

Summary Report



Report Q189

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

The intention with Q189 was to study the legal and procedural framework available for amendment of patent claims after grant, and to explore the possibilities of harmonisation in this field.

It was intended to limit the study to amendments of patent claims made after the conclusion of all formalities relating to the grant, including opposition procedures (where applicable). However, some Groups have made some reference to the opposition systems available in their jurisdictions.

Claim amendment may take many forms, including surrender or revocation of one or more claims, combination of technical features of two or more claims, or minor or complete rewriting of claims, in some cases by adding features from the text of the description. All of these forms are comprised by Q189, and it is clear from the Group Reports that there is a great variety between the extent to which patent proprietors or third parties have access to amending, or provoking amendment, in different countries.

Many of the Reports have provided not only responses to the specific questions but also useful discussion of matters of principle or policy.

The Reporter General has received 42 Reports from the following countries (in alphabetical order): Arab Regional Group, Argentina, Australia, Belgium, Bolivia, Brazil, Bulgaria, Chile, China, Czech Republic, Denmark, Ecuador, Estonia, Finland, France, Germany, Greece, Hungary, Indonesia, Italy, Japan, Latvia, Luxembourg, Malaysia, Mexico, the Netherlands, Panama, Paraguay, Peru, the Philippines, Poland, Portugal, Republic of Korea, Romania, Singapore, South Africa, Spain, Sweden, Switzerland, the United Kingdom, the United States and Venezuela.

1) Analysis of current legislation and case law

- 1) *Does your national law permit post-grant amendment of patent claims? Are utility models – if available – treated the same way as patents or differently? If so, what are the differences?*

Only the Greek Group reports that post-grant amendment of patent claims is not possible at all in that jurisdiction. All other Groups that respond to this part of the question report that amendment is possible.

With few exceptions (Denmark, Finland, Germany, Japan, Paraguay and Portugal), the Groups from countries that do have utility models report that utility models are regulated in the same manner as patents in respect of post-grant claim amendment.

- 2) *Who is entitled to request post-grant amendment of patent claims under your national law?*

The Reports of the Groups show that the laws of their countries are divided as to whether only the patentee or also third parties (or interested third parties) have access to remedies for amendment of patent claims.

It must be acknowledged that the question may not have been sufficiently clearly stated. Some Groups have understood the question to mean whether third parties can request and propose specific amendments to the claim language itself. Others have understood the question to

mean whether third parties have access to administrative or judicial remedies whereby the validity of the patent or some of its claims may be challenged, which may in turn have the effect that the patentee (or in rare cases the relevant administrative or judicial body of its own motion) is prompted to delete specific claims or amend them into a wording that can be upheld as valid.

With this important proviso in mind, a number of Groups Report that only the patentee can request amendment in their country (Australia, Belgium, Bulgaria, China, Ecuador, Italy, Korea, Luxembourg, Malaysia, Mexico, Peru, Portugal, South Africa, Sweden, the United Kingdom and Venezuela). These issues are explored in greater detail in other sub-questions which add nuance to the responses cited here. The Belgian Group reports that where a patent has several co-owners, each co-owner may request amendment of its claims.

Almost all of the Groups either report or imply that third parties, or at least interested third parties, have access to some remedy against granted patent claims, which in turn may prompt the proprietor of the patent to seek amendment, in order to retain some scope of patent protection through a restriction of the claims.

Some Groups expressly report that in their jurisdiction, third parties may request *partial* revocation by bringing invalidity action in the courts (Argentina, Finland, the Philippines and Spain).

No Groups mention a possibility for third parties of proposing actual amended claim language. Some Groups explicitly report that this is the prerogative of the patent proprietor (Romania and the United States).

3) *What is the procedural framework for requesting post-grant amendment of patent claims under your national law, in particular:*

- *What procedures (judicial, administrative or other) are available for dealing with requests for post-grant amendment of patent claims under your national law?*

A number of countries report that only administrative procedures for post-grant patent amendment exist (Chile, China, Czech Republic, Ecuador, Hungary, Japan, Luxembourg, Mexico, Paraguay, Peru, Portugal and Venezuela).

Argentina, Australia, Belgium, Brazil, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Korea, Latvia, Malaysia, the Netherlands, the Philippines, Romania, South Africa, Spain, Sweden, Switzerland, the United Kingdom and the United States) report that claim amendment may be made either in administrative proceedings or by the courts in revocation and/or nullity actions or otherwise.

