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**Datasheet for the decision  
of 4 October 2024**

**Case Number:** T 0056/21 - 3.3.04

**Application Number:** 15700545.5

**Publication Number:** 3094648

**IPC:** A61K39/395, A61K9/00, A61K9/40,  
A61K45/06, C07K16/12

**Language of the proceedings:** EN

**Title of invention:**  
FC-REGION VARIANTS WITH IMPROVED PROTEIN A-BINDING

**Applicant:**  
F. Hoffmann-La Roche AG

**Headword:**  
Adaptation of the description/HOFFMANN-LA ROCHE

**Relevant legal provisions:**  
EPC Art. 84, 69  
EPC R. 42, 43, 48, 49

**Keyword:**  
Adaptation of the description (no) - no legal basis

**Decisions cited:**

G 0002/88, G 0006/88, G 0001/93, G 0001/97, G 0001/98,  
G 0001/04, G 0002/10, G 0002/12, G 0003/14, T 0002/80,  
T 0026/81, T 0011/82, T 0032/82, T 0132/82, T 0162/82,  
T 0115/83, T 0013/84, T 0175/84, T 0283/84, T 0068/85,  
T 0133/85, T 0150/85, T 0023/86, T 0016/87, T 0301/87,  
T 0327/87, T 0238/88, T 0416/88, T 0121/89, T 0194/89,  
T 0454/89, T 0472/89, T 0476/89, T 0544/89, T 0273/90,  
T 0525/90, T 0622/90, T 0760/90, T 0888/90, T 0036/91,  
T 0409/91, T 0435/91, T 0442/91, T 0626/91, T 0757/91,  
T 0113/92, T 0307/92, T 0617/92, T 0694/92, T 0923/92,  
T 0939/92, T 0996/92, T 1055/92, T 1063/92, T 0229/93,  
T 0860/93, T 0057/94, T 0977/94, T 0337/95, T 0470/96,  
T 0488/96, T 0596/96, T 0686/96, T 0740/96, T 1079/96,  
T 0586/97, T 0636/97, T 0841/97, T 1129/97, T 1149/97,  
T 1208/97, T 0274/98, T 0425/98, T 0728/98, T 1048/98,  
T 0049/99, T 0069/99, T 0190/99, T 0396/99, T 0488/99,  
T 0681/01, T 0070/02, T 0241/02, T 0467/02, T 0988/02,  
T 1018/02, T 0412/03, T 0431/03, T 0056/04, T 0787/04,  
T 1279/04, T 0142/05, T 0151/05, T 0223/05, T 0671/05,  
T 1404/05, T 1808/06, T 1202/07, T 1395/07, T 0725/08,  
T 1519/08, T 0478/09, T 1825/09, T 2355/09, T 0197/10,  
T 0712/10, T 2221/10, T 1147/11, T 1691/11, T 2319/11,  
T 1009/12, T 1360/13, T 1517/13, T 0507/16, T 0786/16,  
T 1127/16, T 2601/16, T 0030/17, T 0624/17, T 2766/17,  
T 0663/18, T 1024/18, T 1989/18, T 2293/18, T 0515/19,  
T 1473/19, T 2194/19, T 2502/19, T 3097/19, T 0121/20,  
T 0169/20, T 0367/20, T 1444/20, T 1516/20, T 0433/21,  
T 0010/22, T 0438/22, T 0439/22, T 0447/22, T 0953/22

Swiss Federal Supreme Court, 20 October 2017, 4A\_208/2017, BGE  
143 III 666

German Federal Court of Justice, 10 May 2011, X ZR 16/09, BGHZ  
189, 330

German Federal Court of Justice, 14 June 2016, X ZR 29/15, BGHZ  
211, 1

England and Wales Court of Appeal (Civil Division), European  
Central Bank v Document Security Systems, [2008] EWCA Civ 192  
UK Supreme Court, Actavis UK Ltd & Ors v Eli Lilly, [2017] UKSC  
48

NanoString Technologies Inc et al. v 10x Genomics, Inc. et al.,  
UPC\_CoA\_335/2023, App\_576355/2023

**Catchword:**

In examination of a patent application, neither Article 84 nor Rules 42, 43 and 48 EPC provide a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter.



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Case Number: T 0056/21 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 4 October 2024**

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

**Representative:** Mewburn Ellis LLP  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 9 July 2020  
refusing European patent application No.  
15700545.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairwoman** M. Pregetter  
**Members:** L. Bühler  
D. Luis Alves

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## **Summary of Facts and Submissions**

- I. The decision under appeal is the refusal of the application by the examining division.
  
- II. The decision dealt with a main request and an auxiliary request, both based on the set of claims filed on 20 April 2018 and on the drawing sheets and sequence listings as published. For the main request, the description pages were as filed on 20 December 2018. The description of the auxiliary request was filed on 19 November 2020.

The description of each request contained the passage entitled "SPECIFIC EMBODIMENTS", which contained claim-like clauses. The examining division held that (i) "*[t]hose clauses which are referring to subject-matter outside the scope of the present claims, e.g., all clauses, are considered to render the application unclear as to the actual scope of protection as defined by the claims, contrary to the requirements of Art. 84 EPC*" (point 34 of the decision); (ii) the description contained numbered embodiments in a form as used for claims; these claim-like clauses had to be removed according to the Guidelines, F-IV, 4.4, and in line with decisions under Article 84 EPC (points 22, 30 and 31 of the decision); and (iii) in so far as the description included matter repeated elsewhere in the application, was contrary to the requirements of Rule 48(1)(c) EPC (point 33 of the decision).

- III. With the statement of grounds of appeal, the appellant filed two versions of the description, one corresponding to the main request and the other to the auxiliary request, as considered by the examining division.

- IV. The Board issued two communications under Rule 100(2) EPC, the second suggesting a referral to the Enlarged Board of Appeal.
- V. In response to the first communication, the appellant filed an amended set of claims replacing the set of claims of the main request. In response to the second communication, the appellant agreed to a referral and provided comments on the point of law proposed for referral. The arguments presented have been considered in the present decision.
- VI. Anonymous third-party interventions were filed, submitting literature potentially relevant to the point of law. The appellant responded thereto. Subsequently, two further sets of third-party interventions were filed.
- VII. The appellant's requests, as understood by the Board, are as follows:

The appellant requests that the decision under appeal be set aside and a patent be granted in the following version:

Description:

Pages 1-130 filed in electronic form on 20 December 2018.

Sequence listings:

SEQ ID NO. 1 - 112 as published.

Claims:

Nos. 1-11 filed in electronic form on 15 February 2022.

Drawings:

Sheets 1/27-27/27 as published.



In the alternative, the appellant requests a referral to the Enlarged Board of Appeal.

## **Reasons for the Decision**

### **A. Preliminary considerations**

#### *I. Issues*

1. The decision under appeal is the refusal of the patent application. The examining division held the application with the description pages according to each request to be contrary to Article 84 EPC, Rule 48(1)(c) EPC and the Guidelines for Examination. The appeal hinges on the interpretation of Article 84 EPC.
2. The question to be addressed is that of whether Article 84 EPC provides a legal basis for objecting to an **inconsistency** between what is disclosed as the invention in the description (and/or drawings, if any) and the subject-matter of the claims, the inconsistency being that the description (or any drawing) contains subject-matter which is not claimed, and for requiring removal of this inconsistency by way of amendment of the description (hereinafter: "**adaptation of the description**"). If so, an application could be refused if the applicant did not amend the description accordingly, or did not agree to an amendment of the description proposed by an examining division.
3. Of course, an applicant has the right, in examination, to amend the description **of its own volition** in

accordance with Article 123 EPC. This right is not at issue.

4. As the present appeal concerns *ex parte* proceedings, the Board will deal with the interpretation of Article 84 EPC for the purpose of its application in examination proceedings, i.e. before the grant of a European patent. Opposition proceedings will be addressed to make relevant distinctions.

## *II. Relevance of the Guidelines*

5. The appeal is also not concerned with the **correctness of the Guidelines for Examination** and, even less, with a possible need for their correction. As regards the relevance of the Guidelines for Examination for deciding the appeal, the Board agrees with the position set out in decision T 162/82, OJ EPO 1987, 533. Article 23(3) EPC requires the members of the Boards of Appeal to comply only with the provisions of the European Patent Convention. The Guidelines for Examination are not part of these provisions. In reviewing the contested decision of the examining division, the Board will hence only judge whether the division has acted in conformity with the EPC. The Board will not consider whether the division has acted in accordance with the Guidelines for Examination.
6. The Board will give reasons for its interpretation of Article 84 EPC. To the extent that the Board's interpretation of the European Patent Convention differs from an interpretation that may follow from the Guidelines for Examination, the Board's reasons for the divergence should be readily understood from the explanations below. Article 20(2) RPBA is thus complied with. However, such reasons do not oblige the President

of the Office to "correct" the Guidelines for Examination under Article 10(2) (a) EPC. Indeed, the Board's decision has a binding effect only on the examining division that issued the decision under appeal (Article 111(2) EPC).

*III. Interpretation of the EPC*

7. According to Article 31 of the Vienna Convention on the Law of Treaties (VCLT), a treaty is to be interpreted in good faith in accordance with the ordinary meaning to be given to the terms in their context and in the light of the object and purpose of the treaty. Recourse to supplementary means of interpretation is provided for in Article 32 VCLT to confirm the meaning arrived at by application of Article 31 VCLT or to determine the meaning if the interpretation according to Article 31 VCLT either (a) leaves the meaning ambiguous or obscure, or (b) produces a meaning which is obviously nonsensical or unreasonable. The Boards of Appeal and the Enlarged Board of Appeal have consistently applied these provisions of the VCLT for interpreting the EPC in the past, and the present Board will also do this in the present case.
  
8. It must be borne in mind that the role of the Boards of Appeal is to interpret the EPC using generally accepted principles of interpretation of international treaties. The Boards are not mandated to engage in legislative policy. The boundaries in interpreting the EPC were set out in decision G 1/97 (OJ EPO 2000, 322, point 3.(b) of the Reasons): "*In a codified legal system such as the EPC, the judge cannot simply decide, as the need arises, to substitute himself for the legislator, who remains the primary source of law. He may certainly find occasion to fill lacunae in the law, in particular*

*where situations arise for which the legislator has omitted to provide. He may even contribute to the development of the law, beyond the filling of lacunae. In principle, however, statute law should provide him with reference points, even if these are incomplete (...)." In other words, the Board will refrain from applying considerations of legislative policy and from anticipating further harmonisation of the national laws or practices by way of a progressive interpretation of the law, which would encroach on the powers of the legislator (i.e. the contracting states as well as the Administrative Council).*

**B. *Function and relationship of the claims and the description***

*I. Context of Article 84 EPC*

9. Article 84 EPC is in Part III of the EPC, this part dealing with the **European patent application**. Article 78(1) EPC requires such an application to contain, *inter alia*, a description of the invention, one or more claims, and any drawings referred to in the description or the claims.
10. Article 84 EPC defines the function of claims and sets out formal requirements. Further requirements as to form and content are stated in Rule 43 EPC.
11. The requirements in Article 84 EPC and Rule 43 EPC do not belong to the requirements for patentability in the strict sense. Nevertheless, they constitute requirements for the grant of a patent which are subject to examination (Articles 94 and 97 EPC).

12. The issue under discussion requires consideration of the function of the claims and the description and their mutual relationship. In this context, also Article 69 EPC (and the Protocol on the Interpretation of Article 69 EPC, hereinafter: Protocol) will have to be addressed.

II. *Function of claims*

13. According to **Article 84, first sentence, EPC**, the claims define the matter for which protection is sought. Rule 43(1) EPC further specifies their content. Accordingly, claims are **precise statements of what is sought to be protected in terms of distinctive technical features** of the invention (G 1/93, OJ EPO 1994, 541, point 14 of the Reasons).

In respect of patent applications, the term "claim" implies a "**request**" put forward by an applicant that sets out the subject-matter applied for, which has yet to be examined by the competent authority to determine whether it meets the requirements for the grant of a patent. In this examination, the definition of the "matter for which protection is sought", i.e. the subject-matter claimed, forms the reference point for the assessment of patentability (Articles 52 to 57 EPC) as well as other requirements for the grant of a patent (*inter alia*, the requirements of Articles 82, 83 and, in part, Article 123(2) EPC; hereinafter encompassed by the term "patentability"). The "invention" referred to in Articles 52 to 57, 82 and 83 EPC is the "matter for which protection is sought" as defined by the technical features in the claims (Rule 43(1) and (3) EPC).

14. According to **Article 69(1), first sentence, EPC** (pertaining to the effects of European patents and

European patent applications), the claims determine the **extent of the protection *ratione materiae*** of a patent or patent application (for Article 69 EPC see point 20. below). In other words, claims establish the **substantive demarcation (boundaries) of what is protected** (the "forbidden area" or "ambit of the monopoly"). The rights for the enforcement of European patents or European patent applications, namely the remedies available in case of infringement, are a matter of national law (Articles 67(1) and 64(1) EPC).

In this context, the word "claim" also implies a **"right"** (to exclude others). The function of claims is thus to give notice of the demarcation of the area of exclusivity. Like a legal provision, claims are directed to and, when published, have effects on any member of the public.

15. The above functions are linked in that the subject-matter for which protection is sought is delimited in the claims by technical features, which allow the reader to ascertain the demarcation of the extent of protection (see point 33. below). However, the context in which these functions are stated is different, implying different **points of reference** and different **points in time**. In the context of Article 84 EPC, which pertains to the examination of subject-matter intended for grant of a patent, the subject-matter claimed is delimited and characterised in view of the **prior art** relevant to the examination of patentability, whereas in the context of Article 69(1) EPC, which concerns the enforcement of a patent after grant, the extent of protection conferred by the claims is determined in view of allegedly **infringing subject-matter** (see G 1/98, OJ EPO 2000, 111, point 3.3 of the Reasons). Thus, Article 84 EPC is about properly defining the

subject-matter of examination before grant of a patent, whereas under Article 69 EPC the issue is whether potentially infringing subject-matter falls within the "forbidden area" as demarcated by the claims of the granted patent. As will be discussed below (point 21. *et seq*), the assessment based on Article 69 EPC further requires combining appropriate protection for the patent proprietor with sufficient legal certainty for third parties.

