

# Kluwer Patent Blog

## Will the “Inescapable Trap” of Article 123 (2) and (3) EPC Catch German Parts of European Patents?

Thomas Musmann (Rospatt Osten Pross) · Thursday, February 5th, 2015

by Dr. Simon Klopschinski

Under EPO case law there is the “inescapable trap” of Article 123 (2) and (3) EPC. The German Federal Court of Justice decided in the “Winkelmesseinrichtung” case that the “inescapable trap” does not apply to German national patents. In recent time different nullity boards of the German Federal Patent Court have issued conflicting decisions on the question of whether the Federal Court of Justice’s reasoning in “Winkelmesseinrichtung” also applies to German parts of European patents.

Under EPO case law a European patent has to be revoked when its claims contain a feature which is not disclosed in the original application (Article 123 (2) EPC) and the feature limits the scope of protection conferred by the patent so that it cannot be deleted without extending the scope of protection beyond the granted claims (Article 123 (3) EPC) (see EPO, Case Law of the Boards of Appeal of the European Patent Office, 7th ed., 2013, p. 429 et seq.).

Only in a limited number of exceptions the EPO case law on Article 123 (2) and (3) EPC will not result in the revocation of the European patent. Firstly, the patent will be maintained (in amended form), if - without thereby extending the scope of protection - (a) the added feature can be replaced by another feature disclosed in the application as filed or (b) if the added undisclosed feature has no technical meaning. Secondly, the added feature is a so-called “disclaimer” which does not provide a technical contribution to the subject matter of the claimed invention but merely limits the protection conferred by the patent as granted by excluding protection for part of the subject matter of the claimed invention, in order to restore novelty by delimiting a claim against (a) state of the art under Article 54 (3) and (4) EPC, (b) so called “accidental anticipations”, or (c) subject matter which is not patentable under Article 52 to 57 EPC.

Even though the Enlarged Board of Appeal has acknowledged that its application of paragraph (2) in combination with paragraph (3) of Article 123 EPC may lead to harsh results for the applicant, EPO case law does not offer a solution, e.g. by allowing the so-called “footnote” or “disclaimer” solution. In fact, the Boards of Appeal have decided for instance that the conflict between paragraph (2) and (3) of Article 123

EPC cannot be resolved by a claim with a footnote to the following effect: “This feature is the subject matter of an inadmissible extension. No rights may be derived from this feature.”

In “[Winkelmesseinrichtung](#)” the Federal Court of Justice has decided that the EPO case law on Article 123 (2) and (3) EPC with its harsh results for the applicant does not apply to German national patents. Therefore, a feature which is not disclosed in the original application and whose deletion or replacement by a feature covered by the application as filed would result in an extension of the scope of protection, can remain in the patent claim, provided that its insertion into the claim results in a limitation compared to the content of the original application, meaning that it merely further specifies the technical teaching and has not the effect that the claimed invention is an aliud to the originally disclosed invention. The added feature is disregarded when evaluating patentability of the claimed invention. A disclaimer saying that no rights can be derived from the added feature is not required.

Subsequent to the decision of the Federal Court of Justice in “[Winkelmesseinrichtung](#)” regarding a German national patent, different nullity boards of the Federal Patent Court have issued conflicting rulings on the question of whether the reasoning of “[Winkelmesseinrichtung](#)” applies mutatis mutandis to the German parts of European patents.

In the matter of “[Zentrifugierorgan](#)” the 1st nullity board applied “[Winkelmesseinrichtung](#)” to the German part of a European patent without further discussion.

In “[Unterdruckwundverband](#)” the 4th nullity board left the question undecided, since the added feature led to an aliud which also under the case law of the Federal Court of Justice resulted in the nullity of the patent.

Finally, on April 8, 2014 the 4th nullity board in “[Fettabsaugevorrichtung](#)” held that “[Winkelmesseinrichtung](#)” cannot be applied to the German part of a European patent. Following the EPO case law the board revoked the German part of the European patent in suit on the basis of Article 123 (2) and (3) EPC. Currently, an appeal against this decision is pending before the Federal Court of Justice.

Even though the Federal Court of Justice rejected the EPO case law on Article 123 (2) and (3) EPC with regard to German national patents, it remains to be seen whether the German parts of European patents will get caught in the “inescapable trap” of Article 123 (2) and (3) EPC.

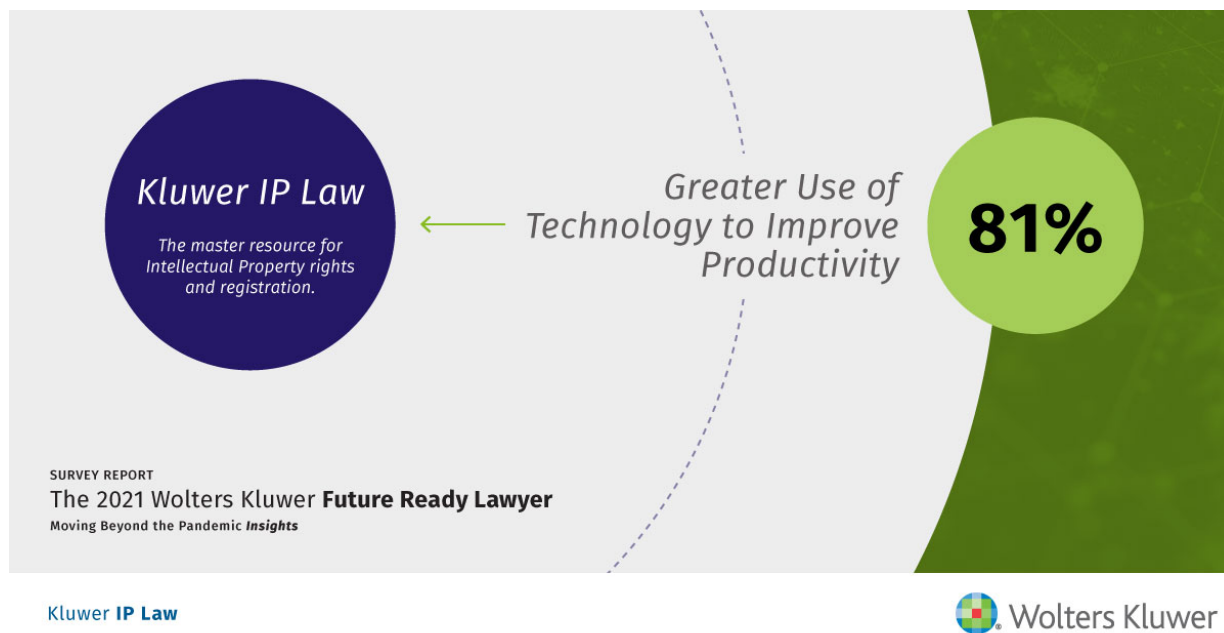
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