

# AIPLA

## American Intellectual Property Law Association

April 02, 2023

Dear Officer,

The American Intellectual Property Law Association (AIPLA) welcomes the opportunity to comment on the latest amendments to the EPO Guidelines for Examination.

AIPLA is a national bar association of approximately 7,000 members that include professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

The 2021 revision of the EPO Guidelines for Examination was intended to harmonize the practice of EPO examiners regarding the subject-matter in a written description relative to the claimed invention. Rather than achieving harmonization, the amended Guidelines have resulted in a greater divergence in examination practice with some examiners adopting an extremely rigid approach requiring amendments to conform the specification to the allowed claims, while others have a more pragmatic approach.

As noted in our April 8, 2022, comments (attached), amendment of the description serves neither the public, nor the applicant's, interest. Rather, it can negatively impact the public, competitors and applicants and owners. In particular, a requirement to delete subject-matter from the description because it is not expressly claimed, or to note that a disclosed embodiment is not covered by the claimed invention, can:

1. prejudice a national court's ability to find infringement by equivalents, because it introduces statements that may be construed as a surrender of an equivalent or an explicit declaration against applicability of the corresponding doctrine;
2. risk a post-grant finding of ***added subject-matter***, if deleted subject-matter changes the interpretation of terms in a claim;
3. negatively impact the ***sufficiency of disclosure if the deleted material is later deemed necessary to practice the claimed invention***;
4. limit an owner's ability to ***amend claims*** during opposition proceedings before the EPO and/or invalidity proceedings before National Courts, by prejudicing the possibility of relying on the deleted subject-matter as a source or basis for post-grant amendments; and

5. increase *costs* for the applicant and the Office with no apparent benefit (the costs become particularly high in the context of long patent applications, such as in biotechnology and pharmaceutical fields, and often prohibitive for small companies).

The revised Guidelines, which entered into force in March 2023, include an amendment to F-IV, 4.3 to include the passage:

*“As long as the resulting text of the description does not present conflicting information to the reader, 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").”*

However, this is preceded by the (unamended) statement that:

*“The terms "disclosure", "example", "aspect" or similar on their own, do not necessarily imply that what follows is not encompassed by an independent claim. Unambiguous expressions have to be adopted to mark an inconsistent embodiment (e.g. by adding "not encompassed by the wording of the claims", "not according to the claimed invention" or "outside the subject-matter of the claims") instead of merely replacing the terms "embodiment" or "invention" by one of the aforementioned terms.”* (emphasis added).

For at least these reasons, the amended Guidelines remain open to inconsistent interpretation by examiners, many of whom continue to adopt an overly zealous approach that is extremely costly and time consuming for both the examiner and applicant and thus counter-productive for an efficient procedure; as well as having the potential to be extremely problematic post-grant.

We also notice that recent decisions from the Boards of Appeal are not consistent regarding the extent to which the description should be amended in agreement with the claims.<sup>1</sup> It is therefore requested that the President of the EPO refer this point of law to the Enlarged Board of Appeal under Article 112 (1) (b) EPC in order to provide clarity on the legal position for all parties.

We appreciate the opportunity to provide these comments and would be happy to further discuss our views on these issues with the EPO. If you have any questions or would like us to clarify any of these points, please let us know.

Sincerely,

Brian H. Batzli

*President*

*American Intellectual Property Law Association*

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<sup>1</sup> Reference is made to T1989/18, T2766/17 and T1444/20 in contrast to T1024/18, T1968/18, T2293/18, T2685/19, T3097/19, T0121/20 and T1516/20.

# AIPLA

## American Intellectual Property Law Association

April 8, 2022

Dear Officer,

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present comments on the 2022 version of the Guidelines for Examination in the EPO.

AIPLA is a national bar association of approximately 8,500 members that include professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA welcomes the current effort of the EPO to collect comments from stakeholders regarding changes to said Guidelines. We hope that our views will assist the EPO in its process of revising its Guidelines to benefit all stakeholders rather than place unnecessary burdens on them.

### **Background**

The 2021 revision of the EPO Guidelines for Examination attracted many comments concerning the new provisions introduced by the Office about mandatory amendments of the description to avoid any possible inconsistency with the claims [Guidelines F-IV, 4.3 and F-IV, 4.4]. In particular, the 2021 Guidelines appeared to rely on a finding in T1808/06 that “inconsistent” embodiments should be deleted wherever possible; and if not possible that such embodiments should be prominently marked, for example, as an “*embodiment not covered by the claimed invention.*”

The practice set forth in the 2021 Guidelines has been followed quite strictly by the Examining Divisions starting from March 2021, by requesting adaptation of the description as a condition for issuing a Communication of Intention to Grant (Rule 71(3) EPC) or by introducing amendments directly in the Text Intended to Grant, subject to the Applicant's approval. The

most recent version of the Guidelines, entered into force on March 1<sup>st</sup>, 2022, substantially maintains the requirements formally introduced in 2021. In particular, although the 2022 Guidelines amend the terms of the relevant sections [particularly F-IV, 4.3], the principal effect of the 2021 Guidelines remains unchanged.

