

Inadmissible extensions under German Case Law

The direct and unambiguous differences in comparison to standing EPO practice

The recent decision “Bausatz” of the German Federal Supreme Court dated February 13, 2020 (docket no. X ZR 6/18) is noteworthy for the clear illustration of the criteria the German Federal Supreme Court applies to the assessment of inadmissible extensions¹. The Federal Supreme Court’s general approach is partially in contrast to the practice pursued by the Boards of Appeal of the EPO. The differences are of particular relevance for the allowability of claims containing (intermediate) generalizations of originally disclosed, more specific embodiments.

Facts and Findings of the Case

The patent in dispute was the German part of European Patent EP 1 338 711. The subject matter of claim 1 is directed to a “kit comprising an article (17) to be suspended on a wall and a fixing arrangement (10) for the article, which arrangement comprises a tube (11), a clamping sleeve (18), a screw element (24) and a pre-mounting housing (19) for producing contact between sleeve (18) and article (17)”.

In the originally filed application, the problems to be solved by the invention are stated in paragraphs [0010] to [0013]. According to this passage of the description, the object of the invention is to provide a fixing arrangement for wall-mountable articles which allows for a precise and secure fastening, is simple to mount without visible mounting points, and does not impair the overall aesthetic appearance. Further, it is stated that the fixing arrangement should also be flexible with regard to its application with different types of articles and walls.

Figure 5 of the patent in dispute (reproduced above) illustrates the configuration of the claimed kit according to a first of two embodiments described in the patent in dispute. The article 17 is highlighted in yellow. The fixing arrangement 10 comprises the four other elements highlighted in color above. The pre-mounting housing 19 is highlighted in green. According to a feature of claim 1 the pre-mounting housing is configured to establish a contact between the sleeve 18 (blue) and the article 17.

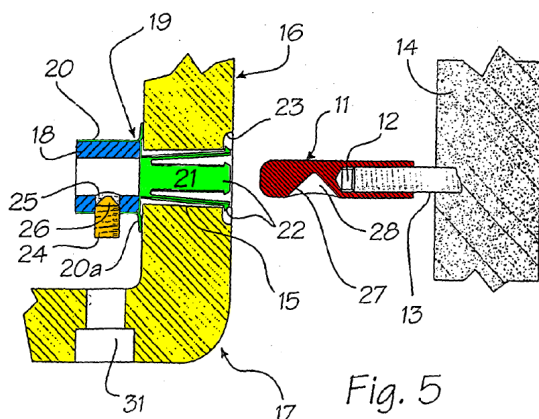
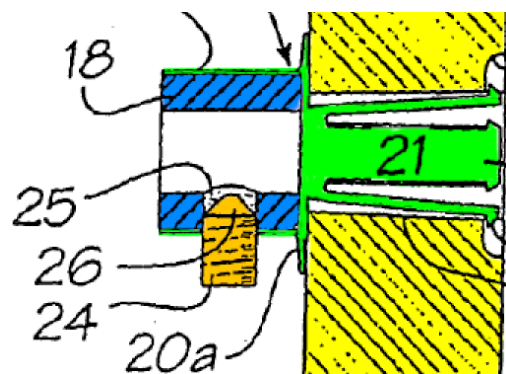


Fig. 5 of the patent in dispute,
emphasis added



Detailed view of fig. 5 of the patent in dispute,
emphasis added

¹Also referred to as added subject-matter or inadmissible broadening in the jurisprudence and literature

In both embodiments described in the patent in dispute, the contact of the pre-mounting housing 19 with the article 17 is established by elastically deformable tongues 21 of the pre-mounting housing 19 with hook-form ends 22 that engage in a seat 23 of the article 17.

As referred to in the decision, according to the first embodiment, the pre-mounting housing 19 houses the clamping sleeve 18 (cf. figure 5 reproduced above). Concerning the second embodiment, it is indicated in the decision that no particular element is provided to establish contact between the sleeve 18 and the article 19 by means of pre-mounting.

Claim 1 as granted contains the feature of “a pre-mounting housing (19) for producing contact between sleeve (18) and article (17)” (“the feature in dispute”), which had been added to claim 1 by the Examining Division with the communication according to Rule 71(3) EPC in the “Druckexemplar”.

