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London, 1-7 October 2023



Amending your Patent – Can it be done prior to or during litigation?

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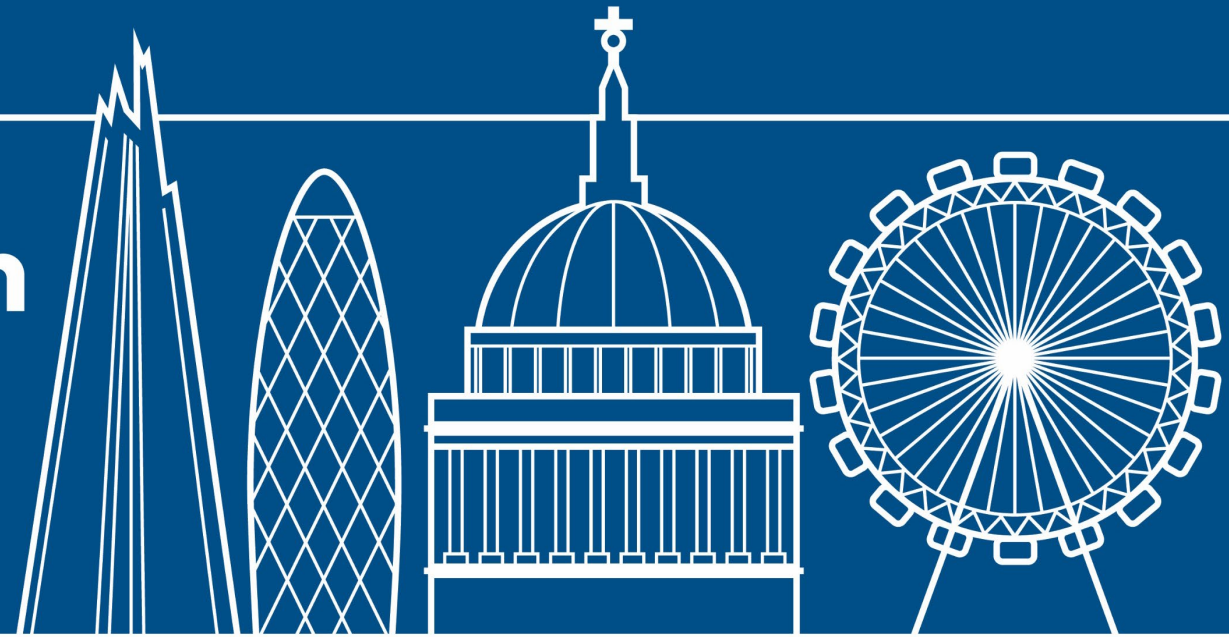
district



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Introduction

Jill M. Browning
Shareholder, Greenblum & Bernstein
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district



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Jill Browning



Greg Chambers



Nicola Dagg



Katsumori Iseki



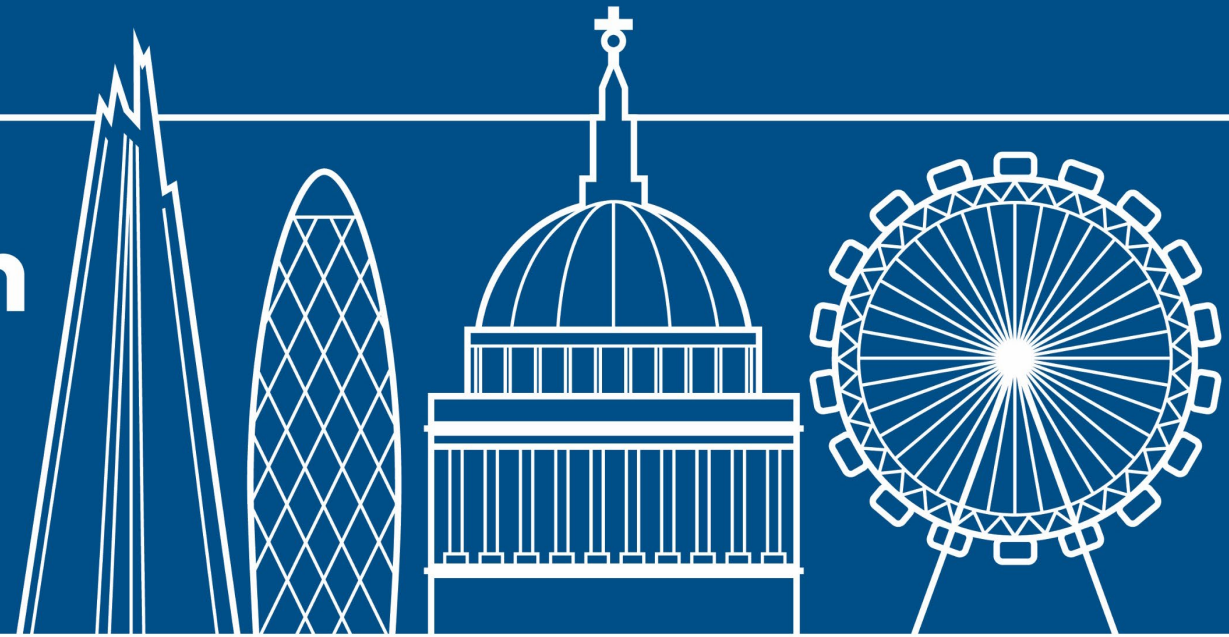
Dan Warren



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Amending Australian Patents Some litigation lessons

Greg Chambers

Consultant, Phillips Ormonde Fitzpatrick

Australia



district



Is post-grant amendment of a patent permissible?

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- Subject to various requirements, an Australian patent may be amended either before, during or after litigation.
- Different issues arise with respect to timing – it is easier to amend a patent prior to litigation, but circumstances may militate against pre-litigation amendment.



Some preliminaries

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The patent specification of a granted patent cannot be amended if:

- a) as a result, the specification discloses or claims new matter (s 102(1));
- b) as a result, the claims are broadened (s 102(2));
- c) as a result, there ceases to be adequate disclosure to perform the invention, or there is a failure to disclose the best method, or the claims are no longer clear and succinct and supported by the disclosure (s 102(2) and s 40).

