

Registry of the Enlarged Board of Appeal  
of the European Patent Office

*for the attention of:*

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Re : **Amicus curiae brief ex Art.10(1) RPEBA in regard of  
referral G1/25 to the Enlarged Board of Appeal**

Our ref. : ACB G1/25 -- OSR

In view of the recent referral G1/25 to the Enlarged Board of Appeal which stems from the interlocutory decision T697/22 of TBA 3.3.02, the undersigned hereby presents his opinion on the legal issues that are deemed pertinent in the context of the referral.

## 1. Introduction

The undersigned presents his opinion hereinbelow as a third party pursuant to Art. 10(1) RPEBA, and states that he does not have any interests or involvement in the present referral case T697/22.

Accordingly, the present opinion reflects my personal assessment of the legal issues pertinent to referral G1/25, based on my professional experience as a European patent attorney and presented from an impartial perspective.



## 2. Referral questions

The following questions have been directed to the Enlarged Board under referral G1/25:

- 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?*

## 3. General considerations in view of referral G1/25

In developing the present opinion on referral G1/25, the following general considerations have been taken into account.

### 3.1 Referral case T697/22 and first instance proceedings

The referral case T697/22 revolves around an Auxiliary Request 1E containing amended claims which in themselves have been found by the referring Board to be allowable, which is an actual confirmation of the assessment by the Opposition Division in first instance.

#### *Opposition proceedings*

Before the Opposition Division, the Auxiliary Request 1E had been augmented by the filing of an adapted description in order to bring the contents of the description in conformity with the amended claims that were found allowable in themselves.



The Opposition Division found that the submitted description was adapted sufficiently, to '*ensure sufficient consistency between the amended claims and the description*' (pt. 19.2 of decision), and that additional adaptation of par. 13, 16 and 20 of the patent was not found necessary even though the contrary was argued by the Opponent.

It was furthermore noted by the Opposition Division that the issue relating to par. 13, 16 and 20, actually cannot be addressed under Art. 84 EPC in view of G3/14.

*Additional remark:*

*The amended claims of Auxiliary Request 1E are actually based on a pure combination of the claims as granted. According to G3/14, it is prohibited to apply Art. 84 EPC in opposition proceedings for an assessment of such amended claims. My interpretation of G3/14 is that it equally includes a prohibition to apply Art. 84 EPC in requiring an adaptation of the description at large. Consequently, Art. 84 EPC cannot be applied in the present referral case, and hence does not necessitate any adaptation of the description.*

### *Opposition-appeal proceedings*

During subsequent appeal proceedings, the Opponent repeated their objections to the adapted description for being non-compliant with Art. 84 EPC.

The referring Board did establish that par. 13 and par. 16 of the adapted description contain inconsistencies with the amended claim 1 of the Auxiliary Request 1E, as these paragraphs disclose a broader technical definition of a 'binder' than defined in the amended claim 1.

In view of these inconsistencies, the referring Board expressed their opinion that it is not well established in relevant case law, whether the presence of the specific inconsistencies as established, would amount to a contravention of any requirement of the EPC, and in particular of Art. 84 EPC.

Accordingly, the Board presented their three referral questions before the Enlarged Board of Appeal, in order to decide on the issue whether the specific inconsistencies that were found in par. 13 and par. 16 of the description of Auxiliary Request 1E would be non-compliant with the EPC.

### 3.2 Recent case law from Boards of Appeal

As comprehensively pointed out by the referring Board, issues which are similar to the issue considered in the present referral case were recently (especially over the last 3 years) decided upon by the EPO in diverging ways and by application of different sources of legal basis. The sources of legal basis have furthermore been interpreted in different ways as well.

Accordingly, a decision on these issues by the Enlarged Board of Appeal is generally warranted to ensure that the law is applied more uniformly as far as practically possible within the framework of the EPC.

From a general perspective, the referral G1/25 is furthermore welcomed as it is directed to a topic which is a part of daily practice commonly occurring during both opposition proceedings and examination proceedings before the EPO.

### 3.3 Personal experience

From a personal perspective, the referral G1/25 covers issues that are in my practice perceived as relating to minor formal requirements of adapting the description. These issues can in most cases be solved in a straight-forward manner at the conclusion of opposition and examination proceedings.

