

Consultation on EPC and PCT-EPO Guidelines

IP Federation submission on the *Guidelines for Examination in the European Patent Office*, March 2021 edition: Part F, Chapter IV – Claims (Art. 84 and formal requirements)

Introduction

The IP Federation represents the views of UK industry in IP policy and practice matters in the UK, Europe and internationally. Its membership of influential IP-intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. Details of the IP Federation membership are given at the end of this submission.

The IP Federation welcomes the opportunity provided by the European Patent Office (EPO) public online user consultation on the *Guidelines for Examination in the European Patent Office* (EPC Guidelines), March 2021 edition. This submission focuses in particular on Part F, Chapter IV - Claims (Art. 84 and formal requirements), Section 4.3. It follows careful consideration in the IP Federation Council and Patent Committee, and is based on our members' considerable experience of prosecuting and opposing European patent applications, and of patent prosecution and litigation across the globe.

Summary

In a nutshell, the IP Federation objects to the changes made in the March 2021 edition of the EPC Guidelines which adversely affect an applicant's ability to include disclosure in the specification at their own discretion that may not directly relate to the claimed subject matter but that may nonetheless be desirable. These changes are not necessary to solve any problem posed by the previous version of the Guidelines, have no support in EPO case law, will create complications which will make the process of patent examination in the EPO less efficient, will therefore give rise to delay, and will create problems of interpretation in the litigation of European Patents.

The positions before and after March 2021

The previous version of the EPC Guidelines F-IV-4.3 states that any inconsistency between the description and the claims must be avoided if it throws doubt on the extent of protection, and therefore renders the claim unclear or unsupported under Art. 84 EPC. However, the Guidelines go on to say that if examples and technical descriptions, in the description or drawings, which are not covered by the claims, are presented not as embodiments of the invention but as background art or examples useful for understanding the invention, they are allowable and may be retained. This means the description can be amended by simple changes in wording, eg from "invention" to "disclosure" or "embodiment" to "example", to remove any inconsistencies so that the subject-matter may be retained.

The previous version added that if apparatuses, products and/or methods in the description and/or drawings which are not covered by the claims are presented not as embodiments of the invention but as background art or examples useful for understanding the invention, the retention of these examples may be allowed. This practice was both reasonable and helpful, not just to applicants but to all who would try to interpret the specification.

By contrast, the new Guidelines F-IV-4.3(iii) *inter alia* require:

“In addition, merely changing the wording "invention" to "disclosure" and/or the wording "embodiment" to "example", "aspect" or similar is not sufficient to clearly state that this part of the description does not fall under the scope of the claimed invention. It has to be explicitly specified that this part of the description does not describe part of the claimed invention.

Similarly, subject-matter in the description being excluded from patentability needs to be excised, reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention.”

The previous practice was entirely appropriate, proportionate and efficient. The new practice is not.

Lack of support for the new EPC Guidelines in EPO case law

The new Guidelines appeal for a basis in EPO Technical Board of Appeal case law, namely EPO Board of Appeal decision T 1808/06. In this, and later decisions which cite it, the Boards of Appeal have found that, to avoid inconsistencies in the specification, references to embodiments which fall outside the scope of the amended claims should normally be deleted, but there has been no suggestion that an inconsistency could arise from the presence of passages that are not presented as “embodiments of the present invention”. Neither has there been any suggestion that the practice before March 2021 of changing the wording "invention" to “disclosure” or "embodiment" to "example" should not be allowable. It is not clear why such a long-ago case as T 1808/06 should now demand this change in practice, or indeed how it supports it.

Effect of the new Guidelines

The practice under the Guidelines prior to March 2021 worked well and has done for many years. By removing the opportunity of addressing certain objections under Art. 84 through simple changes in wording, such as "embodiment" to "example", and introducing a new requirement for features to be “explicitly specified” or “prominently marked”, massively increases complexity and will inevitably lead to more rounds of amendment and delay. This is not an empty prediction; it is an everyday reality since the new Guidelines began to be followed by Examiners ahead of the formal publication in March 2021. The problems are especially acute in the life sciences field.

There will also be serious consequences in the litigation of European Patents. Under Art. 69 EPC, the description is used to interpret the claims. The new Guidelines and their requirement to “explicitly specify” will therefore have a profound effect on claim interpretation in opposition and national litigation

proceedings. This issue is further complicated by the different applications of the Doctrine of Equivalence across different jurisdictions.

Conclusion

The IP Federation objects to the changes made in the March 2021 edition of new Guidelines F-IV-4.3(iii). They introduce a severe and unwarranted limitation on an applicant's discretion to include disclosure in the specification that, while it may not directly relate to the claimed subject matter, is nonetheless desirable from the applicant's point of view. Provided the law established by the EPC and its underlying Rules and Regulations is complied with, it is not appropriate for the EPO arbitrarily to dictate how the applicant should achieve this. As this submission has explained, the recent changes are not necessary to solve any problem under the previous version of the Guidelines, have no support in EPO case law, will create complications which will make the process of patent examination in the EPO less efficient, will give rise to delay, and will create problems of interpretation in litigation of European Patents. For all these reasons, The IP Federation urges the EPO to reconsider its amendments to EPC Guidelines F-IV-4.3(iii) and to restore the previous version.

IP Federation
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IP Federation members 2021

The IP Federation membership comprises the companies listed below. The UK Confederation of British Industry (CBI), although not a member, is represented on the IP Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. The IP Federation is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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