

CA/PL 26/99

Orig.: French

Munich, 04.11.1999

SUBJECT: Revision of the EPC: Article 123 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Patent Law Committee (for opinion)

SUMMARY

After describing the "inescapable trap" created in European patent law by the joint application of paragraphs 2 and 3 of Article 123 EPC, this document outlines the two solutions developed in German patent law to avoid revocation as a result of a similar trap, and endeavours to evaluate the advantages and drawbacks of introducing either of these solutions into European patent law.

CONTENTS

Subject	Page
I. <u>INTRODUCTION</u>	1
II. <u>REVOCATION OF THE EUROPEAN PATENT AS A RESULT OF THE JOINT APPLICATION OF PARAGRAPHS 2 AND 3 OF ARTICLE 123 EPC</u>	2
III. <u>A SIMILAR "FOX TRAP" AND "VICIOUS CIRCLE" IN THE PATENT LAWS OF CONTRACTING STATES</u>	4
A. THE PROVISIONS OF GERMAN PATENT LAW (PatG)	5
B. FIRST GERMAN SOLUTION: MAINTAINING THE PATENT WITH A "LIMITING DECLARATION"	6
C. SECOND GERMAN SOLUTION: DELETING THE UNDISCLOSED LIMITING FEATURE	7
IV. <u>ADVANTAGES AND DRAWBACKS OF THE TWO GERMAN SOLUTIONS</u>	9
A. FIRST SOLUTION: THE "LIMITING DECLARATION"	10
B. CRITICISMS OF THE FIRST SOLUTION	11
C. SECOND SOLUTION: DELETING OR REPLACING THE FEATURE	12
D. CRITICISMS OF THE SECOND SOLUTION	13
V. <u>REVOCATION OF THE EUROPEAN PATENT: ADVANTAGES OF RETAINING THE EXISTING ARRANGEMENTS</u>	13

I. INTRODUCTION

1. It is rare for a patent to be granted in a text corresponding exactly to that originally filed by the applicant. In most cases, the application is amended during the grant procedure, in response to objections raised by the examiner, by limiting the subject-matter vis-à-vis the prior art or clarifying the content of the application documents.
2. Unfortunately, it is impossible in practice to prevent occasional cases of inadmissible amendment. In particular, a patent is sometimes granted with a feature that extends the subject-matter beyond the content of the application as filed.
3. If a third party institutes opposition or revocation proceedings, the patent proprietor may find himself trapped. There is a particular danger of this if the contested feature extends the subject-matter beyond the content of the application as filed but at the same time limits the protection conferred by the patent. Such an "undisclosed limiting feature" can neither be allowed to remain in the patent specification, since it extends the subject-matter beyond the content of the application as filed, nor can it be deleted, as this would extend the protection conferred.
4. This problem has arisen repeatedly in opposition proceedings before the EPO¹⁾ and the German Patent and Trade Mark Office (DPMA). In European patent law it is often impossible to escape from this trap, and a European patent containing an undisclosed limiting feature has to be revoked. In German law, by contrast, it is possible to maintain a patent containing such a feature, either by inserting a statement to the effect that no rights may be derived from the inadmissible feature, or by deleting the feature.
5. These solutions have emerged from the interpretation, by the EPO boards of appeal and the German Federal Patents Court (BPatG), of the relevant provisions of the EPC and of German patent law. It would be appropriate to look carefully at these provisions and at the relevant case law (sections II and III *infra*) before trying to evaluate the respective advantages and drawbacks of the alternative solutions (sections IV and V *infra*).

1) About a dozen such cases arise each year.

