



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Added matter under the EPC



Contents – Added matter under the EPC

- Basic principles under the EPC
 - First to file
- Article 123(2) EPC
 - Interpretation
 - Gold standard
 - Skilled person
 - Level of proof
- Article 123(3) EPC
- Examples for judging allowability of amendments
- Relationship with inventive step and sufficiency of disclosure

Basic principles under the EPC

- The invention must be in a field of technology;
- There must be a non-obvious technical teaching;
- Patent right in exchange for a sufficient disclosure of the invention;
- First to file gets the patent;
- Certainty to third parties.

First to file

- The applicant may not gain an “unwarranted advantage” after filing by adding matter (G1/93):
 - Another applicant might suddenly no longer be the first to file;
 - There would be uncertainty to the public as to what can be expected concerning the outcome of the examining procedure.

First to file

- The application must fully disclose the claimed invention **at the date of filing**.
- The date of filing may be the date of filing of an earlier application from which priority is claimed, but only **“in respect of the same invention”** (A. 87(1) EPC).
- A divisional application **“may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed”** (A. 67(1) EPC).

Rule 139 EPC

- “Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is **immediately evident that nothing else would have been intended** than what is offered as the correction.”

Article 123(2) EPC

- “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.”
 - **subject-matter** pertains not only to the claims but also to the description and drawings;
 - However, we will today focus on amendments to the claims.

Gold standard

- Any amendment can only be made within the limits of what a **skilled person** would derive **directly and unambiguously**, using **common general knowledge**, and seen objectively and relative to the date of filing, from the whole of these documents as filed (G2/10; G 3/89; G 11/91)

Interpretation of Article 123(2) EPC

- The reflection/thinking of the skilled person is **not part** of the content of the original documents of the patent (T89/00)
- After the amendment the skilled person may not be presented with new technical information (G 2/10).

The person skilled in the art

- The same person for the purpose of all relevant articles (added matter, inventiveness, sufficiency of disclosure);
- only has technical skills;
- is non-imaginative;
- has average ability;
- can do routine work and experimentation
- has **common general knowledge**.

Common general knowledge

- What a general practitioner in a technical field is supposed to know;
- it can be shown with textbooks/reference books (if contested);
- it is normally **not** what is contained in specific patent applications or scientific publications.

Level of proof

- The level of proof required for showing that an amendment is directly and unambiguously disclosed is of a very rigorous standard: "**beyond reasonable doubt**".
- The proof must be provided by the party making the amendment.

Certainty to the public after grant – Article 123(3) EPC

- “The European patent may not be amended in such a way as to extend the protection it confers”.

Example - I

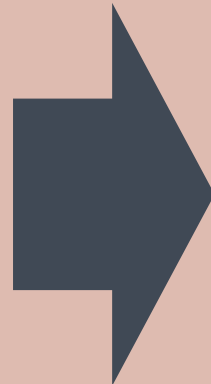
- **Addition** of a feature:
 - $A + B \rightarrow A + B + C$
 - Claim scope narrowed
 - May result in the “A.123(3) trap”
- Checking compliance:
 - Is the feature (C) disclosed in the application ?
 - Together with the other features (A, B) of the claim ?
 - Is it an intermediate generalisation ?

Intermediate generalisations

- The extraction of isolated features from a set of features originally disclosed only in combination is not normally allowable.
- Possible exception if there is no clearly recognisable functional or structural relationship among the features of the specific combination.

Claim: A + B

Embodiment: A + B + C + D



Claim A + B + C

Generalisations

- Replacing a specific term (“nail”) by an undisclosed generic term (“fastening means”) is not normally allowable, because the additional elements covered by the generic term (“screw”, “glue”) are not directly and unambiguously derivable from the application as filed.

Example - II

- **Removing** a feature:
 - $A + B \rightarrow A$
 - Claim scope broadened
 - Unallowable amendment can be “repaired” after grant
- Similar to an (intermediate) generalisation; not normally allowable.
- Additionally, the amendment may result in subject-matter which has not been searched, and therefore may not be allowable for procedural reasons (R. 137(5) EPC).

Relationship with Article 54/56 EPC

- If amendments are made to a claim to overcome an A.54 (novelty) or A.56 (inventive step) objection using wording which deviates from the wording used in the original application, this immediately raises suspicion:
 - the purpose of the amendment is to make the claimed subject-matter novel and inventive, but
 - this was apparently not possible with the wording of the application as originally filed, and hence
 - it becomes very likely that there is added matter.

Relationship with Article 83 EPC

- According to Article 83 EPC “the application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.”
- If the issue under Article 83 EPC is that the application lacks the details to put the invention into practice, these details cannot be added in view of the requirements of Article 123(2) EPC.
- Remember that the skilled person is the same person for purposes of Articles 83, 123(2) and 56 EPC.