*III. Function of the description*

16. According to **Rule 42(1)(c) and (e) EPC**, the description must **disclose the invention** in accordance with Article 83 EPC, i.e. in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (G 1/93, OJ EPO 1994, 541, point 14 of the Reasons). This function stems from Article 8(2) of the Convention on the Unification of Certain Points of Substantive Law on Patents for Invention (signed in Strasbourg on 27 November 1963; hereinafter: "**Strasbourg Convention**"; it is still in force in BE, CH, DE, DK, FR, GB, IR, IT, LI, MK, NL, SE). The terms "clear" and "complete" in Article 83 EPC and Rule 42(1)(c) and (e) EPC refer to the information content of the description. It has to allow the understanding of the technical problem and its solution, and include statements on any advantageous effects of the invention (Rule 42(1)(c) EPC). At least one way of carrying out the invention must be set out in detail by way of examples and drawings, where appropriate (Rule 42(1)(d) EPC). It goes without saying that the (disclosure of the invention in the) description is of relevance to the assessment of patentability (in particular, Articles 83, 56 and 123(2) EPC).

17. A further function of the description is set out in **Article 69(1), second sentence, EPC**. When determining the extent of protection, the description and drawings are to be used to **"interpret" the claims**. This function will be addressed next.

IV. *Relationship between claims and the description*

18. The relationship between claims and the description is addressed in two distinct parts of the Convention:

Article 84 EPC requires that the claims **be supported** by the description. This requirement for support by the description will be addressed separately below (see points 53. *et seq*).

Article 69(1) EPC and the Protocol address the role of the claims and that of the description in determining the **extent of protection** conferred by a patent or patent application.

19. From these provisions, Boards of Appeal have derived policy considerations relevant to the issue under discussion. The relationship between claims and the description as set out in Article 69(1) EPC and the Protocol will thus be discussed in the following paragraphs. The relationship between the grant proceedings and the determination of the extent of protection will be discussed separately (points 27. *et seq*) before dealing with the requirements of support by the description (points 53. *et seq*) and clarity of the claims (points 64. *et seq*) within the meaning of Article 84 EPC.
20. For the understanding of Article 69 EPC, its historical development stemming from the preparatory work on



Article 8 Strasbourg Convention is helpful. The Board makes reference to the comprehensive study by Dieter Stauder, "The History of Art. 69(1) EPC and Art. 8(3) Strasbourg Convention on the Extent of Patent Protection", IIC 1992, 311-328. The following points are noteworthy for the understanding of Article 69(1) EPC:

21. The provision concerning the extent of patent protection was conceived as a **compromise between the interests of the applicants and the interests of the public** as well as between two extreme solutions. Indeed, the interests of the applicants would be best served if the protection conferred by a patent extended to what, from a consideration of the description and drawings by a person skilled in the art, belongs to the general inventive idea contemplated by the applicant. This solution would, however, be at the expense of legal certainty for third parties. Legal certainty would be best served if the extent of protection coincided with the strict, literal meaning of the wording used in the claims. However, if the definition of the invention in the claims missed out aspects thereof, this approach would be to the detriment of the interests of applicants. More importantly, such an approach would open up the possibility of using the inventive idea while remaining outside of the literal text of the claims.
  
22. The compromise is what has been referred to in recent decisions (see, e.g., T 1473/19) as the **primacy of the claims** in determining the extent of protection conferred by a patent. The claims are **conclusive** for the extent of protection in that they establish the substantive demarcation of what is protected. The extent of protection is, however, **not limited** to what

is defined by the strict, literal meaning of the wording used in the claims. The description or drawings may be used to **expand on and complement** the definition of the invention in the claims, but not to resolve an ambiguity or contradiction in a claim. The description is only taken into consideration in determining the extent of protection in so far as it refers to an element of a claim. This compromise was encoded in Article 8(3) Strasbourg Convention and Article 69(1) EPC 1973.

23. The legislator acknowledged that Article 8(3) Strasbourg Convention and Article 69(1) EPC 1973 would, nevertheless, result in **variations in the way national courts determine the extent of protection** of patents. During the preparatory work for the EPC, interested non-governmental organisations expressed their concern that Article 69(1) EPC 1973 (at that time Article 20 of the draft) gave the national courts too broad a latitude in its interpretation and, consequently, also in determining the extent of protection. The ensuing discussions led to the **Protocol on the Interpretation of Article 69 EPC 1973** (hereinafter: "Protocol 1973"). The Protocol 1973 sets out the common understanding of the compromise solution enshrined in Article 69(1) EPC 1973. It was intended to avoid extremes in the interpretation and application of Article 69(1) EPC 1973 (see G 2/88, OJ EPO 1990, 93 and 469, point 2.1. and 4 of the Reasons: "... *The object of the Protocol [1973] is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the*

*wording of the claims as a means of definition. ..."*). However, the Protocol 1973 was **not expected to achieve uniformity** in determining the extent of protection of European patents. Rather, the legislator left it to the national courts - as the addressees of Article 69 EPC 1973 - to do justice to the conflicting interests of patent proprietors and third parties as required by the third sentence of the Protocol 1973, and to strive for further harmonisation in the application of these provisions. Without a supranational court that has the final say and can thereby prevent divergent practice, approximation but not harmonisation of court practice was to be expected, even though the national courts saw it as their task to arrive at a uniform interpretation and application of Article 69 EPC 1973.

The abstract principles concerning the interpretation of Article 69 EPC gave rise to divergent application of the Protocol 1973. An important question was whether the Protocol 1973 allowed the protection conferred by a patent to extend to so-called "**equivalents**". Equivalents relate to technical means or measures which provide the same function or effect as one or more feature(s) specified in a claim. (For an abstract definition of equivalents see, e.g., Article 21(2) of the 1991 Draft Treaty Supplementing the Paris Convention as Far as Patents Are Concerned, PLT/DC/3 as amended by PLT/DC/69, this definition also being taken up in Rule 11(2) of the 2001 Draft Regulation and Practice Guidelines under the Draft Substantive Patent Law Treaty, SCP/5/3). The issue is whether the protection conferred by a patent extends to equivalents which are not encompassed by the terms of the claims and are also not disclosed in the description. If so, the protection extends beyond both the wording of the claims and the disclosure of the patent, which was seen

as being in conflict with the second sentence of the Protocol 1973. The question arose of whether this could nevertheless be justified by the need for adequate protection as set out in the third sentence.

24. The divergence in practice among the national courts as regards the assessment of the extent of protection of European patents was considered in the **revision of the EPC in 2000**. It was discussed whether the Protocol 1973 should be supplemented by provisions regarding the significance of "**equivalents**" and the "**prosecution history estoppel**" (limiting statements by the applicant or patent proprietor during prosecution of the application or in proceedings concerning the validity of the patent) in infringement proceedings (for these issues, see the 10<sup>th</sup> European Patent Judges' Symposium (OJ EPO 2001, Special edition No. 2, 14-65)). Whereas the explanatory notes in the Basic proposal for the revision of the European Patent Convention (MR/2/00) regarding Article 69 EPC and the Protocol 1973 invoked the ambition of developing Europe-wide uniform criteria and rules for the assessment of the extent of protection, a more **cautious approach** was *de facto* taken. Specifically, it was proposed to acknowledge the significance of equivalents without laying down detailed provisions as regards definition and methodology. No proposal was made as regards the "prosecution history estoppel". Eventually, the Protocol 1973 was supplemented by a second article. Article 2 establishes that **due account should be taken of equivalents** to an element in a claim when determining the extent of protection conferred by a European patent. Convergence of the practice is thereby promoted, but not imposed upon the national courts of the Contracting States (see, however, UK Supreme Court, *Actavis UK Ltd & Ors v Eli Lilly*, [2017] UKSC 48, which

changed the law of patent infringement in the UK by acknowledging a doctrine of equivalents).

25. A further change to Article 69(1) EPC to be noted is the deletion of the expressions "Inhalt", "terms", "teneur" in the respective text, as they were perceived to be **unclear** and not to have the same meaning in all three official languages.

V. *Conclusions on the function and relationship of the claims and the description*

26. The following **conclusions** follow from the above discussion:

- (a) Article 69 EPC and the Protocol are concerned with the assessment of the extent of protection conferred by a European patent in case of infringement.
- (b) The term "interpretation" in Article 69(1), second sentence, EPC, refers to the use of the description to expand on and complement parts or elements of the claims beyond the literal meaning of the language of a claim when determining the extent of protection in case of infringement.
- (c) Article 1 of the Protocol sets forth the boundaries for the "interpretation" within the meaning of Article 69(1), second sentence, EPC. While the protection extends beyond the precise wording of the claims, the claims should not be deprived of their determinative role.
- (d) The description may only be taken into consideration in determining the extent of

protection of a patent in so far as it refers to a part or element of a claim. Matter disclosed in the description which is not linked to a part or element of a claim, is not to be considered (G 1/93, OJ EPO 1994, 541, point 14 of the Reasons).

**C. Relationship between the assessment of patentability and the determination of the extent of protection**

*I. Debate over the relevance of Article 69 EPC in grant proceedings*

27. The relationship between the claims and the description needs further elaboration as regards their role in the assessment of Article 84 EPC (as well as other provisions setting out requirements for patentability) and the determination of extent of protection according to Article 69 EPC. The question that arises in this context is whether the assessment according to Article 84 EPC and the determination under Article 69 EPC are linked or separate. This question is relevant to the present decision as the practice for requiring the description to be aligned to the more restricted subject-matter of claims, which are found allowable, is based on the view that Article 84 EPC is linked or even subordinate to Article 69 EPC.

28. The relationship between the assessment of patentability and the determination of the extent of protection was initially discussed in relation to the question of whether it is appropriate to "interpret" the claims in the light of the description and drawings as provided in Article 69(1), second sentence, EPC, to establish whether the requirements for patentability, namely those of Article 84 EPC, have been met. There

are early decisions (such as T 23/86, OJ EPO 1987, 316, point 2 of the Reasons; T 16/87, OJ EPO 1992, 212, point 6 of the Reasons; T 476/89, points 2.2 and 2.4 of the Reasons; (nuanced) T 544/89, point 3.1 of the Reasons; T 57/94 point 2.1 of the Reasons; and T 525/90, point 2.1 of the Reasons), in which the Boards of Appeal have used the description to assess the content of a claim when examining whether its subject-matter was novel and not obvious. In other early decisions (see, e.g., T 327/87, point 2.2 of the Reasons; T 238/88, OJ EPO 1992, 709, point 5.2 of the Reasons; T 416/88, point 4 of the Reasons; T 194/89, point 2.2 of the Reasons; and T 472/89, point 3.2 of the Reasons; T 860/93, OJ EPO 1995, 47, point 5 of the Reasons), the Boards of Appeal interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise within the meaning of Article 84 EPC and to determine the subject-matter claimed. In these decisions Article 69(1) EPC was understood to set forth a **general standard or methodology for claim construction** which was not confined to the determination of the extent of protection of a granted patent in infringement proceedings in accordance with Article 69(1) EPC.

In contrast, T 2/80, OJ EPO 1981, 431, point 2 of the Reasons, T 454/89, point 4.1 of the Reasons, and T 760/90, point 2.2 of the Reasons, required the claims to be clear in themselves. Article 69 EPC 1973 was not concerned with a claim's definition of the matter for which protection is sought, unlike Article 84 EPC 1973 (T 454/89, point 4.1 (viii) of the Reasons). The examination of the requirements of Article 84 EPC and the determination of the extent of protection under Article 69 EPC were seen as separate assessments to be carried out.

29. Subsequent to decisions G 2/88 (OJ EPO 1990, 93 and 469) and G 6/88 (OJ EPO 1990, 114), the relationship between the assessment of patentability and the determination of the extent of protection was discussed in view of the claims' function according to Article 69 EPC to determine the extent of protection conferred by a patent. In the above decisions, the Enlarged Board of Appeal held that the primary aim of the wording used in a claim was to satisfy the requirement of defining the subject-matter for which protection is sought having also regard to the purpose of such claims under Article 69 EPC. These general principles were taken up in a series of decisions and understood to oblige the European Patent Office to ensure, in the interest of legal certainty, that the **public was not left in any doubt as to which subject-matter is covered** by a particular claim and which is not. It was furthermore held that, as a consequence, a claim could not be considered clear in the sense of Article 84, second sentence, EPC, if it did not unambiguously allow this distinction to be made (see, e.g. T 337/95, OJ EPO 1996, 628, points 2.2 to 2.5 of the Reasons; T 586/97, point 4.1 of the Reasons; T 728/98, OJ EPO 2001, 319, point 3.1 of the Reasons).
30. The Board has reservations about the view that there is a link between Articles 84 and 69 EPC which justifies the use of the description to interpret the claims for the purpose of examining an application. In fact, the assessment of patentability, which is a task entrusted to the examining divisions of the EPO alone, should be kept separate from the determination of the extent of protection conferred by a patent, which is a matter for consideration by national courts in infringement proceedings. The reasons are set out below.



