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REQUIREMENTS CONCERNING THE RELATIONSHIP OF THE CLAIMS TO THE DISCLOSURE

prepared by the International Bureau

I. INTRODUCTION

1. During the sixth session of the Standing Committee on the Law of Patents (SCP), held in Geneva from November 5 to 9, 2001, it was suggested that the International Bureau undertake a comparative analysis of different patent systems concerning the relationship of the claims to the disclosure (see paragraphs 173 and 174 of document SCP/6/9 Prov. 2).
2. Many national and regional laws provide provisions regulating the relationship of the claims to the disclosure. Some of them are reproduced in the Annex. In many instances, that relationship is characterized in a way that the claims shall be supported by the description, or, in some laws, by the specification which generally contains the description and the claim(s). In other laws, in place of the words "supported by", terms such as "based on" or "described in" are used. In other cases, the relationship between the claims and the specification is regulated in a manner that the claims shall not go beyond the contents of the specification. The law of the United States of America provides that "the specifications shall contain a written description of the invention."
3. It should be noted that the legal consequences of the non-compliance with such a requirement vary from one country to another. For example, in some countries, the requirement is not a ground for opposition or the revocation of the patent, while in other countries, non-compliance with that requirement results in the revocation of the patent.

Information concerning the legal consequences under different national and regional laws is also contained in the Annex.

4. For the purposes of achieving deep harmonization of patent laws and practices on this issue, rather than focusing on the terminology used, it may be appropriate to explore the different practices and to enhance the understanding of the essential underlying principles of the respective laws. The following part will, therefore, indicate how the requirement concerning the relationship of the claim to the disclosure is applied in practice in Europe under the European Patent Convention (EPC), in Japan and in the United States of America. Part III provides an analysis of the concept underlying the relationship between the claims and the disclosure, and finally, Part IV contains a suggestion by the International Bureau for a draft provision to be included in the Substantive Patent Law Treaty (SPLT).

II. PRACTICES UNDER CERTAIN NATIONAL/REGIONAL LAWS

European Patent Convention (EPC)

5. The relationship of the claim to the disclosure is regulated under Article 84 of the EPC, which states that “The claims must be supported by the description.”

6. According to the Guidelines for Examination in the European Patent Office (EPO) ¹ (hereinafter referred to as the “EPO Examination Guidelines”), C -III, 6.1, this requirement means that there must be a basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than what is justified by the extent of the description and drawings as well as the contribution to the art. It is considered that a fair statement of claim is one which is not so broad that it goes beyond the invention, nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. Therefore, the applicants should be allowed to cover all obvious modifications, equivalent to and uses of that which he has described (Examination Guidelines, C -III, 6.2).

7. As a general rule, a claim should be regarded as supported by the description, unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis (Examination Guidelines, C -III, 6.3). Therefore, a claiming generic form relating to a whole class of, for example, materials or machines, may be acceptable despite its broad scope, if there is a fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed.

8. The following examples relating to the support requirement are given in the Examination Guidelines, C -III, 6.4:

(a) A claim relates to a process for treating all kinds of “plant seedlings” by subjecting them to a controlled cold shock so as to produce specified results, whereas the description discloses the process applied to one kind of plant only. Since it is well-known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicant can provide

¹ Also available at: http://www.european-patent-office.org/legal/gui_lines/index.htm.

convincing evidence that the process is nevertheless generally applicable, he must restrict his claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient.

(b) A claim relates to a specified method of treating “synthetic resin moldings” to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inapplicable to thermosetting resins. Unless the applicant can provide evidence that the method is nevertheless applicable to thermosetting resins, he must restrict his claim to thermoplastic resins.

(c) A claim relates to improved fuel oil compositions which have a given desired property. The description provides support for one way of obtaining fuel oil having this property, which is by the presence of defined amounts of a certain additive. No other ways of obtaining fuel oil having the desired property are disclosed. The claim makes no mention of the additive. The claim is not supported over the whole of its breadth.

