Registry of the Enlarged Board of Appeal
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY

For the attention of: Mr Nicolas Michaleczek (EBAamicuscuriae@epo.org).

Official Ref: G 1/25

30 January 2026

Dear Members of the Enlarged Board of Appeal,

Amicus Curiae Brief – G 1/25

The IP Federation submits this written statement, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, for the assistance of the Enlarged Board in considering referral G 1/25 "Hydroponics".

Introduction

The IP Federation represents the views of UK industry in IP policy and practice matters in the UK, Europe and internationally. Its membership of influential IP intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. Details of the IP Federation membership are given at the end of this letter. The IP Federation membership invest heavily in IP and are very active users of the European Patent Office (EPO). This submission follows a detailed consideration in the IP Federation Council of the question referred in this case, and the views expressed are based on our members' considerable experience of prosecuting European patent applications and the opposition procedure for European patents, including proceedings before the Boards of Appeal.

Summary

In summary, the IP Federation's submission is that the answer to question 1) should be **no**. The European Patent Convention ('EPC') does not impose any obligation to adapt the description to remove inconsistencies following amendments to the claims during opposition proceedings. Such a requirement lacks a clear legal basis in the EPC, introduces unnecessary procedural burdens, and is inconsistent with the pragmatic and internationally harmonised approach adopted by other major patent offices. The claims define the scope of protection, and any residual inconsistencies in the description do not affect compliance with the EPC.

It is the IP Federation's submission that, in light of the answer to questions 1), no answer to question 2) is necessary. Nevertheless, for completeness, the IP Federation reiterates its view that there is no provision in the EPC, whether Article 84, Article 69, or any implementing rule, that mandates adaptation of the description to remove inconsistencies after claim amendments.

Finally, it is the IP Federation's submission that, following the answers above to questions 1) and 2), the answer to question 3) should be **no**. The same reasoning applies during examination proceedings: the EPC does not require full consistency between the amended claims and the description. Imposing such a requirement would unnecessarily complicate prosecution, increase costs, and create risks of added matter without delivering meaningful benefits in terms of legal certainty. Interpretation of scope is a matter dealt with by national courts (and the UPC) under Article 69 EPC and the Protocol and is not a task for the EPO under formal grant requirements. Indeed, national courts have their own tests and mechanisms for dealing with inconsistencies, none of which have resulted in any level of difficulty close to that which this issue presently raises at the EPO.

The Questions

Under Art. 112(1)(a) EPC, Technical Board of Appeal 3.3.02 has, by interlocutory decision T 692/22, referred the following questions to the Enlarged Board of Appeal, assigned **G 1/25**:

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?*

The IP Federation respectfully submits the following observations as *amicus curiae*.

Admissibility of the Referral

1. The IP Federation agrees with the referring Board's identification of a divergence of case law on these points as summarised at sections 12 to 15 of the referring decision. Of particular note is that in the strands of case law identified as requiring the description to be consistent with the claims, there is no consensus in these decisions on one precise legal basis. Rather, the identification of five different lines of attempted justification of legal basis in the case law merely demonstrates the lack of any clear indication in the EPC for this requirement.

2. This lack of consensus is also reflected in the IP Federation members' own experiences with different divisions and boards of the EPO, with clear differences in approach being taken. The IP Federation would therefore welcome clarity from the Enlarged Board on this issue and is of the opinion that it is a point of practical significance, being relevant to the prosecution of all patents before the EPO. The referral should therefore be admissible.

Observations

No Legal Basis in the EPC

3. The various strands of the 'first line' case law outlined by the referring board, which support a requirement to adapt the description, refer to a wide variety of provisions as possible foundations of legal basis. Whilst the IP Federation's submissions are centred around pragmatism, comments on the core provisions cited are made below, and it is the IP Federation's position that none of these, alone or in combination, provide legal basis for the requirement of adapting the description.

4. The IP Federation's view therefore aligns with the 'second line' of case law summarised by the referring board at section 15 of the decision.

Article 84 EPC – Clarity and Support

5. Proponents of mandatory description adaptation often rely on Article 84 EPC, which requires that claims be clear, concise, and supported by the description. However, this provision does not mandate that the description be free of inconsistencies or that unclaimed embodiments be deleted. The term "support" refers to the requirement that the claims must be derivable from the disclosure, ensuring that the invention is sufficiently described to justify the scope of the claims. It does not extend to the reverse, such that it requires editorial harmonisation of the entire description with the claims.

Article 69 EPC and the Protocol on Interpretation

6. Another argument advanced is that Article 69 EPC and its Protocol require adaptation because the scope of protection is determined by the claims interpreted in light of the description. This interpretation is misplaced. Article 69 EPC governs claim interpretation for infringement and validity in national courts, not formal requirements for grant or maintenance. The Protocol emphasises a balance between fair protection for the patentee and legal certainty for third parties, but it does not prescribe editorial consistency as a prerequisite for grant. Courts routinely interpret claims even when descriptions contain inconsistencies, applying established principles without difficulty. Thus, Article 69 EPC and the Protocol cannot justify imposing a formal obligation on applicants to amend descriptions during EPO proceedings.