NB: There is a more liberal test for patents granted on applications for which a request for examination was filed prior to 15 April 2013.



Exceptions



Despite the provisions of s 102(1) and (2), new matter and claim broadening is permissible if it can be demonstrated that the specification requires correction to deal with either:

- a) a clerical error; or
- b) an obvious mistake.



Consents

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- A patent amendment cannot proceed if there is a registered mortgagee or an exclusive licensee unless they provide their consent (s 103(1)).
- However, if the consent is unreasonably withheld the Commissioner may permit an amendment application to be processed (s 103(2)).



Procedural Alternatives for Patent Amendment

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1. Application to the Commissioner prior to the commencement of litigation (s 104); or
2. Application to the Court during the course of litigation (s 105).



Amendment Application before the Commissioner

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s 104

- 1) An applicant for a patent or a patentee, may ... ask the Commissioner for leave to amend the relevant patent request or complete specification or any other filed document for any purpose, including ...
 - a) removing a lawful ground of objection ...; or
 - b) correcting a clerical error or an obvious mistake.

Reg 10.5(1)

The Commissioner must grant leave to amend a patent request, complete specification or other filed document:

- a) if the report on the proposed amendments under sub-regulation 10.2(1) is not an adverse report ...

(Reg 10.2(1) relates to a report concerning compliance with ss 102 and 103 and confirmation that no legal proceedings concerning the patent are pending).



Amendment Application before the Commissioner

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- Even if all technical requirements are met, the amendment cannot proceed if there are any proceedings pending with respect to the patent, e.g. infringement/revocation.
 - s 112: A complete specification relating to a patent must not be amended, except under s 105, while relevant proceedings in relation to the patent are pending.
- If the Commissioner refuses the request, the patentee may appeal to a single judge of the Federal Court (s 104(7)).
- If the Commissioner grants leave to amend, details are advertised in the Official Journal and a third party may oppose within two months of the advertisement of proposed amendment (Reg 10.5(3)).
- The opposition concerns only s 102 issues, involves the exchange of evidence and a hearing. Either party can appeal the decision of the Federal Court.



Amendment Application before a Court

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s 105

(1) In any relevant proceedings in relation to a patent, the Court may, on the application of the patentee, by order direct the amendment of the patent request or the complete specification in the manner specified in the order.

(4) A court is not to direct an amendment that is not allowable under s 102.

Importantly:

- a) The application is subject to the Court's discretion.
- b) If the Court accedes to the amendment request there is no opposition by third parties.



Amendment Application before a Court

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What factors are relevant to the exercise of the Court's discretion:

- a) Has there been unreasonable delay in seeking to amend after the patentee became aware of the deficiencies in the patent specification?
- b) Has the patentee sought to obtain an unfair advantage from a patent it knows or should have known should be amended? (e.g. threatened an alleged infringer on the unamended patent)
- c) Has the patentee made a full disclosure of all the circumstances that explain why amendment is sought and why now?
- d) The court is concerned with the conduct of the patentee and not the merit of the invention.



Amendment Application before a Court

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Discretionary considerations

“A question of principle arises as to whether the conduct of the patentee in relation to invalid claims should in any way impinge upon its entitlement in relation to valid claims or claims that, with amendment, would be valid claims. It may be that persistence in a claim found to be invalid is enough to warrant refusal ... However, the position would be different where some claims are found to be invalid. There is no reason why the fact that a patentee has failed on some claims should be held to deprive it of its prima facie right to put the specification in order ...

See: *ICI Chemicals & Polymers Ltd v Lubrizol Corp* [1999] FCA 1417

c.f. *CSL Limited v Novo Nordisk Pharmaceuticals Pty Ltd (No. 2)* [2010] FCA 1251



Amendment Application before a Court

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Candour obligations

- The patentee carries the onus that the amendment should be made
- If there is a failure to disclose all relevant matters, amendment will be refused.
- There is no obligation to disclose privileged documents but objection to production on this ground is likely to bear heavily against the discretion being exercised favourably.
- Generally required to disclose relevant file histories from corresponding cases including patent attorney/lawyer advices on the relevance of prior art, or any other advice relevant to the amendment being sought.
- Expect the adverse party to issue subpoenas and Notices to Produce. Arguing against the production of any relevant documents is likely to be fatal to the amendment application.

See: *Wimmera Industrial Minerals Pty Ltd v RGC Mineral Sands Ltd* [1997] FCA 693.



Clerical Errors and Obvious Mistakes

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Clerical Error

- A clerical error arises if there is a mistake in the process of writing or transcribing.
- It is not relevant that the error is non-trivial or that it involves a major change in meaning, e.g. the failure to transcribe the word “not”.
- Under the *Patents Act 1952*, the error was subject to correction only if it was an error in the specification itself. The 1990 Act is more generous in that it concerns errors “made in, or in relation to, a complete specification” (see: s 102(3)(a)).

For example, it is possible to correct inventorship details on the Patent Request Form if they were incorrectly transcribed, even though it converts an invalid application to a valid application (see: *Osmose (Australia) Pty Ltd v Timtech Chemicals Pty Ltd* (2010) 86 IPR 419)



Clerical Errors and Obvious Mistakes

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Obvious Mistakes

- Not a mistake obviously made but a mistake which “the instructed public can, from an examination of the specification, appreciate the existence of the mistake and the proper answer for its correction”.
 - See: *General Tire & Rubber Company (Frost’s) Patent* [1972] RPC 259 at 279
- Can extend the scope of the claims or overcome clarity objections. For example, in *Garford v Dywidag-Systems International Pty Ltd* [2014] FCA 1039, the reference in a claim to the “upstream end” of a rock bolt was plainly in error and it was obvious from the description and drawings that the phrase should be replaced with the term “downstream end”.
- An obvious mistake does not need to be a clerical error. It can be an error made by the professional draughtsman of the specification.



