

# Amendments

Closa Daniel  
Beaucé Gaëtan

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# Outline

- Introduction
- Amendments – basic types
- Evaluating amendments – basic examples
- Amendments to the description
- Additional requirements
- Correction of errors
- Amendments in post-grant proceedings
- Additional remarks
- Intermediate generalisation – examples

## Introduction – Article 123(2)

"The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed."

## Introduction – Article 123(2)

"The European patent application or European patent may not be **amended** in such a way that it contains subject-matter which extends beyond the content of **the application as filed.**"

# What is an amendment?

- When an application or patent document is altered.
- When something in the application is changed to give it a different – usually improved – form which the applicant now wishes to adopt.

**The alteration/change is referred to as an "amendment"**

# What is the "application as filed"?

- It includes
  - the claims, the description and drawings
  - in the original language (Art. 70(2) EPC).
  
- It does not include
  - the abstract
  - features only described in a "reference document", unless the description of the invention as filed leaves the skilled person in no doubt that they are part of the invention; compliance with:  
[Guidelines H-V, 2.5](#)
  - in the case of divisional applications: only subject-matter of divisional as filed is included, not subject-matter of parent as filed
  - priority document, even if filed together with the application (exception Rule 56(3)).

# Why Article 123(2) EPC?

- The idea underlying Art. 123(2) is that applicants may not **improve their position** by adding subject-matter not disclosed in the application as filed, which would give them 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, OJ 8/1994, 541).

[\(Guidelines H-IV, 2.2\)](#)

# Art. 123(2) compliance: the basic principle

- Under Art. 123(2) EPC an amendment is **not** allowable if it
  - introduces subject-matter
  - which extends beyond the content of the application as filed.
- By implication, it is otherwise allowable.



# Basic test

*Does the overall change in content of the application result in the skilled person's being presented with information which cannot be directly and unambiguously derived from the application as filed?*

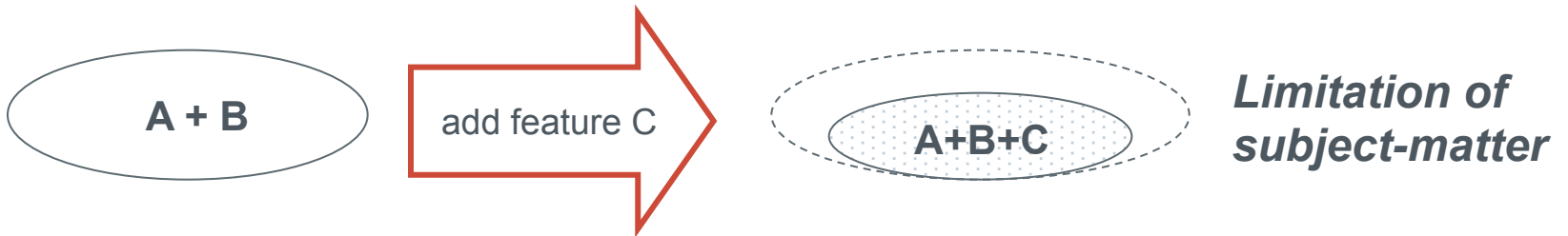
IF YES  Amendment not allowable under Article 123(2) EPC

# Outline

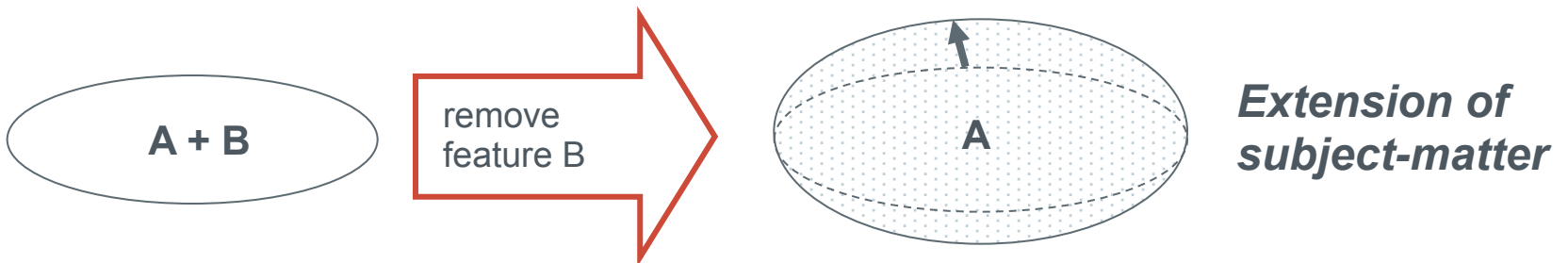
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# Types of amendments to the claims