The Panama Group alone reports that only judicial measures are available.

- *Are all of these procedures freely available under your national law to those wishing to request post-grant amendment of patent claims, or does the law give priority to certain procedural measures in certain situations?*

In a number of countries, administrative procedures to amend are open to the patent proprietor: Australia, Brazil, Chile, China, Czech Republic, Denmark, Ecuador, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Korea (quasi-judicial body), Latvia, Luxembourg, Malaysia, Mexico, the Netherlands, Paraguay, Peru, the Philippines, Portugal, South Africa, Spain, Sweden, Switzerland, the United Kingdom, the United States and Venezuela.

In some countries, administrative procedures are (also) open to (interested) third parties: Brazil, Chile, Czech Republic, Denmark, Korea (quasi-judicial body), the Philippines, Portugal, Romania, the United States and Venezuela.

In many countries, there are restrictions in the access to those measures, or priority is given to one remedy over another:

- in Australia, administrative measures are not open to patentee during court proceedings;
 - in Brazil, the patent office will not make decision in a case that is pending before the courts;
 - in Bulgaria, revocation action must be opened before any administrative action can be brought;
 - in China, administrative proceedings are only open to the patentee if a third party or the patentee files revocation action first;
 - in Denmark, administrative procedures are only open after expiry of the opposition period and only provided any oppositions have been finally decided – administrative proceedings cannot be opened while court proceedings are pending, and administrative proceedings requested by third parties will be stayed if court action is brought after the request was made;
 - in Finland, if the patent proprietor has requested limitation under the new rules of EPC 2000, a request for limitation in Finland shall be stayed;
 - in Germany, third parties who are sued for infringement may not file revocation action while an opposition is pending, but may intervene in the opposition even if the opposition term has passed;
 - in Italy, administrative procedures are open only if there is no nullity action pending in the courts;
 - in Korea, requests to the quasi-judicial body may not be brought while revocation action is pending in courts in the first instance;
 - in the Netherlands, it is reported to be unclear whether there may be priority to judicial proceedings on patentee's request;
 - in Paraguay, a request to *expand* patent claim scope must be made within 2 years after grant;
 - in the Philippines, likewise, a request to *expand* patent claim scope must be made within 2 years after grant;
 - in Sweden, partial revocation by courts can happen only in revocation action brought by third parties;
 - in the United Kingdom, when there are court proceedings pending in which invalidity may be put into issue, claim amendments must be requested during those proceedings;
 - in the United States, the Patent Office may or may not suspend proceedings pending US litigation regarding the same patent.
- *Is it possible under your national law for patentees to make multiple subsequent amendments of patent claims directed towards individual alleged infringers?*

The Group Reports of Argentina, Belgium, Brazil, Bulgaria, Chile, China, Mexico and Paraguay report that this is not possible.

However, as pointed out by the Danish, Ecuadorian, German, Italian and South African Groups, as such amendments are cumulative and must all imply limitation and not expansion of the claims, and since the proprietor cannot fall back on a claim scope that has once been surrendered, it appears to be difficult in practice for a patentee to direct

subsequent amendments towards several individual infringements. The United Kingdom Group points out that under its national law, such activity may have an impact on a tribunal's discretion to allow amendment. The Swiss Group, similarly, speaks of abuse of justice.

The United States Group, whose patent law allows *expansion* of claims within a certain period after grant, points out that matter which has been specifically surrendered cannot be recaptured by a later expansive amendment.

- *Who is entitled to amend claims? Is this limited to courts or do the patent offices also have the competence to amend claims?*

In Panama and Romania, only the courts have the authority to allow or direct amendments of patent claims post grant.

In Bulgaria, China, the Czech Republic, Ecuador, Hungary, Japan, Korea, Luxembourg, Mexico, Paraguay, Peru and Venezuela, administrative bodies alone are competent to allow or direct amendments.

In Argentina, Australia, Belgium, Brazil, Denmark, Estonia, Finland, France, Germany, Hungary, Italy, Latvia, Malaysia, the Netherlands, the Philippines, Portugal, South Africa, Spain, Sweden, Switzerland, the United Kingdom and the United States, courts, as well as administrative bodies, have the competence, in various situations, to amend patent claims after grant, including by deleting some, but not all, claims.

