

Exploring the boundaries of patent claim amendment

Clarity is needed on certain aspects of the law regarding patent claim amendment, argues **Víctor Garrido** of **Dumont Bergman Bider & Co, SC**

Mexican patent law contains provisions for claim amendment both before and after grant. The law is clear that claims cannot be amended after a final decision on prosecution has been issued, thus excluding the possibility of amending the claims in the time window between the date of allowance and date of grant. As a consequence of this provision, claim amendment is not legally feasible for appealing a final rejection. Practice shows that depending on the result of the appeal, it is possible to further amend the claims, specifically in the case of a decision ordering the application to be remanded back to examination. All these aspects might not pose many questions to the Mexican patent system in relation to claim amendment so the matter is not usually considered as a hot topic when discussing the system.

However, a more detailed review of the law, especially the provisions related to post-grant amendments, shows that the law is not exhaustive and that there are some practical and hypothetical situations not sufficiently contemplated, raising concerns as to whether the local framework is suitable or whether it can be revised and improved. This article briefly explores and comments on these concerns, which might be of interest to patent holders and practitioners from other jurisdictions.

Claim amendment during prosecution

Under the Mexican law, amendments to the claims are allowable any time before the Patent Office issues a final decision (allowance/rejection) provided the amendments do not contain

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additional matter broadening the scope of the original application considered as a whole. All amendments, either voluntary or those necessary to overcome objections during the examination process, shall comply with the mentioned legal requirement, which allows for amendments supported by the original application independently of whether the relevant matter was previously claimed or not. It is important to mention that deleting claims or matter from a claim via an amendment does not have the effect of giving up the deleted matter as such matter can either be brought back to the claims set in a future amendment for further discussion or alternatively be prosecuted in a divisional application, if suitable.

On the other hand, the law is not clear as to the definition of impermissible added matter, which would be desirable. Moreover, the law does not specifically address the definition of “the original application considered as a whole” nor the person under the view of whom permissible matter is to be assessed, although it can be assumed that such a person should correspond to a figure established in the law as “having technical skill in the art”. Thus, discussion might take place not only about the boundaries of the extent of “the original application considered as a whole”, but also about the date at which the knowledge of the person skilled in the art should be set, for example an absolute date such as the recognised filing date or the priority date, or a moveable date such as the recognised filing date of the specific matter being amended. The latter is more suitable as the Mexican patent system does contemplate the figure of partial priority, so there might be technical knowledge available to the

person skilled in the art published after the first priority date which might become relevant to determine impermissible subject matter to a specific amendment depending on whether the relevant claim is supported by the first priority application or by a subsequent recognised application.

In summary, although the law contains provisions to allow amendments to the claims during prosecution, improvements seem to be still desirable for the sake of more clarity.

Claim amendment after allowance/refusal

As mentioned, according to the law the claims cannot be amended after the Patent Office issues a final decision on prosecution. As post-grant amendments are contemplated within the law (see below), this means that the claims cannot be legally amended after the issuance of the notice of allowance and before obtaining grant. This also means that rejected claims cannot be amended to be discussed during an appeal despite the first instance to appeal a rejection being the Patent Office itself.

At first glance, not allowing amendments after allowance seems to be fair. The applicant is being offered rights over the matter the applicant demanded either at the last amendment submitted during prosecution or at the filing date (many applications are allowed without undergoing amendments or office actions at the examination stage). Nonetheless, applicants might be disappointed with the restriction preventing the amendment of an allowed application as there might be reasons why amending the allowed claims would be desirable, the discussion of which fall outside the scope of this article.

More importantly, the desired amendments might be such that they would be allowable and suitable during prosecution but not after grant. A review of the restriction, or at least a discussion about its suitability, should therefore be desirable. It seems that allowing this type of amendment would not contravene other legal dispositions within the Mexican legislation or international treaties signed by the country if the current law is revised to implement a system in which the applicant is first notified of the intention to grant a patent and given at least one opportunity to submit an amendment. The discussion otherwise should consider whether amendments after the notice of the intention to grant could or could not be of the same type as those permitted before allowance which accepts bringing back into the claims matter previously cancelled or not previously claimed but supported by the specification. If this is the case, the revision to the law should contemplate examination of the amended claims and provide restrictions as to the number of times this type of amendment should be practicable in order to prevent abuse of the system. Moreover, this discussion should also take into account the time limit for filing divisional applications because, as mentioned above, cancelling matter from the claims during prosecution does not generally prevent the applicant from seeking said matter in a divisional application.

Claims cannot be amended to appeal a final rejection. This seems not only reasonable but in harmony with the Mexican

legal system in general. Under the current practice, up to four office actions can be issued before the Patent Office renders a final decision, meaning that theoretically applicants are provided with opportunities to amend patent claims to put them into a form that is acceptable to the Patent Office. Some final rejections are appealed to challenge the legality of the actions performed by the Patent Office during prosecution. In such cases, the result of the appeal might be an order to remand the case to reinstate a stage of the prosecution. Such a stage might be for example the examination process thus allowing for further claim amendment.

Disregarding the number of office actions issued during examination, a final rejection grounded under an issue not discussed during examination might be issued. In such a case, it does not seem proper to refrain the appellant from trying an amendment. In this regard, at least an appeal has been processed in which the appellant obtained a decision ordering the Patent Office not only to re-examine the application but to do it by taking into account amended claims submitted by the appellant to the court when they initiated the appeal procedure instead of studying the previously rejected claims again. Unfortunately, more cases with a similar outcome are unheard perhaps because of the number of conditions that have to be met for a decision similar to this to be rendered.