**ADDITION** (e.g. to overcome novelty objection)

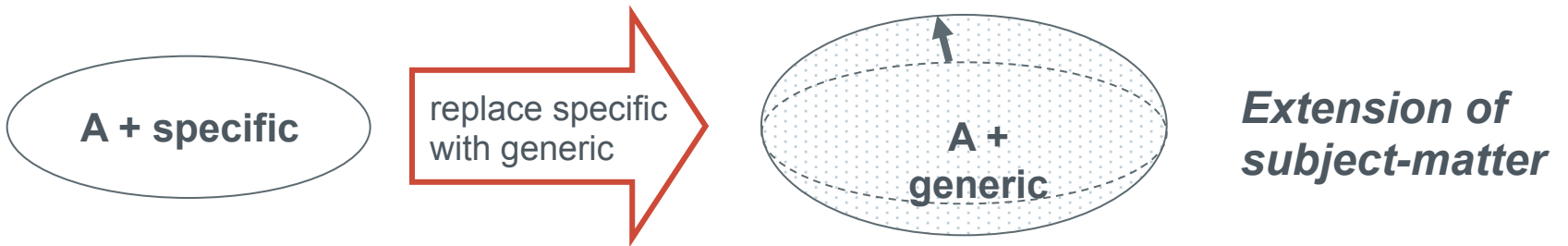


**REMOVAL** (e.g. no relevant prior art found during search)



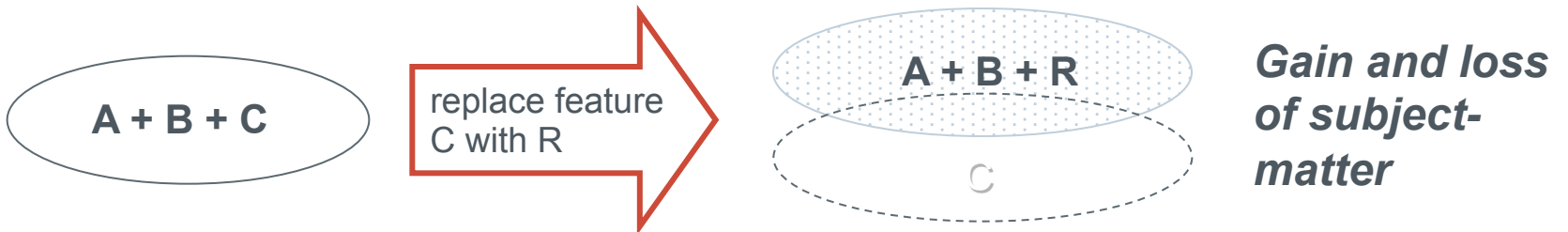
# Types of amendments to the claims

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



replacing a *specific* feature with a more *generic* one (copper - metal; alarm clock - clock)

**REPLACEMENT** (e.g. to overcome novelty objection)



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# Evaluating amendments: overview

Three tests for evaluating amendments:

Test	Applicable to amendments by		
	Addition	Generalisation	Removal
Novelty test	•		
Basic test	•	•	•
Essentiality test		•	•

# Evaluating amendments

## Basic test (disclosure test or modified novelty)

*Does the overall change in the content of the application result in the skilled person's being presented with information which cannot be directly and unambiguously derived from the application as filed, even when account is taken of matter which the skilled person takes as implied?*

*– generally used for addition or generalisation*

# Evaluating amendments

## Essentiality test

*Replacement/removal of a feature is allowable if the skilled person would directly and unambiguously recognise that:*

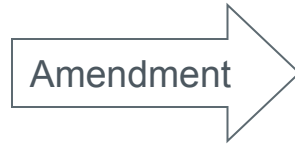
- the feature was not presented as essential in the disclosure*
- it is not indispensable for the function of the invention in the light of the technical problem it serves to solve*
- the replacement/removal requires no real modification of the other features to compensate for the change*



# Examples – addition of a feature

*Claim 1: A+ B*

*Claim 2: C*



*Claim 1: A+B+C*

**BASIC TEST: NEW INFORMATION?**

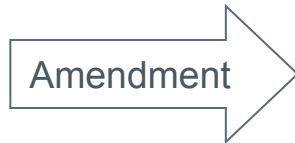
No, A+B+C known from application as filed,  
since claim 2 as filed depends on claim 1

***Amendment allowable***

# Examples – addition of a feature

**Claim 1: A + B**

*C not mentioned in  
application as filed*



**Claim 1: A + B + C**

**BASIC TEST: NEW INFORMATION?**

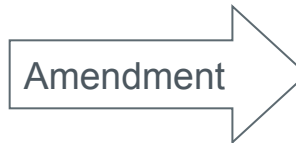
Yes, since C and A+B+C new information for the skilled person