SLW INSTITUTE

GLOBAL IP CONFERENCE

with Advanced PCT Training | 2018

Track II: European Patent Practices

Subject Matter Basis at the EPO

Meet the Presenters



Nathalie Baptiste

European Patent Attorney, *Schwegman*



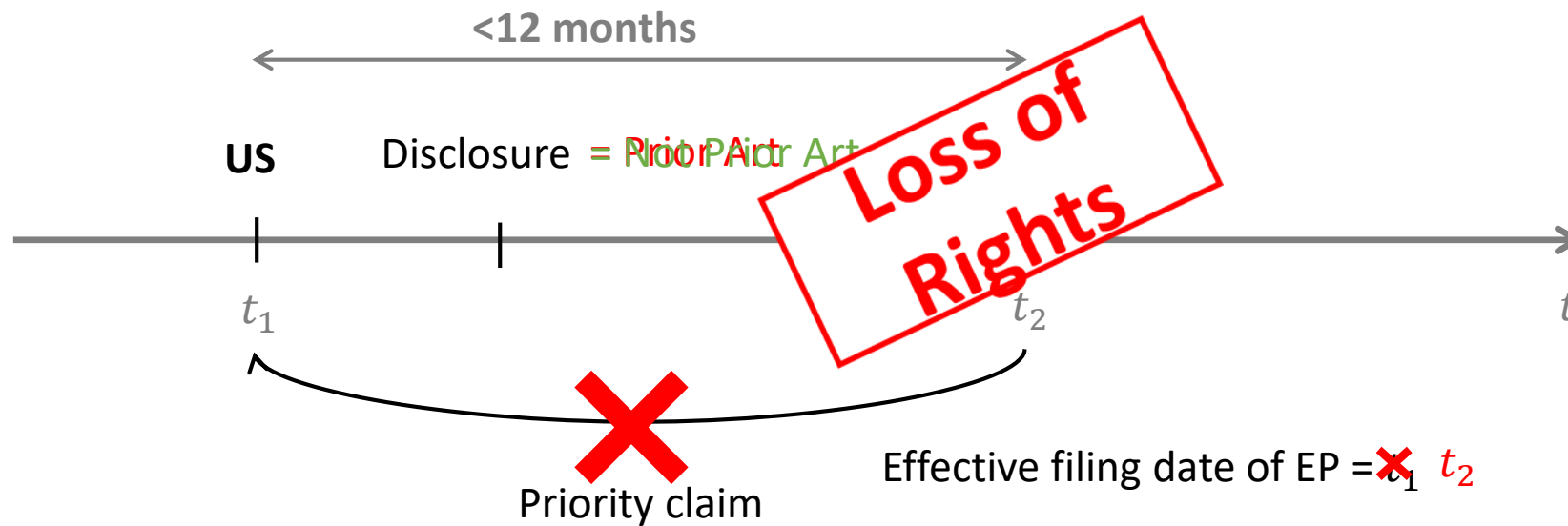
Bryn Williams

UK Principal Attorney, *Schwegman*

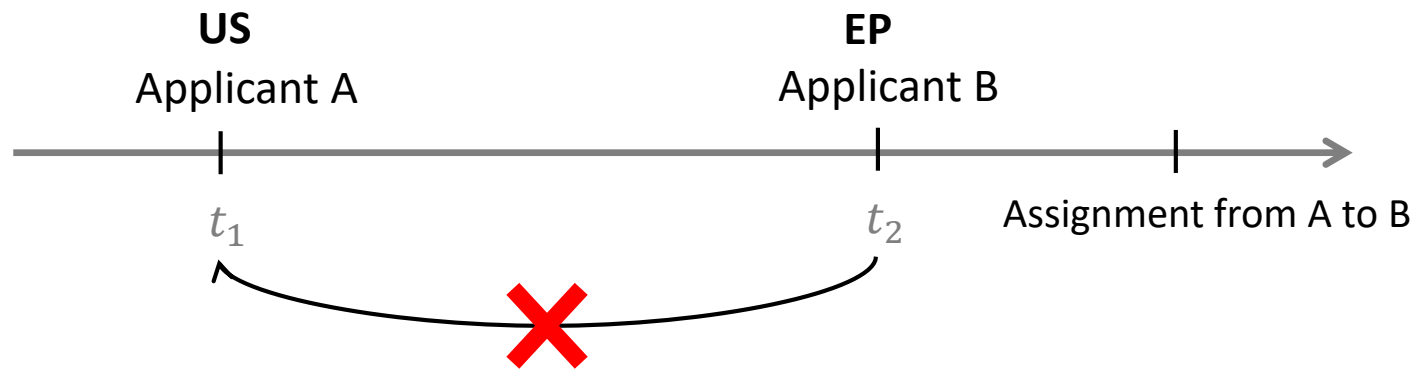
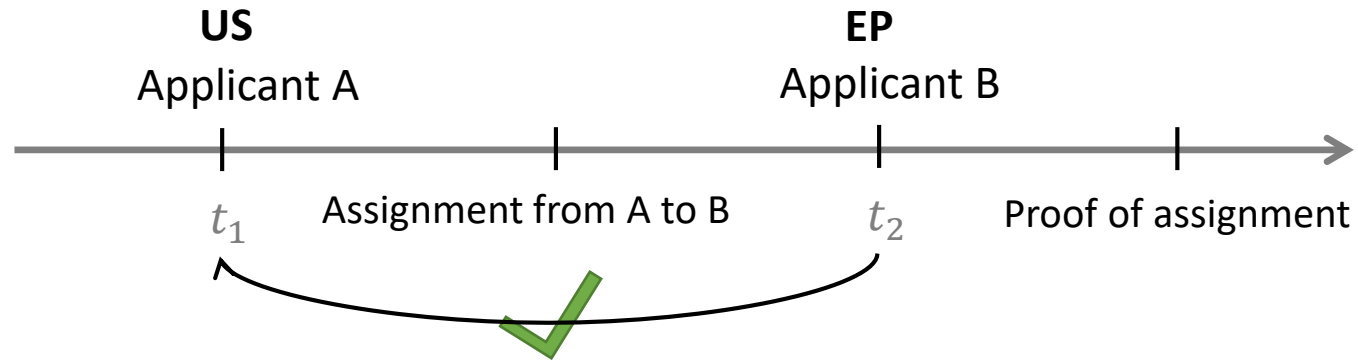


