

Sufficiency in European Patent Law

A patent must contain all of the information that is necessary for the skilled person to carry out the invention. If essential information is lacking, then the patent is insufficient and therefore invalid. It is not possible to cure insufficiency by adding further information to the patent (application) after filing, so it is important to give this requirement due consideration before a patent application is filed.

Background

Patents are intended to promote innovation by encouraging disclosure of inventions in return for a monopoly right for a limited period. The requirement in European patent law for "sufficiency" ensures that the disclosure is adequate .

What is sufficiency?

The concept of sufficiency requires that every patent must provide enough information to enable a person of ordinary skill in the field to perform the invention. Thus, any key information that is required to work the invention must be included in the patent; it is not permissible to hold back any information that is essential for the performance of the invention. For example, a patent directed to a chemical process must identify the required starting materials, as well as all essential process steps. The patent need not give information which is within the ordinary general knowledge of those working in the field but must not require them to be inventive.

Consequences of insufficiency

Sufficiency is a requirement for patentability in Europe. This means that a patent application which is found to lack sufficiency will not proceed to grant unless the insufficiency can be cured. This can only be done by changing (usually limiting) the nature of the invention claimed since no additional information can be added to the application after filing. A granted patent may be attacked by a third party for lack of sufficiency, and if the attack is successful, the patent will be revoked. It is therefore crucial to ensure that a patent meets the sufficiency requirement.

How much information is required?

The requirement that the invention has to be described in such a way that the skilled person is able to carry out the invention means that only inventions which can realistically be put into practice can be patented. If it is not possible to explain how to implement the invention, then the patent is insufficient. For example, it is not enough to realise that it would be good if lenses were scratch-resistant, it is also necessary to explain how a scratch-resistant lens coating may be made.

However, it is not in fact necessary to prove that the invention has been put into practice, so it is not necessary to include worked examples in an application or to have built a prototype. All that is required is a description of the invention which is detailed enough that a skilled person could carry out the invention.

Different ways of carrying out the invention

The requirement of sufficiency in Europe can typically be met by describing just one way of carrying out the invention. It is not necessary to describe the *best* way of carrying out the invention. However, there are particular instances, especially in the chemical and biotechnological fields, where more than one way of performing the invention has to be described to show that the invention may be carried out across the whole scope of the claims.



Special requirements

In some technical fields, particularly in the biotechnology sector, special rules determine how the sufficiency requirement may be met. For example, it is essentially impossible to describe a new micro-organism using only words and drawings in such a way as to enable a skilled person to obtain that micro-organism. It has therefore been established that the sufficiency requirement in cases involving micro-organisms can be met by making a deposit of the micro-organism with a recognised depository institution. We can provide you with details of suitable depository institutions.

Parameters

When defining an invention by reference to parameters, care must be taken to include a clear and reliable test for determining the parameters. This is especially important when referring to unusual parameters, but even for seemingly standard parameters such as the thickness of a material it is best to include information regarding the conditions, such as the pressure and temperature, under which the parameter should be tested.

Important considerations

A patent or application may not be amended after filing to include any additional information, so it is not possible to add during prosecution any further information required to enable the skilled person to perform the invention. If a broad claim is found to be insufficiently disclosed, it may be possible to narrow the claim to limit it to those parts of the invention which are sufficiently disclosed. However, if the entire invention is found to be insufficiently disclosed, it is unlikely that this deficiency can be cured, and the patent or application will be found invalid. It is therefore very important to consider the issue of sufficiency before a patent application is filed and to ensure that all essential information is included in the patent application at the filing stage. We have the expertise to help you to ensure that your patent application meets the sufficiency requirement.

Further advice

If you would like any further advice please contact us at Dehns using the details below.

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