A background image of two men in suits standing in a modern office with large windows and hanging lights. The image is overlaid with a blue gradient.

Webinar 13 June 2024

Upcoming referrals to the Enlarged Board of Appeal of the EPO


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Agenda

- T56/21: Bringing the description, figures and examples into conformity with the claims
- T439/22: Interpreting the claims in the light of the description



Bringing the description, figures and
examples into conformity with the
claims - T56/21

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Article 84 EPC

The claims shall define the matter for which protection is sought.
They shall be clear and concise and be supported by the description.

EPO Guidelines F IV 4.3

- The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking appropriately so that it is clear that they do not fall within the subject-matter for which protection is sought.
- An inconsistent embodiment may also be remedied by ensuring that it is not referred to as being "according to the invention" throughout the description and by complementing the reference to it with an explicit statement to the effect that it is retained due to being useful for understanding the invention (e.g. "embodiment useful for understanding the invention", "comparative example from background art").

EPO Guidelines 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.

A commonplace objection from the EPO

The applicant is furthermore requested to **bring the description, figures and examples into conformity with these claims**; care should be taken during revision, especially of the introductory portion including any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC). **Figures and examples no longer forming part of the invention should either be indicated as such or be removed.**

Failure to do so could lead to the refusal of the application under Article 97(2) EPC in combination with Article 84 EPC.

T56/21 – Background

- EP 15 700 545.5 *"FC-Region variants with improved protein A-binding"*.
- A **Rule 71(3) EPC communication** was issued 24-06-2019, allowing the pending set of claims, with the amendments proposed by the examining division.
 - Including the **deletion of numbered, claim-like clauses on pages 89-93.**
- Applicant disapproved the text proposed for grant

T56/21 – Background

- Applicant arguments:
 - The only legal text which requires the alignment of the description with the claims is the EPO Guidelines, but these are not legally-binding provisions
 - Deletion of the “claim-like clauses” would violate the rights of the applicant e.g. to form a basis for an admissible amendment after grant.
- Examining division:
 - The EPO Guidelines are “additional essential requirements” under the EPC
 - The legal basis for requiring deletion of pages 89-93 lies in Art. 84 EPC itself.

T56/21 – Background

- Examining division also referred to Rule 48(1)(c) EPC:

(1)The European patent application shall not contain:

...

(c) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

- The application was rejected for failing to comply with Art. 84 EPC
- Applicant appeals.

Issues

- Established EPO Case Law – claim interpretation should be clear in themselves and not require reference to the description. T2/80, T454/89, T1129/97, T488/99, T1141/06, T725/08, T786/16, T624/17, T663/18
- If this is the case, why is there a requirement that the description be adapted?
- Marking embodiments as “not part of the invention” – may have an effect on subsequent infringement proceedings; cf. *Ensygnia v Shell* ([2023] EWHC 1495 (Pat))

Ensygnia v Shell ([2023] EWHC 1495 (Pat))

- Method for identifying whether a user was authorised to access a service.
 - E.g. mobile payment service at a petrol station
 - a method comprising a user using their mobile phone to scan "*a graphical encoded object*" (e.g. a QR code) "*displayed on a display of a computing apparatus*"
- Claims as granted:
 - "*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,*"

Ensygnia v Shell ([2023] EWHC 1495 (Pat))

- Post-grant amendment at the UK Patent Office:
 - *"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"*
- Plus, embodiments in the description and certain Figures relating to electronic displays were said to be "outside the scope of the claims"

Ensygnia v Shell ([2023] EWHC 1495 (Pat))

- In infringement proceedings at the High Court:
 - Judge May agreed that, in the claims as granted
"a display" forming part of a "computing apparatus"
would generally be understood to be an electronic one.
- Judge May: I do not think it would even occur to the skilled reader reading this passage in the context of the application as a whole that the invention could be implemented using a sign that is not electronic or which cannot be changed

Ensygnia v Shell ([2023] EWHC 1495 (Pat))

- The original claims = an electronic display
- The amended patent = “electronic display is not part of the invention” (limited to a “static sign”)
- The amendments to the description text changed the meaning of the claims
- Subject-matter was thus added, and the claims were broadened post-grant.

