



# Newsletter Edition 1/2022

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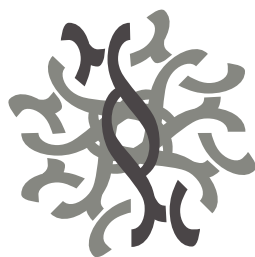
Düsseldorf/Essen/Frankfurt/Munich, 18 January 2022

Austria deposits the instrument of ratification - the Protocol is in force

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T 471/20 and T 1989/18 - No inadmissible extension by citation of citations, but lack of legal basis for adapting the description?

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M I C H A L S K I • H Ü T T E R M A N N  
P A T E N T A N W Ä L T E

# Austria deposits the instrument of ratification - the Protocol is in force

After Austria has already completed the parliamentary procedure<sup>1</sup> for ratification of the Protocol<sup>2</sup> last year, it will now deposit the instrument with the EU in Brussels in the near future, the corresponding courier shipment is already on its way.<sup>3</sup> Thus, the necessary thirteen states are together and the protocol will now enter into force,<sup>4</sup> i.e. the Unified Patent Court is then officially established and can make the necessary preparations for the start of the unitary patent system.

This concerns in particular the selection of judges. In an interview<sup>5</sup> on JUVE Patent, the chairman of the Preparatory Committee, Alexander Ramsay, clarified that there would not be another round of applications, but that one would work with the applications received in 2016 and 2019. Applicants have also already been contacted to inquire if they would maintain their candidacies.

In addition to the selection of judges, many formal processes are necessary, in particular the committees of the Unified Patent Court must be constituted. Of particular importance is the Administrative Committee, where each member country has a seat, as it must formally adopt the Rules of Procedure.

The published version<sup>6</sup> of the Rules of Procedure is so far only preliminary. It is unclear whether significant changes will be made, but it is rather certain that there will be a new Rule 262A, which opens up the possibility of having documents treated confidentially before the Unified Patent Court and possibly even conducting "*in camera*" proceedings, which would mean that only the lawyers of the opposing side (and of course the Senate) would have access to certain documents.<sup>7</sup>

However, it is heard that the "opt-out" Rule 5 may still be modified; this would of course be of great practical importance, as an "opt-out" will be possible within the "protocol phase".<sup>8</sup>

Effective January 1, 2022, our firm has appointed three colleagues as partners. Dr. Deborah Meyer and Dr. Kevin Lamberts have previously completed their training with us, and Dr. Rolf Claessen joined us in August 2021 from a Cologne law firm. All three are chemists and work at our Düsseldorf office. Fabian Pech, M.Sc. already joined us last year. He has German and European accreditation and previously worked in his own law firm. He is a mechanical engineer with special expertise in process engineering, drive and transmission technology, materials and medical technology and also works at the Düsseldorf office.

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1 cf. our newsletter [14/2021](#)

2 Exact title: „Protocol to the Agreement on a Unified Patent Court on provisional application“, cf. our newsletters [Newsletter 9/2021](#), [11/2021](#), [12/2021](#) und [14/2021](#)

3 We would like to thank Mag. Thomas Adocker, Law firm Schwarz Schönherr for a confirmation to this effect following a request to the Office of the President.

4 Pursuant to Article 3, the Protocol shall enter into force on the day following the decisive deposit

5 Cf here: <https://www.juve-patent.com/news-and-stories/people-and-business/alexander-ramsay-the-london-question-wont-delay-the-upc/>

6 Cf here: [https://www.unified-patent-court.org/sites/default/files/upc\\_rules\\_of\\_procedure\\_18th\\_draft\\_15\\_march\\_2017\\_final\\_clear.pdf](https://www.unified-patent-court.org/sites/default/files/upc_rules_of_procedure_18th_draft_15_march_2017_final_clear.pdf)

7 cf Hüttermann GRUR Int. 2019, 1148 for further reading

8 cf. our newsletter [14/2021](#)

The entry into force of the Protocol is an important step towards the introduction of the unitary patent system and at the latest now all those active in the field of intellectual property should make themselves aware with the system.

## T 471/20 and T 1989/18 - No inadmissible extension by citation of citations, but lack of legal basis for adapting the description?

It is common practice at the European Patent Office to adapt the description to the claims to be granted when a patent is granted, be it after successful examination in the granting procedure or in amended form in opposition or appeal. Failure to amend the description will usually result in rejection. In particular, in opposition and appeal, a patentee cannot rely on having an opportunity to amend the description after the hearing if the patentee does not attend the hearing.<sup>9</sup>

In the case of a description adjustment, it is usually required on the one hand that cited citations, at least the closest prior art, are cited. A brief statement of the contents of cited documents is considered to be in accordance with the requirements of Art. 123(2) EPC.<sup>10</sup>

Furthermore, contradictions between the claims to be granted and the description/drawings, which could make the scope of the claims unclear, must be avoided.<sup>11</sup> This is because according to Art. 84 EPC the claims must be supported by the description.<sup>12</sup> Disclosure in the description and/or drawings which is incompatible with the claims to be granted is thereby deleted as far as possible. This is also to apply to embodiments which are no longer covered by the claims, unless these embodiments are useful to emphasize certain aspects of the subject-matter of the claim.

