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To the attention of:
the Enlarged Board of Appeal of the European Patent Office
85540 Haar
Germany

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re: Referral G 1/25
Amicus curiae brief submitted pursuant to Article 10 RPEBA by Alessandro COSSU

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I. THE QUESTIONS

1. The questions submitted to the Enlarged Board of Appeal by the Technical Board of Appeal 3.3.02 with the decision **T 697/22** of 27 July 2025 (in the following cited as *the referring decision*) are the following:

> *1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?*
>
> *2. If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?*
>
> *3. Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?*

II. ADMISSIBILITY AND FORMULATION OF THE QUESTIONS

2. It will be assumed in the following that the referral is admissible and that no reformulation of the questions is necessary.

III. THE PROPOSED ANSWERS

3. For the reasons presented in detail below, it is submitted that the three questions should be answered as follows:

> 1. **yes**: if the claims of a European patent are amended **during opposition proceedings or opposition-appeal proceedings**, and the amendment introduces an inconsistency between the amended claims and the description of the patent, in the sense that the description discloses a solution in terms that are partially or wholly not in agreement with the claimed invention, **it is necessary**, to comply with the requirements of the EPC, **to adapt the description to the amended claims so as to remove the inconsistency**;

2. The provisions of the EPC requiring the adaptation of the description to the amended claims are Article 84, second sentence, second half clause, EPC and Rule 42(1)(c) EPC; under certain circumstances, Rule 48(1)(c) EPC is also applicable;

3. no: the answer would be the same as for question 1: if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application, it is likewise necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency.

4. As explained in detail below, it follows from a textual, systematic and historical analysis of the provisions of Part III of the Convention and of the Implementing Regulations that the claims and the description of a European patent application, as part of one and the same document (in view of Art. 78 EPC) having the purpose of clearly disclosing the invention (in view of Art. 83 EPC) for which protection is sought for in terms of claimed technical features (cf. R. 43(1) EPC), must be in agreement with each other.

5. Contrary to the view held in some recent decisions of the Boards of Appeal, the requirement that the claims shall be supported by the description cannot be understood as merely requiring that the subject matter recited in the claims be disclosed *somehow* and *somewhere* in the description, with no restrictions on the disclosure provided by the description: on proper construction of its wording, the expression «*supported by the description*» in the English version of Art. 84, second sentence, second half clause, EPC (and its corresponding counterparts in the German and French versions) also sets a mandatory requirement on the description to disclose a solution that is consistent and not in disagreement with the invention as defined in the claims.

6. Furthermore, also from a systematic consideration of the requirements of sufficiency of disclosure (Art. 83 EPC) and support by the description (Art. 84, second sentence, second half clause, EPC) it follows that the requirement of support cannot be seen as a requirement in respect of the claims only: it also defines a requirement to be satisfied by the description.

7. An interpretation of the requirement of support in Art. 84 EPC as only defining a requirement of the claims, with no conditions being required of the description, conflicts with the fact that, under Art. 83 EPC, claims *on their own* may be a source of disclosure of the invention, provided the disclosure in the claims in enabling: it would never be possible to fulfil the requirement of support of the claims *through amendment of*

the description, in such a situation, **if the requirement of support** in Art. 84, second sentence, second half clause, EPC **were considered to define a requirement in respect of the claims only** (s. points 84-90 below).

8. The general requirement of consistency of any European patent application, derivable in general terms from Art. 78(1) and Art. 83 EPC, is concretely expressed in **Art. 84, second sentence, second half clause, EPC and in Rules 42(1)(c) and 48(1)(c) EPC**, which thus **represent the specific legal provisions of the EPC necessitating an adaptation of the description to amended claims**, if an amendment to the claims of a European patent application introduces an inconsistency (in the sense defined below: s. point 10-18 *infra*) between the description and the amended claims.

9. The same general requirement of consistency governs any European patent and, if an amendment to the claims of a European patent introduces an inconsistency between the description and the amended claims, then - in view of the principles established in **G 3/14** - the same legal provisions listed in the preceding point require that the description be adapted to the claims, during opposition and opposition proceedings.

IV. THE REASONS FOR THE PROPOSED ANSWERS

A. INTERPRETATION OF THE TERM *INCONSISTENCY* IN T 697/22

10. In general terms, the questions referred to the Enlarged Board of Appeal concern the relationship between the description and the claims of a European patent (s. question 1) or a European patent application (s. question 3) and ask whether the EPC contains legal provisions requiring that the description be adapted to the claims, whenever an amendment of the claims introduces an *inconsistency* between the amended claims and the description (s. question 2).

11. The referring decision does not define the meaning of the term *inconsistency*.

12. At point 10.5 of **T 697/22**, the board uses the term to refer to a situation where claim 1 of auxiliary request 1E claims a method of growing a plant in a hydroponics growing medium comprising a *binder*, wherein the binder is based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. In contrast to the definition of the binder in the claim, the description filed during first-instance proceedings discloses that the binder is not necessarily based on citric acid, ammonia and dextrose as claimed: these compounds are only listed as examples of compounds on which the binder might be based (s. paragraphs [0013] and [0014]): in particular, paragraph [0013] states that the binder may be based on more general classes of compounds.

13. The term *inconsistency* is thus used in the referring decision to describe a situation where the disclosure of a technical feature of the claimed subject matter (the binder, in the specific case) provided in the description *differs* from the definition of the same feature in the claim: *inconsistency* is therefore used in the decision to refer to a *difference* between the disclosure of an element of the solution in the description and the definition of that element in the claimed solution.

14. However, the term *inconsistency* in English means more than a difference: it implies an *incompatibility*[1].

15. In the case underlying the referring decision, the incompatibility arises from the fact that the claim claims a solution requiring the binder to be based on certain *specific compounds*, whereas the description discloses a solution allowing the binder to be based on *broader classes of compounds*: the description thus discloses a solution in which *the binder need not necessarily be based on the specific compounds listed in the claim*; as a matter of fact, the description discloses that the binder might even be based on compounds that are not claimed. Hence, an element of the claimed solution - the binder - is disclosed in the description in terms that are *in disagreement* and thus *incompatible* with the solution defined in the claim.

16. Although the incompatibility in the case underlying the referring decision concerns one element of the solution only, i.e., the binder, an incompatibility between the description and the claims may arise more generally, in cases where the description discloses *more than one element of the solution in terms that are incompatible with the solution defined in the claim*; it may also arise whenever the description discloses a different solution that is *wholly in disagreement* with the claimed solution.

17. An *incompatibility between the terms* in which the solution is disclosed *in the description and the terms* in which it is defined *in the claims* will be understood in the following to also encompass cases of *terminological disagreement* between the description and the claims, i.e., situations where a claimed technical feature is referred to, in the description, *by means of a different term*, i.e., a *different word*, *or by a term* which, although identical to that used in the claims, is *given in the description a meaning departing from the generally accepted meaning* of that term in the technical field of the patent.

18. Terminological disagreement is thus considered as being a special case of the situation underlying the referring decision, where the disagreement between the description and the claims arises from the description giving a term that is recited in the claims a *meaning departing from the meaning given to that very same term in, or derivable from the technical context of, the claims*.

[1] s. the definition of the word *inconsistent* in the online Merriam-Webster Dictionary: https://www.merriam-webster.com/dictionary/inconsistent

19. It is observed incidentally that the fact that the courts of Member States to the EPC have developed interpretation rules for dealing with cases of disagreement between the claims and the description is not relevant for answering the questions referred to the Enlarged Board of Appeal, since those questions solely concern proceedings before the European Patent Office and should therefore be answered *on the basis of the EPC only*.

20. If, as in the case underlying the referral, the description of a patent defines a claimed technical feature in *terms* that are *incompatible* with the definition of that feature in the claim, it must be ascertained whether such an incompatibility is allowable or not under the EPC. This task will be undertaken in the following.

B. AMBIT OF THE REFERRED QUESTIONS

21. Since the questions also concern the case of inconsistencies arising during examination proceedings between the description and the claims of a European patent application (s. question 3), it is understood that the referring Board is essentially seeking clarification from the Enlarged Board on the more general issue of whether an incompatibility between the description and the claims (in the sense defined above), arising from an amendment of the claims of a European patent application (during examination proceedings, including subsequent appeal proceedings) or a European patent (during opposition proceedings, including subsequent appeal proceedings), is objectionable under the EPC and, if so, under which provisions of the Convention such an incompatibility should be objected to.

22. The conclusions of the preceding point may be rephrased by saying that the questions in their entirety ask which provisions of the EPC relate the description and the claims to each other and whether at least some of these provisions impose an adaptation of the description to amended claims, if the amendment introduces an incompatibility between the description and the claims in the sense presented above (s. section IV.A above).

C. PRINCIPLES OF INTERPRETATION APPLIED TO ANSWER THE QUESTIONS

23. It is established in the jurisprudence of the Boards of Appeal that the principles of interpretation laid down in Articles 31 and 32 of the Vienna Convention on the Law of Treaties (in the following: *VCLT*) are applicable to the interpretation of the EPC (s., for example, G 1/83, Reasons, no. 4).

24. Therefore, in the following discussion of how the questions referred to the Enlarged Board of Appeal should be answered, the provisions of the EPC identified below as being relevant will be analysed in accordance with the principles of interpretation of Article 31 VCLT, according to which a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.

25. Furthermore, pursuant to Article 32 VCLT recourse will be made to historical material such as the *Travaux Préparatoires* to the EPC 1973, as supplementary means of interpretation, either to confirm the results of interpretation reached on the basis of Article 31 VCLT or whenever those results are not clear-cut.

26. In view of Article 177(1) EPC, the text in each of the three official languages of the EPC will be considered in the analysis of the legal provisions of the Convention that are deemed relevant for the discussion. For the sake of brevity, the wording of the provisions will be normally quoted in English only, unless it is held that the corresponding wording in German and/or French might convey a different meaning or shed light on the interpretation of the English text.

D. THE LEGAL PROVISIONS OF THE EPC RELATING THE DESCRIPTION AND THE CLAIMS TO EACH OTHER

27. Since the questions referred to the Enlarged Board of Appeal concern the nature of the *legal relationship* between the description and the claims as defined in the EPC and whether that relationship defines a requirement that the description should be adapted to amended claims, in case of inconsistencies between the description and the amended claims, **it is necessary first to identify the legal provisions of the EPC that relate the description and claims to each other**.

28. Although the first question concerns that relationship between the description and claims in a European *patent*, it is considered expedient to begin the analysis with the identification and discussion of the provisions of a European patent *application* that relate the description and claims to each other, since the relevant provisions applicable to European *patents* in opposition and opposition-appeal proceedings are, to a large extent, the same as those set out in full for a European patent application (cf. R. 86 EPC and Art. 101(3) EPC; also cf. **G 9/91**, Reasons, no. 19).

29. Whenever provisions defined in the Convention for European patent applications are also applicable to European patents, this will be expressly noted in the course of the discussion of the relevant provisions identified for European patent applications. Any exceptions excluding, in opposition and opposition-appeal proceedings (s., in particular, **G 1/91**, Reasons, no. 3.2, and **G 3/14**, Catchword), the applicability of the provisions governing a European patent application to European patents will be noted.

30. The analysis will then consider the provisions of the Convention *specifically* relating the description and the claims of a European *patent* to each other. Those provisions, which are Art. 69 EPC and the Protocol of Interpretation of that article, will be analysed in light of their object and purpose in the general context of the Convention, having particular regard to the second Recital of the Preamble of the EPC.

