To the attention of the Registry of the Enlarged Board of Appeal

European Patent Office, Richard-Reitzner-Allee 8, 85540 Haar, GERMANY

AMICUS CURIAE BRIEF

submitted by BARDEHLE PAGENBERG Partnerschaft mbB Patentanwälte Rechtsanwälte[1] on January 30, 2026,

in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal concerning Referral G 1/25 ("*Adaptation of the Description*") from Technical Board of Appeal 3.3.02 in case T 0697/22.

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I. Introduction

1 BARDEHLE PAGENBERG is a firm of European and German Patent Attorneys, UPC Representatives, and Attorneys-at-Law with offices in Munich, Düsseldorf and Hamburg and affiliated offices in Paris and Barcelona. We represent a broad spectrum of clients, from start-ups to small and medium-sized enterprises and large multinational corporations with extensive patent portfolios. Our practice covers the entire lifecycle of patents, including prosecution, opposition, appeal, and litigation before the European Patent Office (EPO), the German Patent and Trademark Office (DPMA), the Unified Patent Court (UPC), and national courts across Europe.

2 Given our extensive presence in all of these fora for our clients, we have a profound interest in a uniform and practicable application of the European Patent Convention (EPC). The questions referred to the Enlarged Board of Appeal in **G 1/25** touch upon a matter of fundamental importance in daily

[1] Special thanks for their contribution to:
Dr. Albert Lindner, Dr. Sorel Stan, Dr. Maximilian Vieweg

practice that affects every applicant, patent proprietor, and third party interacting with the European patent system. The current diverging case law of the Boards of Appeal on the mandatory adaptation of the description to amended claims has created significant legal uncertainty and procedural inefficiency for all stakeholders.

3 In our view, the EPC does not support a general practice of requiring the adaptation of the description to amended claims, as a condition for grant or maintenance of a European patent. Also, there are no solid indications from post-grant proceedings that legal certainty or procedural economy is improved by the adaptation of the description during examination or opposition. Rather, as experience shows, it is a requirement that in practice creates more problems than it solves, since it pre-empts the interpretive function of national courts and the UPC and places an additional burden on applicants and proprietors.

4 Correspondingly, in this brief, submitted pursuant to Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, we will argue that the questions referred should all be answered in the negative.

II. The Referred Questions

5 In its interlocutory decision **T 0697/22** of July 29, 2025, Technical Board of Appeal 3.3.02 referred the following questions of law to the Enlarged Board of Appeal:

> ***1)*** *If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?*

2) *If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?*

3) *Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?*

III. Summary of Proposed Answers

6 We respectfully submit that the questions should be answered as follows:

- **Answer to Question 1: No.** It is not necessary under the EPC to adapt the description to amended claims to remove an inconsistency introduced by the amendment during opposition or opposition-appeal proceedings.

- **Answer to Question 2:** This question does not require an answer, as the answer to Question 1 is in the negative.

- **Answer to Question 3: No.** The answer to questions 1 and 2 would not be different for amendments made during examination or examination-appeal proceedings. There is no requirement under the EPC to adapt the description in this context either.

IV. The Absence of a Legal Basis in the EPC

7 A core principle of administrative law is that any requirement imposed by an administrative body upon a user must have a clear and unambiguous basis in the governing law. The EPO, as a creation of the EPC, may only impose requirements that are explicitly or implicitly mandated by the Convention. The practice of requiring description adaptation lacks in our view such a basis.

8 In detail:

1. Article 69 EPC

9 Article 69 EPC relates to the extent of protection. Article 2 of the Protocol on the Interpretation of Article 69 EPC which according to Article 164(1) EPC is an integral part of the European Patent Convention concerns equivalents and reads as follows (emphasis added):

> *"For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims".*

10 Equivalents are by definition subject-matter not expressly included in the claims. However, they play a noticeable role in infringement proceedings for determining the extent of protection. By requesting a rigorous removal of all the subject-matter from the description not directly covered by the claims, including equivalents, the proprietor may be put at a considerable disadvantage in infringement proceedings if features disclosed in the description are (positively) taken into account for determining equivalency.

