

Amendment & Correction of Patent Applications and Patents



Lecture to CIPA Informals

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March 2022

Thank you to Julia Gwilt for 2021 lecture and slides



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Agenda

- Difference between amendment and correction
- UK & EPO
 - Why?
 - When?
 - Limitations
- EPO/UPC
 - Central limitation after grant
- Correction



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Legally distinct

- A correction is an alteration to better express the intention of the drafter at the time of drafting.
 - Takes effect *ex tunc* (as if it had always been so)
 - UKPA s117 & 117A, R49 & 105
 - EPO R139
- An amendment is a change requested because
 - New facts have come to light (e.g. prior art) or the circumstances have changed.
 - Takes effect *ex nunc* (when filed) for an application but *ex tunc* for a UK patent
 - UKPA s19, 27, 75 & 76, R31, 35 & 75
 - EP art 123, R137 & 138



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Amendment

Why, when, how?



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Why amend

- Objections raised by examiner
 - Formal objections (e.g. drawings requirements)
 - Substantive objections - always ask the question “can I argue the case or must I amend?”
- Voluntary amendments
 - To account for prior art that has not (or not yet) come to the examiner’s attention
 - To streamline prosecution towards early grant
 - To read a claim more closely onto a particular competitor product
 - To save money (fees, time)



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When can an applicant amend?

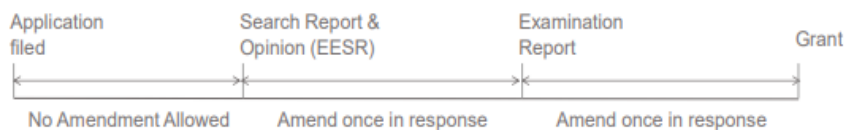
- UK
 - Not before the search report has issued
 - (but that does not stop you from filing a putative set of claims to direct the search)
 - As often as you wish between search and the first examination report
 - Once in response to the examination report - R31(4)
 - In the case of combined search & examination, your opportunities are usually the same - R31(b)(ii),
 - Thereafter, only at the examiner’s discretion R31(5)
 - UK Examiner’s discretion is quite widely granted
- Similar for UK national phase of PCT



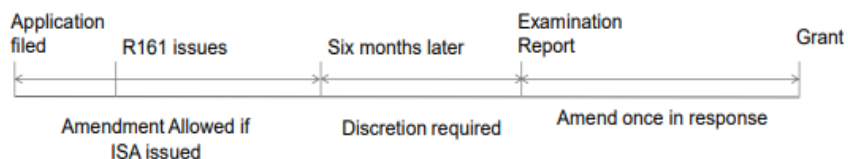
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When can an EP application be amended?

EP direct application



EP regional phase application (EP=ISA)



EPO Examiner discretion thereafter is subject to rules of practice
– more on this later



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How - Types of amendment

- Limiting amendments
 - Distinguish subject matter claimed from prior art
 - Inclusion of additional features
 - From dependent claims
 - From description
 - From drawings
 - Disclaimer
 - Deletion of alternatives from a list
- Broadening amendments
 - Removing a feature from a claim
 - Replacing one feature with a different feature



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How – procedure - EP R137(4)

- “The applicant shall identify the amendments”
 - E.g. file a replacement set of claims together with a set of marked-up claims
 - Don’t file endless unamended pages – only file the pages that you are amending
- “and indicate the basis for the amendments in the application as filed”
 - If you do not, you may get an office action and 1 month to do so
 - Good practice for UK too



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Substantive issues



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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.
- EPC Art 123(2)
 - ... In such a way that it contains matter which extends beyond the content of the application as filed.
- Underlying principal is that the applicant cannot improve his/her position *vis-à-vis* public reading the patent application as filed and published (G 1/93).



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Protoned's application

1983 FSR p110

- Deletion of the word “compression” in relation to a spring was a notional addition to the body of the specification of all other types of spring and therefore prohibited by section 76 as extending the disclosure.



