



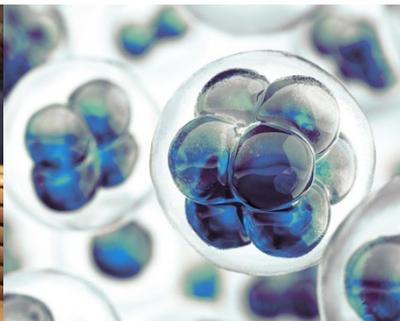
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Guidelines2day 2022

Adaptation of the description to the claims



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9 March 2022

Presenter



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Presenter



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- AT, examiner and expert in Directorate Procedural Support
- DG1 - Patent Granting Process



Agenda

- Activities in 2021
- Legal framework
- Inconsistencies
- Changes in the 2022 Guidelines
- Questions

Activities in 2021

- March 2021: Publication of Guidelines 2021
- 20.5.2021: 1st SACEPO WP GL meeting on revision on Guidelines
- 28.10.2021: 2nd SACEPO WP GL meeting on revision on Guidelines
- 04.11.2021: Workshop with users, Board of Appeals members, national judges and EPO on adaptation of description
- 12.11.2021: Special meeting of the SACEPO WP GL dedicated to the adaptation of the description to the claims

Judges and chair of BoA participating in workshop on 4.11.2021:

- **Sir Christopher Floyd**, formerly Court of Appeal, United Kingdom
- **Rian Kalden**, Court of Appeal The Hague, The Netherlands
- **Matthias Zigann**, Regional Court Munich, Germany
- **Andreas Haderlein**, Chairman of Technical Board, Boards of Appeal

Legal framework

Article 84 EPC

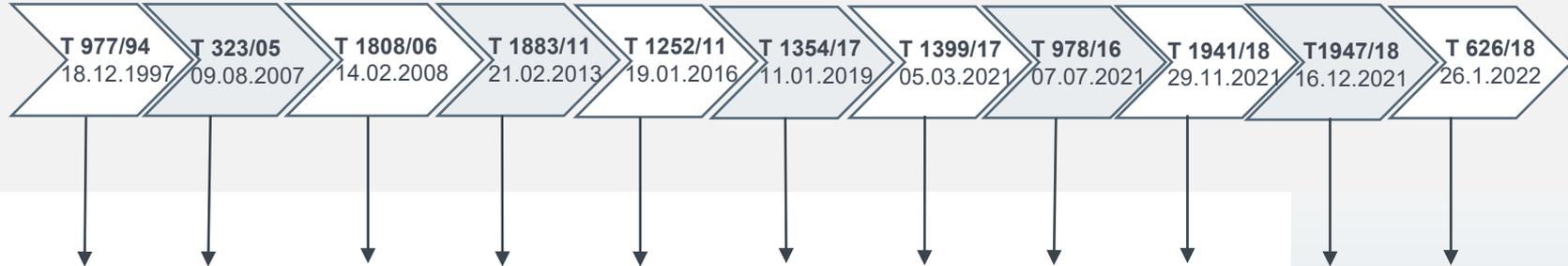
The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

Consistency of claims with the description

=

No contradiction between the description and the claims

Legal framework



In order to meet the requirement of Article 84 EPC:

- the claims have to be supported by the description,
- the description has to be amended,
- 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,
or an **embodiment which is not covered by the claims must be prominently stated.**

Legal framework: Individual decision T 1989/18

- **Different line taken:** T 1989/18
- **Statement in the decision:**
Neither Art. 84, Rule 42(1)(c) nor Rule 48(1)(c) EPC can serve as the basis for refusing an application with a non-adapted description
- EPO will not follow this decision, **since it is seen as an isolated decision.**
- The established case law was **confirmed by two recent decisions on 16.12.2021 and 26.1.2022**
- **Case law will be carefully monitored.**

T 1494/17 by Board 3.5.02 of
16.12.2021

T 626/18 by Board 3.2.01 of
26.1.2022

Guidelines for Examination

Clarification 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 semi-conductor 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 2022, F-IV, 4.3(iii)

(iii) Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought

According to Art 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description. Parts of the description that give the skilled person the impression that they disclose ways to carry out the invention but are not encompassed by the wording of the claims are inconsistent (or contradictory) with the claims. Such inconsistencies may be present in the application as originally filed, or may result from amending the claims to such an extent that they are no longer consistent with the description or drawings.

