Guidelines2day

Adaptation of the description
Live session on 9 March 2022
(PL91-2022)

Questions and answers

Preamble

This is a collection of questions which were asked during the Q&A part of the presentation but which could **not** be answered during the live session anymore.

1. T 1989/18 and general legal aspects

Can I suggest a referral by the President to settle the case? This “isolated” decision seems a quite convincing…

Is not that the function of the Enlarged Board - and not of the first instance or of external judges?

According to Article 112(1)(b) EPC, the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on a point of law. In the case at stake, only one isolated decision has been issued so far and the conditions are not met for allowing the President to refer a question to the Enlarged Board of Appeal. The Office will of course monitor the future decisions on that topic.

How do you think about consistency of inconsistency b/w the 2022 guideline and the recent board case T 1989/18?

I am truly surprised that you take the authority to neglect T 1989/18, or to even consider it to be incorrect. In my understanding of the EPC, such evaluation of conflicting decisions is in the competence of the Enlarged Board of Appeal (only). To secure legal certainty, for applicants as well as third [parties, a referral seems appropriate. (Note that the Board in T 1989/18 argued why the earlier decisions are wrong and for that reason did not ask for a referral - with the conflicting decisions as a result. Such choice is at their competence, as they only need to refer if they consider that it is not clear how to

interpret the law - so, they DO consider it clear and unambiguous). I expect that many applicants/representatives will refer to T 1989/18 in the near future, as long as there is no absolute settlement of the situation by the competent authority - the Enlarged Board.

T1989/18 is seen in the context of the previous and later decisions relating to the application of Article 84 EPC on the adaptation of the description to the claims which clearly laid down that those embodiments which are no longer supported by the claims must either deleted or earmarked as not falling with the claimed subject matter. In addition, for example in decision T 1024/18 of 1 March 2022, Board of Appeal 3.2.06 in a five-member composition explicitly disagrees with the recent decision T 1989/18, by explaining that Art. 84 EPC covers three distinct requirements on claims, namely their clarity, their conciseness and their support by the description. The criterion that the claims be "supported by the description" is not in any way subordinate to the requirement of "clarity" of the claims but is a requirement of its own (as is conciseness of the claims) (reason 3.1.7 T1024/18).

I heard earlier about a second decision going in the same direction of T 1989/18. Can someone supply the reference to that decision?

The Office is not aware of a second decision of the Board of Appeals supporting the interpretation given in T1989/18.

T 1989/18 may not be a one-off and hence is not to be ignored in my eyes. Existence of previous decisions going in another direction does not exclude that the case law may change...

The case law may indeed change, and this is the reason why the Office is and will keep monitoring the decisions issued by the Boards of Appeal on that topic.

The EPC nowhere says that the description and the claims must be 1:1 corresponding. It just says that the claims must be supported by the description. Thus, there may be more.

Could you cite where in the EPC is the legal basis for a prohibition of reciting embodiments as clauses?

The requirement results from the interpretation given to Article 84 EPC in the established case law. For example, a recent decision T 1024/18 points out that according to long established case law of the Boards of Appeal, the requirement that the "claims shall be supported by the description" according to Art. 84 EPC has been interpreted as requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC.

Does this inconsistency practice in the EPO align with the practices of other EPC member states?

The EPO is applying the provisions of the EPC as interpreted by the Boards of Appeal of the EPO. National legislations of the EPC member states are adopted by national legislators.

I am sorry, if the UK court has an issue, it could be solved by UK legislation and case law, e.g. the national law/case law can define how the file wrapper is used, as e.g. in NL (where the file wrapper can be used to prevent that equivalents which have been abandoned can still be used based on claim interpretation alone).

For example, decision T1024/18 contemplates post grant national proceedings relating to European patents by stressing the relevance of the adaptation of the description in the context of Art. 69(1) EPC, according to which the description is also to be considered when interpreting the claims. Inconsistencies between the claims and the description could thus be the source of diverging interpretations as regards the scope of the claims. Thus, the support requirement of Art. 84 EPC also serves the aim to ensure legal certainty for national post-grant proceedings (as do the requirements of clarity and conciseness).

For national patents granted by National Patent Offices, see previous reply.

Isn't this entire discussion about requiring the description to be supported by the claims?

Article 84 EPC requires that the claims shall be supported by the description**.**

In my eyes the claims are to be self-consistent, i.e. to be read and understood by themselves. The boundaries of the claims are defined in the claims themselves, not in the description. The adaptation of the description should not "block" otherwise allowable application claims. What do you think about this point of view?

The claims shall be clear but also supported by the description. There is no contradiction between these requirements. However, embodiments which are not directly claimed but fall within the scope of the claimed subject matter may be referred to for instance before national jurisdictions.

Has any consideration been made of the additional cost to applicants of making these changes during prosecution, when in fact there is little historical issue with descriptions containing embodiments clearly not falling within the scope of the claims? Surely if it is clear to the ED what embodiments fall outside of the scope of the claims, why would this cause issues at any point after grant? Surely the same view would be taken in post grant proceedings and such embodiments would then not be used to infer any limitations on the claims?

