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2016 - Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

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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, but only in certain specific cases.

In particular, Article 30 of the Uruguayan Patent Act No. 17.164 provides that a patent application may not be amended, except in the following cases:

- A) To correct errors in data, text or graphic expressions
- B) To clarify, specify, limit or restrict object of the application.
- C) Whenever modifications are deemed appropriate by the patent examiners.

Furthermore, Article 30 provides in Paragraph 2) that "*No modification, correction or clarification shall be allowed whenever the same entails broadening of the information contained in the original application*".

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

As a general rule, amendment of claims may be filed at any time after the filing of the application.

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.

As mentioned in question 1, the standard for determining whether amendments are permissible is set forth in Article 30 of the Patent Act, which provides that amendments are allowed only if the same do not entail broadening of the information contained in the original application.

Moreover, nor the Patent Act, nor its Implementing Regulation, establish a specific term for the filing of voluntary amendments to the application (including amendment to the set of claims). Nevertheless, as per the Uruguayan Patent Office practice, voluntary amendments are received by the Patent Office while the application is pending and before the substantial examination has been completed.

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

The general remarks regarding amendments of patent applications referred above are applicable both to the amendments of the description and the claims.

- 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.

There is no definition of impermissible added matter under Uruguayan Law.

Whether or not an amendment amounts to impermissible added matter or not is left to the interpretation of the Uruguayan Patent Office and Uruguayan Courts (which should apply the standard described in question 3) a).

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;

While, Uruguayan Patent Law does not provide express guidelines as how patent application as filed should be interpreted in the assessment of impermissible added matter, it arises from the same that the same should be interpreted as from the standpoint of a person skilled in the relevant 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 would be date on which the patent application was filed, or the date of the priority, if applicable.

- 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?

no

Please explain:

No express provision in Uruguayan Patent Law regarding post-grant proceedings for removing impermissible added matter from a granted patent. Article 30 of the Uruguayan Patent Act only refers to patent applications (and does not mention granted patents).

Moreover, Article 44 of the Uruguayan Patent Act provides that a patent shall be invalid in case matter that was not included in the original application is claimed, in accordance with the provisions of the Act.

Therefore, the patent (or the claim containing impermissible added matter) may even be declared invalid in the particular case brought before court, or be annulled, totally or partially (this, depending on the nature and powers of the court or administrative authority which is reviewing 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?

See response No. 1.

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

yes

Please explain:

It would be desirable to further clarify the standard regarding permissible amendments, both at the patent application stage and in case of post-grant proceedings.

- 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?

See comments in number 7 above.

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

yes

Please explain:

See comments in number 9 above.

- 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?

See comments in number 6 above.

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:

It would be desirable to achieve harmonization in the definition of impermissible added matter, its scope, boundaries and standards.

However, as already mentioned, there is no relevant case law or detailed analysis of this issue either at the Patent Office, or Courts level, and the matter is still yet to be clarified. Scholars have also not specifically addressed this issue as regards current Uruguayan law. For this reason, we consider that harmonization efforts and discussion should be considered once the matter is clarified first at the PTO or Court level in our jurisdiction, on how the current statute and standards should be interpreted and applied.

- 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)?

- 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?

- 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