II. REVOCATION OF THE EUROPEAN PATENT AS A RESULT OF THE JOINT APPLICATION OF PARAGRAPHS 2 AND 3 OF ARTICLE 123 EPC

6. Despite the care exercised by the examining divisions, European patents are sometimes granted with undisclosed features, in contravention of Article 123(2) EPC. If an opponent invokes Article 100(c) EPC, and if the feature limits the protection conferred by the patent, the combined effect of paragraphs 2 and 3 of Article 123 EPC leads to an "impasse"²⁾ - the undisclosed limiting feature cannot remain in the patent without contravening Article 123(2) EPC, but it cannot be removed, since this would constitute an extension of protection, in contravention of Article 123(3) EPC; consequently, the opposition division has to revoke the patent³⁾.
7. An analogous situation may arise where the national courts of contracting states are called upon to assess the validity of a European patent. They may have to decide whether an amendment of the claims during proceedings before the EPO meets the requirements of the EPC. The national courts apply Article 138(1)(c) and (d) EPC: an undisclosed limiting feature which can neither remain in the claims (without contravening Article 123(2) EPC) nor be deleted (without contravening Article 123(3) EPC) leads to the revocation of the European patent.
8. Although the patent proprietor must be held solely responsible for the text in which the European patent is granted, he often regards revocation as unjust: because of an inadmissible feature (often of little importance⁴⁾) which the EPO originally accepted, he suffers an irremediable loss of rights, even where the invention according to the original application was patentable⁵⁾.

2) T 108/91, Lockable closure, OJ EPO 1994, 228, point 2.3.

3) See, for example, T 938/90, Polyester composition/TEIJIN; T 526/92, Lubricating oil additives/EXXON; and T 911/92, Drehmaschine/WOHLENBERG.

4) See O. Bossung, in "The law and practice of the Enlarged Board of Appeal of the European Patent Office during its first ten years", 1996, p. 135 (144): "Die ... Fälle zeigen, daß es ... fast immer nur um Kleinigkeiten geht".

5) Ibid.: "...obwohl eine definierbare 'Rest'-Erfindung vorliegt".

9. The EPO boards of appeal have regretted the "paradoxical result" of the application of Article 123(2) and (3) EPC, considering the revocation of the patent to be "unjust", "not appropriate and not intended by the Convention"⁶⁾. The Enlarged Board of Appeal, examining a point of law concerning the "contradictory requirements of Article 123, paragraphs 2 and 3, EPC"⁷⁾, acknowledged that the combined application of these provisions "could operate rather harshly against an applicant, who runs the risk of being caught in an inescapable trap and losing everything..."⁸⁾.
10. Nevertheless, in the view of the Enlarged Board, the current wording of Article 123 EPC offers no possibility of avoiding this "inescapable trap", which leads to the revocation of the European patent in its entirety. Indeed, the purpose of Article 123 EPC is to create a "fair balance" between the interests of applicants and patent proprietors, on the one hand, and third parties on the other (G 1/93, points 8-9):
 - Article 123(2) EPC is designed to prevent the applicant from securing an unwarranted advantage - which could jeopardise the legal certainty of third parties - by adding an element or feature which was not disclosed in the application as filed;
 - Article 123(3) EPC is designed to protect the interests of third parties by prohibiting any broadening of the protection conferred by the claims of a granted patent.

According to the Enlarged Board of Appeal, paragraphs 2 and 3 of Article 123 EPC are independent of one another, and each has a mandatory character (G 1/93, point 13): a European patent cannot be maintained unless it complies with both paragraphs.

11. The decisions of the boards and the Enlarged Board have shown that certain kinds of amendment do not necessarily lead to revocation:
 - thus, if a feature not disclosed in the application but added during the grant procedure has no technical meaning, it may be removed from the claims without contravening Article 123(3) EPC⁹⁾;

6) T 231/89, Flat torsion spring/BRUYNZEEL, OJ EPO 1993, 13, point 3.1.

7) T 384/91, Conflict/ADVANCED SEMICONDUCTOR, OJ EPO 1994, 169, point 2.5.

8) G 1/93, Limiting features/ADVANCED SEMICONDUCTOR PRODUCTS, OJ EPO 1994, 541, point 13.

9) T 231/89, Headnote II and point 3.5.

- likewise, replacing an inaccurate technical statement, which is evidently inconsistent with the totality of the disclosure of the patent, by an accurate statement of the technical features involved, does not extend the protection conferred¹⁰⁾;
 - the patent can also be maintained if an added feature can be replaced by another feature disclosed in the application as filed without violating Article 123(3) EPC¹¹⁾;
 - finally, an added feature which merely excludes protection for part of the subject-matter of the claimed invention according to the original application documents is not considered as subject-matter extending beyond the content of the application as filed¹²⁾.
12. This case law has in several instances provided a means of escape from a "trap" involving a risk of revocation; however, it has not been possible to solve all the problems that may arise.

