D YOUNG & CO PATENT NEWSLETTER no.89

June 2022
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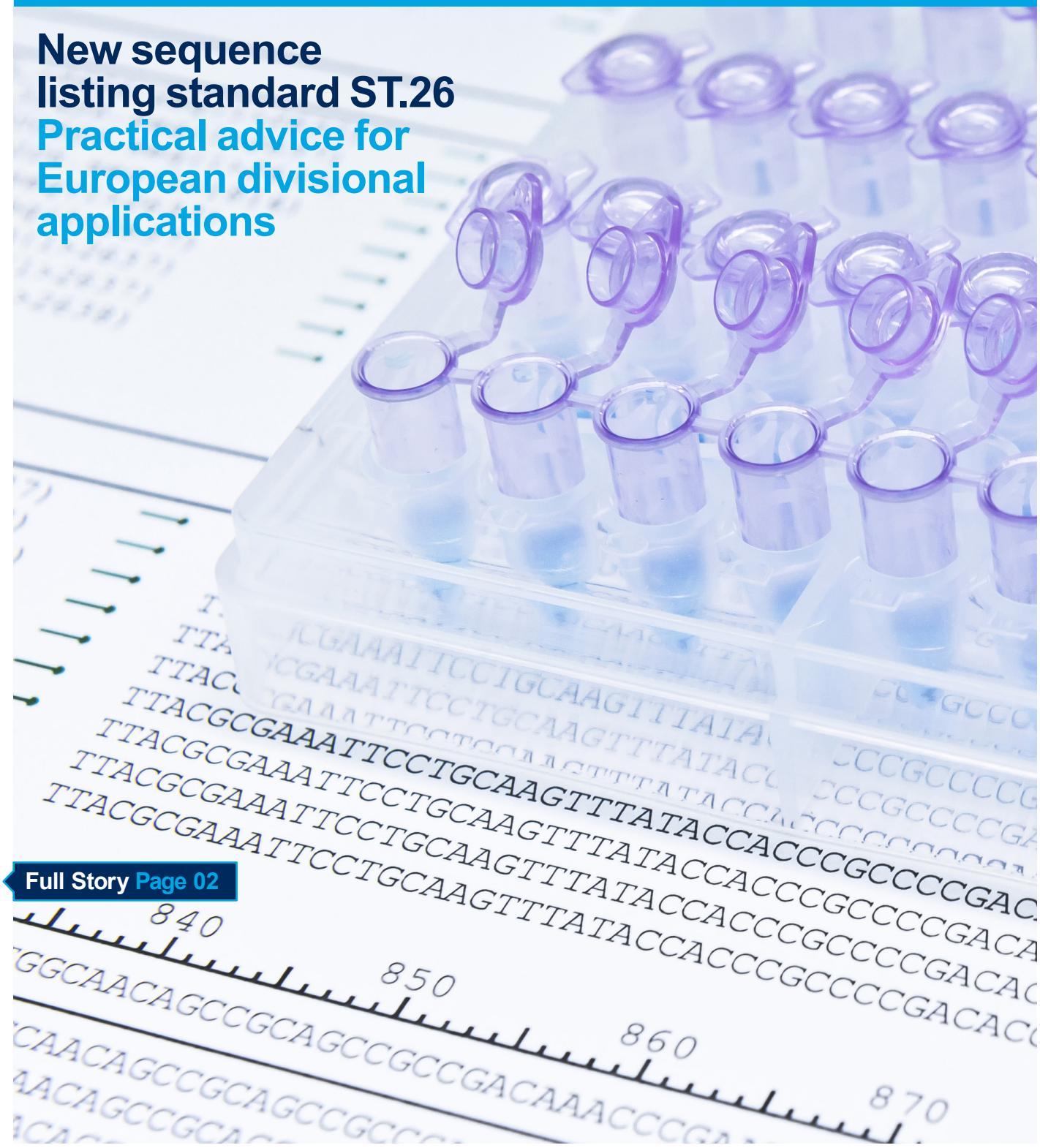

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Editorial

As we head into summer I wish all of our readers a very warm welcome to this patent newsletter. Our attorneys are back on the road again and greatly enjoying interacting with clients and contacts in person. Meanwhile back at our desks we continue our dedicated custodianship of our clients' patent applications, carefully monitoring the evolution of rules and case law. This newsletter covers a range of topics relating to the correct handling of European patent applications, covering sequence listing formats, computer simulations, and correct handling of application documents. Finally, with the start of the UP and UPC on the horizon, we remind readers of the range of guides and webinars on the topic which are available on our website.

Nicholas Malden, Editor

Events

European Biotech Patent Case Law
Webinar, 26 July 2022
Partners Simon O'Brien and Anthony Latham present our regular webinar round up of important and recent European biotech case law.

