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**Datasheet for the decision
of 23 November 2023**

Case Number: T 0438/22 - 3.4.03

Application Number: 18211801.8

Publication Number: 3511980

IPC: H01L25/065, H01L25/16,
H01L25/18, H01L25/00,
H01L23/538, H01L23/52,
H01L23/498, H01L23/522

Language of the proceedings: EN

Title of invention:

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Applicant:

INTEL Corporation

Relevant legal provisions:

EPC Art. 10(2)(a), 69(1), 78, 82, 83, 84, 94(3), 97(1), 112(1)
(a), 123(2), 123(3)

EPC R. 42, 44, 48, 71(1), 100(2)

RPBA 2020 Art. 13(2), 20(2)

Guidelines for examination F-II 7.4, F-IV 4.3, F-IV 4.4, F-IV
4.4 (version March 2021)

Keyword:

Claims - main request - support in the description (no)
Amendment after summons - taken into account (yes)
Late-filed auxiliary request 0 - request clearly allowable
(yes)
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

T 0749/00, T 1989/18, T 1024/18, T 1808/06, T 2293/18,
T 1399/17, T 2766/17, T 1516/20, T 0121/20, T 1968/18,
T 2685/19, T 3097/19, T 0454/89, T 0169/20, T 1473/19,
T 2968/19, G 0003/14, T 2194/19, T 1444/20, T 1426/21,
T 0329/89, T 1903/06, T 0853/91, J 0018/04

Catchword:

1. There is no provision stipulating that examples within the meaning of Rule 42(1)(e) EPC should not be in the form of claim-like clauses, i.e. in the form of one or more independent clauses followed by a number of clauses referring to previous clauses, at the end of or in another part of the description. There is no justification for deleting such examples just because they were drafted as claim-like clauses. They are to be treated like any other part of the description and thus, *inter alia*, must support the claims (Article 84 EPC). (Reasons 3.4 and 3.5)

2. It is a general and overarching objective, and as such also a "requirement" of the Convention, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, it is legitimate to insist on its removal under Articles 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC. (Reasons 5.5.3)

3. The board approves the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected. (Reasons 5.7.2)

4. A referral to the Enlarged Board of Appeal whose sole purpose is to correct the Guidelines and which is not necessary either for ensuring a uniform case law within the boards or for the board's decision is not admissible. Such a referral could be perceived as an attempt to encroach on the President's powers under Article 10(2)(a) EPC. (Reasons 8.2.2)



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Case Number: T 0438/22 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 23 November 2023

Appellant: INTEL Corporation
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Santa Clara, CA 95054 (US)

Representative: 2SPL Patentanwälte PartG mbB
Landaubogen 3
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 20 August 2021
refusing European patent application No.
18211801.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: M. Ley
T. Bokor

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 18 211 801 pursuant to Article 97(2) EPC.
- II. In a communication under Rule 71(3) EPC dated 10 March 2021, the examining division informed the appellant of its intention to grant a patent based on the fourth auxiliary request (labelled "auxiliary request 3"). In an annex, it provided the reasons for the non-allowability of the higher-ranking main and first to third auxiliary requests.
- III. In a letter dated 12 July 2021, the appellant stated that it did not approve the text intended for grant and requested the grant of a patent on the basis of one of the higher-ranking requests or issue of an appealable decision.
- IV. In accordance with Rule 71(6) EPC, examination proceedings were resumed, and the decision under appeal was issued.

The examining division decided that the main request was not allowable because pages 30 to 38 of the description comprised claim-like clauses and therefore infringed what was stipulated in the Guidelines F-IV, 4.4 (in the version of March 2021) and lead "to unclarity as to the actual scope of protection (Article 84 EPC)".

The appellant's argument given during oral proceedings that deletion of the claim-like clauses would lead to a loss of disclosed subject-matter that could be needed,

e.g. in case of opposition, was not convincing for the examining division.

Claim-like clauses were not allowed under the Guidelines, and this was binding on the examining division.

Amended description pages according to first to third auxiliary requests were held not to comply with Article 123(2) EPC and not to meet the clarity requirements of Article 84 EPC. The examples on these pages should be "prominently marked as not being part of the present invention". As they were not, they resulted in a lack of clarity and should have been deleted (Article 84 EPC, Rule 48(1)(c) EPC).

- V. The appellant requests that the impugned decision be set aside and a European patent be granted on the basis of the main request underlying the impugned decision or auxiliary request 0 filed with the letter dated 3 August 2023, which differs from the main request in comprising different description pages.

Although the appellant indicated in the statement setting out the grounds of appeal that the main request was based on claims 1 to 15 "filed on Aug. 7, 2020", the board understands that the claims filed on 17 August 2020 were meant. The same set of claims was also re-filed with the statement setting out the grounds of appeal.

The appellant further submitted that a decision of the Enlarged Board of Appeal under Article 112(1)(a) EPC may be required on the point of law discussed in the statement setting out the grounds of appeal, and the appellant requests referral of the questions under

point 6 of the statement setting out the grounds of appeal, point 2 of its letter dated 3 August 2023 or similar to the Enlarged Board of Appeal.

VI. Claim 1 of the main request and auxiliary request 0 has the following wording:

*A semiconductor package comprising:
a first semiconductor die (130) having an upper surface and a lower surface, the first semiconductor die including input/output circuitry (140);
a first electrical mesh (110) disposed on the upper surface of the first semiconductor die and conductively coupled to the circuitry included in the first semiconductor die, the first electrical mesh including:
a first plurality of conductors (310) wherein;
each of the first plurality of conductors is disposed on the upper surface of the first semiconductor die and spaced apart from the remaining first plurality of conductors; and
a second plurality of conductors (320), wherein:
each of the second plurality of conductors is disposed on the upper surface of the first semiconductor die and spaced apart from the remaining second plurality of conductors; and
each of the second plurality of conductors intersects and conductively couples to at least one of the first plurality of conductors;
a plurality of second semiconductor dies (120), each of the plurality of second semiconductor dies including processor core circuitry, each of the second semiconductor dies conductively coupled to a node formed by an intersection of one of the first plurality of conductors with one of the second plurality of conductors.*

VII. The appellant's arguments can be summarised as follows.

(a) Claim-like clauses

The only reason for the rejection of the main request were the examples described on pages 30 to 38 because the examining division considered these examples to be claim-like clauses. According to the examining division, claim-like clauses were not allowed under the EPC Guidelines F-IV, 4.4.

The appellant pointed out that there was no decision of the boards (or the Enlarged Board of Appeal) which formed the basis for this part of the EPC Guidelines. It was solely based on long-standing practice developed over time by the examining divisions.

The unconditional application of Guidelines F-IV, 4.4 forced the applicant to limit the disclosure of a patent application in an unjustified way.