III. A SIMILAR "FOX TRAP" AND "VICIOUS CIRCLE"¹³⁾ IN THE PATENT LAWS OF CONTRACTING STATES

13. The national laws of several member countries contain provisions similar to those of Article 123 EPC, preventing applicants from claiming for additional matter after the date of filing¹⁴⁾, prohibiting any extension of the protection conferred by the patent¹⁵⁾, and enabling national offices and courts to enforce these prohibitions by revoking the

10) T 108/91, Headnote and point 2.3; see also T 31/93, WABCO.

11) G 1/93, Headnote I, final sentence, and point 13. See, for example, T 194/84, Cellulose fibres/GENERAL MOTORS, OJ EPO 1990, 59, and T 371/88 Transmission apparatus/FUJI, OJ EPO 1992, 157. According to decision T 911/92, point 3, this is only possible in "wenige[n] Ausnahmefälle[n]".

12) G 1/93, Headnote II and point 16, second case.

13) These terms are used in, respectively, EUROTAB 4/94, p. 6 (document originating from Sweden) and EUROTAB 18/94, p. 5 (from the United Kingdom).

14) See, for example, Section 76(2) of the United Kingdom patent law, Section 32(2) of the Irish patent law, Section 13 of the Danish, Finnish and Swedish patent laws, and Section 91(3) of the Austrian patent law.

15) See, for example, Section 76(3)(b) of the United Kingdom patent law.

patent or declaring it null and void¹⁶⁾. Such provisions are an essential means of preserving the balance between rewarding the inventor and upholding the rights of third parties.

14. The national provisions mean that an “inescapable trap” may arise at the national level, too. However, although the problem of undisclosed limiting features has been mentioned in Sweden and the United Kingdom¹⁷⁾, Germany seems to have been the only country to address the issue specifically. It may therefore be helpful to look at the relevant provisions of German law and analyse the two solutions developed by the BPatG for avoiding revocation.

A. THE PROVISIONS OF GERMAN PATENT LAW (PatG)

15. The relevant provisions correspond very closely to the EPC:
- Section 38, first sentence, PatG prohibits amendments which extend the scope of the subject-matter of the application (=Article 123(2) EPC);
 - Section 21(1)(4) PatG includes, as a ground for revocation, the extension of the subject-matter of the patent beyond the content of the application as originally filed (=Articles 100(c), 123(2) and 138(1)(c) EPC);
 - Section 22(1), second alternative, PatG includes, as a ground for nullity, the broadening of the scope of the patent (=Articles 138(1)(d) and 123(3) EPC);
 - Sections 21(2) and 22(2) PatG provide that, if the grounds for revocation or nullity affect the patent "in part only, the patent shall be maintained in the form of a corresponding limitation. The limitation may be effected in the form of an amendment to the claims, the descriptions or the drawings" (see Article 138(2) EPC).

16) The contracting states have implemented Article 138(1)(c) and (d) EPC under their national laws. See, for example, Section 72(d) and (e) of the United Kingdom patent law, Section 58(c) and (d) of the Irish law, Section 52(1), (3) and (4) of the Danish, Finnish and Swedish patent laws, Article L 613-25(c) of the French intellectual property code, and Article 26(1)(3)(a) of the patent law of Switzerland.

17) See EUROTAB 4/94, p. 6-7 (the “telephone exchange” case) and W. Cornish, Intellectual Property, 3rd ed., 1996, p. 138, n. 33, referring to the decision in “Raychem’s Application”, RPC 1986, 547.

16. This legal framework is supplemented by a provision which has no equivalent in the EPC:

- Section 38, second sentence, PatG provides that: "No rights may be derived from amendments which broaden the scope of the subject-matter of the application".

17. As in European patent law, a trap has arisen in German patent law where an undisclosed feature is added during examination before the DPMA (in contravention of Section 38, first sentence, PatG) and can no longer be deleted during post-grant opposition proceedings without extending the protection conferred (which would contravene Section 22(1), second alternative, PatG).

B. FIRST GERMAN SOLUTION: MAINTAINING THE PATENT WITH A “LIMITING DECLARATION”

18. To avoid revoking the patent, two Senates of the BPatG as from 1988 adopted a solution apparently facilitated by the provisions of the PatG. In the reasons for their decisions, the two Senates¹⁸⁾ drew attention to:

- the possibility of maintaining a patent subject to limitation where a ground for revocation or nullity affects the patent in part only (Section 21(2) and 22(2) PatG);
- the wording of Section 38, second sentence, PatG, which does not mean that an undisclosed feature necessarily has to be removed.

