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Article 123(2) EPC, Recent Case Law and a Chessboard

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1. The basic principle

The Enlarged Board of Appeal of the EPO has elaborated on the fundamental concept behind Article 123(2) EPC² in decision G 1/93³. Stating that an applicant cannot add subject-matter not disclosed in the application to achieve an unfair advantage and jeopardize the legal security of third parties⁴. Decision G 1/93 deals, in particular, with the possible conflict between Article 123(2) and Article 123(3) EPC and has been viewed and commented on from different points of view⁵. However, the basic principle elaborated in G 1/93 must certainly be welcomed by anyone who has ever been in the situation of defending a third party against amended claims tailored to cover the third party's business; but evidently unsupported by the original application. There is good reason for provisions in the EPC to prevent an applicant from acquiring an unjustified legal position.

At the application stage, it is Article 123(2) EPC itself which safeguards the legal certainty of third parties. In opposition proceedings the requirement of Article 123(2) EPC is enshrined in Article 100(c) EPC; in limitation proceedings under Article 105b EPC it must be observed according to Rule 95(2) EPC. The standards for assessing whether an amendment finds basis in the underlying application are the same in all these cases. The same assessment standards must also be applied when a divisional application is examined for compliance with the requirements of Article 76(1) second sentence, first half sentence, EPC, as was explicitly confirmed in G 1/05⁶. Whilst there is no *ex officio* examination of compliance with Article 76(1) EPC in limitation proceedings, Article 100(c) EPC provides a basis for such an examination in opposition proceedings. Likewise, a fresh application filed in accordance with Article 61(1)(b) EPC must comply with the requirements of Article 76(1) EPC⁷, such that again no extension beyond the original disclosure is permissible. Once granted, a European patent may also be declared null when its subject-matter extends beyond the content of the application as filed, as stipulated in Article 138(1)(c) EPC.

In all proceedings and irrespective of the applicable provision in the law, it is therefore always the content of the first application filed with the office which is decisive for determining whether an amendment is supported by the original disclosure. The original disclosure is equally found in description, claims and drawings⁸, and it is well known that it only encompasses subject-matter which is disclosed "directly and unambiguously"⁹. Several tests have been developed in the case law to assess whether particular subject-matter after amendment is found in the original application in a direct and unambiguous manner.

2. The several tests

Following the elaborations in the case law book, three tests can be mentioned which are regularly applied by the EPO for testing whether an amendment is in conformity with the requirements set out in particularly Article 123(2) EPC. These three tests will now be briefly discussed.

2.1 Novelty test

The basic idea of the novelty test is that no subject-matter should be created by amendment which results in subject-matter which – compared to the application as filed – would be new¹⁰. Since the development of this test it has at first been considered particularly useful in the case law, even where amendments amounted to deletions¹¹. In the context of generalizations, compared to the original disclosure, a strict application of the novelty test has not been accepted. Instead, it was held that the test for additional subject-matter and the novelty test are only similar in that they both ultimately ask whether or not the tested subject-matter is directly and unambiguously derivable from the relevant source¹². Limits of the novelty test were also discussed in other decisions¹³, and the current version of the case law book even comes to the conclusion that the recent case law makes no reference to the novelty test anymore¹⁴.

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2 The wording of Article 123(2) EPC underwent a minor editorial change when the EPC2000 entered into force, i. e. formerly used indefinite articles were replaced by a definite article. It is not apparent that this change has any influence on procedural or material aspects of Article 123(2) EPC.

3 O.J. EPO 1994, 541

4 Id., point9 of the Reasons

5 See e.g. Wheeler, GRUR Int. 1998, 199, „Der „Konflikt“ zwischen Artikel 123(2) und (3) EPÜ“; Laddie, GRUR Int. 1998, 202, „Die unentrinnbare Falle Überlegungen aus dem Vereinigten Königreich“; Brinkhof, GRUR Int. 1998, 204, „Kollision zwischen Artikel 123(2) und (3) EPÜ“; Rogge, GRUR Int. 1998, 208, „Zur Kollision zwischen Artikel 123(2) und (3) EPÜ“; Pfeiffer, epi Information 1/2003, 21, „Zu EPÜ Art. 123(2) und (3)“