Example 1 on page 30 corresponded substantially to allowable claim 1. As an example, example 3 on page 30 related to an optional aspect of example 1 which was not in the remaining part of the specification and did not correspond to any of the claims. If forced to delete example 3, the appellant would lose disclosure which might be needed during opposition or invalidation proceedings before national courts. The deletion of the relevant sections would lead to a loss of description and interpretation basis and a change of the disclosure providing the framework for interpreting the extent of protection (Article 69(1) EPC). The scope of protection would be "unduly modified compared to the original disclosure". Deletion of non-claimed but still covered subject-matter was not justified merely because this

subject-matter was retained in the description in the form of claim-like clauses.

Moreover, repeating the wording of the independent claims or in general all claims "somewhere in the specification" and "explain[ing] additional, optional aspects" was common (and "almost always accepted" by examining divisions). It should be irrelevant whether the wording of claims was repeated at the beginning or the end of the specification, whether it related to a specific figure, or whether the claims were repeated as numbered examples. It seemed to the appellant that the examples on pages 30 to 38 would not have been objected to if the examples were not numbered.

Furthermore, the passage of the Guidelines did provide "the theoretical possibility to amend the claim-like clauses to avoid claim-like language" (as the appellant had done for the then auxiliary request 2 filed with the grounds of appeal and corresponding to auxiliary request 1 underlying the impugned decision). Editing the claim-like clauses to remove their explicit claim-like character did not solve the problem, and rewriting the disclosure was always problematic under Article 123(2) EPC.

Finally, the appellant argued that neither reason why claim-like clauses had to be deleted mentioned in the Guidelines applied. Example 1 on page 30 corresponded to claim 1; the following examples related to optional features of example 1. There was no inconsistency with the claimed subject-matter, and the examples could not lead to any lack of clarity. Example 3 did not duplicate a claim and, thus, was not an irrelevant and unnecessary reduplication.

The appellant added that it had become common practice of examining divisions to force applicants to delete parts of the specification due to the use of claim-like clauses without analysing whether the deletion was justified. In the appellant's opinion, the Guidelines needed to be amended to avoid their application by default. The application of this part of the Guidelines should be limited for when no disclosure would be lost due to the deletion.

During the oral proceedings before the board, the appellant pointed out that a patent application in the US could be filed with claim-like clauses because, on the one hand, the USPTO did not allow multiple-dependencies of claims, and, on the other hand, the EPO had a strict approach on what is directly and unambiguously derivable from the application as originally filed and often does not accept US-type claims as a basis for amended claims. In other words, including claim-like clauses in the description of a patent application might be a consequence of the stricter approach of the EPO. Claim-like clauses served as useful support and disclosure during the grant procedure. It would be contradictory to require their unconditional removal as a prerequisite for the grant of a European patent.

(b) Questions requested to be referred to the Enlarged Board of Appeal

Section F-IV, 4.4 of the Guidelines raised a fundamental question, namely whether it was justified to force an applicant to delete parts of the description solely due to the wording used being identified by the examining division as claim-like.

Beside the current application and many other applications of the same applicant, the "problem of claim-like clauses" seemed to occur with many patent applications.

An answer to the following questions referred to the Enlarged Board of Appeal would ensure uniform application of the law:

Question 1:

Is it allowed to reject an application due to the usage of "claim-like clauses" in the specification?

Question 2:

If the answer to question 1 is yes, is it allowed to reject an application due to the usage of "claim-like clauses" in the specification, even if disclosure would be lost, if the "claim-like clauses" would be deleted?

Question 3:

If the answer to question 1 is yes, is it allowed to reject an application due to the usage of "claim-like clauses" in the specification without detailed analysis on whether the usage of the "claim-like clauses" actually leads to "unclarity as to the actual scope of protection" or "irrelevant and unnecessary reduplication"?

In its letter dated 3 August 2023, the appellant added that the recent case law of the boards (e.g. T 1444/20) indicated that the unconditional deletion of examples was not justified by the mere fact that the matter of the description pages concerned was in the form of claim-like clauses, contrary to what was stated in section F-IV, 4.4 of the Guidelines. However, the

examiners continued to work according to the Guidelines. It was not uncommon for EPO actions to be issued solely to address claim-like clauses. There was a clear contradiction between the case law of the boards and the Guidelines. Consequently, for any patent application containing claim-like clauses, an (unnecessary) appeal had to be filed to avoid the deletion of the claim-like clauses. How many appeals had to be filed until the case law of the boards was taken into account to amend considered for a change in the Guidelines for Examination?

In case T 56/21, the board seemed to see the need for a referral to the Enlarged Board of Appeal for a very similar issue, see the communication dated 21 July 2023 issued in that case. The appellant requested referral of the same question in the current case, namely:

Is there a lack of clarity of a claim or a lack of support of a claim by the description within the meaning of Article 84 EPC if a part of the disclosure of the invention in the description and/or drawings of an application (e.g. an embodiment of the invention, an example or a claim-like clause) is not encompassed by the subject-matter for which protection is sought ("inconsistency in scope between the description and/or drawings and the claims") and can an application consequently be refused based on Article 84 EPC if the applicant does not remove the inconsistency in scope between the description and/or drawings and the claims by way of amendment of the description ("adaptation of the description")?

This general question on the applicability of Article 84 EPC to compel the applicant to amend the

specification seemed to encompass, at least in part, the question of whether it was permissible to reject an application due to the usage of claim-like clauses in the specification. However, as pointed out by the appellant, it appeared that the question did not completely address the current behaviour of examiners, who always objected to claim-like clauses whether or not they were "encompassed by the subject-matter for which projection is sought". Irrespective of the answer to this question, the Guidelines still required claim-like clauses to be removed, regardless of their content.

Hence, the appellant suggested referral of the following questions of law to the Enlarged Board:

Question 1:

Is it allowed to reject an application solely due to the usage of "claim-like clauses" in the specification and independent from the content of the "claim-like clauses"?

Question 2:

If the answer to question 1 is yes, is it allowed to reject an application due to the usage of "claim-like clauses" in the specification, even if disclosure would be lost, if the "claim-like clauses" would be deleted?

(c) Adapting the description to the claims

In a letter dated 3 January 2022, the appellant called the attention of the board to decision T 1989/18, which was argued to support the "opinion of the representative that the decision under appeal was erroneous and needs to be set aside".

The appellant also argued that in certain circumstances the description should be amended but as little as possible ("*so wenig wie möglich*"), also in view of the huge amount of work and cost possibly necessary for an applicant to adapt the description. The effort to remove every single inconsistency was disproportionate given that few granted patents ended up in infringement actions.

In the current case, the description according to the main request was already adapted to the claims. The appellant referred to points 6.1 and 6.2 of the board's communication under Rule 100(2) EPC and argued that no amendments were to be made, i.e. that it was not necessary to replace the wording "may include" with "includes". If a feature was explicitly claimed, it was clear that the feature is obligatory even without a corresponding statement in the description. Even if the marking of claimed features as obligatory did not lead to any legal disadvantage for the applicant, the effort was disproportionate to the advantages. In the case at hand, the claims were supported by the description because their features were disclosed in the description.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. The main request corresponds to the main request underlying the impugned decision.