***Amendment not allowable***

- one equivalent in the application does not form a basis for other equivalents
- broad range in the application does not form a basis for a specific sub-range
- generic term in the application as filed is not a basis for a specific term
- the fact that a feature is not disclosed is not a basis for introducing an explicit reference to its absence

# Examples - generalisation

- **Claim 1: *A + specific matter***  
**(e.g. copper)**
- ***description states: the invention may be applied to all matter within the same generic category (e.g. metal)***



**Claim 1: *A + generic category***  
**(e.g. metal)**

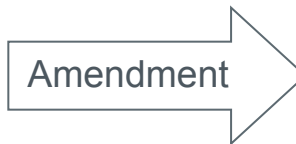
**BASIC TEST: NEW INFORMATION?**

No, since the skilled person would understand from the description that the invention is disclosed for all kinds of matter within the generic category (all metals)

***Amendment allowable***

# Examples - generalisation

- **Claim 1:** *A + specific matter (e.g. copper)*
- **description:** *no reference to metals other than copper*



**Claim 1:** *A + generic category (e.g. metal)*

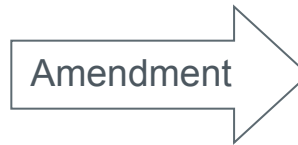
**BASIC TEST: NEW INFORMATION?**

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

***Amendment not allowable***

# Examples - removal of a feature/generalisation

- **Claim 1:**  $(A + B) + (C + D)$
- **description states:** *C and D are linked (e.g. functionally)*



**Claim 1:**  $A + B + C$

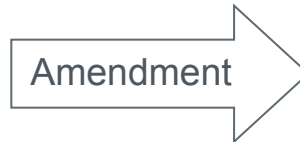
**ESSENTIALITY TEST**

Removal of D requires modification of other features, since feature C is known only in combination with D, and no effect for C alone is known

***Amendment not allowable***

# Examples - combining different embodiments

- Claim 1: **A**
- Claim 2 (*dep. on 1*): **B**
- Claim 3 (*dep. on 1*): **C**
- **description:** *B and C are alternatives*



Claim 1: **A + B + C**

**BASIC TEST: NEW INFORMATION?**

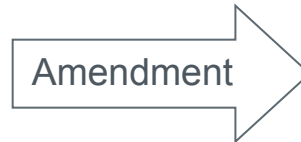
Yes. The application as filed discloses A+B or A+C, since B and C are alternatives, while B and C in combination not disclosed

***Amendment not allowable***

# Examples - intermediate generalisation

- **Claim 1: A + B**

- **description:** *embodiment with A, B, C, D, E; C, D and E being closely linked (structurally, functionally)*



**Claim 1: A + B + C**

**BASIC TEST: NEW INFORMATION?**

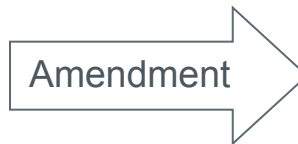
- Yes, since C not known in the application as filed without D and E
- Essentiality test applicable to deletion of D and E from A+B+C+D+E

***Amendment not allowable***

# Examples - intermediate generalisation

▪ Claim 1: **A + B**

▪ *description: embodiment with A, B, C, D, E; C, D and E each producing a technical effect*



Claim 1: **A + B + C**

**BASIC TEST: NEW INFORMATION?**

- No, since skilled person knows from the description that A+B+C would produce a technical effect independently of D and E
- Essentiality test applicable to deletion of D and E from A+B+C+D+E

***Amendment allowable***



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# Amendments to the description

- ***Acknowledgement of prior art, Rule 42(1)(b)***
  - any reference inserted after filing should be purely factual
- ***Adaptation of the description of the claims, Rule 42(1)(c)***
  - often required after amending claims. Allowable if amendment of the claim is allowable.
- ***Revision of the problem stated, Rule 42(1)(c)***
  - only permissible if the skilled person can deduce the effect emphasised without difficulty from the application as filed
- ***Subsequent clarification or addition of effects of the invention***
  - if a technical feature's effect, although not mentioned in the application as filed, can be deduced by the skilled person, its clarification does not contravene Art. 123(2)
- ***Excision of subject-matter***
  - normally after a non-unity objection. Deletion does not confront the skilled person with new information

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# Additional requirements

- **Rule 137(1), (2) and (3)**

*Defines stages for filing amendments during the procedure*

- **Rule 137(4) EPC**

*When filing any amendments referred to in [paragraphs 1 to 3](#), the applicant shall **identify them** and **indicate the basis** for them in the application as filed. If the examining division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.*

- **Rule 137(5) EPC**

*Amended claims **may not relate to unsearched subject-matter** which does not combine with the originally claimed invention or group of inventions to form a **single general inventive concept**. Nor may they relate to subject-matter not searched in accordance with [Rule 62a](#) or [Rule 63](#).*

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# Correction of errors

## Rule 139:

*Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is **immediately evident that nothing else would have been intended** than what is offered as the correction*

Correction of errors is a special case of amendment and therefore also subject to Art. 123(2) requirements.