6 O.J. EPO 2008, 271, point5.1 of the Reasons

7 See Article 61(2) EPC

8 G 11/91, O.J. EPO 1993, 125, Headnote 1, and G 2/95, O.J. EPO 1996, 555, Headnote

9 A terminology used e.g. in the Headnotes of G 3/89 and G 11/91, O.J. EPO 1993, 117 and 125; see also Case Law of the Boards of Appeal of the European Patent Office, Sixth Edition, July 2010 (hereinafter abbreviated in the footnotes as „Case Law of the Boards of Appeal“, also referred to in this article as the „case law book“), Section III.A.7, 346

10 T 201/83, O.J. EPO 1984, 481, point 3 of the Reasons

11 T 136/88, point 4.1 of the Reasons

12 T 194/84, O.J. EPO 1990, 59, Headnote; confirmed in T 118/89, point 3.2 of the Reasons

13 E.g. T 133/85, O.J. EPO 1988, 441, point 5 of the Reasons; T 177/86, point 5 of the Reasons; T 150/07, point 1.1.4 of the Reasons

14 Case Law of the Boards of Appeal, Section III.A.7.3, 354

This conclusion, although found in some case law as well¹⁵, however appears to be at odds with the “exceptions” referred to in the very same paragraph in the case law book. The Guidelines still explicitly refer to the novelty test as the applicable test in the case of additions, namely in the paragraph which illustrates the field of application of Article 123(2) EPC¹⁶. This seems to be a clear indicator that this test is considered a useful tool at first instance. This view, expressed in the Guidelines, is further supported by quite recent case law; specifically by decision T 1374/07, which makes reference to T 201/83 and considers the novelty test applicable at least where the amendment is by way of addition¹⁷. This was also confirmed by the Enlarged Board of Appeal in decision G 2/10 that no amendment may create novel subject-matter¹⁸.

It can probably be said that the novelty test has limitations, but that it is still considered in the case law as a suitable method for determining whether or not amended subject-matter is sufficiently supported, i.e. directly and unambiguously disclosed in the original application. Decision T 60/03 puts it this way: “Whereas the “novelty test” may assist in determining the allowability of an amendment, it cannot override the basic criteria.”¹⁹ It is not the only tool for assessing support within the original disclosure, but one which can be, and in fact is, used where deemed applicable.

2.2 Essentiality test

Amendments are possible by way of addition, but also by way of deletion or replacement; which two cases should be distinguished²⁰. This is where the essentiality test may come into play. Essential means essential for the invention, and a feature fulfilling this criterion cannot be removed from an independent claim without contravening Article 123(2) EPC²¹. Following decision T 260/85, a stepwise test was developed in the case law for the assessment whether a deleted feature is essential²²; the test is sometimes also called the three-point test. The first point is whether the feature was not explained as essential in the original application. The second point is whether the feature is not indispensable for the function of the invention before the background of the solved technical problem. The final third point is whether the occurred replacement or removal requires no real modification of other features to compensate for the change. Only when all three points can be answered in the affirmative is essentiality denied and a replacement or removal of a particular feature may be allowable.

The three-point essentiality test is also referred to in the Guidelines²³ and has been applied in more recent

case law²⁴. It was even considered also suitable for the scenario in which a feature in a claim is generalized and the scenario in which a feature is isolated from an embodiment set out in a description²⁵. Evidently, the essentiality test is another tool for assessing compliance of amendments with Article 123(2) EPC.

2.3 Deducibility test

Contrary to the order in this article, the “deducibility test” is the first test which is discussed in the case law book in the section referring to tests for assessing the allowability of an amendment²⁶. The deducibility test thus seems to be given particular emphasis. A reason could be that one may see the deducibility test as an umbrella under which the novelty test and the essentiality test can be united. In fact, in T 514/88 the novelty test and the essentiality test were considered non-contradictory and pose the same question; namely whether there is consistency between the amendment and the original disclosure²⁷. In this context, it was also demanded by the Board of Appeal that the disclosure of the subject-matter, after amendment in the underlying application, fulfills the two almost notorious criteria, i.e. directness and unambiguously²⁸.

In the already mentioned decision G 2/10, the Enlarged Board of Appeal did not refer to a “deducibility test”, but called the relevant test the “disclosure test”²⁹. This test nevertheless seems to be one asking for a direct and unambiguous disclosure because in G 2/10 this principle, as laid down in G 3/89 and G 11/91, is referred to as the “‘gold’ standard”³⁰. The requirement that amended subject-matter must be directly (or clearly) and unambiguously disclosed in the originally filed documents also appears to be accepted as the decisive assessment standard by national courts of the EPC member states³¹.