9. Turning to the Case Law of the Boards of Appeal², Part II, Chapter B, 3 provides some references to the decisions of the Boards of Appeal. In decision T 133/85 (OJ 1988, 441), the board took the view that a claim which did not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which was therefore inconsistent with the description, was not supported by the description for the purpose of Article 84 (see also T 409/91, OJ 1994, 653). In T 659/93, the board confirmed that the requirement that the claims should be supported by the description meant that they had not only to contain all the features presented as essential in the description, but had also to reflect the applicants’ effective contribution by enabling the skilled person to carry out their teaching throughout the field to which they applied.

10. In this context, it should be noted that Article 83 of the EPC, which reads as follows, also relates, to a certain extent, to the relationship of the claims to the disclosure:

“The European patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.”

11. According to the Examination Guidelines, C -II, 4.1, the purpose of the provisions of Article 83 (enablement requirement) is:

(i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and

(ii) to enable the reader to understand the contribution to the art which the invention as claimed has made.

12. The Examination Guidelines, C -III, 6.4, sixth paragraph, note that the objection of lack of support under Article 84 often also constitutes an objection of insufficient disclosure of the invention under Article 83. The example given is that the disclosure is insufficient to enable the skilled person to carry out the “invention” over the whole of the broad field claimed, and thus at the same time, the broad claim is not supported by the description. The Examination Guidelines explain that both requirements are designed to reflect the principle

² Also available at: http://www.european-patent-office.org/legal/case_law/e/index.htm.

that the terms of a claim should be commensurate with, or be justified by, the invention. However, according to Articles 100 and 138 of the EPC, non-compliance with Article 83 is not a ground for opposition or the revocation of the patent under the law of the EPC Contracting States, while the enablement requirement under Article 83 is a ground for opposition or revocation.

13. The Case Law of the Boards of Appeal also distinguishes two requirements under Articles 83 and 84 (Part II, Chapter B, 3). In T 1055/92, the board stated that since the primary function of a claim was to set out the scope of protection sought for an invention, this implied that it was not always necessary for a claim to identify technical features or steps in detail. This primary function of the claim should be clearly distinguished from the requirement that the European patent application had to disclose the invention in such a way as to enable a person skilled in the art to carry out that same invention. The board considered that it was sufficient if the application as a whole described the necessary characteristics of an invention in a degree of detail such that a person skilled in the art could perform the invention. This requirement, however, related to Article 83 and was not relevant to Article 84. Under Article 83, sufficient disclosure was required of a European patent application as a whole but not of an individual claim as such. A claim had to comprise the essential features of the invention; the essential features should in particular comprise those features which distinguished the invention from the closest prior art (see also T 61/94). In T 156/91, the alleged absence of essential features in the claim was not viewed as a question of reproducibility of the invention within the meaning of Articles 83 and 100(b), for which the disclosure as a whole is always the criterion; instead, what was involved was an objection under Article 84.

14. Reference is also made to Part II, Chapter A, 6.1 of the Case Law of the Boards of Appeal. It refers to the decisions T 409/91 (OJ 1994, 653) (*ex parte* proceedings) and T 435/91 (OJ 1995, 188) (*inter partes* proceedings), in which it was pointed out that the protection conferred by a patent should correspond to the technical contribution to the art made by the disclosure of the invention described therein, which excluded the patent right being extended to a subject-matter which, after reading the patent specification, would still not be at the disposal of the skilled person. The available information had to enable the skilled person to achieve the envisaged result within the whole ambit of the claim containing the respective functional definition without undue difficulty, and the description with or without the relevant common general knowledge had to provide a fully self-sufficient technical concept as to how this result was to be achieved. In T 409/91 (OJ 1994, 653) (*ex parte* proceedings) the invention related to mineral oils containing paraffin wax such as diesel fuel. Such oils become less fluid as the temperature of the oil decreases due to crystallization of the wax. The inventors found that waxy fuels having wax crystals of sufficiently small size at low temperatures pass through paper filters used in diesel engines might be obtained by using additives with a structure described in the application by a general formula. In the description of the application in suit, the use of these additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that the claims defined some other invention, namely the "principle" of avoidings called "cold filter plugging" by reducing the size of the wax crystals. It was held that the claim to the latter invention was not supported by the description, as the description constantly referred to the use of additives.

