



Study Guidelines

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2016 – Study Question (Patents)

Added matter: the standard for determining adequate support for amendments

Introduction

- 1) This Study Question concerns the role and effects of impermissible added matter in relation to amendments to patents.
- 2) The term **patent** as used in these Study Guidelines refers to a granted patent or an application for a patent, or both, as the context requires. Where it is necessary to distinguish between the two, these Study Guidelines refer to granted patents and patent applications.
- 3) The term **impermissible added matter** as used in these Study Guidelines refers to a proposed amendment to a patent that is impermissible because it lacks support (often referred to as "basis") in the application as filed. This includes added matter as referred to in Article 123(2) of the European Patent Convention.
- 4) The term **amendment** as used in these Study Guidelines refers to any amendment of, deletion from or addition to a patent specification, including to the description, figures or claims.
- 5) The primary objective of this Study Question is to define impermissible added matter. It is concerned with examining the support (or basis) for making amendments having regard to the patent application as filed. This Study Question is not concerned as such with:
 - a) extensions of the scope of protection caused by an amendment where the amendment does not otherwise comprise impermissible added matter, e.g. where a claim is added for a combination A+B taught in the specification, making the patent broader than an old claim A+B+C; or

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- b) insufficiency where there is no impermissible added matter, e.g. adding a claim for an embodiment disclosed in the application as filed, but without full instructions being provided in the specification for putting that embodiment into full effect.

6) In addition, a number of other questions arise, described below.

Previous work of AIPPI

7) AIPPI has previously considered added matter in the following contexts.

- a) The Resolution on Q69 – "Sufficient description of the invention" (Munich, 1978) addressed added matter but was mainly focussed on the issue of sufficiency. AIPPI resolved that:

- i. The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art; and*

- ii. Article II, paragraph 4: In addition to the correction of purely immaterial faults, the description of the invention may be amended in the course of the grant procedure, under the control of the examiner, and on the essential condition that this modification adds no new inventive matter to the description.*

- b) The Resolution on Q189 – "Amendment of patent claims after grant" (Gothenburg, 2006) addressed requirements for amending patents after grant, especially from the point of view of the scope of protection of the patent. AIPPI resolved that:

- 2) Patent claim amendment after grant must not extend the scope of protection of the claims as granted;*

- 3) Patent claim amendment after grant must always have support in the original specification, drawings or claims, and in particular there should be no possibility of adding new subject matter; (emphasis added)*

...

- 5) It should be possible to amend patent claims after grant by introducing any subject matter from the specification, claims or drawings into the claims, provided this does not extend the original scope of protection of the claims as granted;*

Paragraph 3 of Resolution Q189 is highly relevant in the context of this Study Question, and makes it clear that new subject matter should not be added when amending the claims of a granted patent.

However, Resolution Q189 does not address the amendment of patent applications.

- c) The Resolution on Q193 – "Divisional, Continuation and Continuation in Part Patent Applications" (Singapore, 2007) addressed rules for basing divisional applications on matter disclosed or not disclosed in the parent application. AIPPI resolved that:

4) In a divisional application, it should be possible to claim subject matter that was unclaimed, but was disclosed in the parent application.

*5) If matter not disclosed in the parent application as filed is included in a divisional application, the divisional application should not be invalid provided that the **added matter is deleted prior to grant**. (emphasis added)*

Paragraph 5 of the Resolution on Q193 assumes that the test for impermissible added matter is whether that matter is not disclosed in the relevant application as filed, and also explains that an appropriate corrective action is to delete that impermissible added matter prior to grant.

- d) The Resolution on Q209 – "Selection inventions" (Buenos Aires, 2009) resolved in paragraph 13 that the impact of late submission of data (i.e. after filing the application) be studied further.
- 8) It is clear from the Resolution on Q189 that AIPPI has resolved that patent claim amendment after grant should always have support in the original specification, drawings or claims, and in particular there should be no possibility of adding new subject matter.
- 9) However, AIPPI has not yet squarely addressed the definition of impermissible added matter, the impact of impermissible added matter on amendments to both granted patents and patent applications, the extent to which the analysis depends on the construction of the patent by the skilled person, and relevant date(s) for the construction of the application as filed. It is not the intention of this Study Question to disturb prior Resolutions, but to simply refine the definition of impermissible added matter, and to explore methods of remedying impermissible added matter problems.

Discussion – Impermissible added matter and scope of this Study Question

- 10) The Agreement on Trade-related aspects of Intellectual Property Rights (**TRIPs**) does not mandate a support requirement as part of the basic substantive rules relating to patents. However, TRIPs does mandate some disclosure requirements:

Article 29

Conditions on Patent Applicants

1. Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.

11) If a claim, sought to be introduced by way of amendment, has no basis in the description then it is obviously not described sufficiently clearly and completely.

12) In the United States, §35 USC 132 stipulates:

No amendment shall introduce new matter into the disclosure of the invention.

13) In Europe, Article 123(2) of the European Patent Convention (**EPC**) requires:

The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

14) Article 123(2) has been interpreted in the case law of the EPO's Technical Boards of Appeal such that amendments are permitted within the limits of what the skilled person would derive directly and unambiguously, using common general knowledge from the application as filed (the so called "gold standard"; G 2/10; G 3/89; G 11/91 and T 248/12). This is also reflected in the EPO's Guidelines for Examination H, IV-2.2.