Furthermore, for particular scenarios, it seems that additional (sub)criteria have been developed in the EPO’s case law. In case of a so-called intermediate generalization, for example, the features of the generalized embodiment must be “separable”³², and such a generalization must further be recognizable “without any

24 T 775/07, point 2.1 of the Reasons

25 T 404/03, point 10 of the Reasons

26 Case Law of the Boards of Appeal, Section III.A.7.1, 347ff; the term „deducibility test” is however only used in this article as an abbreviation for a „Direct and unambiguous deducibility of amendments from the application as filed”

27 T 514/88, O.J. EPO 1992, 570, point 2.4 of the Reasons

28 Id., point 2.7 of the Reasons

29 G 2/10, Loc. cit., point 4.5.1 of the Reasons

30 G 2/10, Loc. cit., point 4.3 of the Reasons

31 See e.g. the decision from the Court of Appeal of England and Wales, *European Central Bank v Document Security Systems Incorporated* [2008] EWCA Civ 192, and the decision from the German Federal Supreme Court, BGH GRUR 2010, 910, *Fälschungssicheres Dokument*, which in parallel cases come to the same conclusion as regards an unallowable extension beyond the original disclosure and which with respect to disclosure requirements refer to „clearly and unambiguously” and „unmittelbar und eindeutig”, respectively. The corresponding decision from the French Court of Appeal dated 17 March 2010, RG n° 08/09140, concludes that the skilled person was not enabled by the original application to deduce the claimed invention („...ne permettait a l’homme du métier de déduire...”). It is, however, interesting that the concerned patents were national parts of an EP patent which was granted after an application appeal procedure before the EPO.

32 T 461/05, point 2.6 of the Reasons („dissociables”)

15 T 150/07, point 1.1.4 of the Reasons

16 Guidelines for Examination in the European Patent Office, June 2012 (hereinafter abbreviated as „Guidelines”), H-IV, 2.2

17 T 1374/07, point 2.2 of the Reasons

18 G 2/10, O.J. EPO 2012, 376, point 4.6 of the Reasons with reference to G 2/98, O.J. EPO 2001, 413

19 T 60/03, point 2 of the Reasons

20 T 404/03, Catchword

21 T 260/85, O.J. EPO 1989, 105, Headnote 2

22 T 331/87, O.J. EPO 1991, 22, Headnote

23 Guidelines, H-V, 3.1

doubt³³ in order to be allowable under Article 123(2) EPC. It does therefore not come as a surprise that the Boards of Appeal typically apply Article 123(2) EPC in a restrictive manner when it comes to intermediate generalizations³⁴. But even restrictively applying Article 123(2) EPC can hardly mean limiting the original disclosure to what is explicitly disclosed, given that it is accepted in the case law that applications also may contain an implicit disclosure³⁵. Also, adding terms not originally disclosed is not automatically prohibited, and a pure semantic analysis of relevant passages of the original disclosure is not sufficient for assessing the allowability of amendments³⁶. Accordingly, the amended subject-matter need not necessarily be found in the original application in an explicit and furthermore literal manner, but still must be found therein in a direct and unambiguous manner; whatever that precisely means for the actually judged case.

In summary it can be said that there are currently three so-called “tests” for original disclosure, the comparably specific tests for novelty and essentiality, and the broader test for deducibility. All three tests are applied these days by the Boards of Appeal and the first instances, respectively, of the EPO for judging whether or not an amendment is in accordance with Article 123(2). It is not known to the author whether *Teschemacher* had these three tests in mind when referring to the three yardsticks applied within the EPO, the first being strict, the second stricter and the third brutal³⁷. When it comes to lists and fields of features, respectively, it seems that the applicant – and also the draftsman prior to the filing of the application – should be prepared for any of these approaches. A chessboard may serve as an example.

3. How to claim a chessboard

Obviously, a chessboard is not patentable. For the purpose of this article, it will only be an illustration of how information can be presented. Almost everyone knows that a chessboard has 64 squares, with eight lines typically denominated a to h and eight rows typically denominated 1 to 8, and also typically with a frame surrounding the 64 squares. This gives rise to at least three different kinds of representation of the information “chessboard”, and it is quite instructive to study what the consequences of these possible presentations are with a view to amendments. The study is made in reverse order and will assume that the most valuable part of the chessboard is the square “e4” so that even if prior art anticipates other parts of the chessboard, “e4” shall be covered by an amended claim.

