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La Zizanie de l'OEB sur l'Adaptation de la Description

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We have long meant to write something about the need, or the lack thereof, for adapting the description to amended claims. The announcement in the second preliminary opinion of Technical Board of Appeal (TBA) 3.3.04 in [T 56/21](#), suggesting a referral of this question to the Enlarged Board of Appeal, combined with the sole appellant's agreement with such a referral and perhaps a modicum of personal inertia, has kept us from it. But meanwhile we know that things took a different turn: in short, TBA 3.3.04 had second thoughts about a referral and instead issued a whopping 86-page decision explaining and justifying its firm opinion that neither Art. 84 EPC nor Rule 43 EPC provide a legal basis for a mandatory adaptation of the description, and that Rule 48 cannot be used as a basis for a refusal of a European patent application. The applicant may, however, amend the description of its own volition.

In other words, according to Board 3.3.04 the description no longer needs to be adapted to any amended claims, and requesting an amended description would even contravene the EPC. In view of the fact that the current Guidelines for Examination, Chapter H-V 2.7 explicitly require that:

The description must be brought into line with amended claims by amending it as needed to meet the requirements set out in F-II, 4.2, F-IV, 4.3(iii) and F-IV, 4.4.

and threaten the applicant with this:

If the applicant does not amend the description as required despite being asked to do so, the examining division's next action may be to issue a summons to oral proceedings; for the time limit, E-III, 6(iii) applies

we seem to be entering interesting times with this decision. By the way, the French word “la zizanie”, which we borrowed from Asterix Vol. 15 (German title “[Streit um Asterix](#)”, English: “[Asterix and the Roman Agent](#)”), means “discord”. The ancient Athenians illustrated it like this



(own picture – note that we are not taking a position on which Boards are the [Lapiths](#) and which the Centaurs)

How will *cette zizanie* within the EPO be resolved? That's the big question.

Might the EPO legal division act?

Of course, the EPO's legal division may simply take this decision at face value, delete Chapter H-V 2.7 from the Guidelines (and similar sections elsewhere, e.g. in Chapter F-IV, 4.3 and 4.4) and the other Boards of Appeal may adopt the reasoning of T 56/21. This would be a simple way to achieve harmony within the EPO and legal certainty for applicants (at least with respect to the procedure; whether the patents thus granted would also enjoy a higher legal certainty may be left for another discussion). And most applicants and representatives would probably rejoice. Adapting the description is tedious, dull and certainly among the least-loved activities of a patent practitioner. And it takes a lot of time and is, hence, expensive. Add to this the fact that the United States Patent and Trademark Office never requires the description to be adapted, yet patent enforcement obviously works there as well, and you may arrive at the conclusion that there is certainly no "business case" for the adaptation of a description if the claims are amended.

But we doubt that this is where things will go. For a start, the Board at reason 6 go out of their way to explain that no adaptation of the Guidelines is required, despite the fact that the examining division referred to and applied these when refusing the application. Add to this the fact that at the first instance level, we have observed exactly the opposite trend: the Guidelines for Examination have repeatedly been supplemented with more and more paragraphs stipulating that the description must be amended and specifying cases where such an amendment must be required. For example, the above quoted Section from Chapter H-V 2.7 cannot be found in the Guidelines of 2009 or of 2013. The closest paragraph in the 2009 Guidelines is this:

C-VI-13 (iii) Agreement of description and claims

If the claims have been amended, will the description require corresponding

amendment to remove serious inconsistency between them? For example, is every embodiment of the invention described still within the scope of one or more claims? (see III, 4.3). Conversely, are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment? It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against Art. 123(2), as explained in the following paragraphs.

This sounds considerably more pragmatic and allows the examiner more discretion than current H-V 2.7. In addition, the catalogue of cases in which objections under Art. 84 EPC should be raised has also been expanded over the past couple of years. Thus, for the EPO's Legal Division, following the rationale of T 56/21 would certainly mean a complete U-turn.

How might the other Boards respond?

We may be wrong, but we are also sceptical whether other Boards will (completely) follow T 56/21. The decision itself lists quite a number of recent cases in which other Boards have taken a partially or completely different position than Board 3.3.04. The Board acknowledged on page 85 of its decision that “it could be argued that there are diverging decisions”, but went on to postulate that

it is rather more the case that the practice is evolving (compare T 433/21, point 8.4 of the Reasons, advocating a non-coercive discourse) taking into account the revision of the EPC in 2000 and developments thereafter (in particular the acknowledgment of equivalents in the Protocol and the negotiations on a supranational court for infringement and nullity proceedings).