Pros and Cons of Amendment Forum Alternatives

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Issue	Commissioner (s 104)	Court (s 105)
s 102 Compliance	Yes	Yes
Opposition	Yes	No; other than within the proceedings
Candour / Discovery	No	Yes
Discretion	No	Yes
After infringement proceedings launched	No	Yes
Costs	Relatively modest, unless there is a Court Appeal	Usually awarded against the patentee and generally substantial, regardless of the outcome
Clerical Errors / Obvious Mistakes	Yes	Yes



Consequences on Compensation following Amendment

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- General rule: Rights for damages or an account of profits for infringement accrue from the date of publication of the patent specification (s 57(1)).
- However, if the claims of an application are amended after OPI, there is no right for compensation before the date of the amendment unless at least one valid claim of the OPI specification was infringed and at least one valid claim of the amended set was infringed (s 57(4)).
- Furthermore, there is no right to either damages or an account of profits with respect to the infringement of an amended patent from a time before the date of the amendment, unless the Court is satisfied that the specification without the amendment was framed in good faith and with reasonable skill and knowledge (s 115).



Restriction on Recovery of Compensation

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s 115

- 1) Where a complete specification is amended after becoming open to public inspection, damages shall not be awarded, and an order for an account of profits, in respect of any infringement of the patent before the decision or order allowing or directing the amendment:
 - a) unless the court is satisfied that the specification without the amendment was framed in good faith and with reasonable skill and knowledge ...



Restriction on Recovery of Damages

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What is good faith and reasonable skill and knowledge?

- *Good Faith* requires that the specification be drafted honestly with a view to claim a monopoly in something to which the applicant reasonably considers it is entitled. It may be bad faith to draft claims known to be prior published.

(See: *Chiron Corp v Organon Technika Limited* [1994] FSR 458)

- *Reasonable skill and knowledge* – this is an issue relevant to the drafter – not the patentee’s conduct after the specification has been drafted (*Chiron*).
 - Requires that the specification be drafted with knowledge of the law and in a form that would be produced by a person with reasonable skills in drafting and knowledge of the invention and the law.



Consequences if Claim Amendment not allowed under s 105

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s 138

(3) After hearing a revocation application “the Court may by order revoke the patent, either wholly or so far as it relates to a claim ... “

- If all the claims are invalid without the requested amendment, then the patent will be revoked.
- If only some of the claims are invalid without the requested amendment, then the Court has the power to revoke just some of the claims. However, this is a discretionary matter, e.g. *Lockwood v Doric* [2011] FCA 1877



Amendment to change the inventor recorded on the Register

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- Available for any person by application to the Commissioner under s 191A (subject to discretionary factors similar to those discussed with reference to s 105) provided that there are no pending proceedings. After the patent is granted not available under s 104.
- Available to “a person aggrieved” by application to the Court – s 192.
- A “person aggrieved” is typically a person that claims some entitlement in the patent. The patentee can seek an order under s 105 to amend the inventor on the “patent request” subject to discretionary issues.



Some Cases

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- *Smith Kline & French Laboratories Limited v Evans Medical Limited* [1989] FSR 561
- *Wimmera Industrial Minerals Pty Ltd v RGC Mineral Sands Ltd* [1997] FCA 693
- *ICI Chemicals v Polymers Ltd v Lubrizol Corp* [1999] FCA 1417
- *CSL Limited v Novo Nordisk Pharmaceuticals Pty Ltd (No. 2)* [2010] FCA 1251
- *Bayer Pharma AG v Generic Health Pty Ltd* [2012] FCA 1510



Some Scenarios

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- Amend to address a change in the law
Available both before the Commissioner prior to litigation, or before the Court (subject to discretionary factors) during litigation – potential consequences to damages
- Amend to address newly discovered prior art
Available both before the Commissioner prior to litigation or before the Court (subject to discretionary factors) during litigation – potential consequences to damages
- Amend to address an argument asserted during litigation
Available before the Court – potential consequences to damages and subject to discretionary factors



Thank You

Greg Chambers

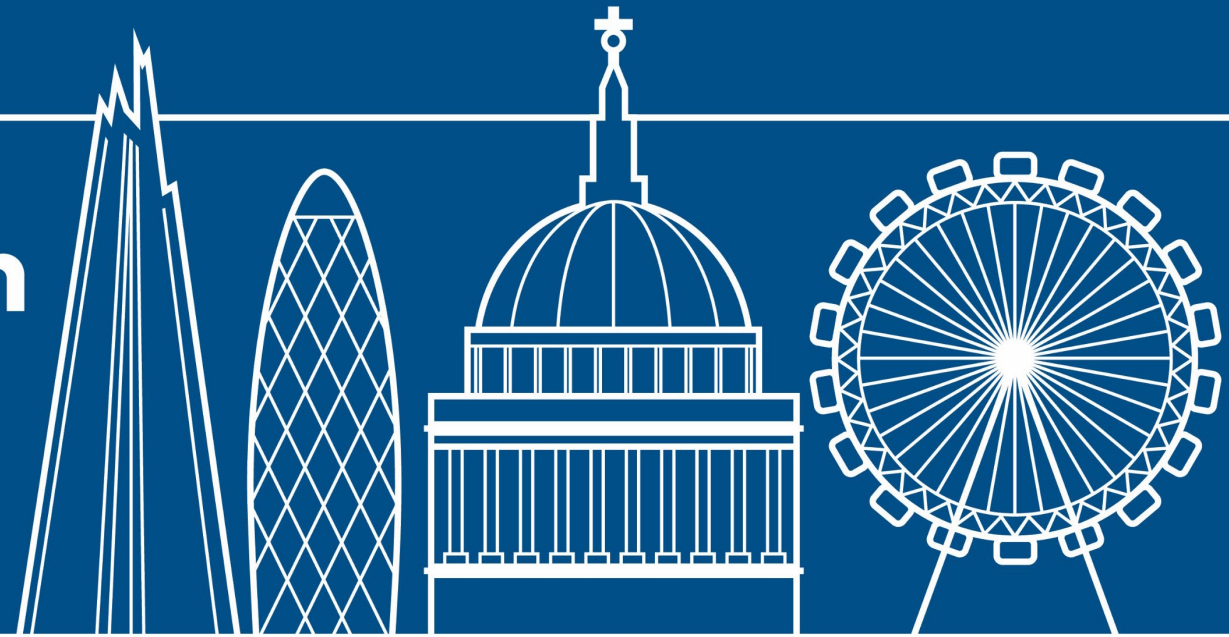




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Claim amendments in the UK

Nicola Dagg
Partner, Kirkland & Ellis
UK





Claim amendments in the UK

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General Rule 1 - The extent of protection of the patent must not be broadened once the patent has been granted.

