2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

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?

The below response represents the aforementioned authors’ analysis only. The Group has not discussed this matter and this paper does not purport to represent the Group formal position.

Before turning to provide the authors’ response to the questions below regarding the admissibility of added matter, it should be noted that Israeli law does not have rules similar to the EU rules regarding “added matter”. The closest legal framework existing in Israel to the EU added matter doctrine would be the rules regarding the amendment of a patent specification and claims. We have therefore based our response on those rules.

In addition, Israel has a pre-grant opposition system. Therefore, and as will be described hereunder, there are differences between the amendments rules that apply to patent applications before acceptance, and the amendments rules that apply to patent applications after acceptance and granted patents.

With respect to patent applications - amendments are possible throughout the prosecution of the application until acceptance (see question 4 below). After the examination proceedings and upon the acceptance of a patent application (Israel has a pre-grant opposition system), amendments are
possible only for clarification purposes or to eliminate a mistake in the specifications or in order to restrict the claims (section 65 of the Israeli Patents Law, 1967 ("the Patents Law")). It is also possible to correct clerical errors in the specification (section 69 of the Patents Law). In addition, section 66 of the Patents Law provides that: "The Registrar shall permit an amendment if he is satisfied that it will not widen the scope of the claims in the specification or add to the specifications things not originally contained therein in substance; notice of the grant of permission for the amendment shall be published on the internet".

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

With respect to patent applications - amendments are possible throughout the prosecution of the application until acceptance (see question 4 below).

Under our Group's current law, with respect to granted patents and patent applications after allowance, it is possible to amend the claims, provided that the aforesaid conditions are met.

There is no difference in the criteria applicable for the amendment of patent claims and the criteria applicable for the amendment of the description of and/or figures included in a patent.

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 as described is derived from statutory provisions, patent office guidelines, as well as in Israeli case law.

As noted above, section 65 of the Patents Law states that a granted patent may be amended only for clarification purposes or to eliminate a mistake made in the specifications or in order to restrict the claims. Section 66 of the Patents Law sets forth the general limitations with respect to the amendment of granted patents and accepted patent applications. According to said section 66, the Israeli Registrar of Patents ("the Registrar") will allow the amendment, provided that no new substantial subject matter is introduced following the amendment and the amendment did not result in a broadening of the claims.

The Registrar needs to be satisfied that the amendment fulfils the statutory purposes of section 65, as outlined above. According to long established case law (American Cyanamid v. La Petite), the patentee should be allowed to claim the invention as could originally be claimed in light of the description.

It has been held in several patent office decisions that section 65 of the Patents Law (stipulating the circumstances under which a patentee has the right to request to amend his patent) and section 66 of
the Patents Law both specify cumulative, rather than alternative, requirements with which the sought amendment must comply.

It has further been held in patent office decisions that introducing a new dependant claim in an amendment usually does not fall within the scope of the requirements of sections 65 and 66 of the Patents Law and, therefore, will not be permitted. Such decisions of the patent office have hitherto not been tested at court.

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

There are no such differences.

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.

The scope of amendments that may be sought by a patentee in respect of the granted patent or by an applicant after the allowance of the patent application (after examination) is detailed in answers (1) and (2) above.

As to patent applications under examination, an applicant may amend the specification, either at the request of the patent office examiner or at the applicant's own initiative (section 22 of the Patents Law). If amendments of a substantive nature were made in the specification of claims, then according to section 23 of the Patents Law, the Registrar may prescribe, for the purposes of examining novelty, inventive step and first-to-file rights that, if it is possible to distinguish between such amendments and the existing specification, the date of the amendments shall be the date on which they were submitted to the patents office; and that if it is not possible to make such distinction, the date of the application as a whole shall be the date on which the amendments were submitted to the patents office.

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 term “impermissible added matter” is not expressly defined in the Israeli law since, as mentioned in the authors' preliminary remark above, provisions similar to the EU rules regarding “added matter” has not been introduced into the Israeli law. Accordingly, in reliance on the rules which apply in Israel with regard to the amendment of a patent specification and claims as described above, it would seem that any amendment which does not meet the criteria set out in sections 65 and 66 of the Patents Law would be deemed impermissible.

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 is interpreted in a manner that the claims and description are considered as constituting a single document. Although what is not claimed is disclaimed, the claims have no
meaning outside the context of the specification as a whole, as read by a person of average skill in the art, equipped with the common general knowledge in the field of the invention. In addition, statements made by the patent applicant during the examination proceedings may also be used as a tool for interpreting the patent. (and might also serve as a basis for file wrapper estoppel, to the extent that such doctrine has been adopted by the Israeli Law).

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?

