



## An End to Adapting the Description to Allowed Claims at the EPO?

February 2, 2022

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According to EPO Examining Division practice, once claims are found to be allowable, the description must be “*adapted to the claims to avoid inconsistencies between the claims and the description*” (The Guidelines for Examination in the European Patent Office, Part F, Chapter IV, section 4.3, paragraph iii[1]). In a recent decision (T1989/18[2]) an EPO Technical Board of Appeal considered the legal basis for this requirement.

The appeal was filed against a decision by the Examining Division to refuse European patent application number 12810245.6[3]. While the claims were found to be allowable, the amendments made to the description to “*adapt*” it to the claims were considered insufficient. In particular, the Examining Division considered that the description was broader than the subject matter of the allowed claims. The application was therefore refused for falling foul of Article 84[4] of the European Patent Convention (EPC), which requires that the claims be clear, concise, and supported by the description.

In the Grounds of Appeal, the applicant argued that there is no basis in the EPC to require that the description be so adapted. The applicant also noted that this requirement, which appears only in the Guidelines for Examination in the European Patent Office, is often applied in an inconsistent way by different EPO examiners.

The Technical Board of Appeal considered each of Articles 69(1)[5] and 84 EPC, as well as Rules 42(1)(c)[6] and 48(1)(c)[7] EPC and held that there is no legal basis in the EPC to require a description to be adapted to allowed claims. In regard to Article 84 EPC in particular, the Technical Board of Appeal stated that if allowed claims are clear in and of themselves, and supported by the description, their clarity is not affected by any described subject matter which may fall outside the scope of such allowed claims.

### What does this mean for Canadian applicants?

The requirement to adapt a description to an allowed set of claims has long been an irritation for many applicants and patent practitioners, who often perceive this extra formal step as an unnecessary and costly addition to an already costly procedure. For North American applicants and practitioners, the requirement has been particularly burdensome because of the ever-present specter of file wrapper estoppel.

While it remains to be seen whether (and how quickly) the EPO will amend The Guidelines for Examination in the European Patent Office to reflect this decision, applicants and practitioners can now use this decision to push back on objections made by EPO examiners. For more information regarding any of the above, or for guidance on how to take advantage of this recent decision, please get in touch with a member of the [Bereskin & Parr Patent Team](#).



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[1] [https://www.epo.org/law-practice/legal-texts/html/guidelines/e/f\\_iv\\_4\\_3.htm](https://www.epo.org/law-practice/legal-texts/html/guidelines/e/f_iv_4_3.htm)

[2] <https://www.epo.org/law-practice/case-law-appeals/recent/t181989eu1.html>

[3] <https://worldwide.espacenet.com/patent/search/family/047504950/publication/EP2794651A2?q=12810245.6>

[4] <https://www.epo.org/law-practice/legal-texts/html/epc/2020/e/ar84.html>

[5] <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ar69.html>

[6] <https://www.epo.org/law-practice/legal-texts/html/epc/2020/e/r42.html>

[7] <https://www.epo.org/law-practice/legal-texts/html/epc/2020/e/r48.html>

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