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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

National/Regional Group

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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?

Note: The term "patent" shall refer to a patent application or a granted patent.

Amendments to the description of a patent are acceptable provided that the amendments must not disclose any matter extending beyond that disclosed in the application as filed. Please refer to the following sections:

Pre-grant

(Section 84(2)): (2) No amendment of an application for a patent shall be allowed under section 31 if it results in the application disclosing any matter extending beyond that disclosed in the application as filed.

Post-grant

(Section 84(3)): (3) No amendment of the specification of a patent shall be allowed under section 38(1),

81 or 83 if it — (a) results in the specification disclosing any additional matter; or (b) extends the protection conferred by the patent

You will note that for granted patents, the amendment must not extend the protection conferred by the patent. However, we note that for the purposes of this study question, we are only concerned with the question of added matter. The question of extended protection conferred by the patent, and insufficiency where there is no impermissible added matter will not be discussed.

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

Yes, as per the requirements in (1) above.

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 for determining whether amendments are permissible can be found in statutes, patent office guidelines and case law. As mentioned above, the Singapore Patents Act sets out the requirement that the amendment should not result in added matter. The interpretation of the sections in our Patents Act can be found in case law and the 2015 Examination guidelines of the Intellectual Property Office of Singapore (IPOS).

The Singapore courts have, in a few cases, followed the test set down in the UK case *Bonzel and Schneider (Europe) AG v International Ltd* [1991] RPC 553, and in the Singapore case of *Novartis AG and another v Ranbaxy (Malaysia) Sdn Bhd* [2012] SGHC 253 at [8], the court followed a further elaboration of the test in *European Central Bank v Document Security Systems Incorporated* [2007] EWHC 600.

The Bonzel test is a three step test to determine if the disclosed matter extends beyond the application as filed:

1. to ascertain through the eyes of the skilled addressee what is disclosed both explicitly and implicitly in the application;
2. to do the same in respect of the patent as granted;
3. to compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition; the comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly. This is similar to the novelty test, which assesses whether the prior art in one document or article in use contains sufficient information so that the person skilled in the art could derive the subject-matter in question from it directly and unambiguously, including any features implicit therein...

In the case of *European Central Bank v Document Security Systems Incorporated*, Bonzel test is further elaborated to consider whether the added subject matter provides a technical contribution to the subject matter of the claimed invention that would give an unwarranted advantage to the patentee. Hence, if the added matter for example, “excludes protection for part of the subject matter of the claimed invention as covered by the application as filed, the adding of such a feature cannot reasonably be considered to give any unwarranted advantage to the applicant”.

Not surprisingly, hindsight is to be avoided when considering the disclosure.

Thus, any amendment will result in impermissible added matter unless such matter is **clearly and unambiguously** disclosed in the application either **explicitly or implicitly** as viewed by the skilled person. Examiners should take a purposive approach to the construction of any document (see: [2015 Examination guidelines section I\(i\) 7.38](#))

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

No.

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.

Rule 49 of the Patent Rules does provide that amendment made prior to grant can only be submitted during certain periods of time in the course of prosecution. The applicant may, unless the Registrar otherwise requires, of his own volition, amend the description, claims, drawings and abstract at any time before payment of the fee for the grant of a patent, except that any such application for amendment shall not be made –

(a) at any time after the filing of a request for a search report under section 29(1)(a) and before the receipt of that report by the applicant;

(b) at any time after the filing of a request for a search and examination report under section 29(1)(b), unless the amendment is contained in a response filed under rule 46(3) in respect of that report;

(c) at any time after the filing of a request for an examination report under section 29(1)(c) or (3), unless the amendment is contained in a response filed under rule 46(3) in respect of that report;

(d) at any time after the filing of a request for a supplementary examination report under section 29(1)(d), unless the amendment is contained in a response filed under rule 46(3) in respect of that report; or

(e) at any time after a request for a review under section 29B(1) is made.

This is to ensure that the scope of search and examination is not altered after the request is filed. An amendment cannot be filed after allowance but before grant.

Apart from these restrictions however, the impermissible added matter standard does not change according to the timing of the 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 matter is a ground for refusal and is determined as per the test set out in question 3.

- 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 whole of the description, drawings and claims must be considered through the eyes of the skilled person in the art. Although the application includes the abstract, it is mentioned in the 2015 Examination guidelines section I(i) 7.41 that the abstract should be disregarded in determining whether an amendment adds matter.

- 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?

