

EPO tightens up on strict European amendment practice

Szonja Szenczi-Molnár of Inspicos explains why patent applicants should clearly explain the alternatives and possible combinations concerning claims when drafting description text, in light of a ruling on the allowability of amendments

Under existing EPO practice, an amendment that introduces subject matter that extends beyond the content of the application as filed is unallowable, if the change results in the skilled person being presented with information that is not directly and unambiguously derivable from the content of the application as filed.

A decision by an EPO technical board of appeal ([T 1137/21](#)) in June 2023 relates to the allowability of amendments. Claim 1 of the main request was based on claims 1, 4, 9, 11, 13, and 17 as originally filed. The appellant (the patent proprietor) argued that the examples fell under the wording of the claim and that claim 1 did not present the skilled person with new information.

The board of appeal disagreed.

Claim 1 was found to be the result of multiple selections of very specific combinations of features present in different dependent claims, made from among numerous possibilities, having varying degrees of preference. No passage of the original application disclosed the features of claim 1 in combination. While the examples fell under claim 1 of the main request, they were under the most preferred options of the various parameters and ranges, and thus were not sufficient as pointers to the specific selections of claim 1.

Claim 1 did not relate to converging alternatives ([T 1621/16](#)) either, due to the lack of pointers. Additionally, some amendments were found to be an arbitrary combination of end points.

Therefore, when drafting patent applications, it is recommended that the description text clearly explains the alternatives and their possible combinations, or at least contains pointers to allow the combination of the less-preferred embodiments, if relevant, in a clear and unambiguous manner.