- 4) *What are the substantive conditions for allowing post-grant amendment of patent claims under your national law, in particular:*

- *Is there a distinction in your national law between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendments?*

Four Groups state that there is no distinction between the remedies available to, or substantive conditions applicable to requests made by patentees and third parties, respectively (Brazil, Bulgaria, Chile and Czech Republic). The French Group states that there is no distinction between the substantive conditions that apply to requests for amendment made by patent proprietors and third parties, respectively.

In respect of the extent to which *judicial and administrative measures* are available to patent proprietors and third parties, respectively, reference is made to item I)3, second indent, above.

In Argentina, Belgium, Denmark, the Netherlands, Spain and Sweden, as in the soon-to-come EPC limitation system under Article 105 a)-c) EPC, the proprietor may seek limitation of the claims for whatever reason. On the other hand, where third parties seek limitation of granted patents, this must be based on the partial invalidity of the patent as granted.

- *In what ways may patent claims be amended post grant under your national law?*

Almost all Groups report that amendments must imply a limitation or certainly no expansion of the scope of protection, and the remaining claims must have support in the specification or the drawings as originally filed. Paraguay, the Philippines and the United States allow expansion of the claims within the first two years after grant.

In some countries, it is only possible to revoke the patent in its entirety, or to revoke or surrender one or more claims in their entirety, but not to rewrite or amend individual claims (Argentina, Brazil, Luxembourg and Spain). In France and Hungary the same applies where the amendment is sought in administrative proceedings, but not in judicial proceedings.

In other countries, individual patent claims may be amended, either by combination of the features of one or more claims or even by introducing features taken from the specification which have not previously been included in any of the claims (Belgium, China, Denmark, the Netherlands, Sweden, Switzerland and the United Kingdom). However, in Denmark and in Sweden there are certain limitations as to the extent to which *courts* are able to handle amendments that go beyond combination of features from two or more claims.

A number of Groups have not reported on this particular issue.

The Australian Group reports that it is not allowed to use amendment of patent claims to over-come prior art that ought to have been disclosed to the patent authority when the application was originally filed. Furthermore, the courts have a discretion as to whether or not amendments should be allowed, in particular where patent proprietors have delayed applying for amendment for a prolonged period after becoming aware of additional prior art, especially where the unamended patent has been used in bad faith as a threat towards competitors.

The Dutch and Swedish Groups report that under their national law, it is a requirement that the skilled person should be able to foresee in advance, by analysing the original patent and the state of the art, that the patent should only have been granted with the limitation now sought, and that it would be valid within the narrower bounds defined by the amendment. It must also be clear to the skilled person that the amendment is merely a limitation.

- *Is it a requirement (or a possibility) under your national law that the description/specification be amended to correspond with amendments of the claims?*

The Groups report that such amendment is a *possibility* in Australia, Brazil, Czech Republic, Denmark, Estonia, Germany, Italy, Korea, Malaysia, Mexico and Paraguay. These Groups do not report whether it is also a requirement.

In Bulgaria, Chile, China, Ecuador, France, Panama, Sweden, Switzerland and Venezuela, this is not possible at all. The French Group refers to the new EPC system where amendment of the specification and drawings will be possible.

In Belgium, Finland, Hungary, Japan, Peru, the Philippines, Romania, South Africa and the United States (to a limited extent) amendment of the specification is a possibility but not a requirement.

In Argentina, Latvia, Portugal and Spain, the issue is unresolved in the law.

- *Is it possible to make amendments for the purposes of clarification and/or correction of errors?*

Clarification or correction of errors is not possible in Belgium, Brazil, Bulgaria, China (possibly except obvious errors), France (except evident errors or mistranslations), Germany or Hungary.

Such amendments are allowable in Argentina (no examination), Australia (clerical errors or obvious mistakes), Chile, Czech Republic, Denmark, Ecuador, Estonia, Finland, Italy, Japan, Korea, Latvia, Malaysia, Mexico, the Netherlands (at least if triggered by invalidity arguments), Panama, Paraguay, Peru, the Philippines (if errors were made in good faith), Portugal (if the errors do not affect essential elements of the invention), Romania, South Africa (different procedure for errors and clerical errors), Spain, Sweden (only in judicial proceedings and only minor clarifications or corrections), Switzerland, the United Kingdom (separate proceedings for clarifications and corrections), the United States and Venezuela (only material errors).

