

Part H

Amendments and Corrections

Contents

Chapter I – The right to amend I-1

Chapter II – Admissibility of amendments – general rules II-1

1.	Introduction	II-1
2.	Admissibility during examination procedure	II-1
2.1	Before receipt of the search report - Rule 137(1)	II-1
2.2	After receipt of the search report - Rule 137(2)	II-1
2.3	After receipt of the first communication - Rule 137(3)	II-2
2.4	At an advanced stage of the proceedings	II-3
2.5	Amendments filed in reply to a Rule 71(3) communication	II-3
2.5.1	Criteria for admitting such amendments	II-3
2.5.2	Amendments filed in reply to Rule 71(3) invitation admitted	II-4
2.5.3	Amendments filed in reply to Rule 71(3) invitation rejected	II-4
2.5.4	Exceptional case where amendments must be admitted	II-4
2.5.5	Rule 137(4) applies to amendments filed at this stage	II-4
2.6	Further requests for amendment after approval	II-5
2.7	Late-filed requests after summons to oral proceedings in examination	II-6
2.7.1	Concept of "clear allowability"	II-6
2.7.2	Additional criteria for admissibility of requests	II-6
3.	Admissibility in opposition procedure	II-7
3.1	Amendments in reply to the notice of opposition	II-7
3.2	Amendments not related to the grounds of opposition	II-7
3.3	Amendments occasioned by national rights	II-8

3.4	Insistence on unallowable amendments	II-8
3.5	Late-filed requests in opposition proceedings	II-9
4.	Limitation procedure	II-9
5.	Amendments required by Rule 62a and/or Rule 63	II-9
6.	Amendments directed to unsearched matter - Rule 137(5)	II-9
6.1	Rule 62a and/or Rule 63 cases	II-10
6.2	Subject-matter taken from the description	II-10
7.	Amendments in case of non-unity	II-11
7.1	Restriction to a single, searched invention	II-11
7.2	Restriction to unsearched subject-matter	II-12
7.3	Not restricted to single invention or claims amended	II-12
7.4	Euro-PCT cases	II-13
7.4.1	Where the EPO does not perform a supplementary search	II-13
7.4.2	Where the EPO performs a supplementary search	II-13

Chapter III – Admissibility of amendments - other procedural matters

III-1

1.	Introduction	III-1
2.	Procedure for amendments to documents	III-1
2.1	Indication of amendments and their basis under Rule 137(4)	III-1
2.1.1	Rule 137(4) communication and response thereto	III-1
2.1.2	Amendments withdrawn or superseded in the Rule 137(4) period	III-2
2.1.3	Rule 137(4) and oral proceedings	III-3
2.1.4	Transitional provisions relating to Rule 137(4)	III-4
2.2	Amendment by submitting missing documents or by filing replacement pages	III-4
2.3	Amendments using copies	III-5

2.4	Amendments made by the EPO at the request of a party	III-5
2.5	Withdrawal of amendments/abandonment of subject matter	III-6
3.	Auxiliary requests	III-6
3.1	General principles	III-6
3.1.1	Sequence of requests	III-7
3.1.2	Obligation to give reasons	III-7
3.1.3	Neither main nor auxiliary requests allowable	III-7
3.1.4	Indication of amendments made in main and/or auxiliary requests in examination proceedings	III-7
3.2	In the search phase	III-7
3.3	In examination proceedings	III-8
3.3.1	Admissibility of auxiliary requests	III-8
3.3.1.1	Criteria for admissibility of auxiliary requests	III-8
3.3.1.2	Timeliness and structure of auxiliary requests	III-8
3.3.2	Preparing the decision	III-8
3.3.3	Complete text for auxiliary request not yet available	III-9
3.3.4	Complete text for auxiliary request available	III-9
3.3.5	Applicant does not approve the text proposed for grant	III-9
3.4	In opposition proceedings	III-9
3.4.1	Written procedure	III-9
3.4.2	Oral proceedings	III-10
3.5	In limitation proceedings	III-10
3.5.1	General principles	III-10
3.5.2	Written procedure	III-11
3.5.3	Oral proceedings	III-12
4.	Different texts in respect of different Contracting States	III-12
4.1	Dealing with different texts in examination	III-12
4.2	Different text in respect of the state of the art according to Art. 54(3) and Art. 54(4) under EPC 1973	III-13
4.2.1	Art. 54(3) and (4) EPC 1973 in opposition proceedings	III-13

4.3	Different text where a partial transfer of right has taken place pursuant to Art. 61 or Rule 78	III-13
4.3.1	Different text where a partial transfer of right takes place pursuant to Art. 61 in examination proceedings	III-13
4.3.2	Different texts where a transfer of the patent in respect of certain designated states takes place in opposition proceedings	III-14
4.3.3	Opposition cases with different texts where a partial transfer of rights by virtue of a final decision pursuant to Art. 61 and Rule 18(1) and Rule 18(2) took place in examination proceedings	III-14
4.4	Different text where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973	III-14
4.5	Different text where national rights of earlier date exist	III-14
5.	Calculation of claims fees	III-15

Chapter IV – Allowability of amendments - Art. 123(2) and Art. 123(3)

1.	Introduction	IV-1
2.	Allowability of amendments under Art. 123(2)	IV-1
2.1	Basic principle	IV-1
2.2	Field of application of Art. 123(2)	IV-1
2.3	Content of the application as "originally" filed – general rules	IV-2
2.3.1	Features described in a document cross-referenced in the description	IV-2
2.3.2	Missing parts of the description or missing drawings filed after the date of filing	IV-3
2.3.3	Claims filed after the date of filing	IV-3
2.3.4	Sequence listings filed after the date of filing	IV-3
2.3.5	Priority documents	IV-4
2.3.6	Cases in limitation proceedings where the application documents as filed are no longer available	IV-4
2.3.7	Citation of prior art in the description after the filing date	IV-4
2.3.8	Clarification of inconsistencies	IV-4
2.3.9	Trademarks	IV-4

2.4	Content of the application as "originally" filed - special applications	IV-5
2.4.1	Applications filed by reference to an earlier application	IV-5
2.4.2	Divisional applications	IV-5
2.4.3	Applications resulting from a decision under Art. 61	IV-5
2.4.4	International applications	IV-5
2.5	Assessment of "added subject-matter" – examples	IV-6
3.	Allowability of amendments under Art. 123(3)	IV-6
3.1	Basic principles	IV-6
3.2	Field of application	IV-6
3.3	Protection conferred by the patent as granted	IV-7
3.4	Version of the granted patent to be considered	IV-7
3.5	Assessment of impermissible extension of the protection conferred	IV-7
3.6	Conflicts between Art. 123(2) and Art. 123(3)	IV-8
3.7	Conflicts between Art. 123(3) and other requirements of the EPC	IV-8
4.	Compliance of amendments with other EPC requirements	IV-9
4.1	General principles	IV-9
4.2	In examination proceedings	IV-9
4.3	In opposition proceedings	IV-9
4.4	In limitation proceedings	IV-10
4.4.1	Art. 84	IV-10
4.4.2	Examination of the description and/or drawings	IV-10
4.4.3	Points to be disregarded	IV-10

Chapter V – Allowability of amendments - examples

1.	Introduction	V-1
2.	Amendments in the description	V-1
2.1	Clarification of a technical effect	V-1

2.2	Introduction of further examples and new effects	V-1
2.3	Supplementary technical information	V-1
2.4	Revision of stated technical problem	V-2
2.5	Reference document	V-2
2.6	Alteration, excision or addition of text in the description	V-3
3.	Amendments in claims	V-3
3.1	Replacement or removal of a feature from a claim	V-3
3.2	Inclusion of additional features	V-3
3.2.1	Intermediate generalisations	V-4
3.3	Deletion of part of the claimed subject-matter	V-6
3.4	Broadening of claims	V-6
3.5	Disclosed disclaimer	V-6
4.	Disclaimers not disclosed in the application as originally filed	V-7
4.1	The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers)	V-7
4.2	The subject-matter to be excluded is disclosed in the application as originally filed	V-8
5.	Amendments to drawings	V-9
6.	Amendments derived from drawings	V-9
7.	Changes in claim category	V-10
7.1	Product claim to use claim	V-10
7.2	Product claim to method claim	V-10
7.3	Method claim to product claim	V-10
7.4	Method claim to use claim	V-11
8.	Changes in the title	V-11

Chapter VI – Correction of errors	VI-1
1. Introduction	VI-1
2. Errors in bibliographic data	VI-1
3. Errors in publication	VI-1
4. Corrections of errors in application and patent documents during proceedings	VI-1
4.1 Admissibility of corrections	VI-1
4.2 Allowability of corrections	VI-1
4.2.1 Correction of description, claims and drawings	VI-2
4.2.2 Missing parts of description and missing drawings filed as corrections under Rule 139	VI-2
4.3 Examples	VI-3
5. Correction of errors in decisions and related application and patent documents	VI-4
5.1 Admissibility of corrections	VI-4
5.2 Allowability of corrections	VI-5
5.3 Correction of the translations of the claims	VI-5

Chapter I – The right to amend

A European patent application or European patent may be amended in examination, opposition and limitation proceedings. With regard to amendments filed in such proceedings, there are a number of important aspects to consider. Firstly, amendments must be admissible, i.e. they must be admitted into the procedure by the competent department of the EPO. Secondly, amendments must be allowable, which means that they must not:

- (i) add to the application or patent subject-matter which was not disclosed in the application as originally filed (Art. 123(2))
- (ii) introduce other deficiencies (such as lack of clarity in the claims - Art. 84)
- (iii) extend the protection conferred by a granted patent (Art. 123(3)).

Chapters H-II and H-III deal with the admissibility of amendments, while Chapters H-IV and H-V deal with their allowability. Chapter H-VI is dedicated to the correction of evident errors in documents submitted to the EPO or in decisions of the Examining or Opposition Divisions.

Chapter II – Admissibility of amendments – general rules

1. Introduction

How the admissibility of amendments is assessed will depend on the type of procedure (examination, opposition or limitation) and on the stage of the proceedings, as detailed in the following sections.

2. Admissibility during examination procedure

2.1 Before receipt of the search report - Rule 137(1)

In the case of a European patent application filed directly at the EPO (not via the PCT), it is not possible for the applicant to amend the application before receiving the European search report (Rule 137(1)).

Rule 137(1)

In the case of a Euro-PCT application requiring a supplementary European search according to Art. 153(7), the applicant may amend the claims, description and/or drawings before the application is subject to the supplementary search either by maintaining amendments filed in the international phase under Art. 19 PCT and/or Art. 34(2)(b) PCT or by filing amendments on and/or after entry into the European phase under Rule 159(1)(b) and/or Rule 161(2) respectively (see also E-VIII, 3 and B-III, 3.3.2).

For replies to an invitation under Rule 62a or 63, see H-II, 5.

2.2 After receipt of the search report - Rule 137(2)

After receiving the European search report and the search opinion, the applicant must respond to the search opinion (see B-XI, 8) and may, in his reply and of his own volition, amend the description, claims and drawings (see C-II, 3 and subparagraphs, and C-III, 3.2). Likewise, for applications for which no supplementary European search report is prepared (see B-II, 4.3) when entering the European phase from the PCT, the applicant is required to respond to the WO-ISA, IPER or SISR where the ISA and, if applicable, the IPEA or SISA was the EPO (see E-VIII, 3.1 and 3.2). This response to the WO-ISA, IPER or SISR may include amendments made by the applicant of his own volition to the description, claims and drawings. Thereafter, the applicant may amend the application only with the consent of the Examining Division.

Rule 137(2)

For applications:

Rule 71(1)

- (i) for which no search opinion is prepared (see B-XI, 1.1 and 7),
- (ii) for which a search opinion was prepared, but where the search report was drawn up before 1 April 2010 (in which case Rule 70a does not apply and the applicant is not required to respond to the search opinion), or

- (iii) which enter the European phase from the PCT, where the EPO was the ISA, IPEA or SISA and prepared a written opinion, but for which a communication under Rule 161 was already issued before 1 April 2010,

it is after receipt of the first communication from the examiner in examination proceedings that the applicant may "of his own volition, amend once the description, claims and drawings", provided that the amendment is filed at the same time as his reply.

2.3 After receipt of the first communication - Rule 137(3)

Subsequent to the applicable event mentioned in H-II, 2.2, the applicant may amend only if the examiner consents to the amendments proposed. Giving the Examining Division this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (see C-IV, 3). In exercising its discretion the Examining Division must consider all relevant factors; in particular, it must balance the applicant's interest in obtaining a patent which is legally valid and the EPO's interest in bringing the examination procedure to a close in an effective way (in accordance with the principles set out in G 7/93). Furthermore, the exercise of discretion under Rule 137(3) needs to be reasoned.

