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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?

Patent applications:

Amendment of the description and/or figures of a patent application is possible, provided no impermissible added matter is introduced. As stipulated in Art. 72(1) and (2) of the Hungarian Patent Act (HUPA):

“(1) A patent application may not be amended in such a way that, by introducing new content, its subject matter becomes broader than that disclosed in the application at the date of filing.

(2) The applicant shall be entitled to amend the description, claims and drawings as laid down in paragraph (1) until the day on which the decision concerning the grant of the patent is made.”

Patents:

Amendment of the description and/or figures of a granted patent is not possible.

Correction of clerical errors in the letters patent document in relation to the text as granted is possible by Errata. This type of correction can be initiated without a time limit. The Hungarian Intellectual Property Office (HIPO) has the competence to effect such amendments. Thereinafter the present report

will not further address this type of amendment.

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

Patent applications:

Yes, provided no impermissible added matter is introduced (Art. 72(1) and (2) HUPA).

Patents:

Particular claims can be voluntarily deleted (surrender as stipulated in Art. 41(3) HUPA), or in nullity proceedings also amendments limiting the scope of protection are possible (Art. 42(2) HUPA). No other amendments are possible.

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 of permissible amendments exists in statutes and is refined in the Guidelines of the HIPO. Generally, amendments are permissible if they do not introduce new content broadening the subject matter compared to that disclosed in the application at the filing date. The Guidelines of the HIPO declare that impermissible new contents are those not directly and unambiguously learnable by a skilled person from the application as filed. According to the Guidelines, however, introducing any content being obvious for a skilled person on the basis of the teaching of the application is permissible. In the opinion of the Hungarian Group, the Guidelines of the HIPO create legal uncertainty in this respect.

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

Yes, the substantive standards for amendments are different before and after grant.

Patent applications:

The same substantive standards apply for amendments to the description, figures and claims.

Patents:

No amendments are possible to the description and/or figures, while claims can be voluntarily individually deleted, or limited in nullity proceedings.

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 same standard applies until the day of the decision to grant. Thereafter, only the claims can be amended by deleting individual claims, or, in nullity proceedings, also by limiting the scope of protection.

- 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 any new content the result of which is that the subject matter of the application becomes broader than that disclosed in the application as filed on the acknowledged filing date.

- 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 as the notional skilled person would understand the patent application as filed.

- 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 is the acknowledged filing date.

- 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 possibility of remedy primarily depends on whether the impermissible added matter is in the claims or in the description/drawings.

Impermissible added matter in the claims: the defect can be remedied in nullity proceedings if removal of the impermissible portions constitutes a limitation of the granted scope (HUPA 42(2)). If such removal does not constitute a limitation of the granted scope, no remedy is possible and the patent is nullified in its entirety or with respect to the respective independent claim(s).

Impermissible added matter in the description and/or drawings: the defect cannot be remedied.

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 Hungarian Group considers that the current law in Hungary is rather in the favour of the applicant with respect to permissibility of amendments during examination (see our answer to point 9 below).

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

yes

Please explain:

A number of aspects could be improved.

Literally interpreted, the relevant provisions of HUPA do allow to introduce new content, if it does not result in a broadening of the subject matter. However, it is not clear how the term “subject matter” is to be interpreted. If “subject matter” means only the scope that is claimed in the independent claims, then new content can be introduced freely provided it does not result in a broader claimed scope. This possible interpretation may result in allowing unlimited technical additions to the description/drawings, which is not desirable. In one case known to the Hungarian Group, the HIPO relied on this interpretation and found a considerable amount of new technical content permissible, even in the dependent claims.

The term “broadening” is also vague. This term does not have the same meaning as the more exact “extend beyond” expression. A subject matter (at least partly) outside the subject matter originally disclosed, having a same or a narrower coverage-size may be interpreted as to constitute a permissible amendment on the basis of the legal provision.

The Guidelines unfortunately suggest that amendments being obvious for a skilled person on the basis of the original teaching are permissible. In the opinion of the Hungarian Group, this interpretation opens the gate for introducing e.g. further embodiments, technical details, which does not seem to be desirable.

- 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?

Only the claims can be amended by deleting individual claims or in a limiting sense in nullity proceedings; this is considered by the Hungarian Group to be a fair balance.

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

yes

Please explain:

There is one aspect that could be improved.

It should be possible to amend the description and the figures after grant by deleting impermissible amendments introduced.

- 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?

The approach is considered to be effective. An aspect to be improved is that obviousness should not be a threshold for permissible amendments, but only amendments with a content directly and unambiguously learnable or derivable by a skilled person from the application as filed should be possible.

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:

Yes, harmonisation is desirable for promoting greater legal certainty for both patentees and third parties in patent portfolios having international dimensions.

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

The so called disclosure test could be used as a basis for the definition: an amendment is not allowable if the overall change in the content of the application results in the skilled person being presented with information which is not directly and unambiguously learnable or derivable from the application as filed, even when account is taken of matter which is implicit to a skilled person.

(According to a minority opinion within but not supported by the Hungarian Group, an amendment should be allowable only if its content was explicitly present in the application as filed.)

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?

Adding claims before grant should be possible. Adding claims per se after grant should be prohibited as the possibility of addition of claims opens the gate for abusive amendments resulting in a scope extending beyond (even if narrower than) that of the granted one.

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, removal of claims per se should be allowed as such amendments cannot extend the scope beyond that of the granted one.

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:

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?

The filing date should be the relevant 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?

This is a trap situation. If the claim-limitation being an impermissible added matter cannot be replaced by a narrower limitation not being an impermissible added matter, the patent (or the relevant independent claim) is to be invalidated. The Hungarian Group sees no option for remedy.

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

The Hungarian Group considers that setting an internationally harmonized, steady and exact threshold for permissible amendments is of primary importance. A diverging or a less exact threshold may lead to the inclusion of fatal mines into granted patents that usually explode just at the time the patent becomes important and is enforced, causing an irreparable harm for patentees. The disadvantages of a less exact threshold are reflected e.g. by published decisions and statistics of the European Patent Office, showing that a considerable number of granted European patents are revoked in oppositions due to added matter found impermissible. It is conceivable that no fair balance of interests can be established if entire patents can be lost by irreparable impermissible amendments caused by uncertainties of permissibility.

Fairly adjusting the position of the threshold-limit is also important for achieving a fair balance between interests of applicants/patentees and third parties. However, in the opinion of the Hungarian Group, exactness should prevail over fairness, meaning that fairness considerations should not deteriorate or dilute exactness of the definition of the threshold.

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

Pharmaceutical industry

Summary

The Hungarian Group considers that setting an internationally harmonized, steady and exact threshold for permissible amendments is of primary importance. It is conceivable that no fair balance of interests can be established if entire patents can be lost by irreparable impermissible amendments caused by uncertainties of permissibility. Fairly adjusting the position of the threshold-limit is also important for achieving a fair balance between interests of applicants/patentees and third parties. However, in the opinion of the Hungarian Group, exactness should prevail over fairness, meaning that fairness considerations should not deteriorate or dilute exactness of the definition of the threshold.