Claims 1 to 15 according to the main request were submitted for the first time on 17 August 2020 and substantively correspond to the original claims. Description pages 29 to 38 according to the main request correspond to pages 29 to 38 as originally filed, except that in line 24 of page 29, the term "embodiments" has been replaced by "examples", and the last paragraph on page 38 has been deleted.

3. Claim-like clauses

3.1 The relevant passage F-IV, 4.4 in the Guidelines of March 2021 has the following wording:

"Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant because:

- they are inconsistent with the claimed subject-matter, they lead to unclarity as to the actual scope of protection and hence do not fulfil the requirements of Art. 84 (see F-IV, 4.3(iii));

- they only repeat the claimed subject-matter in a very literal manner, they are an irrelevant and unnecessary reduplication and hence do not fulfil the requirements of Rule 48(1)(c) (see F-II, 7.4).

The term 'claim-like clauses' means clauses present in the description which use claim language such as 'according to the preceding clause', 'according to clause 1', 'characterised in that', 'further comprising', and so on. These claim-like clauses are usually found at the end of the description and/or in the form of numbered paragraphs."

- 3.2 Regarding the claim-like clauses on pages 30 to 38 of the description according to the main request, to the board's knowledge, there appears to be no decision of the boards or the Enlarged Board of Appeal that forms the basis of the relevant part of the Guidelines of March 2021 (or of the corresponding passage in the current version of the Guidelines).
- 3.3 It appears that sometimes T 0749/00, Reasons 4 is cited in addition to the passage of the Guidelines F-IV, 4.4. The competent board in that case held that the list of items (1) to (109) on pages 23 to 49 of the description were designated as "preferred embodiments of the present invention", while they contained "various subject-matter not contained in the claims of the main request". This was a matter which had to be considered when adapting the description. The case was remitted to the department of first instance for further prosecution. This board cannot derive from this that claim-like clauses have to be, unconditionally, removed from the description.
- 3.4 The board is of the view that examples 1 to 63 described on pages 30 to 38 cannot be mistaken for claims (either by patent professionals, such as patent attorneys, patent examiners or patent judges, or the public) since it is evident that they are a part of the description and because they are not denoted as "claims".

Examples 1 to 63 in the format of claim-like clauses provide ways of carrying out the invention claimed using examples, as provided for in Rule 42(1)(e) EPC. The board is unaware of any provision stipulating that examples within the meaning of Rule 42(1)(e) EPC should not be in the form of claim-like clauses, i.e. in the

form of one or more independent clauses followed by a number of clauses referring to previous clauses, at the end of or in another part of the description.

3.5 Thus, the examples described on description pages 29 to 38 are to be treated in the same way as any other part of the description. There is no justification for deleting them just because they were drafted as claim-like clauses.

4. Adaptation of the description to the claims - the reasons of the impugned decision

4.1 The board takes it that the examining division held that description pages 30 to 38 created inconsistencies between the claimed subject-matter and the description within the meaning of the Guidelines 2021 F-IV, 4.3(iii) (see the first indent in section F-IV, 4.4 of the Guidelines 2021). According to the examining division, these inconsistencies should be removed by adapting the description to the claims, i.e. by removing pages 30 to 38 as required by the Guidelines 2021, section F-IV, 4.4.

The examining division did not argue that there was an "irrelevant and unnecessary reduplication" or that the requirements of Rule 48(1)(c) EPC were not met (see the second indent in that section of the Guidelines 2021).

4.2 From the appellant's letter dated 3 January 2022, the board understands that the appellant argues that in view of T 1989/18, Article 84 EPC and Rule 48 EPC do not provide a legal basis for adapting the description to the claims and hence that the alleged inconsistencies between the description and the claims are not to be removed by deleting pages 30 to 38.

From its arguments provided during oral proceedings, the board understands the appellant's view to be that in some circumstances an adaptation of the description is necessary and should be done.

- 4.3 The competent board in case T 1989/18 held that the "[c]laims must be clear in themselves when being read with the normal skills including the knowledge about the prior art, but not including any knowledge derived from the description of the patent application or the amended patent" (T 1989/18, Reasons 4). Article 84 EPC only mentioned the description in the context of the additional requirement that it must support the claims. "Under this requirement, the subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described" (T 1989/18, Reasons 5). Neither Article 84 EPC nor Rule 42 or 48(1)(c) EPC could serve as a legal basis for "the requirement that embodiments disclosed in the description of an application which are of a more general nature than the subject-matter of a given independent claim must constitute potential subject-matter of a claim dependent on that independent claim" (T 1989/18, Reasons 4 to 13).
- 4.4 In the understanding of the current board, the findings of T 1989/18 in Reasons 13 address the general problem of the scope of amendments to the description, in particular to what extent an applicant can be forced to make statements about the substance of the description to bring it into conformity with the scope of the finally approved claims, either by express deletions or the addition of qualifying statements about their relationship to the subject-matter of the claims. The current board must address essentially the same problem.

- 4.5 The current board concurs that under Article 84 EPC, claims must be clear in themselves, at least as a general although not absolute principle, as explained in more detail below. Concerning the interpretation of the requirement of Article 84 EPC that the claims must be supported by the description, this board does not agree with the findings of decision T 1989/18. The board also disagrees on the scope and applicability of Rule 48(1)(c) EPC as a legal basis for an obligatory adaptation of the description.
- 4.6 On the contrary, the board agrees with the long established case law of the boards that "supported by the description" means requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC (see T 1024/18, Reasons 3.1; T 1808/06, Reasons 2; T 2293/18, Reasons 3.3; T 1399/17, Reasons 2.2; T 2766/17, Reasons 6; T 1516/20, Reasons 5.3; T 0121/20 Reasons 10; T 1968/18, Reasons 7.10; T 2685/19, Reasons 6).
5. Legal basis in the EPC for requiring the adaptation of the description to the claims
- 5.1 The board takes it that it is beyond dispute that the EPC provides at least the formal legal basis for the powers of the examining division to require an amendment of the description. Article 94(3) EPC stipulates that the examining division shall invite the applicant to amend the application as often as necessary. The application consists of the description, claims and optional drawings (Article 78 EPC). The description is an indispensable part of the application and is therefore also an indispensable part of the European patent, once granted. Rule 71(1) EPC

explicitly states that the possible amendments seen as necessary by the examining division may concern all three parts of the application, i.e. the description, claims and drawings.

