be understood that an amendment of the European patent application is not permissible when, as a consequence of such amendment, the person skilled in the art is confronted with information which cannot be directly and unambiguously derived or deduced from that previously present in the application, even considering what is implicitly disclosed;

(iii) What is implicitly disclosed in the application should be differentiated from what results obvious starting for the content, explicitly as well as implicitly, of the application. Any amendments introduced into the application on the basis of this last scenario do not satisfy the requirements of Art. 123.2 CPE;

(iv) By implicit disclosure one should understand that which a person skilled in the art would understand as necessarily included in the application as a whole even though not expressly indicated. Or, in other terms, by implicit one should understand that which is not explicitly disclosed, but is a clear and unequivocal consequence of what is explicitly mentioned [...], taking into account, for example, scientific laws [...] or the prior art [...]. In this sense, the Boards of Appeal have considered as implicit content an embodiment that constitutes the logical complement of another explicitly disclosed in the example in the application [...] or a technical feature that should be readily understood in view of other two explicitly disclosed ones [...];

(v) It should be understood that an amendment performed in the application is directly and unambiguously derived when there exists no doubt that the subject-matter of the patent resulting from the amendment can be found described, either explicitly or implicitly, in the disclosed information of the application as originally filed [...]. It is therefore not enough that the subject-matter of the patent resulting from the amendment is coherent with the description [...] or fits within the terms of a plausible interpretation of what is disclosed in the description [...].

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

No, the same standard applied regardless of the section of the application documents in which the amendment has been made.

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 same standard applied regardless of when an amendment is performed.

Whenever such an amendment is performed, assessment as to inadmissibility is directed to the added matter stemming from a comparison of matter resulting from the moment an amendment is performed and matter existent at the time of filing the application documents as originally filed.

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.

Art. 41(3) **LP** defines added matter as in the following:

“Claim amendments may not result in an extension of the content of the application.”

Art. 48(5) **new LP** provides for amending any part of the application documents:

«5. The patent application or patent cannot be amended in such a manner that its subject-matter extends beyond the content of the application as originally filed.»

It should be noted that neither the current LP, nor the new LP, makes explicit reference to “inadmissible added matter” as such. Instead, all new matter, introduced by way of an amendment, which extends beyond the content of the application as originally filed, is inadmissible. Therefore, inadmissible matter is defined as that which conforms to an extension of the content of the application as originally filed.

Nevertheless, according to the Decision dated May 3, 2013, of Section 28 of the Provincial Courts of Madrid, following EPO Case Law, that it should be understood that an amendment of the European patent application is not permissible when, as a consequence of such amendment, the person skilled in the art is confronted with information which cannot be directly and unambiguously derived or deduced from that previously present in the application, even considering what is implicitly disclosed. The Guidelines help to clarify how this analysis is applied, in particular in relation to, explicit and implicit, content originally present in the 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;

Considering the LP, the Guidelines, and Case Law already mentioned, the content of the patent application as filed is interpreted taking into account:

- that it comprises the information disclosed in the application as a whole, comprising the claims as well as the description and the figures;
- that it is interpreted from the point of view of a person skilled in the art;
- that both explicit disclosures as well as what is implicitly disclosed must be taken into consideration;
- that implicit disclosures comprise all that which the person skilled in the art would understand as necessarily included in the application as a whole even if not expressly mentioned[DP1][#_msocom_1] ; that an explicit reference to the technical content of another document is an integral part of the content of the application as originally filed (for example, when the description mentions that “The materials necessary for performing this process can be any material as enumerated in the scientific article X, table Y”); the prior art disclosed in the description; or the matter disclosed but not claimed or excluded (explicitly disclaimed subject-matter).

[DP1][#_msoanchor_1] En evitación de introducir explicaciones o interpretaciones del concepto de “implícito” que pudieran resultar innecesariamente limitadoras de este concepto, parece aconsejable ceñirse a la definición del diccionario de la real Academia Española (“Incluido en otra cosa sin que esta lo exprese”)

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 in order to determine the knowledge of the notional skilled person is the filing date of the application (or priority date).

In relation to **Spanish patent applications and patents**, the only (temporal) reference can be found in the Guidelines, in respect of the correction of obvious errors, wherein it is stated that “*The correction of an error must be unequivocally derivable from the application documents as originally filed, as would be interpreted by a person skilled in the art at the filing date of the application*”. In relation to the amendments, the material limits are defined as “*The limits for an amendment to be considered*

permissible are dictated by the content of the application as filed”, which corresponds to the version of the content at its filing date.