19. On this legal basis, the BPatG adopted the “limiting declaration solution”¹⁹⁾, which consists in maintaining the patent with a declaration explaining that a feature - which was added during the proceedings before the DPMA and cannot be removed without extending the protection conferred - constitutes an inadmissible extension of the subject-matter of the patent and confers no rights on the patent proprietor.

18) Decisions "Flanschverbindung", 12th Senate BPatG, GRUR 1990, 114 (116, left-hand column) and "Elektrischer Kontaktstift", 23rd Senate BPatG, BIPMZ 1991, 77 (78, left-hand column).

19) Term based on the German "Schutzrechtsbeschränkungserklärung", also known as the "Fussnoten-Lösung" (footnote solution - see G 1/93, point 6), "Disclaimer-Lösung" (disclaimer solution - see decision in "Zerkleinerungsanlage", 8th Senate BPatG, GRUR 1998, 810 (811, left-hand column, point II.2.2), W. Anders, VPP-Rundbrief 1999, 10 (11), Benkard/Rogge, Patentgesetz, 9th ed. 1993, Section 22, n. 13, p. 693), or "Kommentar-Lösung" (commentary solution) (see Stamm, Mitt. 1998, 207).

20. This declaration serves a dual purpose²⁰⁾:

- first, it establishes that the feature lies outside the protected teaching and that it is not to be taken into consideration in any assessment of patentability;
- second, it limits the protection conferred by the patent to cases where this same feature is present, so that the scope of the protection is not broadened.

21. In the view of both Senates, this makes it possible to strike a fair balance between the interests of the patent proprietor and those of third parties:

- the patent proprietor avoids the revocation of his patent (on condition, admittedly, that the invention is patentable without the undisclosed limiting feature) but has to accept the inclusion of a statement explaining that the feature extends the subject-matter of the patent beyond the content of the application as filed and confers no rights on him;
- third parties can rely on the content of the application as filed and will find, in the patent maintained as amended, a statement earmarking the undisclosed feature;
- in infringement proceedings, the feature may operate to the disadvantage of the patent proprietor, who enjoys only the narrower protection conferred by the claim containing the limiting feature.

C. SECOND GERMAN SOLUTION: DELETING THE UNDISCLOSED LIMITING FEATURE

22. Recently, two Senates of the BPatG²¹⁾ proposed a further solution aimed at resolving the problems of the relationship between Section 22 (1), second alternative, and Section 21(1)(4) PatG.

23. This solution consists in deleting, at the opposition stage, an undisclosed feature which plays a part in defining the subject-matter of the patent, if it becomes apparent that the feature in question extends the subject-matter beyond the content of the application as filed.

20) See "Elektrischer Kontaktstift", BIPMZ 1991, 77 (78, top of left-hand column).

21) See "Controllable filter switch", 20th Senate BPatG, OJ EPO 1998, 617 (621, point II.2(c)(bb)) and "Zerkleinerungsanlage", 8th Senate BPatG, GRUR 1998, 810 (812, left-hand column).

24. Such deletion is generally accompanied by an extension of the protection conferred, which constitutes a ground for nullity that has to be taken into consideration in opposition proceedings. However, the two Senates took the view that Section 22(1), second alternative, PatG does not apply to an extension of protection resulting from the deletion during opposition proceedings of an undisclosed feature which has extended the subject-matter of the patent beyond the content of the application as filed. Instead, the application of Section 22(1), second alternative, PatG is limited to "those cases in which the granted claims have been extended but the extension does not go beyond the content of the application as filed"²²⁾. Both Senates considered that this restrictive interpretation of Section 22(1), second alternative, PatG provided the only way of striking a just balance between the interests of the inventor and those of the public.
25. The two Senates of the BPatG made repeated reference to two decisions²³⁾ handed down by the Federal Court of Justice (BGH) in the mid-1970s, when German opposition proceedings **preceded** the grant of the patent. The BGH had ruled that inadmissible amendments - by virtue of Section 26(5), second sentence, PatG 1968 (=Section 38, second sentence, PatG 1981) - were to be deleted at any time during the grant procedure²⁴⁾, ie during the actual examination procedure or during any opposition proceedings (which took place after the application was made open to public inspection prior to grant)²⁵⁾. Thus a fundamental principle of PatG 1968 was that an amendment extending the subject-matter beyond the content of the application as filed should not lead to the loss of the application: the applicant's interest in obtaining the grant of a patent had to take precedence over the requirement of third parties for legal certainty²⁶⁾.
26. The two Senates took the view that this case law remained relevant, since the preparatory work for PatG 1978 and 1981 (which in particular introduced post-grant opposition proceedings and extended the grounds for revocation and nullity) contained no indication that the German legislator wished to alter the previous arrangement and put the applicant in a less advantageous position²⁷⁾.