Issues in EPO post-grant proceedings

- T450/20 – The application as filed often...differs from the patent as granted, ...and it [the application as filed] usually cannot...provide guidance for interpreting the claims of the patent as granted. (Reasons 2.16).
- Implies that the claims of a patent as granted should not necessarily be interpreted using description as filed (...but instead using the description as granted?)

T56/21 – Divergence in the Case Law

- T 1989/18 (Board 3.3.04, same applicant and Board as T 56/21), T1444/20 (Board 3.3.01) and T 2194/19 (Board 3.5.03) all found a lack of legal basis for the requirement for the description to be amended in line with the claims.
- T 3097/19 (Board 3.5.06) on the other hand, disagreed with these decisions and found that the requirement for the description to be amended in line with the claims does have legal basis in Article 84 EPC

T56/21 – Concepts in the Case Law - I

- There must be **correspondence** between the claims and the description
- *“nothing is claimed which is not disclosed in the description”*
- Reflects the wording of Article 84 EPC
- See T26/81, T409/91, T1129/97

T56/21 – Concepts in the Case Law - II

- The claims and the description must be **consistent**
- *“all the features described in the description as being necessary...must be present in a corresponding claim”*
- T133/85, T888/90, T1055/92, T939/92, T409/91

T56/21 – Concepts in the Case Law - III

- The claims must be **commensurate** with the description
- *“the subject-matter of the claims must be justified by the extent of the description and drawings.*
- The claims must not cover subject-matter which, after reading the description, still would not be at the disposal of the skilled person
- T26/81, T133/85

T56/21 – Enlarged Board of Appeal – G3/14

- In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, **the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.**
- For example – if the claims are amended in opposition, by combining claim 1 and claim 3, then compliance with Article 84 EPC (of the amended claim) cannot be examined.
- Literal insertion of complete dependent claims as granted into an independent claim cannot be understood as an “amendment” (*G3/14, reasons 80-81*)
- But – in this situation – can Article 84 EPC be used as legal basis for aligning the description text with the amended claim?

T56/21 - Proposed question to the EBA

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")?

T56/21 – questions proposed by the applicant

- Question 1. Is there a lack of clarity of ~~a claim~~ the claims or a lack of support of ~~a claim~~ the claims 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~~ the specification (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 as defined in the claims ("inconsistency in scope between the description and/or drawings and the claims"?)

T56/21 – questions proposed by the applicant

- Question 2. If the answer to question 1 is 'yes', 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")?

T56/21 – third party observations

- Two sets of third-party observations (TPOs) were filed anonymously on 24 November 2023.
- The TPOs cite several articles published in the official journals of the European Patent Institute, EPI, (epi information) and of the Chartered Institute of Patent Attorneys (the CIPA journal).
- The articles cited in the TPOs all appear to support the Board's view that the recent case law is divided over the description amendment requirement, as well as drawing attention more generally to the negative consequences of the EPO's current approach.

A blue-tinted photograph of two men in business suits standing in a modern office hallway with glass railings and track lighting. The man on the left is looking towards the man on the right.

Interpreting the claims in the light of the description - T439/22

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T439/22 – recent developments

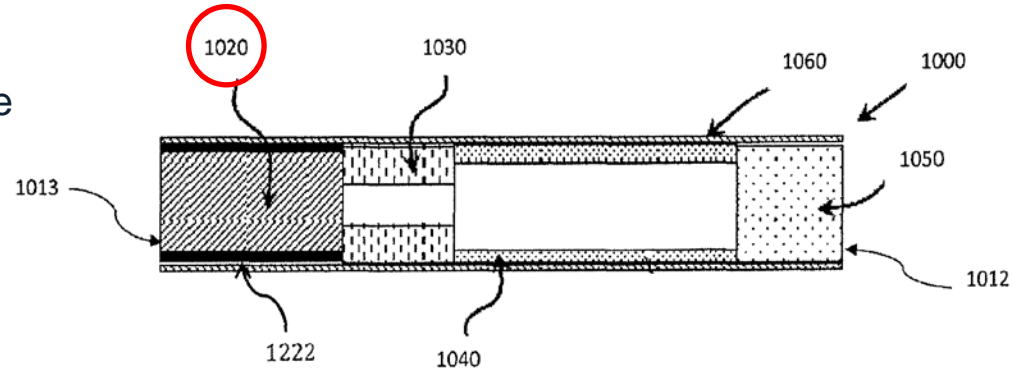
- Minutes of the oral proceedings on 10 April 2024: “After deliberation by the Board the Chairman indicated that a referral to the EBA appeared necessary to allow for the Board to come to a conclusion on the decisive questions of the case”.
- A decision was expected by 10 June 2024 in accordance with statements made by the Chairman at the oral proceedings.
- Communication from the Board on 7 June 2024: The date on which the decision is to be despatched is postponed until 1 July 2024.
- Today’s presentation is based on the preliminary opinion of the Board of 5 December 2023

