



Scope of Permission to Amend the Claim in the Patent Application: A Comparative Study in the United States, Britain and International Documents

Mohammad Javad Abdullahi¹ | Maryam Sharifi Renani^{2*} | Reza Arabzadeh³

1 Assistant Professor of Islamic Azad University Khomeinishahr Branch, Isfahan, Iran

2 Ph.D. Candidate in Private Law, University of Isfahan, Iran

3 PhD Candidate in Private Law, Shahid Beheshti University, Tehran, Iran

* Corresponding Author Email: maryamsharifi@yahoo.com

Abstract

Amendment of claim in application before issuance of the patent is considered accepted in most legal systems of the world. What is being challenged is allowance of the amendment of the claims in the application after the issuance of the patent. Iran's legislature has limited the possibility of amendment before the issuance of the patent, and his silence regarding the possibility of amendment after the issuance of the patents indicates on impermissibility of them. American and British judicial proceedings insist on the permission of amendments even after the issuance of the patent.

The European patent Convention (EPC) is an important regional document that allows such amendments in terms of legal conditions. Despite the enumeration of the competitive risks of allowing amendments on the one hand and requirements of balance between rights of inventors and the standards of competition right and antitrust norms on the other hand.

According to Article 105A of the European Convention on Patents 2000, even after granting a patent, the holder can modify his patent. Sections 72 and 75 of the UK Patents Act 1977 also recognize post-issuance of patent amendment under certain conditions. In addition, the controller may initiate proceedings that may lead to such amendments. According to the European Patent Convention of 1973, amendments after the granting of a patent could only occur during the proceedings of the objection; And otherwise, the amendments after issuance were subject to its prescription in national law. It should be noted that the amendments during the protest lawsuit will be accepted only if they are appropriate and necessary, which means that the objection is made to make the amendments necessary. Article 138 (3) of European patent Convention (2000) has considered the right to amend the patent during the national patent proceedings for the holders of the European patent.

Amendments do not necessarily mean expanding the scope of the claim. Rather, it may clarify or change the claim. Define the invention more clearly to distinguish it from



prior knowledge and prior art, or provide better tracking for disclosure.

Although the United States Patent Office has prescribed a relatively unlimited amount of claims amendments, this does not mean that the holder of the patent has the right to make any changes in the application. The scope of the amendment of the claim is to the extent that the previous disclosure made by the inventor gives him this permission. In addition, it is necessary to comply with all the requirements related to the ability to register claims in the reformation phase.

While the patentee is permitted to claim the same invention in a different manner, he cannot amend his application to support an innovative concept not disclosed in the original application. The claim contained in the statement should not be modified in such a way as to expand the scope of the application that was originally filed. Failure to comply with these requirements exposes the invention to invalidation. Applicants are limited to the scope of the invention description included in the application. This restriction ensures that the patent holder is not allowed to expand the subject matter of the invention and cannot claim innovation that was created after the priority date..

Prescribing the amendment of claims before registration is a useful mechanism in balancing the patent system. The benefits of the amendment after the issuance of the patent certificate are assumed as a precautionary tool in the patent system, which gives the inventor a new opportunity to prevent competitors from exploiting the results of his invention.

Retrospective acceptance of post-issuance amendments of claim constantly changes the boundaries of the inventor's property rights. In support of the competitors who have made long-term investments based on the certificate before the reforms, such as building a factory, etc., the American courts have given the retroactive effect of the reforms and allowed the competitors to continue their activities without the need They pay royalties.

Due to the non-acceptance of retroactive effect of the amendments, it can be said that the contracts concluded on the date before the amendments will be implemented in the same way and, as a rule, the subsequent amendments will not have any effect on those contracts, unless the parties agree to the contrary in the contract or by virtue of another contract.

Observing the legal justifications and benefits and economic benefits of prescribing the amendment of the claim after the issuance of the certificate in the United States of America and the European Union can be a convincing proof of the need for the Iranian legislator to pay attention to permission of amendments after the issuance of the patent, to end its silence and keep pace with the system. The modern legal systems of the world should harmonize the domestic laws in order to weigh the right of inventors to modify the claim and respect the acquired rights of third parties, especially competitors.

The Authors are trying to draw the legislator's attention to the benefits of the permission of the amendments even after issuance of the patent. And they are also trying to mention the rules governing the limitations of the amendments in the light of discussed jurisdictions.

Keywords: Invention, Patent, Application, Amendment, Claim.