Additive International Conference
Nottingham, UK, 13-14 July 2022
Alice Stuart-Grumbar will be attending this conference, formerly known as the International Conference on Additive Manufacturing & 3D Printing.

CIPA IP Paralegal Conference 2022
Nottingham, UK, 07 October 2022
William Burrell will be speaking about "Post Brexit UK Design Registration Tips and Practices" at the Chartered Institute of Patent Attorneys' IP Paralegal Conference.

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Sequence listing standards

New sequence listing standard ST.26 Practical advice for European divisional applications

Where a patent application discloses nucleotide or amino acid sequences, a formal sequence listing must be filed, to provide the sequences in a standardised format for searching. The current format for sequence listings is governed by the ST.25 standard, however from 01 July 2022 patent offices will begin using the new ST.26 standard. Here we discuss the key differences between the two standards, and emphasise key points which must be considered for European divisional applications.

Key differences between ST.25 and ST.26 standards

The new ST.26 standard requires sequence listings to be filed as an **XML file**. The new format is intended to facilitate searching and exchange of sequence data.

Importantly, the new ST.26 standard **prohibits** the inclusion of sequences shorter than ten specifically defined nucleotides or four specifically defined amino acids. For example, a polynucleotide with the sequence 5'-anctggcaan-3' cannot be included, since it only has eight specifically defined nucleotides. The new ST.26 standard also makes it **obligatory** to include D-amino acids, linear portions of branched amino acid sequences and nucleotide analogues.

When to use the new ST.26 format

For new PCT applications (and direct (non-PCT) European and UK applications) filed **on or after 01 July 2022** the new ST.26 standard will apply, irrespective of the priority date. The old ST.25 standard will apply for applications filed before 01 July 2022, even if the sequence listing is submitted after that date.

> Importantly, European divisional applications filed on or after 01 July 2022 must comply with the new ST.26 standard.

In contrast, the UKIPO has confirmed that for UK divisional applications filed on or after the 01 July 2022, the sequence listing should be filed using the standard required for the parent application.

Practical advice - European divisional applications

D Young & Co has a dedicated sequence listing team that regularly prepares sequence listings. The sequence listing team have been preparing for the new ST.26 standard and we have been updating our internal practices as necessary.

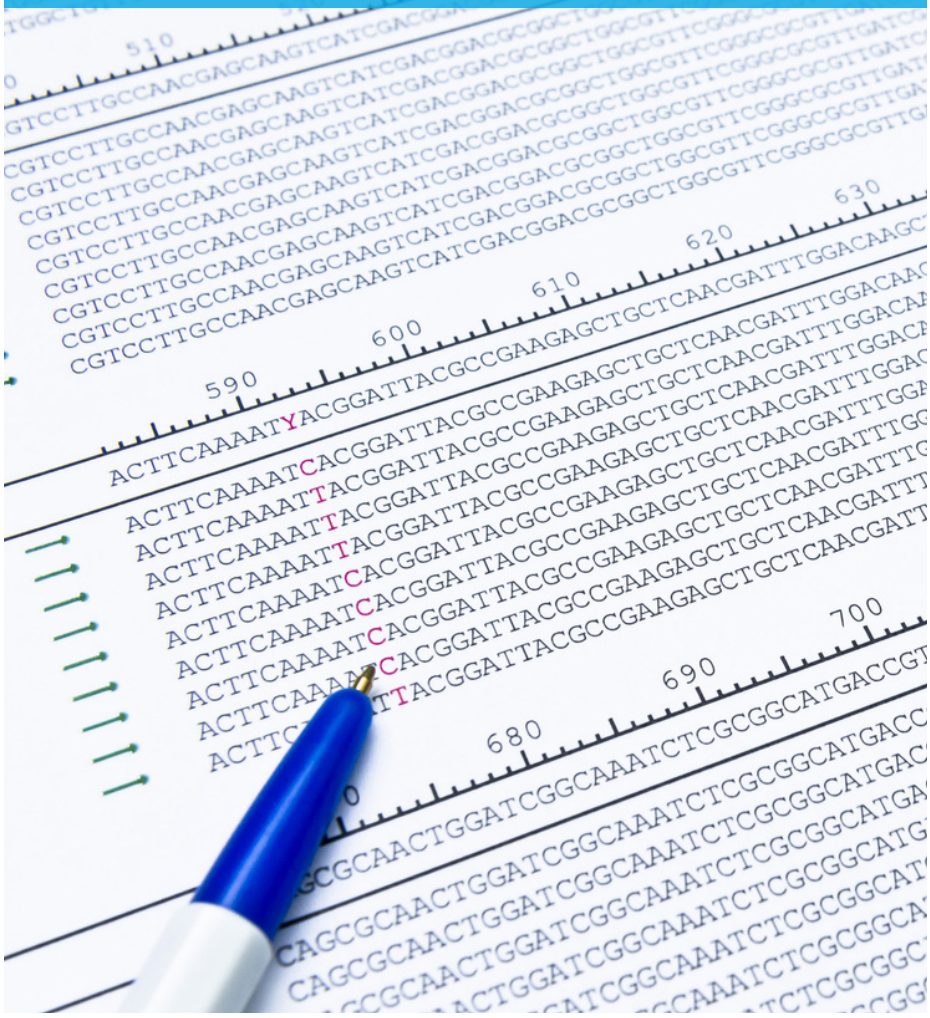
For new PCT applications (and direct European and UK applications) the changeover to the new ST.26 standard will usually be straightforward.

