ORDINE DEI CONSULENTI
IN PROPRIETÀ INDUSTRIALE

IL CONSIGLIO

AMICUS CURIAE BRIEF

in case G 1/25 before the Enlarged Board of Appeal

(Art. 10 of the applicable Rules of Procedure)

Ordine dei Consulenti in Proprietà Industriale

1.1 The Institute

The Italian Institute of Industrial Property Consultants (*Ordine dei Consulenti in Proprietà Industriale* - OCPI) was established on 3 April 1981 by Ministerial Decree, the provisions of which were subsequently included in the Italian Industrial Property Code (*Codice della Proprietà Industriale*) of 2005.

OCPI is a national organization of public interest and operates under the supervision of the Director of the Italian Patent and Trademark Office (*Ufficio Italiano Brevetti e Marchi* – UIBM).

OCPI is based in Milan and administered by a Council composed of ten people elected among its members, including two representatives from the industry. A separate Disciplinary Board, consisting of five full members and three alternate members, is appointed by the President of the Court of Milan for tasks associated with the OCPI Code of Conduct.

The OCPI register includes about 1.350 members from both private (89%) and corporate (11%) practice, with a trademark and a patent section. According to the Italian law, representation before the Italian Patent and Trademark Office and before its Board of Appeal is possible only for members of OCPI and for lawyers.

Approximately 75% of the members of the patent section are also European Patent Attorneys active before the European Patent Office, most of whom are, as well, qualified as litigators before the Unified Patent Court (UPC). The seven Technically Qualified Judges of this latter Court based in Italy are also members of OCPI.

The main activities of OCPI are institutional, educational and related to advocacy. In particular, the Institute advices governmental bodies, manages qualifying examinations, (co)organizes congresses and seminars and handles CLE. It also promotes advancements in the IP profession and drives legal developments.

1.2 Interest of OCPI in the outcome of case G1/25

As mentioned above, OCPI members act as patent attorneys at both national and international level and advice Italian and foreign companies in European Patent practice, being drivers for innovation and strategic protection choices.

Therefore, OCPI has a strong interest in the development of the case law of the European

Patent Office, with a view to improve legal certainty, predictability and harmonization to the benefit of patent applicants, patentees and third parties.

Given the importance of the outcome of case G1/25 for pursuing said objectives, OCPI welcomes the opportunity to submit its view.

The referred questions

In appeal proceedings pending as case no. T 0697/22, Technical Board of Appeal 3.3.02 (hereinafter, the "referring Board"), by interlocutory decision of 29 July 2025 (hereinafter, the "referring decision"), has referred the following questions 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?*

The Enlarged Board of Appeal has invited third parties to submit written statements pursuant to Art. 10 of the Rules of Procedure of the Enlarged Board of Appeal (Official Journal EPO 2025, A59). The position of OCPI is explained in the following sections.

Admissibility of the referral

OCPI agrees with the referring Board that, as summarized in points 14 and 15 of the referring decision, there exist two clearly diverging lines of case law addressing the above questions.

In summary, one line of case law holds that the EPC requires those parts of the description which do not fall within the scope of the claims (as amended in examination or opposition proceedings) to be deleted or at least explicitly disclaimed as not relating to the claimed invention. The second line of case law, by contrast, concludes that no legal basis for such a requirement to adapt the description to the amended claims can be found in the EPC.

Accordingly, OCPI agrees that there is a need for a referral under Art. 112(1)(a) EPC.

The meaning of "*inconsistency*"

Question 1 refers to an "*inconsistency*" between claims and description that may arise because of claim amendments.

As it is clear from point 10.5 of the referring decision and from the case law analysed by the referring Board in points 14 and 15, the "*inconsistency*" at issue specifically concerns the presence of unclaimed subject-matter in the description, i.e. the situation identified in the Guidelines for Examination (version of April 2025) under section F-IV, 4.3(iii):

> *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.*

Such situations commonly arise when the claims are narrowed during examination or opposition proceedings, while the description still reflects the broader subject-matter originally claimed.

In the referring decision, the competent Board found that paragraphs [0013] and [0016] of the description disclosed binders that no longer fell within the scope of the amended claims, thereby identifying an "*inconsistency*".

For the purposes of the present brief, other types of inconsistencies, such as those addressed in section F-IV, 4.3(i) and (ii) of the Guidelines, are not considered, as they are not relevant to the referred questions.

The "*support*" requirement under Art. 84 EPC

Art. 84 EPC requires that the claims be clear, concise and supported by the description. However, it does not prohibit the description from containing subject-matter, related, e.g., to the technical field of the invention or the relevant prior art, which is not claimed but is - for example – "*useful for understanding the invention*" (section F-IV, 4.3 of the Guidelines). Provided it supports the claims, the description can take any form which the applicant considers to be the most appropriate (section F-II, 4.10 of the Guidelines).