11 Article 2 of the Protocol on the Interpretation of Article 69 EPC had not been part of the EPC 1973 but was added to the EPC 2000 in order to acknowledge the significance of equivalents. In view of this, it is very difficult to imagine that the lawmakers of the EPC envisaged a removal of subject-matter not literally covered by the claims, thus eliminating elements which might be helpful or even necessary for determining the extent of protection in subsequent infringement proceedings. Such a deviation from the lawmaker's intent would only be justified if other provisions of the EPC required it, which, as shall be demonstrated below, is not the case.

12 Requiring the removal of initially disclosed subject-matter may leave the patent proprietor in the awkward position of having disclosed information

for utilizing the technical teaching given to the public, but potentially being deprived of the appropriate reward with regard to parts of this disclosure.

2. Legal basis allegedly in support of an adaptation of the description

13 The fact that "[t]*here is no consensus in these decisions on one precise legal basis*" and therefore five "*subordinate lines can be distinguished*" for justifying the necessity to adapt the description (see **T 0697/22**, point 14.3) indicates that the decisions supporting the adaptation failed to identify a consistent legal basis in the EPC. Most of those decisions belonging to the first line of case law as defined in point 14.2 of **T 0697/22** rely on Article 84 EPC in one way or another as legal basis.

14 Article 84 EPC defines the requirements that the claims have to meet. It does not relate to the application in its entirety. According to its second sentence, the claims have to be clear, concise and supported by the description. It is noted that consistency is not a requirement of Article 84 EPC. Consistency is, however, frequently used in the relevant decisions of the first line case law as a secondary indicator allegedly leading to lack of support.

a. Support by the description

15 Support by the description means that the description must contain all the information which is necessary for understanding the invention defined by the claims. The subject matter defined by the claims should correspond to the technical contribution to the prior art as outlined in the description. But support by the description does not mean that the description may not extend or modify the understanding of the invention for which protection is sought over the bare claim wording. For example, the description may

contain definitions which, if absent, would lead to a different scope of protection.

16 The elements required for such support are listed in Rule 42 EPC and include among others information in connection with the technical problem of the invention and its solution with respect to the known background art (Rule 42(c) EPC) and at least one way of carrying out the claimed invention (Rule 42(e) EPC). Rule 42 comprises a positive list, and if the items of that list can be found in the description, then the claimed invention is supported by it. Further useful information may be added. But this list does not include any requirement to adapt the description, nor does Rule 42 EPC provide that subject-matter lacking a – clear? potential? partial? – counterpart in the claims must be absent.

17 Thus, it is incomprehensible that the support in the form of, e.g., five examples showing how to carry out various alternatives of the claimed invention should all of a sudden be rendered void by the presence of a further example, which pertains to an equivalent not or no longer encompassed by the claim wording. **T 0056/21** (see point 82) correctly points out that "*the requirement of support of the claims by the description according to Article 84, second sentence, EPC, ensures that subject-matter can only be claimed in so far as this subject-matter is also disclosed in the description, Article 84 EPC does not preclude the inclusion, in the description, of subject-matter which is not claimed. Otherwise, subject-matter without correspondence in a claim would have to be removed to conform with Article 84 EPC, and the patent could consequently only be limited, if necessary, by combining claims*".

18 The concern that deletion of subject-matter in the course of the adaptation of the description might reduce the options for amending the claims in further proceedings is not a purely theoretical consideration but happens in

daily practice. Reference is made to **T 1149/97**, where in opposition-appeal proceedings the introduction of features taken from the description which had originally been disclosed but later declared as no longer being part of the claimed invention in the process of adapting the description was found not to be allowable in view of Article 123(3) EPC.

19 In fact, in view of T 1149/97, the wording of Article 123(3) EPC was amended for the EPC 2000 in order to clarify that the European patent in its entirety rather than only the claims thereof (see Article 123(3) EPC1973) may not be amended in such a way as to extend the protection it confers[2]. This clarification, which brought Article 123(3) EPC 2000 in line with Article 138(1)(d) EPC enhances the risk that deletion of subject-matter in the process of description adaptation reduces the options for further amendments not only in post-EPO proceedings, but already in opposition-appeal proceedings, because "*by reinstating features, which in order to avoid inconsistencies in the patent specification have either been deleted from the pre-grant documents or have been clearly indicated as no longer relating to the claimed invention, as a rule the extent of protection of the patent will be affected, whether such features be introduced into the claims or reinstated into the patent specification"* (T 1149/97, point 6.1.12).

