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## 2016 – Study Question (Patents)

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

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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.

Article 25/1 of the Industrial Property Law (IPL ) and chapter II/paragraph 5.2 of Regulation on Grant of Patents for Inventions and Utility Models (Patent Regulation ) establishes that amendments and formalities corrections in an application can be made on owners' initiative or on the request of PTO up to the date of grant of the patent.

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

Yes.

Same reply as under question 1 above.

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.

To the best of our knowledge, there are no standards applied on such regard.

It must be considered that applications for national or international patents in the Albanian office are very insignificant; the main part of the applications are extensions and/or validations of European patents.

Anyhow, we believe that the patent office is directed/has the tendency to treat the amendments relevant correction of formal unintentional mistakes or inaccuracies as addressed by the provisions of the law. The amendment on subject matter shall not be permissible.

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

There are no substantive standards applicable. However, reference must be made to the criteria addressed in law: (i) descriptions must be clear, complete and reflect all the needed information for a skilled person to carry out such invention (art. 19/1 of IPL and chapter III/paragraph 1.1/ç of Patent Regulation); and (ii) claims must be clear, concise and supported by the description (art. 20/1 of IPL and chapter II/paragraph 5.2).

Per analogy when assessing the amendments the same criteria as required to submit the descriptions and claims should be used, specifically, the criteria of clarity and complete.

- 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.

n/a

- 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.

In our practice so far, the impermissible added matter is NOT used as a ground for refusing an amendment. The patent office shall refuse any request of the owner with effect on the subject matter.

- 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 is interpreted by its description and drawings (art. 42 of IPL).

- 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?

N/A

- 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.

Any dispute concerning the subject matter must be resolved in court. Should the grounds for revocation upon a court decision affect the patent only partially, revocation shall be pronounced in the form of a corresponding limitation of the patent. The limitation may be effected in the form of an amendment to the claims (art. 74 of IPL).

Per analogy, in case if a court decision should be in place relevant impermissible added matter, the defect remedy mechanism recognized by the provisions of the law for the patentee is through "limitation" in the content of the filed/initial patent

## 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?

n/a

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

- 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?

n/a

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

- 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?

## 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.

Impermissible added matter means any matter, material, fact, which imply substantive changes to the original descriptions, figures, drawings and/or claims of the 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:

No. In our opinion same definition and criteria must be applied at all stages.

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

yes

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

yes

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:

In our opinion, the definition must be established in the provisions of the law, and must be mandatory for the patent office, while the court will be governed by such definition but may further elaborate it.

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?

In our opinion, the notional skilled persons must evaluate the permissibility of an amendment before granting of the patent.

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?

In our opinion, in this case it would be the case of a patent refusal or revocation.

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