For example, an inconsistency may exist due to the presence of an alternative feature which has a broader or different meaning than a feature of the independent claim. Further, an inconsistency arises if the embodiment comprises a feature which is demonstrably incompatible with an independent claim.

However, it is not an inconsistency when an embodiment comprises further features which are not claimed as dependent claims, as long as the combination of the features in the embodiment is encompassed by the subject-matter of an independent claim. Similarly, it is not an inconsistency when an embodiment fails to explicitly mention one or more features of an independent claim as long as they are present by reference to another embodiment or implicit.

For borderline cases where there is doubt as to whether an embodiment is consistent with the claims, the benefit of the doubt is given to the applicant."

The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where the claims may be broadened instead.

inconsistency

delete or mark

Legal framework: Implications

Claim construction

In litigation proceedings, judges construe granted claims



Claims and description consistent

EPO delivers patents in compliance with Art. 84 EPC

Everything is considered in scope

- **Matter** described as an “embodiment”, “example”, “aspect” or the like may be taken as being within the scope of protection
- **Practice to take prosecution history into account varies**

Unpredictable outcome

- Jeopardises legal certainty
- May result in rendering a limitation in the claims ineffective

The national Courts need a description adapted to the claims

UK High Court, *L'Oréal v RN Ventures* (2018)

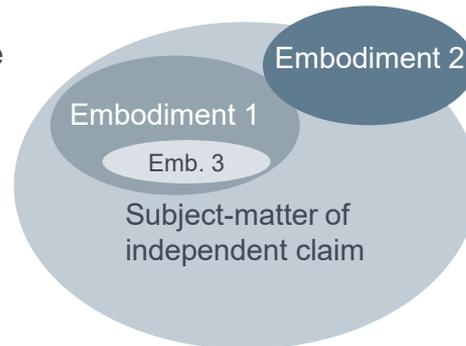
Inconsistency - What is it?

Embodiment

parts of the description which disclose a specific mode of carrying out the invention

(e.g. G 2/10)

Inconsistency = **Embodiment** not falling within the **subject-matter** of the independent **claims**



Inconsistency - What is it?

- Inconsistencies between the claims and the description **must be** removed (Art. 84 EPC, support)

↓ Normally by amending the description. In some cases it might be possible to broaden the claims.

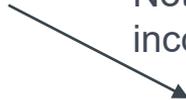
- Inconsistency = embodiments which do not fall within the claimed subject-matter

Inconsistency



- alternative feature with broader or different meaning
- incompatible features

Not an inconsistency



- further features which are not claimed as dependent claims
- some features are implicit (or present by reference to other embodiments)

Inconsistency - Example - T 1399/17

Claim

A triglyceride-based dietary fat for use in a method for limiting the level of cholesterol...wherein said dietary fat is a blend of **natural fats**...

Description

...**desirably**, the balance of fatty acids is achieved using a blend of natural fats...

...**preferably**, the dietary fat composition is a blend of natural fats...

...**interesterified fats** may still be used in the present invention...

