

T 2194/19 – Amendment of the Description in Line with the Claims – Required or not?

T 2194/19 ist eine weitere Entscheidung einer EPA-Beschwerdekammer, welche die Schlussfolgerung ablehnt, wonach gemäss dem EPÜ alle in der Beschreibung einer Patentanmeldung genannten Ausführungsformen unter die unabhängigen Ansprüche fallen müssten. Im Gegensatz zu den Prüfungsrichtlinien des EPA und anderen Entscheidungen vertrat die vorliegend zuständige Beschwerdekammer die Auffassung, dass Art. 84 EPÜ eine Änderung der Beschreibung nur dann vorschreibe, wenn zwischen den Ansprüchen und der Beschreibung eine echte Unstimmigkeit oder ein Widerspruch bestehe, wodurch die Ansprüche unklar erschienen, während die blossе Tatsache, dass eine Ausführungsform nicht oder nicht mehr von den relevanten Ansprüchen erfasst werde, nicht ausreichend sei. Im Widerspruch zu früheren Entscheiden folgerte die Beschwerdekammer daher, dass weder Art. 84 EPÜ noch Regel 42 (1) c) EPÜ verlangten, dass alle in der Beschreibung offenbarten Ausführungsformen der Erfindung durch die Ansprüche abgedeckt sein müssten.

T 2194/19 est une autre décision de la chambre de recours juridique de l'OEB qui rejette la conclusion selon laquelle la CBE exige que tous les modes de réalisation mentionnés dans la description d'une demande de brevet entrent dans le champ d'application des revendications indépendantes. Contrairement aux Directives relatives à l'examen de l'OEB et à d'autres décisions, la chambre de recours juridique a estimé que l'article 84 CBE n'imposait une modification de la description que s'il existait une véritable discordance ou une contradiction entre les revendications et la description, qui rendrait les revendications peu claires, alors que le simple fait qu'un mode de réalisation ne soit pas ou plus couvert par les revendications pertinentes n'était pas suffisant. En contradiction avec des constatations antérieures, la chambre de recours a donc conclu que ni l'article 84 CBE ni la règle 42(1) c) CBE n'exigeaient que tous les modes de réalisation de l'invention exposés dans la description soient couverts par les revendications.

I. Introduction

The question whether the description of European patents can mention embodiments not covered by the patent claims has been a subject of debate for some time. The European Patent Office (EPO) amended its Guidelines for Examination¹ as of 1 March 2021 to provide for certain new requirements regarding inconsistencies between the patent claims and the description (F. IV. 4.3), namely when parts of the description and/or drawings are not covered by the claims (iii). Pursuant to the new Guidelines, all embodiments mentioned in the description must be covered by the independent patent claims, otherwise such parts must be deleted. In recent months, various decisions from different EPO Boards of Appeal have been issued dealing with the question of whether or not such requirement can be derived from the European Patent Convention (EPC).² The answers found by the Boards diverge. The majority of decisions issued so far concluded that a corresponding legal basis can be found in the EPC and thus support the EPO management's view. However, in some instances, the opposite conclusion has been reached, thus the issue is far from settled.

T 2194/19³ of 24 October 2022 is the third decision in this series of diverging rulings and thus of considerable interest for future discussion.

In the following, the relevant considerations of the decision are first briefly presented and then placed in the context of the previous case law regarding the «amendment of the description requirement» and the discussion relating to it.

II. Summary of Decision T 2194/19 of 24 October 2022

In T 2194/19, the Technical Board of Appeal dealt with an appeal of an Examining Division decision which refused a patent application regarding an «error-correcting code interleaver». The respective application concerned digital communication systems in which communication data is transmitted via interleaving using error correction. According to the application-as-filed, the invention provides «for a very efficient and reliable use of memory for error-correcting code interleaving» (paragraph [0011]).

ALEXANDRA BÜHLMANN, MLaw, Rechtsanwältin, Zürich.

LARA DORIGO, lic. iur., LL.M., Rechtsanwältin, Zürich.

The english translation of the lead is included on Swisslex and legalis only.

