

# Actually adapting the description to amended claims?

How to deal with T 56/21 in practice



## Background

There is an ongoing discussion on whether and to what extent the description needs to be adapted to allowable claims amended relative to original claims in European (EP) examination proceedings. For example, embodiments described in the specification and falling under the original claims may no longer fall under the granted claims due to the amendment. This may entail an inconsistency between the claims and what is disclosed as the invention in the description. It is EP practice (within the framework of the ›adaptation of the description‹) to remove this inconsistency by amending, i.e. adapting, the description. However, for various reasons, it may be desired to avoid an (extensive) adaption of the description to amended claims.

In earlier decisions such as T 757/01, the Board of Appeal (BoA) referred to Article 84 EPC stipulating an adaption of the description to the wording of the amended claims, without giving reasons for this interpretation of Article 84 EPC, however.

Some discussion has come up with the BoA decision T 56/21, according to which the BoA in examination of a patent application could not identify a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter, either in Article 84 EPC or in Rules 42, 43 and 48 EPC. As a consequence, the question arises whether decision T 56/21 can successfully support the view that adapting the description is not necessary based on the BoA's findings in T 56/21.

## BoA's Findings in T 56/21

In the case underlying T 56/21, the description contained a passage entitled ›SPECIFIC EMBODIMENTS‹, which contained claim-like clauses. The Examining Division refused the application on this basis with reference to Article 84 EPC, the Guidelines for Examination and Rule 48(1) (c) EPC.

Based on a discussion of several earlier decisions relating to the adaptation of the description, in decision T 56/21 the BoA came to the following conclusions (see in particular margin no. 99 of T 56/21):

- **Article 69 EPC** concerns the enforcement of a patent after grant and, hence, the extent of protection conferred by the claims is determined in view of allegedly infringing subject-matter (see margin no. 15, also G 1/98). Hence, Article 69 EPC and its Protocol are concerned with the **extent of protection** (›demarcation of what is protected‹, see margin no. 14 of T 56/21) in the context of national (or UPC) proceedings of a European patent following such examination, and are



not concerned with the assessment of patentability in examination before the EPO. Article 69 EPC and its Protocol are hence not applicable to examination proceedings before the EPO.

Only when it comes to amendments after grant, under Article 123(3) EPC, the extent of protection before and after the amendment is assessed by the EPO (see e.g. margin nos. 32 and 90 of T 56/21).

- **Article 84 EPC** pertains to the examination of subject-matter intended for grant of a patent and, hence, the subject-matter claimed delimited and characterized in view of the prior art relevant to the examination of patentability (see margin no. 15). 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 any considerations of extent of protection (under Article 69 EPC) when examining a patent application.
- **Article 84 EPC and Rule 43 EPC** set forth requirements for the claims. **They do not provide a legal basis for mandatory adaptation of the description to claims of more limited subject matter.** Specifically, due to the fact that Article 84 EPC sets out requirements to be met by the claims and not by the description, **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 (margin no. 76).

Within the limits of Article 123 EPC, an applicant may, however, amend the description on its own volition.

- **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 (in particular Rule 48(1)(c) EPC) does not provide a ground for refusal based on the inclusion of merely ›irrelevant or unnecessary‹ matter in the description intended for grant and even less based on ›discrepancies‹ between the subject-matter claimed and disclosed in the description.

## Discussion and Outlook

In our experience, most of the Examining Divisions consider decision T 56/21 as a singular decision. Consequently, it appears that most of the Examining Divisions do not and are not willing to follow this decision. Rather, we presume that Examining Divisions may follow such a decision only if confirmed by the Enlarged Board of Appeal (EBA) or if it became advised practice as outlined in the Guidelines for Examination. At present, the decision has not (yet) found its way into the Guidelines for Examination and will probably only do so if and when there are subsequent decisions and, in the event of divergence, a referral to the EBA. The BoA in T 56/21, however, did not see any reason to refer the case to the EBA (see margin nos. 100 to 104).

Denying a requirement for adapting the description is likely to result in more EP patents without a properly adapted description. If the unamended description entails contradictions, this is likely to lead to issues under Article 69 EPC in subsequent proceedings (EP opposition proceedings, national or UPC infringement or revocation proceedings). In particular in infringement proceedings, where courts generally tend to interpret granted claims with the aim not to contradict the overall teaching of the patent (i.e. the description of the granted patent), issues may arise more frequently. Notably, the BoA does acknowledge the importance of a clear definition of the subject-matter in the claims for post-grant proceedings (see margin no. 34 in T 56/21). Apparently, the BoA sees a ›solution‹ in that clarity of the claims should be key in examination, such that 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 (see margin no. 33).

In summary, there is likely little reason to change the current EP practice of adapting the description upon claim amendments in view of T 56/21. Rather, EP proceedings are often pragmatically based on a cost-benefit analysis, as on the one hand unnecessary adaptations of the description can take a lot of time (and generate costs), and on the other hand a rejection of non-critical adaptations of the description, e.g., proposed by the Examiner, also generates delays (and costs) for a further submission.



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