

Learning path for patent examiners

Amendments: Intermediate level

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Introduction

This publication, "Amendments, Intermediate level", is part of the "Learning path for patent examiners" series edited and published by the European Patent Academy. The series is intended for patent examiners at national patent offices who are taking part in training organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include novelty, inventive step, clarity, unity of invention, sufficiency of disclosure, amendments and search. Also addressed are patenting issues specific to certain technical fields:

- patentability exceptions and exclusions in biotechnology
- assessment of novelty, inventive step, clarity, sufficiency of disclosure and unity of invention for chemical inventions
- the patentability of computer-implemented inventions, business methods, game rules, mathematics and its applications, presentations of information, graphical user interfaces and programs for computers
- claim formulation for computer-implemented inventions

Each publication focuses on one topic at entry, intermediate or advanced level. The explanations and examples are based on the European Patent Convention, the Guidelines for Examination in the EPO and selected decisions of the EPO's boards of appeal. References are made to the Patent Cooperation Treaty and its Regulations whenever appropriate.

The series will be revised annually to ensure it remains up to date.

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All references to natural persons are to be understood as applying to all genders.

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1. Learning objectives

Participants to this course will learn:

- What constitute the content of the application as originally filed in special cases
- How to evaluate the allowability of amendments by intermediate generalisation
- How to evaluate amendments in the description and in the drawings
- How to evaluate amendments via a disclaimer
- Admissibility and allowability requirements of amendments in opposition proceedings

2. Content of the application as "originally" filed – special cases

International applications

For the purposes of Article 123(2) EPC, the documents as originally filed are those originally filed in the PCT phase (normally published as a WO publication).

Therefore, amendments made during the PCT phase (including amended, substitute or rectified sheets, even if attached to the WO publication) or upon entry into the regional phase before the EPO must, if maintained in the European phase, fulfil the requirements of Article 123(2) EPC, and all such amendments must be carefully considered.

Divisional applications

The content of the application as originally filed for a divisional application corresponds only to the subject-matter of the divisional application as filed, not to the subject-matter of the parent application as filed.

Under Article 76(1) EPC, (2nd sentence), the subject-matter of a divisional application may not extend beyond the content of the parent application as originally filed. Additional subject-matter to that of the parent application needs to be removed. A divisional application needs to be assessed separately under Article 76(1) EPC, 2nd sentence, and under Article 123(2) EPC. Amendments made to the divisional application subsequent to its filing may not extend beyond the content of the divisional application as originally filed (Article 123 EPC).

Sequences of divisional applications are possible. A divisional application can be the earlier application in the sense of Article 76 EPC for a further divisional application. It is a necessary and sufficient condition for a divisional application of a sequence of divisional applications to comply with Article 76(1) EPC, 2nd sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed.

Missing parts of the description or missing drawings filed after the date of filing

Missing parts of the description and/or missing drawings allowed under Rule 56(3) EPC are always considered to be part of the application documents "as originally filed".

The procedure under Rule 56 EPC allows the applicant to file missing drawings or parts of the description subsequently, and to rely on the priority document in order to avoid the application being

re-dated to the date on which the missing parts were filed. Under Rule 56(3) EPC, re-dating is only avoided where the missing parts were "completely contained" in the priority document.

Note that the provisions of Rule 56(3) EPC apply only to the filing stage of the application, without further implications. In particular, it is not permissible at later stages of the procedure to rely on the priority documents to correct or amend the application as filed.

Applications filed by reference to an earlier application

Under Rule 40(1)(c) EPC, the applicant may file a European application by reference to a previously filed application. Since claims are no longer required in order for a date of filing to be accorded, applicants have three options:

- (i) When filing the European application, they can indicate that the reference to the previously filed application includes the claims.
- (ii) At the time of filing, they can file a new set of claims together with an indication that the description and any drawings are filed by reference to a previously filed application.
- (iii) When filing the European application, they can indicate the reference to a previously filed application and file the claims after the date of filing (Rule 58 EPC).

