

Kluwer Patent Blog

Will Father Christmas bring new referrals for the EPO Enlarged Board of Appeal?

Miquel Montaña (Clifford Chance) · Thursday, December 22nd, 2022

Christmas is a season for rest, family gatherings, warm wishes, hopes and good cheer. These days, children and adults alike may be preparing their wish list for Father Christmas. One of the gifts that patent *aficionados* are expecting with excitement for 2023 is a clear answer to the questions referred to the EPO Enlarged Board of Appeal (“EBA”) in case T 116/18 (i.e. plausibility). Unless the final answers are clear and consistent with decades of EPO case law, they will do no good to legal certainty, the legal principle the EBA is expected to cherish.

Due to the historical inclination of some of the EPO’s Technical Boards of Appeal (“TBA”) to embark into waters that are uncharted in the European Patent Convention (“EPC”) and/or the Implementing Regulations which, according to article 164 of the EPC, are part of the former, there is a possibility that Father Christmas may bring new referrals for the EBA. These “voyages” might have been charted at the behest of TBA Decision T 2194/19 of 24 October 2022 which, deviating from other TBAs, has highlighted that neither the text of the EPC nor the Implementing Regulations provide a legal basis for requiring the adaptation of the description to the scope of protection of the claim(s) finally granted. Certainly, one could not cite the Guidelines for Examination as an alleged legal basis. This is because, as it is widely known, the Guidelines lack any force of law. A different question is that many applicants may decide to adapt the description to the claim(s) finally granted for reasons of convenience and/or to avoid delays in the examination procedure.

As the TBA highlighted in paragraphs 6.1 to 6.2 of T 2194/19, one thing is that the “invention claimed” (which may not necessarily be the same thing as the “invention”) must have support in the description, but a different thing is that all the “embodiments” of the description have to be covered by the claims as granted. According to the TBA, the latter conclusion “[...] *cannot be derived from the EPC*“. And it may have a point. So, in view of the divergence of views among several TBAs on this topic, if Father Christmas is making his list (of gifts for patent *aficionados*) and checking it twice, a referral to the EBA on this topic may top the list.

Until -if and when- that referral arrives, may we wish our readers all the best for the Christmas season and lots of health and good luck in the New Year.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Thursday, December 22nd, 2022 at 6:25 pm and is filed under [EPC](#), [EPO](#), [Patents](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.