The Chilean, Czech, Danish and Peru Groups point out that such amendments must be supported by the original disclosure, and that is probably the situation in many countries, even where this has not been reported. In Estonia, corrections may be made even if they imply an expansion of the scope.

5) *What are the consequences for third parties of post-grant amendments of patent claims under your national law, in particular:*

- *What are the consequences for third parties' liability for patent infringement where patent claims are amended post grant?*

All Groups that have commented on this agree that under their law, future conduct of third parties is assessed on the basis of the amended claims.

As to conduct prior to the amendment the national laws are more diverse.

The Ecuadorian, Estonian, Paraguayan and Peruvian Groups do not believe that claim amendments have any retroactive effect on prior conduct under their national laws.

In a large number of countries, it is clear that amendment has retroactive effect: Argentina, Brazil (where claims are held partially invalid in infringement proceedings, the effect is only *inter partes*), Bulgaria, Chile, China, Czech Republic, Denmark, France (not in the case of voluntary surrender of claims), Germany, Hungary (not in the case of voluntary surrender of claims), Italy, Japan, Malaysia, the Netherlands (not in the case of voluntary surrender of claims), Panama, [the Philippines], Romania, Spain (not in the case of voluntary surrender of claims), the United Kingdom and the United States.

The South African Group observes that it is arguable that acts conducted prior to the amendment took place in the belief that the patent was invalid. This defence may not, however, be effective if the acts were covered by a part of the claims that is upheld in spite of amendment.

The United Kingdom Group observes that acts taking place before the amendment may confer liability for damages if the patentee can show that the specification of the patent was drafted in good faith and with reasonable skill and knowledge. If the published claims lacked novelty, there can be no liability for damages. If the claims merely lacked inventive step, there might. In general, the policy in the United Kingdom is to discourage covetous patents by denying remedies.

The United States Group observes that under US law, acts taking place before amendment are not infringing unless they are covered by surviving claims which also existed originally.

- *Are amendments effective only **inter partes** or, conversely, **erga omnes**, including in relation to previously decided cases?*

Brazil alone reports that decisions within infringement actions have effect only *inter partes*. All other Groups that comment on this issue report that amendments have effect *erga omnes*.

A number of Groups observe that retroactive effect of patent claim amendments does not pertain to finally decided and settled infringement cases (*res iudicata*) (Australia, Belgium, Brazil, Bulgaria, China, Ecuador, Finland, France, Mexico, Panama, Portugal, Sweden and the United Kingdom), although in some of these countries the amendment may have effect on cases that are under appeal or where a final decision is not yet enforced.

Other Groups believe amendments do have effect even on finally decided cases (Czech Republic, Denmark (with some reservations as to repayment of damages etc.), Germany, Korea, the Netherlands (except in case of voluntary surrender of claims), the Philippines and Venezuela).

- Are amendments effective **ex nunc** or only **ex tunc**? Does that depend on the context in which the amendment is made?

In Ecuador, Mexico, Panama, Paraguay, Peru and Venezuela, patent claim amendments have effect only *ex nunc*. The same applies in the United States, except in case of minor corrections which take effect *ex tunc*.

In many other countries, patent claim amendments have effect *ex tunc*: Argentina, Australia, Brazil, Bulgaria, Chile, China, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Korea, the Netherlands, the Philippines, Portugal, South Africa, Spain, Sweden, Switzerland and the United Kingdom.

In Argentina, Australia, Belgium, France, Hungary, the Netherlands, Spain and Sweden, this does not apply to cases where the patent proprietor voluntarily surrenders some of the claims (or the patent in its entirety).

II) Proposals for substantive harmonisation

- 6) *Should post-grant amendment of patent claims be permitted?*

There is overwhelming support in favour of permitting post-grant amendment of claims. Only the Ecuadorian, Greek and Indonesian Groups do not support the concept.

A number of Groups explicitly state that their support is conditioned on expansion of the scope of protect not being allowed, or that amendments should only be allowed if they limit the scope of protection (Argentina, Chile, Finland, Italy, Korea, Mexico and Peru).

The Chinese Group observes that it is difficult for applicants to delimit claims accurately from the prior art and to write complete and perfect claims. In light of this, it would be unfair to invalidate the entire patent because of an invalidity problem that pertains only to part of what is claimed. However, access to amendment should, in the interest of legal certainty, be restricted so as to balance the interests of the patent proprietor against those of the public at large. There should also be a possibility for patent proprietors to voluntarily correct or clarify claims.