5.2 Thus, the question is instead what type of amendments to the description can be required from an applicant, within the general obligation to bring the application in conformity with the requirements of the Convention (Articles 94(3) and 97(1) EPC). The provisions of Rules 42 and 48 EPC are directed to the content of the description and the matter of the application as a whole and, as such, seem to be the appropriate basis for seeking guidance. Article 84 EPC is primarily directed to the claims and refers only indirectly to the description. However, as the Enlarged Board of Appeal has often stated with reference to the Vienna Convention, it is a general principle that legal provisions are to be interpreted not only on the basis of the ordinary meaning of the legal terms but also in light of their object and purpose (literal and teleological interpretation, "Case Law of the Boards of Appeal of the EPO", 10th edition, 2022 (CLBA), III.H.1.2.1. and III.H.1.2.3). The object and purpose of a legal provision may be derived not only from its literal wording but also from its context within the statute (systematic interpretation, CLBA, III.H.1.2.2), and the overall purpose of the statute. The board is of the opinion that with the help of these principles, useful guidance can be found for identifying possible purposes of amendments to the description. In the board's understanding, the decisions cited under point 4.6 above also arrived at their findings by analysing the overall purpose of the EPC and the special purpose of the description, as part of the specification of the

European patent, within the common system of law as established by the EPC (Article 1 EPC).

- 5.3 Accordingly, when interpreting the above-cited provisions of the EPC, not only their wording but also the totality of the EPC can and should be taken into account, to the extent that the wording of the provisions alone does not give an exhaustive interpretation of their scope. Thus, while Article 84 EPC and Rule 42 or 48 EPC may not be sufficiently detailed to answer the question of what substantive criteria apply to amendments to the description which the examining division may legitimately require applicants to make, further guidance can be derived from the EPC as a whole.
- 5.4 Amendments of the description primarily serve the procedures following grant.
- 5.4.1 To avoid any misunderstanding, of course every amendment of the application serves the procedures following grant. Ideally, an application proceeds to grant without amendment. Amendments are only necessary if the application does not fulfil the requirements of the Convention. No provision is made for amendments necessary only for the purposes of the examination procedure but which would not otherwise be expected to be included in the patent specification, i.e. that they are intended to be deleted at a later stage of the examination procedure before grant.
- 5.4.2 That said, some amendments need to be made earlier than others. It is long-standing and settled practice that the description is only amended at the very end of the grant proceedings. Typical amendments are the citations of relevant prior art (Rule 42(1)(b) EPC) and the

adaptation of the description to the claims finally found patentable. Other types of substantive amendments that are not outright deletions are hardly possible in view of the strict requirements of Article 123(2) EPC.

- 5.4.3 There are good reasons for the practice of such "last-minute" amendments to the description. The claims may need to be amended earlier because all important aspects of the examination, such as the examination for added subject-matter, novelty and inventive step, can only be completed when the applicant definitively establishes before the EPO - within the text of the application - the subject-matter **for which protection is sought** within the meaning of Articles 84 and 113(2) EPC (the board's emphasis). This means that the applicant has to define the subject-matter for which it desires protection, which must be the object of the substantive examination. On the other hand, the examination procedure is expected to be efficient and with as few procedural steps as possible, without expecting unreasonable and potentially unnecessary efforts from the applicant. Given that the examination concentrates on the claims, the practice has emerged that amendments to the description are made only at a late stage and typically only after examination of the claims are concluded with a positive result, although procedurally it is of course not prohibited to file claims together with the correspondingly amended description. From this settled practice, it follows logically that the amendments to the description are primarily seen to serve only future purposes during the life of the European patent but typically play no or only a minor role in the substantive examination up to grant.

5.4.4 The appellant has argued that the description may serve various purposes, e.g. as a basis for later amendments during opposition. The board does not doubt this, but opposition proceedings cannot be the primary goal for the amendments to the description provided for by Article 94(3) EPC and Rule 71(1) EPC. If the patent is to be amended during opposition proceedings, the amended application documents must fulfil the requirements of the Convention in the same way as after grant (Article 101(3)(a) EPC). This makes it clear that amendments to the description must also serve purposes wholly beyond the sphere of the proceedings before the EPO.

5.4.5 There are many decisions of the boards that deal with the potential application of Article 69(1) EPC (see e.g. CLBA, II.A.6.3.2 and the decisions cited there). The statements about a limited or the non-applicability of Article 69(1) EPC in proceedings before the EPO are easily misunderstood to mean that the bodies of the EPO need not or should not take into account provisions of the Convention which do not directly define the powers and obligations of the respective body of the EPO, and Article 69(1) EPC is one of these provisions. Such an extreme position is certainly not tenable and cannot be derived from the case law. Directly applying a legal provision and knowing the purpose of a legal provision are two different things. The bodies of the EPO not only may but must take into account all provisions of the Convention to the extent that they provide guidance on the tasks to be performed by the body. For the question before the board, this means that the EPC as a whole should be consulted to determine the legitimate purposes of the amendments to the description. This must of course involve determination of the purposes of the description as part of the patent specification.

- 5.5 The role of the description in the procedures after grant is derivable from the EPC.
- 5.5.1 This finding, namely that the amendments to the description must serve the purpose of the description in post-grant proceedings, leads directly to Article 69(1) EPC, which explicitly and unambiguously states at least one legislative purpose of the description, namely that it should assist in the interpretation of the claims for determining the extent of protection. Accordingly, amendments to the description can and should also serve this purpose. This, in turn, serves both the authorities and courts, which have to determine the extent of protection in national proceedings, and the public, which also needs to know the extent of the exclusive right conferred by the patent. It is in the interests of all these parties that the extent of protection is defined as precisely as possible.
- 5.5.2 It is of course true that Article 69(1) EPC itself does not directly define a "requirement of the Convention" which the patent application as such must meet within the meaning of Article 97(1) EPC for a patent to be granted based on it (T 1989/18, Reasons 6). However, it establishes a direct connection to Article 84 EPC in that it makes it clear that the extent of the effective protection provided by a European patent, i.e. the enforceable rights derivable from a patent should, as far as possible, be related to the very same subject-matter found to be patentable during the grant proceedings. This general principle is not affected by the fact that national courts may apply a different standard from those of the EPC and that the scope of protection might be extended to include equivalents under the provisions of the Protocol on the

interpretation of Article 69 EPC (which is an integral part of the Convention, Article 164(1) EPC). The claims still remain the central element for determining the extent of protection.

- 5.5.3 It is a general and overarching objective, and as such also a "requirement" of the Convention, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, it is legitimate to insist on its removal under Articles 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC.