T439/22 – EP 3 076 804

1. A heated aerosol-generating article (1000, 2000) for use with an electrically-operated aerosol-generating device (3010) comprising a heating element (3100), the aerosol-generating article comprising an aerosol-forming substrate (1020, 2020) radially encircled by a sheet of thermally-conductive material (1222, 2222), in which the aerosol-forming substrate comprises a gathered sheet of aerosol-forming material circumscribed by a wrapper, the wrapper being the sheet of thermally-conductive material which acts as a thermally-conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article.

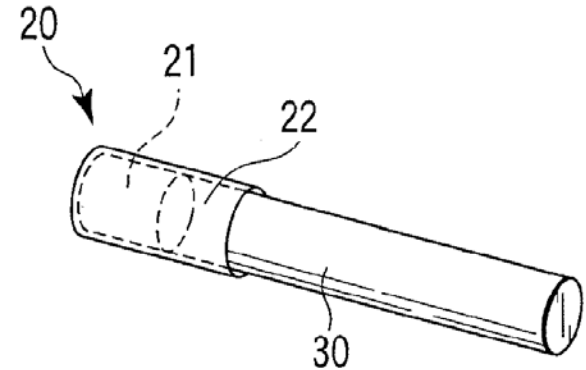
T439/22 – EP 3 076 804

- [0035] As used herein, the term 'gathered' denotes that the sheet of tobacco material is convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod.
- [0071] The aerosol-forming substrate 1020 comprises a rod formed from **a crimped and gathered sheet** of homogenised tobacco wrapped in aluminium foil 1222 to form a plug.



D1 – EP 2 368 449 A1

- A roll 20 including a tobacco sheet shaped into a hollow cylindrical structure is inserted into the hollow part of the heater 11.
- The tobacco sheet 21 may be wound as a single or multiple layers. In this case, only **the tobacco sheet 21 may be spirally wound** or a laminate of the tobacco sheet 21 and aluminum foil may be spirally wound.



The Opposition Division's analysis 1/2

In fact, the opposition division interprets the term "*gathered sheet*" as implying that said sheet is geometrically modified into a more complex shape in analogy to "gathering" as used as a sewing technique (see e.g. corresponding Wikipedia entry "Gather (sewing)" and figure below).



Illustrations: [https://en.wikipedia.org/wiki/Gather_\(sewing\)](https://en.wikipedia.org/wiki/Gather_(sewing))



The Opposition Division's analysis 2/2

Re. 7.3.1: gathered sheets of tobacco material are widely used in the tobacco industry and as such the term "*gathered sheet*" has a clear and agreed meaning in the art, this being that a sheet is gathered when it is folded and convoluted to occupy a tri-dimensional space as best exemplified in the figure under point 7.2 above. A rolled sheet as disclosed in D1 is thus not a gathered sheet.

Board of Appeal - preliminary opinion 1/2

There is agreement that document D1 discloses a heated aerosol-generating article comprising features (a), (b) and (d) of claim 1. Under discussion is whether the spirally wound aerosol-forming substrate (21) of the heated aerosol-generating article disclosed in D1 destroys the novelty of the "gathered sheet of aerosol forming material" recited in feature (c) of claim 1 (emphasis added).

