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European Patent Office
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Germany

Via Email: patentlaw@epo.org

Re: Public online user consultation on the Guidelines

Dear European Patent Office:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on the updated Guidelines for Examination in the EPO (Guidelines) published on the 1st of February 2023.

IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO’s vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO’s mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO is grateful for this opportunity to share feedback. It provides the following general comments on the Guidelines review process, followed by specific comments on Section F-IV 4.3 of the Guidelines (which concerns description amendments). It hopes that our suggestions will be helpful to the EPO’s continued efforts to improve the Guidelines.

Annual Revision of the Guidelines for Examination

IPO commends the EPO for seeking to regularly update and improve the Guidelines and, in particular, the ongoing efforts to increase both the clarity of the Guidelines and the consistency of their application. IPO has two suggestions regarding certain aspects of the current drafting and review process.

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IPO believes that, for further clarity and consistency, the Guidelines should only establish definitive positions when there is settled law. When the Guidelines seek to establish a definitive position on an aspect of examination which goes beyond settled law, changes to the Guidelines can lead to creation of new law as Examining/Opposition Divisions and Boards of Appeal are faced with disagreements between Examiners and Applicants/Proprietors/Opponents which may not have arisen otherwise. In addition, areas of the Guidelines that are more prescriptive than the case law allows are also prone to inconsistency in application by Examiners.

Also, IPO would suggest that the review process should ask for comments on the Guidelines before they enter into force. The current review process invites comments on each edition of the Guidelines after their entry into force. The current consultation concerns the 2023 edition of the Guidelines, which entered into force on 1 March 2023. IPO expects that allowing comment on Guidelines after they enter into force could make it more difficult for significant revisions to be made in light of user feedback. Furthermore, through the annual revision cycle, the subject edition of the Guidelines will have been in force by the time any such revisions are made. During that time, decisions are made on the basis of those Guidelines. Changing the timeline for comments could have a positive impact on consistency and clarity, both for users and for the Office.

In the following section, IPO outlines its concerns with the section of the Guidelines relating to description amendments, and highlights challenges associated with the application of the current Guidelines.

Guidelines on Description Amendments

In 2021, the Guidelines were updated to clarify the requirements relating to description amendments. Section F-IV 4.3 begins:

“Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence.”

This requirement for consistency between description and claims is not, *per se*, new. However, a number of additions were made to the Guidelines that suggest the EPO intended to take a much stricter approach than it previously had. By way of example, the following guidance was added:

“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).

[...] 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.

Similarly, subject-matter in the description being excluded from patentability 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”

Legal & Procedural Developments

It is not clear that a stricter approach is consistent with the state of the law. The Boards of Appeal have had, and continue to hold, divergent views on the need for and required extent of description amendments. Even after the 2021 Guidelines were published, several BoA decisions have concluded that there is no legal basis for requiring strict correspondence between the allowed claims and the description. These include at least T 1989/18, T 2194/19 and T 1444/20.

Although later editions of the Guidelines have attempted to moderate the strictness of some of requirements found in the 2021 update, IPO believes that the Guidelines can still be, and sometimes are, interpreted to provide a strict approach to what is not yet a settled area of the law.

Applicants continue to experience widely divergent approaches from Examiners, with some Examiners requiring no or only very minor description amendments, and others mandating such significant amendments that whole pages of the description have to be deleted, including embodiments which, while not explicitly recited by the claims, still fall within their scope.

Procedural Certainty and Equitable Examination

Such inconsistent approaches create significant procedural uncertainty, both for applicants and for third parties seeking to interpret granted claims. To facilitate predictability and fairness amongst applicants, IPO suggests that the EPO should adopt a more consistent and more moderate approach to description amendments.

Under the current situation, for applicants, not knowing what the Examiner’s approach will be makes it difficult to predict what kind of description amendments will be required. If multiple rounds of amendments are needed to reach agreement, even after the claims have been declared allowable, grant will be significantly delayed, and the enforceable life of the ensuing patent shortened as a result. This uncertainty also prevents applicants from being able to pursue efficient prosecution strategies. For example, an applicant may be more reluctant to make certain claim amendments out of concern that the Examiner might require very strict compliance between claims and description – which could in turn, again, delay grant.

For third parties, the inconsistent approach to description amendments by Examiners will make it impossible to know whether an embodiment has been deleted because it truly is not part of the invention, or because the patentee was required to make overly broad deletions from the description in order to get a notice of allowance.

In addition, continuing to try to enforce very strict, literal correspondence between description and claims puts applicants for European patents at a significant disadvantage, and not just because of the additional costs and time involved in navigating overly strict requirements, but because of the additional issues explained herein.

For the sake of procedural certainty, fairness amongst applicants, and clarity for third parties, we strongly believe that the EPO should adopt a more consistent and, importantly, a more moderate approach to description amendments, in line with other major patent-granting bodies.

Post-Grant Impact

The description is a critical part of any patent and will be used to interpret the claims during any post-grant validity or infringement actions. Importantly, the very fact of having made amendments to the description will also be used to infer meaning and limitations to the claims. Prosecution history estoppel is frequently used in litigation for the purposes of claim construction and to preclude a patentee from invoking the doctrine of equivalents to broaden the scope of their claims to cover subject matter ceded by the amendments. Critically, European prosecution history estoppel can be used in courts even outside of Europe, including in the U.S., as admissions by the patentee that limit claim scope interpretation.

Forcing an applicant to delete subject matter from the description because it doesn't explicitly appear in the claims can be used to:

- *Infer a lack of novelty or inventive step:* Since the Guidelines state that “subject-matter in the description being excluded from patentability needs to be excised,” litigants will argue that amendments by the applicant were an admission of a lack of patentability;
- *Infer limitations to claim construction:* Since the Guidelines state that “embodiments in the description which are no longer covered by the independent claims must be deleted,” litigants will argue that the applicant knowingly and intentionally limited the scope of their claims by deleting or “disclaiming” subject matter from the description. This will be especially problematic where the applicant is forced to make unduly broad deletions, including of embodiments that are in fact still within the scope of the claims;
- *Limit the use of the doctrine of equivalents:* Requiring strict compliance between description and claims will result in litigants arguing that strict compliance with the literal meaning of the claims was an essential requirement of the invention and that equivalents cannot therefore be deemed to infringe the claims.

An unduly strict approach to description amendments will put patentees who have obtained protection through the EPO at a severe disadvantage post-grant, not just in Europe but beyond, and could discourage applicants from using the EPO altogether.

Unique Requirement

To the best of IPO's knowledge, no other major jurisdiction has requirements for description amendments as strict or severe as those set out by the EPO Guidelines for Examination as interpreted and implemented by at least some Examiners. The resulting uncertainty, lack of fairness, and impact on enforcement impose an undue cost on the applicant and do not support the fundamental premises of patent protection. It makes the EPO a far less desirable route to protection and could result in applicants choosing other forums instead. A more consistent, more moderate approach would be beneficial for all.

Final Remarks

IPO believes that a renewed effort is needed to ensure that the Guidelines do not extend beyond settled case-law. In addition, IPO considers that a review process that allows draft changes to the Guidelines to be commented on before entry into force would improve the feedback and review process. Finally, IPO suggests that the EPO adopt a more consistent and more moderate approach to description amendments.

IPO thanks the EPO for its attention to IPO's comments submitted herein, and welcomes further dialogue and opportunity to provide additional comments.

Sincerely,



Karen Cochran
President