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DESCRIBED BUT NOT DISCLOSED

VALEA

Lena Hagström, Johan Ståhlberg and Anna Theander from Valea describe the EPO's strict approach to added subject matter

Described but not disclosed

Applicants from different countries disclose their inventions in patent applications to obtain patent protection in many different jurisdictions, including contracting states of the European Patent Convention (EPC). Before a patent application proceeds to a grant, the applicant is usually required to amend the originally filed claims to bring them into conformity with the regulations of the EPC.

Throughout the proceedings, a recurrent problem is that the applicant makes amendments that are deemed to contravene Article 123(2) of the EPC, that is, the amendments are considered to extend beyond the content of the application as filed. The strict approach to added subject-matter by the EPO is not something that can be readily explained in a few sentences. A fundamental principle is, however, that an amendment must be directly and unambiguously derivable from the content of the application as originally filed.

Our experience is that the requirements for amendments are more liberal in many other jurisdictions, such as in the USA. Therefore, this problem is accentuated when an application is not fully adapted to the regulations under the EPC, as may occur for example when an applicant has filed an international patent application (a PCT application) which is to enter the regional phase before the EPO, or a national patent application in a jurisdiction with less strict requirements and from which national patent application priority is claimed in an EP application.

So at the time of drafting the PCT application or the priority founding national application, it is very important to ensure as far as possible that the application complies with the regulations of as many jurisdictions as possible, and not only the regulations under the EPC. Yet, under the EPC there is, for example, a major difference between “according to one embodiment” and “according to any of the embodiments above” when presenting a feature in the application text. The latter will provide much greater leeway for possible subsequent amendments. Furthermore, it is also very important to completely disclose numerous embodiments of the invention, rather than briefly describing the basic principles of the invention.

In order to shed light upon how complex it may be to draw the line between when subject-matter is considered to be added and when it is not, we will look at some recent case law of the Boards of Appeal of the EPO.

Addition of a feature - allowed

In this example (T0151/08), an amendment concerning a claim directed towards a flow meter is considered. According to the application as originally filed, the flow meter comprises a disc-like membrane means positioned inside a case, and a circumference of the membrane means is affixed to the walls of the case. In an amended claim, it was stated that a perimeter of the membrane means is affixed to an inner wall portion of the case. The Board held that the perimeter of the membrane means was necessarily affixed to an inner wall portion of the case, since the membrane means

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is positioned inside the case. Moreover, it was considered that a number of drawings, which according to the application as filed qualified as embodiments of the invention, disclosed examples in which the membrane means was positioned inside the case and at the same time defined an end of the case. Therefore, the portion of the wall to which the membrane means was affixed was necessarily an inner portion of the case. It was concluded that the term inner wall portion could be derived directly and unambiguously from the application as originally filed.

A seemingly important factor in this case appears to be what was illustrated in the drawings, which of course form part of the application as filed. Therefore, drafting and describing the drawings thoroughly may very well turn out to be worthwhile. As a result, it may be possible to find a literal basis for amendments in the descriptive text, thereby maintaining a safe distance from what may be considered added subject-matter.

Addition of a feature - not allowed

This example (T0636/08) relates to an amendment to a claim directed to a message transmission apparatus for use in a vehicle. In the application as originally filed, it is disclosed that the message transmission apparatus is arranged to transmit a message to a third party. In an amended claim, the applicant held that the third party is a third party computer. From the description, it may be understood that one example of the third party is an operator of a telecommunication network. The Board held that the addition of the term computer was not allowed, because the only computer disclosed in the application as filed was “a computing arrangement” in the vehicle, which is not the same entity as the third party.

A possible learning point from this is to give examples to terms that may need to be clarified. If possible, one should try to provide examples which gradually become more and more specific.

Deletion of a feature - allowed

The following example (T1920/08) relates to an assembly for connecting a tip to a hand piece. In an amendment, the term tubes was deleted from an independent claim. The application was refused by the Examining Division since the amendment was deemed to contravene Article 123(2) of the EPC. In an appeal against the decision, the applicant successfully argued that the deletion of tubes fulfilled the requirements under Article 123(2) of the EPC. One factor contributing to this success was that the term tubes was not mentioned in a passage generally acknowledging the invention. Therefore, a claim directed towards an assembly without tubes was found to be supported by the description as filed. Moreover, it was shown that the tubes were not described as essential, nor as indispensable for the function of the invention, and the deletion of the tubes did not require a substantial modification of other features to compensate. Hence, the criteria of the essentiality test (T331/87) had been fulfilled.