- Any amendment resulting in something being an infringement post-amendment will not be allowed.
- broadening an individual claim does not necessarily involve broadening the protection of the patent (*Siegfried Demel v. C&H Jefferson*)

General Rule 2 - Any amended claim must be clear and concise

- Patents Act 1977 s. 14(5); *Horne Engineering v Reliance Water Controls*
- Court will not revisit questions of clarity for matter which was already in the claim (*Chiron (No.5)*)

General Rule 3 - UK Court has limited discretion to refuse amendments provided that they comply with the requirements of the Patents Act

- Same approach as EPO; *Markem v Zypher*



Amendment vs correction

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A. Typographical / clear errors

- Patents Act 1977, s. 117
 - Obviousness (Rule 105(3) Patents Rules 2007)
 - If obvious, will not extend scope (CompactGTL v Velocys plc.)
- UK IPO
 - Request for correction
 - Opposition (s. 117(2)).
 - Examination and Decision
- *Ex tunc* (as if it had always been so)

B. Substantive errors

- Patents Act 1977,
 - s.19 (before grant)
 - s. 27 (after grant)
 - s. 75 + 76 (during litigation)
- Claim amendment must not extend scope of protection (Patents Act 1977, s. 76)
 - Conversant v Huawei, patent invalid on ground of added matter
- *Ex nunc* (from now on)



Claim amendments made during UK litigation

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Discovery of new prior art: novelty or inventive step objection

- **Options**
 - Argue against prior art assertion
 - Amend claim
- **No added matter, so any amendments must be based on:**
 - Information in any dependent claims
 - Information in the specification
- **Practice point: ensure description of invention is of sufficient depth when patent application is filed**



Claim amendments made during UK litigation

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Timing of amendments

- **No fixed time**
- **Be tactical – wait until opponent has given details of:**
 - Intended prior art
 - Allegedly infringing product or process
- **Rare that Court will object to late filing unless:**
 - Abuse of process
 - Procedurally unfair



Claim amendments made during UK litigation

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Application to amend

- **Must apply to Court. Application must include:**
 - Particulars of the amendment sought
 - Details of the grounds upon which the amendment is sought
 - A statement as to whether the applicant contends that the claims prior to the amendment are valid
- **Consider:**
 - **Conditional** – i.e. only if patent as granted held to be invalid
 - **Unconditional** – i.e. validity of the patent as granted is not defended
- **Application must be served within 7 days on:**
 - UK IPO
 - All other parties to litigation
- **Application must be advertised in the *Official Journal***

Opposition

- **Notice of Opposition can be filed by any person within 14 days of advertisement**
- **Must :**
 - Include grounds of opposition
 - Be served on all parties and the UK IPO



Claim amendments - parallel proceedings

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Interaction with EPO proceedings

- Conform to position advanced in parallel EPO opposition proceedings
- Final decision of the EPO (Technical Board of Appeal) takes effect *ab initio*:
 - e.g., post-trial and pre-appeal, Court can only consider the amended claim despite any judgment from the High Court (*Palmaz's Patent*)
- Central amendment – adjournment of UK proceedings



Claim amendments - parallel proceedings

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Example: AB v MED-EL [2022] EWHC 1345 (Pat)

- 1 June 2022: UK High Court declared UK patent invalid for obviousness
- 28 September 2022: EPO Technical Board of Appeal maintained the patent following amendments to claim 1
 - Also decided patent was not obvious
- 9 June 2023: UK Court of Appeal had to decide appeal on basis of amended claim
 - Held that amendments made no difference to obviousness issue
 - First instance decision upheld
 - Decision of EPO on obviousness disregarded

(a) An implant system for a recipient patient, said implant system comprising:

(b) a planar implant coil housing (402) for implanting under the skin of said patient

(i) containing a receiver coil for transcutaneous communication of an implant communication signal, and

(ii) containing a first attachment magnet (401) within the plane of the implant coil housing (402),

(c) a planar external transmitter coil housing (405) for placement on the skin of the patient over said implant coil housing (402),

(i) said external transmitter coil housing (405) comprising a second attachment magnet (404) within the plane of the external transmitter coil housing;

characterised in that

(d) said first attachment magnet (401)

(i) is rotatable in said plane of the implant coil housing (402), and

(ii) the first and second attachment magnets have a magnetic dipole parallel to the respective plane of the implant coil housing (402) or external transmitter coil housing for transcutaneous magnetic interaction with ~~said second attachment magnet (404)~~ each other allowing to form a magnetic attraction connection between them in which the magnetic dipole of said first attachment magnet (401) is parallel to said plane of the implant coil housing (402) and said dipole of said second attachment magnet is parallel to said plane of said external transmitter coil housing,

(e) wherein said first attachment magnet has a planar disc shape or cut away disc shape



Claim amendments - parallel proceedings

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UPC proceedings

- UK patent is separate and distinct from European patent or Unitary patent at issue in UPC
- Infringement
 - Court's permission not required if application to amend included with Defence to Counterclaim for Revocation (Rule 30.1). Otherwise, permission required (Rule 30.2).
 - Same requirements for application as UK / EPO
- Revocation
 - Court's permission not required if application to amend included with Defence to Revocation (Rule 49.2). Otherwise, permission required (Rule 50.2).
 - Same requirements for application as UK / EPO



Impact of claim amendments

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Recovery of damages post amendment

- Recovery of damages may be limited if infringement is found (s.62(3) Patents Act 1977)
- Court will take into account:
 - Knowledge of infringement
 - Whether specification framed in good faith, and with reasonable skill and knowledge
 - Whether proceedings brought in good faith

Costs of amendment

- Costs are at the discretion of the court
- Court used to order the Patentee to pay the Defendant's costs of the amendment application regardless of whether amendment was allowed or refused