D.1. ANALYSIS OF THE LEGAL PROVISIONS GOVERNING THE RELATIONSHIP BETWEEN THE DESCRIPTION AND THE CLAIMS OF A EUROPEAN PATENT APPLICATION

31. Starting with European patent applications, the relevant part of the Convention is Part III, as apparent from its title («*The European patent application*»). Part III contains several legal provisions that relate the description and the claims of the European patent application to each other: in particular, Articles 78, 83 and 84 EPC.

32. Relevant provisions are also defined in the corresponding Part III of the Implementing Regulations, in particular in Rules 42 and 48 EPC.

D.2 ART. 78(1) EPC AND ART. 83 EPC - ONENESS OF THE DESCRIPTION AND THE CLAIMS

33. Within Part III, Art. 78(1) EPC stipulates that the description and the claims are, along with any drawings, mandatory constituent parts of any European patent application: the description and the claims thus belong together as parts of one and the same document[2].

34. A requirement to the same effect is established for European patent specifications in R. 73(1) EPC and R. 87 EPC, contained in Part V of the Implementing Regulations.

35. According to Article 83 EPC, the European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

36. According to the established case law of the Boards, the parts of the application that constitute the source of the disclosure of the invention required by Article 83 EPC are **the description, the claims and the drawings** in combination (s. *ex multis* **T 14/83**, Reasons, no. 3): it is the description and the claims which, along with any drawings, **in combination determine the disclosure of the invention** and must fulfil the requirement of sufficiency defined in Art. 83 EPC (s. **G 3/89**, Reasons, no. 1.4).

37. This also applies to European patents (s., for example, the comments on Art. 100(b) EPC in the Singer/Stauder/Luginbühl commentary to the EPC, 8. edition, mn. 5 and 6[3]).

38. It is thus apparent also from the language of Article 83 EPC, defining the requirement of disclosure of the invention by reference to the **application as a whole**, that **the description and the claims belong together**, since it is these parts of the application in combination (together with any drawings, if present) that must

[2] cf. **T 150/85**, Reasons, point 4, where the relationship between the description and the claims is discussed with reference to Art. 78(1) EPC.

[3] s. F. Bostedt in Singer/Stauder/Luginbühl, *Europäisches Patentübereinkommen*, 8th edition, Carl Heymanns Verlag, Cologne, 2019, Art. 100 EPC, mn 5 and 6.

ensure an adequate disclosure of the invention, capable of enabling the skilled person to put the invention to work.

39. It therefore follows already from a systematic consideration of Articles 78(1) and 83 EPC that the **description and the claims**, **as parts of one and the same document** that are **required, in combination, to disclose the invention**, belong together in the sense that they **must be *consistent* with each other**: it is hardly imaginable how two parts of the same document could fulfil *in combination* the function of disclosing the invention in a clear manner, if those parts contained contradictory definitions of the invention.

40. In his commentary on Art. 84 EPC in the *Münchner Gemeinschaftskommentar* to the Convention, Rudolf Teschemacher highlighted this point in marginal note 115 in very clear terms[4]:

> «*Ansprüche und Beschreibung sind Teile eines einheitlichen Dokuments, nämlich der europäischen Patentanmeldung (Art. 78(1)(b) und (c)), aus der die europäische Patentschrift entsteht (Art. 98). Die Zusammengehörigkeit dieser Unterlagen kommt darin zum Ausdruck, daß die Offenbarungserfordernisse in Art. 83, 100(b) und 138(1)(b) durch Ansprüche, Beschreibung und ggf. Zeichnungen zu erfüllen sind. Schon daraus folgt, daß* ***Ansprüche und Beschreibung*** *übereinstimmen müssen. Sie können entsprechend ihrer unterschiedlicher Funktion unterschiedliche Informationen enthalten,* ***dürfen einander*** *aber* ***nicht widersprechen****. Dieser allgemeine Grundsatz schlägt sich in dem Erfordernis von Art. 84 S. 2 nieder, daß die Ansprüche von der Beschreibung gestützt sein müssen. Diese Bestimmung findet ihre Entsprechung in R. 27(1)(d)[5], nach der in der Beschreibung die in den Ansprüchen gekennzeichneten Erfindung darzustellen ist*» (text highlighted in boldface in the original; emphasis through underlining of the text added).

D.3 G 1/24 AND THE PRINCIPLE OF ONENESS OF THE DECRIPTION AND THE CLAIMS

41. These preliminary conclusions drawn on the basis of a systematic consideration of the language of Articles 78(1) and 83 EPC in the context of Part III of the Convention, having regard to the object and purpose of the provisions of that Part, which is to define the requirements of the European patent application, are consistent with the findings of the Enlarged Board of Appeal in its recent decision **G 1/24**.

[4] R. Teschenacher, *Münchner Gemeinschaftskommentar*, Carl Heymans Verlag, 7th instalment, May 1985, Art. 84 EPC, mn. 115.
[5] R. 27(1)(d) EPC 1973 corresponds to **R. 42(1)(c) EPE 2000**: «*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*».

42. At point 12, number 2) of that decision the Enlarged Board ruled, with regard to the examination of the patentability of the claims of a European patent application, that «*the description and any drawings are always referred to when interpreting the claims, and not just in the case of unclarity or ambiguity*».

43. By affirming the line of case law of the Boards that has consistently called for an interpretation of the claims of a European patent application that takes account of the description and the drawings, the Enlarged Board in **G 1/24** has simply reaffirmed the principle underlying Art. 83 EPC that **the description and the claims, being the source of the disclosure of the invention** (along with any drawings), **are parts of a unitary document and should always be considered together**, for the purpose of enabling the invention for which protection is sought to be understood by the skilled person. This principle will be referred to, in the following, as the **principle of oneness** of the description and the claims.

D.4 THE PRINCIPLE OF ONENESS AND THE PRIMACY OF THE CLAIMS

44. This conclusion is neither weakened by, nor inconsistent with, the circumstance that another provision of Part III of the Convention, namely Art. 84, first sentence, EPC, assigns the claims - and the claims only - the function of defining «*the matter for which protection is sought*» and that this exclusive function of the claims, often referred to as the principle of **primacy of the claims**, has been likewise reaffirmed by the Enlarged Board in its decision **G 1/24** at point 12, number 1)[6].

45. This is so because the definition of **the matter for which protection is sought for**, as required of the claims pursuant to Art. 84, first sentence, EPC, **and the obligation to disclose the invention in an enabling manner**, which obligation is to be fulfilled by the application as a whole, **serve *different* purposes**.

46. The requirement of Art. 84, first sentence, EPC that the claims shall define the matter for which protection is sought for must be fulfilled by defining that matter *in terms of the technical features of the invention*, according to Rule 43(1) EPC; furthermore, the definition of the matter must be *clear and concise in itself*, according to Art. 84, second sentence, first half clause, EPC.

47. It follows from these requirements that **the primary function of the claims is to clearly and succinctly** set out*, i.e., **demarcate the scope of protection*** **sought for an invention** (cf. **T 1055/92**, Reasons, points 4 and 5).

48. The ultimate purpose of assigning the claims this primary function of demarcation is twofold:

[6] At point 12, number 2) of **G 1/24** the Enlarged Board ruled that «***the claims are*** *the starting point and* ***the basis for assessing the patentability of an invention*** *under Articles 52 to 57 EPC*» (emphasis added).

49. On the one hand, **the clear and concise definition of the invention** for which protection is applied for in terms of the technical features recited **in the claims**, rather than in the whole application, **allows** the matter whose patentability must be assessed in proceedings before the European Patent Office to be easily identified and distinguished from the prior art, thereby enabling **an efficient assessment of the patentability** of the invention by the European Patent Office: to this end, a comparison of the prior art with the claims, rather than with the whole disclosure of the application, is normally sufficient[7].

50. On the other hand, the very same definition of the invention in terms of the technical features recited in the claims allows third parties to quickly and reliably determine whether they are working within the scope of the claims or not (cf. **T 754/13**, Reasons, point 2.1), through a comparison of their products or processes with the technical features recited in the claims, rather than with the whole disclosure of the application. In other term, **the demarcation function of the claims also serves the purpose of legal security for third parties**.

51. In this respect, it is pointed out that Article 67(3) EPC stipulates, with regard to the provisional protection conferred by a European patent application after its publication, that any Contracting State which does not have as an official language the language of the proceedings may prescribe that provisional protection in accordance with paragraphs 1 and 2 above shall not be effective until such time as a **translation of the *claims*** in one of its official languages - **rather than a translation of the whole application** - has been made available to the public or has been communicated to the person using the invention in the said State.

52. The provisions of Art. 67(3) EPC show that **it is *the claims* that have the function of signalling to the public what is the matter for which provisional protection is conferred** by a published European patent application, thereby confirming that the claims serve a purpose of legal security.

53. The claims thus primarily serve the double purpose of enabling the European Patent Office to efficiently assess the patentability of an invention and allowing third parties to clearly determine the scope of protection sought for.

54. It is for this reason that the Boards of Appeal have consistently held that «*it is not always necessary for a claim to identify technical features or steps in detail*» (s. **T 1055/92**, Reasons, point 4) and that it is rather the description (with any drawings, if present) that has the primary function of setting out the details of an

[7] s. the aforementioned commentary on Art. 84 by R. Teschemacher in *Münchner Gemeinschaftskommentar*, mn. 2 and 28; also s. the remarks in the Annex to the „Haertel Study", p. 11 (discussed in more detail below): «*Denn **eine Neuheitsrecherche wird** wesentlich dadurch **erleichtert**, daß der Kern der Erfindung **durch genau formulierte Ansprüche** vom allgemeinen Stand der Technik abgegrenzt wird*» (emphasis added).

invention «*so as enable a person skilled in the art thereafter to be able to carry out the invention*», as explained in T 133/85, Reasons, point 5, page 11, last paragraph.

55. As very aptly stated in the same passage of T 1055/92 quoted in the preceding point, «*under Article 83 EPC* ***sufficient disclosure is required of an application as a whole*** *(claims together with the description and drawings),* ***but not of a patent claim as such****.*» (emphasis added).

56. It is underlined for the avoidance of doubt that, pursuant to the wording of Article 83 EPC, the claims may well be - *on their own* - a source of disclosure of the invention in a European patent application (or a European patent) - in contrast to Article 5 PCT, which instead mentions *only the description* as the source of the disclosure. The Guidelines, for example, state at F-II, 4.5 that «*in cases where the subject-matter of a dependent claim can be understood* […] *by the wording of the claim itself* […] *no additional explanation of this subject-matter will be necessary*»: this implies that it is possible for a dependent claim to be a source of disclosure of subject matter not disclosed in the description or the drawings.

57. It will be shown below that this difference between the EPC and the PCT is of great relevance for the interpretation of the requirement of support by the description set out in Art. 84 EPC.

58. It follows from the foregoing discussion that the special function which, under Art. 84, first sentence and second sentence, first half clause, EPC is attributed exclusively to the claims, namely demarcating the scope of protection sought for an invention (s. point 47 supra) for facilitating the assessment of patentability of the invention and for the sake of legal certainty (s. points 49 and 50), does not conflict with the function which, under Article 83 EPC in combination with Art. 78(1) EPC, is attributed to the claims and the description in combination, namely to enable the skilled person to understand the invention for the purpose of carrying it out.

