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2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

Germany

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I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

YES.

2) Under your Group's current law, are amendments to the claims of a patent possible?

YES.

3) Further to your answers to questions 1) and 2), please indicate:

a) the standard for determining whether such amendments are permissible and indicate whether this standard exists in statutes, regulations, patent office guidelines, and/or in case law.

A. General principles

The rules for determining the permissibility of amendments are codified for Germany in Section 38 of the German Patent Act ("PatG"): *"Up to the time of the decision to grant a patent, the contents of an application may be amended on condition that the subject matter of the application is not extended"*,

and in the European Patent Convention (“EPC”) in Article 123(2) EPC: *“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”*.

The “content of the original application” is determined by the claims, the description, and the drawings. However, the abstract and the priority documents, if any, do not form part of the “content of the original application”. Subject-matter only disclosed in referenced documents (incorporation by reference) is considered to belong to the “content of the original application” only if the referenced document was either publicly available or had been submitted to the patent office at the date of filing. Moreover, case law of the European Patent Office (“EPO”) emphasizes that features added from the referenced document must be precisely defined and identifiable within the disclosure of the referencing document^[1].

The standard set forth by the legislator is further specified by case law^[2] and the “Guidelines for Examination in the EPO” (in the following: “EPO Guidelines”). In order for an amendment to be allowable, according to the EPO Guidelines, the skilled person must be able to derive the amended subject-matter *“directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document”* (Part H, Chapter IV.2.2). As early as in the *Luftverteiler* decision of 2001^[3] and in particular since the *Olanzapin* decision of the German Federal Court of Justice (“FCJ”) in 2008^[4], the German case law has been largely adopting the diction of the EPO: *“In the context of the question of whether there is an inadmissible extension [beyond the content of the application as filed], only that which can ‘directly and unambiguously’ be gathered from the originally filed documents belongs to the content of the disclosure of a patent application, but not any further reaching findings at which the skilled person arrived on the basis of his common general knowledge or by a variation of the disclosed teaching.”*^[5]

In principle, the jurisprudence of the German courts and of the EPO Boards of Appeal has been largely harmonized; at least both repeatedly use the formula *‘directly and unambiguously disclosed’* as the gold standard for evaluating amendments. However, in practice, the German case law is still more generous at times. What can be considered to be “directly and unambiguously” disclosed in Germany is sometimes more than that which the EPO accepts as “directly and unambiguously” disclosed. A clear difference between German and EPO practice exists, for example, in a situation in which an amended claim is directed at a subset of features of a preferred embodiment (intermediate generalization)^[6]. While the EPO is very critical with such amendments, German practice mostly allows them.

In addition to the *“directly and unambiguously”* formula, the German case law at times works with the notion that a patent claim may not be directed to a subject matter which the original disclosure did not identify as *“belonging to the invention”*, e.g. for deciding whether a feature which is only disclosed in a drawing can be added to a claim^[7], or whether claiming a subset of features of a preferred embodiment (intermediate generalization) is permissible^[8]. Occasionally, this may lead to different results than under the EPO case law. For example, it may not be possible in Germany to direct a patent claim to a solution which was mentioned in the original specification if the aim of the invention was to avoid the disadvantages associated with that solution^[9].

In conclusion, amendments which are not *“directly and unambiguously”* derivable from the original application, but which are only *obvious* to the skilled person (including non-inventive routine workshop variations (non-material changes)) are not considered to form part of the content of a German or European patent application. However, *implicitly* disclosed matter is considered disclosed, as long as the implicit disclosure is direct and unambiguous.

B. Specific aspects and case groups

I. Combinations of features from different embodiments

a) Germany

An applicant may claim a combination of features taken from different embodiments, if and when the claimed feature combination is originally disclosed in the application. Conversely, the applicant may not combine features of different embodiments in an arbitrary manner. The inclusion of a combination of individual features of an example in the patent claim could extend beyond the content of the application, if the combination in its entirety circumscribes a technical teaching that the skilled person could not derive as a possible embodiment of the invention from the original application^[10].

What the skilled person is able to derive from the application as originally filed is the relevant criterion, the aim of which is avoiding a so-called “cherry picking” from the different embodiments. Consequently, a combination of features from different embodiments which are not associable with each other as understood by the person skilled in the art would typically result in an impermissible extension.^[11]

b) EPO

For the EPO’s assessment of whether a specific combination of features has been disclosed, a relevant question is whether a skilled person would seriously contemplate combining the different features cited in that document.^[12]

The EPO Boards of Appeal do not tolerate any “cherry picking” of features from unconnected parts of the description or examples. It is generally not sufficient that the elements of a feature combination are disclosed as such in the application as filed; they must also be disclosed in combination with each other, or there must at least be a pointer in the application as filed to such a combination. Even preferred features cannot always be combined with each other.^[13]

II. Abstractions/generalizations of terms or concepts

a) Germany

A generalization of a specific term can be permissible, depending on the nature of the generalization, the overall disclosure in the application as filed and the skilled person’s common general knowledge.

If, for example, the specified terms “bromine”, “chlorine”, “fluorine” and “iodine” are listed for a group X in the application as filed, it should be permissible to use the generic term “halogen” in lieu of the individual species. If the original application only discloses “bromine”, it will depend on the context whether a generalization to “halogen” will be admissible. For example, if the context is that “bromine” is a leaving group of a molecule in a reaction, the generalization to “halogen” may be problematic, since fluorine is generally no suitable leaving group. On the other hand, where it is clear from the context that a species such as bromine was only meant as a representative of a larger class (pars pro toto), a generalization to said larger class should be allowable. A generalization is in general permissible, provided that sufficient support in the original disclosure exists. This is typically the case if a skilled person understands an originally disclosed example as an embodiment of the general teaching of the invention and if this general teaching can be derived from the original application documents^[14].

