

On EPC Article 123 sections 2 and 3¹

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1.Introduction

A patent attorney's trainee will stumble over it early after the beginning of his or her training; it causes much work for any patent attorney; and anybody filing a patent application will possibly spend a lot of money in order to avoid it: the trap between sections 2 and 3 of EPC Article 123², which, set up in the examination proceedings, may inescapably in the opposition proceedings prove a death trap for the patentee, as he might lose his patent.

The "trap" addressed in this essay is the situation of an independent patent claim being patented with an illegal broadening, contrary to Art. 123 section 2, what, according to Art. 123 sect. 3, cannot be reversed by deletion in opposition proceedings. A possible consequence may be the revocation of the patent concerned. The case law compilation "Case Law of the Boards of Appeal of the European Patent Office" of the European Patent Office dedicates a whole chapter (III C) to this dilemma. The Enlarged Board of Appeal of the European Patent Office has commented on this problem in G 1/93³ to Brinkhoff's⁴ satisfaction and Rogge's⁵ dismay. On behalf of any patent attorney, considerable effort and consultancy service will be called for, particularly for inexperienced clients, or for those experienced in foreign, more permissive legal situations, as soon as the examination proceedings start, in order to steer clear of the threat of a revocation during possible future opposition proceedings. But as hard as one may try, problems cannot always be evaded.

- There will always be cases which cannot be blamed on the applicant, that features of "complex disclosure" - in a borderline case a euphemism for "doubtful disclosure" - must be used. This may occur e.g. when a distinction needs to be made between an invention and strange state of the art: The whole of the application shows that and where the invention differs from said state of the art, but this is not explicitly stated in the papers and/or is not made clear by the drawings, because the quoted (strange) state of the art could not be foreseen as such, and thus no preventive action could be taken when the applica-

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² To be more precise: the clash of Art. 100c) and Art. 123 sect. 3, for the opponent will back their opposition with Art. 100c), and not with Art. 123 sect. 2, which is substantially identical. During national revocation proceedings, Art. 138 sect. 1c) would be of relevance.

³ OJ EPA 1994, 541, GRUR Int. 1994, 842

⁴ *Brinkhoff*, GRUR Int.1998, 206 – Kollision zwischen Art. 123(2) und (3) EPÜ

⁵ *Rogge*, GRUR Int.1998, 208 – Zur Kollision zwischen Art. 123(2) und (3) EPÜ

tion was drafted. In this kind of situation, the disclosure of the desired feature is scraped together from different parts of the application, and the Examining Division might be (and in most cases, will be) convinced of the disclosure of the feature in question. The same issue, however, might be decided otherwise if it is once more subject to decision during opposition proceedings. Naturally, the opposer will argue against disclosure, and he may succeed in the endeavor.

- Similar problems may arise from nuances in meaning, due to shifts in translations.
- Practically, the trap may be posed in the international phase of a PCT-application: A non-European applicant may amend his patent application during international search or during the international preliminary examination of the application. In most cases, he will start out from the original "domestic" documents (e.g. US or JP), possibly before his "domestic" patent office, and all this most likely based on domestic experience, principles and points of view. On occasion they will not be aware that their amendments at least also have to be in line with the EPC, since the documents as originally filed according to EPC Art. 123 sect. 2 are not those possibly filed with the EPO when entering the regional phase, but the PTC application as originally filed. If a patent claim that was positively decided during the international preliminary examination is not once again checked for disclosure during the regional phase, illegal broadenings may be patented.
- It is a very disagreeable fact that the holder of a patent can never be sure of an explicitly positive decision on disclosure from the part of the Examining Division. Disclosure of a feature may have been explicitly established in the first instance, but still the patentee may be trapped during the opposition proceedings since the issue of disclosure may be decided upon otherwise.

The worst-case scenario would then be the revocation of the patent as a whole just because of the disclosure problem of a detail. The purpose of this essay is to discuss whether the conflict between Art. 123 sect. 2 and 3, if it does occur, necessarily has to be solved by means of revocation of the patent or if it can be avoided otherwise.

One purpose of Art. 123 sections 2 and 3 and 100c) is to grant legal certainty to the affected third party by tying the applicant for a patent down to whatever was filed for application for a patent and afterwards patented and accordingly published. In this regard, EPC Art.123 makes good sense, and it also appears preferential to handle the matter in a somewhat less generous fashion lest the patent system degenerates to some sort of "gambling to the disadvantage of third parties". Thus, this essay does not favor weakening the requirement for disclosure,

but rather handling the matter in a fashion elaborated below, which, in the view of the author, does justice to all parties – to the applicant, the holder of the patent, and to the third party affected – and which is also in line with the rules in force.

2. Case Constellations

One can imagine various constellations regarding “illegal broadening”, which are to be presented in the following. As an example, take an European patent application relating to an apparatus having a metallic connecting member for connecting two component parts, and some further features ABC. Say, the application does not give any further information (specification, claims, drawings) on “metallic connecting member”, meaning that what is disclosed within the application is restricted to the piece of information of “metallic connecting member”; and no alternatives, generalizations, or special further developments being described. With regard to the “disclosure”, the following constellations C0 to C3 may arise:

Constellation C0: Say, claim 1 (such as originally filed) reads as follows:

“Apparatus having a metallic connecting member for connecting two component parts, and ABC.”

According to what has been said above, this is uncritical as far as disclosure is concerned and thus admissible.

This is quite different in

Constellation C1: Say, claim 1 reads as follows:

“Apparatus having a connecting member for connecting two component parts, and ABC.”

In this case, the feature “metallic” has become a nuisance to the applicant, and he has deleted it. Within this essay, C1 shall generally mean the deletion of a disclosed feature, with the deletion not being disclosed. True, this amendment is inadmissible in the absence of disclosure; but this is of no concern for the purpose of this essay since the amendment thus committed may be remedied in opposition proceedings by re-inserting the feature “metallic” into the claim, thus curing the defect in line with Art. 123 section 2 without violating Art. 123 section 3.

The problem arises in

Constellation C2. Say, claim 1 reads as follows:

“Apparatus having a metallic connecting member for connecting two component parts, the connecting member being a screw connection, and ABC.”

In C2, the “connecting member” has been further developed into a “screw connection” without this being disclosed. The feature “the connecting member being a screw connection”, and in general, any not-disclosed features restricting the scope of the patent will be in the following referred to as and symbolized by “feature ZZZ”. In general, C2 in this essay stands for any patented, independent patent claim having an amendment of an additional feature which has not been disclosed but which restricts the scope of the patent. It is only this constellation that shall be of interest in this essay, because it is only this constellation that provides the dilemma, the situation of being trapped between Art. 123 sections 2 and 3: To retain ZZZ within the claim is regarded unconditionally impossible according to Art. 123 section 2; deleting it is impossible according to Art. 123 section 3, and the result may be the revocation of the patent as a whole.

