

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 16 December 2021**

**Case Number:** T 1989/18 - 3.3.04

**Application Number:** 12810245.6

**Publication Number:** 2794651

**IPC:** C07K16/00, C12N15/67

**Language of the proceedings:** EN

**Title of invention:**

Expression vector element combinations, novel production cell generation methods and their use for the recombinant production of polypeptides

**Applicant:**

F. Hoffmann-La Roche AG

**Headword:**

Adaptation of the description/HOFFMANN-LA ROCHE

**Relevant legal provisions:**

EPC Art. 69(1), 84

EPC R. 42(1)(c), 48(1)(c)

**Keyword:**

Adaptation of the description to claims - allowable (yes)

Claims - support in the description (yes)

**Decisions cited:**

T 0454/89, T 0544/88, T 0329/89, T 1903/06, T 0853/91,  
T 0443/11, T 1065/99, T 1646/12, T 1246/12



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1989/18 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 16 December 2021**

**Appellant:** F. Hoffmann-La Roche AG  
(Applicant) Grenzacherstrasse 124  
4070 Basel (CH)

**Representative:** Burger, Alexander  
Roche Diagnostics GmbH  
Patentabteilung  
Nonnenwald 2  
82377 Penzberg (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 5 March 2018  
refusing European patent application No.  
12810245.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** B. Claes  
**Members:** O. Lechner  
L. Bühler

## Summary of Facts and Submissions

- I. The appeal lodged by the applicant ("appellant") lies from the examining division's decision to refuse the European patent application No. 12 810 245.6, entitled "*Expression vector element combinations, novel production cell generation methods and their use for the recombinant production of polypeptides*".
- II. Although the examining division found the set of claims of the main request (submitted with a letter of 18 January 2018) to be allowable, it held that the amendments on page 9, line 23, page 10, line 19 and page 11, line 1 of the description adapted to those claims (submitted with the same letter) did not comply with the requirements of Article 84 EPC, in particular because they related to subject-matter which was broader than the subject-matter of claim 17 of the request.
- III. The relevant amendments on pages 3, 9, 10 and 11 of the description of the main request read as follows (insertions compared with the description as filed are underlined, deletions are crossed out):

Page 3, line 7:

"The invention is defined by the claims."

Page 9, line 23:

"In one embodiment of the invention the expression vector comprises either [...]"

Page 10, line 19 and page 11, line 1:

"In one embodiment of the invention ~~of all aspects as reported herein~~ the expression vector comprises [...]"

Claim 17 of the main claim request reads:

"17. An expression vector comprising

a first expression cassette comprising in 5' to 3' direction a hCMV promoter, a nucleic acid encoding an antibody light chain, a bGH polyA signal sequence, and a hGT terminator sequence,

a second expression cassette comprising in 5' to 3' direction a hCMV promoter, a nucleic acid encoding an antibody heavy chain, a bGH polyA signal sequence, and a hGT terminator sequence."

- IV. With its statement of grounds of appeal, the appellant re-submitted the amended description dealt with in the decision under appeal as the main request and submitted two further amended descriptions as auxiliary requests 1 and 2. It submitted arguments to the effect that each of the submitted descriptions complied with the requirements of Article 84 EPC.
- V. In a telephone conversation, the rapporteur informed the representative of the board's provisional view that the amendment to the description of the main request on page 3, line 7, i.e. the introduction of the sentence "*The invention is defined by the claims*" (see section II), introduced ambiguity with respect to other amendments to the description.
- VI. By letter dated 19 March 2021, the appellant submitted an amended description as a new main request, in which the amendment on page 3, line 7 of the previous main request had been deleted.

VII. The appellant's arguments relevant to the decision are summarised as follows:

Adapting the description of a patent application to the set of claims on which an examining division intended to grant a patent was governed solely by the requirements of Article 69(1) EPC, Article 84 EPC and Rule 42 EPC.

The amendments to the description were entirely consistent with the claims as found allowable by the examining division and did not cast doubt on the granted patent's scope of protection.

The EPC did not require that parts of the description of an application which were no longer covered by the set of amended claims on which an examining division intended to grant a patent had to be marked as "*non-related disclosure*" or even had to be deleted when adapting the description to those claims.

VIII. The appellant requested that the decision under appeal be set aside and the case be remitted to the examining division with the order to grant a patent on the basis of the set of claims 1 to 24 filed with the letter of 22 March 2017, the figures 1/15 to 15/15 as published and the description according to the main request, as filed with the letter of 19 March 2021 or, alternatively, the description according to either of auxiliary requests 1 or 2, as filed with the statement of grounds of appeal.

## Reasons for the Decision

### *Admissibility of the appeal*

1. The appeal complies with the requirements of Article 108 EPC and Rule 99 EPC and is admissible.

### *Adaptation of the description*

2. The examining division refused the application because it considered that the description of the application in the form of the main request with the amendments on page 9, line 23, page 10, line 19 and page 11, line 1 (see section II) did not comply with the requirements of Article 84 EPC. The reasons for this were, in particular, that the subject-matter disclosed on page 9, line 23 to page 10, line 18, was "*broader than the subject-matter of the allowable claim [sic] claim 17 which concerns the expression vector of the invention*" and "*[i]t cannot be interpreted that this passage concerns an embodiment which would be a dependent claim of claim 17*". Moreover, the passages on page 10, lines 19 to 33 and page 11, lines 1 to 16 did not "*indicate that these embodiments could be embodiments of the vector as stated in claim 17 and further comprising other elements in addition*".
3. Hence, the examining division took the view that the scope of protection was unclear.
4. First and foremost, Article 84 EPC requires that the *claims* are clear, i.e. that they properly define and delimit the subject-matter for which protection is sought in understandable and unambiguous terms. Claims must be clear in themselves when being read with the normal skills including the knowledge about the prior

art, but not including any knowledge derived from the description of the patent application or the amended patent (see e.g. decision T 454/89, Reasons, point 4.1 (vii)).