If an amendment is admissible, subsequent proceedings are based on the description, claims and drawings as amended. Consent to an amendment does not necessarily imply that the application as amended is free from any objection under the EPC. Distinctions should be drawn between different types of amendments.

Art. 94(3)

Amendments remedying a deficiency in response to the preceding communication must always be admitted, provided they do not give rise to some new deficiency. Amendments limiting a claim which is already considered allowable should normally be admitted. The same applies to amendments improving the clarity of the description or claims in a manner clearly desirable.

A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant further prior art of which the applicant has only just become aware (e.g. either through further citation by the examiner or through knowledge obtained from another source). Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO. In exercising his discretion under Rule 137(3), the examiner should bear in mind the length of the proceedings to date and whether the applicant has already had sufficient opportunity for amendments. He should refuse in particular amendments reintroducing deficiencies previously pointed out to and removed by the applicant.

Additional reasons for not admitting amendments according to Rule 137(3) include the non-admittance of:

- one or more requests where auxiliary requests are filed (see H-III, 2.1.1, last paragraph), and
- a request filed in, or in preparation for, oral proceedings (see III, 2.1.3),

where this is for reasons of procedural economy (taking into account the applicant's right to comment according to Art. 113(1)), where Rule 137(4) is not complied with in respect of the request in question.

Additional limitations on possible amendments of the application may apply if the European or supplementary European search report was a partial one due to Rule 63 or restricted in accordance with Rule 62a (see H-II, 6 and subparagraphs).

Rule 62a

Rule 63

Rule 137(5)

2.4 At an advanced stage of the proceedings

Any request by an applicant to replace the text of the application on the basis of which a patent could be granted by a text that has been extensively revised should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. This applies particularly in cases where the Examining Division has indicated that a version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version.

Rule 137(3)

2.5 Amendments filed in reply to a Rule 71(3) communication

If, in reply to the communication under Rule 71(3) and within the specified period, the applicant files a request for amendments under Rule 137(3) and/or a correction of errors under Rule 139, the procedure is as defined in C-V, 4. This applies regardless of whether the request is an explicit request for amendment or is drafted as an approval which is conditional on the filed amendments and/or corrections.

Rule 71(6)

2.5.1 Criteria for admitting such amendments

Decision G 7/93 dealt with the criteria to be applied when examining the admissibility of late-filed amendments in examination. The particular case to which that decision relates arose when the rules were differently formulated, and in a situation where the applicant had already given his consent to the version proposed by the Examining Division. However, what was said by the Enlarged Board in that case can be considered generally applicable to new requests put forward at a late stage of the proceedings, i.e. when the applicant has already had at least one opportunity to amend the application and the Examining Division has already completed substantive examination of the application (see T 1064/04).

Rule 71(3)
Rule 137(3)

In particular, applying the principles of G 7/93 to amendments filed in response to the communication under Rule 71(3) (see C-V, 1 to 3) means that this communication does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure. In deciding whether to admit such amendments, a balance must be struck between the applicant's interest in obtaining a patent which is valid in all of the designated states and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. At this stage of the proceedings, the substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only those amendments which do not appreciably delay the preparations for grant of the patent will be admitted under Rule 137(3). It is, however, appropriate to admit separate sets of claims for one or more designated States that made a reservation under Art. 167(2) EPC 1973 (see H-III, 4.4) or for which prior national rights exist (see H-III, 4.5).

2.5.2 Amendments filed in reply to Rule 71(3) invitation admitted

Rule 71(6)

If the Examining Division gives its consent under Rule 137(3) to these amendments and/or the correction and considers them allowable without issuing a further communication under Art. 94(3), it issues a second communication under Rule 71(3) based on the amended/corrected text (see C-V, 4.6), after which it then proceeds to the grant of the patent pursuant to Art. 97(1).

2.5.3 Amendments filed in reply to Rule 71(3) invitation rejected

Rule 71a(2)

Where amendments or corrections are not admitted, or where they are admitted but not considered allowable, examination will be resumed (see C-V, 4.7).

2.5.4 Exceptional case where amendments must be admitted

Rule 137(3)

It should be noted that if no communication under Art. 94(3) has preceded the communication under Rule 71(3) and the application was one of the exceptional cases (i), (ii) or (iii) mentioned in H-II, 2.2, the applicant may amend the description, claims and drawings of his own volition (see C-III, 2.1, for the conditions any amendment must satisfy). If the Examining Division finds that these amendments are allowable, a second communication according to Rule 71(3) is issued based on the text as amended (see C-V, 4.6). However, if the Examining Division is of the opinion that the amendments are not allowable (a finding of inadmissibility with regard to these amendments not being possible), the examination procedure should normally be resumed in accordance with C-V, 4.7.

2.5.5 Rule 137(4) applies to amendments filed at this stage

Any amendments filed in reply to the communication under Rule 71(3) must satisfy the requirements of Rule 137(4) by identifying the amendments and indicating the basis for them in the application as filed (see H-III, 2.1). If these requirements are not met and the

application is of one of the types mentioned in H-III, 2.1.4, the Examining Division may send a Rule 137(4) communication before proceeding further (see H-III, 2.1.1). If the applicant replies to this communication in time, the Examining Division will then decide if it consents to the amendments and will proceed accordingly as indicated in C-V, 4.

2.6 Further requests for amendment after approval

Once the applicant has approved the text communicated to him pursuant to Rule 71(3), by paying the fees and filing the translation of the claims, further requests for amendment will only exceptionally be admitted under the discretionary power of the Examining Division given by Rule 137(3). A clear example of an admissible request is where the applicant files separate sets of claims for designated States that made reservations under Art. 167(2) EPC 1973 (see H-III, 4.4) or for which prior national rights exist (see H-III, 4.5). Similarly, it is appropriate to admit minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see G 7/93). If these amendments involve changes to the claims, these should of course be accompanied by translations, as required by Rule 71(3).

Rule 71(5)
Rule 137(3)

If amendments are filed and do not comply with the requirements of Rule 137(4), the examiner may send a communication under Rule 137(4) (see H-III, 2.1.1).

When exercising its discretion under Rule 137(3) an Examining Division must consider and balance the applicant's interest in obtaining a patent which is legally valid in all of the designated states and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. The criteria for exercising its discretion under Rule 137(3) at this late stage are whether the request can be decided on in a reasonable period of time, and whether the amendments are allowable. If either of these criteria is not satisfied, the request for amendments should be refused by the Division in the exercise of its discretion according to Rule 137(3).

Refusal of amendments must be reasoned, and both Art. 113(1) and Art. 116(1) must be observed (see C-V, 4.7.1). It must be shown that the conditions defined in G 7/93 are not met. This means that arguments must be given as to why the amendments are not minor in nature but in fact necessitate resuming substantive examination while considerably delaying the issue of a decision to grant the patent.

However, once the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant, the Examining Division is bound by it (see G 12/91) and can only amend it to the limited extent provided for in Rule 140 (see H-VI, 4.1). In examination procedure, this corresponds to the date on which the centrally generated Form 2006, "*Decision to grant a European patent pursuant to Art. 97(1) EPC*", is forwarded to the postal service. This date is

Rule 140

shown at the bottom right-hand corner of Form 2006. The Examining Division is no longer competent to decide on a request for amendments or corrections under Rule 139 if the filing of the request and the completion of the proceedings occur on the same date (T 798/95).

2.7 Late-filed requests after summons to oral proceedings in examination

2.7.1 Concept of "clear allowability"

In examination procedure, the Division will apply the criterion of "clear allowability" in exercising its discretion under Rule 137(3) for treating requests filed late during the proceedings without proper justification (T 153/85).

Late-filed claims will not be admitted into the proceedings if they are not clearly allowable, i.e. they clearly do not satisfy the requirements of the EPC, because for example they clearly violate the requirements of Art. 123(2).

The "clear allowability" criterion is also applied to patent proprietors' late-filed requests in opposition proceedings (T 98/96).

2.7.2 Additional criteria for admissibility of requests

If the applicant files a reasonable number of requests related to amendments before the final date set in accordance with Rule 116(2), such requests should be admitted into the proceedings (see also H-III, 3).

If these requests or additional requests are filed after the above final date, they are late-filed and will be subject to the "clear allowability" criterion (see H-II, 2.7.1). Thus, the Division should first consider the requests before deciding on their admissibility. The mere fact that they are filed late is not *per se* a reason for not admitting them. This issue will normally be dealt with during oral proceedings.

If, after discussions, the Division comes to the conclusion that the late-filed requests are not clearly allowable, it should not admit them under Rule 116(2) and 137(3) on the grounds that they do not contain subject-matter which is clearly allowable, i.e. because this subject-matter clearly does not meet requirements of the EPC (where the applicant does not attend the oral proceedings, see H-III, 3.4.1 and E-II, 8.3.3). In the decision, reasoning is also to be given as to why the specific requirement(s) is(are) clearly not met.

As far as the criterion for admitting late-filed amendments is concerned, the Examining Division's first step should be to consider whether the claims are clearly not allowable, for example because they clearly violate the requirements of Art. 123(2). If the claims do not contain subject-matter which is clearly not allowable (i.e. they pass this first step in the examination of their admissibility), they should be

admitted if they are then subsequently also found to satisfy the following criteria (T 1273/04):

- the amendments are clearly permissible under Art. 123(2), Art. 84, Rule 137(5) and, where applicable, Rule 139;
- the newly defined subject-matter constitutes a convergent development of the subject-matter which has been the subject of examination;
- the subject-matter of the amended claims is clearly new.

However, it should be borne in mind that a request filed in response to a change of the subject of the proceedings, e.g. when a further document is cited for the first time during the oral proceedings, has to be admitted under Rule 116(1) (T 951/97).

3. Admissibility in opposition procedure

3.1 Amendments in reply to the notice of opposition

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments are admissible only if they are required in order to meet a ground for opposition. However, the ground for opposition does not actually have to have been invoked by the opponent. For example, in opposition proceedings admissibly opened on grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter. Opposition proceedings cannot be used merely to tidy up and improve the disclosure in the patent specification (see T 127/85). The mere addition of new claims to the claims as granted is inadmissible because such amendments cannot be said to meet a ground of opposition. However, the replacement of one independent claim as granted by multiple, e.g. two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted is admissible if such a replacement is occasioned by grounds of opposition specified in Art. 100 (see T 223/97).

Rule 80

3.2 Amendments not related to the grounds of opposition

If the proprietor proposes amendments to the patent in reply to the grounds of opposition and the Opposition Division intends to maintain the patent in amended form, pursuant to those grounds, other amendments, not related to the grounds of opposition (e.g. corrections, clarifications), 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 as a limitation of the claim, it would be admissible under Rule 80 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 (with the exception of unity of invention - G 1/91). If the Division is of the opinion that such a limiting clarification is not necessary, it should consider that the practice of interpreting a claim in a contracting state may be quite different from that of the EPO, and hence the patentee may see a need for such a limiting clarification.

Such amendments, however, should not be 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) (see G 12/91).

If an allowable request exists for maintenance of the opposed patent either as granted or in amended form, the following amendments should not be allowed:

- (a) filing of further claims (see T 829/93 and T 223/97);
- (b) comprehensive redrafting of the dependent claims;
- (c) comprehensive redrafting of the description.

In the absence of any amendments submitted by the patent proprietor with a view to meeting the grounds for opposition, there is no possibility to make any other amendments.

3.3 Amendments occasioned by national rights

Apart from the above (H-II, 3.1 and 3.2), amendments occasioned by national rights of earlier date are admissible pursuant to Rule 138 (see also G-IV, 6, with the exception of withdrawing the designation, see H-III, 4.5).

3.4 Insistence on unallowable amendments

If the patent proprietor requests amendments going beyond those permissible under Rule 80 (see H-II, 3.1 and 3.2), he should be invited to withdraw them. If he then maintains his request, it should not be allowed (for the reasoning see for example T 127/85, Headnote, and T 406/86, Headnote 1).

If, in addition to the request containing unnecessary amendments, there is an auxiliary request which meets the requirements of the Convention and in particular does not comprise amendments not complying with Rule 80, the decision must include the grounds for refusing the higher ranking first request(s).

It may occur that there is only one request which would be allowable, but it comprises amendments which clearly do not comply with

Rule 80. If the amendments cannot be allowed, the Division should explain the situation to the patentee so that revocation of the patent solely under Rule 80 can be avoided.