In its *Polymerschaum* decision^[15], the FCJ summarized its jurisprudence in quite some detail. It reminded that it had approved generalizations of originally disclosed working examples to avoid unfair restrictions of the applicant when using the disclosed content. It regarded a “broad” claim to be unobjectionable from the point of view of added matter, if a working example presented itself as an

embodiment of the more general teaching as defined in the claim and if this teaching in its claimed generality could already be taken from the application as filed as belonging to the invention as filed^[16], be it in the form of a claim formulated in the application as filed, or be it from the whole context of the application as filed. Such generalizations have been mainly admitted in cases where only one or only some of the features of a working example have been included in the claim, that all together, but also individually, support the success of the invention.^[17] The (intermediate) generalization of a chemical compound has also been admitted in one particular case.^[18]

b) EPO

According to the EPO case law, a generalization is only permissible if it is directly and unambiguously derivable by a skilled person from the original application as a whole.^[19] Although this general rule appears to be similar to the above described German jurisprudence, it has to be noted that in practice, the EPO applies a much stricter, almost photographic approach as to what a skilled person is regarded to be able to derive from a document using his or her expert knowledge. In particular, disclosure of isolated examples with no indication of a generalization may not be considered sufficient support for a generalization.^[20] One Board of Appeal explained in the head note of a decision: “*The slightest doubt as to the derivability of the amendment from the unamended document rules out the amendment*”.^[21] A specific term in a claim may only be replaced by a generic term if the specific term has to be construed in the sense of the generic term, and if using the specific term in the claims would exclude an example embodiment unambiguously disclosed as part of the invention.^[22]

Having said that, it is hardly conceivable that the EPO would allow a generalization from “bromine” to “halogen” without explicit support for “halogen” in other parts of the application as filed. Or, to put it in other words, if the application as filed nowhere discloses “halogen”, but discloses only “bromine”, the EPO will not allow such an amendment. Even if the original application discloses fluorine, chlorine, bromine and iodine, it is not certain that the EPO would allow a replacement of these elements by the general term “halogen”, as the term halogen might arguably also (conceptually) comprise the radioactive halogen astate.

The same applies to the replacement of a structural feature by a non-disclosed functional feature. However, in at least one case where the function of a structural claim feature was disclosed in the original application, an EPO Board of Appeal allowed the replacement of the structural feature by a functional feature.^[23]

III. Deletion of features in claims

In a case where certain features are deleted from a claim, the scope of protection of the claim becomes broader. This is no problem *per se* (before grant), as long as the application as filed contains unambiguous disclosure also for this broader subject matter. Quite often, however, there is no literal support for the broader scope (i.e. a disclosure of the invention without the deleted features), and instead it has to be examined if the skilled person upon appreciating the entire patent application would have understood that a technical teaching of such broader scope is also encompassed by the patent application. To this end, the EPO and the FCJ, respectively, have developed differing, to a large extent incompatible tests:

a. Germany

The relatively recent FCJ decision “Kommunikationskanal”^[24] is of particular interest in this context. It was strictly speaking a decision on the right to priority, yet the FCJ ruled that the same principles also apply to the determination of disclosure for assessing novelty and the allowability of amendments. In this decision, the FCJ ruled that a feature may be deleted from a claim, if a skilled reader would understand from the original application that the deleted feature referred to a preferred embodiment rather than to the general teaching of the originally claimed solution. The FCJ emphasized that this analysis requires an evaluation with the knowledge of a skilled person. It is the skilled reader who would – based on his expert knowledge at the priority date of the invention – judge whether or not a deleted claim feature is either (i) an optional feature of an embodiment or (ii) an element of the claimed invention. In result, for a generalization (resulting from deletion of a feature) to be allowable, the person skilled in the art must be capable to appreciate from the original application the generalized claimed teaching as a possible embodiment of the invention from the original application.

In case the application discloses a plurality of inventions, the significance of this test becomes apparent: let’s assume the application would disclose invention A and invention B, and would describe a particular feature as an essential element of the inventive solution for invention B, but not for the invention A. In this scenario, the claim element could be deleted from a claim seeking protection for invention A.

a. EPO

In the landmark decision T 331/87^[25], a so called “three prong test” was developed. In accordance with this test, which is also recited in the EPO Guidelines^[26], the replacement or removal of a feature from a claim is permissible if the skilled person can directly and unambiguously recognize that:

- a. the feature was not explained as essential in the disclosure;
- a. 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
- a. the replacement or removal requires no real modification of other features to compensate for the change.

Let’s assume again the application would disclose invention A and invention B, and would describe a particular feature as an essential element of the inventive solution for invention B, but not for the invention A. In this scenario, following the above recited test, the claim element could not be deleted from a claim seeking protection for invention A, as it was disclosed as “essential” in the application.

