

Amendment v Correction

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Amendment v Correction

- Start with a story (case law example)

Amendments

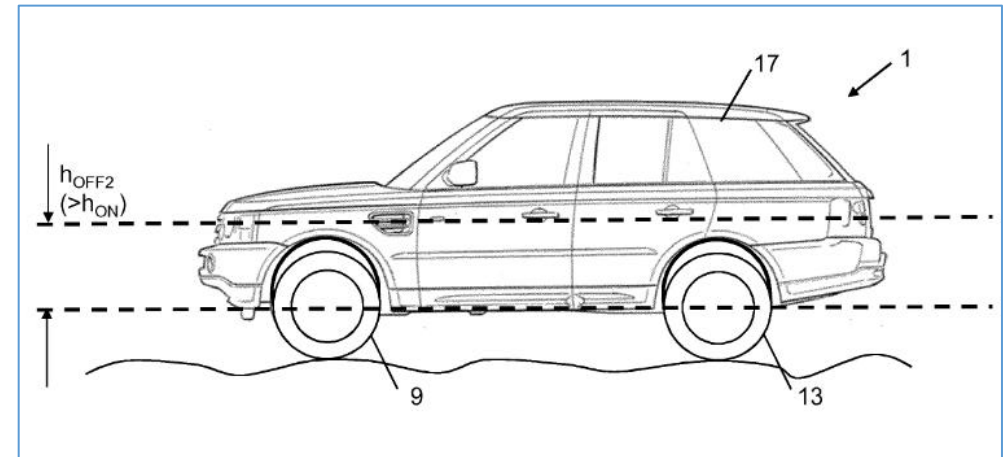
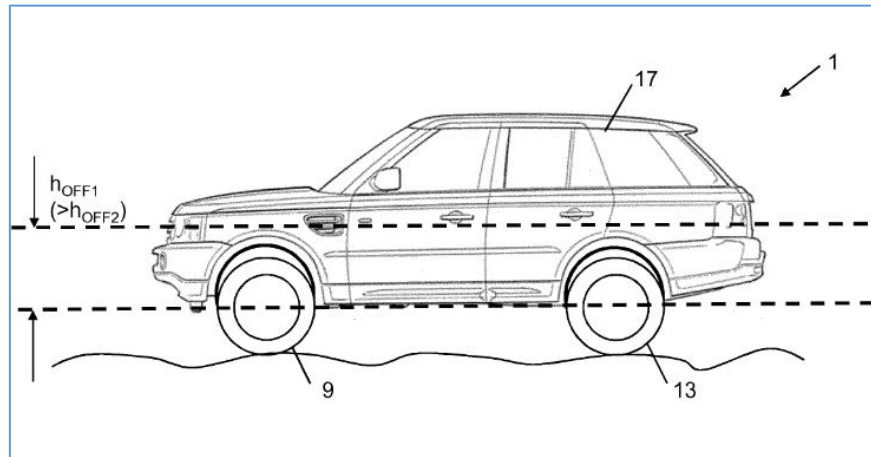
- Back to basics
- Deeper dive
- Post grant

Correction

Summary



Case Law Example - Adapted from T 0992/23



First target off-road ride height h_{OFF1} (75mm) is greater than
a second target off-road ride height h_{OFF2} (50mm)



Case Law Example - Adapted from T 0992/23

Application as filed contained:

- High level claim 1 to a method of controlling a ride height of a vehicle by selecting a target on-road ride height based on the vehicle speed
- A detailed example of a method for selecting between first and second target ride heights **based on first and second speed thresholds**, wherein there is **hysteresis calibration when defining the first and second speed threshold**

Prior art document EP-A describes a general method which anticipates claim 1

The feature of selecting between first and second target ride heights based on first and second speed threshold is novel and inventive over EP-A

Can we amend claim 1 to include this feature? What is the correct legal test?



