

Added Subject-Matter (Art. 123(2) EPC)

How to Avoid Pitfalls in EPO Applications and Patents!

Topics

- How to avoid pitfalls in examination and opposition proceedings with regard to Art. 123(2) EPC
- Taking the necessary precautions when drafting the original application
- Case law of the Boards of Appeal on Art. 123(2) EPC
- WORKSHOP: exercises on added subject-matter and intermediate generalisation

**Avoid loss
of application
and patent!**

Your speakers



Daniel Xavier Thomas
Former Director, Directorate-General 1 - Operations,
European Patent Office,
Munich (Germany)



Harrie Marsman
MSc, European and Dutch
Patent Attorney, Of Counsel,
V.O. Patents and Trade-
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Art. 123(2) EPC: How to Avoid Pitfalls!

Aims and objectives

The concept of added subject-matter for an application or a patent under Art. 123(2) EPC is a very important concept in European patent law. An application to which matter has been added with respect to the originally filed documents is generally refused. Similarly, a patent containing added subject-matter is generally revoked in opposition or nullity proceedings. Thus, it is important to be well informed on the topic and to avoid pitfalls which can be easily circumvented, either when drafting an application or when amending it during grant, opposition or nullity proceedings. It is also important to be aware of the significant body of well-established case law of the Boards of Appeal of the EPO, which over time has become increasingly stringent. The aim of the seminar is to show all aspects which have to be taken in account in order to avoid the pitfall of an objection under Art. 123(2) EPC at any time during prosecution of the application or the life of a patent.

Who should attend?

You work in an IP, patent or R&D department or as a patent attorney in private practice and want to avoid pitfalls when it comes to added subject-matter? Then this course is intended for you. Knowledge of patent law is required.

Event information

Learn more on sufficiency of disclosure in EPO applications in our Art. 83 EPC course at the same location the day after (webcode 19 10 180).

Your speakers



Daniel Xavier Thomas
Former Director, Directorate-General 1 - Operations of the EPO

Daniel X. Thomas is an electronics engineer by training. He started his career in the patent field in 1971 and has at last been heading directorates in various fields of electronics, physics and mechanics. Although he retired from active service at the EPO in 2013., D.X. Thomas continues to be active in the field of IP. To that effect he is leading workshops/seminars relating to various aspects of the European granting procedure. Daniel X. Thomas is also working as consultant in IP matters for various firms around Europe: legal practitioner firms, patent representatives or technical companies.



Harrie Marsman
MSc, European and Dutch Patent Attorney, Of Counsel, V.O. Patents and Trademarks, The Hague (NL)

Harrie Marsman is a chemist by training and started as a trainee in the patent profession in 1989 at V.O. Patents and Trademarks. Since 1994, he is a European Patent Attorney and since that time his focus was on opposition proceedings, especially in the fields of plastic polymers, food technology, household and personal care products. After having been partner in the V.O. firm for 20 years, he is now an Adviser for V.O. In addition, Harrie is training young professionals in the patent field, in particular for the Dutch national exam and the European Qualifying Examination.

23 October 2019, 09:00 - 17:00

Added Subject-Matter in EPO Applications and Patents

- What is to be understood under 'direct and unambiguously derivable' from the originally filed application documents?
- Examples of amendments non-allowable under Art. 123(2) EPC
- Reference documents for the application of Art. 123(2) EPC
- Necessity to indicate amendments and their basis
- Features from a cross-referenced document
- Added subject-matter and clarity
- Other not allowable cases of adding subject-matter: prior art described in the application

Three Points Test (Former 'Essentiality Test')

- Not allowable intermediate generalisation; allowable intermediate generalisation
- Intermediate generalisation and priority; conclusions to be taken

Revision of the Stated Technical Problem

Broadening of Features

Modified Novelty Test

Correction of Errors in Applications and Decisions

- Correction of errors in applications
- Correction of errors in decisions

Missing parts of description/drawings at filing

Added Subject-Matter and extension of protection

Disclaimer

- Disclosed disclaimers (Type I)
- Undisclosed disclaimers (Type II, according to G 1/03)
 - Allowable undisclosed disclaimers
 - Not allowable undisclosed disclaimers - G 1/16
 - Drafting of disclaimers
 - Disclaimer and priority
- Disclaimers excluding embodiments of the invention (Type III, according to G 2/10)

Registration under
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Registration Form

Yes, I will attend the Practical Course

Added Subject-Matter (Art. 123(2) EPC)

Yes, I agree that FORUM Institut may inform me about events and relevant expert content by:

email; and/or telephone.

I may withdraw my consent at any time.

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How to register

Registration: +49 6221 500-500

Conference no.: 19 10 181

Website:

www.forum-institut.com

Date and venue

Wednesday, 23 October 2019 in Amsterdam
09:00 - 17:00

DoubleTree by Hilton Amsterdam Centraal Station
Oosterdokstraat 4 · NL 1011 Amsterdam
Tel. +31 20 5300800 · Fax +31 20 5300801

Fee

€ 1120.00 (+ 21% VAT)

The fee includes course documentation (including free download) as well as refreshments, lunch and a certificate. You will receive an invoice as well as confirmation.

Any Further Questions?



Please feel free to contact me if you have any questions.

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