
Case Law of the Boards of Appeal of the European Patent Office

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the same, ie explicit or implicit disclosure, the board concluded that the findings of T 301/87 could be applied to the present situation. Thus the disclosure in the application as originally filed of the deposition of the recombinant bacteriophage Lgt11-P3 was not considered to be a basis within the requirements of Art. 123(2) EPC for the disclosure of a DNA sequence designated as "the P3 coding sequence" which was allegedly contained in that bacteriophage, but which as such was not disclosed in the application as originally filed.

In T 792/94 the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC), allowing scope for an interpretation which extended beyond the overall teaching of the initial application, the amendment contravened Art. 123(2) EPC.

Decisions T 673/89 and T 685/90 prohibited the later inclusion of **equivalents**. T 673/89 concerned a dual circuit braking system. The board held that the mere fact that the original claim did not indicate how the signals were transmitted in the brake circuits was not a basis for deliberately supplementing its teaching with a further embodiment not referred to in the application documents as originally filed. In T 685/90 the board stated that specific equivalents of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) EPC against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2) EPC. In T 265/88 the board refused to allow originally undisclosed equivalents to be added by using a wider technical term in place of the single technical means originally disclosed. T 118/88 had concluded that the obviousness of a feature was no replacement for the original disclosure.

In T 40/97 the board considered what the originally filed application taught the person skilled in the art and took the view that in a case where a number of generally similar embodiments were discussed in equivalent terms, the person skilled in the art would, in normal circumstances and when nothing pointed to the contrary, notionally associate the characteristics of an element of one embodiment described in some detail with the comparable element of another embodiment described in lesser detail.

In T 284/94 (OJ 1999, 464) the board stated that an amendment of a claim by the introduction of a technical feature taken in isolation from the description of a specific embodiment is not allowable under Art. 123(2) EPC if it is not clear beyond any doubt for a skilled reader from the application documents as filed that the subject-matter of the claim thus amended provides a complete solution to a technical problem unambiguously recognizable from the application. Nor is an amendment allowable under Art. 123(2) EPC which replaces a disclosed specific feature either by its function or by a more general term and thus incorporates undisclosed equivalents into the content of the application as filed.

In T 243/89 the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board of appeal saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Provided the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

III.A.1. Content of the application as originally filed

In T 157/90 and T 397/89 it was stressed that it was insufficient for the generalisation of a feature to have only formal support in the application as filed. If, for example, the application as filed only described specific embodiments, and the feature's general applicability was not evident to the skilled person, then generalisation could not be allowed.

In T 906/97 the board stated that an a posteriori demonstration that the original claims, considered in isolation from the rest of the application documents, could possibly be construed in such a way as to cover a specific type of apparatus failed to provide convincing evidence that such specific apparatus was actually disclosed to the skilled person.

In T 770/90 the board ruled that an unduly broad claim not supported by the description as originally filed was not a suitable "reservoir" for amendments. On the issue of Art. 123(2) EPC, the board stated in T 296/96 that the content of a document was not to be viewed as a reservoir from which features pertaining to separate embodiments could be combined in order to artificially create a particular embodiment. When assessing whether a feature had been disclosed in a document, the relevant question was whether a skilled person would seriously contemplate combining the different features cited in that document. That was not the case in the application as filed.

In T 54/82 (OJ 1983, 446) the board held that an objection under Art. 123(2) EPC did not necessarily arise when an amendment was proposed which involved combining separate features of the original subject-matter of an application. When considering whether different parts of the description in an application could properly be read together, the state of the art might also be taken into account.

Expanding on T 13/84 (OJ 1986, 253) it was stated in T 547/90 and T 530/90 that reformulating the technical problem was not in breach of Art. 123(2) EPC provided the problem as clarified and the solution proposed could have been deduced from the application as a whole in the form originally filed.

Decision T 784/89 (OJ 1992, 438) ruled on a computer-controlled method of producing NMR images disclosed explicitly in the documents as filed. By reference to another patent application an apparatus was implicitly disclosed comprising a programmable component which, when suitably programmed, was used for the claimed method. The board considered that only this specific combination had been disclosed. To claim an apparatus for carrying out a method was considered an inadmissible extension of the European patent application because the claim covered apparatus which could also be used in other methods and to achieve other effects. The only allowable claim was for an apparatus for carrying out a method comprising a programmable component which could be suitably programmed to carry out the method.

In T 526/92 the patent related to an additive concentrate having a high TBN of at least 235 for incorporation in a lubricating oil composition. The application as filed contained no explicit reference to TBN apart from the examples where 235 was the lowest value mentioned. The feature "having a high TBN of at least 235" was introduced during the examination proceedings to distinguish the claimed subject-matter from compositions with low TBN values up to 100 disclosed in a citation. The board revoked the patent on the grounds that it breached Art. 123(2) EPC, stating that the precondition of the disclaimer had not been met (see also G 1/03 concerning law applicable to disclaimers in Chapter III.A.1.6.3).

In this case, however, TBN values had not been originally disclosed as a "broad" range but only as single, punctate values; thus a new range was defined which had not been disclosed originally. Furthermore, the generic part of the original specification did not contain any information indicating that TBN played any role in the framework of the application in suit. This meant that there was also no information whatsoever concerning a TBN range, whether open-ended or not. Nor was there any information at all in the description regarding the contribution of a TBN to the solution of a technical problem. Moreover, it could not be concluded that the individual TBN values disclosed in the examples were representative of a TBN range starting at 235 and without any upper limit. The board held that there was a contravention of Art. 123(2) EPC where values of a parameter were given only in the examples, without the significance of this parameter becoming evident from the original specification, arbitrarily forming a range which was open-ended in one direction and had one limit selected from the examples in the other.

T 201/83 (OJ 1984, 481) and T 17/86 (OJ 1989, 297) started from the assumption that a limitation could also constitute an inadmissible extension of the subject-matter of the application. In T 201/83, however, the board came to the conclusion that the amendment of the concentration range for a component of a claimed alloy was allowable on the basis of a value described in a specific example since the skilled person could have readily recognised that this value was not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention to a significant degree. The new limit could therefore be deduced from the original documents. In T 17/86 the examining division took the view that, although the introduction into a claim of a particular technical feature constituted a limitation, it nevertheless contravened Art. 123(2) EPC since the feature concerned had been described in the application solely in association with another feature not included in the claim. The board, however, stated that the application as filed unmistakably showed that the combination of technical features in the new claim thus amended was sufficient to produce the result sought in the application.

In T 1067/97 the board confirmed that if a claim was to be restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. An amendment of this nature would only be justified in the absence of any clearly recognisable functional or structural relationship among said features.

In T 714/00 the board said that extracting an isolated feature from an originally disclosed combination and using it to delimit claimed subject-matter could only be allowable in connection with Art. 123(2) EPC if that feature was not inextricably linked with further features of that combination.

With regard to isolation and extraction of combined features, T 25/03 first recalled that according to the established case law of the boards of appeal, if a claim was restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. That kind of amendment would only be justified in the absence of any clearly recognisable functional or structural relationship among said features (see for example T 1067/97). In the case at issue the board concluded that since claim 1 resulted from the extraction of isolated steps from the specific combination disclosed as essential in the embodiment of Figure 4, and since the appellant had not referred to other parts of the application as filed that could support the proposed