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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, amendments to the description and figures of a patent are possible.

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

Yes, amendments to the claims of a patent are possible.

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 whether such amendments are permissible is defined as: "extension of the scope of protection is not permitted".

This standard exists in the Law on Patents.

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

There are no differences between the substantive standards for amendments under 1) and 2) above.

- 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.

Amendments to the description, figures and claims according to standard described in 3(a) are possible after filing but before grant.

Amendments to the description, figures and claims according to standard described in 3(a) are also possible after grant as a result of a cancellation action (partial cancellation).

The patentee can delete some patent claims after grant upon filing a written declaration.

- 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.

If impermissible added matter is a ground for refusing an amendment, then impermissible added matter is defined as "the matter which lacks support or is not disclosed in the relevant application as filed".

- 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 as follows: "the disclosure of invention which in sufficiently clear and detailed manner discloses the invention so that a skilled person in the relevant filed is able to realize the invention".

Furthermore, it is defined that patent claims define the scope and the subject of protection. Patent claims must be clear, concise and fully supported by the description of invention and figures, if available.

- 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 knowledge of the skilled person is not precisely defined. It is assumed that the relevant date is the patent priority date which affects the novelty of the invention.

- 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:

If an amendment that was made to a patent application prior to grant is later reviewed by our patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, there is a mechanism for the patentee to remedy the defect. The defect can be corrected during the cancellation procedure (partial cancellation) invoked by the Bosnian Patent Office. During this procedure, the patentee could remove portions of the amendment found to be impermissible.

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 Law on Patents does not provide any provisions that could be interpreted as measures for striking a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter.

It is interesting to note that the Bosnian Patent Office does not conduct full examination of patent applications. Bosnian Patent Office has agreements on cooperation with a number of foreign patent offices so the full examination is conducted in cooperation with these foreign patent offices (which are authorized PCT examination authorities or other offices which conduct full examination).

Furthermore, if a patent application filed in Bosnia and Herzegovina is also filed for the same invention abroad, then the Bosnian Patent Office can grant the patent based on the result of full examination conducted abroad (by an authorized PCT examination authority or a foreign patent office which conducts full examination and which has agreement on cooperation with the Bosnian Patent Office).

Consequently, any comments on striking a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter is in fact a question for the patent office which is in fact conducting full examination of the application filed in Bosnia and Herzegovina.

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

no

Please explain:

Please see our comments in 8).

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?

Amendments to the description, figures and claims according to standard described in 3(a) are also possible after grant as a result of a cancellation action (partial cancellation). Claims can be deleted

upon filing a written declaration by the patentee.

Considering the procedure for full examination explained in 8), it is not clear whether the examination body which had conducted full examination would be consulted regarding these amendments. In our opinion, the examination body would be consulted in order to approve these amendments, and therefore the same comments as given in 8) would apply to the question of striking the balance.

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

no

Please explain:

Improvements are not foreseen at this moment.

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?

It is very difficult to answer this question since different foreign offices conduct full examination of patent applications filed in Bosnia and Herzegovina.

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, harmonization of impermissible added matter would be very helpful.

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

Impermissible added matter is which lacks support and/or is not disclosed in the application as filed.

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:

This definition should not depend on when an amendment is made.

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

No.

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

no

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:

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 patent priority date which affects the novelty of the invention.

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?

Roll back the amending process step by step until the state of no extension of scope is reached.

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

No comments.

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

Summary