

Amendment v Correction

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Introduction

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Content

Differences between amendment and correction

UK & EP:

- When can we amend patent/patent application
- Requirements for amendment
- When can we correct an error in a patent/patent application

EP (only):

- Central limitation for a granted patent

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Distinct Legal Meaning

Correction

- Alteration to better express the intention the drafter had **at the time of drafting**
- Takes effect ***ex tunc*** (always in that state)
- UK S117 & 117A, R 49 & 105 - EP R139

Amendment

- Alteration sought because
 - the drafter has become aware of new facts or
 - the circumstances have changed
- Takes effect **when filed**
- UK S19, 27, 75 & 76, R 31, 35 & 75 - EP Art 123, R137 & 138

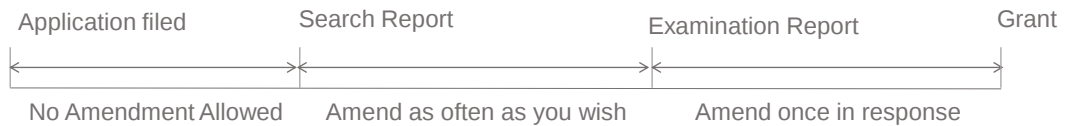
Amendment

Procedural considerations

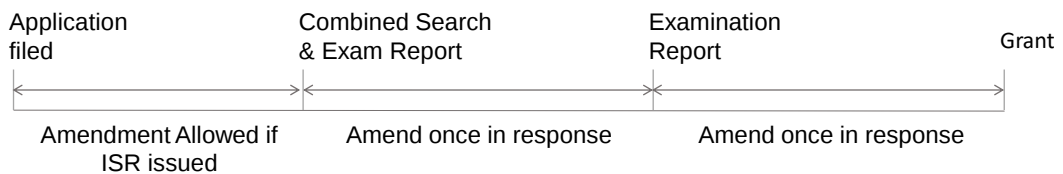


When can amendments be filed on a UK application?

UK direct application

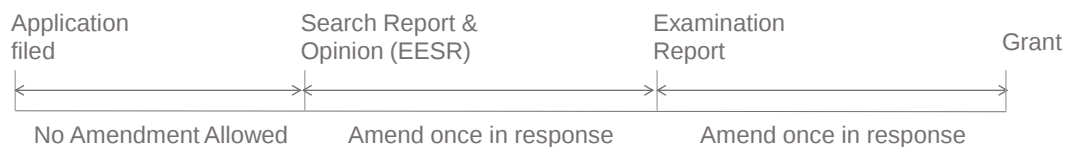


UK national phase application

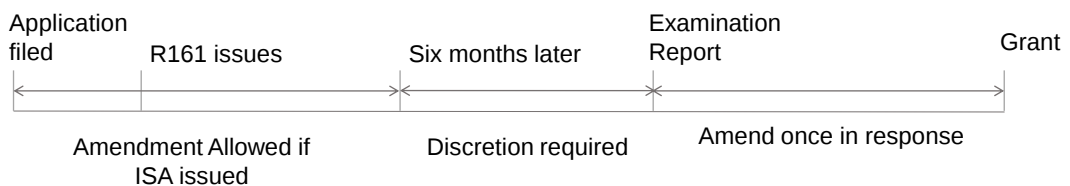


When can amendments be filed on an EP application?

EP direct application



EP regional phase application (EP=ISA)





Why amend?

- Deal with objections raised by UK/EP examiners
- Voluntary amendments (NB consent may be required)

Types of claim amendments?

- Replacement or removal of a feature
- Inclusion of additional features
- Add disclaimer
- Delete part of claimed subject matter, e.g.
 - Original claim: "a polymer blend XY ... containing, as a filter, graphite, talc, asbestos or silica"
 - Prior art: : "a polymer blend XY ... containing asbestos"
 - Amended claim: : "a polymer blend XY ... containing, as a filter, graphite, talc, or silica"

Amendment

Formal requirements



Possible structure for response

- Consider using headings
- Identify amendment & basis
- Novelty
- Inventive step
- Any other issues, e.g.
 - Clarity
 - Unity
 - Insufficiency
- Standard wording
 - Request for oral proceedings

Why do we request oral proceedings?

Why do we need to identify the basis for amendments?



Basis - EPC

Rule 137(4)

- The applicant shall **identify the amendments** and
- **indicate the basis** for them in the application as filed.

If the Examining Division notes a failure to meet either requirement, it may request **correction** of this deficiency **within a period of one month**.

Good practice to do this for UK too.