59. Hence, as argued above at point 39, to fulfil this function of enabling the skilled person to understand the invention for the purpose of carrying it out, the claims and the description must be consistent with each other.

D.5. ANALYSIS OF THE REQUIREMENT OF SUPPORT BY THE DESCRIPTION IN ART. 84 EPC

60. A proper understanding of the requirement of support of the claims by the description requires an analysis of the relationship between this requirement, expressed in Art. 84, second sentence, second half clause EPC and the requirement that the application in its entirety must disclose the invention in an enabling manner. The relevant legal provisions defining the latter requirement (for brevity referred to as the

requirement of *sufficiency of disclosure*) are Art. 83 EPC and R. 42(1)(c) EPC, the latter being an implementing regulation of Art. 83 EPC that defines requirements to be satisfied by the description.

61. As explained in detail below, this principle of consistency between the claims and the description is codified in the provisions of **Article 84, second sentence, second half clause, EPC and Rule 42(1)(c) EPC** which, as suggested in the passage from the commentary on Art. 84 EPC quoted above at point 40[8], **form a pair of corresponding provisions defining the mandatory requirement that the description and the claims of a European patent application must be consistent with each other**.

62. With regard to the meaning of the requirement of support by the description, the following may be gleaned from the case law of the Boards of Appeal.

63. The claims, insofar as they provide a definition demarcating the invention for which protection is sought and thus setting its outer boundaries against the prior art, are typically generalisations of the concrete embodiments disclosed in the description and thus normally have a broader scope than the description (cf. **T 26/81**, Reasons, point 4, page 3, and **T 133/85**, Reasons, point 5, page 12, first paragraph).

64. In the case law, the requirement that the claims be supported by the description has been generally understood as having the purpose of ensuring that the degree of generalisation in the claims and the corresponding monopoly to be conferred upon grant correspond to the invention actually described in the application, so as to avoid that this monopoly extend to «*activities which are not dependent upon the invention which has been described in the application*» (s. **T 133/85**, *loc. cit.*).

65. In the words of the seminal decision **T 26/81**, «*since most claims are generalisations of examples disclosed in the description, the purpose of this provision* [i.e., the requirement of support of Art. 84 EPC; author's remark] *must be seen as safe-guarding that the claims do not cover any subject-matter which, after reading the description, still would not be at the disposal of a skilled person.*» (s. **T 26/81**, Reasons, point 4, page 3).

66. The requirement that the claims be supported by the description entails, in particular, that the claims should include all the features which, on proper interpretation of the description, are **essential features** of the invention (s. **T 32/82**, Reasons, point 5, **T 133/85**, Headnote, point 1, and **T 1055/92**, Reasons, point 5).

67. This applies not only to features which were described in the application as originally filed as being essential for the invention (as in the case of **T 133/85**: cf. Headnote, point 2), but also to **new essential features**

[8] R. Teschemacher in *Münchner Gemeinschaftskommentar*, Art. 84 EPC, mn. 2 and 28.

which must be added to the claim in order to clearly identify the solution and **to distinguish the invention from the prior art** if, as it normally happens in proceedings before the European Patent Office, «*pertinent documents are cited with the result that the core of a claimed invention has to be changed and also* ***the corresponding problem to be solved appears in a modified form.***» (emphasis added).

68. However, the fact that Art. 84, second sentence, second half clause, EPC defines a requirement in respect of the claims (cf. the title of Art. 84), as for example stated in **T 26/81**, Reasons, point 4, cannot be understood as putting no limits on the description and allowing its disclosure to be at odds with the invention as claimed.

69. This is incorrect not only in view of the above discussion on Art. 78(1) and 83 EPC, but also upon a **proper interpretation of the wording of Art. 84, second sentence, second half clause, EPC**, considered in itself and in the wider context of Part III of the Convention and its Implementing Regulations, notably in view of R. 42(1)(c) EPC.

70. This interpretation will be undertaken in the following, to show that **Art. 84, second sentence, second half clause, EPC also defines a requirement to be satisfied by the description** and ultimately **necessitating consistency between the claims and the description**.

D.5.1 INTERPRETATION OF THE TEXT OF ART. 84, SECOND SENTENCE, SECOND HALF CLAUSE, EPC

71. Starting with the wording of Art. 84, it is observed first that the expression *to support* literally means to bear the weight of something, especially from below, to *keep it from falling*, sinking, or slipping, to bear or hold up something[9], to serve as a *firm foundation* or prop for something[10], in keeping with its etymology from Latin *supportare* (via Old French *supporter*), a compound of *sub-*, from below, and *portare*, to carry. In other words, ***to support*** **means to provide a foundation for bearing something and preventing it from falling.**

72. It is also observed that the English version of Art. 84, second sentence, second half clause, EPC uses a ***passive*** **verb construction**.

73. From a grammatical point of view, passive («*be supported*») is an *aspect* of the verb[11] that expresses a new state which arises on the subject as the result of an action[12].

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[9] s. the definition of the verb *to support* given in the online version of the *American Heritage Dictionary*: https://www.ahdictionary.com/word/search.html?q=support.

[10] s. the definition of the verb *to support* given in the online version of the *Merriam-Webster Dictionary* (entry 3a): https://www.merriam-webster.com/dictionary/support.

[11] The word *aspect* is used here in the technical meaning it has theoretical linguistics, to designate a property of verbs in which the action or state is considered as to its beginning, duration, completion or repetition and without reference to its position in time.

[12] s. C. Beedham, «*Language and Meaning*», John Benjamins Publishing Company, Amsterdam, 2005, p. 39.

74. The passive verb construction used in the sentence «*the claims shall be supported by the description*» thus means that **the required change of state of the claims** - from lacking a firm foundation to **becoming "firmly supported"** - **must arise through the agency or instrumentality of the description**. Stated otherwise: the requirement that the *subject* of the passive sentence - *the claims* - must be in the *state of being supported* has to be brought about *through the instrumentality of the agent - the description*.

75. Furthermore, the new state of the claims that must be brought about through the agency of the description is not just a state in which the claims *somehow* rest on some passage of the description: the word «*supported*» entails that **the claims must be brought to a state in which they rest firmly and cannot fall** (s. point 71 above)**, which means that the description must not contain contradictory statements that would "put into question" the claims, causing them to "fall".**

76. Hence, **the passive construction used in the English version of Art. 84, second sentence, second half clause, EPC**, according to which the claims shall «*be supported by the description*», does not merely define a requirement of the claims to the effect that their matter must be somehow disclosed somewhere in the description: it **also defines a requirement for the description,** in the sense that **the description must provide the required support to the claims in a manner that is not at odds with the claims**.

77. The same interpretation applies to the German version of the provision, which - like its English counterpart - uses a passive construction[13]: «*die Patentansprüche müssen **von der Beschreibung gestützt werden***».

78. According to the *Digitales Wörterbuch der deutschen Sprache*, *stützen* means «***einer Sache*** […] ***durch eine Stütze Halt geben und sie dadurch am Fallen oder Zusammenbrechen hindern***»[14], i.e., to **provide firm support to something** by means of a prop and to **thereby prevent it from falling or collapsing**.

79. Thus, the German version of Art. 84, second sentence, second half clause, EPC, does - exactly as its English counterpart - define a requirement not only for the claims, but also for the description, in the sense that the state of the claims being firmly supported and prevented from faltering must be ensured through the agency of the description.

80. Unlike the English and German versions, the French version uses an active construction: «*les revendications doivent **se fonder sur la description**.*» (emphasis added).

[13] A so-called *Vorgangspassiv*, according to the traditional German grammatical terminology, i.e., a passive expressing a process, a change.
[14] https://www.dwds.de/wb/st%C3%BCtzen

81. According to the online version of the *Dictionnaire de l'Académie Française*, «*se fonder sur*» means «*s'appuyer sur; reposer sur*», i.e., to *rest* on something.

82. With its *active* form, the French version arguably only expresses a requirement in respect of the claims; however, it does express the requirement that the support should be *firm*, i.e., such that what is supported is not put into question or falters: hence, the French version of Art. 84 EPC does imply a nuance of consistency, like its English and German counterparts.

83. In view of the agreement between the English and German versions and on account of the fact that the French version confirms that, as also apparent from the English and German texts, the support to be provided must be free of contradictions, it is concluded that **the wording of the provision does, on proper interpretation, also define conditions to be satisfied by the description**.

D.5.2 SYSTEMATIC INTERPRETATION OF ART. 84, SECOND SENTENCE, SECOND HALF CLAUSE, EPC IN THE CONTEXT OF PART III OF THE CONVENTION

I) RELATIONSHIP BETWEEN ART. 84, SECOND SENTENCE, SECOND CLAUSE, EPC AND ART. 83 EPC

84. Turning now to a systematic interpretation of Art. 84, second sentence, second half clause, EPC in the context of Part III of the Convention, there is a **substantive argument of great weight** for rejecting the view that Art. 84, second sentence, second half clause, EPC only defines a requirement in respect of the claims, with no conditions being set on the description.

85. **If the requirement of support** in Art. 84, second sentence, second half clause, EPC **only defined a requirement in respect of the claims** with no conditions on the description, as for example maintained in the decision **T 56/21**, **it would never be possible to fulfil the requirement of support in the description for subject matter disclosed only in a claim as originally filed**.

86. Pursuant to Art. 83 EPC, **a claim may well be the sole original source of disclosure of subject matter**, provided the disclosure in the claim is clear and complete for the skilled person to carry it out and provided the claimed subject matter fulfils the requirements of Art. 123(2) EPC: for example, a dependent claim as originally filed may be the sole source of disclosure for an embodiment of the invention defined in an independent claim, with no corresponding description in the description as originally filed, if the technical features recited in the dependent claim as filed are sufficient for the skilled person to work out the embodiment[15].

[15] This situation is specifically foreseen and described in the Guidelines, F-II, 4.5, third par. and F-IV, 6.6.

87. In such a situation, the requirement that the dependent claim be supported by the description is clearly not satisfied by the application as filed, because the claimed embodiment is not disclosed in description as originally filed.

88. Unless Art. 84, second sentence, second clause, EPC is understood as also defining a requirement for the description, it would never be possible to fulfil the requirement of support through amendment of the description, in this situation.

89. Such a conclusion is patently at odds with the fact that Article 83 EPC, in general, does allow a claim to be the sole source of disclosure of subject matter of an application, provided the matter in the claim enables the skilled person to carry out the claimed subject matter.

90. It follows that, to reconcile the requirement of Art. 83 EPC with the requirement of support defined in Art. 84, second sentence, second clause, EPC, the latter must be interpreted as also defining a requirement of consistency to be satisfied by the description with regard to the claims. It is observed in passing that this conclusion appears to be in accord with the view held in T 409/91, Reasons, no. 3.4, p. 10, that «*the underlying purpose of the requirement of support by the description, insofar as its substantive aspect is concerned, and of the requirement of sufficient disclosure is the same*».

91. Hence, the view expressed for example in T 56/21 that the requirement of support in Art. 84, second sentence, second half clause, EPC defines a requirement of the claims only, and not of the description, must be rejected: on proper consideration of the requirements of Art. 83 EPC and Art. 84, second sentence, second half clause, EPC, which must be compatible with each other, the requirement of support in Art. 84 EPC must be interpreted as also defining a requirement to be satisfied by the description vis-à-vis the claims.