Although two Boards of Appeal pointed out that the T 331/87 test cannot be maintained, this test is still applied in the practice of the EPO.^[27]

IV. Intermediate generalizations (adding individual features of an embodiment in isolation)

Intermediate generalization, as the term is commonly used, refers to a case where an amendment introduces some, but not all elements of a specific embodiment into a claim. For such an amendment it is often questionable whether the combination of the features of the claim (in its original version) with the newly added features from the specific embodiment, but without the remaining features of said embodiment, is to be considered originally disclosed for a person skilled in the art. A controversial

issue, both in legal practice and in the legal discussion, is whether the applicant in fact would need to include all features of this specific embodiment into the claim.

a) Germany

The FCJ made it clear very early on^[28] that there is no legal doctrine requiring that all features of an embodiment relating to the problem of the invention have to be included in the claim. Rather, if there are several features of an embodiment that contribute to the result achieved by the invention, both individually and in combination with each other, it is the patentee's choice to limit the patent by including only some or all of these features. As the FCJ emphasized in its case law, this does not abandon or limit the requirement of original disclosure^[29], which has to be assessed in any case. It does, however, firmly establish the view that the disclosure of a specific embodiment of a patent application goes beyond the combination of all features of this embodiment and is limited to such a combination only in special cases. In particular, if a feature of an embodiment, taken per se, contributes to an advantageous solution of the problem of the invention, there is no need to include further features of this embodiment that specify how this solution can be implemented in practice^[30]. A feature or property of a specific embodiment may be omitted in a claim, if it is clear for a person skilled in the art that the invention can be practiced without this feature in an embodiment thereof^[31].

On the other hand, as the FCJ pointed out^[32], the patent claim may not be directed to subject matter of which it is not apparent for a person skilled in the art that protection for it was sought by the application. The court also made clear that a patentee cannot arbitrarily combine individual elements of an embodiment. Rather, the combination chosen by the applicant, taken in its entirety, must have been apparent for a person skilled in the art as a possible embodiment of the invention. In a recent case^[33], the FCJ decided that – if it cannot be determined by abstract or general considerations how the result intended by the invention can be achieved or fostered –, the generalization from a specific material of a specific embodiment, having a property that fosters the desired result, to a broader class of materials, is not permissible, where the materials of the general class do not have that property and it is not directly and unambiguously clear that the properties of the alternative materials in that class make a contribution to the desired result as well.

b) EPO

In a way, in the practice of the Examining and Opposition Divisions and, to some extent, in the case law of the Boards of Appeal of the EPO, the opposite view to that of the German courts is taken. As a rule, it is not permissible to isolate individual features from a combination of features, unless certain (rather strict and exceptional) criteria are fulfilled^[34]. The case law applied different tests in this regard. One test requires that it should be evident beyond any doubt to a skilled person that the isolated feature(s) on its own enable(s) the object to be achieved^[35]. Another test requires that characteristics taken from a working example may only be combined with other features disclosed in a more general context, if the skilled person can recognize without any doubt from the application as filed that these characteristics are not closely related to the other characteristics of the working example and apply directly and unambiguously to the more general context^[36]. A related criterion is the absence of any clearly recognizable functional or structural relationship among the features of the specific embodiment^[37], which was also combined with the criterion that the extracted feature is not inextricably linked with the other features of the embodiment.^[38]

The current EPO Guidelines^[39] adopt this latter criterion, i.e. that the feature at issue is not related or inextricably linked to the other features of the embodiment from which it was taken, and additionally requires that the overall disclosure justifies the generalizing isolation of the feature and its introduction into the claim. Also, according to the EPO Guidelines for Examination, it is a necessary condition for an intermediate generalization to be allowable, that there is no structural and functional relationship between the features of the embodiment that are added to the claim and the features which are left out. In recent decisions it was held that an amendment omitting certain features of an embodiment is only inadmissible, if the amendment provides new information to a person skilled in the art which was

not directly and unambiguously derivable from the application as originally filed^[40]. It was held^[41] that such new information arises when the omitted features are necessary to carry out the embodiment. In a further decision, a Board of Appeal, however, rejected the argument that – if a person skilled in the art has understood the function of an element of the claim and those features relevant for this function are included in the claim – the amendment is only inadmissible, if a person skilled in the art is then provided with new information^[42]. In the same decision, the Board of Appeal rejected the notion of “relevant information”, holding that this is contrary to the prohibition of the introduction of any new information^[43].

An amendment to a claim by a feature which is isolated from other features of an embodiment was held admissible due to an absence of functional and structural relationship, if the features at issue form a separate functional unit^[44]. In a case related to a method of producing a chemical compound (Trichlorosilane/TCS), the Board of Appeal held that if the parameters of a specific embodiment can be varied independently to achieve the desired result (selectivity to TCS) and there is no reciprocal relationship between the parameters with regard to this result, a specific value of a parameter disclosed in an example can be included in the claim in isolation without violating Art. 123 (2) EPC^[45]. However, such cases are the exception rather than the rule in the practice before the EPO.

Considering that an intermediate generalization involves two types of disclosure, namely a broad disclosure (typically a claim), to which the amendment is a limitation, and a narrow one (typically a specific embodiment), to which the amendment is a generalization, the EPO can be said to use the narrow disclosure of the embodiment as the basic focus and starting point and to deal with the issue whether a person skilled in the art could directly and unambiguously recognize a broader disclosure in said embodiment than the combination of features specifically described. The reverse question, namely whether considering the broad disclosure, a person skilled in the art could directly and unambiguously recognize the claimed subject matter as a specific embodiment thereof, is rarely investigated in EPO case law.

V. Amendments taken from drawings

In recent jurisprudence, the FCJ has emphasized that patent claims, description and drawings are equivalent means of disclosure^[46]. Therefore, amendments can in principle also be based on drawings alone^[47]. However, amending a claim on the basis of the drawings can be problematic, if the drawings are just schematic and the applicant intends to derive a certain detailed feature from them^[48].

The EPO takes a similar but in practice stricter position with regard to the admissibility of amendments derived from drawings. It allows amending the claims and the description by adding technical features from the drawings only if the skilled person can derive these features directly and unambiguously from the whole content of the application as filed using common general knowledge and if he recognizes that these features are the deliberate result of the technical considerations directed to the solution of the technical problem involved.

