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D E C I S I O N
of 2 February 1994

Case Number: G 0001/93
Application Number: 82306422.5
Publication Number: 0084221
IPC: G02B 5/00, B29D 11/10

Language of the proceedings: EN

Title of invention:
Method for the manufacture of a thin optical membrane

Patentee:
Advanced Semiconductor Products

Opponent:
Mitsui Petrochemical Industries

Headword:
-

Relevant legal norms:
EPC Art. 123(2), (3)

Keyword:
"Conflicting requirements of Article 123, paragraphs (2) and (3) EPC"

Decisions cited:
T 0231/89 (OJ EPO 1993, 13) G 0003/89 (OJ EPO 1993, 117)

.../...

Headnote:

1. If a European patent as granted contains subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC.

2. A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC. The ground for opposition under Article 100(c) EPC therefore does not prejudice the maintenance of a European patent which includes such a feature.

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Headword:

Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS

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EPC Art. 123(2), (3)

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"Conflicting requirements of Article 123, paragraphs (2) and (3) EPC"

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Case Number: G 0001/93

D E C I S I O N
of the Enlarged Board of Appeal
of 2 February 1994

Appellant: Advanced Semiconductor Products
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Respondent: Mitsui Petrochemical Industries Ltd.
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Representative: Senior, Alan Murray
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**Decision referring a
point of law:**

Interlocutory decision of the Technical Board of
Appeal 3.4.2 dated 11 November 1992 in case
T 0384/91.

Composition of the Board:

Chairman: P. Gori
Members: E. Persson
P. Lançon
G.D. Paterson
C. Payraudeau
R. Schulte
P. van den Berg

Summary of Facts and Submissions

- I. European patent number 84 221, concerning a method for the manufacture of a thin optical membrane, was granted in 1987. Independent Claim 1 reads as follows:

A method of making an optical membrane from a solution comprising at least one polymer and at least one solvent, characterized by the steps of depositing the solution on a horizontal surface of a support (8) which is rotatable about a substantially vertical axis: accelerating the support (8) from a first to a second speed of rotation to centrifugally spread the solution radially outwardly; forming the membrane during rotation of the support (8) by evaporation of the solvent in the solution, the radial stresses imposed on the membrane and the said evaporation of the solvent causing the membrane formed to be taut on the surface and **substantially free of striae** (emphasis added); and removing the membrane, after formation, from the surface of the support (8).

- II. The patent was opposed on all the grounds contained in Article 100 EPC. As far as the ground for opposition under Article 100(c) EPC is concerned, it was submitted, *inter alia*, that the feature "substantially free of striae" in Claim 1 of the patent, being added during the examination of the patent application, constituted subject-matter extending beyond the content of the application as filed. The Opposition Division accepted that submission and revoked the patent in accordance with Article 102(1) EPC (without dealing with any other ground for opposition relied upon by the opponent).

III. The patentee appealed against the decision of the Opposition Division, requesting, before Technical Board of Appeal 3.4.2, that the case be remitted to the first instance for further prosecution on the basis of certain amendments of the claims of the patent in suit. As to the feature "substantially free of striae" in Claim 1, it was suggested, by way of auxiliary requests, to replace that expression by "of substantially uniform thickness" or to insert at the end of the description the following statement: "The words 'substantially free of striae' in Claim 1 did not appear in the application as filed. However, there is no contravention of Article 123(2) EPC, because these words are to be understood as equivalent to 'of substantially uniform thickness'".

The opponent requested that the appeal be dismissed.

IV. Technical Board of Appeal 3.4.2, having analysed the technical implication in the present context of the term "striae", which, for the purpose of the present case before the Enlarged Board of Appeal, may be regarded as a kind of irregularity within an optical membrane (filament, faint ridge, etc.), giving rise to distortion of light passing through the membrane, came, in its interlocutory decision of 11 November 1992, to the conclusion that the added feature "substantially free of striae", although not being precise in its scope, was not void of technical meaning. The Board further considered that, although directed to the product, it formed a limiting feature of method Claim 1, since it determined that the method steps must be such that substantial freedom from striae was achieved. Since the feature in suit could not be derived from the patent application as filed, the Board, like the Opposition

Division, held that it represented subject-matter extending beyond the content of the application as filed in the sense of Article 123(2) EPC.

