



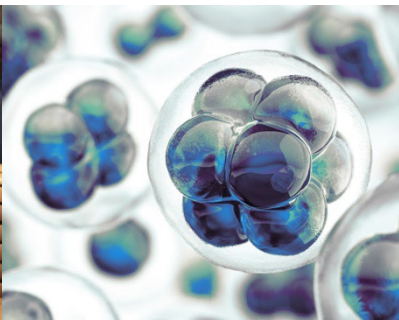
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Guidelines2day

Clarity and disclosure – Adaptation of the description



Jean-Luc Gal
Nicolas Wyplosz



Lawyer, Patent Law
Administrator, Procedural support Examination



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Presenters

Nicolas Wyplosz

- FR, Administrator in Directorate Procedural support
- DG1 - Patent Granting Process

Jean-Luc Gal

- FR, Lawyer in Directorate Patent Law
- DG5 – Legal and International Affairs

Overview

Part I – Legal framework

- EPC Provisions / Guidelines
- Importance of clarity
- Examiners' work

Part II – Recent changes in the Guidelines

- GL F-IV
- Adaptation of the description

Questions - Poll

- ask your questions via chat to "**All Panelists**"
- unanswered questions will be addressed offline

EPC Provisions

Claims – Description - Drawings

3 essential provisions for the claims

Art. 84 EPC requires 3 provisions for the claims:

- clear
- concise
- supported by the description

*Art. 84 EPC: “The claims shall define the matter for which protection is sought. They shall be **clear** and **concise** and be **supported** by the description.”*

Dictionary definition of ‘clear’: free from doubt or confusion

Additional provisions for the claims

Rule 43 EPC, directly related to Art. 84 EPC, contains additional provisions concerning the claims.

- 2-part form (§1)
- categories of claims (§2)
- dependency of claims (§3-4)
- number of claims (§5)
- reference to description and drawing in claims (§6)
- reference signs (§7)

Rule 43 EPC- Form and content of claims

Provisions for the description

Rule 42 EPC contains provisions concerning the content of the description.

- disclosure of the technical field
- disclosure of the technical problem
- cite the prior art
- describe the figures

The description should disclose the invention as claimed pursuant to R.42(1)c

Rule 42 EPC - Content of the description

Guidelines on Clarity

- The meaning of the terms of a claim must, as far as possible, be **clear for the person skilled in the art** from the wording of the claim alone
- The clarity of the claims is of the **utmost importance** in view of their function in defining the matter for which protection is sought

F-IV 4.1
F-IV 4.2

Importance of clarity

Search & Examination

Post-Grant stage

Search division / Examination division

- ground for refusal (Art. 97 EPC)
- the **search division** and the **examining division** should be able to search and examine the application
 - **Search division**: is it possible to search the prior art? A clarification request is possible
 - **Examining division**: is it possible to assess patentability?

Opposition – Revocation

- no valid ground for opposition (Art. 100 EPC)
- no valid ground for revocation (Art. 138 EPC)

but

- problems of interpretation at EPO in opposition:
risk of revocation on other grounds
- the **opposition division** considers the introduced amendments (G3/14)

Refusal C-V 14
Opposition D-III 5 - G3/14
Revocation D-VIII 1.2.1

Legal certainty - Infringement

Public – National courts

F-IV 4.1, 4.2
F-IV 6.1

- the **public** (competitor, opponent) should understand the scope of the claim
- the **national courts** should understand the scope of the claim

Examiners' work

Clarity: Examination

- Examining Division = 3 Examiners
- Construe with **a mind willing to understand**
- Give the words the meaning and scope they normally have in the relevant art

F-IV 4.2
F-IV 4.5.2

Guidelines: F-IV 4 provisions

- 4.3 Inconsistencies
- 4.4 General Statements
- 4.5 Essential features
- 4.6 Relative terms
- 4.7 About, approximately, substantially
- 4.9 Optional features
- 4.10 Result to be achieved
- 4.11 Parameters
- 4.12 Product-by-process claim
- 4.13 Expressions stating a purpose
- ...
- 4.22 Broad claims