However, for European divisional applications, it will be necessary to convert old ST.25 sequence listings into the new ST.26 format. Although the new WIPO sequence software provides a tool to convert sequence listings, preparing sequence listings for European divisional applications may take significantly more time.

> Where possible, we would advise deciding if a European divisional application is to be filed in good time whilst the parent application is still pending (for example, before the deadline to respond to the Rule 71(3) communication).

If the original ST.25 sequence listing was filed on the date of filing of the parent application, it may form part of the description. In that case, conversion of the original ST.25 sequence listing to the new ST.26 format will need to conform to the EPO's strict requirements regarding the addition of subject-matter. In addition, care must be taken to

From 01 July 2022 patent offices will use the ST.26 standardised format for searching



ensure that conversion does not result in deletion of any subject-matter.

There are several possible scenarios in which conversion of the original ST.25 sequence listing could potentially result in the addition or deletion or subject-matter, for example:

- where the original ST.25 sequence listing includes short sequences which are not included elsewhere in the application. As these sequences are excluded in the new ST.26 format, subject-matter will be lost unless specific action is taken (such as adding these sequences to the description).
- where the original ST.25 sequence listing includes "Xaa" there is no default value, and may refer to e.g. "any amino acid". In contrast, in ST.26, the default value for "X" is restricted to any of the 22 naturally-occurring amino acids. Unless the default value is edited, subject-matter may therefore be lost.
- where the original ST.25 sequence listing includes custom features there might be no corresponding feature key in ST.26. Unless the new ST.26 sequence listing is further annotated to add custom features, subject-matter may therefore be added or lost.

WIPO has issued recommendations to deal with these different scenarios. In addition, various options are available to further mitigate the risk of adding or deleting subject matter when converting the original ST.25 sequence listing into the new ST.26 format. For example, all or part of the original ST.25 sequence listing could be added to the description. However, this may incur excess pages fees.

The most appropriate approach for European divisional applications will depend on the length and complexity of the sequence listing and the extent to which the sequences in the original ST.25 sequence listing are included elsewhere in the application. Applicants are therefore advised to contact their usual D Young & Co representative to discuss the most appropriate action for European divisional applications when the original ST.25 sequence listing formed part of the description.

Take-home messages

The new ST.26 sequence listing standard applies to patent applications filed on or after 01 July 2022.

For European divisional applications, the original ST.25 sequence listing will need to be converted into the new ST.26 format. Sequence listings for European divisional applications may therefore take significantly longer to prepare.

Where the original ST.25 sequence listing formed part of the description, the conversion into the new ST.26 format must neither add nor omit subject-matter compared to the parent application.

Authors:
Gemma Seabright & Nathaniel Wand

Patentability of computer simulations
Clean energy and energy management solutions

Rising energy prices and a global climate crisis have led to an ever-increasing demand for lower cost clean energy solutions (such as solar energy, wind energy, tidal energy or the like). As a consequence, home energy storage solutions have become more widespread as they enable consumers to capitalise on lower energy tariffs whilst addressing problems related to the inherent supply variability of some forms of clean energy (for example, solar energy). For example, home energy storage solutions enable a consumer to store excess energy when it is produced (such as by solar panels during the day) for use at a later time (for example, at night). Alternatively, a consumer can sell surplus energy back to the electricity transmission network at times of peak network demand.

However, clean energy sources and independent energy storage solutions can further complicate control of electricity transmission networks. That is, control of a transmission network in which a large number of independent clean energy sources and storage solutions are integrated with conventional energy sources (such as power stations) can become very complex. Computer simulations can be used in order to identify potential shortfalls in energy supply before they occur and to predict the levelised cost of energy in the transmission network. Indeed, simulations enable an optimal configuration of available energy sources and energy storage solutions to be determined in order to reduce the overall cost of supplying electricity. Therefore, computer simulations can reduce the complexity of control of an electrical transmission network and other types of energy management solutions.

With investment in clean energy solutions on the rise, an interesting question arises how patents can be used in order to protect innovation in energy management solutions and, in particular, the complex simulations underpinning these solutions.

In this article we review the legal position of patenting simulations at the European Patent Office (EPO) and consider how this can be applied to energy management solutions.