While we certainly agree that the Board's practice is evolving, we are not convinced that it is evolving in the same direction. For example the Boards in both T 3097/19 (published less than 2 years ago in November 2022) and T 438/22 (published less than 1 year ago in November 2023) were certainly able “to take into account the revision of the EPC in 2000 and developments thereafter (in particular the acknowledgment of equivalents in the Protocol and the negotiations on a supranational court for infringement and nullity proceedings)”, but came to different conclusions, i.e.:

“The purpose of the claims to define the matter for which protection is sought (Article 84 EPC) imparts requirements on the application as a whole, in addition to the express requirements that the claims be clear, concise and supported by the description. The Board deems it to be an elementary requirement of a patent as a legal title that its extent of protection can be determined precisely. Whether this is the case for a specific patent application (or an amended patent) can only be decided with due consideration of the description. Claims and description do not precisely define the matter for which protection is sought if they contradict each other (...). ” (T 3097/19, headnote 3).

And

“It is a general and overarching objective, and as such also a ‘requirement’ of the Convention, that authorities, courts, and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, it is legitimate to insist on its removal under Articles 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC. ” (T 438/22, headnote 2).

Thus, it appears that TBA 3.4.03 in T 438/22 and TBA 3.5.06 in T 3097/19 take a fundamentally different approach that includes the presumption of a close connection of the claims and the description, both of which form “a legal title” or “a unitary title”, i.e. the patent or patent application. As a corollary of this understanding, the description will always have to be considered when determining the claimed subject-matter. TBA 3.3.04 strongly disagrees with this understanding and considers that the description is not to be used when checking the requirements of Art. 84 EPC, because the latter solely pertains to the claims, not the description.

Thus, while it is not impossible that TBA 3.4.03 and TBA 3.5.06 will perform a legal about-turn and throw their support behind 3.3.04’s approach, it seems unlikely. Striking in this regard is that, to our knowledge, all decisions dispensing with the need to adapt the description have originated from Boards having the same legal member, Mr. Lukas Bühler.

Why was there no referral?

Given the above, in our view it is surprising that TBA 3.3.04 decided not to refer the case to the Enlarged Board in their decision. What stopped them? At reasons 101 – 104, the Board held that no referral is necessary since:

- 1)??Article 84 is unequivocal in not requiring adaption;
- 2)??Reasons for the traditional EPO practice of requiring this aren’t convincing;
- 3)??The lack of legal requirement for adaptation appears intentional; and
- 4)??There is no divergence, only an evolution of case law on this issue.

These reasons are rather difficult to follow. Even if TBA 3.3.04 are personally convinced of 1), they should at least accept that this is a pretty hotly contested point between themselves and other Boards, as evidenced by T 3097/19 and T 438/22. The same goes of course for 2): other Boards have set out what they consider to be convincing reasons for adaptation. 3) is also clearly disputed, since other Boards have taken the view that Art 84 EPC implies or at least supports a legal requirement to adapt. In any case, surely a lack of legal requirement for adaptation should speak for a referral, when this is the practice required by the EPO in tens of thousands of communications each year! All of this undermines 4), as there is in our view no doubt that there is divergence, at the very least on the issue of whether the EPO can require adaptation.

We wonder then whether some other factor stopped the members of Board 3.3.04 taking this to the

next level. It can of course not be excluded that the Board discussed its decision with other Boards beforehand and wished to express an emerging common view among the Boards, but we do not view this as overwhelmingly likely. Perhaps it was felt that other Boards should first have a chance to consider TBA's 3.3.04 comprehensive and extensive argumentation before possibly referring this matter to the Enlarged Board in case they really disagreed therewith. Perhaps strategic considerations stayed their hand: if other Boards weren't following 3.3.04, what hope would there be of a decision in their favour from the Enlarged Board, itself made up of legal members of the Boards? Or maybe they felt that a referral decision being so emphatic and detailed as T 56/21 would look like they were trying to do the Enlarged Board's work for them? We'd be interested to hear any theories you might have in the comments below. Oh to be a fly on the wall of the Café in Haar!

Whatever the reason, T 56/21 leaves EPO Users with considerable legal uncertainty, at least for the time being. Our present impression is that adaptation will continue to be generally required by most EPO examining and opposition divisions, unless more Boards show that they agree with the position taken in T 56/21. Under these circumstances, the only way to avoid an adaptation of the description is to get a refusal on this issue, appeal, and hope that your legal member is Mr. Bühler (who has been involved in all of the decisions questioning the legal basis for the existing practice)!

Our view on the requirement to adapt the description

Even though we mostly agree with the result reached in T 56/21 that an adaptation of the description should normally not be required, we have problems following a lot of the Board's reasoning, in particular where the Board postulated that the description should not be considered when interpreting the claimed subject-matter. However, we will leave this issue to the Enlarged Board in G 1/24.