5.6 Rule 48(1) (c) EPC

- 5.6.1 Rule 48(1) (c) EPC may not appear to provide an explicit legal basis for the removal of subject-matter not covered by the claims from the description. However, Rule 48 EPC as a whole is obviously directed at European patent applications, both on the basis of its wording and its systematic position within the EPC. To that extent, it is also directed at European patents because practically all provisions of the EPC on the content of a European application have the purpose of establishing the final text of a European patent. This also applies to the two types of prohibited matter

defined in Rule 48(1) (a) and (b) EPC (matter contrary to "ordre public" or morality, and disparaging statements), in the following denoted as "offensive matter" for sake of brevity. In the end, the patent specification is also published. It would not appear to make sense to exclude offensive matter from publication under Rule 48(2) and (3) EPC only to publish it later in the granted European patent. Thus, the board sees no plausible purpose for the provisions of Rule 48(1) (a) to (c) EPC other than to prevent the presence of prohibited matter in the granted patent, whatever the origin of this rule may be, as may be inferred from the *travaux préparatoires* for the corresponding Rule 34 EPC 1973 (the Regulations under the PCT at that time). Certainly, the corresponding provisions of the PCT (currently Rule 9.1(i) to (iv) PCT) are primarily directed at applications upon filing. In the PCT, the title of the rule is "Expressions, Etc., Not to Be Used" ("*Nicht zu verwendende Ausdrücke usw.*" and "*Expressions, etc., à ne pas utiliser*" in German and French). Under the PCT, it makes sense to treat such rules as only suggestions given that proceedings under the PCT are normally not aimed at interfering with the substantive content of an application. Nonetheless, these suggestions are made at the international application stage precisely because such matter may have to be removed later at the national or regional stage.

- 5.6.2 Whatever the purpose of the cited rule may be under the PCT, in the system of the EPC, it would seem to serve no purpose if the provisions of Rule 48(1) EPC were merely to serve as guidelines but had no legal effect if ignored. By its title alone (Prohibited matter/*Unzulässige Angaben/Éléments prohibés*), it is difficult to interpret the general purpose of the rule as being a

mere suggestion to the applicant. The matter of Rule 48(1)(c) EPC is not complemented, either, with further special provisions as given in Rule 48(2) and (3) EPC for the types of offensive matter covered by Rule 48(1)(a) and (b) EPC. Such matter can be removed already before the publication of the application under Rule 48(2) and (3) EPC. In this regard, there is a difference between the EPC and the PCT. Under the PCT, the applicant is invited to voluntarily delete all matter which essentially corresponds to the substance of Rule 48(1) EPC, i.e. including irrelevant and unnecessary matter (Rule 9.2 PCT). There is no comparable provision in the EPC suggesting early and voluntary deletion of prohibited (or merely irrelevant or unnecessary) matter, and nor do the Guidelines suggest that this matter should be deleted at an early stage of the proceedings. Hence, for the matter defined in Rule 48(1)(c) EPC, its possible removal should be effected in the grant proceedings, and the board sees no reason why an applicant cannot be invited under Article 94(3) EPC and Rule 71(1) EPC to amend the description and bring it in conformity also with the requirements of Rule 48(1)(c) EPC, whether at an early or late stage of the proceedings leading to grant. Any other interpretation, e.g. that non-compliance with Rule 48(1)(c) EPC could be a reason for immediate refusal of the application, would seem manifestly absurd and unreasonable, as also recognised in T 1989/18, Reasons 11.

- 5.6.3 The board is not aware of any statement in the *travaux préparatoires* to the EPC 1973 which might suggest that non-compliance with Rule 34 EPC 1973 (the predecessor to Rule 48 EPC 2000) was *not* considered by the lawmakers to be a bar to grant. The contrary appears to be derivable from the observation of the Swiss

delegation that "as inventions whose publication was contrary to 'ordre public' or morality should not be patentable, then if applications containing statements contrary to 'ordre public' or morality should not be published either" (Minutes of the proceedings of Main Committee I of the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents, document M/PR/I, No. 2226). This position was supported by the Netherlands and Austrian delegations. In the same source, the Chairman's remark (No. 2236) only refers to a non-intended refusal by the **Receiving Section**, but nevertheless envisages the obligatory omission of the "objected matter" by the Receiving Section. The board sees no positive legislative intention to let such prohibited matter remain in the application all the way up to grant, neither for the offensive matter matter falling under Rule 48(1)(a) and (b) EPC nor for the irrelevant or unnecessary matter falling under Rule 48(1)(c) EPC (Rule 34(1)(a)-(c) EPC 1973). The discussion of the minutes concentrated clearly on matter contrary to "ordre public" or morality and disparaging statements. There is no explicit statement anywhere in the Minutes of the Diplomatic Conference that prohibited matter will be no obstacle to grant as a matter of course. The Austrian delegation, while supporting the view of the Swiss delegation on the suppression of the publication of matter contrary to "ordre public" or morality, did in fact mention that patents may possibly be granted that contained such matter (No. 2228): "[The Austrian delegation] wondered what should happen if, in the procedure up to grant, the European Patent Office did not object to the invention as being contrary to 'ordre public' or morality and thus authorised its publication, but objected to its publication **later in the procedure up to grant**. In this case, to revoke the

patent would be too severe a penalty" (board's emphasis). The English version of the Minutes is apparently wrong in No. 2228 when referring to "*later in the procedure up to grant*". The German and French versions make it clear that "**later in the opposition procedure**" was meant. Taking the entire statement into account, it would appear that even the Austrian delegation perceived that such matter could only remain in the application unintentionally and resulting from a misjudgement or oversight of the EPO but should not lead to a revocation of the patent during opposition proceedings if a later re-examination during these proceedings found that the patent did contain this type of prohibited matter. As mentioned above, the patent specification is also published - this appears to be the plausible explanation why the Austrian delegation was worried about the possible revocation of the patent. It is hard to see why the Austrian delegation may have expected a revocation of the patent on the basis that the *published application* may have contained prohibited matter - prohibited matter in the *published patent specification* would have been a much more obvious reason for the revocation. Finally, the only optional nature of Rule 34 EPC 1973 with regard to disparaging statements mentioned in the last sentence of the statement of the Swiss delegation (No. 2232) seems to concern the optional omission from the published application under Rule 34(3) EPC 1973 (corresponding to Rule 48(3) EPC), but this cannot lead to the conclusion that prohibited matter can also remain in the patent specification.

- 5.6.4 In summary, the board finds that the provisions of Rule 48(1) EPC, including those of Rule 48(1)(c) EPC, are not to be regarded as merely optional guidelines

but as mandatory and to be complied with for a patent to be granted on a European patent application.

- 5.6.5 On its plain literal interpretation, Rule 48(1)(c) EPC refers only to irrelevant or unnecessary matter. Unnecessary matter was also defined as superfluous matter in an early draft, which appears to have the same meaning. Neither of these terms can be directly understood to mean matter not covered by the claims. Irrelevant matter may have no discernible relationship to the disclosed or claimed invention, while unnecessary matter, if it is to be understood as something other than irrelevant matter, may refer, for example, to duplicate matter that does not contain any additional useful information. Assuming, for the sake of argument, that these terms refer only to matter which is entirely neutral for the interpretation of the claims, this would lead to the arguably unreasonable result that, while the applicant may be ordered to remove neutral matter from the description, other matter which is obviously detrimental to an important objective of the Convention, such as the requirement of harmonised claim interpretation explained above, may be allowed to remain in the description without any further consequences. In this way, Rule 48(1)(c) EPC also at least implicitly supports the mandatory removal of matter not covered by the claims from the application. If, on the other hand, matter not covered by the claims was in fact intended to be encompassed by "irrelevant or unnecessary" matter, Rule 48(1)(c) EPC would of course provide the direct legal basis for the removal of such matter (see e.g. decision T 329/89, point 4.4; decision T 1903/06, point 2). This view is apparently the basis for the instructions in the Guidelines, Chapter F-II, 7.4 for the treatment of irrelevant or unnecessary matter within the meaning of

Rule 48(1)(c) EPC. Under these instructions, subject-matter no longer covered by the claims must also be considered unnecessary within the meaning of this rule.

