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Article 123(3) EPC – EPO Case Law on Amendments in Composition Claims Converges

Thorsten Bausch (Hoffmann Eitle) · Tuesday, March 19th, 2013

Article 123(3) EPC stipulates that a European patent may not be amended in such a way as to extend the protection it confers. A special case of extension of the protective scope may occur in claims which define both the type of and the amount of a specific component. An issue addressed in a series of recent decisions of the Boards of Appeal of the EPO is whether and under which conditions such a claim violates Article 123(3) EPC if after grant of the patent the type of the component is restricted to preferred embodiments. The conclusions reached in the earlier decisions differ greatly, ranging from a clear yes, irrespective of the wording chosen for the claim restriction (see e.g. [T2017/07](#)), to a clear no, again irrespective of the selected claim wording (see e.g. [T1556/07](#)). The more recent decisions [T0009/10](#) and [T0999/10](#) are more differentiated and come to different conclusions for different claim wordings. Thus, based on these decisions the uncertainty created by the earlier decisions has possibly been removed, and guidelines may now be available for patentees as to how to amend claims in post-grant proceedings. This will be outlined in more detail below.

1) Introduction – The Logic behind the Problem

Before turning to case law, a logical approach as regards the meaning of the different claim wordings discussed therein will be applied to show what claim language would actually be admissible, and what language would not be admissible. As an example one may consider a patent comprising the following claim (1):

(1) Lighting device comprising 3-5 light emitting diodes (LEDs).

Furthermore, let's assume that the description and/or a dependent claim defines that in a preferred embodiment the LEDs are white LEDs. Assuming that the patentee wishes to make an amendment restricting the LEDs to white LEDs, at first glance two alternative claim formulations (1a) and (1b) appear to be possible.

(1a) Lighting device comprising 3-5 white LEDs.

(1b) Lighting device comprising 3-5 LEDs, wherein the LEDs are white LEDs.

However, upon closer analysis one recognizes that (1a) and (1b) are not equivalent. More precisely, an embodiment covered by (1b) is also covered by (1a), while an embodiment covered by (1a) does not necessarily fall within the scope of (1b). Further, while (1) and (1b) state that the

total number of LEDs shall be 3-5, (1a) merely states that the number of white LEDs shall be 3-5. This means that (1a) also covers lighting devices comprising the 3-5 white LEDs and some red or green ones as well, for example.

Accordingly, from a logical point of view, the limitation as to the total number of LEDs is lifted in (1a), which extends the scope of claim (1a) and would therefore constitute a violation of Article 123(3) EPC. Contrary thereto, (1b) maintains the total number of LEDs at 3-5, and adds the further requirement that the LEDs must be white. Claim (1b) would therefore be in conformity with Article 123(3) EPC.

2) The Decisions of the Boards of Appeal

2.1) T 2017/07

In T 2017/07 the claim 1 as granted was directed at a composition comprising 0.5-50 % C3-5-alkylene carbonate. In a preferred embodiment the alkylene carbonate was propylene carbonate.

In its decision, the Board came to the conclusion that both a claim directed at a composition comprising 0.5-50 % propylene carbonate (alternative (1a) above) as well as a claim directed at a composition comprising 0.5-50 % C3-5-alkylene carbonate, wherein the C3-5-alkylene carbonate is propylene carbonate (alternative (1b) above) would violate Article 123(3) EPC. In the Board's view, the term C3-5-alkylene carbonate present twice in (1b) cannot have different meanings, and thus must be identical in both occurrences. Thus, the Board assumed that in (1b) C3-5-alkylene carbonate actually means propylene carbonate, with the consequence that the amount of 0.5-50 % also in (1b) was considered to restrict only the amount of this specific compound, but not that of the broader generic term. As a result, the Board (from a logical point of view incorrectly) concluded that (1a) and (1b) aim at exactly the same teaching, extending beyond the granted claim and thus violating Article 123(3) EPC.

2.2) T 1556/07

In T 1556/07 the Board decided the exact opposite of T 2017/07. In this case the claim 1, in a greatly simplified form, was directed at an agent comprising 0.1-40 % of at least one A selected from a1, a2, a3 and a4. In the amended claim the component A was restricted by deleting one alternative, thus leaving at least one A selected from a1, a2 and a3. In principle, this corresponds to a claim wording according to the alternative (1a) as above.