Unsearched subject matter - EPC

Claims may **not** relate to unsearched subject-matter

Unless can successfully argue that

- it **combines with** the **originally claimed invention** or group of inventions
- to form a **single general inventive concept**

Applies to:

- Claims not searched in a search report – why might claims not be searched?
- Rule 62a: Multiple independent claims – invited to indicate which claim to search
- Rule 63: No meaningful search possible – invited to file statement of matter to search
- Rule 64: Lack of unity – invited to pay additional fees



Auxiliary Requests - EPC

Parties may submit a main request followed by one or more auxiliary requests

- If main request is allowable, auxiliary requests are ignored.
- If main request is not allowable, auxiliary requests are considered in sequence chosen by requester.
- If an auxiliary request is allowable, all subsequent requests are ignored.

Requests should normally represent a convergent development, i.e. sequential limitations in direction of an intended invention (T127/04)

Not typically allowed under UK practice unless examiner thinks that they will accelerate prosecution – see MOPP



Other specific issues - EPC

Single claim in each category UNLESS

- Plurality of interrelated products
- Different uses of product or apparatus
- Alternative solutions to a particular problem, where it is inappropriate to cover in a single claim

Two-part format (R43(1) & F IV 2.2)

Reference numbers (R43(7))

Amend description

- Identify prior art (R41(2)b)
- In line with claim amendments



Amendment of Description – H V 2.7 (NEW)

Description must be brought into line with amended claims

Must meet requirements of

- FII 4.2 – May need to amend “field of invention” and “summary of invention” – e.g. the invention is set out in the appended claims
- FIV 4.3 – May need to remove inconsistencies between description and claims
 - Embodiments which are no longer covered by independent claims to be deleted
 - Unless reasonably considered useful for highlighting specific aspects of claims
 - If not deleted, must be marked as “not covered by claimed invention”
 - Not sufficient to change “invention” to “disclosure”, “embodiment” to “example”, “aspect”
 - Features required by the independent claims may not be described using wording such as “preferably”, “may” or “optionally”.
- FIV 4.4 – Delete claim like clauses & “spirit of the invention” wording



Other specific issues - UK

Compliance period is later of:

- 4.5 years from priority
- 1 year from first examination report

Divisional application must

- be filed no later than 3 months before end of compliance period AND
- be in order for acceptance within compliance period for parent!

Notification of intention to grant

- Clear time frame to file divisional application – but note deadlines above

Amendment

Substantive requirements



Amendment must NOT add subject matter

UK – Section 76

No amendment of an application for a patent shall be allowed ... if it results in the application disclosing **matter extending beyond that disclosed in the application as filed**.

EP – Art 123

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



Underlying principles

UK & EPC

- An amendment should be directly and unambiguously derivable from application as filed

UK

- A skilled man should not, upon looking at the amended specification learn anything about the invention which he could not learn from the unamended specification (UK - *Richardson-Vicks Inc.'s Patent* [1995] RPC 568)

EP

- Third parties should be able to rely on the original application to determine the likely scope of protection (G 1/93).
- Can take in account matter which is implicit to person skilled in the art (G2/10)



What is not part of the application as filed?

- Abstract
- Priority document
- Parent application for a divisional application
- Anything filed after the date of filing, e.g.
 - Claims
 - Sequence listings
 - Missing parts/drawings
- Features described in a cross-referenced document unless certain conditions met



Essentiality test – H V 3.1

Replacement or removal of a feature from a claim allowed, if

- Feature was not explained as **essential** in the disclosure and

the skilled person would **directly and unambiguously** recognise that

- the feature is not, as such, **indispensable** for the function of the invention in the light of the technical problem the invention serves to solve
- the replacement or removal requires **no modification** of other features to compensate for the change (it does not in itself alter the invention)



Inclusion of additional features – H V 3.2

Inclusion of features into claim (e.g. from other claim, description, drawings) allowed, if

- Resulting combination is **directly and unambiguously** disclosed in the application in an **explicit** or **implicit** manner

It is not sufficient that the combination is

- Not inconsistent with the description
- Reasonably plausible
- Obvious in view of the application



Test for intermediate generalisation – H V 3.2.1

When a feature is taken from a particular embodiment and added to the claim, it has to be established that:

- the feature is not related or **inextricably linked** to the other features of that embodiment, and
- the overall disclosure **justifies the generalising isolation** of the feature and its introduction into the claim
- For all types of amendment (removal, replacement etc), need to consider combination of amended main claim together with dependent claims (new section H V 3.3)



Examples – H V 3.2.1

Claim - a heddle for the harness of a loom

- Specific embodiment has
 - two inventive features and
 - an eyelet having the shape of a spindle.

Can you introduce the two inventive features without the specific shape into the claim?

Is the situation different if the general part of the description mentions that the eyelet may have different shapes such as an elliptic shape?



Discretion to admit amendments – H II 2.3

If amendments remedy a deficiency without giving rise to new one – they will be admitted

Examples – are these amendments likely to be admitted?

