

Learning path for patent examiners

Amendments: Entry level

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1. Learning objectives

Participants to this course will learn:

- what is an amendment;
- what are the different types of amendments;
- the stages at which amendments may be submitted;
- what are the requirements for admitting amendments;
- how to evaluate in simple cases whether an amendment is allowable.

2. The right to amend

A European patent application or European patent may be amended in examination, opposition and limitation proceedings at the EPO.

This is reflected in Article 123(1) EPC: "The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations."

An amendment is an alteration or change to the application or patent, to give it a different – usually improved – form. The applicant or patentee makes an amendment, for example, to restrict the scope of a claim in order to overcome objections raised in view of the available prior art.

Article 123(1) EPC refers to both patent applications and European patents. European patents may be amended in opposition proceedings, in which case a patent may ultimately be maintained in amended form (Article 101(3) EPC). European patents may also be amended in limitation proceedings at the EPO (Article 105b EPC) at the proprietor's initiative (Article 105a(1) EPC).

The right to amend is subject to specific requirements, namely that amendments must be admissible, i.e. meet the requirements for being admitted into the proceedings, and also allowable.

These requirements apply because applicants should not improve their position by adding subject-matter not disclosed in the application as originally filed – this would give them an unwarranted advantage and could jeopardise the legal certainty for third parties relying on the content of the application as originally filed (Article 123(2) EPC). This principle applies also to European patents, i.e. patentees should not improve their position by extending the scope of a granted patent in a way that would otherwise jeopardise the legal certainty for third parties relying on the scope of the patent as granted (Article 123(2) and (3) EPC).

The requirements regarding the right to amend are assessed from the standpoint of the skilled person on a technical and reasonable basis, avoiding artificial and semantic constructions.

The right to amend differs depending on the stage of the procedure.

At the **search stage**, applicants are not entitled to make amendments before receiving the European search report, unless the Receiving Section invites them to remedy deficiencies (Rule 137(1) EPC) (exception: Euro-PCT application; Article 153(7) EPC).

For Euro-PCT applications requiring a supplementary European search (Article 153(7) EPC), the applicant may amend the originally filed claims, description and/or drawings before the application is subject to the supplementary search.

In **examination**, applicants are given at least one opportunity to amend the application of their own volition (Article 123(1) EPC).

Rule 137(3) EPC gives the examining division discretionary power to refuse further amendments, particularly in order to bring the examination phase to an end. Nevertheless, the "right to be heard" (Article 113(1) EPC) must be respected.

After **grant**, the right to amend is further limited (e.g. Rule 80 EPC in opposition; Rule 95 EPC in limitation proceedings).

Legal references:

Art. 123 EPC, Art. 101(3) EPC, Art. 105b EPC, GL H-I

3. Content of the application as "originally" filed

Under 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**.

The content of the application as filed is made up of the claims, the description and drawings in the original language (Article 70(2) EPC). It does not include the abstract or the priority document.

The content of the application as originally filed also includes any features implicitly disclosed to a person skilled in the art. The term "implicit disclosure" means the **clear and unambiguous consequence** of what is explicitly mentioned in the application as filed. The common general knowledge must thus be taken into account when deciding what is clearly and unambiguously implied by the explicit disclosure of a document. Section G-VII, 3.1 of the Guidelines for Examination provides further details of what is considered as common general knowledge.

Attention is drawn to the fact that the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implicitly disclosed by that document.

Other aspects may also be considered within the content of the application as originally filed, but this is subject to specific requirements. Cross-referenced documents cited in the description, missing parts of the description or drawings filed after the filing date, claims filed after the filing date and sequence listings filed after the filing date are some examples. Section H-IV, 2.2 of the Guidelines for Examination provides further details.

Examples

The description of the application as originally filed discloses an apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support.

What is the content of the application as originally filed?

The content of the application as originally filed includes the disclosure of the apparatus mounted on resilient supports but not the fact that said supports are helical springs.

The application as originally filed does not explicitly disclose using helical springs, and this cannot be deemed implicit because various other options are possible (air springs, leaf springs, rubber elements, etc.). Using helical springs is therefore not a **clear and unambiguous consequence** of having the apparatus mounted on resilient supports.

Legal references:

Art. 123(2) EPC, Art. 76(1) EPC, GL H-IV, 2.2, GL G-VII, 3.1

4. Admissibility of amendments

5. Indicating the basis for amendments

When filing amendments, the applicant must (i) identify them and (ii) indicate the basis for them in order to enable the division to assess whether they comply with the provisions of Article 123(2) EPC.

To this end, the division may request that amendments have to be indicated either with respect to the immediate previous amendments in the sequence or with respect to the application as originally filed. The requirement to indicate amendments is to be understood as an opportunity for the applicant to provide convincing arguments to the division as to why the amendment(s) is/are directly and unambiguously derivable from the application as filed. These arguments are particularly important for the outcome of the division's assessment of Article 123(2) EPC where literal support for the amendment(s) is not present in the original application.