- 1 Guidelines for Examination in the European Patent Office, March 2021: [https://documents.epo.org/projects/babylon/eponet.nsf/0/C4B20952A0A7EF6BC125868B002A5C61/\\$File/epo_guidelines_for_examination_2021_hyperlinked_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/C4B20952A0A7EF6BC125868B002A5C61/$File/epo_guidelines_for_examination_2021_hyperlinked_en.pdf), all links last visited march 14th 2023.
- 2 T 1989/18; T 1024/18; T 0121/20; T 2766/17; T 2293/18; T 1444/20, T 1516/20, T 2194/19 and T 3097/19.
- 3 Technical Board of Appeal, 24 October 2022, T 2194/19.

The Examining Division refused the application based on the following grounds: In the reasoning of the appealed decision, the Examining Division raised objections under Art. 123(2) EPC with respect to certain features of claim 1 and independent claim 5. In addition, it raised objections under Art. 84(2) EPC with respect to the same claims, in view of inconsistencies between the claims and parts of the description, which, according to the Examining Division's reasoning, rendered the claims unclear and raised doubts as to their support by the description.

By way of background, pursuant to the applicable EPO Guidelines for Examination, «[a]ny inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported» (F-IV, 4.3). The Guidelines go on to explicitly state that such an inconsistency may arise if an embodiment in the description «comprises a feature which is demonstrably incompatible with an independent claim» (F-IV, 4.3. (iii)). The Examining Division's decision to refuse the application on the grounds of inconsistencies between the claims and the description was therefore in line with the applicable Guidelines for Examination of the EPO.

The applicant appealed the decision to the EPO Technical Boards of Appeal. In its decision, the competent Board first dealt with the objections raised by the Examining Division based on added subject-matter (Art. 123(2) EPC) and lack of clarity and support by the description (Art. 84(2) EPC). In conclusion, the Board in this regard held that these objections were overcome by amendments to the claims, which the applicant had made during examination.

In a second step, the Board addressed the Examining Division's arguments for the rejection of the patent application based on lack of conformity of the description with the independent claims, which it summarized as follows:

«6.1. In items (a) and (a1) to (a3) of the Reasons 4 of the appealed decision, the examining division observed that the following paragraphs of the description, namely:

- paragraph [0027], relating to Figure 3;
- paragraph [0033], relating to Figure 5;
- paragraph [0035], relating to Figure 6;
- paragraphs [0039] and [0041], relating to Figure 8;
- paragraph [0043], relating to Figure 9,

concern convolutional interleaving using a memory size of $\langle(I(I-1)*J)/2+I+1\rangle$ (emphasis added by the board).

The examining division regarded this to be at odds with the smaller memory size of $\langle(I(I-1)*J)/2+1\rangle$ used in independent claim 1.

It is apparent from item (a6) of Reasons 4 that the examining division equated the term «embodiment» with subject-matter that has to fall «within the scope of the invention as defined by the claims». They concluded that the description so adapted was not in conformity with the independent claims, contrary to Rule 42(1)(c) EPC, because the term «embodiment» was used in parts of the description that describe subject-matter that was not part of the subject-matter of these independent

claims. Moreover, the examining division held that the «invention» must always be the «invention claimed» and the «invention» was defined by the independent claims (cf. Reasons 1, referred to in Reasons 4, item (b2) of the appealed decision).»

The Board of Appeal, however, disagreed with the Examining Division's view. Its main considerations were the following:

«6.2. The board does not endorse the objection raised in Reasons 4 of the impugned decision for the following reasons:

6.2.1. First, the board is not convinced that, according to the EPC, the «invention» is necessarily and always to be equated with the «invention claimed» (see e.g. T 944/15, Reasons 17).

6.2.2. Secondly, this board takes issue with the conclusion that the requirement that the claims are to be supported by the description (Article 84, second sentence, EPC) necessarily means that all the «embodiments» of the description of a patent application have to be covered by the (independent) claims, i.e. that all the embodiments must fall within the scope of those claims. This conclusion cannot be derived from the EPC. It can also not be derived from the jurisprudence of the Boards of Appeal, according to which merely inconsistencies or contradictions between the claims and the underlying description are to be avoided in that context (see e.g. T 1808/06, Reasons 2; T 2293/18, Reasons 3.3.5). The board considers that 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. The mere indication that the embodiment does not or no longer fall under the respective claim(s) is not sufficient in this regard.