15. In sum, the support requirement under Article 84 EPC requires that the subject matter of every claim must have its basis in the descriptions so that a person skilled in the art is able to extend the particular teaching of the description to the whole scope of the claimed invention.

Therefore, if a claim does not include essential features of the invention, the claim is not supported by the description. On the other hand, the enablement requirement under Article 83 EPC provides the extent of details to which the claimed inventions should be disclosed. Although these two requirements are distinct, in some cases, where a claim is unreasonably broad vis-à-vis the disclosure in the description, the application could be rejected on the basis of both requirements.

Japan

16. Section 36 of the Japanese Patent Law (Law No. 121 of April 13, 1959, as amended) provides the requirements concerning the claims. In addition to the requirements concerning the clearness and conciseness of the claims, paragraph (i) of Section 36(6) provides the following:

“(6) The claim(s) under Subsection (3)(iv) shall comply with each of the following paragraphs:

(i) the invention(s) for which a patent is sought is described in the detailed description of the invention³;

...”

17. The Examination Guidelines⁴, I-1, 2.2.1, states that Section 36(6)(i) is intended to prevent seeking patent protection for an invention which is not disclosed to the public. They explain that the determination on whether a claimed invention is “the one described in the detailed description of the invention” should be made based on whether a matter corresponding to what is claimed is written in the detailed description of the invention. The claimed invention is not written in the detailed description of the invention where:

(a) it is clear for persons skilled in the art that the matter corresponding to what is claimed is neither stated nor implied in the detailed description of the invention; or

(b) terms used in the claims and those used in the detailed description of the invention are inconsistent for persons skilled in the art, and as a result, the relation between the claim and the detailed description of the invention is unclear.

18. The Examination Guidelines provide examples that fall under the cases referred to in the above paragraph.

-Examples falling under subparagraph (a):

[Example 1] A claim has a numerical limitation, while a specific numerical value is neither stated nor implied in the detailed description of the invention.

³ According to Section 36(2) and (3) of the Japanese Patent Law, an application consists of a request, a specification, drawings, if necessary, and an abstract. The specification contains the title of the invention, a brief explanation of the drawings, a detailed description of the invention and claim(s). Therefore, the “detailed description of the invention” can be considered as a synonym to the “description”.

⁴ Also available at: http://www.jpo.go.jp/infoe/1312_002_e.htm.

[Example 2] A claim is solely directed to an invention using an ultrasonic motor, while the detailed description of the invention only states the embodiment of the invention using a D.C. motor and neither states nor implies anything about an ultrasonic motor.

-Example falling under paragraph (b)

[Example 3] It is unclear whether the “data processing means” of a word processor stated in the claims correspond to the “means for changing the size of characters,” the “means for changing line spacing” or both of them which are stated in the detailed description of the invention.

19. Non-compliance with Section 36(6)(i) is a ground for opposition as well as for the revocation of the patent.

20. In addition, Section 36(4) provides for the so-called enablement requirement, i.e., the detailed description of the invention should be stated in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art. According to the example of non-compliance with Section 36(4) in the Examination Guidelines I-1, 3.2.2, this requirement may be invoked in two instances. Firstly, a person skilled in the art cannot carry out the claimed invention because of a defective description of the invention, for example, the technical means corresponding to a matter defining the claimed invention is described in a merely functional or abstract way, or the relation between each of such technical means is unclear and incomprehensible. Secondly, a person skilled in the art cannot carry out the claimed invention, because part of the claimed invention is not supported. For example, a claim is directed to a generic concept, while the detailed description of the invention provides only a specific concept so that a person skilled in the art cannot carry out another specific concept covered by the claim.

21. In sum, Section 36(6)(i) requires that the claimed invention be described in the detailed description of the invention. Examples in the Examination Guidelines show that the non-compliance with such a requirement may be invoked where it is clear for a person skilled in the art that the claimed invention is not indicated or implied in the detailed description of the invention, such as in consistency of the terms used. The enablement requirement under Section 36(4) is invoked in order to reject the unreasonably broad claims not supported by the detailed description of the invention.