Thank You

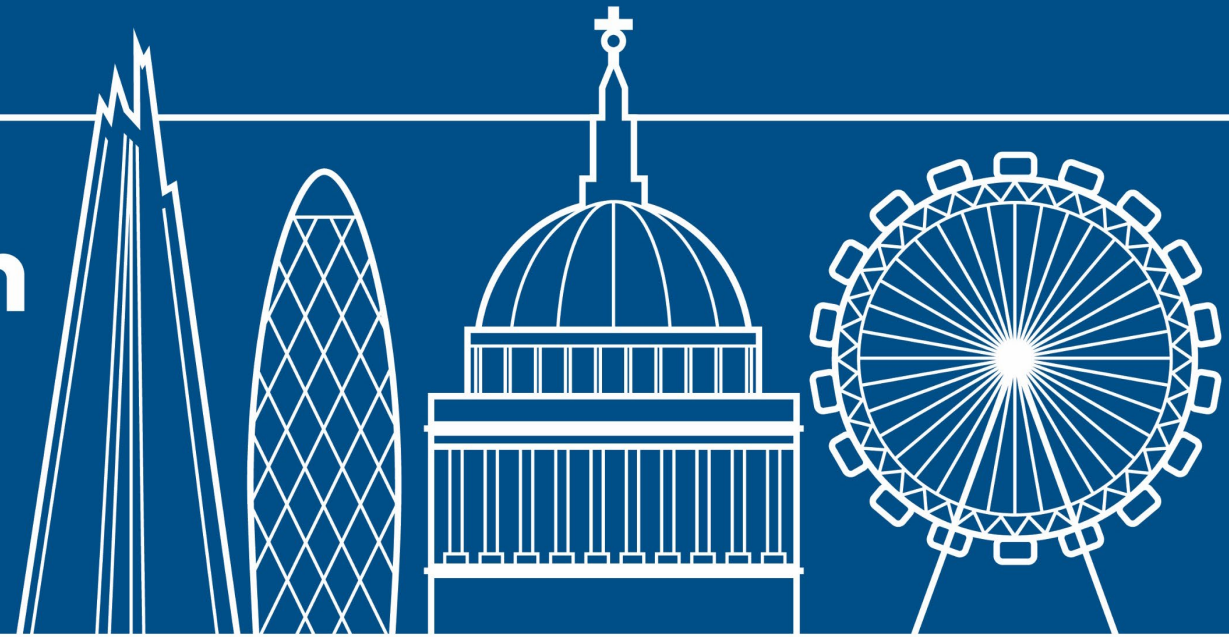
Nicola Dagg



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Amending Japanese Patents – Can it be done prior to or during litigation?

Katsumori ISEKI

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district

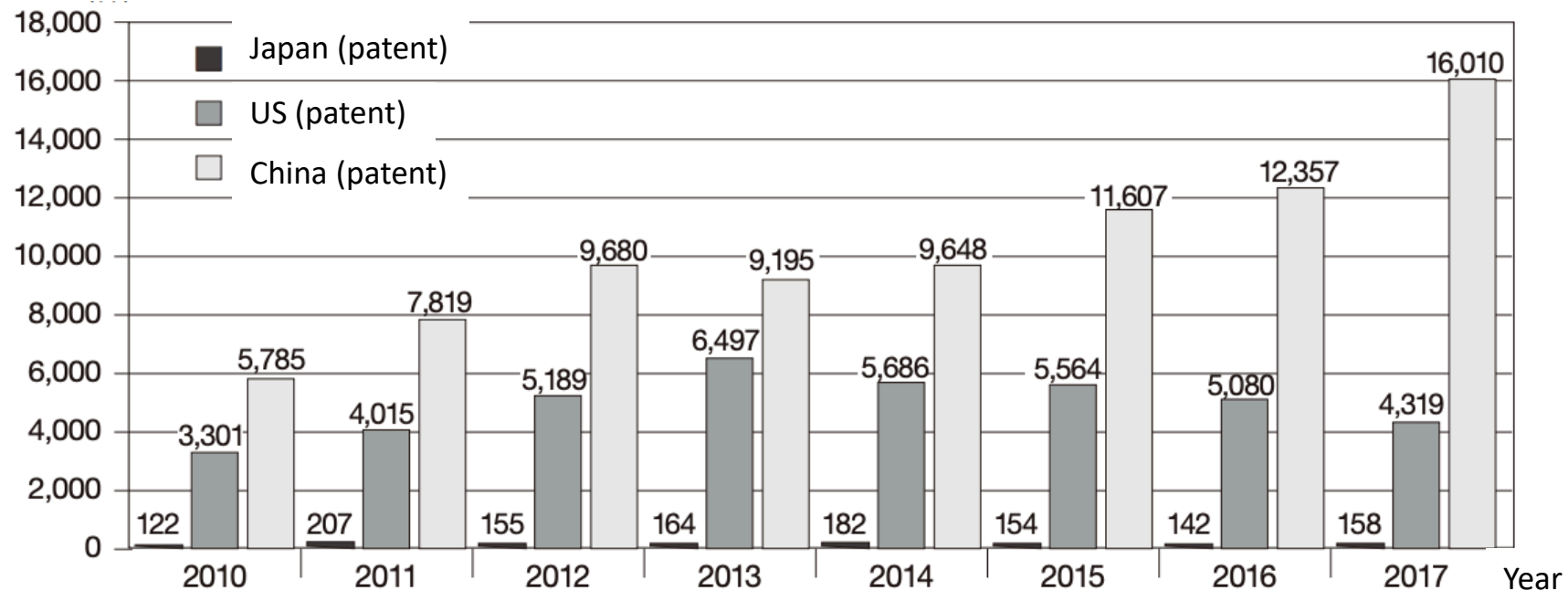


Overview - patent infringement litigation in Japan

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The number of patent infringement litigation in Japan, US, and China



source: <https://www.soeci.com/> (2019)

*Averaged examination period to the court decision in the first instance is about 14 to 15 months.



