



Submission date: 1st June 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

Thailand

Contributors name(s)

Chavalit UTTASART, Kallayarat CHINSRIVONGKUL, Suradet ATSAWINTARANGKUN and Pisanu THANADOLSATHIEN

e-Mail contact

chavalitlaw@chavalitlaw.com

Date

01-06-2016

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?

For the pending patent, an amendment to the description and/or figures is permissible provided that it does not extend beyond the substantial subject matter originally disclosed (Section 20). In case the patent application is first filed in a foreign country under the Paris Convention, an amendment must not extend beyond the scope of the specification originally filed. For a national phase application, an amendment must not extend beyond the scope of the specification of the PCT application,

For the granted patent, an amendment to the description and/or figures is not permissible.

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

For the pending patent, an amendment to the claims is possible provided that it does not extend beyond the original specification.

For the granted patent, an amendment to the claims is impermissible. However, a surrender of any granted claims is allowed (Section 53).

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.

Section 20 of the Patent Act provides that the applicant may amend the patent application in accordance with the rules and procedures prescribed in the Ministerial Regulations, provided that such amendment does not extend beyond the scope of the substantial subject matter originally disclosed.

According to the revised Patent Examination Guidelines, the following amendments will be permissible:

1. an amendment in compliance with the examiner's instructions;
2. an amendment, by adding the details of the background of the invention in order to clearly understand the invention;
3. an amendment to the description/claims so as to correspond to each other;
4. an amendment to the description/claims so as to be clear and concise; and
5. a correction of any misprint.

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

There is no difference.

- 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.

For the pending patent, an amendment can be made at any time before issuing a notification of allowance for a patent.

For the granted patent, only a surrender of the allowed claim(s) is permissible during the patent term of protection.

- 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.

Under the Examination Guidelines, the following are considered as impermissible added matter:

1. the added matter which is beyond the scope of the specification originally filed; and
2. the added matter which is not supported by the original description/claims/drawings.

However, the added matter which is generally known by any person skilled in the art, or where the amendment is for the purpose of making the specification sufficiently clear and concise, which does not extend beyond the scope of the claimed invention originally disclosed, is permissible.

- 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 patent application 'as filed' means the complete detailed description, claims and drawings filed at the filing date.

- 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 knowledge of the notational skilled person is the date as of the filing or priority, as the case may be.

- 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:

After a patent is granted, a correction of the patent application before the Patent Office is not allowed. However, if any allowed claims contain said impermissible added matter, the patent owner may surrender such claims.

A correction of the granted patent before the court is not available.

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?

During the pre-grant proceedings, the balance will be determined by the examiner. From a practical perspective, an amendment will be permissible if such amendment is supported by the specification originally filed or it is general knowledge which is well known by any person skilled in the art; in order to make the specification clear.

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

no

Please explain:

With regard to an amendment to the patent application, an amendment to the current law is 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?

Under the current law, a voluntary amendment of the granted patent is not allowed.

However, if the allowed claims containing the impermissible added matter are regarded as invalid, a surrender of claims is available.

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

yes

Please explain:

Currently, an amendment of a post-grant patent - either a non-substantial or substantial matter - is not allowed.

Therefore, the law should be amended in order to allow a correction of defects and/or removal of the impermissible added matter in the patent after an allowance for patent, but before issuing a Letters Patent. However, an amendment should not be allowed after the Letters Patent is issued.

- 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?

Examiners having at least a bachelor's degree in science and/or engineering, serve as the person skilled in the art to determine the permissibility of amendment. This approach is very effective.

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:

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

- 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:

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

For the pending patent, an addition of claims is permissible provided that it does not enlarge the scope of the specification originally filed.

For the granted patent, an addition of claims is not permissible.

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

yes

Please explain:

For the pending patent, a removal of claims is allowed provided that it does not go beyond the scope of

the specification originally filed.

For the granted patent, a surrender of allowed claims is permissible.

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 of knowledge for the notational skilled person should be the date as of the filing or priority, as the case may be.

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?

For the pending patent, an amendment to the specification should be allowed to be made so that the scope of invention will not be extended.

For the granted patent, the patent law should adopt the re-examination system or the post-grant opposition in order to allow the patent owner to correct/remove the defect of the granted patent.

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

None.

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

Summary