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. If the deficiency is not remedied, the application is deemed to be withdrawn (Article 94(4) EPC).

Whether the requirements of Rule 137(4) EPC are met is assessed independently of whether the amendments in question comply with Article 123(2) EPC; it is a matter of admissibility. For example, the applicant may indicate that a particular amendment is based on a technical feature disclosed only in a schematic drawing. If the feature supposedly forming the basis for the amendment is indeed disclosed in the drawing indicated by the applicant, the requirements of Rule 137(4) EPC are met, irrespective of whether the amendment based on that technical feature is allowable under Article 123(2) EPC.

Legal references:

R. 137(4) EPC

6. Allowability of amendments

Once the competent department has admitted an amendment into the proceedings, it must then decide whether the amendment is allowable, i.e. whether it satisfies the requirements of the EPC. It is important to note that an admissible amendment is not automatically allowable.

Legally speaking, the allowability of amendments is a question of whether the application thus amended is allowable. An amended application must of course satisfy all the requirements of the EPC. Regarding Article 123 EPC, if the applicant seeks to amend the description (other than

references to the prior art), the drawings or the claims in such a way as to introduce subject-matter which extends beyond the content of the application as filed, the application thus amended cannot be allowed.

An amendment is therefore considered **unallowable** if it introduces subject-matter which extends beyond the content of the application as originally filed, i.e. if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not **directly and unambiguously derivable** from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art.

In **opposition** proceedings, a further requirement needs to be fulfilled 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. 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 is a basis for doing so in the application as filed.

Examples

If an application as originally filed relates to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that it is possible to add a further ingredient not disclosed in the application as originally filed, then this amendment is normally objected to as contravening the requirement of Article 123(2) EPC.

Legal references:

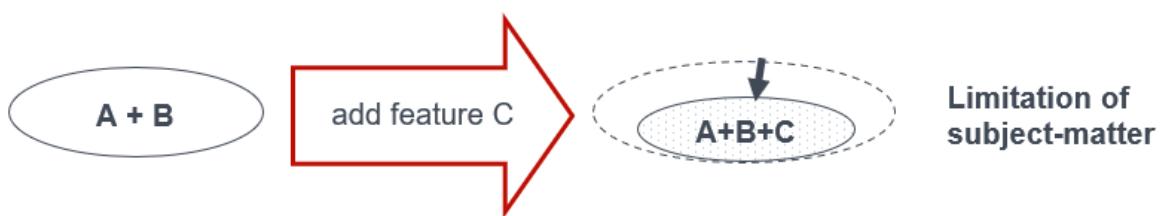
Art. 123(2), (3) EPC, GL H-IV, 2.1.

7. Overview of amendment types

Amendments may be categorised as follows:

Amendment by addition:

Addition (e.g. to overcome novelty objection)

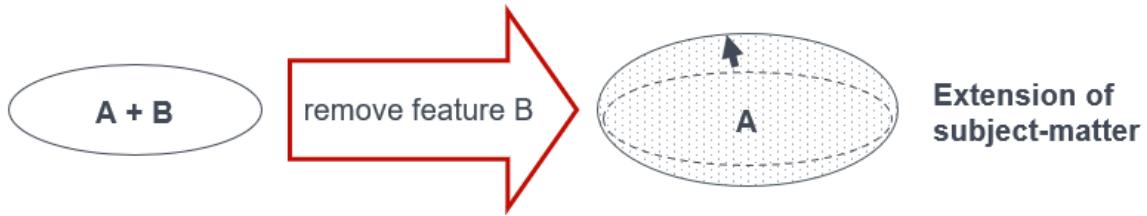


A claim may be limited by including additional features, for example:

- from dependent claims that were dependent on the claim to be limited
- from the description (see also Guidelines H-V, 3.2.1)
- from drawings (see Guidelines H-V, 6)
- resulting from an independent claim being converted to a dependent claim

Amendment by removal:

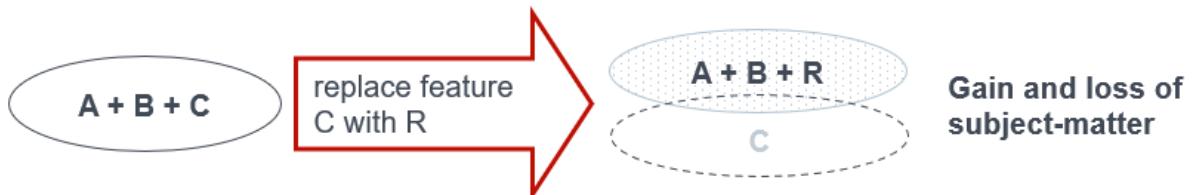
Removal (e.g. no relevant prior art found during search)



Deleting parts of the claimed subject-matter is permissible if the corresponding embodiments were originally described, e.g. as alternatives in the claim or as embodiments explicitly set out in the description.