There is a further constellation,

Constellation C3. Say, claim 1 reads as follows:

“apparatus having a screw connection for connecting two component parts, and ABC.”

This version C3 combines qualitatively the effects of constellations C1 and C2: a feature (“metallic”) has been dropped without disclosure, as in C1. This means that also non-metallic connections fall into the scope of the patent. This feature, however, could be re-inserted into the claim without extending the scope of the patent. Furthermore, something new and different (“screw”) has been added without disclosure and, as in constellation C2, this leads to the kind of problem described there.

Constellations C0 and C1 are uncritical for the purpose of this essay. C2, however, may well be “solved” by revoking the patent by invoking Art. 123: concerning feature ZZZ, it must allegedly on no account stay the way it is, this inevitably violating EPC 123 section 2, and it cannot be amended by deleting ZZZ because this would mean violating EPC Art. 123 section 3. So the complete revocation of the patent appears to be the only way out. C3 is uncritical as far as deleting features is concerned and may, as regards the rest, be traced back to C2.

The revocation of the patent as a whole just because of the problem of disclosure of one detail is a sort of death trap set up - unknowingly in most cases – during

the examination proceedings that time and again snaps shut painfully during the opposition proceedings.

It should be noted that the aforementioned constellations will only be regarded as far as independent patent claims are concerned. These are the only matter of interest to this essay. Inadmissible broadenings may, of course, occur in dependent claims, too. Those, however, are significantly easier to remedy because dependent claims may normally be revised without violating Art. 123 sect. 3 since the scope of a patent is, after all, determined by the independent claims and cannot be extended by deleting a dependent claim or one feature thereof.

3. A different point to view and a possible modus operandi

In the following, a different handle of the cases of constellation C2 above shall be presented, under substantive and procedural aspects.

a) substantive aspects

During the opposition proceedings, a patent claim like the one in C2 may be handled in a way that the feature *ZZZ* is retained within the patent claim but that the Opposition Division or the Board of Appeal will not take it into account when it comes to assessing patentability of the application in question and particularly when it comes to deciding whether or not it is based on inventive activity. What is achieved by this is that the holder of the patent is not allowed to derive the right to his patent by means of the inadmissible feature, so that there will be no advantage accruing from the illegal broadening by feature *ZZZ*.

One could also imagine that in a dispute around the right from the patent (infringement case), the extending feature *ZZZ* has an impact on the rest of the features of the patent claim, such that they – because of the interpretation dependent on *ZZZ* – now include matter in the scope of the patent which they would not include if the claim was interpreted without feature *ZZZ*. This would also mean an advantage for the holder of the patent, accruing from feature *ZZZ*. This scenario, however, is hardly likely ever to be of practical relevance. If one, nevertheless, seeks to make sure it does not occur, the holder of the patent will furthermore have to declare their renunciation of the effects of the patent concerning matter that may fall into the scope of the patent because of a scope-extending interpretation thereof depending on feature *ZZZ*. This way, a possible gain from the interpretation depending on feature *ZZZ* would also be avoided.

In the example of constellation C2, the outcome of the suggestion made above would be an examination for patentability that only takes the feature of “metallic connecting member” into account, which feature is not touched by the problem of disclosure; whereas the feature of “the connecting member being a screw connection” – the feature that does come with the problem of disclosure – would

not be considered when deciding about the inventive activity, although it would remain in claim 1. In later infringement proceedings, should an interpretation of the rest of the patent claim be needed, the holder of the patent would not benefit from an interpretation of the patent depending on feature *ZZZ* that extends the scope of the patent, because they would already have declared their renunciation of the protection accruing therefrom. Potential infringers nevertheless still might put forward arguments geared for feature *ZZZ* for an interpretation that restricts the scope of the patent, and these might prevail.

What is thus essential is that the critical feature *ZZZ*

- be retained within the claim and thus keep its function of restricting the scope of the patent, but
- be not considered by the Opposition Division or the Board of Appeal when establishing whether or not there has been inventive activity, and that it cannot extend the scope of the patent by means of interpretation, so that it does not have the effect of qualifying the protected matter nor any other effect affecting the scope of the patent, save for the effect of restricting it.

On the whole, constellation C2 has thus been reduced in its handling and effects to a construction that can be thought of as pieced together from two elements:

- the right-justifying and right-limiting features within the framework of what was originally disclosed, which is certainly uncritical; and
- a further restriction of protection, according to the illegal broadening which restricts the protection because it was retained in patent claim 1 as a restricting feature which, just as before, co-determines in the usual way the scope of the patent, but did not contribute to patentability because the Board or the Opposition Division did not take the feature in question into account. To this, the aforementioned renunciation of protection by the holder of the patent is added, so that the illegal feature will not bring any inadmissible advantage to the holder of the patent when the patent claim is being interpreted, in case this becomes necessary during the infringement proceedings.

If it proves feasible, this way of handling constitutes a way out of the trap between Art. 123 sections 2 and 3. The patent would not necessarily have to be revoked because of the clash of sections 2 and 3, but it could rather be handled the usual way; meaning that the critical feature would be retained restrictively within the claim (and thus result in a "usual" scope of the patent), but that the question of inventive activity would be settled leaving it out. If inventive activity is confirmed in this case – i.e. without the feature *ZZZ* – (and if there are no other obstacles) the patent may be kept up (possibly otherwise restricted).

There would be no reason for the holder of the patent to be unhappy about this way the matter was handled: They had once applied for the critical feature and they retain it in the patent claim with its effect of restricting the scope of the patent. The only risk that might have proven a disadvantage to them: They have agreed to a restriction because they felt the patentability of their invention could be derived (amongst others) from this restriction. The way of handling the matter described above, however, leaves them with the restriction, but rules out the possibility to take it as a basis for arguing in favor of the patentability of their invention. The holder of the patent will have to just put up with this, particularly for the sake of the interests of the affected public that are of greater priority.

The affected third parties, i.e. the public, should also be pleased: They are not being confronted with anything which could not be read right from the beginning from the relevant publications. The justification of the right to the patent is argued solely referring to what was originally disclosed, i.e. referring to what was put down in the published patent application; and the scope of the patent does not extend beyond what is apparent from the published patent specification.