- V. As to the suggestion of the patentee to replace the feature "substantially free of striae" by "of substantially uniform thickness", Technical Board of Appeal 3.4.2 considered that such replacement would not contravene Article 123(2) EPC, since it was properly covered by the original description. However, it would extend the protection conferred by Claim 1 of the patent as granted in the sense of Article 123(3) EPC in that not only would such a method be protected, the parameters of which are chosen to lead to a membrane substantially free of striae, but also a method which, although leading to substantially uniform thickness, would nevertheless produce striae (which the Board on technical grounds considered could easily be the case).
- VI. In considering the suggested insertion at the end of the description of the statement referred to in paragraph III above, Technical Board of Appeal 3.4.2 found it very doubtful, whether the sense of the added feature "substantially free of striae" could be shifted by such insertion. In any case, the Board considered that such insertion itself would go beyond the content of the patent application as filed in the sense of Article 123(2) EPC, since the expression "substantially free of striae", on the one hand, and the alleged fact that it was equivalent to "of substantially uniform thickness", on the other, were not supported by the original disclosure.
- VII. It appeared to Technical Board of Appeal 3.4.2 that, in the circumstances of the case before it, the requirements for fulfilling paragraphs 2 and 3 of Article 123 EPC went in opposite directions and that any

attempt to remove the feature "substantially free of striae" from Claim 1 of the patent in suit, added incorrectly before grant, would result in extending the protection conferred by the patent.

VIII. Technical Board of Appeal 3.4.2, in considering the principle relationship between paragraphs 2 and 3 of Article 123 EPC, noted that no difficulty arises as long as a patent is correctly granted and that the problems involved in the case before it were created during the examination procedure. The Board held that although an applicant is fully responsible for amendments to the application made or agreed upon by him during examination, some share of responsibility also falls upon the Examining Division if not objecting to inadmissible amendments proposed by an applicant. In the Board's view, it was not a satisfactory situation that an applicant can never be quite sure that amendments proposed or accepted by him during examination, acting in good faith, may not lead him into an inescapable trap.

IX. Having also considered, *inter alia*, how the above problem had so far been dealt with in the jurisprudence of the Boards of Appeal of the EPO and also of the German Federal Patent Court (Bundespatentgericht), Technical Board of Appeal 3.4.2 concluded that the relationship between paragraphs 2 and 3 of Article 123 EPC represents an important point of law which needs to be clarified in order to ensure uniform application of the law. The Board, therefore, referred the following question to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC:

If a European patent as granted contains subject-matter which extends beyond the content of the application as filed and also limits the scope of protection conferred by the claims, is it possible during the opposition proceedings to maintain the patent in view of paragraphs 2 and 3 of Article 123 EPC?

- X. In response to a communication of 17 February 1993, the parties to the appeal proceedings, being parties also to the proceedings before the Enlarged Board by virtue of Article 112(2) EPC, filed observations on the referred point of law; at the request of both parties, oral proceedings took place on 19 October 1993; for the patentee (appellant) spoke Mr. David Young Q.C. and for the opponent (respondent) Mr. Nicholas Pumfrey Q.C.

Reasons for the Decision

1. Insofar as the parties have in their submissions before the Enlarged Board of Appeal referred to the facts of the case pending before Technical Board of Appeal 3.4.2, the Enlarged Board observes that it is only concerned with the point of law referred to it and that the facts of the particular case before the referring Board may only serve as an illustration of some practical aspects on the principle matter involved. It is also to be noted that it is outside the scope of the proceedings before the Enlarged Board in the present case to consider procedural matters, which are not directly related to the point of law referred to it. Thus, the Enlarged Board will not deal with the matters raised under points 7 and 8 of the letter from the opponent dated 16 June 1993, concerning how Opposition Divisions should

handle cases where patents have been opposed on several grounds and how Boards of Appeal should reason their decisions.

