

Referral G 1/25 on description adaptation

Long awaited clarification or post-hoc rationalization?

Referral G 1/25 will finally have the Enlarged Board of Appeal address the diverging case law on whether or not an amendment of the description, typically prior to grant (to ensure that the specification matches the granted claims as closely as possible) should be necessary before the European Patent Office (EPO).



Background - why is this important?

A debate regarding the necessity and/or legal basis for the EPO's policy of requiring amendment of the description prior to grant to match the granted claims as closely as possible has been ongoing since the EPO's Guidelines for Examination («GL») were updated in 2021.

Prior to 2021, it was sufficient to add a boilerplate phrase, such as »the extent of the invention is defined in the claims« or »embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention«; however, since 2021 it has been necessary to either completely delete all embodiments falling outside of the scope of the claims or to explicitly state for each such embodiment that it falls outside the scope of the claims (GL F-IV 4.3). The EPO argues that these amendments are necessary to ensure legal certainty for third parties regarding the scope of protection. For example, if an application as filed states a certain feature to be »optional«, or »preferred«, and during prosecution this feature is introduced into the independent claim, then it would be necessary to amend the description to reflect that this feature is no longer optional, but mandatory. Likewise, if a broader range or long list of options is presented in the application as filed and the claims are amended to narrow the range or delete options from the list, then these amendments would have to be implemented in the description as well.

Whilst the EPO's efforts to improve legal certainty for third parties are commendable, it is not often so straightforward to safely amend the description as requested, especially in view of potential issues in post-grant proceedings, including infringement proceedings. This can be illustrated by considering a few selected decisions of the Technical Boards of Appeal in recent years.

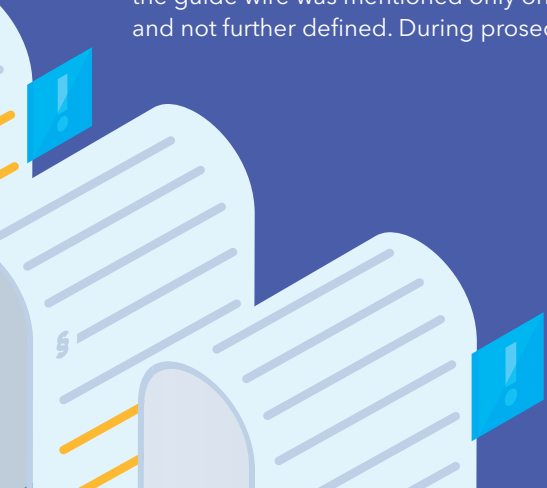
For example, in **T 450/20**, the claims as filed were directed to a stent for unblocking blood vessels. Claim 1 as granted required a device comprising inter alia a guide wire and a tapering mesh »*permanently attached*« to the wire. The feature of a tapering portion »*permanently attached*« to the guide wire was mentioned only once in the description and not further defined. During prosecution, prior art was

cited that disclosed an embodiment that the Examining Division deemed to include a guide wire and a tapering mesh attached to the wire. This prior art document specified that the wire could be detached if necessary. The application as filed stated that the attachment of the guide wire »*may be permanent or a releasable mechanism*«, i.e. that permanent and releasable were mutually exclusive alternatives. By limiting claim 1 to permanent attachment, the possibility of a releasable mechanism was excluded and an allowable claim was reached on this basis. The Applicant was then required to amend the description, and all reference to a »*releasable mechanism*« was deleted. During opposition/appeal proceedings, the Board held that the claims had to be interpreted in view of the description of the granted patent, **NOT the application as filed**. Given that permanent attachment was no longer presented as the (mutually exclusive) alternative to releasable attachment in the granted patent, the Board felt free to interpret the claims in what they saw as the broadest sensible manner, adopting their own definition of »permanent« that included the releasable attachment of the prior art embodiment, and revoked the patent for lacking novelty, despite the patent having been amended to specifically exclude this prior art embodiment during prosecution.

As can be seen from this example, it is very easy to inadvertently alter the meaning of the claims by amending the description. The recent decision by the Enlarged Board of Appeal in **G 1/24** that the description should **always** be consulted when considering claim interpretation has reinforced that pre-grant description amendments can be of considerable importance in post-grant proceedings.