The renunciation by the holder of the patent, such as mentioned above, would still leave the affected third parties the possibility to argue for an interpretation that depends on the feature *ZZZ* and that restricts the scope of the patent.

There will always remain the possibility – however unlikely – of problems relating to the legal appearance of such a patent: An independent patent claim of a granted patent with “powerful” features that have not been disclosed, appears *prima facie* much harder to oppose than it actually is. A third party faced with claim 1 of constellation C2 including feature *ZZZ* might easily be of the opinion that they are required to show that the feature *ZZZ*, too, is state of the Art. This might seem too complicated to them, so that they might refrain without closer examination from opposing the patent or filing a nullity action. Furthermore, it might seem that a patent claim can be interpreted depending on feature *ZZZ* in such a way, that it has a scope of protection which it would not have without the interpretation depending on feature *ZZZ* – and which it actually does not have due to the renunciation expressed by the holder of the patent. Those effects, however, may be countered by means of suitable hints, e.g. in the form of footnotes referring to patent claim 1, or at the end of the description, which shall be further elaborated below.

b) procedural aspects

The principle of disposition provides that the applicant for a patent be the master of the proceedings insofar as it shall be them who will determine what is to be presented to the decision-making body. Following this principle, the applicant should bring a suitable request to prompt the above handling by the EPO. A suitable request might read as follows:

Maintenance on the basis of claim 1 [and further documents], provided that the feature “the connecting member being a screw connection” be not considered in establishing patentability. Simultaneously, it is stated that the effects of the patent concerning subject-matter that might also come under the scope of the patent because of a scope-extending interpretation of the patent depending on the feature “the connecting member being a screw connection” shall be renounced.

In the case of the claims of constellation C3, a revised patent claim might be presented that might read as follows:

apparatus having a metallic connecting member, which is a screw connection, for connecting two component parts, and ABC.

By means of this revised patent claim, the feature “metallic” is re-inserted without violating article 123 section 2. Neither is article 123 section 3 violated by putting the disclosed generic feature “connecting member” before the problematic term “screw connection”. This way, the problematic term “screw connection” is isolated so it can be requested – analogously as mentioned above – not to be considered without thereby forfeiting the disclosed feature “connecting member” for the justification of the patent claim (clarity, inventive activity).

The request should be directed to neglecting feature ZZZ concerning patentability in general, not just concerning novelty and inventive activity because, e.g., problems of lacking clarity, too, should not and cannot be remedied by illegal broadenings.

c) The Footnote (or similar devices)

In order to counter the problem of a wrong legal appearance and the problem of interpretation as described above, a clarifying note may be inserted at a prominent place of the revised patent specification. For example, immediately before or immediately after the patent claim in question, there may be a passage reading as follows:

Upon request of the patentee, the feature “the connecting member being a screw connection” has not been considered when deciding the patentability of claim 1, for lack of disclosure. Neither will patentability be able to be derived from this feature in the future. It does co-determine the scope of the patent, though. The holder of the patent has declared their renunciation of the effects of the patent concerning matter that might come under the scope of the patent to it due to an interpretation depending on the feature “the connecting member being a screw connection” extending the scope of the patent.

Thus, even on casual inspection of this passage, it will be clear that feature *ZZZ* has not contributed to the patentability of the patent and that it will not be able to do so in the future, and that it is not, and will not be, possible to gain an advantage from a certain interpretation.

As can be seen, the present essay also proposes to make use of a clarifying passage or a footnote. A few brief thoughts about the relevance of said footnote:

If it figures in a patent one day, as suggested in this essay, this would be due to a decision which also determined that the footnote was to become a part of the patent that had been kept up. The more important part of the same decision is, however, the very keeping up of the affected patent; to be precise, by not taking feature *ZZZ* into account. This means that something substantively important had happened before the footnote was introduced. And this means that the latter fulfils in this respect no function of its own, or merely a clarifying one. The essential effect is brought about by the way how the competent body made its decision and not by any sort of legal effect that the footnote may have. But still, the footnote may fulfil various functions:

- it instructs future tribunals deciding on the right to the patent (e.g. Board of Appeal, Nullity Board) to do as was done the first time, i.e. to once again not take feature *ZZZ* into account. Whether or not this is necessary is open for discussion because a certain legal way of handling certain constellations need not be repeated over and over again within each individual case. Under this aspect, the footnote seems superfluous.
- it makes clear that feature *ZZZ* co-determines the scope of the patent, or rather restricts it. Thus, the footnote says nothing more than Art. 69 and seems therefore once again superfluous.
- it avoids problems as regards wrong legal appearance such as mentioned above, which shall not be repeated here. In this respect, the footnote makes good sense and may even become necessary.
- it renounces the protection gained through an interpretation of the patent depending on feature *ZZZ*, as mentioned above. In any case, the renunciation of the protection will require a declaration along these lines by the patentee, which they can, after all, give only before the competent body. They will even have to do it, since the renunciation may well be - should need arise – a precondition for the patent to be kept up. If the renunciation does not become valid before the declaration is published, the footnote will be needed as a “vehicle for publication”. If the renunciation comes about just by the holder of the patent giving a corresponding declaration before the tribunal seized of the matter, the relevant passage would once more fulfil “merely” the necessary function of sorting out a wrong legal appearance.

In a nutshell: In as far as the right to the patent is affected, the footnote is of no importance at all, for the essential effects are not triggered by the footnote but by the decision by the competent body. Only in case of issues of a wrong legal appearance or a renunciation will the footnote gain importance. The footnote suggested is thus not to be understood first of all as an instruction on how, in the future, in the course of a patent's existence the critical feature is to be assessed; but at least also a clue as to how it was dealt with in the decision during the opposition or appeal proceedings.

Footnote? Or hint in the specification? Or rather an appendix to the patent claim? Regarding the high-priority purpose of the explanation, that is, to avoid an incorrect legal appearance, it will make good sense to put them close to the patent claim that might produce this wrong legal appearance, e.g. right before or right after it. If, for example, claim 1 was the problematic one, it could possibly be followed by a paragraph like the one presented above, and these two would then be followed by claims 2 following.

