

**CA/PL 27/99**

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Munich, 05.11.1999

SUBJECT: Revision of the EPC: Articles 84, 100 and 138 EPC

DRAWN UP BY: European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

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#### SUMMARY

This document revisits a proposal to the effect that lack of support of the claims by the description under Art. 84 EPC should be made into a ground of opposition or revocation under Arts. 100 and 138 EPC, and concludes that that this should not be done.

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## I. INTRODUCTION

1. Under the EPC, the grounds on which a patent may be opposed or revoked are exhaustively listed in Art. 100 and Art. 138 EPC respectively. Thus, a patent may be invalidated *inter alia* on the grounds that the subject-matter is not patentable within the terms of Arts. 52 to 57 EPC,<sup>(1)</sup> as well as when the specification does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,<sup>(2)</sup> thereby failing to comply with Art. 83 EPC. However, non-compliance with Art. 84 EPC, stating that "(t)he claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description", does not constitute a ground of invalidity.
2. In 1996, with the objective of allowing unduly broad claims to be attacked post-grant, the UK delegation proposed that the Committee on Patent Law should consider whether lack of support of the claims by the description, thus contravening the second sentence of Art. 84 EPC, should be made a ground of opposition and revocation under Arts. 100 and 138 EPC respectively.<sup>(3)</sup> This request was reiterated at the beginning of this Committee's work on the EPC revision,<sup>(4)</sup> reflecting ongoing concerns about this point in the United Kingdom.
3. Earlier discussions in this Committee failed to elicit substantial support for this proposal from other delegations, most of which felt that current grounds of invalidity were sufficient to solve the problems posed by unduly broad claims.<sup>(5)</sup> In SACEPO, there was no agreement on this point. However, several important groups opposed the proposal: UNICE, FICPI and the *Deutsche Anwaltskammer*. The gulf between the two positions may be explained by the differences regarding claims and their interpretation which existed prior to the creation of the EPC in the national laws of the United Kingdom on the one hand, and of the continental patent systems on the other.

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<sup>(1)</sup> Arts. 100(a) and 138(1)(a) EPC.

<sup>(2)</sup> Arts. 100(b) and 138(1)(b) EPC.

<sup>(3)</sup> See CA/PL 4/96.

<sup>(4)</sup> See CA/16/98, point III.F.

<sup>(5)</sup> See CA/PL 8/96 at p. 12, paragraph 58.

4. In fact, a perusal of the national legislation of the EPC contracting states governing the requirement of support as found in the second sentence of Art. 84 EPC underscores the complexity and difficulty of the issue. Whereas 10 member states either contain a *verbatim* provision in their respective Patent Acts (AT, BE, CY, ES, FR, GR, IE, LU, UK) or are planning to implement one in their current draft patent law (MC), 9 member states appear to have no reference to this requirement at all, either in their statutes, or in their implementing regulations (CH+LI, DE, DK, FI, IT, NL, PT, SE). It may be further noted that in Switzerland, this requirement was originally inserted in Art. 29(2) of the Patent Regulations, but the clause was deleted in 1986. In short, there appears to be no harmonization on this point, indicating how differently this requirement seems to have been construed and weighted within the respective national contexts.
5. Recently, the *epi* suggested that lack of clarity should be made a ground of invalidity.<sup>(6)</sup> However, until now, this has never seriously been contended. Consequently, the contentious issue at hand is confined to the remaining requirement of Art. 84 EPC that the claims be **supported by the description**. Is the omission of this requirement from the list of grounds of opposition and revocation an inherent lacuna in the European patent system, which should be remedied in the course of the current revision exercise?

