



ARTICLE

ADDED MATTER BEFORE THE UPC: AN APPROACH IDENTICAL TO THAT OF THE EPO



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PROPRIÉTÉ INTELLECTUELLE

Before the UPC, as before the EPO, patent validity litigations frequently include one or more attacks for non-compliance with Article 123(2) EPC concerning the extension of the claimed subject matter beyond the content of the application as filed.

Based on the UPC's case law on this subject, we sought to understand the criteria applied by the UPC to determine whether a patent complies with the requirements of Article 123(2) EPC.

In the cases *Abbott v. Sibio Technology Limited and Umedwings Netherlands B.V. (together Sibionics[1])* concerning Abbott's patent EP-3 831 283, the validity of claim 1 of the patent under Article 123(2) EPC was one of the key issues. Sibionics launched multiple attacks in this regard, arguing in particular that claim 1 resulted from an unallowable intermediate generalisation. This argument was used both in defence against Abbott's application for a provisional injunction before The Hague Local Division and in its action for revocation related to the same patent before the Paris Central Division.

The application for a provisional injunction gave rise to a first instance decision[2] followed by an appeal decision[3], and the revocation action gave rise to a first instance decision[4]. While Sibionics won in first instance in The Hague – the patent being considered more likely to be invalid due to added matter – Abbott won on appeal – the patent being considered more likely to be valid and infringed – and, in the revocation action, before the Paris Central Division – the patent being considered valid by the Court in first instance.

Let us examine the grounds for these three decisions.

The UPC adopts the EPO's "gold standard"

As a reminder, the "gold standard" stems from decision G2/10[5] of the EPO's Enlarged Board of Appeal, according to which: *"An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed."*

This criterion is therefore based on what a **person skilled in the art**, relying on their **general knowledge**, could **objectively deduce**, on the **priority date**, **directly** and **unambiguously**, **explicitly** or **implicitly**, from the application as **filed**. This **gold standard** has become the EPO's benchmark for assessing compliance with Article 123(2) EPC. It is included in the EPO Guidelines for Examination (H.IV-2.1) and in the Case Law of the EPO Boards of Appeal (II.E.1.3.1).

The two first instance decisions of the UPC in the *Abbott v. Sibionics* case explicitly cite the gold standard[6]. The Court of Appeal does not explicitly use the term "gold standard", but it does mention the exact terms that constitute this criterion[7]:

"There is added matter if the claim as granted contains subject-matter that extends beyond the content of the application as filed. In order to ascertain whether there is added matter, the Court must thus first ascertain 13 what the skilled person would derive directly and unambiguously using his common general knowledge and seen objectively and relative to the date of filing, from the whole of the application as filed, whereby implicitly disclosed subject-matter, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content."

As of 10 September 2025, this is the only decision by the Court of Appeal that has ruled substantively on an argument concerning added matter

Thus, it follows, in particular from the Court of Appeal's decision of 14 February 2025, which has greater jurisprudential force, that the EPO's gold standard is also the UPC's standard for assessing compliance with Article 123(2) EPC. Parties facing issues of extension of subject matter before the UPC therefore have a strong interest in adhering as closely as possible to this standard and to EPO practice.

Several **subsequent** first instance decisions refer to the Court of Appeal's judgment in setting out the legal test to be applied with regard to compliance with Article 123(2) EPC, notably those handed down by Paris[8], Hamburg[9] and Munich[10] Local Divisions, as well as by the Nordic-Baltic Regional Division, which, although it does not explicitly cite the Court of Appeal, echoes its wording[11].



With regard to decisions of the court of first instance **prior** to the Court of Appeal's order, the approach used is more or less similar to the EPO's practice, whether explicitly or implicitly. A few examples illustrate this situation:

The aforementioned decision of The Hague Local Division had thus applied the gold standard precisely, probably because both parties had referred to it. Similarly, the Munich Local Division also mentioned almost all the terms of the gold standard, except for implicit disclosure, probably because it did not need to do so in order to decide the dispute in the context of an application for a provisional injunction[12] :

*"Any modification (...) may (...) only be made within the limits of what a **person skilled in the art** can **directly and unambiguously** infer from all of these documents as originally filed, using **general technical knowledge, objectively** and in relation to the **filing date**."*

The Central Division in Paris had used a more succinct text without applying the gold standard, but rather the criterion of "direct and unambiguous deduction" from decision G1/06 of the Enlarged Board of Appeal of the EPO applying to divisional applications[13] :