As a general rule, the relevant date of knowledge of the notional skilled person would be the priority date 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:
The mechanism available to the patentee for remedying the defect is specified in sections 65 and 66 of the Patents Law, which, as noted above, provide that the patent specification may be amended only in order to clarify it, eliminate a mistake in the specification or restrict the claims (section 65) and that the requested amendment will not widen the scope of the claims in the specification or add to the specifications things not originally contained therein in substance (section 65). Therefore, in so far as the nature of the amendment falls within the scope of the said sections, the patentee will be permitted to apply to the patent office for amendment of the patent during post-grant proceedings.

Alternatively, a judge may order, in the framework of court proceedings, on amendments to 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?

It is upon the examiner to decide whether new matter of substantial nature is added. If amendments of a substantive nature are made in the specification, the Registrar may order, for the purposes of novelty, inventive step and for applying the "first-to-file" principle, that such amendments be accorded the date of their submission. In addition, according to a Circular dated June 1, 1980 published by the Registrar, which does not constitute binding law, the addition of new examples of novel compounds would be considered added matter that requires post-dating to the date of submission of the amendment.

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

no
Please explain:
Since each invention turns on its own facts, it seems hardly possible to establish guidelines relating to
what is considered impermissible added matter. It would be easier, as in the case of the aforesaid Registrar’s Circular, to expressly determine “impermissible added matter” in specific situations.

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?

As noted above the overarching principle, as set out by the Supreme Court, is that the patentee should be allowed to claim the invention as could be originally claimed in light of the description (American Cyanamid v. La Petite), provided that the scope of the claims is not broadened and no new matter is introduced.

According to current law and practice, where an application to amend the specification is filed with the patent office, the application must meet the aforesaid rules of section 65 and 66 of the Patents Law.

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

yes
Please explain:

The authors are divided as to whether there are aspects of these laws that could be improved. For example, according to one opinion, it should be clarified that once an independent claim was restricted, dependent claims may be added which were not included in the original set of claims. Furthermore, according to this opinion, there is currently some ambiguity on the issue, as transpires from decisions of the Patents Office. According to another opinion, which is based on certain decisions of the Patents Registrar, introducing a new dependent claim in an amendment would usually not be deemed as falling within the scope of the requirements of sections 65 and 66 of the Patents Law and the balance between allowing a patentee to make appropriate amendments to a granted patent and preventing the patentee adding impermissible matter, thus, will not be permitted.

Correcting clerical errors in the specification may be permitted post grant.

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?

Due to our very limited experience on the issue in Israel we are unable to state whether this approach is effective. However, it is likely that the question of whether an amendment broadens the claims or not, depending on the interpretation of the original and amended claims, will indeed be determined by the court from the standpoint of the notional person skilled in the art.
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:

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

The authors are divided with regard to this matter. Two proposals were made:

1. “Impermissible added matter”: the addition to the specification, of substantial matter not included in the patent application as filed, including description, experiments and/or claims which is not directed to clarify, eliminate a mistake in the specification or restrict the claims and that it would not widen the scope of the claims in the specification or add to the specifications things not originally contained therein in substance.

2. “Impermissible added matter”: the addition to the specification, of substantial matter not included in the patent application as filed, in an express or implied manner, including description and/or claims of substantial nature regarding the validity of the patent or the patent application; except for correcting a clerical error.

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)?

yes

Please explain:

Yes. During examination impermissible added matter, as defined above, should be allowed subject to the limitations provided by Section 23 of the Patent law (see question 4 above). The authors are divided with regard to the scope of eligibility of “post grant” amendments. According to one opinion, only one additional condition should be added, namely, that the amendment will not result in broadening the scope of the patent. According to another opinion, any amendment requires support in the specification as well as compliance with the cumulative conditions of sections 65 and section 66 of the Patents Law as detailed above should be added.

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

The authors are divided with regard to this question. According to one opinion, rules against impermissible added matter should not prohibit the addition of claims per se. In this context, the patentee should be allowed to claim the invention as could be originally claimed in light of the description (American Cyanamid v. La Petite). According to another opinion, rules against impermissible added matter should prohibit the amendment of a granted patent or of a patent application which has been accepted and allow the amendment only in cases in which it is deemed necessary, namely, for clarification purposes, in order to eliminate a mistake in the specification or to
restrict the claims (and provided that such amendment would not widen the scope of the claims in the specification or add to the specifications things not originally contained therein in substance). According to this opinion, introducing depended claims will not be allowed.

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<td>No. The patentee should be allowed to claim the invention as could be originally claimed in light of the description (American Cyanamid v. La Petite).</td>
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<th>Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?</th>
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<th>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?</th>
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<th>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?</th>
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**Summary**