4. Observations

In the following, both the present handle as well as the suggestion made above shall be checked with regard to questions such as whether the proposal is substantively and procedurally feasible. It is the opinion of the author that there are arguments that make, on the one hand side, the handle up to now appear by no means unappealed or indispensable, and which, on the other hand side, seem to make the above proposal possible.

a) The punishing character of the present handle

The revocation of the whole patent just because the requirement for disclosure of one feature has failed to be met, leads to a punishing character of Patent Law: If during the examination procedure a feature was claimed - regardless of this being deliberate or accidental - which is, during opposition proceedings, found not to have been disclosed, the momentarily favored handle provides as a remedy not a possible repair with effect *ex tunc* (similar to the approach in Civil Law, which is establishing a lawful situation for the future and compensating for the past) but rather the forfeiture of the patent as a whole. It may be questioned if this is proper: one might even ask if this can be brought in line with general principles of law: There can be no question that the applicant must be allowed to seek their right to the limit of the permissible. It is only natural that they might end up on the "wrong" side of the "border", particularly in complex situations such as they have been hinted at at the beginning. If the applicant seeks their right, they will run, with the present handle, the risk not only to have the illegally broadened patent later cut down to lawful size, but of forfeiting it altogether.

This punishing character appears all the more problematic as it is not the applicant themselves who did something wrong all on their own (namely, put the problematic feature into the patent claim), which they will be held responsible for. It is true that they requested their application to be patented including the critical feature. The request, however, has been examined by the examiner, and it has been granted, after all, by the three examiners of the Examining Division. For this examination, which has to include ex officio all preconditions for patentability, the applicant had to pay the application fee. This means that the “trap” is also set up due to a decision by the examination division that was later found to be wrong. Even more provoking, one could go as far as to say that the applicants request does not at all set up the “trap”, for the request as such has no such “trap-setting” effect; the request would rather have had to be rejected by the examining division and a different request could have been granted; in this case the trap would not have been set up. What does set it up is then only a decision by the Examining Division that was discovered to be wrong afterwards. To put it this way would certainly not do justice to the applicant’s responsibility for drafting his claims. But, on the other hand, it does mirror the applicant’s right to seek their right to the full, by means of requests to be filed by themselves and to be examined by the EPO, an endeavor that might – the trap menace being handled as it is at the moment – become a game of chance with the whole patent as a stake.

Even the incorrect official contribution - examination and wrong decision – will according to the momentary handle not make the holder of the patent proof against the maximum penalty, which is the forfeiture of the patent as a whole. Right on the contrary: At least in parts caused by the fact that the official contribution was incorrect, the mentioned legal consequences ensue.

Whether the penalty of “complete forfeiture of the right” can be brought in line with the holder’s right to seek their right to the fullest, may be questioned. Due to the penalty of “complete forfeiture of the right” the holder of the right is de facto hindered to seek their right in borderline cases. Under this aspect, one may ask whether calling the trap’s snapping shut “operate rather harshly” (in no. 13 of the grounds for decisions) in G1/93 is not somewhat euphemistic. In the least, one would have to view it as alien to the system, but it might be plain against the law, too, particularly if there exist any other apparent remedies, which would do justice to the interests meriting protection of all parties concerned.

b) Procedural barriers...

... to the proposal made above are not apparent. In line with the principle of disposition, the person applying for a patent shall be the master of the proceedings, meaning that it is their request that determines what is to be used as a basis for the decisionmaking. According to this principle, it is not possible ex officio to

handle the matter as proposed above (under no. 3). But in case there is a suitable request by the holder of the patent, e.g. like the one proposed above, it is hard to see why the modus operandi proposed should not be procedurally feasible.

There is no apparent legal ground to deny admissibility to the petition drawn up more or less like the one above. In line with the principle of disposition, the Board of Appeal or the Opposition Division would have to take and exploit the patent claim such as it has been requested, and to take this as a basis for the decisionmaking.

c) EPC Article 84

In line with article 84, the patent claims “shall define the matter for which protection is sought”. The modus operandi suggested above under no. 3 complies with this article, regarding the right to the patent as much as the right from the patent. The patent claim dealt with such as proposed above mentions everything that justified the right to the patent, i.e. the application for protection – and one further feature. Since the patent claim as a whole unfolds in the usual way the scope of the patent, particularly including the critical feature *ZZZ*, the requirement for the patent claims to define the matter for which protection is sought has also been met.

Art. 84 also demands that the patent claims be clear and concise. Lacking clarity is no ground for opposition. But in case there arise amendments during the opposition (appeal) proceedings, it is understood that they have to meet the requirements of Art. 84. A request such as proposed above (particularly for not considering a feature *ZZZ*) will certainly ensue such an amendment; for as far as the question of patentability is concerned, the feature has “vanished”, just as if it had been deleted. This resulting in an unclear patent claim would be faulty in line with Art. 84. If this lack of clarity can be remedied within the limits of disclosure, the problem is solved. If not, the patent will have to be revoked, which would not even be unfair, either, because this would mean that from the beginning the lack of clarity could only be remedied by the illegal broadening, which is not permissible.

d) EPC Art. 123 sect. 2 and 100c): “Subject-matter”

In the author’s opinion, neither Art. 123 section 2 nor 100c) withstands the proposition made above, for a feature that was not taken into account when deciding about patentability does not have to be regarded as being part of the “subject-matter of the patent” in terms of Art. 123 section 2.

Art. 123 section 2 and/or Art. 100c) has certainly been violated when a not-disclosed feature in an independent patent claim has contributed to the patentability of the matter claimed. But what happens if – as suggested above – the feature has expressis verbis not contributed to protectability, but still figures in

the claim? No doubt at least Art. 123 section 3 has not been violated. But what about Art. 123 section 2 or Art. 100c)? Have they been violated?

Art. 123 section 2 is geared to the comparison of a “subject-matter “ with a “content”. It shall be quoted hereinunder:

Art. 123 – Amendments:

(1) [...)

(2) A European patent application of a 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 claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.

What causes the holder of a patent trouble during the opposition proceedings is not so much Art. 123 section 2, but rather the substantially identical

Art. 100 - Grounds for opposition.

The opposition may only be supported by the fact that

a) [...]; b) [...]; c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Art. 61, beyond the content of the earlier application as filed.

The author is of the opinion that it is hard to say just what is meant by the term “subject-matter of the patent”. The passage “content of the application as filed” hints to what is colloquially referred to as “the original disclosure” . But once again, one may ask just what has to be considered for covering the term “content”; and particularly whether the “content” is made up by merely technical statements or whether also statements and *modi operandi* referring to Patent Law may co-determine the “content”, namely those that take into account whether a feature is to contribute or has contributed to patentability and to the interpretation of the patent.