6.2.3. Thirdly, the board considers that in particular Rule 42(1)(c) EPC cannot be the legal basis for establishing such a general and broad requirement for an adaptation of the description to the claims. It is simply not what this provision says. Rule 42(1)(c) EPC requires that the description discloses the invention, as claimed, in such terms that the technical problem and its solution can be understood, and that it states any advantageous effects of the invention with reference to the background art. These requirements set out in Rule 42(1)(c) EPC, however, cannot be taken to mean that all the embodiments described in the description of a patent application have to fall within the scope of the claims.»

In sum, this Board thus concluded that Art. 84 EPC only requires the amendment of the description in the event that there is a genuine inconsistency or contradiction between the claims and the description, which renders the claims unclear, whereas the mere fact that the embodiment is not or is no longer covered by the relevant claim(s) is not sufficient in this respect. Furthermore, according to this Board decision, Rule 42(1)(c) EPC does not provide any legal basis for «a general and broad requirement for an adaptation of the description to the claims». Hence, in contradiction to the previous finding of the Examining Division, this Board concluded that neither Art. 84 EPC nor Rule 42(1)(c) EPC requires all embodiments of the invention disclosed in the description to fall within the scope of the claims.

III. Background to the discussion

1. The Examination Guidelines of the European Patent Office

The recent controversy over description amendments began, as already indicated above, with the introduction of the requirement for applicants to amend the description of a patent application in line with the allowed claims in the 2021 EPO Guidelines for Examination (which entered into force on 1 March 2021).⁴ At the EPO, it has been the practice for years to adjust the description before granting a European patent to ensure that the subject-matter of the granted claims and the description are consistent. However, the requirements for the description were significantly tightened by the 2021 Guidelines.

The 2021 EPO Guidelines explicitly stated 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. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated (T 1808/06)» (F-IV-4.3 (iii)). Prior to 2021, minor adjustments to the description were usually sufficient to convince the Examining Division that the description was consistent with the claims. The 2021 Guidelines, however, explicitly state that «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» (F-IV-4.3 (iii)).

The introduction of these stricter requirements triggered considerable criticism. It was complained that the new requirements result in a longer registration time as well as increased costs. On the other hand, there appear to be no advantages justifying such efforts, particularly if it is considered that the scope of protection of a patent is defined by its claims, which is why an amendment of the description to adapt it to the claims seems superfluous.

Since the introduction of the controversial requirements, the Guidelines have been adapted twice (in force since 1 March 2022⁵, respectively 1 March 2023⁶), and Section F-IV, 4.3 of the Guidelines referring to description amendments has been reworded. The EPO itself classified the updates as «minor changes» only,⁷ but overall, the changes appear to be an attempt to somewhat soften the EPO's much criticized approach. For example, the above-cited passage in the 2021 Guidelines, stating that embodiments in the description that are no longer covered by the independent claims must be deleted or prominently stated as not being covered by the claims, has been removed from the 2022 and 2023 Guidelines. Furthermore, in borderline cases where doubt exists as to whether an embodiment is consistent with the claims, the applicant should be given the benefit of the doubt. However, the current Guidelines

still require that inconsistencies between the description and the claims be addressed, either by deleting the inconsistent passage from the description or by indicating that the inconsistent embodiments are not covered by the subject-matter of the claims. In this respect the 2023 Guidelines specify that such embodiments shall not be referred to as being «according to the invention» throughout the description and by complementing the reference with an explicit statement to the effect that the embodiment is retained due to being useful for understanding the invention (e.g. «embodiment useful for understanding the invention» or «comparative example from background art»). Since the most recently updated wording is quite similar in scope to the 2021 and 2022 versions, the revised Guidelines are not to be understood as announcing a substantive change of EPO practice.

2. Previous case law

The EPO Guidelines 2021, which are a guide to current EPO case law and practice without legally binding effect, cite T 1808/06 as the basis for the requirement to amend the description. In this decision, the Board of Appeal held that the requirement to amend the description derived from Art. 84 EPC. More specifically, the relevant Board concluded that «in order to meet the requirement of Article 84 EPC that the claims have to be supported by the description, 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.»