In the Examination guidelines section D 2.21, the skilled person is taken to be a person of ordinary skill in the art who possesses the common general knowledge in the particular art at the earliest relevant date.

The basis for consideration for added subject matter is to compare between the specification as filed and the specification as proposed to be amended. Therefore, it would appear that the priority date should be the relevant date in question.

- 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 patentee is allowed to make amendments pursuant to section 83(1) in a post-grant proceeding subject to the discretion of the court or Registrar (see (10) below for discretionary factors taken into account). However, such amendments must additionally not extend the protection conferred by the patent pursuant to section 84(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?

The patent applicant may file a response, with amendments to the specification, during the examination of a patent application. A balance is struck by ensuring that such amendments must have been explicitly or implicitly disclosed in the specification as filed.

The Examiner considers if the amendments add new subject matter as described in the answer to question 3. If the Examiner is of the opinion that the amendments add new subject matter and are not permissible, an objection is raised in a further written opinion or examination report. The patent application cannot proceed to grant without resolving all objections from the Examiner.

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

yes

Please explain:

The current provisions appear to be adequate.

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 pursuant to section 38(1), 81, and 83 of the Patents Act.

The Registrar must be satisfied that the amendment is allowable, which will then be published. A person may give notice to the Court or the Registrar of his opposition to an amendment proposed by the proprietor of the patent.

A patent may be revoked on the grounds that an amendment that should not have been allowed was made (i.e. addition of new matter) pursuant to section 80(1)(e).

If amendments are made to a patent pursuant to section 83(1) in revocation or infringement proceedings, the court or Registrar has discretion to determine the allowance of the amendments according to the factors below:

- a. whether the patentee has disclosed all the relevant information with regard to the amendments;
- b. whether the amendments are permitted in accordance with the statutory requirements;
- c. whether the patentee delayed in seeking the amendments (and, if so, whether there were reasonable grounds for such delay);
- d. whether the patentee had sought to obtain an unfair advantage from the patent; and
- e. whether the conduct of the patentee discourages the amendment of the patent.

(see Novartis AG and another v Ranbaxy (Malaysia) Sdn Bhd 2013 2 SLR 117)

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

no

Please explain:

The current provisions appear to be adequate.

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, since the specification is directed towards the skilled person, any amendment must be viewed as to what the skilled person will learn with and without the amendment. As mentioned above, in assessing whether an amendment is clearly and unambiguously disclosed, a test akin to novelty is applied. When assessing novelty under the patentability requires, the standard applied is also 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.

1. Impermissible added matter is any addition or deletion to the subject matter of an invention which is not expressly or implicitly disclosed in the application as filed, as seen through the eyes of the notional person skilled in the art.

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?

No as the addition of claims may not necessarily lead to impermissible added matter. Further, applicant or patentee should be allowed to define their invention freely provided there is support in the description and post grant, it does not extend protection.

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

no

Please explain:

No. See comments above in (16). This should be governed by other provisions dealing with whether or not a claim may be broadened post grant.

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:

Yes. If the patent office and court applies different definitions, it will lead to uncertainty for patentees and third parties.

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?

Since the amendment is compared to the application as filed, the relevant date of knowledge should be as at the priority date of the application.

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?

Such a scenario may result in the revocation of the entire patent. Some flexibility or exceptions to the law is needed to allow the patentee to amend post-grant, while considering the whole application as filed and the reasons behind the initial amendment that led to the impermissible added matter. This may lead to uncertainty but the alternative will be the complete loss in patent rights.

Perhaps one solution may be to only allow the broader claim to be enforced only from the date of publication of the amended claim so that the public are shielded from a potential infringement action based on claims which they were unaware of.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

It may be worth considering whether added matter may be allowed prior to publication of the patent application and before any search and/or examination is required. This may be useful for patent applicants so that they need not have to re-file the application within the priority year, and there would seem to be little prejudice to the Patent Office or third parties. However, we recognise that this would be a major change to our current system.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary

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In Singapore, it is impermissible to amend the application and specification if it adds matter. Pre-grant and post grant amendments are allowed. Whether or not the amendment contains impermissible added matter is assessed by comparing the amendment to the application as filed, and deciding whether the subject matter of the amendment is already disclosed explicitly or implicitly in the application as filed. The assessment is made by the person skilled in the art. This provides as safeguard to ensure that no new matter is added. There are also certain rules as to when such amendments may be filed to ensure the integrity of the search and examination process. With regard to post grant amendments, the scope of protection of the claims must not be broadened. We support harmonisation of laws along the above lines.