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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

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

Yes

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.

#### Amendment of Patent application

(1) Amendments permissible provided that they do not go beyond the disclosure in the patent application as initially filed : Patents Act 1983 Section 26A [NB : this is a general provision on amendments to patent applications]. Also see Guidelines For Patent Examination section 5.1.1 and 5.1.3 at [www.myipo.gov.my](http://www.myipo.gov.my)[<http://www.myipo.gov.my>] .

(2) Correction of clerical errors or obvious mistakes are specifically mentioned as being permissible : Patents Act 1983 Section 79

(3) Amendment must not cause the application as amended to be open to further objection (eg. amendment must not introduce obscurity) : see Guidelines For Patent Examination section 5.1.1 at [www.myipo.gov.my](http://www.myipo.gov.my)

(4) Extensive reworking of description or claims to distinguish a highly relevant prior art may be allowed (provided always that the amendments do not go beyond the disclosure in the patent application as initially filed): see Guidelines For Patent Examination Section 5.1.4

(5) Any subsequent request to withdraw an amendment is itself a request for further amendment : see Guidelines For Patent Examination section 5.1.4 at [www.myipo.gov.my](http://www.myipo.gov.my)

(6) An amendment is regarded as introducing added matter, and is therefore not permissible, if the amendment results in a person having ordinary skill in the art being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to such person in what has been expressly mentioned : see Guidelines For Patent Examination section 5.3.2, 5.3.3, 5.3.4, 5.3.5 and 5.3.6 at [www.myipo.gov.my](http://www.myipo.gov.my)[<http://www.myipo.gov.my>]

#### Amendment of Granted Patent

(1) Amendments permissible but must not go beyond the disclosure of the patent application as initially filed ie. must not result in introduction of added matter : Patents Act 1983 section 79A. See also Guidelines For Patent Examination section 5.5 at [www.myipo.gov.my](http://www.myipo.gov.my)[<http://www.myipo.gov.my>] (but see below constraints on amendments to the claims)

(2) Requirements/standards as set out above for amendments to patent applications also apply to granted patents : Guidelines For Patent Examination section 5.5 at [www.myipo.gov.my](http://www.myipo.gov.my)[<http://www.myipo.gov.my>] (but see below constraints on amendments to the claims)

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

Yes. Amendments to the claims of a granted patent must not extend the scope of protection beyond that conferred at the time of grant of the patent, even if the amendments do not go beyond the disclosure of the patent application as initially filed : Patents Act 1983 section 79A. See also Guidelines For Patent Examination section 5.5.

[Note the difference with a pending patent application : Whilst a patent application is pending, amendments to the claims which result in the claims conferring a wider scope of protection than that conferred prior to the amendments, may be allowed provided that the amendments do not go beyond the disclosure of the patent application as initially filed. See the broad provisions of Patents Act 1983 section 26A.]

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 patent applications, the answers to question 3 above apply to amendments made at anytime after filing but before allowance.

Once a notice of allowance is issued, any amendments made are considered as if they are made to a granted patent hence the constraints set out in the answer to question 3 part b above will apply.

- 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.

1) Any matter which is "beyond the disclosure of the patent application as initially filed" (see Patents Act 1983 section 26A) or which is "beyond that disclosed prior to the amendment of the granted patent" (see Patents Act 1983 section 79A). See also Guidelines For Patent Examination (section 5.3 :subsections 5.3.1 to 5.3.7)

2) An amendment is regarded as having introduced impermissible added matter if the overall change in the content of the application results in the person having ordinary skill in the art being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to such a person in what has been expressly mentioned. (Guidelines For Patent Examination section 5.3.2)

- 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 the notional person of ordinary skill in the art would understand said patent application : see Patents Regulations 1986 Regulation 12(1)(c). Also Guidelines for Patent Examination section 5.3.2 at [www.myipo.gov.my](http://www.myipo.gov.my)

- 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 notional skilled person would be the priority date of the patent application : see Patents Act 1983 section 14(2)(a), and Guidelines for Patent Examination section 5.3.2 at [www.myipo.gov.my](http://www.myipo.gov.my).

- 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:

#### Post-grant proceeding at Patent Office

There is no opposition proceeding at the Patent Office. "Post-grant proceeding" above refers to applications made by the applicant to amend any part of the patent specification after the patent has been granted. Amendments to remove impermissible added matter in the form of portions of the description or figures are usually allowed. Amendments to remove impermissible added matter from

the claims which would result in the claims conferring a narrower scope of protection than that conferred at the time of grant may be allowed. Amendments to remove impermissible added matter from the claims which would result in the claims conferring a broader scope of protection than that conferred at the time of grant would not be allowed : See Patents Act 1983 Section 79A subsection (1) and subsection (2).

#### Proceedings in court

The Patents Registrar shall not approve any amendments during the pendency of any court proceedings in Malaysia in which the validity of the patent may be put in issue : See Patents Act 1983 section 79A subsection (3).

