Avoid pitfalls when limiting claims in Europe

For many years there has been debate about EPO practice relating to amendments under Article 123(2) EPC in examination and opposition proceedings. Charlotta Vink and Louise Tottie of Valea examine the latest cases.

According to Article 123(2) of the European Patent Convention (EPC) a European patent application may not be amended to include subject-matter that extends beyond the content of the application as originally filed. Contravention of this provision is a ground for opposition after grant, and/or national revocation. The guiding principle for all amendments is that they should be directly and unambiguously derivable for a person skilled in the art from the application as originally filed. While literal support is not required, the boundaries for what a skilled person can understand from an application will depend of the circumstances of the case. In this article we highlight some EPO decisions relating to claim amendments involving limitations to elucidate which amendments are considered to comply with the requirements of Article 123(2).

The Article 123(2) and (3) trap

The importance of correct claim amendment may be illustrated by the so-called Article 123(2) and (3) trap. In such a situation the claim(s) of a granted patent contain(s) a limiting claim feature lacking basis in the application as filed, which is contrary to Article 123(2). The problem cannot be overcome by removal of the limiting claim feature since this would extend the scope of protection conferred by the patent, thereby contravening Article 123(3). Thus, unless the limiting claim feature can be replaced by a properly supported claim amendment, the patent owner will inevitably fall into the Article 123(2) and (3) trap and the patent will be revoked.

Frequently, the applicant for or the owner of a European patent
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has to limit the claims in view of prior art. Although claim amendments involving limitations may often be based on intended fallback positions present in the patent application, there are also circumstances where claim limitation is not straightforward. For instance, claim limitation may have to be based on a part of the patent description not explicitly drafted as a fallback position and/or a disclaimer removing subject-matter may have to be introduced.

EBA decisions

The principles for assessing an amendment for its compliance with Article 123(2) have been established in decisions G 3/89 and G 11/91 of the Enlarged Board of Appeal. These principles were later confirmed in decision G 2/10 relating to disclaimers. In particular, G 2/10 establishes that the subject-matter remaining after claim amendment must be directly and unambiguously derivable from the application as filed. In other words, the skilled person must not be presented with new information that cannot be derived clearly and unambiguously from the application as filed.

Although G 2/10 discusses claim amendments relating to the introduction of disclosed disclaimers, that is disclaimers having a basis in the application as filed, subsequent decisions have found it to be applicable also to undisclosed disclaimers. According to decisions G 1/03 and G 2/03 the introduction of undisclosed disclaimers may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC (an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention); and
- disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.

Further, G1/03 and G2/03 state that:

- A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.
- A disclaimer that is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC.
- A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

However, in addition to the requirements of G1/03 and G2/03 it has been found that the requirements of G2/10 must also be fulfilled.

Decisions T 748/09 and T 1870/08 both relate to claims amended by introduction of an undisclosed disclaimer and illustrate different outcomes upon application of the teaching of G2/10.

In T 748/09 claim 2 of the main request included a proviso with the wording “with the proviso that a metal alloy consisting essentially of 50 – 98.9 % Nb, 0.5 – 5 % Zr and 0.6 – 49.5 % Ta is excluded”.

The proviso was introduced because of a so-called Article 54(3) document, namely a European patent application filed before and published after the effective filing date of the patent in the present case. However, the Board found that the introduction of the disclaimer resulted in confronting the skilled person with new information he could not derive clearly and unambiguously from the application as filed. For instance, the upper limit of less than 50% niobium was not disclosed anywhere in the application as filed. Accordingly, the amendment was found unallowable.

However, in T 1870/08 also relating to a claim amendment involving an undisclosed disclaimer due to an Article 54(3) document, the Board came to the conclusion that the subject-matter was indeed directly and unambiguously derivable from the application as filed and thus allowable. This case concerned a superconducting wire comprising an oxide superconductor oxide in a sheath member, and with a sheath member material selected from Au, Ag or an alloy thereof. The disclaimer specified that when the sheath material was Ag or an alloy thereof, the oxide superconductor was not of the K2NiF4 type. The Board found that it was clear from the application that the oxide superconductor may have a perovskite type of crystal structure, and that this comprises structures which are not of the K2NiF4 type. Further, the application disclosed that the sheath member contained a material selected from the group of Ag, Au, Pt, Pd and their alloys. Thus, the subject-matter of the amended claim was disclosed in the originally filed application and the amendment complied with the requirements of Article 123(2).

Claim limitation language

Commonly, patent claims use the claim language “comprising”. Decisions T 287/11 and T 2017/07 show that the allowability of claim limitations in such cases very much depends on the facts of the case.

In T 287/11 claim 1 of the granted patent read: “An aerosol hair styling composition comprising(a) from 5% to 90% by weight of a water-soluble polyalkylene glycol [...](b) ... (c)”.