The Office is aware of the extra efforts for both the applicants and the examining division for ensuring that the description is adapted to the claims. However, this requirement derives from the EPC (Article 84 EPC) to which the EPO is bound and ensures that patents granted by the EPO are of high quality. Competitors contemplating a possible entry into the market may rely on them.

This discussion has concentrated on inconsistencies. Is it not inconsistent to equate (1) a requirement that the claims are to be supported by the description, with (2) a requirement that the description is to be adapted to the claims?

According to Article 84 EPC, the claims must be supported by the description. This means that when the description is not aligned with the claims, it must be adapted to the claims.

2. Opposition

Could you comment on the "responsibility" aspect in an opposition case. What if the opponent requests an amendment and this is not accepted by the Proprietor?

Opposition proceedings, by definition, comprise more than one party. Both parties have a right to comment on any adaptation of the description. It is the proprietor's responsibility to adapt the description to any amended claims.

3. Examination

How often does an inconsistency between the claims and description actually end up being a problem?

In many cases applicants adapt the description when an allowable set of claims has been identified and when requested to do so by the examiner. In a handful of cases per year examiners need to send a second communication when the adaptation was not or only incompletely done. In rare cases, maybe less than once a year, no agreement can be reached in the written procedure and the applicant is summoned to oral proceedings only dedicated to adaptation of the description. In most cases thereof an agreement will be reached before the date of the oral proceedings.

Is a harmonised approach expected throughout the EPO, or will it as usual differ from examiner to examiner?

The Guidelines concerning adaptation of the description have been revised with the aim to better explain when and how the description needs to be amended. In addition, internal harmonisation activities are taking place.

If my claim says "racing car", that claim is supported as soon as the description mentions such a racing car, but also if it mentions airplanes.

As concerns inconsistencies between the claims and the description, the embodiment relating to the airplane is acceptable as long it is clear that there is the claimed racing car on that airplane.

When during the prosecution no amendments are made to the claims and a A94(3) communication is received only asking the applicant to adapt the description, this means that a review on the description shall still be made?

There are sometimes cases where the description cites broader embodiments than the original claims. This requires amendments. Sometimes it may also happen that examiners send out a sort of standard text to the applicant not considering the claims are in their original form and that no amendments are required. In any case, before a grant the description should be reviewed for other deficiencies, such as incorporation of prior art (F-III, 8.), statements relating to the spirit of the invention and similar (F-IV, 4.4)

It is up to the applicant what he considers to be relevant to add to the description, not to an examiner as long as it is not violating an EPC requirement.

Yes, as long it is not violating the EPC, which includes Article 84 EPC and which in turn requires the claims and the description to be consistent.

4. How to adapt

If there are no identified inconsistencies, e.g. optional features that are now mandatory, is there still legal basis for an Examiner to require the addition of a sentence like: "The invention is defined by the claims".

If there are no inconsistencies between the description and the claims adding a sentence of "The invention is defined by the claims" does not seem necessary. There may be situations in which adding such a sentence, in particular after amendments/deletions to the description, may improve readability.

Instead of marking with "not according to the invention" is it still allowed to use the term "disclosed herein"

The term "disclosed herein" is an ambiguous expression similar to "disclosure", "example", "aspect" and does not clearly mark a non-inventive embodiment as such, see F-IV, 4.3(iii).

Is the statement "according to the disclosure" sufficient to mark that the embodiment is no longer "according to the invention". Further, PCT description written by US attorneys frequently write "according to the disclosure". Should you then change it to "according to the invention" so that at the end of the proceedings, one can add "according to the disclosure" in case an embodiment should be excluded?

The term "according to the disclosure" is an ambiguous expression similar to "disclosure", "example", "aspect" and does not clearly mark a non-inventive embodiment as such, see F-IV, 4.3(iii). For this reason, the approach outlined in the question cannot be used.

Art. 52(1) EPC suggests that an invention is not necessarily new or does not necessarily involve an inventive step. However, if the word “invention” is used in the description, is this nevertheless to be understood as a reference to the matter for which protection is sought?

Yes, it will be.

The theory being "adaptation of the description" is clear but putting it into practice is far from straightforward in many cases.

For this reason, the respective section of the Guidelines was revised in order to provide more guidance to the applicants and examiners.

What if an embodiment partially falls within and partially outside of the scope of the claims? Should the embodiment be marked as out of the scope of the claims in its integrity?

If this embodiment can be delimited versus the independent claims, the part outside the scope of the claims needs to be marked as such. If it cannot be delimited the entire embodiment needs to be marked as not being according to the invention.

Should the title be also adapted when, for example, a process and a device were originally claimed but the final set of claims only contains one of those subject-matter?

The title will be amended by the division, if necessary.

If features from an embodiment in the description clearly fall within the subject matter of the claims, but other features of that embodiment fall outside of the claims, can the description be rewritten to add a further embodiment only containing the subject matter that falls within the claims (excluding those features outside of the claims)?

This is a way of adapting the description. The embodiment falling outside the claims then needs to be deleted our marked accordingly.