What is the “subject-matter” of the patent or of the application for a patent in terms of Art. 123 sect. 2 ? In order not to compare totally different things, and to retain a logical structure, one will have to state that the “subject-matter” such as regarded in Art. 123 sect. 2, is also some kind of “content”, namely the “content” of the right after the amendment. This way, Art. 123 sect. 2 compares “content” (after the amendment) to “content” (as originally disclosed), the com-

parison being linked to the demand that the content do not increase⁶. This brings one once more back to the question what the “content” is, no matter if in the original or in the amended version. The question regarding the “subject-matter” is then, once again, uncertain as far as the question of what the “content” is, has not been answered. And this question is not a trivial one, either. This becomes quite obvious when one thinks about what the “subject-matter” or the “content” is not:

First of all, one would have to take into account that Art. 123 sect. 2 is also, but not exclusively, geared to the patent claims. It rather covers the right as a whole, which also includes the remaining parts, i.e. the description and the drawings. For this reason alone, the “subject-matter” would not be the “scope of the patent claims” (“protection conferred”); but also for the reason that Art. 123 sect. 2 is deliberately not geared to the term “protection conferred” that is used in other places (Art. 69).

Can the “subject-matter” or the “content” be understood as the sum of all the scopes of the patent that may, due to disclosure, be legally shaped? This aspect would also include the possibility of shaping the patent claims referring to the other parts of the application or the patent, particularly within the framework of the originally disclosure. But this view, too, is faulty considering the purpose of of Art. 123 sect. 2: In the case of an amendment according to constellation C2, the scope of the patent would at any rate (particularly also when the feature ZZZ was taken into account in the usual way concerning the question of patentability) lie completely within the scope of the patent that may legally be shaped within the original disclosure, so that a broadening according to constellation C2 would not be covered by a such defined “subject-matter” of Art. 123 sect. 2, and would thus be uncritical, which is really not desired, though. On the whole, any reflection involving the scope of the patent seems unsuitable when it comes to interpreting the terms of “subject-matter” and/or “content” in relation with Art. 123 sect. 2

Can the subject-matter of the application for a patent or the patent itself be the “momentarily claimed (in the application) or patented (in the patent) combination of features”? Part of the truth may lie in this “literary understanding” - the “subject-matter” being what was put down in the patent claim – but certainly not the whole truth. Once again, attention has to be drawn to the fact that Art. 123 sect. 2 and Art. 100c) are not solely geared to the patent claims but to the right as a whole, i.e. including the description and the drawings, which might cause certain interactions. Under the aspect above, the latter would not be taken into

⁶ One could also turn things around and designate the “content” as a “subject-matter” of some kind, or one could even pick a meta-term for both terms, which shall not be done here, though. What is most important here is to find a comparable quality and its “quantitative” determining criteria. The designation (“content” or “subject-matter”) is of less importance.

account. By the way: a patent is not (only) a piece of literature, but (also) a technical text in the context of Patent Law. This means that it may seem sensible a priori to include legal aspects, too, when interpreting terms such as “subject-matter” or “content”.

The author is of the opinion that G1/93 uses the term “subject-matter” differently than the norm that it interprets, i.e. Art. 123 sect. 2, which mentions the “subject-matter“ in the singular, this leading to the conclusion that Art. 123 sect. 2 assumes that one patent has one “subject-matter”, whatever that may be. Things are completely different in G1/93, though: No. 11 of the grounds for decisions says e.g.: “... Such added matters may be generalisations ...” or „... If during examination of an application, added subject-matter of such non-limiting character is introduced ... “ and no.15: „... The above conclusions are based on the assumption, that the added feature in question falls within the concept of subject- matter which ...“ or „... It remains, however, to be considered whether a limiting feature necessarily has always to be regarded as such subject-matter ... or in no. 16: “... In the view of the Enlarged Board, such feature is, on a proper interpretation of Article 123(2) EPC, therefore not to be considered as subject-matter extending beyond the content of the application as filed within the meaning of that provision ...”. No.1 of the reasons for decisions says: “... Nor can it be amended by deleting such limiting subject-matter from the claims ...”

G1/93 uses the term “subject-matter” often synonymously to the term “feature”, which means that a patent or a even a patent claim would accordingly have many “subject-matters”, according to this definition. This understanding does not match the one of Art. 123 sect. 2. Rule 29⁷ “Form and content of claims” exhibits a use of language consistent with the one of Art. 123 sect. 2, which does not match the one of the Enlarged Board of Appeal. This means that G1/93 does not correspond terminologically to the norm that it examines; which one might take as an indication as to how incompletely the term “subject-matter of the patent” is defined.

After several further considerations, one might arrive at a view that is geared to the recipients’ horizon, which is more or less how Schulte⁸ defines the “subject-matter of the application” for German Patent Law, in the same context of Patent Law, namely as ”for what a patent is possibly sought, as a person skilled in the art understands it from the whole content of the original application”⁹. Surely

⁷ Rule 29, form and content of claims: “(1) The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate claims shall contain: ... “ Thus *one* subject-matter is to be defined by *various* features.

⁸ *Schulte*: Patentgesetz, 6th edition, §38, no. 20

⁹ The Federal Court of Justice defines in its decision „Zeitlegramm“ (GRUR 2001, 140) the term of „Content of the application as originally filed“ quite“ similarly, referring to German Patent Law §§ 22, 21: „The content of the [...] application as originally filed is composed of everything that an expert in the relevant field of technology with average knowledge and average skill in the art gathers from it as being part of the invention filed.“ (authors translation)

not only technical aspects, but also aspects of Patent Law will be necessary in order to correctly determine the “subject-matter” of an application or of a patent, at least according to Schulte, who is of the opinion that the “subject-matter” shrinks due to material renunciations, i.e. declarations referring to Patent Law beyond technical explanations.

There is a lot that would argue for including aspects of Patent Law when determining the “subject-matter” and/or the “content” of a right. Imagine, a technical feature *YYY* has been originally and regularly disclosed as optionally usable. For some reason, though, the applicant says at the end of the specification: “The holder renounces using the feature *YYY* for justifying patentability.” Is the applicant allowed to change their mind afterwards and then go ahead and put the feature *YYY* in patent claim 1, thus justifying patentability? The author does not think so, particularly considering the renunciation and the legal certainty of the public. If this was right, it would be an indication that the passage “content of the application as filed” in Art. 123 sect. 2 alone has to be understood as also referring to qualities, considerations and expectations of Patent Law. Most of all, the outcome of this mind-game, such as the author suspects, hints at the necessity to also take the question into account, what kind of legal relevance the applicant meant to give or has given to their technical disclosure, when interpreting the term “content”.