Although the adaptation of a description is the end-responsibility of the applicant resp. patentee, it is normally performed in a close co-operation with the EPO on the basis of consensus wherein the EPO regularly takes a leading role.

However, occasionally an applicant or patentee may have legitimate concerns regarding the adaptation of a description, either in view of the intended scope of protection of the patent, or in view of safeguarding any future amendment to the claims during opposition proceedings or during validity proceedings before a national court.

Although such situations are regarded as exceptional from my perspective, a sufficiently clear legal basis for the requirement of an adaptation of the description is nevertheless warranted for situations wherein no consensus is reached between the applicant resp. patentee and the EPO, and possibly an opponent.

### 3.4 Possible beneficial aspects of G1/25

If the referral G1/25 would result in providing further guidance on the extent to which a description should be adapted, then this could accordingly provide a clarification and simplification of the proceedings before the EPO in regard of this particular issue.

As such, an enhanced predictability in regard of this particular issue during both opposition proceedings and examination proceedings would be accomplished, which would be beneficial to all parties involved.

## 4. Referral questions in view of admissibility under Art. 112(1)(a) EPC

### 4.1 Interpretation of the scope of the referral questions

The three referral questions have an inherently broad scope, as they are directed to address the issue of any inconsistency introduced by an amendment of the claims at any stage of examination and opposition proceedings.

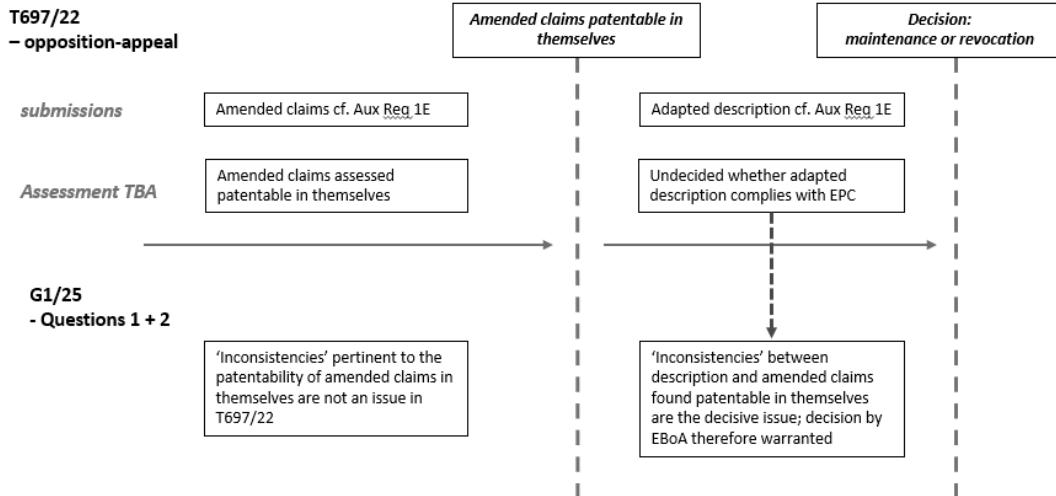
The referral case however, clearly has a more narrow scope, because the actual inconsistency in the description found by the board in T697/22 relates to a specific procedural situation wherein ***the amended claims in themselves have already been found patentable in opposition proceedings***.

Therefore, the three referred questions are regarded to be primarily directed to situations wherein the EPO requests a patentee or applicant to '***bring the description in conformity with the claims***', i.e. as a concluding, final act of the proceedings after the claims themselves have already been found patentable.

It is submitted that any broader interpretation of the scope of the referral questions would not be admissible in view of Art. 112(1)(a) EPC, because it would expand the scope of legal issues to such an extent that issues are addressed which are not decisive for the referral case itself (viz. the examples in section 5.2 below).

The above interpretation regarding the scope of the referral questions is illustrated below for the referral questions 1 and 2, by a schematic representation of the development of the opposition-appeal proceedings of the referral case T697/22.





## 4.2 Referral question 3

Referral question 3 is in itself not necessary to be addressed in order to decide on the referral case, and may be found not admissible in view of Art. 112(1)(a) EPC.

However, it should be noted in view of the referral as a whole, that identical provisions of the EPC apply to both the examination and opposition proceedings once amended claims have been found patentable, because Art. 101(3) EPC stipulates that an amended patent during opposition proceedings is assessed in view of all the requirements of the EPC.