- Amendments to address an objection under Art 83 that the entire specification does not disclose how to carry out the invention.
No – likely to add matter
- An amended set of claims retaining a certain feature which the Examiner has previously considered adds subject matter.
Unlikely unless can argue Art 123 satisfied
- An amended set of claims without a certain feature which the Examiner has previously considered is essential.
Unlikely unless can argue feature not essential



Practicalities

- Can be difficult to remove features from claims
- Claim amendments may need to use exact wording from application as filed but even this may not be enough!
- When receiving instructions from overseas note:
 - Amendment rules may be more relaxed, e.g. US.
 - Basis provided may not be sufficient
- Beware Examiner's amendments

Amendment

Post Grant



Amendment must also NOT extend protection

UK – Section 76

No amendment of an application for a patent shall be allowed ... if it results in the application disclosing **matter extending beyond that disclosed in the application as filed.**

EP – Art 123

(2) The EP application or EP patent may not be amended in such a way that it contains subject matter which **extends beyond** the content of the **application as filed.**

(3) The **EP patent** may not be amended in such a way as to **extend the protection** it confers



Trap - Example

The patent describes a system and method for incorporating promotions within recorded programs

Granted claim 1 is:

Highlighted feature adds subject matter

Can it be deleted?

1. A method for providing promotions within recorded programs comprising:

receiving (210) a selected program to record at a user input device;

using a processor to determine whether the selected program is to be recorded;

in response to determining whether the selected program is to be recorded, the processor:

selects (320) a promotion to record for inclusion with the selected program; and causes (330) the program and the promotion to be recorded such that the promotion is presented when a user plays the recorded program.



Possible escape routes

Replacement by a feature:

- which has basis in the application as filed **and**
- which does not extend the protection conferred by the patent as granted

Retention only if:

- The feature does not provide a **technical** contribution to the subject-matter of the claimed invention



Central Limitation

Proprietor may request that their EP patent is:

- Revoked OR
- Limited by amendment

Takes effect across all contracting states

If opposition filed:

- central limitation cannot be requested
- any previously filed central limitation proceeding is terminated



Central Limitation - Procedure

Formal requirements reviewed

Substantive examination ONLY to check

- It is indeed a limitation
- No clarity objections
- Any added subject matter – both Art 123(2) and (3)
- *Prima facie* meets patentability requirements

No examination of

- Reasons for limitation request
- Novelty and inventive step



Central Limitation - Outcomes

- allowed
 - for revocation with *ab initio* effect (i.e. effective from date of grant)
 - for limitation from date of republication (i.e. need to pay grant and printing fees)
- objections raised – normally only one opportunity to respond
- rejected

Examples

A granted claim directed to a generic plant is limited to a specific plant variety. Allowed?

NO - excluded from patentability under Art. 53(b)

A claim granted to a device comprising a controlled explosion system is limited to a claim reciting an anti-personnel mine comprising the controlled explosion system

NO - contrary to Art. 53(a).



Post grant amendment in UK

Section 27 – general power to amend

- on application from proprietor
- third party can object
- if allowed, amendment deemed to have effect from grant date

Section 75 – amendment in infringement or revocation

- as above
- allowance of amendments is a matter of discretion and similar consideration to s.27 apply

—
Correction
—



Correction of any document possible

UK

- Error of translation
- Error of transcription
- Mistake
- Clerical error

EP

- Linguistic errors
- Errors of transcription
- Mistake



Test for allowability

UK

- Is it clear that there is an error AND
- If so, is it clear what is now offered is what was originally intended

EP

- Must be immediately evident that an error has occurred
- Must be immediately evident what the correction should be



Can we correct the following?

UK

- Incorrect prior art publication number if number relates to completely different subject matter
- Incorrect physical parameter

EP

- Replace “respectfully” with “respectively” in a claim
- Add “s” to the word particle as the corresponding verb “have” was in the plural form
- Replace “included” by “excluded” based on a mere count of the number of instances of the relevant words

All yes – except last one



Correction of error in withdrawal

UK

- Possible to correct an error or mistake in a withdrawal of a patent application

But if application successively resuscitated third party rights to continue an infringing act may arise if

- they began **in good faith** to do the infringing act or
- they made **in good faith serious and effective preparations** to do so



Correction in granted EP patent

During opposition proceedings - allowed

- If occasioned by a ground for opposition
- When claims otherwise amended during the opposition
- But not if merely an attempt to circumvent the restrictions to correcting the approved text

During limitation proceedings - allowed

- if it is a limitation
- if it is clear (Art 84) and
- if it meets Article 123
- But clarifying amendment to dependent claims only allowed if necessitated by another amendment

Need to check text attached to 71(3) carefully because these provisions are narrow

Questions?

Amendment and Correction

Julia Gwilt