



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Sharon E. Crane, Ph.D.
Secretary General

6 November 202506 November 2025

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

Attention: Mr. Nicolas Michaleczek

Via email: EBAamicuscuriae@epo.org

RE // Case Number G 1/25

Dear Mr. Michaleczek

FICPI is pleased to have the opportunity to submit the enclosed Amicus Curiae Brief providing comments with respect to the Referral to the Enlarged Board of Appeal on G 1/25.

Yours sincerely,

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Secretary General

Encs.

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Written statement for case G 1/25 before the Enlarged Board of Appeal

6 November 2025

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have the opportunity to provide this written statement for case G 1/25 in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

I. CASE G 1/25

The following questions have been referred to the Enlarged Board of Appeal in the interlocutory decision for case T 0697/22:

- 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?*



II. FICPI'S COMMENTS

1. Definition of “inconsistency”

The interlocutory decision for case T 0697/22 of 29 July 2025 analyses in detail two diverging lines of case law of the Boards of Appeal and one case of a court of first instance of the Unified Patent Court (UPC_CFI_278/2023).

From said analysis it emerges that both lines of case law use the term “inconsistency” (not mentioned in the EPC) only to indicate the presence of unclaimed subject-matter in the description.

A more specific definition and some examples of this kind of inconsistency can also be found in the Guidelines for examination, F-IV 4.3(iii) - *“Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought”*.

Said examples refer to situations in which a hypothetical independent claim includes, e.g. the feature “A comprising B”, while the description discloses the features “A comprising B or C” or “A preferably comprising B”. In these situations, according to F-IV 4.3(iii), the description should be amended by deleting or disclaiming the unclaimed features (e.g. “A comprising B or C” or “A preferably comprising B”), otherwise the independent claim(s) would be “inconsistent” and thus not supported by the description.

The presence of features or embodiments which are not encompassed by the wording of the claims would cause a lack of support also according to the first line of case law and to the objections of the opponent-appellant in case T 0697/22.

In view of the above, the basic question posed by the interlocutory decision in case T 0697/22 seems to be whether this kind of inconsistency violates Art. 84 EPC.

For sake of clarity, the present written statement does not deal with other kinds of inconsistencies, such as, for example, those defined by the Guidelines for Examination at F-IV 4.3(i) and F-IV 4.3(ii), since they are not considered by the interlocutory decision in case T 0697/22.

2. Art. 84 (clarity)

FICPI believes that the above-mentioned inconsistency cannot render a claim unclear, unless the description contains an explicit indication that a specific unclaimed subject-matter is covered by the claims, e.g. by using references such as “according to the claim” or “according to the claimed invention”. In this case, the description should be amended to remove any explicit reference to the claims, as it would throw doubt on their extent of protection.

In all other cases, it is clear that, even in the most creative interpretation, unclaimed subject-matter (e.g. “A comprising C” and “A not comprising B”) is not encompassed by the wording of an independent claim (e.g. “A comprising B”), especially when the primacy of the claims is taken into account, as required by Art. 84 EPC, first sentence.

Therefore, unclaimed subject-matter in the description, as such, does not contradict the claims, so that it cannot throw doubt on their extent of protection.

This is also indirectly confirmed by the fact that the first line of case law and the objections of the opponent-appellant in case T 0697/22 always indicate the support requirement, not the clarity requirement, as a basis for their objections.

Consequently, FICPI believes that the clarity requirement of Art. 84 EPC is not violated by the presence of unclaimed subject-matter in the description, provided that this subject-matter does not explicitly refer to the claims.

For this reason, terms such as “according to the/an invention/embodiment/example/aspect” should be acceptable in the description, also when associated with unclaimed subject-matter, since they do not explicitly refer to the claims or “the matter for which protection is sought” mentioned in Art. 84 EPC.

On the other hand, since Art. 84 EPC does not mention “the invention”, the claims clearly do not include by default the invention (or inventions) and all embodiments disclosed in the description, so that applicants/owners should be left free to retain them in their applications/patents (this is also important for technical dissemination purposes).