## II. PROPOSAL TO INCLUDE LACK OF SUPPORT UNDER ART. 84 EPC AS A GROUND OF OPPOSITION / REVOCATION

6. As seen, in CA/PL 4/96, the UK delegation proposed that lack of support under Article 84 EPC should be provided as a ground of opposition and revocation. It argued that whilst there is broad overlap between the requirements of sufficiency of disclosure under Art. 83 EPC and support by the description under Art. 84 EPC, these concepts are not co-extensive. Two particular examples were given illustrating this point:
  - (a) where specifications are sufficient to instruct the skilled reader on how to make all compounds in a class, but where some or most of the compounds do not fulfil the stated purpose or show the technical effect according to the invention; and

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<sup>(6)</sup> This was not suggested in their earlier contribution to the debate on Art. 84 EPC, see Info 4/PL 3, prepared for the third meeting of the Patent Law Committee in 1996.

- (b) where an invention based on a second medical use of a known substance may be sufficiently described, but no evidence is adduced that the treatment has been tried and tested.

7. In these two cases, under old UK law, such claims would have been rejected on the ground of lack of fair basis. Under old UK law, the requirement of sufficient disclosure was regarded as serving the narrower purpose of intending that the public could work the invention after expiry of the patent. Sufficiency was clearly distinguished from the requirement that the claims be fairly based on the matter disclosed in the specification, which performed the function of ensuring that the extent of the monopoly claimed did not exceed the contribution to the art made by the patentee through his specification.<sup>(7)</sup>
8. The present UK proposal for the inclusion of lack of support as a ground of opposition appears to be based on the assumption that lack of support under Art. 84 EPC has been ascribed the same meaning as the objection of lack of fair basis under Sec. 32(1)(i) of the 1949 UK Patents Act. It appears to be assumed that opening lack of support as a ground of opposition would vest a general power in the Opposition Divisions, Boards of Appeal and also national courts to revoke a patent if it was felt that it should either not have been granted, or not have been granted in such wide terms.
9. Therefore, before considering this proposal any further, the significance of the requirement of support under Art. 84 EPC must be analysed in order to determine whether the proposal would be the appropriate means to achieve the desired result.

### **III. THE REQUIREMENT OF SUPPORT OF THE CLAIMS BY THE DESCRIPTION UNDER ART. 84 EPC**

#### **A. ORIGINS OF ART. 84 EPC**

10. The historical materials on the genesis of the EPC offer scant evidence of the legislative intent behind the adoption of Art. 84 EPC. The provision is rooted in Art. 6 PCT, itself probably inspired by requirements found in UK and US law.

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<sup>(7)</sup> On this point, see *Biogen Inc. v. Medeva Plc* [1997] RPC 1, at p. 27.

11. However, the first appearance of this requirement was not in the draft Convention itself, but in a preliminary draft Rule, drawn up in 1963.<sup>(8)</sup> This, in conjunction with the fact that lack of support was not contained in the exhaustive list of grounds for opposition and revocation suggests that the (mainly continental) framers of the EPC considered the provision not to be of a fundamentally substantive character.
12. Once the decision was made to require claims as an independent part of the European patent application, it became necessary to define the purpose of claims and their relationship to the description, particularly in light of Art. 69 EPC and the Protocol on its interpretation. Eventually, the precursor of Art. 84 EPC was deemed important enough to be inserted into the Convention itself.
13. It may be noted that in old UK law, the objection of lack of fair basis formed a ground of invalidity, pursuant to Sec. 32(1)(i) of the UK Patents Act of 1949. However, there is no hint that the fathers of the EPC were aware of the significance of the principle of lack of fair basis in the former UK law.

## **B. EPO PRACTICE**

14. According to the Guidelines for Examination in the EPO, the requirement that the claims must be supported by the description means that there must be a basis in the description for the subject-matter of every claim, and that the scope of the claim must not be broader than is justified by the extent of the description and the drawings.<sup>(9)</sup>
15. Balancing the interests of patentees and third parties, a fair statement of claim is one which is not so broad that it goes beyond the invention, yet not so narrow as to deprive the applicant of a just reward for the disclosure of his invention.<sup>(10)</sup> The Guidelines further specify that as a general rule, a claim should be regarded as supported by the description unless there are well-founded reasons for believing that the skilled man would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to whole of the field claimed by using routine methods of experimentation or analysis. An

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<sup>(8)</sup> For background information on the origins of Art. 84 EPC, see CA/PL 12/95, at pp. 1-2.

