

- if any required translation is not filed in due time  
then the document is deemed not to have been received.
- D-X, 2.1 In this case the limitation is deemed not filed and the limitation fee, if paid, is refunded.
- A-VIII, 4.2 The person concerned is notified accordingly.  
*Since there is no time limit for filing a request for limitation [see § XVIII.1.1.3], this does not deprive the patentee of the right to simply re-file his request for limitation a second time.*
- Fee reduction**
- R.6(3) Where the applicant files his request for limitation in an admissible non-EPO language, he will qualify for a reduction in the limitation fee.
- Rfees 14(1) The reduction is 20% of the limitation fee.
- G6/91 The essential item of the act in question must be in the admissible non-EPO language, in order to qualify for the reduction.
- A-XI, 9.2.6 In order to qualify for the language fee reduction, **all** of the items referred to in R.92(2)(a), R.92(2)(b), R.92(2)(c) and R.92(2)(e) must be in the admissible non-EPO language [see above]  
*Consequently, these are considered to be the "essential items" under G6/91.*  
*Clearly, the amended limited set of claims required under R.92(2)(d) [plus any amendments to the description or drawings] cannot be in the language according to Art.14(4), because amendments to the patent documents must be in the language of the proceedings [R.3(2)]. Consequently, the amended patent documents do not have to be in the admissible non-EPO language to qualify for the fee reduction.*
- Multiple patentees**  
*There is no specific information on cases where there are multiple patentees and not all of them have the right to file documents in a language according to Art.14(4) (and so not all of them have the right to the fee reduction under R.6(3) and Rfees 14).*  
*However, it would appear that the EPO does grant the fee reduction in such cases.*
- XVIII.1.2. Examination of the request for limitation**
- Art.105b(1) The European Patent Office shall examine whether the requirements laid down in the Implementing Regulations for limiting the European patent have been met.
- Art.105b(2) If the EPO considers that the request for limitation meets these requirements, it shall decide to limit the European patent in accordance with the Implementing Regulations.
- Art.105b(2) If the EPO considers that the request does not meet these requirements, it shall reject the request.
- Subject of the proceedings**
- R.90 The subject of limitation proceedings is the EP patent as granted or as amended in opposition or limitation proceedings before the EPO.
- XVIII.1.2.1. Examination of substantive issues**
- R.95(2) If a request for limitation is admissible, the Examining Division will examine whether the amended claims meet the requirements indicated below.  
*Only if the limitation is not found inadmissible, will the substantive examination be carried out. Deficiencies in the request for limitation which if not corrected lead to the limitation being rejected as inadmissible have already been mentioned in § XVIII.1.1.5 and the procedures for correcting deficiencies is explained in § XVIII.1.1.6.*
- R.95(2) The amended claims must satisfy the following criteria:
- They must constitute a limitation with respect to:
    - the claims as granted in examination, or, where applicable,
    - the claims as maintained in amended form in opposition or limitation proceedings.
  - They must satisfy Art.123(2), i.e. the amended claims must not contain subject matter extending beyond the content of the application as originally filed.
  - They must satisfy Art.123(3), i.e. the European patent may not be amended in such a way as to extend the protection it confers.
  - They must satisfy Art.84, i.e. the claims as limited must be:
    - clear,
    - concise, and
    - supported by the description
- Note that R.95(2) obliges the Examining Division only to check the allowability of the amended claims, however, amendments to the description and/or drawings can also cause violations of the above requirements.*
- Concerning the limitation of the claims**
- D-X, 4.3 Limitation is to be intended as a reduction of the extent of protection. Mere clarifications are not considered to be limitations.  
An amendment to the claims which:
- leads to narrower protection, but
  - falls partly outside the extent of protection conferred by the claim previously on file

is not normally a limitation and would almost certainly contravene Art.123(3).

**Concerning added matter - Art.123(2)**

*For information concerning the requirements of Art.123(2), see § XI.2.5.3. The following must however also be considered:*

D-X, 4.3 Amendments to the description and/or drawings will also be checked for compliance with Art.123(2).