II. *Extent of protection not relevant to grant proceedings*

31. Article 123(3) EPC is the only provision applicable in proceedings before the EPO (apart from Article 85 EPC) which explicitly refers to the protection conferred by a European patent. Article 123(3) EPC prohibits the extension of the protection by way of **amendment of the patent**. The determination of the extent of protection of a European patent (i.e. the claims, description and drawings, if any) under Article 123(3) EPC is to be carried out in accordance with Article 69 EPC and the Protocol (G 2/88, OJ EPO 1990, 93 and 469, points 4 and 4.1 of the Reasons, see also point 3.3 of the Reasons: "... *In this connection, Article 69 EPC and its Protocol are to be applied, both in proceedings before the EPO and in proceedings within the Contracting States, whenever it is necessary to determine the protection which is conferred. ...*"; G 1/93, OJ EPO 1994, 541, point 11 of the Reasons; see T 1149/97, OJ EPO 2000, 259, point 6.1.10 of the Reasons, summarising the relevant considerations). It should be noted, that the (possibly adapted and hence amended) description of the patent, and not that of the application as filed, is relevant to the assessment of Article 123(3) EPC, which is in line with the rationale of Article 69 EPC. Moreover, a finding of extension of protection might result from an amendment of the claims **or** of the description. Such extension is determined by comparing the amended claims or the amended description with the claims or the description as granted.
32. As is clear from its wording, Article 123(3) EPC is examined in post-grant proceedings, i.e. opposition and limitation proceedings (Article 105a EPC; as regards nullity proceedings before national courts, see

Article 138(1)(c) EPC corresponding to Article 123(3) EPC). This has been further elaborated in decision G 1/93 (OJ EPO 1994, 541), in which the Enlarged Board of Appeal confirmed that Article 69 EPC 1973 is relevant in the context of Article 123(3) EPC 1973. According to G 1/93, this provision had the purpose of protecting the interests of third parties by **prohibiting any broadening of** (the claims of) **a granted patent**. By reference to Article 69(2) EPC 1973, the Enlarged Board of Appeal further explained that such interests were **not at issue before grant** because the protection conferred by a European patent application was retroactively determined by the claims as granted or amended after grant (G 1/93, OJ EPO 1994, 541, point 10 of the Reasons). Thus, the extent of protection and its broadening is not a matter to be assessed during examination. In examination, legal certainty for third parties is protected by Article 123(2) EPC. This provision prevents subject-matter being inserted into an application, by way of amendment, which may provide a basis for extending the protection conferred by the patent as granted in comparison with what was disclosed and claimed in the application as filed. Hence, outside of Article 123(3) EPC (and Article 138(1)(c) EPC) there is no justification for applying Article 69 EPC and the Protocol in respect of any requirement of the Convention to be met by a European patent application. Furthermore, it is **not the task of the EPO as a patent examining authority**, but for the national courts (and other authorities) of the Contracting States, which are responsible for patent infringement proceedings, to determine the extent to which protection is to be conferred (see T 175/84, OJ EPO 1989, 71, point 5.2 of the Reasons; T 442/91, point 3 of the Reasons; T 740/96, point 3.3 of the Reasons; T 1208/97, point 4 of the Reasons; T 1279/04, point 3 of the Reasons;

T 223/05, point 3.5 of the Reasons; T 1404/05, point 3.6 of the Reasons; T 30/17, point 2.1.7 of the Reasons).

*III. Examination of Article 84 EPC not linked to Article 69 EPC*

33. According to the Enlarged Board of Appeal claims must be clearly and unambiguously formulated in terms of the essential technical features of the invention because they are determinative for the protection conferred by the patent (or patent application) according to Article 69(1), second sentence, EPC (see G 2/88 OJ EPO 1990, 93 and 469, points 2.5 and 7 of the Reasons; G 6/88, OJ EPO 1990, 114, points 2.5 and 7 of the Reasons). The Board agrees that the weight attached to the claims in the determination of the protection conferred by a patent requires a clear definition of the subject-matter in the claims in terms of technical features of the invention. This definition must be such that it characterises the subject-matter claimed to unambiguously delimit it from the prior art and to allow an examination as to whether the subject-matter claimed meets the patentability requirements of the EPC. Such clear definition of the subject-matter claimed inherently enables the extent of protection to be determined under Article 69 EPC in case of infringement (T 728/98, OJ EPO 2001, 319, point 3.1 of the Reasons; T 1129/97, OJ EPO 2001, 273, points 2.1.2, 2.1.3, and 2.1.9 of the Reasons; similarly T 274/98, point 4.3 of the Reasons; T 425/98, point 4.3 of the Reasons; T 49/99, point 12 of the Reasons; T 56/04, points 2.7 and 2.12 of the Reasons). Claims which are clear to the person skilled in the art from their wording alone, serve the overriding purpose of legal certainty (G 1/04, OJ EPO 2006, 334, point 6.2 of the

Reasons). For this reason, and in view of decision G 3/14 (OJ EPO 2015, A102, headnote), **clarity of all independent and dependent claims should be key in examination.**

34. While the Board agrees on the importance of a clear definition of the subject-matter in the claims for post-grant proceedings before the national courts (infringement and nullity proceedings), the Board does not consider it possible to draw the conclusion that the assessment of Article 84 EPC is linked or subordinate to Article 69 EPC and the Protocol. Rather, the assessment of clarity and support according to Article 84 EPC **should not be confused** with the determination of the extent of protection conferred by a granted patent. Thus, it cannot be concluded *e contrario* from Article 69(1), second sentence, EPC, which requires use of the description for interpreting the claims when determining the boundaries of the protection, that the description must be used in the same way when assessing the conformity of claims with the requirements of Article 84 EPC. Indeed, the use of the description according to Article 69(1), second sentence, EPC is neither about claim construction (i.e. understanding the individual features of a claim and determining its subject-matter; see G 1/98, OJ EPO 2000, 111, point 3.1 of the Reasons) nor about resolving ambiguities in claims (see point 26. (b) and (d) above). Rather, Article 69(1) EPC instructs the competent courts of the Contracting States to extend, within the limits laid down by the Protocol, the boundaries of the "forbidden area" beyond the strict, literal meaning of the wording used in the claims held allowable by the granting authority. The term "interpretation" refers to the use of the information content of a description when determining the

protective effects starting from the strict literal understanding of the wording of the claims and ascertaining "*fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties*".

IV. *Enlarged Board of Appeal's further guidance on the relationship between patentability and the extent of protection*

35. The purported link between Article 69 EPC and the examination of Article 84 EPC and patentability in general is also difficult to reconcile with the guidance by the Enlarged Board of Appeal. In addition to decision G 1/93 dealing with Article 69 EPC in the context of the requirements of Article 123(2) and (3) EPC, which was discussed above (see point 32. above), and the *dicta* in G 1/98 and G 1/04, which were also mentioned above (concerning claim construction: G 1/98, OJ EPO 2000, 111, point 3.1 of the Reasons; concerning clarity: G 1/04, OJ EPO 2006, 334, point 6.2 of the Reasons), an *obiter dictum* in decision G 2/12 (OJ EPO 2016, A27) is of particular relevance. The Enlarged Board of Appeal explicitly acknowledged the dissimilarity between the assessment of patentability in examination (and opposition) and the determination of the extent of protection under Article 69 EPC, as has been argued above (see G 2/12, OJ EPO 2016, A27, point VIII.2.(6) (b), 4th paragraph, of the Reasons):

*"A distinction needs to be made between, on the one hand, the aspects of patentability and, on the other hand, the (protective) effects of European patents or patent applications. The EPC clearly provides for such a clear division, as the requirements for patentability are governed by Articles 52 to 57, 76, 83, 84 and 123*

*EPC whereas the extent of protection and the rights conferred by European patents or patent applications are specified in Articles 64(2) and 69 EPC in particular."*

This dictum supports the present Board's view that Article 69 EPC has no bearing on the assessment of Article 84 EPC in examination.

V. *No limiting interpretation of claims in grant proceedings*

36. Article 69(1) EPC and the Protocol can also not be considered to provide, by analogy, a general methodology for claim construction in grant proceedings. Applying the guidance of the Protocol in grant proceedings would amount to putting the cart before the horse. Indeed, the purpose of the grant proceedings is to arrive at an allowable definition in one or more claims of the matter for which protection is sought, rather than to establish before grant what the appropriate protection derived from such wording might be. Moreover, relying on the description to "interpret" the features in the claims before assessing their compliance with the requirements for patentability of the EPC would serve a different purpose than in the context of Article 69(1) EPC and would also have implications for the relationship between the claims and the description.

37. If the description were used to understand the claims before assessing Article 84 EPC, the description would serve to clarify and align the understanding of what is claimed with what is disclosed (see, e.g., T 238/88, OJ EPO 1992, 709, point 5.2 of the Reasons; T 36/91, point 2 of the Reasons; T 70/02, points 2.5 to 2.7 of the

Reasons). In other words, the description would not merely be used to confirm or broaden (e.g. by inclusion of equivalent elements) the objective meaning given by the skilled reader to the features in a claim (see point 50. below). Rather, the subject-matter would be understood to be directed to what is disclosed as the essentials of the invention, and limiting features found in the description would be read into the claims, or definitions in the description would be used to give terms in a claim a specific meaning. **The description would thus be given the function of supplementing or even replacing the definition in the claims of the subject-matter for which protection is sought.**

38. Following such an approach, the subject-matter assessed for patentability would be different from the subject-matter claimed, since the elements derived from the description and taken into account when interpreting the invention as claimed are not reflected in the wording of the claims. Claims would consequently be deprived of the function ascribed to them by Article 84, first sentence, EPC. This is because the meaning of the features in a claim would depend on the understanding of those features when considering the whole disclosure in the description, which could depart from an objective reading of the claims by the skilled reader. **Claims would thus merely serve as a guideline and the actual subject-matter examined would be determined from a consideration of what is disclosed in the description as the essentials of the invention.** Such a view would mean reverting to a situation before the EPC and the Strasbourg Convention where claims were not mandatory or determinative in the definition of the substantive boundaries of the exclusive right. Generally resorting to the description when assessing the conformity of the claims with Article 84 EPC would

thus be contrary to the object and purpose of this provision (T 1129/97, OJ EPO 2001, 273, point 2.1.3). Ambiguous delimitations of the subject-matter claimed would be encouraged, as resulting ambiguities could be resolved in reliance on the description. This would have a reverse effect on clarity required by Article 84 EPC.

39. Moreover, the assessment of further requirements for patentability, in particular those of Articles 52 to 57 EPC, would be influenced if, by reference to Article 69(1), second sentence, EPC, a feature in a claim were given a meaning which is only derivable from the description. Broad claims could thus be granted based on a narrower interpretation considering the description. This would lead to diverging decisions in opposition and in nullity proceedings where the patent specification is read by different minds in a different factual context. Such divergence would compromise legal certainty (see, e.g., T 1018/02, point 3.8 of the Reasons: "*..., the description cannot be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader. ... Otherwise third parties could not rely on what a claim actually states (cf. Article 69(1) EPC: The terms of the claims determine the extent of protection whereas the description is only used to interpret the claims) and Article 123(2) EPC would become meaningless in respect of amendments to the claims.*"). Moreover, patent proprietors would also face uncertainty as to the validity of their patents.
40. Similar considerations apply as regards the assessment of Articles 83 and 123(2) EPC. If the definition of the invention in the claims, which is the subject of the assessment under Article 83 EPC, were read against the



background of what is disclosed in the description, the reasoning concerning sufficiency might become circular in that the subject-matter claimed is aligned with the disclosure in the description before examination of sufficiency (see, e.g., T 1404/05, points 3.4 to 3.6 of the Reasons, refusing such approach). The same holds true if the subject-matter of amended claims is first interpreted in light of the entire disclosure in the description before examining under Article 123(2) EPC whether the amendments result in subject-matter which is not directly and unambiguously disclosed in the application as filed. An amended claim which, as such, lacks basis in the description as filed, could be seen as conforming with Article 123(2) EPC based on an understanding of the subject-matter claimed which is in line with the disclosure.

41. Hence, also when assessing patentability as well as Articles 83 and 123(2) EPC in examination, Article 69(1), second sentence, EPC, does not provide any basis for supplementing a claim by virtue of its "interpretation" with features found in the description or for excluding what is literally covered by the terms of the claims. The Board agrees with decision T 1473/19 that giving claims a more restricted interpretation in accordance with the description is excluded by Article 69, first sentence, EPC (T 1473/19, points 3.16 to 3.16.2 of the Reasons). However, the purported general principle of claim interpretation advocated in T 1473/19, namely that the claims should be understood in light of the description when assessing Articles 52 to 57 EPC, Article 123(2) and Article 83 EPC, would boil down to merely confirming an objective understanding of the wording of the claims and not go beyond claim construction as determined by the wording of each claim.

VI. *No limiting interpretation of claims in opposition proceedings*

42. Except for T 2/80 and T 238/88, the early cases referred to in point 28. above concern appeals in opposition. Although the present case is about examination proceedings, the Board notes that similar considerations to those set out above apply also in *inter partes* proceedings before the EPO (except for Article 123(3) EPC). To the extent that granted claims do not comply with the requirements of Article 84 EPC, they "must be lived with" (G 3/14, OJ EPO 2015, A102, point 55 of the Reasons; see also point 59 of the Reasons regarding the implications in national proceedings). If the claims lack clarity, the opposition divisions and Boards of Appeal must establish the subject-matter claimed for the purpose of examining any ground for opposition. Hence, they must construe unclear or contradictory claims to give them a technically sensible meaning in order to be able to assess any ground for opposition. Whatever the correct approach to claim interpretation is (which was and still is debated, see Kemal Bengi-Akyürek, *Anspruchsauslegung und Beschreibungsanpassung - wie weit darf man gehen?*, GRUR Patent 2023, 110), Article 69(1), second sentence, EPC, as well as Article 1 of the Protocol concern the determination of the extent of protection which is relevant to the assessment of Article 123(3) EPC only. Consequently, there is no basis for adopting the specific approach set out in Article 1 of the Protocol in the assessment of grounds for opposition.
43. However, even if this provision were considered to state a general principle of law on the interpretation

of claims, this approach would still not allow information found in the description to be incorporated into the definition of the subject-matter claimed (see, e.g., T 1279/04, point 3 of the Reasons; T 1404/05, point 3.6 of the Reasons; T 1127/16, headnote; T 30/17, point 2.1.7 of the Reasons). Claims would lose their proper functions if their subject-matter could be redefined by way of giving a feature in a claim a meaning which conforms with the description but departs from how the feature is to be understood objectively (for such a re-definition, see, e.g., T 617/92, point 2.2 of the Reasons: the term "thermostatic valve" was understood as a control valve of a particular type, and the feature "pressed-on valve plate" was understood in such a way that the tight contact of the valve plates was achieved by elastic pressure). Indeed, as set out above (point 38.), if this approach was followed, claims would merely serve as a guideline in the assessment of grounds for opposition. Due to the uncertainty involved, this would be unfair to third parties.