United States of America

22. 35 United States Code (U.S.C.) Section 112, first and second paragraphs, provide that:

“The specifications shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out this invention.

“The specifications shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

The first part of Section 112, first paragraph is called the written description requirement and the second part of that paragraph is called the enablement requirement.

23. According to the Manual of Patent Examining Procedure (M.P.E.P.)⁵, 2162, the requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent. The grant of a patent helps to foster and enhance the development and disclosure of new ideas and the advancement of scientific knowledge. Upon the grant of a patent, information contained in the patent becomes a part of the information available to the public for further research and development, subject only to the patentee's right to exclude others during the life of the patent. In exchange of the patent rights granted, 35 U.S.C. 112, first paragraph sets forth the minimum requirements for the quality and quantity of information that must be contained in the patent to justify the grant. Failure to comply with the disclosure requirements is a ground for revocation of the patent.

24. The M.P.E.P., 2163 provides the Guidelines for the examination of patent applications with respect to the written description requirement. These Guidelines are designed to assist examiners in analyzing claimed subject matter for compliance with substantive law, although they do not have legal effect. According to these Guidelines, the written description requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention (see *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 14404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998)). The written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Therefore, to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention (see *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ 2d at 1116).

25. An objective standard for determining compliance with the written description requirement is "does the description clearly allow a person skilled in the art to recognize that the inventor invented what is claimed." An applicant must convey with reasonable clarity to those skilled in the art that the applicant was in possession of the invention as of the filing date, and the invention is whatever is now claimed. The fundamental inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. (see M.P.E.P., 2163.02)

26. The Guidelines provide that an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as

⁵ Also available at: <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>

⁶ According to Section 112, the specification contains so-called description and claim(s). Therefore, a satisfactory description may be in the claims or any other part of the originally filed specification for the purpose of determining the compliance with the written description requirement and the enablement requirement.

words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. This may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. A specification may show actual reduction to practice by describing testing of the claimed invention or, in the case of biological material, by specifically describing a deposit of such biological material. Such a deposit is not a substitute for a written description of the claimed invention. The written description of the deposited material need to be as complete as possible because the examination for patentability proceeds solely on the basis of the written description.

27. The written description requirement generally involves the question of whether the subject matter of a claim is supported by [conform to] the disclosure of an application as filed (see M.P.E.P., 2163.01). Most typically, a question as to whether a specification provides an adequate written description may arise in the context of determining whether new or amended claims are supported by the description of the invention in the application as filed, whether a claimed invention is entitled to the benefit of an earlier priority date or effective filing date under 35 U.S.C. Section 119, 120 or 365(c), or whether a specification provides support for a claim corresponding to a claim in an interference.

28. In relation to the addition of “new matter” going beyond the disclosure as of the filing date, the M.P.E.P. 2163.06 clarifies that lack of written description is an issue that generally arises with respect to the subject matter of a claim. If new matter is added to the disclosure, either in the abstract, the specification or the drawings, the examiners should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require the applicant to cancel the new matter. If new matter is added to the claims, the examiners should reject the claims under 35 U.S.C. 112, first paragraph – written description requirement. Where the claims have not been amended *per se*, but the specification has been amended to add new matter, a rejection of the claims under 35 U.S.C. 112, first paragraph, should be made whenever any of the claim limitations is affected by the added new matter.

29. The issue of lack of adequate written description, however, may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention (see, e.g., *Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398). The Guidelines provide three cases where the claimed invention as a whole may not be adequately described. Firstly, the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to a person skilled in the art. For example, the claim “A gene comprising SEQ ID NO: 1” may cover specific structures such as a promoter, a coding region or other elements. Although all genes encompassed by this claim share the characteristic of comprising SEQ ID NO: 1, there may be an insufficient description of those specific structures which are also covered by the claim.

30. Secondly, the claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method for its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequenced described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed

sequence. Further, a description that does not render a claimed invention obvious cannot sufficiently describe the invention for the purposes of the written description requirement (*Eli Lilly*, 119 F.3d at 1567, 43 USPQ2d at 1405).

31. Thirdly, a lack of adequate written description issue also arises if the knowledge and level of a person skilled in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process.