Computer simulations

In order for a computer-implemented method such as a computer-implemented simulation to be patentable, it must be new, involve an inventive step and be susceptible of industrial application. Of these requirements, it is often inventive step which is most difficult to demonstrate for a computer-implemented simulation.

The decision G1/19 issued by the Enlarged Board of Appeal of the EPO clarified that computer-implemented methods of simulating, designing or modelling should be examined for inventive step according to the same criteria as any other computer-implemented inventions (that is, using the COMVIK approach).

In the COMVIK approach the differences between the subject matter of the claim and the closest prior art are identified. If the differences do not make any technical contribution, an objection of lack of inventive step under Article 56 EPC is raised. However, if the differences do make a technical contribution over the closest prior art, the inventiveness of these features is assessed through the well-established problem-solution framework.

Therefore, in the COMVIK approach (which, following G 1/19, should be applied to computer-implemented simulations) all those features which contribute to producing a technical effect serving a technical purpose contribute to the technical character of the invention and should be considered during the assessment of inventive step.

In G 1/19 the Enlarged Board of Appeal noted that it was necessary to leave the definition of what constitutes a technical feature open, in order that such a definition could be extended to accommodate new scientific developments (see, for example, G 1/19, point 77). Therefore, it remains difficult to explicitly define which features of a computer-implemented simulation will be considered in an assessment of inventive step. However, the Enlarged Board of Appeal held that, for establishing the presence of a technical effect, it is not sufficient that the simulation is based on technical principles underlying the simulated system or process.

In other words, the fact that a computer-implemented simulation simulates a technical system or process is not decisive in whether the simulation produces a technical effect.

Instead, what is required is that the claimed features produce a further technical effect going beyond the straightforward or unspecified implementation on a standard computer system (G 1/19, points 50 and 51, citing T 1173/97 and G 3/08). This should be assessed on a case-by-case basis (G 1/19, point 141).

In the context of a computer-implemented simulation, the Enlarged Board of Appeal noted that the necessary further technical effects could be obtained in a number of different ways.

First, a computer-implemented simulation comprising features which interact with an external physical reality at the level of their input or output may provide a technical effect related to this interaction. For example, a computer-implemented simulation may provide a technical effect through an input measurement method that calculates or predicts the physical state of an existing real object. This would provide a technical effect which could contribute to the assessment of inventive step. Alternatively, a computer-implemented simulation may provide an output such as a control signal which causes a change in a physical state of an existing real object which would provide a technical effect which could contribute to the assessment of inventive step.

However, according to the Enlarged Board of Appeal in G 1/19, even a computer-implemented simulation without an input or output having a direct link with physical reality (such as a purely numerical simulation) may still provide a technical effect solving a technical problem which can contribute to the assessment of inventive step. For example, the technical contribution of a model or simulation may be that it is specifically adapted to the internal functioning of the computer system or network on which it is implemented (see G 1/19, point 115).

Furthermore, in the case of a numerical simulation, a technical effect may arise from the further use of such data. That is, if the

Computer simulations are key to the design of clean energy transmission networks

claimed process results in a set of numerical values, it depends on the further use of such data (which can happen as a result of human intervention or automatically within a wider technical process) whether a resulting technical effect can be considered during the assessment of inventive step. It was held by the Enlarged Board of Appeal in G 1/19 that if such further use is not at least implicitly specified in the claim then the further use (and technical effect arising from such further use) will be disregarded from the assessment of inventive step (see point 137, G 1/19).

Accordingly, the decision G 1/19 of the Enlarged Board of Appeal confirms that computer-implemented simulations are patentable at the EPO provided that they satisfy the requirements of novelty, inventive step and industrial applicability. Following the COMVIK approach for computer-implemented methods, only those features which provide a technical effect serving a technical purpose will be considered during the assessment of inventive step.

Application to energy management solutions

As computer-implemented simulations are patentable at the EPO, it is possible to obtain patent protection for innovation in the area of energy management solutions when those solutions are based on simulations. Therefore, a potential applicant should not be discouraged from filing a patent application at the EPO merely because their invention lies in improvements to a computer-implemented simulation.

However, given the complexity of the case law surrounding computer-implemented simulations at the EPO, it is important for an applicant to carefully analyse their solution in order to identify aspects of the simulation which can be linked to the production of a technical effect which can contribute to the assessment of inventive step. The patent application for such an invention should be carefully crafted in order that these aspects are highlighted and explained such that an inventive step can be demonstrated during prosecution of the application at the EPO.

It must be remembered that for the purpose of establishing the presence of a technical effect, it is not sufficient that the simulation is based on technical principles underlying the simulated system or process. Therefore, the mere fact that the simulation is directed to modelling a technical situation, such as the distribution of energy from different sources within a transmission network, may not itself be sufficient to demonstrate a technical effect at the EPO.