*VII. Divergent views on relevance of Article 69 EPC for claim construction*

44. There are many decisions in opposition appeals which, for the above reasons, refused to resolve ambiguities or contradictions in a claim by departing from the objective meaning of the terms used in light of the description (see, e.g., T 121/89, point 2 of the Reasons; T 454/89, point 4.1 (vii) and (viii) of the Reasons; T 760/90, point 2.2 of the Reasons; T 1208/97, point 4 of the Reasons; T 681/01, point 2.1.1 of the Reasons; T 223/05, point 3.5 of the Reasons; T 1279/04, point 3 of the Reasons; T 1202/07, point 2.4 of the Reasons; T 197/10, point 2.2 of the Reasons; T 1127/16,

headnote; T 30/17, point 2.1.7 of the Reasons). See, in particular, T 1404/05, point 3.6 of the Reasons:

*"Whether a court considering infringement might choose to limit the extent of protection conferred by a claim to less than the literal meaning of the claim because of some limitation stated in the description is a matter for such court. In proceedings before the European Patent Office, if a proprietor wishes to argue for a narrow scope of the claim this should be on the basis of the wording of the claim, and not on the basis of something appearing only in the description, as in such EPO proceedings the proprietor has the possibility, subject to meeting the requirements of Article 123(2) EPC, of restricting the wording of the claim to reflect the meaning he is contending for."*

45. Other decisions held that, for the purpose of examining patentability under the EPC in the light of the prior art, unclear features in claims should be given the broadest technically sensible meaning (see, e.g., T 470/96, point 3.2 of the Reasons; T 596/96, point 3.2 of the Reasons; T 686/96, point 2.6 of the Reasons; T 69/99, point 4 of the Reasons; T 787/04, point 3.2 of the Reasons; T 671/05, point 4.2 of the Reasons; T 1517/13, point 1.8 of the Reasons; T 2502/19, point 2.2 of the Reasons: "... the claims should be taken by themselves, i.e. without relying on the description and drawings, and tested against the broadest possible or objectively reasonable construction which would occur to the skilled reader. This is because Article 84 EPC stipulates that the matter for which protection is sought is defined by the claims. It does not require to rely on any other part of the application documents. ..."; T 10/22, point 2.3 of the Reasons).

46. In further decisions, the opinion was that ambiguous claims should not be construed to the detriment of persons on whom the claims will be imposed, but in a way that does not favour the person responsible for the drafting either (T 431/03, point 2.3.2 of the Reasons; T 151/05, point 3.2.2 of the Reasons; T 1519/08, point 5.1.2 of the Reasons; T 478/09, point 6 of the Reasons).
47. As regards the assessment of clarity under Article 84 EPC (if applicable), numerous decisions endorsed T 454/89 and confirmed that claims must be clear *per se* to a person skilled in the art with general knowledge of the technical field in question, without the need to refer to the description of the patent in suit (T 1129/97, OJ EPO 2001, 273, point 2.1.2 of the Reasons; T 1048/98, point 2.2 of the Reasons; T 49/99, point 12 of the Reasons; T 488/99, point 3.2.1 of the Reasons; T 412/03, point 2.4.1 of the Reasons; T 725/08, point 6.5 of the Reasons; T 786/16, point 1.5 of the Reasons; T 663/18, point 1.4.2 of the Reasons; T 515/19, point 1.1 of the Reasons; see also G 1/04, OJ EPO 2006, 334, point 6.2 of the Reasons).
48. There is thus a considerable body of decisions which contradicts a purported link between Article 69 EPC and the examination of patentability in examination and in opposition. These decisions coexist with others which, for the purpose of examining patentability, interpret claims considering the whole disclosure in the description (T 190/99, headnote and point 2.4 of the Reasons; T 396/99, ultimate paragraph of point 3.5 of the Reasons; T 70/02, point 2.5 of the Reasons; as regards the more recent decisions see Kemal Bengi-Akyürek, *Anspruchsauslegung und Beschreibungsanpassung - wie weit darf man gehen?*, GRUR Patent 2023, 110; see

also T 367/20). Within the latter body of decisions, some have nevertheless pointed to limitations of the use of Article 69(1) EPC for interpreting the claims (see, e.g., T 544/89, point 3.1 of the Reasons: only features recited in a claim are open to interpretation; T 860/93, OJ EPO 1995, 47, point 5 of the Reasons: the description cannot be used to resolve contradictions; T 467/02, point 2.3 of the Reasons: the description can only be used for interpreting unamended granted claims, but not in examination; T 1473/19, point 3.16 and 3.16.1 of the Reasons: the description cannot be used to limit the subject-matter claimed). These limitations cast doubt on the purported link between Article 69 EPC and the examination of patentability, which is the main legal consideration underpinning the view that claims always have to be interpreted considering the whole disclosure in the description.

49. The question of whether it is appropriate to "interpret" the claims in the light of the description and drawings as provided in Article 69(1), second sentence, EPC, to establish whether the requirements for patentability, namely those of Article 84 EPC, have been met, was, and still is, debated (see the referral under Article 112 EPC in case T 439/22 pending as G 1/24). However, it appears that the debate is focussed on whether Article 69(1) EPC and Article 1 of the Protocol provide by analogy a general methodology for claim construction.

*VIII. No extensive interpretation of claims when assessing patentability*

50. While it has been argued above that it would be improper, when examining patentability, to limit the claimed subject-matter under consideration by way of

its interpretation considering the description, the claims could arguably be interpreted in line with the principles set out in the Protocol so as to extend the claimed subject-matter beyond the strict wording of the claims and to also include equivalent matter. The aim of such an approach would appear to be to avoid a wide discrepancy between the subject-matter under consideration when assessing patentability and infringement. Such a discrepancy arises if the wording of the claims is regarded as determinative in the case of patentability, leading to a narrow definition of the subject-matter, but further subject-matter is brought into the wording in infringement proceedings (which is sometimes referred to as the Angora cat phenomenon: see England and Wales Court of Appeal (Civil Division), *European Central Bank v Document Security Systems*, [2008] EWCA Civ 192, paragraph 5). Indeed, the view of the Court of Appeal of the Unified Patent Court that the determination of infringement and the assessment of nullity should be based on the same definition of the subject-matter (see Order, 26 February 2024, *NanoString Technologies Inc et al. v 10x Genomics, Inc. et al.*, UPC\_CoA\_335/2023, App\_576355/2023, Headnote 2) appears to aim to prevent a discrepancy between the subject-matter of the same patent in infringement and nullity proceedings (see Peter Meier-Beck, *Die Beurteilung des Rechtsbestands eines Patents durch das Einheitliche Patentgericht*, GRUR Patent 2024, 178, Nos. 29 and 31, who opines that a distinct approach to claim construction for patentability and infringement implies a split consciousness). To the extent that infringement and nullity of a European patent are dealt with in the same proceedings before a Local or Regional Division of the Unified Patent Court (Article 33 (3) (a) UPCA) or its Court of Appeal, the same understanding of the

claimed subject-matter under consideration is a matter of consistency.

51. However, the Board has reservations about interpreting claims in grant proceedings with the intention to determine the extent of protection with respect to possible infringing subject-matter, rather than to determine the contents and meaning of the claims independently of considerations of appropriate protection. This holds *a fortiori* if - by way of analogy with Article 2 of the Protocol - matter which falls outside of the meaning of a feature in the claim but is equivalent to that feature, is considered encompassed by the wording of the claims for consideration of patentability. There are different reasons.

The point of reference is different for patentability and infringement (see point 15. above). In proceedings concerning patentability, the subject-matter of the claim is assessed against the prior art (Articles 54 and 56 EPC), whereas in infringement proceedings the allegedly infringing subject-matter is juxtaposed with what is claimed in the patent (see G 1/98, OJ EPO 2000, 111, point 3.3 of the Reasons: "... *In order to exclude from patenting subject-matter which is not novel or inventive, all embodiments within the claims must be examined. In contrast, the question of infringement arises when a specific embodiment is alleged to be within the scope of the claimed invention. In this case, the features of the allegedly-infringing embodiment have to be compared with the features of the relevant claim according to the rules of interpretation applied by the Courts responsible for deciding on infringement cases. This may include examining whether a feature of the claim is realized in equivalent*



*form.*"). In infringement proceedings, unlike in grant proceedings, considerations of preventing a competitor from free-riding on the efforts of the patent proprietor will impact on the determination of a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties. Except where a court is competent to consider both infringement and validity of a patent in the same proceedings (which is, e.g., the case for the Local or Regional Division of the Unified Patent Court proceeding in accordance with Article 33(3)(a) UPCA, and the Court of Appeal of the Unified Patent Court), patentability and infringement are decided by different authorities, at different points in time, and on the basis of a different factual framework. It is therefore questionable whether the presumed purpose of a uniform determination of the subject-matter of claims for the purpose of deciding on patentability and infringement can be achieved when examining a patent application.

It is, moreover, difficult to see how the Protocol, namely its Article 2, should be implemented when examining Article 84 EPC and other provisions setting forth requirements for patentability, in particular Articles 54 and 56 EPC. Again, the definition in the claim would not match the subject-matter assessed for patentability. If equivalent matter which is neither claimed nor disclosed is included in the subject-matter claimed at the time and for the purpose of assessing patentability, this might result in a finding of lack of patentability based on a broader definition of the subject-matter as compared to the definition in the claims. Indeed, a specific feature in a claim could be given a more generic meaning under Article 69 EPC and the Protocol. This is inappropriate. The purpose of claim construction in grant proceedings is to identify

the subject-matter of the claims for comparing it with the (available) prior art, rather than anticipating infringement.

*IX. Conclusions on the relationship between Article 84 and Article 69 EPC*

52. The following **conclusions** follow from the above discussion:

- (a) In proceedings before the EPO, the extent of protection conferred by a patent is only relevant to the assessment of Article 123(3) EPC in post-grant proceedings.
- (b) The assessment of clarity and of support of the claimed subject-matter by the description before grant of a patent is a matter distinct from determining the extent of protection conferred by granted claims after grant. It is the purpose of the assessment of Article 84 EPC as part of the examination of patentability to arrive at a definition of the patentable subject-matter in terms of distinctive technical features distinguishing it from the prior art.
- (c) Article 69(1) EPC and the Protocol are not concerned with the definition of the subject-matter according to Article 84, first sentence, EPC. Instead they are concerned with the post-grant effects of a patent in the Contracting States. Their purpose is to prevent the protection conferred by a patent being limited to "literal infringement" relying on a narrow construction of the claims in a patent.

- (d) Article 69 EPC and the Protocol are not concerned with the "interpretation" of claims in the sense of claim construction, i.e. determining the meaning of the terms of a claim and its subject-matter for the purpose of assessing patentability. These provisions do not therefore provide a general methodology for determining the subject-matter claimed for assessing patentability in examination.
- (e) Relying on the description to resolve ambiguities or contradictions in claims of an application before assessing their compliance with clarity and support requirements under Article 84 EPC deprives claims of their function as defined by Article 84, first sentence, EPC, and affects the assessment of Article 84 EPC and further requirements for patentability.
- (f) It is not the purpose of the examination of European patent applications to anticipate equivalent matter potentially relevant to infringement. Construing claims in a way that extends the subject-matter claimed beyond the strict wording of the claims when assessing patentability distorts this assessment.
- (g) The meaning of the claims put forward by an applicant has to be understood before assessing compliance with the requirements for patentability of the EPC. The finding of lack of clarity is a potential result of such construction, not a condition for claim construction. Since granted claims have the character of a legal norm rather than that of a contractual clause, claims should be construed objectively (not subjectively) based on the usual technical understanding of the features

in the context of the claim as a whole (see T 10/22, point 2.3 of the Reasons: "... when it comes to claim construction, the often used reference to 'a mind willing to understand' is about relying on 'a mind willing to objectively construe a claim' (which from the outset excludes illogical or technically nonsensical interpretations to avoid 'a mind desirous of misunderstanding' as invoked in T 190/99), rather than 'a mind willing to understand the applicant's or patent proprietor's alleged intention'."). The description provides the overall context and, more importantly, the disclosure which supports the subject-matter claimed and forms its basis under Articles 83 and 123(2) EPC. Nevertheless, the understanding of the disclosure should not replace or add to the definition of the subject-matter in the claims by way of implicit features, but allow for a definition of patentable subject-matter in the claims.

- (h) In summary, Article 84 EPC is not mutually complementary or subordinate to Article 69(1) EPC and the Protocol. Article 69(1) EPC and the Protocol are therefore not to be applied in examination (explicitly T 56/04, point 2.12 of the Reasons; see also T 1129/97, OJ EPO 2001, 273, point 2.1.3 of the Reasons; T 488/99, point 3.2.1 of the Reasons; T 1279/04, point 3 of the Reasons; T 223/05, point 3.5 of the Reasons; T 1825/09, point 3 of the Reasons; T 2319/11, point 1.4 of the Reasons; T 1009/12, point 2.4 of the Reasons; T 2601/16, point 2.3.3. of the Reasons).

**D. Article 84 EPC - Interpretation of the requirement of support by the description**

*I. Title and wording*

53. It follows from the title and wording of Article 84 EPC that this article states a requirement in respect of the claims and not of the description. This is confirmed by the phrase that the claims must be supported by the description. Indeed, it is the definition in the claims of the matter for which protection is sought that needs support. This means that the subject-matter of a claim must be taken from the description, and that it is not admissible to claim subject-matter which is not described. Thus, the ordinary meaning of the words does not support a requirement to bring the description into agreement with claims intended for grant by deleting or disclaiming subject-matter in the description which is not claimed.

*II. Legislative history*

54. The legislative history of the EPC 1973 offers little evidence on the legislative intent (or of the aim or purpose) of the requirement for the claims to be supported by the description. (For background information on the legislative history of Article 84 EPC 1973 see document CA/PL 12/95, points 6 to 12.)

55. The implementing provision No. 4 to Article 68 of the Convention, third paragraph, second sentence of the first draft of the Implementing Regulations to the Convention relating to a European Patent Law ("Haertel draft" of March 1963), which stipulates the requirements as to the form and contents of the claims,

might be seen as a precursor to the requirement of support of the claims. This provision read as follows: "... Die Patentansprüche müssen mit der Beschreibung und mit den Zeichnungen **im Einklang** stehen." The provision can be translated as follows: The claims are required to be **in agreement with** the description and drawings. It should be noted that, according to Article 68(1)(b) together with Article 70(2) of the European Community draft concerning a European patent law of June 1962, the claims were at that time not a separate part of the application, but part of the description. The wording was intended to address the concern that the claims might include subject-matter which is not included in the description, and not the other way round (see Results of the ninth meeting of the "Patents" working group, which took place in Munich from 1 to 12 July 1963, 7669/IV/63, page 7 and 8). Hence, this is in line with the literal interpretation of the requirement of support by the description in Article 84 EPC.