This practice is not without problems and requires above all two things: restraint and a sense of proportion. Against this background, it met with little approval from European representatives that the 2021 version of the Examination Guidelines was expanded in this respect and now requires the applicant to make more changes in the description. The above-mentioned case law was also included and explicit reference was made to decision T 1808/06.<sup>13</sup>

Among other things, this has led in the past year to blanket disclaimers such as “not belonging to the invention” being included in the description, depending on the examining division, and to deletions being made in the context which, as a result, may well be regarded as a change in the disclosure in the direction of new technical information. When the examining division has disagreed on what does and does not belong to the invention, this practice has led to abstruse phrases such as “partly not belonging to the invention.”

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<sup>9</sup> Decision T 985/11, No. 31 - 33 of the reasons

<sup>10</sup> Decision T 11/82, head note

<sup>11</sup> Decision T 1808/06, No. 2 of the reasons

<sup>12</sup> Cf e.g. T 1808/06, No. 2 of the reasons; Decision T 1399/17, No. 2.2 of the reasons; Decision T 1667/08, No. 3.2 of the reasons

<sup>13</sup> [https://www.epo.org/law-practice/legal-texts/html/guidelines/d/f\\_iv\\_4\\_3.htm](https://www.epo.org/law-practice/legal-texts/html/guidelines/d/f_iv_4_3.htm)

Apart from possible problems under Article 123(2) EPC, there is no going back for the applicant after deletions,<sup>14</sup> which may have potential consequences under Article 123(3) EPC.<sup>15</sup> This raises the fundamental question for the applicant of what consequences deletions of technical disclosure in the description may have on the interpretation of the claims. After grant of the patent, the national courts use the description to interpret the claims, which is not sufficiently appreciated by the Boards of Appeal or the Guidelines.

Decision T 471/20 concerns a description amendment in which the applicant not only cited prior art but also included the statement that the filling unit disclosed therein was not a robot.<sup>16</sup> The opposition division considered this statement to be an inadmissible extension, since there was no basis for it in the original description. The Board of Appeal rejected this decision.<sup>17</sup> It was not relevant to the decision whether the statement “not a robot” was correct or a “subjective” description. It did not concern the invention and thus could not lead the skilled person to interpret the claims in a certain way. Consequently, no new technical information would be introduced, so that such a statement could not lead to an inadmissible extension.

With regard to deletions in the description, Examining Divisions have occasionally lacked the necessary restraint, not only in the last year, so that a Board of Appeal in appeal case T 1989/18 had to deal exclusively with the application of the above-mentioned practice according to T 1808/06. Surprisingly, it de facto breaks with previous case law.

In that case, the Examining Division had rejected the application because the applicant had not accepted a proposed change in the description from “embodiment” to “disclosure”. Contrary to the applicant’s argument, the text passage in question was broader than the corresponding independent claim and would therefore not be in conformity with Art. 84 EPC without a description amendment.

The Board of Appeal saw no legal basis for requiring the applicant to change “embodiment” to “disclosure”. In a telephone conversation, the applicant was informed that the inserted sentence “The invention is defined by the claims” resulted in a lack of clarity. After deleting the sentence, the case was referred back to the Examining Division for grant.

According to the decision, the claims must be clear to the person skilled in the art within the meaning of Art. 84 EPC on their own, against the background of his technical knowledge and the prior art, but not against the background of knowledge of the description of the patent application or the amended patent.<sup>18</sup> If the claims are clear on their own and supported by the description, their clarity is not affected by the fact that the description contains subject matter that

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<sup>14</sup> Decision T 1149/97, No. 6.1.4-6.1.8 of the reasons

<sup>15</sup> Decision T 1149/97, No. 6.1.12 of the reasons

<sup>16</sup> cf No. 2.3 of the reasons

<sup>17</sup> cf No. 2.3 of the reasons

<sup>18</sup> cf No. 4 of the reasons

is not claimed.<sup>19</sup> As in previous decisions,<sup>20</sup> the board concludes that Art. 69 EPC cannot be considered as a legal basis, since this article does not establish a requirement that an applicant must fulfill. The board could also not find a legal basis for rejection in provisions of the Implementing Regulations to the EPC.

The board thus concluded that there was no legal basis for requiring “embodiments” in the description to be eligible as potential dependent claims.

As welcome as the decision is, it is unlikely to carry much weight in light of the overwhelming number of decisions to the contrary. Doubts also creep in at one point in the reasoning of the decision: While Art. 84 EPC clearly concerns claims, it merely states that they must be clear and concise and supported by the description. The requirement established by case law that the claims must be clear in themselves cannot be relevant to the decision here.

More helpful may be the Board’s reference to the Munich Diplomatic Conference on the EPC, which allegedly supports the Board’s view.<sup>21</sup>

It thus remains to be seen whether decision T 1989/18 will have an impact on the examination guidelines. It has been suggested by both the epi and the Standing Advisory Committee to the EPO (SACEPO) that the current guidelines under F-IV-4.3 and 4.4 be amended. However, as it looks at present, there will only be clarifications as to what is to be understood as a contradiction between description and claims and what is not.

## In our own affairs

We wish your relatives, employees, colleagues and, of course, yourself all the best for the current, still difficult time.

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<sup>19</sup> cf Nr. 5 of the reasons

<sup>20</sup> cf Nr. 5 of the reasons

<sup>21</sup> cf No. 11 of the reasons