20 A complete adaptation of the description is in many cases impossible anyway. The description of a patent application is drafted at a moment in time when the applicant cannot know the final version in which the patent will ultimately be granted or maintained. The text of the description is, as a rule, rather complex, as it has to serve many purposes, not only in connection with Article 84 EPC but also with regard to, e.g., sufficiency of disclosure, inventive step, or as a reservoir for amendments which might become necessary when the proprietor is confronted with new evidence in

[2] OJ EPO 2007, Special Edition No. 4, pages 144-145

opposition proceedings or in further proceedings at national courts or the UPC. Certain information only unfolds meaning in conjunction with other pieces of information, so that striking one aspect may undesirably influence other aspects, too. If the applicant or proprietor is requested to delete passages from the description relating to subject-matter which, although not or no longer claimed, nevertheless contains information which is essential for understanding or carrying out the invention, the formalistic requirement of a completely harmonized description can render the subject-matter of the claims improperly limited, insufficiently disclosed, lacking an inventive step, or inadmissibly amended.

21 Using the concept of consistency as a yardstick for support from the description is in our view wrong and not in accordance with the EPC.

b. Clarity

22 As a preliminary remark it is noted that all decisions of the first line of case law relying solely on Article 84 EPC base their reasoning on lack of support. As a consequence, clarity appears to be, if at all, a minor issue in these proceedings. However, point 21.2 of T 0697/22 reminds us that inconsistency between an amended claim and the description has become of even greater significance in view of **G 1/24**. Therefore, it might be concluded that inconsistencies between description and claims increase the likelihood of rendering the claims unclear as a consequence of the requirement to mandatorily consult the description for claim interpretation. But this is not the case. Interpretation of the claims in the light of the description is not boundless but finds its limits in the concept of claim primacy which was not set aside by G 1/24. Claim primacy is enshrined in the first sentence of Article 84 EPC and for post-EPO proceedings in Article 1 of the Protocol on the Interpretation of Article 69 EPC. The relationship between claim primacy and claim interpretation in

the light of the description is comprehensively defined in the decision of the German Federal Court of Justice (Bundesgerichtshof, BGH) X ZR 16/09 of May 10, 2011, headnote A of which reads as follows:

> *"Bei Widersprüchen zwischen den Patentansprüchen und der Beschreibung sind solche Bestandteile der Beschreibung, die in den Patentansprüchen keinen Niederschlag gefunden haben, grundsätzlich nicht in den Patentschutz einbezogen. Die Beschreibung darf nur insoweit berücksichtigt werden, als sie sich als Erläuterung des Gegenstands des Patentanspruchs lesen lässt".*
>
> *Translation:*
>
> *"In cases of contradictions between the patent claims and the description, those parts of the description that are not reflected in the patent claims are in principle not included in the patent protection. The description may only be considered insofar as it can be read as an explanation of the subject matter of the patent claim".*

23 EPO case law arrives at similar conclusions (see e.g. G 1/93, point 14). This interpretation established for determining the extent of protection according to Article 69 EPC is also to be applied in proceedings at the EPO. In other words, using the terminology of G 1/24: not adapting the description does not give rise to clarity issues; instead, the description is "*consulted*" only to the extent it can be read as an explanatory aid for claim interpretation. This burden of interpretation must be borne by all stakeholders of the system.

24 It follows that G 1/24 did *not* increase the significance of inconsistencies between description and claims which could render a mandatory adaptation of the description recommendable or even necessary.

