

Guidelines for Examination in the European Patent Office (status April 2009)

Part C GUIDELINES FOR SUBSTANTIVE EXAMINATION Chapter VI EXAMINATION PROCEDURE

5. Amendments

5.1 Making amendments

The general considerations relating to the procedures for making amendments are set out in E-II.

5.2 Allowability of amendments

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-XII, 3.6 (see also VI, 3.3). 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 III, 7.7). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

(ii) Changing to unsearched subject-matter

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. This applies particularly when this unsearched subject-matter alone is now claimed, whereas it should not be applied if a feature originally disclosed in the description is added to an originally-filed claim in order to meet an objection, e.g. lack of novelty or inventive step, raised by the examiner. In the latter case, however, an additional search (see VI, 8.2) may be required.

Thus, if an objection under Rule 137(4) 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. If no such objection is raised, the Examining Division should consider requesting an additional search (see VI, 8.2).

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 VI, 4.7).

(iii) 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 III, 4.3). Conversely, are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment? It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against Art. 123(2), as explained in the following paragraphs.

5.3 Additional subject-matter

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 II, 4.3 and 4.19). Nor will the straightforward clarification of an obscurity or the resolution of an inconsistency be objected to. 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.

5.3.1 Basic principle; priority document

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, OJ 8/1994, 541). 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 IV, 9.2 (see T 201/83, OJ 10/1984, 481).

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, OJ 4/1989, 105). For correction of errors, see VI, 5.4.

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 VI, 3.1 and A-III, 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, OJ 3/1993, 117 and 125, respectively). For Euro-PCT applications a review is possible under Rule 82ter PCT.

5.3.2 Examples

For example, 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). Likewise, in an application which describes and claims 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.

However, care should be taken when amendments are based on details which may only be derived from the schematic drawings of the original application. 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).

5.3.3 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).

5.3.4 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 paragraphs VI, 5.3 to 5.3.3. 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.

5.3.5 Evidence

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 III, 6.3). Similarly a new effect (e.g. the one mentioned in VI, 5.3.4) 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 IV, 11.10).

5.3.6 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.

5.3.7 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 5.3.3 and 5.3.4 above).

5.3.8 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, OJ 10/93, 616) 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, not published in OJ):

- (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)).

5.3.9 Alteration, excision or addition of text

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.

5.3.10 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, OJ 1-2/1991, 22).

5.3.11 Disclaimers not disclosed in the application as filed

Limiting the scope of a claim by using a "disclaimer" to exclude a technical feature not disclosed in the application as filed does not infringe Art. 123(2) in the following cases (see G 1/03, OJ 8-9/2004, 413, and G 2/03, OJ 8-9/2004, 448, and III, 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, not published in OJ). 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, both not published in OJ);
- (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

However, 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.

5.4 Correction of errors

Correction of errors is a special case involving an amendment, therefore the requirements of Art. 123(2) apply likewise.

Linguistic errors, errors of transcription and other mistakes in any document filed with the EPO may be corrected at any time. 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, OJ 3/1993, 117 and 125, respectively).

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, OJ 10/1996, 555).

Such requests for correction can only be considered until such time as the decision to grant a patent or to refuse the application 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, OJ 5/1994, 285).

5.5 Plural forms of amendment

A situation may arise in which, as a result of amendment, the application has two or more distinct sets of claims (see IV, 7.1.1 and III, 8.1).

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.

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.

A similar situation may arise where a final decision on entitlement to the grant of a European patent applies to only some of the States designated in the application (see VI, 9.2.4).