

Resolution



Question Q189

Amendment of patent claims after grant (in court and administrative proceedings, including re-examination proceedings requested by third parties)

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Q189

AIPPI

Noting:

- a) that one of the crucial aspects of patent law is the determination of the scope of protection which is mainly determined by the terms of the claims;
- b) that typically, the wish to amend claims arises when prior art appears which may be held against those claims;
- c) that the amendment of claims has to balance different interests: on the one hand the patent proprietor should be awarded for his invention in an appropriate manner; on the other hand, third parties are entitled to legal certainty;
- d) that in many countries claims may be amended during prosecution, i.e. before grant of the patent, but the situation is more diverse in respect of amendments after grant;
- e) that new developments are under way with regard to post-grant amendments in various jurisdictions, including amendments of the European Patent Convention and the patent statutes of the United States;
- f) that the right of the proprietor to restrict a patent claim to its valid content, where it would otherwise not meet the patentability criteria, was asserted in Resolution Q142 (Rio de Janeiro 1998);

Resolves that:

- 1) Amendment of patent claims after grant should be possible for the patent proprietor;
- 2) Patent claim amendment after grant must not extend the scope of protection of the claims as granted;
- 3) Patent claim amendment after grant must always have support in the original specification, drawings or claims, and in particular there should be no possibility of adding new subject matter;
- 4) Possible ways of amending claims after grant should include, but should not necessarily be limited to, deletion of one or more claims, or combination of the features of two or more claims;
- 5) It should be possible to amend patent claims after grant by introducing any subject matter from the specification, claims or drawings into the claims, provided this does not extend the original scope of protection of the claims as granted;
- 6) It should be possible for the patent proprietor to amend by correcting obvious errors in the granted claims;

- 7) Notwithstanding the above, it should be possible for the patent proprietor to correct any printing errors made by the authorities in the granted claims.
- 8) Only the patent proprietor should have the right to make amendments to claims after grant;
- 9) However, third parties should be able to challenge the validity of granted patents, in respect of individual claims or in respect of the patent as a whole;
- 10) Patent claim amendment after grant should have effect *erga omnes* (i.e. in relation to everyone);
- 11) Patent claim amendment after grant should be effective *ex tunc* from the effective date of the claims as granted; conduct of third parties prior to the amendment should not be held to be infringing unless a valid claim covering the alleged infringing activity was present in both the original and the amended patent;
- 12) Patent claims amended after grant should fulfil the patentability criteria of the relevant patent law;
- 13) There should be an administrative route available for patent claim amendment after grant by the patent proprietor;
- 14) Parallel judicial and administrative proceedings related to amendment of the claims should be avoided;
- 15) The patent authority should publish the amendment of claims after grant and the publication should reveal the differences between the original and the amended claims.
- 16) In general, the same criteria should apply for amendment of the claims of utility models after registration, where applicable, as for the amendment of patent claims after grant.