Rule 42 EPC – Content of the Description

7. Rule 42 EPC is sometimes cited as requiring adaptation because it specifies what the description must contain, including disclosure of the invention and prior art. However, Rule 42 addresses the initial filing requirements, not post-amendment alignment. Its purpose is to ensure that the application provides the relevant information described at the time of filing, not to mandate editorial perfection after claim amendments. There is no language in Rule 42 that obliges applicants to remove inconsistencies introduced during prosecution or opposition. Extending Rule 42 to impose such a requirement would go beyond its intended scope and create obligations unsupported by the EPC.

Policy and Practical Considerations

8. Notwithstanding the lack of legal basis outlined above, the IP Federation's position is one centred around pragmatism. If, contrary to the above, the Board does consider there to be legal basis, the IP Federation requests the Board carefully consider the practical considerations outlined below regarding the impact of any mandatory description adaptations, particularly the extent of any

such mandatory adaptations. These considerations demonstrate that such a requirement would introduce inefficiencies, create unnecessary burdens, and fail to deliver meaningful benefits for legal certainty.

Principle of Legal Certainty

9. Advocates for mandatory adaptation argue that it promotes legal certainty by preventing misleading disclosures. In reality, legal certainty is achieved through clear claims, which define the scope of protection under the EPC. The presence of inconsistencies in the description does not alter the wording of the claims or their legal effect. National courts and the UPC have no difficulties interpreting patents with unadapted descriptions, demonstrating that legal certainty does not depend on editorial alignment. Imposing mandatory adaptation would add complexity without delivering meaningful benefits and could even undermine certainty by introducing risks of added matter, insufficiency and unintended scope changes.

10. For example, a scenario that demonstrates these difficulties is one where two embodiments are disclosed in an application as filed: embodiment 1 (describing features A, B and D) and embodiment 2 (describing features A and C). Subsequently, during prosecution, claim 1 was amended to claim features A and C, and a dependent claim related to feature D was also present. In this scenario, if the patentee was required to remove the embodiment no longer within the scope of claim 1, so deleting embodiment 1, they might lose their best description of how feature D could work in practice. This could cause concerns such as sufficiency for the patentee in relation to the dependent claim and cause uncertainly for third parties who might struggle to define its precise scope without the clear description of this feature in the deleted embodiment. Furthermore, this would likely have been an unnecessary risk, as it was clear from the scope of the claim that embodiment 1 was never covered. In such a scenario, the patentee is forced to take unnecessary risk, the third party is in no clearer a position than they would have otherwise been (in fact they may well be in a worse position).

Pragmatism and Efficiency

11. Mandatory adaptation of the description imposes significant cost and delay, particularly in opposition proceedings where time limits are strict and parties are already under considerable pressure to address substantive issues. Description amendments often require extensive editorial work, especially for complex specifications, and can lead to multiple rounds of review and objection.

12. These efforts do not improve the technical quality or validity of the patent; they merely consume resources that could be better spent on resolving substantive matters such as novelty, inventive step, and sufficiency. A pragmatic approach that focuses on the claims, the true determinant of scope, would better serve the interests of efficiency and fairness.

International Harmonization

13. As far as the IP Federation is aware, no other IP5 patent office (i.e. the USPTO, JPO, CNIPA, or KIPO) , or the UK IPO, requires applicants to reconcile inconsistencies between the claims and the detailed description following amendments. Rather, these offices recognise that claims define the scope of protection and that editorial perfection in the detailed description is unnecessary. The EPO's current practice is therefore an outlier, creating unnecessary complexity for global filers and undermining efforts toward international

harmonisation. Divergence from global norms increases costs for applicants and introduces uncertainty into cross-jurisdictional strategies, which is contrary to the objectives of the EPO and the broader European patent ecosystem.

Courts Can Address Interpretation

14. As noted in paragraph 9 above, national courts already interpret claims with little trouble under Article 69 EPC and the Protocol, considering the description where relevant (in line with the EPO's own, newer, findings in G 1/24). Description inconsistencies do not prevent courts from applying established interpretative principles, as demonstrated by decades of case law across EPC contracting states, and indeed the last two and a half years of UPC case law. These courts have not reported difficulties in handling patents with unadapted descriptions, confirming that legal certainty can be maintained without imposing editorial obligations.

15. For example, the referring decision points to a UPC case, *AGFA v Gucci* (UPC_CFI_278/2023, Order dated 30 April 2025). Here, the Court identified inconsistencies between the claim scope and embodiment in the description but found, applying the UPC's principles of claim interpretation, that it was "immediately apparent" that these were not consistent with the granted claims and, in the end, saw no issue with upholding the patent with such inconsistencies present.