In cases (i) and (ii), the claims will form part of the application as originally filed whereas in case (iii) the claims filed after the date of filing will not and will thus have to fulfil the requirements of Article 123(2) EPC.

Features described in a document cross-referenced in the description

Features which are not disclosed in the description of the invention as originally filed but which are only described in a **cross-referenced document** identified in that description are *prima facie* **not** within "the content of the application as filed" for the purpose of Article 123(2) EPC.

It is only under particular conditions that such features can be introduced by way of amendment into the claims of an application.

Such an amendment would not contravene Article 123(2) EPC 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 thus to the content of the application as filed and
- such features are precisely defined and identifiable within the disclosure of the reference document

Priority document

Under Article 123(2) EPC, it is impermissible to add to a European application matter present only in the priority document for that application, unless this is done under the provisions of Rule 56(3) EPC.

Legal references:

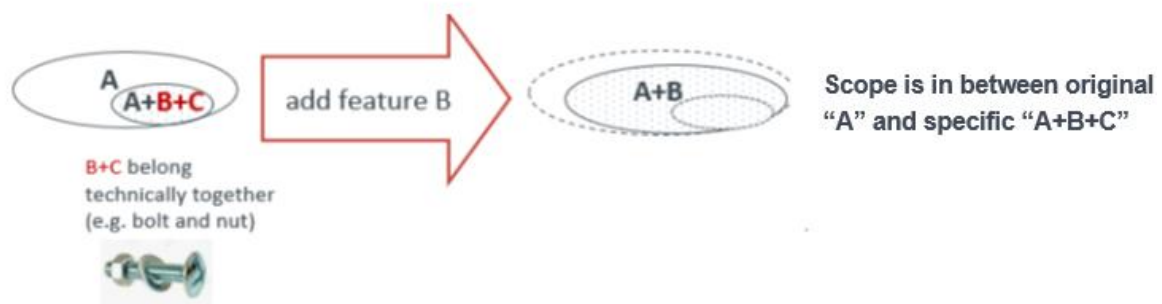
Art. 123(2) EPC, Art. 76(1) EPC, GL H-IV, 2.2, GL H-IV, 2.3, GL F-III, 8

3. Intermediate generalisation

Extracting a specific feature in isolation **from** an originally disclosed **combination** of features and using it to delimit claimed subject-matter may be allowed only if there is no structural and functional relationship between the features. This is known as an **intermediate generalisation**.

When evaluating whether the limitation of a claim by a feature extracted from a combination of features fulfils the requirements of Article 123(2) EPC, 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.

As illustrated in the picture below, an intermediate generalisation occurs when out of a disclosed specific combination of features ("A+B+C") only isolated features ("B") are used to amend a more generic context ("A").



When a feature is taken from a particular embodiment and added to the claim, it has to be established that:

- the feature is not related or inextricably linked to the other features of that embodiment
- the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim

In any case, it has to be ensured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using the common general knowledge.

Examples

Example 1

Application as originally filed:

Claim 1: A+B

The description discloses an embodiment with features A, B, C, D and E. In addition, the description explains that the features C, D and E are closely linked, structurally and functionally.

After amendment:

Claim 1: A+B+C

Basic test: is the skilled person presented with "new" information?

Answer:

Yes, because feature C is not known in the application as filed without features D and E. The overall disclosure does not justify deleting D and E from A+B+C+D+E.

The amendment to claim 1 is not allowable under Article 123(2) EPC.

Example 2

Application as originally filed:

Claim 1: A+B

The description discloses an embodiment with features A, B, C, D and E. In addition, the description explains that features C, D and E each produce a different technical effect.

After amendment:

Claim 1: A+B+C

Basic test: is the skilled person presented with "new" information?