25 There are cases in which statements made in the description might indeed cause unclarity in the claims. This happens for instance when the

description contains a new definition of a compound which contradicts its generally accepted meaning:

> **Example***:*
>
> *Claim 1: A composition comprising an alcohol*
>
> *Description: The alcohol is selected from a group comprising methanol, ethanol, n-propanol and acetic acid.*

26 In this example, the description might cause unclarity because it is questionable whether acetic acid is included in the claim or not. In the first place, this type of unclarity is not related to the referral questions which relate to claim amendments or the question whether subject-matter is or is no longer claimed. Yet, this situation may be tied to the referred questions if the application's original claim 1 is directed to a composition not reciting "an alcohol", whereas the embodiments in the original description allowed for the composition to also comprise an alcohol, with the definition of alcohol as recited above. One may argue that the amendment resulted in an "inconsistency" as to the use of acetic acid which needs to be addressed. However, in fact the "inconsistency" was part of the documents from the outset. In such a case, a clarity objection after the amendment may be as appropriate as prior to the amendment and is not tied to the amendment. In such a case, it is up to the applicant how they intend to address the clarity objection – an amendment of the description may be one solution, but there may also be others (e.g., by rewording claim 1 to make acetic acid an alternative to alcohol).

27 Some decisions point out that the description has to be adapted to amended claims in order to avoid legal uncertainty. Legal certainty is also frequently associated with the need for the public to properly assess the scope of patent claims, and thus to avoid that participants in the market are left with

ambiguity when assessing a competitors' patents. However, as any practitioner may have experienced, even if the description is entirely "adapted" to the claims, the assessment of the scope of the claim may often not be a straight-forward task. Rather, it requires a systematic approach, as applicable in the respective jurisdiction. Just as with any legal norm, an act of interpretation is required, and legal expertise may and should be consulted for in-depth analysis. We have not experienced that alterations of the description to "adapt" its content to the claim language help for this interpretative act. Rather, they may raise additional questions, e.g., as to the need for the change, the impact of the change, etc.

c. Rule 42 EPC

28 **T 0140/19** mentions Rule 42 EPC in connection with the adaptation of the description. However, the board took no decision on this matter but simply remitted the case back to the opposition division, following the request for remittal made by all the parties to the proceedings. As already mentioned, Rule 42 EPC is concerned with the content of the elements that have to be in the description. We are not aware of any decision refusing an application or revoking a patent on the basis of Rule 42 EPC, because the description was not or was insufficiently adapted.

d. Further legal bases cited in T 0697/22

29 Point 14.3 of T 0697/22 cites "*requirements of the EPC as a general basis*" and *"the requirements of consistency as a general (legal) principle"* as further legal bases cited in connection with the requirement to adapt the description. It is noted that no refusals or revocations were based on these very unspecific grounds, and there is no need to comment on the suitability of a general justified desire as a legal basis for adaptation of the description.

3. Article 138(2) EPC and Article 138(3) EPC

30 The fact that the lawmaker did not consider an adaptation of the description *sine qua non* for legal certainty is directly derivable from the wording of Article 138 EPC adopted by the Diplomatic Conference by the Revision Act of 29 November 2000, in the text drawn up by the Administrative Council by Decision of 28 June 2001 (hereinafter: EPC 2000), which governs the post-grant proceedings relating to the revocation of European patents . The 1st sentence of Article 138(3) EPC reads:

> *"In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. "*

31 In other words, the amendments to Article 138 EPC reflect the explicit will of the lawmaker not to amend the description or the drawings (see OJ EPO 2007, Special Edition No. 4, pages 168-169; Preparatory documents: CA/PL 19/00; CA/PL PV 13, points 98-107; CA/PL PV14, points 103-109; CA/100/00, pages 195-198, MR/2/00, pages 199, 202; MR 24/00, page 98):

> *"The new wording of Article 138(2) EPC makes it clear that limitation and partial revocation of a European patent are always to take the form of a corresponding amendment to the patent claims. This does away with the possibility previously provided for under Article 138(2), second sentence, EPC 1973 to pronounce partial revocation by amending the claims, the description or the drawings.*
>
> *[...]*
>
> *New Article 138(3) EPC makes this principle explicit and binding in proceedings relating to the validity of European patents. Now the patent proprietor has the right in such proceedings to submit an amended, i.e. limited, version of the claims which in his view meets the objections to the validity of his patent. This limited version of the patent must then form the basis for subsequent proceedings. If the*

> *court or authority dealing with the case considers that the proprietor's own limitation is insufficient, it may further limit the patent or revoke it in full".*

32 Thus, a limitation of the patent can only occur "*by amending the claims*". Nevertheless, possible "*inconsistencies*" between description and the claims caused by "*amendments*" to the claims in post-grant proceedings before the national court or the UPC do not seem to be of concern, even at a point in time where the patent is typically part of a litigious dispute (otherwise, the patent would normally not be attacked).