Basic court proceedings - patent infringement litigation in Japan

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The **two-phase** proceedings system:

1) The **first** phase for examination on **infringement**

- the court first conducts proceedings on whether the patent has been infringed
- in this phase, **the validity of a patent may be disputed** (Article 104-3(1))



2) The **second** phase for examination on **damages**

- the court finds that infringement has actually occurred and then the second phase proceeding will be conducted

* The validity of a patent can be disputed both in a trial for patent invalidation before JPO and in the court proceedings (double truck system)



Key points - Amending Japanese Patents-Can it be done prior to or during litigation? (1)

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Key points :

- 1) Correcting a patent **in the court** during patent infringement litigation : **NO**
- 2) Correcting a patent **outside of the court (before JPO)** prior to or during patent infringement litigation : **YES**



Key points of Amending Japanese Patents-Can it be done prior to or during litigation? (2)

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Key points :

- 1) Correcting a patent **in the court** during patent infringement litigation : **NO**
- 2) Correcting a patent **outside of the court (before JPO)** prior to or during patent infringement litigation : **YES**

With respect to 1), however, basically correcting a patent before JPO can allow the patentee to file an **Allegation of Correction of a patent** in the court during patent infringement litigation

In other words, in the first phase for examination on **infringement**, under certain requirements*, the patentee can file a **Counter-Allegation of Correction (Re-Defense of Correction)** of a patent against an **Allegation of Invalidity (Defense of Invalidity)** of a patent by the defendant (in this sense, I could say 'substantially' YES to 1)) *requirements will be described later

With respect to 2), there are three options available for correcting a patent before JPO: a **trial for correction (Article 126)**, a **request for correction in a trial for patent invalidation (Article 134(3))**, and a **request for correction in an opposition to a granted patent (Article 120-5 (1))**



Key points of Amending Japanese Patents-Can it be done prior to or during litigation? (3)

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Key points :

- 1) Correcting a patent **in the court** during patent infringement litigation : substantially **YES**
- 2) ...

Some additional points :

- In response to **one** allegation of invalidity (Defense of Invalidity), a counter-allegation of correction (Re-Defense of Correction) can be filed **at least twice** (or more) according to the variety of procedures for correcting a patent before JPO unless the court finds the purpose of unreasonably delaying the proceedings
- More than one allegation of invalidity can be filed. However, this opportunity is more limited than a counter-allegation of correction under the principle of timely filing and of excluding the purpose of unreasonably delaying the proceedings (Article 104-3(2))



Types of correcting Japanese patent before JPO prior to or during litigation

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- 1) Correcting a patent in a **trial for correction (Article 126)**
- 2) Correcting a patent in a **request for correction in a trial for patent invalidation (Article 134(3))**
- 3) Correcting a patent in a **request for correction in an opposition to a granted patent (Article 120-5 (1))**

*A request for correction trial 1) can be filed anytime (even after patent expiration) except between time that **an opposition to a granted patent or patent invalidation trial becomes pending before the Japan Patent Office** and **the time that ruling on the opposition or the trial becomes final and binding**. A trial for patent invalidation can be filed anytime after patent grant (even after patent expiration). An opposition to a granted patent can be filed in six months after publication of patent gazette.

*Several opportunities of correcting a patent in these procedures are available.



Requirements of correcting Japanese patent in a trial for correction before JPO (Article 126)

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Main requirements of a **trial for correction** :

- 1) Purpose of a correction is limited to the following
 - **Restriction of the scope of claims**
 - **Correction of errors or mistranslations**
 - **Clarification of an ambiguous statement**
 - Rewriting a claim that cites another claim into a claim that does not cite that other claim
- 2) A correction must be made within the scope of the matters stated in description, etc. (**no new matter**)
- 3) A correction must **not substantially enlarge or alter** the scope of claims
- 4) The invention defined by what is stated in the scope of claims after the correction must be one that is **independently patentable** upon the filing of the patent application
- 5) In case there is an exclusive licensee or a pledgee, the consent with such a person is necessary



Requirements of correcting Japanese patent in a request for correction in a trial for patent invalidation before JPO (Article 134(3))

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Main requirements of a **request for correction in a trial for patent invalidation** :

- 1) Purpose of a correction is limited to the following
 - **Restriction of the scope of claims**
 - **Correction of errors or mistranslations**
 - **Clarification of an ambiguous statement**
 - Rewriting a claim that cites another claim into a claim that does not cite that other claim
- 2) A correction must be made within the scope of the matters stated in description, etc. (**no new matter**)
- 3) A correction must **not substantially enlarge or alter** the scope of claims
- 4) In case there is an exclusive licensee or a pledgee, the consent with such a person is necessary

*Main requirements of a **request for correction in an opposition to a granted patent (Article 120-5 (1))** are the same above



Requirements of Counter-Allegation of Correction of a patent in the court proceeding

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Requirements:

- 1) Corrected a patent in a trial for correction or a request for correction in a trial for patent invalidation *
- 2) Meet the requirements of correcting a patent
- 3) By doing 1), invalidation reason(s) claimed in an allegation of invalidity by defendant can be overcome
- 4) Infringed product is within the scope of the corrected patent claim

*The requirement 1) is not always necessary under special circumstances based on some court decisions.



The progress of patent dispute and the types of correcting a patent

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The purpose of correcting a patent is to cure some deficiency of the patent. In most cases, correcting a patent can be used against a claim of patent invalidity in the arisen patent dispute or in its preliminary step. There must be some dispute in the background of correcting a patent.

Types of correcting a patent according to the progress of patent dispute in Japan are following as examples:

- 1) In a preliminary step of dispute, patentee preventively requests **a trial for correction(JPO)**
- 2) In response to a claim of patent invalidity by an accused infringer in the various situations:
 - in the negotiation step, patentee requests **a trial for correction(JPO)**
 - in the court step, patentee requests **a trial for correction(JPO) and files a counter allegation of correction against an allegation of invalidity**
 - in the court step with the trial for invalidation pending(JPO), patentee files **a request for correction in its invalidation trial(JPO) and files a counter allegation of correction against an allegation of invalidity**

Practically, correcting a patent after initiating an infringement litigation can be done only in such cases where **an allegation of invalidity is filed in the court or a trial for invalidity is filed before JPO**