Claiming Priority at the EPO

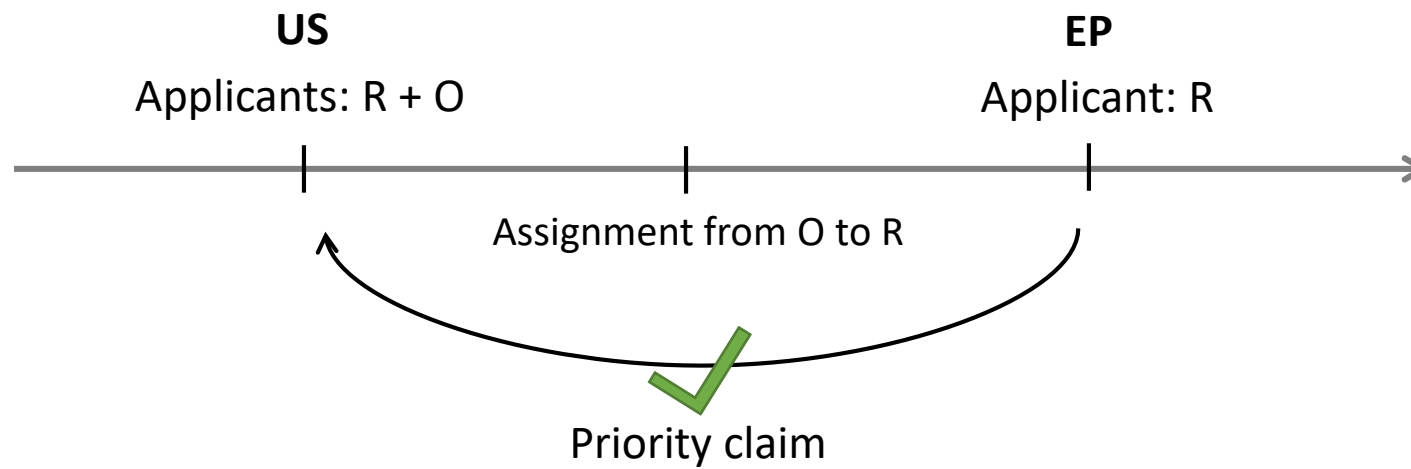
Strict standard for priority!



