

Bringing the description in line with the scope of claims? The potential end of the 'Angora cat paradox' & other stories for sleepless nights

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BALDER

Past and present

Amendments relating to the description:

- the description should be brought into conformity with the new claims;

February 2020

Comments

DESCRIPTION

Page 1: Mention of relevant prior art in the description (Rule 42(1) EPC)

Pages 22-25: Deletion of irrelevant and/or superfluous information (Rule 48(1)(c) EPC, Guidelines F-II, 7.4)

Page 26: Doubtful extent of protection (Guidelines F-IV, 4.4)

April 2023

April 2022

4. Formal issues

To meet the requirements of Rule 42(1)(b) EPC, the document D1, D2 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

5. Adaptation of the description

The description should be brought into conformity with the amended claims, to that it fulfils the following requirements:

- The technical field of the invention (Rule 42(1)(a) EPC; Guidelines F-II.4.2) must correspond to the amended set of claims.
- The summary of the invention (Rule 42(1)(c) EPC; Guidelines F-II.4.5) must correspond to the amended set of claims. Where appropriate, statements such as "The invention is set out in the appended set of claims" or "The invention is as defined in claim X" may be used instead of repeating the claims verbatim.
- Embodiments which are no longer covered by the claims must be deleted, unless they can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. If this is the case, they must be clearly marked as not being part of the present invention (T 1808/06 and Guidelines F-IV, 4.3)
 - Any combinations of features which do not fall under the scope of the amended independent claims must be clearly marked as not being part of the present invention.
 - Statements such as "The following examples/aspects/embodiments X, Y, Z are not according to the invention and are present for illustration purposes only" may be used at the start of the description or in the list of figures.
- The technical features of the independent claims may not be presented as optional in the description. Where they precede a feature of an independent claim, terms such as "for example", "may", "can", "exemplary", "optionally", "preferably" and the like must be removed.
- "Claim-like" clauses must be deleted prior to grant. Claim-like clauses are clauses present in the description which use claim language such as "according to the preceding clause" or "characterised in that" (Guidelines F-IV, 4.4). Claim-like clauses include examples, embodiments or aspects which are presented as claim-like clauses. The simple conversion of these clauses into separate optional features will not be admitted either.

Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter extending beyond the content of the application as originally filed (Article 123(2) EPC).

Outline

- The evolution of the EPO Guidelines for Examination (2021-2023)
- Diverging EPO BoA decisions (I)
 - ✓ EPO BoA decisions timeline and analysis
 - ✓ T 1399/17, T 1989/18 and T 1024/18
- Diverging EPO BoA decisions (II) - The aftermath of T 1989/18 vs T 1024/18: More ripples in the sand
 - ✓ T 2766/17, T 2293/18, T 3097/19, T 1444/20, T 2194/19, T 0121/20, T 1516/20 and T 1426/21
 - ✓ T 56/21 (ongoing appeal proceedings)
- Conclusion: Some thoughts on the adaptation of the description
- (The High Court of England and Wales on the impact of adapting the description (June 2023): *Ensygnia vs Shell* [2023] EWHC 1495)

- **The evolution of the EPO Guidelines for Examination
(2021-2023)**

EPO Guidelines for Examination 2021

F-IV 4.3 (iii) - 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.

They (*i.e.* the claims) shall be clear and concise and be supported by the description

The claims shall define the matter for which protection is sought

EPO Guidelines for Examination 2021

F-IV 4.3 (iii) (cont'd):

- Embodiments in the description which are no longer covered by the independent claims must be deleted unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims:
 - The fact that an embodiment is not covered by the claims must be prominently stated (T 1808/06).
 - Changing the wording “invention” to “disclosure” and/or “embodiment” to “example”, “aspect” or similar is not enough.
 - The description must be amended in such a way that terms such as “preferably”, “may” or “optionally” shall not precede a feature of an independent claim.
- 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.

EPO Guidelines for Examination 2021

F-IV 4.4 – [...] claim-like clauses

- 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;
 - They only repeat the claimed subject matter in a very literal manner, they are an irrelevant and unnecessary reduplication and hence do not fulfill the requirements of Rule 48(1)(c).

The EP application shall not contain any statement or other matter obviously irrelevant or unnecessary under the circumstances

But what if claim-like clauses contain additional subject matter not encompassed by the other parts of the description?

EPO Guidelines for Examination 2022 - ¿In search of equilibrium?

F-IV 4.3 (iii) Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought

- 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 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.



EPO Guidelines for Examination 2022

F-IV 4.3 (iii) (cont'd)

- 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.
- An inconsistency arises if the embodiment comprises a feature which is demonstrably incompatible with an independent claim.

But who sets the bar which decides what a “broader or different meaning” is or whether two features are “demonstrably incompatible”? Upon which criteria? On what legal and technical basis?

EPO Guidelines for Examination 2022

F-IV 4.3 (iii) (cont'd)

- An inconsistency between the description and the claims cannot be removed by introducing at the beginning of the description a generic statement [...] 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”).
- 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 “disclosure”, “example”, “aspect” or similar.
- Subject-matter in the description regarded as an exception to patentability under Art. 53(c) 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".

EPO Guidelines for Examination 2022

F-IV 4.4 – [...] claim-like clauses

- 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 → No longer mentioned that claim-like clauses “only repeat the claimed subject matter in a very literal manner, they are an irrelevant and unnecessary reduplication and hence do not fulfill the requirements of Rule 48(1)(c).”

EPO Guidelines for Examination 2023

F-IV 4.3 (iii) Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought

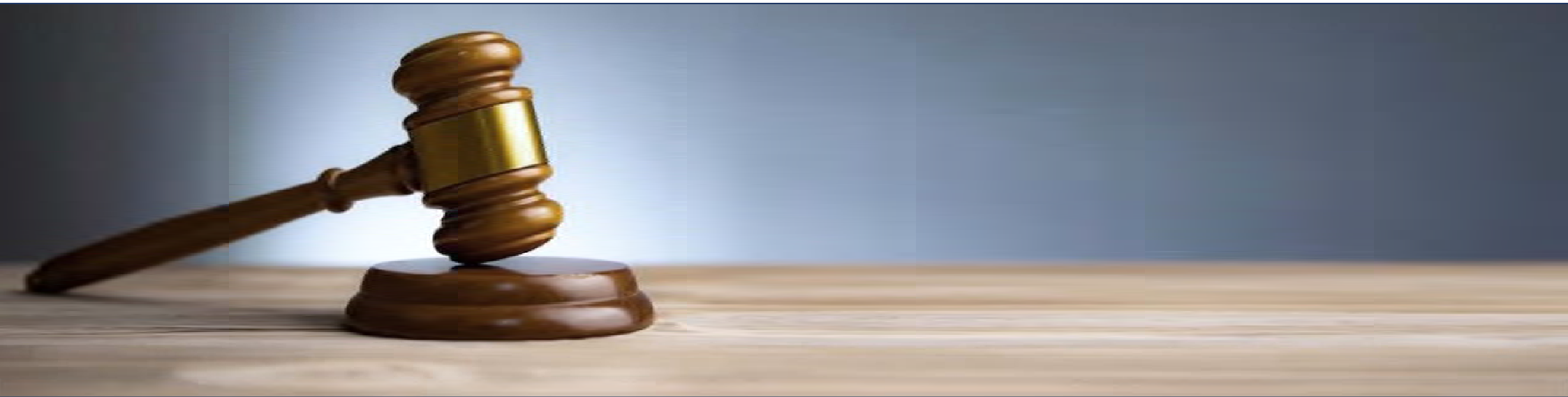
Examples aimed at illustrating the meaning of having a “broader and different meaning” or having a feature which is “demonstrably incompatible” with a different claim are provided.

- The independent claim defines a feature as being made of "purely substance X", whereas the description defines it as being made of a blend of substances "X and Y";
- The independent claim defines the feature of an article comprising nicotine-free liquid material, whereas the description states that the liquid material may contain nicotine.

The benefit of the doubt for borderline cases is still given to the applicant...