<sup>(9)</sup> See the 1999 Guidelines for Examination in the EPO, Part C-III 6, at 6.1.

<sup>(10)</sup> *Ibid.*, Part C-III, 6.2; T 888/90, Sub-combination/BAXTER, OJ 1994, 162, pt. 3.1.

examiner is to raise an objection of lack of support only if he has well-founded reasons.<sup>(11)</sup> However, pursuant to proposed amendments to the Guidelines clarifying the practice of the Office, once the examiner has set out a reasoned case that a broad claim is not supported by the description over the whole of its width, the onus of demonstrating that the claim is fully supported lies with the applicant.<sup>(12)</sup>

16. Finally, examiners are advised that although lack of support is an independent objection under Art. 84 EPC, it can often be considered as an objection of insufficient disclosure under Art. 83 EPC, and although the provision under which the objection is raised is inconsequential at the examination stage, it is important in opposition proceedings where only the latter ground is available.

### **C. INTERPRETATION OF THE REQUIREMENT OF SUPPORT BY THE BOARDS OF APPEAL**

17. The general principle under Art. 84 EPC is that the subject-matter for which protection is sought must be derivable from the claim and that nothing can be claimed which is not disclosed in the description as filed. As worded, the requirement of support by the description could be interpreted as being merely a matter of formal correspondence between the claims and the description. However, over the years, the Boards of Appeal have interpreted this requirement as encompassing two elements: the claims must be both consistent and commensurate with the description.
18. The element of consistency is met when the claims and the description are in agreement. If there are contradictions between the examples contained in the description and the claims, there is no support by the description.<sup>(13)</sup> Thus, a claim which does not contain a feature which is identified as essential in the description is inconsistent with and not supported by the description and is thus open to objection

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<sup>(11)</sup> *Ibid.*, Part C-III, 6.3.

<sup>(12)</sup> Proposed amendments to the Guidelines designed to ensure a stricter application of the requirements of Art. 84 EPC in the examination phase have completed the internal procedure and are expected to be promulgated by decision of the President soon. For the text of these amendments, see SACEPO 26/99, at p. 27.

<sup>(13)</sup> See T 150/85, unpublished, at pts. 3 and 4.

under Art. 84 EPC.<sup>(14)</sup> Put another way, the embodiment contained in the description must squarely fall under the claims.<sup>(15)</sup>

19. The second element encompassed by the requirement of support in Art. 84 EPC is meant to safeguard that the claims do not cover any subject-matter which, after reading the description, still would not be at the disposal of the skilled person.<sup>(16)</sup> On the one hand, Art. 84 EPC entails that claims cannot be drafted so broadly as to encompass activities which are not dependent upon the invention which has been described in the application. On the other hand, Art. 84 EPC clearly envisages that the matter for which protection is sought can be defined in a generalised form, compared to the specific description or embodiments of the invention.<sup>(17)</sup>
20. It is necessary in this context to examine the relationship between Art. 83 and Art. 84 EPC. Article 83 EPC states that the invention must be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Although the requirements of Art. 83 and Art. 84 EPC govern different parts of the patent application, since Art. 83 EPC relates to the disclosure of the invention, whilst Art. 84 EPC deals with the definition of the invention by the claims, the requirements of support by the description and of sufficient disclosure are regarded in at least one case as sharing the same underlying purpose, namely to ensure that the extent of the patent monopoly claimed should be justified by the actual technical contribution to the art.<sup>(18)</sup>
21. Thus, the requirement that the claims be supported by the description has been understood as meaning that they must not only contain all the features presented as being essential in the description, but also reflect the applicants' effective

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<sup>(14)</sup> T 32/82, Control circuit/ICI, OJ 1984, 354, at pt. 15; T 133/85, Amendments/XEROX, OJ 1988, 441, pt.2, at p. 446 ; T 1055/92, Clarity/AMPEX, OJ 1995, 214, at pt. 5; T 939/92, Triazoles/AGREVO, OJ 1996, 309, at pt. 2.2.2.