Board of Appeal - preliminary opinion 2/2

- According to one line of case law the (broad) definition in paragraph [0035] cannot be left unconsidered.
 - The same definition of what counts as “gathered” according to the patent is to be applied when assessing the prior art.
- Following another line of case law - the “classical approach” - the support of the description for interpreting the claims should only be resorted to in the exceptional case where the subject-matter of the invention and/or its technical context needs to be clarified.
 - When the wording of a claim is clear for the skilled person, the supporting role from the description is deemed neither necessary nor justified.

Article 69(1) EPC & Protocol

The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

Art. 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated (...)

The diverging case law

- **“Classical approach” = “Strict literal definitional approach”**
 - Art. 69 EPC considered only in the context of Art. 123(3) EPC
 - T 169/20, T 1279/04, T 30/17
- **Contextual approach**
 - Interpreting the claimed features for the purposes of establishing the extent of protection is not different from determining the claimed subject-matter in the context of Art. 54(2), 56, 83 and 123(2) EPC
 - T 1473/19, T 556/02, T 1646/12, T 2007/19

The “classical approach” – T169/20 - 1/3

- Art. 84 and Rule 42 and 43 EPC provide an adequate legal basis for claim interpretation when assessing patentability.
- Art. 69 EPC is relevant in the context of infringement and Art. 123(3) EPC only, but not in the context of assessing patentability of the invention.

The “classical approach” – T169/20 – 2/3

- As implicitly derivable from Art. 84, the support of the description for interpreting the claims should only be resorted to in the exceptional cases where the subject-matter of the invention and/or its technical context needs to be clarified.
 - Case law recited in CLBA, 10th Edition II.A.6.3.3
- The support of the description should, in any case, not be used for restricting or modifying the subject-matter of the invention beyond what a person skilled in the art would understand from the wording of the claims within the relevant technical context.
 - Case law recited in CLBA, 10th Edition II.A.6.3.4

The “classical approach” – T169/20 – 3/3

The expressions

“the patent is its own dictionary”

and

“the terms used in patent documents should be given their normal meaning in the relevant art, unless the description give the term a special meaning”

are at odds with the well-established principle of the primacy of the claims.

The contextual approach – T 1473/19 – 1/3

- Claims must be read through the eyes of the skilled person and interpreted with a mind willing to understand, taking into account the whole disclosure of the patent.
 - Case law recited in CLBA 10th Edition II.A.6.1

The contextual approach – T 1473/19 – 2/3

- The only provisions in the EPC for interpreting the claims are provided by Art. 69 EPC.
 - Art. 84 EPC does not contain any rules for the interpretation of claims.
 - Art. 84 EPC at most defines the standard to be applied when assessing clarity.
- Art. 69 EPC in conjunction with its Protocol is hence applicable to the interpretation of the claims in the context of Art. 54, 56, 83 and 123(2) EPC

The contextual approach – T 1473/19 – 3/3

- The purpose of Art. 84 EPC is to enable a clear delimitation of the scope of protection in order to ensure that the extent of protection of the patent can be determined under Art. 69 EPC.
- There is no convincing reason not to apply Art. 69 EPC and the Protocol when determining the claimed subject-matter in EPO proceedings (i.e., in the context of Art. 54(2), 56, 83 and 123(2) EPC).
- Interpreting the claimed features for the purposes of establishing the extent of protection is not different from determining the claimed subject-matter in the context of Art. 54(2), 56, 83 and 123(2) EPC.

Further case law in line with the contextual approach

- T 556/02, T 1646/12, T 2007/19

Contextual interpretation has its limits

- **T 1473/19:**
 - Limiting features which are only present in the description but not in the claim cannot be read into a patent claim.
 - The primacy of the claims limits the extent to which the description may serve as a dictionary for the terms used in the claims.

Back to T439/22 – Preliminary opinion of the BoA

- A fundamental point of law arises from the diverging lines of case law represented by T 1473/19 and T 169/20.
- A narrow interpretation of the claim language ignoring a definition given in the description would be in conflict with a broader interpretation by national courts or the Unified Patent Court.

The background is a blue-tinted image of a glass door or window. On the glass, the 'inspicos' logo is visible, with the word 'inspicos' in a stylized font and 'EUROPEAN PATENT ATTORNEYS' in smaller capital letters below it. The text 'Thank you' is centered in the middle of the image in a white, sans-serif font.

Thank you

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