VI. Non-disclosed disclaimers

The EPO permits the insertion of a so-called non-disclosed disclaimer in a claim under Art. 123(2) EPC to exclude subject-matter not disclosed in the application as filed in specific cases. The allowability of such non-disclosed disclaimers has been scrutinized by the Enlarged Board of Appeal in the Decisions G1/03 and G 2/03 and further reflected in G2/10. As a result, non-disclosed disclaimers are allowable under Art.123(2) EPC in order to:

- (i) establish novelty of a claim over a prior right under Art. 54(3) EPC;

- (ii) establish novelty of a claim over an accidental anticipation under Art. 54(2);
- (iii) exclude subject matter which, under Art. 52 to Art. 57 EPC, is excluded from patentability for non-technical reasons such as methods for medical treatment under Art. 53 (c) EPC.

A non-disclosed disclaimer may not be used to excise non-disclosed non-working embodiments. Furthermore, a non-disclosed disclaimer may not be used to support inventive step and it may not result in a situation where the subject-matter remaining in the claim after introduction of the disclaimer is no longer supported by the application as filed (G1/03 and G2/10).

VII. Ranges

a) Germany

According to the German case law, the restriction of a broad range of values to a preferred narrower range of values is generally allowable^[49]. It is also allowable to replace a broad range of values by the limits of a preferred range^[50]. The FCJ left open whether the skilled person considers all intermediate values within a broad range of values to be disclosed as well, if the intermediate values are not mentioned explicitly^[51]. It is allowable to replace the broad range by a narrower range defined by different upper and/or lower limits. According to the current jurisprudence, it is not even necessary that these new limits be disclosed as such in the application as filed^[52].

b) EPO

According to the case law of the EPO, the intermediate values of a range of values are considered not to be disclosed in the application as filed if only the upper and lower limits of the range are explicitly disclosed. Consequently, in such a case it is not allowable to replace the original broad range of values by a narrower range having upper and lower limits defined by any one of the intermediate values.

However, the disclosure of a range of values together with a preferred narrower range also directly discloses the two possible subranges lying within the overall range on either side of the narrower range. Hence, a combination of the preferred narrower range and one of these sub-ranges is also supported by the original disclosure.

Footnotes

1. [^](#) EPO, decision T 689/90 of January 21, 1992.
2. [^](#) See, for example, EPO G 3/89 of November 19, 1992, EPO OJ 1993,117 of November 30, 1993.
3. [^](#) FCJ, decision X ZR 168/98 of September 11, 2001 – Luftverteiler, citing EBA Decision G2/98 with approval.
4. [^](#) FCJ, decision X ZR 89/07 of December 16, 2008—Olanzapin.
5. [^](#) FCJ, decision Xa ZR 124/07 of July 8, 2010—Fälschungssicheres Dokument.
6. [^](#) FCJ, decision X ZB 18/00 of September 11, 2001—Drehmomentübertragungseinrichtung
7. [^](#) E.g., FCJ, Ia ZB 17/66 (GRUR 1967, 476) of 26 January 1967—Dampferzeuger; FCJ, decision X ZR 119/09 of November 25, 2014 – Schleifprodukt.
8. [^](#) E.g., FCJ, X ZB 18/00 (GRUR 2002, 49) of 11 September 2001—Drehmomentübertragungseinrichtung; FCJ, decision X ZR 117/11 of July 17, 2012 – Polymerschäum; FCJ, decision X ZR 107/12 of February 11, 2014 – Kommunikationskanal.
9. [^](#) FCJ, X ZB 2/77 (GRUR 1978, 417) of 20 December 1977—Spannungsvergleichsschaltung
10. [^](#) FCJ, decision X ZB 18/00 of 11 September 2001 – Drehmomentenübertragungseinrichtung
11. [^](#) FCJ, decision Xa ZR 148/05 of 14 May 2009 – Heizer