Notably, there are grounds for rejections such as lack of novelty, lack of inventive step, lack of support and the like which could be successfully challenged by amending the claims. This implies that the application as rejected is not allowable but might comprise patentable matter so that an amendment could be more suitable, and perhaps the only solution to the issue for the applicant. Even though, under the current system, if the Patent Office acted properly during prosecution, it is legally correct not to grant the patent because the final refusal would not be incorrect or illegal. Arguably, this type of situation might be the reason why amendments to rejected claims are permitted in some other jurisdictions during appeal procedures. It is therefore recommendable that at least a discussion is held as to whether Mexico should reconsider the restriction of not allowing claim amendment before going to an appeal procedure. Alternatively, a discussion could also take place as to the suitability of providing for an opportunity to amend the claims as result of the appeal procedure if during the appeal procedure the appellant shows that the rejection would become void in view of an amendment.

Claim amendment after grant

There is room for amending the claims after grant restricted to correct evident or clerical errors and to narrow down the scope of the granted claims so the system arguably seems to provide judicial certainty and to strike a proper balance between allowing a patentee to amend its patent and protecting the public by preventing the patentee to practise impermissible amendments.

There is no limitation as to the time to submit post-grant amendments nor as to the number of post-grant amendments feasible during the patent term. Only the patent owner can request post-grant amendments either directly or via his repre-

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sentative. There seems to be consensus that post-grant amendments in Mexico are effective *erga omnes* and *ex nunc*. Discussion seems to be desirable as to whether other types of amendments not broadening the scope of protection should also be acceptable such as those introducing dependent claims or those directed to claim the matter from a single claim in two or more claims. These types of amendments do not seem to be permitted at present but might in some circumstances be desirable for patentees.

Legal provisions regarding post-grant amendments might be seen at first glance to be complete but they are not. It would be surprising to foreign practitioners to know that the Mexican law does not contain any provision addressing patent claim amendment during infringement and invalidation procedures – both always heard first by the Patent Office – other than the possibility of partial invalidation discussed below. Also surprising would be to find out that departments within the Patent Office act regarding some matters as if they were different entities not being compelled to communicate with each other. As a result of these concurring conditions, it is in fact procedurally possible to voluntarily amend the claims of a patent being the subject of litigation first because the law does not prohibit such amendments and second because the department processing post-grant amendments at the Patent Office is different from the department processing invalidation and infringement actions which in turn is different from the department issuing technical opinions to help to decide invalidation and infringement actions. Whether the amendment would have an impact on the litigation procedure depends in turn on whether the amendment is brought for discussion by at least one of the parties in the trial or *ex officio* by the Patent Office itself. It is therefore theoretically possible that the amendment is performed but not taken into account in the litigation procedure, which sounds strange, especially in the case of the outcome of the litigation procedure being a partial invalidation. This is obviously a confusing situation which needs to be cleared up because amendments during litigation have turned into reality.

For example, cases have been heard in which the patentee has voluntarily amended its patent claims after engaging in litigation. The amendments have been processed by the corresponding department at the Patent Office. The Patent Office has been questioned at least once by the affected party about the reason why the Office accepted an amendment to a patent undergoing litigation. The Office simply responded that it allowed the amendment because there was no legal provision refraining the Office from doing so.

Under the Mexican legislation all evidence for litigation is to be submitted by the parties at the very beginning of the procedure as no discovery period is contemplated. New evidence is only exceptionally admissible under particular conditions, one of them being that the evidence did not exist at the due time. Once a voluntary post-amendment has proceeded, a patentee brought the amended claims to a trial as new permissible evidence. The Patent Office admitted such evidence, which arguably changes the situation under which the trial has been established. How this change would actually impact the outcome of the decision in the trial is unclear but it is at least questionable that the Patent Office accepted this type of amendment. The outcome of the litigation procedure might have resulted in the patent claims being partially invalidated and therefore amended as they have been via the voluntary post-grant amendment. Apparently, the post-grant amendment would not have had critical impact in the outcome. However, there is a difference in the effect that both amendments have even if they might look the same because contrary to the voluntary post-grant amendment the partial invalidation has retroactive effect.

In another *sui generis* case, the voluntary post-grant amendment was submitted but for a reason it was not brought by either party into the litigation procedure. The Patent Office, however, when ordering the department in charge of performing the technical opinion to help to decide the case requested said department to take into account the amended claims. Moreover, some patents in which a post-grant amendment has been in-

troduced were not only undergoing invalidation actions but were also the basis of infringement actions. Perhaps the relevance of the amendment in these latter cases is more evident, but it is a fact that the current law is not properly equipped to face this type of situation.

All these types of cases will surely be heard by higher instances, but meanwhile they have shown the need for improvements to the current law.

Finally, as mentioned, the Mexican law provides for partial invalidation of granted claims. This invalidation can be interposed either by an interested third party (not the patentee), including the Federal Public Ministry, or be the result of an *ex officio* faculty exerted by the Patent Office. From the law, it is understood that a partial invalidation can take the form of a whole deletion of, or an amendment to, the affected claim(s). This post-grant amendment is different from those voluntarily requested by the patentee in that it has *ex tunc* and not *ex nunc* effects. Here a question arises as to what should proceed in the theoretical case of an alleged patent infringer already found liable with regard to claims totally or partially invalidated after the infringement procedure, for example as result of an invalidation action won by a different interested party after the infringement has become *res judicata*. Legally, the invalidation should have retroactive effect. The law is silent about this concern but it seems that a discussion to implement a restitution action or a similar remedy available to the alleged infringer should also take place.

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