Therefore, an identical assessment of compliance with the EPC is in principle applied during both examination proceedings and opposition proceedings, in view of adapting a description once amended claims have been found patentable in themselves.

Accordingly, an analysis of the relevant provisions of the EPC that is necessary to answer questions 1 and 2, will largely overlap with an analysis of the provisions of the EPC in view of question 3.

For a comprehensive analysis of the EPC on the issues raised in G1/25, it therefore makes sense that the Enlarged Board would admit question 3 for the sake of offering a complete legal background to an answering of questions 1 and 2. Such an approach

would furthermore be expedient given that the relevant provisions of the EPC are basically identical in both proceedings.

Finally, this approach is also regarded opportune in view of the fact that diverging case law has emerged in both examination and opposition proceedings on similar issues of adapting the description in regard of amended claims that are found patentable.

## 5. 'Inconsistencies between description and amended claims'

### 5.1 Not defined in the EPC; but discussed in Guidelines

The topic of 'inconsistencies between description and amended claims' is not indicated as such in the EPC. Any generic requirement that inconsistencies in the description should be removed once amended claims are found allowable in themselves, is not indicated in the EPC either.

Nevertheless, the Guidelines for Examination as published by the EPO provide a helpful starting point for a discussion on this topic: in Chapter F-IV, sections 4.3 and 4.4, a variety of possible inconsistencies between description and claims are outlined and classified according to the following four basic types, which can be summarized as follows:

- i) Verbal inconsistency between the claim wordings and the description;
- ii) Description discloses limitations which are essential to the invention, but these are not specified in the claim (or a vice-versa situation);
- iii) Description discloses subject-matter which is not covered by the claims;
- iv) Description contains claim-like clauses different from the claims.

In the above sections of the Guidelines it is prescribed that in most cases such inconsistencies should be solved, and these cases are illustrated by several concrete examples.

## 5.2 Narrowing down the types of ‘inconsistencies’ that are relevant for G1/25

Not all the sorts of inconsistencies indicated in the Guidelines are encompassed by the topic on which this opinion is focused, namely the topic of *“bringing the description in conformity with amended claims, after the claims have been found allowable in themselves”* (as discussed in section 4.1 above).

For instance, the following inconsistencies between the description and the claims are regarded as not encompassed by the scope of the referred questions, and therefore fall outside the scope of this opinion, because they relate to inconsistencies which are pertinent to an examination of the patentability of the amended claims under the EPC:

- The description contains a definition of a term giving it a different meaning than the meaning of the term *per se* in the claim; such an issue would be a violation of **the requirement that the claim needs to be clear in itself** and needs to be solved under Art. 84 EPC before a decision on patentability can be rendered (i.e. an issue comprehensively addressed in recent G1/24);
- The description discloses an essential feature of the invention, but this essential feature is not included in an independent claim. Under Art. 84 EPC and Art. 56 EPC **an essential feature should be included in the independent claim** before a decision on patentability can be rendered.

Notwithstanding the above indicated exceptions, this opinion will cover all the four inconsistency types, with an emphasis on types i) and iii), i.e. a verbal inconsistency existing between an amended claim and the description, or the description disclosing information which is not covered by the amended claims.

It is noted that the inconsistencies of type ii) are regarded as only partly encompassed by the referred questions, namely in instances wherein the amended claims contain limitations which are essential to the invention, while these limitations are in the description not disclosed as being essential.

Furthermore, the inconsistencies of type iv) which pertain to clauses contained in the description, is a topic that is discussed in a separate chapter.

## 5.3 ‘Bringing the description in conformity with amended claims’

Overviewing the scope of the present referral, it is regarded more appropriate and more precise, to refer to the main topic of this opinion as ‘a presumed requirement under the EPC that a description shall be brought in conformity with amended claims’, and not to refer to the main topic as ‘a presumed requirement under to the EPC to remove inconsistencies between the description and the amended claims’.

As demonstrated above, the latter indication would include situations which are not encompassed by the referral case, whereas the former indication more precisely narrows the topic down to the scope of the referral case itself.

## 5.4 Legal basis for ‘conformity of the description with amended claims’

The topic of ‘conformity of the description with amended claims’ is not indicated as such in the EPC. Any generic requirement to establish such conformity once amended claims have been found allowable in themselves is not stipulated in the EPC either.