Both the error and the correction must be such that it is immediately evident (at least once attention has been drawn to the matter):

- (i) that an error has been made; and
- (ii) how it must be corrected.

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# Amendments in post-grant proceedings

## Article 123(3)

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

**Claim as granted: A + B**

(opposed on basis of  
Art. 123(2) EPC because  
no basis for B in appl. as filed)

B has to be  
deleted

**Claim : A**

(protection is extended;  
infringement of Art. 123(3))

**PATENT IS REVOKED**

**Art. 123(2)-(3) trap**



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# Additional remarks

- Not only the added feature as such, but also the resulting combination of features must be derivable from the application as filed
- As a rule, a feature within a disclosed group of features may not be "extracted" by isolation from other features to which it is closely linked. This depends on how closely the individual features are linked (problems solved, technically or functionally interrelated, ...)
- The content of the application as filed must not be treated as a reservoir from which individual features relating to separate sections can be combined to “artificially” create a particular combination.
- Creation of new embodiments by artificially combining features from unrelated, separate embodiments generally contravenes Article 123(2) EPC.
- Where an amendment is based on drawings, the skilled person must be able to clearly and unmistakably recognise from those drawings, as seen 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.
- The applicant is generally not given the benefit of the doubt in cases involving added subject-matter
- Ultimate responsibility for the amendment lies with the applicant (G 1/93)

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# Intermediate generalisation – examples

The following slides show examples of allowable and non-allowable cases of intermediate generalisations

# T 264/03

- Claim: an in-line retention drip irrigation emitter comprising a **flow-limiting passageway ...**
- Amended claim: claim + "wherein the emitter further comprises a **sleeve ...** and has at least a partially **cylindrical body** intimately received in and enclosed by the **sleeve**"
- Disclosed embodiment: **the sleeve forming a side-wall** of the **flow-limiting passageway**
- This technical relationship not present in amended claim 1

## NON-ALLOWABLE INTERMEDIATE GENERALISATION

# T 461/05

- **Claim 1:** method of telepayment
- **Amended claim 1:** method of telepayment + "(a) l'équipement du client comprend une carte d'identification (SIM) propre au client, et (b) la carte d'identification (SIM), invite le client à composer un code confidentiel."
- **Disclosed embodiment (claim 6):**
  - a. l'équipement du client comprend une carte d'identification (SIM) propre au client
  - b. la carte d'identification (SIM), invite le client à composer un code confidentiel.
  - c. l'équipement mobile du client est de type GSM
  - d. ...
- **Description:**
  - *Preferably*, the customer's mobile equipment is of the GSM type, of any generation;
  - which makes it possible, *for example*, to use a portable GSM with a bank payment card
- Omitted features neither presented as essential in the original application nor regarded by the skilled person as essential to carry out the invention

## ALLOWABLE INTERMEDIATE GENERALISATION

# T 425/06

- **Claim:** a bone interface anchor .... the top of the bone screw head having a **projection** which has a convexly **rounded** rod interface **surface** for contact with the stabilisation rod and is engageable by a driver to screw the bone screw into the bone in use
- **Amended claim:** claim + **the projection is an external hex projection**
- **Embodiment:** **external hex projection**, the **rounded** exterior **surface** includes a **knurl**
- **Description:**
  - Function of the hex projection: providing engagement with a driver in order to drive the screw into the bone
  - Function of the knurl: provides a high friction between the projection and the rod.
- Knurl is not functionally linked to the hex projection in the original disclosure

## ALLOWABLE INTERMEDIATE GENERALISATION

## T 25/03

- **Claim:** Control method of a yarn monitoring
- **Amended claim:** claim + features relating to a **step of** detecting a yarn diameter average deviation and to a **step of** detecting a yarn evenness deviation
- **Application as filed:** **specific combination of steps**, said **specific sequence** considered ***essential*** for obtaining the desired result.
- Amended claim leaves open which step is carried out first

### NON-ALLOWABLE INTERMEDIATE GENERALISATION



Thank you for your attention