Instead, a technical effect produced by the simulation will be required in order that an inventive step can be demonstrated. Where a simulation interacts with the physical state of an existing real object (such as an electricity transmission network) such an interaction may be used to demonstrate the existence of a technical effect. For example, if a simulation results in the generation of a control signal which is used in order to change the way electricity is distributed within an electricity transmission network (by activating or deactivating certain energy sources) it is likely that the simulation will be considered to produce a technical effect which can contribute to an inventive step.

Particular care should be taken when the simulation is a purely numerical simulation which does not involve an interaction with the physical state of an existing real object. In these cases, it should be explained in the application how and why the simulation is adapted for a specific technical implementation (for example, how and why the prediction of levelised cost of energy in a transmission network can be performed with particularly efficient use of storage or computational resources). Alternatively, if the technical effect arises from the future use of the results of the simulation, that future use should be at least implicitly specified by the wording of the claims. For example, this may arise when a numerical simulation is used during the design of a future wind farm to predict the placement of turbine-generator units to meet a certain energy production requirement. If the future use of the results of the simulation is not at least implicitly specified by the wording of the claims in this situation, then it may be very difficult to convince an examiner at the EPO of the presence of an inventive step.

Conclusion

Demand for lower cost clean energy solutions is set to increase in the coming years as governments take further action to address rising energy costs and the global climate crisis. Computer simulations will likely play an important role in the design and control of energy transmission networks incorporating these clean energy solutions. Patent applications for simulations at the EPO must be handled with particular care in order to ensure that the technical effect of the simulation is apparent from the application.

Author:
Simon Schofield

Introduction of Rule 56a EPC
Correction of erroneously filed parts of a patent application

European patent law currently provides applicants with a limited window following the filing date of a patent application to file further parts of the description or drawings that were missing in the documents originally filed. Specifically, Rule 56 EPC allows applicants to file missing parts of the description of drawings within two months of the filing date or from a notification from the European Patent Office (EPO) that missing parts have been identified. If this provision is used, the filing date of the application is re-dated to the date the missing parts are received at the EPO, unless these parts were completely contained in an earlier application from which the application claims priority.

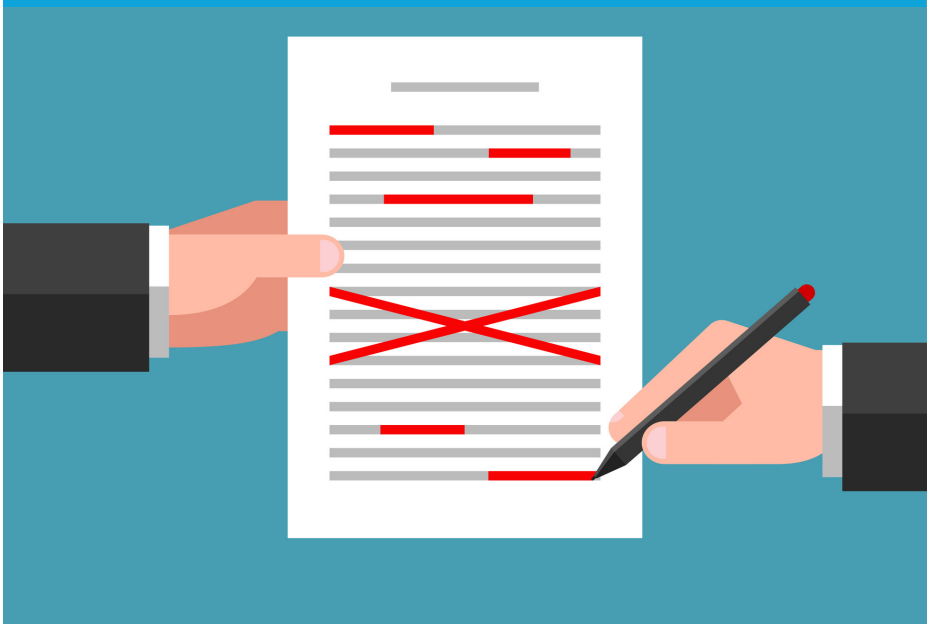
There is no provision at present, however, to correct the filing of **erroneously** filed parts, that is, parts of the application that were never intended to be filed but will, however, be published if the application is not withdrawn. Thus, in the situation where erroneously filed parts of the description or drawings disclose information that should not be made public for commercial reasons, the only solution under the law as it stands is to simply withdraw the application containing the erroneous subject-matter and file another application. In this unfortunate situation, the filing fee already paid for the application containing the erroneously filed parts would be lost, and, more seriously, having to refile the application at a later date could result in the priority claim being lost due to filing outside the priority year.