The Estonian Group states that amendment should be permitted, in particular to enable patentees to take account of information that was not available to them at the time of filing the application.

The Finnish Group observes that one should take into account the need for protecting the patent system from abuse, and also that an analysis should be made of the impact that wide-ranging access to amend may have on the quality of issued patents. Patent applicants should not be tempted to draft too wide patent claims in the first place. The Finnish Group believes US style inequitable conduct doctrines would be worth considering for other countries and in connection with international harmonisation.

The German Group observes that the public has an interest in the revocation of invalid patents, and patentees have an interest in being able to limit their patents to a scope that would make them legally valid.

The Japanese Group observes that it would be too severe to always revoke invalid patents in their entirety. This would lead to insufficient protection for patents.

The Dutch Group observes that, in accordance with AIPPI Resolution Q142, patentees should be allowed to restrict a claim to its valid content.

The United Kingdom Group observes that access to claim amendment is vital to ensure a proper balance. However, third parties should have a reasonable degree of security, and tribunals should have a discretion when awarding remedies on infringement based on patent claims that have been amended.

7) *Who should be entitled to request post-grant amendment of patent claims and who should have the competence to amend?*

Nearly all Groups support that the patent proprietor should be able to request amendment.

Most Groups (Argentina (unless a trial is already pending), Australia, Brazil, Bulgaria, China, Czech Republic, Denmark, Ecuador, Estonia, Finland, Germany, Hungary, Japan, Korea, Latvia, Mexico, the Netherlands, Panama, Paraguay, Peru, Portugal, Romania, South Africa (unless a trial is pending), Spain, Sweden, Switzerland, the United Kingdom and the United States) believe the proprietor should have access to administrative procedures for handling the request.

Some Groups observe that the proprietor should also have access to seek amendment by judicial procedures: Australia, Brazil, Denmark (within framework of revocation actions), France, Hungary (within framework of infringement proceedings), Korea, the Netherlands, Romania, South Africa, Sweden (within framework of infringement proceedings), the United Kingdom and the United States.

As previously observed, it is explicitly stated in some Reports but appears to be implicit in all the Reports that third parties should be able to challenge the validity of a patent (or specific claims thereof) in the courts. As observed by several Groups, this may prompt the proprietor to seek amendment of his claims.

Other than that, some Groups would support that (interested) third parties should have access to administrative procedures for challenging the claims of a granted patent, in whole or in part: Argentina, Brazil, Bulgaria, Czech Republic, Hungary, Panama, Romania, Switzerland and the United States.

The Dutch Group observes that there should be substantive examination of amended claims, if there was substantive examination when the patent was granted.

8) *What should be the substantive conditions for allowing post-grant amendment of patent claims?*

The Groups have provided a wide range of criteria or conditions. They may be summarised as follows:

It should be a condition that the claims as granted are not valid in light of the prior art: Argentina, Denmark (not valid or not clear), Estonia, Hungary, Latvia and Spain (in administrative proceedings).

Only limitation of scope of protection should, in principle, be allowed: Chile, Denmark, France, Germany, Japan, Peru and Sweden.

No broadening of scope of protection should be allowed: Australia, Brazil, China, Ecuador, Germany, Korea (would consider this if there were a "prior user right" attached), Luxembourg, Mexico, the Netherlands, Panama, Peru, Portugal, Romania, Spain and the United Kingdom.

Broadening of scope of protection should be permitted for a reasonable period of time after grant: the United States and Argentina.

No inclusion of new matter should be allowed: Australia, China, Denmark, Germany, Luxembourg, the Netherlands, Panama, Peru, Portugal, Romania, South Africa ("in substance", not literally), Spain, Switzerland and the United Kingdom. Matter that was not in the original claims should not be allowed to be introduced into the claims: China, Italy, the Netherlands and South Africa (each amended claim must be wholly within the scope of at least one granted claim).

Correction or clarification of obvious errors should be allowed: Australia, Japan, Latvia, Mexico, South Africa (even if this implies a broadened scope) and Spain.

Clarification should not be allowed: France.

The amended claims must fulfil all substantive patentability criteria: Brazil, Chile, Denmark, Finland, Paraguay and Sweden.

Only deletion or combination of claims should be allowable: China.