92. This understanding of the requirement of support as defining a condition to be satisfied not only in respect of the claims but also of the description is clearly recognisable in the early case law of the Boards of Appeal.

93. For example, the decision T 133/85 discusses, at point 2 of the Reasons, on page 8, last paragraph, «*the alternative of* ***amending the description to support*** […] ***a broad claim***», thereby showing that the requirement of support of the claims was understood by the Board in this decision as also implying a requirement of consistency of the description vis-à-vis the claims, since the highlighted sentence shows that, in the Board's view, support of the claims can be achieved through the agency of an amended description.

94. A similar view is also expressed in the decision T 11/82 (s. Reasons, point 16), where the Board argued that, «*if, as in the present case, amended claims are submitted, following the issue of the European Search*

Report and/or as a result of a communication from the Examining Division, ***it will be necessary to make consequential amendments to the description****, in order* ***to ensure*** *inter alia* ***that the amended claims are supported by the description****, in conformity with Article 84 EPC.*» (emphasis added).

95. A similar understanding of the requirement of support of the claims by the description has been expressed also in **T 150/85** (cf. points 4 to 7), where the Board objected to several passages of the description disclosing solutions (in form of examples) which were in disagreement with the solution defined in the claims.

96. In view of the substantive argument outlined above, it is maintained that the requirement of support of the claims by the description requires the latter to disclose a solution that is consistent with the solution defined in the claims and thus sets on the description a condition that must be satisfied.

97. Hence, if an amendment to the claims introduces an **inconsistency** between the description and the claims **during examination or examination-appeal proceedings**, the inconsistency being to the effect that the solution disclosed in the description is in partial or complete disagreement with the solution as defined in the claims in terms of technical features, **it must be concluded that the legal requirement of Art. 84, second sentence, second half clause, EPC is not complied with and requires an amendment of the description, to be satisfied**.

98. **This applies** not only to a European patent application but **also to a European patent during opposition or opposition-appeal proceedings**, in view of **G 3/14**, because the non-compliance of the patent with the requirement of Art. 84, second sentence, second half clause, EPC has been brought up by the amendment of the claims and may therefore be examined also in opposition or opposition-appeal proceedings.

99. It follows already from this finding that **the answer to question 1 and question 3 is the same and must be positive**: to comply with the requirements of Art. 84, second sentence, second half clause, EPC, it is necessary to adapt the description so as to remove the inconsistency, **whenever the solution disclosed in the description is in partial or complete disagreement with the solution defined in the claims in terms of technical features**.

II) R. 42(1) EPC

100. Turning now to R. 42(1)(c) EPC, this provision, by stipulating that the description must disclose the invention *as claimed* in such terms that the technical problem and its solution can be understood, sets the requirement that **the description must disclose the solution underlying the invention that is defined in the claims in terms of technical features, rather than the solution to some other invention**.

101. It is recalled that, according to the established case law of the Boards of Appeal, **Rule 42(1)(c) EPC**, corresponding to Rule 27(1)(d) EPC 1973, is an implementing regulation of Art. 83 EPC and **is of a *mandatory* character**: there can be no «*derogation from the essence of the requirement in Rule 27(1)(d) that the invention should be presented in such a way that the technical problem and its solution can be understood*» (s. **T 26/81**, Reasons, point 5).

102. Rule 42(1)(c) EPC (i.e., former Rule 27(1)(d) EPC 1973) furthermore constitutes the **basis for the assessment of the inventive step** at the European Patent Office, i.e., the so-called ***problem and solution approach***. As indicated in the headnote of **T 26/81**:

> «***If it is impossible to satisfy the requirement of Rule 27(1)(d) EPC that the invention should be disclosed in such terms that*** *the technical problem and* ***its solution can be understood****, - a requirement which is of a* ***mandatory*** *character -, then it will be clear that* ***an invention within the meaning of Article 52 EPC does not exist****; but if it is accepted by an Examining Division that an independent claim defines a patentable invention, it must be possible to derive a technical problem from the application. Thus, the requirement of Rule 27(1)(d) EPC cannot be set up as a separate formal criterion independent of inventiveness*» (emphasis added).

103. It is also recalled that the requirement of former Rule 27(1)(d) EPC 1973 and present **Rule 42(1)(c) EPC applies to the description** of a European patent application ***at any stage***, i.e., not only to the description as filed, as explained at points 16 and 18 of the Reasons of **T 11/82**, but **also when amended claims are submitted**:

> *«16.* ***The argument that Rule 27(1)(c) EPC applies only to the description as filed, must also be rejected****. The Examining Division, correctly, considered that this was inconsistent with the provisions of Rule 36(1) EPC, which stipulates that the provisions of Rule 27 EPC shall apply to documents replacing documents making up the European patent application.* ***If****, as in the present case,* ***amended claims are submitted****, following the issue of the European Search Report and/or as a result of a communication from the Examining Division,* ***it will be necessary to make consequential amendments to the description, in order to ensure inter alia that the amended claims are supported by the description*** *[…]*
>
> *18.* ***The Board does not accept the appellants' professional representatives' arguments in relation to Rule 27(1)(d) EPC*** [i.e., Rule 42(1)(c) EPC 2000] ***any more than it accepts their arguments in relation to Rule 27(1)(c) EPC****. The clearly mandatory character of Rule 27(1)(d) EPC has already been recognised by a Technical Board of Appeal in Case T26/81 (Official Journal EPO 1982, 211). In the present case,* ***the appellants are obliged to amend the description so that it discloses the invention as claimed in the***

amended claims in such terms that the technical problem and its solution can be understood.» (emphasis added).

104. If the claims of a European patent application are amended in the course of examination proceedings, this entails that the invention as claimed and thus the solution in terms of claimed technical features has changed[16].

105. It follows from the mandatory requirement of Rule 42(1)(c) EPC at any stage that the description must be amended to elucidate the solution underlying the invention defined in the amended claims, rather than the solution to a different invention which is not encompassed by the amended claim.

106. In this respect, it is important to recall what the Board stated in the seminal decision T 26/81 at point 9 of the Reasons.

107. The Board first observed that, if the provisions of Rule 27(1)(d) EPC 1973 (i.e., present Rule 42(1)(c) EPC), requiring «*that the description shall disclose how the invention can be understood as the solution to a technical problem*» are «***neither satisfied*** *by the original description, nor, after request,* ***by an amendment****»,* it necessarily follows that «***an invention*** *within the meaning of Article 52* ***does not exist***» (emphasis added).

108. The Board went on by reasoning that «***whether the condition of Rule 27(1)(d) is fulfilled will have to be judged in relation to*** *or as a consequence of* ***the examination of the pertinent claim in respect of novelty and inventive step*** *and* ***this condition cannot be set up as a separate formal criterion independent of inventiveness***» (emphasis added).

109. It follows from these remarks that the requirement of Rule 42(1)(c) EPC must be ensured with respect to the invention which - upon examination of the pertinent claims and thus, in case of amendment, upon examination of the amended claims - has been found to fulfil the substantive requirements of patentability of the Convention.

110. The conclusion that the conditions of R. 42(1)(c) EPC (or former Rule 27(1)(d) EPC 1973) would be satisfied by a description disclosing an invention in terms that are in disagreement with a claim found to define

[16] cf. the remarks on p. 294 of the article by G.S.A. Szabo, «*The Problem and Solution Approach to the Inventive Step*», 1986, 10 EIPR, pp. 293-303: «[D]*ependency of the technical problem on the objectively emerging closest prior art may require a shift from what was originally assumed to what was in fact the case. This need not be interpreted as an 'amendment' of the characterisation of* ***the invention****, since the latter* ***remains unaffected, being the solution of the problem and not the problem itself***» (emphasis added).

a **patentable** invention **would be contradictory to the finding that a patentable invention exists**, as implied by point 9 of **T 26/81**[17].

111. It is therefore concluded that **R. 42(1)(c) EPC also provides a legal basis for requesting the adaptation of the description of a European patent application**, if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings and the amendment to the claims introduces an inconsistency between the description and the claims.

112. It may be in fact stated that **Art. 84, second sentence, second clause, EPC and R. 42(1)(c) EPC correspond to each other**, as already noted above (s. point 40), and **form a pair of legal provisions defining in combination the requirement that the description and the claims** of a European patent application **must be consistent with each other**[18].

113. It is furthermore underlined that R. 42(1)(c) EPC is applicable to European patents also during opposition proceedings and subsequent opposition-appeal proceedings, in view of R. 86 EPC and on account of **G 9/91**, Reasons, point 19, where the Enlarged Board of Appeal expressly stated that «*in case of amendments of the claims or other parts of a patent* ***in the course of opposition or appeal proceedings****, such* ***amendments are to be fully examined*** *as to their compatibility with the requirements of the EPC.*» (emphasis added).

114. This latter remark clearly entails that the requirement of R. 42(1)(c) EPC, being an implementing regulation of Art. 83 EPC having mandatory character (cf. **T 26/21**, Headnote), is to be fully examined also in opposition proceedings and subsequent opposition-appeal proceedings. It is of relevance here that no decision of the Enlarged Board of Appeal has excluded the applicability of R. 42(1)(c) EPC in opposition and opposition-appeal proceedings, in derogation from R. 86 EPC.

115. Hence, regardless of whether an inconsistency between the description and amended claims of a European patent, brought about by the amendment of the claims, is deemed to introduce a non-compliance with Art. 84, second sentence, second half clause, EPC which may be allowably objected under Art. 84 EPC (in keeping with the conditions for the examination of Art. 84 EPC in opposition defined in **G 3/14**, Catchword),

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[17] cf. **T 26/81**, Reasons, point 9 «***If*** *therefore as applicants maintain, the Examining Division has in fact accepted that* ***claim 1 defines a patentable invention, a conclusion that the conditions of Rule 27(1)(d) have not been*** *or cannot be made to be* ***satisfied, is contradictory***» (emphasis added).

[18] s. R. Teschenacher, *Münchner Gemeinschaftskommentar*, Art. 84 EPC, mn. 115: «***Dieser allgemeine Grundsatz*** *schlägt sich* ***in dem Erfordernis von Art. 84 S. 2*** *nieder, daß die Ansprüche von der Beschreibung gestützt sein müssen. Diese Bestimmung* ***findet ihre Entsprechung in R. 27(1)(d), nach der in der Beschreibung die in den Ansprüchen gekennzeichneten Erfindung darzustellen ist.***» (emphasis added).

such an inconsistency may *at any rate* be objected to pursuant to R. 42(1)(c) EPC, in opposition and opposition-appeal proceedings, if the description discloses a solution in terms that are partially or wholly in disagreement with the claimed invention.

III) FURTHER PROVISIONS OF THE EPC EMBODYING THE PRINCIPLE OF CONSISTENCY

116. A number of further provisions in Part III of the Convention and of the Implementing Regulations supports the finding that, under the EPC, there is a general requirement that the description and the claims of a European patent application must be consistent with each other.

117. One of these provisions in particular, namely R. 48(1)(c) EPC, is applicable in examination and examination-appeal proceedings and, on account of R. 86 EPC, also in opposition and opposition appeal proceedings. If the inconsistency arises because the description discloses a solution that is *wholly different* and thus in disagreement with the claimed invention, R. 48(1)(c) EPC *may* be applied to remove the inconsistency, as detailed below, since the solution disclosed in the description would in this case represent matter that is obviously *irrelevant* for understanding the claimed invention[19].

