

European Patent Applications and European Patent Amendments - the EPO Approach to Added Subject Matter - the Golden Rule

This article takes a look at certain challenges which have to be taken into account while submitting amendment(s) in European patent application or European patent, including:

- the EPO “Gold Standard” for assessing amendments.
- reliance on the existing invention disclosure; and
- unwarranted advantage.

Added Matter

The European Patent Office (EPO) have long taken a relatively strict view on amendments to European patent applications after filing. It is not permitted to add information to a patent application after filing. Under Article 123 EPC:

“(1) The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given at least one opportunity to amend the application of his own volition.

(2) The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

(3) The European patent may not be amended in such a way as to extend the protection it confers.”

A situation where an applicant needs to make amendments in either a European patent application or a European patent may occur at any stage of the proceedings before the EPO either before or after grant. During the application phase, the applicant shall be given at least one opportunity to amend the application of his own volition. However, proposed amendments by the applicant are not always eligible, due to the Art 123 EPC rule against adding matter to the European patent application.

Adding new matter could occur in different ways, including adding a feature itself, or removing or replacing a feature from a claim. Whatever the reason for the amendment, whether establishing novelty over the prior art or simply aiming to eliminate inconsistencies and unclear features during examination, it always leads in the end to either limiting or broadening the scope of protection. In any case, the amendment must not cause the information contained in the document to be extended beyond the original disclosure of an invention.

The term 'Gold Standard' for assessing compliance with Art. 123(2) EPC was coined (introduced) in EPO decision G 2/10, OJ 2012, 376 at the time of the 11th edition of the EPC. It stated that (1) any amendment to the parts of a European patent application or of a European patent, irrespective of the context of the amendment made, can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing and (2) any amendment to the parts of a European patent application or of a European patent that extends beyond the content of the application as filed is subject to the mandatory prohibition. As it can be seen, the Gold Standard is tightly bounded with the terms of 'skilled person' and 'common general knowledge'. These terms can be explained as follows:

Common general knowledge can come from various sources and does not necessarily depend on the publication of a specific document on a specific date, as it is laid down in the Guidelines for Examination in the EPO, Section G-VII, 3.1. An assertion that something is common general knowledge need only be backed by documentary evidence (e.g. a textbook) if the knowledge is contested.

EPC Guidelines, Chapter VII, (3), defines a "person skilled in the art" as a skilled practitioner in the relevant field of technology who possesses average knowledge and ability and is aware of what was common general knowledge in the art is at the relevant date. Further, when seeking a solution to a problem, experts may treat a person from another technical field, where a solution to the problem is already disclosed, to be a skilled person. Flexibility in defining a technical field leads to flexibility in defining a skilled person and constitutes another level of complication.

The terms of a skilled person and a common general knowledge are subject to interpretation during examination or proceedings, since an expert and an inventor have different attitudes towards understanding those terms. The EPC legislation doesn't provide clear guidance on how to interpret the terms '*average knowledge*' and '*average ability*' of a skilled person. EPC Guidelines, Chapter VII, (3), state that the skilled person is presumed to have had access to everything in the "state of the art" and, as it can be seen in Case Law of the Boards of Appeal, 10th edition, Chapter II, E, (1.3.2), the standpoint of the skilled person should be interpreted as a technician working in the field, whose emphasis is given to the literal content of the original application rather than the technical information that it conveys. The question is whether being a carrier of '*average knowledge*' with '*average abilities*' is equivalent to warrantable operating (or being able to operate, at least) with a certain piece of information in a

wanted (by an expert) way as default due to 'having access to everything in the 'state of the art'.

In the light of the above, when submitting amendment(s), as a precaution it is useful to consider the applicant as a skilled person in the expert's understanding. It is also important to provide at the stage of drafting the patent application, a good written basis to derive potential future amendment features directly and unambiguously from the application as filed.

Sufficiency of Disclosure

Moving on to the options for amendment of the original, already existing invention disclosure as filed. As it is laid down in Art.83 EPC, the European Patent Application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The description claim(s) and drawing(s) present in the application determine the sources where the claimed subject-matter is disclosed. Any claim amendment to the application or granted patent should be based on the content of the application as filed, and it shall also be incorporated into the single general inventive concept.

Not only completeness but also cross-referencing of existing features with potentially new ones in the claim must be present in the original disclosure. As it can be seen from decision T 676/90, the content of an application is defined, not only by features mentioned or shown therein, but also by their relationship to each other. For example, a figure could never be interpreted in isolation from the overall content of the application but only in the general context.