However, since the entry into force of the EPO Guidelines 2021, diverging conclusions have been reached regarding the existence of a legal basis in the EPC for the requirement to amend the description, although overall, the Boards of Appeal have ruled more often in favor of the existence of a legal basis for such requirement. The two leading decisions for the views in favor of and against the existence of such legal basis are T 1989/18, which first held that there was no legal basis for a requirement to amend the description, and T 1024/18, which was issued later and concluded that Art. 84(2) EPC means that the entire description must be in line with the allowed claims. The relevant considerations of these decisions are briefly summarized in the following.

4 Guidelines for Examination in the European Patent Office, March 2021: [https://documents.epo.org/projects/babylon/eponet.nsf/0/C4B20952A0A7EF6BC125868B002A5C61/\\$File/epo_guidelines_for_examination_2021_hyperlinked_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/C4B20952A0A7EF6BC125868B002A5C61/$File/epo_guidelines_for_examination_2021_hyperlinked_en.pdf).

5 Guidelines for Examination in the European Patent Office, March 2022: [https://documents.epo.org/projects/babylon/eponet.nsf/0/E5CF26FC37C06F00C12587F700552B22/\\$File/epo_guidelines_for_examination_2022_hyperlinked_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/E5CF26FC37C06F00C12587F700552B22/$File/epo_guidelines_for_examination_2022_hyperlinked_en.pdf).

6 Guidelines for Examination in the European Patent Office, March 2023: [https://documents.epo.org/projects/babylon/eponet.nsf/0/616B456AA59D7B02C12589630059E5C2/\\$File/epo_guidelines_for_examination_2023_hyperlinked_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/616B456AA59D7B02C12589630059E5C2/$File/epo_guidelines_for_examination_2023_hyperlinked_en.pdf).

7 List of sections amended in 2023 revision: www.epo.org/law-practice/legal-texts/html/guidelines/e/m.htm.

2.1. T 1989/18 of 16 December 2021: No requirement to amend the description

In T 1989/18 the Board of Appeal had to consider whether there was legal basis for the refusal of the application on the grounds that the description included subject-matter that was broader than the claimed invention and that the description had not been amended in line with the allowed claims. After accepting the claims as allowable, the examiner had refused the application for the sole reason that the description did not comply with the requirements of Art. 84 EPC.

The Board reviewed a wide range of legal provisions in the EPC with a view to whether they might give rise to a requirement for consistency between the description and the claims.

Article 84 EPC states that «[t]he claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description». With regard to this provision, the Board concluded that it does not provide for a prohibition of additional subject-matter in the description that does not appear in the claims. Pursuant to the Board, the description cannot be relied upon to resolve a clarity issue in the claim, rather the claims must be clear themselves.

The Board also considered Art. 69 EPC, but held this provision to be irrelevant to the issue of description amendments, given that it is not concerned with the definition of the subject-matter sought to be protected by a claim, but instead only deals with how the claims should be interpreted.

Furthermore, the Board also considered whether Rule 42(1) EPC or Rule 48(19)(c) of the EPC Implementing Regulations, which are part of the EPC according to its Art. 164, could provide a legal basis for a requirement to amend the description in line with the claims. Rule 42(1)(c) EPC requires that the description shall disclose the invention, as claimed, in such terms that the technical problem and its solution can be understood. In the absence of a unity objection, the Board of Appeal could not see how this provision could be used to justify a requirement to amend the description in line with the claims. In the case under review, the Board particularly failed to see how the objected passages impaired the understanding of the technical problem and its solution as set forth in the summary of the invention.

Finally, with regard to Rule 48(1)(c) EPC, the Board of Appeal observed that the overall purpose of this Rule was to prevent publication of content, which is contrary to public policy or morality. It could thus not be the purpose of Rule 48(1)(c) EPC to keep a patent specification free of unnecessary information; therefore, Rule 48 EPC also could not serve as a legal basis for the rejection.

The same line of reasoning was subsequently adopted by another Board of Appeal decision – T 1444/20.

2.2. T 1024/18 of 1 March 2022: The description must be amended in line with the claims

In T 1024/18, the Board also dealt with the interpretation of Art. 84(2) EPC, but it refused to follow the reasoning of T 1989/18 and instead came to a different conclusion, which supports the EPO Guidelines. For the Board of Appeal in T 1024/18, Art. 84 EPC is concerned with the clarity, conciseness and support of claims. Therefore, «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».