Although a **generic requirement** of adapting the description is lacking in the EPC, it will be demonstrated below that in some particular situations, **some specific requirements** can be derived from certain provisions from the EPC which impose that in such particular situations the description is brought in conformity with amended claims which have been found patentable in themselves.

## 6. Restrictive interpretation of the EPC

### 6.1 Restrictive approach

Considering that a generic requirement for adapting the description to amended claims is not present in the EPC, it follows from a codified system as the EPC that any specific provisions of the EPC which impose a conformity requirement for particular situations, should be interpreted and applied in a restrictive manner. Such a restrictive approach entails that the conformity requirement is only applied to issues that are directly related to the situations that are encompassed by these specific provisions.

The restrictive approach conversely entails that the specific provisions of the EPC cannot be interpreted in such a broad sense, that a generic requirement may still be inferred from such provisions.

This restrictive approach is furthermore considered a legitimate and fair approach in view of the rights of the applicant and patentee, who should not unduly be forced to adapt the description of their application resp. their patent without any clear indication derivable from the applicable law.

### 6.2 Specific provisions of the EPC requiring an adaptation of the description

In accordance with the above adopted, restrictive application of the EPC, only clear indications in the law from which a concrete situation can be inferred that directly relates to an inconsistency between the description and amended claims, should be taken into account when the conformity of the description with the amended claims is assessed.

In my opinion, such clear indications in the law from which it can be inferred that conformity of the description with the amended claims is required, are given in the provisions of **Art. 84 EPC**, **Art. 82 EPC**, **Art. 53 EPC**, and **Art. 52(2) EPC**.

The implications of these provisions on examination and opposition proceedings are slightly different, and are therefore discussed below in separate parts A and B.

## 7. Provisions from the EPC requiring an adaptation of the description

### Part A -- Examination proceedings

#### 7.1 Art. 84 EPC

Art. 84 EPC, first sentence, stipulates that the claims should be a definition of the 'matter for which protection is sought', i.e. a definition of the invention such as referred to in Art. 52 EPC.

Art. 84 EPC, second sentence, stipulates that 'the claims shall be clear and concise and be supported by the description'.

It is noted that Art. 84 EPC applies to the claims as prosecuted during examination proceedings, and thus includes also an amended version of the claims such as encompassed by the scope of the present referral.

The requirement 'the claims shall be clear and concise' applies only to the claims in themselves, and not to the description (cf. T988/02, r.3.3.1). The clarity of the claims in themselves is furthermore not a topic of this opinion, because it is not a topic in the referral case.

The requirement that 'the claims shall be supported by the description' stipulates in my view that a relationship between the description and the claims is required by the EPC in two fundamental regards:

- A *verbal* relationship is required between the description and the wordings of the claims as a definition of the invention;
- A *substantive* relationship is required between the description and the subject-matter of the claims as a definition of the invention.

Such an interpretation is derived from Art. 84 EPC, first sentence, that the claims define the invention, and the linguistical fact that the claims are composed of a collection of words (and formulae, - if applicable) having a syntactical relationship with each other.

In my opinion, the precise wordings of the claims and the abstract meaning of the claims are therefore inextricably linked to each other, which requires an assessment of Art. 84 EPC in regard of both aspects.

### 7.1.1 Requirement of verbal relationship

The required verbal relationship between the description and the wordings of the claims as a definition of the invention, implies in my opinion the following requirement:

→ The definition of the invention according to the amended claims is contained verbatim in the description, or a reference is made in the description to the claims as appended, in order to comply with Art. 84 EPC.

- If such a definition is not yet contained in the description, it should be regarded a violation of Art. 84 EPC which has to be corrected. Such a correction amounts to an act of rendering the description in conformity with the claims.

### 7.1.2 Requirement of substantive relationship

The required substantive relationship between the description and the subject-matter of the claims as a definition of the invention, implies in my opinion the following requirements:

- The subject-matter of the claims should be sufficiently explained in the description in order to support an inventive step under Art. 56 EPC, and to support a sufficient disclosure under Art. 83 EPC.
- When such information is not available in the description, it does not result in an inconsistency with the claims, but instead a lack of fundamentally required information for which the claims may be refused under Art. 56 or Art. 83 EPC.
- The lack of substantive information in the description as required under Art. 56 or Art. 83 EPC is an issue that is not encompassed by the scope of the present referral, because it is an issue that instead relates to the question of patentability of the claims in themselves.

