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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 37 of the Luxembourg Law on Patents of 20.07.1992 as amended, allows the applicant to amend the description and drawings before grant.

Essentially, the amendments may be carried out, once, until filing the request for novelty search; and once, after receipt of the search report.

Exceptionally, the description and figures may be amended post-grant, during nullity proceedings (article 73, paragraph 2).

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

Yes, the claims may be amended before grant at the same time points as indicated under 1).

The claims may also be amended after grant.

Amendments are however restricted to voluntary withdrawal of one or more claims at any time (article 72). Only exceptionally, amendments of the claims may be allowable in nullity proceedings /article 73 (2). ?

For a European patent, another possibility of claim amendment is offered by article 138 (3) EPC. The proprietor of the patent has the right to limit the patent by amending the claims in proceedings relating to the validity of the European patent. The patent as thus limited shall form the basis for the proceedings. A corresponding article is featured in the pending draft law amending the Patent Law.

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.

Article 37 provides that a patent application may “not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed”.

It may be kept in mind that, in addition to the above limitation, post-grant amendments may not broaden the scope of protection of the patent. ?

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

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.

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.

The language of article 37 above is the same as article that of 123(2) EPC.

According to established EPO case law, it is impermissible to add to a European application subject matter which the skilled person cannot derive **directly and unambiguously**, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document.

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” comprises the description, the claims, and the drawings, as they were on the

date of filing.

If the application is filed without claims, then the subsequently filed claims are not part of the “application as filed” for the assessment of allowability of amendments.

According to European case law, what is taken into consideration in the “application as filed” includes the explicit disclosure but also any implicit disclosure, i.e. any disclosure that the skilled person would consider as necessarily contained in the patent application as a whole when reading what is explicitly mentioned, on the basis of his general knowledge.

- 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 is the date of filing of the application.

- 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:

Added subject matter is a cause of nullity (article 73.c).

As indicated under 2) above, the description, claims and figures may be limited in the frame of nullity proceedings, where the grounds of nullity only partially affect the patent.

Exceptionally, the patentee may amend the claims, description or drawings.

Here again, one must keep in mind that post-grant amendments may not broaden the scope of protection of the 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?

The ability of the applicant to amend the application is enshrined in the law, article 37.

Of course, the right to amend the patent application needs to be limited to preserve the rights of third-parties, who should be able to predict what possible amendments could be made by the applicant based on the patent application as filed.

The combined provisions of article 37.4 and 73.1c provide a safeguard using the same language as the EPC, forbidding amendments of the patent/application *in such a way that it contains subject-matter which extends beyond the content of the application as filed*".

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?

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:

Harmonization is desirable in order to improve predictability of amendments.

It is important for both the proprietor and third-parties to be able to asses with good predictability what kind of amendment is impermissible or not.

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?

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

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?

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?

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