According to the Guidelines (section F-IV, 6.1), the support requirement under Art. 84 EPC is satisfied where the claimed subject-matter has a basis in the description:

> *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).*

According to section F-IV, 6.6, claimed subject-matter must be copied into a description which does not mention it:

> *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, the initial claims are usually copied at the end of the description as "clauses", since any further alteration of their form would violate Art. 123(2) EPC. Therefore, claim-like clauses are not only allowable but also necessary in some cases, precisely to satisfy the support requirement of Art. 84 EPC.

According to WIPO, in the framework of a study concerning sufficiency of disclosure carried out

by the Standing Committee on the Law of Patents[1], the support requirement as explained in the aforementioned section of the Guidelines is in line with the interpretation of the same requirement adopted "*in most jurisdictions*":

> *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".*

Moreover, in many jurisdictions, including Italy, no requirement of adaptation of the description by deleting or disclaiming passages thereof is applied, either in conjunction with national applications/patents, European validations or national entries according to the PCT.

It is further observed that decision G 1/24 (point 8) seems to confirm that Art. 84 EPC relates to the content of the claims only:

> *Using Article 84 EPC as an alternative basis for interpretation of the claims can also be criticised. Article 84 EPC addresses the content of the patent application and is formal in nature, does not mention the invention and provides no guidance on how to interpret claims. It only sets out an instruction to the drafter of what needs to be in the claims, and an instruction to the EPO to determine whether the claims meet that purpose (see T 1473/19 Reasons 3.8).* (Emphasis added)

In light of the above, OCPI submits that Art. 84 EPC does not provide a legal basis for requiring amendments to the description merely because it contains unclaimed subject-matter.

Rules 42 and 48 EPC

Rule 42 EPC is mentioned in T140/19 (cited in the referring decision) as a legal basis for requiring adaptation of the description.

In particular, Rule 42(1)(c) EPC provides that the description shall:

> *disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects of the invention with reference to the background art.*

Therefore, Rule 42 EPC only requires the description to disclose the claimed invention and does not provide a legal basis for requiring an applicant/proprietor to adapt the description to the claims. In other words, Rule 42 EPC relates to the implementation of Art. 83 EPC, defining the minimum requirements of the description in order to secure that the technical content of the patent application, as defined at the filing date, can be put into practice. Accordingly, Rule 42 EPC is satisfied also when the description provides examples supporting the amended claims and further examples which - e.g. as a consequence of amendments or a restricted definition in the claims - are not within the scope of the latter.

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

Moreover, in case T 438/22 (mentioned in point 14.3.2 of the referring decision) Rule 48 EPC was mentioned in combination with Art. 84 EPC as a possible legal basis for requiring adaptation of the description. However, Rule 48(1)(c) EPC is meant to avoid that a patent application is used for other purposes than disclosing an invention, by containing statements or other matter "*obviously irrelevant or unnecessary under the circumstances*". Therefore, Rule 48 EPC is not applicable to the issues in dispute, at least because the examples contained in the description are needed to understand the original teaching of the specification and therefore cannot be regarded, for their very nature, as "*irrelevant*" or "*unnecessary*".

The diverging case law addressed by the referring decision

The referring Board mentions T 1024/18 as a guiding decision of the first line of case law mentioned in previous section 3.

According to paragraph [3.1.10] of that decision,

> *[…] when amendments are made to the claims (amendment to the granted claims in the present case), the description must be made consistent therewith in the sense that a reader is not presented with any information conflicting with the wording of the claims […].*

OCPI respectfully disagrees with this reasoning: unclaimed subject-matter does not, as such, "conflict" with the wording of the claims.

Furthermore, decision T 1024/18 does not appear to convincingly explain why claims that are fully supported by the description would cease to be supported merely because the description also discloses unclaimed subject-matter.

Similar considerations do apply with respect to the other decisions forming said first line of case law.

OCPI therefore aligns itself with the second line of case law, in particular with decision T 56/21, which concludes that *"neither Article 84 nor Rules 42, 43 and 48 EPC provide a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter."*. (Catchword; par. [99(c)]).

Adverse effects of requiring adaptation of the description

Requiring the deletion, or the disclaimer, of unclaimed subject-matter from a patent disclosure is not only unsupported by the EPC, as discussed above, but may also have adverse legal and practical effects on applicants, patent owners and third parties, for multiple reasons.