3.5 Late-filed requests in opposition proceedings

With respect to how late-filed requests are dealt with in opposition proceedings, reference is made to E-V, 2.1 (general examples), and E-V, 2.2 (examples concerning oral proceedings).

4. Limitation procedure

For admissibility of amendments in the limitation procedure, reference is made to D-X.

5. Amendments required by Rule 62a and/or Rule 63

Where the search was limited to certain subject-matter by application of Rule 63 (see B-VIII, 3.1 and 3.2), the claims must be amended in such a way as to remove the unsearched subject-matter and the description adapted accordingly.

Rule 63(3)

Where the search was limited to certain claims by application of Rule 62a (see B-VIII, 4.1 and 4.2), the claims must be amended in such a way as to remove the unsearched independent claims and the description adapted accordingly. To this end, the claims may be amended, for example, by deleting an unsearched independent claim or, where this complies with Art. 123(2) and Art. 84, by making an unsearched independent claim dependent on another independent claim of the same category which *has* been searched.

Rule 62a(2)

In both of these cases, a specific amendment is necessary, unless the applicant can convincingly argue that the invitation sent under Rule 62a(1) and/or Rule 63(1) was not justified.

Such amendments may, however, be made only in examination proceedings or, preferably, in reply to the search opinion. Since the applicant may not amend the claims before receipt of the search report (Rule 137(1)), any claims filed in reply to an invitation under Rule 62a or Rule 63 will be taken only as an indication of what the applicant wants the EPO to search and dealt with accordingly (see B-VIII, 3.2 and 4.2). The applicant will then have to confirm maintenance of these amendments formally on entry into the examination phase (see A-V, 2.2).

6. Amendments directed to unsearched matter - Rule 137(5)

Rule 137(5) sets out two further conditions for amendments to claims, namely that amended claims may not relate to (i) unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept and (ii) subject-matter not searched in accordance with Rule 62a and Rule 63 (see, however, H-V, 5).

6.1 Rule 62a and/or Rule 63 cases

Rule 137(5)

Amended claims may not relate to subject-matter not searched in accordance with Rule 62a or Rule 63. Consequently, the presence of this subject-matter in the description cannot be used as a basis for its re-introduction into the claims.

6.2 Subject-matter taken from the description

If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in the description and the Search Division did not find it appropriate to extend the search to this subject-matter, see B-III, 3.5) and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not admissible.

Rule 137(5)

In practice, within the framework of Art. 123(2) and Art. 82, Rule 137(5) should be construed as permitting any limitation of searched subject-matter which is unitary with the originally claimed subject-matter, irrespective of whether the technical feature(s) used for the limitation has/have been searched.

Thus, the addition to a claim of a technical feature which makes a contribution to the effect(s) of the originally claimed invention(s) and which was expressly not searched but was disclosed in the context of the invention in the application as filed (usually in the description) will not result in an amended claim lacking a single general inventive concept with respect to the originally claimed invention(s). Consequently no objection under Rule 137(5) should be raised in these circumstances, even though an additional search may be required.

However, where features taken from the description and pertaining to a different inventive concept than the original claim are added to the claim, an objection under Rule 137(5) may be raised. It may occur that the description of the application contains a further general inventive concept, distinct from that underlying the main claim and its dependent claims, if any, but not clearly identified or declared as such in the description. In such a case, if the subject-matter of the main claim based on the first inventive concept is amended, any amendment of the claim pertaining exclusively to said further inventive concept could justify an objection of lack of unity "*a posteriori*" (see T 1394/04).

Therefore, an objection under Rule 137(5) will normally arise if the applicant attempts to replace a technical feature contained in a claim with a different technical feature taken from the description.

Similarly to this case, but in contrast to the situation discussed above (where the added technical feature makes a contribution to the effect(s) of the originally claimed invention(s)), an objection under Rule 137(5) would also arise if a technical feature taken from the description which has an effect unrelated to the effect(s) of the

originally claimed invention(s) were added to a claim, except where the amendment does not result in a change in the general inventive concept. Such a situation could arise for instance if the original claims included a broad claim, the subject-matter of which was not new or did not involve an inventive step, but also included other claims defining one or more inventions, and a technical feature from the description which had an effect not mentioned in the original claims was added to that broad claim, such that there is lack of unity between the new limited claim and the claims originally present.

If an objection under Rule 137(5) is to be raised, the applicant should be informed that he may continue to pursue such subject-matter only in the form of a divisional application under Art. 76, provided that at least one of the periods provided for in Rule 36(1)(a) and (b) has not yet expired (see A-IV, 1.1.1, 1.1.1.2 and 1.1.1.3).

If a communication from the Examining Division does not raise an objection as to lack of unity under Art. 82, but rather raises an objection as to the admissibility of an amendment according to Rule 137(5), this does not cause the period for the filing of a divisional application according to Rule 36(1)(b) to start, or to start again if a unity objection has been raised before in examination proceedings (see A-IV, 1.1.1.3). Consequently, in such a case, if the period provided for in Rule 36(1)(a) has already expired and, if a unity objection has been raised before in examination proceedings, the period provided for under Rule 36(1)(b) has also expired, it will not be possible for the applicant to file a divisional application. If no such objection under Rule 137(5) is raised, the Examining Division should consider performing an additional search (see C-IV, 7.2).

However, applicants should bear in mind that the examining procedure should be brought to a conclusion in as few actions as possible. So the Examining Division may exercise its right not to admit further amendments under Rule 137(3) (see H-II, 2.3).

Rule 137(3)

7. Amendments in case of non-unity

7.1 Restriction to a single, searched invention

In reply to an objection of lack of unity, the applicant must restrict the claims to a single invention which has been searched. The examination can then be continued as for a unitary application but limited to that invention (see C-III, 3.1 and 3.2). However, if in response to a negative opinion concerning that invention the applicant later amends the claims to switch to a different searched invention, the exercise of the Division's discretion under Rule 137(3) to refuse to admit the amendments should be considered, in order to avoid serial examination of the different searched inventions (see also C-III, 3.4).

7.2 Restriction to unsearched subject-matter

If not all of the claims have been searched, in accordance with G 2/92 the applicant will be required to restrict the claims to one of the searched inventions. If in reply to the search opinion the applicant then restricts the claims to one of the originally claimed inventions which has not been searched, the examiner will write a first communication repeating the lack-of-unity objection raised in the search opinion. Any arguments of the applicant should be duly considered and dealt with in the communication.

If the application is restricted to unsearched but originally claimed subject-matter, it can be refused under Art. 82 and Rule 64 in line with G 2/92 (subject to the applicant's rights under Art. 113(1) and 116(1)).

7.3 Not restricted to single invention or claims amended

If in response to the search opinion the applicant does not restrict the application at all, or does restrict it, but still maintains two or more inventions, the objection of lack of unity raised at the search stage can be maintained, assuming that the examiner considers that it remains valid. The examiner will then write a first communication repeating the lack-of-unity objection raised in the search opinion.

If the applicant does not restrict the application at all, or does restrict it, but still maintains two or more inventions, the application can be refused under Art. 82 (subject to the applicant's rights under Art. 113(1) and 116(1)).

If the claims still cover an unsearched invention, an objection under Art. 82 and Rule 64 would also apply, in line with decision G 2/92 as discussed in H-II, 7.2.

If the claims have not been simply restricted, but have instead, or additionally, been amended, such amendments can often result in the previously raised lack-of-unity objection no longer being valid, or in the arguments on which the objection was based no longer being complete. Such amendments would thus result in the objection having to be either withdrawn or at least newly argued.

Sometimes lack of unity of invention arises only during substantive examination, for example following an amendment of one or more claims so as to overcome an objection of lack of inventive step. In such situations the examiner should raise an objection, but only in very clear cases. If the examiner raises such a new lack-of-unity objection at this stage, this qualifies as a new objection which would start the 24-month period for filing a divisional application according to Rule 36(1)(b) (see A-IV, 1.1.1.3).

7.4 Euro-PCT cases

7.4.1 Where the EPO does not perform a supplementary search

Where the EPO does not perform a supplementary search, the application must be limited to an invention searched in the international phase by the EPO. The above principles then apply *mutatis mutandis* (see also E-VIII, 4.2).

7.4.2 Where the EPO performs a supplementary search

Where the EPO performs a supplementary search on an application which is considered to lack unity, the applicant will not be invited to pay additional fees, but the supplementary search report will be established for the first invention only. The application must be limited to the invention searched in the supplementary search. The above principles then apply *mutatis mutandis* (see also E-VIII, 4.2).

Chapter III – Admissibility of amendments - other procedural matters

1. Introduction

This chapter deals with procedural matters and formal requirements relating to the admissibility of amendments. An important requirement dealt with is the applicant's obligation to identify amendments and indicate the basis for them in the application as filed (Rule 137(4)). The chapter also deals with the format of and procedure for making amendments, as well as issues relating to auxiliary requests and how to deal with different texts for different contracting states.

2. Procedure for amendments to documents

2.1 Indication of amendments and their basis under Rule 137(4)

When filing amendments, the applicant must identify them and indicate the basis for them in the application as filed. The requirement that the basis for amendments be indicated is met if, on consulting those parts of the application indicated, it is not necessary to look further in order to assess the amendment's compliance with Art. 123(2). Non-specific indications such as "see the description as filed" or "see the claims as filed" or "see the examples as filed" are generally not considered sufficient. This requirement also applies in cases where the applicant requests the Examining Division to amend his application (see H-III, 2.4).

Rule 137(4)

Whether the requirements of Rule 137(4) are met is assessed independently of whether the amendments in question comply with Art. 123(2). 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) are met, irrespective of whether the amendment based on that technical feature is allowable according to Art. 123(2) (see H-IV, 2.5).

Where the application was not filed in an official language of the EPO, in the absence of evidence to the contrary, for the purpose of assessing compliance with Art. 123(2) the EPO assumes that any translation of the application as filed is accurate. Consequently, in order to comply with Rule 137(4) it is sufficient to indicate the basis of an amendment in the translation of the application as filed.

Rule 7

2.1.1 Rule 137(4) communication and response thereto

If the Examining Division notes a failure to meet either requirement of Rule 137(4), it may issue a communication requesting the correction of this deficiency within a period of one month. The amendments in respect of which such a communication may be sent include, *inter alia*:

Rule 137(4)

- (i) claims filed after the date of filing under Rule 58 (see A-III, 15)

- (ii) amendments filed before entry into the European phase from the PCT under Art. 19 PCT and/or Art. 34 PCT (see E-VIII, 3)
- (iii) amendments filed on entry into the European phase from the PCT under Rule 159(1)(b) (see E-VIII, 3)
- (iv) amendments filed after entry into the European phase from the PCT under Rule 161(1) or Rule 161(2) (see E-VIII, 3)
- (v) amendments filed in response to the search opinion (see B-XI, 8)
- (vi) amendments filed during the examination procedure (see, however, H-III, 2.1.3), including those filed after the communication according to Rule 71(3).

Such a communication can only be sent in respect of amendments which are part of a current request. It cannot relate to amendments which have since been withdrawn or superseded.

Art. 94(4)

If the applicant fails to comply with this requirement within the above-mentioned period of one month, the application is deemed to be withdrawn due to the applicant's failure to reply to this communication from the Examining Division. The applicant may request further processing for failure to observe this time limit (see E-VII, 2.1).

If the amendments are filed in response to a communication according to Rule 71(3) and the requirements of Rule 137(4) are not satisfied in respect of them, the Examining Division may send a Rule 137(4) communication. Thereafter, if the applicant replies in time, the Examining Division will then decide whether to admit the amendments (see H-II, 2.5.5).

Where auxiliary requests are filed, a Rule 137(4) communication may also be sent in respect of one or more of the main and/or auxiliary requests. Alternatively, where Rule 137(4) is not complied with in respect of a specific request (main or auxiliary), this request may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with Art. 113(1), be deemed inadmissible according to Rule 137(3).

2.1.2 Amendments withdrawn or superseded in the Rule 137(4) period

If the applicant replies in time to the Rule 137(4) communication by withdrawing the amendments in respect of which the communication was sent but without identifying those amendments or indicating their basis in the application as filed, then no loss of rights will occur according to Rule 137(4). However, where objections are thereby re-introduced into the application, this may result in the amendments being deemed to be inadmissible according to Rule 137(3) (see H-II, 2.3).

No further Rule 137(4) communication will be sent in respect of further amendments filed in a timely response to the Rule 137(4) communication. By the expiry of the one-month period, the applicant must have identified and indicated the basis of:

- (i) amendments in respect of which the Rule 137(4) communication was sent and which are not superseded by further amendments filed during the one-month period under Rule 137(4), and
- (ii) amendments filed during that one-month period.