22) See "Controllable filter switch", OJ EPO 1998, 617 (622).

23) See "Regelventil", GRUR 1975, 310, and "Fadenvlies", GRUR 1977, 714.

24) See "Regelventil", GRUR 1975, 310 (311, left-hand column).

25) See "Fadenvlies", GRUR 1977, 714 (716, top of left hand column).

26) Ibid., point (e).

27) See "Zerkleinerungsanlage", GRUR 1998, 810 (811, right-hand column).

27. From this it follows that the present post-grant opposition procedure also serves "to finalise the form of the patent, which often involves the amendment of claims"²⁸⁾. Even at the post-grant stage, during opposition proceedings, it is therefore possible to limit the subject-matter to what was originally disclosed. If the limitation of protection is derived from a feature beyond the scope of the initial disclosure, adherence to the scope of the original disclosure takes precedence over the ground for revocation under Section 22(1), second alternative, PatG, and the deletion of the undisclosed feature is not seen as leading to an extension of protection²⁹⁾.
28. This makes it possible to resolve the conflict between the interests of the inventor and those of third parties: "The inventor is appropriately rewarded for his work, and at the same time the public interest in deleting the inadmissible amendment is sufficiently acknowledged"³⁰⁾. Of course, it is necessary to ensure that the invention is patentable without the deleted feature. The need remains to protect the interests of third parties who, in the interval between the grant of the patent and the conclusion of opposition proceedings, have relied on the extent of protection conferred by the patent as granted, but then find that the protection conferred by the amended patent is broader than before. The 20th Senate took the view that it was up to the infringement courts "to decide how to protect the interests of the person whose action affects the extent of protection which is then amended as a result of the deletion"³¹⁾. The solution envisaged is illustrated in the Senate's decision by several examples of legislation granting a continued right of use - on payment of equitable remuneration - to third parties who have begun to use an invention on the basis of assumptions made in good faith about the extent of protection conferred³²⁾.

IV. ADVANTAGES AND DRAWBACKS OF THE TWO GERMAN SOLUTIONS

29. The prospect of a revision of the EPC raises the question whether one of the solutions devised by the German courts could be adopted in European patent law. The following section examines the amendments which would be necessary for the implementation of each solution and evaluates their respective advantages and drawbacks.

28) See "Controllable filter switch", OJ EPO 1998, 617 (624, point II.3 b)).

29) Ibid., p. 624, point II.3(a) *in fine*.

30) Ibid., p. 625, point II.3(c).

31) Ibid., p. 625, point II.3(d).

32) One such example is provided by Section 123(5) PatG, protecting the position of a person who has in good faith exploited a lapsed patent which has subsequently re-entered into force as a result of re-establishment of rights, by allowing the person to continue using the invention. This provision corresponds to Article 122(6) EPC.

A. FIRST SOLUTION: THE "LIMITING DECLARATION"

30. A revision of the EPC to adopt this solution could consist in supplementing the wording of Article 123 EPC with a text similar to Section 38, second sentence, PatG. The EPC would then expressly provide that no rights may be derived from an amendment which extends the subject-matter of a European patent application or European patent beyond the content of the application as filed.
31. Such a provision would enable the opposition division to neutralise an undisclosed limiting feature. A carefully worded statement³³⁾ would serve to explain **that** the inadmissible feature remaining in the European patent has not been taken into account in the assessment of patentability **and that** the protection conferred by the European patent is limited to cases in which this feature exists.
32. The amendment of Article 123 EPC would have to be accompanied by at least two further amendments in order to guarantee the implementation of this solution by the EPO and the national courts:
- it would seem necessary to supplement Article 100(c) EPC by adding a reference to the amended Article 123 EPC, so as to provide the opposition divisions with a sound legal basis for not revoking a European patent containing a limiting declaration;
 - similarly, it would be necessary to supplement Article 138(1) c) EPC by inserting a reference to the amended Article 123 EPC, so as to make it clear that the national courts with jurisdiction for revocation proceedings involving European patents may not take the undisclosed limiting feature into account when assessing the patentability of the invention. This would also allow national courts to maintain a European patent with a limiting declaration in a case where an inadmissible feature is only discovered after the European patent has left the EPO.
33. Revision of the EPC to establish the possibility of maintaining a European patent with a limiting declaration has long been considered an acceptable solution: the