First of all, amending the description or the drawings *de facto* alters the original meaning of the claimed features, which, according to G1/24 (following UPC_CoA_335/2023), should always be interpreted by consulting the description and drawings. In other words, adapting the description to amendments to the claims determines a "loop" of amendments that sharply contradicts legal certainty. In fact, any manipulation of the original disclosure incurs a serious risk of determining

a mutating interpretive reference that undermines legal certainty. On the contrary, there is no doubt that an unamended description fully reflects the disclosure provided by the applicant at the date of filing, which is a fundamental information not only in examination and opposition proceedings, but also when the patent is enforced. In this respect, it is noted that Rule 40(1)(c) EPC defines the principle for which the accorded filing date of a patent application is inseparable from the description as originally filed.

The alteration of the basis for interpreting the claims has also important fallbacks under several requirements of the EPC, as explained below.

First of all, said adaptation may lead to a violation of Art. 123(2) or (3) EPC, as confirmed, for example, by the catchword of decision T 500/01:

> *A claim, the wording of which is essentially identical to a claim as originally filed, can nevertheless contravene the requirements of Article 123(2) EPC, if it contains a feature whose definition has been amended in the description in a non-allowable way.*

A similar example of such an adverse effect can be found in decision T 1227/10.

Moreover, the disclosure of an unclaimed embodiment could include technical elements or definitions that may also be relevant for a claimed embodiment. In this case, deleting or disclaiming said disclosure might result in an inadvertent modification of essential information provided to the skilled reader in order to put the invention into practice and, therefore, determine the nullity of the patent under Art. 100(b) EPC or Art. 138 (1)(b) EPC.

In addition, the removal, or disclaimer, of an alleged inconsistency could impact the application of the doctrine of equivalents, particularly with respect to the consideration given to the prosecution history, which is not uniform among national courts[2].

Finally, the removal of an inconsistency might even remedy to an initially self-contradictory disclosure, resulting in a different teaching or general understanding with respect to the original application.

In summary, the above scenarios show that the removal of unclaimed subject-matter from the description reduces legal certainty for patent owners and third parties, instead of solving an alleged *"inconsistency"* between description and claims.

Therefore, consistently with the EPO Strategic Plan 2028[3] and its commitment to efficiency and quality in examination procedures, OCPI is of the opinion that the EPO and the Boards of Appeal should refrain from requiring the removal or disclaimer of unclaimed subject-matter (as well as claim-like clauses) from the description of European patent applications or patents, both during

[2] Summary Report on Question Q229 of AIPPI (https://www.aippi.fr/upload/Seoul_2012/q229-rapport-international-de-synthese-_final_e_270912.pdf): prosecution history is taken into account in Denmark, Finland, France, Netherlands, Sweden and Turkey, is not considered in Czech Republic, Hungary, Norway and Portugal, and is taken into account in limited circumstances in Austria, Germany, Poland, Spain and the United Kingdom.

[3] https://link.epo.org/web/about-us/office/en-epo-strategic-plan-2028.pdf

examination and opposition proceedings and the relevant appeals, irrespective of whether the claims have been amended.

Conclusions – The suggested answers to the referred questions

Considering the foregoing, the following conclusions are drawn.

No legal source, either explicitly or implicitly, prohibits that the claims (literally) refer to a more limited subject-matter than the description. In particular, neither Art. 84 EPC nor any other source of law or established practice requires a strict one-to-one correspondence between the claims and the totality of features disclosed in the description or the drawings.

The request to adapt the description (and drawings) to the scope of the amended claims appears to respond to a purely formal and administrative requirement that cannot overrule legal certainty. While a perfect "symmetry" between description and claims might appear, *prima facie*, desirable, such symmetry contradicts the very basic principle of crystallizing the contribution that the patent disclosure provides to the state of the art at the filing date.

Therefore, OCPI proposes the following answers to the questions referred to the Enlarged Board of Appeal in case G 1/25:

1. **No:** the EPC does not require the removal or disclaimer of unclaimed subject-matter (a so called "*inconsistency*") from the description of a European Patent amended during opposition proceedings or opposition-appeal proceedings.
2. No answer is needed in view of 1.
3. **No:** the EPC also does not require the removal or disclaimer of unclaimed subject-matter from the description of a pending European Patent application, irrespective of whether the application has been amended during examination proceedings or examination-appeal proceedings, since the principles of legal certainty, procedural fairness and statutory interpretation equally apply in examination and opposition proceedings.

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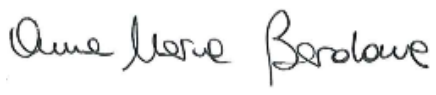
Milan, 30 January 2026

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