- 5.7 The power of the EPO to insist on removing matter must be balanced against the legitimate interest of the applicant to retain disclosed matter.
- 5.7.1 As set out above under points 5.1 to 5.6, when interpreted correctly, the provisions of the EPC provide a firm legal basis for the power of the EPO to require adapting the description to the claims. On the basis of its wording alone, Rule 42 EPC may not appear to provide a legal basis for removing matter from the description. This rule concentrates on the required content of the application and does not explicitly state that any further matter that may not be seen to fall within the required content is to be removed from the description. However, Rule 48 EPC makes it clear that such amendments can also be required, even if this results in the deletion of disclosed matter from the application.
- 5.7.2 The purpose of the description as a support for the interpretation of the claims is certainly important but is not the sole purpose of the description. As is apparent from Article 83 and Rule 42(1), paragraphs (c) to (e) EPC, the European patent must, with the help of the description, be enabling, i.e. must provide sufficient details for the skilled person to carry out the invention. Requiring the unconditional deletion of subject-matter would often result in the deletion of enabling disclosure (see e.g. decision T 853/91, points 2.1 and 2.2). A typical example would be where the required technical details for carrying out the invention are given for an embodiment which will later

not be covered by the claims, without repeating the relevant details for another embodiment that will remain covered. In such a case, requiring the deletion of the non-covered embodiment would clearly be against the legitimate interests of the applicant. This has led to the settled practice that subject-matter not covered by the claims must be "removed" through an appropriate statement of the applicant in the description which effectively does not remove the technical teaching of the patent but only the legal claim to the relevant parts of the disclosure. In the view of the board, this practice results in a correct and equitable compromise between the interests of the applicant to retain the disclosed subject-matter and the overall purpose of the description to facilitate claim interpretation and the common understanding of the claimed subject-matter. Thus, the board approves the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected.

- 5.8 The applicant has no legitimate interest in retaining subject-matter in the description not covered by the claims.

As set out above, the required amendments to the description should not unnecessarily interfere with the legitimate interests of the applicant, for example, by limiting its procedural options in subsequent amendments to the patent. However, the grant of a patent represents a legal watershed where subject-matter not covered by the claims must be accepted as having been effectively abandoned by the applicant (notwithstanding the possibility of pursuing such subject-matter in a divisional or similar parallel

application). Subject to Article 123(3) EPC alone, this non-covered subject-matter cannot be reintroduced into the scope of protection during opposition proceedings. Nor can this non-covered subject-matter be continued in a divisional application, not even through a re-establishment of rights under Article 122 EPC (J 18/04, Headnote III). The board does not see how an applicant could lose rights by non-covered subject-matter being removed from the description, either by deletion or by statement, and the appellant also conceded that effective rights would not be lost.

6. The board's analysis is in line with the conclusions of the main line of the case law

6.1 Concerning the legal basis derivable from the provisions of Article 84 EPC, the board finds that the requirement in Article 84 EPC that the claims be supported by the description includes the requirement that the description be consistent with the claims not only in some part but throughout. This finding is in agreement with e.g. T 1024/18, Reasons 3.1.9 and 3.1.10. For example, it cannot be said that an independent device claim with features (a), (b), (c) and (d), i.e. with these four features being mandatory, is supported by a description stating that the invention is a device composed of features (a), (c) and (d) alone with optional feature (b); features (a), (b), (c) and (e); or features (f), (g) and (h). Such embodiments or examples are evidently inconsistent with the device claim. Embodiments of the invention which are not consistent with the claims "must therefore be deleted or clearly identifiable to the reader, for example by rewording of relevant passages to indicate that such passages are not, or are no longer, part of the invention" (T 1808/06, Reasons 2).

This established case law of the boards has been included into the Guidelines for Examination in the European Patent Office (see F-IV, 4.3, in particular).

- 6.2 The board is also aware of decision T 3097/19. The competent board in that case held that the "purpose of the claims to define the matter for which protection is sought (Article 84 EPC [first sentence]) imparts requirements on the application as a whole, in addition to the express requirements that the claims be clear, concise and supported by the description" (see T 3097/19, Headnote 3. and Reasons 24 to 34).

The board also concurs with this approach. The second sentence of Article 84 EPC covers three requirements to be fulfilled for the purpose of their function defined in the first sentence (in agreement with T 3097/19, Reasons 28.1 and 37; T 454/89, Reasons 4.1). These three requirements are thus necessary but not sufficient conditions for the claims to define the matter for which protection is sought.

- 6.3 The idea that the description is entirely unnecessary for claim interpretation is unrealistic and simply "wishful thinking", just like the case law expecting claims to be clear in themselves. It is established case law of the boards that in proceedings before the EPO, there are circumstances in which the description and drawings are to be used to interpret the claims (see CLBA, II.A.6.3. or T 0169/20, Catchwords, Reasons 1; T 1473/19, Catchwords, Reasons 3; T 2968/19, Reasons 1.3).

This is all the more so as clarity is not an exact but a relative term. The wording of the claim is chosen by

the applicant to define the desired scope of protection and distinguish the invention from the prior art. The clarity of a claim is normally judged by the applicant and the examiner against the prior art known to them. As soon as new prior art emerges that is obviously "between" the perceived claimed subject-matter and the prior art previously considered, the claim possibly ceases to be clear.

The order of G 3/14 states that, "[i]n considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC".

This does not mean that the claims according to the patent as granted meet all the requirements of Article 84 EPC, e.g. that they are clear, concise and supported by the description, even if they ideally should be. The order of G 3/14 implies that the examination for compliance with the requirements of Article 84 EPC is limited. A granted claim may turn out not to comply with Article 84 EPC but "such non-compliance must be lived with" (see G 3/14, Reasons 55).

In the current board's view, as pointed out above, a frequent and even established way of living with this issue is to use the description and the drawings to interpret the claims. However, if the description is necessary, there is no good reason for leaving it unamended if it cannot fulfil its purpose, i.e. if it does not support the claims due to e.g. inconsistencies between the description and the claimed invention.

In any event, any argument emphasising that Article 84 EPC does not require an amendment of the description since this is not a prerequisite for the clarity of the claims and is generally of no practical use for the substantive examination or the grant proceedings only reinforces the argument that any amendment of the description must necessarily serve the post-grant proceedings.

