

## Inadmissible enlargements in EPC grant proceedings: Caution Trap



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### I. Introduction

There is a developing trend in examination procedures before the European Patent Office towards an increasingly formalistic handling of Art. 123(2) EPC. These objections, known as “inadmissible amendments” or “inadmissible enlargements”, are particularly painful for the Applicant as they may lead to rejection of the application or a later revocation of the patent, without ever taking into account the inventive step of the subject-matter of the application. The priority year has usually expired at the time of such a rejection, meaning that the Applicant may irretrievably lose the entire investment in the patent application. In such cases, there remains the option of an expensive divisional application or - at least in Germany and Austria - the possibility of splitting-off a utility model, in order to save at least part of the application.

In the following, the purpose of Art. 123(2) EPC and the standard of evaluation laid down by the Enlarged Board of Appeal for the application of Art. 123(2) EPC, shall be briefly outlined. Subsequently, the consequences for the Applicant resulting from an excessively formalistic approach in the

application of Art. 123(2) EPC, will be discussed on the basis of a current case study. Even during the grant procedure, traps may arise for the unwary Applicant which, in some cases, cannot be solved.

### II. Sense and purpose of Art. 123 (2) EPC, the gold standard

According to Art. 123(2) EPC, the European patent application or the European patent may not be amended in such a way that its subject-matter extends beyond the content of the application as filed.

The purpose of this provision is to prevent the Applicant from obtaining an undue advantage by acquiring patent protection for aspects which were not disclosed in the original application. In this respect, Art. 123(2) EPC contributes to the legal certainty of third parties, since they must be able to rely on the fact that an Applicant cannot obtain protection for subject-matter extending beyond the original disclosure of the initial application.

The interpretation of Art. 123(2) EPC is normally based on the “gold standard” as defined by the Enlarged Board of Appeal:

*“Each amendment to a European patent application referring to the disclosure parts [...] may [...] only be made within the limits of what can be derived directly and unambiguously*

- *by a person skilled in the art*
- *from the entirety of the documents as filed*
- *using common general knowledge – objectively and relative to the date of filing –”*

The admissibility of an amendment depends, therefore, on whether the person skilled in the art receives new technical information which is not derivable from the application documents as originally filed.

According to European case law, the point of view of the person skilled in the art is decisive. Patent applications are not addressed to linguists, but to a specialist audience who reads the application with the intention of understanding it and giving it a technical meaning. A reading style that excessively focuses on the structure of the text of the application in the manner of a philologist or logician, should be rejected.

Unfortunately, this standard of assessment is not always consistently applied during examination proceedings. The effects that an overly formalistic reading style can have on the Applicant, can readily be illustrated by a recent rejection of a patent application before the EPO.

### III. Current Case Study

The application concerned an information system with displays and a control unit for a vehicle. In the original version of claim 1, which was based on a foreign priority application, it was claimed that the information system was installed in the vehicle ("information system installed in a vehicle"). This was objected to in the examination procedure as lacking clarity under Art. 84 EPC, since it was not clear from the wording whether the vehicle formed a part of the claimed information system or not.

The Applicant amended Claim 1 to the effect that the information system is installable in a vehicle. This amendment received objection under Art. 123(2) EPC, since an information system installable in a vehicle was, in the Examining Division's opinion, not directly and unambiguously derivable from the original application documents – allegedly, only an information system *already installed* in the vehicle was disclosed.

Thus there was no way for the Applicant to clarify the allegedly unclear feature, without giving rise to an objection under Art.

123(2) EPC. After a further decision and at Oral Proceedings, the conflict finally led to the rejection of the application.

### IV. The trap of Art. 84 - Art. 123(2)

The above case study clearly illustrates a rarely discussed conflict with Art. 123(2) EPC. In the context of the formalistic approach to the disclosure of the application, the feature objected to as unclear under Art. 84 EPC cannot be clarified without infringing Art. 123(2) EPC. The reasoning by the Examining Division that no "installable but not yet installed information system" is disclosed, appears artificial and can only be justified on the basis of a reading of the application documents in which the technical content of the description is given a secondary importance. Regrettably, the Examining Division did not accept these arguments as relevant in the underlying case presented.

Thus, if Art. 123(2) EPC is strictly applied, an inescapable trap can readily arise from Art. 84 EPC and Art. 123(2) EPC in the grant proceedings. In view of the above-mentioned trend towards a more formalistic handling of Art. 123(2) EPC, it is to be expected that this issue will occur more frequently.

### V. Conclusion

Although the Guidelines for Examination in the European Patent Office, which came into force in November 2018, indicate that the gold standard alone is decisive for the application of Art. 123(2) EPC, a trend towards an even more formalistic handling of Art. 123(2) EPC seems to have emerged recently during examination proceedings before the European Patent Office (EPO). There are increasing occurrences of conflicts between the clarity requirement of Art. 84 EPC and the amendment restrictions of Art. 123(2) EPC, which in some cases may lead to an inescapable trap in the examination proceedings.

The Boards of Appeal have clarified that the fact that a claim feature is unclear, does not imply that this feature does not constitute a limitation of the claim, so that the mere deletion

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of unclear features regularly leads to an objection under Art. 123(2) EPC (T 2224/12).

Thus, when drafting new applications, it must be ensured that the claims meet the clarity requirement of the EPC or that they can be clarified on the basis of the description. If the description of the application in the above case study had included a clarification to the effect that the invention comprises the information system independent of the vehicle, a way out of Art. 84 - 123(2) - trap would have been available.

It is, of course, difficult to assess in advance which wording will, during examination proceedings, ultimately lead to a conflict between Art. 84 EPC and Art. 123(2) EPC. Therefore, taking time to include the most comprehensive and clearest definitions possible of each of the essential inventive features, which can then later be used to clarify the claims, should not be overlooked.

## Take-home messages:

- The EPO's Examination Divisions often apply a very strict standard when assessing inadmissible enlargements.
- This may result in inescapable traps during examination proceedings, where the Applicant has no possibility to amend the application in such a way that it meets all the requirements of the EPC.
- In the light of this development, particular attention must be paid to this issue when drafting patent applications which will ultimately be prosecuted through the EPO.

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