



Practice Note

concerning

The use of consistory clauses in patent descriptions to refer to the contents of the claims in statements of invention.

Legislation

- Patents Act 1992, as amended: Ss 19, 20 & 23
 - Patent Rules, 1992, as amended: Rs 10 & 19
- See the appendix for the relevant provisions.*

Overview

The Controller does not accept the practice of using consistory clauses referring only to the claims as statements of invention as sufficient to support said claims, but requires that the description, without external reference, sets out the invention such that it fully supports the attendant claims. Patent applications which fail to observe this requirement will be considered to be deficient and referred back to the applicant/agent for correction.

Introduction

Patents comprise four sections, a description, claims, drawings (if any) and abstract. It has been common practice heretofore to use the description to disclose the invention and the claims to define the matter for protection. Recent changes in practice at the EPO and UKIPO have led to the introduction of a form of consistory clause into the description, wherein such clauses, rather than setting out a statement of the invention in themselves, do so instead by reference to the claims presented in conjunction with the description. Such descriptions may later discuss aspects of the invention and consider different embodiments or applications of the invention, but the statement of invention, being in the form of a reference to the invention as set out in the claims, means that such descriptions may only comprise a rationale for parts of the invention and not the invention as a whole.

The IPOI does not consider that this is consonant with good practice. It is now often not possible in this situation to understand the invention on the basis of the description alone. A patent description that does not independently set out the invention cannot be considered to support the claims, since their support is based merely on reference to them, essentially requiring the claims to support themselves.

Rationale

Irish legislation requires that the patent disclose the invention sufficiently clearly and completely for a skilled person to be able to carry it out (S19). Further, though the claims define the matter for which protection is sought, these claims **must** be supported by the description (S20). Further, it is noted that the applicant, to attain a filing date, is only required as a minimum, with respect to technical disclosure, to provide a description of the invention (S23(1)(c)(i)). Since an applicant is not required to have submitted claims on the filing date, but may delay providing claims for up to 12 months after the filing/priority date (S23(9)), it is a reasonable to expect that a description within and of itself should set out in full the technical subject matter comprising the invention.

Claim-referencing consistory clauses act against this by outsourcing basic teaching regarding the invention to the claims. Although the claims themselves count as disclosure, their role is to define the scope of protection, and to do so concisely (S19). The description allows the reader to comprehend the invention in its wider setting, the consideration and value of alternative embodiments, and their context with respect to the state of the art which they seek to improve. That is to say, the role of the description is to disclose and teach the invention. For this reason, the description should be capable of being read independently, and a full understanding of the workings of the invention should be impartable to the skilled person on the basis of that description. For this reason, the description itself requires some statement of invention, and it is not appropriate to simply refer this out to the accompanying claims.

Further, the Controller is not satisfied that mere reference to the claims constitutes support. To provide support, it is not enough for the description to merely agree or not contradict the claims provided, such as claim-referencing consistency clauses do, but rather the description should actively teach all aspects of the invention encompassed by the claims. Otherwise, the claims alone effectively become their own support.

The UK and EP rationale that consistency clauses remove repetition, and also that they ease an administrative burden on the applicant when amending the claims is therefore not one that is accepted by this Office, because it takes away the ability of the description to provide, within itself, teaching to encompass the full understanding of the invention. In any event, where claims are amended, both offices are clear on the requirements for amending the description to ensure that matter removed from the claims is either removed from or clearly disavowed in the description.

The Controller therefore considers that descriptions which rely on claim-referring consistency clauses do not constitute support of the claims. Further, the administrative burden of checking a description comprising consistency clauses to ensure that all aspects of the claims are clearly supported by the description is not justified.

Conclusion

Accordingly, the Controller wishes to draw to the attention of applicants and agents that patent applications, wherein the description relies on claim-referencing consistency clauses as statements of invention and to support the claims, will be considered deficient with respect to Section 20 of the Patents Act, and subject to correction. Such applications will be referred by the examiner to the applicant or their agent. Accordingly, such applications will inevitably be subject to delay in processing.

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Appendix - Relevant legislation

Patents Act (extracts)

Disclosure of invention.

19. (1) A patent application shall disclose the invention to which it relates in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Claims.

20. The claim or claims shall define the matter for which protection is sought, be clear and concise and be supported by the description.

Date of filing application.

23. (1) The date of filing of a patent application shall be taken to be the earliest date on which the applicant paid the filing fee and filed documents which [contains] — ...

... (c) (i) a description of the invention for which a patent is sought even where the description does not comply with other requirements of this Act or with any requirements that may be prescribed.

(9) An application which has a date of filing under this section or is deemed to have a date of filing accorded to it by virtue of section 24 or 81 shall be treated as withdrawn where [the following] applies: ...

... b) one or more claims or the abstract has not been filed within the relevant prescribed period.

Patent Rules (extracts)

Description.

10. The specification forming part of a patent application in accordance with section 18 shall commence with the title of the invention (which shall be brief and indicate the matter to which the invention relates), continue with the description of the invention followed by the claim or claims and drawings, if any, in that order.

Prescribed period for filing claims and abstract.

19. (1) The period prescribed for filing the claims and abstract for the purposes of section 23(9) shall be twelve months from the date of filing or, if priority has been claimed, from the date of priority.