In relation to **European patents**, and in the scope of a request for correcting errors, Decision G3/89 of the Enlarged Board of Appeals of the EPO stated that “*under Article 123 EPC, what matters is what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing*”.

- 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:

Not for the case of a **Spanish patent under the current LP**. According to current regulations, it is not possible to amend the claims of a Spanish granted patent. Therefore, no voluntary amendments are foreseen which would allow correcting an otherwise inadmissible amendment. On the other hand, in nullity proceedings, it is possible to declare the nullity of one or more claims, which could eventually remedy the defect, albeit indirectly.

On the other hand, for the case of European granted patents, it is possible, by means of a voluntary limitation of the European patent, or even by amending the claims following Art. 138.3 CPE.

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 **current LP** defines two possible routes in the granting procedure: The General Grant Procedure (without examination) and the Procedure with Examination. In both cases, in case of amendments, an examination as to the permissibility of the amendments is performed.

Therefore, it seems that the current regulations do provide the necessary equilibrium by prohibiting amendments that refer to information or content not directly and unambiguously derivable by the person skilled in the art from the original application.

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

yes

Please explain:

One difference existing between both national patent granting procedures under the **current LP** is that, in the General Grant Procedure, fewer procedural points exist which would allow performing corrective amendments to the patent application during the grant procedure.

Under the **new LP**, in which the General Grant Procedure is eliminated, and examination of all

applications becomes compulsory, more procedural points will become available which allow reaching the fair equilibrium between performing amendments with the objective of complying with all the requirements for a grant, as well as allowing to comply with the requirements of admissible added matter. Particular mention is made that the applicant will have at least one opportunity of correcting the defect, in case amendments are performed which are officially objected as introducing inadmissible added matter.

As a side note, a part of the Working Group is of the opinion that it would be desirable to reintroduce in the new LP the previously existent **Patents of Addition** (similar to the US Continuation-in-part), with the objective of introducing new matter, and accepting a new effective filing date for such new matter. Another part of the Working Group is of the opinion that it was correct that this type of IP right has been eliminated from the new LP.

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?

No. The **current LP** does not allow performing amendments to a granted Spanish patent. Neither voluntarily nor in reaction to a nullity proceedings against such patent. Nevertheless, some of the claims of such patent may be nullified as a result of such proceedings, thereby resulting effectively in a modified patent - it is not possible to partially nullify a single claim (art. 112 LP).

The equilibrium found in the pre-grant phase (Question 8) disappears completely in the post-grant proceedings, which have proven to be excessively rigid and inflexible in relation to performing amendments. In case it is demonstrated that a granted claim contains inadmissible added matter, the only remedy is to nullify that claim, as the proprietor is not allowed to amend the claim in order to solve all pending nullity objections. This generates the risk that patents may be revoked directly due to such procedural inflexibility, and not more importantly for patentability reasons (novelty, inventive activity).

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

yes

Please explain:

This scenario changes under the **new LP** wherein basis is provided for the proprietor to amend the patent in case of nullity proceedings:

«If the grounds for nullity only affect a part of the patent, this will be limited by means of an amendment of the affected claim or claims, and it will be declared partially null. To these effects, in the brief responding to the grounds of nullity, the patent proprietor, without prejudice to being able to defend as a main request the validity of the granted claims, will be able to defend, as auxiliary requests, the set or sets of claims that it presents in the response brief.»

In a similar fashion, after Art. 103.4:

«4. In the nullity proceedings, the proprietor of the patent can limit its scope by amending the claims. The patent, so limited, will serve as a basis of the proceedings.»

Therefore, as a main request, it will be possible to defend the granted claims, and as an auxiliary request, new set(s) of limited claims.

Likewise, the new LP provides the possibility for the proprietor to request, of his own accord, the limitation of the patent (Article 105 new LP).

Following Art. 48.5 new LP, it should be mentioned that the new LP prohibits inadmissible added matter in the same terms for applications as for granted patents:

«5. The patent application or **patent** cannot be amended in such a manner that its subject-matter extends beyond the content of the application as originally filed.»

The analogous situation is found in Art. 123(2) CPE which regulates inadmissible added matter in the same terms for applications as for granted patents. With these changes, the new LP conforms to the CPE, in relation to amendments to granted patents.