- Mandatory feature is referred to as being optional
- “Interesterified fats” are not natural fats

Inconsistency - Responsibility

- Duty of the **applicant**

Final responsibility for the text of the patent lies with the **applicant** (Art.113(2) EPC and G1/10) but the examining division must provide at least one example of an inconsistency

- Examining division will adapt only in simple and **straightforward** cases

- Recommended to **clarify** with the applicant which embodiments describe the claimed invention and which do not

- The Guidelines C-V, 1.1 define the extent of changes that the division can propose with a Rule 71(3) communication

Inconsistency - Responsibility

- If the only outstanding objection is amendment of the description, applicant will be invited to bring the description in line by:
 - a communication under Art. 94(3) with **two-month** time limit; or
 - contact by telephone, minutes of consultation will be dispatched with **one-month** time limit (or less if the applicant agrees)
- If there are other objections, but **suggestions** to overcome are given:
 - applicant will be invited to bring the description in line when filing amended claims **if the suggestion is followed**
- Guidelines 2022, B-XI, 3.8; C-II, 3.1 and 3.2; C-III, 2

Changes in the 2022 Guidelines

GL2021 v GL2022 - Definition of Inconsistency

Examples

Where the embodiment:

- comprises an alternative feature which has a broader or different meaning than a feature of the independent claim
- defines subject-matter corresponding to a claim deleted as not allowable (exception to patentability, e.g. a method under Art. 53(c) EPC)
- comprises a feature worded as being optional whereas it is mandatory in the claim (or omits altogether)

GL2021 v GL2022

GL 2021

GL2022

For example, an inconsistency may exist due to the presence of an **alternative feature** which has a broader or different meaning than a feature of the independent claim. Further, an inconsistency arises if the embodiment comprises a feature which is demonstrably **incompatible** with an independent claim.

Comment: Definition of an inconsistency

GL2021 v GL2022

GL 2021

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.

GL2022

Similarly, ~~subject-matter~~ **Subject-matter in the description regarded as exceptions to patentability under Art. 53(c)** 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. **For the latter case, the description may be amended by adding an indication as follows:** “The references to the methods of treatment by therapy or surgery, or in vivo diagnosis methods in examples X, Y and Z of this description are to be interpreted as references to compounds, pharmaceutical compositions and medicaments of the present invention for use in those methods”.

Comment: Specification on how to deal with embodiments falling under the exceptions to patentability under **Art. 53(c)**

GL2021 v GL2022

GL 2021

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.

GL2022

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~~ **if they make a mandatory** feature of an independent claim **appear as being optional**.

Comment: Editorial change, clarification

GL2021 v GL2022 - Definition of Inconsistency

What is it not?

- Where the embodiment:
 - has further features which are not claimed as dependent claims
(as long as the combination of the features in the embodiment is encompassed by the subject-matter of an independent claim)
 - fails to explicitly state some features of an independent claim
(as long as they are present by reference to another embodiment or implicit)
- Dependent claims by definition state further features, these features may be worded as optional in the description
- **Benefit of the doubt** as to the presence of an **inconsistency** is given to the applicant

GL2021 v GL2022

GL 2021

GL2022

However, it is **not an inconsistency** when an embodiment comprises **further features which are not claimed** as dependent claims, as long as the combination of the features in the embodiment is encompassed by the subject-matter of an independent claim. Similarly, it is not an inconsistency when an **embodiment fails to explicitly mention** one or more **features** of an independent claim **as long as they are present by reference to another embodiment or implicit.**

For borderline cases where there is doubt as to whether an embodiment is consistent with the claims, the **benefit of the doubt** is given to the applicant.

Comment: Examples of what is **not** an inconsistency
Benefit of doubt given to the applicant

GL2021 v GL2022 - How to Adapt?

- **Generic disclaimers** are considered insufficient
- **Deleting** embodiments which no longer fall within the subject-matter of the claims

or

- **Marking** appropriately to retain subject-matter useful for highlighting specific aspects of the invention or as background

=> It is not required to provide any justification for choosing marking (clarified in GL 2022). **Deletion or marking equally possible**

GL2021 v GL2022

GL 2021

GL2022

An inconsistency between the description and the claims cannot be removed by introducing at the beginning of the description a **generic statement** 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. To remove the inconsistency, **such a statement has to refer to specific embodiments** (e.g. “Embodiments X and Y are not encompassed by the wording of the claims but are considered as useful for understanding the invention”).

Comment: “**Generic disclaimers**” are considered insufficient

GL2021 v GL2022

GL 2021

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 (T1808/06).