The applicant does not need to comply with Rule 137(4) in respect of amendments which are superseded by further amendments filed in the one-month period. For example:

03.06.2010	Application filed: 10 claims
25.03.2011	Extended European search report drawn up
21.08.2013	Amended claims 1-10 filed in examination proceedings, no basis indicated
03.09.2013	Examining Division sends a Rule 137(4) communication in respect of amended claims 1-10 filed on 21.08.2013
07.10.2013	Amended claims 6-10 filed
14.10.2013	One-month period under Rule 137(4) expires

In the above example, the applicant must, by expiry of the one-month period according to Rule 137(4) on 14.10.2013, indicate the basis for amended claims 1-5 as filed on 21.08.2013 and for amended claims 6-10 as filed on 07.10.2013, and failure to do so results in the application being deemed to be withdrawn according to Art. 94(4). It is not necessary for the applicant to indicate the basis for the superseded amendments to claims 6-10 filed on 21.08.2013. Note in particular that, where the basis for the amendments to claims 6-10 filed on 07.10.2013 is not indicated by 14.10.2013, then no further Rule 137(4) communication is sent in respect of these amendments and the application is deemed to be withdrawn on expiry of the one-month period on 14.10.2013.

2.1.3 Rule 137(4) and oral proceedings

A Rule 137(4) communication will not be sent where the amendments in question are filed during oral proceedings. Nonetheless, it is a requirement of Rule 137(4) that amendments and their basis be identified. If the applicant fails to fulfil this requirement in respect of amendments filed during oral proceedings, the amendments may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with Art. 113(1), be rejected as inadmissible by the Examining Division, exercising its discretion under Rule 137(3).

Amendments filed in preparation for oral proceedings in response to the summons thereto according to Rule 116(2) will be dealt with in those oral proceedings as indicated above. However, if the oral proceedings are cancelled or the applicant does not attend and the procedure is continued in writing after the oral proceedings are held in his absence, a Rule 137(4) communication may be sent by the Examining Division in respect of those amendments.

2.1.4 Transitional provisions relating to Rule 137(4)

The above procedure applies to the following applications (see Art. 2(2) of the Decision of the Administrative Council of 25 March 2009, OJ EPO 2009, 299):

- (i) European applications for which the search report is drawn up on or after 1 April 2010,
- (ii) Euro-PCT applications for which the supplementary European search report is drawn up on or after 1 April 2010, and
- (iii) Euro-PCT applications for which the international search report is drawn up by the EPO acting as International Searching Authority on or after 1 April 2010 (Art. 153(6)).

2.2 Amendment by submitting missing documents or by filing replacement pages

The content of a European patent application or patent may be amended within the limits laid down in Art. 123(2) and (3). (For the conditions governing amendments, see also A-V, 2, H-II, H-IV, H-V, and D-V, 6) This will normally be done by submitting missing documents or by filing replacement pages. Where replacement pages are filed the applicant or patent proprietor should, in the interests of procedural efficiency, identify clearly all amendments made, and indicate on which passages of the original application these amendments are based.

Amendments should preferably be identified using functions available in a text editor to clearly indicate deletions and insertions in the amended text. Pages with such indications should be submitted in addition to clean copies.

The basis for amendments should preferably be indicated by including in the letter of reply a list of the amendments made and the precise basis for amendments in the originally filed documents. Where the basis is not explicit, e.g. where a different wording is used or features are taken only from drawings or generalised from a specific embodiment, a short explanation of why Art. 123(2) is fulfilled should be given.

2.3 Amendments using copies

Amendments, particularly to the description or claims, may be made by using copies in accordance with the following procedure:

If he deems it expedient, the examiner or formalities officer may, on a copy of one or more pages of the documents to be amended, put forward suggestions as to how amendments should be made in such a way as to take account of the objections raised. The annotated copies (not the working documents which are to remain in the dossier) will then be forwarded to the applicant or, in opposition proceedings, to the proprietor of the patent and the other parties, in the communication setting out the objections. In this communication, the applicant or proprietor will not only be informed of the deficiencies recorded and invited to adopt a position or submit amendments within a fixed time limit, but will also be invited simultaneously to resubmit the said copy and – as an alternative to submitting replacement pages – to indicate on this copy, separately from the comments of the examiner (preferably typewritten and in such a way as to be well legible after photocopying), any amendments to be made to the pages concerned. Opponents may also be invited to submit their comments in the same way.

The parties may also submit copies of one or more amended pages on their own initiative. The filing of completely retyped documents should normally be objected to, for reasons of procedural economy, as these documents will have to be checked for correspondence with the original documents (see T 113/92). Requests to this effect will, therefore, normally not be admitted under Rule 137(3). Only where the amendments are so extensive as to affect the legibility of the copies, replacement pages must be filed. In this case such pages may also be requested by the examiner on his own initiative.

2.4 Amendments made by the EPO at the request of a party

Where necessary, deficient documents may also be amended at the request of a party by the competent department of the EPO. This could be the procedure for minor amendments, e.g. where it is necessary to insert details which were omitted in the request for grant, and the number of amendments involved is reasonable, or where whole pages or paragraphs are to be deleted. The party concerned should submit a list summarising the amendments to be undertaken by the EPO. It is, however, at the discretion of the examiner to decide whether the number of changes requested is in fact unreasonable and would take a considerable amount of time to deal with. If so, the examiner will require that the party makes the amendments and submits amended pages. This procedure could also be followed for minor amendments to drawings, e.g. for amending a reference number or deleting one or more whole figures (as regards the removal of references following an amendment to the description, see F-II, 4.8). In the case of complicated amendments to drawings, where it is not immediately clear how the changes are to be made, the party concerned, who as a rule is the applicant or proprietor, must submit replacement pages.

2.5 Withdrawal of amendments/abandonment of subject matter

Any subsequent request to withdraw an amendment is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examiner, the corresponding amendment will be admitted only if the examiner consents.

In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated.

3. Auxiliary requests

In examination, opposition and limitation proceedings, parties may submit a main request followed by one or more auxiliary requests (see also D-IV, 5.3).

Example 1:

"We request grant of a patent as per the documents originally filed or, alternatively, as per the amended documents now enclosed."

Example 2:

"We request that the opposition be rejected or, alternatively, that the patent be maintained in amended form as per the enclosed documents."

Such further (auxiliary) requests are made in case the Examining or Opposition Division cannot allow the main (first) request.

If in examination proceedings an applicant files text labelled as an auxiliary request, but also indicates that he is not yet willing to restrict himself to that request, the text should not be considered as a true auxiliary request within the meaning of this chapter, such that it would not be possible to proceed directly to the issue of a communication under Rule 71(3) based on this text (see C-V, 1.1). In such circumstances it would be appropriate to contact the applicant by telephone to establish whether he would be prepared to proceed to grant on the basis of that text. The applicant's agreement or non-agreement that a Rule 71(3) communication can be based on such an auxiliary request must be mentioned in the minutes of the telephone conversation or, in the case of agreement, in the Rule 71(3) communication (see C-VII, 2.5).

3.1 General principles

If the main request is allowable, the Division will ignore any auxiliary requests.

If the main request is not allowable, the Division will consider the auxiliary requests, in the sequence chosen by the requester.

If an auxiliary request is allowable, the Division will ignore all subsequent requests.

3.1.1 Sequence of requests

Under Art. 113(2), the EPO decides upon European patent applications or patents only in the text submitted to it, or agreed, by applicants or proprietors. These parties must therefore clearly indicate the text they are proposing or, if they are submitting more than one text, the sequence in which they want the EPO to consider them. Otherwise the Division does not know which version to base its decision on and would ultimately have to refuse the application, revoke the patent or reject the request for limitation for lack of any clear request.

3.1.2 Obligation to give reasons

In examination, opposition and limitation proceedings, whenever a request by any of the parties is refused, reasons must always be given.

3.1.3 Neither main nor auxiliary requests allowable

If the Examining or Opposition Division cannot allow the main request or any of the auxiliary requests, it must issue a decision to that effect, taking Art. 113(1) and 116 into account. The decision must include the reasons for rejecting/refusing the main request and each of the auxiliary requests, except where the requests in question have been withdrawn.

3.1.4 Indication of amendments made in main and/or auxiliary requests in examination proceedings

Where main and auxiliary requests are filed in examination proceedings and the applicant does not identify the amendments and/or does not indicate the basis for them in the application as filed, a communication according to Rule 137(4) may also be sent in respect of one or more of the main and/or auxiliary requests (see H-III, 2.1.1).

Alternatively, where Rule 137(4) is not complied with in respect of a specific request (main or auxiliary), this request may be rejected as inadmissible under Rule 137(3) (see H-III, 2.1.1). When exercising its discretion under Rule 137(3), an Examining Division must consider and balance the applicant's interest in obtaining a patent which is legally valid in all of the designated states and the EPO's interest in a speedy conclusion of the proceedings. Furthermore, the exercise of discretion under Rule 137(3) needs to be reasoned.

3.2 In the search phase

In the search phase, under Rule 137(1) amendments to the claims are not admissible before the applicant receives the European search report, and therefore no auxiliary requests can be submitted. If auxiliary requests are submitted before the establishment of a supplementary European search report (see H-II, 2.1), only the main request will be taken into account in the search (for exceptions where

main and auxiliary requests are both considered at the search stage, see B-VIII, 3.2.2 and 4.2.2).

3.3 In examination proceedings

3.3.1 Admissibility of auxiliary requests

3.3.1.1 Criteria for admissibility of auxiliary requests

As set out above, in this case the Examining Division must, when exercising its discretion under Rule 137(3) not to admit one or more auxiliary requests, balance the interests of the applicant and procedural efficiency.

Thus, an auxiliary request which contains minor deficiencies but otherwise complies with the requirements of the EPC should normally be admitted into the procedure.

When deciding on the admissibility of auxiliary requests the principles set out in H-II should be considered for each of the requests, since each request is in fact a set of amended claims.

Auxiliary requests reintroducing subject-matter which has already been considered unallowable and has been removed by the applicant will not be admitted (see also H-II, 2.3). The same may apply to auxiliary requests introducing new deficiencies.

3.3.1.2 Timeliness and structure of auxiliary requests

For late-filed requests, in addition to the criteria set out in H-II (in particular, H-II, 2.4, 2.5 and 2.6), the subject-matter of the new claims should not diverge considerably from the claims already filed. The requests should normally represent a convergent development, i.e. the subject-matter of the auxiliary requests should constitute sequential limitations in the direction of an intended invention and should not make use of different characteristics in order to branch out in different directions (T 1685/07). Filing a large number of unstructured requests or requests involving different variants late in the procedure may lead to the requests not being admitted.

3.3.2 Preparing the decision

If the Examining Division is able to allow an auxiliary request (but not the main request or any higher-ranking auxiliary requests), it will inform the applicant accordingly in a communication under Rule 71(2) or in an annex to the communication according to Rule 71(3), giving its reasons for refusing the main and higher-ranking auxiliary requests (see C-V, 1.1).

In oral proceedings, it may be appropriate to ask the applicant whether, in view of an allowable request, he would be prepared to withdraw the unallowable higher-ranking request(s). However, the applicant is not obliged to do so.

If auxiliary requests are submitted after the date set according to Rule 116(1) but the applicant/representative does not attend the oral proceedings, the Examining Division will apply the criteria set out in H-III, 3.3.1, in deciding on the admissibility of the auxiliary requests and may exercise its discretion under Rule 137(3) not to admit one or more of the requests (see H-II, 2.3, and H-III, 3.1.4), and it may do so in the absence of the applicant/representative.

3.3.3 Complete text for auxiliary request not yet available

If a complete text corresponding to the allowable auxiliary request does not yet exist, the applicant must be asked to make the necessary amendments.

In oral proceedings, the Division should always try to have the description brought into line with the version of the claims it considers allowable. If necessary, the oral proceedings should be interrupted for this purpose.

3.3.4 Complete text for auxiliary request available

If a complete text of the application according to the allowable auxiliary request already exists, a communication under Rule 71(3) is issued. In an annex to this communication the Division must give its reasons for refusing the higher-ranking requests (see also C-V, 1.1). Where appropriate, this may be done by reference to earlier communications. If the applicant approves this proposed text, then in accordance with Rule 71(3) he indicates this by filing the translations of the claims and paying the fees for grant and publishing without filing any request for amendment or correction of the proposed text (if such a request is filed, the procedure is as indicated in C-V, 4). If he does so, the application proceeds to grant on the basis of the text of the auxiliary request as proposed in the communication under Rule 71(3) (see C-V, 2).