In opposition appeal proceedings the claim was amended to read: “An aerosol hair styling composition comprising (a) from 5% to 90% by weight of a water-soluble polyalkylene glycol [...](b) ... (c) wherein the water-soluble polyalkylene glycol
conforms to the formula $A(OC\!H_2C\!H(R))n-OA$ […]”

This amendment, which at first sight appears to be a limitation, was found to be an extension of the claim scope. This is because the range of “… 5% to 90% by weight…” after amendment relates to the compounds of specific formula $A(OC\!H_2C\!H(R))n-OA$. Due to the claim language “comprising” the composition of the claim may contain water-soluble polyalkylene glycols other than the compound of formula $A(OC\!H_2C\!H(R))n-OA$, resulting in a total amount of water-soluble polyalkylene glycols outside the range of the granted claim. In the end, the patent owner was able to resolve the problem by adding to the claim that the total amount of water-soluble polyalkylene glycol should be in the range of 5% to 90% by weight.

T 2017/07 concerns a similar case where granted claim 1 was amended during opposition proceedings by addition of “… the alkylene carbonate being propylene carbonate” to read: “A hair dye composition which comprises (a) an acid dye and (b) alkylene carbonate having 3-5 carbon atoms, […] wherein the content of the alkylene carbonate is 0.5-50% by weight, the alkylene carbonate being propylene carbonate…”

In this case, the Board stated that the composition of the amended claim may comprise, in addition to an acid dye and propylene carbonate, components including other alkylene carbonates having three to five carbon atoms, that is ethylene carbonate and/or butylene carbonate, in any amount, with the consequence that the granted upper limit of 50% by weight of alkylene carbonate having three to five carbon atoms may be exceeded. The amended claim encompasses compositions having a content of more than 50% by weight of alkylene carbonate having three to five carbon atoms, which embodiment was excluded from the compositions of the granted claim. Thus, the scope of the amended claim was broader than that of the granted claim, thereby contravening Article 123(3).

The owner tried to remedy the problem of added subject-matter by replacing “comprising” with “consisting of”. As basis for the amendment, the owner referred to a paragraph in the description stating that component (b) included polypropylene carbonate, the propylene carbonate being particularly preferred. Further, the owner referred to some of the examples in which propylene carbonate was used. However, the Board found that this way of isolating a special feature from a particular embodiment and generalising it in the claim was not allowable.
The case mentioned above is an example of a so-called intermediate generalisation, sometimes called an intermediate limitation, wherein a claim is limited by addition of a feature isolated from a specific embodiment. Extracting a feature from an embodiment and using it for claim limitation may only be allowed if there is no structural and functional relationship between the extracted feature and the remaining features of the embodiment. This illustrates the strict interpretation of Article 123(2), and shows that for a feature to constitute sufficient basis there must be a direct and unambiguous disclosure of the feature, as well as a clear teaching that a selection or combination with this feature may be made.

The fact that the term “comprising” may not always be replaced by “consisting of” or “consisting essentially of” is discussed in decision T 759/10. In this case, the patent owner had amended claim 1 by replacing “the texturizing agent comprises” by “the texturizing agent consisting essentially of”, which had no explicit basis in the application as filed. The owner argued that the term “comprising” encompassed three alternatives, namely (1) “comprising”, (2) “consisting of” and (3) “consisting essentially of”, and that each of these alternatives would immediately come to the skilled person’s mind when reading the term “comprising”. The Board did not agree, and stated that each term has a different technical meaning, namely (1) that any further component can be present (“comprises”), (2) no further component can be present (“consists of”) and (3) specific further components can be present, namely those not materially affecting the essential characteristics of the texturizing agent (“consists essentially of”). The Board went on to say that the skilled person is not at liberty to choose whichever of the three terms he wishes when reading the term “comprising”. Thus, from this decision it is clear that the facts of the case will determine if such an amendment will be considered directly and unambiguously derivable from the application as filed and thus be allowable.

A special case concerns alloys, where the claim language “comprising” is frequently used while also specifying that an element is used as balance so that the composition components add up to 100%. In such a case, replacement of “comprising” with “consisting of” appears to be allowable, as indicated in decision T 107/14. The reason for this is that the claim is in fact directed to closed compositions due to the presence of a balance element.

Advice for patent applicants

To summarise, due to the strict application of the rules for claim amendments in Europe, it is advisable to take the above teachings into account when drafting patent applications intended to be filed in Europe. Even though the guiding principle is that the amendment should be directly and unambiguously derivable from the application as originally filed, it can be helpful if literal support is provided. Therefore, we recommend including in the application text alternative claim language so that for instance “comprising” may be exchanged for “consisting of” or “consisting essentially of”, and also an explicit basis for embodiments such as ranges or a specific combination of features for which the applicant may wish to obtain patent protection.