## 7.2 Art. 82 EPC

Art. 82 EPC stipulates that the application relates to one invention only, which requirement is thus valid for both the description and the claims.

Accordingly, Art. 82 EPC requires that conformity exists between description and amended claims to the extent that the description and the claims both relate to the one single invention.

→ Art. 82 EPC thus requires that when claims are deleted for relating to another invention, also the parts in the description that relate to this other invention should be deleted.

## 7.3 Art. 54 EPC

Art. 53 EPC defines three exceptions to patentability as excluded subject-matter under (a), (b) and (c), stipulating that a patent shall not be granted for such excluded subject-matter.

Accordingly, Art. 53 EPC requires that conformity exists between description and amended claims to the extent that both the description and the claims do not include subject-matter mentioned in Art. 53 EPC.

→ Art. 53 EPC thus requires that, when claims are deleted for relating to excluded subject-matter, also the parts of the description that relate to this excluded subject-matter should be deleted.

## 7.4 Art. 52(2) EPC

Art. 52(2) EPC mentions four subjects under (a), (b), (c) and (d) which are not regarded an invention, and which are thus not eligible for a patent

Accordingly, Art. 52(2) EPC requires that conformity exists between description and amended claims to the extent that both the description and the claims do not include subject-matter mentioned in Art. 52(2) EPC.

→ Art. 52(2) EPC thus requires that when claims are deleted for relating to excluded subject-matter, also the parts in the description that relate to this excluded subject-matter should be deleted.



## Part B -- Opposition proceedings

### 7.5 Same provisions apply as in examination proceedings, with some restrictions

In opposition proceedings wherein a patent in amended form is examined (e.g. a patent for which amended claims are submitted as in the referral case) Art. 101(3) EPC stipulates that the patent shall comply with all the requirements as defined by the provisions of the EPC.

Hence, the above outlined four provisions of the EPC that are to be applied during examination proceedings, are in principle equally applicable during opposition proceedings.

Nevertheless, certain case law from the Board of Appeal has restricted the equal application of these four provisions to some extent, as set out below.

#### ***Art.84 EPC (partially prohibited - G3/14)***

Art. 84 EPC should be applied in opposition proceedings in a similar way as set out above for examination proceedings, unless the application of Art. 84 EPC is prohibited under G3/14.

#### ***Art. 82 EPC (prohibited – G1/91)***

During opposition proceedings, the compliance with Art. 82 EPC is prohibited to be assessed ex Art.101(3) EPC, as decided in G1/91.

#### ***Art. 53 EPC***

The compliance with Art. 53 EPC is a ground for opposition ex Art.100(a) EPC and should be complied with in regard of conformity of the description with the claims.

#### ***Art. 52(2) EPC***

The compliance with Art. 52(2) EPC is a ground for opposition ex Art.100(a) EPC and should be complied with in regard of conformity of the description with the claims.

## 8 Discussion on other provisions of the EPC

### 8.1 Significance of R.42(1) EPC

R.42(1) EPC generally indicates the required contents of the description at the initial filing of the application ex Art.78(1), but not to what extent the description should be brought in conformity with the claims when these are amended later on.

R.42(1) EPC sets a requirement which is applicable to the description throughout examination, and possibly opposition, proceedings.

Concretely, R.42(1) EPC requires in respective sections (c) and (e), that parts of the description explain 'the invention as claimed' sufficiently clearly to the public, in order to comply with respective Art. 56 EPC and Art. 83 EPC. As such, these sections (c) and (e) impose substantive requirements on the description in order to provide a sufficiently clear explanation of the invention as claimed.

However, such substantive requirements to the description relate to issues which are not encompassed by the scope of the present referral, because these issues relate to the question of patentability of the claims in themselves.

In summary, R.42(1)(c) EPC does not offer any clear legal basis which requires an adaptation of the description in view of amended claims which are found patentable in themselves, during both examination and opposition proceedings before the EPO.

### 8.2 Significance of Art. 69(1) EPC

Art. 69(1) EPC defines the scope of protection conferred by a patent as follows:

*The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.*

Art. 69(1) EPC does not relate to the amendment of claims during examination or opposition, and does not indicate any requirement that conformity between description and amended claims should be created after such an amendment.