33 As the Enlarged Board of Appeal emphasized in **G 1/24**, Reasons 16:

> *"16. The Enlarged Board finds it a most unattractive proposition that the EPO deliberately adopt a contrary practice to that of the tribunals that are downstream of its patents. On this point, the Enlarged Board agrees with the harmonization philosophy behind the EPC (see G 5/83, Reasons 6, and G 3/08, Reasons 7.2.2.)"*

34 Therefore, following the *ratio decidendi* of **G 1/24**, no stricter requirements should apply for amendments before the EPO.

4. Summary and final observation

35 According to the present practice, the adaptation of the description is carried out at the end of the examination or opposition proceedings, when all the other decisions concerning, e.g., novelty, inventive step, sufficiency or allowability of the amendments have already been taken. As a matter of fact, there are numerous decisions in which a Board of Appeal had decided on all the relevant points and then remitted the case to the Department of First Instance for adaptation of the description as the sole remaining issue. An adapted description therefore rather seems to be a formalistic

housekeeping issue which is irrelevant for examining whether or not the claimed subject-matter meets the requirements of the EPC.

36 Against this backdrop, it can be summarized that

- there is no legal basis in the EPC for forcing the applicant or proprietor to adapt the description to amended claims,
- consistency of claims and description is not a general requirement of Article 84 EPC,
- deleting equivalents from the description may cause disadvantages in infringement proceedings, and
- adapting the description causes time-consuming and unnecessary work and may lead to unexpected alterations, reducing legal certainty rather than increasing it.

V. The Perspective of National Courts and the UPC

37 The argument that description adaptation is necessary for the benefit of national courts and the UPC is unfounded. The judiciary does not need the EPO to act as a pre-emptive editor; it is fully capable of handling the patent document as a whole. These judicial bodies are highly sophisticated and are well-equipped to interpret patent claims in accordance with Article 69 EPC and its Protocol. Thus, no need for adaptation of the description arises from the perspective of national courts and the UPC:

1. National courts have no difficulty with un-adapted descriptions – to the contrary

38 For decades, national courts in the EPC member states have been interpreting European patents. There is no evidence that they have struggled due to the presence of embodiments in the description that are not covered by the claims. To the contrary, in many cases truncated strings of disclosure lead to unclarities and require re-completion. This raises the question of why the EPO should impose something that is supposedly for the benefit of the courts, when the courts are not interested in it.

39 Article 138 (2) EPC 1973 allowed for a "*limitation* [to] *be effected in the form of an amendment to the claims, the description or the drawings*". Nevertheless, in practice, the option of amending the description and drawings was "*practically never used*" in national nullity proceedings[3]:

> *„Im Nichtigkeitsverfahren macht man in der Praxis dagegen praktisch nie von der Möglichkeit Gebrauch, auch die Beschreibung und die Zeichnungen zu ändern, so dass bei einer Beschränkung der Ansprüche möglicherweise mit deren eingeschränkter Fassung nicht mehr vereinbare Teile in der Patentschrift bleiben. Das muss dann bei der Auslegung des beschränkten Patents berücksichtigt werden".*
>
> *Translation:*
>
> *"In nullity proceedings, however, the option of also amending the description and drawings is practically never used in practice, with the result that, if the claims are limited, parts of the patent specification may remain that are no longer compatible with their limited wording. This must then be taken into account when interpreting the limited patent".*

[3] F.-W. Engel, *"Zur Beschränkung des Patents und deren Grenzen",* GRUR 2009, 248.

