Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

European Patent Institute · Bayerstrasse 83 · 80335 Munich · Germany

The Enlarged Board of Appeal
Richard-Reitzner-Allee 8
85540 Haar
Germany

Attention: Mr. Nicolas Michaleczek
via email: EBAamicuscuriae@epo.org

Re: Enlarged Board of Appeal Case G 1/25

29 January 2026

Amicus Curiae Brief filed on behalf of epi in respect of Case G 1/25

Dear Sirs,

A. Introduction

This *amicus curiae* brief is filed by the Institute of Professional Representatives before the European Patent Office (commonly known as "**epi**"). The membership of **epi** consists of all persons on the List maintained by the EPO under Article 134 EPC. At present there are around 14,700 members working either in private practice or being employed by companies or institutions who represent before the EPO applicants, patentees, opponents, appellants and third parties in connection with EP applications and granted EP patents. Many of **epi**'s members are also authorised to represent clients before the Unified Patent Court (UPC) and national courts. **epi** members represent clients from all around the world and from single inventors to multinational corporations. Our members—all European Patent Attorneys—therefore have a very keen interest in the questions referred to the Enlarged Board and wish to contribute their substantial experience gained from the day-to-day work with the EPO in and around the area related to the questions. Many of our Members also have a strong international exposure and are hence familiar with other jurisdictions' practices and their advantages and drawbacks.

The Referral

The present Referral to the Enlarged Board of Appeal arises from the interlocutory decision of Technical Board of Appeal 3.3.02 dated 29 July 2025 in case T 0697/22, which, in accordance with Article 112(1)(a) EPC, referred three questions to the Enlarged Board of Appeal.

President • Peter R. Thomsen
epi Secretariat · Bayerstrasse 83 · 80335 Munich · Germany
Phone +49 89 242052-0 · Fax +49 89 242052-220
info@patentepi.org · www.patentepi.org

Direct Phone: +41 79571 0076
president@patentepi.org

The Questions

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?*

B. Admissibility of the Referral

epi considers that the referral is admissible.

C. The Position of epi

1. **epi** considers that the legal basis for requiring amendment of the description is, if anything, Article 84 EPC[1]. There are two parts of Article 84 EPC (second sentence) which are particularly relevant. The first part is that the claims shall be clear and concise. The second part is that the claims shall be supported by the description.

   As regards the clarity of the claims, it is agreed that, if a claim is unclear when read in isolation[2], for example because there is *technical* inconsistency between features within the claim[3] or the claim includes a feature which is genuinely unclear to the skilled person (such as a relative term or a feature defined by a parameter which is unclear in itself), then an objection under Article 84 EPC should be raised.

2. **epi** considers that, if a claim is clear when read in isolation, then amendment (of the claim and/or the description and/or figures) would **only** be necessary if the content of the description or figures leads to an objection that the claim is **genuinely** unclear

[1] See Annex 1 attached. Rules 42 and 48 EPC do not provide relevant legal basis.
[2] By "read in isolation" we mean when read by a skilled person without having read the rest of the application or patent. This is in agreement with G 1/24 Headnote, for example.
[3] See CLBA II.A.3.1: *A prerequisite for arriving at a technically sensible claim interpretation is that the claim is technically consistent: if two features are separately clear, but inconsistent with each other from a technical point of view, then their combination, and the claimed subject-matter, cannot be clear (T 935/14).*

within the meaning of Article 84 EPC[4] or unpatentable under Articles 52, 53, 57 or 83 EPC.

If the description contains a disclosure which broadens the scope of a feature of the claim so that an objection of lack of novelty or lack of inventive step may be raised, then such an objection should be raised under either Article 54 or Article 56 EPC as soon as possible in the proceedings[5].

Where there is **no** effect on the scope of the claim as interpreted by the skilled person, no requirement of the EPC necessitates amendment of the description.

3. The second part of the second sentence of Article 84 EPC relates to support by the description. The EPO's position seems to be that this requires that the description should **only** contain matter which is entirely consistent with what is present in the claims and nothing else[6].

   epi cannot see any justification for the EPO's position within Article 84 EPC itself. All Article 84 EPC provides is a positive requirement: the claim shall be supported by the description. No negative (or reverse) requirement may be derived from Article 84 EPC that the description shall not include anything else.

   Thus, the description of a granted patent may legitimately include subject matter that is not encompassed by the claims: this meets the requirements of the EPC. **epi**'s position is also supported by the "second line of case law" mentioned in the Referring Decision.