12. [↑ EPO, decision T 296/96 of 12 January 2000.](#)
13. [↑ EPO, decision T 108/08 of 25 October 2011.](#)
14. [↑ FCJ, decision X ZR 107/12 of February 11, 2014 - Kommunikationskanal.](#)
15. [↑ FCJ, decision X ZR 117/11 of July 17, 2012 - Polymerschaum.](#)
16. [↑ FCJ, decision X ZR 18/00 of September 11, 2001 ? Drehmomentenübertragungseinrichtung.](#)
17. [↑ FCJ, decision X ZB 9/89 of January 23, 1990 ? Spleißkammer; decision X ZR 88/09 of 24 February 2012- Elektronenstrahltherapiesystem.](#)
18. [↑ FCJ, decision X ZR 51/72 of December 18, 1975 - Alkylendiamine I.](#)
19. [↑ EPO, decision T 653/03 of April 8, 2005.](#)
20. [↑ EPO, decision T 435/91 of March 9, 1994.](#)
21. [↑ EPO, decision T 383/88 of December 1, 1992.](#)
22. [↑ EPO, decision T 371/88 of May 29, 1990.](#)
23. [↑ EPO, decision T 628/91 of June 16, 1996.](#)
24. [↑ FCJ, decision X ZR 107/12 of February 11, 2014 - Kommunikationskanal.](#)
25. [↑ EPO, decision T 331/87 of 6 July 1989.](#)
26. [↑ Part H - Chapter V-3.1. Note that this part was not amended lately.](#)
27. [↑ EPO, decision T 0910/03 of 7 July 2005 \(with reference to G2/89\) and decision T 2311/10 of 24 September 2012](#)
28. [↑ FCJ, decision X ZB 9/89 of January 23, 1990 - Spleißkammer, Headnotes 2 and 3](#)
29. [↑ FCJ, decision X ZB 9/89 of January 23, 1990 - Spleißkammer, supra, Section II 3 b\) of the reasons, decision X ZB 18/00 of September 11, 2001 - Drehmomentübertragungseinrichtung](#)
30. [↑ FCJ, decision X ZR 226/02 of October 15, 2007 - Sammelhefter II, Section 32 to 33, FCJ X ZR 107/12 - Kommunikationskanal, section 24, FCJ X ZR 119/09 of November 25, 2014 - Schleifprodukt, section 19](#)
31. [↑ FCJ, decision X ZR 6/13 of December 9, 2014 - Presszange, Section 28, decision X ZR 107/12 of February 11, 2014 - Kommunikationskanal, Sections 22 to 34](#)
32. [↑ FCJ, decision X ZR 226/02 of October 15, 2007 - Sammelhefter II, supra, Section 31, citing decision X ZB 18/00 of 11 September 2001 - Drehmomentübertragungseinrichtung, supra.](#)
33. [↑ FCJ, decision X ZR 119/09 of November 25, 2014 - Schleifprodukt.](#)
34. [↑ EPO, decision T 25/03 of February 8, 2005, section 3.3. of the reasons, decision T 284/94 of November 25, 1998, section 2.1.6 of the reasons, see also decision T 962/98 of January 15, 2004 - Ecolab, Section 2.5 of the reasons, decision T 1164/04 of April 4, 2006, section 3. of the reasons, Guidelines for Examination at the European Patent Office, November 2015, H V. 3.2.1.](#)
35. [↑ EPO, decision T 17/85 of October 26, 1987, section 2.3. of the reasons, decision T 284/94, supra, section 2.1.3 of the reasons, decision T 1644/11 of April 4, 2014, section 2.2. of the reasons](#)
36. [↑ EPO, decision T 962/98, supra, section 2.5., decision T 0879/09 of January 14, 2010, section 2.1.3 of the reasons](#)
37. [↑ EPO, decision T 582/91 of November 11, 1992, section 2.2. of the reasons, decision T 25/03, supra, section 3.3. of the reasons, decision T 219/09 of September 27, 2010, section 3.1. of the reasons, decision T 2311/10 of September 24, 2012, section 2.4. of the reasons](#)
38. [↑ EPO, decision T 219/09, supra](#)
39. [↑ Guidelines for Examination at the European Patent Office, November 2015, H V. 3.2.1.](#)
40. [↑ EPO, decision T 0461/05 of July 10, 2007, section 2.4. of the reasons, decision T 1906/11 of January 18, 2013, section 4.2.2. of the reasons](#)
41. [↑ EPO, decision T 0461/05, supra, section 2.4. of the reasons, decision T 273/11 of September 12, 2011, section 12.1. of the reasons](#)
42. [↑ EPO, decision T 248/12 of March 5, 2013, sections 3.3.3 to 3.3.10 of the reasons](#)
43. [↑ The Board of Appeal did not address the issue that the “relevance” in this context was related to a function that was disclosed for a person skilled in the art and the “relevant information” was meant to further specify this function or the implementation thereof, i.e. it did not consider the question whether the amendment described a specific embodiment or implementation of the general function that was disclosed for a person skilled in the art.](#)
44. [↑ EPO, decision T 2311/10, supra, section 2.4. of the reasons](#)
45. [↑ EPO, decision T 500/11 of September 4, 2013, section 3.4. of the reasons](#)

46. [FCJ](#), decision X ZR 10/88 of March 20, 1990 - Crackkatalysator; decision X ZR 29/93 of May 4, 1995 - Zahnkranzfräser; decision X ZR 156/02 of January 30, 2007 - ru?ckspu?lbare Filterkerze.
47. [FCJ](#), decision Xa ZR 52/08 of February 18, 2010 - Formteil
48. [FCJ](#), decision X ZB 2/12 - of August 6, 2013 - Tintenstrahldrucker
49. [FCJ](#), decision X ZB 10/88 of March 20, 1990 - Crackkatalysator; decision X ZB 11/90 of May 12, 1992 - Chrom-Nickel-Legierung; decision X ZR 112/13 of September 15, 2015 - Teilreflektierende Folie
50. [BPatGE](#) 22,1,3
51. [FCJ](#), Teilreflektierende Folie, at 34.
52. [FCJ](#) decision X ZR 40/12 of September 24, 2013 - Fettsäuren, para. 29

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?

There are no differences between the substantive standards for amendments of the claims and amendments of the description.

4) To the extent your answer to question 3) depends on timing (e.g. after filing but before examination, after allowance but before grant, and after grant), please explain how the standard changes and during which time periods.

The substantive standard (i.e. a patent application and a patent may not be amended by adding subject matter not disclosed in the application as filed) is to be observed in all pre-grant and post-grant proceedings during which the application or patent may be amended, including examination, opposition, revocation and limitation proceedings (§§ 38 S1 and 21 (2) Nr. 4 PatG; Art. 123(2), 76(1), 100(c) and 138(1)(c) EPC)^[1].

In addition, amendments after grant, e.g. in post-grant opposition, revocation or limitation proceedings, are subject to the further requirement that such amendments may not extend the scope of protection conferred by the patent as granted.^[2]

Footnotes

1. [FCJ](#) Sec. 38 para. 1 and Sec. 21 (2) No. 4 PatG; Art. 123(2), 76(1), 100(c) and 138(1)(c) EPC.
2. [FCJ](#) Sec. 22 (1) 2nd Alt. PatG; Art. 123(3) and 138(1)(d) EPC.

5) Further to your answer to question 3), if impermissible added matter is a ground for refusing an amendment, please explain how impermissible added matter is defined.

As per the standard defined in the answer to Question 3a), impermissible added matter can be defined as matter which the skilled person cannot derive directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicitly disclosed to a person skilled in the art.