Amendment by replacement:

Replacement (e.g. to overcome novelty objection)

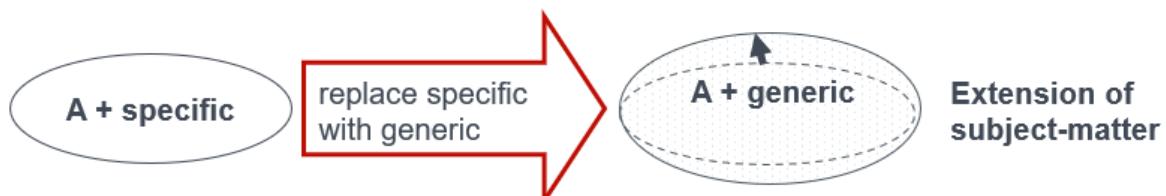


A claim feature may also be replaced with another one. In the example above, feature C is replaced with feature R.

In all the above cases, in order to determine whether the amendment fulfils the requirements of Article 123(2) EPC, it should be evaluated whether the amendment introduces subject-matter which extends beyond the content of the application as originally filed, i.e. if the overall change in the content of the application results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the original application, even when account is taken of matter which is implicit to a person skilled in the art.

Amendment by generalisation:

Generalisation (e.g. no relevant prior art found during search)



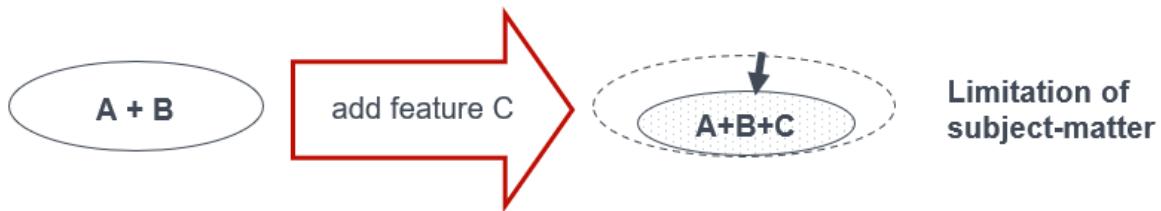
Replacing a **specific** feature with a more **generic** one
(copper – metal; alarm clock – clock)

Claim features may be generalised, for example by replacing a specific feature of "two devices connected by a screw" with a generic feature of "two devices connected by fastening means".

8. Amendment by adding features

A claim may be limited by the inclusion of additional features, provided **the resulting combination was directly and unambiguously disclosed** in the application as originally filed in an explicit or implicit manner and does not relate to an invention which was not searched.

Addition (e.g. to overcome novelty objection)



A special case may arise if a particular feature is extracted in isolation from an originally disclosed combination of features (for example in the description) and used to delimit claimed subject-matter. This "intermediate generalisation" may be allowed only if there is no structural and functional relationship between the features (see Guidelines H-V, 3.2.1).

Examples

Example 1

Application as originally filed:

Claim 1: A+B

Claim 2 (dependent on claim 1): C

After amendment:

Claim 1: A+B+C

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

Answer:

No, A+B+C is known from the application as originally filed since claim 2 as originally filed depends on claim 1.

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

Example 2

Application as originally filed:

Claim 1: A+B

C not mentioned in the application as originally filed

After amendment:

Claim 1: A+B+C

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

Answer:

Yes – since C is not disclosed in the application as originally filed, the skilled person is presented with new information: A+B+C.

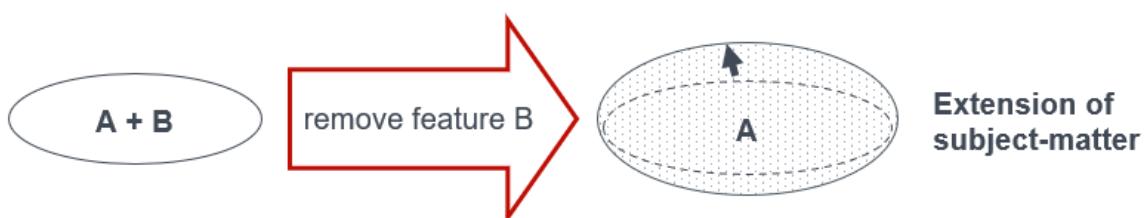
The amendment to claim 1 is not allowable under Article 123(2) EPC.