**Extent of protection - Art.123(3)**

D-X, 4.3 For changes in claim category and its possible effects in extending protection under Art.123(3), D-V, 6.3 applies:

*For information concerning the requirements of Art.123(3), see § XV.4.4.2. In particular, the following must also be considered:*

D-X, 4.3, G1/93 &

D-V, 6.1 Amendments to the description and drawings can also result in an extension of protection in contravention of Art.123(3).

D-X, 4.3 Consequently, the Examining Division will also check any amendments to the description and/or drawings for compliance with Art.123(3).

*One open question remains here, where the limitation is filed after a previous limitation or the maintenance of the patent in amended form in opposition proceedings. Does Art.123(3) apply taking into account the claims as originally granted or the latest more limited version of the claims in the patent provided in previous opposition or limitation proceedings?*

*Since the limitation request must limit the claims with respect to the latest set of claims of the patent as granted or amended in limitation or opposition proceedings [R.95(2)], then in most cases, this requirement of R.95(2) would prevent Art.123(3) from becoming a problem anyway, since it would not appear possible on the one hand to limit the claims and at the same time violate Art.123(3) relative even to the narrowest most recent set of claims.*

**Clarity, conciseness support - Art.84**

D-X, 4.3 C-III, 4.3 also applies to limitation proceedings:

C-III, 4 Clarity of the claims, in particular:

C-III, 4.3 Inconsistencies between the claims and the description can lead to a lack of clarity of the claims.

D-X, 4.3 Consequently, the Examining Division may also examine amendments to the description to determine if they affect the clarity of the claims.

*There is no explicit requirement in the Guidelines D-X, that the description be adapted to the limited claims (such a Guideline does exist for examination*

*proceedings - C-II, 7.4). R.92(2)(d) indicates that amendments to the description may be applicable, but D-X, 2.2 does not further elaborate on the requirement for amendment of the description during limitation proceedings. However, if the limitation of the claims causes a serious inconsistency with the description, then Art.84 and C-III, 4.3 may in combination require that the description be adapted.*

**Patentability not checked**

D-X, 4.3 The patentability of the claimed subject matter under Art.52 - Art.57 will not be checked [*this is not a requirement of the request under R.95(2)*].

D-X, 4.3 In particular, the EPO will not check if the limitation provides delimitation over specific prior art.

*In theory all patentability issues should have been dealt with in the examination procedure [and in any opposition procedure if this also took place before the limitation procedure]. This is subject to the narrow exception of the disclaimer case, see below.*

*However, two notable problems may arise with regard to the absence of any patentability check:*

**Patentability Problem #1**

*These are cases where:*

- *The claims are limited by the incorporation of a feature taken from the description, which does not appear in the priority and so the limited claims do not enjoy a priority right [G2/98]*
- *the original claims had a full priority right, because they never contained this feature*
- *a document damaging to novelty and/or inventive step was published in the priority period.*

*In this case, the Examining Division is not permitted by R.95(2) to re-examine any patentability issues and so for such a request it would be obliged to issue a decision limiting the patent in a way which resulted in non-novel and/or non-inventive claims.*

**Patentability problem #2**

*The originally granted claim related to a generically defined genetically modified plant [allowed under G1/98].*

*The proprietor then limits the claim in limitation proceedings, to a specific plant variety, disclosed in the application as originally filed, but not present in the granted claims. This is an allowable limitation under R.95(2), but is excluded from patentability under Art.53(b) according to G1/98.*