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

The content of the patent application is to be assessed from the point of view of the notional skilled

person on the basis of the application documents in its entirety^[1]. Any invention disclosed in the original application relating to the invention may be claimed.^[2] Therefore, the determination of the content of the application is not limited to the subject matter of the claims.

Footnotes

1. [^ FCJ, decision X ZR 101/89 of December 3, 1991 - Frachtcontainer](#)
2. [^ FCJ, decision X ZB 9/89 of January 23, 1990 - Spleißkammer](#)

b) if interpreted as the notional skilled person would understand the patent application as filed, what is the relevant date of knowledge of the notional skilled person?

The relevant date of knowledge of the skilled person is the filing date of the patent application^[1]. In case an application claims the priority of an earlier application, the relevant date of knowledge of the skilled person is likewise the date of filing of the (later) application.^[2]

Footnotes

1. [^ BPatG 23 W \(pat\) 47/10](#)
2. [^ FCJ, decision X ZR 4/00 of October 14, 2003 - Elektronische Funktionseinheit; decision X ZR 107/12 of February 11, 2014 - Kommunikationskanal](#)

7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

yes

Please explain:

The general answer to this question depends on whether the impermissibly added matter extends or limits the claim. If it just extends the scope of the claim, e.g. in the case of adding a further non-disclosed alternative, then removing this amendment in post-grant proceedings is generally no problem. If, on the other hand, the impermissible amendment results in a limitation of the claim, then the matter is much more difficult and may even result in an “inescapable trap” for the patent proprietor in EPO proceedings. This is because any deletion of a limiting amendment tends to extend the scope of the protection, which is not allowable post grant under the EPC and German patent act.

Whether or not a mechanism for the patentee is available to remedy the defect depends on the specific case and on the jurisdiction. The remedies in post grant proceedings (i) before the EPO, and (ii) before the German Patent and Trademark Office (“GPTO”), German Federal Patent Court (“BPatG”) or FCJ are very different in this regard:

i. EPO

In accordance with the decision G1/93 of the Enlarged Board of Appeal of the EPO, if a European patent contains subject-matter which

- extends beyond the content of the application as filed within the meaning of Art. 123 (2) EPC, and
- also limits the scope of protection conferred by the patent,

such patent is normally to be revoked. Namely, such a patent cannot be maintained unamended, because Art. 123(2) and Art. 100 (c) EPC prejudice the maintenance of the patent (as it contains added

matter) and such a patent also cannot be maintained by deleting such limiting subject-matter from the claims, because such (further) amendment would extend the protection conferred, which is prohibited by Art. 123 (3) EPC. This situation is known in the EPC procedure as the “inescapable trap”.

The only exception to this rule, which decision G1/93 allows, is to maintain a non-disclosed limiting feature in the claim in the exceptional case that this feature does not provide a technical contribution to the claimed subject-matter, but merely limits the protection conferred by the patent by excluding protection for part of the claimed subject-matter. In practice, however, this exception plays no role, since most amendments are introduced precisely because they provide a technical contribution, and hence can form the basis of arguments for novelty and/or inventive step.

(ii) Germany

The FCJ rejects the EPO’s inescapable trap and pointed out in various decisions^[1] that a non-disclosed feature may in the majority of cases remain in a granted claim and will continue to limit the scope of protection of the patent. However, validity of such a patent has to be examined as if the feature were not present. That is, the non-disclosed feature cannot be used for any argument in support of patentability. However, in case a granted claim contains a non-disclosed feature which is not only limiting, but rather an aliud (i.e. subject matter not encompassed by the original scope), then, also in accordance with the jurisprudence of the German Federal Court of Justice, the patent has to be revoked, in order to prevent the public from a scope of protection that was unforeseeable upon appreciation of the application as filed.^[2]

Footnotes

1. [FCJ, decision Xa ZB 14/09 of October 21, 2010 – Winkelmesseinrichtung; decision X ZB 2/12 August 6, 2012 – Tintenstrahldrucker; decision X ZR 43/09 of June 21, 2011 - Integriationselement](#)
2. [FCJ, decision X ZR 161/12 of 17 February 2015 – Wundbehandlungsvorrichtung, section 45](#)

II. Policy considerations and possible improvements to your current law

8) How does your Group’s current law strike a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter?

Both, German and EPO patent law try to strike a balance by admitting only those amendments that have a clear and unambiguous basis in the application as filed and hence do not provide the applicant with an unwarranted advantage over third parties. The yardstick for any allowable amendment always is the whole content of the application as filed, as understood by an ordinary skilled person.

9) Are there aspects of these laws that could be improved?

yes

Please explain:

The “gold standard”, i.e. that only those amendments are allowable that are clearly and unambiguously derivable for a person skilled in the art from the application as filed, appears reasonable and meets little controversy in Europe. But “the devil is in the detail” and a lot depends on what exactly is considered “clearly and unambiguously derivable”. Unfortunately, the jurisprudence of the EPO and the German courts differ quite a bit in several important aspects, e.g. intermediate generalizations, deletion of claim features, limitation of numerical ranges, non-disclosed limiting

features etc., as has been discussed herein above. It would generally be desirable to harmonize the EPO's jurisprudence and German national jurisprudence as much as possible.

Which direction could or should such harmonization take? In our opinion, the skilled person and his/her understanding of the disclosure of the application as filed in this exercise should be considered more seriously. The EPO's case law on added matter has meanwhile reached a stage where (almost) only that is considered 'clearly and unambiguously disclosed' which has a literal basis in the application as filed. In other words, the EPO case law only falls very short of a merely photographic understanding of the application as filed and tends to apply an extremely severe standard that - in this strict form - is unique in the world.