Legal references:

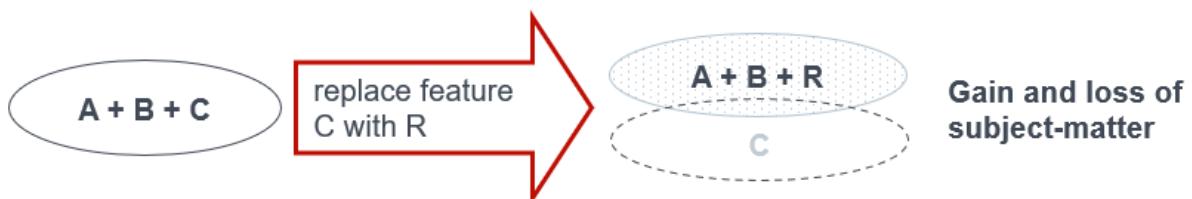
GL H-V, 3.2

9. Amendment by replacing or removing features

Removal (e.g. no relevant prior art found during search)



Replacement (e.g. to overcome novelty objection)



A claim may be amended by removing a feature from the claim as originally filed or by replacing a feature with another one.

The requirement of Article 123(2) EPC is only met if the replacement or removal of a feature lies 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 (or the date of priority as per Article 89 EPC), from the whole of the original application documents.

If the amendment by replacing or removing a feature from a claim fails to pass the following test – known as the **essentiality test** – by at least one criterion, it necessarily contravenes the requirements of Article 123(2) EPC:

- The replaced or removed feature was not stated as being essential in the originally filed disclosure.
- The skilled person would directly and unambiguously recognise that the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention

serves to solve (in this context, special care needs to be taken in cases where the technical problem is reformulated during the proceedings; see Guidelines H-V, 2.4, and G-VII, 11).

- The skilled person would recognise that the replacement or removal requires no modification of one or more features to compensate for the change (it does not in itself alter the invention).

Even if the above criteria are met, the division must still ensure that the amendment by replacing or removing a feature from a claim satisfies the requirements of Article 123(2) EPC ("the replacement or removal of a feature lies within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge").

Examples

Example 1

Application as originally filed:

Claim 1: (A+B) + (C+D)

The description states that C and D are functionally linked.

After amendment:

Claim 1: A+B+C

Essentiality test:

Removing D makes it necessary to modify other features since feature C is known only in combination with D and no effect for C alone is known.

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

Example 2

Original claim:

"An electric car, comprising an electrical engine, a rechargeable battery for providing power to the engine and a solar panel."

Original description:

"[...] The solar panel recharges the rechargeable battery [...]."

Amended claim:

"A car, comprising an electrical engine and a solar panel."

The description only describes a solar panel for charging a battery, so the battery is essential to the invention.

Removing the battery from the claim would introduce new subject-matter, e.g. an electrical engine which is directly powered by a solar panel, because modifications are required to compensate for removing the battery.

The skilled person would therefore be presented with information which is not directly and unambiguously derivable from that previously presented by the application.

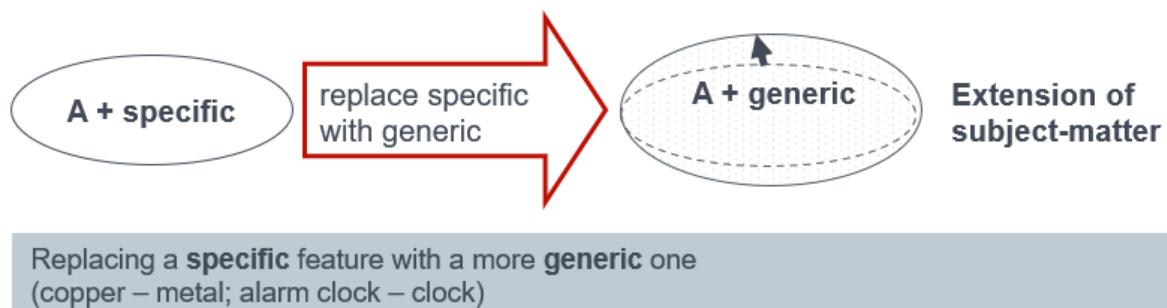
The amendment is not allowable under Article 123(2) EPC.

Legal references:

GL H-V, 3.1

10. Amendment by generalisation of features

Generalisation (e.g. no relevant prior art found during search)



Examples

Generalisation – Example 1

Application as originally filed:

Claim 1: A + copper

The description states that the invention may be applied to all metals and is not limited to copper.

After amendment:

Claim 1: A + metal

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

Answer:

No, because the skilled person would understand from the description that the invention is disclosed for all kinds of metal and is not limited to copper.

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

Generalisation – Example 2

Application as originally filed:

Claim 1: A + copper

The description does not disclose the use with any metals other than copper.

After amendment:

Claim 1: A + metal

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

Answer:

Yes, because the description as filed only discloses the invention in relation to copper (specific matter), without any reference to the generic category (metal).

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

Legal references:

Art. 123(2) EPC

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

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