

Deletion of “claim-like” clauses: an EPO Board of Appeal allows them to remain in the granted patent (T 0438/22)

Summary

A recent decision T 0438/22 from the EPO’s Boards of Appeal questions the justification for the EPO’s Guidelines for Examination requirement that “claim-like” clauses in the description of the patent specification be unconditionally deleted.

The debate at the heart of the decision revolves around the inclusion of “claim-like” clauses: clauses present in the description that despite not being specified as a claim, are structured as such. They are often found in divisional applications, where the original set of claims from the parent application may be appended to the description as “claim-like” clauses.

Legal basis relating to the removal of claim-like clauses

Article 69 EPC currently stipulates that the patent description will be used when interpreting the claims, from which it follows that claims can only adequately define the invention if they are not contradicted by any subject matter present in the description. Thus, amendments to the description might also affect how the claims are interpreted during infringement proceedings after the patent has been granted. A contradiction between the claims and the description may be considered to contravene Article 84 EPC (“The claims ... shall be clear and concise and be supported by the description”).

The EPO Guidelines for Examination, applying Article 84 EPC, specifically state

concerning “claim-like clauses” that **“claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought”** (F-IV, 4.4).

T 0438/22 concerned Intel’s patent application “Distributed Semiconductor Die and Package Architecture” (EP3511980). This application was refused by the examining division on the grounds that in the main request, the description contained “claim-like clauses” and so contravened Article 84 EPC.

Intel’s argument was that there was no decision from the Boards of Appeal forming the basis of these Guidelines; they were solely based on the practice of the examining divisions. Intel cited decision T 1989/18, in which the Board of Appeal searched for but failed to find any legal basis in the EPC for the requirement that the description must be brought in line with the claims. Furthermore, Intel asked for a referral to the Enlarged Board of Appeal regarding whether it was justified to require an applicant to completely remove whole sections of the description because the wording was ascertained to be “claim-like”.

While agreeing with Intel that there was no prior Board of Appeal authority for the Guidelines on the removal of “claim-like” clauses, the Board disagreed with Intel about the overarching principle of adaptation. The Board of Appeal reiterated that the description must be adapted to be consistent with the allowed claims, and that according to the principles set out in the Vienna Convention “the object and purpose of a legal provision may be derived not only from its literal wording but also from its context within the statute”. Therefore, while Article 84 EPC is primarily directed to the claims, the question of what criteria apply to amendments that can legitimately be required by the examining division can be addressed considering the EPC as a whole.

The Board held that there was no legal basis requiring claim-like clauses to be deleted simply because they were drafted in that form. However, the Board considered that the patent specification represents a unitary legal title. Therefore, the description should serve the overriding objective to provide a common understanding and interpretation of the claims. Accordingly, it was legitimate to insist on removal of subject matter from the description that impedes this common understanding.

Based on these considerations, the Board of Appeal decided that the applicant need not remove the claim-like clauses, but required them to be amended so that the clause wording was not inconsistent with the claims.

Looking to the future

In the present case a referral to the Enlarged Board of Appeal was refused. However, the question of whether the EPO can refuse an application if the applicant does not amend inconsistencies between the description and the claims is expected to be referred to the Enlarged Board of Appeal in appeal case T 56/21. A decision from the Enlarged Board may clarify the issue, on which the Boards of Appeal still seem to be in disagreement.