

Assessing added subject-matter under Article 123 (2) EPC

Introduction

Under European patent office (EPO) practice, an applicant cannot amend their patent or patent application in a way that would present a person of skill in the art with subject-matter that was not directly and unambiguously disclosed in the application as originally filed.

The EPO is known for its strict approach when it comes to assessing added subject-matter and has adhered to the so-called "gold standard" set by the Enlarged Board of Appeal in decision G 2/10:

What would a person of skill in the art derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed?

In other words, when the subject-matter of an amendment is directly and unambiguously disclosed in the application as filed, it should be allowed by the EPO.

However, a recent update to the EPO Guidelines for Examination raised some uncertainty as to whether the EPO was leaving behind its strict standard in favour of a more liberal approach in assessing added subject-matter.

EPO Guidelines for Examination Part H-IV, 2.3

The paragraph copied below was added to the EPO Guidelines Part H-IV, 2.3 in November 2014 following Board of Appeal (BoA) decision T 2619/11, which suggested a more lenient approach in assessing amendments:

"When assessing the conformity of the amended claims to the requirements of Art. 123(2), the focus should be placed on what is really disclosed to the skilled person by the documents as filed as directed to a technical audience. In particular, the examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole."

The Guidelines are widely used by examiners and attorneys alike, during prosecution of applications and opposition of patents. Therefore, it seemed that the EPO had softened its stance on added matter objections.

On the contrary, in T 1363/12 the BoA clearly stated that the EPO is not becoming more lenient in its approach and further that there has been **no change** in the standard to be applied when assessing amendments.

T 1363/12

During this appeal, the patentee tried to rely on the amended EPO Guidelines and BoA decisions T 667/08 and T 2619/11 to back up their argument that the EPO should apply a more lenient standard of review when evaluating added subject-matter under Article 123(2) EPC.

The Board responded by making it clear that the BoA is not bound by the EPO Guidelines for Examination and further that the "gold standard" should still be adhered to when assessing added matter. When referring to decisions T 667/08 and T 2619/11, the Board stated that a more lenient approach may be applied, but its application is "very case-specific" and "can only be decided on the basis of the facts of each individual case".

Therefore, the Board has re-stated its jurisprudence that the subject-matter of amendments to a patent or patent application must be directly and unambiguously disclosed in the application as filed and that the EPO Guidelines Part H-IV, 2.3 and decisions T 667/08 and T 2619/11 do not set a general standard for the assessment of added matter.

Practice points

Despite the legal position that word-for-word basis is not required when amending a patent or patent application, it is best practice, where possible, to make amendments using subject-matter that has verbatim basis in the application as originally filed. This eliminates any doubt as to whether the subject-matter of the amendment is directly and unambiguously disclosed in the application as filed, either during examination or opposition.

Having solid basis for an amendment is particularly important to avoid the Article 123(2) and Article 123(3) trap, wherein a patent is revoked because a feature of an amended claim is found to violate Article 123(2) EPC but its removal would extend the scope of protection beyond that conferred by the granted patent, which is also a ground for revocation.

If it is not possible to provide word-for-word basis in the application as filed, or if such a verbatim amendment would be commercially too limiting, amendments should only

be made if there is convincing argumentation that a person of skill in the art, using common general knowledge, would have derived the subject-matter of the amendment from the application as filed.

While the EPO Guidelines are not binding on the Boards of Appeal, they nevertheless remain persuasive to examiners. We recommend at least citing the amended EPO Guidelines Part H-IV, 2.3 and decisions T 667/08 and T 2619/11 in favour of the more lenient approach, particularly because the Board has acknowledged that assessment of added matter is dependent on the facts of each individual case. One has to be able to argue why in the context of the case at hand, the skilled person would recognise that the amended feature was always present in the application.