Is it possible to specify that an embodiment does not fall within the scope of the claims but is equivalent to the claimed invention? If an equivalent embodiment (i.e. under doctrine of equivalents) needs to be specifically excluded completely and not referred to as equivalent, perhaps this could exclude it being caught as an infringement (under the doctrine of equivalents).

Article 2 of the Protocol on the Interpretation of Article 69 EPC governs the interpretation of the extent of protection conferred by a European patent by equivalents. It applies for granted patents and is left to national courts and therefore is outside the examination procedure.

Granted claim 1: A+B+C+D, original Fig. 1 and original claim 1 are broader: A+B+C. Is the embodiment of Fig. 1 inconsistent and does it need to be marked?

Yes.

In a summary of the invention, there is written [01] In an embodiment, feature A is part of the device. [02] In an embodiment, feature B is part of the device. The amended claim mentions that the device includes features A and B. Should the description be amended to delete the wording "in an embodiment"?

Amending the description as suggested above will not rectify any discrepancy between the claims and the description, see F-IV, 4.3(iii) and the section relating to the terms "disclosure", "example", "aspect" or similar.

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5. Oral Proceedings

Is it necessary to check for inconsistency and final adaptation of the description take place during the oral proceedings before ED?

The purpose of an oral proceedings is to bring the case to a close. Consequently, the applicant needs to be prepared to adapt the description during the oral proceedings in the case an allowable set of claims has been identified.

6. General

Could you explain why a generic disclosure is not acceptable?

If a generic disclosure is broader than the independent claims it creates an inconsistency between the description and the claims and thus needs to be amended by deletion of marking. The independent claims need to be the most generic disclosure of the invention.

7. Time aspect

Thorough examination of the adaptation is very good. Are all parties aware that this cannot come without extra time investment from the side of examiners? I am particularly thinking of descriptions of hundreds of pages.

The Guidelines with respect to adaptation of the description have been amended to give more guidance to applicants and examiners alike. The practice of the EPO has not changed. Therefore, the new Guidelines are not expected to result in more work for applicants and examiners, to the contrary, it is expected to lead to a more efficient procedure.

Will the divisions make sure that the description is appropriately adapted if there are hundreds of pages, e.g. in the field of biotechnology, and if so, how? I do not think that it is justifiable to grant a patent without checking that the adapted description is indeed in conformity with the claims, as it is also the responsibility of the examining division to examine that the application complies the requirements of Art. 84.

Applications will be examined for compliance with all provisions of the EPC with the same degree of thoroughness irrespective of their sizes.

8. Claim like clauses

Could you please provide an example of a non-claim like phrase in comparison to a claim like phrase?

Claim like clauses are drafted identical to claims except that "claims" is replaced by "phrases", "clauses" or there like. Claims define an invention in a very abstract way and usually are drafted in a single (long) sentence. Specifying features or embodiments in the description embedded in the "flow" of text will usually not be considered as claim like clauses. Usually claim like clauses are appended to the description in divisional applications and Euro-PCT applications.

May I ask whether "claim-like clauses" means the list of embodiments which may be form the final part of a description?

See answer provided above.

Usually, a specification has a section called 'Summary of the invention". The usual practice is that this part is identical to the main claim (or main claims). Would such "Summary of the Invention" be considered claim-like clauses?

If only claim 1 is found in the summary of the invention, this would be acceptable. However, if also all of the dependent claims are found there using identical wording as in the claims, this would be a typical example of claim like clauses.

Claim like clauses are added for a specific purpose to divisional and EURO-PCT applications. Then you may easily return to subject-matter of the (parent) application as filed.

This is well understood. The claim like clauses requirement is not a filing requirement but a requirement that needs to be met at grant. In post grant procedures, such as opposition or limitation proceedings, it is not possible to revert to broader embodiments outside the scope of the claims as granted. For this reason, they do not serve any purpose anymore at grant stage. More limiting claim like clauses may be incorporated into the description if they are redrafted in a non-claim like wording.

Claims "copied" as embodiments into the description: sometimes this should provide a basis for contextual disclosure. However, sometimes examiners say that embodiments in the text do not provide a proper base for combination of features...

This depends on how these embodiments are drafted, but this is a different topic than claim like clauses according to F-IV 4.4 and more related to the provisions of Article 123(2) EPC.

My understanding is that claim-like phrases in the description, in particular in the summary, are there to ensure features of the invention that could be claimed (assuming they are granted) but maybe aren't necessarily claimed on filing to not have 1000 claims, but that by being literally in the description allow claim amendments to be performed easily limiting the risk to infringe Art123(2) - if they were in the description, no doubt they could go on the claims - is this common practice?

It depends how the claim like clauses are drafted. Claims are drafted in a very particular manner in accordance with Rule 43 EPC. Claim-like clauses are clauses present in the description which despite not being identified as a claim, appear as such and usually comprise an independent clause followed by several clauses referring to previous clauses. This is different than how usually a description is drafted, which is a coherent document addressing the skilled person and outlining how an invention is put into practice. Claim like clauses in the sense of F-IV, 4.4 are seen rarely in the description but 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.