## 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?

1) Correction of clerical errors and obvious mistakes are allowed : see Patents Act 1983 section 79

2) Any other amendments are also allowed provided that the amendments do not go beyond the disclosure of the patent application as initially filed : see Patents Act 1983 section 26A

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

yes

Please explain:

The Guidelines For Patent Examination section 5, issued by the Malaysia Intellectual Property Corporation, provide guidelines on how the provisions of the Patents Act 1983 relating to amendments and added matter are to be applied or put into practice. Part of these guidelines should be incorporated as part of the law, perhaps as part of the Patents Regulations 1986.

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, subject to certain conditions, are allowed : see Patents Act 1983 section 79A.

The aforesaid provision attempts to strike the above-mentioned balance by :

1) allowing correction of clerical errors and obvious mistakes : see Patents Act 1983 section 79A subsection (1)

2) allowing other types of amendments which the Patents Registrar, at his discretion, find acceptable : see Patents Act 1983 section 79A subsection (1)

3) imposing a condition that the amendments must not have the effect of disclosing a matter which extends beyond that disclosed before the amendments : see Patents Act 1983 section 79A subsection (2)

4) imposing a condition that the amendment would not have the effect of extending the protection conferred at the time of grant :see Patents Act 1983 section 79A subsection (2)

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

yes

Please explain:

The Guidelines For Patent Examination section 5 including subsection 5.5 issued by the Malaysia Intellectual Property Corporation, provide guidelines on how the provisions of the Patents Act 1983 relating to post-grant amendments and added matter are to be applied or put into practice. Part of these guidelines should be incorporated as part of the law, perhaps as part of the Patents Regulations 1986.

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, this approach is effective.

It would help if the statutes could provide further details on the notional person skilled in the art and how he is to perform his tasks. Currently only the Guidelines For Patent Examination and case law provide some guidelines on this.

### 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:

A patent applicant frequently seeks to secure patent protection for his invention in several countries. Both patentee and third parties would in the long term benefit from the certainty provided by harmonisation of the definition of impermissible added matter.

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

#### **Proposed definition of impermissible added matter :**

A matter which is added, at any time after the date of filing of the patent application, to any part of the patent specification, and which would be regarded by a person having ordinary skill in the art as falling under all of the categories below:

(a) not expressly mentioned in any part of the patent specification as initially filed , and

(b) not implicit in what has been disclosed in the patent specification as initially filed having regard to

the common general knowledge as at the applicable priority date, and

(c) not directly and unambiguously derivable from the patent specification as initially filed when read as a whole again having regard to the common general knowledge as at the applicable priority date.

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:

Since impermissible added matter as defined above is essentially any matter which is not present in the patent specification or not implicit in or derivable from said patent specification as at the initial date of filing, the definition should remain the same at whatever stage after said initial date of filing.

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:

If the addition or removal of claims would introduce added matter, the rules against impermissible added matter would ensure that addition or removal of such claims would not be allowed anyway.

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:

The definition should be the same to provide certainty.

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 evaluating whether or not a matter is expressly mentioned or disclosed in the patent application as initially filed, the relevant date of knowledge for the notional skilled person should be the date of the patent application as initially filed.

In evaluating whether or not a matter is implicit in what has been disclosed in the patent specification as initially filed, the common general knowledge which should be considered by the notional skilled person is that existing as at the applicable priority date.

In evaluating whether or not a matter is directly and unambiguously derivable from the patent specification as initially filed when read as a whole, the common general knowledge which should be considered by the notional skilled person is that existing as at the applicable priority date.

In evaluating whether or not a matter has the effect of extending the protection conferred at the time of allowance or at the time of grant, whichever is applicable, the common general knowledge which should be considered by the notional skilled person is that existing as at the applicable priority date, as said person should construe or interpret the claims in light of said knowledge as at that date.

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?

The impermissible added matter should first be deleted. The affected claim, which now confers an impermissible extension of scope should be further amended so that it would not confer an impermissible extension of scope.

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

1. Under the current patent law and practice :(a)Amendments to the patent specification in a patent application are possible provided that the amendments do not go beyond the disclosure of the patent application as initially filed.(b)Amendments to the patent specification in a granted patent are possible provided that the amendments do not go beyond the disclosure of the patent application as initially filed and do not extend the scope of protection beyond that conferred at the time of grant.(c)Whether or not a matter is added matter is looked at in the eyes of the notional person having ordinary skill in the art.
2. It is proposed that guidelines or details on how the law on amendments and added mater is applied or put into practice be incorporated as law, perhaps as part of the Patents Regulations 1986.
3. Harmonisation of the definition of impermissible added matter in the various jurisdictions is desirable as it would provide certainty.
4. A proposed definition of impermissible added matter :

*A matter which is added, at any time after the date of filing of the patent application, to any part of the patent specification, and which would be regarded by a person having ordinary skill in the art as falling under all of the categories below:*

*(a) not expressly mentioned in any part of the patent specification as initially filed , and*

*(b) not implicit in what has been disclosed in the patent specification as initially filed having regard to the common general knowledge as at the applicable priority date, and*

*(c) not directly and unambiguously derivable from the patent specification as initially filed when read as a whole again having regard to the common general knowledge as at the applicable priority date.*