Answer:

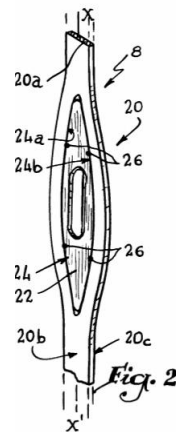
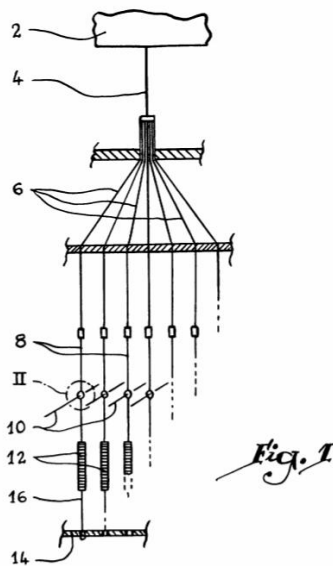
No, because the skilled person knows from the description that A+B+C would produce a technical effect independently of D and E. The overall disclosure justifies deleting D and E from A+B+C+D+E.

The amendment to claim 1 is allowable under Article 123(2) EPC.

Example 3

Application as originally filed:

Claim 1: heddle for the harness of a loom, wherein the heddle comprises features A and B



The description discloses a first embodiment in which the eyelet (22) of the heddle has the shape of a spindle.

The general part of the description mentions that the eyelet can also have other shapes such as an elliptical shape.

After amendment:

Claim 1: heddle for the harness of a loom, wherein the heddle comprises features A, B and an eyelet (22)

Basic test: is the skilled person presented with "new" information?

Answer:

No. Although the feature of the eyelet is described in a specific embodiment in which the eyelet has the shape of a spindle, the description also discloses that the eyelet can have other shapes. The specific shape of the eyelet is therefore not related or inextricably linked to the other features of that embodiment. In addition, the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim.

The amendment to claim 1 is allowable under Article 123(2) EPC.

Legal references:

GL H-V, 3.2.1

4. Amendments in the description

The applicant may amend the description for various reasons.

Bringing the description in line with amended claims

Under Rule 42(1)(c) EPC, the description must disclose the invention, **as claimed**, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art.

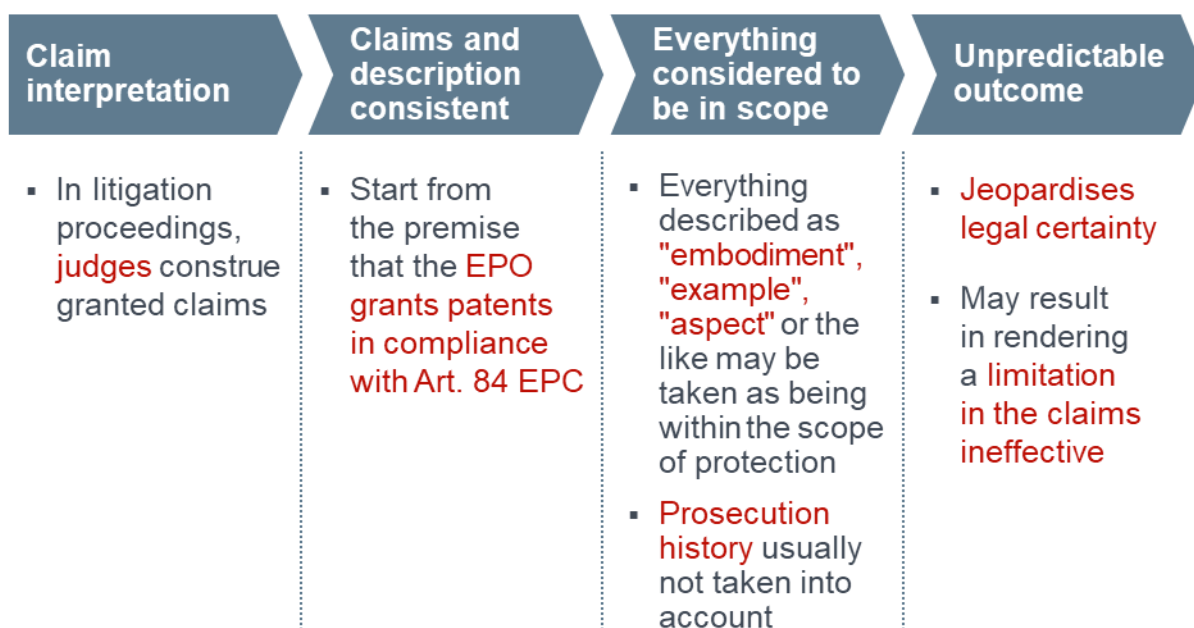
In addition, under Article 84 EPC, the claims have to be clear and concise and be **supported by the description**.