56. In 1970, the Haertel draft was aligned with Article 6 PCT (see Article 66 of the preliminary draft of Implementing Regulations to a Convention Establishing a European System for the Grant of Patents of 1970, BR/50/70).

Article 6 PCT read (and still reads) as follows:

"The Claims

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be **fully** supported by the description."

(Emphasis added by the Board).

In the second preliminary draft of a Convention Establishing a European System for the Grant of Patents of 1972, the word "fully" in the phrase "fully supported by the description" was deleted from Article 71a, which related to the purpose, form, and content of the claims, as it was perceived to be too restrictive (see BR/169/72, point 72, BR/168/72, point 92 and BR/177/72, point 42). The provision was thus given the wording that Article 84 EPC has today (apart from minor editorial changes in the German text of the revised EPC).

57. The notes on Article 6, third sentence, PCT, which are part of the documentation of the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty 1970, discuss the relationship between the drawings and the description in respect of the requirement of support of the claims by the description. They address the situation where drawings are necessary to express certain "features of the disclosure" because these features cannot, as a practical matter, be described in words, and where it is hence necessary, for the purpose of disclosure of the invention, to consider the description together with the drawings. According to the notes, the claims are nevertheless "fully supported by the description" in such a situation and the drawings are to be considered "incorporated by reference in the description."

The concern addressed is that the phrase "fully supported by the description" could be interpreted in a restrictive manner excluding drawings. However, no further guidance on Article 6, third sentence, PCT is given. Also, the further materials do not provide

information on the criterion of support by the description.

58. Overall, while the legislative history does not shed light on the requirement of support of the claims by the description, it does not contradict the literal interpretation either.

*III. Decisions of the Boards of Appeal*

59. The prerequisite of support by the description was held to require that the definition of the subject-matter for which protection is sought in the claims correspond to and be consistent with the description.

60. The first aspect (i.e. that the claims correspond to the description) requires that the claimed subject-matter be **drawn from the description** and that nothing be claimed which is not disclosed in the description (T 26/81, OJ EPO 1982, 211, point 4 of the Reasons; T 409/91, OJ EPO 1994, 653, point 3.3 of the Reasons; T 1129/97, OJ EPO 2001, 273, point 2.2 of the Reasons; see also Case Law of the Boards of Appeal of the European Patent Office 1987-1992, II.B.3).

61. The second aspect (i.e. that the claims are consistent with the description) requires that all the features described in the description as being necessary to carry out the invention (**essential features**) be present in a corresponding claim (T 133/85, OJ EPO 1988, 441, headnote 1 and point 2 of the Reasons; T 888/90, OJ EPO 1994, 162, point 3.1 of the Reasons; T 1055/92, OJ EPO 1995, 214, point 5 of the Reasons; T 939/92, OJ EPO 1996, 309, point 2.2.2 of the Reasons; T 409/91, OJ EPO 1994, 653, point 3.3 of the Reasons, the latter referring to decision T 32/82, OJ EPO 1984, 354,



regarding clarity of the claims; T 1129/97, OJ EPO 2001, 273, point 2.2 of the Reasons). See, however, point 68. below regarding decisions basing the requirement to include all essential features on the requirement for clarity or on the first sentence of Article 84 EPC.

62. Decision T 26/81 further required the claims not to cover subject-matter which, after the reading of the description, would still not be at the disposal of the skilled person (T 26/81, OJ EPO 1982, 211, point 4 of the Reasons). In other words, the claims must be **commensurate** with the description, i.e. their subject-matter must be justified by the extent of the disclosure in the description. Similarly, in case T 133/85 it was held that the extent of the patent monopoly, as defined by the claims, should correspond to the technical contribution to the art for it to be supported or justified (T 133/85, OJ EPO 1988, 441, point 5 of the Reasons). Both decisions T 26/81 and T 133/85 thus required that, as part of the assessment of support of the claims under Article 84 EPC 1973, the permissible extent of generalisation from the description to the claims be determined.
63. The assessment of the **permissible extent of generalisation** in claims when examining the support of the claims by the description brought in the **policy consideration** of a fair balance between the abstract definition of what is claimed on the one hand and what is "made available" to the public as the "invention" in the description on the other hand. The balance sought is between the contribution to the art provided by the disclosure in the description and the breadth of the claims, in particular when using functional terminology. This assessment gave rise to a debate on

the proper delimitation of the assessment of support by the description, sufficiency of disclosure and inventive step (as for the relationship between the requirements of Articles 83 and 84 EPC 1973, see T 301/87, OJ EPO 1990, 335, points 3.1 to 3.3 of the Reasons; T 409/91, OJ EPO 1994, 653, point 3.5 of the Reasons; T 435/91, OJ EPO 1995, 188, points 2.2.1 and 2.2.2 of the Reasons; followed in later decisions, see, *inter alia*, T 923/92, OJ EPO 1996, 564, points 22 and 27 of the Reasons; T 939/92, OJ EPO 1996, 309, point 2.2.2 of the Reasons; as for the relationship between the required support of the claims by the description and other requirements for patentability see T 626/91, point 3.1 of the Reasons; T 1055/92, OJ EPO 1995, 214, point 4 of the Reasons; T 939/92, OJ EPO 1996, 309, points 2.4.2 and 2.4.3 of the Reasons; T 694/92, OJ EPO 1997, 408, points 3 to 8 of the Reasons). For the present discussion it is sufficient to note that these decisions confirmed that Article 84 EPC required **overly broad claims** to be **brought into line with the disclosure** in the description by way of **limiting the subject-matter claimed**.

***E. Article 84 EPC - Interpretation of the requirement of clarity***

*I. Title and wording*

64. According to the title and wording of Article 84 EPC, the requirements of clarity and conciseness are stated in respect of the claims and not of the description (see point 16. above regarding clarity and completeness of the description). Thus, claims must be clear *per se*, which means that the terms used to define the matter for which protection is sought must be intelligible and free of contradiction.

65. Rule 43(6) EPC confirms that claims should be clear in themselves. Specifically, claims may rely on references to the description or drawings only where necessary. Thus, exceptionally, an applicant may resort to references to the description to define the matter for which protection is sought. Similarly, Rule 43(7) EPC provides that reference signs in drawings may be used in the claims if the intelligibility of a claim can thereby be increased. However, these reference signs are not to be construed as limiting the claim.

*II. Legal history*

66. The legal history of Article 84 EPC (see above point 54.) does not provide a better or different understanding of the requirement of clarity (and conciseness). Reference can be made to Article 6 and Rule 6 PCT as adopted at the Washington Diplomatic Conference 1970, with which the text of the EPC was aligned.

*III. Decisions of the Boards of Appeal*

67. As regards the interpretation of the requirement of clarity by the Boards of Appeal, it was held in one of the very first decisions that **the claims per se must be free of contradiction. It must be possible to understand the claims without reference to the description** (T 2/80 OJ EPO 1981, 431, point 2 of the Reasons). This principle was confirmed in many later decisions: see T 454/89, point 4.1 of the Reasons; T 760/90, point 2.2 of the Reasons; T 1129/97, OJ EPO 2001, 273, point 2.1.2 of the Reasons; T 488/99, point 3.2.1 of the Reasons; T 49/99, point 12 of the Reasons; T 988/02, point 3.3.1 of the Reasons; T 56/04, points

2.7 and 2.12 of the Reasons; T 725/08, point 6.5 of the Reasons; T 786/16, point 1.5 of the Reasons; T 624/17, point 6.1 of the Reasons; T 663/18, point 1.4.2 of the Reasons; T 515/19, point 1.1 of the Reasons; see also G 1/04, OJ EPO 2006, 334, point 6.2 of the Reasons). As to the diverging decisions see points 48. *et seq* above.

68. In T 32/82 (OJ EPO 1984, 354, point 15 of the Reasons) it was stated that the requirement of clarity in Article 84 EPC had to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must clearly define the object of the invention, i.e. **indicate all the essential features** thereof. This decision was confirmed in many later decisions (see, e.g., T 283/84, point 3.2 of the Reasons; T 132/82, point 3 of the Reasons; T 622/90, point 2 of the Reasons; T 307/92, points 1 and 4 of the Reasons). Although many decisions have regarded the omission of essential features in a claim as infringing Article 84 EPC, some decisions have held such lack of essential features to result in a lack of support (see point 61. above) while other decisions have invoked Article 84, first sentence, EPC (see T 115/83, point 4 of the Reasons; T 68/85, point 8.2 of the Reasons; T 409/91, OJ EPO 1994, 653, point 3.2 of the Reasons; T 488/96, point 3 of the Reasons, all these decisions also relied on Rule 29(1) EPC 1973). However, this is not relevant to the present decision.

**F. Decisions of the Boards of Appeal on the adaptation of the description**

*I. Early decisions of the Boards of Appeal*

69. The requirement for the description of an application or a patent to be adapted to claims of restricted subject-matter before grant or maintenance of a patent appears to have its origin in the **policy consideration** of ensuring a reasonable degree of certainty for third parties in determining the extent of protection as set forth in the **Protocol** 1973. Since, according to Article 69 EPC 1973, the extent of protection conferred by the patent is to be determined in cases of infringement by (the terms of) the claims, which have to be interpreted considering the description and the drawings, several decisions reasoned that the subject-matter claimed not only had to be justified by the actual technical contribution to the state of the art as disclosed in the description, but that the description also had to be brought into line with amended claims considered allowable (T 11/82, OJ EPO 1983, 479, points 5, 16 and 25 of the Reasons; T 13/84, OJ EPO 1986, 253, point 20 of the Reasons; both decisions relied, moreover, on Rule 27(1)(c) and (d) EPC 1973; see also T 150/85, point 4 of the Reasons, concluding, however, in point 5 that the examples did not correspond to the claims, which were held not to be supported by the description). These decisions therefore ascribed the **aim of ensuring legal certainty for third parties about the extent of protection** (referred to as "scope of protection" or "scope of the claims" in many decisions) to Article 84 EPC. However, it is not entirely clear from these decisions whether a possible uncertainty arising from the lack of complete agreement between the description and the claims was

seen as resulting in a lack of clarity or a lack of support of the amended claims contrary to Article 84 EPC.

70. Without citing the above cases, their rationale was followed by Board 3.3.01 in several cases (T 273/90, T 113/92, T 996/92, T 229/93). Apart from T 229/93, these cases concern appeals in opposition on the issue of adaptation of the description.

(a) In case T 273/90, the opponent requested that the description of the contested patent be adapted "completely" to the amended claims. The opponent argued that a description, which was not brought completely into line with the amended claims, would give rise to legal uncertainty as to the scope of protection and therefore result in claims which infringed Article 84 EPC 1973 (T 273/90, point III of the Facts and Submissions). The Board found itself in agreement with the appellant/opponent on the point of law (T 273/90, point 1 of the Reasons). In its reasons, the Board referred to a "**possible remaining presence of legal uncertainty in the construction of the claims (Article 84 EPC)**".

(b) The same approach was taken in case T 113/92 (see point 2 of the Reasons). The Board held that **legal certainty** required the description to be adapted **where a patent had been limited by amendment of the claims**. Any information which no longer explained the limited subject-matter of the patent, and which was not necessary or useful for understanding the invention, had to be removed from the description.

(c) In case T 996/92, Board 3.3.01 confirmed its previous decisions and required, for reason of **legal certainty regarding the scope of the claims**, that the description be brought into "complete agreement" with the amended claims (T 996/92, point 1 of the Reasons).

(d) In decision T 229/93 concerning a **refusal by the examining division**, Board 3.3.01 confirmed its approach of bringing the description fully into line with the scope of amended claims and explicitly relied on Article 84, second sentence, EPC 1973 (see point 5 of the Reasons).

71. Independently of the above practice in Board 3.3.01, the need for an adaptation of the description to amended claims was addressed in decision T 757/91, which concerned the second appeal in opposition after remittal of the case for adaptation of the description. The Board rebutted the proprietor's argument that there was no basis in the EPC for requiring an adaptation of the description to the wording of amended claims and referred to the requirement of support of the claims under Article 84 EPC 1973 (T 757/91, point 2.2 of the Reasons). However, no reasons for this interpretation of Article 84 EPC were given. It is noteworthy that the decision also discussed Rules 27 and 34(1)(b) EPC 1973 (Rules 42 and 48(1)(b) EPC) concerning the content of the description and prohibited matter, respectively.

72. Some of the above decisions were followed in decisions T 1063/92, T 636/97, and T 1079/96.

(a) Decision T 1063/92 concerned a second appeal in opposition after remittal of the case by the Board. The decision mainly deals with the binding effect

under Article 111(2) EPC 1973. It concludes that **the Board was only competent for the adaptation of the description "supporting" the amended claims** (points 2.4 and 3 of the Reasons). The Board also addressed a possible way to reduce the likelihood of a "ping-pong" effect between the Boards of Appeal and the opposition divisions in a situation of remittal of the case for adaptation of the description (see points 4.1. and 4.2 of the Reasons).

- (b) In T 636/97, which concerned a second appeal in opposition, the Board stated, "that **the adaptation of the description must follow the dictates of legal certainty**; that is, the restriction has to be taken into account by deleting all statements which do not relate to the now more limited subject-matter of the patent, and which are not necessary or useful for understanding the invention." (see T 636/97, point 3.1 of the Reasons; emphasis added by the Board; see, however, also points 3.2 and 3.3 of the Reasons).
- (c) Likewise, the Board in case T 1079/96 followed the above decisions in an appeal by the opponent against an interlocutory decision on the ground that the opposition division had failed to hear the parties on the need to adapt the description (see point VII of the Facts and Submissions). Contrary to the patent proprietor's view that it was neither appropriate nor necessary to adapt the description to the amended claims (see point VIII of the Facts and Submissions), the Board held that **Article 84 EPC 1973 required the description to be in agreement with the amended claims**, and that the opposition division had committed a substantial



procedural violation by deciding on the allowability of the patent in a form infringing Article 84 EPC without giving the opponent the opportunity to comment on the form of the amended patent, as required by Rule 58(4) EPC 1973 (see points IX and XII of the Facts and Submissions, and points 1 and 5 of the Reasons).

