



Intellectual Property International, P.C.

310.545.9851 • 3770 Highland Ave, Manhattan Beach, CA 90266 • info@schleeip.com

Broadening claims at the EPO

Definition of broadening claims

Broadening claims is generally understood as removing a claim limitation, regardless of whether other claim limitations are added if such added claim limitations are not fully encompassed by the removed claim limitation. For example, if a claim includes features A+B+C, an amended claim having features A+C+D+E+F is viewed as broadened by removing feature B, regardless of adding claim features D+E+F. If a claim limitation is not entirely removed, but narrowed by claiming it more specifically, this is not understood as a broadening since the narrowed limitation is fully encompassed by the initial broader limitation. For example, if a term like “attachment means” is substituted by the term “screw”, this is not understood as a broadening but narrowing. However, for such narrowing, disclosure for the screw as a possible attachment means does of course need to be found in the original disclosure.

When is claim broadening typically desired?

As time after the drafting date of the original disclosure goes by the technical development often results in alternatives of claim features that were indeed viewed as important at the time of drafting, specifically for distinguishing over the prior art. For covering the Applicant’s product by the claimed combination, it would then be necessary to either substitute the original claim feature by the alternative feature or to remove this feature from the independent claim. Assuming the alternative was not envisaged at the time of drafting the application, consequently also the disclosure lacks disclosing this alternative so that substitution by that alternative is not an option. The only remedy

would then be to remove this claim feature from the independent claim, resulting in claim broadening as defined above. Another scenario may be that prior art the Applicant was unaware of at the time of drafting teaches the originally claimed combination of features so that different features than originally claimed are needed for distinguishing over the prior art. In the example above, if such prior art teaches the combination A+B+C as originally claimed, but does not teach features D+E+F, and assuming that both an amended claim A+B+C+D+E+F and A+C+D+E+F would fulfill the novelty and inventive step requirement, the Applicant would typically prefer the broader claim A+C+D+E+F that does not include feature B. The Applicant does of course like to have only as many features in the independent claim as necessary to fulfill the novelty and inventive step requirement, which can result in the claim broadening as defined above, even if additional limiting features are added for distinguishing over the prior art.

What is the issue with broadening claims?

The issue is that removing a feature from an original claim creates a new combination of features and may therefore be found contravening [Article 123\(2\) EPC](#). This means, removing a claim feature and therefore creating a new sub-combination of features may be found to be an amendment that *“contains subject-matter which extends beyond the content of the application as filed.”* Coming back to the example above, removing feature B from an original A+B+C claim creates a different combination A+C. For creating such different sub-combination, support in the original disclosure needs to be found. In other words, a disclosed combination does not automatically disclose all sub-combinations. Therefore, a disclosure of the combination A+B+C does not automatically disclose the sub-combinations A+B, A+C and B+C. Globally, standards vary widely as to what level of support may be needed for removing a feature from an originally claimed combination of features. The European Patent Office (EPO) is on the more stringent end of that spectrum. For example, if an original claim includes the claim feature combination A+B+C, the EPO typically presumes that all features A+B+C are “disclosed” only in that combination. For rebutting this presumption, the EPO typically requires disclosure of an embodiment of the invention that does not include the feature

the Applicant wishes to remove from the claim, or requires other forms of disclosure that support that the removed features is not disclosed only in combination with the other features in the claim, for instance an express statement that feature B is optional and the invention works also without the feature B.

Another hurdle to removing feature B is that this feature might be viewed as an [“essential feature”](#). According to the EPO Guidelines for Examination, F-IV, 4.5.2 an essential feature is defined as a feature that is *“necessary for achieving a technical effect underlying the solution of the technical problem with which the application is concerned (the problem usually being derived from the description)*. The Guidelines further require: *“The independent claim(s) should therefore contain all features explicitly described in the description as being necessary to carry out the invention.”* Therefore, even when meeting the Article 123(2) EPC requirement for removing feature B, the “essential feature” requirement that is evaluated in view of the problem that is solved by the invention may still kick in.

Why are particularly US Applicants running frequently into claim broadening problems in foreign filings?

There are various reasons why the U.S. claim requirements and strategies are not very well aligned with the requirements and strategies in many other countries. An important difference is that several independent claims in the same claim category are admissible in US patent applications. Since amendments in the U.S. bear the risk of limiting the scope of the claims under the doctrine of equivalents, possibly due to the [file-wrapper estoppel](#) when presenting arguments and the Festo presumption, getting claims allowed without amendments has benefits in the United States. As a consequence, often several independent claims are pursued for getting one or more allowed without amendments. Therefore, these independent claims may be of narrower scope. When the same claims are filed in a PCT application and no additional measures are taken in the specification that may widen the disclosure to expressly cover various sub-combinations, the Applicant may essentially only pick 1 independent claim per claim category method or apparatus and then run into the “disclosure” and “essential feature” problems described

above that may prohibit removing a claim feature from such narrower independent claim. Another problem of US style claims worth mentioning in this context is the limitation the U.S. system has on multiple dependencies in claims, resulting in fewer expressly disclosed combinations of features.

What can the Applicant do to prevent claim broadening limitations?

Since these claim broadening limitations stem from the scope of the original disclosure, the problem should be addressed as well as possible when drafting the original specification and claims. In other words, the broadening limitations are not a broadening limitation as such since claims of a pending patent application can be broadened if the original disclosure supports that. When based on an International patent application under the Patent Cooperation Treaty (PCT), the original disclosure is the content of that PCT application. In direct foreign patent applications, the original disclosure is determined by the content of such direct foreign patent application. If for instance a Convention Priority under the Paris Convention is claimed there is no need to file the identical version of the priority application as a PCT application or as a direct foreign patent application. For priority claim purposes, it is advisable to have comparable claims between the priority application and the PCT application. However, some claims of the priority application could be chosen that are comparable, and all claims of the priority application can be pasted into the specification in a format that is very similar to claims, but named "embodiment". This allows also disclosing multiple dependencies, for example by a wording like *"The embodiment of one of embodiments 1-3, further comprising ..."* etc. This strategy expands on the total number of expressly disclosed sub-combinations. When drafting the specification of the PCT application it is also possible to expressly state that certain features are optional, that the invention works also without these features, and further expressly list some alternatives of the respective features. This can of course also be already done in the underlying priority application. Further, with respect to the European Patent Office (EPO), the "essential features" that are required to be in the independent claims are determined based on the objective problem solved by the combination of features in the independent claim over

the closest prior art - typically the prior art that has the most features in common with the incident invention. Even though the solved problem is “objectively” determined by the Examiner, disclosing in the specification a number of possible problems solved may also help arguing later on that certain features are not essential for solving that problem. It is of course difficult to foresee when claim broadening may be needed, either since a technical alternative was not envisaged or a prior art was not known at the time of drafting, but at least some of the discussed measures can be implemented with reasonable effort and without affecting the underlying domestic application to which priority is claimed.

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ABOUT AUTHOR ALEXANDER SCHLEE



Alexander Schlee is a registered German, European and US patent attorney and holds the German equivalent to a master’s degree in Mechanical Engineering. He is the founder of Schlee IP International P.C. in 2007 succeeding a Los Angeles branch office he founded as a former equity partner of Viering, Jentschura & Partners in the year 2000. Among other volunteer activities he served on the State Bar of California International Law Section Executive Committee and is a former president of the Los Angeles Intellectual Property Law Association LAIPLA. Alexander Schlee assists particularly clients having strong international Intellectual Property interests, among these especially clients doing business between the United States and Germany.