Consequently, if claims are amended, the description may need to be amended accordingly. Any inconsistency between the description and the claims must be avoided if it may throw doubt on the extent of protection and therefore render the claim unclear or unsupported under Article 84, second sentence, EPC or, alternatively, render the claim objectionable under Article 84, first sentence, EPC.

Another reason for bringing the description in line with amended claims is because national courts will use the description to interpret the claims, under Article 69(1), second sentence, EPC.

Article 69(1) EPC: "The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, **the description and drawings shall be used to interpret the claims.**"

The following diagram explains how judges construe the claims on the basis of the description. It also shows how a description not adapted to the claims jeopardises legal certainty.



Consequently, embodiments which no longer fall within the scope of claims should be deleted, or they should be marked appropriately to retain subject-matter useful for highlighting specific aspects of the invention or as background. In addition, the features required by the (amended) independent claims may not be described as being optional. Wording like "preferably", "may" or "optionally" must therefore be removed for the features required by the (amended) independent claims.

In addition, the "field of the invention" and "summary of the invention" may also need to be amended to correspond to the claims.

It is down to applicants to bring the description in line with the amended claims because the final responsibility for the text of the patent lies with them. If the description is not amended as required despite requests to do so, the non-compliance is a reason for refusal on the ground of Article 84 EPC.

Acknowledging prior art

Another reason for amending the description relates to Rule 42(1)(b) EPC, under which the description must indicate the background art which, as far as is known to the applicant, can be regarded as useful to understand the invention, draw up the European search report and examine the European patent application, and, preferably, cite the documents reflecting such art.

Revising the problem stated

In some cases, the applicant may wish to amend the problem stated in the description. This may be the case, for example, when the claims have been restricted in order to address an objection for lack of inventive step and the stated problem needs revising to emphasise an effect that the thus restricted invention can attain but the prior art cannot.

The problem stated in the description may be amended only if the skilled person can readily deduce the emphasised effect from the application as filed.

If the suggested amendment would contravene Article 123(2) EPC, it will be necessary to amend the description in some other way, e.g. by defining the problem in more general terms or by omitting any express statement of the problem altogether.

Subsequently clarifying or adding effects of the invention

If the skilled person can readily deduce the effect of a technical feature despite its not being mentioned in the application as originally filed, clarifying the effect does not contravene Article 123(2) EPC.

Removing subject-matter

The description may need to be amended by deleting subject-matter from it. If the examining division maintains a non-unity objection, for example, the applicant is invited to state on which invention the prosecution of the application should be based and to limit the application accordingly by removing any parts belonging to the other inventions (the applicant may file divisional applications for these inventions).

In general, deleting subject-matter (e.g. a complete embodiment) does not present the skilled person with new information.

Legal references:

Art. 123(2) EPC, Art. 84 EPC, Art. 69 EPC, R. 42(1)(b), (c) EPC, GL H-V, 2, GL F-IV, 4.3, GL C-V, 4.5

5. Amendments to drawings

Amendments to drawings are possible but must comply with Article 123(2) EPC.

Sometimes, the drawings used for publication of the application are not those originally filed but are subsequently filed drawings, because the latter are more suitable for reproduction. It should be verified that the subsequently filed drawings do not contain new technical information, which would conflict with Article 123(2) EPC.

It is normally **not** possible under Article 123(2) EPC to add completely new drawings to an application since in most cases a new drawing cannot be unambiguously derivable from the mere text of the description.