Rather, the article gives general guidance to national courts for establishing the scope of protection of a patent in view of an infringement by a third party.



As such, Art. 69(1) EPC does not offer any clear legal basis which requires an adaptation of the description in view of amended claims which are found patentable in themselves, during both examination and opposition proceedings before the EPO.

## 9. For consideration: an extended interpretation of Art. 84 EPC in view of customary law

When a description has been adapted to amended claims on the basis of the four provisions set out in chapter 7, one may find that this could still result in a description which contains some 'residual inconsistencies' that are potentially confusing in view of providing a clear explanation of the invention to the public or the skilled person.

Although lacking a clear legal basis in the EPC, it is given in consideration as a corollary to Art. 84 EPC and in view of customary law (e.g. the Guidelines), that in limited, specific instances such 'residual inconsistencies' in a description should additionally be corrected on the following grounds.

### 9.1 Unambiguous verbal support of the amended claims in the description

As elaborated in chapter 7, Art. 84 EPC requires a verbal relationship between the description and the amended claims, so that it is ensured that the 'claims are supported by the description'.

Accordingly, it has been inferred that Art. 84 EPC imposes the following requirement:

*The definition of the invention according to the amended claims is contained verbatim in the description, or a reference is made in the description to the claims as appended, in order to comply with Art. 84 EPC.*

However, a description may contain some alternative definitions of the invention which are not claimed as such in the amended claims.

Such alternative definitions of the invention may render the required verbal support of the amended claims ambiguous in certain instances, with the effect that the requirement of verbal support in the description may be seen as not fully complied with.

When in such specific instances the required verbal support of the amended claims is indeed rendered ambiguous, it is proposed that the description should be corrected in this regard.

In summary, it is proposed that the interpretation of Art. 84 EPC is extended such that Art. 84 EPC additionally requires that the description presents an unambiguous verbal support of the amended claims.

### 9.1.1 Instances wherein verbal support is rendered ambiguous

In my opinion, the required verbal support of the amended claims is rendered ambiguous in the following instances:

- i) The description contains a full definition of the invention that is not claimed in itself, but it forms an integral part of an amended claim instead.
- ii) The description contains a full definition of the invention that is not claimed in itself, but the full definition is based on a main subject (i.e. the subject reference) identical to the main subject of an amended claim, while the full definition of the invention is specified differently than in the amended claim.

In such situations it is proposed that such full definitions of the invention are removed from the description, in order to secure an unambiguous verbal support of the amended claims.

*Examples:*

- i) *An amended independent claim 1 is based on a pure combination of an original independent claim 1 and a dependent claim 2; when the description contains a full definition corresponding to original independent claim 1, such a full definition should be removed.*
- ii) *An amended claim 1 is directed to a 'snaredrum' as a main subject which is specified in certain terms. The description contains a full definition of a 'snaredrum' as a main subject which is however specified in a different way, and which definition is not claimed in itself by another amended claim. Such a full definition should be removed.*

### 9.1.2 Instances wherein verbal support is not rendered ambiguous

In my opinion, the required verbal support of the amended claims is not rendered ambiguous in the following instances:

- iii) The description contains a full definition of the invention which is based on a main subject (i.e. the subject reference) that is not identical to the main subject of an amended claim, and the full definition is not claimed in itself, nor forms an integral part of an amended claim.

*Examples:*

- iii) An amended claim 1 is directed to a 'snaredrum' as a main subject which is specified in certain terms. The description contains a full definition of the invention relating to a 'drumkit comprising a snaredrum' which is not claimed in itself, nor is an integral part of an amended claim.*
- iii) An amended claim 1 is directed to a 'snaredrum' as a main subject which is specified in certain terms. The description contains a full definition of the invention relating to a 'method of producing a snaredrum' which is not claimed in itself, nor is an integral part of an amended claim.*

### 9.1.3 Other instances wherein verbal support is not rendered ambiguous

- iv) A part of the description discusses a certain feature as optional or preferable in the context of the invention, while the same feature is presented as essential in an amended claim.

The verbal support of the amended claims is not rendered ambiguous by such a part of the description, because the disclosure of a preferred or optional feature cannot be construed to be a full definition of the invention that amounts to an alternative definition which could render the support of the amended claims ambiguous.

