

Amendments before the EPO

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Legal Basis – Article 123 EPC

- (1) The European patent application or European patent **may be amended** in proceedings before the European Patent Office, in accordance with the **Implementing Regulations**. In any event, the applicant shall be given **at least one opportunity to amend** the application of his own volition.
- (2) The European patent application or European patent **may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed**.

Article 123(2) EPC

- “...may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.”
- Approximately 1470 T-decisions from the Board of Appeals, and at least 12 G-decisions from the Enlarged Board
- **Extremely strict interpretation** - typically a difficult subject for non-European applicants

Rule 137(4) EPC

When filing any amendments...the applicant shall **identify them and indicate the basis for them** in the application as filed.

If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.

(Applicant does not have the benefit of the doubt – T400/94)

“Gold standard” – G3/89, G2/10

- An amendment is not allowable if...it results in the skilled person being presented with information which is not:
 - ...directly and unambiguously derivable...
 - ...seen objectively and relative to the date of filing...
 - ...from the whole content of the application as filed...
 - ...when account is taken of common general knowledge...

“directly and unambiguously”

- An amendment should not require, e.g.:
 - extensive calculations/reasoning (“direct”)
 - assumptions (“the amendment is apparent if bending resistance is measured along axis Y-Y”)
 - chance (“the amendment finds support in 50% of the mutations”)

Not relevant for the assessment

- Obviousness
- Consistency with original disclosure
- Relevance of technical information
- Plausibility
- Mere comparison of amended and unamended subject-matter – mere semantic analysis
- Enabled to achieve result without undue difficulty

Basic example (GL H-IV 2.4)

- Claim 1: An apparatus mounted on a resilient support”
- Amendment: “An apparatus mounted on a helical spring”
- If there is no disclosure of a helical spring, the amendment will not be allowed.

The reverse example - generalisation

- Claim 1: An apparatus mounted on a helical spring”
- Amendment: “An apparatus mounted on a resilient support”
- Would not be allowed, in the absence of alternative types of resilient supports, or general language.

Deletion of a feature

- Claim 1: An apparatus mounted on a helical spring”
- Amendment: “An apparatus mounted on a spring”
- Can an applicant delete the word “helical”?

Deletion of a feature (GL H-V 3.1)

- Allowed if...
 - The deleted feature is not presented as essential
 - The deleted feature doesn't actually contribute to the solution of the technical problem
 - Replacement or removal of said feature does not require substantial modification of other features to compensate for the change.

Features from a reference document

- "...hereby incorporated by reference..."
- Not usually valid in Europe



Features from a reference document

- Incorporation is only allowable if there is no doubt that:
 - (i) protection is or may be sought for such features;
 - (ii) such features contribute to solving the technical problem underlying the invention;
 - (iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and
 - (iv) such features are precisely defined and identifiable within the disclosure of the reference document.

Amendment of ranges

- At temperature of 100-200°C, preferably 120-150°C
- The part-ranges 100-120, 120-200, 100-150 and 150-200°C should be allowable amendments
- An amendment to a range, with a new endpoint based on a single datapoint may also be allowable, if no intermediate generalisation occurs, and the skilled reader will understand that a technical effect is achieved in the new range.

Intermediate generalisation

- If two or more features are inextricably linked, it is generally not possible to only include one of them in an amendment, without the others; e.g.
 - Claim 1: *An adhesive comprises components A and B*
 - Claim 2: *B is an ethylene copolymer with a melting point of 300°C or greater*
 - The amendment that B is an ethylene polymer (without the limitation to the melting point) would be an intermediate generalisation

Intermediate generalisation

- A particular problem, when support for an amendment is provided in examples, or specific embodiments
- “The content of the application as filed must not be considered to be a **reservoir from which individual features** pertaining to separate embodiments **can be combined in order to artificially create a particular combination.**” (Case Law book II-E 1.4.1)
- To avoid this problem, draft your application in short sentences, or provide arguments why a certain feature functions in isolation

Two-list principle

- A selection and combination of one item from each of two lists generally contravenes Article 123(2), unless there is additional evidence for said selection/combination.
- A two-fold selection from the same list presents the same problems.
- “singling out”

Markush formulae

- R1 = A, B, C, D, E
- R2 = V, W, X, Y, Z
- It is not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description (T288/92; T1537/14)

Markush formulae

- R1 = A, ~~B, C~~, D, E

- R2 = V, W, X, ~~Y~~, Z

- Probably OK

- Not OK

- R1 = A, B, C, D, E

- R2 = V, ~~W, X, Y, Z~~

- Probably not OK

“Disclaimers” (negative claim features)

- “...wherein element A does not extend beyond element B in the horizontal plane”
- “...provided that R1 is not H when R2 is halogen...”
- “...said delivery means does not comprise a capacitor element”

“Disclosed disclaimers”

- i.e. the specification or claims as originally filed contain the negative feature(s), expressed in negative language.
- Allowed (EPO Guidelines H-V 3.5 and T170/87)
- Should be clear and concise.

“Undisclosed disclaimers” – G1/03

- i.e. the specification or claims as originally filed do not mention the disclaimed feature at all (in positive or negative terms).
- Allowed under certain circumstances (G1/03)
 - The disclaimer only establishes novelty (typically over prior art citable under Art. 54(3) EPC), or
 - The disclaimer excises non-patentable e.g. non-technical) subject matter.
 - The disclaimer must only excise exactly what is necessary to establish novelty lack of a priori patentability.

“Undisclosed disclaimers”

An undisclosed disclaimer is not allowable if:

- i. it is made in order to exclude non-working embodiments or remedy insufficient disclosure;
- ii. it makes a “technical contribution” to a patentable solution
- iii. it addresses additional issues, e.g.
 - it also provides patentability over a separate prior art document under Art. 54(2),
 - it also removes also a deficiency under Art. 83

GL H-V 4.1

Disclaimers (G3/10)

- i.e. the specification or claims as originally filed mention the disclaimed feature, but in positive, not negative terms.

- E.g.

R1 = A, B, C, D, E

R2 = V, W, X, Y, Z

“provided that R1 is not A and R2 is not V”

- Allowed under certain circumstances (G3/10)

Disclaimers (G3/10)

- Test: “...would the skilled person...using common general knowledge, regard the remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed”
- Look at the remaining subject-matter in the claim; does it present the skilled person with new information?
- Avoid “singling out” or “intermediate generalisations”

Disclaimers (G1/16)

- Question: does the “golden standard” of G3/10 conflict with the requirements of an “undisclosed disclaimer” in G1/03
- No – the nature of the disclaimer determines the “test”
- Decision: if a disclaimer is undisclosed, then use the G 1/03 test, if the disclaimed subject matter is disclosed, use the golden standard

Tips

- Provide your European counsel with as much support as possible
- Do not “tidy up” for the sake of it
- Remember: inadmissible amendments constitute a ground for invalidation in most European countries, and a ground for opposition at the EPO.