33 T 962/98, Catchword

34 For a discussion of case law on intermediate generalisations, see Pentheroudakis, GRUR Int. 2008, 699, „Zulässigkeit von Änderungen der Patentansprüche nach Art. 123 (2) EPÜ im Hinblick auf die Problematik der sog. ‚Zwischenverallgemeinerung‘ (intermediate generalisation)“; see also Case Law of the Boards of Appeal, Section III.A.2

35 See e.g. T 1125/07, point 3.2 of the Reasons

36 T 1269/06, point 2 of the Reasons

37 *Teschemacher*, Mitteilungen der deutschen Patentanwälte, 2008, 289, 294, „Aktuelle Rechtsprechung der Beschwerdekammern des EPA – Notizen für die Praxis“

3.1 Representation by a frame

The first discussed disclosure of a chessboard is the aforementioned frame. It is not uncommon to use general terms in a patent specification for describing and summarizing technical aspects of the invention which is believed to have been made. So in order to cover the most valuable part “e4” without unduly limiting the claim from the outset, the frame surrounding the chessboard could be used as a characterizing feature. Such a characterization will however become problematic once prior art³⁸ is discovered which discloses a particular part of the framed area, say for example the square typically denominated “e7”. According to the general principle that a specific disclosure takes away the novelty of a generic claim embracing that disclosure³⁹, the frame would be anticipated by the prior art disclosure of “e7”. At this point, an amendment of the claim using the frame as a definition is required to restore novelty.

One possibility for doing so could possibly be removing the anticipating prior art element from the subject-matter defined by the frame, namely by disclaiming that element. The valuable “e4” would then still be covered. However, in this scenario the only representation of subject-matter is the frame itself, nothing else. There is accordingly no reference to a disclaimer by which “e7” may be removed from the framed area, so that any used disclaimer would be a so called undisclosed disclaimer. As is well-known, unless particular conditions are fulfilled which are not of interest for the discussion herein, the disclaimer solution is thus not allowable in the present scenario⁴⁰. Different ways out of the anticipation are not available because the original disclosure contains no other definitions or levels of generalisation apart from the frame. Especially, “e4” is not mentioned individually. Then, irrespective of the applied test for assessing the amendment, claiming the “chessboard minus e7” or the more limited “e4” will fail for non-compliance with Article 123(2) EPC.

In this scenario, no subject-matter is patentable anymore due to the limited original disclosure. Of course, this situation is the reason for drafting applications such that there are fall-back positions in case unexpected and novelty-destroying prior art must be dealt with. One possibility for such fall-back positions is to provide lists of features which are more specific compared to the general term covering them.

3.2 Representation by lists

Chess notation uses the eight rows and eight lines making up the chessboard. In fact, this has already been done above when referring to “e4” or “e7”. There are lines a to h and rows 1 to 8. This makes it possible to unambiguously identify “e4”. But really unambiguously? Following the logic of T 181/82⁴¹, according to which the definition of a C1 to C4 alkyl bromide does not

38 In the sense of Article 54(2) EPC

39 See e.g. Guidelines, G-VI, 5

40 G 1/03, O.J.EPO 2004, 413, and G 2/03, O.J. EPO 2004, 448

41 O.J. EPO 1984, 401

represent a listing of each of the chemically possible eight alkyl bromides, the disclosure "a to h" probably discloses "a"⁴², but not necessarily "e". In order to be on the safe side in this respect, it would be required to define lines a, b, c, d, e, f, g and h in combination with rows 1, 2, 3, 4, 5, 6, 7 and 8. Again, it shall be assumed that prior art unfortunately discloses "e7", so that amendments are required to obtain protection for "chessboard minus e7", or at least for the valuable "e4". The less ambiguous aim, i. e. protection for "e4", is analysed first.

In the scenario discussed here, the definition of the chessboard is realized using two indices, one number and one character, i. e. by two lists of indices. Now the alarm bells are ringing. Whilst a chess player, who is a skilled person when it comes to chessboards, would certainly have no problems to make the correct move when instructed to move a piece to e4, according to EPO case law a simultaneous selection from two lists typically creates novel subject-matter⁴³. The natural question is whether this principle is also applicable when it comes to amendments. According to e.g. decisions T 727/00 and T 686/99 it in fact does, because a multiple selection within two lists of alternative features is considered to generate a fresh particular selection⁴⁴. The novelty test is applied and the fresh particular selection is therefore something which goes beyond the original disclosure.

According to the basic decision T 12/81, one requirement for creating new subject-matter by selection of elements from two lists is that those lists must each be a "list of certain length"⁴⁵. In decision T 727/00 referred to above, the first list had six members and the second list twenty-three members, which in the Board's opinion was sufficient for satisfying the required certain length. Would this also hold true for the chessboard, for the two lists with eight elements each defining the chessboard by means of indices? At first sight, it appears that the case law is not unambiguous in this respect.