Thank You

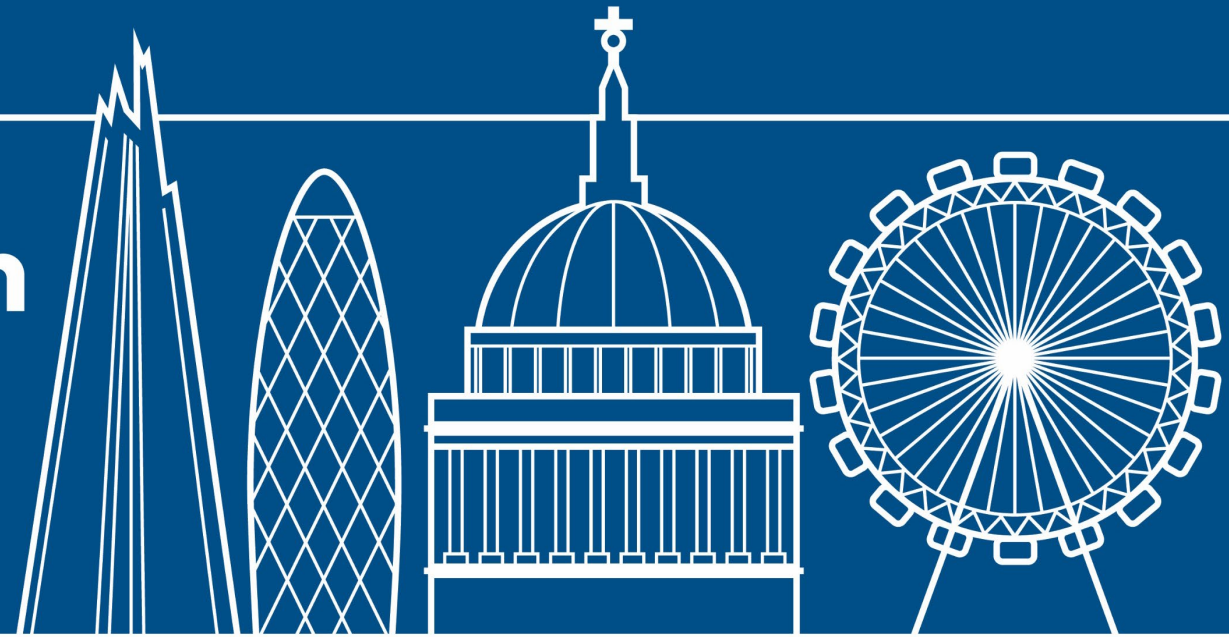
Katsumori ISEKI



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US Post Grant Amendments

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US



US Post Grant Amendments

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October 6, 2023

Daniel J. Warren

Partner

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Safeguarding your assets

When can you amend claims?



Proceeding	Original Prosecution	Post Grant	Litigation
Can you amend	Yes	Maybe	No
Claim Construction Standard	Broadest reasonable interpretation	Plain and ordinary meaning	Plain and ordinary meaning
Standard of proof for Invalidity	Preponderance of the evidence	Preponderance of the evidence	Clear and convincing evidence

- Court can correct obvious errors “not subject to reasonable debate.”
- Intervening Rights 35 USC § 252: Loss of the right to damages if claims are amended.



Background

Pre-AIA

- **Reissue:** Correct a defect that will or may result in invalidity. Broadening only for the first two years. Only patent owner.
- ***Ex Parte* Reexamination:** Narrowing amendments are allowed. Can be filed by anyone but only the patent owner participates.
- ***Inter Partes* Reexamination:** Narrowing amendments were allowed. Could only be filed by third parties. Limited third party participation.



PATENT



AIA (2011)



Eliminated *Inter Partes* Reexamination.

Replaced with Post Grant Review (PGR), *Inter Partes* Review (IPR), and Cover Business Method (CBM).

Cancelling claims or a reasonable number of narrower substitute claims.

Generally, a one to one swap of cancelled claims and narrower substitute claims.

Motion to amend generally must be made at the start of the proceedings.

May be conditional on challenged claims being found unpatentable.

To start, few motions were filed and almost no motions were granted.