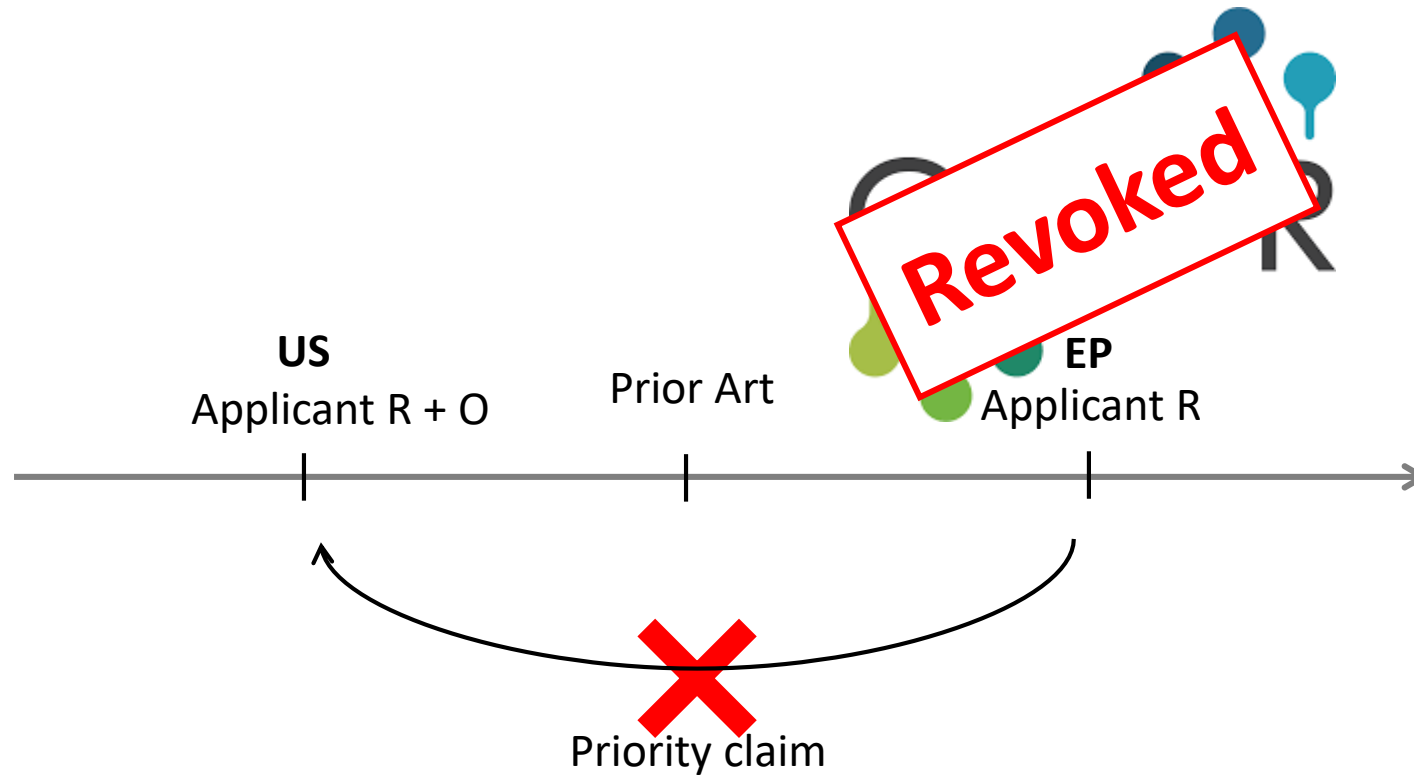
Pitfall #1: Priority entitlement



Pitfall #1: Priority entitlement

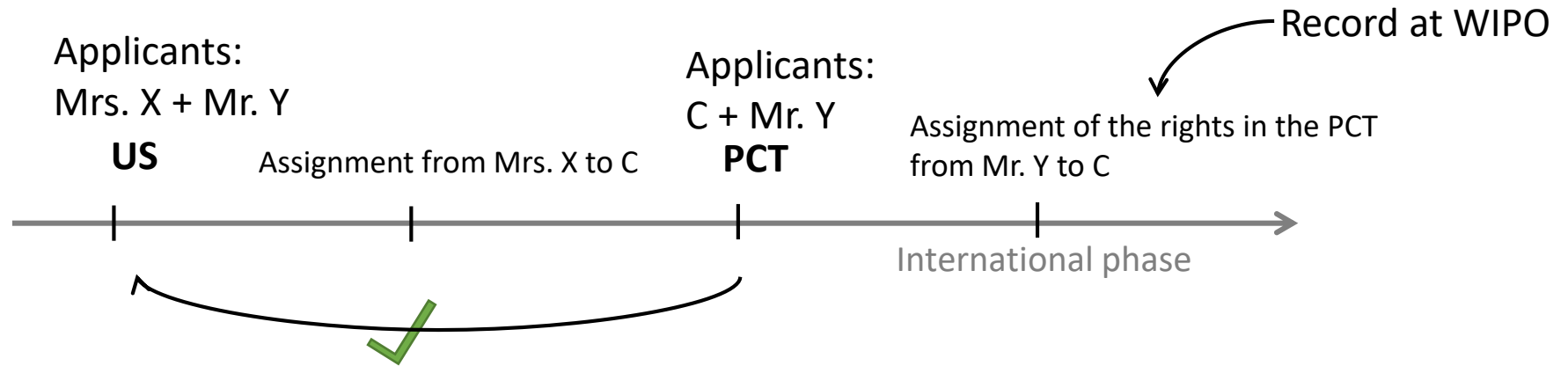
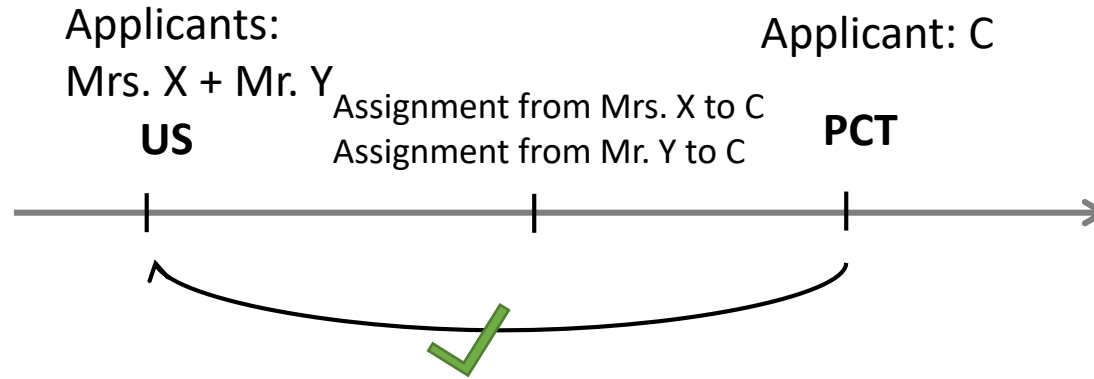