15) Moreover, the general principle from the Guidelines following case G 1/93 is:

The underlying idea of Art. 123(2) EPC is that an applicant is not allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (see G 1/93). An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person 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 a person skilled in the art. (Guidelines H-IV, 2).

- 16) Further, in the situation where features are removed from a disclosed embodiment so as to produce a generalisation of originally disclosed subject matter, EPO case law has established that the following questions should be posed in order to determine whether such a generalisation is allowable:
- (1) are the features explained as essential in the disclosure;
 - (2) are the features, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve; and
 - (3) does the removal require any real modification of other features to compensate for the change?
- 17) From a practical perspective, the nature of patent prosecution and judicial processes has tended to influence the manner and way in which added matter is assessed. Whilst courts in some countries have access to expert evidence which assists the court in understanding what the skilled person would have gleaned from the application as filed, in other countries the court may not have access to such evidence and might instead itself need to construe the application as filed or under the guidance of technical judges.
- 18) Similarly, patent offices will typically not have access to expert evidence to guide them on the meaning of the application as filed.
- 19) The EPO's "direct and unambiguous" requirement has, in particular, become a vexed issue in that it hints at a more literal approach than that set out in Article 123(2) of the EPC, and the principles established in G 1/93. Recently, some decisions of the Board of Appeal have taken a softer line and, moreover, a 2014 revision to the Guidelines for Examination introduced some wording which appeared to soften the strict assessment:

When assessing the conformity of the amended claims to the requirements of Art. 123(2), the focus should be placed on what is really disclosed to the skilled person by the documents as filed as directed to a technical audience. In particular, the examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole. (Guidelines H-IV, 2.2)

This still leaves open the question of what is directly and unambiguously derivable from the application as filed by the skilled person. On an analytical level, this question is about what the patent application as a whole teaches the skilled person. Of course, the scope of a granted patent (and in some situations and in some countries, the scope of a patent application) is highly relevant to issues such as infringement, novelty and obviousness.

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- 20) These issues are further complicated by the nature of the analysis in determining scope and teaching. In some countries, construing the scope of the patent claims is a matter of law and therefore not directly determined with the assistance of expert evidence, while the teaching of the patent application as filed is guided much more by expert evidence. In other countries, there is no difference between the nature of the analysis when determining scope and teaching.
- 21) If the teaching is narrower than the claim scope, then the patent can be bad for insufficiency if it does not enable the invention to be practised to its full claimed scope. As noted above, this Study Question does not directly address sufficiency, but simply the permissibility of a later increase in the teaching of the patent, potentially with a commensurate broadening in scope, if that increase in teaching was by way of an amendment to a claim.
- 22) However, if the scope of the patent has been broadened by amendment, e.g. by deletion of a limitation in the claim, thereby broadening the claim, but there is no increment in the teaching, that broadening is not due to impermissible added matter. This Study Question is not directed specifically to extensions of scope if such extension is not due to impermissible added matter.
- 23) If the scope of the patent has been narrowed by amendment, e.g. by adding claim integers, the additional information taught by those claim integers may be impermissible added matter.
- 24) The teaching of the patent application as filed might be said to be:
 - a) the literal disclosure of the patent application as filed;
 - b) the literal disclosure of the patent application as filed, supplemented with all matter that can be directly and unambiguously derived from the patent application as filed;
 - c) the patent application as filed, unchanged, read with the common general knowledge of the skilled person;
 - d) the application as filed incorporating all uninventive routine workshop variations (or non-material changes) of the application as filed;
 - e) the application as filed and anything which was obvious to the skilled person from the application as filed; or
 - f) something else.
- 25) Another way of looking at this question is to ask what the skilled person would do, when the application as filed is placed in front of them and they are asked to implement the invention in accordance with it. When the skilled person has an objective in mind and is implementing the invention, what might or could be obvious to the skilled person from the application as filed may be less relevant

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if it is not directly related to the objective in mind.

- 26) A highly relevant consideration is what approach would promote greater certainty for both patentees and third parties, especially as many patent portfolios have an international dimension with families of patents in more than one country or region. That question is the primary issue addressed in this Study Question.
- 27) Further issues that arise are:
- a) what, if any role does the skilled person play in analysing impermissible added matter?
 - b) what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?
 - c) should the definition of impermissible added matter depend on when an amendment is made (for example, before versus after grant)?
 - d) should the definition of impermissible added matter prohibit the addition of claims per se (as opposed to adding or removing limitations to claims)?
 - e) should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?
 - f) how can impermissible added matter be remedied?

Questions

I. Current law and practice

You are invited to submit a Report addressing the questions below. Please refer to the 'Protocol for the preparation of Reports'.

*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?
- 2) Under your Group's current law, are amendments to the claims of a patent possible?
- 3) Further to your answers to questions 1) and 2), please indicate:

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- 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.
 - 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.
 - 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;
 - 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?
 - 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?

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?
- 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.*
- 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)? If yes, 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?
- 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.