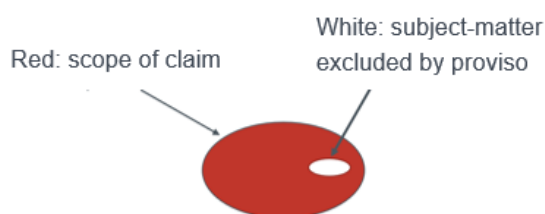
Legal references:

GL H-V, 5

6. Disclaimer

A disclaimer is a negative feature in a claim, expressly stating that a particular technical feature is excluded from the scope of the claim. The negative limitation includes the technical feature itself and a means (e.g. lexical, grammatical) to express the absence/exclusion.

Once a disclaimer has been introduced, the remaining subject-matter should be less than that of the unamended claim.



There are three categories of disclaimers:

1. The claims were already drafted with a disclaimer (e.g. "not molecule XY") or the claims already contain a negative limitation in the form of a disclaimer (e.g. "feature X is of a material other than iron ...").
2. A working embodiment of the application **as claimed/as disclosed** is disclaimed in the course of the proceedings ("**disclosed** disclaimer") (G.2/10).
3. An embodiment **not disclosed** in the original documents is disclaimed in the course of the proceedings ("**undisclosed** disclaimer") (G.1/03).

The allowability criteria differ depending on the type of disclaimer.

1. If the claims were already drafted with a disclaimer or the claims already contain a negative limitation in the form of a disclaimer, there is no amendment as such.
2. The allowability of a **disclosed** disclaimer depends on whether the subject-matter remaining in the claim after the introduction of the disclaimer is directly and unambiguously disclosed in the application as filed to the skilled person, be it explicitly or implicitly, in light of their common general knowledge at the date of filing.
3. The allowability of an **undisclosed** disclaimer depends on whether:
 - the disclaimer restores novelty over a disclosure under Article 54(3) EPC
 - the disclaimer restores novelty over an accidental anticipation under Article 54(2) EPC or

An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention. An accidental disclosure has nothing to do with the teaching of the claimed invention and is not relevant for examining inventive step.

- the disclaimer removes subject-matter which, under Articles 52-57 EPC, is excluded from patentability for non-technical reasons

These criteria notwithstanding, the introduction of an undisclosed disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. The disclaimer may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. Hence, inventive step has to be assessed disregarding the undisclosed disclaimer.

The disclaimer may not remove more than necessary either to restore novelty (cases (i) and (ii) above) or to disclaim subject-matter excluded from patentability for non-technical reasons (case (iii) above).

Legal references:

GL H-V, 4, GL H-V, 4.1, GL H-V, 4.2, G 2/10, G 1/03

7. Compliance of amendments with other EPC requirements

An amended application must satisfy all the requirements of the EPC.

In opposition proceedings, amendments made to the patent must be examined as to whether they comply with the EPC as a whole.

- Clarity requirements must be fulfilled (G 3/14).
- Exception: Article 82 EPC (G 1/91).

In limitation proceedings at the EPO, the amended claims are to be examined only with regard to Article 84 and Article 123(2) and (3) EPC.

Legal references:

R. 95 EPC, GL H-IV. 4.1, G 3/14, G 1/91

8. Extending the scope of a patent

Opposition proceedings frequently give rise to amendments to the claims, as a result of grounds for opposition raised under Article 100 EPC.

In these cases, under Article 123(3) EPC, the claims of the European patent may not be amended **in such a way as to extend the protection conferred by the patent**.

The aim of Article 123(3) EPC is to protect the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there is a basis for doing so in the application as filed.

This is based on decision G 1/93 of the Enlarged Board of Appeal, Reasons, 9:

"With regard to Article 123(2) EPC, the underlying idea is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. Article 123(3) EPC is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed."

Examples

Application as originally filed:

Claim 1: A+B

Patent as granted:

Claim 1: A+B+C

After grant, an opponent files an objection on the ground of Article 100(c) EPC because feature C is not disclosed in combination with features A and B in the application as originally filed.