3. Art. 84 (support)

With reference to the support requirement, FICPI observes that Art. 84 EPC requires that the claims be supported by the description and there is no provision in the EPC requiring the description to be supported by the claims, i.e. requiring a one-to-one correspondence between description and claims.

This is confirmed by the Guidelines for examination, F-IV, 6.1, which define the support requirement of Art. 84 EPC as follows:

“The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (see T 409/91). Regarding the support of dependent claims by the description, see F-IV, 6.6.”

For the above example, both features “A comprising B or C” and “A preferably comprising B” in the description include the feature “A comprising B”, so that an independent claim “A comprising B” would be fully supported by the description according to F-IV, 6.1.

On the other hand, according to F-IV, 6.6, the description must be amended when the claims disclose subject-matter which is not in the description, as follows:

“Where certain subject-matter is clearly disclosed in a claim of the application as filed but not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter.”

In this case, in order to satisfy the support requirement and, at the same time, avoid issues of added subject-matter under Art. 123(2) EPC, applicants usually include the initial set of claims, with the term “claim” substituted by “clause” or the like, in the description. For the same purpose, this practice is also adopted by applicants when filing divisional applications.

Therefore, according to the Guidelines for examination, F-IV, 6.1, the support requirement of Art. 84 EPC is satisfied when claimed subject-matter is included in the description, not vice versa.

FICPI observes that this interpretation substantially corresponds with the “universal” interpretation adopted by the other patent offices, as explained e.g. at paragraphs 58-78 of the “Study on the sufficiency of disclosure” SCP/22/4 of WIPO¹:

“59. The meaning of the term “the claims shall be fully supported by the description” is largely similar in most jurisdictions. In general, the term means that there must be a basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than is justified by the description and drawings. The examination guidelines of some offices also add that the scope of the claims must not be broader than is justified by “the contribution to the art”.”

In fact, as far as known by FICPI, there is no other patent office in the world that requires the deletion of unclaimed subject-matter from the description, though claim support is usually required in most jurisdictions and Art. 6 PCT even contains a stricter requirement, namely that the claims “shall be fully supported by the description.” (emphasis added).

¹ https://www.wipo.int/edocs/mdocs/scp/en/scp_22/scp_22_4.pdf

FICPI further observes that the same interpretation can be found in the first version (4419/IV/63-D) of the support requirement discussed in 1963 during the Travaux Préparatoires of the EPC²:

*Art. 68 (5) No patent claim may contain any subject matter that is not disclosed in the description.*³

A second version (Art. 66(1), BR/68/70) corresponding to Art. 6 PCT, was proposed in 1970. However, at the beginning of 1972 (Art. 71(a) BR/169/72) it was considered “*whether, as most of the organizations proposed, the word “fully” should be deleted and whether it should be replaced by a less restrictive wording.*” (emphasis added). Soon after, (Art. BR/177/72) the term “fully” was deleted without any replacement, to arrive to the current version of Art. 84 EPC.

Thus, this “less restrictive” interpretation of the support requirement can be found in:

- a) the second line of case law mentioned in T 0697/22,
- b) the EPO Guidelines for examination, F-IV, 6.1 and 6.6,
- c) the “universal” interpretation adopted by the other patent offices, and
- d) the Travaux Préparatoires of the EPC.

On the other hand, as mentioned before, the Guidelines for examination, F-IV, 4.3, propose a stricter interpretation requiring description amendments.

However, F-IV, 4.3 does not explain why unclaimed subject-matter in the description would violate the support requirement, since this violation is already taken for granted, as follows:

“According to Art. 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description.”

Also the decisions cited by the first line of case law (see e.g. T 1024/18, point 3.1.1., and T 0438/22, point 4.6) do not provide any proper explanation on why claims which are supported by subject-matter included in the description are no longer supported when the description also contains unclaimed subject-matter.