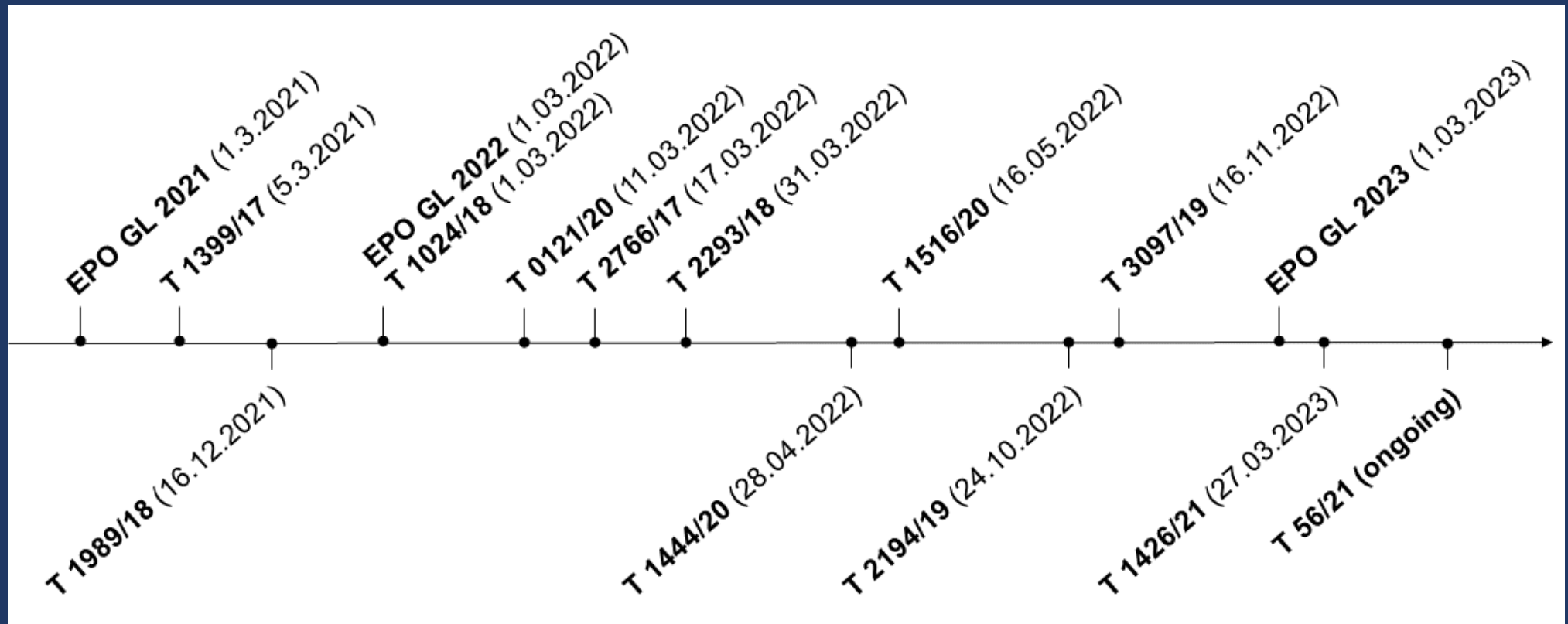
F-IV 4.4 [...] claim-like clauses

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 → Approach regarding claim-like clauses unamended (vs 2022 EPO GL)



Diverging EPO Board of Appeal decisions (I)

EPO BoA decisions - Timeline



EPO BoA decisions – Analysis (I)

Decisions supporting stringent adaptation requirements				Decisions supporting more flexible adaptation requirements			
T Decision nr.	Decision date	BoA	Distribution status†	T Decision nr.	Decision date	BoA	Distribution status†
1399/17	05.03.2021	3.3.09	D	1989/18	16.12.2021	3.3.04	D
1024/18	01.03.2022	3.2.06	C	1444/20	28.04.2022	3.3.01	D
0121/20	11.03.2022	3.2.01	D	2194/19	24.10.2022	3.5.03	D
2766/17	17.03.2022	3.2.02	C	1426/21	27.3.2023	3.2.01	D
2293/18	31.03.2022	3.5.02	C	56/21	Ongoing	3.3.04	tbd
1516/20	16.05.2022	3.2.01	D				
3097/19	16.11.2022	3.5.06	C				

†D = not distributed; C = distributed to board chairmen; B = distributed to board chairmen and members; A = published in the EPO's OJ

All BoA opinions issued against the strict adaptation requirements provided in the amended EPO/GL have received distribution status “D”, while more than 50% of those supporting that approach received distribution status “C”!

EPO BoA decisions – Analysis (II)

Decisions supporting stringent adaptation requirements				Decisions supporting more flexible adaptation requirements			
T Decision nr.	Decision date	BoA	Distribution status†	T Decision nr.	Decision date	BoA	Distribution status†
1399/17	05.03.2021	3.3.09	D	1989/18	16.12.2021	3.3.04	D
1024/18	01.03.2022	3.2.06	C	1444/20	28.04.2022	3.3.01	D
0121/20	11.03.2022	3.2.01	D	2194/19	24.10.2022	3.5.03	D
2766/17	17.03.2022	3.2.02	C	1426/21	27.3.2023	3.2.01	D
2293/18	31.03.2022	3.5.02	C	56/21	Ongoing	3.3.04	tbd
1516/20	16.05.2022	3.2.01	D				
3097/19	16.11.2022	3.5.06	C				

†D = not distributed; C = distributed to board chairmen; B = distributed to board chairmen and members; A = published in the EPO's OJ

BoA 3.2.01 appears not to be following a consistent approach: Two decisions against the new EPO/GL approach but one against it!

EPO BoA decisions – Analysis (III)

Decisions supporting stringent adaptation requirements				Decisions supporting more flexible adaptation requirements			
T Decision nr.	Decision date	BoA	Distribution status†	T Decision nr.	Decision date	BoA	Distribution status†
1399/17	05.03.2021	3.3.09	D	1989/18	16.12.2021	3.3.04	D
1024/18	01.03.2022	3.2.06	C	1444/20	28.04.2022	3.3.01	D
0121/20	11.03.2022	3.2.01	D	2194/19	24.10.2022	3.5.03	D
2766/17	17.03.2022	3.2.02	C	1426/21	27.3.2023	3.2.01	D
2293/18	31.03.2022	3.5.02	C	56/21	Ongoing	3.3.04	tbd
1516/20	16.05.2022	3.2.01	D				
3097/19	16.11.2022	3.5.06	C				

†D = not distributed; C = distributed to board chairmen; B = distributed to board chairmen and members; A = published in the EPO's OJ

Both the earliest and the most recent BoA opinions against the strict adaptation requirements set out in the EPO/GL have been issued by the same BoA (3.3.04) regarding two patents from the same patent applicant (F. Hoffmann-La Roche AG)

T 1399/17

**(Balanced myristate- and laurate-containing edible
oil;
Brandeis University)**

T 1399/17 – First signs of change are glimpsed

Appeal proceedings against the OD decision to maintain the patent in amended form (AR1, including amended claims + amended description) were based on an apparent inconsistency between the claims and the specification:

1. A triglyceride-based dietary fat for use in a method for limiting the level of at least one of triglycerides (TG), total cholesterol (TC) and LDL cholesterol in the plasma of a human or livestock animal, whose fatty acid composition comprises

10 to 35% by weight linoleic acid;

at least 10% by weight monounsaturated fatty acids; and

15 to 55% by weight saturated fatty acids,

wherein 10 to 45% by weight of said fatty acid composition is myristic acid (14:0) plus lauric acid (12:0) in which at least 3% of said fatty acid composition is myristic acid and at least 3% is lauric acid,

wherein said dietary fat is a blend of natural fats ~~and/or oils~~, and

wherein the total weight percent of fatty acids in said fatty acid composition is 100%.

VS

[0040] [p]referably the dietary fat composition is a blend of natural fats [...]

[0125] While Applicants prefer to avoid use of interesterified fats, such fats may still be used in the present invention [...]