3.3.5 Applicant does not approve the text proposed for grant

If the applicant does not approve the text according to the auxiliary request as proposed in the communication under Rule 71(3), the procedure is as set out in C-V, 4 (see in particular C-V, 4.7 and 4.6.2).

3.4 In opposition proceedings

In opposition proceedings, if an auxiliary request by the proprietor for maintenance of the patent in amended form is allowable, the Division cannot revoke the patent (see T 234/86).

3.4.1 Written procedure

If the Opposition Division, after examining the parties' submissions, considers it can maintain the patent only in amended form as per an auxiliary request from the proprietor, it must first ensure that the parties have been allowed to comment under Art. 113(1) on the grounds and evidence behind the non-allowance of the higher-ranking request(s) and on the grounds and evidence behind the allowance of the lower-ranking request (where oral proceedings have been requested see also H-III, 3.5.2).

If, despite the existence of an allowable request, the proprietor continues to maintain one or more unallowable higher-ranking requests, an interlocutory decision is issued. This decision must include the finding that the patent and the invention to which it relates, as amended in accordance with the allowable auxiliary request, meet the requirements of the EPC. It must also set out the reasons, based on grounds and evidence already communicated to the parties, for refusing the higher-ranking requests and for allowing the lower-ranking request.

3.4.2 Oral proceedings

If the Opposition Division is able to allow an auxiliary request but not the main or higher-ranking auxiliary requests, the chairman should inform the parties (possibly after interrupting the proceedings) which request is allowable and that the higher-ranking request(s) is/are not allowable (and on which grounds they are not allowable), ensuring beforehand that the parties have already had the opportunity to comment on all grounds and evidence underlying this finding. The chairman will then normally ask the proprietor if he is prepared to convert the allowable auxiliary request into a main request (by abandoning all higher-ranking unallowable requests). The Division cannot, however, insist on the proprietor making such a declaration.

If, despite the existence of an allowable auxiliary request, the proprietor continues to maintain higher-ranking unallowable requests, the Division issues an interlocutory decision to the effect that:

- (a) the main request and possibly one or more auxiliary requests is/are not allowable
- (b) in respect of the allowable auxiliary request, the amended patent and the invention to which it relates satisfy the requirements of the EPC.

If, on the other hand, the proprietor withdraws the higher-ranking requests such that the allowable auxiliary request becomes the main request, the Division will issue an interlocutory decision to the effect that this request satisfies the EPC.

The Division should try as far as possible to ensure that, if it allows an auxiliary request at oral proceedings, the complete final text is available at the end of the proceedings.

3.5 In limitation proceedings

3.5.1 General principles

The filing of auxiliary requests (e.g. claim versions) together with a main request is possible in limitation proceedings, just as in examination proceedings. However, it should be remembered that there are restrictions with regard to the possibility of filing amendments in limitation proceedings (see D-X, 4.3 and 4.5).

The procedure to be applied, subject to any request for oral proceedings, is slightly different to that applicable in pre-grant proceedings under Rule 71(3), especially in view of the requirements of Art. 113(1) and (2). In particular, in a case where an auxiliary request is allowable and the main request is not, if this were communicated under Rule 95(3), this would no longer leave the requester the option of having his main request rejected with an appealable decision. Thus, the following applies:

- (a) if the main request is allowable, the invitation under Rule 95(3) to file the translations and pay the fees will be issued on that basis;
- (b) if an auxiliary request is allowable, but not the main request (and possibly other higher-ranking requests), the proprietor will be informed of the reasons in a communication under Rule 95(2) and invited to abandon the non-allowable request(s); if he does not do so, the request will be rejected as in (c) below;
- (c) if none of the requests is allowable, initially a communication under Rule 95(2) setting out the reasons and indicating a possible remedy is sent to the requester; if no remedy is undertaken, a decision rejecting the request is issued, and the annex prepared by the Examining Division will need to set out the reasons why none of the requests are allowable.

In cases (b) and (c), the decision may be appealed by the requester.

3.5.2 Written procedure

If the Examining Division, after examining the request for limitation, considers that the patent can be limited only on the basis of an auxiliary request, it informs the requester accordingly in a communication under Rule 95(2), giving reasons why the main request and any higher-ranking auxiliary requests are not allowable and informing the requester which auxiliary request is considered allowable. Where appropriate, the Division also informs the requester what amendments must be made to the patent specification documents to bring them into line (Art. 105b(1) and Rule 95(2)).

If in response to the communication under Rule 95(2) the requester withdraws his unallowable request(s) and (where applicable) makes any amendments still outstanding, the Examining Division will issue a communication under Rule 95(3) inviting him to pay the prescribed fee and to file the translation of the limited claims of the allowable request (see D-X, 5).

If the requester insists on maintaining an unallowable request, and fails to comply with the Examining Division's request that he file documents corresponding to the allowable auxiliary request, the request for limitation must be rejected (Art. 105b(2) and Rule 95(4)). The decision must give the reasons for not allowing the higher-ranking request(s)

and must point out, as regards the allowable auxiliary request, that the requester failed to comply with the Division's request to submit a text enabling the patent to be limited on the basis of the allowable request.

3.5.3 Oral proceedings

If the Examining Division is able to allow an auxiliary request but not the main or higher-ranking requests, the chairman should inform the requester (possibly after interrupting the proceedings) which request is allowable and why the higher-ranking request(s) is/are not. He will then normally ask the requester if he is prepared to convert the allowable auxiliary request into a main request. The Division cannot however insist on the requester making such a declaration.

If, despite the existence of an allowable text, the requester continues to maintain an unallowable higher-ranking request, the request for limitation shall be rejected (Rule 95(4)). The Division will issue a decision giving the reasons for not allowing the higher-preference requests and pointing out, as regards the allowable auxiliary request, that the requester failed to comply with its request to submit a text enabling the patent to be limited on the basis of the allowable request.

4. Different texts in respect of different Contracting States

4.1 Dealing with different texts in examination

A situation may arise in which, as a result of amendment, the application has two or more distinct sets of claims (see H-III, 4.2 to 4.5).

In examining the sets of claims referred to above, it will generally be found expedient to deal with each one quite separately, especially where the difference between them is substantial. The communication to the applicant will thus be divided into two or more parts, and the aim will be to have each set of claims, together with the description and drawings, brought into a state where it is in order to proceed to grant.

If the examiner considers that the description and drawings are so inconsistent with either set of claims as to create confusion, he should require the applicant to amend the description and drawings to remedy this. If the applicant voluntarily proposes such amendment the examiner should admit it only if he considers it necessary. In particular, different descriptions and drawings will be required only if it is not possible to set out clearly in a common description which subject-matter is to be protected in the different Contracting States.

Hence this type of application will, after amendment, either consist of two or more distinct sets of claims each supported by the same description and drawings, or two or more sets of claims each supported by different descriptions and drawings.

4.2 Different text in respect of the state of the art according to Art. 54(3) and Art. 54(4) under EPC 1973

If the EPO notes that in respect of one or more of the designated Contracting States the content of an earlier European patent application forms part of the state of the art pursuant to Art. 54(3), two situations could arise:

- (i) the filing date of the application or patent under examination is before the date of entry into force of the EPC 2000. Art. 54(4) EPC 1973 is still transitionally applicable (see Art. 1, Decision of the Administrative Council of 28 June 2001, OJ EPO 2003 Special edition No. 1, 202). Here, if conflicting prior art gives rise to different texts of the claims, different sets of claims for the Contracting States concerned may be filed.
- (ii) the filing date of the application or patent under examination is on or after the date of entry into force of the EPC 2000. As Art. 54(4) EPC 1973 has been deleted, the conflicting prior art belongs to the state of the art for all Contracting States, irrespective of the effected designations. Likewise, it is irrelevant if the designation fee(s) for the earlier European patent application has/have been paid, since there is no provision in the EPC 2000 corresponding to Rule 23a EPC 1973. Consequently, the possibility of having different texts for different Contracting States on the basis of Art. 54(3) no longer exists.

4.2.1 Art. 54(3) and (4) EPC 1973 in opposition proceedings

The substance of H-III, 4.2, applies *mutatis mutandis* in opposition proceedings. The transitional provisions to the EPC 2000 require that, if the underlying application for a patent was filed before the date of entry into force of the EPC 2000, the conflicting prior art under Art. 54 be treated in accordance with EPC 1973, e.g. taking into account Art. 54(3) and (4) of EPC 1973 with the system of common designations. However for patents for which the underlying application was filed on or after the date of entry into force of the EPC 2000, the provisions of the latter apply, in which the system of common designations for conflicting prior art under Art. 54(3) no longer exists. Accordingly, different texts for different states are not acceptable any more for such patents (see F-II, 4.3 and H-III, 4.2).

Rule 138

4.3 Different text where a partial transfer of right has taken place pursuant to Art. 61 or Rule 78

4.3.1 Different text where a partial transfer of right takes place pursuant to Art. 61 in examination proceedings

If by a final decision pursuant to Art. 61 it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, the original European patent application must contain, "where appropriate", for the designated Contracting States in which the decision was taken or recognised, claims, a description and drawings which are different

Art. 61(1)(b)

Rule 17

Rule 18(1) and (2)

from those for the other designated Contracting States (see also H-III, 4.1 and C-IX, 2).

4.3.2 Different texts where a transfer of the patent in respect of certain designated states takes place in opposition proceedings

Rule 78(2)

Where a third party has, in accordance with Art. 99(4), replaced the previous proprietor for one or some of the designated Contracting States (see D-I, 6, third paragraph), the patent as maintained in opposition proceedings may for those States contain claims, a description and drawings which are different from those for the other designated Contracting States, without, of course, going beyond the original disclosure.

4.3.3 Opposition cases with different texts where a partial transfer of rights by virtue of a final decision pursuant to Art. 61 and Rule 18(1) and Rule 18(2) took place in examination proceedings

The substance of H-III, 4.3.1, applies *mutatis mutandis*.

4.4 Different text where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973

Art. 167(2)(a)
EPC 1973

Where a Contracting State has entered reservations in accordance with Art. 167(2)(a) EPC 1973, patent applications and patents seeking protection for chemical, pharmaceutical or food products as such may include different sets of claims for that State and for the other designated States respectively. Such reservations were made by Austria, Greece and Spain. Without prejudice to Art. 167(5) EPC 1973, the reservation for Austria ceased to have effect after 7 October 1987, those for Greece and Spain after 7 October 1992 (for Spain, see Notice from the EPO dated 18 June 2007, OJ EPO 2007, 439).

Normally, a common description should be sufficient for all sets of claims.

4.5 Different text where national rights of earlier date exist

Art. 139(2)

National rights of earlier date are not comprised in the state of the art (Art. 54) for the purposes of the EPO examination for patentability. Consequently, a specific search for national rights of earlier date is not made, although any documents found are mentioned in the search report (see B-VI, 4.2). However, under Art. 139(2), national rights of earlier date can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. These rights represent exceptions to the uniformity of European substantive patent law. Where national rights exist, therefore, the applicant has a legitimate interest in submitting separate claims to ensure that the patent granted will not be partly revoked in some Contracting States. The filing of separate claims should, however, neither be required nor suggested.

If an applicant produces evidence in examination proceedings of the existence of pertinent national rights of earlier date in a particular designated State, it is appropriate to allow the submission of separate claims for the Contracting State in question (see H-II, 2.5 and 2.6). The evidence must be in the form of a printed specification or, where applicable, a copy of the utility model or utility certificate or of the application for it (see Art. 140); this is necessary to prevent unjustified deviation from the unity of the European patent.

The effect of the national right of earlier date is determined by the relevant national provisions. The examiner does not have to decide whether the applicant has, by means of separate claims, limited the scope of his application to the extent required. That is the responsibility of the applicant.

The examiner must check that the separate claims do not contravene Art. 123(2) and that they meet the other requirements of the EPC.

In contrast to European rights of earlier date, national rights of earlier date are not comprised in the state of the art, so there is no justification for a separate description. However, at a suitable point in the preamble to the description, preferably in a separate paragraph following the information pursuant to Rule 42(1)(a), a reference to this situation must be made, for example along the following lines:

"With reference to ... (e.g. earlier application No. ... in ...), the applicant has voluntarily limited the scope of the present application, and submitted separate claims for ... (Contracting State)."

5. Calculation of claims fees

The claims fees are calculated in accordance with A-X, 11.2, C-V, 1.4, 4.2 and 4.8.1.