33) The statement could be worded along the following lines: "Feature X constitutes an inadmissible amendment which cannot confer any rights on the patent proprietor; rather, the patent proprietor must accept that the amendment may be to his disadvantage" (see P. Heinrich, PatG/EPÜ - Kommentar zum schweizerischen Patentgesetz und den entsprechenden Bestimmungen des Europäischen Patentübereinkommens", 1998, p. 260; and Schulte, Patentgesetz mit EPÜ, 5th ed. 1994, section 21, n. 38, p. 281).

interested circles³⁴⁾, the EPO³⁵⁾ and a number of commentators³⁶⁾, have advocated it as a means of avoiding revocation and thus ensuring that the inventor is duly rewarded, while preserving legal certainty for third parties³⁷⁾.

B. CRITICISMS OF THE FIRST SOLUTION

34. Nevertheless, this solution has given rise to certain criticisms:

- the practical implications of the limiting declaration are not entirely clear. The importance attached (in particular by national courts) to a claim accompanied by a limiting declaration is likely to vary widely, and it will doubtless be impossible to arrive at a harmonised interpretation;
- during the examination procedure, applicants are likely to be more tenacious in pursuing their requests for amendments, arguing that the possibility will always remain of neutralising an inadmissible feature during opposition proceedings.
- the solution does not deal with the problems arising from "aliud"-type amendments: a limiting declaration will not make it possible to avoid revocation in cases where a patent has been granted with an added feature, directed to different subject-matter, which replaces and excludes an originally disclosed feature³⁸⁾.
- finally, it has been argued that the limiting declaration is not sufficient to neutralise the undisclosed feature. This point was made, in particular, by the 20th Senate of the BPatG, which held that "despite the [limiting declaration], the feature which was not originally disclosed and has remained in the claim

34) See SACEPO 2/98, Add. 1 (Bardehle, p. 6, Guigni, p. 11, Parkes/CIPA, p. 21), Add. 2 (FICPI, p. 4), and Add. 5 (Deutsche Patentanwaltskammer, p. 14-15).

35) See CA/16/98, p. 10.

36) See Bossung, in "The law and practice of the Enlarged Board of Appeal of the European Patent Office during its first ten years", 1996, p. 135 (145); Rogge, IIC 1997, 842 (844); Niedlich/Graefe, Mitt. 1999, 249 (lower right-hand column).

37) See Anders, VPP-Rundbrief 1999, 10 (11, left-hand column): "Die Disclaimer-Lösung liegt in der (goldenen?) Mitte"; and "Flanschverbindung", GRUR 1990, 114 (116, right-hand column).

38) See Körber, VPP-Rundbrief 1999, 70 (73, left-hand column), referring to "Absatz-Sicherheitsbindung", 12th Senate BPatG, GRUR 1991, 40, Headnote, point 2.

continues to play a part in defining the claimed subject-matter"³⁹⁾. Thus, in the event of infringement, the inadmissible feature would take on "precisely the legal significance which the [limiting declaration] is designed to remove. Since the inadmissible feature may be cited in proceedings against the patent proprietor, he could only claim rights on the basis of this feature [...], so that the feature is precisely not removed but remains in the patent claim, in contravention of Section 21(1)(4) PatG and Section 38, last sentence, PatG"⁴⁰⁾.

