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Added matter: the standard for determining adequate support for amendments

REPORT OF SWISS GROUP*

Questions

I. Current law and practice

1. Under your Group's current law, are amendments to the description and/or figures of a patent possible?

The Swiss law allows amendments to the description and/or figures. However a distinction should be made between a patent application and a granted patent.

In case of a patent application, the applicant has the opportunity to modify the whole technical documents (which include description, claim[s] and possible figures) on at least one occasion until the examination procedure has been completed; Art. 58 of the Swiss Patent Act (PatA).

In case of a granted patent only the claims may be amended. Amendments to the description and figures of a granted patent are not allowed. However, by amending the claims of a granted patent, the patent proprietor must indicate with a standardized nonspecific statement that parts of the description and figures, which are no more compatible with the new set of claims, should be considered as deemed not to be present. Art. 24 PatA in combination with Art. 97.2 of the Swiss Patent Ordinance (PatO).

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

The Swiss law allows amendments to the claims. See response to point 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 to description, claim(s) and figures are permissible is defined in the Swiss Patent Act, in particular it is ruled under Art. 58.2 PatA and Art. 64.3 PatO in relation to patent applications and under Art. 24 PatA in relation to granted patents.

Under Art. 24 PatA, amendments to the claims are permitted as follows:

- revocation of a patent claim,
- limiting an independent claim by combining the same claim with one or more dependent claims,
- limiting an independent claim in another way, such as by adding a feature taken from the description or figures.

The standard is substantially the same for both patent applications and granted patents and it is based on the general principle that the subject matter of the modified patent application/granted patent should not extend beyond the content of the technical documents as originally filed. Such a principle is in line with the requirements of Art. 123(2) EPC.

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In case of partial surrender or partial nullity of a granted patent, there is the further requirement that the amendment to be permissible must also be contained in the granted patent as published (see point 5) below).

The standard is also mentioned in the Swiss Guidelines for the substantive examination of national patent applications (chapters 5 and 12.2) and it is also applied by Case Law (such as BGE 87 I 397 [1961], 107 II 459 [1981], 113 II 314 [1987]; BGer 4A_109/2011, 4A_111/2011; BPatGer O2012_030 [2013], O2012_033 [2014]).

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

There are no differences in the substantive standards for amendments to the description and/or figures and the claims.

With regard to the claims, there is however a difference between the types of amendment that can be carried out depending on whether the amendment is for a patent application or a granted patent.

In case of a patent application, claim amendments may result – among others – in the filing of new claims (either independent or dependent). This option is however excluded in case of granted patents, wherein only existing claims may be amended by deletion or, in case of independent claims, also by limitation (Art. 24 PatA).

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 timing for an amendment may be relevant only in connection with the claims for the reasons set forth at point 3 above (different types of amendment).

Before the start of the examination procedure the applicant can only amend the technical documents upon invitation of the Swiss Federal Institute of Intellectual Property (IGE) (Art. 51.1 PatO), with the exception for voluntary amendments of the claims, which are only permissible once within 16 months from the filing (priority) date of the patent application (Art. 51.2 PatO).

At the beginning of the examination procedure, the applicant can voluntarily amend the technical documents. After receipt of a first communication from the IGE the applicant can voluntarily amend the technical documents for a second time, provided that the amendment is filed together with the response to the communication. Any other amendment should be authorized by the IGE (Art. 64 PatO). In any case, amendments to a patent application are only allowable prior to completion of the examination procedure (Art. 58.1 PatA). The date of completion is communicated to the applicant at least one month in advance (Art. 59a.1 PatA and Art. 69 PatO). Thereafter only amendments of the claims of the granted patent are possible (Art. 24 PatA, Art. 59a.1 PatA and Art. 72 PatO).

Amendments of the technical documents are also permissible following an opposition procedure in accordance with Art. 59c PatA and Art. 81 PatO. However, opposition procedures in Switzerland are restricted to non-patentable subject matter only, as defined under Articles 1a, 1b and 2 PatA.

The standard for determining whether amendments are permissible or not, does not depend on timing.

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.

Any amendment that results in an extension of the content of the technical documents as originally filed is considered impermissible added matter. For technical documents as originally filed it is meant the documents that have determined the filing date of the application. Under Swiss law, the technical documents also include the abstract, although the latter cannot form the basis for a permissible amendment (Art. 55b PatA).

Furthermore, in case of a partial surrender or partial nullity of a granted patent, a claim amendment should be included both in the technical documents as originally filed as well as in the granted patent

as published in order not to constitute impermissible added matter. In this respect, in case of subsequent amendments of a granted patent, it is the last publication of the limited granted patent that should be considered (this due to the *ex tunc* effect of the amendment).

The presence of impermissible added matter constitutes a ground of nullity (Art. 26.1c PatA).