32. The USPTO also issues a “Synopsis of Application of Written Description Guidelines” which contains a number of examples as well as detailed flowcharts describing how to determine whether the written description requirement is satisfied or not.⁷

33. According to M.P.E.P. 2161, the written description requirement is a separate requirement and distinct from the enablement requirement. See *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (While acknowledging that some of its cases concerning the written description requirement and the enablement requirement are confusing, the Federal Circuit reaffirmed that under 35 U.S.C. 112, first paragraph, the written description requirement is separate and distinct from the enablement requirement and gave an example thereof.) An invention may be described without the disclosure being enabling (e.g., a chemical compound for which there is no disclosed or apparent method of making), and a disclosure could be enabling without describing the invention (e.g., a specification describing a method of making and using a paint composition made of functionally defined ingredients within broad ranges would be enabling in respect of formulations falling within the description, but would not describe any specific formulation).

34. In sum, 35 U.S.C. 112, first paragraph provides the requirements for the quality and quantity of information that must be contained in the specification, in exchange of the patent rights granted. The “written description” requirement necessitates a description that conveys that the applicant was in possession of the claimed invention as of the filing date of the application. In short, the written description requirement generally involves the question of whether the subject matter claimed is supported by the disclosure of an application as filed. Particularly in certain unpredictable arts, the disclosure of the claimed invention could be enabling, although the original application may not provide the adequate support for the claims at issue.

III. ANALYSIS

35. There are a number of theories as regards the objectives and advantages of the patent system. One of them is that a temporary exclusive right is granted to the inventor in return for the disclosure of the invention to the general public. The idea is that the inventor relinquishes the possession of his secret knowledge in exchange for obtaining an exclusive right in the market for a limited period of time. This is considered to meet the interest of society at large, since the knowledge of the inventor, which might be kept secret otherwise, could be shared by others whom may be able to use it for the further development of technologies.

⁷ Also available at: <http://www.uspto.gov/web/menu/written.pdf>

36. Therefore, the disclosure of the invention is considered to be one of the key factors for a well-balanced patent system that works as a steering wheel for technological development. In that context, it is interesting to briefly examine how the specification has evolved in the history of the patent system. In the early stage of the patent system, the exclusive right was granted by the authorities as a privilege to exploit the invention. After a while, the custom to file a specification arose merely to distinguish one invention from another.⁸ It was only at the beginning of the 18th century that a written specification was required as a condition for the grant of patents.⁹ This was based on the increasing belief that the ultimate goal of the patent system should be the wider dissemination of new skills to the public in general. In other words, patents could only be granted if the specification contained sufficient detail to allow the public to understand the invention and to practice it.¹⁰

37. Against this dualistic background, i.e., the grant of an exclusive right versus the disclosure of the invention, first, focusing on the aspect of the disclosure of an invention to the public, it is a basic principle of any patent system that the subject matter of the exclusive right should be disclosed to the public so that the public may acquire the knowledge of the invention. In other words, the public should be put in possession of the claimed invention so that the teaching in the specification is available to persons skilled in the art to make and use the invention once the patent expires.

38. On the other hand, focusing on the aspect of the exclusive right, it is generally recognized that a patent owner gets an exclusive right for what he is entitled to. This includes two aspects. One is that the subject matter of the invention should qualify to get the exclusive right. This means that the exclusive right cannot be granted to every invention. The exclusive right accorded to the patent owner can be justified only if the invention meets certain conditions, which are, in general, novelty, inventive step (non-obviousness) and industrial applicability (utility). Another aspect is that the owner of the patent must be legitimated to receive the exclusive right for the exploitation of the invention. This means that the owner of the patent is entitled to the right and the scope of the subject matter protected does not go beyond what was actually invented as of the filing date. In other words, the protection should not cover subject matter which the inventor has not invented.

39. In many cases, the national/regional laws do not simply state the principles, but rather provide specific rules under those principles related to a specific patent application and to the processing of such application. For example, based on the concept that the claimed invention shall be what was invented by the inventor as of the filing date, many patent systems require that the subject matter of the claim conform to the description of the invention as of the filing date, and amendments and corrections of the claimed invention are allowed only if they do not go beyond what was disclosed as of the filing date.