Pitfall #1: Priority entitlement

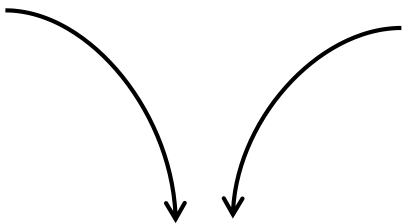


Pitfall #1: Priority entitlement

Practical advice



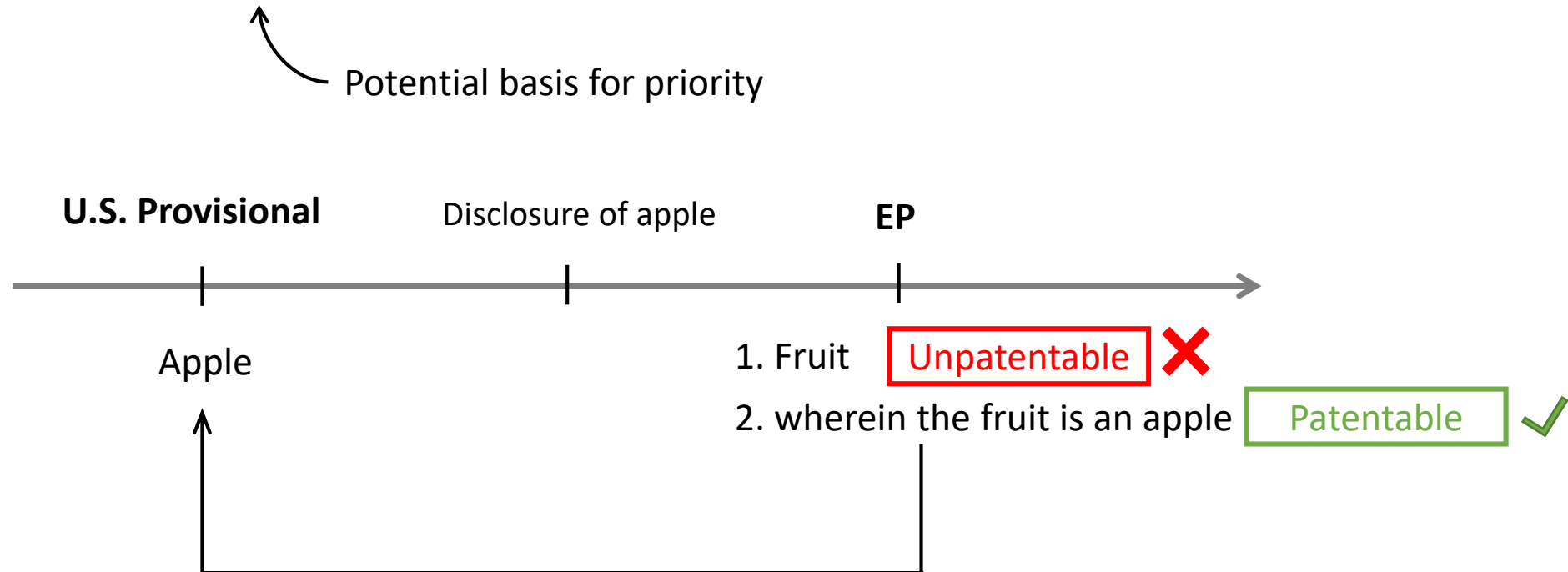
Pitfall #2: Claiming priority to a US provisional

Amendments during examination  = Art. 123(2) Test

The claim must be **directly and unambiguously derivable** from the disclosure of the invention in the priority document.

Pitfall #2: Claiming priority to a US provisional

U.S. Provisional without claims ?



Pitfall #2: Claiming priority to a US provisional

Practical advice

Drafting US Provisional:

Drafting EP Application:

Specification

No claims

Claim language

Narrow claims

Alternative embodiments

Broad claims

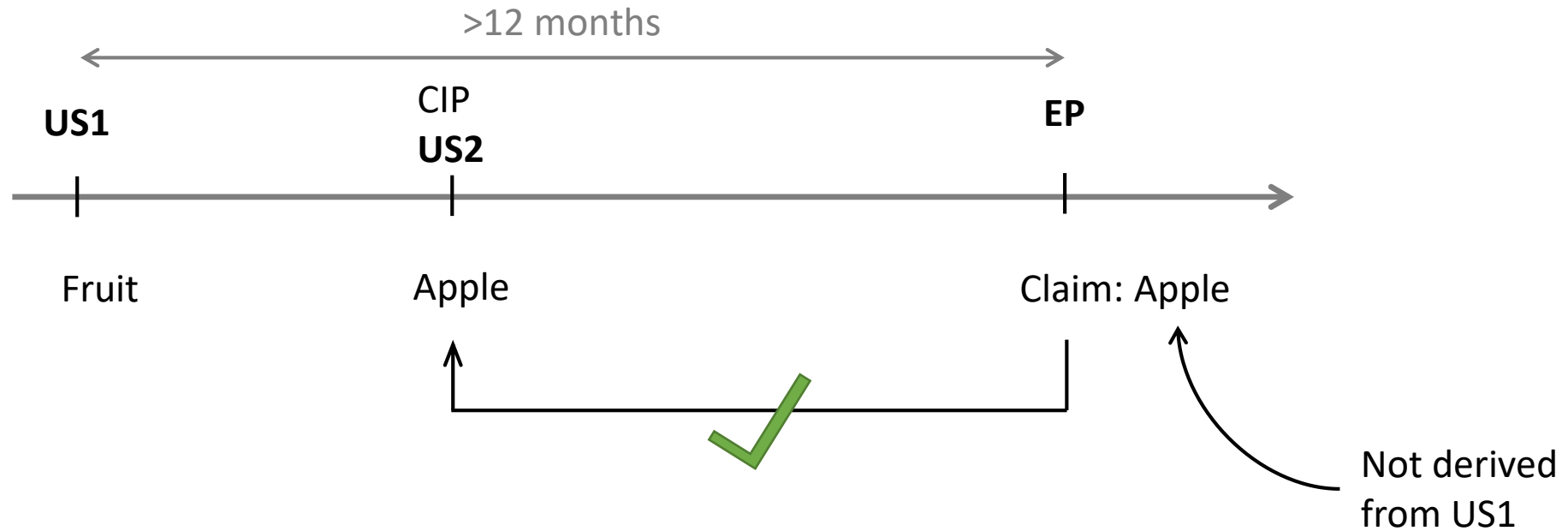
Specific embodiments

1. Broader claims
2. Claims of the US priority



Pitfall #3: Claiming priority to a CIP

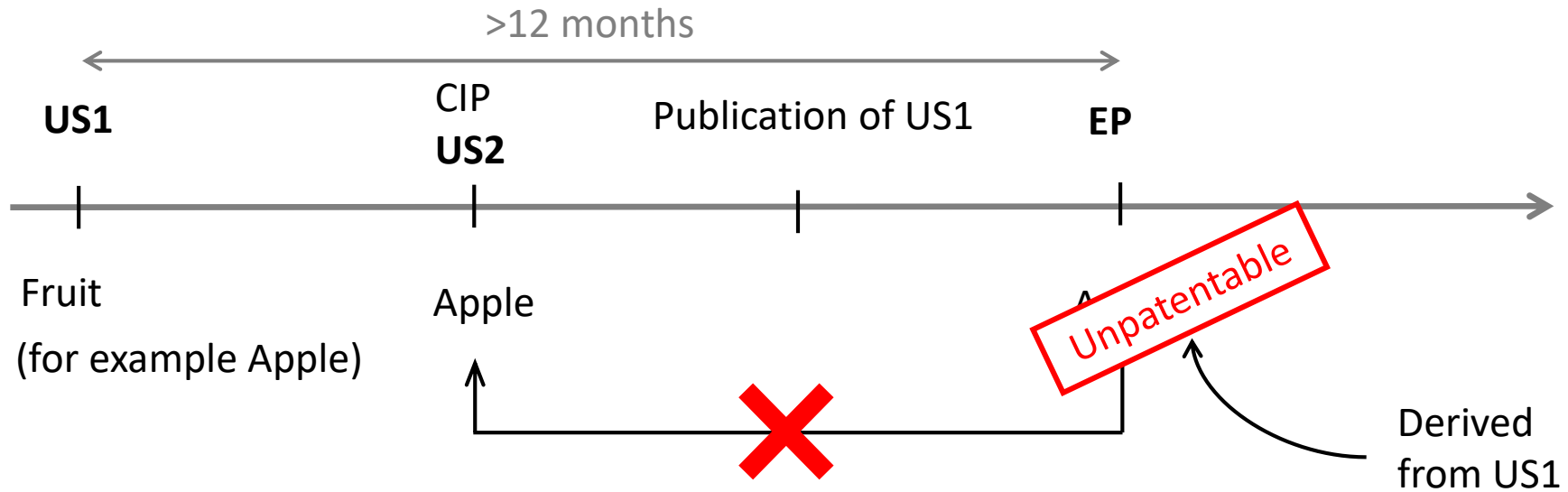
Case 1: Support for the EP Claims Only Found in the CIP



Pitfall #3: Claiming priority to a CIP

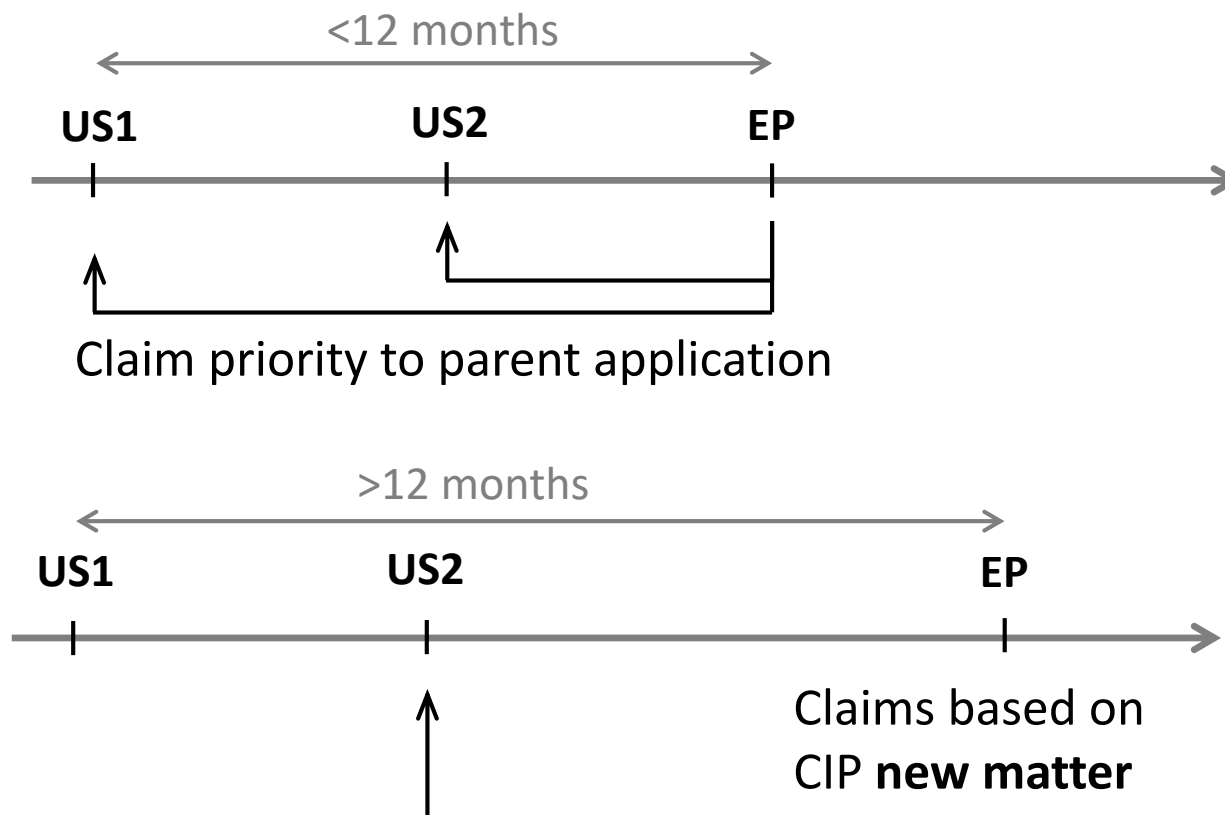
Strict standard for support is an advantage here