C. SECOND SOLUTION: DELETING OR REPLACING THE FEATURE

35. The BPatG's second solution was designed chiefly in response to the last two criticisms cited above. To adopt the deletion solution in European patent law, it would be necessary to amend Article 123(3) EPC by inserting a text expressly permitting the deletion - or, in the case of an "aliud" feature, the replacement⁴¹⁾ - of amendments extending the subject-matter of the European patent beyond the content of the application as filed, even if such deletion - or replacement - led to an extension of the protection conferred.
36. Thus the EPC would expressly provide for an exception to the principle that the protection conferred may not be extended after the patent is granted; amendments designed to limit the subject-matter of the European patent to the content of the application as filed would therefore be admissible.
37. However, such an exception to the principle enshrined in Article 123(3) EPC can only be contemplated if the legal certainty of third parties is fully guaranteed. In particular, it is necessary to prevent the patent proprietor from bringing infringement actions against third parties who have relied on the protection conferred by the European patent as granted and whose infringing acts relate to the broader protection conferred by the amended European patent. It would be necessary, for example, to supplement Article 123(3) EPC with a provision granting a continued right of use to third parties who have begun to use an invention in good faith. Article 122(6) EPC could supply the model for such a provision.
38. Finally, to ensure that national courts do not declare European patents null and void on the ground that the protection conferred by a patent amended during opposition

39) See "Controllable filter switch", OJ EPO 1998, 617 (621, point II.2(c)(aa)); and Stamm, Mitt. 1998, 207 (208, right-hand column, point 6).

40) See "Controllable filter switch", OJ EPO 1998, 617 (620, point II.2(c)(aa)).

41) See "Zerkleinerungsanlage", GRUR 1998, 810 (812, point II.2, left-hand column).

proceedings has been extended beyond that conferred by the patent as granted, it would be necessary to insert in Article 138(1)(d) EPC a reference to the new exception to the principle set out in Article 123(3) EPC. Supplementing Article 138(1)(d) EPC would also make it possible for national courts to delete (or replace) an inadmissible amendment and maintain the European patent in an amended form.

D. CRITICISMS OF THE SECOND SOLUTION

39. Several criticisms have been levelled at this second solution⁴²⁾:

- the solution strongly favours the patent proprietor, who not only avoids revocation but is also able to benefit from an extension of the protection conferred by the amended patent, despite the presence of an inadmissible amendment - even of the "aliud" type - for which he must be held responsible. Although a continued right of use for third parties who have begun to use an invention in good faith may contribute to restoring the balance in individual cases, the rewarding of the inventor takes preference over the legal certainty of third parties;
- the ground for opposition mentioned in Article 100(c) EPC will be largely devalued, since it involves the risk of extending the protection conferred;
- the solution does not make it possible to escape from the trap which may be created by the combined operation of Articles 52(4) and 123(3) EPC (see the decision in T 82/93, Cardiac pacing/TELECTRONICS, OJ EPO 1996, 274).

V. REVOCATION OF THE EUROPEAN PATENT: ADVANTAGES OF RETAINING THE EXISTING ARRANGEMENTS

40. It is apparent from the foregoing that adopting either of the German solutions under European patent law would require several complex amendments to the EPC, with uncertain implications and no prospect of a fully satisfactory result. It must therefore be stressed that there would be considerable advantages in not embarking on a revision of Article 123 EPC.

42) Even in German patent law, this solution does not currently enjoy unanimous support. See the decision in "Verglasungsdichtung", 12th Senate BPatG, Mitt. 1999, 269 (271), taking the view that Sections 21 and 22 PatG do not permit a remedial limitation of the protection conferred by the patent by deleting an undisclosed feature after grant, or the replacement of an undisclosed "aliud" feature with a feature disclosed in the original application. This decision is currently the subject of an appeal before the BGH.

41. First, it should be pointed out that the provisions of Article 123(2) and (3) EPC reflect two principles, each of which has its own justification: the first prohibits the applicant from extending the subject-matter beyond the content of the application as filed, while the second prohibits the patent proprietor from amending the claims in such a way as to extend the protection conferred. These two prohibitions are independent of one another, and their combined application is fully justified in cases where, in view of the prior art, the grant of a patent can only be obtained by introducing an undisclosed feature into the application as filed.
42. Under these circumstances, a "trap" can only result from a double error of judgment on the part of the applicant during the grant procedure, regarding
- (a) the fact that the newly introduced limiting feature is inadmissible, and
 - (b) the patentability of the invention (in particular, the presence of an inventive step), even if the inadmissible feature is absent.