This is particularly true in the case of intermediate generalizations. It seems overly rigid and unnecessary to require from the applicant or the patentee - if he wants to limit his invention by adding one feature described in an embodiment example - that all of the features of this embodiment example must be included into the amended claim. The introduction of an additional feature from the description into the patent claim should normally be allowable, if the originally broader teaching is restricted to a more limited teaching and if the additional feature in the description was clearly identifiable as belonging to the claimed invention and does not appear entirely arbitrary. The control test should be whether the resulting feature combination in its entirety circumscribes a technical teaching that the skilled person could derive as a possible embodiment of the invention from the original application.

Also with respect to claim amendments relating to a limitation of a numerical range, the EPO's case law seems too restrictive. The German group of AIPPI acknowledges that a selection of a subset within a broader range may amount to a non-disclosed choice (and should not be allowed, if the selection itself includes a decisive distinction from the prior art). However, for distinguishing from prior art, non-disclosed limitations of a broader numerical range to a smaller one by moving one boundary should be allowed if and when the skilled reader would have assumed that the limited smaller range amounts to one possible implementation of the invention.

And finally, case law relating to deletion of features in claims could be improved. The German group of AIPPI concurs with recent case law of the FCJ. The analysis, whether or not a feature may be deleted in a claim, should be based on the understanding of the skilled reader. In case the skilled reader would understand that the deleted claim feature relates to an optional feature of an embodiment rather than to an element that contributes to achieving the desired effect of the claimed invention - then the applicant should be allowed indeed to delete such feature. The established test of the EPO following the decision T 331/87 has not proven to be useful: In practice (i) it may be difficult to examine whether or not a particular feature has been explained as "essential" in the disclosure, and (ii) the T 331/87 test fails to examine whether or not the deleted feature contributes to achieving the desired effect of the claimed invention.

10) Does your Group's current law allow amendments post grant? If so, how does your Group's current law strike a balance between allowing a patentee to make appropriate amendments to a granted patent (such as amendments necessary to sustain its validity) and preventing the patentee adding impermissible matter?

The patentee of a German patent or a European patent is entitled to amend the patent post grant, as stated above. Any amendment made in any of these proceedings after grant may not be such that it adds subject matter not disclosed in the application as filed, and may not extend the scope of protection vis-à-vis the claims as granted or amended in post-grant opposition, revocation or limitation proceedings.

Both requirements serve the interest of legal certainty by third parties. Third parties (competitors) must be able to rely on the scope of the patent. Patentees are prevented from improving their positions

post grant by extending the scope of the patent by amendment. So any competitor can rely on the assumption that the granted claims provide the maximum scope the patentee can achieve in any post grant proceedings. Any embodiment not infringing the independent claims of a patent cannot be covered by amendments of the patent in post grant proceedings.

On the other hand, for amending the claims the patentee is not limited to features of the granted claims. The granted claims can be amended by any features from the original application even if the features had been deleted during prosecution and are no longer included in the patent specification.

11) Are there aspects of these laws that could be improved?

yes

Please explain:

We consider the case law of the European Patent Office relating to said “inescapable trap” (cf. answer to question 7) inappropriate. In case the patent was granted on the basis of claims which would include a non-disclosed feature, the German group of AIPPI considers it inappropriate to penalize the patent proprietor by invalidating his patent, regardless of what further amendment the proprietor would agree to. The position of the FCJ seems entirely reasonable. There is no reason to revoke such a patent. It is entirely sufficient to ignore non-disclosed features within granted claims in invalidation proceedings (with the consequence that a prior art would be novelty destroying, even if it discloses all but the non-disclosed feature).

Also, the assumptions of the EPO of what is “clearly and unambiguously” disclosed should be improved. The German group of AIPPI would appreciate if the EPO would examine more carefully how a skilled person interprets a disclosure in a patent application. Skilled persons – by reference to their expert knowledge – are capable of distinguishing between features relating to preferred embodiments and features that constitute a necessary element in order to solve the object of the invention. Asking whether or not a feature in a claim is “essential” - as it is examined under the current EPO benchmark test, following decision T331/87 – is not an appropriate and clear criterion.

12) If your Group's current law uses, at least in part, the notional person skilled in the art to determine the permissibility of amendments, is this approach effective? Are there aspects of this that could be improved?

As mentioned in previous sections, in the case law of both the EPO and the German Courts, an amendment is (only) considered admissible, if the amendment was directly and unambiguously disclosed in the application as originally filed for a person with average skill in the art. The notion of the person skilled in the art is the same as is applied in the context of claim construction, enabling disclosure, inventive step and, notably, novelty. Thus, the understanding of this person skilled in the art is (or at least should be) the key issue as regards admissibility of amendments.

Generally, the approach established by the FCJ and by the Enlarged Board of Appeal of the EPO is effective, as it establishes a reliable concept of what is and what is not comprised in the original application and, accordingly, what is and what is not an admissible amendment. Various similar issues in patent law, such as novelty, scope of protection, etc., are assessed according to the same standards. This safeguards that these issues will be treated in a consistent manner and, in particular, the content of a document of the prior art is assessed according to the same standards as the content of the application as originally filed.

In the daily practice before the patent offices, however, this approach frequently does not work to satisfaction for a couple of reasons. First, many examiners may not be familiar with the full concept of a person skilled in the art and how the understanding of a person skilled in the art and in particular

implicit disclosure is to be determined. Many of them, particularly in the EPO, simply equate the literal (textual) content of the application as filed with the skilled person's understanding. Making a full determination of the knowledge and skills of a person skilled in the art and, accordingly, of the understanding of this person skilled in the art usually goes beyond what can be done in the prosecution before a patent office. Before the EPO, it would (unfortunately) even be quite exceptional.

