

GUIDELINES2DAY

CLARITY AND DISCLOSURE: QUESTIONS AND ANSWERS FROM THE LIVE SESSION 11.03.2021

Thank you for your questions addressed to the panellists. Please understand that the panellists can only provide general replies, without prejudice to the decisions of the competent departments in each individual case. With that proviso, we are pleased to inform you as follows:

The revised **Guidelines F-IV, 4.3(iii)** read:

Part of the subject-matter of the description and/or drawings is not covered by the claims
Where parts of the description give the reader the impression that they disclose ways to carry out the invention but are not or, due to amendments to the claims, are no longer encompassed by the wording of the claims, these parts often throw doubt on the scope of protection and therefore render the claims unclear or unsupported under [Art. 84](#), second sentence, or, alternatively, render the claims objectionable under [Art. 84](#), first sentence. The description must be adapted to the claims in order to avoid inconsistencies between the claims and the description.

Embodiments in the description which are no longer covered by the independent claims must be deleted (for example if the description comprises an alternative for at least one feature which is no longer covered by the amended claims) unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated ([T 1808/06](#)).

For example, if the claims are amended to specify a vehicle employing electric motors but one of the embodiments in the description and drawings employs a combustion engine instead, the inconsistency can be rectified by removing the embodiment with the combustion engine from the description and drawings. Alternatively, this embodiment must be marked as not being covered by the claimed invention (e.g. "embodiment not covered by the claimed invention"). It is not sufficient to use generic statements such as "embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention" without indicating which parts of the description are no longer covered.

In addition, merely changing the wording "invention" to "disclosure" and/or the wording "embodiment" to "example", "aspect" or similar is not sufficient to clearly state that this part of the description does not fall under the scope of the claimed invention. It has to be explicitly specified that this part of the description does not describe part of the claimed invention.

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Similarly, subject-matter in the description being excluded from patentability needs to be excised, reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention.

Moreover, features required by the independent claims may not be described in the description as being optional using wording such as "preferably", "may" or "optionally". The description must be amended to remove such terms when preceding a feature of an independent claim.

1. What does inconsistent mean here? So, alternative solutions that is not covered by dependent claims are not allowed? Or how should we understand inconsistency in this context?

Inconsistency means "not compatible or in keeping with". Then does it mean background part should be removed in the patent description. As background part will never be reflected in the claims?

F-IV, 4.3 (iii): embodiments or "alternative solutions" no longer covered by the claims that are earmarked as not being covered by the claims may remain in the description if they can reasonably be considered to be useful for highlighting specific aspects of the amended claims. However, it must be clearly indicated that these embodiments are not covered by the claimed invention. As far as the question relates to a "background part", the description must indicate the background art according to Rule 42(1)(b) EPC "which [...] can be regarded as useful to understand the invention". This does not appear to be in conflict with the revised F-IV, 4.3(iii).

2. Concerning equivalents (in UK law): would it be OK to say "equivalents to [claim feature X] include Y, Z, etc", rather than "Y, Z is outside the claims"?

As set out in F-IV, 4.4, statements which refer to the extent of protection being expanded to cover "all equivalents" of the claims must be deleted. This part of the Guidelines has not been amended.

3. In the case of a divisional, do you require the divided-out material to be deleted from or clearly denoted in the description of the parent application?

As set out in C-IX, 1.5, the description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus, the repetition in a divisional application of matter in the parent application need not be

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objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. In that case the instructions given in F-IV, 4.3(iii) apply.

4. Could amending an embodiment to “a disclosure useful in aiding interpretation” be allowable?

F-IV, 4.3 (iii): no, it must be clearly indicated that these embodiments are not covered by the claimed invention. The term “disclosure” does not make sufficiently clear to the skilled reader who only has the B1 specification to interpret the scope of protection whether or not the subject-matter is covered by the claims. The words “useful in aiding interpretation” seem to imply the opposite, namely that what follows is to be used to interpret the scope of protection.

5. Assuming that the applicant is required to delete a claim, does it mean that he/she needs to delete the portion of the description referred to such claim too?

F-IV, 4.3 (iii): It depends, if that part of the description is no longer covered by the remaining claims then it must be either deleted or clearly indicated in the description as not being covered by the claims.

6. What about the figures showing the embodiments not covered by the claims? Should those be deleted or marked as well?

Yes. Drawings are part of the disclosure but are explained in the description (Rule 42(1)(d)). If the drawings are not part of the claimed invention, they must either be deleted or it must be explicitly specified in the description that the figures in the drawings are not covered by the claimed invention.

7. Has the approach towards “parametritis” changed? The trend to claim existing products and processes by sticking an equation of an uncommon property to the known product/process.

The part of the relevant Guidelines F-IV 4.11 remains unchanged.

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8. During opposition an opponent says that an undisclosed feature was added to the claim during examination. In order to remove it, the proprietor might need to substitute it with another more limiting feature which was not covered by the granted claims.

Is this possible if this feature was marked as "not belonging to the claimed invention" when adapting the description in the pre-grant procedure?

The clarification of the practice in revised F-IV, 4.3(iii) does not change the assessment of conflicts between Art. 123(2) and Art. 123(3) EPC (see H-IV, 3.5). As held in G 1/93, the added feature can be replaced only by a feature for which there is a basis in the application as filed and which does not extend the scope of protection conferred by the claims as granted. To have proper basis in the application as filed, it appears that the more limiting feature should appear, at least implicitly, in combination with the features of the granted claim. Such a combination would not have been marked "as not part of the invention" since a passage in the description disclosing a more limiting feature together with granted claims does not lead to any contradiction with the claims. It is noted that (just like the amendment of the application by adding an undisclosed feature) it is the responsibility of the applicant to decide on what part of the description has to be marked as "not belonging to the claimed invention".

9. The revised Guidelines F-IV, 4.3. seem very stringent. So, the applicant does not get what he wants - the examiner will only allow what F-IV, 4.3 allows him to grant. Can a more lenient version be considered for next version? It would be appreciated if the Guidelines would also suggest a more lenient form than "It has to be explicitly specified that this part of the description does not describe part of the claimed invention". Can that be considered?

The revised Guidelines are not more stringent. They are a clarification of the existing practice which is based on well-established case law (T 11/82, T 977/94, T 300/04, T 698/01, T 323/05, T 1808/06, T 1252/11, T 1883/11, T 1646/12, T 0237/16 and, very recently, T 1399/17 (points 2.2 and 2.3)).

Like any revision of the Guidelines, the revised F-IV, 4.3(iii) was discussed with users in the context of the [SACEPO Working Party Guidelines](#). The amendments to F-IV, 4.3(iii) did not give rise to any issues.

The revision of the Guidelines is an ongoing process. Like last year, [public consultations](#) are organised for gathering comments from users in addition to the regular consultations in the meetings of the SACEPO Working Party Guidelines. It is possible to contribute suggestions to this revision cycle until 12 April 2021.

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10. When you say that replacing “embodiment” by “disclosure” is not sufficient [Slide 31], is this clearly stated in the guidelines or is this your interpretation of what the guidelines say? To me, this seems overly strict as the terms “disclosure” and “embodiment” have clear meanings and are not interchangeable.

It is stated in the Guidelines, see F-IV 4.3 iii) §3 and 4. The term “disclosure” does not make sufficiently clear to the skilled reader who only has the B1 specification to interpret the scope of protection whether or not the subject-matter is covered by the claims.

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