

## EPO practice on dealing with "Incorporation by Reference" in a specification

### 1. Introduction

1.1 EPO examiners quite often request that the wording "hereby incorporated by reference" be deleted from a description prior to the grant of a European Patent Application. This article explores some of the reasons for the requirement, possible implications of its removal and indicates the specific sections of European law that supports its justification.

### 2. Relevant European Law

2.1 Article 83 of the European Patent Convention (EPC) states that a "European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art"; in short, that the description is "sufficient".

2.2 Thus, when Examiners object to the use of the words "herein incorporated by reference", they usually do so on the ground that the term "lacks clarity" and/or that the description is "insufficient". Fundamentally this is because a European patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document.

2.3 Thus, the Examiner's position is that: if the features in the referred document are essential for understanding the specification, they should be added (subject to restrictions to be discussed below) and if they are not essential, then the reference should be deleted. Therefore, Examiners are expected to consider whether it is in fact essential to know what is in the reference document in order to carry out the invention (as meant by Article 83 EPC) before they request that the "offending" term is removed from the description.

### 3. Rules for the inclusion of prior art references

3.1 If in European practice, specific features from the prior art document do need to be taken into consideration in order to either render the description sufficient and/or to be able to construe the claim, then such incorporation of essential matter or essential features is allowed. However, their inclusion is subject to the following restrictions<sup>1</sup>:

(i) ... the description of the invention as originally filed leaves a skilled reader in no doubt that:

- (a) protection is ....sought for such features;
- (b) such features contribute to solving the technical problem underlying the invention;
- (c) such features at least implicitly clearly belong to the description of the invention contained in the application<sup>2</sup> and thus to the content of the application as filed<sup>3</sup>;and
- (d) such features are precisely defined and identifiable within the total technical information in the reference document.

(ii) if the reference document was not available to the public on the date of filing of the application, **it can only be considered<sup>4</sup>** if:

- (a) a copy of the document was available to the EPO on or before the date of filing of the application; and
- (b) the document was made available to the public no later than on the date of publication of the application<sup>5</sup>.

<sup>1</sup> See EPO Guidelines at Chapter C, Part II, Para 4.19

<sup>2</sup> In accordance with Article 78(1)(b) EPC

<sup>3</sup> In accordance with Article 123(2) EPC

<sup>4</sup> See case law decision T 737/90

<sup>5</sup> In accordance with Article 93 EPC

#### **4. Implications of US practice on European applications**

4.1 The removal of the term mainly has implications on applications which have originated in the US. In US practice, the use of the expression “herein incorporated by reference” is common and allows US practitioners to save time, or short cut, the preparation of a full disclosure. The term is often used when multiple co-pending filings in a single “technical area” are made on the same day. Later in the life of this patent family, one or more of the filings may then become a PCT application and later, a European application. A problem occurs when the Examiner requires that the term be removed, but the information contained in the referenced disclosure is essential to an understanding of the invention (i.e. the application itself lacks sufficiency) and further, the referenced document was not “available to the EPO on or before the date of filing of the application”. In this situation, adding back in the referenced material in order to overcome the sufficiency objection will result in an added subject matter objection (under Article 123(2)). And thus a trap is formed which cannot readily be resolved.

4.2 In all other cases, where the referenced document was either available to the EPO on or before the date of filing of the application and/or the referenced material is not essential to provide sufficiency; then suitable modifications will be allowable.

#### **5. Conclusion**

5.1 Before applying for a PCT application designating Europe (or a direct European application) which is to claim priority from a US application, it would be worth while spending the time to rewrite the description to explicitly include any referenced material, especially if it is not altogether clear whether the reference is a co-pending application or a full prior art document. Otherwise, great care should be taken to heed the EPO rules regarding the addition of subject matter during European prosecution. In any event, it may be prudent to consult a European practitioner.

For further information please contact:

Suzanne Oliver  
HLBBshaw  
Cambridge  
UK

Tel : +44(0)1223 225 300

Fax : +44(0)1223 423 701

E-mail : [suzanne.oliver@hlbbshaw.com](mailto:suzanne.oliver@hlbbshaw.com)

URL : [www.hlbbshaw.com](http://www.hlbbshaw.com)

Peer reviewed by Chris Hirsz

The information provided in this document is, of course, of a general nature and should not be considered as legal advice; if you have any specific questions, please contact us as set out above.

© HLBBshaw Ltd July 2009