If this is true of the “content”, why should it not also be true of the “subject-matter”? According to Schulte, the “subject-matter” is influenced by the explanations of Patent Law¹⁰. So why should it not be permissible to understand the “subject-matter” of the patent in terms of Art. 123 sect. 2 as “what may justify or is to justify the right” (before any decision is made) and/or as “what has justified the right” (after the decision has been made)?

The EPO’s Enlarged Board of Appeal, too, shows that they do not ascertain the “subject-matter of the patent” through a literary interpretation of the patent claim, but regard it as rather more complex. Decision G1/93 regards a set of cases, in which it is what does not contribute technically which is regarded as not belonging to the subject-matter of the patent. Would it not make sense, then, to say that something does not belong to the “subject-matter of the patent” if it did not contribute to justifying the right, in terms of “no contribution to inventive activity”, because it was not taken into account in this respect? Would it not even be permissible to argue thus: Since the feature *ZZZ* was not taken into account as to its technical content, it has not even made a technical contribution, which means that it would belong to the set of cases of G1/93 mentioned above? The author is of the opinion that when it comes to determining the “content” and/or the “subject-matter” of a patent application and of a patent, not only technical aspects will have to be considered, but also aspects of Patent Law, par-

¹⁰ *Schulte* Patentgesetz, 6th edition, §38, no. 20

ticularly those respecting how the applicant means and meant to have their technical information legally handled and/or how these were actually dealt with by the competent body (after a decision was made). This understanding of the terms “subject-matter” and “content” combines a technical and a legal understanding; the legal aspect including the questions whether the applicant means or meant to attribute a right-justifying quality to their feature (which is technically disclosed or which unfortunately figures in the patent claim); or whether the opposition division or the Board of Appeal attached right-justifying quality to a non-disclosed feature: If the latter is not the case, the feature does not belong to the “subject-matter of the patent”. With this precondition, not even the wording of Art. 123 sect. 2 will be violated if the matter is handled as proposed above under no. 3, because the critical feature ZZZ is not part of the “subject-matter of the patent”.

Another argument for non-violation is that the purpose of the norm has been fulfilled: the only thing justifying the right was the original disclosure, and not the illegally added feature. The latter did not serve the establishment of patentability, no rights were derived from it.

The term “subject-matter” is used in different contexts in Patent Law¹¹. In order to get down to the meaning of this term, the author suggests, it is helpful to assume that the term has different meanings in different contexts. There is, e.g. the “subject-matter for which protection is sought”¹². Furthermore, there is the “subject-matter of the invention”¹³ and the “subject-matter of the patent”¹⁴. A very smart contemplation would possibly be to derive just from the difference alone between the two terms that were the last to be mentioned (i.e. the “subject-matter of the invention”, as something purely technical-factual; in contrast to the “subject-matter of the patent”, meaning the aforementioned having entered the context of Patent Law and also gone through the examination proceedings) that for the interpretation of the term “subject-matter of the patent” in terms of Art. 123 sect. 2 and 100c), aspects from Patent Law have to be considered additionally to technical aspects. At any rate, the author thinks, it is not admissible to deny one understanding of the term “subject-matter of the patent” in one legal context on the grounds that this understanding might lead to inconsistent results in another. The contemplation above refers exclusively to the context of Art. 123 sect. 2 and/ or 100c).

¹¹ e.g. EPC Arts. 57, 63sect.2b, 64sect.2, 70sect.2, 75sect.2, 76sect.1, 77sects.2,4; 84, 87sect.4, 94sect.1, 96 sect.2, 97sects. 1,2; 100a), c); 102 sect.3, 122sect.6, 124 sect.1, 138sect.1a),c); German Paten Law §§ 5(1), 9, 11, 21, 25(6); completely differently in arts.25, 71, 73, 74, 106sect.4, 148, 150sect.2; German Patent Law §§ 15(2), 25(3)

¹² Art.84

¹³ e.g. Art.57

¹⁴ e.g.Art.123sect.2

Particularly, there is no contradiction between the “subject-matter of the patent” of German Patent Law § 9 and EPC Art. 123 sect. 2. From the formal point of view alone, these two mentions figure in different legal sources (German Patent Law vs. EPC); but what is at least equally important: They figure in different contexts as regards the substantive quality. Whereas Art. 123 sect. 2 concerns shaping the right and thus the question of the right to the patent, German Patent Law Art. 9 is concerned with the “effect of the patent”, and thus with the question of the right from the patent. It must also be taken into consideration that the “subject-matter of the patent” mentioned there is also co-determined by the interpretation rules of Art. 69, which, for their part, concern only the right from the patent, and thus receives a particular relevance for the question of the right from the patent, which cannot, just for the reason of the same wording, be in every case transferred to the question about the right to the patent, for which Art. 69 is irrelevant.

Looking at all the references to a “subject-matter” in the EPC, one thing will be striking: the “subject-matter” is regularly used as a starting point or as the basis for a particular right, proceeding or procedural act (e.g. a decision). Under this aspect, the term “subject-matter” may be generally understood as a synonym to a “legal object”¹⁵, such as it is done referring to German Law, in Creifeld’s Law Dictionary¹⁶.

Since this legal object is, according to the principle of disposition, subject to the patentees disposition (according to Creifeld, to the “legal power” of a “legal subject”); and since the holder of the patent - by means of a request as proposed earlier in this essay – brings, after all, about a situation in which the illegal broadening is void regarding right-constitutive issues (e.g. derivation and broadening interpretation) (but not regarding the limitations of the right!), it is thus not subject to legal treatment, for the articles of the EPC concerning patentability will not “see” the feature ZZZ, so that it is not part of the “legal object” and thus not of the “subject-matter of the patent”, in terms of Art. 123 sect. 2, either.

Interpreting the term “subject-matter of the patent”, one will, particularly on the opponent's side, frequently meet, as a matter of course, a literary understanding of the term, namely: everything will be regarded as part of the “subject-matter of the patent” that has been physically put down in a patent claim; quite similar to a poem, to which doubtlessly belongs everything that figures in it.

¹⁵ which, however, the English term “subject-matter” does not match really well, in contrast to the French version “objet”, which does match really well

¹⁶ *Creifeld’s Rechtswörterbuch* (Law Dictionary), 11th edition: (Authors translation): “The subject-matter is the legal object subjected to the legal power of a legal subject. The term s.-m. encompasses (physical) things and other, non-physical things, particularly such as rights, claims and other objective assets, such as a company’s goodwill, energy services etc. which – as long as tangible – are frequently handled as things (purchase of electrical current, heat, etc.).”