6.4 How the adaptation of the description is performed is to be decided on a case-by-case basis by the competent body (i.e. examining division, opposition division or board of appeal). However, examples, embodiments or matter not consistent with the claims must be clearly identifiable to the reader. In general, merely replacing the term "embodiment" or "embodiment of the invention" with "disclosure", "example" or "aspect" might not be sufficient. An established way might be to use expressions like "not encompassed by the wording of the claims", "not according to the claimed invention", "outside the subject-matter of the claims" or the like to identify matter not consistent with the claims.

6.5 The board is aware of decision T 2194/19. While the board competent in that case did not explicitly contest that inconsistencies between the claims and the description had to be removed, it was satisfied that the appellant qualified no longer claimed matter with the phrase "an embodiment of the present invention alternative to the embodiment as claimed in the present invention" (see T 2194/19, Reason 6.2.2).

This board opines that a patent application cannot include matter or embodiments qualified as "of the invention" or the like not covered by any independent

claim. Rule 42(1)(c) and (e) EPC supports the view that the term "invention" used in the description refers to the invention as claimed. A description containing embodiments "of the invention" and embodiments "of the claimed invention", i.e. two different inventions, appears in general not to comply with Article 82 EPC in conjunction with Rule 44 EPC.

The board thus instead concurs with T 3097/19, Reasons 34 that embodiments said to be "of the invention" must fall within the scope of the claims.

6.6 The board does not accept the appellant's argument that the description should be amended as little as possible in view of the huge amount of work and cost for an applicant possibly necessary for a proper adaptation of the description and that the effort to remove every single inconsistency was disproportionate given that few granted patents ended up in infringement actions or opposition proceedings. Article 97(2) EPC clearly states that if a European patent application or the invention to which it relates does not meet the requirements of the Convention (e.g. the requirements of Article 84 EPC and Rule 42 EPC), it is to be refused by the examining division. No distinction is made between patents likely to be opposed or end up in an infringement action and the rest.

6.7 The board is also not convinced that the effort required to remove the inconsistencies would be disproportionate. It is the appellant's choice how much matter is included in the claims and how much additional matter is left in the description. Furthermore, it does not seem plausible that the examination would seek to meticulously identify even the smallest inconsistency. Rather, it is to be

expected that the applicant will be invited to remove only obvious inconsistencies which have become apparent during the substantive examination of the claims for novelty and inventive step, at a stage when both the examiner and the applicant are likely to be familiar with the application.

- 6.8 As already pointed out, the examples or claim-like clauses of description pages 30 to 38 are to be treated in the same way as any other part of the description. Hence, any inconsistency with the claims should be removed, as previously discussed. Without a doubt, any amendment made should be in compliance with the requirements of Article 123(2) EPC.

The board notes that this approach is in accordance with decision T 1444/20. The competent board in that case held there was no reason why the presence of the section "Specific embodiments of the invention" in the description should affect the clarity of the claims (T 1444/20, Reasons 2.5). The entire section "Specific embodiments of the invention" related to the same subject-matter (defined by the same method steps) as the current claims in that case and might be taken to provide additional support for the claims in the description, as also required by Article 84 EPC (T 1444/20, Reasons 2.7).

The same approach was used in decision T 1426/21. The board in that case held that any inconsistencies between the claims and those parts of the description disclosing ways to carry out the invention needed to be removed (Reasons 2.3). The numbered "aspects" in the middle of the description might be regarded as claim-like clauses (Reasons 2.4), but they were part of the description (Reasons 2.5). After amendment, there were

no inconsistencies between these aspects and the claims, which were supported by the description (Reasons 2.1, 2.2, 2.5 and 3). The board also held that Rule 42 EPC did not rule out claim-like clauses in the description and that there was no reason to require their deletion (Reasons 2.6).

7. Guidelines 2023, section F-IV, 4.4

7.1 The relevant passages of section F-IV, 4.4 of the Guidelines have been amended in the Guidelines of March 2023 and now read:

"Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought.

'Claim-like' clauses are clauses present in the description which despite not being identified as a claim, appear as such and usually comprise an independent clause followed by a number of clauses referring to previous clauses. These claim-like clauses are usually found at the end of the description and/or in the form of numbered paragraphs, particularly in divisional or Euro-PCT applications, where the original set of claims from the parent or PCT application is appended to the description."

7.2 As explained above, the board is of the view that the mere fact of describing ways of carrying out the invention (within the meaning of Rule 42(1)(e) EPC) in claim-like clauses is not excluded by the EPC and that it is not justified to unconditionally require their deletion from the description, contrary to what is stated in the Guidelines. They are to be treated like

any other part of the description and thus, *inter alia*, must support the claims (Article 84 EPC).

7.3 The board further notes that the Guidelines of March 2023, section F-IV, 4.4 are contradictory because they state that claim-like structures **may** give rise to a lack of clarity (board's emphasis). It appears, thus, that the Guidelines acknowledge that claim-like clauses do not necessarily and inevitably give rise to a lack of clarity. However, the Guidelines require deleting such clauses or amending them to "avoid claim-like language". The board competent in case T 1444/20 came to a similar conclusion on the Guidelines of 11 November 2019 (see T 1444/20, Reasons 2.6).

7.4 As the current board has a different interpretation of the Convention to that provided for in the current Guidelines for Examination, its grounds for this interpretation are provided above (Article 20(2) RPBA).

8. Referral of questions to the Enlarged Board of Appeal

8.1 In view of the above, the board sees no reason to refer the questions under point 6 of the statement setting out the grounds of appeal to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

Regarding the questions formulated in the statement setting out the grounds of appeal and on page 3 of the appellant's letter dated 3 August 2023, the board is of the view that it is not allowed to reject an application solely due to the usage of claim-like clauses in the specification, regardless of the content of these claim-like clauses. No referral of these questions to the Enlarged Board of Appeal is needed.

Regarding the question proposed in relation with the case T 56/21, the board agrees with the appellant that an answer to this question would not necessarily address the issue of the unconditional deletion of claim-like clauses. Moreover, the board is of the view that Articles 84 and 94(3) EPC and Rules 42 and 48 EPC provide a legal basis for requesting the removal of an inconsistency in scope between the description or drawings and the claims, i.e. an adaptation of the description.

8.2 The appellant also submitted that a decision of the Enlarged Board of Appeal was necessary as the Guidelines would have to take into account a decision by the Enlarged Board, which might put an end to the current discrepancy between the Guidelines and the case law.

8.2.1 The board has no doubt that a decision or opinion of the Enlarged Board of Appeal would have a bigger impact on the wording of the Guidelines than a decision of the boards. However, the board is of the opinion that obtaining an amendment of the Guidelines by the EPO is not a legitimate purpose for referring questions to the Enlarged Board of Appeal. The main purpose of a referral to the Enlarged Board of Appeal by a board is to settle issues that arise within the case law. The practice of the EPO and hence the Guidelines are expected to adhere to the case law to the extent that the case law is not manifestly divergent on the issue in question.