With this conformation, the new LP remedies the lack of equilibrium of the current LP, giving the proprietor an opportunity to solve, at least the formal defects, to concentrate the efforts on the ground of patentability (novelty, inventive step).

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?

Yes, the *notional person skilled in the art* is used to determine the permissibility of amendments. This figure is necessary to clarify what was comprised and what was not in the original application. Traditionally, the Spanish expression “*experto en la materia*” has been used as equivalent to the *notional skilled person in the art*, but a majority of the Working Group prefers to designate or identify this figure as “*persona entendida en la materia*” (or “*persona del oficio*”, or “*persona versada en la materia*”, or “*persona con experiencia ordinaria en la materia*”).

[DP1][#_msocom_1] The evaluation as to admissibility of added matter comprises a highly regulated component, so that the point of view of the skilled person has to be necessarily combined with a sufficient degree of knowledge regarding Patent Law. This knowledge regarding Patent Law is pre-supposed in examiners of Patent Offices (Spanish Patents and Trademarks Office, European Patent Office). However it is not always the case in relation to technical experts that act in judicial post-grant

proceedings before the Courts. The function of these technical experts is that of articulating an opinion as would have been done by a person skilled in the art. In particular, in reference to the content of the application as filed, explicit disclosures, implicit disclosures, or the common general knowledge at the filing date. It is difficult to imagine that all the issues relating to this assessment can be performed by a technical expert without a solid knowledge in patent matters (or without someone who has the knowledge).

Therefore technical experts that are summoned to intervene in judicial proceedings to give their opinion regarding added matter should be persons highly familiarised with patents, and having preferably followed a training over the principal substantive and formal aspects of patents.

[DP1][#_msoanchor_1] La figura del experto en la materia es una cuestión compleja que ya fue objeto de estudio específico por la AIPPI, y parece exceder del ámbito de la pregunta detenerse sobre la misma

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, harmonisation is desirable.

As inventions are prosecuted and defended worldwide, it is necessary to have a common understanding of basic substantive issues in the different jurisdictions, as well as a common benchmark, to avoid any distortions caused by the heterogeneity of applying the rules in different countries.

This in turn provides the necessary legal certainty for strategic decisions to be made with minimum risk, both for the applicant/proprietor as well as the public.

Further advantages exist in relation to particular examples. For example, in the context of the commercialisation of IP-backed products and services, it is only reasonable that the same applicant/proprietor expects to receive the same treatment while prosecuting/asserting the same invention as a patent family worldwide in different jurisdictions as the same product/service is ultimately supported by the same invention.

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

Definition:

An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed if the overall change in the content of the application, whether by way of addition, alteration or excision, would result in the notional skilled person being presented with

information which is not directly and unambiguously derivable from that previously presented in the application as filed, when account is taken of matter which is explicitly disclosed as well as implicitly disclosed, also taking into account the common general knowledge available up to the date the application was filed.

Comments:

According to the majority opinion of the Working Group, another theoretical manner of explaining this comparative exercise, is the consideration whether the skilled person who is confronted with an amended version of the application documents, as compared when this skilled person was only aware of the originally disclosed version, would find additional technical information in the amended version.

This consideration should be replicated from the point of view of a notional skilled person attempting to understand and reproduce the teachings of the original disclosure. Hence, such a willing mindset would use the explicit disclosures, complemented by the features implicitly disclosed as well as his common general knowledge, however without involving any creative thinking process. Hence, on one hand, the skilled person is not considering strictly only what appears visually (as text or drawings) in the application documents, but on the other hand, is also not creatively adding technical information to broaden the overall teachings of the application documents. Hence:

- Literal support for the amendment in the application as filed should not be required. It should not be expected that an exact carbon copy of the amended version appears in the original documents as filed (the “*snapshot*” approach).
- Whether an amendment is classified as a particular category in Guidelines or Case Law does not allow, as such, one to draw a conclusion on admissibility. Such common categories are “intermediate generalisation”, or “omission of an originally disclosed feature”, or “modification of an originally claimed feature”, or “multiple selection from two groups of alternative features”.

The definition of other relevant concepts, such as the filing date of an application, explicit/implicit disclosures, the notional skilled person, the common general knowledge of the notional skilled person, and others, is understood as not being part of the scope of this WG.

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:

No, this definition applies regardless of when an amendment is made.

The date of first disclosure in an application of a particular matter defines the filing date for that matter. Hence the standard defining added matter is tied to this original disclosure irrespective of whatever acts or analysis follow (for example, whether a prior art search is performed, or how to interpret the scope of a claim).