40. From this analysis and the practices of several patent offices illustrated in Part II, it follows that the underlying legal principles regard the relationship of the claim to the disclosure is that the patent monopoly should be justified by the contribution to the art through the disclosure to the public of what the inventor had invented. Therefore, the patent protection should not be extended to subject matter which was not recognized by the inventor

⁸ E. Robinson, "James Watt and the Law of Patents, 13 *Technology and Culture*", 1972, p. 118

⁹ E. Robinson, *loc. cit.*, p. 119

¹⁰ S.J.R. Bostyn, "Enabling Biotechnological Inventions in Europe and the United States", 2001, p. 15

as of the filing date. In other words, claiming not only the contribution to the art actually described in the application, but also to obtain exclusive rights beyond that would be contrary to a fundamental principle of patent law. As indicated in the examples presented by several patent offices in Part II, such a situation may arise in different forms. One example would be that, after reading the application, the claimed invention is still not at the disposal of a person skilled in the art because, for example, the essential element for the function or operation of the invention is missing from the claim. Another example would be that the claim is not consistent with the disclosure, for instance, due to contradictions between the elements contained in the claims and the description. One another example would be that, having regard to the description, the scope of the claims covers an area which is not recognized by the inventor, for example, mere speculation.

41. According to one of the commentaries to Article 84 of the European Patent Convention concerning the support requirement, “the applicant shall not be entitled to go beyond the contents of the description in a way which would allow him to claim, in a speculative manner, possibilities that are not yet explored.”¹¹ This observation suggests an approach which is similar to the written description requirement applied by the United States of America.

42. As indicated in Part II, the support requirement and the enablement requirement are distinct and separate requirements. However, where the claim is, for example, overly broad in view of the full scope of the disclosure, it may occur that both non-compliance with the support requirement (in a broad sense) and the enablement requirement are invoked. This would not, however, be so critical to the fate of the application, if the consequence of the non-compliance was the same. Particularly in the field of predictable art, such as machinery or electronics, quite often, the claim defining the invention in a generalized form is supported by a specific description or embodiments of the invention thereby showing that the whole breadth of the claim can be made and used by a person skilled in the art having regard to the specific description or embodiment disclosed. This, however, may not be so obvious in the field of unpredictable art, such as biotechnology.

43. While under the practice of the EPO, EPC Article 84 seems to require that the claims be both consistent and commensurate with the description not only in a formal sense, but also in terms of substance, the practice of the Japan Patent Office (JPO) seems to be limited to the clear-cut cases. According to the Examination Guidelines of the JPO, Section 36(6)(i) is applicable to cases such as the clear omission of the subject matter claimed from the description or an inconsistency of the terms used in the claim and the description. Under that practice, overly broad claims are dealt with by the enablement requirement.

44. In some countries/regions, for example the EPO, the “support requirement” is not a ground for the revocation of the patent, although a patent could be revoked on the ground of the enablement requirement. This issue was discussed at the EPO¹², most recently in conjunction with the revision of the EPC in 2000. In conclusion, the current text was not amended because of the following reasons: to make lack of support a general ground of objection allowing an attack on unduly broad claims without clearly defined content and reliable tests would foster legal insecurity; it would take years to establish the practice by the EPO, the Boards of Appeal and national courts; the principle that the claims must be

¹¹ “Europäisches Patentübereinkommen, Münchner Gemeinschaftskommentar”, May 1985, Note 124 to EPC Article 84

¹² See CA/PL 27/99, “Revision of the EPC: Articles 84, 100a and 138 EPC”

commensurate with the contribution to the art is interpreted as being encompassed in both the requirements under EPC Articles 56 (inventive step) and 83 (sufficiency of disclosure).

45. An additional issue is whether the claimed inventions shall be supported by the description, or be supported by the disclosure in the claims, description and the drawings. If the latter was the case, the claim could be supported by another claim or would be enabling based on the disclosure in, for example, another claim. However, there may not be a major substantiated difference between the two approaches in practice, since what is disclosed in a claim can always be included in the description by way of an amendment.