Case 2: Support for the EP Claims Found in the Parent Application

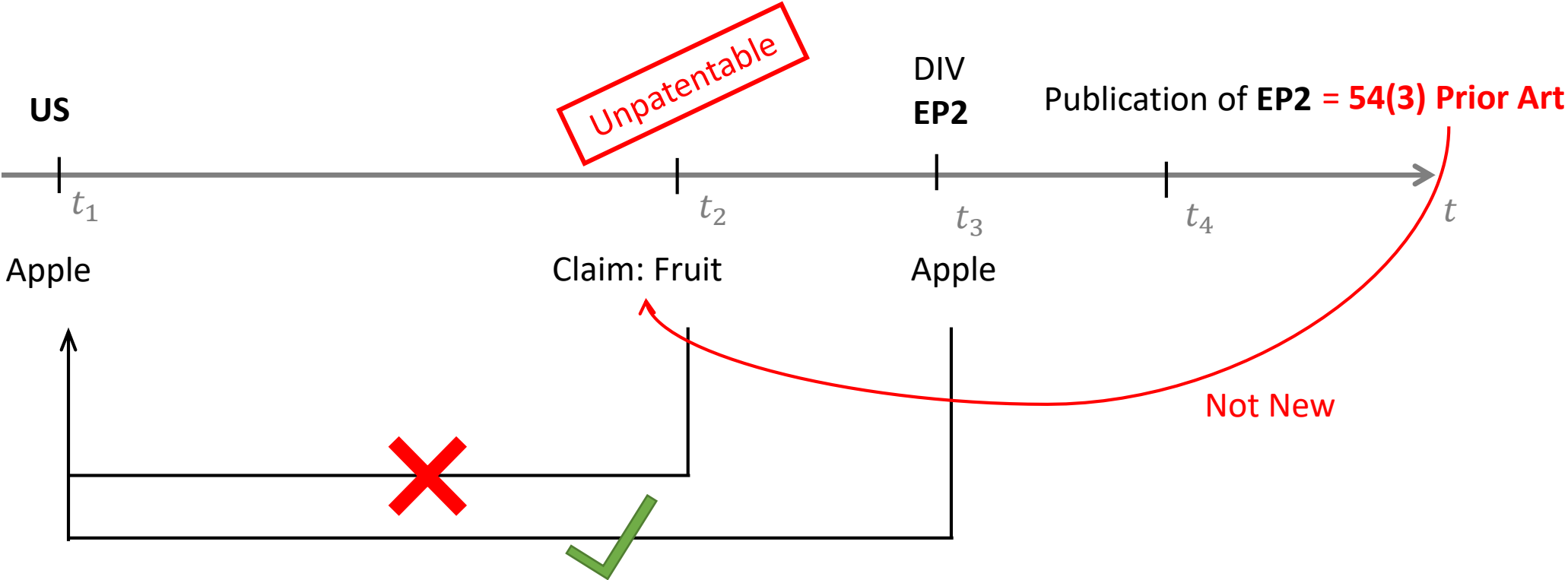


Pitfall #3: Claiming priority to a CIP

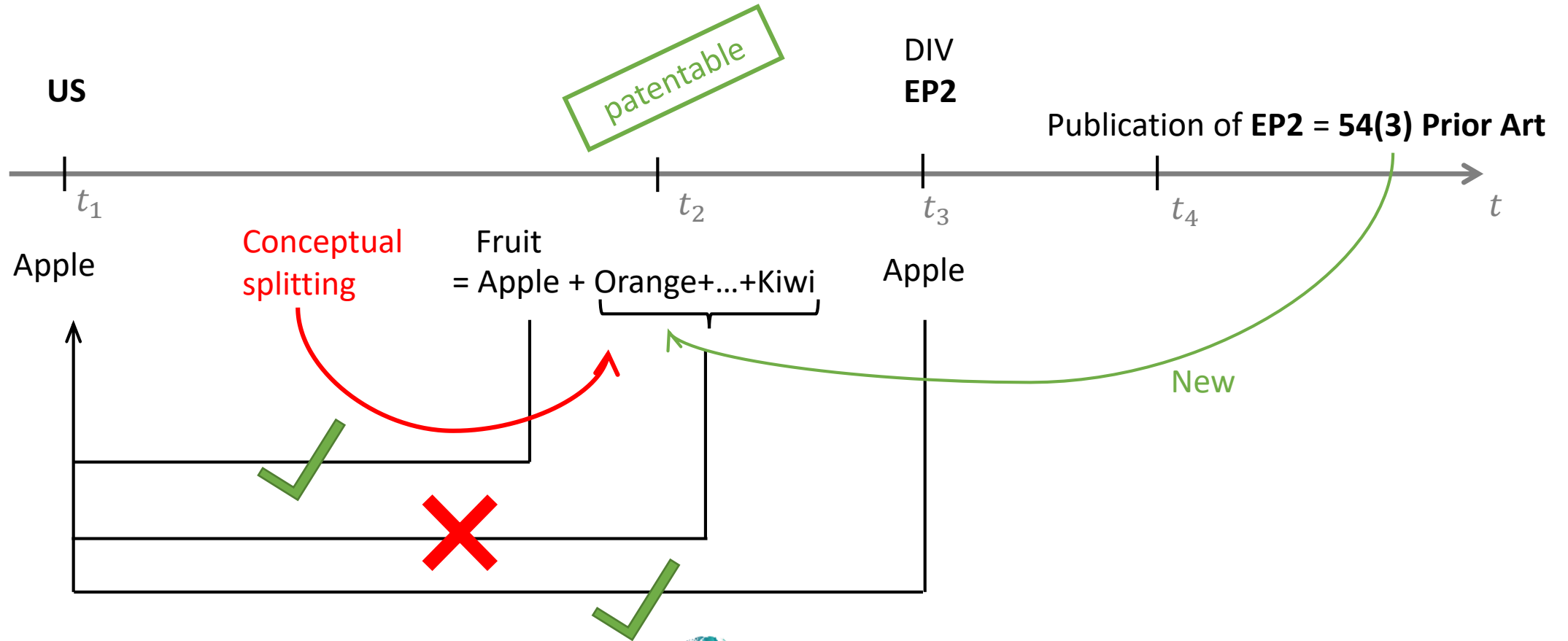
Practical advice



Poisonous Divisionals



Antidote to Poisonous Divisionals



Take-home message

- Pitfall #1: Priority entitlement

Obtain assignments before PCT filing

- Pitfall #2: Claiming priority to a US provisional

When broadening the claims, add dependent claims identical to the claims from the US Provisional

- Pitfall #3: Claiming priority to a CIP

Claim priority to parent application or Recite Claims based on CIP new matter

- Poisonous Divisionals

Do not fear filing divisional applications in Europe



The 123 of European nightmares.....

- Article 123 – added subject matter:
 - (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.



The one, two, three of European happiness

- One – Avoid incorporate by reference
- Two – Avoid embodiments
- Three – Draft fully – fill in the gaps



One –Avoid Incorporation by reference

- Features which are not disclosed in the description of the invention as originally filed but only disclosed in cross-referenced documents are prima facie in breach of Article 123 (2) EPC.
- However there are, IN THEORY, exceptions... Under certain circumstances features can be introduced by way of amendment into the application.



One –Avoid Incorporation by reference

- Such an amendment would not contravene Art. 123(2) if the description of the invention as originally filed leaves no doubt to a skilled reader that:
 - protection is or may be sought for such features;
 - such features contribute to solving the technical problem underlying the invention;
 - such features at least implicitly clearly belong to the description of the invention contained in the application as filed; and
 - such features are precisely defined and identifiable within the disclosure of the reference document.



One –Avoid Incorporation by reference

- Documents not available to the public on the date of filing of the application can only be considered if:
 - a copy of the document was available to the EPO, or to the PCT receiving Office, on or before the date of filing of the application; and
 - the document was made available to the public no later than on the date of publication of the application