References

Books

1. Salehi Zahabi, Jamal. (2009). *The Patent Right: A Comparative Approach*. Sahami Tehran: Company Publications. [In Persian]
2. Shaykhi, Maryam. (2013). *Legislative Strategies in Industrial Property Law*. Tehran: Khorsandi Publications. [In Persian]
3. Lionel Bently, Brad Sherman, Dev Gangjee, and Phillip Johnson (2018). *Intellectual Property Law*, 5th ed, Oxford: Oxford University Press.
4. Martin J. Adelman et al.,randel R.Rader, John RThomas (2014). *Cases and Materials on Patent Law*, American Casebook Series, west Academic Publishing.
5. Mir Hosseini, Seyed Hassan.(2008). *Patent Law*. Tehran: Mizan Publishing. [In Persian]

Articles

6. Habiba, Saeed, & Golriz, Mehrdad Ghayemi. (2021). The Position of Claims in Patent Registration Declarations in the Scope of Patent Protection. *Legal Research Quarterly*. 24 (94). 38-62. [In Persian]
Doi: 10.29252/jlr.2022.225451.2082.
7. Krasser R.(1992). Possibilities of Amendment of Patent Claims During the Examination Procedure. *IIC*, 23. 23 (4). 467-471.
8. Shakeri, Zahra, & Jahromi-Bahaduri, Zahra. (2018). A Discussion on Various Patent Registration Systems with a Focus on Some Registration Principles. *Proceedings of the National Conference Honoring the Academic Excellence of Professor Mohammad Jafar Langroodi*. Eighth Section. *Intellectual Property Law*. 1(1). [In Persian]
9. Stephen T. Schreiner & Patrick A. Doody (2006). Patent Continuation Applications: How the PTO's Proposed New Rules Undermine an Important Part of the U.S. Patent System with Hundreds of Years of History. *J. Pat. & Trademark Off. Soc'y*. 88. (01). 556-569.
10. Robert P. Merges (2007). Software and Patent Scope: A Report from the Middle Innings. *Tex. L. Rev.*85 (01). 1627-1670.
11. Dan L. Burk & Mark A. Lemley (2003). Policy Levers in Patent Law. *Berkeley Program in Law and Economics, Working Paper Series*. 1-228.
<https://escholarship.org/uc/item/4qr081sg>
12. Donald S. Chisum (1992). Patent Law Developments in the United States Court of Appeals for the Federal Circuit During 1991. *Am. U. L. Rev.* 41. (14) .869-903.
13. Tun-Jen Chiang(2010). Fixing Patent Boundaries, 108 *Michigan. LAW. REV.* 108.(4).523-575
https://repository.law.umich.edu/mlr?utm_source=repository.law.umich.edu%2F



mlr%2Fvol108%2Fiss4%2F2&utm_medium=PDF&utm_campaign=PDFCover
Pages.

14. Stephen Y.(2014). Improving Patent Quality with Applicant Incentives. HARV. J.L. & TECH. 28. (18). 77-136
Greg R.(2018). Amending Patent Claims. Harvard Journal of Law & Technology. 32.(1).1-56
https://papers.ssrn.com/sol3/Delivery.cfm/SSRN_ID3362043_code1871473.pdf?abstractid=3249589&mirid=1
15. Timothy B. Lee(2018). Why the Roots of Patent Trolling May Be in the Patent Of-ice, Of-ice, Trolls Love Patents From Examiners Who are “Lenient” About patent vetting”. US Patent and Trademark Office in Alexandria, Virginia, Mar 5, 2018 12:15 pm.
16. “National Patent Drafting Course”, (2017). Chiang Mai, Thailand October 2 to 6, 2017. organized by the World Intellectual Property Organization (WIPO) in cooperation with Chiang Mai University Department of Intellectual Property, Ministry of Commerce of Thailand and the National Science and Technology Development Agency (NSTDA) in Thailand and with the assistance of the Japan Patent Office (JPO). Chiang Mai, October 2 to 6, 2017.
<https://arstechnica.com/tech-policy/2018/03/why-the-roots-of-patent-trolling-may-be-in-the-patent-office/#p3> [<https://perma.cc/W4QB-DXH3>]
17. Parvin, Mohammad Reza.(2009). The Role of Patent Claims in Determining the Technical Scope Protected by Patent Rights: A Study in Biotechnology. 12(4). 71-104. [In Persian]

Act & International Documents:

18. American invention act, (AIA), 2011.
19. Patent Cooperation Treaty (PCT), Done at Washington on June 19, 1970, Amended on September 28, 1979, Modified on February 3, 1984, and October 3, 2001,(as in Force from April 1, 2002).
20. Convention on the Grant of European Patents (European Patent Convention) (EPC), Signed in Munich on November 29, 2000. On June 28, 2001, the Administrative Council of the European Patent Organisation Adopted the Final New Text of the EPC 2000. The EPC 2000 Entered into Force on December 13, 2007