4. The fact that the second part of Article 84 EPC is a very limited requirement is also supported by its legislative history[7].

   As originally drafted, (now) Article 84 EPC included the requirement that the claims be "fully" supported by the description. During the evolution of EPC 1973, many observers pointed out that this was an onerous requirement and, on the basis of these representations, the legislative body decided to remove "fully" and so make the requirement less restrictive.

   In light of this, it is **epi**'s view that **only** the positive requirement that the claims shall be supported by the description must be complied with and there is **no** requirement that the description shall not include anything else.

---

[4] This is in agreement with G 1/24 Reasons 20 *The correct response to any unclarity in a claim is amendment.*
[5] Especially, well before the Rule 71(3) EPC Communication.
[6] Guidelines for Examination F-IV, 4.3: *The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them appropriately so that it is clear that they do not fall within the subject-matter for which protection is sought.*
[7] See Annex 1 hereto

5. This view was widely adopted in the early years of the EPO when, generally, all that was required was that, if there was no statement in the description setting out the text of the claim as filed or as amended, then such a statement should be added to the description, thereby providing formal support. This was made even more simple by just adding "The invention is as defined in claim 1".

   It is therefore **epi**'s view that, during examination, opposition or appeal, the deciding body of the EPO should only raise issues of clarity under Article 84 EPC where the claim is unclear **when read in isolation** or where disclosure in the description or figures broadens the scope of a feature of the claim.

   Objections under Articles 54, 56 or 83 EPC arising as a result of that broadened scope should be addressed under the respective Article. Otherwise, no objection should be raised and hence adaptation of the description is not necessary.

6. It is **epi**'s view that the current EPO **procedure** of routinely requiring removal or marking of disclosure in the description or figures that does not fall within the subject-matter for which protection is sought is without legal basis while also inappropriate. Such adaptation of the description, which is an amendment, should be entirely at the option of the Applicant, who bears the responsibility and any risk:

   Cases such as UPC_CFI_278/2023, hn. 2/3, confirmed by UPC_CFI_363/2024, BGH X ZR 16/09 – "Okklusionsvorrichtung" and BGH X ZR 29/15 – "Pemetrexed", show that responsibility for amendment is indeed borne by the Applicant, not by Examining or Opposition Divisions or Appeal Boards.

   In these cases, the courts decided in favour of a limitation of a claim's scope based on disclosure in the description that had **not** been removed by the Proprietor during prosecution or in post-grant proceedings after amendment. This shows that the courts have legal authority and are competent to deal with the situation of an unamended description having impact on the claim scope.

   Conversely, a widescale adaptation of the description may have serious consequences for the Applicant, for example, by inadvertently adding matter, removing disclosure which is relevant for sufficiency, providing advantages for inventive step, etc.

7. The present EPO **procedure** also leads to disproportionate efforts and costs to Applicants.

   It can take a large amount of time to make the adaptations, including further rounds of examination, and this leads to large costs to Applicants, again generally to no advantage to the Applicants and even to disadvantage to the Applicants. When widescale adaptation of the description is made, translation costs may also multiply the cost downstream, both at the grant stage and after opposition.

Similarly at the EPO's side, a practical disadvantage of the present EPO procedure is that it requires a large amount of time and consideration for the Examining or Opposition Divisions and/or Appeal Boards to deal with adaptation of the description, to no advantage to any party.

The amount of EPO time consumed in dealing with adaptation of the description can be very large and this is to the detriment of the quality and cost of the system as a whole, while it does not lead to any significant increase in the quality of the patent as granted.

In fact, it has often led to considerable complications in post-grant proceedings, such as in the referring case[8].

8. The EPO has previously argued that their current **practice** regarding requiring adaptation of the description was supported by all stakeholders interested in the EPO grant process, in particular by national judges and members of the Boards of Appeal by referring to an expert workshop held on 23 June 2022[9].

   It is **epi**'s opinion that expression of views around 2.5 years ago cannot and should not be understood as an unconditional support of the current practice, in particular by a broad range of users of the European patent system at the present time.

9. In order to find out more about the current views of users on the topic of the need to adapt the description, **epi** therefore carried out a survey among its members. This survey showed that:

   - 71% of respondents consider that amendment of the description should be discretionary,
   - 76% consider that there is no legal basis for requiring amendment of the description,
   - 78% reject enforcement of amendment by the examiners, and
   - 82% oppose a requirement to amend the description continuously.