New Rule 56a EPC

This is set to change from November 2022 with the introduction of new Rule 56a EPC. This new rule will bring the EPC into line with an equivalent provision introduced into the PCT in July 2020, Rule 20.5bis PCT. These provisions of the EPC and PCT, in contrast to previous "missing parts" provisions, explicitly provide for the **exchange** of correct parts of the description or drawings with the erroneously filed parts of the description or drawings in a patent application after filing.

From November 2022, in addition to being able to introduce missing parts of the description and drawings in the two-month window after filing or notification from the EPO, it will also be possible for applicants to correct erroneously filed parts of the application, which will be deemed not to have been filed under the new provisions and hence not be published. The EPO will, from November 2022, also fully apply Rule 20.5bis PCT when acting as receiving office, thus enabling applicants to make use of the analogous procedure under the PCT for international applications filed at the EPO.

Rule 56a EPC allows for the exchange of corrected parts for erroneously filed parts



The procedural aspects of new Rule 56a EPC will essentially mirror those of current Rule 56 EPC. If the erroneous parts of the description or drawings are corrected after the filing date, the application will be re-dated to the date on which the correct parts are received, unless those parts are completely contained in an earlier application from which the application containing erroneously filed parts claims priority.

It is important to note that a significant difference between new Rule 56a EPC and current Rule 56 EPC is that in order to retain the filing date due to the correct parts being "completely contained" in the earlier application, priority must have been claimed from this earlier application on the filing date of the application. This contrasts with the situation for current Rule 56 EPC, where priority of an earlier application may be claimed after filing in order to introduce missing parts completely contained in that earlier application. Rule 56a EPC will thus be less flexible for applicants, and shows the importance of declaring priority of any relevant earlier applications on the filing date.

Conclusion

Of course, it is good practice to avoid reliance on such provisions in the first place, and indeed the use of such provisions is rare in practice. However, it would be naïve to assume that filing errors never occur, and hence it is important to be aware of how such errors can be corrected. In the event that errors are identified with a particular application, it is also best practice to file a corrected application as soon as possible, without paying fees, as an additional safety measure in case there is any issue with the use of the provisions discussed above.

Author:
Khalil Davis

EPO procedure & practice

ViCo at the EPO
Pilot project for videoconferencing in opposition extended to 31 December 2022

On 06 April 2022, it was announced that the President of the European Patent Office (EPO) has decided to further extend the pilot project for oral proceedings in opposition by videoconference (ViCo) until 31 December 2022.

Although requesting oral proceedings to be held by ViCo has been something parties have been able to do for some time, doing so only started to become more commonplace for oral proceedings before the examining division during the past few years. Since March 2020, as a result of the Covid-19 pandemic, oral proceedings before the examining division have been held effectively exclusively by ViCo. It appears likely that this will continue to be the case for all examining division oral proceedings in future, unless there are "serious reasons" against it.

As a result of the Covid-19 pandemic, appeal and opposition oral proceedings have also been held by ViCo in recent years. There is however a greater expectation that there will be a return to in-person oral proceedings for appeals and oppositions than for oral proceedings before the examining division in future, and indeed the Enlarged Board of Appeal did acknowledge in G1/21 that "in-person oral proceedings are for now the optimum format".

Holding oral proceedings by ViCo offers several advantages over in-person proceedings, namely in terms of savings in time and cost, as well as a reduced environmental impact through minimised travel. Furthermore, it has been noted that holding oral proceedings by ViCo makes it easier for accompanying persons (such as expert witnesses and inventors), as well as members of the public, to attend the oral proceedings, while representatives are able to make use of in-office services during the proceedings such as printing and assistance from colleagues. However, disadvantages of holding oral proceedings by ViCo, such as the perceived greater difficulty in presenting arguments and use of non-verbal communication, as well as risks of internet drop-out and other technical faults, have been noted too. An EPO survey conducted in September 2021 observed that roughly two-thirds of respondents believe the provision of oral proceedings in opposition by ViCo to be either "good" or "very good".

Given the generally positive view taken on oral proceedings in opposition by ViCo, as well as the ongoing impacts and restrictions associated with the Covid-19 pandemic, the EPO has extended the pilot project for oral proceedings in opposition by ViCo until 31 December 2022. Similarly to oral proceedings in examination by ViCo, only "serious reasons" preventing oral proceedings in opposition to be carried out by ViCo may result in the proceedings taking place in-person, and in such cases the proceedings will be postponed until after 31 December 2022.

The EPO is, in parallel with the extension of the pilot project, taking further steps towards helping representatives with oral proceedings via ViCo. Such steps include the implementation of additional features in Zoom, such as digital whiteboards and additional channels for language interpretation and conferring within parties who are disparately located being made available, as well as the updating and broadening of the EPO's training portfolio for oral proceedings by ViCo.

As ever, D Young & Co remains committed to assisting clients in all matters, including representation at oral proceedings in opposition.

