



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee, Rome, 6-9 November 2011

“Post-filing amendments”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Rome, Italy, from 6 to 9 November 2011, passed the following Resolution:

SUPPORTING the legal provisions that forbid the addition of subject matter to a patent application after the filing date unless such subject matter can take the date on which it is added;

BUT NOTING WITH CONCERN that some but not all patent authorities examine amendments for the addition of subject matter formalistically and so insist on explicit support for the wording of such amendments in the application as filed, where such an approach is not required by the law;

OBSERVING that, as a result of such overly-strict examination practice, there is a tendency to include wording to provide a literal basis for all potential amendments, making applications considerably longer and more expensive to draft and to analyse and more difficult to comprehend, thus degrading their disclosure function and reducing the quality of any resulting patents;

BUT EMPHASISING that a literal basis for all potential amendments could be included in the application only with a complete knowledge of the relevant prior art, which is never achievable, and that under an overly strict practice, in the absence of explicit support for a necessary amendment, patent protection for a valuable invention may be lost or unduly limited;

THEREFORE URGES patent authorities to avoid a purely literal and formalistic analysis of the original application and instead to adopt a reasonable and balanced approach, at least by taking into account the common general knowledge of persons skilled in the art, supported if necessary by evidence, and therefore allowing any legitimate amendments which such persons would consider not to extend beyond the content of the application as filed.