In the already mentioned decision T 1374/07, it was held that a twofold selection from the same list of eight members is in fact nothing else but a selection from two identical lists of eight members⁴⁶. Applying the quite lively novelty test, the Board then identified an extension beyond the original disclosure. The difference of the decided case to the chessboard example is merely that the lists defining the latter are not identical, but in substance this difference changes nothing. A field of eight times eight members is basically created in both cases⁴⁷, and according to the cited case law, an amended claim directed to claim "e4" would evidently be considered contravening Article 123(2) EPC.

42 In T 181/82, the C1 alkyl bromide, methyl bromide, was considered disclosed.

43 T12/81, O.J. EPO 1984, 401; see also Case Law of the Boards of Appeal, Section I.C.4.1.1b), and the reference to the "two-lists principle" in the Guidelines, G-VI, 8(i)

44 T 727/00, point 1.1.4 of the Reasons; T 686/99, point 4.3.3 of the Reasons

45 T 12/81, Loc. cit., point 13 of the Reasons („Auflistung gewissen Umfangs")

46 T 1374/07, point 2.2 of the Reasons

47 Provided the same member could be selected twice from the list disclosed in the case underlying T 1374/07.

However, there is different case law which seems to indicate that selections from lists are not necessarily in conflict with the original disclosure. According to decision T 607/05, two lower limits of an array were combinable in a claim in agreement with Article 123(2) EPC⁴⁸. When the underlying application is inspected, it would be difficult not to identify two lists from which those parameters were selected, although both lists are found in the same sentence. In effect, a twofold selection from a first list of five explicit numbers and a second, different list of again five explicit elements had been made. The created field of twenty-five elements is apparently smaller than the chessboard, so that the shorter the lists, and hence the smaller the generated fields become, the better the chances for compliance with the requirements of Article 123(2) EPC might be. This is, however, not predictable. A selection from an even smaller field of twenty-four elements, generated by a list of eight members and a list of three members, respectively, was held to be in contravention to Article 123(2) EPC in decision T 137/04⁴⁹.

It could therefore be asked what is the lowest limit of elements in a list such that the list still has a "certain length" in the sense of the above cited case law. A first hint is already found in decision T 7/86, which with respect to lists only deals with novelty issues, but which is cited in decision T 1374/07 as support for the view on selections from two lists in the context of inadmissible extensions beyond the original disclosure. The document relevant for judging a disclosure arising from two lists, in case T 7/86, contained two lists for two substituents on a chemical entity, one list having five members and one list having only two members. Despite these relatively short lists and the just ten possible combinations derivable from the two lists, the Board in T 7/86 with explicit reference to T 12/81 came to the conclusion that the two lists did not result in a disclosure of all individual compounds.

It must thus be expected that a selection from two very short lists can still result in the creation of something novel, i. e. of something not originally disclosed. This expectation is fully met by the quite recent decision T 1710/09⁵⁰ in which the concept of non-disclosure due to selection from two lists seems to have reached its climax. In the underlying case, one examined claim was written in the Swiss-type claim format and defined an administration of a specific medicament in tablet form which had a particular dosing strength. An example was cited in support of the given definition which in a first suggested treatment referred to the claimed dosing strength and the possibility to administer the medicament in the form of tablets or liquid formulations. A second suggested treatment for a different purpose in the same example referred to a dosing strength not claimed, and again mentioned the possibilities of tablets or liquid formulations as dosage forms. The Board took the

48 T 607/05, point 10 of the Reasons

49 T 137/04, point 3.1 of the Reasons

50 A petition for review of T 1710/09 had been filed pursuant to Article 112a EPC (case number R 16/11), but was rejected as clearly unallowable.

example into account and identified two alternatives for the dosing strength and two alternatives for the dosage form⁵¹. Another variable mentioned in this context in the decision, namely the dosing interval⁵², is factually irrelevant because that variable was fixed in the example in the original disclosure to a once-daily dosing regimen. It seems to follow that compared to the explicit example in the underlying application, two lists with two members each were identified. The combination of one member of the first list with one member from the second list was found to go beyond the original disclosure. In some decisions of the EPO's case law, the minimum number of elements for a list of "certain length"⁵³ is thus apparently defined, it is two.