Cases

21. Abbott Laboratories Limited v. Medinol Limited (2010)
22. AC Edwards v. Acme Signs & Displays Ltd. (1992)
23. Allen Engineering Corp. v. Bartell Industries (2002)
24. AP Racing v. Alcon Components Ltd (2014)
25. Aqua Prods., Inc. v. Matal, 872 F.3d 1290 (Fed. Cir. 2017)



26. Biogen v. Medeva (1997)
27. Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989)
28. Bonzel (T.) and Anr v. Intervention Limited and Anr (No. 3) (1991)
29. Brigade (BBS-TEK) v. Amber Valley (2013)
30. Bristol Myers Company v. Manon Freres (1973)
31. Codex Corporation v. Racal Milgo (1983)
32. Cordis Corp. v. Medtronic AVE, Inc., 511 F.3d 1157, 1185 (Fed. Cir. 2008)
33. Crown Cork & Seal Co. v. Ferdinand Gutmann Co. 304 U.S. 159 (1938)
34. European Central Bank v. Document Security Systems Incorporated (2007)
35. G 2/10 Disclaimer (2012)
36. G 2/88 (1990)
37. G 3/89 Disclaimer (1993)
38. G 11/91 Glu-Gln (1993)
39. G 1/93 (1994)
40. Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (1998)
41. Grant v. Raymond, 31 U.S. (6 Pet.) 218, 243 (1832)
42. Hallen v. Brabantia (1990)
43. Imperial Chemical Industries (ICI) (Whyte's) Patent (1978)
44. In re Hounsfield, 699 F.2d 1320 (Fed. Cir. 1983)
45. In re Wilder, 736 F.2d 1516, 1519 (Fed. Cir. 1984)
46. Kimberly-Clark Worldwide v. Procter & Gamble Ltd & Anor (2000)
47. Kintner v. Atlantic Communication Co., 240 F. 716, 717 (2d Cir. 1917)
48. Lars eric norling and anr. V. EEZ-AWAY (UK) LTD. & ORS (1997)
49. Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 909 n.2 (Fed. Cir. 2004)
50. Mack v. United States, 814 F.2d 120, 124 (2d Cir. 1987)
51. Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995 (Fed. Cir. 1993)
52. Merrill v. Yeomans, 94 U.S. 568 (1877)
53. Milliken Denmark AS v. Walk Off Mats (1996)
54. Mölnlycke AB and Anothers v. Procter & Gamble Limited and Anothers (No. 5) (1994)
55. Nokia Corporation v. IPCom GMBH & Co KG (No.3) (2013)
56. Permutit Co. v. Graver Corporation, 284 U.S. 52, 60 (1931)



57. Rambus Inc. v. FTC, 522 F.3d 456, 460–61 (D.C. Cir. 2008)
58. Raleigh Cycle Company Ltd and Another v. H. Miller and Company Ltd (1948)
59. Richardson-Vicks Patent Inc. v. Upjohn Company (1995)
60. Sara Lee Household & Body Care Ltd. v. Johnson Wax Ltd. (2001)
61. Siegfried Demel v. Jefferson (1999)
62. Shockley v. Arcan, Inc., 248 F.3d 1349, 1358 (Fed. Cir. 2001)
63. Slimfold Mfg. Co. v. Kinkead Indus, 810 F.2d 1113, 1116–17 (Fed. Cir. 1987)
64. Smith Kline French (SKF) v. Evans Medical (1989)
65. Snitzer v. Etzel, 465 F.2d 899, 902 (C.C.P.A. 1972)
66. Southco Inc. and Another v. Dzus Fastener Europe Ltd. (1990)
67. Spring Foam v. Playhut (2000)
68. Strix Ltd. v. Otter Controls Ltd. (1995)
69. Sudarshan Chemical Industries Ltd. v. Clariant Produkte (Deutschland) (2013)
70. Symbol Technologies v. Lemelson Medical, Educ. & Research Foundations, 422 F.3d 1378, 1380 (Fed. Cir. 2005)
71. T 66/85 (1989)
72. T 82/93 (1996)
73. T 133/85 (1988)
74. T 170/87 (1989)
75. T 187/91 (1995)
76. T 194/84 (1990)
77. T 201/83 (1984)
78. T 246/86 (1989)
79. T 378/86 (1988)
80. T 514/88 (1990)
81. T 582/91 (1995)
82. T 583/93 (1997)
83. T 684/96 (2000)
84. Unilever PLC v. Chefaro Proprietaries Ltd. (1994)
85. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991)
86. Vector Corporation v. Glatt Air Techniques Ltd. (2007)