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“Gold standard” established by the EPO Boards of Appeal

- An amendment is . . . 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 & Guideline H-IV, 2.1).
- Same standard as for novelty G-VI, 2



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Very strict standard

- For example, you cannot remove a feature from a claim if the features was presented as essential to the invention
 - The claims as filed are deemed to be a statement of all the essential elements of the invention;
 - Therefore removing a feature is deemed to present, to the skilled reader, for the first time, the new information that the feature is non-essential or optional.
 - You need some other statement of invention or embodiment that does not have that feature or some mention that the feature is optional
- Three part “*Houdaille* test” of Guideline H V 3.1 rarely helpful



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Very strict standard

- Not enough that a resulting combination of features is
 - not inconsistent with the description or
 - reasonably plausible or
 - obvious in view of the application
 - Guideline H V 3.2



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Exceptions to prohibition under Art 123(2)

- Prior art citations can be added and discussed – these are not “subject matter”
 - Adding advantages with reference to prior art depends on circumstances of the case
- Reformulating the technical problem
 - Provided the problem and solution could have been deduced from the application as a whole
- Disclaimer to
 - (i) Art 54(3) prior art or (ii) “accidental anticipation” or (iii) non-technical subject matter - G1/03



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Intermediate generalization not permitted

- An example of an “intermediate generalization” is:
 - Claim 1 calls for elements A + B
 - Claim 2 calls for elements A + B + C + D
 - Amendment is sought to features A + B + C
- Under what circumstances is it permitted to separate elements C and D?
 - What does the specification say about the relationship between C and D?
- Or a claim calls for “P, Q, R, S or T” and you want to delete T from the group.



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Test for intermediate generalization

Guideline H V 3.2.1

- When a feature is taken from a particular embodiment and added to a 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.
- More examples in Guideline H-V, 3.3 where one element is to be deleted from a group.
 - Is what remains still a generic group, or merely a set of species?



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Intermediate generalization example

- Original claim 1 related to a **coating composition comprising**
 - at least one rosin compound, at least one polymer and an antifoulant.
- Amended claim related to a **method for preparing a coating composition** comprising the **mixing of**
 - at least one rosin compound, at least one polymer and an antifoulant.
- The only basis for the **method** was certain specific examples with specific quantities. The claim was an unallowable generalisation of the examples.
 - Guideline H-V, 3.2.1, example 3



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What is not part of the application as filed?

- Abstract
- Priority document
- Patent application (for a divisional application)
- Anything filed after the date of filing claims
- Sequence listing
- Missing parts/drawings
- Features contained in a cross-referenced document unless certain very specific conditions are met



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Further EPO rules on amendments

- Cannot amend to unsearched subject matter
 - Rule 62a – multiple independent claims – invited to indicate which claims to search
 - Rule 63 – No meaningful search possible invited to file statement of matter to search
 - Rule 64 - Invited to pay additional fees
- May be able to argue
 - that the subject matter combines with the originally searched invention or group of inventions to form a single general inventive concept or
 - that it should have been searched (B-III, 3.5)
- Cannot amend to a different invention once examination has begun C-III, 3.4



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Discretion to amend at the EPO

- EPO seeks to bring examination to closure in as few actions as possible.
 - Take into account the circumstances of each individual case and the stage of the proceedings which the application has reached to date
 - Has the applicant squandered opportunities?
 - Is there progress forward to something that may be allowable, or does the examiner think it is a hopeless case?
 - Each amendment should normally converge in a consistent direction (T127/04)
 - Auxiliary requests are a way to present several “rounds” of amendment in parallel.



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Other specific EPO issues

- Single independent claim in each category (product/process) unless one of the exceptions of Rule 43 applies.
- Two-part form R43(1) & F-IV 2.2
- Reference numerals R43(7)
- Indentation of prior art in description – R41(2)b
- Consistency between claims and description – new Guidelines March 2022 F-IV, 4.3; F-IV, 4.4



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Other specific UK issues

- Compliance period is later of
 - 4.5 years from priority
 - 1 year from first examination report
 - Do not waste a moment if the compliance period is imminent.
- UKIPO is also adopting a practice akin to EPO Rule 43(2) in that *“the requirement that the claims shall be concise refers to the claims in their entirety as well as to the individual claims”*. Manual of Patent Practice sections 14.140 & 14.159



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Amendment after Grant



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Amendment of a granted patent must not extend protection

- Patents Act s 76
- EPC Article 123(3)
- “Trap” between s75 & s76 or between Art 123(2) and 123(3)
 - A limiting amendment was made before grant and was allowed, although it should not have been, because it added subject matter
 - It cannot now be removed, as to do so would extend protection
 - The patent must be revoked and cannot be saved.