IV) R. 49(2) EPC

118. The first of these further provisions is R. 49(2) EPC in combination with Art. 2(10) of the Decision of the President of the European Patent Office dated 25 November 2022 on the presentation of application and other documents: this provision stipulates, as originally foreseen by R. 35(13) EPC 1973, that the terminology shall be consistent throughout the European patent application[20].

119. This entails, in particular, that **the terminology in the description must be consistent with the terminology used in the claims** and provides further confirmation of the principle, derived above, that **the description and the claims of a European patent application must be consistent with each other** and free of contradictions, for example **in the terminology** used in the description and the claims to refer to elements of the invention for which protection is sought.

V) R. 48(1)(C) EPC

120. A further provision that is relevant for the discussion, as already noted above, is R. 48(1)(c) EPC, which stipulates that the European patent application shall not contain any statement or other matter obviously irrelevant or unnecessary under the circumstances.

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[19] s. R. Teschemacher, *Münchner Gemeinschaftskommentar*, Art. 83 EPC, mn. 66.
[20] also cf. **T 56/21**, Reasons, point 80.

121. Contrary to the view expressed in **T 56/21**, Reasons, points 96 and 97, **the purpose of this provision**, as also apparent from an analysis of the available historical material such as the *Travaux préparatoires* (s. the detailed analysis below)[21], **is to ensure that the European patent application be kept clear and understandable and free of any matter that is obviously irrelevant or unnecessary for an understanding of the invention as defined in the claims**[22].

122. Nothing in the Rule or in other parts of the Convention warrants the conclusion drawn in **T 56/21** (s. Reasons, point 96) that a European patent application which does not comply with R. 48(1)(c) EPC could not be refused: **it follows plainly from the wording of R. 48(1)(c) EPC in combination with Art. 97(1) EPC that the requirements of the Rule are to be examined and, if not complied with, the Office is entitled to refuse an application under Art. 97(2) EPC in combination with R. 48(1)(c) EPC**[23].

123. Although R. 48(1)(c) EPC does not define a requirement to be satisfied specifically by the description and the claims in relation to each other, it does provide confirmation that **the European patent application**, the purpose of which is, pursuant to Art. 83 EPC, to disclose the invention in a clear and complete manner, should attain this purpose by limiting the disclosure to **what is necessary for understanding the invention** for which protection is sought for. Hence, **any parts of the application that are obviously irrelevant or unnecessary for an understanding of the invention as claimed are to be excised** and failure to comply with the requirements of R. 48(1)(c) EPC can lead to a rejection of a European patent application.

124. What is obviously irrelevant or unnecessary under the circumstances must be ascertained on the basis of the concrete facts of a case. Matter that does not fall under the claims but which is useful for understanding the claimed invention may in some cases be considered necessary under the circumstances, for example in a divisional application claiming a process to produce an end product and containing a description of the process for producing an intermediate product required for obtaining the end product . The description of the process

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[21] s. for example, **BR/51/70**, mn. 24, concerning the discussion of the **implementing regulation to Art. 66, no. 6 of the Draft Implementing Regulations** proposed the Implementing Regulations sub-committee of the Working Group I, on the basis of a previous draft prepared in 1964 by the EEC Patents Working Group (s. mn. 5 of **BR/51/70**). **The implementing regulation to Art. 66, no. 6 discussed in BR/51/70** , mn. 24 has the title «*Unzulässige Angaben*» in the German version and thus **relates to prohibited matter**. The text of the provision proposed by the Working Group (under the title «*re. Art. 66, no. 5*» [*sic!*]) and the corresponding PCT provision, i.e., R. 9(1) PCT, with which the implementing regulation of the Draft had been aligned on the suggestion of the Working Group, are reproduced in document **BR/GT I/52/70**. It is apparent from the discussion in **BR/51/70**, mn. 24 that **the purpose of the implementing regulation to Art. 66, no. 6 was to ensure accuracy and clarity of the wording of the application**.

[22] s. O. Bossung, *Münchner Gemeinschaftskommentar*, Art. 78 EPC, mn. 103, 104.

[23] R. Teschemacher in Singer/Stauder, *Europäisches Patentübereinkommen*, Art. 78, mn. 63, par. 2: «***Nach der klaren Bestimmung der R. 48(1) c) darf die europäische Patentanmeldung solche Angaben nicht enthalten****; dies ist nach Art. 94(1) im Sachprüfungsverfahren zu prüfen.* ***Wird*** [ein Vorstoß] ***beanstandet und stimmt der Anmelder*** *einer Streichung dieser Angaben* ***nicht zu, so muss nach Art. 97(1) die europäische Patentanmeldung zurückgewiesen werden***» (emphasis added).

for producing the intermediate product would clearly be relevant for understanding the claimed process to produce the end product.

125. In the case of a European patent application, **clear cases of matter that is both irrelevant and unnecessary** are represented by **general statements** in the description **implying that the extent of protection may be expanded in some vague way**, **statements referring to the «*spirit of the invention*» and the so-called claim-clauses**.

126. With regard to the latter, it is specifically noted that such clauses also violate the requirement, set in Art. 78(1) EPC, that **the description and the claims of a European patent application must be formally distinct parts of the application**.

127. The description of a European patent application must not contain claims. The **legislative history** of the requirements governing the relationship between the description and the claims, discussed below, **shows that the legislator decided to formally separate the description and the claims**, which were originally part of the same document. **To allow claim-clauses in the description would go against the clear will of the legislator** (s. point 190 below).

128. Furthermore, R. 48(1)(c) is applicable in opposition and opposition-appeal proceedings (in view of R. 86 EPC) if a European patent contains matter that is obviously irrelevant or unnecessary for an understanding of the invention that is defined in the claims of a European patent.

129. These conclusions are supported, as explained in more detail below, by the historical evidence on the origin this provision.

130. It is however worthwhile recalling already here that R. 48(1)(c) appears to have been inspired by the provisions on German patent applications («*Anmeldebestimmungen*») in force in 1968, namely §3, par. 6[24], which stipulated that the description should only contain matter necessary for explaining the invention and whose non-fulfilment was a ground for refusing German patent applications. Also the Dutch provisions on patent applications (*Octrooireglement*) in force at the time contained similar provisions prohibiting the inclusion of unnecessary matter[25] and appear to have inspired the corresponding provision of the EPC.

[24] s. Bossung, *Münchner Gemeinschaftskommentar*, Art. 78 EPC, mn. 91 with references to the jurisprudence of the Federal Court of Justice in footnote 48, notably to the decision «*Faltbehälter*», GRUR 1970, 258 = Bl. 1970, 163.

[25] B. M. Telders, *Nederlandsch Octrooirecht*, Martinus Nijhoff, the Hague, 2nd revised edition, 1946, mn. 179 discussed in footnote 46 below, where the requirement of clarity of the description is discussed with reference to decisions of the *Octrooiraad*, for istance a decision of 2 September 1919, according to which «*noodelooze uitwijdingen* [sic] *behooren dus te worden vermeden*», i.e., unnecessary digressions should therefore be avoided. The Dutch Patent Act of 1910 was in force at the time the works on the EPC began.

131. Hence, regardless of the fact that the wording of R. 48(1)(c) EPC is clear and does not warrant a consultation of the *Travaux préparatoires* to the PCT, as instead suggested in T 56/21 (s. Reasons, point 97), recourse to historical material relevant to the EPC confirms the interpretation of R. 48(1)(c) EPC reached already on the basis of an analysis of its literal wording.

VI) PRACTICE OF THE EPO WITH REGARD TO THE DESCRIPTION OF DIVISIONAL APPLICATIONS

132. Of relevance for the discussion of the principle of consistency between the description and the claims is also the practice of the European Patent Office in relation to the description of divisional patent applications.

133. According to Art. 82 EPC, the European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

134. According to the Guidelines, F-V, 5.1, where a European patent application is found to lack unity, the applicant is invited to limit not only the claims but also the description, by excision or amendment of parts of the description (cf. Guidelines C-III, 3.3); furthermore, according to the Guidelines, C-IX, 1.5, the description and drawings of a divisional application should in principle be confined to matter that is relevant to the invention claimed in that application.

135. The practice of the Office is rooted in Rule 25(2) EPC 1973, according to which «*where possible, the description and the drawings of the earlier patent application or any European divisional application shall relate only to the matter for which protection is sought by that application*» (emphasis added).

136. As stated in T 501/91 (s. Reasons, point 7), the main purpose of Art. 82 EPC is to prevent several unrelated inventions from being dealt with in a single patent application in order to save fees.

137. If the sole purpose of Art. 82 EPC were to prevent applicants from having several unrelated inventions from being searched at the cost of a single search fee, it would be sufficient to request applicants to limit the claims only.

138. However, as further noted in T 501/91, Art. 82 EPC also ensures that, in the interests of a rational examination procedure, unrelated subject matter is not lumped together in a single patent application.

139. It is thus apparent that the practice of the European Patent Office of inviting applicants, in the case of non-unitary patent applications, to excise from the description subject matter that is unrelated to the searched invention for which examination is requested serves the purpose of ensuring that the disclosure of the

description relates to only the invention to be examined and does not creates the impression that protection is sought for matter no longer falling under the claims[26].

140. The practice of the Office of requesting the excision of non-unitary matter from the description of a European patent application lacking unity thus provides further confirmation of the principle, derived above, that the description and the claims of a European patent application must be consistent with each other and should not relate to matter irrelevant to what is claimed[27].

VII) CONCLUSIONS ON THE FURTHER PROVISIONS OF PART III

141. In summary, from an analysis of the provisions in Part III of the Convention and of the Implementing Regulations discussed above, interpreted in accordance with the ordinary meaning to be given to the terms of each provision, both individually and in the wider context of Part III and taking into account their object and purpose, it may be concluded that the European Patent Convention contains legal provisions requiring, in examination and examination-appeal proceedings, the adaptation of the description to amended claims so as to remove any inconsistency between the amended claims and the description that is introduced by the amendment to the claims.

142. At least one of these provisions, i.e., R. 48(1)(c) EPC, is fully applicable also in opposition and opposition-appeal proceedings.

V. PROVISIONS GOVERNING THE RELATIONSHIP BETWEEN THE DESCRIPTION AND THE CLAIMS FOR DETERMINING THE EXTENT OF PROTECTION - ART. 69(1) EPC

143. According to Art. 69(1) EPC, «*the* ***extent of the protection*** *conferred by a European* ***patent*** *or a European patent* ***application*** *shall be determined by the* ***claims****. Nevertheless, the* ***description*** *and drawings* ***shall be used to interpret the claims****.*» (emphasis added).

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[26] cf. the comment in this sense of R. Teschemascher in Singer/Stauder, *Europäisches Patentübereinkommen*, Art. 82, mn. 19: «*Wird ein Einwand erhoben, so* […] [*wird*] *der Anmelder aufgefordert, die Anmeldung auf einen einheitlichen Gegenstand zu beschränken. Dies gilt nicht nur für die Ansprüche,* ***auch eine Streichung von Teilen der Beschreibung kann erforderlich werden****. Dies wird* ***unter dem Gesichtspunkt der Klarheit*** *insbesondere dann der Fall sein,* ***wenn andernfalls der Eindruck entstünde, es werde Schutz für einen Gegenstand beansprucht, der tatsächlich nicht mehr unter die Ansprüche fallen soll****.*» (emphasis added).