16. In this regard, it should also be noted that following G 1/24, the EPO's own claim construction principles should be aligned with those of the UPC: the description and drawings must always be consulted for interpretation, but inconsistencies do not mandate editorial correction. This harmonisation underscores that claim construction, not formal adaptation, is the correct mechanism for resolving discrepancies.

17. Similarly, courts in national jurisdictions face no such difficulties either. For example, the English courts routinely apply purposive construction and the doctrine of equivalents, even where descriptions contain embodiments not covered by the claims, without requiring harmonisation of the two.

18. In *Shenzhen Carku Technology Co., Ltd v The Noco Company*[1], Meade J considered infringement by equivalence, and as part of his findings on the third limb of the *Actavis* test for equivalence, considered the disclosure of multiple embodiments in the description compared to the (literal) scope of the claims. At paragraph 106 Meade J stated the following:

    "*The position here is that both relays and power FETs are mentioned in the specification. This gives some support to the view that relays were deliberately not claimed*."

19. At paragraph 112. Meade J then found:

    "*Relays are not within the scope of the claim by virtue of equivalence. I have answered this by reference to Actavis question 3, but I agree with the analysis of the Birss J, as he then was, in Facebook v Voxer* [2021] EWHC 1377 (Pat) *at [201] that question 3 may be thought of along with question 1. If question 1 is*

[1] [2022] EWHC 2034 (Pat)

answered in the patentee's favour on the basis that two known alternatives are not materially different, focusing on their similarity, it may make it all the more significant that the patentee, knowing of both, only mentioned one of them in the claim."

20. This decision, and the further case referred to in paragraph 112 of it, demonstrate national courts' ability to address claim construction and doctrine of equivalents easily, without mandating harmonisation of patents' descriptions with their claims.[2]

21. A similar example regarding German national practice was presented in the *amicus curiae* submission of Dr. Michael Schmid, dated 6 October 2025, which stated the following:

"*For instance, in Germany, the Federal Court of Justice held in BGH X ZR 16/09 ("Okklusionsvorrichtung") that if a variant is disclosed but the skilled person understands it to be excluded from protection (for example, due to deletion from the claims), equivalence cannot be used to reclaim it. This demonstrates that courts can address such interpretive issues independently of whether the description was formally aligned with the claims during prosecution.*"

22. These examples of jurisprudence demonstrate that courts, both UPC and national, are fully equipped to handle inconsistencies without imposing mandatory adaptation. Legal certainty is achieved through interpretation, not editorial perfection.

Applicant Autonomy

23. Applicants should retain discretion to manage their patents post-grant, including whether to adapt the description. As noted above, forcing adaptation risks introducing added matter under Article 123(2) EPC or creating sufficiency issues, and may inadvertently affect claim interpretation in litigation. These risks are particularly acute in opposition proceedings, where amendments are often made under time pressure, e.g. at the end of a long opposition oral proceedings, and without full consideration of downstream consequences. This is particularly burdensome for complex specifications and multi-party oppositions. Further, opponents may attempt to abuse the procedure by raising objections, e.g. to description amendments proposed by the Proprietor before the opposition division following amendment of claims in appeal. Here, the opponent could force a further set of oral proceedings and a subsequent appeal by objecting to proposed description amendments. Imposing mandatory adaptation would therefore constrain applicant autonomy, increase litigation risk and increase cost and complexity and timeliness of procedure without delivering proportional benefits.

24. Similar concerns were raised by the UK delegate of the sub-committee that worked on Article 84 EPC, and documented in the minutes of the *Travaux Préparatoires,* at paragraphs 18 to 20 under the heading "Re Article 66, No. 3". Here, at paragraph 19, the UK delegate submitted that applicants should have the greatest freedom in light of different national law approaches. The IP Federation's opinion takes this reasoning one step further, in demonstrating that

[2] Other English case law examples reflecting these principles also exist.

there is no need for strict alignment of the description as national courts deal with claim scope successfully, albeit in their own ways. The opinions of the other delegates on this issue were also focused on pragmatism, stating that the wording of Article 84 EPC "*should make the task of the applicant easier*" and "*imposing a certain amount of uniformity on the claims*". For example, the delegates agreed that the word "fully" should be deleted from present day Art. 84 EPC[3]. Whilst the UK delegates opinion was not followed by all other delegates, there is certainly no suggestion or reference in the *Travaux Préparatoires* to require alignment of the description with the claims.

Conclusion

25. The IP Federation urges the Enlarged Board to **answer Questions 1 and 3 in the negative**:

- The EPC does not require adaptation of the description to remove inconsistencies after claim amendments; and
- Imposing such a requirement is legally unfounded, inefficient, and contrary to international best practice.

Yours faithfully

Christopher David England
European Patent Attorney
Secretary, IP Federation

[3] See page 35 of the minutes

IP Federation members 2026

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the UK, Europe and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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