In view of the above, FICPI believes the support requirement of Art. 84 EPC means that claimed subject-matter must be present in the description and nothing else, so that that the presence

² <https://link.epo.org/web/legal/epc/TP1973-Articles-75-89.zip>

³ „Kein Patentanspruch darf einen Gegenstand enthalten, der nicht in der Beschreibung aufgefuehrt ist.“

of unclaimed subject-matter in the description (a so-called “inconsistency”) does not violate this requirement.

4. Rule 42 EPC and Guidelines F-IV, 4.4

The interlocutory decision of T 0697/22 mentions a single decision (T 140/19) in which Rule 42 EPC was invoked instead of or in addition to Art 84 EPC. However, the decision seems to be irrelevant, since it does not provide any explanation, apart from the need to remit the case *“to the opposition division for adaptation of the description, particularly since a large number of adaptations appear to be necessary.”*

Guidelines F-IV, 4.4 are also cited in the interlocutory decision, in particular with reference to the “clauses”, as follows:

“Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought.

“Claim-like” clauses are clauses present in the description which, despite not being identified as a claim, appear as such and usually comprise an independent clause followed by a number of clauses referring to previous clauses.”

FICPI believes that the requirement of deleting claim-like clauses is unjustified, since features or embodiments included in the description cannot be confused with the claims, irrespective of the form in which these features/embodiments are presented in the description, provided that there is no explicit reference to the claims.

Moreover, the deletion of claim-like clauses causes issues of Art. 76(1) or Art. 84 EPC when they are added at the end of a description to satisfy the support requirement or in case of divisional applications, as explained above, so that this deletion may unnecessarily harm applicants.

5. Practical consequences

As explained above, deleting or explicitly disclaiming unclaimed subject-matter not only is unnecessary but also can *“require substantial additional work by applicants, proprietors and/or their representatives, leading to significant increased costs”*, as explained in FICPI Resolution EXCO/FR22/RES/002 (copy enclosed) of 2022, especially when the description includes more than a simple unclaimed feature (e.g. “A comprising B or C”).

In fact, descriptions and drawings of patents/applications usually contain several embodiments/examples, each one comprising several combinations of alternative and/or additional features shared with other embodiments/examples. In these cases, deleting or

explicitly disclaiming unclaimed subject-matter both in the description and in the drawings is very difficult if not even impossible, so as to create an undue burden on applicants.

Furthermore, the disclosure of an unclaimed embodiment (or claim-like clauses) may contain details on a claimed feature which are not sufficiently disclosed in the remainder of the description, so that the removal of this embodiment from the description or the drawings might inadvertently invalidate an otherwise valid patent/application, because of Art. 83 EPC or Art. 138 (1)(b) EPC.

More importantly, if the mere presence of unclaimed subject-matter in the description had an effect on the interpretation of the claims, as argued by the first line of case law, then deleting or disclaiming this subject-matter would also change the claim interpretation, with the possible consequence that the relevant patent/application would be potentially invalidated because of Art. 123 (2) and/or (3) EPC, in view of Art. 69 EPC and G 1/24.

The irrelevance of unclaimed subject-matter with respect to claim interpretation is also confirmed by headnote 3 of the above-mentioned UPC case:

“3. Specifications in the description that are not consistent with the granted claims cannot serve as a basis of a broad interpretation of a claim.”

As a consequence, the solution (amending the description) seems to be much worse than the problem (a so-called “inconsistency” in the description).

Therefore, FICPI urges the EPO and the Boards of Appeal to refrain from requesting the deletion of unclaimed subject-matter (and/or claim-like clauses) from the description of European patent applications or European patents, both during examination(-appeal) and opposition(-appeal) proceedings, and also when the claims have not been amended.

It is observed that, in the case T 0697/22 in question, a request to delete unclaimed subject-matter from the description was denied because it was considered a late-filed amendment of the appeal case, thus possibly leading to the revocation of a patent with allowable claims (auxiliary request 1E) due to a purely formalistic reason.