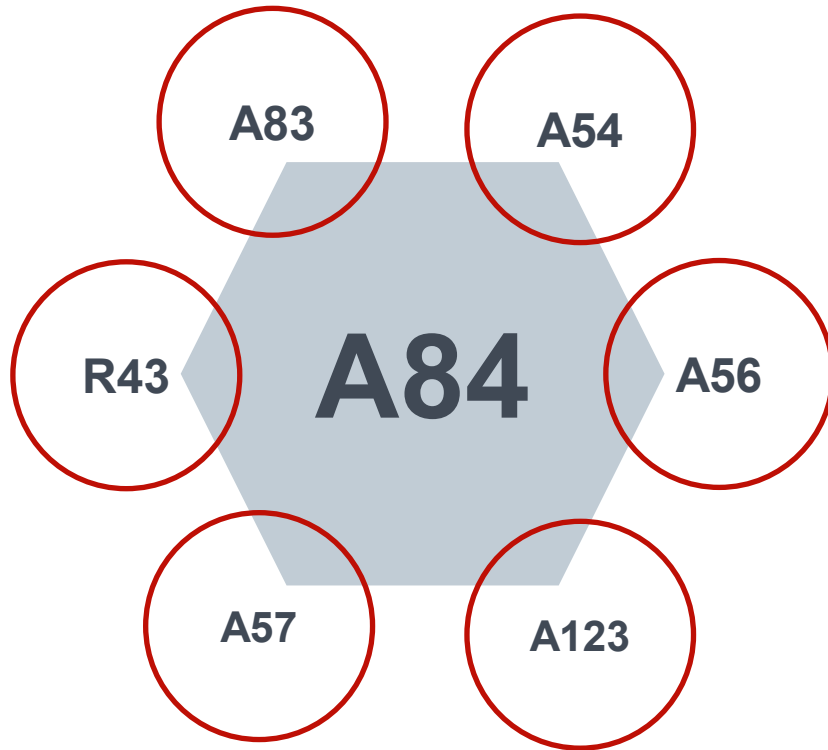
Examining Division must check that the application complies with F-IV provisions

Guidelines revision F-IV

1 March 2021

- Amendment of the description F-IV, 4.3
- Computer implemented inventions F-IV 3.9.2 (25.03.21)
- Changes relating to biotechnology (G3/19) F-IV, 4.12
(22.04.21)

Problems are interrelated



Art. 84 + Art. 83
Art. 84 + Art. 123
Art. 84 + Art. 54
etc.

Problems are interrelated Art. 84 / Art. 123

■ **Art. 84 objection from Examining Division**

- Applicant is entitled to modify the application to answer the objection under Art. 123(1)
- Are the modification in compliance with Art. 123(2) – added subject matter?

➤ It is the duty of the applicant to adapt the description to the claims / not with the examining division

Guidelines 2021

Adaptation of the description

Adaptation of the Description

- embodiments no longer covered by the claims must be **deleted** or **prominently marked** as not being covered
- **it is the duty of the applicant** to adapt the description
- embodiments not falling under the claimed inventions need to be deleted or marked "*embodiment not covered by the claimed invention*"
- general statements are insufficient as well as replacing "*invention*" by "*disclosure*" or the like

Article 84

Claims must be supported

F-IV, 4.3

Clarity and interpretation of claims

T 1808/06

A reminder of the existing legal framework

- Not a new practice, but a clarification of the Guidelines aiming at harmonisation

GL 2001, C-III, 4.3(iii)

- (iii) part of the subject-matter of the description and/or drawings is not covered by the claims

For example, the claims all specify an electric circuit employing semiconductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However, if examples in the description and/or drawings which are not covered by the claims are presented not as embodiments of the invention but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed.

GL 2021, F-IV, 4.3(iii)

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 **all are amended to specify an electric circuit a vehicle employing semiconductor devices** electric motors but one of the embodiments in the description and drawings employs **electronic tubes a combustion engine** instead. ~~In such a case,~~ the inconsistency can ~~normally be rectified removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter~~ **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.

A reminder of the existing legal framework

- **Supported by case law:** T 11/82, T 977/94, T 300/04, T 698/01, T 323/05
- T 1808/06 (headnote and point 2 of the reasons):

2. In order to meet the requirement of Article 84 EPC that the claims have to be supported by the description, **the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear.** Any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised. **Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter.** In such a case, the fact that an embodiment is not covered by the claims must be **prominently stated.**

The placing of reliance on **Article 69(1) EPC**, as was done in the decision under appeal, **is not an appropriate justification for a less stringent adaptation of the description.**

- Confirmed also in T 1252/11, T 1883/11, T 1646/12, T 0237/16

Legal certainty – National courts – Revocation

- problems of interpretation before a **national court** in litigation/infringement cases
- risk of **revocation** on other grounds
- revocation for a particular territory/country

Risk: uncertainty on the scope of protection may lead to different interpretation = different decisions by different courts.

Risk: unclarity may lead to the revocation of the patent on other grounds.

National courts – Revocation



The national Courts need a description adapted to the claims “UK High Court, L'Oréal v RN Ventures (2018)”

- 67. Mr Davis submitted that the shear mode is described as “an aspect”, and in EPO practice, the use of the word “aspect” indicates that what follows is outside the scope of the invention. However, he was unable to point to any authority or guideline which supported this. He sought to refer to the prosecution history of the Patent, which is not admissible in this context (see below). Nor could the approach taken by one examiner establish any general practice.
- 68. I do not accept RN Ventures’ submission. **Where an aspect is outside the scope of the invention, the description of the Patent makes this clear.** Paragraph [0013] refers to “*another aspect which is not part of the invention.*” Conversely paragraphs [0033] - [0034] *et seq* make clear that both the shear and tension and compression arrangements are part of the invention, and that the former is preferred.