2. In the question put to the Enlarged Board concerning the possibility under given circumstances to maintain a European patent during opposition proceedings, reference is made to paragraphs 2 and 3 of Article 123 EPC. From a formal point of view, it is to be noted, as recognised also by the parties, that in opposition proceedings the provision of **Article 123(2) EPC** is not directly under consideration but rather that of **Article 100(c) in conjunction with Article 101 EPC**. The relevant question is, in fact, whether the ground for opposition under Article 100(c) EPC, that the subject-matter of the European patent extends beyond the content of the application as filed, prejudices the maintenance of the patent. This ground for opposition is related to Article 123(2) EPC in the sense that it is applicable only if the application has been amended during **the proceedings before grant** in a manner contrary to what is allowed under Article 123(2) EPC. Such unallowable amendment may also constitute a ground for revocation of the European patent under the law of a Contracting State to the EPC in accordance with Article 138(1)(c) EPC.

3. As to **Article 123(3) EPC**, which prohibits amendment of the claims of a European patent during opposition proceedings in such a way as to extend the protection conferred by the patent, this provision is obviously directed only to **the proceedings after grant**. An amendment violating Article 123(3) EPC may constitute a ground for revocation of the European patent under the law of a Contracting State to the EPC, as foreseen under Article 138(1)(d) EPC.

4. Problems concerning the application of Article 123(2) and (3) EPC have in the past been dealt with in a number of cases before the Boards of Appeal; some of these cases have been referred to and commented upon by the parties in the course of the proceedings before the Enlarged Board in the present case, in particular T 194/84 (OJ EPO, 1990, 59, T 371/88 (OJ EPO, 1992, 157), T 231/89 (OJ EPO, 1993, 13), T 938/90 (EPOR 1993, 287) and T 108/91 (EPOR 1993, 407 and headnote in OJ EPO, 5/93). Insofar as in these cases the Boards of Appeal have found support in the original applications for replacing added undisclosed technical features by other features without violating Article 123(3) EPC, they seem to be uncontroversial. Nor would it seem to be disputed that an added undisclosed feature without any technical meaning may be deleted from a claim without violating Article 123(3) EPC, as held in case T 231/89. However, the core of the matter before the Enlarged Board in the present case is rather what to do in a situation where, before grant, there was added to a claim an undisclosed limiting, technically meaningful feature, which cannot be deleted or replaced by any other feature properly disclosed in the application as filed without extending the protection conferred by the patent as granted in contradiction to Article 123(3) EPC. This principle matter has so far only been dealt with in some depth in case T 231/89; it was also touched upon in the cases T 938/90 and T 108/91.
5. In case T 231/89, the Board of Appeal held that a scope limiting feature in a claim, added before grant in contravention of Article 123(2) EPC, may remain in the claim notwithstanding its character of added matter, provided such feature is immaterial in respect of the novelty and inventive step of the claimed subject-matter. This consideration has been criticised by the opponent as based on irrelevant speculation about a

relationship between paragraphs 2 and 3 of Article 123 EPC, which was unnecessary to the decision in that case and which took place where no arguments on the question had been advanced. The opponent has also drawn the attention of the Enlarged Board to the fact that even Technical Board of Appeal 3.4.2, in its referring decision, expressed doubts about the above consideration. In the opponent's view, paragraphs 2 and 3 of Article 123 EPC represent quite separate fundamental principles of European patent law being of equal importance and to be applied by the EPO in accordance with their wording.

