

In T 689/90 (OJ 1993, 616) the board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were prima facie not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) EPC 1973, namely if (a) the description of the invention as filed left the skilled reader in no doubt that protection was sought for those features; (b) they helped achieve the invention's technical aim and thus formed part of the solution to the technical problem underlying the invention claimed; (c) they implicitly clearly belonged to the description of the invention contained in the application as filed (Art. 78(1)(b) EPC 1973) and thus to the content of the application as filed (Art. 123(2) EPC 1973); and (d) they were precisely defined and identifiable within the total technical information contained in the reference document. In the case at issue these requirements were not fulfilled. See also T 196/92, T 558/03, T 1497/06, T 1415/07, T 1378/08, T 664/11, T 1451/12, T 2498/12, T 672/14; see also T 474/05 in which the reference in the application to a document was within a specific context, and the amendment went beyond this context and was thus not allowable; see also T 2477/12, applying T 689/90 in the context of Art. 76(1) EPC where the priority application, containing sequence listings, had been "incorporated by reference" in the parent application.

In T 1125/17 the board emphasised that requirement (a) of T 689/90 was very stringent. With reference to T 1415/07, it highlighted that it had to be unambiguously derivable to the skilled person which features of the application were to be taken from the reference document. A mere mention of a prior art document as an "example" was normally insufficient to identify which features or groups of features were of particular relevance for the citing application.

In T 737/90 the board held that a cross-referenced document could only be taken into account if the relevant addressees of the application containing the reference had ready access to the referenced document (the EPO before publication of the application and the public after it).

On incorporation by reference in the context of novelty, see chapter I.C.4.2 above.

### **1.3. Standard for assessing compliance with Article 123(2) EPC**

#### **1.3.1 Gold standard: directly and unambiguously derivable**

Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Art. 123(2) EPC and can therefore, irrespective of the context of the amendment made, 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 these documents as filed (G 3/89, OJ 1993, 117; G 11/91, OJ 1993, 125; G 2/10, OJ 2012, 376, referring to this test as "gold standard"; confirmed for disclosed disclaimers in G 1/16, OJ 2018, A70; for undisclosed disclaimers, see however chapter II.E.1.7.2 c)). After the amendment the skilled person may not be presented with new technical information (G 2/10).