Best practice: How to bring the description in line?

- Deleting embodiments which no longer fall within the scope of claims; or
- Mark appropriately to retain subject-matter useful for highlighting specific aspects of the invention or as background
- Which terms are clear?
 - “Invention” or “claimed subject-matter”
 - “not part of the invention”, “not according to the invention”, “not falling within the scope of the claimed subject-matter”, “not covered by the claims”
 - “according to the invention”, “forms part of the invention”, “within the scope of the claims”
 - However, mere **replacement** of “embodiment” with the terms “example”, “aspect”, “disclosure” or similar is **not** sufficient

Established practice: Optional features / Technical field and summary

Essential features in the independent claims may not be described as being optional

Remove wording of "preferably", "may" or "optionally"

Derives from definition of consistency

Dependent claims by definition state the further features and may be worded as optional

The **technical field** of the invention must correspond to the amended set of claims

The **summary** of the invention must correspond to the amended set of claims

F-IV, 4.3 (iii)

Rule 42(1)(a)

F-II, 4.2: technical field of the invention

Rule 42(1)(c)

F-II, 4.5: summary of the invention

T237/16 reason 4.1

Interest of the applicant is to adapt the description to the claims

C-V, 1.1

Duty of the applicant

Final responsibility for the text of the patent lies with the **applicant** (Art.113(2) EPC and G1/10)

Examining Division could do it in simple and **straightforward** cases

Recommended to **clarify** with the applicant which embodiments describe the claimed invention and which do not – to act in **good collaboration**

What if the description is not (sufficiently) amended to address the objections?

Examining Division will formulate **reasoned objections**

At last resort, Examining Division **to consider summons to OP**

H-V, 2.7

Bringing the description into line with amended claims

Further questions



Now

via chat to "All Panelists"

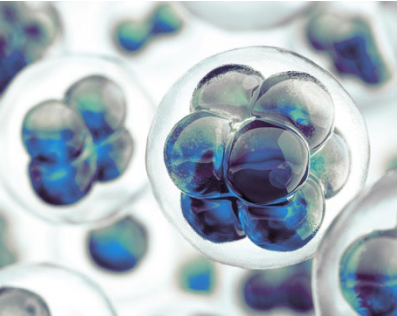


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Thank you for your attention!



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Field specific changes

Plants or Animals Not Exclusively Produced by an Essentially Biological Process

F-IV, 4.5.2
Revised practice

- Clarity of claims towards plants or animals (not exclusively produced by an EBP) comprising a functionally defined phenotypic trait and which are worded as product-by-process claims
- Why? Public needs to clearly understand what the subject-matter for which protection is sought actually is
- **Need of identifiable and unambiguous technical features** (i.e. genetic information of the genome) to the plant or animal, in order that the claim(s) directed to a plant or animal fulfil(s) the clarity requirement

Product-by-Process Claims

- Biological Processes

- Adaptation to **G 3/19**
- Exclusion under Rule 28(2) does not apply to applications / patents with an effective filing/priority date before 1.7.2017
- **Need of a disclaimer** if a technical feature of a claimed plant or animal, can be the result of both either a technical intervention (e.g. directed mutagenesis) and or an essentially biological process (a natural allele)
- Examples in G-II, 5.4.2.1, and G-II, 5.4

F-IV, 4.12
No retroactivity of Rule 28(2)

Interpretation of Computer Related Means-Plus-Function Features

- Clarifying on when "*means for*" referring to computer means are limiting:
 - When "means for" refers to computer means, the processing steps being defined as "means for + function" (first claim) and "computer adapted to + function" (second claim) are to be interpreted as limiting.
 - A prior-art document disclosing a specific mean comprising several steps and a computer only anticipates the claims of the application if the prior-art document also discloses that the computer is programmed to carry out the claimed steps.

F-IV, 4.13.2

See example with computer adapted to eyeglass lens grinding machine

"Identity" and "Similarity in Amino or Nucleic Acid Sequences

F-IV, 4.24

- **Clarification** and interpretation of the terms “identity”, “similarity” and “homology” in claims involving amino acid or nucleic acid sequences.
- **No change of current practice.**
- Amino acid and nucleic acid sequences are often characterised by a percentage of identity, similarity or homology to a given sequence. The calculation of the % is based on different algorithms and matrices.
- The terms are interpreted in their broadest sense if no algorithm or calculation method is defined.