10. The EPO is an international outlier (compared with, for example, the JPO, USPTO and CNIPA) with regards to adaptation of the description. None of these other major patent offices require adaptation of the description in a similar way to that required by the EPO.

[8] Further practical points are addressed in Annex 2.
[9] See G 1/24 ("Heated aerosol") Comments by the President of the EPO paragraph 87 and footnote 97 with reference to https://www.epo.org/en/news-events/news/epo-practice-confirmed-adaptation-description

Within the EPC member states, the survey suggests that 69% have no practice of amending the description and 82% lack jurisprudence on the subject. It therefore appears that the EPO is acting contrary to the accepted international norms or practice.

11. Even where there is a practice of amendment of the description, the requirement is not onerous. For example, in the Manual of Patent Practice of the UKIPO, it is stated that *"Objections should only be raised relating to an inconsistency between claims and description when the inconsistency causes genuine difficulty in determining the scope of the claims. Examples where this might (but not always) occur are: ... if it is difficult to determine whether an embodiment falls within the scope of the claims, then an objection should be made. However, in general, an objection should not be raised if an embodiment falls outside the scope of the claims as the claims should clearly define the monopoly sought"*[10].

This is consistent with the **epi**'s view that Article 84 EPC does not require deletion of disclosure which is not covered by the subject matter or scope of the claims.

D. epi's answers to the Questions

In light of the arguments made above, **epi** considers that the answers to the questions should be as follows:

1. ***No.*** *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, it is* ***not*** *necessary, in order to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency.*

   The concept of an "inconsistency" is not well-established and has been expanded and applied beyond any legal justification.

   The Patentee should ***only*** *be required to make adaptations to the description if a disclosure in the description or figures renders a claim* ***genuinely*** *unclear so that it does not meet the requirements of Article 84 EPC or gives rise to an objection under any one of Articles 52 to 57 or 83 EPC.*

   Apart from these scenarios, ***no*** *adaptation of the description is necessary.*

2. *The legal basis for requiring amendment of the claims, as referred to in the answer to Question 1 above, is Article 84 EPC but this stipulation does* ***not*** *provide legal basis for requiring adaptation of the description.*

[10] https://www.gov.uk/guidance/manual-of-patent-practice-mopp/section-14-the-application#ref14-144

*In particular, Article 84 EPC does **not** provide a basis for requiring removal or marking of disclosure in the description that does not fall within the subject-matter for which protection is sought or the scope of the claims.*

3. ***No. epi**'s answers to Questions 1 and 2 apply mutatis mutandis.*

If the Enlarged Board would like to receive further input regarding the questions, **epi** would be pleased to provide such input.

Yours sincerely

Peter R. Thomsen

President of **epi**

Annexe 1 - Legal Provisions Considered by epi

Article 52(1) EPC

> European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

To assess this requires identification of the invention. Article 84 EPC provides the means to identify the invention.

Article 84 EPC

> The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

Travaux Préparatoires

The referring Board referred to these but said that they did not find anything clear. However, there is more in these than the referring Board saw. The original version of Article 84 was drafted to read:

> *… They shall be clear and concise and be fully supported by the description.*
>
> *… Sie müssen deutlich und knapp gefaßt und in vollem Umfang von der Beschreibung gestützt sein.*

It was then reported that:

> The Conference decided that Working Party I should examine the questions whether, as most of the organisations proposed, the word "fully" should be deleted and whether it should be replaced by less restrictive wording.

After this examination:

> The Working Party decided to comply with the request of a number of the non-governmental international organisations by deleting the word "fully".

Nothing was said about the German language version. However, in the version included in the proposed EPC considered by the Diplomatic Conference in 1973, the words "*in vollem Umfang*" in the German version and "*fully*" in the English version did not appear. The French version has similar wording.

From this, it can be concluded that the legislators did not intend Article 84 EPC to be restrictive. This can also be seen from the fact that failure to meet the requirements of Article 84 EPC was not made a ground of opposition.

The situation did not change with EPC 2000. No attempt was made to change the wording of Article 84 EPC and no attempt was made to make Article 84 EPC a ground of opposition.

Therefore, the intention of the legislators in 1973 has not been changed and Article 84 EPC therefore cannot be used to impose a restrictive view on what amendments are required.

Article 94(3) EPC

> If the examination reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, as often as necessary, to file his observations and, subject to Article 123, paragraph 1, to amend the application.

