



Amending the requirement for Description Amendments: the EPO's hot topic of 2022

Patent lawyers are well-aware of the influence a patent's description can have on the monopoly granted by the claims of that patent. Whilst, strictly, what matters is the patent's claims, any ambiguity takes one back to the description. European Patent Convention ("EPC") Rule 42 specifies that the description must describe the invention such that it can be understood by reference to the underlying technical problem to be solved. The material included in a patent's description therefore matters. Too little may limit the patentee's ability to rely on a wider interpretation in post-grant amendments or enforcement against an allegedly infringing product. Too much material risks falling foul of the European Patent Office's ("EPO's") strict new Guidelines for Examination ("the Guidelines") on inconsistencies between the description and the claims (section F-IV-4.3). Under these Guidelines, examiners can require amendments to the description, including by the explicit disclaiming of certain embodiments as not being part of the invention. This, of course, can have significant implications, particularly when assessing infringement by the doctrine of equivalents.

2022 saw a plethora of EPO Board of Appeal decisions grappling with description amendments, with differing views. So where do we stand?

The Background: T 1808/06 (2008) and the 2021 EPO Guidelines for Examination

T 1808/06 set out the general approach to the claims being supported by the description, in the context of claim amendments: *"the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear. Any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised."* The position was considerably reinforced in 2021 by amendments to the Guidelines, which required either the deletion of embodiments in the description that were not covered by the independent claims; or an explicit statement disclaiming an embodiment as part of the invention.

The Claims take precedence: T 1989/18 (December 2021)

The end of 2021 marked the first divergence from the strict description amendment requirements. The Examiner refused the application on the basis that the patent's description of the invention identified subject matter that was broader than the claims. The Board of Appeal set this decision aside. It placed considerable weight on the language of Art. 84 EPC that the claims must be "clear and concise" (or "clear in themselves", to use the wording of the decision). The subsequent mention of the "description" in Art. 84 related only to the subject matter of the claim and not its clarity. Neither was the Board of Appeal persuaded that Art. 69 EPC (on the use of the description to interpret claims), nor EPC Rule 42 (disclosure of the claimed invention in terms of the technical problem and its solution), nor EPC Rule 48

(obviously irrelevant or unnecessary matter in an application), had legal basis to require description amendments in that case.

Spring confusion: 2022 EPO Guidelines update, and T 1024/18

In early 2022, updated Guidelines saw the wording of section F-IV-4.3 edited again. Although the requirement to delete or disclaim certain embodiments remained similar (*"The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought"*), the 2022 update appeared to provide the patentee with some leeway: *"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"*.

However, hot on the heels of the updated Guidelines was another Board of Appeal decision, T 1024/18 (March 2022). Among other issues, the decision addressed description amendments. It specifically called out – and disagreed with – T 1989/18. Two embodiments in the description were cited as being inconsistent with the claims. Referring again to Art. 84 EPC, the Board of Appeal concluded that, although the claims may well be "clear", *"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 such, consistent with a strict approach, the Board of Appeal found the claims must be consistent with the description throughout, *"not only in some part"*. In the absence of an amended description, the patent was revoked.

Referral to the Enlarged Board of Appeal, or are the decisions reconcilable?

Plenty more decisions on description amendments came during the remainder of 2022. Numerous cited and disagreed with the decision in T 1989/18, holding up the decision of T 1024/18 as the correct approach: the claims must be consistent with the description *throughout*, regardless of whether the claims were clear on their own. This position was seemingly confirmed by the EPO directly, following an "expert workshop" it hosted in June amidst the confusion. However, whilst the balance of decisions certainly weighs on the side of the strict approach advocated for in the EPO Guidance, there have still been decisions that conclude that the claims have primacy: T 1444/20 (April 2022) concluded that in circumstances where redundant subject matter in the description did not impair the understanding of the technical problem, no description amendment was necessary; and indeed that T 1989/18 was correct to find there was no legal basis to require the removal of matter which is obviously irrelevant or unnecessary.

Might we see a referral to the Enlarged Board of Appeal? Perhaps. Or maybe an October 2022 decision gives hints at the way through. In T 2194/19, the Board of Appeal steered clear of citing T 1989/18, but did decide that the conclusion that all embodiments must fall within the scope of the independent claims is one that *"cannot be derived from the EPC"*. Rather, it appears to suggest a case-by-case approach: *"it may well be that, in a given case, there is such an inconsistency or contradiction between the claims and an "embodiment" of the description. But this has to be justified by the examining division."* Such an approach will not give practitioners the confidence they desired. 2023 will surely see more activity in the description amendment saga.