

Congress Milan 2016
Adopted Resolution
20 September 2016

Resolution

2016 – Study Question (Patents)

Added matter: the standard for determining adequate support for amendments

Background:

- 1) This Resolution solely concerns the role and effects of impermissible added matter in relation to amendments to patent applications and to patents. It does not concern other possible grounds of rejection or consequences of amendments to patent applications and patents (including the extension of scope of protection of a granted patent as such).
- 2) The primary objective of this Resolution is to define what should be deemed “impermissible added matter.” More specifically, this Resolution addresses the legal restrictions on amendments to the description, claims and drawings of patents and patent applications, and requirements that amendments be supported by the application as filed.
- 3) Recognising that terminology may differ between jurisdictions, for the purposes of this Resolution:
 - a) The term **impermissible added matter** refers to a proposed amendment to a patent application or to a patent that is impermissible because it lacks support (often referred to as “basis”) in the application as filed;
 - b) The term **specification** includes the description, drawings (if any), sequence listings (if any) and claims;
 - c) The term **amendment** refers to any amendment of, deletion from or addition to a patent application specification, or to a patent specification;

- d) In jurisdictions where the filing date of a continuation application or divisional application is considered to be the date on which such application is submitted, the application filing date shall be deemed to be the filing date of the earliest parent application from which a continuation application or divisional application was filed.
- 4) If not limited, amendments could involve the introduction of impermissible added matter. A rationale for limiting amendments, by prohibiting amendments that introduce impermissible added matter, is that legal certainty and the interests of third parties can be balanced against the applicant's or the patentee's right to fair patent protection.
- 5) 45 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General of AIPPI and distilled into a Summary Report. (See below links.)
- 6) Based on the individual Reports as summarised in the Summary Report, it appears that at present the law regarding impermissible added matter is not uniform. In particular, there are variations between the laws reported by Groups regarding, amongst other things:
 - a) the definition of impermissible added matter;
 - b) the rules used to interpret the application as filed, whether and to what extent the common general knowledge of the notional skilled person should be taken into account, and whether and to what extent implicit disclosures in the application as filed should be taken into account;
 - c) whether the addition of claims to a patent application or to a patent is prohibited *per se*;
 - d) whether and under what conditions it is permissible to extend the scope of protection of a patent or patent application, based on added matter.
- 7) Paragraphs 5 and 6 of this Resolution concern, *inter alia*, what are known in some jurisdictions as "intermediate generalisations."
- 8) A large majority of Groups supported harmonisation of the definition of impermissible added matter for all patents and patent applications.
- 9) At the AIPPI World Congress in Milan in September 2016, the subject matter of this Resolution was further discussed within a Study Committee and again in a

full Plenary Session, which led to the adoption of the present Resolution by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) ***Impermissible added matter*** should be defined as matter extending beyond the content of a patent application as filed.
- 2) The content of the application as filed should be interpreted:
 - a) to include what is explicitly disclosed in the application as filed; and
 - b) to include what is implicit or inherent in the application as filed to a person skilled in the art, using their common general knowledge as at the filing date.
- 3) Amendments proposed by the applicant or by the patentee need not be found word-for-word in the application as filed.
- 4) The addition of a claim not present in the application as filed should not, *per se*, be considered as introducing impermissible added matter.
- 5) The addition to a claim of a subset of features disclosed in an embodiment in the application as filed does not introduce impermissible added matter if the resulting combination of features would be understood by the skilled person to be an embodiment of the invention as disclosed in the application as filed.
- 6) The deletion of a feature from a claim does not introduce impermissible added matter if the resulting claim would be understood by the skilled person to be an embodiment of the invention as disclosed in the application as filed, notwithstanding that the resulting claim may only include a subset of features disclosed as an embodiment.
- 7) The correction of clerical errors or obvious mistakes should not be considered as introducing impermissible added matter.
- 8) National and regional legislation should include a definition of impermissible added matter consistent with paragraphs 1) to 7) above.
- 9) An amendment of a patent application or a granted patent should not be acceptable to a Patent Office or Court, if it introduces impermissible added matter.

Links:

- Study Guidelines
<http://aiippi.org/wp-content/uploads/2015/12/2016-Study-Guidelines-Added-Matter.pdf>
- Summary Report
http://aiippi.org/wp-content/uploads/2016/08/2016_Summary-Report_Patents_FINAL_0908161.pdf
- Group Reports of National and Regional Groups and Independent Members
<http://aiippi.org/committee/added-matter/>