IV. SUGGESTION BY THE INTERNATIONAL BUREAU

46. In view of the above, the International Bureau suggests the inclusion of the following provision in the SPLT, which attempts to express the features common to the three examined systems:

“Article 11

Claims

...

(3) [*Relationship of Claims to Disclosure*] The claimed inventions shall be fully supported by the disclosure of the [claims,] description and the drawings, as prescribed in the Regulations.

...

“Rule 11 bis

Relationship of Claims to Disclosure Under Article 11(3)

The subject matter of each claim shall be supported by the [claims,] description and the drawings in a manner to allow a person skilled in the art to extend the teaching therein to the entire scope of the claim, thereby showing that the applicant does not claim subject matter which he had not recognized on the filing date.”

47. The Committee is invited to note the contents of this document and consider the proposals made by the International Bureau as contained in paragraph 46.

[Annex follows]

ANNEX

Provisions Concerning Relationship of the Claims to the Disclosure
Under National/Regional Law

AUSTRALIA
Patents Act 1990

Section 40

...

(3) The claim or claims must be clear and succinct and fairly based on the matter described in the specification.

...

- Section 40 is a ground for opposition and revocation of the patent.

BRAZIL
Law No. 9.279 of May 14, 1996, to Regulate Rights and Obligations Relating to Industrial Property

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Article 25

The claims shall be supported by the description, shall characterize the special features of the application and shall clearly and precisely define the subject matter for which protection is sought.

- Article 25 is a ground for administrative nullity and nullity of the patent.

CHINA
Patent Law of the People's Republic of China

Article 26, fourth paragraph

The claims shall be supported by the description and shall state the extent of the patent protection asked for.

- Article 26 is a ground for re-examination and revocation of the patent.

INDIA
The Patents Act, 1970 (39 OF 1970), as Amended by the Patents (Amendment) Act, 1999

Article 10

...

(5) The claim or claims of a complete specification shall relate to a single invention, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification and shall, in the case of an invention such as is referred to in section 5, relate to a single method or process of manufacture.

be

...

- Article 10(5) is not a ground for opposition, but is a ground for revocation of the patent.

JAPAN
Patent Law (Law No. 121 of April 13, 1959, as amended)

Section 36 (Applications for patent)

...

(6) The claim(s) under Subsection (3)(iv) shall comply with each of the following paragraphs:

(i) the invention(s) for which patent is sought is described in the detailed description of the invention;

...

- Section 36(6)(i) is a ground for opposition and revocation of the patent.

UNITED STATES OF AMERICA
35 U.S.C.

Section 112, first paragraph

The specifications shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

...

- Section 112, first paragraph is a ground for revocation of the patent, but is not a ground for reexamination.

AND E UROPEAN COMMUNITY
Decision 486, COMMON Rules on Industrial Property

Article 30, first paragraph

The claim defines the matter for which patent protection is sought. It shall be clear and concise and be fully supported by the description.

- Article 30, first paragraph is a ground for revocation of the patent.

EURASIAN PATENT ORGANIZATION (EAPO)
Patent Regulations under the Eurasian Patent Convention

Rule 21

...

(4) The claim shall define the subject matter for which protection is sought. Claims shall be clear and concise and shall be fully supported by the description.

...

- Rule 21(4) is a ground for opposition and revocation of the patent.

EUROPEAN PATENT ORGANISATION

European Patent Convention, 1997

Article 84: The Claims

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

- Article 84 is a ground for neither opposition nor revocation of the patent.

AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI)
Agreement Relating to the Creation of an African Intellectual Property Organization,
Constituting a Revision of the Agreement Relating to the Creation of an African and
Malagasy Office of Industrial Property (Bangui (Central African Republic), March 2, 1977)

Article 11(d)(i v)

Any person wishing to obtain a patent for an invention shall file with the Minister responsible for industrial property, or send to him by registered post with a request for acknowledgment of receipt:

...

(d) a sealed package containing in duplicate:

....

(iv) the claim or claims defining the scope of the protection sought, but which do not go beyond the contents of the specification mentioned under subparagraph (i), above.

- Article 11(d)(iv) is not a ground for revocation of the patent.

[End of Annex and of document]