Amendment of the description to adapt to the allowable claims not only risks opening up new novelty and inventive step attacks, as demonstrated above, but may even open up the possibility for adding subject matter, if the amendment(s) to the description would change the meaning of the claims (see discussion in **T 471/20** and **T 500/01**).

Furthermore, such explicit statements excluding certain subject matter can have a critical effect on determining the scope of protection of the patent in infringement proceedings, especially when applying the principle of infringement under the doctrine of equivalents. For example, UK patent law uses the so-called Actavis test, the third question of which reads »*Would [the person skilled in the art] have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?*«. Explicit statements in the specification excluding certain embodiments are very likely to be seen as indication that strict compliance with the literal meaning of the claims would be required.



A referral a long time in the making?

Whilst many in the patent profession have been unhappy about the level of risk posed to patentees/applicants in post-grant proceedings, including infringement proceedings, as a result of these strict requirements regarding amendment of the description, the critical question that has finally led to referral G 1/25 to the Enlarged Board of Appeal is a question of what the legal basis for this requirement to amend the description would be. Many technical boards have relied upon Article 84 EPC; however, other boards have rejected this as a suitable legal basis.

In **T 56/21**, which was discussed in the MAInsight article on this subject in Vol. 2¹, the Technical Board of Appeal detailed each of the potential legal bases in detail and rejected each in turn, as summarized below:

- Article 69 EPC** concerns the enforcement of a patent after grant and, hence, the extent of protection conferred by the claims is determined in view of allegedly infringing subject-matter (see margin no. 15, also G 1/98). Hence, Article 69 EPC and its Protocol are concerned with the extent of protection (»demarcation of what is protected«, see margin no. 14 of T 56/21) in the context of national (or UPC) proceedings of a European patent following such examination, and are not concerned with the assessment of patentability in examination before the EPO. Article 69 EPC and its Protocol are hence not applicable to examination proceedings before the EPO. Only when it comes to amendments after grant, under Article 123(3) EPC, the extent of protection before and after the amendment is assessed by the EPO (see e.g., margin nos. 32 and 90 of T 56/21).

- Article 84 EPC** pertains to the examination of subject matter intended for grant of a patent and, hence, the subject matter claimed delimited and characterized in view of the prior art relevant to the examination of patentability (see margin no. 15). Article 84 EPC and Rule 43 EPC are not a corollary of Article 69 EPC even though claims are the main determinant of the extent of protection. Consequently, the requirements of Article 84 EPC and Rule 43 EPC are to be assessed separately and independently of any considerations of extent of protection (under Article 69 EPC) when examining a patent application.

- Article 84 EPC and Rule 43 EPC** set forth requirements for the claims. They do not provide a legal basis for mandatory adaptation of the description to claims of more limited subject matter. Specifically, due to the fact that Article 84 EPC sets out requirements to be met by the claims and not by the description, Article 84 EPC on its own does not provide a legal basis for a mandatory adaptation of the description to the more limited subject-matter claimed (see margin no. 76). Within the limits of Article 123 EPC, an applicant may, however, amend the description on its own volition.

- Rule 48 EPC** is concerned with the publication of an application and the avoidance of expressions which are contrary to public morality or public order, or certain disparaging or irrelevant statements. Rule 48 EPC (in particular Rule 48(1)(c) EPC) does not provide a ground for refusal based on the inclusion of merely »irrelevant or unnecessary« matter in the description intended for grant and even less based on »discrepancies« between the subject-matter claimed and disclosed in the description.

¹ MAInsight Vol. 2, 2025, p.30-32

Whilst it cannot be denied that adapting the description is established practice at the EPO, there are many who see this requirement (in particular the strict requirements introduced in 2021) as a decision of the EPO to supersede the legislator by introducing their own requirements and attempting to find a (somewhat tenuous) legal basis therefor via post hoc rationalization. This was certainly the position of the Technical Board of Appeal in **T 56/21**.

Against this background, the possibility of a referral to the Enlarged Board of Appeal has been speculated for a number of years, with several technical boards making referrals that have been rejected as inadmissible by the Enlarged Board for reasons that are usually specific to the cases underpinning the individual referrals. Other technical boards (such as the Board responsible for **T 56/21**) have even concluded that a referral to the Enlarged Board would be unnecessary, since they deemed that it is unequivocal that there is **not** a suitable legal basis for the EPO's practice of requiring pre-grant amendments to the description.