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.**



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)



Case Law Example - Adapted from T 0992/23

In this example, the step of selecting between first and second target ride heights based on first and second speed threshold is

explicitly mentioned in the specification BUT

is inextricably linked to the hysteresis calibration

thus the amendment to include this feature is an intermediate generalisation



Case Law Example - Adapted from T 0992/23

Is the situation different if the application was filed with

- A dependent claim 2 which specified:

selecting between first and second target ride heights based on first and second speed threshold

And

- A dependent claim 3 (dependent on claim 2) which specified:

Using a hysteresis calibration when defining the first and second speed threshold

Back to Basics

When Can An Amendment be filed?
What can it be based on?



When do we normally amend?

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

What do we mean by amendment?

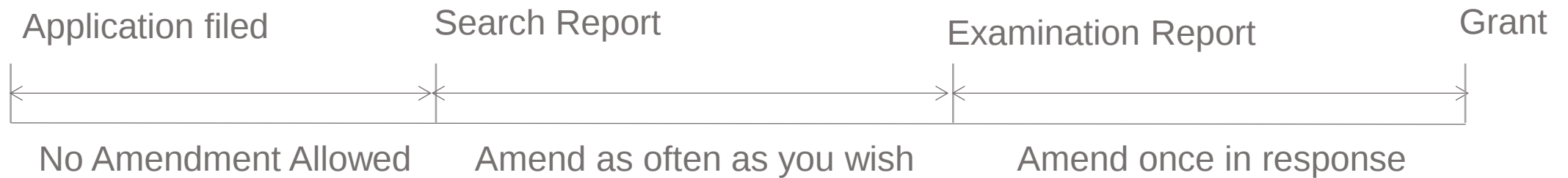
Preparing

- an amended set of claims
- possibly an amended description/drawings
- accompanying letter to patent office to explain amendments
- possibly letter/email to client to explain above

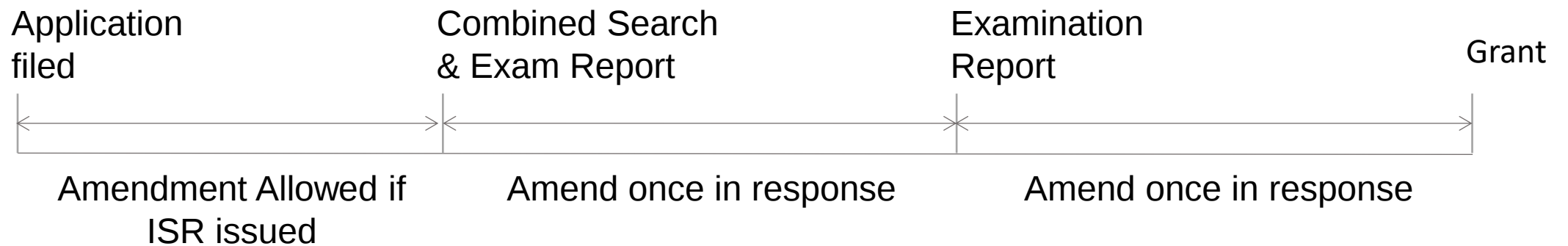


When can amendments be filed on a UK application?

