

# Sufficiency of Disclosure in EPO Applications (Art. 83 EPC)

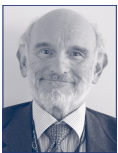
Don't Say Too Much or Too Little!

## Topics

- Key Issues of Sufficiency of Disclosure
- Enabling Disclosure
- Insufficiency of Disclosure
- Art. 83 EPC applied to biotech: nucleotides and amino sequences; biological material
- Sufficiency vs. clarity and added subject-matter
- Disclaimers and sufficiency

Balancing the needs for  
information and secrets

## Your speakers



**Daniel Xavier Thomas**  
Former Director, Directorate-General 1 - Operations,  
European Patent Office,  
Munich (Germany)



**Harrie Marsman**  
MSc, European and Dutch  
Patent Attorney, Of Counsel,  
V.O. Patents and Trade-  
marks, The Hague (NL)

# Sufficiency of Disclosure in EPO Applications

## Aims and objectives

Art. 83 EPC is like the less well-known step-sister of novelty and inventive step: applicants often pay less attention to the sufficiency of disclosure. However, it is as important as the other patentability criteria. The apparently simple wording of Art. 83 EPC might cause some problems in practice: if the invention is not sufficiently disclosed, then you risk a refusal in examination, give ground for opposition and may not use it as prior art. Our speakers will help you to gain an indepth understanding of Art. 83 EPC. You will know what enabling disclosure really implies. By the means of practical examples, our speakers will help you to avoid insufficient disclosure. You will know how to master the challenges of Art. 83 EPC in the interplay with other relevant EPC articles and rules. After the course, you will be able to better balance the needs for disclosing the necessary information insuring sufficiency of disclosure of your invention.

## Who should attend?

You work in an IP, patent or R&D department or as a patent attorney in private practice and do not want to make mistakes when it comes to sufficiency of disclosure?

Then this course is intended for you. Knowledge of patent law is required.

## Event information

Learn more on added subject-matter in EPO applications and patents in our Art. 123(2) EPC course at the same location the day after (webcode 19 10 181).

## Your speakers



**Daniel Xavier Thomas**  
Former Director, Directorate-General 1 - Operations of the EPO

Daniel X. Thomas is an electronics engineer by training. He started his career in the patent field in 1971 and has at last been heading directorates at the EPO in various fields of electronics, physics and mechanics. Although he retired from active service in 2013., D. X. Thomas continues to be active in the field of IP. To that effect he is leading workshops/seminars relating to various aspects of the European granting procedure. Daniel X. Thomas is also working as consultant in IP matters for various firms around Europe: legal practitioner firms, patent representatives or technical companies.



**Harrie Marsman**  
MSc, European and Dutch Patent Attorney, Of Counsel, V.O. Patents and Trademarks, The Hague (NL)

Harrie Marsman is a chemist by training and started as a trainee in the patent profession in 1989 at V.O. Patents and Trademarks. Since 1994, he is a European Patent Attorney and since that time his focus was on opposition proceedings, especially in the fields of plastic polymers, food technology, household and personal care products. After having been partner in the V.O. firm for 20 years, he is now an Adviser for V.O. In addition, Harrie is training young professionals in the patent field, in particular for the Dutch national exam and the European Qualifying Examination.

**22 October 2019, 09:00 - 17:00**

## Key Issues of Sufficiency of Disclosure

- Legal sources: Article 83 EPC, Rule 42; person skilled in the art; disclosure

## Enabling Disclosure

- How to disclose an invention
- Objections concerning essential features: under Article 83 EPC (Functional features and sufficiency); under Article 84 EPC; combined objections
- Reference documents; incorporation by reference; proper names, trade-marks; norms/standards
- Sufficiency in case of medical use claims - plausibility

## Insufficiency of Disclosure

- Fundamental insufficiency: performance of the invention depends on chance, invention contrary to well established laws of physics; invention defined by parameters
- Partial insufficiency; in cases of doubt about insufficiency
- Reproducibility / occasional failures

## Sufficiency of Disclosure

- Sufficiency and Rule 56
- Broad claims/enablement over the whole scope of the claims/ contribution to the art
- Consequences of a lack of sufficiency at search and examination stage
- Insufficiency in opposition proceedings: burden of proof; interplay with Art. 84 and 56
- Sufficiency vs. clarity: substantiation of lack of sufficiency in opposition (hidden clarity objection)
- Sufficiency vs. added subject-matter

## Disclaimers and sufficiency

- Undisclosed disclaimers (G 1/03); disclaiming an embodiment (G 2/10)

## Applications relating to biotechnology

- Nucleotides and amino sequences
- Biological material as such: public availability; deposit of biological material; priority claim; Euro-PCT applications

## 'Reach-through' claims

## Case Law on Sufficiency of Disclosure

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**Conference no.: 19 10 180**

**Website:**

[www.forum-institut.com](http://www.forum-institut.com)

**Date and venue**

Tuesday, 22 October 2019 in Amsterdam  
09:00 - 17:00

DoubleTree by Hilton Amsterdam Centraal Station  
Oosterdokstraat 4 · NL 1011 Amsterdam  
Tel. +31 20 5300800 · Fax +31 20 5300801

**Fee**

€ 1120.00 (+ 21% VAT)

The fee includes course documentation (including  
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confirmation.

## Any Further Questions?



Please feel free to contact me if  
you have any questions.

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