Figure 7 of the patent in dispute (reproduced below) illustrates the configuration of the claimed kit in the position in which the article 17 is fixed to a wall 14 by means of the fixing arrangement 10.

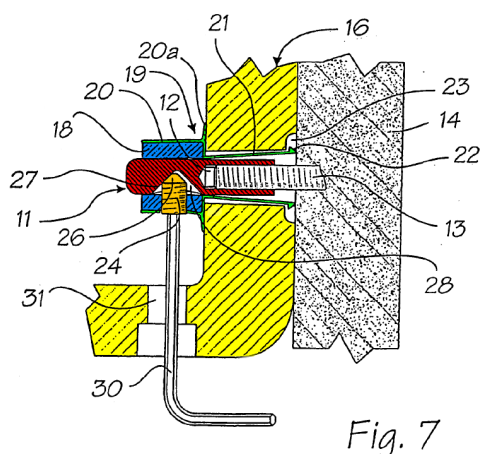


Fig. 7

Decision of the Federal Patent Court

In the first instance, the Federal Patent Court held that the feature in dispute constituted an inadmissible extension, since the originally filed application documents do not disclose the feature in dispute in such a general manner as contained in the claim, i.e. that the pre-mounting housing is configured to establish a contact between the sleeve 18 and the article 17.

The Federal Patent Court ruled that there was no direct and unambiguous disclosure for the generalization that the contact between sleeve 18 and article 17 is conveyed by the pre-mounting housing, without specifying the structural contact-establishing means disclosed in the specific embodiments of the description.

According to both embodiments disclosed in the application as filed, the contact between the pre-mounting housing 19 and the article 17

is established via predominantly axially running tongues 21 resiliently deformable under bending stress. The tongues 21 are insertable into a hole 16 of the article 17 to be suspended until their hook-form ends 22 engage in a seat 23 that is formed at the end remote from the insertion end of the article 17.

In this regard, the Federal Patent Court noted that the two embodiments differ in the contact producing means between the pre-mounting housing 19 and the sleeve 18. However, both embodiments disclose elastically deformable tongues 21 with hook-shaped ends 22 for producing contact between the pre-mounting housing 19 and the article 17. No other means for producing contact between the pre-mounting housing 19 and article 17 are disclosed in the application as filed.

The feature in dispute generalizes the contact mediation between sleeve 18 and article 17 via the pre-mounting housing 19 by omitting the specific configuration for the means that establish contact between pre-mounting housing 19 and article 17.

Based on these observations, the Federal Patent Court concluded that the feature in dispute is not derivable from the originally filed application documents in a sufficiently direct and unambiguous manner to justify said generalization.

Decision of the German Federal Supreme Court

The Federal Supreme Court refuted the findings of the Federal Patent Court on the feature in dispute and held that the omission of the specific contact-establishing features in claim 1 did not constitute an inadmissible extension.

The feature in dispute is disclosed in paragraph [0022] of the application as filed, which reads (emphasis added):

[0022] The contact between the sleeve 18 and the sanitary article 17 is conveyed by a pre-mounting housing 19 made of plastic, which has a cup-shaped section 20 for receiving the sleeve 18 and several diverging, mainly axially extending tongues 21 which are elastically deformable under bending and can be inserted into the hole 15 outside the tube 11 until their hook-shaped ends 22 engage in a seat 23 formed on the side facing away from the insertion side.

Original claim 2 also contains the feature in dispute, together with the specific configuration of the pre-mounting housing 19 as disclosed in paragraph [0022] cited above.

In the decision, the principles of the established jurisprudence of the Federal Supreme Court regarding the assessment of inadmissible extensions are laid out. According to these principles, it is decisive that the subject-matter of the patent does not extend beyond the content of the application as filed, which is constituted by the entirety of the originally filed application documents. For the assessment of the content of the disclosure, the principles underlying the assessment of novelty are applicable. The teaching of the claims has to be directly and unambiguously derivable as a possible embodiment of the invention from the originally filed application.

