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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. Both pre-grant and post-grant amendments to description are possible under respective requirements. Yes. Both pre-grant and post-grant amendments to description are possible under respective requirements.

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

Yes. Both pre-grant and post-grant amendments to claims are possible under respective requirements.

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.

Permissibility of amendments is statutorily mandated in, particularly, Taiwan's Patent Act.

Article 43 of the Act stipulates the amendments to invention patent applications. Paragraph 1 of the same Article says largely that "[...] when examining a patent application for invention, [Taiwan

Intellectual Property Office (TIPO)] may, upon request or on its own initiative, notify the applicant to amend the description, claim(s), or drawings within a specified time period.” The standard for such pre-grant amendment requires “not [to] extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) as filed, [except] for correction of translation errors,” which shall not extend beyond the foreign language version of the application.

Article 67 of the Act stipulates instead the voluntary amendments to granted patents for inventions. Post-grant amendments are however limited only to the actions of (1) deleting claim(s); (2) narrowing down the scope of claim(s); (3) correcting errors or translation errors; and (4) clarifying ambiguous statement(s). Further, that “post-grant amendment shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) as filed,” or “it shall not substantially enlarge or alter the scope of the claim(s) as published” are posed as the standard.

Regulations in detail for both amendments to patent applications and granted patents can be found in the Patent Examination Guidelines.

Also, when an application is filed originally in a foreign language for the purpose of securing an earlier filing date, the foreign language copy shall not be amended. In other words, amendments only apply to the later-submitted Chinese translation version of the application. The only admissible amendment in relation to foreign language version is correction of translation errors for Chinese version in both pre-grant and post-grant phases.

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

For pre-grant phase of the prosecution, there is no difference between the standards for amendments to either claim or description. Amendment to the description shall be derivable by a skilled person based on the application as filed directly and unambiguously so the skilled person can understand the invention and enable the same. No new matters are allowed. Amendments to claims, likewise, may extend beyond the disclosure by either being supported by the description or being derivable directly and unambiguously from the application as filed. (See Pages 2-6-1 and 2-6-8 of the Patent Examination Guidelines)

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.

Two sets of provisions prescribe the standards for pre-grant and post-grant grant amendments, respectively. For pre-grant amendments, there is no standard changes as to at which prosecution stage the application specifically is. The same applies to post-grant amendments.

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.

Impermissible added matters, specifically the unallowable additions, as exemplified in Page 2-6-15, or Section 5 of Chapter 6 of Part 2, of the Guidelines are as follows:

1. A technical feature not previously exists in the disclosure as filed;
2. A clear and sufficiently disclosed technical feature which cannot be directly or unambiguously derived from the disclosure as filed;
3. A known technique but not being clearly described in the disclosure as filed nor being directly or unambiguously derived from the disclosure as filed;

4. A solution cannot be directly or unambiguously derived from the disclosure as filed;
5. A new component which leads to specific effect not being previously described;
6. A technical feature being the data out of the measurements of the drawings; and
7. A drawing of which the information is not being previously disclosed in the description.

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 application as filed includes the matters that can be directly and unambiguously derived from the description of the filed specification, claims, and drawings which are interpreted by a person having ordinary skills in the art.

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 determining the level of knowledge a PHOSITA should have is the filing date (or priority date, if claimed).

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:

The applicant is afforded with remedial acts to remove impermissible added matters. When TIPO rejects an application according to Article 46 of the Patent Act by finding an amendment extending beyond the scope of disclosure as filed, as prescribed in Paragraph 2 of the same Article, the applicant is given a designated period of time, usually 4 months for non-Taiwan nationals with an extendable period of 2 month upon request to remove the impermissibility as another amendment.

During an invalidation proceeding, the patentee may also request for post-grant amendment. Plus, as prescribed in Article 77, the invalidation request shall be reviewed and entered into a decision along with and taking into consideration the post-grant amendment.

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?

TIPO examiner has the discretion to make an application final in the second office action. In response to final OA the applicant can only take four kinds of amending actions very similar to those applicable for post-grant amendments, and new claims resulting in *de novo* search may not be entered if the new claims add impermissible matter.

On the other hand, adding impermissible matter shall always be rejected in spite of when it is presented. Applicant should be rather careful not to recklessly introduce new matters that may invite an unwelcome final OA.

Plus, introduction of impermissible matters during pre-grant amendment is a ground for initiating an invalidation proceeding. Potential risks of invalidity may deter the application from carelessly introducing new matters.

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?

Yes, post-grant amendments are available, but are only limited to (1) deleting claims; (2) narrowing down the scope of claims; (3) correcting errors or translation errors; and (4) clarifying ambiguous statements. Further, that "post-grant amendment shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing as filed" or "it shall not substantially enlarge or alter the scope of the claim(s) as published."

Again, adding impermissible matters during post-grant amendment is also a ground for initiating an invalidation proceeding.

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

yes

Please explain:

Additional standards are applicable for post-grant amendment, where "the amendment shall not substantially enlarge or alter the scope of the claim(s) as published" even if the amendment does not add impermissible matter. The standard of "enlargement" can be easily comprehended, but that of "alternation" is relatively ambiguous. The examples furnished in the Patent Examination Guidelines do provide some basics for the determination of "alternation" but they are still heavily disputed between the Patent Authority and the patentee, or between the opposing parties of an invalidation action. The Courts also have different opinions as to what are considered "alternation." More consistent standards should be established.

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 permissibility of amendments is determined by a PHOSITA in view of the disclosure. Because PHOSITA's knowledge and level of skill may shift, or particularly increase over time, the criteria for interpreting the scope of disclosure are not rigid. However, standing on the perspective of the applicant, such flexible approach may leave applicants with challenges to defend their on-the-edge 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:

Not applicable.

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

Not applicable.

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:

The definition of impermissible added matter should be the same before and after grant to ensure consistency.

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

We believe that no limitations should be applied to addition of claims per se or adding limitations to claims for pre-grant amendment so long as no impermissible added matter is introduced.

As for rules against adding new claims after merits have been examined by the Patent Authority, we think this should be at the Patent Authority's discretion to ensure examination efficiency. However, procedures should be available to the applicant prior to the grant of the patent for adding new claims if new claims cannot be added after merits have been examined, namely via subsequent divisional or continuation applications.

As for addition of claims per se, once the patent is granted, because the inventions covered by the new claims would have been deemed as being contributed to the public if the applicant did not attempt to cover such in subsequent divisional or continuation applications, rules should be established to prohibit such.

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

no

Please explain:

We believe that no limitations should be applied to removal of claims per se for pre-grant or post-grant amendment.

As for removing limitations from claims, such should be permitted for pre-grant amendment. However, for post-grant amendment, as such may enlarge the scope of protection, and the difference in scope would have been deemed as being contributed to the public if the applicant did not attempt to cover such in subsequent divisional or continuation applications, rules should be established to prohibit such.

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:

For the sake of ensuring consistency.

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?

Not applicable.

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 pre-grant amendment, enlargement of scope should be acceptable so long as the resulted inventions are supported by the original disclosure.

As for rules against extension of scope prior to grant but after merits have been examined by the Patent Authority, we think this should be at the Patent Authority's discretion to ensure examination efficiency. However, procedures should be available to the applicant prior to the grant of the patent for adding new claims if the claims scope cannot be enlarged after merits have been examined, namely via subsequent divisional or continuation applications.

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