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Example *Conversant v Huawei Ltd*

[2019] EWHC 1687 (Pat)

- European patent for 3G mobile phone technology invalid on the ground of added matter.
 - Had the patent been valid, it would have been essential to the 3G UMTS standard and would have been infringed.
- The feature “*checking to determine whether the medium access control entity (MAC) is transmitting data packets in a current air interface transmission time interval (TTI)*”, had been added to the claim during prosecution but lacked support.



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Example *Conversant v Huawei Ltd*

[2019] EWHC 1687 (Pat)

- Conversant sought to amend:
 - *checking to determine whether the MAC entity is transmitting data packets in a current air interface transmission time interval, by checking whether the MAC entity is able to empty the radio link control buffer in the current air interface TTI.*
- Arnold J said the starting point was that there was **no explicit disclosure** in the application of
 - *a check to determine whether the MAC is transmitting* in the current TTI.
 - It therefore followed that there was no explicit disclosure of doing so **by checking** whether the MAC is able to empty the RLC buffer.



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Post grant amendment in UK

- Section 27 – general discretion “Comptroller may allow” amendment, on application from proprietor
 - Reasons must be given MPE 27.07
- Third party can object – section 75(2)
 - Rule 76 - any person may oppose . . . amendment under section 75(2)
 - **Two weeks** after publication R76(2)(a)
- If allowed, amendment deemed to have effect from grant date s75(3)



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Central limitation of a European patent

- Articles 105a & 105b EPC
- At request of proprietor, patent may be revoked or limited by amendment **of the claims**
- No discretion
 - No reason need to be given
 - If the examiner decides the [very basic] requirements of Rule 92 are met, the request shall be admitted
 - Amendment applies to all designated states
- Cannot request revocation or amendment if opposition proceedings are pending
 - Limitation proceedings terminated if oppo is filed



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Examination of Central limitation of a European patent

- Examined (R95) for
 - Art. 84 - clear, concise and supported)
 - Art. 123(2) – no added matter
 - Art. 123(3) – no broadening of claim
- Limitation of a dependent claim only is permissible, but
 - No non-limiting amendments that are not a consequence of the limitation of the claims
 - No “tidying up”
 - No adding of dependent not directly caused by the limitation.



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Amendment before the UPC

- Defence to counterclaim for revocation – Rules 30 & 32
 - Only 2 months from defendant’s counterclaim for revocation
- Defence to service of statement for revocation – Rule 51
 - Only 2 months for proprietor-defendant to file any amendment



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Corrections



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Correction of any document is possible

- UKPA s117(1)
 - Error of translation, error of transcription, mistake, clerical error
 - BUT if the request is to correct a specification, it must be clear that there is an error and that the correction offered was originally intended – Rule 105(3) and CIPA Guide 117.05
- Same before the EPO
 - Rule 139



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Correction of specification

- Not generally possible to make a correction that would not have been permitted as an amendment (G3/89)
 - But when correcting an error, it is possible (indeed often necessary) to adduce evidence as to what a skilled person would have understood the specification to mean
 - E.g. evidence from the priority document – J4/85



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Correction of other documents

- Incorrect priority declaration
 - If the correction means a different priority date, it is important that the request is filed early.
 - Easier to correct if the public are on notice that a request for correction is filed in time for publication
- Incorrect applicant or inventor
- Errors in documents but not procedural errors
 - CIPA Guide § 117.07
- Correction of an error in withdrawal is a special case R117A



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Correction of UK patent after grant

- Published in Journal
- 4 week period for opposition R76(2)(b)



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