*"Such an extension occurs **if the subject matter cannot be deduced directly and unambiguously from the earlier application by a person skilled in the art**."*

The Munich Local Division was able to dismiss an attack under Article 123(2) by simply referring to the subject matter of Article[14] :

*"The assertion that (...) does not go **beyond the understanding of the documents initially submitted** from the point of view of a person skilled in the art."*

Similarly, the Paris Central Division , citing the applicant for invalidity, presented the attack under Article 123(2)[15] as follows:

*"According to the applicant, the patent provides the skilled person **with additional relevant technical information concerning the fact that (...). Consequently, (...) was not part of the original content of the disclosure**."*

A clarification of the test to be used to assess Article 123(2) EPC was therefore necessary. This was done by the Court of Appeal, whose decision can be summarised as follows: the **gold standard, nothing but** the gold standard and, above all, the **whole** gold standard. Subsequent decisions at first instance seem to show a before and after this decision by the Court of Appeal.

An example of the application of the gold standard will now be presented in the specific case of intermediate generalisation.

A specific case: intermediate generalisation

Intermediate generalisation consists of "extracting a specific feature by isolating it from a combination of features initially disclosed, and using it to delimit the claimed subject matter" (EPO Guidelines H.V-3.2.1). This can be illustrated by a theoretical example: the description of a patent application presents an embodiment comprising characteristics A, B and C. Extracting characteristic B alone to include it in a claim that does not include A and C is an intermediate generalisation. This may or may not be allowable.

In *Abbott v. Sibionics*, Sibionics claimed that claim 1 of the contested patent resulted from an **unallowable** extension of the subject matter by way of intermediate generalisation.

In the first instance in The Hague, Sibionics obtained a ruling from the LD that claim 1 was likely to be invalid due to added matter. In its decision, The Hague Local Division again relied on a "100% EPO" criterion, namely that Abbott "*had failed to demonstrate **the absence of a structural and functional link***"[16] between the feature added to claim 1 during the examination procedure and the feature omitted from the description. In doing so, the Court cited the criterion set out in particular in the Case Law of the EPO Boards of Appeal II.E.1.9.1.

On appeal, the Court overturned the LD's decision and declared the patent likely to be valid, considering in particular that, for a person skilled in the art, the omitted feature contributed to the overall functioning of the claimed device[17] , but[18] "*did not contribute to the technical teaching of the invention as disclosed in the original application and was therefore not relevant in that respect. In other words, a person skilled in the art would not consider the use of [the omitted feature] to be necessary to achieve the overall purpose and effect of the invention.*"

The Court of Appeal concluded[19] , that:

*"(...) the skilled person does not discern a **functional or structural relationship** (...). Failing an **inextricable link** with the features of these embodiments, not including [the omitted characteristic] in claim 1 cannot be considered as an intermediate generalization."*



The Court of Appeal therefore referred to the two criteria in EPO case law II.E.1.9.1., namely the existence of a **"functional or structural link"** on the one hand and an **"inextricable"** (or inseparable) **link** on the other[20] .

It is important to note that the distinction between the features necessary to achieve the technical effect of the invention (which cannot be omitted) and those necessary for the general functioning of the claimed device (which can be omitted) again results from case law from the EPO, namely decisions T1762/21[21] and T802/13[22] . It should also be noted that the 11th edition of EPO case law II.E.1.9.1 mentions decision T1762/21.

The Court of Appeal therefore fully aligned itself with EPO practice in establishing that claim 1 did not result from an unallowable intermediate generalisation.

The Paris Central Division, whose decision was subsequent to that of the Court of Appeal, also relied on the criterion based on **the absence of a functional or structural link** to admit the intermediate generalisation as admissible[23] . It then stated[24] :

*"The Court accepts that it may **sometimes be difficult or even artificial to clearly distinguish between features which are relevant to the object of the invention and features which are merely relevant to the general functioning of the device, as the definition of the object of the invention may be complex and involve various aspects.**"*

However, it considered that it was not necessary to rule on this point[25], as the key issue remains that of the possible link between the omitted feature and the feature introduced into the claim under consideration during the examination procedure.

In this case, the Central Division in Paris considered that, insofar as means other than the omitted feature were disclosed in the description (in this case to ensure the tightness of the claimed device), this omitted feature was not functionally and structurally related to the feature added to claim 1. It therefore concluded that claim 1 did not result from an unallowable intermediate generalisation.