Rewriting of claims should not be allowed: China and France (redrafting of badly drafted claims).

One of the reasons for allowing amendment should be that there was insufficient disclosure in the specification: Czech Republic.

Patent proprietors should be required to disclose the reason for seeking amendment, and the proposed amendment should cure the defect disclosed: Sweden and the United Kingdom.

There should be no requirement for stating a ground for requesting the amendment: Finland.

There should be no conditions: the Philippines.

The Paraguayan and United Kingdom Groups observe that third parties should have the right to make observations relating to proposed amendments.

- 9) *Should there be a distinction between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?*

Again, there was a wide variety of the views contributed by the Reports. They may be summarised as follows:

There should be no distinction between the remedies available to patentees and third parties: Brazil, Czech Republic, Hungary, Latvia, the Netherlands, Paraguay, Peru, Romania, Switzerland and Venezuela.

There should be no distinction between the substantive conditions applicable to requests by patentees and third parties, respectively: Brazil, Czech Republic, Germany, Hungary, Latvia, Paraguay, Peru, Romania, Switzerland and Venezuela.

Patentee should have access to voluntary partial surrender of claims by some administrative measure: Argentina, Estonia, Finland, France (by reference to future EPO system), Germany, Japan and Switzerland.

Third parties should also have access to amendment through some administrative route: Estonia (if patentee consents) and the Netherlands (except that patentee must consent to amendments requested by third parties unless nullity grounds prevent maintenance of the claims in any form requested by patentee).

Third parties should only be able to request (partial) revocation but not amendment: China, Denmark, Finland (only interested third parties), Germany, Japan, Korea, Mexico, Portugal, Spain, Sweden and the United Kingdom.

In countries where there is no substantive examination of patent claims upon grant, only patentee should be able to request post-grant amendment: Italy.

To the extent third parties can request amendment, it should be a condition that the patent would be invalid if left unamended: Denmark.

Third parties should only be allowed to object to and seek remedies against amendments requested by patentee: South Africa.

Review of granted claims should be open to patentees and third parties, but only patentee should be allowed to amend the claims: the United States.

Except for patentee's voluntary partial surrender, all amendments requested by patentee or third parties should be subject to the same conditions, including a scrutiny not less strict than substantive examination: Argentina.

Where patentee voluntarily surrenders claims, third parties should be able to request substantive examination of the amended claim set: Germany.

10) *What should be the consequences for third parties' liability for patent infringement where patent claims are amended post grant?*

The Reports generally support a solution whereby third parties' liability should be determined by the patent claims as restricted by the amendment: Argentina, China, Australia (except where new features have been introduced from specification), Czech Republic (*ex tunc*), Denmark (*ex tunc*), Estonia (*ex tunc*), Finland, Germany (*ex tunc*), Hungary (*ex tunc*), Italy (*ex tunc*), Japan (*ex tunc*), Korea (*ex tunc*), Latvia (*ex tunc*), the Netherlands (*ex tunc*, except in cases of voluntary surrender of claims), Peru, Romania, Spain (*ex tunc* provided the amendment is the result of revocation action), Sweden (*ex tunc*), Switzerland (*ex tunc*), the United Kingdom (*ex tunc*, except finally decided cases),

However, even on this point there are further nuances:

The Ecuador and Paraguay Groups suggest that amendment should have effect in future only.

The Australian, Swedish, and United Kingdom Groups submit that there should be a discretion to completely limit liability to conduct taking place after amendment.

Where new features have been introduced from the specification, the Australian and French Groups believe there should be liability only for acts taking place after the amendment.

The United States Group holds that no liability should exist unless a valid claim covering the accused activity was present both in the original and the amended patent.

The Groups of Mexico and Venezuela report that the solution should depend on the type of infringement and the nature of the amendment.

Finally, the Philippines Group submits that the amendment should have no effect at all on third parties' liability.

11) *Does your Group have any other views or proposals for harmonisation in this area?*

The Argentinian Group observes that the right to amend claims rather than deleting entire claims should be exceptional. There should also be a provision to allow broadening of claims in exceptional circumstances, within a limited term, for example where a limiting feature was clearly unintentional. This would presuppose that there is support in the description.

The Chinese Group believes patent proprietors should be allowed to voluntarily correct obvious errors as well as abandon claims without judicial revocation action.