*Again no objection can be made to such a limitation under R.95(2).*

D-X, 4.2	<p><b>Additional information from requester</b></p> <p>The requester can supply information with the request as to why he believes it to be allowable [<i>i.e. why he believes its satisfies the above criteria</i>].</p> <p><i>Although the requester is not obliged to file additional information concerning the allowability of the request, where such information is present it will be considered by the Examining Division. For example, the requester may indicate the basis in the application as originally filed of a limiting feature which is introduced in the claims, in an attempt to pre-empt any Art.123(2) objections by the Examining Division. Alternatively, he might explain why he believes that a newly inserted feature used to limit claim 1, is clear under Art.84.</i></p>	<p>Failure to comply with the above requirements means that the disclaimer violates Art.123(2) [<i>i.e. it constitutes the introduction of an embodiment with no basis in the application as originally filed</i>]</p> <p><i>For these reasons it would appear that in the case of a disclaimer introduced into the claims in the limitation procedure, the requester will have to indicate why he is introducing the limitation [a disclaimer] and will also have to provide the Examining Division with the prior art on which it is based [so that criteria (i) and (ii) can be checked].</i></p> <p><i>The Examining Division will then have to consider the relevance of that prior art to the assessment of inventive step, in order to assess whether or not the disclaimer complies with criterion (ii) and so if it is allowable under R.95(2) and Art.123(2). This appears to be a limited exception to the R.95(2) and D-X, 4.3, which otherwise do not allow the Examining Division to assess patentability issues.</i></p>
D-X, 4.2	<p>The requester can indicate the reasons behind his request for limitation, however, this is not a requirement of the procedure.</p> <p><i>The reasons for the request are of no relevance for the EPO [subject to the possible exception of the disclaimer case – see below].</i></p> <p><b>Considering third party observations</b></p>	<p><b>XVIII.1.2.2. Invitation to correct deficiencies, oral proceedings, right to be heard</b></p>
Art.115	<p>Third parties may file observations on the patentability of the claimed invention pre and post grant.</p>	<p>R.95(2) If the request does not comply with the prescribed requirements [<i>i.e. the claims do not constitute a limitation or infringe Art.123(2), Art.123(3) or Art.84</i>], then the Examining Division will give the requester one opportunity to correct the deficiencies, within a period to be specified.</p>
D-X, 4.5	<p>Since these observations are limited to issues of patentability, they are ignored by the Examining Division in limitation proceedings, because no examination of patentability is allowed by R.95(2).</p>	<p>D-X, 4.4 The normal period is two months.</p>
-	<p>However, the requester could, in response to an invitation to rectify deficiencies under R.95(2) file further limitations of the claims to address these observations.</p>	<p>D-X, 4.4 This period can, in principle be extended under R.132(2) [<i>if this is requested before the period expires</i>]. However, this is only allowed in exceptional circumstances.</p>
-	<p>If no R.95(2) invitation is issued [<i>because the original request was found to be both admissible and allowable</i>], then the requester will have to file a further request for limitation if he wants to take such observations into consideration.</p>	<p><i>Since limitation proceedings have a high priority, the general approach to extending time limits without good reason provided in E-VIII, 1.6 does not apply to limitation proceedings.</i></p>
G1/03	<p><b>The disclaimer case – limited exception</b></p> <p>A disclaimer may only be introduced into the claims of a European application or patent in order to establish novelty over prior art, wherein:</p>	<p>R.95(2) The correction of the deficiencies may entail amendments of:</p> <ul style="list-style-type: none"> <li>- claims and/or</li> <li>- description and/or</li> <li>- drawings.</li> </ul>
(i)	<p>the disclaimer is only that which is necessary to establish novelty under Art.54 [<i>i.e. it excludes exactly that which the prior art discloses, no more, no less</i>]</p>	<p>D-X, 4.2 Where the Examining Division makes objections in such a communication, the requester can respond by indicating why he believes that the request is allowable [<i>i.e. argue against any objections raised by the Examining Division</i>].</p>
(ii)	<p>the prior art being excluded is not relevant to the assessment of inventive step under Art.56 [<i>e.g. because it addresses an unrelated technical problem or is a document under Art.54(3)</i>]</p>	<p><b>Oral Proceedings</b></p> <p>D-X, 4.4 If the requester requests Oral Proceedings, the Examining Division will have to hold these before rejecting the request due to non-allowability.</p>