In summary, the three above-mentioned decisions are based on the reasoning followed by the EPO to establish whether there is an unallowable intermediate generalisation. They all refer to the issue of establishing a **functional or structural link**, or an **inextricable link**, between the omitted feature and those of claim 1.

Finally, for the applicant seeking invalidation of the patent, it may sometimes be tempting to multiply attacks on the basis of Article 123(2) EPC by trying to use every possible argument. However, assessing compliance with Article 123(2) EPC involves an exegesis of the application as filed. It therefore requires **rigorous interpretation and argumentation** based on a text that should lead the practitioner to target their attacks. This is what the Paris Central Division emphasises when it recalls[26] :

"A mere allegation that there is a functional or structural relationship is not enough for the Court to conclude that there is an unallowable intermediate generalisation. On the contrary, a concrete explanation of an alleged functional or structural relationship, based on the content of the original disclosure, would be necessary."

In matters of 123(2), the quality of the arguments therefore undoubtedly prevails over the quantity of attacks.

[1] The authors of the article represented Abbott in this litigation jointly with Taylor Wessing.

[2] LD The Hague, 19 June 2024, Abbott v. Sibionics, ACT_14945/2024, UPC_CFI_131/2024, ORD_30431/2024, see in particular page 12, paragraph 3.4

[3] CoA Luxembourg, 14 February 2025, Abbott v. Sibionics, APL_39664/2024, UPC_CoA_382/2024, ORD_67504/2024

[4] CD Paris, ACT_27463/2024, UPC_CFI_231/2024, ORD_69322/2024, Sibionics v. Abbott, 21 July 2025, see in particular page 13, paragraphs 68 and 69

[5] EPO, Enlarged Board of Appeal, decision G2/10, referral T 1068/07, 30 August 2011

[6] Paragraph 3.4 of the decision of the LD The Hague (19 June 2024) and paragraph 69 of the decision of the CD Paris (21 July 2025)

[7] Paragraph 52 of the Court of Appeal decision of 14 February 2025

[8] CD Paris, 23 May 2025, Hurom v. NUC Electronics, ACT_17434/2024, UPC_CFI_163/2024, ORD_69293/2024, paragraph 59

[9] LD Hamburg, 10 July 2025, Nera Innovations v. Xiaomi, ACT 19746/2024, UPC_CFI_173/2024, ORD_69307/2024, pages 49 and 50



[10] LD Munich, 1 August 2025, Headwater Research LLC v. Samsung, ACT_7603/2024, UPC_CFI_54/2024 and UPC_CFI_396/2024, ORD_69436/2024, page 33

[11] RG Nordic-Baltic, 21 July 2025, Edwards Lifesciences v. Meril et al., UPC_CFI_380/2023, ORD_598566/2023, paragraphs 76 and 77

[12] LD Munich, 19 September 2023, NanoString v. 10x Genomics, ACT_459746/2023, UPC_CFI_2/2023, page 58

[13] CD Paris, 19 July 2024, Meril v. Edwards Lifesciences Corporation, ACT_551308/2023, UPC_CFI_255/2023, ORD_598365/2023, paragraph 54

[14] LD Munich, 13 September 2024, Philips v Belkin, ACT_583273/2023, UPC_CFI_390/2023, page 36

[15] CD Paris, 29 July 2024, Bitzer Electronics v. Cartier Corporation, ACT_555899/2023, UPC_CFI_263/2023, ORD_598395/2023, paragraph 38

[16] Paragraph 5.4 of the decision of the Local Division in The Hague of 19 June 2024

[17] Paragraph 72 of the Court of Appeal's decision of 14 February 2025

[18] Paragraph 75 of the Court of Appeal's decision of 14 February 2025

[19] Paragraph 78 of the Court of Appeal decision of 14 February 2025

[20] These two criteria are presented as alternatives in the case law of the EPO II.E.1.9.1.

[21] Paragraphs 2.4 and 2.5

[22] Paragraphs 4.5 to 4.7

[23] Paragraph 82 of the decision of the Central Division in Paris of 21 July 2025

[24] Paragraph 87 of the decision of the Central Division in Paris of 21 July 2025

[25] Ibid

[26] Paragraph 85 of the decision of the Central Division of Paris of 21 July 2025
