
Amending the description prior to grant of a European patent – recent developments (EPO, Boards of Appeal, Decisions T 1989/18 and T 1444/20)

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1. Background

For many years, it has been common practice at the EPO to adapt the description prior to grant of a European patent to ensure that the subject-matter of the allowable claims and the description are consistent. In 2021, the requirements in this regard became much stricter. The 2021 update of the Guidelines for Examination required that embodiments *“in the description which are no longer covered by the independent claims must be deleted ... unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims”*, and further that in such case *“the fact that an embodiment is not covered by the claims must be prominently stated”*. This extremely strict approach was somewhat relaxed in the current version of the Guidelines 2022, but it is still not sufficient to make only minimum amendments, which were sufficient prior to 2021 (it was often sufficient to supplement the description with statements such as *“the invention is defined by the claims”*).

It is paramount for applicants to think twice before light-heartedly making last-minute amendments to the description at the end of the patent-prosecution process, just before grant, which may lead to a reduced scope of protection. Specifically, labelling an embodiment as *“not covered by the claims”* might carve a *“hole”* into the scope of protection, the extent of which is difficult to foresee. To avoid such *“hole”*, it would generally be preferable to fully delete such an embodiment from the description rather than to state that it is *“not covered by the claims”*. In particular, having the doctrine of equivalents in German infringement proceedings in mind, particular care should be taken to ensure that the description does not provide a basis for arguing that the claimed invention is a selection from described alternatives. According to the decision X ZR 76/14 of the German Federal Court of Justice (*“V-förmige Führungsanordnung”*, ref. 27), such selection from alternatives that provide the desired technical effect generally has the consequence that the alternatives not claimed can no longer be considered equivalents.

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2. T 1989/18

In the case T 1989/18, the Board of Appeal (BoA) 3.3.04 found that there is no legal basis for the requirement that the description should be streamlined with the claims. The Examining Division had refused an application for the sole reason that the description identified embodiments as being part of the invention which were not part of the invention as defined by the claims. On appeal, the BoA 3.3.04 considered various potential legal bases (Art. 84, Art. 69 EPC as well as R. 42(1)(c) and 48(1)(c) EPC) for the requirement to adapt the description. However, all of them were ultimately rejected, such that the decision was set aside.

The BoA pointed out that Art. 84 EPC requires the claims to be clear and to be supported by the description to the extent that the claims should not include subject-matter that does not have a basis in the description (cf. reasons, refs. 4, 5). However, subject-matter in the description that does not appear in the claims is not prohibited. The claims at hand were considered to be clear in themselves and to be supported by the description (cf. reasons, ref. 15). The BoA concluded that clarity of the claims is not affected if the description contains subject-matter which is not claimed.

Concerning Art. 69 EPC, the BoA held that this provision is irrelevant to amendments to the description as it rather deals with the construction of claims and not with the definition of the subject-matter for which protection is sought (cf. reasons, ref. 6).

Concerning R. 42(1)(c) EPC, the BoA decided that *“the passages objected to by the examining division [...] do not impair*

the understanding of the technical problem and its solution as set forth in the summary of the invention”, and therefore, the requirements of R. 42(1)(c) EPC were met (cf. reasons, ref. 8). Finally, regarding R. 48(1)(c) EPC, the BoA noted that the purpose of R. 48 EPC as a whole is to prevent the publication of matter contrary to morality or public order. The purpose of R. 48(1)(c) EPC cannot be to keep a patent specification free of unnecessary information, and therefore R. 48 EPC cannot serve as a legal basis for the refusal either (cf. reasons, refs. 10 to 12).

3. T 1444/20

In the further case T 1444/20, the BoA 3.3.01 considered whether it is necessary for *“claim-like clauses”* to be deleted from the description. Claim-like clauses are often added to the description of European applications as claim-like fallback positions for which no claim fees have to be paid. Notably, even before the Guidelines 2021 were introduced, it was standard practice to delete such claim-like clauses before grant. However, the BoA found that *“there is no reason why the presence of the section “Specific embodiments of the invention” in the description should affect the clarity of the claims”* (cf. reasons, ref. 2.5), as the *“numbered embodiments ... cannot be mistaken for claims, since it is evident that they are a part of the description text, and they are not denoted as “claims”, either.”* (cf. reasons, ref. 2.4). The BoA also criticized that the Guidelines were inconsistent *“in that they acknowledge, on the one hand, that claim-like clauses may (or may not) give rise to a lack of clarity, but require, on the other hand, that such claim-like clauses must*

in the description do not result in a lack of clarity of the actual claims, Article 84 EPC cannot provide the justification for removing them” (cf. reasons, ref. 2.6).

As a result, the BoA found that as long as claim-like clauses in the description do not result in a lack of clarity of the claims, Art. 84 EPC does not justify their removal.

Summary and Outlook

The two above cases do provide arguments for applicants to fend off extensive adaptations of the description. However, there are quite a few cases, such as T 1024/18, T 2766/17 and T 2293/18 (which came after T 1989/18) that do follow the standard EPO line of argument that Art. 84 EPC provides a legal basis for the requirement to amend the description. Moreover, unlike the decisions T 1989/18 and T 1444/20 that were given the lowest distribution code “D” (*i.e.*, the decisions

are not distributed to other BoAs), the other decisions were given distribution code “C” (*i.e.*, all are distributed to the other BoAs). Hence, the two decisions T 1989/18, T 1444/20 will likely be treated as exceptions by the EPO Examiners who will presumably continue to insist on extensive adaptations of the description. Applicants will all the more have to take utmost care to adapt the description in a manner such as to minimize any corresponding limitation of the scope.