6. In the course of the proceedings before the Enlarged Board, reference was also made to British and German jurisprudence and doctrine in respect of added undisclosed matters; in particular the so-called "footnote solution" as applied e.g. in a decision of the Bundespatentgericht of 28 June 1988 ("Flanschverbindung"; GRUR 1990, 114) has been scrutinised. This solution is characterised by a statement to be added to the description of the patent in suit to the effect that the undisclosed feature (which is maintained in the claim in order to avoid an extension of the protection conferred) represents an inadmissible extension from which no rights may be derived. The patentee has submitted that a solution along this line could provide one possibility of "neutralising" the effect of an added undisclosed feature, while the opponent, arguing that the "footnote solution" has to be considered as based on a special provision of German law (Section 38 of the Patents Act of 1981) with no correspondence in the EPC, has contended that the addition of a statement to the description in accordance with the "footnote solution" would not have any "neutralising" effect but in fact amount to the adding again of new, undisclosed matter.

The opponent has also drawn the attention to the fact that the "footnote solution" has not yet been considered, let alone approved, by the German Federal Court of Justice (Bundesgerichtshof).

7. The patentee has also referred to the standing practice of allowing disclaimers in order to limit the protection conferred in view of prior art made known to applicants during examination, and submitted that it would be in line with this practice to allow a clearly limiting feature of the kind under consideration in the present case to remain in a claim without invalidating the patent. A similar argument was brought forward by the Board of Appeal in case T 231/89, referred to above.
8. Both parties have referred to and commented comprehensively upon the purposes and functions of Article 123(2) and (3) EPC within the system of European patent law. It seems to the Enlarged Board to be common ground that the main purpose of these provisions is to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other, as reflected also in the Protocol on the interpretation of Article 69 EPC. The problem, however, is of course what constitutes such a fair balance in the circumstances of an individual case.
9. With regard to Article 123(2) EPC, the underlying idea is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. Article 123(3) EPC is directly aimed at protecting the interests of third

parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed.

10. The extent of the protection conferred by a European patent or a European patent application is governed by the provisions of Article 69 EPC. In this respect, it is to be noted that according to Article 69(2) EPC, the patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the application, insofar as such protection is not thereby extended. In other words: even if the claims of the patent as granted are broader than those of the application as published, which may be the case provided there is a basis for that in the application as filed, third parties' rights are not affected by such broadening for the period up to grant of the patent; if, on the other hand, the claims of the patent as granted are narrower than those of the application as published, third parties are benefiting from this as from the outset.

11. From the point of view of legal security for third parties, relying on the content of a patent application as filed and published, the adding of undisclosed subject-matter, **which may provide a basis for extending the protection conferred by the patent as granted** in comparison with what was disclosed and claimed in the application as filed, represents obviously a real danger. Such added matters may be generalisations of specific features or embodiments and the introduction of new alternatives. In principle, it does not matter whether the addition concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Article 69 EPC and the Protocol on the interpretation of this provision.

However, the claims are no doubt the most important element in this respect. If during examination of an application, added subject-matter of such **non-limiting character** is introduced contrary to Article 123(2) EPC and objection is raised in opposition proceedings under Article 100(c) EPC, the added matter can be removed from the patent without violating Article 123(3) EPC, since the protection conferred by the patent is not being extended but narrowed, and the patent be maintained in amended form on the basis of the content of the application as filed in accordance with Article 102(3) EPC. In other words: a fair balance between the interests of the patentee and third parties can be restored.

12. However, the point of law referred to the Enlarged Board in the present case does not concern the situation referred to above but the special case that an undisclosed technical feature, **limiting the scope of protection of the claims of the patent as granted** in comparison with the application as filed and published, has been added during examination. From the point of view of legal security for third parties, obviously this case differs fundamentally from the above situation in that third parties, having relied on the application as filed and published, are not being faced with a granted patent with a wider scope of protection than could be foreseen but with a patent conferring less protection and thus interfering to a lesser extent with their activities.
13. The Enlarged Board agrees with the opponent that there is no support under the EPC for the idea expressed by the Board of Appeal in case T 231/89, that there is a mutual relationship between paragraphs 2 and 3 of Article 123 EPC, the one to be applied as primary and the other as subsidiary depending on the facts of the