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Subsequently, it is stated that generalizations of originally disclosed features are permissible, in particular when, of a plurality of features of an embodiment, which

- a) if considered together
but also
- b) if considered separately

contribute to the success the invention aims to achieve, only one or a few features are included in a claim. In this regard, reference is made to the Federal Supreme Court's previous decisions X ZR 107/12 "Kommunikationskanal" and X ZR 63/15 "Digitales Buch").

Applying these principles it is acknowledged that the application as filed only discloses pre-mounting housings 19 with diverging, mainly axially extending and elastically deformable tongues 21 with hook-shaped ends 22.

However, according to the assessment of the Federal Supreme Court, it has to be taken into account that the application as filed fails to disclose any indication that said structural features are decisive for the solution of the problem that is indicated in the application and that the invention is aiming to solve.

The decision discusses both embodiments of the description. As described above, both embodiments provide a pre-mounting housing 19 for producing contact between the sleeve 18 and the article 17, as specified in claim 1. It appears to be implied that, since the means for producing contact between the pre-mounting housing 19 and the sleeve 18 differs between the embodiments, the specific means for producing contact between pre-mounting housing 19 and sleeve 18 is not regarded to be decisive for the solution of the problem of the invention.

The elastically deformable tongues 21 and hook-shaped ends 22 that establish contact between the pre-mounting housing 19 and the article 17 and are present in both embodiments. The Federal Supreme Court states that it was readily recognizable for the person skilled in the art that these specific design features are only disclosed as examples of the more general feature in dispute.

According to the Federal Supreme Court's assessment, the person skilled in the art would readily recognize that, in order to solve the problem stated in the application as filed (i.e. enabling the fixation of an article in a secure and simple manner without visible fastening points), it is sufficient to provide a pre-mounting housing 19 with which the sleeve 18 abuts against an inner wall of the article 17, and which allows a secure and correct positioning of the sleeve 18 in relation to the article 17, so that upon fastening of the screw element 24 a thrust is effected on the article 17 to secure the latter to the wall.

Based on this understanding, the Federal Supreme Court considers it evident for the person skilled in the art that the disclosure of the embodiments, in which the pre-mounting housing 19 comprises elastic tongues 21 with hook-shaped ends 22, will only be understood as an exemplary illustration of the general teaching relating to the positioning of the pre-mounting housing 19 on the article 17.

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Against this background the Federal Supreme Court concludes that the application as filed sufficiently clearly discloses that the invention includes fixing arrangements that generally comprise pre-mounting housings 19 for establishing a contact between a sleeve 18 and an article 17.

Jurisprudence of the Boards of Appeal of the EPO

In relation to the decision "Bausatz" as analyzed above, Article 123(2) EPC is the relevant legal provision underlying the examination of amendments with respect to their admissibility.

As stated in G01/93 the underlying idea of Art. 123(2) EPC is that an applicant should 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. In other words: The public may not be confronted with an extent of protection, which could not have been established by a skilled person having studied the whole content of the technical disclosure as originally filed (cf. e.g. T0157/90, T0187/91, cf. Case Law of the Boards of Appeal, Ninth Edition, July 2019, II.E.1.1).

The general criteria, referred to as the „gold“ standard, for assessing compliance with Art. 123(2) EPC (cf. G02/10) applies to any amendment of the disclosure (i.e. the description, claims and drawings) of a European patent application or a European patent. According to the gold standard, amendments can only be made within the limits of what *“a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed”* (G03/89, G11/91).

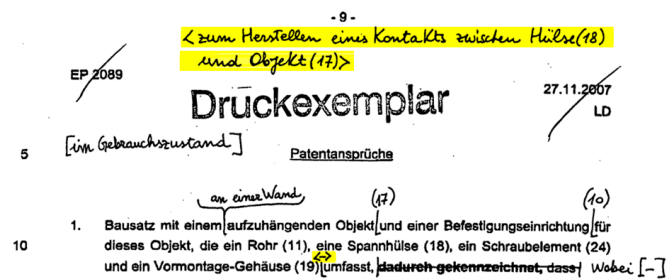
Consequently, after an amendment, the skilled person may not be presented with new technical information (G02/10).

