Filing patents takes time and money, but rights can often be undermined by the emergence of new-found prior art. Ropes & Gray LLP's **David P Halstead** and **Maya Escobar** discuss the corrective procedures

Getting it right the second time

Multinational patent protection is part and parcel of any global intellectual property (IP) strategy. But, unfortunately, long after key applications have been issued as patents, a piece of prior art may surface, a product may undergo a redesign, or an ambiguity may be uncovered. In such circumstances, correcting an issued patent may be necessary to adequately protect a product. However, as we found during our own efforts to correct an international patent portfolio, corrective procedures vary on a country-by-country basis, leading to additional strategic challenges. The different systems can be roughly categorised into five main groups:

1. Fixed scope

Certain countries permit free amendment of the claims of an issued patent, as long as the amended claims are supported by the specification and do not exceed the scope of the granted claims. In Australia, for example, we were able to revise granted claims and add new dependent and independent claims. The added claims were examined only to ensure that they were clear and succinct, supported by the specification and within the scope of the granted claims.

Our experiences in South Africa were quite similar, save for an additional requirement to give reasons for the amendments. New Zealand, however, proved slightly more restrictive. While we were able to add new dependent claims, we were warned that new independent claims were disfavoured.

2. Re-examination, reissue

Canada, like the US, provides re-examination and reissue mechanisms for amending the claims of an issued patent. These procedures differ from the procedures in most countries in that the claims receive a more thorough and substantive review by an examiner. Re-examination in both countries follows the same general principles, namely that any party may request re-examination by citing new prior art against the issued claims. Reissue is available in Canada, as in the US, to correct a patent that accidentally contains omissions or mistakes, and can be used to broaden or narrow claims. However, unlike in the US, this procedure is available for only four years after issuance in Canada; thereafter, reissue is not available even to narrow the claims.

3. Disclaimer

Another corrective mechanism available in certain jurisdictions is a disclaimer which generally may: (1) disclaim an entire patent; (2) disclaim certain claims of a patent; or (3) disclaim only a portion of certain claims.

While in the US it is possible only to either disclaim a patent or disclaim certain claims, we found that certain jurisdictions such as Canada and New Zealand permit a patentee to disclaim only a portion of an issued claim, thereby reducing the scope of the claim. Such disclaimers may narrow the claim by removing elements of a Markush group (a listing of alternative claim elements) or may take the form of exclusionary provisos.

4. Narrowing amendments

We found that most jurisdictions offer limited corrective options, permitting only restrictive amendments to the claims, such as the limitation procedure recently adopted by the European Patent Office with EPC 2000. For example, in Israel we were advised that a patent can be amended only to clarify it, eliminate a mistake in the specification, or restrict the claims. Although we were warned that new independent claims should not be added and new claims should be drafted as dependent

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claims whenever possible, in practice we were permitted to rewrite a dependent claim as independent, while narrowing the scope of the original independent claim.

Similarly, in Japan, the claims of an issued patent may be amended as long as the amendments are based on the disclosure and restrict a feature which, in some form, is already present in the granted claims. For example, we were advised that if a reaction temperature of up to 80°C was originally claimed, amendment to up to 40°C is possible; however, if no temperature limitation was in the original claims, introduction of this limitation would not be permitted.

The contours of Taiwanese and Mexican patent law are similar to those of Israel and New Zealand in that post-grant amendments are allowed only to narrow the claims or correct obvious or formal mistakes. However, an important distinction we encountered is that the number of claims cannot be increased in Taiwan or Mexico, even if dependent and properly supported in the specification. In Taiwan, we were able to add new claims by deleting an equal number of issued claims. In contrast, in Mexico we were not permitted to add a new claim in place of another, apparently on the theory that adding a new claim introduces new matter. The functional effect of this restriction is similar to that imposed by disclaimer systems.

5. No post-grant amendments

Unfortunately, we found that it is not possible to amend an issued patent in China for any reason. For an important patent family, it may be worth keeping a divisional application pending in China to preserve the ability to pursue new claims after the parent has issued.

Planning ahead

While it is helpful to know the processes to make amendments should a problem arise, prior knowledge can also help companies put together prosecution strategies to place a patent in a more advantageous position from the outset. Given constraints in post-grant amendments in many jurisdictions, applicants should tailor their approach in important applications to maximise options for correcting a patent later on. Such strategies provide added flexibility to reposition patent protection in response to an unanticipated change in the patent landscape.

When drafting independent claims, securing the broadest claims possible – in addition to its obvious advantages – provides the most room to manoeuvre in jurisdictions that offer amendments within the patent's original scope. Pursuing multiple independent claims of overlapping scope, each approaching the invention from a different angle, ensures maximum flexibility in many post-grant amendment procedures.

Dependent claims also offer important strategic advantages; for example, pursuing a variety of dependent claims of differing scope is helpful in jurisdictions that offer only disclaimers. Using those claims to address multiple aspects of the invention provides an additional advantage in jurisdictions such as Japan, where new features cannot be added to the issued claims. Applicants should avoid narrowing multiple claim elements into a single dependent claim, instead drafting individual claims, each focusing on a single aspect of the invention. This approach preserves the most options for rewriting dependent claims as independent claims, and for excising problematic claim elements without unnecessarily narrowing claim scope. Finally, seeking narrow claims to cover known products and any identifiable product candidates individually offers a last bastion of meaningful protection, especially in jurisdictions that prohibit the addition of new claims to a patent after grant.

While it is impossible to anticipate every setback, a little knowledge, forethought and creativity can help patent practitioners prepare for the unforeseen.

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