[0208] Interesterified dietary fats were prepared by the Stepan Company (Northfield, IL) using random chemical interesterification to combine the following fats or fatty acids and vegetable oils [...]

Parties disagreed on whether the patent specification had been correctly adapted, in particular regarding the features “natural fat” and “natural oil”.

T 1399/17

Appellant (opponent):

- The terms “natural fats” and “natural oils” refer to edible fats and oils which are extracted from animal, microbial or preferably plant sources, or a fraction of such oil that does not contain a significant level of triglyceride molecules which have been artificially structurally modified and preferably no such artificially structurally modified triglyceride molecules.
- The specification as amended, though, contains in several locations references to interesterified fats which are stated in the specification in their present form as may be part of the composition in the use claimed. Thus there may result doubt as to the scope of the patent.

Patent proprietor:

- A natural fat according to the definition merely does not contain a “significant amount” of artificially structurally modified triglycerides, but structurally modified fats (such as interesterified fats) indeed are within the scope of the claims.
- Furthermore, the term “natural fat” is not relevant for the patentability of the claims which derive from the balanced linoleic and chlosterolemic myristic/lauric acid ratio, so the objection based on an inconsistency is unfounded.
- The amendments must be appropriate and necessary, and nothing more (T 0323/05).
- The skilled reader in the present context understands that some examples may not form part of the claimed subject matter as maintained, but are illustrative. Data and examples are absolute and do not change merely because the scope of the claims do. It is, therefore, neither appropriate nor necessary to delete them.

T 1399/17

The BoA found the patent proprietor's arguments not convincing:

- Article 84 EPC requires that the claims be supported by the description. This also applies to claims which have been amended in opposition (Article 101(3)(a) EPC).
- The specification of the patent as amended in oral proceedings did not reflect this, so it cast doubts on the scope of the claim.
- The Respondent (*i.e.* the patent proprietor) surprisingly reacted by submitting an Auxiliary Request with a broader scope (requirement of the dietary fat being a blend of natural fats deleted from claim 1!) during appeal proceedings, instead of amending the description according to the Main Request. → Rejected on contravening the prohibition of *reformatio in peius* because appealing opponents would have been placed in worse position than if they had not appealed.
- The Board issued a preliminary opinion showing its intention to revoke the patent and, in reply to that, the Respondent did not provide any comments and withdrew its request for oral proceedings, so they were cancelled, and the patent was finally revoked.

T 1989/18

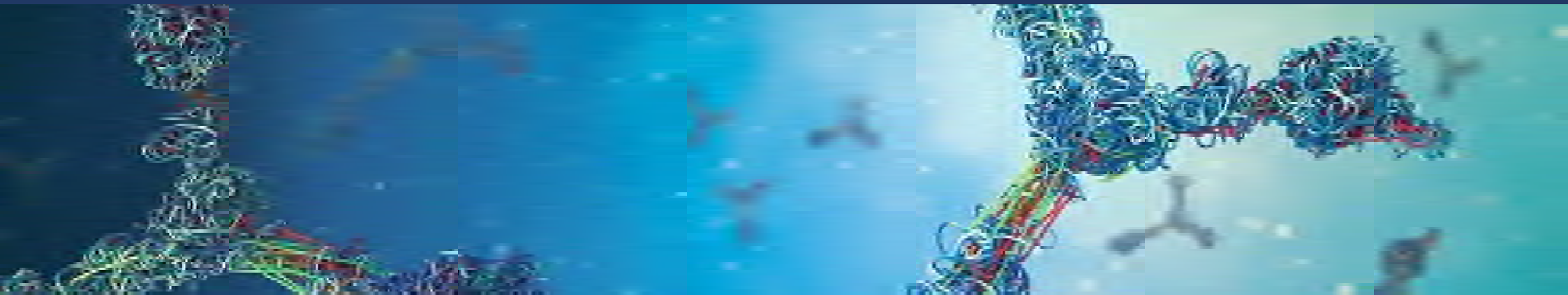
(Expression vector element combinations, novel production cell generation methods and their use for the recombinant production of polypeptides;
F. Hoffmann-La Roche AG)

T 1989/18 - Context

Independent claim deemed allowable by the Examining Division (non-exhaustive claim set analysis):

17. *An expression vector comprising*

- A first expression cassette comprising in 5' to 3' direction a hCMV promoter, a nucleic acid encoding an antibody light chain, a bGH polyA signal sequence, and a hGT terminator sequence,*
- A second expression cassette comprising in 5' to 3' direction a hCMV promoter, a nucleic acid encoding an antibody heavy chain, a bGH polyA signal sequence, and a hGT terminator sequence.*



T 1989/18 – Text intended for grant

(Non-exhaustive) Amendments suggested by the Examining Division in the text intended for grant (R. 71(3) EPC):

In one embodiment 2 of the disclosure the 2
~~the~~ expression vector comprises either

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,
- a fourth expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,

or

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding an antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence, and
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,

whereby the antibody light chain is a common light chain for both antibody heavy chains.

T 1989/18 – Response to R. 71(3) EPC

(Non-exhaustive) Amendments submitted by the applicant in their response to the R. 71(3) EPC communication, who argues that the suggested amendments may not be required as they seem to be suggested simply for improving the reading of the specification, but the wording in the specification is clear and therefore they are not necessary:

In one embodiment ~~the~~ 2 of the disclosure the 2 → “of the invention”

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,
- a fourth expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,

or

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding an antibody light chain, a polyA signal sequence, and optionally a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence, and
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and optionally a terminator sequence,

whereby the antibody light chain is a common light chain for both antibody heavy chains.

The Examining Division considered that these amendments were not acceptable as they concerned embodiments which were not part of the invention as claimed and did not represent a due generalisation of that subject matter → Summons to oral proceedings are issued!

T 1989/18 – Oral proceedings

(Non-exhaustive) Amendments filed by the Applicant in the written submissions in preparation to oral proceedings:

In one embodiment of the invention the expression vector comprises either

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody light chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody light chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,
- a fourth expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,

or

- a first expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding an antibody light chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,
- a second expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a first antibody heavy chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence, and
- a third expression cassette comprising in 5' to 3' direction a promoter, a nucleic acid encoding a second antibody heavy chain, a polyA signal sequence, and ~~optionally~~ a terminator sequence,

whereby the antibody light chain is a common light chain for both antibody heavy chains.

Patent application rejected despite having allowable claims!!

- The subject matter in those passages is broader than the claimed subject matter, so the present formulation is held to be technically incomprehensible, even with a mind willing to understand.
- The description does not meet the requirements of Art. 84 EPC as laid down in R. 42(c) EPC.

T 1989/18 – Appeal proceedings

The BoA appears not to endorse the GL/EPO 2021 approach regarding the adaptation of the description:

- Claims must be clear in themselves when being read with the normal skills including the knowledge about the prior art, but not including any knowledge derived from the description of the patent application or the amended patent.
- In particular, if the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject-matter which is not claimed.
- When assessing clarity (*of a claim*), the description cannot be relied upon to resolve a clarity issue in a claim, nor can it give rise to any such issue if the definition of the subject-matter in a claim is clear *per se*.
- Case remitted to the Examining Division with the order to grant the patent!

T 1024/18

**(Apparatus and method for forming absorbent cores;
Curt G. Joa, Inc.)**

T 1024/18 - Context

During appeal proceedings against the decision to reject the opposition, the independent claim of AR2 was considered allowable (BoA preliminary opinion). It was only then required to file an amended description...