<sup>(15)</sup> T 237/92, unpublished, at pt. 3.4.

<sup>(16)</sup> T 26/81, "Containers", OJ 1982, 211, at pt. 4; T 409/91, Fuel Oils/ EXXON, OJ 1994, 653, at pt. 3.3.

<sup>(17)</sup> T 133/85, Amendments/XEROX, pt. 5, at p. 448.

<sup>(18)</sup> T 409/91, Fuel Oils/EXXON, at pt. 3.3 and 3.5.

contribution by enabling the skilled person to carry out their teaching throughout the field to which they apply.<sup>(19)</sup> Generally, the issue to be considered when assessing whether claims are adequately supported by the description is whether it can reasonably be assumed that the technical problem the invention is to solve will be solved by the subject-matter of the claim in its entire scope and not only, for example, by a limited portion of that scope, which alone might have been disclosed in the description.<sup>(20)</sup> These cases show that, unlike in old UK law, where sufficiency of disclosure and breadth of claim were distinct concepts - formally, at least - under the precepts of the EPC the extent of the enabling disclosure and the matter of support are considered to be closely linked.

#### **D. CONCLUSION**

22. It appears that both examples put forward by the UK delegation and mentioned above in § 6(a) and (b) would have fallen under the scope of application of the principle of lack of fair basis under old UK law. However, neither could be qualified as cases falling afoul of the requirement of support of the claims by the description under Art. 84 EPC as applied by the EPO and interpreted by the Boards of Appeal.<sup>(21)</sup> Thus the requirement of support under the EPC is not co-extensive with that of lack of fair basis under the old UK law.
23. Furthermore, as pointed out by a Board of Appeal, it does not follow from the requirement that the claims must be supported by the description under Art. 84 EPC that a claim is objectionable simply because it is "unreasonably broad".<sup>(22)</sup>
24. Thus, as an intermediate conclusion, the inclusion of lack of support under Art. 84 EPC in the list of grounds for opposition or revocation would hardly be adapted to achieve the desired result, which appears to be to create a general objection giving

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<sup>(19)</sup> T 659/93, summarised in OJ 1995, Special Edition, at p. 53; see also T 386/94, Chymosin/UNILEVER, OJ 1996, 658, at pt. 6; T 332/94, summarised in OJ 1999, Special Edition, at p. 29.

<sup>(20)</sup> T 126/89, Fluid filter cleaning system/FILTRATION, [1990] EPOR 292, at p. 295, pt. 3.2.

<sup>(21)</sup> See CA/PL 6/96, at pp. 1-2.

<sup>(22)</sup> T 939/92, Triazoles/AGREVO, at pt. 2.2.2.



superior instances full discretion to review the contents and scope of claims which are attacked as being overly broad or "not fairly based" on the description, beyond the parameters established by the case law of the Boards of Appeal.

#### **IV. DEALING WITH UNDULY BROAD CLAIMS UNDER THE EPC**

25. However, this does not mean that unduly broad claims cannot be effectively challenged under the EPC. It is generally accepted that the extent of the patent monopoly should correspond to and be justified by the technical contribution to the art.<sup>(23)</sup>
26. At the examination stage, Art. 84 EPC provides a tool which facilitates an objection to overly broad claims. However, post-grant, the EPC does not provide for a catch-all review of the scope of claims at the superior instance's discretion through a single, generalised clause. Under the EPC, two provisions providing well-defined tests going to the substantive conditions of patentability may be and have been used to achieve this goal: Art. 83 and Art. 56 EPC.
27. Indeed, the test as to whether the claims are commensurate with the contribution to the art has been formulated by the Boards of Appeal in the following manner: the invention must be disclosed so as to be enabling across the breadth of the claim in such a manner as to be reproducible by the man skilled in the art without undue burden or inventive activity.<sup>(24)</sup> Thus, the application as filed must contain sufficient information to allow a person skilled in the art using his common general knowledge to carry out the invention within the whole area claimed.<sup>(25)</sup>
28. In the *Modifying plants cells/MYCOGEN* case, the Board of Appeal showed how closely interrelated and how critical the issues of support of the claims, sufficiency of disclosure and inventive step are in cases where it is particularly difficult to find a proper balance between the breadth of the claims and the actual contribution to the