The author, however, is of the opinion that this interpretation is incomplete. Even the EPO's Enlarged Board of Appeal uses a "technical" rather than a "literary" interpretation of the term "subject-matter" by regarding everything that does not contribute technically as not being part of the subject-matter, although it figures in the patent claim. Since, as elaborated above, further trains of thought will bring one to the conclusion that not only technical but also legal contemplations are necessary for the interpretation of the term "content" as well as for "subject-matter", it seems appropriate to use for the term subject-matter neither a literary nor a purely technical understanding, but rather a combination from a technical and a legal understanding, which also takes into account whether a feature is to contribute or has contributed to patentability, and whether it is able to extend the scope of the patent to the patent in ways of interpretation. If such a combined technical-legal understanding of the term "subject-matter" is used, and when a not-disclosed feature ZZZ of a patent claim, has not been taken into account for patentability – such as elaborated above – this patent claim is in accordance with Art. 123 sect. 2 and/or 100c). Since Art. 123 sect. 3 has not been violated, either, one has escaped the trap.

To sum up: There are two lines of argument for a feature that has not been taken into account for patentability not to be regarded as "being part of the subject-matter of the patent":

- Since the feature ZZZ has not been taken into account ("was invisible"), it did not contribute technically, and it would thus have to be immediately subordinated to one of the uncritical cases of G1/93.
- Since it has not been taken into account, it has, in the least, made no contribution to patentability, so that according to a technical- legal understanding of the term "subject-matter of the patent", it does not belong to the latter, either.

Once the feature ZZZ does not belong to the "subject-matter of the patent", it cannot violate Art. 123 sect. 2.

e) The decision G1/93

In decision G1/93, the EPO's Enlarged Board of Appeal dealt with the problem of the "trap". In praxi, G1/93 is in its superficial result of no help for escaping the trap. The set of cases that it studies, which, according to G1/93, do not require revocation of the patent (no technical contribution; replaceable by disclosed features without extending the scope of the patent) are rather exotic, so that in the present modus operandi they will seldom apply to the cases occurring in reality. In so far, the "trap" has not been deactivated by G1/93 but rather prima facie confirmed.

The author is of the opinion, though, that the *modus operandi* suggested above is still not contrary to the statements of the mentioned decision. It rather develops it further. The statements in G 1/93 important for the ideas of this essay can be summed up as follows:

- No. 5 of the grounds for decisions touches upon the idea that has already been considered in earlier EPO jurisdiction, namely to retain a feature that has not been disclosed in the claim if it is of no relevance to the judgement of inventive activity. The ground for non-violation of Art. 123 sect. 2 set forth in this earlier case law – ranking considerations amongst sections 2 and 3 of Art. 123 - is being dismissed in no. 13 of the grounds for decision. In contrast to the earlier EPO case law just mentioned, this essay does not substantiate the non-infringement of Art. 123 sect. 2, by a non-disclosed feature retained in the patent claim, by means of ranking considerations amongst individual norms; but rather by means of a proper-seeming interpretation of the term “subject-matter of the patent”.
- No. 6 of the grounds for decision touches upon the so-called “footnote solution”, also referring to German Patent Law § 38. The way the considered footnote is to function and the way it is to be understood, remain unclear, though. Maybe this is a further reason why this solution is dismissed in no. 14, on the grounds that the EPC offers no basis for this. But one may certainly say that the EPC is – at least formally – not opposed to the insertion of a “footnote” such as elaborated under 3c)¹⁷. A patent is not only a text of technical content, but also a right, which, apart from the technical part contains a great deal of legally relevant information (applicant, date of filing the application, priority, ...) which, accordingly, will also be published. It is therefore not clear why the insertion of a footnote in the patent documents and its ensuing publication, such as proposed above, should not be possible.
- No. 16 of the grounds for decision makes comments as to just what is to be understood by the “subject-matter” of the patent¹⁸. Whatever did not contribute technically is, according to no. 2 of the grounds, not to be regarded as subject-matter in terms of Art. 123 sect. 2. The *modus operandi* suggested above may be subsumed under these comments, because if the critical feature ZZZ was ignored in the decisionmaking, it did not contribute technically and did

¹⁷ e.g. Art.84, r.27, r.29

¹⁸ „If, on the other hand, the feature in question merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such feature cannot reasonably be considered to give any unwarranted advantage to the applicant. Nor does it adversely affect the interests of third parties (cf. paragraph 12 above). In the view of the Enlarged Board, such feature is, on a proper interpretation of Article 123(2) EPC, therefore not to be considered as subject-matter extending beyond the content of the application as filed within the meaning of that provision. It follows that a patent containing such a feature in the claims can be maintained without violating Article 123(2) EPC or giving rise to a ground for opposition under Article 100(c) EPC.“

thus not justify a right, although, in a literary sense, it still figures in black and white, i.e. in the patent claim.

G1/93 starts thinking about ascertaining the “subject-matter” also with reference to the “contributing effects” of features. In so far, the suggestion made above is in line with the mentioned decision. By means of the *modus operandi* and the understanding of the term “subject-matter of the patent” propagated in this essay, the G1/93 is being developed further. From this basis, it is quite obvious that EPC Art. 123 sect. 2 has not been violated.

f) Official practice: disclaimer

The EPO does knowingly grant patent claims with non-disclosed technical information: the so-called disclaimers¹⁹. Disclaimers were admitted, at least for a long time, in order to distinguish inventions from state of the Art. Frequently, value ranges or individuals of chemical compound groups were concerned, the disclaimer exempting particular value ranges of individuals. The exempted value ranges of individuals did not have to be explicitly originally disclosed. By inserting a disclaimer, also novelty of a patent claim in contrast to state of the art was established. These disclaimers had technical and right-justifying relevance (exempting a value range, establishing novelty), and they were admitted. G1/93 has already taken notice of this practice, but has not further commented it. The use of non-disclosed disclaimers has been questioned recently, particularly with reference to the decision G2/98²⁰ of the EPO’s Enlarged Board of Appeal. But, if for many years, the addition of features of technical and right-justifying relevance were regarded admissible, it should be all the more feasible to keep up patent claims containing features that did not contribute technically or justify the right to the patent, as elaborated above.

g) National Law in Germany

Regarding Art. 125, it is sensible and necessary to have a look at national approaches to the subject under discussion, too. This essay deals with the aspect of German Law. One will notice, that, when faced with approaches of German Patent Law, the contemplation and *modus operandi* suggested above is neither far-fetched nor bizarre. It can, to a certain extent, even be regarded to be in agreement on the system, and in certain areas even as predetermined.