Chapter IV – Allowability of amendments - Art. 123(2) and Art. 123(3)

1. Introduction

Chapters H-II and H-III deal with the admissibility of amendments, i.e. whether the competent department of the EPO will admit amended application or patent specification documents into the procedure. After an amendment has been admitted into the procedure, the competent department 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.

2. Allowability of amendments under Art. 123(2)

2.1 Basic principle

The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the EPC including, in particular, inventive step and the other matters listed in B-XI, 3.6 (see also C-III, 2).

If, however, the applicant seeks to amend the description (other than references to the prior art), the drawings or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed.

2.2 Field of application of Art. 123(2)

The underlying idea of Art. 123(2) is that an applicant is not 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 (see G 1/93). An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, 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. At least where the amendment is by way of addition, the test for its allowability normally corresponds to the test for novelty given in G-VI, 2 (see T 201/83).

2.3 Content of the application as "originally" filed – general rules

Under Art. 123(2), it is impermissible to add to a European application subject-matter which is not directly and unambiguously derivable from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document.

The term "implicit disclosure" means no more than the clear and unambiguous consequence of what is explicitly mentioned in the application as filed. Whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, 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 the disclosure of that document necessarily implies (T 823/96).

2.3.1 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 which is identified in such description are *prima facie* not within "the content of the application as filed" for the purpose of Art. 123(2). 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 Art. 123(2) if the description of the invention as originally filed leaves no doubt to a skilled reader (see T 689/90) that:

- (i) protection is or may be sought for such features;
- (ii) such features contribute to solving the technical problem underlying the invention;
- (iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and
- (iv) such features are precisely defined and identifiable within the disclosure of the reference document.

Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90):

- (i) a copy of the document was available to the EPO on or before the date of filing of the application; and

- (ii) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

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

The procedure under Rule 56 allows the applicant to file missing drawings or parts of the description subsequently, and to rely on the priority document in order to avoid re-dating of the application to the date of filing of the missing parts. Under Rule 56(3), re-dating is only avoided where the missing parts were "completely contained" in the priority document (see C-III, 1 and A-II, 5). The provisions of Rule 56(3) 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 (in keeping with G 3/89 and G 11/91). For Euro-PCT applications a similar provision exists under Rule 20.6 PCT, whereby a review by the EPO as elected or designated Office is possible under Rule 82*ter* PCT.

Rule 56

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

2.3.3 Claims filed after the date of filing

Claims filed after the date of filing under Rule 58 are never considered to be part of the application documents "as originally filed" and must therefore comply with the requirements of Art. 123(2) (see A-III, 15). For this reason, the examiner has to check that the claims satisfy the requirements of Art. 123(2), according to the same practice and standards as established in examination for amendments filed in other phases of the procedure (see H-V).

Rule 58

2.3.4 Sequence listings filed after the date of filing

A standardised sequence listing filed after the date of filing does not form part of the description (Rule 30(2)). Such a standardised sequence listing is not published either as an annex to the application or together with the specification (see the Notice from the EPO dated 28 April 2011 concerning the filing of sequence listings, OJ EPO 2011, 376, IV.2).

Pages and electronic files disclosing sequences or constituting a non-standardised sequence listing which were filed at the date of filing are an integral part of the application as originally filed and are treated like any other parts of the description.

A subsequently filed standardised sequence listing may contain only the sequence information - in a standardised form - already contained in the original application, and in particular the number of sequences and their numbering should be the same as in the original description

(above EPO Notice, section I.2.4). To this end the applicant must file a statement confirming that the subsequently filed standardised sequence listing does not include matter which goes beyond the content of the application as originally filed (Article 2(2) of the Decision of the President dated 28 April 2011 on the filing of sequence listings, OJ EPO 2011, 372). In line with this, a subsequently filed standardised sequence listing cannot be used to determine the originally disclosed content of the application, but only for search purposes (above EPO Notice, section I.2.5).

A subsequently filed standardised sequence listing is not to be examined for compliance with the requirements of Art. 123(2), as it is not part of the description.

2.3.5 Priority documents

Under Art. 123(2) it is impermissible to add to a European application matter present only in the priority document for that application (see T 260/85), unless this is done under the provisions of Rule 56(3) (H-IV, 2.3.2). For correction of errors, see H-VI, 4

2.3.6 Cases in limitation proceedings where the application documents as filed are no longer available

In order to verify that the limitation introduced into the claim(s) meets the requirements of Art. 123(2), the application documents as filed are the ones to be considered. In rare cases where the patent to be limited is of an older date, it may happen that the original file is destroyed, with the result that the original application documents as filed are no longer available (see Rule 147 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.1). Examination of Art. 123(2) has then to be based on the available published application instead of the original application documents, on the assumption that it is identical in content to the application as filed.

2.3.7 Citation of prior art in the description after the filing date

Art. 123(2)

There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examiner (see F-II, 4.3 and F-III, 8).

2.3.8 Clarification of inconsistencies

The straightforward clarification of an obscurity or the resolution of an inconsistency will normally not be objected to, provided that the clarification does not contravene the requirements of Art. 123(2).

2.3.9 Trademarks

If an amendment is made in order to clarify the meaning of a trademark or to replace a registered trademark with a corresponding technical term, the examiner should be particularly careful to ascertain that the amendment does not conflict with Art. 123(2). The composition of a trademarked product may have changed over time.

2.4 Content of the application as "originally" filed - special applications

2.4.1 Applications filed by reference to an earlier application

According to Rule 40(1)(c), the applicant may file his European application by reference to a previously filed application (A-II, 4.1.3.1). Since claims are no longer required in order for a date of filing to be accorded, the applicant has three options:

- (i) when filing the European application, indicate that the reference to the previously filed application includes the claims
- (ii) at the time of filing, 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, indicate the reference to a previously filed application and file the claims after the date of filing (Rule 58).

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 Art. 123(2) (see H-IV, 2.3.3).

2.4.2 Divisional applications

Under Art. 76(1), the subject-matter of a divisional application may not extend beyond the parent application as originally filed. Furthermore, amendments made to the divisional application subsequent to its filing may not extend beyond the content of the divisional application as originally filed (Art. 123(2); for more details see C-IX, 1.4).

2.4.3 Applications resulting from a decision under Art. 61

If, as a result of a final decision, it is adjudged that a person other than the applicant is entitled to the grant of a patent, that person may file a new European patent application under Art. 61(1)(b). In this case, the provisions of Art. 76(1) apply *mutatis mutandis* to the new application filed under Art. 61(1)(b).

This means that the new application must not contain any subject-matter extending beyond the earlier (unentitled) application as originally filed. Furthermore, Art. 123(2) means that this new application may not be amended in such a way as to extend its subject-matter beyond its content as originally filed, even where the subject-matter in question is contained in the earlier application (for more details see C-IX, 2.1).

2.4.4 International applications

For the purposes of Art. 123(2), 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 Art. 123(2), and all such amendments must be carefully considered.

2.5 Assessment of "added subject-matter" – examples

If an application relates to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient may be added, then this amendment should normally be objected to as offending against Art. 123(2).

A new range that is based on the combination of the lower limit of the general range with the lower limit of the preferred range, thus excluding the preferred range, may be acceptable (see T 1170/02).

In an application which describes and claims an apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs.

If, however, the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, show helical springs, the specific mention of helical springs would be allowable, at least in the context of the specific embodiment where it is disclosed (see also H-V, 3.2.1).

3. Allowability of amendments under Art. 123(3)

3.1 Basic principles

Art. 69(2)

The European patent as granted or as amended in opposition, limitation or revocation proceedings determines retroactively the protection conferred by the European patent application, insofar as such protection is not thereby extended.

Opposition proceedings will frequently give rise to amendments to the claims, following from grounds for opposition raised under Art. 100. Reasoned requests filed independently by the proprietor of the patent for an amendment to the claims, e.g. for limitation of the patent in view of an aspect of the state of the art which has come to his knowledge, may also result in amendments to the claims after examination by the Opposition Division.

Art. 123(3)

In such cases the claims of the European patent may not be amended in such a way as to extend the protection conferred by the patent.

3.2 Field of application

Art. 123(3) 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 (see G 1/93, Reasons 9).

3.3 Protection conferred by the patent as granted

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. *Art. 69(1)*

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

Since, pursuant to Art. 69(1), 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 (see G 1/93).

3.4 Version of the granted patent to be considered

In order to verify the criteria of Art. 123(3) the examiner needs to compare the text of the amended claims with the claims of the patent as granted or as amended in opposition or earlier limitation proceedings, whichever claims are the most recent in force. This means that for the purposes of Art. 123(3) the amended claims are not necessarily compared to the claims as granted. When modified claims later replace the claims as granted (because of an opposition or earlier limitation(s)), the criterion for Art. 123(3) is applied with regard to the latest of these modified claims.

3.5 Assessment of impermissible extension of the protection conferred

In view of the above considerations, all amendments made to claims and any connected amendments to the description and drawings in the course of opposition proceedings, such as a change in the technical features of the invention, must be examined to determine whether such amendments could result in the extension of the subject-matter beyond the content of the application as originally filed (Art. 123(2)) or in the extension of the protection conferred (Art. 123(3)).

If, in view of Art. 84, the application documents have been adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule, subject-matter deleted for this reason cannot be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) (the cut-off effect). An analogous finding applies to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention (see T 1149/97).

Special attention should be paid to the requirements of Art. 123(2) and Art. 123(3), which have to be dealt with separately:

- (a) Examination for compliance with Art. 123(2) is conducted in the same way as in examination proceedings.

- (b) Examination for compliance with Art. 123(3), 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 (Art. 69 and the Protocol on the Interpretation of Art. 69).

3.6 Conflicts between Art. 123(2) and Art. 123(3)

A possible conflict between the requirements of Art. 123(2) and (3) may occur where, in the procedure before grant, a feature was added to the application which is considered unallowable under Art. 123(2) in opposition proceedings. In that case, Art. 123(2) would require deletion of such a feature whereas Art. 123(3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100(c). However, where this feature can be **replaced** by a feature for which there is a basis in the application as filed **and** which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, **without providing a technical contribution to the subject-matter of the claimed invention**, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see G 1/93). The technical significance of a feature in a claim is governed by its contribution to the technical definition of the claimed subject-matter, and that contribution is to be assessed by the skilled person in the light of the original disclosure (see T 518/99).

3.7 Conflicts between Art. 123(3) and other requirements of the EPC

Art. 123(3)

Other requirements of the EPC may also interact with Art. 123(3) after grant. For instance, if a patent as granted only contains claims that in fact define a "method for treatment of the human or animal body by therapy or surgery practised on the human or animal body" or contain such a method step, and such a patent is opposed under Art. 53(c), then Art. 53(c) and 123(3) may operate in combination so that the patent must inevitably be revoked, in that:

- the patent cannot be maintained as granted because its claims define subject-matter which is excluded from patentability under Art. 53(c); and
- the patent cannot be maintained in amended form because amendment of the claims as granted by deletion of such "method features" would be contrary to Art. 123(3) (see T 82/93).

4. Compliance of amendments with other EPC requirements

4.1 General principles

The other EPC requirements with which amendments have to comply will depend on whether the amendments are filed in examination, opposition or limitation proceedings (see below).

4.2 In examination proceedings

The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the EPC including, in particular, inventive step and the other matters listed in B-XI, 3.6 (see also C-III, 2). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage.

(i) Unity of invention

Do the amended claims still satisfy the requirements of Art. 82? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, but the amended claims do not necessitate further search, the examiner should consider carefully whether an objection of lack of unity is justified at this stage of the proceedings (see F-V, 8). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

(ii) Agreement of description and claims

If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? For example, is every embodiment of the invention described still within the scope of one or more claims? (see F-IV, 4.3). Conversely, are all of the amended claims supported by the description? (see F-IV, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment (see H-V, 8)?

4.3 In opposition proceedings

The proprietor of the patent should, where this is not obvious, indicate the points in the original application documents or claims of the granted patent from which the amendments may be derived (Art. 100(c) and Art. 123(2)). In addition, he should file observations as regards the patentability of the subject-matter of the patent as amended (with reference to Art. 100(a) and (b)), taking into account the state of the art and objections raised in the opposition notice together, where appropriate, with the evidence presented in support.

Opposition is not an opportunity to re-examine the whole patent; it is the amendments introduced into the patent which must be examined as to whether they comply with the EPC as a whole (see T 227/88, T 301/87 and T 472/88). Therefore the Opposition Division should check that the patent, by the amendments themselves, does not contravene the requirements of the EPC (with the exception of Art. 82, see G 1/91 and D-V, 2). With respect to Art. 84, see D-V, 5. For the form of amended documents, see H-III, 2.2 to 2.4. It should be noted that the formal requirements, in particular Rules 30 to 34 and Rules 42, 43, 46, 48 and 50, must be satisfied (see Rule 86).