GL2022

~~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 (T1808/06).~~

The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought.

Comment: **Deletion or marking** of inconsistent embodiments are **equally possible**

How to adapt? - How to mark inconsistent embodiments

Evaluate potential inconsistencies



particularly if the claim is amended by limitation to a feature to meet the EPC requirements

Not an inconsistency if there are embodiments falling within the scope of the claims but not claimed as dependent claims

Can the subject-matter be referred to by numbered embodiments, examples, figures?

Yes

No

"The examples/aspects/embodiments X, Y, Z are **not according to the invention** and are present for illustration purposes only"

use at the start of examples/aspects/embodiments or list of figures

Mark up in the text of the description by adding "**not according to the invention**"

How to adapt? - How to mark inconsistent embodiments

- ➔ Mere **replacement** of “embodiment” with the terms “example”, “aspect”, “disclosure” or similar is **not sufficient**

Why not?

- Terms used interchangeably in case law
- Do not specifically mean “not encompassed by the claimed subject-matter”
- Always possible to find new wording in applications

Recommended terms

- subject-matter of claims
- Invention

Examples:

“not falling within claimed subject-matter”, “not covered by the claims”, “not part of the invention”, “not according to the invention”

GL2021 v GL2022

GL 2021

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.

GL2022

~~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.~~

The terms “disclosure”, “example”, “aspect” or similar do not necessarily imply that what follows is not encompassed by an independent claim. Unambiguous expressions have to be adopted to mark an inconsistent embodiment (e.g. by adding “not encompassed by the wording of the claims”, “not according to the claimed invention” or “outside the subject-matter of the claims”) instead of replacing the terms “embodiment” or “invention” by one of the aforementioned terms.

Comment: Specification which **wording** is or is not to be used for marking inconsistent embodiments

GL2021 v GL2022 - Objection

Before refusing an application due to an inconsistency between the claims and the description, the **division needs to provide at least one example** of such inconsistency.

GL2021 v GL2022

GL 2021

GL2022

When inviting the applicant to amend the description, the **division provides examples of embodiments inconsistent with the independent claims** and brief reasons as to why. If the inconsistency concerns describing a mandatory feature of an independent claim as optional, the division provides an example passage.

Comment: When raising an objection, the examining division must provide at least one example of an inconsistency.

GL2021 v GL2022 - Examples

Original claim

Vehicle with a motor and features A, B ...

Amended claim

a vehicle with an electric motor

Description

Embodiment 1: vehicle with an electric motor, features A, B..-

Embodiment 2: vehicle with a combustion engine, features A, B ..

- Embodiment 2 is no longer consistent with the independent claim (unless it can be inferred the combustion engine is used in combination with the electric motor)
- **Clear-cut case, must** be amended

GL2021 v GL2022

GL 2021

GL2022

Example: Independent claim defines a **vehicle with** a broad feature of a **“motor”**, together with other features. The description and the drawings comprise Embodiment 1, in which the vehicle has an electric motor, and **Embodiment 2**, in which the **vehicle has a combustion engine**. During the prosecution, in order to fulfil the requirements of inventive step, the **independent claim** is amended to specify a **vehicle employing an electric motor** since the combination of claimed features using a combustion engine was anticipated by the prior art. **Embodiment 2 is no longer consistent** with the independent claim, unless it can be inferred from this embodiment that the combustion engine is used in combination with the electric motor. This inconsistency can be rectified either by removing Embodiment 2 from the description and drawings or by marking Embodiment 2 as not being covered by the claimed subject-matter (e.g. “Embodiment 2 is not covered by the subject-matter of the claims” or similar wording).

Comment: A new example was chosen taking into account discussions with SACEPO.

GL2021 v GL2022 - Claim-like clauses

- Claim-like clauses **must** be deleted before grant
- The applicant may formulate paragraphs in a non-claim like manner.