5. Article 84 EPC only mentions the description in the context of the additional requirement that it must support the claims. Under this requirement, the subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described. However, when assessing clarity, the description cannot be relied upon to resolve a clarity issue in a claim, nor can it give rise to any such issue if the definition of the subject-matter in a claim is clear *per se*. In particular, 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 .
  
6. When assessing clarity, Article 69 EPC is of no relevance since it is only concerned with the extent of protection conferred as one of the effects of an application or patent (chapter III of the EPC) whenever that extent is to be determined by whoever is competent to do so. Article 69 EPC is not by itself concerned with a requirement of the Convention to be met by an application or patent - in particular, unlike Article 84 EPC it is not concerned with the definition proper of the subject-matter sought to be protected by a claim. Moreover, even if it were possible, for the purpose of Article 84 EPC, to interpret the claims in the light of the description and drawings as provided for in Article 69 EPC in order to establish whether the conditions governing clarity have been satisfied, the board fails to see how that approach could lead to a



lack of clarity of the claims (as opposed to a lack of clarity of the description) if the clear terms of the claims did not encompass subject-matter disclosed in the application or patent.

7. Thus, Article 84 EPC cannot serve as a legal basis for the refusal.
  
8. As per Rule 42(1)(c) EPC (Rule 27(1)(d) EPC 1973 and Rule 27(1)(c) EPC 1973, before and as of 1 June 1991, respectively) the description shall disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art. In line with the concept of a technical invention on which the EPC is founded, the first half-sentence requires the description to disclose how the invention can be understood as the solution to a technical problem. However, in the absence of an objection of lack of unity under Article 82 EPC, the board fails to see how the above-mentioned provision could be the legal basis for requiring the applicant, as a general rule, to bring the description in line with claims intended for grant, and to remove passages of the description that disclose embodiments which are not claimed. In the case in hand, the passages objected to by the examining division (the amendments on page 9, line 23, page 10, line 19 and page 11, line 1 of the description) do not impair the understanding of the technical problem and its solution as set forth in the summary of the invention on page 3 of the application as filed. The requirements of Rule 42(1)(c) EPC are thus met, so they cannot form the legal basis for the refusal either.

9. The board has also considered Rule 48(1)(c) EPC (Rule 34(1)(c) EPC 1973) as a possible legal basis requiring the adaptation of the description. Under Rule 48(1)(c) EPC, a European patent application shall not contain any statement or other matter obviously irrelevant or unnecessary under the circumstances. According to both the wording and history of this provision, it is concerned not with the contents of granted patents but with patent applications. The introductory sentence makes reference to European patent applications as opposed to the contents of the description as in Rule 42 EPC. Paragraphs (2) and (3) mention the publication of those applications. Rule 48 EPC is based on Article 21(6) and Rule 9 PCT, which provide that the international application may not contain matter contrary to morality or public order, disparaging statements or obviously irrelevant or unnecessary matter. Any such matter may be omitted from the publication of the international application. The preparatory documents provide no guidance as to what could amount to "obviously irrelevant or unnecessary" statements or matter, and Rule 48 EPC is entirely silent on the legal consequences.
10. A number of decisions have relied on Rule 48(1)(c) EPC as a (potential) legal basis for requiring the description to be adapted to the subject-matter as claimed (see e.g. decision T 544/88, OJ EPO 1990, 429, point 5; decision T 329/89, point 4.4; decision T 1903/06, point 2; decision T 853/91, point 2; decision T 443/11, point 4). In the board's judgement, however, the purpose of Rule 48(1)(c) EPC cannot be to keep a patent specification free of unnecessary information and to make sure that its content relates only to what protection is sought, for several reasons.

11. As set out in point 9, according to the wording and history of Rule 48 EPC, it does not pertain to patent specifications. Furthermore, points (a) to (c) of Rule 48(1) EPC are in the order of their offensiveness, ranking from high to low. This is reflected in paragraphs (2) and (3) of Rule 48 EPC. At the Munich diplomatic conference, there was general acceptance that the application should not be refused even if the application as filed contained statements or other matter contrary to "ordre public" or morality. Moreover, Rule 48(3) EPC remained optional (see Minutes of the proceedings of Main Committee I of the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents, document M/PR/I, No. 2225 to 2236). It is therefore difficult to conceive that the legislator intended to impose more severe sanctions on less offensive matter, in particular to provide a ground for refusal based on the inclusion of merely "irrelevant or unnecessary" matter (see also the doubts expressed in decision T 1065/99, point 7).
12. Therefore, Rule 48 EPC cannot serve as a legal basis for the refusal either.
13. In view of the above considerations, the board fails to see how the aforementioned provisions of the EPC, or any others, can lead to the requirement that embodiments disclosed in the description of an application which are of a more general nature than the subject-matter of a given independent claim must constitute potential subject-matter of a claim dependent on that independent claim. The board accordingly concludes that the decision under appeal is erroneous and is to be set aside.

14. Support for the claimed subject-matter can be found on page 4, line 5 to page 6, line 20 and on page 9, lines 3 to 4 of the description of the application.
15. The claims are thus clear, concise and supported by the description as required by Article 84 EPC.
16. In view of the above considerations, the main request is considered to comply with the requirements of the EPC.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent in the following version:
  - pages 1 to 76 of the description filed with the letter of 19 March 2021
  - claims 1 to 24 filed with the letter of 22 March 2017
  - drawing sheets 1/15 to 15/15 as originally filed

The Registrar:

The Chair:



A. Chavinier Tomsic

B. Claes

Decision electronically authenticated