

# Amendments in Europe and the United States

*Attitudes differ if you try to broaden your claim after applications, reports Annalise Holme.*

A patent is an exclusive right granted to an inventor or his assignee for a fixed period of time in exchange for a disclosure of the invention. The procedure for granting patents, the requirements placed on the patentee and the extent of the exclusive rights vary widely between countries according to national laws and international agreements.

It is an ever-present requirement in international patent practice that amendments to a patent or patent application should not add subject-matter that extends beyond the content of the application as filed.

The underlying idea of prohibiting added subject-matter is that an applicant or patentee should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give the patentee an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application or the granted patent.

However, the circumstances in which the various jurisdictions find the same amendment allowable differ. In the following, some of the differences between the practice in the United States and before the European Patent Office (EPO) are discussed.

## Legal provisions

The legal provisions in the European Patent Convention are disclosed in Art. 123 EPC stating that '*A European patent application or a 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*'. After grant, it is a ground of opposition (under Article 100(c) EPC) or revocation (under Article 138(1)(c) EPC) of a granted European patent if *'the subject-matter of the European patent extends beyond the content of the application as filed'*.

A similar provision is found in US patent law under 35 U.S.C. 132(a), 'No amendment shall introduce new matter into the disclosure of the invention' and 35 U.S.C. 112, first paragraph stating that 'the specification shall contain a *written description* of the invention', specifying that an applicant must include in the application a specification adequately disclosing the invention and how to make and use it.

## Amendments

Amendments are normally made during the examination phase, where the applicant attempts to overcome cited prior art and accidentally makes an amendment which can be regarded as extending beyond the content of the application as filed, or where the applicant, after filing a patent application, develops or encounters further embodiments of his invention which fall outside his original disclosure, because of a limitation which (with hindsight) is unnecessary and he will accordingly wish to broaden his disclosure and claims.

The question of what constitutes new matter may sometimes be difficult to resolve. After all, an applicant may rely on every part of the application as originally filed for support for a claim amendment. Additionally, an applicant is entitled to rely on any inherent or implied teachings of the specification, drawing(s) and claims, in addition to the express teachings. Still further, because there is no *in haec verba* requirement, an applicant is not constrained to the terminology used in the application as filed.

Thus the issue in respect of amendments is whether the original application's specification provides adequate support for the claims that were amended or added later.

In Europe, this means that the requirement of prohibiting added subject-matter (Art. 123 EPC) is interpreted very strictly, which reduces the possibility of a granted patent having significantly different or broader scope than the patent application as published. Claim broadening, in particular, is subject to particularly careful examination under European practice.

In the United States an amendment must be adequately disclosed in the original specification, otherwise the written description requirement of 35 U.S.C. 112 is not met. Even though the original specification may meet the enablement and best mode requirements of section 112, the written description requirement can bar subsequently amended or added claims.

## Generalization amendments

One of the differences between US and EPO practice encountered on a daily basis is amendments constituting generalization of one or more specific terms or embodiments. Where the EPO only allows a more general definition of a term if it is clear *beyond any doubt* for a skilled reader from the application documents as filed that the amendment have basis in said application, the United States Patent and Trademark Office (USPTO) allows generalizations if the originally filed application *reasonably conveys* to a skilled reader that the applicant had possession of the subject-matter later claimed. The difference may seem insignificant but in practice it is an extensive problem.

As a simple example, the EPO refused a replacement of the original term 'diesel engine' by the term 'combustion engine'. The reasoning for said decision was that in the application as filed, the treatment of exhaust gas was always related to a diesel engine, and the application gave no basis that said treatment was suitable for any other type of combustion engine. Extending the protections of the patent to all kinds of combustions engine would therefore include embodiments not disclosed in the original applications, and thereby give the applicant an unwarranted advantage, and would be damaging to the legal security of third parties relying on the content of the original application (see T 653/03 for further details).

Based on experience from similar cases, it is in my opinion likely that if the same situation had arising in a US application the USPTO would have allowed the amendment. The reasoning being that the person skilled in the art would understand that it was unimportant which kind of combustion engine is used as the claimed technology easily could be extended to other kinds of combustion engine. It would therefore be an unduly restriction to limit the claim to diesel engines only.

Thus, where the EPO would refuse to allow undisclosed equivalents to be added to the application, eg by using a wider technical term than originally disclosed or by combining different features from different embodiments, case law from the US courts show that they allow generalized claims added after the original filing of a patent application where the new claim is for broader or different subject-matter than that claimed or disclosed in the specification.

These differences in US and EPO practice often result in discussion of whether or not a required amendment is allowable.

For instance, if the applicant or proprietor needs to limit the scope of protection to one or more specific embodiments in view of the prior art, and the only basis for the limiting technical feature(s) is described for a specific embodiment, an amendment which has been allowed in a corresponding US application is not automatically allowable for the EPO application.

One of the reasons for this is that most EPO applications originating from US applications have a very short general description and an extensive detailed description, ie the description of the specific embodiments shown in the drawings. Consequently, if the relevant technical feature(s) is added to a claim which also comprises technical features not present in the specific embodiment, this could result in embodiments not disclosed in the application as filed.

Furthermore, since it is not allowable to amend a claim by introducing a technical feature taken in isolation from the description of a specific embodiment (see T 284/94 for further details), the applicant will often have to incorporate additional technical features in the claim. Thus, if the only basis for the amendment is in the detailed description, this could result in a more limited scope of protection than if the basis had been in the general description. In extreme cases the consequence could be that the EPO patent is limited to only one specific embodiment, which often makes the patent unenforceable in respect of an infringer.

In this respect it is important to remember that even though relevant case law is helpful in determining when an amendment is allowable, the final evaluation is a factual one made by the patent offices and courts on a case-by-case basis.

## Conclusion

As is evident from the above, the EPO and the US courts evaluate generalization amendments differently, and it is therefore advisable when drafting a new application to remember that a number of restrictions for amendments exist before the EPO, and that most of these restrictions can be met if the application is drafted correctly.

Furthermore, there seems to be some hope that the somewhat arbitrary tests employed by the EPO in order to evaluate added subject-matter may be giving way to a more comprehensive and flexible test of the consistency of the amended text with the originally filed text.

Finally, it is significant that many countries evaluate added subject-matter the same way as the EPO and it will therefore be interesting to witness if the freedom available to patentees in the United States can withstand the drives toward harmonization, or whether the rarely invoked 'new matter' or disclosure of the invention objections in the United States is due for reinterpretation.

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