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 main criterion for the evaluation of impermissible added matter is the identity of the technical information interpreted on the basis of the general knowledge of the person skilled in the art (novelty test, BGE 107 II 459).

In this respect, the addition of an undisclosed equivalent, although obvious, should be regarded as impermissible added 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?

The relevant date of knowledge of the skilled person is the date of filing or date of priority of the patent application (BPatGer O2012_033 [2014]).

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?

Correction of impermissible added matter is possible by means of a request for partial surrender of the granted patent, which has to be filed before the Swiss Federal Institute of Intellectual Property (Art. 24 PatA) or, in case of a European patent with effect in Switzerland, also through a request for limitation before the EPO (Articles 105a–c EPC). Furthermore, impermissible added matter may be deleted from a granted patent during opposition proceedings (Art. 81 PatO) or by a decision of partial nullity issued by the Federal Patent Court (Art. 27 PatA).

In case of correction of impermissible added matter, care should also be taken not to enlarge the scope of protection of the granted patent, which is not allowed either. This issue is however not part of the present Study Question and will thus not be discussed further.

II. Policy considerations and possible improvements to your current law

1. 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 balance is governed by Art. 58.2 PatA, which substantially allows any type of amendment of the technical documents provided that the amendment does not introduce subject matter to the modified patent application, which extends beyond the content of the technical documents originally filed. The criteria for evaluating when an amendment is not permissible, is discussed at point 6.a above.

2. Are there aspects of these laws that could be improved?

No.

3. 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, by means of partial surrender of the granted patent (Art. 24 PatA) or, in case of a European patent with effect in Switzerland, also by means of a request for partial limitation (Articles 105a–c EPC), during opposition proceedings (Art. 81 PatO) or by a Court decision (Art. 27 PatA).

The balance is governed by Art. 24c PatA (or 123[2] EPC), see discussion at points 3 and 5 above.

The main criteria for the evaluation of impermissible added matter is substantially the same as in case of an amendment carried out during the examination procedure of a patent application, with the further requirement that the amendment should also be included in the granted patent as published.

4. Are there aspects of these laws that could be improved?

Yes, with respect to Art. 24c PatA. This provision requires that the amendment must also be present in the granted patent as published. This requirement is however not present in the EPC.

In the interest of legal certainty to third parties, the possibility of amending the description and figures of a granted patent may be considered, as it is currently possible under the EPC.

5. 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?

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III. Proposals for harmonization

1. Is harmonization 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.

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

The Swiss Group is of the opinion that the definition provided in the Guidelines for Examination in the EPO, chapter H IV, 2.1, last paragraph (November 2015)¹ is appropriate.

3. 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.

No.

¹ 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 (see G 2/10). At least where the amendment is by way of addition, the test for its allowability normally corresponds to the test for novelty given in G-VI, 2 (see T 201/83).

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

In case of a patent application, it should be possible to add new claims provided that these do not extend the subject matter of the patent application beyond the content of the technical documents as originally filed.

In case of a granted patent, addition of new claims, although fully supported by the technical documents as originally filed (such as the description), should be prohibited in the interest of legal certainty to third parties.

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

No.

6. Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

Yes.

7. 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 relevant date should be the filing or the priority date of the patent application.

8. 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?

There should be no remedy under these circumstances.

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

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Summary

The Swiss Patent Act allows amendments to the description, figures and claims. Only the claims may be amended in case of a granted patent. The standard for determining whether amendments to description, figures and claims are permissible is also defined in the Swiss Patent Act. It is substantially the same both for patent applications and granted patents and it is based on the general principle that the subject matter of the modified patent application/granted patent should not extend beyond the content of the technical documents as originally filed. Any amendments that result in an extension of the content of the technical documents as originally filed are considered impermissible added matter. Furthermore, in case of a partial surrender or partial invalidity of a granted patent, a claim amendment, in order not to constitute impermissible added matter, should be included both in the technical documents as originally filed as well as in the granted patent as published. The main criterion for the evaluation of impermissible added matter is the identity of the technical information interpreted on the basis of the general knowledge of the person skilled in the art (novelty test). The relevant date of knowledge of the skilled person is the earlier of the date of filing or of priority of the patent application. Correction of impermissible added matter is possible by means of a request for partial surrender of the granted patent, which has either to be filed before the Swiss Federal Institute of Intellectual Property, during opposition proceedings or by a decision of partial invalidity issued by the Federal Patent Court. The Swiss Group is in favor of a harmonization of a definition of impermissible added matter and suggests that an appropriate definition of impermissible added matter is provided in the Guidelines for Examination in the EPO, chapter H IV, 2.1, last paragraph (November 2015). Furthermore, in case of a granted patent, addition of new claims, although fully supported by the technical documents as originally filed, should be prohibited in the interest of legal certainty to third parties.

