

1.11.5 Adding prior art citations to the description

a) General

In T 2321/08 the board came to the conclusion that R. 27(1)(b) EPC 1973, or equivalent R. 42(1)(b) EPC, does not put a stringent obligation on the applicant to acknowledge prior art known to him, and to cite documents known to him reflecting this prior art, already at the time of filing the application. Furthermore, no requirement of the EPC prohibits amending an application in order to meet the provisions set out in R. 27(1)(b) EPC 1973 or R. 42(1)(b) EPC (endorsed by T 1123/09 and cited in Guidelines F-II, 4.3 – March 2022 version; see also T 2450/17).

In T 11/82 (OJ 1983, 479) it was pointed out that the mere addition to the description of a reference to prior art could not reasonably be interpreted as the addition of "subject-matter", contrary to Art. 123(2) EPC 1973. Whether it did so would clearly depend on the actual language used and the circumstances of the case.

In T 450/97 (OJ 1999, 67) the board confirmed that the mere addition of a reference to prior art did not contravene Art. 123(2) EPC 1973. It added that after limitation of the claims, also at the opposition stage, a document which subsequently proved not only to be the closest state of the art, but also to be essential for understanding the invention within the meaning of R. 27(1)(b) EPC 1973 was to be introduced in the amended description. See also T 276/07.

In T 889/93 the appellant (patent applicant) explained that the closest prior art was shown in two figures of the contested application. In his reply to the board's objection of obviousness he submitted that these figures did not show the state-of-the-art device correctly as they were misleadingly oversimplified. The board allowed originally filed drawings to be replaced by better ones since this only removed an inaccuracy in the representation of the state of the art and did not affect the disclosure of the invention per se.

In T 471/20 the board had to decide whether, in the case in hand, the insertion into the description of a new paragraph acknowledging a prior-art document resulted in subject-matter extending beyond the content of the application as filed. The board held that the paragraph in question did not provide a definition to be used when interpreting the claims and that its insertion therefore did not provide the person skilled with any new technical information. A referral of questions to the Enlarged Board was not required to enable the board to decide the case in hand.

See also T 725/05 (addition of a discussion of a prior-art document which went far beyond that document's disclosure) and T 452/08 (added reference to prior art redefined a feature) and chapters II.E.1.14.3 and II.E.1.14.4.