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<sup>(23)</sup> T 409/91, Fuel Oils/EXXON, at pts. 3.3 and 3.4; T435/91, Detergents/UNILEVER, OJ 1995, 188, at pts 2.2.1 and 2.2.2; T 939/92, Triazoles/AGREVO, at pt. 2.4.2; T 133/85, Amendments/XEROX, at p.448, pt. 5, T 694/92, Modifying plant cells/MYCOGEN, OJ 1997, 408, at pt. 5.

<sup>(24)</sup> T 694/92 Modifying plant cells/MYCOGEN, at pt. 5; T 435/91, Detergents/UNILEVER, at pt. 2.2.1.

<sup>(25)</sup> T 409/91, Fuel Oils/ EXXON, at pt. 2.

art by the disclosure of the patent in suit.<sup>(26)</sup> Indeed, the general legal principle that the extent of the claims should correspond to and be justified by the technical contribution to the art applies not only in the context of sufficiency of the disclosure under Art. 83 EPC, but also governs the test of inventive step under Art. 56 EPC, in that any subject-matter falling within a valid claim must be inventive. If this is not the case, the claim must be amended so as to exclude obvious subject-matter in order to justify the monopoly.<sup>(27)</sup>

## **V. CONCLUSIONS**

29. Calls for the inclusion of Art. 84 EPC as a ground for opposition and revocation may be partly based on a misapprehension of both the contents of the requirement of support of the claims by the description and of the scope of possibilities for attacking unduly broad claims which exist under Arts. 83 and 56 EPC.
30. The introduction of an open-textured, general ground for opposition and revocation based on "lack of support" as currently interpreted by the EPO and the Boards of Appeal would hardly be adapted to achieve the objectives aimed at by the UK proposal, insofar as it would not be co-extensive with the objection of lack of fair basis under old UK law.
31. To make lack of support a general ground of objection allowing an attack on unduly broad claims without a clearly defined content and reliable tests would foster legal insecurity. It would take years for the boundaries to be drawn by the EPO, the Boards of Appeal and national courts.
32. The potential for abuse and frivolous oppositions would be considerable. As pointed out in CA/PL 6/96, broad claims are not bad in themselves, and they should be challenged based on sound reasons. The mere objection that a claim is too broad because not enough examples are given is an easy objection to make, but both justifying and refuting such an allegation are technically and legally difficult tasks.
33. The present system is argued to be balanced and to protect the public adequately against unduly broad claims. The Boards of Appeal have been able to develop clear rules which allow the review of unduly broad claims to be dealt with in a predictable

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<sup>(26)</sup> T 694/92, Modifying plant cells/MYCOGEN, at pt. 8.

<sup>(27)</sup> T 939/92, OJ 1996, 309, at pt. 2.4.2.

manner promoting legal security, through a strict application of the patentability requirements under Art. 56 and 83 EPC. The principle that the claims must be commensurate with the contribution to the art is interpreted as being encompassed in both the requirement of sufficient disclosure under Art. 83 EPC and that of inventive step under Art. 56 EPC.

34. The grounds of invalidity listed under Art. 100 and 138 EPC reflect world-wide standards, the EPC enshrining not only harmonized principles in force in the member states of the Organisation, but having been taken as a model by many third countries in the drawing up of their national legislation. As far as is known, there is no modern patent law which provides that lack of support constitutes a ground for revocation of a patent. Very persuasive evidence would have to be presented to the effect that the current, widely accepted grounds of invalidity are insufficient before introducing new grounds. Moreover, such new grounds would have to be carefully defined so as to be capable of being easily established and accepted by the patent community at large.
  35. Consequently, it is proposed that neither clarity, nor lack of support under Art. 84 EPC should be added to the exhaustive list of grounds for opposition and revocation found respectively in Arts. 100 and 138 EPC.
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