

# Inledning

SFIR, 17 januari 2022

# Anpassning av beskrivningen

Under lång tid har man som sökande behövt göra vissa anpassningar av åtminstone inledningen av beskrivningen i ljuset av ändrade patentkrav.

I en uppdatering av Guidelines 2020 implementerades en mycket strikt approach till detta baserat på ett tidigare beslut från BOA, T 1808/06.



# Guidelines

Where parts of the description give the reader the impression that they disclose ways to carry out the invention but are not or, due to amendments to the claims, are no longer encompassed by the wording of the claims, these parts often throw doubt on the scope of protection and therefore render the claims unclear or unsupported under **Art. 84**, second sentence, or, alternatively, render the claims objectionable under **Art. 84**, first sentence. The description must be adapted to the claims in order to avoid inconsistencies between the claims and the description.



# Guidelines

Embodiments in the description which are no longer covered by the independent claims must be deleted (for example if the description comprises an alternative for at least one feature which is no longer covered by the amended claims) unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated (T 1808/06).



# Guidelines

For example, if the claims are amended to specify a vehicle employing electric motors but one of the embodiments in the description and drawings employs a combustion engine instead, the inconsistency can be rectified by removing the embodiment with the combustion engine from the description and drawings. Alternatively, this embodiment must be marked as not being covered by the claimed invention (e.g. "embodiment not covered by the claimed invention"). It is not sufficient to use generic statements such as "embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention" without indicating which parts of the description are no longer covered.



# Guidelines

In addition, merely changing the wording "invention" to "disclosure" and/or the wording "embodiment" to "example", "aspect" or similar is not sufficient to clearly state that this part of the description does not fall under the scope of the claimed invention. It has to be explicitly specified that this part of the description does not describe part of the claimed invention.



# Ett normalt föreläggande numera

## Adaption of the description

The applicant should amend the description as needed to fulfil the following requirements:

- The technical field of the invention (Rule 42(1)(a), GL F-II.4.2) must correspond to the amended set of claims.
- The summary of the invention (Rule 42(1)(c) and GL F-II.4.5) must correspond to the amended set of claims. If appropriate, statements such as "The invention is set out in the appended set of claims" or "The invention is as defined in claim X" can be applied instead of repeating the claims verbatim.
- All embodiments which are not covered by the claims anymore must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. In such case, they must be prominently marked as not being part of the present invention (T 1808/06):
  - For example, independent claim <X> has been amended by limiting it to the feature of <feature A> . Ways of carrying out the invention using features presented as alternatives to this feature must either be deleted or the fact that they are not encompassed by the claims must be prominently stated.
  - Any combinations of features which do not fall under the scope of the amended independent claims must be prominently marked as not being part of the present invention. For example, amended claim <X> comprises features <A>, <B> and <C> and the description on page X refers only to B+C as an embodiment of the invention. It must be marked as not being part of the invention.
  - Statements such as "The following examples/aspects/embodiments X, Y, Z are not according to the invention and are present for illustration purposes only" may be used at the start of the description (or in the list of figures) when such a situation arises.
- Subject-matter in the description being excluded from patentability under Article 53 EPC needs to be excised, reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention.
- All technical features of the independent claims shall not be presented as optional in the description. Terms such as "for example", "may", "can", "exemplary", "optionally", "preferably" and the like should be removed when preceding a feature of an independent claim.
- Claim-like clauses must be deleted prior to grant. The term "claim-like clauses" means clauses present in the description which use claim language such as "according to the preceding clause", "characterised in that", ... (GL F-IV, 4.4). These "claim-like clauses" also include examples, embodiments or aspects presented as claim-like clauses. A simple conversion of these clauses into separate optional features will not be admitted, either.

# Så kommer T 1989/18 som en julklapp!

Ansökan avslogs av ED på grunden att Art. 84 inte var uppfylld.

BOA anser:

- ✓ Att Art. 84 endast berör beskrivningen i anslutning till att den måste ge stöd (*support*) för kraven.
- ✓ Att om kraven är tydliga och har stöd i beskrivningen, så kan inte kravens tydlighet påverkas av att beskrivningen innehåller sådant som inte omfattas av kraven.
- ✓ Att Art. 69 inte är relevant vid bedömning av tydlighet.
- ✓ Att Art. 84 därför inte kan utgöra grund för avslaget.
- ✓ Att inte heller Rule 42(1)(c) eller Rule 48(1)(c) kan utgöra grund.

## T 1989/18 - Slutsats

In view of the above considerations, the board fails to see how the aforementioned provisions of the EPC, or any others, can lead to the requirement that embodiments disclosed in the description of an application which are of a more general nature than the subject-matter of a given independent claim must constitute potential subject-matter of a claim dependent on that independent claim. The board accordingly concludes that the decision under appeal is erroneous and is to be set aside.

## Guidelines som rättskälla

“It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention itself including the Implementing Regulations, the Protocol on the Interpretation of Article 69 EPC, the Protocol on Centralisation, the Protocol on Recognition, the Protocol on Privileges and Immunities and the Rules relating to Fees, and secondly to the interpretation put upon the EPC by the boards of appeal and the Enlarged Board of Appeal.” **General Part 3**

# Tolka patent med inaktuell beskrivning

## **Article 69<sup>61, 62</sup>**

### **Extent of protection**

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

39 § Patentskyddets omfattning bestämmes av patentkraven. För förståelse av patentkraven må ledning hämtas från beskrivningen.