The question is therefore whether there is good reason to create an exception from either of the above-mentioned principles and allow the patent proprietor to rectify, in *inter partes* proceedings, the error of judgment which he committed as an applicant during the grant procedure.

43. Answering this question in the negative, a certain parallel may be drawn with the situation where a patent proprietor, in infringement proceedings, alleges that the contested embodiment constitutes an equivalent form, although this embodiment had been deliberately excluded during the grant procedure ("prosecution history estoppel").
44. The EPO boards of appeal have already developed a number of solutions (see point 11 above), taking each case on its merits, for avoiding the trap resulting from the combined requirements of Article 123(2) and (3) EPC. These include the solution specifying that an added feature which merely excludes protection for part of the subject-matter of the claimed invention does not breach Article 123(2) EPC. This solution deserves particular consideration and appears to be capable of further development in case law.
45. Maintaining Article 123 EPC in its present form also offers the following advantages:

- the legal certainty of third parties would remain guaranteed; they could confidently rely on the content of the application as filed and the extent of protection conferred by the patent as granted;
- the applicant and the examiner would not relax their vigilance, in the knowledge that a wrongly admitted amendment carried the risk of an irremediable loss of rights;
- responsibility for inadmissible amendments would, as in the past, lie firmly with the applicant, who would know that an amendment extending the subject-matter beyond the content of the application as filed could lead to revocation of the patent.
- finally, the principles enshrined in Article 123(2) and (3) EPC have a considerable practical importance, and it would be unwise to limit their application in order to solve a problem that only affects a dozen cases a year.

46. On the basis of all the above points, the Patent Law Committee is asked to consider whether a revision of Article 123 EPC should be undertaken.

"Inescapable trap"	Limiting declaration solution	Deletion solution
Revocation of the European patent - except in cases where boards of appeal have been able to remove the "trap"	Maintaining the patent with a declaration to the effect that no rights may be derived from the inadmissible feature	Deletion of the feature (or replacement in case of an "aliud" feature) - return to original disclosure
<ul style="list-style-type: none"> - guarantees legal certainty for third parties - ensures that applicant and examiner remain vigilant - applicant is solely responsible for inadmissible amendments which he himself has accepted - principles enshrined in Article 123 are not limited by any exceptions. BUT generally leads to revocation (12 cases per year).	<ul style="list-style-type: none"> - avoids revocation - guarantees legal certainty for third parties. BUT doubts about practical impact of limiting declaration (differing interpretations by national courts, soundness of maintained patent); growing insistence of applicants on pursuing requests for amendments; does not resolve problem of "aliud" features.	<ul style="list-style-type: none"> - avoids revocation (even for "aliud" cases). BUT extension of protection conferred by amended patent (favourable to patent proprietor responsible for amendment, even if right of continued use is granted to third parties who have begun to exploit the invention in good faith; ground for opposition under A100(c) devalued; trap created by A52(4) and A123(3) remains.
retaining existing situation: - leaves room for possible developments in case law (EPO boards of appeal and national courts)	several amendments necessary: - A100(c) - A123 (see Section 38, 2nd sentence, PatG) - A138(1)(c) (reference to amended A123)	several amendments necessary: - A123(3) (exception to principle) - A123(3) (cf A122(6)) - A138(1)(d) (reference to amended A123)
G 1/93 "Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS" 2.2.1994, OJ EPO 1994, 541	BPatG - "Flanschverbindung" , 27.6.1988, 12th Senate, GRUR 1990, 114 BPatG - "Elektrischer Kontaktstift" , 10.4.1990, 23rd Senate, BIPMZ 1991, 77 BPatG - "Verglasungsdichtung" , 3.12.1998, 11th Senate, Mitt. 1999, 269 <i>Case law on basis of PatG 1968</i> BGH - "Aufhänger" , 7.12.1978, GRUR 79, 224	BPatG - "Controllable filter switch" , 25.8.1997, 20th Senate, OJ EPO 1998, 617 BPatG - "Zerkleinerungsanlage" , 9.1.1998, 8th Senate, GRUR 1998, 810 (includes "aliud" cases) <i>Case law on basis of PatG 1968</i> BGH - "Regelventil" , 17.9.1974, GRUR 1975, 310 ; BGH - "Fadenvlies" , 1.3.1977, GRUR 1977, 714