8.2.2 The wording of Article 112(1)(a) EPC may appear to suggest that the removal of a discrepancy between the Guidelines and the case law could also be understood as "ensuring uniform application of the law" and as such

be a good reason for an admissible referral. However, the Enlarged Board of Appeal has no formal powers in this respect. This can be inferred from Article 112(3) EPC, which makes it clear that the formal binding power of the decision of the Enlarged Board of Appeal is limited to the case before the referring board. There is no comparable provision for an opinion of the Enlarged Board of Appeal resulting from a referral by the President of the EPO under Article 112(1)(b) EPC. Ordering the amendment of the Guidelines is also beyond the powers of the boards. The EPC clearly states that it is within the functions and powers of the President to adopt the Guidelines (i.e. internal administrative instructions, see Article 10(2)(a) EPC). This must include the powers to decide how the Guidelines are to be kept up to date with the case law. Given this, the board does not consider that a referral whose sole purpose is to correct the Guidelines but which is not necessary either for ensuring a uniform case law within the boards or for the board's decision is admissible. Such a referral could well be perceived as an attempt to encroach on the President's powers under Article 10(2)(a) EPC.

8.2.3 The public is not completely excluded from the procedure under which the Guidelines are amended. The board observes that the Guidelines (in "1. Preliminary remarks" of the "General part") state that the Guidelines are to be updated at regular intervals to take account of developments in European patent law and practice. Ways of communication with the EPO are indicated in this section. As far as the board is aware, the EPO normally opens a public user consultation before a new version of the Guidelines come into force.

9. Description according to the main request

9.1 Turning now to the description according to the main request, as pointed out above, the examples of description pages 30 to 38 are to be treated in the same way as any other part of the description. Any inconsistency with the claims should be removed, as previously discussed.

In the current case, the description essentially corresponds to the description as originally filed, and the claims correspond to the claims as originally filed. Hence, a skilled person reading the patent application according to the main request would assume that the part of the description from page 4, line 12 to page 39, last line titled "DETAILED DESCRIPTION" discloses the invention as claimed and describes ways of carrying out the invention claimed using examples as required by Rule 42(c) and (e) EPC. All examples described in this passage thus concern, in the board's view, the claimed invention.

Hence, any inconsistency between the claims and the description is to be removed as pointed out under point 6 of the board's communication under Rule 100(c) EPC dated 10 May 2023.

9.2 For example, the passage on page 4, lines 14 to 25 describes an embodiment according to claim 1, i.e. the connection of a base die and multiple IP cores disposed across the upper surface of the base die via an electrical mesh network. The sentence of lines 22 to 25 has to be read in this context, contrary to the appellant's view.

However, according to this sentence, the IP cores do

not necessarily comprise "processor core circuitry" ("Example IP cores may include, but are not limited to, semiconductor dies having: processor core circuitry, ..."), whereas according to both independent claims 1 and 8, it is mandatory for the second semiconductor dies to include "processor core circuitry".

- 9.3 Similarly, a skilled person reading the description understands that page 5, line 19 to page 6, line 2 should describe a semiconductor package in accordance with claim 1, i.e. an embodiment of the claimed invention, whereas the term "may include" on page 5, line 20 suggests that such a semiconductor package does not necessarily have all the claimed features.
- 9.4 As a further example, page 8, lines 28 and 29 states that "each of the IP cores 120 may be conductively coupled to a respective electrical mesh network node", whereas claim 1 manifestly requires mandatory conductive coupling.
- 9.5 Example 1 of page 30 is to be understood as an example falling within the scope of independent claim 1. Similarly, examples 13, 26, 38 and 51 should be examples of independent claims 8, 1, 14 and 1, respectively. However, the term "may include" used on page 30, line 2; page 31, line 16; page 33, line 9 and page 36, line 25 suggests that the described entities do not necessarily have all the claimed features.
- 9.6 The expression "Example 2 may include elements of example 1" on page 30, line 15 suggests that example 2 might not include all elements of example 1 and thus might not fall within the scope of claim 1.

10. Hence, the board does not agree with the appellant that the description according to the main request can be left unamended. The main request does not comply with the requirements of the EPC.

Auxiliary request 0

11. In comparison to the main request, description pages 1 to 38 of auxiliary request 0 have been amended according to the board's suggestions in point 6 of the board's communication pursuant to Rule 100(2) EPC. Auxiliary request 0 is thus a direct response to issues raised for the first time by the board. The board used its discretion under Article 13(2) RPBA 2020 to admit this request into the appeal proceedings.

Example 1 on page 30 defines the claimed first and second semiconductor dies as the base die and IP cores. The board also accepts that there is *de facto* no difference between "disposed on the upper surface of the ... die" and "disposed proximate the upper surface of the ... die" as "disposed on" generally does not exclude any intermediate elements.

In other words, example 1 of page 30 falls within the scope of independent claim 1. Similarly, examples 13, 26, 38 and 51 fall within the scope of independent claims 8, 1, 14 and 1, respectively.

Examples 2 to 12, 14 to 25, 27 to 37, 39 to 50 and 52 to 63 define further examples all comprising the features of examples 1, 13, 26, 38 and 51, respectively. Some of these examples have a counterpart in the dependent claims, others do not, as also pointed out by the appellant. Thus, it can no longer be said that examples 1 to 63 are inconsistent with the claimed

subject-matter of the independent claims. They do not repeat claimed subject-matter and are not "an irrelevant and unnecessary reduplication of the claims" (Rule 48(1)(c) EPC). They are examples within the meaning of Rule 42(1)(e) EPC. These examples (in the form of claim-like clauses) also do not fulfil the two conditions mentioned in F-IV, 4.4 of the Guidelines 2021, as the appellant also pointed out.

Hence, there are no inconsistencies between the claims according to auxiliary request 0 and the description on page 29 to 38. These claims are thus supported by the description as required by Article 84 EPC.

12. The set of claims according to the auxiliary request 0 correspond to those filed on 17 August 2020 that formed the basis of the examining division's communication under Rule 71(3) EPC.

The board thus notes that the examining division is of the view that the subject-matter of these claims meets the patentability requirements and considers these claims allowable.

The board, having no reason to interfere with the finding of the examining division that the claims meet the requirements of the EPC, thus concludes that the documents according to the appellant's auxiliary request 0 comply with the requirements of the EPC and thus form a suitable basis for the grant of a patent.

Order

For these reasons it is decided that:

1. The request for referral of questions to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The case is remitted to the examination division with the order to grant a patent in the following version:

Description:

Pages 1 to 28 filed with the letter dated 3 August 2023, under the title of the application "Distributed Semiconductor Die And Package Architecture"

Pages 29 to 38 filed with the letter dated 3 August 2023, under the title of "auxiliary request 0"

Claims: 1 to 15 filed with the grounds of appeal

Drawings: Sheets 1/11 to 11/11 as originally filed

The Registrar:

The Chairman:



T. Buschek

T. Häusser

Decision electronically authenticated