This does not provide a requirement for the description to contain only subject matter relating to the invention.

Rules 42 EPC

> (1) The description shall:
>
> (a) specify the technical field to which the invention relates;
>
> (b) indicate the background art which, as far as is known to the applicant, can be regarded as useful to understand the invention, draw up the European search report and examine the European patent application, and, preferably, cite the documents reflecting such art;
>
> (c) 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;
>
> (d) briefly describe the figures in the drawings, if any;
>
> (e) describe in detail at least one way of carrying out the invention claimed, using examples where appropriate and referring to the drawings, if any;
>
> (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable.
>
> (2) The description shall be presented in the manner and order specified in paragraph 1, unless, owing to the nature of the invention, a different presentation would afford a better understanding or be more concise.

This Rule only specifies what must be in the application, not what must not be in the application. There is **no** provision for exclusion of subject matter not claimed. In any event, this is a non-exclusive list of what **can** be in the application and does not say anything about what **cannot** be in the application.

Rule 48 EPC

(1) The European patent application shall not contain:

(a) statements or other matter contrary to "ordre public" or morality;

(b) statements disparaging the products or processes of any third party or the merits or validity of the applications or patents of any such party. Mere comparisons with the prior art shall not be considered disparaging *per se*;

(c) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

(2) If the application contains matter prohibited under paragraph 1(a), the European Patent Office may omit such matter from the application as published, indicating the place and number of words or drawings omitted.

(3) If the application contains statements referred to in paragraph 1(b), the European Patent Office may omit them from the application as published, indicating the place and number of words omitted. Upon request, the European Patent Office shall furnish a copy of the passages omitted.

This Rule indicates that it is possible that certain matter can be excluded *ex officio*. The nearest it gets to excluding inconsistent matter is paragraph (1)(c) but there is no guidance as to what is "obviously" irrelevant or unnecessary.

This is an exclusionary Rule and so the exclusions should, as usual, be interpreted restrictively and the list should be regarded as being a complete list.

Therefore, there is still nothing establishing that inconsistent matter, as currently interpreted by the EPO, must be removed. If there is dispute between the examiner and the applicant as to whether certain subject matter is or is not "irrelevant", then that subject matter is not "obviously" irrelevant.

Bearing in mind that deletions or other amendments can have unforeseen (even unforeseeable) effects, and irrevocable consequences downstream, the proprietor/applicant must be given the last word on whether or not to delete allegedly irrelevant subject matter.

Rule 71(1) EPC

(1) In any communication under Article 94, paragraph 3, the Examining Division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified.

(2) Any communication under Article 94, paragraph 3, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

…

(6) If the applicant, within the period under paragraph 3, requests reasoned amendments or corrections to the communicated text or keeps to the latest text submitted by them, the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings.

…

Rule 71(1) EPC specifies that the Examining Division shall notify the applicant of any deficiencies and invite the applicant to correct the deficiencies, for example by amending the description. However, this does not say which deficiencies need to be addressed. Again, this could refer back to Article 84 EPC but this then raises again the question of what this Article requires.

T 1024/18

The referring Board used this case as the prime example of cases requiring full adaptation of the description. These all at least to some extent rely on the legal provisions above and so may not be correct, depending on the view of the legal provisions.

T 1989/18

The referring Board used this case as the prime example of cases not requiring full adaptation of the description. The same point applies as for T 1024/18. In T 1989/18, the rationale is that "clarity is not affected if the description contains subject-matter which is not claimed".

This is consistent with **epi**'s view.

G 1/24

G 1/24 indicated that, when interpreting a claim, it is necessary to look at the description. However, this does not say anything about the effect of looking at the description. It is considered that the effect of looking at the description is the subject of the present referral.

Thus, **epi** is of the view that the decision in G 1/24 does not affect the conclusions reached above.

Guideline F-IV, 4.3

epi considers that the Guidelines should reflect the law as established by the EPC, the Rules and the jurisprudence of the Boards of Appeal. Some of the Guidelines have already been held to be incorrect.

epi is of the view that this provision in the Examination Guidelines is incorrect and will need to be amended following the Enlarged Board's decision. It should be amended to make it clear that the Applicant/Proprietor has the final responsibility for amendment of the description.

UPC decision of the Local Division in Hamburg

The referring Board referred to a decision by the Hamburg local division of the UPC where the Hamburg division was able to reach a final decision on the validity of the claims even though there were inconsistencies between the claims and the description. There is a similar decision from the Paris Local Division.