40 From the evolved case law, we refer to the following:

a. The German Federal Court of Justice (BGH, X ZR 16/09 – *Okklusionsvorrichtung*)

41 The German Federal Court of Justice, for example, has a long and stable jurisprudence on claim interpretation. It routinely considers the description and drawings to understand the technical context and the meaning of claim terms. In cases involving the doctrine of equivalents, the BGH determines based on the entirety of the file, including the prosecution history, whether the proprietor has made a selection or disclaimer that would preclude a finding of equivalence (the principle of "*selection decision*" or *Auswahlentscheidung*, see BGH, X ZR 16/09 – *Okklusionsvorrichtung*, confirmed e.g. in BGH, X ZR 29/15 – *Pemetrexed I*).

42 The BGH does not expect or require the EPO to have "cleaned" the description. On the contrary, the full, un-amended description and the complete prosecution file are valuable tools for the court to ascertain the correct scope of protection, balancing the proprietor's interests with legal certainty for the public.

43 The following example may illustrate unwanted effects of amending the description: assuming an embodiment disclosed in the original patent application is stricken from the description, be it during prosecution or opposition, or the respective appeal proceedings. When asserting this patent, a discussion may arise whether the stricken embodiment, or a similar embodiment, could still be encompassed by the patent's scope of protection under the doctrine of equivalents. If the embodiment was still part of the patent's description, an equivalent patent infringement would be less likely assumed, because, according to the referred to case law, one

would assume a choice of the proprietor to include the embodiment in the description but not claim it. Obviously, the same argument could not be made (anymore), if the embodiment was removed from the description – without a good reason, it seems.

b. The German Federal Patent Court (4 Ni 7/17 – *Polsterumformungsmaschine*)

44 The decision of the German Federal Patent Court in 4 Ni 7/17 (*Polsterumformungsmaschine*) provides a clear example of a national court capably handling an un-adapted description. In that case, the patent claim had been limited during prosecution, creating an apparent contradiction with an embodiment shown in Figure 9 of the patent. The description had not been adapted to reflect the narrowing amendment.

45 The court did not find this problematic. Instead, it resolved the apparent conflict by consulting the prosecution history ("*Anspruchsgeschichte*"). The court explicitly noted that the embodiment in Figure 9 was tailored to the original, broader claim and that the contradiction only arose because the claim was later limited, stating:

> *„…dass das hinzugekommene Merkmal M1.1.5 in Widerspruch zu diesem Ausführungsbeispiel getreten ist, ohne dass eine insoweit erforderliche Anpassung der Beschreibung bei Erteilung des Patents erfolgt ist."*
>
> *Translation:*
>
> *"…that the added feature M1.1.5 has come into conflict with this embodiment, without a necessary adaptation of the description in this respect having been made upon grant of the patent."*

46 This demonstrates that national courts are not confused by such "*inconsistencies*". Instead, they are fully capable of using the prosecution history to understand the context and correctly interpret the patent.

c. The Düsseldorf Regional Court (4a O 9/15)

47 The Düsseldorf Regional Court (*Landgericht Düsseldorf*) in its decision 4a O 9/15 (*Kunststoffträgerplatte*) established a critical principle for interpretation:

> *„Wird in einem Einspruchs- oder Nichtigkeitsverfahren die Beschreibung angepasst und eine neue Patentschrift veröffentlicht, hat die Auslegung allein anhand der geänderten Patentschrift und damit hier anhand der B2-Schrift zu erfolgen".*
>
> *Translation:*
>
> *"If, in opposition or nullity proceedings, the description is adapted and a new patent specification is published, the interpretation must be based solely on the amended patent specification, and thus here on the B2 version".*

48 This ruling means that once a description is adapted (e.g., to create a B2 document), the original disclosure (in the B1 document) is legally irrelevant for the purpose of claim interpretation before the court. Any embodiments, context, or alternative options deleted from the description are permanently lost to the proprietor. This creates an often unintended prosecution history estoppel, severely limiting the proprietor's ability to argue for a scope of protection that includes equivalents. The EPO, by mandating such deletions, is not clarifying the patent but is actively and permanently limiting its enforceable scope.

