

DISCLOSURE OF THE INVENTION IN A PATENT APPLICATION



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According to Article 83 of the European Patent Convention (EPC) an invention must be disclosed in a patent application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Article 83 is relevant not only in the substantive examination stage but its terms are also prerequisite for the published European patent application to serve as prior art against the grant of later patent applications.

Applicants are often reluctant to describe in the patent application important aspects of their invention. On the one hand they want a patent and monopoly on the invention, on the other hand they are afraid of being copied in opted-out jurisdictions if they reveal too many features of the invention. A patent application drafted in view of this compromise may turn out to be a poor solution since it fails to comply with at least the 'complete' requirement of Article 83 EPC.

Some recent decisions from the Technical Board of Appeal of the European Patent Office (EPO) are discussed below to provide an indication of how to comply with Article 83 EPC and how to use it in opposition proceedings.

If an opposition under Article 83 EPC is successful the European patent can be revoked even if the invention in fact was both novel and inventive. Decision T 1340/10 of May 22, 2013 related to a European patent application describing 22 specific embodiments of ceramic aggregate particles and their preparation. Despite the huge number of examples of embodiments the opponent claimed that the skilled person was unable to carry out the invention. Moreover the opponent argued that the skilled person would not know whether or not he was working within the area defined by the claims. The opponent did not provide evidence for his allegations.

On the first objection the EPO disagreed, stating that the opponent had the burden of proof and that he did not provide any evidence, for instance by reproducing an example showing that the preparation details disclosed in the European patent, in particular in its examples, were insufficient to arrive at the claimed subject matter. For the second objection the EPO took the view that it concerned the boundaries of the claims, and thus their clarity, not the disclosure of the invention.

Decision T 0538/10 of June 11, 2013 concerns Article 83 as a ground for opposition. This ground was mentioned for the first time during the written proceeding of the opposition, but well after termination of the nine-month deadline for filing the opposition. So the ground under Article 83 constituted a new ground for opposition, introduction of which is normally not allowed.

The Board of Appeal found that there was no doubt that the issue of sufficiency according to Article 83 EPC was discussed during the oral

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proceedings before the Opposition Division and was decided upon in the decision under appeal, and that the Opposition Division *de facto* had admitted the ground into the opposition proceedings. Nor did any of the parties challenge the admission of the new ground.

The issue under consideration was that the specification of the patent contained no particular teaching of a molar ratio in relation to colour properties of a brominated polystyrene. In the absence of any such guidance, the skilled person would therefore expect, in particular because the products are 'not conventionally produced', that carrying out a process according to the preferred embodiments disclosed in the specification would lead to preferred brominated polystyrene having the claimed colour properties.

But examples given for the invention showed the opposite. In view of the fact that two of the five examples performed according to the teaching of the patent in suit led to products outside the main claim—even though the European patent provided three examples showing the preparation of products as claimed—the Technical Board of Appeal found that this was not sufficient to support a general guidance of how reliably to prepare the claimed products and refused the European patent.

Examples of how to carry out the invention and preferred embodiments should therefore be provided in the specification to support clarity and completeness of the claims, and the application in its entirety, but the examples and preferred embodiments must demonstrate what is claimed.

The requirements of Article 83 are often given less attention than the requirements for novelty and inventive step. However if a European patent application is drafted without clear and complete information of how to carry out the invention, the European patent application can be refused in examination, is open to opposition under this ground, and it may even be so that it cannot be used against other patents as prior art in oppositions. ■

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