A good example of an insufficient manner of disclosure of the invention can be derived from T 1164/11, where the applicant managed to overcome the objection of a lack of scientific explanation by stating a "surprising effect" of the claimed device "without

knowing the real phenomena occurring". The Board accepted that it might not be possible to provide a scientifically sound explanation and that the invention might still be sufficiently disclosed if such an unexpected effect was convincingly demonstrated. However, the original application was devoid of any test results or experimental evidence that could give an indication of the claimed result.

As it is summarised in Case Law of the Boards of Appeal, 10th edition, Chapter II, C, (9.2), when the patent does not give any information as to how a feature of the invention can be put into practice, there exists only a weak presumption that the invention is sufficiently disclosed. Serious doubts whether the skilled person can carry out the invention as claimed, e.g. in the form of comprehensible and plausible arguments, are sufficient. Since the feature in question having the meaning intended by the applicant cannot be found in textbooks and does not represent common general knowledge, the burden of proof for establishing sufficiency is clearly on the applicant/patentee, who has to operate while reasoning within the entirety of the earlier application as filed.

If an applicant wishes to keep some details of know how hidden in order to prevent the invention from being copied, especially when a person skilled in the art cannot find the missing information in the common general knowledge, this may lead to insufficient disclosure of the invention itself in the application as filed and decrease chances of making amendments after filing.

Unwarranted Advantage

Another concern related to adding new subject-matter is the issue of unwarranted advantage, introduced in decision G 1/93, which prevents an applicant from getting an unwarranted advantage by obtaining patent protection for something he had not properly disclosed and maybe not even invented on the date of filing of the application.

Although an added feature may limit the scope of protection conferred by the patent, if it provided a technical contribution to the subject-matter of the claimed invention, it would give an unwarranted advantage to the patentee and could be damaging to the legal security of third parties relying on the content of the original application.

Thus, for example, adding new matter in respect of ranges in the claim(s) is considered to provide unwarranted advantage as any amendment to the ranges must have the effect of modifying the claimed subject-matter, and thus also provided a technical contribution. If a newly claimed limited range was allowed (even though unsupported), any subsequent selection invention based on the new range would have to be refused as not being novel, which would otherwise not necessarily be the case (see T 592/99).

Introducing a disclaimer in a claim may also be a problem, as by restricting the claimed subject-matter to a group of certain compositions/devices having specific technical characteristics and properties gives an applicant an unwarranted advantage (see T 287/14). Allowing various restrictions to be filed initially in a broad speculative claim is considered to be unfair to third parties. It would give an applicant an unwarranted advantage over other applicants who were the first to attribute any significance to a specific combination of parameters and their ranges of values encompassed by such a broad original claim (T 389/13). Selections from lists of converging and non-converging alternatives are not treated in the same way. In the case of non-converging alternatives, selecting specific elements from such lists led to a singling out of an invention from among several distinct alternatives, which might provide an unwarranted advantage. On the other hand, due to fully encompassing each of the narrower elements from a list of converging alternatives by all the preceding less preferred options, amending a claim by selecting one element from a list of converging alternatives does not lead to a singling out of an invention from among a plurality of

distinct options, but simply to a subject-matter based on a more or less restricted version of the feature (T 615/95 and G1/93).

Generally, if a claim includes contradictory features, this contradiction cannot be resolved by merely disregarding the technically inaccurate feature and considering only the convenient technically meaningful feature. Any other approach would provide an unwarranted advantage to the applicant/patentee (see T 190/99) and the slightest doubt that the unamended patent could be construed differently to the patent as amended would preclude the allowability of the amendment (see T 307/05).

Summary

In this article, we started with three challenges and arrived at an extended list of issues which arise during amendment.

- Unavoidably subjective interpretation of the terms 'skilled person', 'common general knowledge', 'average knowledge of a skilled person', 'average ability of a skilled person', and what should be considered as a standpoint for each of these terms.
- Solid basis for new matter to be added must exist in the application as filed. Such basis must be, not only sufficiently clear and complete from the document as originally filed, but also refer to existing features and contribute in general to the inventive concept. The scope of such solid basis must provide compliance with the unity of invention requirement.
- Amendments like ranges in claims, disclaimers, various restrictions, selections from lists of converging and non-converging alternatives, contradictory features and, finally, the slightest doubt that the unamended patent could be construed differently to the patent as amended may result in the applicant obtaining an unwarranted advantage, which is not allowable.

This article is intended to make applicants aware of the limitations of amending a European patent application during European patent examination, and after grant, and to assure you that, with our appropriate support, any such amendments can be kept within the **Golden Rule** prohibiting added matter.

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