2. The Unified Patent Court (UPC)

49 Moreover, also the newly established UPC has already demonstrated its ability to handle such interpretive issues.

50 In the case **Agfa v. Gucci**[4], the Hamburg Local Division was faced with a description that contained a broader definition than the granted claims. The court had no issue in concluding that the claims take precedence and that (Headnote 3):

> *"specifications in the description that are not consistent with the granted claims cannot serve as a basis for a broad interpretation of a claim".*

51 This decision demonstrates that the fear of courts being misled by un-adapted descriptions is not justified. The established principles of claim interpretation, which give primacy to the claims while using the description as a contextual aid, are sufficient to ensure legal certainty.

52 In the case **N.J. Diffusion v. Gisela Mayer**[5], the Paris Local Division was similarly faced with an embodiment mentioned in the description that did not fall within the scope of the claim wording. Also this court had no issue in interpreting the claim despite the un-adapted description (Headnote 1):

> *"La Cour relève d'ailleurs que l'ajout des termes « placées bord à bord » dans la revendication 1 aurait dû entrainer, lors de la phase de délivrance dudit brevet, la suppression du mode de réalisation de l'invention dit « en superposition » mentionné dans la description car ce mode n'entre pas dans le périmètre de protection des enseignements du brevet tels que retenus finalement dans les revendications".*

[4] UPC_CFI_278/2023, April 30, 2025
[5] UPC_CFI_363/2024, August 1, 2025

Translation:

"The Court also notes that the addition of the words "placed edge to edge" in claim 1 should have led, during the grant procedure of the patent in question, to the deletion of the embodiment of the invention described as "superposed," as mentioned in the description, since that embodiment does not fall within the scope of protection of the teachings of the patent as ultimately defined in the claims".

VI. Practical and Procedural Considerations

53 The general requirement for mandatory description adaptation is impractical and, in our view, not supporting an efficient functioning of the patent system.

54 Thus, correctly adapting the description such that it no longer contains subject-matter not reflected in the claims while at the same time not deleting information that could be relevant for sufficiency, inventive step or as a reservoir for further amendments which might turn out to be necessary in the course of further proceedings is a very time-consuming and practically often difficult task. In most cases, an adaptation of the description is much more than just deleting one or two passages which are no longer needed or characterizing an embodiment as not belonging to the invention anymore – wholly, in all aspects? or only in some?

55 In view of the "*frontloaded*" system now applied by the Boards of Appeal, a proprietor is forced to submit a considerable number of auxiliary requests at a very early stage of opposition appeal proceedings. In the proceedings leading to referral decision T 0697/22, the board did not admit an adapted description submitted at the oral proceedings in view of Article 13(2) RPBA. Therefore, the conclusion must be drawn that an adapted description has to be submitted at a point in time when the proprietor does not know which

request will finally be allowed, which means that they are obliged to submit at an early stage of the proceedings adapted descriptions for all the auxiliary requests. This unnecessarily multiplies the already time-consuming task, which is in our view unacceptable.

VII. The Distinction Between Examination and Opposition Proceedings

56 Referral question 3 points out that different criteria for adapting the description might apply for examination and opposition proceedings. Article 97(1) and 101(3)(a) EPC define exactly the same conditions for a patent to be granted or to be maintained in amended form, respectively: the requirements of the EPC have to be met. In the absence of any legal basis for a mandatory adaptation of the description, there is no difference between examination and opposition. In both proceedings, the description does not need to be adapted.

VIII. Conclusion

57 Since the EPC does not contain any provision on when and how to adapt the description to amended claims, and such a general requirement can also not be deduced from other provisions, we do not see a legal basis for burdening applicants and proprietors with this task.

58 Moreover, practical experience does not suggest additional difficulties for claim interpretation between “adapted” and “non-adapted” description. As we have tried to show, the former may even be harmful to legal certainty, since any adaptation may trigger debates about the impact thereof.

59 We thus suggest that the referred questions as proposed in section **III** are answered such that there is no general requirement to adapt the description

if an amendment introduces an "*inconsistency*" between the amended claims and the description of the patent or patent application.

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