

"Containing" does not automatically disclose "Consisting of" - German Federal Court of Justice Tightens Requirements for an Amendment to be Allowable under Art. 123(2) EPC

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Thorsten Bausch (Hoffmann Eitle)

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The German Federal Court of Justice (FCJ) issued a nullity appeal judgment on 12 July 2011 in which the requirements for an amendment to be held allowable under Art. 123(2) EPC and Sec. 38 German Patent Act seem to have been further tightened as opposed to the previous practice. The decision (case number X ZR 75/08, decision keyword "Reifenabdichtmittel") is available in German via the FCJ's web server www.bundesgerichtshof.de.

The case in question relates to European patent EP 0 753 420, which is directed at a preparation for sealing tyres ("Reifenabdichtmittel" in German). This patent was invalidated by the Federal Patent Court in the first instance for lack of inventive step. The FCJ confirmed this decision and dismissed the appeal. The main request was dismissed for lack of inventive step for case-specific reasons. Of particular interest, however, is the Federal Court of Justice's finding on the first auxiliary request, which was rejected as contravening Art. 123(2) EPC.

To briefly summarize the facts of the case, the patent as granted relates to a preparation for sealing tyres, which was characterized in that the preparation contains a natural rubber latex and an adhesive resin compatible with the rubber latex. In contrast, Patentee's first auxiliary request was directed at the use of an agent for sealing tyres, wherein the agent consists of a rubber latex, a pH regulator, an adhesive resin compatible with the rubber latex, a freeze-protection agent and optionally a dispersing agent, wherein the rubber latex consists essentially only of a natural rubber latex.

The FCJ seemed to have no problem with the change in claim category and with the amendment that the rubber latex is essentially a natural rubber latex, both of which had a basis in the application as filed. But it took exception to Patentee's attempt to limit the claimed composition to one that exclusively consisted of the above-mentioned components. It was not in dispute that there was no general basis in the application as filed for a composition that only consisted of these components and that the application as filed explicitly taught that the addition of a filler, preferably fibrous components, may be advantageous to seal larger leaks. To support his point, patentee pointed to a working example disclosing a composition that only consisted of these components. That did not convince the FCJ, however, who did not read this example as excluding further components such as fibrous materials that were even described as preferred in the application as filed. The FCJ stated that there is no hint anywhere in the entire application as filed that such an exclusive composition of the sealing agent containing, above all, no fillers has any particular technical advantages or is otherwise desirable and hence is considered as belonging to the invention.

Even though it is, strictly speaking, not part of the decision, the FCJ published the following official headnote in connection with this case:

"If it can be taken from the application as filed that a product should "contain" certain components, this does not automatically disclose as belonging to the invention the fact that no further components may be added thereto. In order to disclose that it belongs to the invention that the product exclusively "consists" of the named components, additional indications in the application as filed are required as a rule, such as an indication that it has particular advantages or is otherwise desired that the product exclusively consists of the named components."

The FCJ did not relate its decision to the most recent case law of the EPO (T 2017/07, T 1063/07; see however also T 997/06 and T 457/98 for the opposite opinion), but the most recent series of its decisions (Olanzapin, Fälschungssicheres Dokument, Einkaufswagen II, Hubgliedertor II) leaves little, if any, doubt that the FCJ has now definitely taken the EPO's relatively narrow concept of disclosure to heart and made it its own. It even appears that the specific German wording that the amended feature must be disclosed as "belonging to the invention" in the application as filed may imply an additional requirement beyond its mere disclosure in the original application. A merely peripheral disclosure of the amended feature as a possibility, but not as part of the original invention may accordingly not be enough to justify an amendment.

Thorsten Bausch