These decisions, *inter alia*, show that it is not necessary for the description to be consistent with the claims in order for a Court to be able to deal with a case.

Annex 2 - Practical Matters

Is it essential for examiners to ensure that the description is consistent with the claims and refuse applications unless the applicant amends the description? For the reasons given above, **epi** considers that the answer should be "**no**". The members of the deciding bodies should point out any possible inconsistencies which might affect the clarity of the claim or lead to an attack under Article 54, 56 or 83 EPC and invite the Applicant/Proprietor to make an amendment. If the Applicant/Proprietor does not make an amendment, they take on the risk that a **claim** has a broader scope than it had when read in isolation, in which case the **claim** may be refused under any one of Articles 54, 56 and 83 EPC. However, if there is no objection to a **claim**, then no requirement for amendment should be made.

The present practice puts too much work on the EPO. If the EPO has to ensure that the specification for grant is completely free of inconsistency, there will be a large amount of work done on this, especially where the Applicant disagrees with the examiner. This means that the quality of the examination proceedings goes down and the time to grant goes up. Additionally, **epi** believes that perfection cannot be approached, let alone reached, and that the lack of the EPO's responsibility for any oversights cannot make this the EPO's task.

The other side of this is that it is a large amount of work for Applicants, which means that the cost of obtaining a patent goes up. In the multilingual regime of European patents, this work includes (re-)translating the text at every amendment.

Another major consideration is the enormous risk involved for the Applicant and their representative, if amendments inadvertently lead to invalidity through added matter, or lead to an unintended restriction or extension of the extent of protection. There is no corresponding risk or responsibility on the EPO or its examiners and so the responsibility and discretion should remain entirely with the Applicant. Even if amendments are free of such problems, the mere existence of amendments generates a burden of examination on all parties throughout the life of the patent. Every amendment becomes the subject of scrutiny and costly debate, even if the outcome is that the amendment was correct and harmless. The number of amendments "required" should therefore be minimised as a matter of principle.

Amending the description is, in the vast majority of cases, pointless. Even where there may be inconsistency between the description and the claims, it is generally possible to deal with this during opposition, opposition-appeal and litigation. The deciding bodies in most cases have no difficulty in dealing with cases where there may be inconsistency between the description and the claims. One just has to look at the large number of appeal cases where the Appeal Board is able to come to a decision on a multitude of auxiliary requests without any amendment of the description. If the Board finds a set of claims which is allowable, they just remit it to the Opposition Division for amendment of the description. There are very few cases where there is any problem before the Opposition Division with amendment of the description. As the Hamburg case shows, and is certainly the case in many litigations, judges

can deal readily with cases where there may be inconsistency between the claims and the description.

There are very rare cases where a **claim** may be unclear due to unrelated disclosure in the description. This is routinely dealt with by the deciding instance taking the meaning of the claim which disadvantages the applicant or proprietor. This is a sensible and established way of proceeding.

Why, therefore, is there any general need for amendment?

If there is any need for amendment, is there any need to get to the situation which was present in the referring case? In that case, the Proprietor had provided an amended description allegedly matched to the auxiliary request which the Opposition Division and the Board found allowable. However, the Opponent argued that the amendments were not sufficient. The Proprietor therefore filed, during the appeal proceedings, a further amended description, but the Board decided that this was a change of case and therefore refused to admit the further amended description. If, as a result of this case, it is decided that an amended description is required to be filed every time a new set of claims is filed, the burden placed on the EPO and the Applicants/Proprietors will be huge. It will waste a large amount of examiner and Board member time if the examiners look to see whether the amended description matches the amended claims. It is more likely that the examiners and Board members will ignore the amended description until an allowable set of claims is found. Only at that stage will they look at the description. This will mean that Applicants and Proprietors will waste a large amount of time preparing amended descriptions which will clog up the EPO's electronic systems at great expense to no purpose. It therefore should be a general rule that, if amendment of the description is required, it should only be required once an allowable set of claims has been found by the Examining Division, the Opposition Division or the Appeal Board. For the Appeal Boards, remittal to the Examining Division or Opposition Division for adaptation of the description could be a requirement.

If, as would happen only in very rare cases compared to the number of applications prosecuted before the EPO, amendment of the description would be truly critical to the determination of the scope of the patent claims, these specific cases should be dealt with by the competent instances, such as the Opposition Divisions or the UPC, rather than imposing onerous work on all Applicants in all application procedures.