Art 84 is indeed mainly directed at the claims. They shall be clear, concise and supported by the description. Nonetheless, the question whether the claims are clear can only be answered after their subject-matter has been understood by the skilled person, and it seems self-evident to us that the primary basis for the skilled person's understanding can only be the patent (application) as a whole, including its description. To exclude the description as a source when forming this understanding seems awkward to us, not least because it violates the EPO's own rule that interpretation of any document requires examining its whole disclosure.

Does this mean that claims will always be clear, because the skilled person will have understood their subject-matter after having carefully read the description and construed the claims with a mind willing to understand (T 190/99)? Certainly not. There will still be cases where the claims are in apparent contradiction with the description, and there may also be cases where the description offers contradictory or unclear explanations of the terms of a claim. In these cases, an Art 84 EPC objection can and should be raised. Conversely, in cases where a claim as such might be understood in two ways, but the description clearly explains which way is meant, we see no compelling reason for a clarity objection. The description can and should be used as the patent's dictionary.

What follows from these first principles if a claim has been amended (limited)? Firstly, we think that the amended claim must of course be clear, when viewed together with the description. Any

remaining unclarity should be removed, which can be accomplished either by further amending the claim, or – at least in some cases – by amending the description, particularly if the unclarity only arises due to a contradictory or unclear definition of a term which is (also) used in the claim.

Beyond this, however, we see little justification for requiring an adaptation of the description. In particular, the support requirement in Art 84 should not be misused for requiring the description to be co-extensive with the claims or for requiring a deletion of examples that no longer fall under the amended claim. The ancient Athenians might have expressed this scenario in the following terms.

Suppose the application as filed disclosed and claimed a peripteral octastyle Doric temple with 46 outer columns such as this one:



(All pictures taken from: Maxime Collignon (1849-1917), *Le Parthénon: l'histoire, l'architecture et la sculpture*, Paris 1914. Online Version available [here](#).)

The application to this temple had to be amended a couple of times for historical reasons. First, a church dedicated to the Virgin Mary and then a Mosque with a Minaret were erected within this temple (both amendments clearly violating Art 123(2) EPC). In 1687, the Parthenon was misused as a gunpowder magazine to defend Athens against a Venetian military expedition (arguably violating both Art 53(a) EPC and Art 123(2) EPC). This resulted in big destructions when a Venetian cannon ball hit the magazine. From 1800 to 1803, [the 7th Earl of Elgin](#) removed several of the sculptures to London (Art 123(2) EPC again). Any remaining Christian and Muslim additions were removed again in 1832, once Otto I, brother of the Bavarian King Ludwig I (and like him an ardent admirer of classic Greek art), became King of Greece. As a consequence, the status in the early 1900s was as shown above and below. Only about 31 of the original 46 outer columns were still standing.



Let us assume that the applicants were happy with an amended claim directed at a doric temple with only 31 columns and finally wanted their patent on this basis. In our opinion, it would then be utterly unreasonable to request from the applicants to remove the (perfectly fine and elaborate, see above and [here](#)) support for the remaining 15 columns (which are now no longer claimed) from the description. Or, to put it in simple words, we see no compelling reason why the description should not be allowed to include more support than specifically needed for the claim. As long as the claim remains clear and has (at least) the support it needs to be understood and enabled, no objection under Art 84 EPC should arise. We also see no legal basis for requesting the applicant to designate the support for the unclaimed columns as “not according to the invention”. Both the public and the infringement courts will be able to recognize that the claims as originally filed were amended and to conclude therefrom that not all “embodiments” of the description are necessarily also covered by the amended claims.

Thus, some common sense and a somewhat restrained application of Art 84 EPC, which mainly focuses on removing apparent unclarities, might well yield about the same result as T 56/21 but with a much less dogmatic approach.

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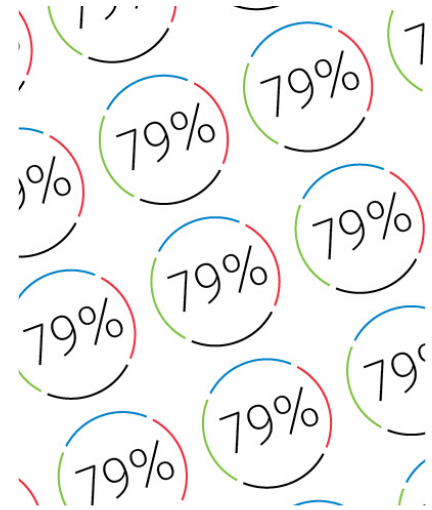
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