

**US Bar - EPO Liaison Council
29th Annual Meeting
Munich, 18 October 2013**

5. EPO practice issues

B. Article 123 EPC and support in the description



Article 123(2) EPC

"The European 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."

- protects third parties/public relying on the content of the application
- guarantees legal certainty
- prohibits unwarranted advantages

"Gold standard" disclosure test

An amendment is not allowable if the overall change in content of the application results in the **skilled person** being presented with technical information which is not **directly and unambiguously derivable**, seen objectively and relative to the **date of filing**, from the **whole content** of the application as filed, even when account is taken of matter which is **implicit** to a person skilled in the art using common general knowledge.

(G 3/89; G 11/91; G 1/03, G 2/10)

01-10-2013

Recent case law of the Boards of Appeal

When deciding on issues of added subject-matter,

- it is essential to identify the **actual teaching conveyed by the original disclosure**,
- subject matter needs to be considered which - **even if not explicitly revealed as such** in the application as filed - is nevertheless directly and unambiguously derivable from its content (implicit disclosure),
- **literal support is not required** by the wording of Article 123(2) EPC.

(T 667/08, T 583/09, T 2296/08)

01-10-2013

Recent case law of the Boards of Appeal

When deciding on issues of added subject-matter,

- **focus** should **not** be disproportionately **directed to the structure of the claims as filed**, to the detriment of **what is really disclosed** to the skilled person by the documents as filed.
(T 2619/11)
- the requirements of Article 123(2) EPC are violated only in cases where **the skilled person would find an additional, technically relevant piece of information in the amended version of the application**; that a specific dependent claim as originally filed refers to a particular advantageous embodiment cannot delimit the entire disclosure.
(T 1906/11)

01-10-2013

Disclaimers and corrections

- When introducing a disclaimer, the requirements of Article 123(2) EPC need to be satisfied. (G 2/10, T1870/08)
- It is not possible to correct the text of a granted patent (description, claims, drawings). (G 1/10)

01-10-2013