73. In T 977/94, the Board inferred from the requirement for support of the claims by the description that an invention could only be claimed in so far as it was based on the description. The Board furthermore held that the description consisted of a statement of the constituent elements of the invention, whereas the purpose of the claims was to define, in a concise manner, those same constituent elements of the invention. Consequently, it had to be ensured that there was **identity of invention between amended claims and the description**, i.e. that the constituent elements of the claimed invention were also described as such in the description. Hence, it appears that the Board derived from Articles 84 and 69 EPC that the "invention as described" had to match the "invention as claimed", which required an adaptation of the description to claims defining a more restricted invention.
74. A noteworthy decision is T 1149/97, OJ EPO 2000, 259, which concerned an appeal in opposition. The patent proprietor inserted limiting features into the claims based on subject-matter in the application as filed, which had, however, been deleted from the description before grant or was indicated therein as no longer belonging to the claimed invention. The Board considered the issue of whether such deletions or indications reduced the original disclosure to the subject-matter retained in the patent specification,

preventing any subsequent **reinstatement of the subject-matter "abandoned" before grant**. Relying on decision T 977/94, the Board held that adapting the description (and the drawings) to the wording of amended claims intended for grant was fundamental under Articles 84 and 69 EPC to establish consistency between the claimed invention and its description having regard to the support and extent of protection. Therefore, reinstatement of subject-matter which in view of Articles 84 and 69 EPC had been deleted or indicated as no longer relating to the invention before grant to avoid inconsistencies in the patent specification, was held, as a rule, not to be admissible under Article 123(3) EPC after grant.

*II. Discussion of and conclusions on the early decisions of the Boards of Appeal*

75. In the above decisions, both clarity of the claims and their support by the description within the meaning of Article 84 EPC were relied on as a legal basis for requiring the description to be adapted to match the subject-matter of the claims. Two main reasons were put forward to justify this requirement under Article 84 EPC: the policy consideration of ensuring **legal certainty for third parties about the extent of protection conferred to a granted European patent** in accordance with Article 69 EPC, and the **common function of the claims and the description to define the "invention" in a European patent**. These justifications misconstrue the relationship between Articles 84 and 69 EPC as intended by the legislator and understood by the Enlarged Board of Appeal, as well as the relationship between the claims and the description, as will be set out below (see also the discussion in section C, in particular points 33. et seq, 36. et seq, and 52.).

76. The policy consideration of ensuring legal certainty for third parties about the extent of protection links, and even subordinates, the assessment of Article 84 EPC (and patentability) to the determination of the extent of protection according to Article 69 EPC. As discussed above (see sections B and C, in particular points 26. and 52.), Article 69 EPC and the Protocol are not concerned with grant proceedings before the EPO. The addressee is the national authorities entrusted with the enforcement of patents. Conformity with the requirements for the grant or the maintenance of a patent in proceedings before the EPO (with the sole exception of Article 123(3) EPC) is to be assessed separately and independently of Article 69 EPC and the Protocol. This follows from the rationale of G 1/93 (OJ EPO 1994, 541, point 10 of the Reasons) and the explicit statement in G 2/12 (OJ EPO 2016, A27, point VIII.2.(6)(b), 4th paragraph, of the Reasons). Also, decision G 3/14 (OJ EPO 2015, A102, points 57 to 59 of the Reasons) deals with Article 69 EPC and the Protocol only in the context of national proceedings after grant of a European patent. The distinction between extent of protection and patentability was also made in many decisions (see T 1279/04, point 3 of the Reasons; T 223/05, point 3.5 of the Reasons; T 1404/05, point 3.6 of the Reasons; these decisions were followed in many other decisions). While the decisions of the Boards of Appeal evolved as regards the relationship between Article 84 EPC and Article 69 EPC in the context of claim interpretation (see point 44. above), adapting the description to amended claims of restricted subject-matter appears to have remained a habit rather than a duly contemplated practice. However, the relationship between the description and the claims as well as between Articles 84 and 69 EPC

cannot be viewed differently in the context of claim interpretation and in the context of adaptation of the description. This is due to the fact that Article 84 EPC sets out requirements to be met by the claims and not by the description. Inconsistencies between the claims and the description, which are argued to potentially cast doubt on the extent of protection conferred by the patent, can only be seen as encompassed by the requirements for support or clarity if the definition of the matter for which protection is sought can be derived both from the claims and from the description (the "disclosure"), applying Article 69(1), second sentence, EPC. Thus, if Article 84 EPC cannot be regarded as linked or subordinate to Article 69(1) EPC and the Protocol, as is the reasoned view taken by the present Board, Article 84 EPC on its own does not provide a legal basis for a mandatory adaptation of the description to the more limited subject-matter claimed. In this regard, the Board disagrees with decision T 1808/06 (see point 2 of the Reasons), which did not explain why the requirement of support of the claims by the description pursuant to Article 84 EPC could be interpreted as requiring **consistency** between the subject-matter claimed and the disclosure in the description independently of Article 69(1) EPC.

77. The reference to the different functions of claims under Articles 84 and 69 EPC in decisions G 2/88 and G 6/88 (see G 2/88 OJ EPO 1990, 93 and 469, points 2.5 and 7 of the Reasons; G 6/88, OJ EPO 1990, 114, points 2.5 and 7 of the Reasons) may have given rise to the policy consideration of ensuring legal certainty for third parties about the extent of protection. However, decisions G 2/88 and G 6/88 point, first and foremost, to the need for a clear definition of the subject-matter claimed in view of the pivotal role of this

definition in the determination of the protection of the claimed invention in the Contracting States. As set out in point 33. above also with reference to decision T 1129/97 (OJ EPO 2001, 273, points 2.1.2 and 2.1.3), the Board agrees that a clear and concise definition of the subject-matter claimed as required by Article 84, second sentence, EPC, is of importance in view of the second function of the claims, which is to give third parties notice of the features and characteristics of the subject-matter falling under the right of exclusivity thus demarcating the "forbidden area". This second function makes claims comparable to a legal provision (see point 14. above). Legal certainty for third parties requires that claims be understood without having to resort to the description (see G 1/04, OJ EPO 2006, 334, point 6.2 of the Reasons). Ambiguous or vague features in claims are to the detriment of legal certainty as they blur the boundaries of the forbidden area. Since clarity is a claim requirement, a clarity deficiency in a claim should be removed by way of amendment of its wording, and not by seeking to understand the technical subject-matter, which the claim possibly defines, considering the description (see, e.g., T 49/99, point 12 of the Reasons).

While it is accepted by this Board that a clear definition of the subject-matter in the claims is a prerequisite for determining the extent of protection conferred by a patent, this does not provide a rationale for adapting the description to match the subject-matter claimed. Evidently, adapting the description to unclear claims would fail to provide the required legal certainty. However, requiring that a description be adapted to clear claims would likewise fail to improve legal certainty about the extent of

protection of a granted patent under Article 69(1) EPC, since the Protocol was intended to avoid extremes in the interpretation and application of Article 69(1) EPC 1973 rather than to achieve uniformity (see G 2/88, OJ EPO 1990, 93 and 469, point 2.1. and 4 of the Reasons). By requiring the description to match the subject-matter of the claims, the EPO and the Boards of Appeal may have attempted to **reduce the variability in the determination of the extent of protection of a patent by the national courts of the Contracting States** under Article 69(1) EPC and the Protocol, and to arrive at a more "harmonised" determination of the extent of protection of granted patents. However, this encroaches on the competence of both the national courts and the legislator(s) (see T 712/10, point 8.2 of the Reasons; point 103. below).

78. The decisions discussed in point F.I. may also have sought to address the concern that the description could be used under Article 69(1) EPC and the Protocol to **extend the protection conferred** by a granted patent by **including subject-matter which is not claimed but disclosed**. However, according to Article 69(1) EPC and Article 1 of the Protocol, the description may only be taken into consideration in determining the extent of protection of a patent in so far as it refers to a part or element of a claim. Matter disclosed in the description which is not linked to a part or element of a claim, is not to be considered (G 1/93, OJ EPO 1994, 541, point 14 of the Reasons; see German Federal Court of Justice, 10 May 2011, X ZR 16/09, BGHZ 189, 330, headnote a); German Federal Court of Justice, 14 June 2016, X ZR 29/15, BGHZ 211, 1, headnote a)). In other words, while Article 69 EPC and the Protocol assist a patent proprietor in contending for a broader protection than may be warranted by the literal meaning

of the claim, these provisions do not provide for an extension of the protection beyond what is claimed by way of technical features. Thus, accepting the determinative role of the claims as enshrined in Article 69(1), first sentence, EPC, a discrepancy in extent of protection should not normally arise in a situation where the description discloses additional subject-matter which is not encompassed by the claims, in particular in embodiments, examples or claim-like clauses disclosed in the description which do not come under the definition of the subject-matter claimed (see, e.g., German Federal Court of Justice, 10 May 2011, X ZR 16/09, BGHZ 189, 330; German Federal Court of Justice, 14 June 2016, X ZR 29/15, BGHZ 211, 1; see also T 507/16, point 1.4.4 of the Reasons).

79. On the other hand, according to Article 2 of the Protocol, in determining the extent of protection conferred by a European patent, national courts are to take due account of any element which is equivalent to an element specified in the claims. The legislator thus appears to have accepted that the protection conferred by a patent includes equivalent matter even if such matter is neither claimed nor described. Therefore, if equivalent elements disclosed in an application are removed from the description in examination because they are no longer encompassed by the subject-matter of the claims intended for grant, they could nevertheless extend the protection conferred unless the patent proprietor is barred by a prosecution history estoppel. An example showing the relevance of (undisclosed) equivalent matter is the litigation concerning pemetrexed. The claims of European patent EP 1 313 508 were directed to the disodium salt of pemetrexed ((2S)-2-[[4-[2-(2-amino-4-oxo-3,7-dihydropyrrolo[2,3-

d]pyrimidin-5-yl)ethyl]benzoyl]amino]pentanedioic acid) in combination with vitamin B12 for use in the treatment of cancer. Several national courts found generic products using a different form of pemetrexed to be (obvious) variants to the claimed disodium salt and hence to infringe the patent by equivalence (see, e.g., UK Supreme Court, *Actavis UK Ltd & Ors v Eli Lilly*, [2017] UKSC 48; German Federal Court of Justice, 14 June 2016, X ZR 29/15, BGHZ 211, 1; Swiss Federal Supreme Court, 20 October 2017, 4A\_208/2017, BGE 143 III 666 [also dealing with the issue of a prosecution history estoppel]). None of these variants held to be infringing came under the unambiguous structural definition of the patent claims, and nor had such variants been disclosed and discussed in the application as filed or the patent as granted. This illustrates that the striking of the balance between fair protection for the patent proprietor and a reasonable degree of legal certainty for third parties is a matter for national courts in infringement proceedings and not for the EPO.

80. An issue could nevertheless arise if the description **defines a term** in a claim more broadly than how the term would be understood in the associated technical field (e.g. if the claim is directed to an "tagged protein" and the description contains a definition of this feature which includes proteins without tags). Despite this discrepancy between the narrow understanding of the term in the claim and the broad definition in the description, the assessment of the requirements for the grant or the maintenance of a patent could be based on the clear but narrower meaning of the term in the claim. Indeed, according to a number of decisions, the description cannot be used to interpret a term used in a claim, which has a clear



technical meaning, i.e. the meaning usually understood by the skilled reader, to give this term a different meaning (see, e.g., T 1018/02, point 3.8 of the Reasons; T 197/10, headnote and point 2.3 of the Reasons; T 2221/10, point 33 of the Reasons; T 1691/11, point 1.3 of the Reasons; T 30/17, point 2.1.10 of the Reasons; T 1395/07, point 4 of the Reasons). Accordingly, the examination of the requirements for the grant or the maintenance of a patent based on the unambiguous but narrow understanding of a term in a claim could lead to a patent which, in case of infringement, is possibly given an extent of protection exceeding the limitations implied by the clear terms of the claims, and is thus to the detriment of persons on whom the claims will be imposed. This consequence gives rise to the question of whether, exceptionally, a broad definition of a term in the description, which is not in line with the skilled person's narrower understanding, should be objectionable, thus giving rise to an amendment of the description in examination. Rule 49(2) EPC together with Article 2(10) of the Decision of the President of the European Patent Office dated 25 November 2022 on the presentation of application and other documents (OJ EPO 2022, A113; see Rule 35(13) EPC 1973), which requires the terminology to be consistent throughout the European patent application, provide the legal basis for objecting to such inconsistency in terminology (see T 841/97, point 2.1 of the Reasons; T 2355/09, point 5 of the Reasons). However, there is no need to reach a conclusion on this question since a discrepancy in the definition of a term is not at issue in the present appeal.

81. The possible impediment to reinstating matter deleted in the course of aligning the description with allowable claims before grant, as exemplified by

decision T 1149/97 (OJ EPO 2000, 259), cannot be seen as a reasonable result of an interpretation of Article 84 EPC (even assuming that this decision did not establish a strict rule under Article 123(3) EPC as suggested by decision T 241/02, points 2.3.5 and 2.3.6). A similar concern exists as regards nullity proceedings having regard to Article 138(1)(d) EPC. Also, possible implications by a "prosecution history estoppel" caution against the practice of adapting the description in examination to match the subject-matter claimed. The divergent legal situation at national level was discussed during the revision of the EPC without, however, resulting in a harmonised approach by amendment of Article 69 EPC or the Protocol (for further developments, see point 103. below). Thus, non-voluntary adaptations of the description before grant might have different consequences in different Contracting States, which additionally has a deterrent effect. It should also be noted that deletions in the description could become an issue when adapting the description for the maintenance of the patent in amended form (see, e.g., T 142/05, headnote and points 3 to 5 of the Reasons; T 1147/11, points 5.1 to 5.5 of the Reasons; T 1360/13, points 4.2 and 4.9 of the Reasons; T 953/22, points 3.1 and 3.2 of the Reasons).