UK direct application



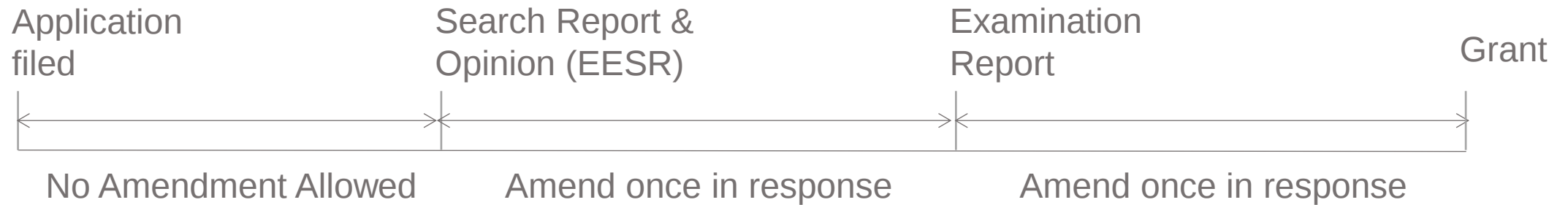
UK national phase application



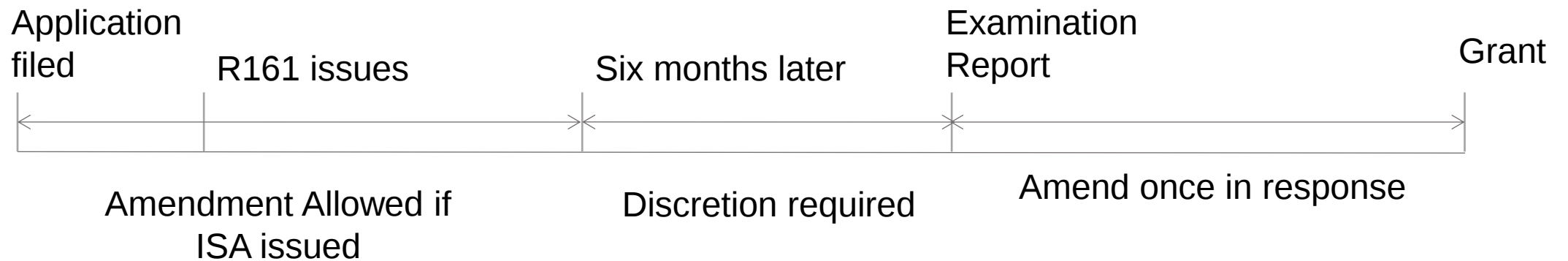


When can amendments be filed on an EP application?

EP direct application



EP regional phase application (EP=ISA)





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

Amendment

Deeper dive



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.



Another test - 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)



Unsearched subject matter – H IV 4

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

Description must be brought into line with amended claims – G1/24 watch this space

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

- while parent is pending
- be filed no later than 3 months before end of compliance period AND
- be in order for acceptance within compliance period for parent!
- Note the new divisional compliance period determination

Notification of intention to grant

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

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



Interplay between Art 123(2) and 123(3) EPC

Going back to the example above – during prosecution we obtain a granted claim specifying

- selecting between first and second target ride heights based on first and second speed threshold
- **without** hysteresis calibration

During opposition, the opponent successfully argues this is an intermediate generalisation

What can we do?



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



Possible escape routes

We cannot delete the feature because this is a technical feature and thus its removal would be an impermissible broadening

BUT

We can limit to the hysteresis calibration to overcome the objection

Not always possible to solve the problem

Have a look at the “comma” case – T1473/19 for another recent example



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 – Different claims for different states

Limitation which results in different claims in different states is allowable WHEN
There is a conflict with national prior rights

Needs to inform EPO of the national prior rights OR
Will be refused

Note that EPO is now searching for national prior rights
These are reported in 71(3) communication

Different claims in different states is not possible for a unitary patent



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



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



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

Priority application –Rule 56 & 56a EPC

Admin Council decision & effective from 1 November 2022

Missing drawings & description can be added without redating the application when

- Completely contained in a priority application AND
- Filed within 2 months of date of filing OR
- Filed within two months of communication notifying of missing parts

Erroneously filed drawings & description can also be replaced when

- Completely contained in a priority application AND
- Same time limits as above

These missing parts/corrections are considered to be part of the application as filed
Only can be done at filing stage not in examination



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



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

Summary



Practical Guides

Europe

- Go through the detail of Section H of the Guidelines which covers
 - Admissibility of amendments
 - Allowability of amendments
 - Correction of errors

UK

- Manual of Patent Practice – sections 19 and 27 (amendment), 117 (error)
- Formalities Manual (see chapters 9 and 12)



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



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 (EP)

Questions?

Amendment and Correction

Julia Gwilt
