

1.14. Amending the description

1.14.1 Amendment to provide support for unsupported claim

T 133/85 (OJ 1988, 441) concerned a case where a feature was described as an essential feature of the invention but was not contained in the claim. The claim was therefore not supported by the description (Art. 84 EPC 1973). An amendment to the description to provide support for the claim was, however, not allowable under Art. 123(2) EPC 1973, because the amended description would contain subject-matter which extended beyond the content of the application as filed – namely information that such feature was not an essential feature of the invention.

1.14.2 Impact on the claimed subject-matter

The board in T 835/11 held (in relation to a divisional application) that an amendment to the description could result in an inadmissible extension only if it changed the subject-matter. That might be the case, for instance, if the description initially defined a feature in the claims more narrowly than its usual meaning; deleting the definition from the description could then result in an inadmissible extension of the patent's subject-matter. Removing or adding examples might also affect how the claims were understood and so also change the patent's subject-matter (see e.g. T 1239/03, in chapter II.E.1.14.4 below). The boards had also repeatedly held that reformulating the problem to be solved could inadmissibly extend the patent's subject-matter (see e.g. T 13/84, OJ 1986, 253, in chapter II.E.1.14.6). By contrast amendments to the description which had no effect on the claimed subject-matter were not open to objection. In the case in hand, Art. 100(c) EPC had not been infringed. See also chapter II.E.1.14.4 "Shift in the interpretation of a claim by amendment of the description"; however, see also chapter II.E.1.14.5 "Shift in the information provided by the examples after amendment of claims".

1.14.3 Adding prior art citations to the description – removing the wrong label "prior art"

For cases concerning the addition of prior art citations to the description, see above in this chapter II.E.1.11.5.

In T 1039/93 certain figures of the application **as filed** had been erroneously labelled as prior art while in fact representing in-house technical knowledge of the appellant that had not been made available to the public. The board did not object to the deletion of the labels "prior art" from the relevant figures since such deletion neither infringed Art. 123(2) EPC 1973 nor affected the disclosure of the state of the art; on the contrary such amendment was necessary to avoid giving an inaccurate representation of the state of the art. After the amendment the description correctly indicated the prior art as required by R. 27(1)(b) EPC 1973.

1.14.4 Shift in the interpretation of a claim by amendment of the description

In T 500/01 the board stated that a claim, the wording of which was essentially identical to a claim as originally filed, could nevertheless contravene the requirements of