

Added Matter Part 2

Pre-Grant Amendments

- Broadening the scope of a claim before grant is allowed as long as the resulting claim is clearly and unambiguously disclosed in the application as filed
- An optional feature can therefore usually be deleted from a claim without violating Article 123(2) EPC.
- However, oxymoronicly, there are still ways to add matter when deleting features from a claim.

Intermediate generalisations

- An undisclosed combination of features that lies between two disclosed embodiments is an intermediate generalisation.
- E.g. if a description discloses a first example having feature A, and a second example having features A+B+C, an amendment to delete C (leaving only A and B) would be an intermediate generalisation between the first and second examples.

Shrinking lists

- An amendment to shrink a list (by deleting items within the list) can also add matter.
- This can be a particular issue in chemical application where generic chemical formulae are used, often with multiple options for each substituent.
- The deletion of items from lists must not lead to the selection of a particular combination of features that was not originally disclosed.

Post-Grant Amendments

- Unlike pre-grant amendments, an amendment post-grant cannot broaden the scope of a granted claim. This is governed by Article 123(3) EPC.
- This can lead to an inescapable trap if an added matter objection under Art.123(2) EPC is raised post-grant that cannot be remedied without deleting a feature.
- Applicants are therefore advised to check basis for claim limitations carefully.

Practical tips to navigate added matter:

Provide a general disclosure of each feature, not linked to other features

Include statements describing preferred combinations of features

Include multiple dependent claims or numbered embodiments

Avoid relying on figures or examples for basis if possible