

Added subject matter woe at the EPO – how it's best avoided

The European Patent Office has a reputation for being very strict when assessing whether an amendment has basis in the application as filed. Applications drafted without European patent practice in mind often fall foul of the EPO's very strict approach to added subject matter, resulting in applicants not obtaining patent protection at all or obtaining patent protection which is narrower than is probably deserved. This newsletter provides some helpful tips to avoid those added subject matter objections.



Simon Haslam
Senior Associate, Cardiff
simon.haslam@abelimray.com

In order for an amendment to have basis in the application as filed at the EPO the amendment must be “directly and unambiguously derivable” from the application as filed. The application as filed is either the European application as filed or the PCT application as filed, if the European application is derived from a PCT application. While “directly and unambiguously derivable” does not mean “verbatim”, as a rule of thumb it is generally preferable for any amendment to be taken verbatim from the application as filed. This means that the applicant or their attorney has to think in detail about the claim language when filing the application. This explains why the descriptions of many applications drafted with the EPO in mind contain a series of statements which mirror the language of the claims. These so-called statements of invention are used to provide verbatim basis for future amendments and to allow the applicant to explain the benefits of particular claim features. It is therefore extremely useful for applications destined for the EPO to include such statements of invention. They are conventionally included towards the beginning of the description, but can merely be added as a set of clauses. The clauses should have multiple dependency, like multiple-dependent claims, which are common in European practice.

One rather trite example set of such clauses may be:

A first aspect of the present invention will now be described with reference to the following clauses of which:

- + Clause 1 - A lawnmower comprising a cutting means
- + Clause 2 - The lawnmower according to clause 1 in which the cutting means comprises a rotatable cutter.
- + Clause 3 - The lawnmower according to clause 1 or clause 2 comprising a receptacle for receiving cut grass
- + Clause 4 - The lawnmower according to any of clauses 1 to 3 comprising a handle.

A second aspect of the present invention will now be described with reference to the following clauses of which:

- + Clause 5 - A method of cutting a lawn comprising contacting a rotating cutter with the lawn
- + Clause 6 - The method of cutting a lawn according to clause 5 comprising collecting cut grass.

Generalisation of features

If the only basis for an amendment was a widget comprising a spring, the EPO would most likely refuse to allow a broader claim directed to a widget comprising “a bias means” on the ground of added subject matter.

Similarly, the EPO would probably reject a claim to a widget comprising “a spring” on the ground of added subject matter, if the only basis for amendment was for a widget comprising a specific type of spring, such as a leaf spring.

In order to avoid such a situation, the specification should contain statements of invention or clauses which contain all of the possible claims and fall-back positions which the applicant may envisage using. The clauses should be written taking into account that the EPO does not like the undisclosed generalisation of specific features, amendments to narrower (but undisclosed features) and that the EPO is generally quite happy with functional language.

For example, a suitable layered claim approach providing suitable amendment opportunities may be:

- + Clause 1 - A widget comprising a bias means.
- + Clause 2 - The widget of clause 1, in which the bias means comprises a spring.
- + Clause 3 - The widget of clause 1 or clause 2, in which the bias means comprises a leaf spring or a coil spring.
- + Clause 4 - The widget of any of clauses 1 to 3, in which the bias means comprises a leaf spring.

If the application does not contain such statements of invention or similar clauses, then there is a much greater risk that the EPO will find that an amendment adds subject matter. For example, the EPO rules concerning allowing amendments directed to features taken from examples are strict, and often prohibit amendment to features taken from the Detailed Description.

Further problems can arise in relation to use of the word “embodiment”. The EPO often interprets the word as meaning limited to a particular example, to the exclusion of other “embodiments”, so that features from different “embodiments” cannot be combined. From the viewpoint of EPO practice, “embodiment” should be avoided, in particular when used with statements of invention or similar clauses.

Amendment based on features imported from other applications

An area in which EPO practice differs from practice in the US is in relation to importation of the teaching of other documents outside the patent application. The EPO does not permit the general importation of amendments by general reference to another application of the sort “the present application incorporates by reference the disclosure and teaching of European patent application 12345678.9 in its entirety”. Basis for amendment can be incorporated at the EPO, however, by referring to particular features disclosed in other documents. For example, “The widget of the present invention comprises a bias means. The bias means may have those features described in relation to bias means described in European patent application no. EP12345678.9” would allow the applicant to use the features of the bias means in EP12345678.9 in amendments.

Negative limitations or disclaimers

One area in which the EPO is probably slightly more lenient than the USPTO is in relation to negative limitations or disclaimers. A disclaimer may be used to disclaim the disclosure of another European application which has an earlier priority date than the application in suit, but was published after the

priority date of said application. In this case, a disclaimer may be used to disclaim the subject matter of the earlier application without any textual basis in the application as filed.

The post-grant trap

If the EPO allows an amendment during patent prosecution and that amendment is subsequently found to add subject matter, for example, in opposition proceedings, then the patent could be fatally flawed, depending on the nature of the “offending” amendment. If the added subject matter objection can be overcome by making a narrowing amendment which has basis in the application as filed, then the patent can be maintained in a narrowed form. However, if this is not possible, for example, if the only way to deal with the added subject matter is to delete the “offending” feature, then this is not permitted because a post-grant amendment cannot broaden the scope of the patent, and removal of an “offending” feature will almost always broaden the scope of the patent. It is therefore important to ensure that any amendment has basis in the application as filed or at the very least that there is a suitable narrowing fall-back position which has basis in the application as filed.

Getting it right early on – the priority document

The criteria the EPO uses for assessing added subject matter are essentially the same as those used to assess whether or not a priority claim is valid. Therefore, it is sensible to start thinking about patent protection in Europe when filing the priority application, and include suitable claim, clause and/or statement of invention language in the priority application.

The EPO has developed particular rules and case law in specialist areas (such as chemistry, pharmaceuticals and biotechnological inventions), and these are beyond the scope of this article.

If you have any questions about matters in the Newsletter, please get in touch with your usual Abel & Imray contact, or e-mail to ai@abelimray.com

London

20 St. Andrew Street
EC4A 3AG, UK
T +44(0)20 7242 9984
F +44(0)20 7242 9989

Cardiff

3 Assembly Square
Britannia Quay
CF10 4PL, UK
T +44(0)29 2089 4200
F +44(0)29 2089 4201

Bath

Westpoint Building
James Street West
BA1 2DA, UK
T +44(0)1225 469 914
F +44(0)1225 338 098