[27] cf. O. Bossung, *Münchner Geschäftskommentar*, Art. 78, mn. 103. In this passage, the author discusses the applicability of R. 34(1)(c) EPC 1973, corresponding to R. 48(1)(c) EPC, and significantly makes the following comment:

> «*Zu folgenden Stichwörtern, bei denen sich die* ***Begriffe des Unnötigen*** […] *überschneiden, seien einige Hinweise gegeben: Nr. 1* ***Ausgeschiedende Gegenstände***
> […] *sind aus der Beschreibung grundsätzliche zu entfernen* […] ***Siehe auch R. 25(2).***» (emphasis added).

It is thus apparent from this comment that the provision of the EPC 1973 stipulating the excision of non-unitary matter from the description of a divisional application, i.e., R. 25(2) EPC 1973, was seen by the author as having a purpose similar to that of R. 34(1)(c) EPC 1973, i.e., the predecessor of R. 48(1)(c) EPC.

144. Art. 69(1) EPC assigns the claims the function of «*defining the technical features of the subject invention and thus its technical subject-matter»,* in order that the extent of the protection conferred by a European patent or the extent of provisional protection conferred by a published European patent application can be determined (cf. **G 2/88**, Reasons, no. 7).

145. The requirement that the description must be used to interpret the claims for the purpose of determining the extent of protection conferred by a European patent or by a published European patent application is a further confirmation that the description and the claims belong together and that, in order to fulfil the function assigned by Art. 69(1) EPC to them in combination, namely enabling the determination of the extent of protection, they must be consistent with each other.

146. As already noted above in relation to the requirement of sufficiency of disclosure, it is hardly imaginable how the description and the claims, as parts of the same document, could possibly fulfil in combination the crucial function of enabling the determination of the scope of protection, if they contained contradictory definitions of the invention.

147. **Art. 69 EPC may be seen as the counterpart of Article 84 EPC**, as noted for example by R. Teschemacher in his commentary on Art. 84 EPC in the *Münchner Gemeinschaftskommentar*, the only difference being that the former is applied during *infringement proceedings* by *national courts*, while the latter is applied by the *European patent Office* during the *assessment of patentability of the claims*.[28].

148. Art. 69(1), first sentence, EPC and Art. 84, first sentence, EPC assign the claims the **same primary function** of **clearly demarcating the scope of protection** (s. point 47 *supra*), to thereby ensure **legal security** for third parties (cf. point 50 above). The demarcating function assigned to the claims by Art. 84, first sentence, EPC additionally serves the purpose of facilitating the assessment of their patentability during proceedings before the European Patent Office (s. point 49).

149. Art. 69(1), second sentence, EPC stipulates the principle that the interpretation of the claims for the purpose of establishing the extent of protection has to be done by using the description (together with any drawings). Art. 84, second sentence, second clause, EPC stipulates the principle that the description and the claims must be consistent with each other, as explained above.

150. It is recalled that, according to the first and second Recitals of the Preamble to the EPC, the main object of the Convention is «*to strengthen co-operation between the States of Europe in respect of the protection of*

[28] R. Teschemacher, *Münchner Gemeinschaftskommentar*, Art. 84, mn. 2.

inventions […] *by a single procedure for the grant of patents and* ***by the establishment of certain standard rules governing patents so granted***» (emphasis added).

151. As explained by M. van Empel in his commentary on the EPC[29], the «*standard rules governing patents so granted*» mentioned in the second Recital of the Preamble concern, *inter alia*, «*certain common standards for protection provided by the European patent» that are «set out in Articles 64(2) and 69*» and are to be seen as part of the so-called "maximum solution" which had been agreed at the Inter-Governmental Conference and the purpose of which was to promote harmonisation of patent legislation in Europe, in particular by ensuring that that the interpretation of European patents be done according to broadly harmonised criteria[30].

152. As noted by van Empel in his comment on Art. 69[31], «***the more uniform interpretation and construction may be expected for European patents*** *in the various Contracting States, the more uniform and* ***the more coherent the drafting of European applications will also be***» (emphasis added).

153. This confirms that the principles set out respectively in Art. 69, second sentence, EPC and Art. 84 second sentence, second half clause, EPC are intended to achieve the same overarching objective that the documents which, in combination, must disclose the invention for which protection is conferred, in the case of a European patent, or sought for, in the case of a European patent application, should form a **coherent and consistent unity**.

154. The remark by van Empel paralleling the interpretation of European patents and the drafting of European applications is consistent with the reason, discussed in detail below, why in 1970 the sub-committee of the Patents Working Group I tasked with the preparation of Draft Implementing Regulations felt it «***so important*** *- particularly* ***from the point of view of infringement actions -***» to insert the provision **Re. Article 66, no. 3**, which required the claims to be clear and concise and **fully supported by the description**», in the Convention itself (s. **BR/51/70**, mn. 18).

155. The provision **Re. Article 66, no. 3**, which is the **predecessor of Art. 84, second sentence, EPC**, was clearly seen by the sub-committee as having a **decisive influence on the assessment of the scope of protection in post-grant infringement proceedings before national courts**. By dictating that the claims of a European patent application be supported by the description and by linking this requirement to the subsequent interpretation of the scope of protection, which has to be done on the basis of the claims under consideration

[29] M. van Empel, *The Granting of European Patents*, A. W. Sijthoff, Leyden, 1975, mn. 58.
[30] s. the remarks presented in this sense at the Inter-Governmental Conference by a considerable number of non-governmental international organisations in **BR/39/70**, mn. 5.
[31] M. van Empel, *The Granting of European Patents*, mn. 661,

of the description of the European patent, it is clear that the committee considered the provision Re. Article 66, no. 3 of the 1970 Draft Implementing Regulations, i.e., future Art. 84, second sentence, EPC as pursuing the same goal of future Art. 69(1) EPC and as having the function of ensuring a consistent disclosure of the invention.

156. Reference to post-grant infringement proceedings in the remarks of the sub-committee in **BR/51/70**, mn. 18 also highlights an underlying objective of harmonisation of European patent law. by tying the requirements of the application before grant to the assessment of infringement after grant: *tout se tient*, in the Convention.

157. In view of these considerations, it is maintained that Art. 69(1), second sentence, EPC provides further support for the conclusion that the requirement of support defined in Art. 84, second sentence, second clause EPC puts a requirement both on the claims and on the description to be consistent with each other, having regard to the need for an efficient and harmonised determination of the scope of protection conferred by a European patent after grant.

VI. THE TRAVAUX PRÉPARATOIRES TO THE EPC 1973

158. The analysis of the evidence available in the Travaux Préparatoires to the EPC 1973 on the provisions governing the content and function of the description and the claims and their relationship confirm the results of the textual and systematic interpretation of Art. 84 EPC and R. 42(1)(c) and 48(1)(c) EPC discussed above.

159. In the working proposal of a Convention (s. **IV/3858/61**) prepared by the Chairman of the EEC Patents Working Group, Kurt Haertel, **the claims were initially an integral part of the description**, in line with former German law[32] and Dutch law[33].

160. According to par. 1 of Art. 64 of the proposal, which defines the content of the description, the invention must be disclosed in the description so clearly and fully that a skilled person can carry it out accordingly. According to par. 2 of the same provision, at the end of the description one or more claims must precisely define what the applicant desires protection for[34].

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[32] s. for example R. Teschemacher, *Münchner Gemeinschaftskommentar*, Art. 84, mn. 12, footnote 25, referring to §26(1), sentence 5 of the German Patent Act of 1978 (PatG 1978).

[33] s. Art. 20 of the Dutch Patent Act of 1910 (*Rijksoctrooiwet* 1910).

[34] s. **IV/3858/61**, «*Artikel 64 - **Inhalt der Beschreibung**:*
(1) In der Beschreibung ist die Erfindung so deutlich und vollständig zu offenbaren, dass ein Fachmann sie danach ausführen kann.
*(2) **Am Schluss der Beschreibung** ist in **einem oder mehreren Patentansprüchen** anzugeben, wofür der Anmelder Schutz begehrt.*» (emphasis added).

161. In the remarks presented in the so-called Haertel Draft («*Haertel-Entwurf*») on the aforementioned par. 2 of Art. 64, the Chairman noted that the provision defined the claim as the characterisation of that for which the applicant desires protection and explained that the proposal considered the claims as a constituent part of the description, because they represent a summary of the essential content of the invention disclosed in the description[35].

162. The claims and the description were thus seen in the working proposal as parts of one and the same document, the purpose of which was to clearly and fully disclose the invention for which protection was sought, in line with the finding, discussed above, that the description and the claims of a European patent application belong together and form a unitary document.

163. In the **Annex** to the so-called "**Haertel Study**"[36], the Chairman explained on pp. 10 and 11 that the **formulation of claims** was necessary for a European patent examination procedure, since **the novelty search would be significantly simplified** by providing that the core of the invention be distinguished from the prior art by means of clearly formulated claims[37]. In the same passage, the Chairman also remarked that the formulation of claims in the application would also **simplify the interpretation of the European patent**, since the extent of protection would be limited to what was stated in the claims or, at least, the claims could primarily be considered for interpreting the extent of protection of the patent[38].

164. The question whether the claims should be an independent element of the application or, rather, a part of the description was discussed in the 9th session of the Patents Working Group, but it was decided to leave the question open (s. **7769/IV/63**, discussion of the regulation relating to Art. 68, no. 4, par. 3).

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[35] s. Vorschläge des Vorsitzenden der EWG-Arbeitsgruppe „Patente" vom 29. Mai 1961 - 9. April 1962 zu Art. 1 - 282 des Übereinkommens und zur Ausführungsordnung - „Haertel-Entwurf", zu Art. 64 - Inhalt der Beschreibung: «*Abs. 2 enthält das Erfordernis der Aufstellung von Patentansprüchen und definiert den Patentanspruch als die Kennzeichnung dessen, wofür der Anmelder Schutz begehrt. Da die* ***Patentansprüche*** *eine* ***Zusammenfassung des wesentlichen Inhalts der in der Beschreibung offenbarten Erfindung*** *darstellen, sieht der Arbeitsentwurf sie als* ***Bestandteil der Beschreibung*** *an.*» (emphasis added).

[36] «*Studie über die grundsätzlichen Probleme der Schaffung eines europäischen Patents, das neben die nationalen Patente tritt - von Kurt Haertel*», 7 July 1960, generally referred to as „*Haertel-Studie*" in German.

[37] s. Annex to the „*Haertel-Studie*", p. 10-11:

«*II. Aufstellung von Patentansprüchen*

[…]

1.) Die Ausgestaltung des Verfahrens.

Die Aufstellung von Patentansprüchen ist notwendig, wenn für das europäische Patentrecht ein irgendwie geartetes Prüfungsverfahren vorgesehen wird. Denn ***eine Neuheitsrecherche wird wesentlich dadurch erleichtert, daß der Kern der Erfindung durch genau formulierte Ansprüche von allgemeinem Stand der Technik abgegrenzt wird***». (emphasis added).

[38] s. Annex to the „Haertel-Studie", p. 11: «*2.)* ***Die Aufstellung von Patentansprüchen*** *in der Anmeldung* ***bietet auch die Handhabe, die Auslegung des europäischen Patents zu erleichtern****, indem der sachliche Schutzbereich des Patents auf das beschränkt wird, was in den Ansprüchen offenbart ist oder die Ansprüche in erster Linie zur Auslegung des sachlichen Schutzbereich des Patents herangezogen werden*». (emphasis added).