It may be that the amendment would not have been allowed if only the three criteria of the essentiality test were fulfilled. This can be seen from the discussion of the next example below. In the above case, the paragraph generally presenting the invention proved to be useful, something which may serve as a learning point.

Omission of a feature - not allowed

In this case (T0681/08) the invention related to a crimped connection between a fitting and a metal pipe inserted into a socket. A retaining element for forming a locking arrangement with the metal pipe is secured to the socket. In an amendment, an independent claim was limited to a specific embodiment described in the description. That embodiment made use of a groove. However, the amended claim did not include the feature of the groove. It was unsuccessfully argued that the amendment ought to be allowed, because the

The requirements for amendments are more liberal in many other jurisdictions, such as in the USA

groove was not explained as essential, nor was it indispensable for the function of the invention and the deletion of the groove did not require any substantial modification of other features to compensate. The Board accepted that the fact that the groove was not defined in the independent claim as filed meant that the groove was not a necessary feature of the claimed invention. Furthermore, the Board acknowledged that an embodiment with the groove was a preferred embodiment. Nevertheless, the Board found that since the retaining element was only ever disclosed in conjunction with the groove, its deletion constituted a generalisation that extended beyond the content of the application as filed. Moreover, the Board emphasised that it was irrelevant whether the groove was an essential feature or not. The question was rather whether or not the application as filed disclosed a crimped connection without such a groove.

Had the features of the invention been described and disclosed independently of each other, the outcome in this case may have been different. Care should be taken not to unnecessarily link features together when there is no essential structural or functional relationship between them.

Intermediate generalisations

One example (T0119/05) where an amendment was allowed concerns a case in which a claim as originally filed related to “a ballistic-resistant article comprising... polybenzoxazole polymer fibres”. During proceedings, the claim was amended to read “a bullet proof vest comprising... untwisted, continuous filament-based yarn of polybenzoxazole polymer”, and the question as to whether adequate basis for such an amendment was present or not was discussed. “Bullet proof vest” was explicitly mentioned in the description as an example of such an article and therefore provided sufficient basis for that limitation. Furthermore, as part of the solution to the posed problem it was suggested to make the articles from polybenzoxazole fibres. The Board found that a bullet proof vest made of polybenzoxazole was therefore implicitly disclosed.

In this example it is shown how important it is to provide a thorough description. The amendment was allowed since it was found to be implicitly disclosed, thanks to the description including several embodiments having different combinations of features.

An example (T1408/04) in which the Board found that an unallowable intermediate generalisation was present relates to an absorbent device. During proceedings, claim 1 was limited by introducing features shown in the drawings, namely “a liquid pervious topsheet defining the top surface of the device and

a liquid impervious backsheet defining the opposite surface of the device". These features were not disclosed as such in the text, but were disclosed as part of figures 1 to 3. However, in the embodiment shown in figures 1 to 3, these features were only shown in a specific joined relationship, namely with the peripheral edges of each part extending beyond the core where they were joined along a seam extending around the periphery. According to the Board, these features could not be seen in isolation without the specific joined relationship and the amendment was therefore not allowed. Although other possible

In view of the above discussed examples, one way of ensuring proper basis for future amendments is to carefully choose the wording of the description, avoiding linking features together unnecessarily if no structural or functional relationship is present. Furthermore, disclosing all useful combinations of features as broadly as possible at least reduces the risk of proposing an amendment that is not allowed under Article 123(2) of the EPC.

Moreover, a broad scope of protection usually needs to be supported by a plurality of embodiments. By providing this, the possibility of identifying an allowable amendment is increased.

The learning points above may hopefully provide some guidance for ensuring an adequate basis for amendments. Obviously, however, many other aspects concerning how to successfully draft a patent application are not dealt

A possible learning point from this case is to disclose as much as possible as broadly as possible

arrangements where a topsheet/backsheet structure did not require this specific joined relationship could be envisaged, no such other arrangements were disclosed in the application. Introducing those features omitting their specific joined relationship into the claim thus constituted an unallowable intermediate generalisation of the disclosed embodiment.

A possible learning point from this case is to disclose as much as possible as broadly as possible.

with here.

Finally, it should be borne in mind that a feature of an invention that is described may not necessarily provide sufficient basis for an amendment. Rather, the EPO draws a distinction between that which is described and that which is disclosed, an amendment being allowable only if it is directly and unambiguously derivable for the skilled person from the application as filed.

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