Substance of the present referral

In the present referral, the opposed patent is EP 2 124 521. During first-instance opposition proceedings, the Opposition Division decided to maintain the patent in amended form (on the basis of claims submitted as Auxiliary Request 1E), wherein claim 1 was significantly limited relative to granted claim 1. Paragraphs 13, 16, and 20 of the description as granted were held by the Opponent to contradict the wording of claim 1 of Auxiliary Request 1E; however, the Division held that the contradiction was not significant enough to confuse the person skilled in the art and that these paragraphs were already in contradiction with the wording of claim 1 as granted, thus any lack of clarity under Article 84 EPC had not been introduced by limiting claim 1 as in Auxiliary Request 1E. Since clarity of the granted patent is not a ground for opposition and Rule 80 EPC states that amendments can only be made to address a ground for opposition, no amendment would be necessary or even admissible. This was a somewhat formalistic position that largely avoids discussion of the merits of the objection. In this regard, it is noted that although the Opposition Division is correct that only newly introduced clarity problems may be addressed, many opposition divisions take this opportunity to clean up the description whether or not the contradictions are newly introduced or not, perhaps reflecting the uncertainty regarding whether the objections against the description are Article 84 EPC objections or have another legal basis.

The Technical Board of Appeal in the referring decision (**T 697/22**) agreed with the Opponent that an additional lack of clarity had been introduced, irrespective of whether some degree of uncertainty already existed; however, given that this was the only matter prejudicing the maintenance of the patent (on the basis of Auxiliary Request 1E) and the case law is clearly diverging in this respect, a referral to the Enlarged Board of Appeal was justified.

The referring Board reviewed 115 relevant decisions and concluded that there are two lines of clearly diverging case law (see Reasons 12 and 13). The first line of case law affirms that the description must be adapted. However, the Board of Appeal noted that there is no consensus on the legal basis for this requirement. Some decisions have relied on Article 84 EPC alone (**T 1024/18**), whilst others cite Article 84 EPC in combination with other provisions (**T 438/22**). By contrast, the second (more recent) line of case law argues there is no legal basis whatsoever in the EPC for this requirement. This view holds that the support requirement of Article 84 EPC does not preclude the description from containing unclaimed subject-matter and that forcing adaptation is a policy choice for the legislator, not the EPO (**T 56/21**, as discussed above).

The following questions were referred to the Enlarged Board of Appeal, which has accepted the referral and will thus address this issue:

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- 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?

Outlook and discussion

It is a positive development that the significant divergence in practice before the technical boards will be addressed by **G 1/25**, hopefully the Enlarged Board of Appeal will provide answers as specific as in **G 1/24**, and in particular avoid a vague answer.

Furthermore, given how well-established the practice of description amendments is at the EPO, it is doubtful that the Enlarged Board will overturn this practice entirely, although a return to the pre-2021 practice is one possible outcome.

For the time being, the EPO has announced that there will be no change in their practice whilst **G 1/25** is pending, and no automatic stays will be implemented.² Until **G 1/25** is resolved, patentees and applicants should continue to adapt the description whilst aiming to minimize the potential for issues such as those highlighted above. In other words, **making the minimum number of amendments possible to appease the Examining Division remains the safest option without taking the case to appeal.** That said, if the Examiner has proposed potentially problematic description amendments in the text-intended-to-grant with the Rule 71(3) EPC Communication, then it remains important to push back against any amendment that could potentially cause issues post-grant. While it is always possible to request a stay of proceedings on the basis of the pending referral **G 1/25**, it is far from clear whether the EPO would grant a stay of proceedings or not in view of its announcement.

Interestingly, the EPO's (current) requirement to adapt the description is not a requirement that is, according to the author's knowledge, common to the practice of the majority of patent offices around the world. These other patent offices generally agree that the person skilled in the art would understand that the description describes the invention as reflected in the claims as filed, whilst the granted claims may represent a narrower version of this initially claimed invention. Similarly, they generally hold that it can be easily determined whether an inconsistency derives from a later claim limitation, e.g., by checking what amendments may have been made during prosecution. That said, many EPC contracting states do not rely on so-called file-wrapper estoppel as strongly as, for example, the US patent system, with many EPC contracting states (e.g., Germany and the UK) having court decisions either prohibiting or extremely limiting the relevance of prosecution history in post-grant proceedings.



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² <https://www.epo.org/en/news-events/news/referral-g125-adaptation-description>