1. A method of forming an absorbent core comprising:
at a first core-forming drum (10, 12B) having a continuous pocket, forming a first continuous core (26B) having a first fluff layer and a first super absorbent polymer and fluff mixture layer by introducing a non-woven web (50) to the first core-forming drum, applying the first fluff layer atop the non-woven web using fluff introduction unit (18) and next applying the first super absorbent polymer and fluff mixture layer using super absorbent polymer/fluff mixture introduction unit (40);
at a first debulking unit (20), debulking said first continuous core;
at a second core-forming drum (10, 12S) having a continuous pocket, forming a second continuous core (26S) having a second fluff layer and a second super absorbent polymer and fluff mixture layer by introducing a non-woven web (50) to the second core-forming drum, applying the second fluff layer atop the non-woven web using fluff introduction unit (18) and next applying the second super absorbent polymer and fluff mixture layer using super absorbent polymer/fluff mixture introduction unit (40);
at a second debulking unit (20), debulking said second continuous core;
after debulking said first continuous core, conveying at a first speed said first core towards said second core-forming drum;
after debulking said second continuous core, cutting it using a first anvil/knife unit (42) and receiving the severed [said] second core pieces at a second speed at a core acceleration unit (22, 44), said second speed being less than said first speed;
with said acceleration unit, accelerating the second, smaller core pieces from the second speed to substantially match the first speed; and
depositing said second core from said core acceleration unit onto said first continuous core; and
cutting the first continuous core using a second anvil/knife unit (42).

Non-woven web atop which a first continuous core is formed and a further non-woven web atop which a second continuous core is formed

VS

[0046] Referring now to Fig. 1, a schematic of one embodiment of the present invention, a large and small discrete core, formed on a screen and combined, and then passed downstream for further processing is shown. As can be seen, two simultaneously operating core forming units, one big and one small, are used to form a big core and a small core, both preferably comprised of fluff and SAP. The small core is accelerated to match the speed of the large core prior to downstream processing.

T 1024/18 – Context

- The respondent (*i.e.*, the patent proprietor) indicated that it would not attend the scheduled oral proceedings.
- In view of that, the BoA indicated that a description adapted to those claims had not been filed, so the respondent “may wish to consider the advisability of filing such a description”.
- However, no description was filed in reply to that BoA communication!

T 1024/18 – Board of Appeal decision

- The BoA deems not appropriate to remit the case to the OD for the purpose of adaptation of the description for procedural economy reasons, considering also the fact that one opportunity to amend had already been given to the patent proprietor. → The patent is revoked!
- To provide only support for the claims in one single passage of the description while the rest of the description might give a different or even contradictory meaning to the claims, would in essence negate the general meaning of the words "support by the description" and in fact would allow it to be reduced to a *de minimis* requirement of e.g. repetition of the claim wording while allowing the entire remaining description to be left to explain an entirely different invention to the one claimed.
- The Board finds that the requirement in Article 84 EPC of the claims to be supported by the description includes the requirement that the description is consistent with the claims not only in some part but throughout.
- Inconsistencies between the claims and the description could thus - in particular in national proceedings - be the source of diverging interpretations as regards the scope of the claims. Accordingly, misinterpretation could be avoided in particular if inconsistent information contained in the description or drawings is already removed in the proceedings before the EPO.

T 1024/18 – Board of Appeal decision

- Considering also Article 84 EPC in the wider context of the EPC, this understanding of the provision seems to be in line with the standard of claim interpretation for national proceedings enshrined in Article 69(1) EPC, according to which the description is **also** to be taken into account when interpreting the claims.

But is it true that Art. 69(1) EPC provides an actual basis that allows the conclusion that the description as a whole must be consistent with the claims?

- The support requirement of Article 84 EPC also serves the aim to ensure legal certainty for national post-grant proceedings (as do the requirements of clarity and conciseness).
- The importance of Art. 84 EPC for the interpretation of claims in national proceedings is also documented in the "travaux préparatoires" of the EPC 1973. It emerges from the preparatory documents that a provision corresponding to the current Art. 84 EPC, which was originally part of the Implementing Rules, was relocated to the Convention due to its importance for national infringement proceedings.

This may however not be so clear...

While it is indeed true that it was decided - in the "travaux préparatoires" - to insert those requirements that the "claims must be clear and concise and that they must be fully supported in the description" directly in the Convention itself...

Re. Article 66, No. 3 - Form and contents of claims

The sub-Committee decided to provide in paragraph 1 that the claims must be clear and concise and that they must be fully supported by the description. This provision seemed so important - particularly from the point of view of infringement actions - that the sub-Committee felt inserting this provision in the Convention itself should be considered.

... Working Party I was requested to evaluate the possibility of either deleting the term "fully" or replacing it by a less restrictive wording, finally choosing the former option:

Article 71a - The claims

The Conference decided that Working Party I should examine the questions whether, as most of the organisations proposed, the word "fully" should be deleted and whether it should be replaced by a less restrictive wording.

Article 71a - The claims

The Working Party decided to comply with the request of a number of the non-governmental international organisations by deleting the word "fully" (cf. BR/168/72, point 92).

Besides...

Though it is true that Art. 69(1) EPC defines that the description and drawings shall be used to interpret the claims, it was contrastingly considered in T 1989/18 that Art. 69(1) EPC does not appear to provide any legal basis for the requirement of adapting the description:

- According to Art. 69(1) itself, “the extent of the protection conferred by a European patent or a European patent application shall be determined by the claims” (emphasis added)
- Art. 69(1) allows the use of the description to interpret claims (*DoE*), but it does not deal with the definition of the matter for which protection is sought.



Diverging EPO Board of Appeal decisions (II)
The aftermath of T 1989/18 vs T 1024/18:
More ripples in the sand

T 0121/20, T 1516/20, T 1426/21 – BoA 3.2.01 decisions going in different directions?

- **T 0121/20, T 1516/20 (strict approach is favoured):**
 - 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).
 - The requirement in Article 84 EPC of the claims to be supported by the description includes the requirement that the description is consistent with the claims not only in some part but **throughout**. Thus, when amendments are made to the claims, the description must be made consistent therewith in the sense that a reader is not presented with any information conflicting with the wording of the claims.
- **T 1516/20 (strict approach is favoured):** The board does not follow the decision T 1989/18 cited by the appellant (patent proprietor), according to which an adaptation of the description is not necessary.

T 0121/20, T 1516/20, T 1426/21 – BoA 3.2.01 Decisions going in different directions?

- **T 1426/21 (flexible approach is favoured):** the BoA challenges EPO/GL 2023, F-IV, 4.4: “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”
 - Aspects could not be mistaken for claims, and it is obvious that they are part of the description and not part of the claims defining the protection to be sought.
 - R. 42 EPC defines that "The description shall disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art“ but does not rule out claim-like clauses in the description.
- T 1444/20 (flexible) approach followed, finding that the "specific embodiments of the invention" drafted as claim-like clauses in the description, which were consistent with the claims did not render the claims unclear pursuant Article 84 EPC and met the requirements of Rule 42 EPC.

T 1444/20

The claims of a patent application define the matter for which protection is sought. Article 84 EPC requires this definition to be clear. This means that the claims must be clear in themselves for a person skilled in the art with common general knowledge of the technical field in question, **without the need to refer to the description.**

In the absence of an objection of lack of unity under Article 82 EPC, this does not translate into a requirement to bring the description in line with claims intended for grant, and to remove passages of the description that disclose embodiments which are not claimed.