It would be an improvement indeed, if the EPO Guidelines and the case law of the Boards of Appeal more clearly established that the examination of original disclosure to the skilled person must not stop with the assessment of the explicit literal disclosure, but must also include, as an indispensable element of the examination, an assessment of the general knowledge of a person skilled in the art and of what a person skilled in the art, based on his or her general knowledge, understands beyond the literal disclosure in the original application, in particular which underlying principles and concepts are directly and unambiguously apparent from the original application for a person skilled in the art.

III. Proposals for harmonisation

13) Is harmonisation of the definition of impermissible added matter desirable?

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

yes

Please explain:

The need for harmonization becomes particularly apparent in the case of a PCT application. It is clearly undesirable if amendments to the PCT applications are considered allowable in the one jurisdiction and unallowable in another. It would be helpful if applicants could rely on harmonized standards for the allowability of amendments in all national and regional phases.

14) If yes, please propose a definition of impermissible added matter that you believe is appropriate.

In accordance with the German and European "gold standard", subject matter which cannot be "*clearly and unambiguously*" derived by a skilled person from the application as filed is considered inadmissible added matter. The German group of AIPPI considers this definition a suitable basis for harmonization. This definition reconciles the interests of third parties in legal certainty (i.e. the interest not to be taken by surprise by an unpredictable amendment) with the interest of the applicant to be appropriately rewarded for publishing his invention by - if necessary - appropriately amending his application in view of the prior art cited during prosecution. The notion of "clear and unambiguous" disclosure should be examined with the view point of a fictitious person skilled in the art. Based on his expert knowledge, it should be assumed that this fictitious skilled person would be able to distinguish between elements relating to preferred embodiments and elements of the invention that contribute to solving the object of the invention. An applicant should be permitted to delete elements relating to a preferred embodiment from a claim.

Also, determination of what is "*clearly and unambiguously*" disclosed in an application or patent specification, respectively, should be provided based on the skills and knowledge of the fictitious skilled person. Subject matter should not be considered impermissible added matter, in case a skilled person at the priority date of the application, based on his expert knowledge, would "clearly and unambiguously" understand this subject matter from the original application documents, rather than relying entirely on formal or textual criteria.

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

yes

Please explain:

Until grant of the patent, the standard should be the same in all phases of the examination. However, after grant, it should not be allowed to extend the scope of protection by any kind of amendments.

16) Should rules against impermissible added matter prohibit the addition of claims per se, as opposed to adding limitations to claims?

Before grant: No. After grant: Yes.

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

no

Please explain:

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

yes

Please explain:

19) If your proposed definition refers to the notional skilled person, what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?

The relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment should be the filing or priority date of the application.

20) If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, how should the impermissible added matter defect be remedied in these circumstances?

The German group of AIPPI in general supports the current German case law and does not support the “inescapable trap” in accordance with the decision G1/93 of the Enlarged Board of Appeal of the EPO (cf. question 7 herein above). After grant of a patent third parties must rely on the accuracy of any infringement analysis. For good reasons the legislator provided that after grant no patent may be amended in such a way as to extend the protection it confers. The patent proprietor himself is responsible for the amendments made during prosecution, and thus should make sure that his patent is not granted based on claims which would include a feature that would not be supported by the application as filed.

The German group of AIPPI is in favor of a solution which safeguards the expectation of the public not to be confronted with an extension of the scope of protection post grant, and which - on the other hand - also prevents penalizing patent proprietors unnecessarily. A conceivable trade-off serving both intentions has been defined by the German courts.

Following current German case law, a patent claim which includes a non-disclosed feature could be

maintained unamended, with the effect, that (i) any infringement analysis would be based on all features (including the non-disclosed feature), whereas (ii) novelty and inventive step in any post grant invalidation procedures would be examined on the basis of a subset of the features, i.e. all features of the claims except the non-disclosed features.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

In accordance with the EPC, amendments of a divisional application are considered impermissible added matter in case they are not based on the disclosure of the documents of the divisional application, even if they would find a basis in the original parent application. Such a rule does not exist in German patent law. A German divisional application may be amended with subject matter which is disclosed in the parent application, even if it is not supported by the documents initially filed for the divisional application. The German group of AIPPI is in favor of the German practice – patent law should be harmonized accordingly and allow amendments in divisional applications in case the amendments are supported (only) in the original parent application. The significance of this proposal is easily demonstrated by the following example: Consider that a PCT application was filed in Japanese language, and entered the Regional Phase before the EPO. In case of translation mistakes, the translation could be amended at any time, as the “application as filed” would be the Japanese original application. However, this would not be true for any divisional application. The divisional application would be typically filed in English language (i.e. the language of procedure of the EP patent application), and translation mistakes would again lead to an “inescapable trap”: The translation mistake in the divisional application cannot be maintained, as the feature in accordance with the incorrect translation was not disclosed in the parent application. The correction of the translation likewise cannot be amended, as it would not find any basis in the divisional application. The application (or patent) would consequently have to be refused/revoked. This result is obviously inappropriate.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

The proposals of the German group are not limited to certain industry sectors.

Summary

There is a clear need to harmonize standards for the allowability of amendments. Even German courts and the European Patent Office don't apply the same standards.

Subject matter which cannot be “clearly and unambiguously” derived by a skilled person from the application as filed should be considered inadmissible added matter. The notion of “clear and unambiguous” disclosure should be examined with the view point of a fictitious person skilled in the art. Based on his expert knowledge, it should be assumed that this fictitious skilled person would be able to distinguish between elements relating to preferred embodiments and elements of the invention that contribute to solving the object of the invention. An applicant should be permitted to delete elements relating to a preferred embodiment from a claim.