82. As a further argument for adapting the description in examination, it was put forward that the description and the claims had necessarily to provide the same definition of the invention for which protection is sought or granted. However, requiring identity of invention between amended claims and the description would ascribe the same function, that of defining the invention, to both the description and the claims. This is contrary to Article 84, first sentence, EPC, and Rule 43(1) EPC, which provide for an abstract

definition of the term "invention", equating it to the invention as defined in the claims in terms of technical features, rather than to subject-matter derived from the entire contents of the application documents. Moreover, while the requirement of support of the claims by the description according to Article 84, second sentence, EPC, ensures that subject-matter can only be claimed in so far as this subject-matter is also disclosed in the description, Article 84 EPC does not preclude the inclusion, in the description, of subject-matter which is not claimed. Otherwise, subject-matter without correspondence in a claim would have to be removed to conform with Article 84 EPC, and the patent could consequently only be limited, if necessary, by combining claims. Finally, the view that it is the common function of the claims and the description to define the "invention" in a European patent, gives patent claims the status of a summary without binding character, as provided for in French law in 1955 (see "Gajac Report", Étude comparative du droit matériel en vigueur dans les pays représentés au comité d'experts, présentée par le Secrétariat Général, Committee of Experts on Patents, Council of Europe, 12 January 1955, EXP/Brev (53) 18 rev., page 41, section D.2). This is not in line with the determinative role of the claims under Article 69(1), first sentence, EPC, Article 1, second sentence of the Protocol, as well as the Strasbourg Convention.

83. Overall, the early decisions of the Boards of Appeal requiring a description to be adapted to claims of restricted subject-matter in examination hinge on a legal link between Articles 84 and 69 EPC. However, no convincing or stringent rationale has been put forward that could justify such a link:

- (a) Article 69 EPC and its Protocol address the extent of protection in the context of national proceedings after the grant of a European patent. The proceedings before the EPO are separate and independent of Article 69 EPC.
- (b) The claims, rather than the description, are the primary determinant of the extent of protection. Legal certainty for third parties regarding the extent of protection of a patent is best served by claims which are clear and concise such that they allow the "forbidden area" to be demarcated without needing to resort to the description.
- (c) Adapting the description to match the more limited subject-matter claimed does not improve legal certainty regarding the extent of protection, may have unwarranted consequences in post-grant proceedings and may encroach on the competence of national courts and legislators.
- (d) If the description defines a term more broadly than its technical meaning in the claim, such a discrepancy in terminology should be addressed under Rule 49(2) EPC by amending the description to match the clear but narrower meaning of the term in the claim.

*III. Recent decisions of the Boards of Appeal*

84. The Board refers to the detailed discussion and analysis of the relevant recent decisions by Kemal Bengi-Akyürek (Anspruchsauslegung und Beschreibungsanpassung - wie weit darf man gehen?, GRUR Patent 2023, 110). Among the decisions discussed in

this article, T 1989/18, T 2194/19, T 3097/19, T 1444/20 concern *ex parte* proceedings dealing with the adaptation of the description under consideration. The Board will address T 2194/19, T 3097/19, and T 438/22. The Board is, of course, aware of further decisions in opposition appeal proceedings on this issue, most of which were also addressed in the above-mentioned article (see, *inter alia*, T 2766/17, T 1024/18, T 121/20, T 2293/18, T 1516/20, T 1473/19, T 169/20, T 447/22). However, it is not necessary for the present decision to answer the question of whether and, if so, for which reason a different conclusion may be warranted in opposition proceedings as compared to appeals in examination.

85. Decision **T 2194/19** concerns an appeal against the decision of the examining division to refuse the application for lack of compliance with Articles 123(2) and 84 EPC and Rule 42(1)(c) EPC. The examining division had concluded that the adapted description 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 described subject-matter that was not part of the subject-matter of these independent claims. Moreover, the examining division had held that the "invention" must always be the "invention claimed" and that the "invention" was defined by the independent claims. The applicant had filed an appeal against the decision of the examining division. The Board did not endorse the examining division's objection, for reasons to be discussed. Firstly, the Board was not convinced that, according to the EPC, the "invention" was necessarily and always to be equated to the "invention claimed" (see T 944/15). Secondly, the Board disagreed with the conclusion that the requirement for the claims to be supported by the

description (Article 84, second sentence, EPC) necessarily meant that all the "embodiments" of the description of a patent application had to be covered by the (independent) claims, i.e. that all the embodiments must be encompassed by the claims. This conclusion could not be derived from the EPC. It could also not be derived from the decisions of the Boards of Appeal, according to which merely inconsistencies or contradictions between the claims and the underlying description were to be avoided in that context (T 1808/06, T 2293/18). The Board considered 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. However, this would have to be justified by the examining division. The mere indication that the embodiment does not fall or no longer falls under the respective claim(s) is not sufficient in this regard. Thirdly, the Board considered that Rule 42(1)(c) EPC could not be the legal basis for establishing such a general and broad requirement for an adaptation of the description to the claims. The requirements set out in Rule 42(1)(c) EPC could not be taken to mean that all the embodiments described in the description of a patent application have to be encompassed by the claims. Hence, the Board concluded that the objection raised by the examining division was unfounded.

86. Decision **T 3097/19** concerns the decision of an examining division in examination proceedings to refuse the application for lack of compliance with Articles 83, 84 and 56 EPC. According to the Board, the purpose of the claims to define the matter for which protection is sought placed requirements upon the application as a whole, in addition to the express requirements for the claims to be clear, concise, and supported by the

description. The Board deemed it to be an elementary requirement of a patent as a legal title that its extent of protection could be determined precisely. In the Board's view, the clarity and conciseness requirements in Article 84 EPC ultimately served that purpose, but they were not sufficient to guarantee it. The claims were part of the application or the patent, which had to be read as a whole document (T 860/93). Article 69 EPC expressed the same principle (T 556/02, T 1871/09, T 1817/14). Therefore, under a systematic interpretation of the EPC, the function of the claims, as defined in Article 84 EPC, was only achieved when the potentially conferred extent of protection could be determined precisely. Whether this was the case for a specific patent application (or an amended patent) could only be decided with due consideration of the description. Therefore, if a claim was directed to something which was different from that described as the invention, then the application for grant was self-contradictory, and it could be questioned for which matter the protection was actually sought. For the extent of protection to be determined precisely, the definition provided by the claims of the matter for which protection is sought had therefore to be consistent with the definition of the invention provided by its description. The Board observed that its interpretation of Article 84 EPC could appear to be in conflict with decisions of the Boards of Appeal regarding clarity and claim interpretation. In particular, the frequently expressed requirement that the claims be clear "from the wording of the claims alone" appeared to be hardly compatible with the idea that the patent (application) had to be read "as a whole". The Board did not agree with a *verbatim* reading of the former requirement, and nor did it agree, without further qualification, with the statement of

T 454/89 that: "*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.*" The requirement that the claims must, as far as possible, be clear from their wording alone was, according to the Board, an expression of the desire, in the interests of legal certainty, for the divergence of post-grant decisions to be limited.

87. In decision **T 438/22** the Board pointed out that there was no provision stipulating that examples within the meaning of Rule 42(1)(e) EPC should not be in the form of claim-like clauses (i.e. in the form of one or more independent clauses followed by a number of clauses referring to previous clauses) at the end of or in another part of the description. There was no justification for deleting such examples just because they were drafted as claim-like clauses. They were to be treated like any other part of the description and thus, *inter alia*, they must support the claims (Article 84 EPC). It was not justified to unconditionally require their removal from the description, contrary to what was stated in the Guidelines (F-IV, 4.4). Concerning the interpretation of the requirement of Article 84 EPC that the claims must be supported by the description, the Board disagreed with the findings of T 1989/18. The Board also disagreed with the view that Rule 48(1)(c) EPC could not provide a legal basis for an obligatory adaptation of the description. On the contrary, the Board agreed with the long-established practice of the Boards of Appeal that "supported by the description" meant requiring the entirety of the description to be consistent with any claims found to meet the



requirements of the EPC. According to the Board, it was a general and overarching objective and, as such, also a "requirement" of the European Patent Convention that authorities, courts, and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective was the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contained subject-matter which manifestly impeded a common understanding, it was legitimate to insist on its removal under Article 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC. Regarding the provisions of Rule 48(1) EPC, including those of Rule 48(1)(c) EPC, the Board found that they were not to be regarded as merely optional guidelines but as mandatory and to be complied with for a patent to be granted on a European patent application. The Board approved of the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected. In the Board's view, this practice resulted in a correct and equitable compromise between the interests of the applicant in retaining the disclosed subject-matter and the overall purpose of the description to facilitate claim interpretation and the common understanding of the claimed subject-matter.

IV. *Discussion of and conclusions on the recent decisions of the Boards of Appeal*

88. The main reasons put forward in support of the power of the examining division to object to an inconsistency between the invention disclosed in the description (and/or drawings, if any) and the subject-matter for which protection is sought in the claims, are in essence set out in the respective headnotes:

(a) *"The purpose of the claims to define the matter for which protection is sought (Article 84 EPC) imparts requirements on the application as a whole, in addition to the express requirements that the claims be clear, concise and supported by the description. The Board deems it to be an elementary requirement of a patent as a legal title that its extent of protection can be determined precisely. Whether this is the case for a specific patent application (or an amended patent) can only be decided with due consideration of the description. Claims and description do not precisely define the matter for which protection is sought if they contradict each other (...)." (T 3097/19, headnote 3).*

(b) *"It is a general and overarching objective, and as such also a 'requirement' of the Convention, that authorities, courts, and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part*

*of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, it is legitimate to insist on its removal under Articles 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC."* (T 438/22, headnote 2).

89. The starting point of the reasoning of T 3097/19 is neither clarity of the claims nor support of the claims by the description, but the definition of the function of claims in the first sentence of Article 84 EPC. It is however not entirely clear how this definition of the function of claims could "*impart requirements on the application as a whole*", i.e. stipulate requirements for the further contents of an application within the meaning of Article 78(1) EPC. Of course, claims do not stand on their own; they are one essential part of an application. It also goes without saying that the claims together with the other parts of an application form a single document (to avoid the use of "unitary" [see, e.g. T 2766/17, T 438/22, T 447/22], which might create confusions with the unitary patent). Certainly, decision T 3097/19 did not invoke the uniform concept of disclosure in the assessment of Articles 54, 87 and 123(2) EPC (G 2/10, OJ EPO 2012, 376, point 4.6 of the Reasons), which requires that the disclosure be determined considering the content of application as a whole. The Board fails, nonetheless, to understand how these considerations could provide a rationale for extending the function ascribed to claims to the application as a whole. It appears from the reference to Article 69 EPC and decision G 2/88 that decision T 3097/19 ultimately aligns itself with the (circular) reasoning in the earlier decisions of the

Boards of Appeal, which has been discussed above and which is, in a nutshell, as follows. As the requirements of Article 84 EPC enable the extent of protection to be determined in accordance with Article 69(1) EPC and the Protocol, the requirements of Article 84 EPC are met only if the claims do not give rise to uncertainty about the extent of protection (T 3097/19, point 33: "*... the function of the claims, as defined in Article 84 EPC, is only achieved when the potentially conferred scope of protection can be determined precisely.*"). The wording of the claims alone does not, however, determine the extent of protection. The description must be considered according to Article 69(1), second sentence, EPC. Hence, the certainty about the extent of protection as a purported requirement of Article 84 EPC can only be achieved by the claims and the description together. Therefore, the description must match the subject-matter of the claims to provide certainty about the extent of protection (T 3097/19, point 33 of the Reasons: "*The Board also considers that this consistency between the claims and the description is necessary for legal certainty.*").

90. However, like the earlier decisions, T 3097/19 fails to justify the premise for the alleged further "elementary requirement" of Article 84 EPC to ensure legal certainty about the extent of protection, which premise is a necessary link between Article 84 and 69 EPC. As explained in detail above, the present Board has strong reservations as to the correctness of this view. The present Board's reasons discussed previously are briefly recalled here. Except for the assessment of Article 123(3) EPC, Article 69(1) EPC is not applicable to proceedings before the EPO, but to infringement proceedings in the Contracting States. The issue under

Article 69 EPC is whether or not allegedly infringing subject-matter falls within the forbidden area, not whether the patent was validly granted (which is a matter addressed in Article 138 EPC). As such, Article 69 EPC presupposes that patentability has been examined by the EPO. Hence, although they both deal with the functions of claims, Articles 84 and 69 EPC concern separate proceedings (examination vs infringement proceedings) before different authorities (EPO vs national authorities) and different assessments (requirements for grant of a patent vs infringement) and should therefore not be confused. Moreover, Article 69 EPC was not conceived to achieve a uniform determination of the extent of protection in the Contracting States, but to avoid extremes. The alleged purpose of legal certainty about the extent of protection is not in line with the wording of Article 69(1) EPC, Article 1 of the Protocol, or with the legislator's intent. By putting claims and the description on an equal footing for defining the subject-matter for examination and for determining the extent of protection, T 3097/19 seems to adopt one of the extreme positions that is, in fact, ruled out by Article 1 of the Protocol. Claims are denied their determinative role and have the character of a mere summary or guidelines, since the function, according to Article 84, first sentence, EPC is ascribed to the "application as a whole". This jeopardises - rather than promotes - legal certainty for third parties. In any case, if the subject-matter is clearly defined in the claims, legal certainty as regards the extent of protection is not diminished by matter disclosed in the description which is not claimed. There is thus no case for adapting the description. If the subject-matter in the claims is ill defined or ambiguous, the determination of the extent of protection is prone to

protracted argument. Adapting the description to such claims, if feasible, will not improve legal certainty. The present Board agrees, however, with the suggestion in T 3097/19 (see point 33; see also T 2194/19, point 6.2.2 of the Reasons) that contradictions between the claims and the description could, in specific circumstances, be unfair to third parties seeking to avoid infringement, on account of the resulting uncertainty. Such situations might arise if the description defines a term used in a claim more broadly than the definition corresponding to the accepted meaning in the art (see point 78.). However, it does not appear to be necessary to establish an "elementary requirement" under Article 84 EPC.

91. Similar observations apply regarding decision T 438/22. The idea that authorities, courts and the public should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter might be considered to represent an ideal-world situation. However, this alleged overarching purpose has no basis in the EPC, as will be discussed below (see point 92.), and is even more "unrealistic" if clear patent claims are already considered "unrealistic" (as argued in T 438/22, point 6.2 of the Reasons, which is not true, as is shown by the present application). Indeed, if a clear delimitation of the subject-matter vis-à-vis the state of the art in the claims is considered to be "wishful thinking", this appears to apply even more if - in addition to the claims - the description, which is drafted to contain different levels of abstraction or generalisation of what the applicant considers to be the core of the invention, together with the drawings, is seen as determining such subject-matter. Inevitably,

the subject-matter as claimed will be understood differently when read by different minds, in different contexts, and based on a different legal and factual framework, even if the reader makes use of the "only tool" for realising the idea of uniform understanding.