¹⁹ A survey is provided in „Case Law of the Boards of Appeal“, Ch.II.B.1.2.1, III.A.1.6.3

²⁰ OJ EPO 2001, 413

German Patent Law ("PatG") § 38²¹ provides a passage corresponding to the above proposal. According to the author's observation, this passage is sometimes understood thus that it refers most of all to the right from the patent (scope of the patent). This is not the case, though; at least not exclusively so. PatG § 38 refers to the issue of shaping the right and thus to the issue of the right to the patent (patentability). This means that § 38 does not primarily address the judge in the infringement suit²², but, at least, also the examiner at the German Patent and Trademark Office and/or the judge of a Board of Appeal or the Nullity Board at the Federal Patent Court when they have to decide on patentability. German Patent Law thus also provides that from amendments extending the subject-matter of the application, no right to the patent can be derived; they must not be taken into account. However, § 38 does not stipulate that such amendments must be removed from a claim, should they have occurred. Quite to the contrary, PatG § 38 obviously assumes that an illegal broadening may be retained in the patent claim if no rights are derived from this, because otherwise this regulation would be superfluous in this respect.

The decision "Flanschverbindung"²³ is the "footnote decision" by the Federal Patent Court, cited in G1/93. Here, a solution to the problem of the trap is suggested, to the purpose that the illegal feature be retained in the patent claim but that the description of the patent include a note (called a "limitation" in the decision) that reads (translated) as follows:

"Herein, the feature in claim 1, that the screw heads are seated in the depressions with lateral tolerance, constitutes an illegal broadening from which no rights can be derived.

In vain will one look, in the decision, for any hints as to which effect the so called "limitation" should have; and whether any rights were already derived from the illegal broadening, particularly the right to the patent, by taking the feature into account when assessing the issue of inventive activity. If the feature was taken into account, the decision by the Federal Patent Court does not seem to make much sense, because this would mean that the holder of the patent had derived their right to the patent from the illegal broadening; and the other way round: If not, the "Flanschverbindung"- decision is, at least as far as the essen-

²¹ Authors translation of PatG § 38 [Amendments of the application, inadmissible broadenings]: „Up to the decision to grant the patent, amendments of statements in the application are admissible as far as they do not broaden the subject-matter of the application, before filing the request for examination (*f* 44), however, only as far as the correction of obvious incorrectnesses, the removal of defects objected to by the examiner or the amendments of a claim is concerned. No rights can be derived from amendments which broaden the subject-matter of the application.“

²² A judge will only be addressed in case a feature which has not been disclosed is to be used for interpreting a patent claim

²³ Federal Patent Court, decision dating from June 28th, 1988, GRUR 1990, 114

tial outcome is concerned, in line with the idea of this essay; only the note in the description would render just one part of the story. What speaks against this assumption, though, is the remark in the decision, that the Board granting the patent explicitly refused to include the passage into the "limitation", according to which the holder of the patent would have to allow the feature against themselves. This makes the decision hard to understand because in this case one might draw the conclusion that the holder of the patent does not have to allow the feature against themselves; which would, in the least, also mean that a potential infringer will not get away with the imaginary argument "I am not infringing because my product does not have feature ZZZ", for the holder of the patent does not have to allow the feature ZZZ as a factual limitation to their right. This would be absurd. The decision "Flanschverbindung" on the whole appears strange.

The same is true of the decision "Steuerbare Filterschaltung"²⁴ by the Federal Patent Court, dating from 1987. It holds that deleting a feature ZZZ is admissible and gives reasons for this, which are complex and thus difficult to transfer to EPC. On the one hand, it comments to the "footnote solution" (namely, in no. II.2), to the effect that there the illegally broadening feature probably has not been taken into account when assessing patentability; but on the other hand, it refuses *expressis verbis* to join this *modus operandi*: The ensuing observations to the derivation of the right seem rather strange: "if during the infringement proceedings [...] no derivation of rights from the illegal feature would be [...] allowed ..." This makes one wonder just what kind of derivation of rights (during infringement proceedings!) is being discussed here. The patent claims themselves and/or the features in them are no "derived right", but rather, only as one, its derivation (in as far as the features of the claims were taken into account) and its limitation. The right from the patent, enforced during the infringement suit, is not brought about by the patent claims or its features, but rather factually limited thereby. The legal bases for the infringement suit are PatG §§ 9 through 13. The right to the patent is not derived during the infringement proceedings, but during the examination proceedings. One gets the impression that possibly the terms "right", "derivation of a right" and "limitation of a right" were not differentiated, which is of no great help for the clarification of the matter.

The comparably recent decision by the Federal Court of Justice called "Zeitlegramm"²⁵ thankfully sheds light on the matter. The Federal Court of Justice said concerning the trap problem:

"As regards the interest concerning the scope of the patent, i.e. the extent of an accruing patent right, this requirement has also been met by keeping up the narrower formulation of the granted patent claim. [...] So only care has

²⁴ Mitt.98, 221

²⁵ Federal Court of Justice, „Zeitlegramm“, GRUR 2001, 140

to be taken that as for the rest, i.e. as regards the accruing of patent rights, no rights be able to be derived from the amendment. This does not require the revocation of the granted disputed claims, though. Only the knowledge gained from the later amendment must not be used for positively settling the issue of patentability.”

The case did not give the Federal Court of Justice cause for further elaborations, such as necessity, admissibility and design of a footnote because the case was already settled then. What the Federal Court of Justice says in “Zeitlegramm”, though, anticipates the above suggestion for German Law. Due to Art. 125, the EPO will certainly have to include the BGH decision mentioned above in their future *modi operandi*.

5. Summary

An important term of Art. 123 section 2 and 100c) and 138c), namely the “subject-matter of the patent” has not been made sufficiently clear. If one uses a to some extent prejudiced technical-legal understanding that seems consistent with regard to contemplations about renunciations along the lines that, at any rate, something has not to be considered as being part of the subject matter of the patent that has not substantiated the right to the patent, patent claims that contain an illegal broadening may be in accordance with Art. 123 section 2 and/or 100c) if the feature in question was factually not taken into account when establishing patentability. In line with the principle of disposition, the holder of the patent can bring this about by means of a suitable request. Thus, the purpose of Art. 123 section 2 has also been fulfilled, since the holder of the patent derived no advantages from the broadening that would not have been recognizable in the very beginning. This means, one has escaped the trap of Art. 123 sections 2 and 3, which seems all the more welcome since the present *modus operandi* has to be regarded, because of its punishing character, as alien to the system, maybe even as legally problematic.