4.4 In limitation proceedings

Limitation is not an opportunity to re-examine the whole patent; only the amended claims are to be examined with regard to Art. 84, and Art. 123(2) and (3), i.e. what should be considered is whether the requested amendments introduce a deficiency within the meaning of those provisions. Claims as granted or as maintained should not be examined anew.

4.4.1 Art. 84

It should also be verified that the amended claims are in conformity with Art. 84. For the interpretation of clarity under Art. 84 in limitation proceedings, the usual standards apply (see F-IV, 4, 5 and 6). Note in this respect that mere clarifications made to the claims, in particular to dependent claims, cannot be allowed, unless they are necessitated by the limitation(s) introduced elsewhere in the claims.

4.4.2 Examination of the description and/or drawings

Rule 95(2) requires only the amended claims to be examined in limitation proceedings. Nonetheless, if the applicant has not filed amendments to the description, the examiner should check whether the amended claims are still supported by the description. If this is not the case, in accordance with Rule 95(2) the proprietor should be requested to amend either the description or the claims, in order to comply with Art. 84. In this context it is pointed out that the examiner may not adapt the description of his own motion.

If, however, for the purpose of limitation an amended description and/or drawings are presented together with the claims, these are to be checked, but only for compliance with the requirements of Art. 123(2) and (3) and Art. 84. Note that in this respect amendments made to the description solely in order to improve the patent, or cosmetic changes which are not necessitated by the limited claims, cannot be allowed.

4.4.3 Points to be disregarded

In limitation proceedings there is no examination as to why a request for limitation was filed or whether the goal of the limitation has been achieved, for example if the amended and limited claims are truly novel vis-à-vis a particular prior art document.

In general there is no need to verify whether the limited claims contravene any of Art. 52 to 57. It may however happen that limitation results in *prima facie* non-compliance with the patentability criteria, e.g. Art. 53, in which case the examiner will communicate this non-compliance to the requester.

Examples:

A granted claim directed to a generic plant is limited to a specific plant variety, which would be an exception to patentability (Art. 53(b) and G 1/98). A claim granted to a device comprising a controlled explosion system is limited to a claim reciting an anti-personnel mine comprising the controlled explosion system, which would be contrary to Art. 53(a).

Chapter V – Allowability of amendments - examples

1. Introduction

Chapter H-V provides additional guidance and examples relating to a number of typical situations where compliance with Art. 123(2) and/or Art. 123(3) is an issue. However, it must be borne in mind that the allowability of a specific amendment is ultimately to be decided on a case-by-case basis.

2. Amendments in the description

2.1 Clarification of a technical effect

Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene Art. 123(2).

2.2 Introduction of further examples and new effects

Amendment by the introduction of further examples should always be looked at very carefully in the light of the general considerations outlined in H-IV, 2. The same applies to the introduction of statements of new (i.e. previously not mentioned) effects of the invention such as new technical advantages. For example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a particular fluid, the applicant should not be allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage.

Art. 123(2)

Under certain circumstances, however, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see F-IV, 6.3). Similarly a new effect may be considered as evidence in support of inventive step, provided that this new effect is implied by or at least related to an effect disclosed in the originally filed application (see G-VII, 10).

Art. 123(2)

2.3 Supplementary technical information

Any supplementary technical information submitted after the filing date of the application will be added to the part of the file which is open to public inspection, unless excluded from public inspection pursuant to Rule 144(d). From the date on which the information is added to the open part of the file, it forms part of the state of the art within the meaning of Art. 54(2). In order to notify the public of the existence of such information submitted after the application was filed and not

included in the specification, an appropriate mention will be printed on the cover page of the patent specification.

2.4 Revision of stated technical problem

Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets Art. 123(2). For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasise an effect attainable by the thus restricted invention but not by the prior art.

It must be remembered that such revision is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see H-V, 2.1 and 2.2 above).

If the suggested amendment would contravene Art. 123(2), 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.

2.5 Reference document

Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are *prima facie* not within "the content of the application as filed" for the purpose of Art. 123(2). 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 Art. 123(2) if the description of the invention as originally filed leaves no doubt to a skilled reader (see T 689/90) that:

- (i) protection is or may be sought for such features;
- (ii) such features contribute to solving the technical problem underlying the invention;
- (iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and
- (iv) such features are precisely defined and identifiable within the disclosure of the reference document.

Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90):

- (i) a copy of the document was available to the EPO on or before the date of filing of the application; and
- (ii) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

2.6 Alteration, excision or addition of text in the description

Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene or to omit this layer altogether would not normally be allowable. In each case, the panel disclosed by the amendment example would be quite different from that originally disclosed and, hence, the amendment would introduce fresh subject-matter and therefore be unallowable.

3. Amendments in claims

3.1 Replacement or removal of a feature from a claim

The replacement or removal of a feature from a claim does not violate Art. 123(2) if the skilled person would directly and unambiguously recognise that:

- (i) the feature was not explained as essential in the disclosure;
- (ii) 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; and
- (iii) the replacement or removal requires no real modification of other features to compensate for the change.

In case of a replacement by another feature, the replacing feature must of course find support in the original application documents, so as not to contravene Art. 123(2) (see T 331/87).

3.2 Inclusion of additional features

A claim may be limited by inclusion of additional features, provided the resulting combination was originally disclosed and does not relate to an invention which was not searched, for example:

- (a) from dependent claims, which were dependent on the claim to be limited

- (b) from the description e.g. the examples
- (c) from drawings (see H-V, 6)
- (d) arising from the conversion of an independent claim to a dependent claim.

3.2.1 Intermediate generalisations

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.

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

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. and
- the removal of the omitted features from the embodiment passes the three-point or essentiality test described in H-V, 3.1 above, and
- the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim.

Example 1

The amended claim relates to a heddle for the harness of a loom. The original claim was limited by introducing features that were disclosed only in connection with a specific embodiment in which the eyelet of the heddle had the shape of a spindle. This shape was not included in the amended claim. In the general part of the description it was also mentioned that the eyelet could also have other shapes such as an elliptic shape. Therefore the Board concluded that the amendment was allowable under Art. 123(2) (T 300/06).

Example 2

The subject-matter of new independent claim 4 relating to a method of telepayment was limited with respect to original independent claim 1 by adding only some features of a specific embodiment disclosed in the application as originally filed. This was defined by the Board using the term "intermediate generalisation" or "intermediate restriction". The

Board held that omitting features of an embodiment would introduce new information if these features are necessary for carrying out this embodiment. In the present case, the omitted features were considered to have their own recognisable function independent from the functioning of the rest of the system. Since they were neither presented as essential in the original application nor recognised as essential by the skilled person to carry out the invention, the Board considered that the requirements of Art. 123(2) were met (T 461/05).

Example 3

Claim 1 relates to a water dispersible and flushable absorbent article. Amended claim 1 specifies that each of the first and second fibrous assemblies is a wet laid tissue. The application as filed referred, in connection with the first fibrous assembly, to a wet laid tissue in combination with other features (tissue is apertured; tissue is provided with fibrils or sufficient inherent porosity).

Since the first fibrous assembly is disclosed in the application as filed as being a wet laid tissue only in combination with other features which are not present in claim 1, the amendments made constitute a generalisation of the originally disclosed technical information and thereby introduce subject-matter extending beyond the content of the application as filed (T 1164/04).

Example 4

Original claim 1 relates to a coating composition comprising at least one rosin compound, at least one polymer and an antifoulant.

After amendment a new claim was introduced relating to a method for preparing a coating composition comprising the mixing of at least one rosin compound, at least one polymer and an antifoulant. The only basis for the method is the examples. The Board observed that for some solutions the amount of added rosin was extremely low whereas for others it was extremely high. The subject-matter of the amended claim was considered to be an unallowable generalisation of the examples, since nothing in the description indicated to the person skilled in the art that the observed variations were not essential to make a coating composition (T 200/04).

Example 5

Original claim 1 relates to a multi-processing system comprising a shared memory, a directory and a serialisation point. The serialisation point is defined in functional terms. Claim 1 was amended by adding features that were addressed in the description as part of the cache coherence strategy. The Board held that the incorporated features, albeit disclosed as such, had been isolated in an arbitrary manner from the overall disclosure of the cache coherent memory access architecture. At least one feature had been omitted although its

function was presented as being essential to achieving cache coherence. Therefore amended claim 1 was not directly and unambiguously derivable from the original application (T 166/04).

3.3 Deletion of part of the claimed subject-matter

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

Example:

Original application: "A polymer blend XY ... containing, as a filler, graphite, talc, asbestos or silica"

Prior art: "A polymer blend XY ... containing asbestos".

Limited claim: "A polymer blend XY ... containing, as a filler, graphite, talc or silica".

However, deletions made from more than one list are normally not allowable (T 12/81).

In some cases it may be possible to limit the claim by a positive indication of what then remains, rather than by stating what is being deleted (as a disclaimer would do).

Example:

- "... a polyether of molecular weight from 600 to 10 000" restricted to "... above 1 500 to 10 000" (T 433/86).

3.4 Broadening of claims

A statement regarding use or intended purpose in an independent product claim may be deleted only if the application as filed offers a basis for the assumption that the product can also be used in some other way (and if the statement of purpose does not amount to a functional limitation).

The broadening of a claim by exchanging a particular feature for a more general feature cannot be based on an indication that it would be obvious for a skilled person (see also H-V, 3.2.1).

3.5 Disclosed disclaimer

In this case, the original application already indicates that the disclaimed embodiment is not part of the invention.

Negative features help to define the claimed invention in the same way as positive ones, and must be examined on the same basis. In other words, they may confer novelty and, like positive features, should be assessed as to their relevance to inventive step. They must also fulfil the requirements of Art. 84 (clarity, conciseness and support), and their inclusion must not infringe Art. 123(2) (T 170/87, T 365/88).

Examples:

- "... said delivery means does not comprise a capacitor element";
- "... with the proviso that blends having a melt index of lower than 0.05 are excluded".

Negative features, like positive ones, may be structural or functional, and may relate to either a physical entity or an activity.

4. Disclaimers not disclosed in the application as originally filed

4.1 The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers)

Limiting the scope of a claim by using a "disclaimer" to exclude a technical feature not disclosed in the application as filed may be allowable under Art. 123(2) in the following cases (see G 1/03 and G 2/03, and F-IV, 4.20):

- (i) restoring novelty over a **disclosure under Art. 54(3)**;
- (ii) restoring novelty over an **accidental anticipation** under Art. 54(2). "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". The status of "accidental" should be ascertained without looking at the available further state of the art. A related document does not become an accidental anticipation merely because there are other disclosures even more closely related. The fact that a document is not considered to be the closest prior art is insufficient for achieving the status of "accidental". An accidental disclosure has nothing to do with the teaching of the claimed invention, since it is not relevant for examining inventive step. For example, this is the case when the same compounds serve as starting materials in entirely different reactions yielding different end products (see T 298/01). A prior art, the teaching of which leads away from the invention, however, does not constitute an accidental anticipation; the fact that the novelty destroying disclosure is a comparative example is also insufficient for achieving the status of "accidental" (see T 14/01 and T 1146/01);
- (iii) removing subject-matter which, under Art. 52 to Art. 57, is excluded from patentability for **non-technical reasons**. For example, the insertion of "non-human" in order to satisfy the requirements of Art. 53(a) is allowable.

However, the introduction of the undisclosed disclaimer should not lead, for example, to the singling out of compounds or sub-classes of compounds or other so-called intermediate generalisations not

specifically mentioned or implicitly disclosed in the application as filed (see G 2/10).

An undisclosed disclaimer is **not** allowable if:

- (i) it is made in order to exclude **non-working embodiments** or remedy **insufficient disclosure**;
- (ii) it makes a **technical contribution**.

An undisclosed disclaimer is, **in particular, not** allowable in the following situations:

- (i) the limitation is relevant for assessing inventive step;
- (ii) the disclaimer, which would otherwise be allowable on the basis of a conflicting application alone (Art. 54(3)), renders the invention novel or inventive over a separate prior art document under Art. 54(2), which is a **not accidental** anticipation of the claimed invention;
- (iii) the disclaimer based on a conflicting application removes also a deficiency under Art. 83;

A disclaimer should remove no more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. A claim containing a disclaimer must meet the clarity and conciseness requirements of Art. 84. In the interest of the patent's transparency, the excluded prior art should be indicated in the description in accordance with Rule 42(1)(b) and the relation between the prior art and the disclaimer should be shown.