165. The discussion was conducted on the basis of a working draft of Implementing Regulations («*Arbeitsentwurf zu einer Ausführungsordnung zum Abkommen über ein europäisches Patentrecht*»)[39] prepared in March 1963 by the Chairman of the Working Group, i.e., Kurt Haertel.

166. This draft contained a **provision on the content of the description**, referred to in the original German as «***Zu Artikel 68 - Nummer 3***», requiring that the description be arranged clearly and formulated **linguistically** in a **correct and concise** manner (s. par. 1 of the provision[40]), and a **provision on the form and content of the claims**, referred to as «***Zu Artikel 68 - Nummer 4***».

167. The second sentence of par. (3) of the latter provision governing the form and content of the claims stipulated that the **claims must be in accordance** (literally: in unison, «***im Einklang***», in German) **with the description** and the drawings[41]. This provision, which is the predecessor of Art. 84, second sentence, second half clause, EPC, thus clearly required that **the description and the claims should be consistent with each other**.

168. The comment presented in the decision **T 56/21** (s. Reasons, point D.II.55, p. 41) on the wording of this provision as allegedly being «*intended to address the concern that the claims might include subject-matter which is not included in the description, and not the other way round*» cannot be shared, because it seems to misconstrue the discussion that occurred within the Patents Working Group.

169. An account of this discussion is given in the document **7669/IV/63**, on pp. 7 and 8.

170. During this discussion the French delegate asked whether the requirement defined in in par. 3 of the provision «***Zu Artikel 68 - Nummer 4***»[42] was necessary, in view of the fact that it had been decided that the claims should be part of the description (s. s. **7669/IV/63**, p. 7, last par.). The French delegate and the Belgian delegate then drew the attention of the Working group on the possibility that an inventor might specify in the claims an element that is not contained in the description.[43]

171. The Dutch delegate observed, in this regard, that the Patent Office could always request the inventor to amend the description correspondingly, to which the French delegate replied that he was of the opinion that, in that case, the second sentence of par. (3) - requiring the claims to be in accordance with the description

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[39] Available in the online documentation on the Travaux Préparatoires as "*Haertel-Entwurf AO 1963*".

[40] In the original German text: «***Die Beschreibung muß übersichtlich*** *geordnet sowie* ***sprachlich richtig und knapp*** *abgefaßt* ***sein.***» (emphasis added).

[41] In the original German text: «***Die Patentansprüche müssen mit der Beschreibung*** *und mit den Zeichnungen* ***im Einklang stehen***»; (emphasis added).

[42] The minutes in the last par. of p. 7 of **7669/IV/63** erroneously refer to «***Nummer 3*** *zu Artikel 68*» (emphasis added), but it is clear from the subsequent mention of the content of the claims («*den Inhalt der Patentansprüche*») that the comment of the French delegate concerns **no. 4** of Art. 68.

[43] s. **7669/IV/63**, p. 8, par. 1: «*Herr De Muyser und Herr Fressonet machen die Arbeitsgruppe auf die Möglichkeit aufmerksam, daß ein Erfinder in den Ansprüchen einen Bestandteil aufführt, der in der Beschreibung nicht enthalten ist*».

and the drawings - was not necessary, but that he would have no serious objections to maintaining that provision[44].

172. The entire discussion clearly shows that the delegates shared the common understanding that the description *stricto sensu* and the claims, as parts of one single document formally called "description" in Art. 68 of the draft, should be consistent and have the same content.

173. It is true, as noted in T 56/21, that the remark made by the French delegate and the Belgian delegate concerned a situation where the claims might include subject matter which was not included in the description and not the other way round, but it is incorrect to conclude - as the Board did in T 56/21 - that the discussion reported in 7669/IV/63 would not support a requirement to bring the description into agreement with the claims *by deleting subject matter disclosed in the description but not claimed*, because such a situation (i.e., matter disclosed in the description *stricto sensu* but not claimed) was not discussed at all, in the meeting reported in 7669/IV/63.

174. The conclusion drawn the Board in T 56/2 is thus speculative and does not follow from the content of the actual discussion recorded in the minutes.

175. The passage on pp. 7 and 8 of 7669/IV/63, in particular the exchange between the Dutch and French delegates, merely supports the general conclusion that the delegates shared the understanding that the content of the description and of the claims should be aligned, i.e., be consistent with each other.

176. On the margin of the provision governing the form and content of the claims in the Draft Implementing Regulations of 1963, i.e., the aforementioned provision called «Zu Artikel 68 - Nummer 4», K. Haertel provided an indication of the national legal provisions that he had taken into account for formulating the provision, those national provisions being §3(5) of the German patent application regulations («§ 3 Absatz 5 der *deutschen Anmeldebestimmungen für Patente*» in the original German text) and Art. 23(4), fourth sentence, of the Dutch implementing regulations for patents («*Artikel 24 Absatz 4 Satz 3 der niederländischen Ausführungsbestimmungen für Patente*»).

177. It is recalled that Germany and the Netherlands were the only countries, amongst the six EEC founding countries that were represented in the EEC Patents Working Group, having at the time an examination system for patents.

[44] s. 7669/IV/63, p. 8, par. 2 and 3: «*Herr van Benthem bemerkt hierzu, daß das Patentamt vom Erfinder jederzeit verlangen könne, die Beschreibung entsprechend zu ändern. Herr Fressonet is der Ansicht, daß dann der zweite Satz von Absatz 3 nicht nötig sei. Er habe jedoch keine schwerwiegenden Bedenken gegen seine Beibehaltung*».

178. According to the German and Dutch patent law of the time, the claims were part of the description: for example, the provision cited by K. Haertel, namely §3(5) of the Regulations of 1954, concerning the description with the claim («*Beschreibung mit Patentanspruch*») read as follows: «*Am Schluß der Beschreibung ist anzugeben was als patentfähig unter Schutz gestellt werden soll (Patentanspruch)*». The Dutch Patent Act (*Rijksoctrooiwet - in short: OW*) contained a similar provision (Art. 20 OW)[45].

179. The respective implementing regulations for German and Dutch patent applications (*Anmeldebestimmungen für Patente*, in Germany, *Octrooireglement*, in the Netherlands) required that the **description be clear and complete**[46], drafted as **concise** as possible and **free of any unnecessary parts**[47] **which would cause the disclosure** of the invention **to become obscure or inaccurate**[48].

180. It may be therefore inferred that **the provision governing the form and content of the claims** in the Draft Implementing Regulations of 1963 and, in particular, the predecessor of Art. 84, second sentence, second clause, EPC, namely **par. (3) of the provision relating to Art. 68, no. 4** (s. point 167 *supra*: «*Die Patentansprüche müssen mit der Beschreibung* […] *im Einklang stehen*»), **reflected the requirement of consistency of the description and the claims with each other of the German and Dutch provisions in force at the time**.

181. Although the *Travaux Préparatoires* to the EPC contain little material on this aspect, most likely because a common understanding of the essential aspects of substantive patent law had already been achieved amongst the Six through the work that had led to the Strasbourg Convention on the unification of

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[45] Although Dutch patent applications are no longer subjected to examination, the Dutch Patent Act (*Rijksoctrooiwet*) still stipulates to this day, in Art. 24(1)(e), that the claims are part of the description of a patent application: «*Een aanvrage om octrooi … moet … vergezeld zijn van* ***een beschrijving van de uitvinding, die aan het slot in één of meer conclusies een omschrijving geeft van datgene, waarvoor bescherming wordt verlangd***.» (emphasis added).

[46] This requirement is still foreseen in Art. 25(1) of the Dutch Patent Act: «***De beschrijving van de uitvinding is duidelijk en volledig*** *en wordt zodanig opgesteld dat de uitvinding daaruit door een deskundige kan worden begrepen en aan de hand daarvan kan worden toegepast*». Also s. the Report of the «*Mini-Commission*» of the German AIPPI group on Question 69 («Ausreichende Beschreibung der Erfindung»), AIPPI Yearbook 1977/I, p. 277: «***Die Beschreibung muss vollständig und klar sein***».

[47] s. the various versions of the German regulations (*Anmeldebestimmungen*) cited in the footnote 47 of O. Bossung, *Münchner Gemeinschaftskommentar*, Art. 78 EPC, mn. 91, such as for example §3(2) **AB 1954**: «*In der Beschreibung ist die Erfindung zu erläutern.* ***Alles, was nicht zur Klarstellung der Erfindung dient, ist in die Beschreibung nicht aufzunehmen***.», and the corresponding provision in AB 1965: «***In der Beschreibung sind nur solche Angaben aufzunehmen, die zur Erläuterung der Erfindung notwendig sind***».

[48] s. the comments on the requirement of clarity of the description in the renowned **handbook of Dutch patent law by B. M. Telders**, *Nederlandsch Octrooirecht*, Martinus Nijhoff, the Hague, 2nd revised edition, 1946, in mn. 178 and 179. In this passage, with reference to Art. 20(3) of the Patent Act of 1910 (which remained in force until 1995) and Art. 23(2) of the Implementing Regulations, B. M. states:

> «178. ***Duidelijkheid der beschrijving***. *Als laatsten eisch stelt art. 20 lid 3 O.W. [i.e., Octrooiwet], dat* ***de beschrijving duidelijk moet zijn*** *[...]. De eisch van duidelijkheid geldt zoweel voor de omschrijving der uitvinding zelve, als voor de wijze van uitdrukking en de taal. Men vergeliijke voor de aan de beschrijving te stellen duidelijkheid ook art. 23 lid 3 O.R. [i.e., Octrooiregelement].*
> *179. De eisch van duidelijkheid t.a.v. de omschrijving houdt in, dat* ***de beschrijving niets mag bevatten, waardoor het beeld der uitvinding zoude vervagen of onnauwkeurig zoude worden: noodelooze uitwijdingen behooren due te worden vermeden***».

certain points of substantive law[49], it may be gleaned from the *Travaux Préparatoires* and, in particular, from document **BR 51/70**, mn. 24 that **the members of the sub-committee of Working Party I** tasked with the preparation of the Implementing Regulations **shared a common understanding that the application in its entirety should be consistent**.

182. The passage in **BR 51/70**, mn. 24 concerned the **implementing regulation relating to Art. 66, no. 6 on prohibited matter**, i.e., the predecessor or R. 48(1)(c) EPC (= R. 34(1)(c) EPC 1973), and in particular the question whether there should be a prohibition to make reference to trade marks in the European patent application, so as to ensure that the application and, in particular, the description be clear in itself[50]. After noting that the text of the provision followed the text of the PCT regulations (i.e., R. 9.1 of the PCT regulations: s. **BR/GT I/52/70**, p. 32), mn. 24 of **BR 51/70** states that **the sub-committee** «***did not consider it desirable to include such a prohibition*** *in the Implementing Regulations*», **because** «***it already appeared to be implicit in the provisions regarding the precision and clarity of the terms of the application***». (emphasis added).

183. The fact that the sub-committee considered certain matter (trademarks) to be ***implicitly excluded*** **by the provisions regarding the precision and clarity of the terms of the application** implies that there was **agreement that the application in its entirety was subject to the requirement of precision and clarity**, which again points to a common understanding that **the description and the claims of an application should be consistent**.