In the opposition proceedings, the proprietor amends the claim to remove feature C.

Claim 1 as amended in opposition proceedings: A+B

Although claim 1 as amended in the opposition proceedings fulfils the requirement of Article 123(2) EPC because the application as originally filed disclosed the combination A+B, the requirement of Article 123(3) EPC should also be fulfilled.

Legal references:

Art. 123(3) EPC, GL H-IV, 3, G. 1/93

9. Admissibility of amendments in opposition proceedings

Any amendments made in opposition proceedings must be **occasioned by a ground for opposition** (Rule 80 EPC). Any part of the granted patent – description, claims and drawings – may be amended as long as the amendments are occasioned by a ground for opposition under Article 100 EPC, even if that ground has not been invoked by the opponent.

The grounds for opposition under Article 100 EPC are:

- a. the subject-matter of the European patent is not patentable under Articles 52 to 57 EPC
- b. the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art
- c. the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed under Article 61 EPC, beyond the content of the earlier application as filed

If patent proprietors request amendments going beyond those permissible under Rule 80 EPC, they are invited to withdraw them. If they do not, the request is not admitted.

Further amendments may be admissible:

If the proprietor proposes amendments to the patent in reply to the grounds for opposition and the opposition division intends to maintain the patent in amended form pursuant to those grounds, other amendments not related to the grounds for opposition (e.g. clarifications), or corrections, may be allowed provided that the patent thus amended still fulfils the requirements of the EPC and that the amendments are considered necessary and appropriate. In particular, if one part of a claim has been amended, it may be necessary or appropriate to amend other parts of the claim as well.

Moreover, where a "clarification" can be considered a limitation of the claim, it would be admissible under Rule 80 EPC and could form the basis for maintaining the patent in amended form, provided the other requirements of the EPC are also met by the amended text. If the division is of the opinion that such a limiting clarification is not necessary, it needs to consider that the practice of interpreting a claim in a contracting state may be quite different from that at the EPO, and hence the patentee may see a need for such a limiting clarification.

Such amendments, however, are not proposed by the opposition division and they can only be taken into consideration up to the pronouncement of the decision (in oral proceedings) or until the date the decision is handed over to the EPO's internal postal service for transmittal to the parties (in written proceedings).

If an otherwise allowable request for maintenance of the opposed patent either as granted or in amended form has been submitted, the following amendments are not allowed:

- a. filing of further claims
- b. comprehensive redrafting of the dependent claims
- c. comprehensive redrafting of the description

Amendments in opposition proceedings may also be admissible other than under Rule 80 EPC if they constitute corrections (e.g. under Rule 139 EPC, Guidelines H-VI, 3.1, Guidelines H-II, 3.2).

Examples

Example 1

A patent is granted with an independent claim 1 and claims 2 and 3, which are both dependent on claim 1.

After grant, an opposition is filed citing a document that prejudices the novelty of claim 1 as granted.

The proprietor merely amends claim 2 by combining it with claim 3, without any further explanation. It does not amend independent claim 1.

Is the amendment occasioned by a ground for opposition under Article 100 EPC?

No, because combining claims 2 and 3, without amending claim 1, is not occasioned by any ground for opposition under Article 100 EPC.

Example 2

A patent is granted with an independent claim 1 and claims 2 and 3, which are both dependent on claim 1.

After grant, an opposition is filed citing a document that prejudices the novelty of claim 1 as granted.

In the opposition proceedings, the proprietor merely amends claim 2 by combining it with claim 3, explaining that this amendment is to remove added subject-matter. Independent claim 1 is not amended and the proprietor submits arguments refuting the opponent's objection regarding the novelty of claim 1.

Is the amendment occasioned by a ground for opposition under Article 100 EPC?

Yes, claims 2 and 3 have been amended to overcome a ground for opposition (Article 100(c) EPC). The amendment is occasioned by a ground for opposition under Article 100 EPC even though it has not been invoked by the opponent.