Two –Avoid embodiments

- Avoid describing alternatives as different ‘embodiments’ – EPO examiners can use this to object to the claiming of combinations of features from different embodiments where no explicit combination is disclosed
 - Features cannot be taken from different embodiments - The content of an application must not be considered to be a reservoir from which features pertaining to separate embodiments of the application could be combined in order to artificially create a particular embodiment (EPO Examiner’s Guidelines)



Three – Draft fully – fill in the gaps

- Describe features at hierarchical levels (trunk, branches and leaves) not just at trunk (claims) and embodiments (leaves) level - fill in the information between the low level embodiments and the high level claims.
 - A fixing arrangement for fixing the panels can comprise a fixed arrangement such as the use of bonding, adhesive, and rivets, or a releasable arrangement, such as screws, bolts, clamps, and clips



Three – Draft fully – fill in the gaps

- If filing first in the US with single dependent claims, to provide good basis for claim amendments include the claim text at the end of the description as multiply dependent numbered examples, e.g.
 - A system comprising a widget.
 - A system according to example 1 comprising an additional widget.
 - A system according to example 1 or example 2 comprising a further widget.
 - A system according to any preceding example comprising a thing.



But remember

- The EPO will only allow one independent claim in each category (apparatus, method etc.)
- Multiple independent claims are allowed if (and only if) the subject matter of the application involves one of the following:
 - (a) a plurality of interrelated products eg plug and socket, transmitter and receiver
 - (b) different uses of a product or apparatus
 - (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives in a single claim



The one, two, three of European happiness

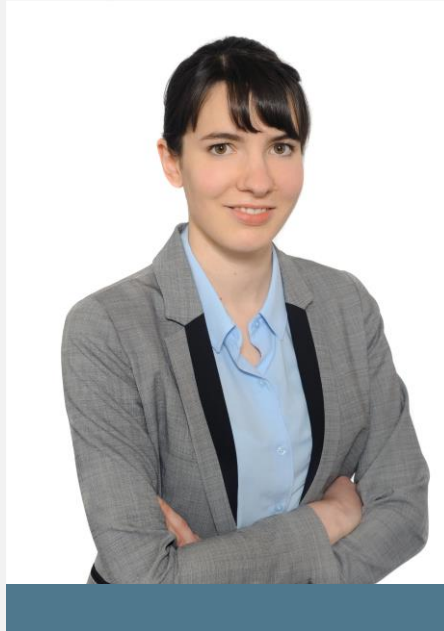
- One – Avoid incorporation by reference
- Two – Avoid embodiments
- Three – Draft fully – fill in the gaps



Questions?



Chris Gabriel
nbaptiste@slwip.com



Nathalie Baptiste
nbaptiste@slwip.com



Bryn Williams
Bwilliams@slwip.com

