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Amendments to the Patent Description: To what extent?

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The recent decision by the European Patent Office (EPO)'s Technical Board of Appeal 1024/18 implies the EPO is likely to be very strict with amendments of the description to be consistent with the subject matter of the allowed claims.

It has long been the practice by the EPO to request applicants to amend the description to bring it into conformity with the allowed claims under Article 84 EPC. The approach to this requirement varied from examiners to examiners. The EPO's Guidelines for Examination has become stricter on requiring amendments to the description in recent times, which in some cases required substantial amendments which amount to almost redrafting of the description to meet the EPO's requirements prior to the grant of the patent.

Background:

Although it has been the practice at the EPO to amend the description to be consistent with the allowed claims, in the recent EPO Board of Appeal decision (T1989/18), which is an appeal matter against the Examining Division's decision to refuse an application under Article 84 EPC because the description related to subject matter that was broader than the subject matter of the claims, the Board reversed the Examining Division's decision stating that there is no legal basis in the EPC which requires applicants to amend a patent application's description to exclude subject matter that is not covered by the claims.

Amendment of description:

Article 84 EPC requires that "*The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.*"

In T 1989/18, the Board found that inconsistencies in the description could not affect the clarity of the claims since, according to Article 84 EPC, these in themselves had to be clear.

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In other words, as long as the claims are clear in themselves and do not claim subject matter beyond that described in the description, Article 84 EPC cannot serve as legal basis to refuse the application, even where the description contains other subject matter falling outside the scope of the claims.

However, in the present T **1024/18 decision the EPO made a complete about turn from T 1989/18.**

In T **1024/18** the Board concurred that according to Article 84 EPC, claims must be clear in themselves, but indicated it is important to note that Article 84 EPC is not entitled "clarity of the claims". The Board stated that the provision of Article 84 EPC relates to the claims in general and actually covers three distinct requirements for claims, namely their clarity, their conciseness and their support by the description. According to the Board, 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 Board further stated that merely providing a part of the description which gives support to the claims appears to be at odds with the wording "supported by the description". Only providing such a part would be rather more akin to the claims having some form of basis in the description or being supported by "part" of the description, whereas the wording of Article 84 EPC requires support by "the description". To put this into context, 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.

Thus, in T **1024/18** the Board concluded the requirement in Article 84 EPC for 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 the description. Thus, the EPO Board of Appeal revoked the patent EP 2609899 on the grounds that an amended description had not been filed with the allowable amended claims on appeal.

Discussion:

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In many cases, extensive amendments to the description to meet the EPO's requirement to make it consistent with the allowed claims, almost results in redrafting the whole description, which not only places an onerous task on applicants, but involves time and additional prosecution cost for applicants. As such, obtaining a European patent is expensive and formal requirements such as amendment to the description leads to additional cost, which may put off small entities, individuals and universities from trying to obtain protection for their inventions.

Further in T **1024/18**, the Board states that inconsistencies between the claims and the description could - in particular in national proceedings - be the source of diverging interpretations as regards the scope of the claims. The Board is of the view that misinterpretation could be avoided in particular if inconsistent information contained in the description or drawings is already removed in the proceedings before the EPO, and that the support requirement of Article 84 EPC also serves the aim of ensuring legal certainty for national post-grant proceedings (as do the requirements of clarity and conciseness).

This view by the EPO's Appeal Board seems interesting, since most national patent offices do not insist so strictly with amending the description to be consistent with the allowed claims. For instance, the current practice at the UKIPO requires generally the statement of inventions to be amended such that they are in line with the allowed claims. It will be interesting to see whether there will be any further decisions on the amendments of the description, and whether there will be a referral to the EPO Enlarged Board of Appeal in view of what might be seen as the conflicting decisions.

A new decision, T 1444/20 has recently been issued, which supports the decision of T 1989/18 that description amendments are unnecessary if the claims are clear in themselves. The Board of Appeal in T 1444/20 considered whether it is necessary for "claim like clauses" to be deleted from the description. Notably, the Board indicated that if claim-like clauses in the description do not result in a lack of clarity of the actual claims, Article 84 EPC cannot provide the justification for removing them. Despite two decisions T 1989/18 and T 1444/20 which support that there is no legal basis in the EPC which requires to amend the description, it appears that the EPO is not keen on changing its current requirement. It appears only a referral on the issue to the Enlarged Board of Appeal will provide some clarification with respect to the existing conflicting decisions.