When the same assessment standards as in the just discussed ruling are applied, it seems that "e4" could never be claimed on the basis of the definition by lines a, b, c, etc. and rows 1, 2, 3, etc., respectively, without contravening the requirements of Article 123(2) EPC. In such a scenario, the novelty test is applicable in order to solidify the deducibility test. No matter how many elements are contained in the originally disclosed lists, any selection from the lists including e.g. "e4" would most likely fail the test.

The fact that "e4" thus cannot be claimed without violating Article 123(2) EPC under the current practice of at least some Boards of Appeal also answers the question whether one would be able to obtain the "chessboard minus e7". In order to cover all sixty-three remaining couples of lines and rows, sixty-three times a twofold selection from two lists would have to be made, thereby sixty-three times going beyond the original disclosure⁵⁴. Instead of presenting features in lists, it is of course also possible to originally disclose in a very specific manner all conceivable elements and feature combinations. Presenting features in an enumerative manner will therefore be discussed next.

3.3 Representation by enumeration

In this scenario, the original disclosure shall explicitly refer to each of the sixty-four squares of the chessboard. This can be done by using the indices of the two lists referred to above, i.e. by writing down each and every combination, namely a1, a2, a3, etc. up to h8. The situation shall be the same as in the above scenarios, "e7" is known and "e4" of certain value.

The first aim is trying to achieve protection for the "chessboard minus e7". Due to the nature of the original disclosure in this scenario, "e7" is part of that disclosure, i.e. part of a list enumerating sixty-four separate elements. It could be opined that there can be no objection when deleting "e7" as one element from a long list of elements, that is, when making a one-di-

mensional restriction, as it seems to be the view in some case law⁵⁵.

However, it is somewhat questionable whether this approach is still true and can be maintained in the light of more recent case law from the Enlarged Board of Appeal. In the author's view, there is no logic or material difference between actually deleting "e7" from a list of 64 elements on the one hand and defining at the end of the list that "e7" is excluded, i.e. disclaiming it. The final list does either not contain the element in question or it is unequivocally defined that the element in question is disclaimed. The message to any third party is the same: "e7" is not part of the claim.

Provided it is correct that a deletion of one element from a list is equal to a statement that a particular element is not part of the list and thereby equal to a disclaimer, what is actually done by deleting an element is disclaiming this originally disclosed element without mentioning the disclaimer in the claim. In decision G 2/10, it was ruled that disclaiming originally disclosed subject-matter is only admissible if the remaining subject-matter passes the deducibility test, i.e. that it is directly and unambiguously disclosed to the skilled person in the application as filed⁵⁶. Whether the Enlarged Board of Appeal's instructions in this respect, namely that the deducibility test in such a case requires a technical assessment of the overall technical circumstances of that individual case⁵⁷, will be of much help in the future is yet to be seen. It can however not be ruled out that without a specific mention of the remaining sub list, disclaiming one element from a certain list might not be allowable in light of G 2/10. Nothing else should then apply to deletions. This is because deletions are hardly something other than disclaimers, removing disclosed subject-matter, which disclaimers are simply unmentioned in the amended claim.

For the chessboard example, this would require that after deleting/disclaiming "e7", the conglomerate of the remaining sixty-three elements needs to be deducible from the original disclosure. The direct and unambiguous disclosure of the group of sixty-three elements does not necessarily need to be explicit, but may also be implicit, and the skilled person as the addressee of the original disclosure must take common general knowledge into account when assessing the deducibility⁵⁸. However, relying on an implicit disclosure is more dangerous as an implicit disclosure can usually be more easily denied than an explicit disclosure. Thus, in order to try to safeguard an original disclosure of the subgroup of sixty-three elements right from the beginning, there is probably no other way but explicitly mentioning it in the specification. A problem is that it is typically unknown in advance which subgroup of sixty-three elements should be disclosed to the skilled reader in a direct and unambiguous manner as a security measure should one of the

51 T 1710/09, point 3.3b) of the Reasons

52 T 1710/09, point 3.3c) of the Reasons

53 Or of „some length“, as it is stated in T 1710/09 at point 4.3 of the Reasons with reference to T 12/81

54 Deletion of especially row „7“ might help to restore novelty over the disclosure of „e7“ and keep „e4“. The deletion of features – in the chosen picture of „squares“ – from the original disclosure is discussed in section 3.3, and the principles of deleting „squares“ and „rows“, respectively, should be the same.