4.2 The subject-matter to be excluded is disclosed in the application as originally filed

The test to be applied is whether the skilled person would, using common general knowledge, regard the remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed.

This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined (see H-V, 3.3).

When it comes to determining whether, after the introduction of the disclaimer, the claim infringes Art. 123(2) or whether it is in conformity with it, this cannot be decided solely by establishing that the disclaimed subject-matter is disclosed in the application as filed.

Whether the skilled person is presented with new information depends on how he or she would understand the amended claim, i.e. the subject-matter remaining in the amended claim and on whether, using common general knowledge, he or she would regard that subject-matter as at least implicitly disclosed in the application as filed.

What is required is an assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.

In this respect it has to be established whether the disclaiming of subject-matter leads for example to the singling out of compounds or sub-classes of compounds or other so-called intermediate generalisations not specifically mentioned or implicitly disclosed in the application as filed (see G 2/10).

5. Amendments to drawings

It sometimes occurs that 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 (for drawings filed under Rule 56, see A-II, 5 and sub-sections). In this case, the formalities officer in the Receiving Section will check that the subsequently filed drawings are identical to the originals.

However, the ultimate responsibility for ensuring that the subsequently filed drawings do not contain new technical information, which would conflict with Art. 123(2), rests with the Examining Division.

If the examiner considers that these drawings conflict with Art. 123(2), he should require the applicant to submit other drawings which correspond exactly in substance to the drawings originally filed.

It should be noted that it will not normally be possible under Art. 123(2) 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. For the same reasons amendments to drawings should be carefully checked for compliance with Art. 123(2).

6. Amendments derived from drawings

Care should be taken when amendments are based on details which may only be derived from the schematic drawings of the original application (see also H-IV, 2.5). The manner in which a particular feature is depicted in the drawings may be accidental. In such cases, the skilled person must be able to clearly and unmistakably recognise from the drawings, in the context of the whole description, that the added feature is the deliberate result of the technical considerations directed to the solution of the technical problem involved.

For example, the drawings may depict a vehicle in which approximately two thirds of the height of the engine is located below a plane tangent to the top of the wheels. An amendment which defines that the major portion of the engine is located below the given level would not infringe Art. 123(2) if the skilled person would recognise that such a spatial arrangement of the engine with respect to the wheels is in fact a deliberate measure directed to the solution of the technical problem (see T 398/00).

7. Changes in claim category

Rule 80
Art. 123(3)

An amendment can be in the form of a change in the category of a claim, possibly combined with a change in the technical features of the invention. Firstly it must be clear that this amendment is necessitated by grounds of opposition (see H-II, 3.1). If that is not the case a change of category should be refused.

Even if this condition is fulfilled, the Opposition Division should exercise great caution in allowing a change of claim category, since the protection as conferred by the claims may thus be extended (Art. 123(3)). Examples are given in the following sections.

7.1 Product claim to use claim

If a patent is so amended that a claim to a product (a physical entity) is replaced by a claim to the use of this product, the degree of protection is not extended, provided that the use claim in reality defines the use of a particular physical entity to achieve an effect and does not define such a use to produce a product (see G 2/88).

7.2 Product claim to method claim

If a patent is so amended that a claim to a product is replaced by a claim to a method for producing the product, this change of category is allowable, provided that the method now claimed only results in the product previously claimed. As it is a fundamental principle of European patent law that the protection conferred by a product claim covers all methods for production of the product, the limitation to one of these methods cannot extend the protection conferred originally (see T 5/90 and T 54/90).

7.3 Method claim to product claim

If a patent is so amended that a claim to a method of operating a device is replaced by a claim directed to the device itself, this change of category is allowable, provided that the original claim contains the claimed features of the device exhaustively, whether in structural or functional terms (see T 378/86 and T 426/89).

If, however, the device as now claimed is for its features no longer dependent on the circumstances of its operation whereas it depended on them under the terms of the prior method claim, then such a change of category should not be allowed (see T 82/93);

By contrast, the change in claim category from a method in which an apparatus is used to the apparatus itself is not allowable (see T 86/90).

7.4 Method claim to use claim

The change from a process for the preparation of a product to the use of the product for a purpose other than previously described is not allowable (see T 98/85 and T 194/85).

On the other hand, the change in a claim from a method in which a certain product is used to a claim to the use of that product in performing that same method is allowable (see T 332/94).

8. Changes in the title

The sole purpose of the title is to inform the public about the technical information disclosed in the application. The title has no bearing on the content of the application as filed or on the protection conferred by the patent, once granted. Furthermore, the title is not part of the documents to be approved by an applicant before a patent can be granted.

Thus the ultimate responsibility for the title rests with the Division, and the examiner is free to ignore any request from the applicant for a change in the title (see also A-III, 7).

Chapter VI – Correction of errors

1. Introduction

Patent specifications may contain errors in the bibliographic data, the description, the claims or the drawings. Errors may also occur in printing the specification, in the decision to grant or in other decisions of the EPO.

These errors can be corrected as set out below.

2. Errors in bibliographic data

Correction of these errors is the responsibility of the formalities officer unless the error is in the decision (e.g. the decision recites the wrong priority number in the summary of facts and submissions), in which case correction is the responsibility of the Examining/Opposition Division.

3. Errors in publication

Errors in publication occur where the content of the printed specification differs from the documents transmitted to the applicant with the communication under Rule 71(3), which form the basis of the decision to grant.

Errors of this kind can be corrected at any time.

A complete republication of the patent specification will take place where appropriate.

4. Corrections of errors in application and patent documents during proceedings

Rule 139

These are linguistic errors, errors of transcription and mistakes in documents filed with the EPO (see H-VI, 4.2.1).

4.1 Admissibility of corrections

Corrections of this kind are possible only if proceedings are pending before the EPO. Requests for correction under Rule 139 are dealt with by the department responsible for the proceedings.

4.2 Allowability of corrections

Correction of errors is a special form of amendment, and the requirements of Art. 123(2) therefore apply *mutatis mutandis*.

Rule 139

Art. 123(2)

If a request for correction does not comply with Rule 139, and the applicant or patent proprietor maintains the request, the proposed change in the text is to be treated as an amendment and must comply with Art. 123(2) and, where applicable, Art. 123(3).

4.2.1 Correction of description, claims and drawings

Linguistic errors, errors of transcription and other mistakes in any document filed with the EPO may be corrected at any time, as long as proceedings are pending before the EPO. However, where the mistake is in the description, claims or drawings, both the error and the correction must be such that it is immediately evident (at least once attention is directed to the matter):

- (i) that an error has occurred; and
- (ii) what the correction should be.

Regarding (i), the incorrect information must be objectively recognisable for a skilled person, using common general knowledge, from the originally-filed application documents (description, claims and drawings) taken by themselves.

Regarding (ii), the correction should be 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 originally-filed application documents.

Evidence of what was common general knowledge on the date of filing may be furnished in any suitable form.

The priority documents cannot be used for the purposes mentioned under (i) and (ii) above (see G 3/89 and G 11/91).

Correction under Rule 139, second sentence, is of a strictly declaratory nature and establishes what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure (see G 3/89 and G 11/91 mentioned above). Therefore, the complete replacement of the application documents (i.e. description, claims and drawings) by other documents is not possible (see G 2/95).

However, during examination proceedings it is to be noted that such requests for correction can be considered only until such time as the decision to grant has been handed over to the EPO's internal postal service, for transmittal to the applicant (in written proceedings), or has been pronounced in oral proceedings (see G 12/91).

4.2.2 Missing parts of description and missing drawings filed as corrections under Rule 139

The applicant may also request that missing parts of the description and/or missing drawings be included in the application documents by way of a correction according to Rule 139. In virtually all cases this will not be possible (see J 1/82).

In **extremely rare cases** the other application documents might allow the skilled person to reconstruct the missing parts of the description and/or missing drawings such that they may be filed by way of a correction according to Rule 139.

By contrast with missing parts of the description and/or missing drawings filed under Rule 56(3), corrections under Rule 139 can never be filed by reference to the priority document (see H-VI, 4.2.1).

4.3 Examples

Corrections of clerical or grammatical errors are usually allowed, insofar as it is evident that an error has occurred and what the correction should be.

Some examples of allowable corrections:

- (i) the replacement of "respectfully" by "respectively" in a claim. (T 34/03)
- (ii) the addition of a plural "s" to the word "particle" as the corresponding verb "have" was in the plural form, and the application as originally filed described a particle size distribution. Since particle size distributions can be defined only for a plurality of particles, the correction was held allowable. (T 108/04)

On the other hand, an applicant cannot rely on:

- (i) a mere count of the number of instances of the relevant words in the application as originally filed for obtaining the replacement of one word by another word, for instance the substitution of "included" for "excluded", if it is not clear that an error has occurred and not possible to ascertain that nothing other than "included" was intended by the drafter. (T 337/88)
- (ii) usual practice or industry standards for measuring concentrations of compounds in the relevant technical field, if the application as originally filed merely refers to "%", without clarification as to whether by weight or volume, and the description contains no clear guidance as to whether "%" refers to concentration by % by weight or % by volume or to something different. (T 48/02)
- (iii) common general knowledge in the absence of further evidence, such as an encyclopaedia or basic textbook, to argue for instance that the skilled person would have immediately recognised that an ASTM standard with a six-digit number did not exist before the priority date of a patent. (T 881/02)

5. Correction of errors in decisions and related application and patent documents

5.1 Admissibility of corrections

Correction of errors in decisions must be clearly distinguished from correction of errors in documents filed by the applicant (or patentee) pursuant to Rule 139. For the latter, see A-V, 3 and H-VI, 4.2 and subparagraphs. Correction of errors made by the applicant (or patentee) in application (or patent) documents cannot be arrived at in a roundabout manner through correction of the decision to grant (or maintain in amended form).

Rule 140

Correction of a decision is admissible only if the text of the decision is manifestly other than intended by the department concerned. Thus only linguistic errors, errors of transcription and obvious mistakes in decisions can be corrected. The correction of a mistake in a decision under Rule 140 has a retrospective effect (see T 212/88).

The documents approved by the applicant for grant or approved by the patentee for maintenance in amended form are part of the decision to grant (see T 850/95) or to maintain in amended form, respectively. If a decision relates to wrong or incomplete documents, e.g. in the case of omission from a granted patent of claims, description parts or drawings which had already been filed as replacements and whose admissibility was never at issue during earlier proceedings, a correction of the text of the description or claims or of the drawings should be allowed.

However, this does not relieve the applicant or patentee from the duty to properly check the documents as proposed for grant or for maintenance in amended form, respectively.

Corrections of decisions are to be made by a decision at the reasoned request of one of the parties or by the EPO of its own motion. If the request for correction is refused, this decision must be reasoned (see T 850/95). These reasons must previously have been communicated to the requester (Art. 113(1)).

The Opposition Division cannot under Rule 140 correct errors in the decision to grant taken by the Examining Division. Even during opposition proceedings, the Examining Division is competent for taking such a decision. The Opposition Division can only correct a decision which it has issued itself.

If a patent is maintained in amended form under Art. 101(3)(a), there are two decisions which refer to documents on the basis of which the patent is to be maintained: the interlocutory decision issued by the Opposition Division according to Art. 106(2), stating that the patent and the invention to which it relates meet the requirements of the Convention, and the decision to actually maintain the patent pursuant to Art. 101(3)(a), which is issued automatically. Documents referred to form an integral part of these decisions. Therefore errors in documents

referred to in these decisions can be corrected if one of the three types of error mentioned in Rule 140 is concerned.

5.2 Allowability of corrections

The sole reason for allowing correction of linguistic errors, errors of transcription and obvious mistakes is to ensure that the decision says what the Division actually intended at the time of issue. If the text given for grant or maintenance of the patent in amended form is not and obviously cannot be the text corresponding to the real intention of the Division (e.g. a page or a claim is missing), the text erroneously indicated can be replaced by the text on which the Division actually intended to base its decision (see T 850/95).

5.3 Correction of the translations of the claims

According to Art. 70(1), the text of a patent in the language of the proceedings is the authentic text. It therefore follows that the translations of the claims of the patent specification required by Art. 14(6) are for information only. Hence no examination of the translations takes place (C-V, 1.3); in particular, the translations do not form part of the decision to grant the patent. Therefore they cannot be corrected under Rule 140.

Hence the only possibilities for the patent proprietor to amend translations are when the patent is maintained in amended form (Rule 82(2)) or, as indicated in Art. 70(4), before a national authority.