Concerning the admissibility of the amendment relating to the feature in dispute in the case underlying the decision "Bausatz", the following questions need to be answered when assessing the allowability of the amendment under the "EPO approach":

- a) Which technical information is conveyed by the amendment?
- b) Which content of the application is relevant with respect to the amendment?
- c) Does the amendment result in the addition of technical information extending beyond the content of the application?

a) The technical information provided by the amendment

In the present case the amendment under consideration has been proposed by the Examining Division for reasons of clarity (Article 84 EPC) in the "Druckexemplar". The relevant part of the "Druckexemplar" containing the amendment is reproduced below, with the amendment highlighted in yellow.



The amendment adds a function associated with the pre-mounting housing 19 to the feature “a kit comprises ... a pre-mounting housing (19)”, namely “for producing contact between sleeve (18) and article (17)”.

As further detailed below, it is apparent that the functional feature added to claim 1 solely provides a further definition with respect to the pre-mounting housing and does not affect the other features of claim 1.

b) The content of the application relevant with respect to the amendment

The relevant passages of the application as filed are claims 2 and 4 relating to a first and a second embodiment, respectively, the description of these embodiments, and the general disclosure of the invention contained in the general part of the description.

With respect to the first embodiment, the relevant disclosure is to be found in claim 2, paragraph [0022] of the description and figures 3 – 7 of the application as filed. In the first part of claim 2, the functional feature that has been added to claim 1 is disclosed:

“the contact between the sleeve (18) and the part (16) of the article (17) to be suspended is provided by the pre-mounting housing (19)”.

The second part of claim 2 comprises the structural features of the first embodiment associated with the above function:

“(the pre-mounting housing) has a cup-form portion (20) for receiving the sleeve (18) and a plurality of diverging, predominantly axially running tongues (21) resiliently deformable under bending stress, which are insertable outside the tube (11) into the hole (16) of the part (16) of the article (17) to be suspended until their hook-form ends (22) engage in a seat (23) that is formed at the end remote from the insertion end”.

With respect to the second embodiment, the relevant disclosure is to be found in claim 4, paragraphs [0038], [0039] of the description and figures 8 – 11 of the application as filed. Claim 4 also comprises the structural features of claim 2 cited above. It is evident that the disclosure of the second embodiment relevant to the amendment does not extend beyond the disclosure of the first embodiment.

The disclosure in the general part of the description, which discloses the problem and the solution underlying the invention in a general manner (cf. paragraph [0016]) does not take any note of the pre-mounting housing and its function according to the amendment.

The relevance of the disclosure of the general part concerning the admissibility of the amendment thus lies in the fact, that it is derivable therefrom (as from the amended claim 1 considered by itself) that the amendment relates only to the pre-mounting housing and consequently does not affect the other features of claim 1.

c) Does the amendment result in the addition of technical information extending beyond the content of the application?

In order to answer the third question, a comparison of the subject-matter of amended claim 1 with the relevant content of the application as filed has to be conducted. Based on this comparison, it is to be assessed whether the technical information provided by the amendment results in the addition of technical information extending beyond the content of the application.

Under EPO practice, the amendment may be viewed as the result of

- the introduction of the first, functional feature of original claim 2 into claim 1,
- without introducing the remaining structural features of claim 2.

Following the EPO approach to examine whether the amendment is admissible, the criteria of the gold standard, namely what “a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed” have to be applied. For the above constellation, this requires an assessment whether the skilled person considers the functional part of claim 2 and the structural part of this claim as being inextricably linked.

Whether an inextricable linkage between these features would be assumed under EPO practice cannot be decisively answered. In this regard, reference may be made to decision T0782/16 (reasons, no. 4.1.3). According to this decision, “[f]or a correct application of [the gold] standard, a distinction needs to be made between subject-matter which is disclosed either implicitly or explicitly in the original (or earlier) application and therefore can be directly derived from it, and subject-matter which is the result of an intellectual process, in particular a complex one, carried out on what is disclosed”.

