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EPO Boards of Appeal Divided about Exchangeability of "Comprising" by "Consisting"

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Can a claim directed to a “Composition comprising A, B and C” amended into a “Composition consisting of A, B and C”, i.e. a composition that only contains A, B and C and no further components? Or does such an amendment violate the added matter provision of Art. 123(2) EPC?

That is the question, and it is a good question, because the answer may depend before which Board of Appeal the case is brought.

TBA 3.3.3 opined in T 1063/07 that such an amendment violates Art. 123(2) EPC. The Board argued that it is “conspicuous” that there is no disclosure in the application as originally filed of a composition that is made up only of the components A, B and C and nothing else, which is the meaning of the term “consisting of” in Claim 1. In fact, the wording “consisting of” does not appear in the application as filed. The replacement in Claim 1 of “comprising” by “consisting of” creates a criticality as to the presence of only the compounds A, B and C in the composition which is not present as a sub-combination in the application as originally filed. Claim 1 of the main request therefore contains added subject-matter.

TBA 3.3.10 followed this reasoning in T 2017/07.

However, TBA 3.3.1 (T 425/98), 3.3.4 (T 997/06) and even 3.3.3 12 years ago (T 457/98) came to the exact opposite conclusion and allowed such an amendment under Art. 123(2). The Board in T 425/98 argued as follows:

The meaning of the word “comprising” is to be interpreted as encompassing all the specifically mentioned features as well optional, additional, unspecified ones, whereas the term “consisting of” only includes those features as specified in the claim. Therefore, “comprising” includes as a limiting case the composition specified by “consisting of”. The Board is satisfied, therefore, that the present request is not amended in such a way that it contains subject matter which extends beyond the application as filed.

The lesson to be learned is that you cannot be careful enough when drafting your application. A clause to the effect that a preferred composition consists of A, B and C, or that the word “comprises” according to the invention also includes as one embodiment that no further components are present appears recommendable.

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