Zusammenfassung

Das Patentgesetz in der Schweiz erlaubt die Änderung von Beschreibung, Figuren und Ansprüchen. Ist das Schweizer Patent hingegen erteilt, können nur die Ansprüche geändert werden. Der Standard für die Zulässigkeit von Änderungen der Beschreibung, der Figuren und der Ansprüche ist ebenfalls geregelt im Schweizer Patentgesetz und ist im Wesentlichen gleich für Patentanmeldungen und erteilte Patente. Massgebendes Prinzip ist, dass der Gegenstand der geänderten Patentanmeldung oder des geänderten Patentbesitzes nicht über den Gegenstand der ursprünglich eingereichten Patentanmeldung hinausgeht. Änderungen, die in einer Erweiterung des Gegenstandes der ursprünglich eingereichten Patentanmeldung bestehen, gelten als nicht zulässig.

Im Fall eines Teilverzichts oder einer Teilnichtigkeit eines erteilten Patentbesitzes sind die geänderten Ansprüche, zur Vermeidung einer unzulässigen Erweiterung, sowohl in den ursprünglich eingereichten Anmeldungsunterlagen als auch im erteilten Patent zu berücksichtigen. Als Hauptkriterium für die Feststellung einer unzulässigen Erweiterung gilt der Neuheitstest, also die Frage, ob der Durchschnittsfachmann unter Heranziehung seines allgemeinen Fachwissens die Erweiterung unmittelbar und eindeutig aus der ursprünglich eingereichten Patentanmeldung herleiten kann. Das massgebliche Beurteilungsdatum für den Durchschnittsfachmann ist das jeweils frühere Datum von Prioritätsdatum oder Einreichungsdatum der Patentanmeldung.

Die Korrektur von unzulässigen Erweiterungen kann über einen Teilverzicht eines erteilten Patentbesitzes erfolgen. Dies ist möglich via entsprechenden Antrag beim Institut für Geistiges Eigentum (Schweizer Patentamt), im Rahmen eines Einspruchsverfahrens oder einer Entscheidung der Teilnichtigkeit des Schweizer Bundespatentgerichts.

Die Schweizer Gruppe befürwortet eine Harmonisierung der Definition des Begriffs «unzulässige Erweiterung» und schlägt vor, dafür die in den Richtlinien für die Prüfung im Europäischen Patentamt, Kapitel H IV, 2.1, letzter Paragraph (November 2015) aufgeführte Definition zu verwenden.

Schliesslich ist die Schweizer Gruppe der Meinung, dass es im Interesse der Rechtssicherheit für Dritte nicht zulässig sein sollte, in erteilten Patentbesitzes neue Ansprüche, obwohl durch die ursprünglich eingereichte Anmeldung gestützt, aufzustellen.

Résumé

La loi fédérale sur les brevets d'invention permet des modifications de la description, des dessins et des revendications. Pour un brevet d'invention délivré, seules les revendications peuvent être modifiées. La norme pour déterminer si les modifications de la description, des dessins et des revendications sont autorisées, est définie dans la loi fédérale sur les brevets d'invention. Les critères sont essentiellement les mêmes pour les demandes de brevets et les brevets délivrés, lesquels sont basés sur le principe général que l'objet des demandes de brevets ou des brevets délivrés ne peut s'étendre au-delà du contenu de la demande telle qu'elle a été déposée. Toute modification qui étend le contenu de la demande au-delà de la demande telle que déposée est considérée comme extension d'objet non autorisée. De plus, dans les cas de renoncements partiels ou de nullité partielle d'un brevet délivré, une modification de revendication, afin d'éviter l'extension d'objet non autorisée, doit être comprise aussi bien dans les documents techniques de la demande de brevet telle que déposée que dans le fascicule du brevet tel que publié. Le critère principal pour l'évaluation de l'extension de l'objet non autorisée réside dans l'identité de l'enseignement technique à la lumière des connaissances générales de l'homme du métier (test de nouveauté). La date à prendre en considération pour les connaissances générales de l'homme du métier est la date la plus antérieure entre celle de dépôt de la demande et celle de la priorité de la demande.

Une correction de l'extension de l'objet non autorisée est possible suite à une demande de renoncement partiel du brevet délivré, laquelle peut être effectuée soit auprès de l'Institut Fédéral de la Propriété Intellectuelle Suisse, pendant une procédure d'opposition ou par décision de validité partielle par le Tribunal fédéral des brevets.

Le groupe suisse est favorable à une harmonisation de l'extension de l'objet non autorisée et propose ainsi qu'une définition appropriée de l'extension de l'objet non autorisée soit basée sur les directives relatives à l'examen pratiqué à l'OEB, chapitre H IV 2.1 dernier paragraphe (édition novembre 2015). Également, le groupe suisse suggère pour les brevets délivrés que l'addition de nouvelles revendications, bien que découlant directement et sans ambiguïtés de la demande de brevet telle que déposée, soit interdite dans l'intérêt de garantir une sécurité juridique aux tiers.