Comparison: EPO and German practice

Some of the criteria cited in the decision “Bausatz” for the assessment whether the amendment constitutes an inadmissible extension correspond to the EPO approach, namely:

- The relevant content of the application is to be assessed considering the entire disclosure of the application; (page 14, margin no. 25 of the decision)
- concerning the evaluation of the disclosure, the principles underlying the assessment of novelty are applicable; (pages 15, 16, margin no. 26 of the decision)
- it is required that the technical teaching is disclosed directly and unambiguously as a possible embodiment of the invention to the person skilled in the art (pages 15, 16, margin no. 26 of the decision).

However, it is debatable to which extent the criteria relating to the allowability of generalizations of features, as stated subsequently in the decision “Bausatz” (page 15, margin no. 26 of the decision), comply with the EPO approach:

1. Exploiting the disclosure, generalizations of embodiments disclosed originally are permissible.
2. This applies in particular when out of various features of an embodiment, which together, but also considered by themselves are conducive to the success according to the invention, only one or some have been introduced into the claim.

The first criterion may be applicable within the EPO approach under certain circumstances, provided that the gold standard is complied with.

Here, a pivotal difference in the conceptual approach to the assessment of inadmissible extensions becomes evident: The EPO approach focuses on the question whether the generalization of an embodiment leads to an extension of the **technical disclosure** of the application as filed, which would convey an unwarranted extent of protection to the applicant.

Such an extension of the technical disclosure is affirmed under EPO practice for generalizations of embodiments as in the present case, if a feature that is **inextricably linked** to other features of the embodiment, is isolated from its context and included in a claim.

The conceptual difference in the approach of the Federal Supreme Court becomes evident from the second criterion above: for the assessment of the allowability of generalizations under German practice, the emphasis lies on the assessment which **contribution** the generalized feature makes **to the success the invention is aiming to achieve**.

Under German practice, the generalization of disclosed embodiments is facilitated because the decisive criterion is not based on the question of a technical, inextricable linkage to other features, but on the question whether a feature in isolation is able to make a contribution to the success the invention is trying to achieve.

Summary

In summary, the decision “Bausatz” clearly illustrates the approach of the Supreme Federal Court with regard to the assessment of generalizations

of originally disclosed embodiments, and the differences of this approach compared to the standing EPO practice. The decision „Bausatz” is in agreement with and further confirms the established jurisprudence of the Federal Supreme Court with regard to generalizations of embodiments disclosed in original application documents (cf., e.g., X ZR 107/12 “Kommunikationskanal”, X ZR 51/13 “Einspritzventil”, X ZR 63/15 “Digitales Buch”, X ZB 1/16 “Ventileinrichtung”, and X ZR 38/18 „Niederflurschienenfahrzeug”).

Under the established jurisprudence of the German Federal Supreme Court, generalizations of features disclosed in the context of specific embodiments are permissible if features that are conducive to the solution of the problem stated in the application are included in a claim separately from further features disclosed with respect to this embodiment. This approach is distinct from the approach pursued by the boards of appeal of the EPO in such cases, which comprises an assessment whether features disclosed in connection with a specific embodiment are inextricably linked.

The decision “Bausatz” again illustrates that the problem of intermediate generalizations, that regularly leads to problems in proceedings before the EPO, is virtually non-existent under German case law. This has also been stated in public by the former presiding judge of the X. Senate of the Federal Supreme Court, Prof. Dr. Peter Meier-Beck.

In addition to the above, the following conclusions, which bear immediate consequences for patent law practitioners before the EPO, can be drawn.

Amendments proposed by an Examining Division in application proceedings before the EPO should be carefully examined, in particular with respect to possible objections that may be based on the amendments in appeal or nullity proceedings with regard to inadmissible extensions.

When drafting an EP application, it should be vigilantly considered whether feature combinations specified in a claim or disclosed in the description necessarily have to be presented in this (possibly unnecessarily limiting) manner.

This applies in particular in cases like the present one, within which a (generally broader) functional feature is defined in combination with (generally narrower) structural features. In such a case care should be taken to not unnecessarily limit the functional feature by the addition of structural features.

When the validity of a granted European patent is to be attacked on the grounds of inadmissible extensions rooted in intermediate generalizations, the filing of an Opposition before the EPO may be preferable over a nullity action before the German Federal Patent Court, due to the different approach pursued in the assessment of inadmissible extensions.

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