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

No, the definition hinges on what was originally disclosed at the first filing date. Hence, it is irrelevant

whether new matter appears as an addition of a claim, or by adding a limitation within a claim.

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, the definition hinges on what was originally disclosed at the first filing date. Hence, it is irrelevant whether new matter appears as a removal of a claim, or by removing a limitation within a claim.

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, this definition applies regardless of what entity/person performs the analysis, such as a Patent Office or Court. Both instances should reproduce faithfully the notional person skilled in the art.

Considering the Patent Office and the Court as two separate instances which apply the same Patent Law, the Court and patent office should have harmonised criteria in applying the common Law, in order to provide consistent legal certainty for the benefit of both applicant/proprietor as well as the public.

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 majority of the group considers that the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment is the date in which the application was filed, and the common general knowledge available up to this date. In most cases this is the filing date of the application/patent, or the priority date in case priority is claimed in the application/patent.

The standard for assessing impermissible added matter is linked to an analysis stemming from the matter which was originally filed at the filing date of that matter. Hence, in order to understand what was encompassed or meant by the inventors in the application documents, all knowledge readily existent up to the filing date would enable the notional skilled person to understand the original teachings meant by the inventors. The fact that the notional skilled person is not an inventor, limits all available knowledge to the common general knowledge readily available to such non-creative technical artisan.

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 impermissible added matter defect should be remedied by performing a permissible amendment which does not extend the scope of protection.

In case possible, the resulting matter would comply with both requirements likewise.

However, in case not possible, the resulting matter would inevitably not comply with at least one of the two requirements. In such case, the only solution is revoking the granted patent as it would not comply

fully with all the requirements of the applicable Law. In such case, the patent proprietor is prejudiced by an imperfect application of the standard for impermissible added matter, either during pre-grant or post-grant proceedings.

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

Patent offices and Courts should implement harmonised criteria rigorously to prevent inadmissible added matter from prejudicing third party rights. However, at the same time, Patent offices and Courts should take a flexible approach when considering the permissibility of amendments, in particular during procedurally strict post-grant proceedings, in order to maintain granted patents which are valid according to the Patent Law. In other words, as long as third party rights are not adversely affected, the benefits of the patent system are promoted via the maintenance of valid patents.

Considering the patent granting system's main objective is to provide an exclusive right for the development of an invention while third party rights are respected, the remaining requirements of the Law should be applied in such a manner that this objective is upheld. A flexible approach would ensure that patents subsist, albeit in amended form, despite imperfections arising during pre-grant or post-grant proceedings. A rigorous system guarantees third party rights are not abused.

The majority of the group considers that on the other hand, a too strict approach results in patents being fully revoked or given too few opportunities for correcting the faults of imperfect prosecution processes. This inhibits the benefits of a patent system as a whole - the proprietor has no incentive, and loses motivation, in investing in technical development, which affects negatively technically related developments in industry in particular and society in general.

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

includes views from a variety of industrial sectors, such as chemical, pharmaceutical, machinery, and information and communications technologies.

Summary

Considering the patent granting system's main objective is to provide an exclusive right for the development of an invention while third party rights are respected, amendments are both necessary and desirable in order to obtain valid patents, as well as for upholding third party rights. Hence, amendments should be considered inadmissible, and not allowed, if not adequately supported in the application as originally filed. An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed if the overall change in the content of the application, whether by way of addition, alteration or excision, would result in the notional skilled person being presented with information which is not directly and unambiguously derivable from that previously presented in the application as filed, when account is taken of matter which is explicitly disclosed as well as implicitly disclosed, also taking into account the common general knowledge available up to its filing date. It is irrelevant whether new matter appears as an addition/removal of a claim, or by adding/removing a limitation within a claim. Both the Patent Office as well as the Court should apply the same criteria for determining admissibility. With the upcoming new Patent Act in Spain, entering into force on April 1, 2017, amendments to claims will be regulated in both pre-grant as well as post-grant proceedings. Patent offices and Courts should implement harmonised criteria rigorously to prevent inadmissible added matter from prejudicing third party rights. However, at the same time, Patent offices and Courts should take a flexible approach when considering the permissibility of amendments, in particular during procedurally strict post-grant proceedings, in order

to maintain granted patents which are valid according to the Patent Law. In other words, as long as third party rights are not adversely affected, the benefits of the patent system are promoted