The Board held that «supported by the description means supported by the whole description, because that is what supported by the description means». Following this reasoning, the Board of Appeal concluded that the requirement in Art. 84 EPC for the claims to be supported by the description includes the requirement that the description is consistent with the claims throughout. As such, the description should be amended so that the reader is not presented with any information which conflicts with the wording of the claims. Given that the applicant in the case at hand had not filed an amended description in line with the otherwise allowable claims, the Board revoked the patent.

T 1024/18 was followed by other Boards that adopted the reasoning, mostly without adding anything further in substance, namely T 2293/18, T 0121/20, T 1516/20 and T 2766/17.

The latest decision in this series is T 3097/19 of 16 November 2022, where the competent Board of Appeal considered that the consistency between the claims and the description is necessary for legal certainty. «The skilled person to whom the claims – and the entire application – are addressed must not be confronted with contradictory statements when reading the patent application as a whole.» Otherwise, as the Board held, there could be doubts regarding the invention for which protection is sought. The Board further held, that it disagrees with the conclusions in T 1989/18, but rather concurs with the conclusions expressed in, especially, T 1024/18 and T 2766/17. It also disagrees with the conclusions of T 2194/19, inasmuch as it considers it necessary that embodiments said to be «of the invention» must fall within the scope of the claims.

All these decisions thus support the conclusion that Art. 84 EPC demands that the description in its entirety must be consistent with the claims.

IV. Conclusions and outlook

The current practice of the EPO regarding the necessity to amend the description to be in line with the scope of the claims, as reflected in the EPO Guidelines for Examination, is thus supported by the majority of decisions from the Boards of Appeal issued on the topic so far. Although the 2022 and 2023 versions of the Guidelines appear to take the general criticism expressed with respect to the description amendment requirement into account to some extent,

it is clear that the EPO in its amendments did not intend to abolish the requirement under Art. 84(2) EPC, which was only officially introduced in 2021 and was unanimously supported by the case law of the Boards of Appeal until the date the new Guidelines were adopted.

It is worth noting that the 2022 Guidelines had been finalized before the publication of any of the decisions denying a legal basis for the description amendment requirement. However, considering that T 2194/19 is now already the third finding of a lack of legal basis for the description amendment requirement in contradiction of the 2021 and 2022 Guidelines, there was at least some uncertainty as to whether the diverging reasoning of the three decisions T 1989/18, T 1444/20 and T 2194/19 would possibly impact the newest revision of the Guidelines. Those who hoped for a softening of the EPO's practice regarding the requirement to amend the description in line with the claims were disappointed by the recent publication of the revised 2023 Guidelines. The version in force since 1 March 2023 in no way reflects or discusses the diverging reasoning of the three decisions T 1989/18, T 1444/20 and T 2194/19. The complete disregard of the divergent reasoning of some Boards of Appeal seems to indicate that the EPO has no intention to change its practice for the time being. The EPO's approach is, of course, backed by the fact that the decisions

in favor of the existence of a legal basis for the amendment requirement are still in the majority. However, with three Boards of Appeal rulings already firmly denying a legal basis for the current strict practice, it appears difficult to reject this view as individual case decisions, and such position would become even more difficult to justify with each successive decision that is not in line with the examination guidelines.

Remarkably, in less than a year, we have seen nine decisions from different Boards of Appeal dealing with the application of the requirement that claims must be «supported by the description» and the requirement of amendment of the description according to Art. 84(2) EPC, coming to different conclusions. It thus appears to be only a matter of time until a Technical Board of Appeal will decide to refer the issue to the Enlarged Board of Appeal (EBA), as foreseen by Art. 112(1) lit. a EPC. In addition, in order to ensure uniform application of the law or if a question of law of fundamental importance arises, the President of the EPO may also refer a question of law to the Enlarged Board of Appeal if two Boards of Appeal have issued divergent decisions on that question. It remains to be seen what will happen first – how many more divergent decisions need to be issued on this question before a decision of the EBA will hopefully bring the desired clarity to applicants.