184. As a result of the discussions at the aforementioned 9th session of the Patents Working Group, it was proposed to amend Art. 68 of the then current draft and to formally separate the claims from the description. According to Art. 68 of this revised draft, defining the requirements of the application, the European patent application had to include a description of the invention (Art. 68(1), letter b) and one or more claims defining the matter for which the applicant requested protection (Art. 68(1), letter c - s. **8980/IV/63**, Art. 68).

185. A note to Art. 68 according to this revised draft explains that the amendment of the provision had the objective of clearly distinguishing the description, the claims and the drawings and made the amendment of the text of several articles of the Draft Convention necessary.

186. The separation of the claims from the description was confirmed in the Preliminary Draft of 1965 (s. **2335/IV/65**, Art. 68(1), letters b and c).

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[49] cf. R. Teschemascher in *Münchner Gemeinschaftskommentar*, Art. 83 EPC, mn. 11.

[50] s. the remark by R. Singer reported in **7669/IV/63**, p. 2, Art. 68 - no. 3 on the prohibition of using trade marks in the description: «*Herr Singer spricht sich für die* ***Beibehaltung des Verbotes*** *aus und weist darauf hin, daß* ***die Beschreibung aus sich heraus verständlich sein müsse***» (emphasis added).

187. While efforts to create a European Patent Convention came to a temporary halt in 1965, work on the PCT was started at international level. The most important requirements as to the content and the form of the claims were worked out in 1968. The result of work of the PCT Committee of Experts set up by the BIRPI for the Meeting of Consultants that took place in Geneva from 30 April to 2 May 1968 was summarised in a Memorandum (document **PCT/C/2**) which, in mn. 13, contained all the requirements of the claims that were subsequently incorporated into Art. 6 and R. 6 PCT.

188. In particular, mn. 13.2 of **PCT/C/2** specified that the claims should be «*clear, concise and **fully supported by the description***».

189. Work at the European level was in the meantime resumed with the preparation of a First Preliminary Draft of a Convention Establishing a European System for the Grant of Patents of 1970, the so-called First Preliminary Draft of 1970[51].

190. **Art. 66 of this Draft maintained the separation between the description and the claims** which had already been adopted in the Preliminary Draft of 1965.

191. Preliminary Draft Implementing Regulations on, *inter alia*, the requirements of the description and the claims of a European patent application in connection with the First Preliminary Draft of 1970 were prepared by the Working Group I sub-committee on Implementing Regulations in 1970.

192. The outcome of the work of the sub-committee is presented in document **BR/50/70**, while document **BR/51/70** contains the minutes of the meeting of the sub-committee, held in September 1970.

193. In the Preliminary Draft Implementing Regulations of 1970, the implementing regulation Re. Article 66, no. 2 specified the requirements of the contents of the description and is substantially identical to R. 27 EPC 1973, i.e., R. 42 EPC, whereas the implementing regulation **Re. Article 66, no. 3** regulates the **form and content of the claims** of a European patent application, par. (1) of this provision requiring that the claims be clear and concise and that they be **fully supported by the description**, as recalled in mn. 18 of **BR/51/70**.

194. As explained in **BR/51/70**, mn. 5, some of the provisions - *inter alia*, Re. Article 66, no. 3, - **were aligned with the text of the corresponding PCT provisions**: in particular, the provision governing the form and content of the claims, i.e., Re. Article 66, no. 3, was based on Art. 6 PCT and R. 9.1 PCT (cf. pp. 25-32 of **BR/GT I/52/70**).

[51] Published in IIC 1970, 80.

195. In the minutes (s. **BR/51/70**, mn. 18) it is indicated that the sub-committee considered **Re. Article 66, no. 3** «***so important*** - *particularly* ***from the point of view of infringement actions*** - *that* [it] *felt inserting this provision in the Convention should be considered*» (emphasis added).

196. The sub-committee's remark about the importance of the provision governing the form and content of the claims of a European patent application from the point of view of infringement is telling.

197. The requirements set out in **Re. Article 66, no. 3 would become** - but for a small change[52] - **Art. 84, second sentence, second half clause EPC**.

198. The sub-committee's remark shows that **the relationship between the description and the claims in a European patent *application***, including the requirement that the claims be supported by the description, was seen by the sub-committee as **particularly important for the subsequent assessment of infringement** of a European patent granted on that application, thereby confirming what has been said above about the relationship between Art. 69 EPC and Art. 84 EPC (s. points 154-156 above).

199. Since the assessment of infringement of a European patent requires the determination of the scope of protection of the patent, which according to Art. 20(1) of the First Preliminary Draft 1970 is to be determined «*by the terms of the claims*» of the patent, subject to the provision that «*the description and drawings* […] *be used to interpret the claims*», it becomes apparent that the sub-committee considered the fulfilment of the requirements governing the relationship between the description and the claims in a European patent application as having a paramount influence on the subsequent determination of the extent of protection of the resulting European patent.

200. In other words, it is apparent that, already at this stage, **the provisions governing the relationship between the description and the claims in a European patent application**, later on merged into Art. 84 EPC, **were regarded as the counterpart of the provision governing the extent of protection conferred by a European patent**, i.e., the future Art. 69 EPC.[53]

201. The suggestion (s. **BR/51/70**, mn. 18) to insert the provisions governing the relationship between the description and the claims into the Convention, mentioned above, was taken up at the Inter-Governmental Conference (s. **BR/125/71**, point 172). Those provisions were combined with the stipulation of the purpose of the claims so as to form a unitary provision, **Art. 71a of the Second Preliminary Draft**, that substantially

[52] The deletion of the word «fully».
[53] cf. R. Teschemacher in *Münchner Gemeinschaftskommentar*, Art. 84 EPC, mn. 2.

corresponds to Art. 84 EPC except for the stipulation (no longer present in Art. 84 EPC) that the claims be *fully* supported by the description.

202. This stipulation in Art. 71a of the Second Preliminary Draft (s. **BR/177/72**, mn. 42) was changed at the suggestion of several professional organisations (s. **BR/169/72**, mn. 72), some of which proposed to replace the English expression «*fully*» (and its counterparts in German and French, namely «*entièrement*» and «*in vollem Umfang*») by the term «*fairly*» (and its counterparts «*convenablement*» and «*in ausreichendem Masse*»).

203. However, contrary to what is for example held in **T 56/21**, Reasons, point 57[54], the suppression of the word «*fully*» in Art. 71a of the Second Preliminary Draft was not motivated by fear that the phrase «*fully supported by the description*» could be interpreted in a restrictive manner excluding drawings, as argued in **T 56/21** on the basis of historical material relating to the genesis of the PCT: **the evidence available from the *Travaux Préparatoires* to the EPC 1973 shows that the reason was that the phrase «*fully supported by the description*» might be construed as requiring strict, literal support**.

204. This is apparent, for example, from the submissions presented by the AIPPI in the document **BR/158/72**.

205. This association noted first, **with regard to** the predecessor of Art. 69(1) EPC, namely **Art. 20(1)** of the Second Preliminary Draft, that «*the words "teneur" or "terms" would lead to a **strict or literal interpretation of the claims***» (s. **BR/158/72**, p. 4) and, subsequently, it remarked **with regard to Art. 71a** the following: «***In consequence of what has been said above concerning Art. 20, the following words should be deleted**: - "entièrement", in the French text; - **"fully" in the English text**, - "in vollem Umfang" in the German text.*» (emphasis added).

206. The reference to the first remark about Art. 20(1) to justify the request of deletion of the word «*fully*» makes it clear that the AIPPII was preoccupied that **the phrase «*fully supported by the description*» could be misinterpreted as requiring literal support in the description. This has nothing to do with the drawings**.

207. It is also observed that the request of deletion of the words «*fully*», «*entièrement*» and «*in vollem Umfang*» from the three versions of Art. 71a of the Second Draft Convention cannot be taken to mean that the description could be at variance or in disagreement with the claims.

[54] **T 56/21** relies on the notes on Art. 6, third sentence, PCT contained in the Records of the Washington Diplomatic Conference, instead of relying on the evidence available in the *Travaux Préparatoires* to the EPC 1973, most notably **BR/147/72** and **BR/158/72**.

208. The expressions suggested as replacements for those words by some organisations, for example by the C.I.F.E (s. document **BR/147/172**, observations on Art. 71a, and the aforementioned document **BR/169/72**, mn. 72), namely «*fairly*», «*convenablement*» and «*in ausreichendem Masse*» rather suggest that the aim was to **mitigate the risk of requiring literal disclosure** - rather than to a reasonable degree - of the matter defined in the claims.

209. From the above outline of the legislative history of the requirement that the claims be supported by the description it is possible to draw the following conclusions:

210. a) the provisions governing the relationship between the description and the claims in the various drafts of the Convention and of the Implementing Regulations prepared until 1965 were based on German and Dutch provisions that required the description and the claims of national patent applications to be **consistent** with each other and **prohibited the inclusion**, in the description, **of matter unrelated to the invention**;

211. b) **this understanding of the relationship between the description and the claims** as being tied to each other so as **to form a consistent disclosure, free of unnecessary parts in the description, also holds for the European patent application** (s. the discussion of the provision on the form and content of the claims in the Draft Implementing Regulations of 1963 and the provision on prohibited matter in the 1965 Draft presented above at points 180 and 182182);

212. c) there is no evidence in the *Travaux Préparatoires* that the alignment of the wording of the predecessor of Art. 84 EPC, namely Art. 71a of the Second Draft Convention, with the provisions of the PCT was meant to depart from that understanding;

213. d) the understanding of the relationship between the description and the claims as being governed by a requirement of consistency was understood to be of great importance for the determination of the extent of protection of a European patent in subsequent infringement proceedings.

214. These conclusions on the basis of the Travaux Préparatoires thus provide support for the textual and systematic interpretation of Article 84, second sentence, second half clause, EPC and of the other provisions, in particular R. 42(1)(c) EPC and R. 48(1)(c) EPC as well as Art. 69 EPC, which govern the relationship between the description and the claims of European patent applications and European patents.

VII. CONCLUSIONS AND ACKNOWLEDGEMENTS

215. In view of the analysis of the legal provisions of the EPC that govern the relationship between the description and the claims both in a European patent application and in a European patent, having regard to the language of those provision considered on its own and in view of their object and purpose the wider system of the EPC and taking into account the evidence derivable from historical sources such as the *Travaux Préparatoires* to the EPC 1973, it may be therefore concluded that **the description and the claims of European patent applications and Europea patents must be consistent with each other**, in the sense that the disclosure of the invention in the description and the definition of the invention in the claims cannot be in disagreement from a technical and terminological point of view; furthermore, the description must disclose the invention defined in the claims and not some different invention.

216. Hence, if an amendment to the claims of a European patent application or a European patent introduces an inconsistency between the description and the claims, in the sense that the description discloses a solution in terms that are partially or wholly not in agreement (technically or terminologically) with the claimed invention, the description must be amended to remove the inconsistency.

217. The legal provisions of the EPC necessitating an amendment of the description to remove the inconsistency are Art. 84, second sentence, second clause, EPC, R. 42(1)(c) EPC and R. 48(1)(c) EPC

218. These provisions are applicable in examination and examination-appeal proceedings as well as in opposition and opposition-appeal proceedings.

219. Mr Peter de Lange of the patent law firm V.O. Patents & Trademarks is heartfully thanked for having kindly provided a copy of B. M. Telders' commentary of 1946 on Dutch patent law, cited above in the footnotes 25 and 48.