EPO GL 2021 (1.3.2021)
T 1399/17 (5.3.2021)
T 1989/18 (16.12.2021)

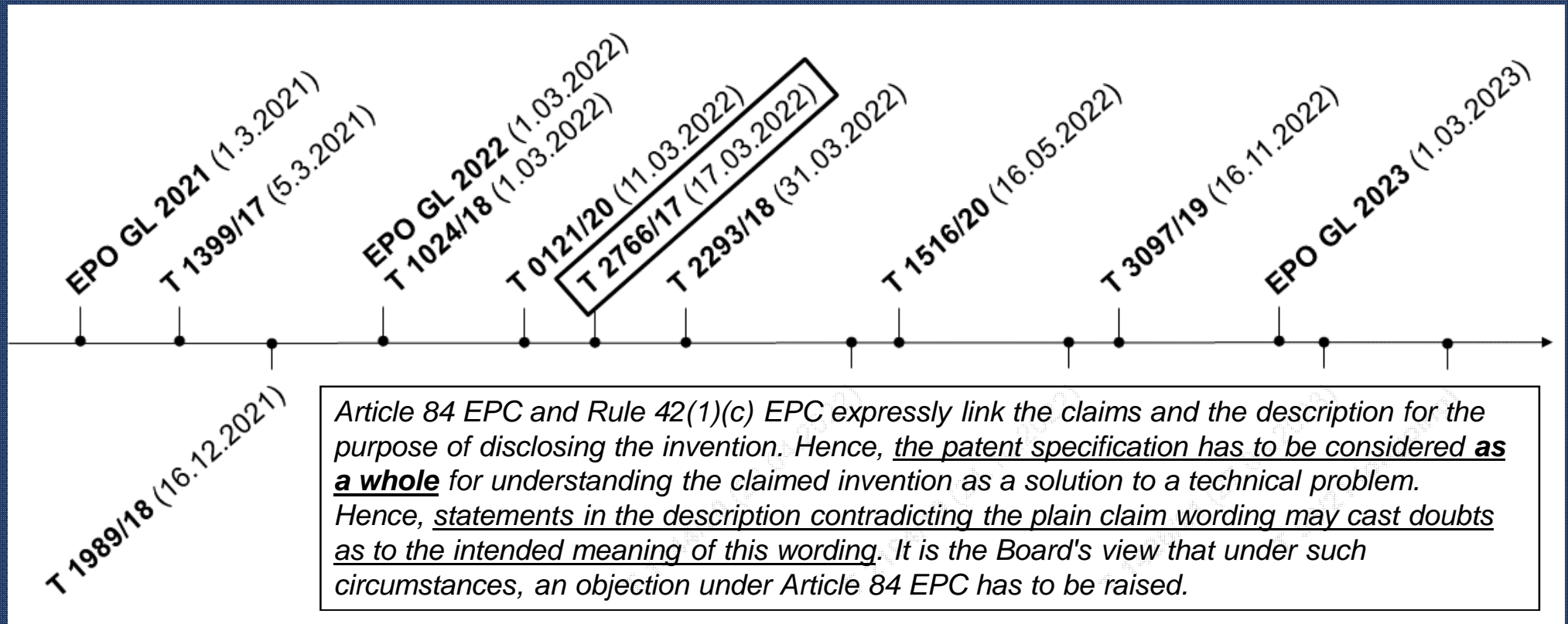
T 1444/20 (28.04.2022)

T 2194/19 (24.10.2022)

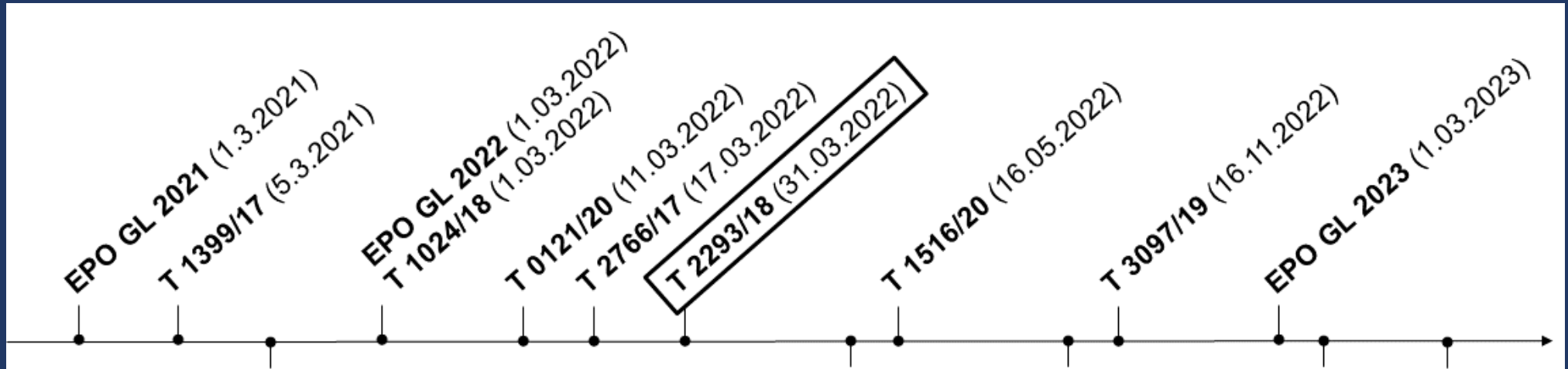
T 1426/21 (27.03.2023)

T 56/21 (ongoing)

T 2766/17



T 2293/18

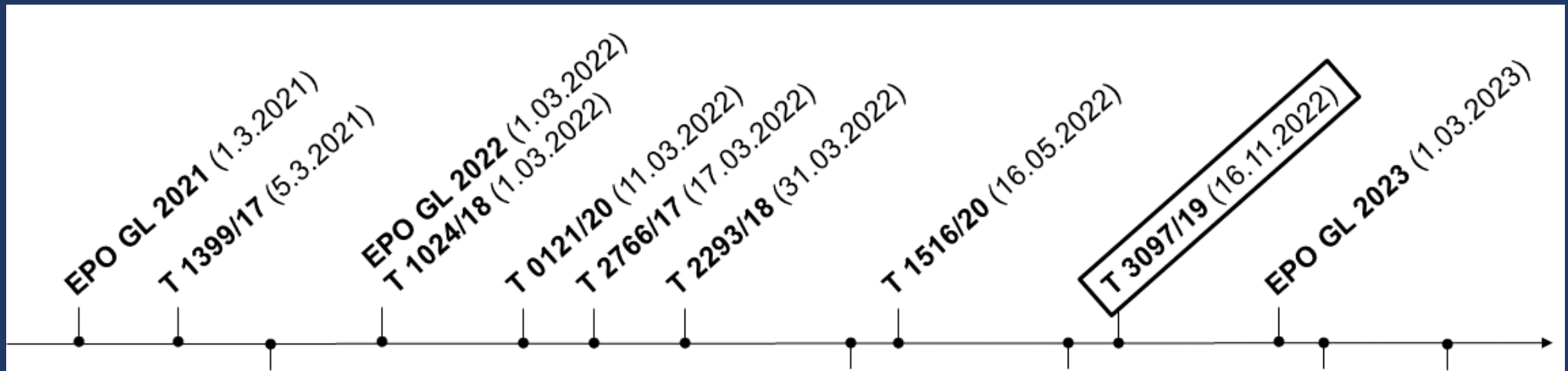


It follows that *claims and description, as parts of a single document, must match. Although they may contain different information according to their different function, as follows from the EPC, they must not contradict each other.*

T 1989/17
If contradictions arise as a result of limitations in the claims, these are to be corrected by adapting the description in such a way that *all information which no longer explains the limited subject-matter of the patent and which is not necessary or useful for understanding the invention is removed.*

In order to meet the requirement of being supported by the description, it is *not sufficient* that the claimed subject-matter is taken from the description and consequently described *in one place*. Rather, *the description as a whole* must be consistent with the claims.

T 3097/19



The Board finds the 3rd and 4th auxiliary requests not to be allowable because their description was not "adapted" to the amended claims, although it did not have any objections under Article 84 EPC to the claim language on its own [...]

The issue of "adaptation" is an artefact of the well-established examination practice at the EPO, adopted for efficiency reasons, to accept and discuss claim amendments without giving consideration to the description until allowable claims are arrived at. Strictly speaking though, the application or patent should always be amended as a whole, so that the description of the invention remains consistent with the claims.

The Board also considers that this consistency between the claims and the description is necessary for legal certainty. [...] Other-wise, they (the skilled person) may be left with doubts as to what is the invention sought to be protected.

T 2194/19

The board is not convinced that, according to the EPC, the "invention" is necessarily and always to be equated with the "invention claimed".

This board takes issue with the conclusion that the requirement that the claims are to be supported by the description (Art. 84, 2nd sentence EPC) necessarily means that all the "embodiments" of the description of a patent application have to be covered by the (independent) claims, i.e. that all the embodiments must fall within the scope of those claims. This conclusion cannot be derived from the EPC. It can also not be derived from the jurisprudence of the Boards of Appeal, according to which merely inconsistencies or contradictions between the claims and the underlying description are to be avoided in that context. [...] But (if there is such an inconsistency) this has to be justified by the Examining Division.