Author:
David Al-Khalili

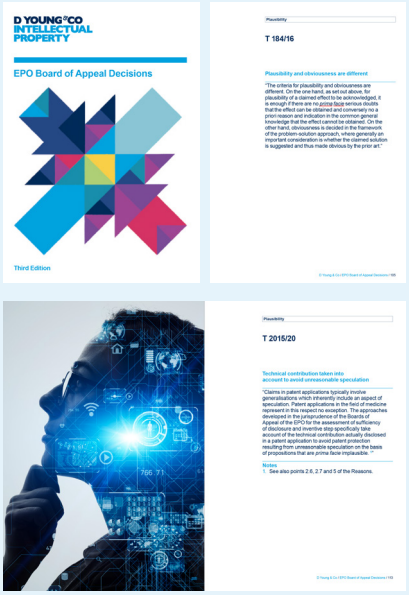
Guide to ViCo at the EPO
We have drawn from our experience of ex parte and inter partes oral proceedings before the EPO by video conference to prepare a guide for participants covering what to expect and how best to prepare. The guide includes our handy client "Checklist for ViCo": www.dyoung.com/vico-guide

Ebook download

EPO Board of Appeal Decisions
Third edition ebook

The third edition of our book of decisions from the European Patent Office (EPO) Boards of Appeal is now available as an ebook download. The selected Board of Appeal decisions have been chosen on the basis of many years of experience in arguing cases before the EPO. In general, they represent some of the most useful and frequently cited decisions used by D Young & Co's patent group during both our defence of and opposition to European patents. In this third edition we have included a number of additional cases and an updated section on the Rules of Procedure of the Boards of Appeal of the European Patent Office. We have also included a new section on oral proceedings being held by video conference (ViCo).

Contributors
The book was written and co-edited by members of our biotechnology, chemistry and pharmaceuticals patent group - Charles Harding, Antony Latham, Matthew Gallon and Rachel Bateman.



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EPO description amendments
The saga continues

There was a collective sigh of relief from many European Patent Office (EPO) users when, towards the end of 2021, an EPO Board of Appeal set aside a decision of the Examining Division to refuse a patent application on the basis of the description not having been adapted to bring it into conformity with an allowable set of claims.

T 1989/18: adaptation of the description of a European patent application
The EPO Board of Appeal considered whether there was legal basis for refusing an application if the description was not adapted to the subject matter of the claims:
https://dycip.com/t198918-ac-04jan22

The issue is far from settled, however, with conflicting Board of Appeal decisions since being issued and the March 2022 edition of the EPO's Guidelines for Examination maintaining the requirements to amend the description.

Why is this an issue?
Under European patent law the scope of protection sought via a European patent application is defined by the claims. Example ways of working the invention (so-called "embodiments") are described in the description. During the prosecution of a patent application, the scope of the claims may be changed. For example, to render the claims novel and inventive over cited prior art, the scope of the claims may be narrowed. This may cause some of the original embodiments in the description to no longer fall within the scope of the claims.

The position of the EPO (at least according to the latest Guidelines for Examination) is therefore that corresponding amendments should be made to the description. For example, embodiments no longer falling within the scope of the claims should either be deleted or marked as "not according to the claimed invention". Applicants, however, often have good reason for not wanting to make such amendments to the description. First, there may be diverging views between the examiner and the applicant as to whether or not a particular embodiment falls within the scope of the amended claims.

Second, there are often corresponding patent applications in other jurisdictions which, due to the differences in patent law between jurisdictions, may provide a different sought scope of protection to the European patent application. Stating in the text of the European patent application that a particular embodiment is "not according to the claimed invention" may therefore cause problems down the line in these other jurisdictions (for example, in post-grant infringement or validity proceedings).

Third, reviewing and amending the description in its entirety is often a non-trivial task which can take significant amounts of time. This results in cost being incurred by the applicant in addition to the costs already incurred in obtaining an allowable set of claims.

On the other hand, it is important for any granted patent to be an internally consistent legal document and for the scope of protection conferred by that patent to be completely clear.

What does the law say?
The European Patent Convention (EPC) does not directly address the need to amend the description to bring it into conformity with an amended set of claims. It does, however, contain a number of provisions which are commonly cited in the case law.

Perhaps the most important is Article 84 EPC: "The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description."

There is also Rule 42(1)(c) EPC: "[The description shall:] disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art."

Furthermore, Rule 48(1)(c) EPC states: "[The European patent application shall not contain:] any statement or other matter obviously irrelevant or unnecessary under the circumstances."

There is also Article 69(1) EPC, relating to the extent of protection conferred by a European patent or patent application. However, given that it is national courts (and, soon, the Unified Patent Court (UPC)) rather than the EPO which have jurisdiction to decide on the extent of protection conferred by a patent, it seems that the Boards of Appeal (with the exception, perhaps, of T 1024/18) are reluctant to give too much weight to this provision.