However, the Board refused to apply the weight percentage to the total amount of component A in the first place (remarkably, and despite the contrary teaching in the description of the patent; see item 3.2.3 of the decision) and thus decided that the claim did not violate Article 123(3) EPC.

As the Board allowed a claim wording according to the alternative (1a) above, the admissibility of alternative (1b) under Article 123(3) has not been addressed.

2.3) T 0009/10

In T 0009/10, the granted (simplified) claim 1 was directed at a composition comprising 1-45 wt.-% of a nonionic surfactant. In a preferred embodiment of the invention, which Patentee wished to claim in amended claims in the opposition stage, the nonionic surfactant (NS) had a hydrophilic/lipophilic balance (HLB) of > 8 . Compared with our example claims, 1-45 %

corresponds to 3-5, the NS corresponds to the LEDs, and the HLB of > 8 corresponds to white. Claim version (1a) was Patentee's main request, while (1b) was the auxiliary request.

With respect to (1a) the Board argued that the amount of 1-45 % was no longer directed at the total amount of NS, but only at the amount of the specific sub-type thereof having a HLB value of more than 8. This means that, e.g., a composition comprising 30 % of NS with HLB 7 and 30 % of NS with HLB 9 is outside the scope of the granted claim (the total amount of NS is 60 %), but is covered by claim (1a) (30 % of NS with HLB > 8 ; the 30 wt.% HLB 7 surfactant no longer matters for claim (1a)). Thus, it was concluded that claim (1a) violates Article 123(3) EPC.

With regard to claim version (1b), the Board assumed that the 1-45 % still relates to the total amount of NS in the composition, and the HLB of > 8 imposes an additional limitation thereon. Accordingly, the claim version (1b) was found to comply with Article 123(3) EPC.

2.4) T 0999/10

T 999/10 dealt with a similar situation, based on a claim directed at a composition comprising 45-85 % of styrene block copolymers (SBCs). In opposition proceedings, the patentee wanted to limit the SBCs to styrene-isoprene-styrene (SIS)-type block copolymers, using a claim wording of composition comprising 45-85 % of SBCs, wherein the SBCs are SIS-type block copolymers in accordance with the present alternative (1b).

The Board concluded that in the formulation (1b), the range of 45-85 % applies to the total amount of SBCs, so the presence of any other SBC types different from SIS is excluded. Hence, the claim was found to comply with Article 123(3) EPC.

3) Conclusion

The earlier case law dealing with the present issue under Article 123(3) EPC is divergent and was either too liberal (T 1556/07) or too strict (T 2017/07). In both cases, the meaning and scope of the claims underlying the respective cases might have been interpreted in a manner not exactly matching a strictly logical interpretation thereof. In the more recent cases of T 0009/10 and T 0999/10, the logic of the earlier decisions has converged into a more differentiated approach, which in our view is the appropriate one and hopefully will become the prevailing view of the Boards of Appeal in the future.

Provided that the above view will indeed be adopted in future, claim amendments following the wording of alternative (1b), on the one hand, wherein the original claim wording and the new limitation are clearly separated from each other as independent and cumulative requirements, should be safe and admissible under Article 123(3) EPC. On the other hand, it will have to be assumed that claim amendments following the structure of alternative (1a) will no longer be admitted under Article 123(3) EP.

Matthias Wolf/Stephan Grimm

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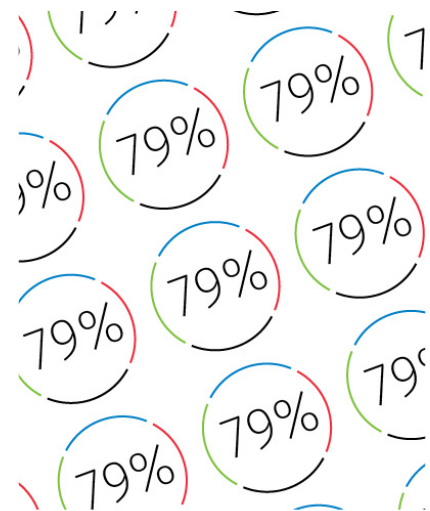
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