T 1989/18 (16.12.2021)

T 1444/20 (28.04.2022)

T 2194/19 (24.10.2022)

T 1426/21 (27.03.2023)

T 56/21 (ongoing)

T 2194/19 (cont'd)

The board considers that in particular Rule 42(1)(c) EPC cannot be the legal basis for establishing such a general and broad requirement for an adaptation of the description to the claims. It is simply not what this provision says. Rule 42(1)(c) EPC requires that the description discloses the invention, as claimed, in such terms that the technical problem and its solution can be understood, and that it states any advantageous effects of the invention with reference to the background art. These requirements set out in Rule 42(1)(c) EPC, however, cannot be taken to mean that all the embodiments described in the description of a patent application have to fall within the scope of the claims.

T 1989/18 (16.12.2021)

T 1444/20 (28.04.2022)

T 2194/19 (24.10.2022)

T 1426/21 (27.03.2023)

T 56/21 (ongoing)

The description shall disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;

T 56/21 (ongoing appeal proceedings)
(Fc-region variants with improved protein A-binding;
F. Hoffmann-La Roche AG)

T 56/21 - Context

The Examining Division issued an Art. 94(3) EPC communication noting that claims appeared to comply with the EPC requirements, and the only pending issue was adapting the description, so the applicant filed description amendments:

Amended Claims

1. Use of the mutation Y436A for increasing the binding of a polypeptide comprising

a first polypeptide and a second polypeptide each comprising in N-terminal to C-terminal direction at least a portion of an immunoglobulin hinge region, which comprises one or more cysteine residues, an immunoglobulin CH2-domain and an immunoglobulin CH3-domain,

wherein the first, the second or the first and the second polypeptide comprise the mutation Y436A (numbering according to the EU index)

to protein A.

VS

IV.1. SPECIFIC EMBODIMENTS

1. Use of the mutation Y436A for increasing the binding of a dimeric polypeptide comprising

a first polypeptide and a second polypeptide each comprising in N-terminal to C-terminal direction at least a portion of an immunoglobulin hinge region, which comprises one or more cysteine residues, an immunoglobulin CH2-domain and an immunoglobulin CH3-domain,

wherein

i) the first and the second polypeptide comprise the mutations H310A, H433A and Y436A, or

ii) the first and the second polypeptide comprise the mutations L251D, L314D and L432D, or

iii) the first and the second polypeptide comprise the mutations L251S, L314S and L432S, or

iv) the first polypeptide comprises the mutations I253A, H310A and H435A and the second polypeptide comprises the mutations H310A, H433A and Y436A, or

v) the first polypeptide comprises the mutations I253A, H310A and H435A and the second polypeptide comprises the mutations L251D, L314D and L432D, or

vi) the first polypeptide comprises the mutations I253A, H310A and H435A and the second polypeptide comprises the mutations L251S, L314S and L432S

to protein A.

T 56/21 – R. 71(3) EPC communication

In the text intended for grant as amended by the Examining Division, however, mutations that were considered outside the scope of the allowed claims, as well as claim-like clauses, were removed from the text intended for grant by the Examining Division:

Comments

DESCRIPTION

Pages 89, 93: removal of claim like statements Guidelines F-VI, 4.4

Page 90: (PAGE DELETED) -Inconsistency between claim and description removed (Art. 84 EPC)

Pages 91, 92: (PAGE DELETED) -removal of claim like statements Guidelines F-VI, 4.4

Page 130: Scope of claim unclear - clarified (Art. 84 EPC)

T 56/21 – Text-intended-for-grant disapproval

The applicant disapproved the text intended for grant, noting the following:

- Two Requests are filed:
 - Main Request: withdrawal of the deletion of the passage entitled “III. SPECIFIC EMBODIMENTS”.
 - Auxiliary Request: moving the passage entitled “III. SPECIFIC EMBODIMENTS” forward to the end of the “Summary of the Invention” section to address the alleged confusion based on GL/EPO F-IV, 4.4 (claim-like clauses) by moving that passage far away from the “end of the specification”.
- The Guidelines for Examination do not constitute legally binding provisions. For a sound legal basis reference to the EPC or case law is mandatory.
- [...] such a deletion request, if maintained, would impart the rights of the applicant to a patent as the BoA as final legal instance in the proceedings before the EPO ruled in the past that “the Board does not consider the original subject-matter “abandoned” in the present case before grant either by deletion from, or express declaration in, the original application documents to form a basis for admissible amendments after grant”.

T 56/21 – Phone consultation

A phone consultation takes place (Nov. 2019), but no agreement is reached:

Examining Division:

- The Guidelines for Examination require that claim-like clauses must be deleted, since they otherwise may lead to unclarity as to the actual scope of protection (GL F-IV, 4.4). Whether these clauses are situated in the description or at its end does not make any difference.
- The Examiner states that the applicant could either submit an adapted description, agree to the amendments made by the examining division or summons to oral proceedings will be issued.

Applicant:

- The representative states that he will withdraw the request for oral proceedings and ask for a decision according to the state of the file → Actions taken by the applicant three weeks later.

T 56/21 – Patent application refused

The patent application is finally refused by the Examining Division:

23 The invention resides in the use of a specific mutation (i.e. Y436A) to increase the binding of a dimeric polypeptide to protein A. The passages of the application objected to by the ED also encompass the use of several polypeptides comprising mutations in a first polypeptide in combination with specific mutations in a second polypeptide which are outside the claimed scope. Those passages are not specific embodiments of the invention. The beginning of the objected passages (present page 89 to page 93 of the description) reads "Specific embodiments".

30 The ED disagrees as the basis for the objection are not the Guidelines, but the non-compliance with Article 84 EPC and the Guidelines were only cited in support of the arguments made. Furthermore, case law of the Boards of Appeal confirm the interpretation that claim-like clauses introduce unclarity (Article 84 EPC). For example in T490/90 (points 5 and 6) the Board was of the opinion that the claim-like clauses needed to be removed as they did not form part of the description, but rather formed redundant subject-matter. The board also concluded that there was no loss of rights involved. The Board stated further that the clauses were unclear and contained obviously unnecessary matter.

T 56/21 – Grounds of Appeal

The applicant initiates appeal proceedings:

Thus, there is no repetition of identical subject matter in the Main Request. (emphasis added by underlining)

At best, different, not-identical, preferred combination of features are present in the Main Request.

Thus, the “Specific embodiments” section comprise subject matter that falls under the scope of the claims, however, that is not specifically mentioned in the claims. Also, not all combinations of features provided in the “Specific Embodiments” section are explicitly mentioned in other parts of the description. It should be kept in mind that the Applicant may have to defend the patent, once granted, in opposition, appeal and national nullity proceedings, wherein the claims may be amended by including subject matter from the specification as long as the overall scope of the claim as originally granted is not broadened. Hence, it is evident that the “Specific embodiments” section comprise relevant subject matter that may be necessary in any further proceedings.

For example, if more than one specific embodiment is disclosed in a European patent application, these are normally summarized in a dedicated section only reciting these specific, i.e. preferred, embodiments. In this section of specific embodiments, in order to reflect any permutation of possible combinations of the individual preferred embodiments and in line with the requirement of the description to be concise according to Rule 48 EPC, a claim-like format is employed. This is the most economical way of presenting this complex subject matter.

T 56/21 – Grounds of Appeal

The Applicant argues the risk of infringing Art. 123(3) EPC if the subject-matter deleted due to adapting the description is later reinserted into the patent:

Therefore, the deletion of the “Specific Embodiments” section would impact the rights of the Applicant with respect to potential future opposition and appeal proceedings as the Applicant is deprived of remedies due to the deletion of specific, preferred combination of features.

This is especially relevant, as the Board of Appeal confirmed in the past that “taking account of the legal effects of the grant of a European patent under Article 123(3) EPC, the Board does not consider the original subject-matter “abandoned” [...] before grant either by deletion from, or express declaration in, the original application documents to form a basis for admissible amendments after grant” (T 1149/97).

