

WHAT IS AN ALLOWABLE AMENDMENT?

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Rules about amendments during patent examination and opposition are stricter at the European Patent Office (EPO) than at the US Patent and Trademark Office, for example. The basis for amendments has to be specified in the patent application as filed. It is not uncommon to receive objections because the amendments fall outside the literal wording of the patent application as filed. Word-for-word amendments can be required.

Article 123(2) of the EPC states what is an allowable amendment: “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.” Note that it reads “subject matter” and not “words”.

In decision *G2/10*, this requirement was formulated as follows: “Any amendment ... [may] only be made 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 whole of these documents as filed.”

So if the skilled person would derive from a drawing an embodiment comprising the features of an independent claim as well as an extra feature, this combination of features would also be allowed.

The idea behind article 123(2) is not to give the applicant a check—even though an applicant or its representative often will understand it that way—but to ensure that third parties should not be presented later on with subject matter that is not disclosed in the application as filed.

Many will testify, however, that the EPO has been stricter and stricter about this during the past several years and, as mentioned above, even requires word-for-word amendments.

There have been interesting decisions in this respect by two different Technical Boards of Appeal (*T667/08* and *T2619/11*) that emphasise that there is no requirement for amendments to have a literal basis on the application as filed.

The first one said: “Literal support is not required by the wording of article 123(2) EPC. An amendment can therefore be allowable if it combines information which has not been disclosed in one and the same section of the original disclosure, but results, for instance, from information gathered from various embodiments possibly associated with general statements regarding the information derivable from the introductory section of the application.”

But remember that what seems to be cherry-picking of one feature here and another there is only allowed if such a combination is “directly and unambiguously derivable, using common general knowledge, and seen objectively and relative to the date of filing”, as we saw above. The arguments and basis for the amendments have to be presented to the examiner in a convincing way.

The Guidelines for Examination in the European Patent Office

“A FIRST STEP AWAY FROM THE WORD-FOR-WORD REQUIREMENT WAS INTRODUCED INTO SECTION H-IV-2.3, CALLED ‘CONTENT OF THE APPLICATION AS ‘ORIGINALLY’ FILED—GENERAL RULES’ OF THE GUIDELINES.”

(guidelines) give instructions principally to the examiners about the practice and procedure to be followed in the various aspects of examination of European applications and patents. The guidelines are updated to take into account developments in European patent law and practice.

With reference to *T667/08*, a first step away from the word-for-word requirement was introduced into section H-IV-2.3, called “Content of the application as ‘originally’ filed—general rules” of the guidelines: “Literal support is, however, not required by the wording of article 123(2) (see *T 667/08*).”

In autumn 2014, the same section was further amended by introducing: “When assessing the conformity of the amended claims to the requirements of article 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.”

There is no explicit reference to any decision, but it is clear from the wording that the amendment is based on *T2619/11*, even though the amendment of the section is not totally word-for-word (was that intentional?).

Even though the guidelines are not the law and not binding on the boards of appeals, the introduction of the mentioned texts gives extra weight to the two cited decisions and gives an indication of how the EPO would like to prosecute European patent applications. ■

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