F-IV, 4.4

-
- ▶ - The two reasons as to why the claim like clauses were interpreted as if they were criteria to be met
 - They were only explanations as to why such clauses must be removed at all times, not criteria to be evaluated
 - To prevent this confusion, this explanation is removed from the section
 - Wording clarification as to what should be considered as a claim-like clause
 - No change in practice

GL2021 v GL2022

GL 2021

Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant because:

- they are inconsistent with the claimed subject-matter, they lead to unclarity as to the actual scope of protection and hence do not fulfil the requirements of Art. 84 (see F-IV, 4.3(iii));
- they only repeat the claimed subject-matter in a very literal manner, they are an irrelevant and unnecessary reduplication and hence do not fulfil the requirements of Rule 48(1)(c) (see F-II, 7.4).

GL2022

Finally, **claim-like clauses must also be deleted or amended to avoid claim-like language** prior to grant **since they otherwise may lead to unclarity on the subject matter for which protection is sought.** because:

- ~~– they are inconsistent with the claimed subject-matter, they lead to unclarity as to the actual scope of protection and hence do not fulfil the requirements of Art. 84 (see F-IV, 4.3(iii));~~
- ~~– they only repeat the claimed subject-matter in a very literal manner, they are an irrelevant and unnecessary reduplication and hence do not fulfil the requirements of Rule 48(1)(c) (see F-II, 7.4).~~

Comment: **Clarification**, the two bullet points were sometimes misunderstood as criteria as to when amendments were necessary

GL2021 v GL2022

GL 2021

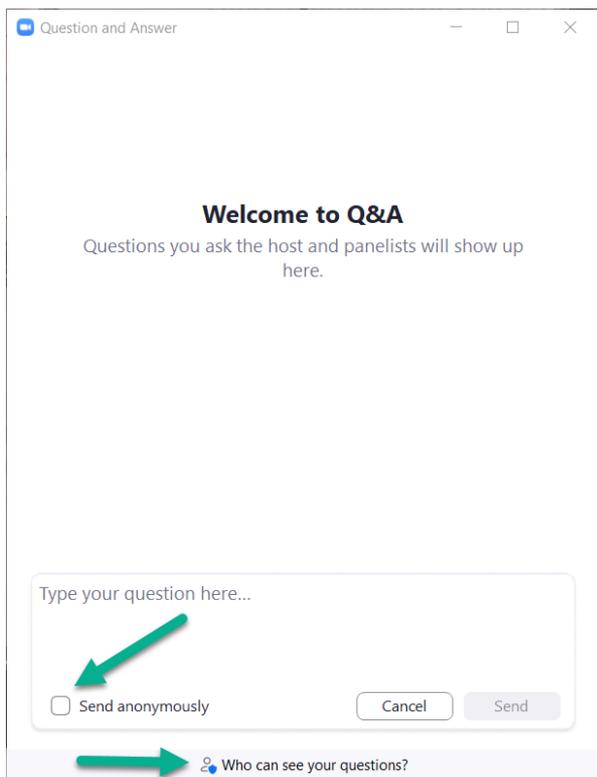
The term “claim-like clauses” means clauses present in the description which use claim language such as “according to the preceding clause”, “according to clause 1”, “characterised in that”, “further comprising”, and so on. These claim-like clauses are usually found at the end of the description and/or in the form of numbered paragraphs.

GL2022

The term “claim like clauses” means **a list of clauses present in the description which, despite not being called “claims”, appears as claims and usually comprises an independent clause followed by a number of clauses referring to previous clauses.** ~~use claim language such as “according to the preceding clause”, “according to clause 1”, “characterised in that”, “further comprising”, and so on.~~ These claim like clauses are usually found at the **end of the description** and/or in the form of **numbered paragraphs**, particularly in **divisional or Euro-PCT applications**, where the original set of claims from the parent or PCT application is appended to the description.

Comment: Clarification, better **definition** of claim like clauses

Your questions



Please write your questions in the **Q&A** (icon at the bottom of the Zoom window).

You may post them anonymously, otherwise your name will be visible to all participants.



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Thank you for your attention!