Thus, once the application documents have been adapted to the amended claims, which is a requirement for the grant of a European patent, whereby a part of the subject-matter originally disclosed is deleted in order to avoid inconsistencies in the patent specification, as a rule, subject-matter deleted for this reason can neither be reinserted into the patent specification nor into the claims as granted without infringing Article 123(3) EPC.

T 56/21 – BoA Communication (21.7.2023)

1. *Need for a referral?*

1.1 In the case under consideration the pivotal issue is how to interpret the requirement of clarity and/or support of the claims by the description according to Article 84 EPC. More precisely, the question is as to whether Article 84 EPC provides a legal basis for objecting to an inconsistency in scope between the invention disclosed in the description and/or drawings and the subject-matter for which protection is sought in the claims, and to require to remove this inconsistency by way of amendment of the description and/or drawings ("adaptation of the description"), and, consequentially, whether an application can be refused if the applicant does not amend the description and/or drawings accordingly, or does not agree to an amendment of the description and/or drawings proposed by the examining division.

1.3 Furthermore, relevant parts of the **EPO Guidelines for Examination**, in their version of 2023, instruct the examining divisions to delete or amend any statement in the description which is inconsistent with the claims in so far as it may throw doubt on the scope of protection (F-IV.4.3), and to delete general statements and claim-like clauses in the description (F-IV.4.4). See also Part H-V.2.7. The board queries whether the EPO Guidelines are in line with the wording and purpose of Article 84 EPC and with the case law on clarity requiring that claims should be clear in themselves without having to resort to the description for an interpretation. The board's concerns will be addressed more in detail below.

T 56/21 – Preliminary BoA opinion (21.7.2023)

2.2 It follows from the **title and wording** of Article 84 EPC that this article states a requirement in respect of the claims and not of the description. This is confirmed by the phrase that the claims must be supported by the description: It is the definition in the claims of the matter for which protection is sought that needs support. This means that the subject-matter of a claim must be taken from the description, and it is not admissible to claim subject-matter which is not described. In short, the disclosure in the description must warrant the definition of the subject-matter of the claims and not the other way round. It is further noted that Article 84 EPC is in Part III, Chapter I of the EPC pertaining to the requirements of a European patent application. It is not part of the Chapter on patentability nor a ground for opposition or revocation. As regards the requirement of clarity, further considerations will be set out below.

2.3 The **legislative history** of the EPC 1973 offers little evidence of the legislative intent behind the adoption of Article 84 EPC (for background information on the legislative history of Article 84 EPC 1973 see document CA/PL 12/95, points 6 to 12).

In the second preliminary draft of a Convention Establishing a European System for the Grant of Patents of 1972, the word "fully" in the phrase "fully supported by the description" was deleted from Article 71a, which related to the purpose, form, and content of the claims, as it was perceived to be too restrictive (see BR/169/72, point 72, BR/168/72, point 92 and BR/177/72, point 42). The provision was thus given the wording Article 84 EPC has today (apart from minor editorial changes in the German text of the revised EPC).

T 56/21 – Preliminary BoA opinion (21.7.2023)

3.2.3 Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC concern the effects of European patents (and applications) in the Contracting States.

It is not for the Office to harmonise the extent of protection conferred by European patents (and applications) by bringing the description and/or the drawings of an application or patent in agreement with the amended claims held allowable.

5.1 Should the appellant see the need for a referral to the Enlarged Board of Appeal, it may consider the following question which is limited to *ex parte* proceedings:

Is there a lack of clarity of a claim or a lack of support of a claim by the description within the meaning of Article 84 EPC if a part of the disclosure of the invention in the description and/or drawings of an application (e.g. an embodiment of the invention, an example or a claim-like clause) is not encompassed by the subject-matter for which protection is sought ("inconsistency in scope between the description and/or drawings and the claims") and can an application consequently be refused based on Article 84 EPC if the applicant does not remove the inconsistency in scope between the description and/or drawings and the claims by way of amendment of the description ("adaptation of the description")?



**Conclusion:
Some thoughts on the adaptation of the
description**

Risks and strategies (I)

T 1149/97 (cited by F. Hoffmann-La Roche AG in T 56/21 grounds of appeal) on the effect of pre-grant abandonments:

6.1.6 There are few decisions on abandonment of subject-matter with substantive effect (see the examples cited in "Case Law of the Boards of Appeal of the European Patent Office", Third edition, European Patent Office 1999, Chapter VI, I-3.1.1). It appears to be common ground among these decisions that in general an abandonment takes substantive effect if particular subject-matter has been **expressly** abandoned together with the complete deletion of the original claim and all support therefor in the specification (see e.g. T 61/85, point 11 of the reasons, and T 64/85, points 2.1 to 2.3 of the reasons; both decisions not published in OJ EPO). In that case, reinstatement of the abandoned subject-matter is no longer possible.

The European patent may not be amended in such a way as to extend the protection it confers.

Since in the case of an alleged cut-off point generally established by the grant of a patent there need not be such express abandonments of subject-matter before grant, any cut-off effect would not, in the Board's view, directly result from an "abandonment" in the strict meaning of the term, i.e. in that it was expressly declared, but only indirectly due to the procedural situation of the file.

From this decision, the conclusion can be drawn that the grant of a patent has, in general, the effect of making pre-grant abandonments substantive.

Article 123(3) EPC expressly addresses the claims of a European patent only, and this choice of wording might be considered to imply that post-grant amendments to the description and the drawings of a European patent are not subject to any restrictions.

Risks and strategies (II)

What happens with claim-like clauses containing additional embodiments (encompassed by the scope of the claims) that could be useful during potential post-grant opposition or nullity proceedings?

Always keep in mind that GL/EPO F-IV, 4.4 not only requires deletion of claim-like clauses, but alternatively also allows the applicant to amend them to avoid claim language. Thus, it is still possible to salvage embodiments that could be of relevance (amendments, DoE) during post-grant proceedings by incorporating them in the description without contravening Art. 123(2) EPC

Risks and strategies (III)

Choose your words very carefully when amending the description, because that patent (application) may undergo post-grant proceedings (opposition proceedings, national/UPC litigation) in the future and every word counts!

GL/EPO F-IV, 4.3 (iii) “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”).”

“Not encompassed by the wording of claims” would appear to provide a more flexible approach to argue infringement by equivalence than the most restrictive “not falling under the scope of the appended claims” → UK: potential impact on third limb of “Actavis” test for “purposive infringement” of patents.

3. Would such a reader (*i.e.*, the person skilled in the art) of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

Risks and strategies (IV)

If “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” and therefore, that alternative feature must be deleted, how will claims be construed when applying the doctrine of equivalents? Is this the end of the Angora cat paradox?



*“When validity is challenged, the patentee says his patent is very small: the cat with its fur smoothed down, cuddly and sleepy. But when the patentee goes on the attack, the fur bristles, the cat is twice the size with teeth bared and eyes ablaze.” (Lord Justice Jacob in *European Central Bank vs DSS* [2008] EWCA Civ 192)*

However, sometimes deletion of a sentence / paragraph may be preferable to marking it as “outside the scope of the claims”, especially if post-grant proceedings are foreseeable, more particularly, infringement proceedings in jurisdictions wherein the doctrine of prosecution history estoppel is applied.

Risks and strategies (V)

Requests for adapting the description are now made at earlier stages of prosecution and more often are extremely detailed and even a bit far-fetched...

The applicant should include in the description a "statement of the invention" which reflects the wording of the newly filed claims.

The relevant passages in the description should be adapted to be in harmony with the present set of claims. In particular the paragraphs [0074]-[0092] must be adapted.

Furthermore, in view of the present set of claims the applicant should indicate which examples are according to the invention and which examples are not according to the invention.

To meet the requirements of Rule 42(1)(b) EPC, the documents cited in the search report should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

According to Rule 49(10) EPC values shall be expressed in units conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement shall also be expressed in units conforming to international standards. The applicant is therefore requested to provide the corresponding SI values for units not conforming to SI units.