- v) A part of the description discloses an example as an embodiment of the invention which is however not covered by the amended claims.

The verbal support of the amended claims is not rendered ambiguous by such a part of the description, because the disclosure of an embodiment of the invention cannot be construed to be a full definition of the invention that amounts to an alternative definition which could render the support of the amended claims ambiguous.



## 9.2 Remarks on adopting the extended interpretation

The extended interpretation of Art. 84 EPC which is proposed above for consideration, may complicate to some extent the assessment of 'conformity of the description with the amended claims', in the following respects:

- The decisive criterion that 'the verbal support of the amended claims is rendered ambiguous in the description', has to be applied on concrete cases, which will regularly involve situations which go beyond the instances and examples described above, and which require a further, precise assessment.
- The decisive criterion of 'ambiguity of the verbal support in the description' has inherently an arbitrary character, which makes the application thereof less predictable and possibly vague.

In those two respects, the extended interpretation may complicate the application of Art. 84 EPC in the context of adapting the description in view of the amended claims, in each instance wherein full definitions of the invention are contained in the description that could render the support of the amended claims ambiguous.

## 10. Clauses

In the context of this opinion, clauses that are included in the description are regarded as normal parts of the description which are formulated in a particular way that is similar to the formulation of a set of claims.

Accordingly, the presence of clauses in the description should generally be examined during both opposition and appeal proceedings by an equal application of the four provisions as set out in chapter 7.

### 10.1 Application of Art. 84 EPC

When clauses are contained in the description, it is hereby posited that these are not regarded to be a verbal support of the amended claims as required under Art. 84 EPC as set out in section 7.1.1 above.

Hence, irrespective of the presence of clauses, the requirement is maintained that a definition of the invention according to the amended claims is contained verbatim in



the description, or a reference is made in the description to the claims as appended, in order to comply with Art. 84 EPC.

When Art. 84 EPC is applied according to the proposed approach set out in chapter 7, no additional adaptation of the clauses themselves would be required.

## 10.2 Extended interpretation of Art. 84 EPC

If the extended interpretation of Art. 84 as set out in chapter 9 would be adopted, the clauses may require adaptation in view of Art. 84 EPC and customary law, in instances wherein the clauses are considered to render the verbal support of the amended claims ambiguous.

- Such an adaptation would be necessary, when a clause represents a full definition of the invention as described for instances i) or ii) outlined in section 9.1.1.
- Such an adaptation would not be necessary, when a clause represents a full definition of the invention as described for the instance iii) outlined in section 9.1.2.

In the above instances wherein adaptation of a clause would be necessary, it is required that such a clause is removed from the description, and that clauses dependent from such a clause are removed as well.

The above application of Art. 84 EPC in its extended interpretation pertains to both examination proceedings and opposition proceedings equally, unless the application of Art. 84 EPC in opposition proceedings is prohibited under G3/14.

## 10.3 Application of Art. 82 EPC, Art. 53 EPC and Art. 52(2) EPC

When the description contains clauses which define subject-matter excluded under Art. 82, Art. 53 or Art. 52(2) EPC, it is obligatory that such clauses are removed from the description during examination proceedings.

During opposition proceedings, Art. 53 and Art. 52(2) EPC should be applied equally as in examination proceedings, whereas the application of Art. 82 EPC is prohibited in view of G1/91.



## 11. Conclusion

From my viewpoint as professional representative, the above outlined view on the provisions of the EPC which require an adaptation of the description in view of amended claims, provides a practical approach to the main issues of G1/25 which is not only directly inferable from the EPC, but also a clarification and simplification for all parties concerned. As such, an enhanced predictability of the proceedings is accomplished.

The proposed practical approach could be most straight-forward when a restrictive interpretation of the EPC would be applied, to the effect that an extended interpretation of Art. 84 EPC is not adopted.

As a final note, it is remarked that the act of adapting the description to amended claims is in practice perceived as a minor, formal and final issue that has to be completed at the conclusion of examination and opposition proceedings, once the claims have been found patentable.

Such a formal issue should not form a bar of unpredictable height that could result in an unexpected consequence of refusal or revocation, or an unexpected rejection of an opposition.

's-Hertogenbosch, 13 November 2025,

Yours sincerely,



Olaf S. Roelands

*European patent attorney  
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