Legal references:

R. 79 EPC, R. 80 EPC, GL H-II, 3

10. Allowability of amendments under Article 123(3) EPC

To evaluate the allowability of an amendment under Article 123(3) EPC, **the text of the amended claims** has to be **compared with the claims of the patent** as granted or as amended in opposition or earlier limitation proceedings, whichever are the most recent in force.

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

The extent of protection conferred by a European patent is determined by the claims. Nevertheless, the description and drawings are to be used to interpret the claims.

The Protocol on the Interpretation of Article 69 EPC, which, pursuant to Article 164(1) EPC, is an integral part of the EPC, specifies how Article 69 is to be interpreted.

Since, pursuant to Article 69(1) EPC, amendments to the description and drawings will also influence the interpretation of the claims and may therefore extend the protection conferred, any such amendments extending protection in this way are not allowable.

Bear in mind that the requirements of Article 123(2) and (3) EPC have to be dealt with separately:

- a. Examination for compliance with Article 123(2) EPC is conducted in the same way as in examination proceedings.
- b. Examination for compliance with Article 123(3) EPC, on the other hand, is based on the claims as granted, or as amended in opposition or earlier limitation proceedings, where necessary using the description and drawings to interpret the claims (Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC).

Examples

Example 1

Application as originally filed:

Claim 1: A+B

Patent as granted:

Claim 1: A+B+C

After grant, an opponent files an objection on the ground of Article 100(c) EPC because the application as originally filed does not disclose feature C in combination with features A and B.

In the opposition proceedings, the proprietor amends the claim to remove feature C.

Claim 1 as amended in the opposition proceedings: A+B

Although claim 1 as amended in the opposition proceedings fulfils the requirements of Article 123(2) EPC because the application as originally filed disclosed the combination A+B, the requirements of Article 123(3) EPC should also be fulfilled.

Claim 1 of the patent as granted defined the combination of A+B+C, and removing feature C in claim 1 as amended in the opposition proceedings constitutes an extension of the scope of protection.

Consequently, the amendment to claim 1 in the opposition proceedings is not allowable under Article 123(3) EPC.

Example 2

Application as originally filed:

Claim 1: A+B

The description also defines features C and D in combination with features A and B.

Patent as granted:

Claim 1: A+B+C

After grant, an opponent files an objection on the ground of Article 100(c) EPC because the application as originally filed discloses feature C in combination with features A, B **and D**.

In the opposition proceedings, the proprietor amends the claim to add feature D.

Claim 1 as amended in the opposition proceedings: A+B+C+D

Claim 1 as amended in the opposition proceedings fulfils the requirements of Article 123(2) EPC because the application as originally filed disclosed the combination A+B+C+D.

Moreover, adding feature D to claim 1 of the patent as granted constitutes a limitation of the scope of claim 1 as granted.

Consequently, the amendment to claim 1 in the opposition proceedings is allowable under Article 123(3) EPC.

Example 3

A composition which is specified in a claim as comprising a component in an amount defined by a numerical range of values is subject to an implicit proviso excluding the presence of that component in an amount outside that range.

An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of limiting the scope of this implicit proviso. However, a composition which is defined as comprising the components indicated in the claim is open to the presence of any further components unless otherwise specified. Therefore, in a claim directed to this kind of openly defined composition, the restriction of the breadth of a component present in it may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition proceedings this amended claim may extend the protection conferred by the granted patent (Article 123(3) EPC) (see T.2017/07 and T.287/11).

Restricting the breadth of the component means that certain materials are no longer explicitly limited by the claim and therefore can be present in amounts which were excluded from the claim as granted.

(GL. H-IV, 3.4)

Legal references:

Art. 123(3) EPC, Art. 69 EPC, GL H-IV, 3

11. Beyond the course

You can deepen what you have learned during this course with the following further readings:

- Guidelines for Examination in the European Patent Office, part H-I to H-V

- Case law book of the Boards of Appeal of the European Patent Office: part II-E, 1 and 2

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