### **The specific requirements established in the 2022 Guidelines vs the most recent EPO case law**

The 2022 Guidelines recite [F-IV,4.3 (iii)]:

*According to Art. 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description. Parts of the description that give the skilled person the impression that they disclose ways to carry out the invention but are not encompassed by the wording of the claims are inconsistent (or contradictory) with the claims. Such inconsistencies may be present in the application as originally filed or may result from amending the claims to such an extent that they are no longer consistent with the description or drawings.*

In order to avoid an “*inconsistency*,” the Guidelines request an applicant to delete the embodiments allegedly not falling within the literal wording of the claims or to mark them with expressions such as “*not encompassed by the wording of the claims*,” “*not according to the claimed invention*,” or “*outside the subject-matter of the claims*.” Recent decision T1989/18 (published too late for consideration in the 2022 Guidelines) contradicts the requirements of the Guidelines. In fact, T1989/18 provides cogent reasoning as to why amendment to the description is not required by Article 84 EPC, in particular, by concluding with the following statement (Reasons 5): “*if the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject-matter which is not claimed*.”

In an obiter remark (Reasons 8) referring to Rule 42(1)(c) EPC, which requires the description of a European patent application to disclose how the claimed invention can be understood as the solution to a technical problem, the T1989/18 decision concludes that this rule cannot form the legal basis for requesting amendments to the description in order to remove alleged inconsistencies with the claims.

T1989/18 also considers the legislative history of Rule 48(1)(c) EPC, which requires a European patent application to be free of irrelevant or unnecessary statements and which has been used by previous boards’ decisions to justify the requirement to adapt the description to the subject-matter as claimed, and concludes that this rule similarly cannot form the legal basis for requesting amendments to the description in order to remove alleged inconsistencies with the claims (Reasons 10-11).

T1989/18 also confirms that Article 69 EPC cannot provide legal basis for the requirement that the description should be amended in line with the claims in that it “*is not by itself concerned with a requirement of the Convention to be met by an application or patent*” (Reasons 6).

### **Criticalities of the new practice**

Deletion of subject-matter from the description and/or marking of disclosed embodiments as not covered by the claimed invention according to the current version of the Guidelines:

- i. may prejudice a national court’s ability to find infringement by equivalents, because it introduces statements that may be considered as a surrender of an equivalent or an explicit declaration against applicability of the corresponding doctrine;
- ii. risk a subsequent, post-grant finding of ***added subject-matter***, if the deletion changes the interpretation of terms in a claim;
- iii. may have an impact upon ***sufficiency of disclosure, if the deleted material is later deemed necessary to practice the claimed invention***;
- iv. may limit patent owner’s ability to ***amend claims*** during opposition proceedings before the EPO and/or invalidity proceedings before National Courts, by prejudicing the possibility of relying on the deleted subject-matter as a source or basis for post-grant amendments;
- v. incur ***costs*** for the Applicant and the Office to no apparent benefit (the costs become particularly high in the context of long patent applications, such as in biotechnology and pharmaceutical fields, and often prohibitive for small companies).

With respect to issue under ii., recent decision T 471/20 (Reason 2.4) confirmed that amendments made to the description that alter the meaning of (a term of) the claims could contravene A. 123(2) EPC if the new meaning was not clear from the specification as filed.

### **Proposed change in the EPO practice to be reflected in the 2023 edition of the Guidelines for Examination**

In view of the criticalities explained in the previous section and in further consideration of the following facts:

- the apparent lack of legal basis for the practice set out in sections F-IV, 4.3 and F-IV, 4.4 of the Guidelines, as highlighted by T1989/18;
- “*any infringement of a European Patent must be dealt with by national law*” [Art. 64(3) EPC]; and
- it would be time and cost consuming for the Applicant and its representative to enter— at the examination stage of an application—into extensive discussion and speculation about which embodiments not covered by the literal claim wording may be deleted, as opposed to those embodiments that need to be retained because they may be of potential interest for subsequent court proceedings;

it is suggested that the EPO:

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- avoid imposing requirements affecting the fair right of the Patent Owner to effectively enforce their patent; and
- align the practice set out in F-IV, 4.3 and F-IV, 4.4 with the findings of T1989/18.

We appreciate the opportunity to provide these comments and would be happy to further discuss our views on these issues with the EPO. If you have any questions or would like us to clarify any of these points, please let us know.

Sincerely,

A handwritten signature in blue ink that reads "Patrick J. Coyne". The signature is written in a cursive style with a large initial 'P' and 'C'.

Patrick J. Coyne

President

American Intellectual Property Law Association