

Avoiding Added Matter Pitfalls: Mastering Amendments Before the EPO

“Added matter” objections are a common and often frustrating hurdle in European patent prosecution. The European Patent Office (EPO) takes a particularly strict stance on claim amendments, especially when compared to more flexible jurisdictions like the United States Patent and Trademark Office (USPTO). To ensure procedural efficiency and help reduce prosecution costs, it is advised that non-European practitioners familiarise themselves with the EPO’s approach to added matter.

This article explores the intricacies of added matter objections before the EPO and offers practical advice to help ensure a smoother prosecution process.

What Is Added Matter?

According to Article 123(2) EPC a patent application or granted patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. This means that, following an amendment, the skilled person must not be presented with any new technical information that was not already present in the application as filed.

The term “application as filed” refers to the originally filed description, drawings, and claims (but not the abstract). Subject matter from another application that is incorporated by reference is only relevant in very limited circumstances. The “incorporation by reference” doctrine is not generally recognised at the EPO.

The rationale behind this provision is to protect legal certainty. Applicants should not be allowed to improve their legal position by introducing subject matter not originally

disclosed, as this could unfairly affect third parties who rely on the original content to assess potential infringement risks.

~~How Is It Assessed?~~

The EPO apply the “Gold Standard” test for assessing whether an amendment adds matter (as set out in decisions G 3/89 and G 2/10). The Gold Standard states that an amendment does not add matter beyond the contents of the application as filed if the skilled person, at the filing date, applying their common general knowledge, would ~~directly and unambiguously derive~~ the amendment from the application as filed. This effectively means that if the amended features are not disclosed verbatim in the specification, they must be clearly disclosed in some other manner.

Although added matter is assessed from the viewpoint of the skilled person using common general knowledge, this does not mean that a feature can be added to a claim if the skilled person knows the feature is common in the relevant field. In addition, if a feature is not implicitly or explicitly disclosed, the feature cannot be added to a claim if it is merely rendered obvious by the application’s disclosure. In other words, the common general knowledge cannot serve to enlarge or replace, in a subjective or artificial manner, the actual content of the original specification.

Instead, an added feature must be at least implicitly disclosed in the original specification (an implicit disclosure is that which the skilled person would consider is a clear and unambiguous consequence of what is explicitly mentioned in the specification).

~~How to Avoid Added Matter Objections~~

General

When filing amended claims, a marked-up version showing the changes should be submitted. In the accompanying submission letter, each amendment must be clearly explained, with precise references to the original application (e.g., specific paragraphs or line numbers). Ideally, relevant excerpts from the description should be quoted directly. It is noted that these rules should be followed whenever amendments are being filed, such as when filing a response to an office action, when filing amended claims for an ex-PCT application, when filing divisional claims, and when filing voluntary claim amendments.

If the amendment is not disclosed verbatim, the submission letter must explain why the skilled person would still directly and unambiguously derive the feature from the original application. Failure to adequately substantiate how the amendments comply with Article 123(2) EPC will usually lead to an objection, and in some cases, the EPO may even decline to conduct a search or continue examination on substantive grounds until a set of claims

complying with Article 123(2) EPC is filed.

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Intermediate Generalisations

An “unallowable intermediate generalisation” is a particular type of added matter objection where a claim is amended to include a particular feature, but fails to include one or more additional features that are disclosed in combination with that particular feature. As an example, if a claim includes features A and B, and the description describes an embodiment containing features A, B, C and D, it must be assessed whether the claim can be amended to include feature C, but not feature D.

To be allowable, the EPO applies a two-step test (see EPO Guidelines Part H – Chapter V-14, 3.2.1):

1. The added feature must not be inextricably linked to the omitted features (i.e., the omitted features must not be necessary for achieving the technical effect associated with the added feature); and
2. The overall disclosure must support the isolation of the added feature and its introduction into the claim.

To avoid an objection based on intermediate generalisation, the submission letter to the EPO should therefore explain why the amendment satisfies this test. Returning to the earlier example, an option would be to point to a part of the description that explains or implies that feature D is optional.

Deletion of Features

An added matter objection can also arise when a feature is removed from an originally filed claim on the ground that a new disclosure of the remaining features in combination without the omitted feature constitutes a new teaching not found in the original specification. To be allowable, the EPO applies a three-step test (as set out in decision T 331/87):

1. The removed feature must not be described as essential in the original disclosure;
2. The skilled person must directly and unambiguously recognise that the feature is not indispensable for the function of the invention in the light of the technical problem the invention serves to solve; and
3. The skilled person must recognise that the removal requires no modification of the other claim features to compensate for the change (it does not in itself alter the invention).

As with intermediate generalisations, the submission letter should clearly demonstrate

how these criteria are met.

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~~The “Inescapable Trap”~~

Under Article 123(3) EPC, a granted European patent cannot be amended in a way that the scope of protection is broadened. In conjunction with an added matter objection, this creates a potential “inescapable trap”: if a granted claim is found to contain added matter, but removing the objectionable feature would broaden the claim beyond what was granted, then the patent would be invalid in a manner that could not be cured by amendment (unless there happens to be an alternative amendment that does not involve added matter and is narrower in scope than the amendment held to add matter).

To avoid falling into this trap, it is crucial to assess every amendment for compliance with Article 123(2) before grant. Post-grant, the consequences of added matter are much more severe and may even be fatal to the patent.

The danger of an inescapable trap means that great care must be taken with regard to added matter during prosecution, even if the issue is not raised by the examiner. Moreover, even an amendment suggested by an examiner can be held to involve added matter after grant, so it should not be assumed that an examiner’s proposal actually complies with Article 123(2). Responsibility for the amendment always remains with the applicant, even when adopting a course suggested by the examiner.

Final Thoughts

When amending claims in Europe, practitioners must apply a far more rigorous approach than may be required in other jurisdictions, such as the US. Frequently it is found that amendments that are acceptable in the US are objected to in Europe.

In addition to the advice set out above, a patent application can be made more robust at the drafting stage. For example, the following points may be taken into account while drafting a patent application:

- **Optional Features:** If a feature is (or could be) optional, say so explicitly or describe alternative embodiments without it. This aids future amendments and helps avoid intermediate generalisation objections;
- **Broad Terminology:** Broadening away from specific language used in a specification can be difficult. Accordingly, when describing multiple specific embodiments, include broad language encompassing them. For example, if describing a temperature sensor, pressure sensor, and fluid flow sensor, also state that the device includes “one or more sensors” to preserve flexibility;
- **Finalised Claims:** Submit claims that are as complete and final as possible at the

outset. If there are several ways to phrase something, include all those options in the description. Avoid relying on prosecution to refine claim language, since post-filing amendments are subject to the EPO's strict added matter provisions.

By understanding and respecting the EPO's stringent approach to added matter, practitioners can better navigate prosecution, reduce costs, and ensure more robust European patents.