According to Guidelines F-IV 4.4 general statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way are not allowed (paragraphs [0093]-[0100]) and must be deleted. In particular, any statement which refers to the extent of protection being expanded to cover the "*spirit of the invention*" or "*all equivalents*" of the claims must be deleted.

[0074] As used herein "uniform" means the same degree of sulfonation across the isolated mass of the sulfonated polymer product as determined by ¹H-NMR of at least 5 small samples taken from the entire product mass.

[0075] All weight percentages are based upon a total of 100 weight percent.

[0076] Unless specified to the contrary herein, all test standards are the most recent standard in effect as of the filing date of this application, or, if priority is claimed, the filing date of the earliest priority application in which the test standard appears.

In order to better safeguard the applicant's interests, it is essential to analyze the amendments/deletions suggested by the Examining Division in detail, because sometimes it may be necessary to respectfully disagree...

Risks and strategies (VII)

“I must not fear. Fear is the mind-killer. Fear is the little-death that brings total obliteration. I will face my fear. I will permit it to pass over me and through me. And when it has gone past I will turn the inner eye to see its path. Where the fear has gone there will be nothing. Only I will remain.”

Frank Herbert, Dune

It may be true, but still... always include request oral proceedings (R. 113 EPC) in your submissions as a precautionary measure because, as confirmed by the body of case law herein discussed, a patent application / patent can be refused / revoked merely because the description has not been properly adapted in line with the scope of the claimed subject matter!

Thank you!

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BALDER



The High Court of England and Wales on the impact of adapting the description (June 2023)

Ensygnia vs Shell [2023] EWHC 1495 - Context

Description and claims of the patent (GB2489332) were amended several times after grant, so it was claim 1 of the C2 specification that was relevant:

A method comprising:
a portable device:

obtaining a graphical encoded information item which is displayed on a display of a computing apparatus, wherein the computing apparatus comprises the display and an electronic apparatus, and wherein the display is a sign;

decoding the encoded information from the encoded information item;

and

transmitting a first message to first server apparatus, the first message including the decoded information and a first identifier identifying the device or a user of the device, wherein the decoded information includes an apparatus identification information item for allowing identification of the computing apparatus,

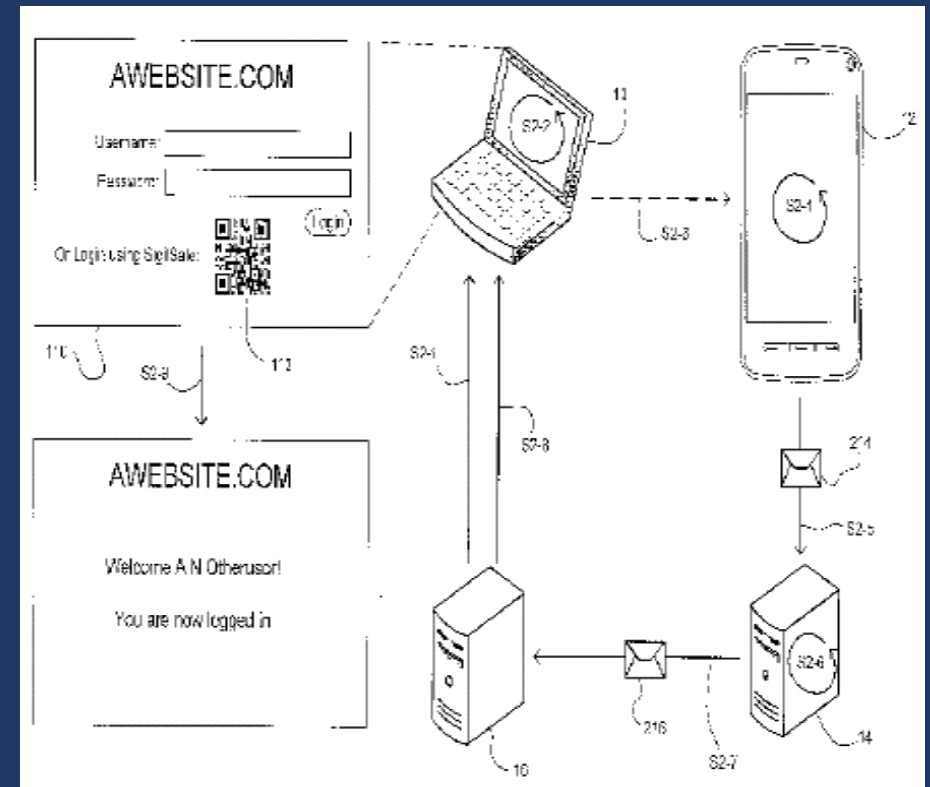
the first server apparatus:

receiving the first message from the device;

establishing the identity of the user of the device, where establishing the identity of the user comprises using the first identifier to determine if the user is registered with the first server apparatus;

in response to establishing the identity of the user, authorising the user to access a service; and:

providing the service to the user via the computing apparatus using the apparatus identification information item to transmit a signal to the electronic apparatus, and the electronic apparatus providing the service to the user.



Ensignia vs Shell [2023] EWHC 1495 - Context

Only Fig. 1 was left from the “outside of the scope of the claims” amendments, and all embodiments were also excluded, except one:

Figure 2 is a schematic illustration of a method according to embodiments outside the scope of the claims; and

According to one embodiment, the invention can be implemented in a building security system. In such an embodiment, the computing apparatus 10 may comprise an electronic door lock. The encoded information item 112, 312, such as a GO as described above, may be displayed on a sign geographically proximate to the electronic door lock. In embodiments outside the scope of the claims, the GO 112, 312 may be provided on an electronic display geographically proximate to the electronic door lock. In such embodiments, the encoded information item may be

Figure 3 depicts an alternate system that is outside the scope of the claims.

According to another alternative embodiment outside the scope of the claims, there is an ATM system. In this embodiment, the computing apparatus 10 is an ATM.

According to another alternative embodiment outside the scope of the claims, there is a self-service shopping environment. In such an embodiment, an encoded

Ensygnia vs Shell [2023] EWHC 1495 - Decision

- Ensygnia sued Shell for infringement due to their system available at Shell petrol stations, wherein a user could scan a QR code that was displayed on a piece of paper or card that had been attached on or near to the petrol pump with its mobile phone app. Shell denied infringement and filed a counterclaim for revocation on the grounds of obviousness, added matter, extension of protection and **uncertainty insufficiency**.
- The point of law in dispute related to embodiments expressly stated to be outside the scope of the claim and “sign” interpretation:
 - The Deputy High Court Judge referred to *InterDigital Technology Corporation & Ors v Lenovo Group Ltd & Ors* [2023] EWCA Civ 105, wherein L.J. Arnold pointed the three key considerations for claim interpretation: (a) the wording of the relevant integer of the claim; (b) the context provided by the specification; and (c) the inventor’s purpose.
 - The Patentee contended that this integer related to a “static” sign - that is, one which is not electronic and does not change between transactions. The Defendants contended that the integer relates to an electronic display on a computer screen or to a subset of a display akin to signage.
 - Embodiments involving an electronic display had been marked as being “outside the scope of the claims”!

Specific type of insufficiency (UK): the language used in the patent claims is so ambiguous that it renders the patent invalid for not disclosing the invention clearly enough

Ensignia vs Shell [2023] EWHC 1495 - Decision

- The Judge considered that it would even occur to the skilled reader reading the relevant passages in the context of the application as a whole that the invention could be implemented using a sign that was not electronic or which cannot be changed.
- However, the patentee had intentionally excluded an embodiment having an electronic display, which had been marked as “outside the scope of the claims”.
- Furthermore, the limitation deliberately included in the claims to a display on a sign could not be disregarded, though it conflicted with some of the teaching of the patent and so does not provide all the advantages of the invention that an electronic display would bring.
- The patent was finally revoked for added matter and extended protection.

201. It follows that a non-electronic sign or display did not fall within the scope of claim 1 as granted, but now falls within the scope of the claim as amended post grant. As a result, the protection of the Patent has been extended by an amendment which should not have been allowed and is invalid for this reason. This reasoning applies equally to claims 2, 7 and 8, which are also invalid accordingly.