92. As regards the basis for the alleged overarching purpose of achieving a uniform understanding, which is elevated to a requirement for the grant of a patent, decision T 438/22 starts its analysis with Article 94(3) EPC and Rule 71(1) EPC. However, the suggestion that these provisions provide "at least the formal legal basis for the powers of the examining division to require an amendment of the description" is not entirely correct (T 438/22, point 5.1 of the Reasons). As the decision itself acknowledges, "*[a]mendments are only necessary if the application does not fulfil the requirements of the Convention.*" (T 438/22, points 5.4.1 of the Reasons, see also the reference to Article 113(2) EPC in point 5.4.3 of the Reasons). Indeed, while examining divisions have the power and duty under Articles 18(1) and 94 EPC to examine whether the application "as a whole" meets the requirements for grant, they do not have the power to require amendments, including amendments of the description, as is clear from Article 94(3) EPC. It is the sole responsibility of an applicant, in response to reasoned objections by the examining division (irrespective of whether they are put forward at the beginning of examination or at the end: T 438/22, point 5.4.3 of the Reasons) that the application does not meet one or more requirements for patentability, to either amend the application in line with Article 123 EPC or to file counter-arguments ("observations" in the terminology of Article 94(3) EPC). Thus, the question remains, whether Article 84

EPC (or Rule 48(1)(c) EPC, see below, points 94. *et seq*), invoked by the examining division in the present case, requires the description to be fully consistent with the patent claims in such a manner that nothing is described which is not encompassed by the claims. The relevance of Rules 42 and 48 EPC argued in T 438/22 (point 5.2 of the Reasons) is based on the unexplained allegation that these provisions "*are directed to the content of the description and the matter of the application as a whole*" and are hence "*the appropriate basis for seeking guidance*" on the interpretation of Article 84 EPC, which, however, is about the claims only. Rule 42 EPC is concerned with the contents of the description and implements Article 83 EPC. The Board agrees with T 2194/19, point 6.2.3 of the Reasons, that in particular Rule 42(1)(c) EPC cannot be a legal basis for establishing a general requirement for an adaptation of the description to the claims. As to Rule 48 EPC see point 94. *et seq* below. What matters for the interpretation of Article 84 EPC in accordance with the established principles of interpretation of an international treaty (see point 2. above) is the relationship between the claims and the description (see point B.IV. above). Such analysis shows that the claims and the description were given different functions by the legislator. The idea that the claims share the function ascribed to them under Article 84, first sentence, EPC, with the description in that, "*within the text of the application*", both, the claims, and the description define the subject-matter for which protection is sought might reflect superseded practice in some Contracting States, but cannot be derived from any provision of the EPC, let alone from the travaux préparatoires (and the Strasbourg Convention). Decision T 438/22 discusses the relationship between the description and the claims only after concluding that



amendments of the description primarily serve the procedures following grant (T 438/22, point 5.4 of the Reasons) and only in relation to the role of the description after grant, i.e. in relation to Article 69(1) EPC (T 438/22, point 5.5 of the Reasons). Thus, decision T 438/22 links Articles 84 and 69 EPC in support of the idea that the description, "as an integral part of the patent specification", should serve the objective of achieving a uniform understanding of the claimed subject-matter before and after grant. To avoid repetition, the Board points to its arguments setting out why it considers such a link, and consequently also the conclusions derived therefrom, to be misconceived and untenable having regard to the guidance found in decisions by the Enlarged Board of Appeal (see the summary in point C.IV. above).

93. The Board's position in respect of the relationship between Articles 84 and 69 EPC has been pinpointed by a different Board in decision T 1279/04. Thus, in place of its own summary, the Board reproduces point 3 of the Reasons of decision T 1279/04:

*"Article 69(1) EPC and the Protocol on its interpretation relate to the extent of protection conferred by the patent or patent application, primarily of concern in infringement proceedings.*

*They serve to determine a fair protection - inter alia by reference to the description and drawings - in the context of an actual alleged infringer in circumstances where the claim wording is set in stone.*

*In accordance with Article 69(1) EPC and the Protocol on its interpretation, this fair protection is a*

*balance struck between a strict literal definitional approach to the claims - legally certain but potentially unfair to the proprietor, because of the inherent problems of claim drafting without a crystal ball - and a loose guidelines approach - potentially unfair, because of its uncertainty, to the alleged infringer.*

*By contrast, in examination and opposition proceedings the value of future legal certainty is paramount. In this forum the function of the claims is to define the matter for which protection is sought (Article 84 EPC, first sentence - which also applies to opposition). There is no case for anything other than a strict definitional approach given that in this procedural stage the claim may and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art.*

*Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted shall be occasioned by grounds for opposition."*

**G. Rule 48(1)(c) EPC**

94. The refusal by the examining division is also based on Rule 48(1)(c) EPC. According to this provision, a European patent application must not contain any statement or other matter obviously irrelevant or unnecessary under the circumstances.

95. Several 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, most recently also decision T 438/22 discussed above. Nevertheless, on closer analysis, the wording and history of this provision suggest that this was not its intended purpose. The Board agrees in this regard with the analysis provided in decision T 1989/18, points 9 and 10 of the Reasons.

96. Rule 48 EPC is about offending, disparaging, or irrelevant statements in a patent application, which statements may be omitted from the publication of the application. This provision is not about the patent specification and even less about purported discrepancies between the description and the claims intended for grant. As is apparent from paragraphs 2 and 3, Rule 48 EPC does not provide for a ground for refusal based on the inclusion of merely "irrelevant or unnecessary" matter. There is simply no room for an argument that irrelevant statements are to be handled more restrictively than statements that offend the public or competitors, and that maintaining such irrelevant statements can even lead to a rejection of the patent application.
  
97. This is also confirmed by the wording and history of Article 21(6) and Rule 9 PCT, with which the EPC was aligned. These provisions deal with the publication of the international application only and non-compliance with these provisions can never lead to the application's being considered withdrawn. See document PCT/DC/3, Main Differences Between the 1968 and 1969 Drafts, point 25 (PCT/DC/3 is part of the documentation of the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty 1970, see page 177 therein):

*"Expressions contrary to morality or to ordre public, certain disparaging or irrelevant statements, references to trademarks, and fancy names, were called 'matter excluded' under the 1968 Draft (Rule 6.2). If the international application contained expressions obviously coming under the definition of 'matter excluded', the receiving Office would have had to invite the applicant to remove them (Article 14(1)(a)(vi) and (b)) and if the applicant did not comply, the application would have been considered withdrawn (Article 24(1)(ii)). Under the 1969 Draft, the notion of 'matter excluded' no longer exists. The receiving Office is no longer required to check the international application in this respect and the presence of that which used to be called 'matter excluded' can never lead to the application's being considered withdrawn. The 1969 Draft merely provides that expressions contrary to morality or public order, as well as disparaging, irrelevant or unnecessary statements, may be noted by the receiving Office or the International Searching and Preliminary Examining Authorities and that such Office or Authorities may suggest to the applicant that he delete them (Rules 9.2 and 66.2(a)(ii)). The applicant's failure to comply with the suggestion will have no consequence and the international application will be processed in the normal way except that expressions or drawings contrary to morality or public order and disparaging statements may be omitted from the international publication. Even if they are so omitted, they will be communicated to the designated Offices (Article 20) and, on request, to any third party (Article 21(6))."*

98. Against this background, deriving from Rule 48(1)(c) EPC a requirement to bring the description of an application into agreement with the claims intended for

grant requires stretching the wording far beyond of what is a reasonable interpretation in accordance with the principles set out in the VCLT. Hence, Rule 48(1)(c) EPC cannot and does not provide a legal basis for the refusal.

**H. Conclusions on the adaptation of the description**

99. The following are the Board's conclusions on the issue of adaptation of the description:

- (a) Article 69 EPC and its Protocol are not concerned with the assessment of patentability in examination before the EPO but with the extent of protection in the context of national proceedings of a European patent following such examination. Article 69 EPC and its Protocol are hence not applicable in grant proceedings before the EPO.
- (b) Article 84 EPC and Rule 43 EPC are not a corollary of Article 69 EPC even though claims are the main determinant of the extent of protection. Consequently, the requirements of Article 84 EPC and Rule 43 EPC are to be assessed separately and independently of considerations of extent of protection when examining a patent application.
- (c) Article 84 and Rules 43 EPC set forth requirements for the claims. They do not provide a legal basis for a mandatory adaptation of the description to claims of more limited subject-matter. Within the limits of Article 123 EPC, an applicant may, however, amend the description on its own volition.
- (d) Rule 48 EPC is concerned with the publication of an application and the avoidance of expressions which

are contrary to public morality or public order, or certain disparaging or irrelevant statements. Rule 48 EPC does not provide for a ground for refusal based on the inclusion of merely "irrelevant or unnecessary" matter in the description intended for grant and even less for "discrepancies" between the subject-matter claimed and that disclosed in the description.

***I. No point of law referred to the Enlarged Board of Appeal***

100. While the Board initially envisaged referral of a question to the Enlarged Board of Appeal under Article 112(1)(a) EPC, it did not proceed with the referral, for the following reasons.
101. There is no need to seek guidance on the issue set out in point 2. above, since the requirements of Article 84 EPC for the purpose of examining European patent applications appear unequivocal when considering the different elements of interpretation (see points 7. and 8.), the guidance by the Enlarged Board of Appeal (see, the references in point 35.), and the practical implications. The wording of Article 84 EPC as well as its context leave no room for requiring, in examination, that the description be adapted to allowable claims to match their subject-matter. While confirming the relevance of Article 69 EPC for the assessment of Article 123(3) EPC, the Enlarged Board of Appeal also distinguished between, on the one hand, the assessment of patentability, i.e. Articles 52 to 57, 76, 83, 84 and 123 EPC, and, on the other hand, the assessment of the extent of protection and the rights conferred by European patents or patent applications, i.e. Articles 64(2) and 69 EPC. As to the practical implications, adapting the description in examination

might have unwanted effects in the event of a "prosecution history estoppel" being applied at national level.

102. The Board is also not persuaded by the reasons for the practice requiring the description to be adapted to allowable claims. A more uniform determination and better predictability of the extent of protection of a granted European patent in infringement proceedings can only be achieved if granted claims are clear in themselves. Adapting the content of the description to match the subject-matter of allowable claims reduces the reservoir of technical information that could be used in national courts in the Contracting States to determine the protection conferred by the granted patent. However, such harmonisation of the practice of national courts by way of interpreting Article 84 EPC contrary to its wording, is outside of the powers of the EPO (see T 712/10, point 8.2 of the Reasons). If the legislator considers it justified to require that the description be aligned with the subject-matter of claims held allowable, the legislator should provide for the respective legal basis by way of amendment of the EPC.

103. The lack of such a provision appears to be intentional. The legislator, which already considered amendments to Article 69 EPC and the Protocol as part of the revision in 2000, has in fact taken a different approach. In 2000, the Contracting States began negotiations on a draft agreement on the establishment of a European patent litigation system. These negotiations were aimed at creating an optional protocol to the EPC which would commit its signatory states to an integrated judicial system, including uniform rules of procedure and a common appeal court. This optional protocol would have

offered the possibility for all Contracting States to the EPC to participate. Such a European patent litigation system would have provided a more effective means for achieving legal security and predictability as regards the determination of the extent of protection of national parts of granted European patents under Article 69 EPC in infringement proceedings. However, the European Commission regarded the negotiations on the optional protocol as unlawful in view of a set of proposed Community patent regulations. The negotiations were continued among the EU-member states and eventually led to the Agreement on a Unified Patent Court which was signed on 19 February 2013 by 24 states and entered into force on 1 June 2023. It is currently in force in 18 EU member states. It is also noted that the Appeal Court has already dealt with Article 69 EPC and the Protocol (see Court of Appeal of the Unified Patent Court, 26 February 2024, NanoString Technologies Inc et al. v 10x Genomics, Inc. et al., in the proceedings for provisional measures concerning EP 4 108 782, UPC\_CoA\_335/2023, App\_576355/2023, concerning EP 4 108 782). In view of these developments, a requirement to adapt the description to amended claims disregards the choices made by the legislators and encroaches on the competence of the national courts. Therefore, a referral does not seem to be appropriate.

104. The function of claims and of the description, and their mutual relationship, were viewed differently by the Boards of Appeal already in their earliest decisions. Consequently, the Boards of Appeal also diverged in respect of the relationship between Article 84 EPC on the one hand and Article 69 EPC on the other. However, the distinction made by the Enlarged Board of Appeal between patentability and the



protection conferred by a patent, as well as the decisions stressing that claims should be clear in themselves, contrasted with this practice and called for its re-assessment. Thus, while it could be argued that there are diverging decisions, it is rather more the case that the practice is evolving (compare T 433/21, point 8.4 of the Reasons, advocating a non-coercive discourse) taking into account the revision of the EPC in 2000 and developments thereafter (in particular the acknowledgment of equivalents in the Protocol and the negotiations on a supranational court for infringement and nullity proceedings). Moreover, the Board does not consider that its interpretation of Article 84 EPC deviates from an interpretation or explanation of Articles 84, 69 and 123 EPC in decisions or opinions of the Enlarged Board of Appeal. Hence, a referral is also not mandatory under Article 21 RPBA.

***J. Decision in the present case***

105. For the above reasons, the decision under appeal is to be set aside. As the examining division's objection that the claim-like clauses in the passage entitled "SPECIFIC EMBODIMENTS" extend to subject-matter outside of what was claimed, was the only issue raised against the allowability of the subject-matter claimed, the case can be remitted to the examining division with the order to grant a patent based on the main request on file.

## 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:  
Description:  
Pages 1-130 filed in electronic form on 20 December 2018.  
Sequence listings:  
SEQ ID NO. 1 -112 as published.  
Claims:  
No. 1-11 filed in electronic form on 15 February 2022.  
Drawings:  
Sheets 1/27-27/27 as published.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

M. Pregetter

Decision electronically authenticated