The Danish Group suggests that the regime provided by the EPC 2000 reform (Articles 105 a)–c)) would be a well-balanced model for harmonisation: only the patent proprietor would be able to request revocation or limitation through an administrative procedure without substantive examination, whereas third parties may only seek revocation by judicial remedies.

The German, Italian, Luxembourg and Swedish Groups also believe the solution of EPC 2000 is fair and transparent. However, the German Group believes there should be substantive examination of amended claims similar to the examination during the grant procedure. In any event, administrative decisions concerning amendments should be subject to judicial review.

The Japanese Group observes that amendment should be available to patentees in all jurisdictions, partly because this reduces the need or risk of a tendency towards an increased number of claims. It should always be left to the patentee to decide how claims should be amended, and only patent offices should have the competence to allow amendments.

The Korean Group observes that there should be a suitable public notice system for claim amendments, and third parties should be able to challenge the validity of amendments.

According to the Portuguese Group, the law should state expressly and exhaustively how claim amendments could be made.

The United Kingdom Group submits that conditional amendments (to be considered only if the tribunal considers the original claims invalid) should not be allowed, as this places an unreasonable burden on those attacking the patent. Patentees should be encouraged to select the amendment they want and think is defensible, and for that reason it should also not be possible to put forward EPO opposition-style auxiliary requests.

The United States Group observes that it is beneficial to have some provision for third party attacks (in administrative proceedings) after expiry of the opposition period, because this avoids an excess of oppositions from undertakings who are not yet in a position to assess whether the patent will be commercially detrimental to them.

III) Conclusion

There is support in the Group Reports for seeking to achieve harmonisation in this area, and although the current situation varies from one country to another, there appears to be a wide consensus about many important aspects:

- 1) Amendment of patent claims after grant should be possible for the patent proprietor, because it would be too severe to preclude him from limiting the patent to its valid scope if a ground for invalidity only pertains to parts of the claimed matter;
- 2) There should be an administrative route available for patent claim amendment by the patent proprietor;
- 3) 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, throughout the lifetime of the patent;
- 4) Third parties' right to challenge granted patents should not extend to a right to obtain particular amendments of individual claims, as this should be open only to the patent proprietor;
- 5) The amendments of claims after grant that should be open to the proprietor in all countries should include the possibility to delete one or more claims or to combine the features of two or more claims;
- 6) Patent claim amendment after grant must always imply a restriction of the scope of protection of the patent;
- 7) Patent claim amendment after grant must always have support in the original specification, and there should be no access to adding new matter;
- 8) Patent claim amendment after grant should have effect *erga omnes*;
- 9) Patent claim amendment after grant should be effective *ex tunc*; past conduct of third parties should only be held to be infringing if covered by both the original claims and the amended claims;
- 10) Amended patent claims should fulfil the ordinary patentability criteria;
- 11) There should be a possibility for the patent proprietor to correct obvious errors in the granted claims by way of an administrative procedure;

12) Competition between judicial and administrative measures for amendment should be avoided; it should not be possible to request administrative limitation while revocation action is pending in the courts; if revocation action in the courts is brought while an administrative amendment procedure is pending, the administrative procedure should be stayed until the conclusion of the judicial proceedings;

13) In general, the same criteria should apply for amendment of the claims of utility models, where applicable, as for the amendment of patent claims after grant.

Certain other proposals have been brought forward which have not been discussed in other Reports but which merit discussion within the Working Committee. These include:

14) Third parties should have the possibility of opposing claim amendments requested by the proprietor, by way of some administrative procedure, at least if an opposition procedure exists upon grant within the patent system where the patent was originally granted; the term for filing such opposition may be shorter than the opposition term upon original grant;

15) When voluntarily limiting granted patent claims, the patent proprietor should be able to request substantive examination of the patentability of amended claims by the patent authority that originally granted the patent, if the patent system in question provides for substantive examination of patents pregrant;

16) In judicial revocation action concerning patents granted after substantive examination of patentability, the court should have the possibility, on the request of one of the parties, to obtain the opinion of the patent authority that granted the patent, as to the patentability of the original and/or amended claims.

Furthermore, the Reporter General suggests that the Working Committee discuss how EPC 2000 could best be implemented in the countries party to the EPC.

The Reporter General also suggests that the Working Committee explore and discuss the ongoing revision of the United States patent system; will third party re-examination throughout the lifetime of the patent remain open if opposition upon grant is introduced?