55 See e.g. T 978/99, point 4.1 of the Reasons; similarly in T 633/09, point 3.3.3(a) of the Reasons

56 G 2/10, Loc. cit., Headnote 1a

57 G 2/10, Loc. cit., Headnote 1b

58 G 2/10, Loc. cit., Headnote 1a

squares of the chessboard already be known from the prior art. The draftsman is thus left with only one choice, and that is disclosing all sixty-four possible subgroups of sixty-three squares. Should the applicant be afraid of prior art anticipating two squares, all possible subgroups with sixty-two elements each should also be explicitly disclosed – and so forth for all conceivable permutations.

For a moment, it is sufficient to look at the subgroups each containing sixty-three elements. Logically, there are sixty-four such subgroups which will necessarily be presented as alternatives in the original disclosure. In sixty-three of the subgroups, the valuable element “e4” will be present. Accordingly, those groups will typically be attributed the same weight in the original disclosure. When facing anticipation by “e7”, it would however be required to extract the particular subgroup without “e7”, i.e. to select one subgroup from a number of subgroups which are all of equal weight. This is unfortunate because where alternatives are of equal weight and no preference is attributed to them, a singling out thereof appears to be inadmissible⁵⁹. That is, even the cumbersome exercise of writing down each and every conceivable permutation might not help if no preference of the one or the other permutation is clearly indicated. The reason is that according to decision T 1710/09, an alternative can be admissibly extracted from the original disclosure only provided this alternative is given a particular weight in the specification⁶⁰. Although the cited decision assesses a combination of features in this context, it could indeed be understood to prohibit the selection of one element out of a series of elements of equal weight even where no second selection is made. One relevant passage of the decision reads as follows:

“In all cases, the alternatives are of equal weight, no preference is indicated by specific words or in any other directly recognisable way and their singling out for reasons of original disclosure is not allowed.”⁶¹

Is this a kind of “singling-out test” or which kind of test is applied? In fact, explicit reference to decision T 12/81 is found in T 1710/09⁶², so that the novelty test seems to be used by the Board in the latter decision. However, subject-matter which is not novel in the sense of Article 54 EPC (because a skilled addressee would seriously contemplate applying the technical teachings of a relevant prior art document in the range of overlap⁶³), can apparently still be novel according to the novelty test used in the mentioned decision for assessing the allowability of amendments. This is because at least according to decision T 1710/09, when it comes to amendments there shall be no room for asking what the skilled person would seriously contemplate⁶⁴. The novelty test in the context of amendments therefore seems to be very strict, probably even stricter than the novelty test in the context of novelty itself. With the

approach adopted in T 1710/09, it cannot be ruled out that selecting one element from a single list of elements of equal weight is not permissible and creates an unallowable extension.

Such an approach might in fact be in line with G 2/10. Selecting one element out of a series of elements of equal weight cannot reasonably be seen to be different from deleting all other elements from the original series. As argued above, this factually means that all other originally disclosed elements of the series are disclaimed, so that the remaining element would have to be directly and unambiguously disclosed to the skilled person in the application as filed. Without a particular weight being attributed to the selected/remaining element, a direct and unambiguous disclosure of that element as an individual may be questionable. For example, an original disclosure may refer to alternative chemical compounds for a certain purpose. If later one of these compounds is chosen, this might lead to a forbidden singling out of one compound. Such a singling out is used in G 2/10 to illustrate which standards must be applied when testing a disclaimer disclaiming positively disclosed subject-matter for conformity with the original disclosure⁶⁵.

Alternatively, such a singling out can be also seen as a one dimensional shrinking of the original list to one element. When read together, decisions G 2/10 and T 1710/09 might thus suggest that a one-dimensional restriction of a list of elements is impermissible unless the remaining element(s) is/are given a particular preference in the original application. With such a conclusion and when “e7” is known in the present scenario, even disclosing all possible subgroups of sixty-three squares including “e4” as equally suitable alternatives should consequently be insufficient to obtain protection for “chessboard minus e7”. This amended subject-matter is then not validly claimable anymore.