The case law
The current requirements for amending the description according to the Guidelines for Examination (in particular, Part F-IV 4.3) seem to be based primarily on T 1808/06. Here, the Board of Appeal concluded that: "In order to meet the requirement of Article 84 EPC that the claims have to be supported by the description, the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear."

T 1808/06 of 14 February 2008
Read the full decision:
https://dycip.com/t180806

T 1808/06 is well-established. It was the March 2021 version of the Guidelines for Examination, however, which explicitly introduced and elaborated on the specific requirements for amending the description. Many EPO users found the requirements particularly onerous and it was the most commonly-raised issue during the EPO's subsequent Guidelines for Examination consultation.

Should apparent discrepancies between the claims and description cause refusal?

Consultation on EPC and PCT-EPO Guidelines – Spring 2021
Read the consultation (pdf):
https://dycip.com/consulation-epc-pct-2021

T 1989/18 was published in December 2021. This decision diverged from T 1808/06, stating: "Article 84 EPC only mentions the description in the context of the additional requirement that it must support the claims. … [I]f the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject-matter which is not claimed."

Accordingly, Article 84 EPC could not serve as legal basis for refusing a patent application simply because the description had not been adapted.

It was also concluded that the relevant passages of the description did not impair the "understanding of the technical problem and its solution" required under Rule 42(1)(c) EPC and that there were no legal consequences in the EPC for having "obviously irrelevant or unnecessary" matter in the patent application according to Rule 48(1)(c) EPC.

T 1024/18 was published in March 2022. It explicitly diverged from T 1989/18 by interpreting the need in Article 84 EPC for the claims to be "supported by the description" as the description being consistent with the claims "not only in some part but throughout". Any inconsistency between the description and the claims therefore meant the claims were not supported by the description as required by Article 84 EPC.

T 1989/18 (Adaptation of the description/HOFFMANN-LA ROCHE) of 16 December 2021
Read the full decision:
https://dycip.com/t198918

Recently, T 1444/20 (published in April 2022) took a similar interpretation to T 1989/18. It concluded there was nothing to suggest that "the current claims are not clear in themselves to a person skilled in the art". It was also found that the "Specific embodiments of the invention" mentioned in the description (which appeared to be considered as "claim-like clauses") could not be mistaken for claims. Article 84 EPC therefore could not be used as a justification for objecting to the claims.

T 1444/20 also concluded that, in the absence of an objection under Article 82 EPC (that is, a lack of unity of invention), Rule 42(1)(c) EPC did not "translate into a requirement to bring the description in line with claims intended for grant, and to remove passages of the description that disclose embodiments which are not claimed" and that the description did not "impair the understanding of the technical problem and its solution". T 1444/20 also explicitly agreed with much of the analysis of T 1989/18 regarding Rule 48(1)(c) EPC. It was thus concluded that neither Rule 42(1)(c) EPC nor Rule 48(1)(c) could be used as justification for refusing the application.

T 1444/20 of 28 April 2022
Read the full decision:
https://dycip.com/t144420

What next?

These cases do seem to relate to slightly different scenarios. For example, T 1444/20 is focused on the deletion of "claim-like clauses". T 1024/18 relates primarily to a specific embodiment in the description being inconsistent with the claims. T 1989/18 considers the specific case of an embodiment in the description with a broader scope than the claims. However, they all relate to the issue of whether or not a patent application can be refused for not complying with the EPC because of apparent discrepancies between the claims and the description. There does not appear to be a consistent answer to this.

The EPC does, of course, anticipate such scenarios. To ensure uniform application of the law, Article 112 EPC provides for questions of law to be referred to EPO's Enlarged Board of Appeal by either the Board of Appeal or the President of the EPO. So, it might not be surprising if we see the question of description amendments being referred to the Enlarged Board of Appeal before too long.

In the meantime, in these uncertain times, we can expect EPO users to continue to try their luck arguing for whichever interpretation of the law best helps their case.

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And finally...

UP & UPC

Online demo mode access to UP forms

EPO unitary patent and Unified Patent Court preparations

On 16 June 2022 the European Patent Office (EPO) announced that its online filing system now offers access to unitary patent forms in demo mode.

It is not yet possible to access forms in production mode, but the demonstration mode allows patent applicants and their representatives to familiarise themselves with the new unitary patent features such as drafting, signing and sending requests for unitary effect and subsequently filed documents.

This is a welcome step forward in preparations for the unitary patent, which is expected to launch together with the Unified Patent Court in late 2022 or early 2023. We eagerly await a separate update on the UPC Case Management System which will enable opt-outs to be filed once the sunrise period commences.

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Our UP & UPC resources, including articles, webinars and guides, are online at www.dyoung.com/upandupc

Webinars include:

- Introduction to the UP & UPC
- UPC opt out
- Unitary patent v European patent validation
- UPC: representation and judges
- UPC: structure, language and where to start a case

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