However, it is evident that, for procedural economy, the description of a patent/application should be adapted only when necessary (i.e. due to a contradiction between the description and the present claims) and hence only after a set of amended claims has been approved by a examination/opposition division or a board of appeal, especially when several sets of claims are discussed, as in case T 0697/22.

At any rate, the formal adaptation of the description should not be considered as an amendment of the appeal case, since it cannot affect the outcome of the case (unless it is refused).



Thus, FICPI believes that, irrespective of the answer to the referred questions, an applicant/proprietor should always be given at least one opportunity to amend the description after a set of claims has been approved by an examination/opposition division or a board of appeal.

III. Suggested answer to the referred questions

In view of the above, FICPI suggests answering the questions referred to the Enlarged Board of Appeal as follows:

1. **No, it is not necessary to adapt the description to the claims to remove an inconsistency consisting of the presence of unclaimed subject-matter in the description, since no requirement of the EPC necessitates such an adaption.**
2. **There is no need to answer to question 2 in view of the answer to question 1.**
3. **The answer to question 1 applies to all proceedings and also when the claims have not been amended. At any rate, irrespective of the answer to these questions, an applicant/proprietor should always be given at least one opportunity to amend the description after a set of claims has been approved by an examination/opposition division or a board of appeal.**

IV. Enclosures

FICPI Resolution EXCO/FR22/RES/002 “*Compulsory Amendment of Description and Drawings*”

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Resolution of the Executive Committee Cannes, France, 25 to 29 September 2022

“Compulsory Amendment of Description and Drawings”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee at the World Congress held in Cannes, France, 25 to 29 September 2022, passed the following resolution:

CONSIDERING the practice of the European Patent Office (EPO) to require applicants and proprietors to remove from the description and drawings of European patent applications or patents (e.g. at the end of opposition proceedings) subject-matter which is not specifically recited by the claims,

NOTING that the Guidelines for examination in the EPO (“Guidelines”) allow applicants and proprietors to either remove from the description and drawings subject-matter which is not covered by the claims, or to alternatively present such subject-matter not as embodiments of the invention but as background art or examples useful for understanding the invention, in order to avoid potential inconsistencies between the claims and the description/drawings (Guidelines F-IV.4.3(iii)),

OBSERVING that there is a critical difference between subject-matter that falls outside the wording of the claims on the one hand and subject-matter that falls within the wording of the claims but is not explicitly recited as such in the claims on the other,

FURTHER OBSERVING that, pursuant to Article 69 (1) of the European Patent Convention (EPC), while the extent of the protection conferred by a European patent or a European patent application shall be determined by the claims, the description and drawings shall be used to interpret the claims, and thus that the removal of subject-matter from the description and the



“Compulsory Amendment of Description and Drawings”

drawing may adversely affect the position of an applicant or a proprietor at a later stage, in particular in court proceedings,

FURTHER NOTING that the practice of the EPO is inconsistent with all of the other IP5 Offices, as well as the vast majority of the Offices of the EPC Contracting States and that users benefit from harmonisation of practices and procedures at the IP5 and EPC national Offices,

EMPHASING that decisions T1444/20 and T1989/18 made clear that no provision of the EPC requires the deletion or marking of subject-matter which is not covered by the claims,

FURTHER NOTING that these decisions are contradicted by T1024/18, T121/20, T2293/18 and T2766/17,

BELIEVING that decision T1989/18 supersedes decision T1808/06, which does not contain any thorough analysis of Article 84 EPC and justifies the deletion of unclaimed subject-matter with reference to the Guidelines,

ADVISING that amendment of the description and drawings can require substantial additional work by applicants, proprietors and/or their representatives, leading to significant increased costs,

URGES the EPO to refrain from insisting on the removal of any subject-matter from the description and the drawings of European patent applications or European patents, provided that the presence of such subject-matter does not throw doubt on the extent of protection by clearly contradicting the claims.