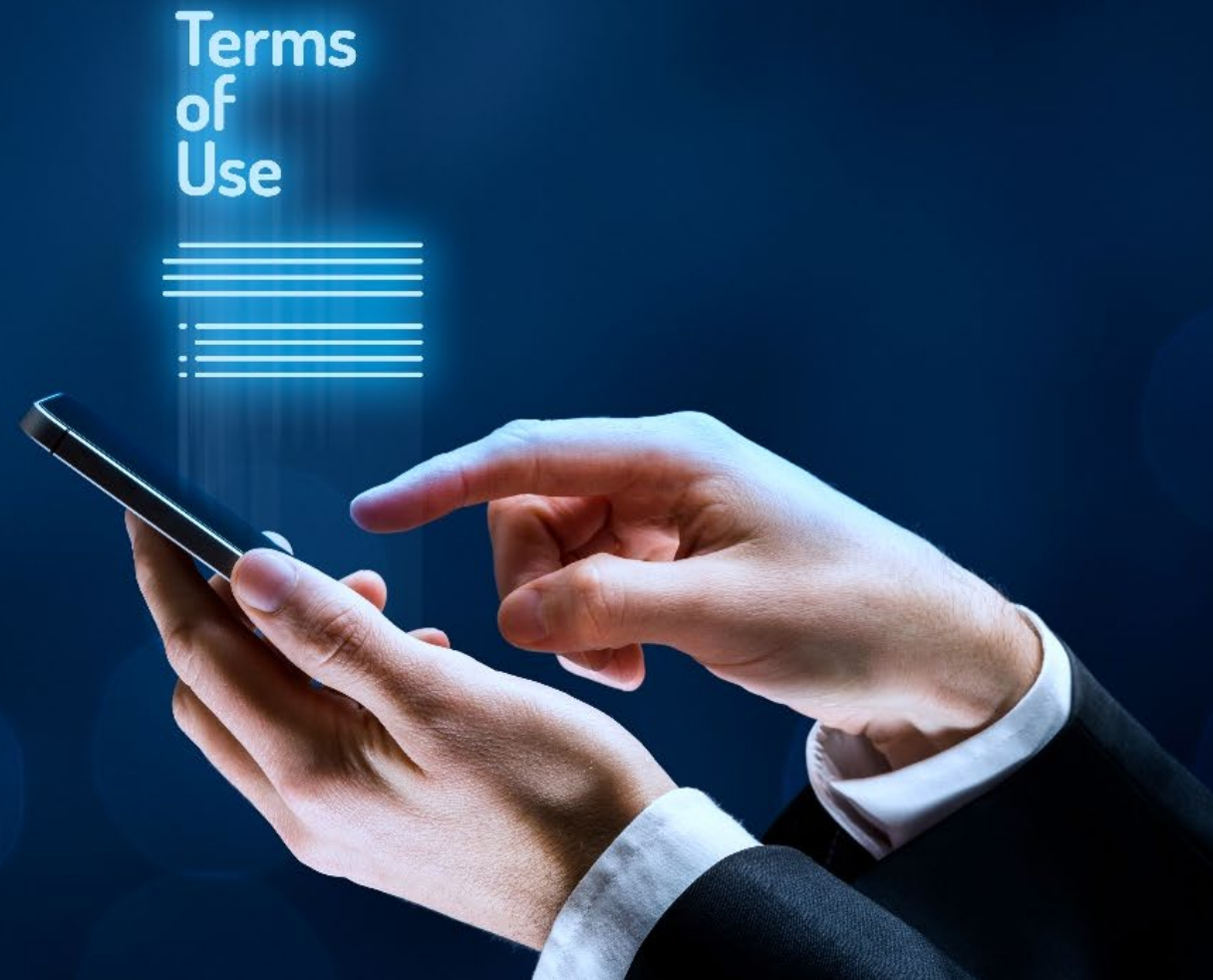


2019 pilot program

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- The Patent Owner may request preliminary guidance in the first motion to amend.
- Must confer with the Board.
- May file a revised motion to amend in response to the preliminary guidance.
- Increase in number of motions filed and granted but still relatively small (about 30% success rate).





2019 pilot program *(cont'd)*

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- Allocation of burdens in motions to amend.
- Petitioner has the burden of unpatentability.
- PO has burden on statutory issues:
 - 1) Reasonable number of claims.
 - 2) Amendments are supported by the original disclosure.
 - 3) Amendments respond to a ground of unpatentability.
 - 4) Amendments do not enlarge the scope of the claim or introduce new matter.
- Generally, a one-to-one swap of cancelled claims and narrower substitute claims.
- PO may request that the amended claims and the original claims are substantially identical to maintain damages.
- **Current proposals on further changes**

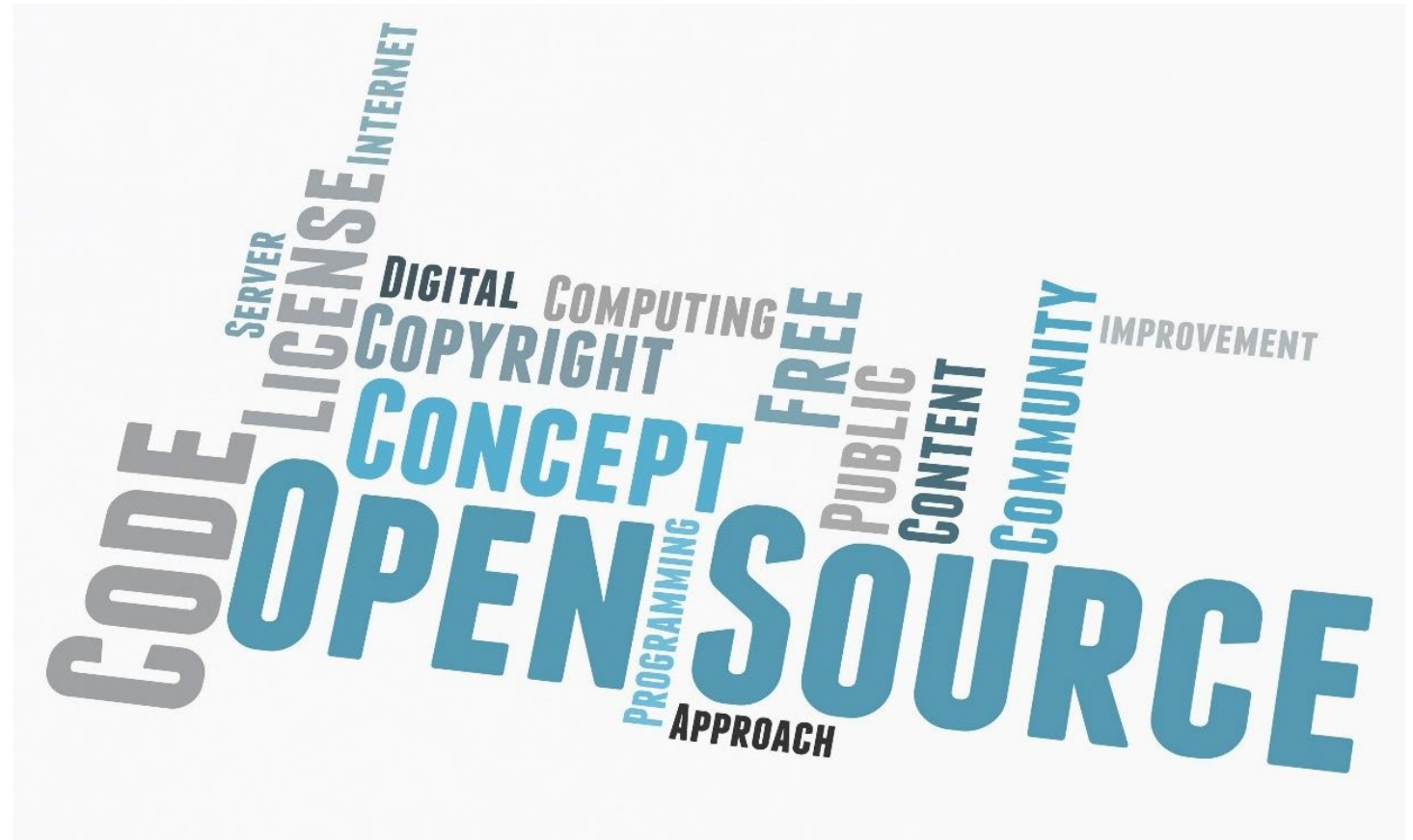


Post-grant summary

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- Limited at best
- Amendments eliminate damages
- Litigation
- No – other than minor “typos”







FICPI ExCo & 21st Open Forum

London, 1-7 October 2023



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