



## Added Matter/Extension of Protection at the European Patent Office

A European patent application or patent can be amended at various points in the patenting procedure, but there are restrictions on amendments to prevent new subject matter being introduced and to prevent any extension of the scope of protection given by a patent after grant.

According to Article 123(2) of the European Patent Convention: *"The European patent or patent application may not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed"*.

According to Article 123(3) EPC: *"The European patent may not be amended in such a way as to extend the protection it confers"*.

Contravention of either of these provisions is a ground for revocation of a European patent. Hence, it is important to avoid amendments that are at risk of an attack based on Article 123.

### The approach of the EPO - extension of subject matter

The EPO takes a strict approach to the unallowable extension of subject matter, often referred to as "added matter". The basic principle applied by the EPO is that the amendment must not result in *"the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application"*. It is permissible to take account of matter that is implicit to the person skilled in the art. This approach applies to amendments to any part of a patent or patent application, and it can be important to consider if amendments to the description or drawings might add matter.

Often, an amendment will add one or more new features to the claims. If a new feature cannot be derived from the original disclosure, then the amendment is not allowable. However, the EPO also take the approach that a claim-broadening amendment can add matter, because it results in disclosure of the subject matter falling between the scope of the broader claim and the unamended claim. Hence, it is important to consider added matter in relation to both narrowing and broadening amendments.

An example of an unallowable broadening amendment would be the case where claim 1 was amended to broaden the scope of the term "electric light bulb" to "light generating means" if there is no more general disclosure in the application.

Another example of an unacceptable broadening amendment is known as an "intermediate generalisation". Consider the situation where claim 1 is directed to a compound comprising A + B, claim 2 is directed to the compound of claim 1 further comprising C + D, and the application contains no more general disclosure. An amended claim to the compound comprising A + B + C would be considered to add subject matter because there is no disclosure of the combination of A + B + C, without D, in the application as filed.

Ideally for prosecution before the EPO, a patent application should discuss optional features and combinations of features. Unless there are good reasons the application should avoid suggesting that certain sets of features can only be present in combination. Additionally, the application should identify what is essential to the invention and, more importantly, what is not essential. If a non-essential feature is disclosed as being essential, for example by stating it is necessary to meet an object of the invention, removing this feature from a claim could risk adding matter.



In practice, many European Examiners will look for an explicit disclosure of a newly claimed feature or combination of features in the application as filed, or even for explicit disclosure of the wording of an amendment. However this is not always required and it is important to seek advice from a European patent attorney to ensure that best use is made of the original disclosure when preparing an amendment to meet the applicant's needs.

### The approach of the EPO - extension of protection

Article 123(3) is only concerned with *post-grant* amendments that have the effect of *broadening* the scope of protection. As well as amendments to the claims, amendments to the description and or drawings must also be taken into account, because they can be used to interpret the claims.

An amendment to delete a feature from the granted claims, or to replace a feature in the granted claims with a broader feature from the description would not be allowable. Also, if disclosure within the description or drawings has the effect of giving a narrowed interpretation of the claims, deletion of this disclosure would not be allowable to avoid the claims being given a broader interpretation.

### Article 123(2)-123(3) trap

Particular care needs to be taken to consider the interaction between the two provisions mentioned above. Whilst post-grant amendments can be made to address an issue under Article 123(2) (for example during the Opposition or Central Limitation procedures), in some cases removing the added matter is not possible because it will unallowably broaden the scope of the claim in contravention of Article 123(3). This will result in the patent being irretrievably invalid. Hence, it is especially important to avoid making narrowing amendments during prosecution that potentially add matter that cannot be reversed post-grant except by broadening the scope of protection. This applies to both the claims and the description.

The principles discussed here apply during all proceedings before the EPO as well as in proceedings in a national Office or Court relating to a national part of a European patent.

### Further information and advice

Several of the issues discussed above are peculiar to European practice and therefore it is important to seek advice from a European Patent Attorney. If you have any questions or have a particular issue to discuss in relation to amendments then please get in touch with any member of the Dehns Patents group using the details below.

#### United Kingdom

Dehns  
St Bride's House  
10 Salisbury Square  
London  
EC4Y 8JD

T: +44 (0)20 7632 7200  
F: +44 (0)20 7353 8895  
E: mail@dehns.com

Dehns  
Aspect House  
84-87 Queens Road  
Brighton  
BN1 3XE

T: +44 (0)1273 244200  
F: +44 (0)20 7353 8895  
E: brighton@dehns.com

Dehns  
Willow Court  
West Way  
Oxford  
OX2 OJB

T: +44 (0)1865 305100  
F: +44 (0)20 7353 8895  
E: oxford@dehns.com

#### Germany

Dehns  
Singlspielerhaus  
Sendlinger Str. 29  
80331 Munich

T: +49 89 2422 8130  
F: +49 89 2422 8140  
E: munich@dehns.com

[www.dehns.com](http://www.dehns.com)