individual case. This interpretation is not in line with the mandatory character of Article 123(2) EPC, as explained by the Enlarged Board in its opinion in case G 3/89 (OJ EPO 1993, 117). Paragraphs 2 and 3 of Article 123 EPC are mutually independent of each other. Thus, if a limiting feature is considered to fall under Article 123(2) EPC, it cannot be maintained in the patent in view of Article 100(c) EPC, nor can it be removed from the claims without violating Article 123(3) EPC. Only if the added feature can be replaced by another feature disclosed in the application as filed without violating Article 123(3) EPC, the patent can be maintained (in amended form). This may in practice turn out to be a rare case. In this sense, it must be admitted that Article 123(2) in combination with Article 123(3) EPC can operate rather harshly against an applicant, who runs the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment is limiting the scope of protection. However, as submitted by the opponent, this hardship is not *per se* a sufficient justification for not applying Article 123(2) EPC as it stands in order to duly protect the interests of the public. Nor does it, in principle, matter, that such amendment has been approved by the Examining Division. The ultimate responsibility for any amendment of a patent application (or a patent) always remains that of the applicant (or the patentee).

14. The Enlarged Board also agrees with the opponent that there is no basis under the EPC for a "footnote solution" of the kind referred to in paragraph 6 above. This follows from the mandatory character and effect of Article 123(2) and (3) EPC as discussed in the previous paragraph, as well as from the functions of the description and claims of a patent granted under the European patent system.

The main function of the description of a European patent is to disclose the invention so that it may be carried out (Article 83 EPC). The function of the claims is to define the subject-matter which is to be protected in terms of its technical features (Article 84 and Rule 29(1) EPC). If a technically meaningful feature is included in a claim of a granted patent, Article 69(1) EPC requires that such feature, in combination with the other technical features of the claim, should be taken into account by a national court when it determines the extent of protection conferred by the patent, during infringement proceedings under national law pursuant to Article 64(3) EPC, for example. Article 69(1) EPC and the Protocol to Article 69 EPC allow reference to be made to the description of a patent for the purpose of interpreting the wording of such technical features of a claim and thus determining the subject-matter which is to be protected. However, none of the above provisions of the EPC envisages or allows a statement to be included in the description of a particular patent, qualifying the rights which may be derived from the presence of a particular technical feature in a claim of that patent. In the Enlarged Board's view, the introduction of such a statement in a patent during opposition proceedings, as envisaged by the so-called "footnote solution", would be incompatible with the European patent system having regard to the above-mentioned provisions of the EPC, and would go beyond the competence of the EPO within such system.

15. The above conclusions are based on the assumption, that the added feature in question falls within the concept of **subject-matter which extends beyond the content of the application as filed** in the sense of Article 123(2) EPC. It remains, however, to be considered whether a limiting feature necessarily has always to be regarded as such subject-matter. This question must be answered

in the light of the overall purpose of Article 123(2) and (3) EPC to create a fair balance of interests, as explained in paragraphs 8 and 9 above, and having regard also to the effect of Article 69(2) EPC as referred to in paragraph 10 above.

16. Whether or not the adding of an undisclosed feature limiting the scope of protection conferred by the patent as granted would be contrary to the purpose of Article 123(2) EPC to prevent an applicant from getting an unwarranted advantage by obtaining patent protection for something he had not properly disclosed and maybe not even invented on the date of filing of the application, depends on the circumstances. If such added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to the patentee contrary to the above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter in the sense of that provision. A typical example of this seems to be the case, where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom. 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 effect 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** in the sense 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. The feature being maintained in the claims, there can be no violation of Article 123(3) EPC either.

17. Whether or not a limiting feature is to be considered as added subject-matter in the sense of Article 123(2) EPC, can, of course, only be decided on the basis of the facts of each individual case.

Order

For these reasons, it is decided that:

The question referred to the Enlarged Board of Appeal is to be answered as follows:


1. If a European patent as granted contains subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC.

2. A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC. The ground for opposition under Article 100(c) EPC therefore does not prejudice the maintenance of a European patent which includes such a feature.

The Registrar:


J. Rückerl

The Chairman:


P. Gori