For the far more limited subject-matter “e4”, the situation is probably more comfortable. In this scenario, “e4” is explicitly disclosed and – given its value – it is reasonable to assume that it is provided with some particular weight in the specification, in other words it is given a certain priority among the sixty-four disclosed squares. Then, irrespective whether it is “selected” from the one-dimensional list of sixty-four elements or whether all elements apart from “e4” are “deleted” from the list, “e4” is directly and unambiguously disclosed, even in the sense of G 2/10 and T 1710/09, respectively. In the scenario discussed here it should hence be possible to draft a claim directed to “e4” in compliance with Article 123(2) EPC. Contrary to the representation by a frame or the representation by lists, respectively, at least the most valuable element of the invention can be saved despite the partly anticipating prior art. The reason is that the disclosure of the invention in the original application is divided into small sections with particular weight being placed on the most relevant section. This leads to a comparison of the

59 T 1710/09, point 3.5.2 of the Reasons

60 T 1710/09, point 4.2 of the Reasons

61 T 1710/09, point 3.5.2 of the Reasons

62 T 1710/09, point 4.3 of the Reasons

63 T 26/85, O.J. EPO 1990, 22, Headnote I

64 T 1710/09, point 4.1 of the Reasons

65 G 2/10, Loc.cit., point 4.5.4 of the Reasons

discussed types of original disclosure as to allowable amendments and the resulting subject-matter.

3.4 Comparison of the discussed types of representation

When studying the second discussed type of representation, the representation by lists, it is seen that in principle this type of representation is well known as illustrated by the indices regularly found on a chess-board. In patent drafting, lists have traditionally been used quite frequently. However, an unintentionally overbroad disclosure using lists, which is in part anticipated by prior art, may result in a completely unpatentable application. Neither the original disclosure minus the prior art disclosure nor the unambiguously novel and most valuable part of the made invention may ultimately be claimable any more under the provisions of Article 123(2) EPC.

The two other discussed types of representing features, i.e. the frame and the permutations, are almost contrary to each other. The inventive concept is in both cases initially believed to be quite broad, and protection for the entire concept is sought. However, when a frame is chosen for the representation, this means all or nothing. If no prior art within the frame comes up, the entire frame may be patentable. With prior art falling into the frame, no limitations by way of amendment are possible and nothing will be patented. On the other hand, the very detailed disclosure of all possible features and permutations can also win the total protection if there is no novelty-destroying prior art. In case a partial anticipation occurs, it could happen that the claimable aspect of the invention must be limited down to very specific and hence very limited subject-matter.

4. Conclusions and suggestions

Drafting a fresh application is an interesting, yet definitively not simple exercise in view of the requirements for an original disclosure should amendments become required at a later stage due to conflicting prior art. For a patent attorney, there is a natural duty to define a new invention in rather broad terms so as to develop an intellectual property right which is of real value for the client. However, with broad terms, there is always the risk that a single anticipation sinks the entire vessel. This

is the situation illustrated by the frame of the chess-board.

It is therefore usually tried to split up a broad term into smaller elements. Already for a two-dimensional definition, it appears not advisable to group such elements in lists, because combinations of elements from lists are immediately suspicious of creating something new and therefore not originally disclosed. The fictitious skilled person is not a chess player; in EPO case law rows and lines are not sufficient to define a square.

The discussed recent case law may further suggest that enumerating permutations detailing a broader term, i.e. enumerating explicitly disclosed combinations of elements, is also of limited use. For the chessboard, this means that explicitly naming all squares as well as all conceivable sub-groups of squares is not necessarily a way out in case one square belongs to the prior art. When no preference is attributable to a specific subgroup of such enumerated permutations or squares, or to a single permutation or square, even a one-dimensional shrinking of the original disclosure could possibly violate the provisions of the EPC which govern amendments. This is a conclusion which may be drawn from G 2/10 and further case law. From the applicant's perspective, such a conclusion is certainly unpleasant.

As aforesaid, sometimes people identify three approaches applied by the EPO for assessing amendments, the strict, the stricter and the brutal. At present, there seems to be a tendency in the Boards of Appeal's case law to confirm this *bon mot*. Of course, there can be no doubt that third parties' interests must be safeguarded, and Article 123(2) EPC and the equivalent provisions prohibit a misuse of the applicant's freedom to draft and amend patent claims. The other side of the coin is a danger of an undue restriction of the very same freedom enjoyed by the basic users of the EPC system, applicants and patentees. The author concurs with the viewpoint that Article 123(2) EPC not only defines a prohibition, but should also be understood as an offer to utilize and exploit the original disclosure in order to achieve the deserved protection for the entire patentable subject-matter of the original application⁶⁶. Whichever test for assessing whether or not amendments are supported by the original disclosure is used, balancing of all relevant interests, including those of applicants and patent proprietors, must not be underestimated.

⁶⁶ Blumer in: Singer, Stauder, *Europäisches Patentübereinkommen*, Art. 123, marginal no. 32, with reference to Kraßer, GRUR Int. 1992, 699,702, and to Zeiler, *Mitteilungen der deutschen Patentanwälte*, 1993, 353