



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

16 April 2026

Dear Sirs,

Reference is made to the Communication issued by the Enlarged Board on 11 March 2026 in connection with the above-mentioned referral.

These third-party submissions are made on behalf of the Institute of Professional Representatives before the EPO (“**epi**”). They complement the *amicus* brief already filed by **epi** on 29 January 2026.

Question 1

In discussing Question 1, the Enlarged Board has referred in its Communication of 11 March 2026 to two types of inconsistency. The first type is an inconsistency which does not cause a non-compliance with the EPC and the second type is an inconsistency which causes a non-compliance with the EPC. This view appears to be consistent with the arguments set forth in the *amicus* brief filed by **epi** on 29 January 2026 and is therefore in our view a sensible conclusion. However, **epi** suggests that this conclusion could benefit from a more detailed elaboration.

The first point which **epi** suggests that the Enlarged Board should make is that it follows from this, in line with the opinion expressed in the Enlarged Board’s Communication, that there is no need to require any amendment (of the description and/or of the claims) in respect of the inconsistency of the first type. This type of inconsistency can remain in the description without affecting the validity of the claims and so there should be no requirement for any amendment. Consequently, there is no requirement anywhere in the EPC “requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC” (quoted from page 41, first quoted paragraph of the referring decision).

The second point the Enlarged Board should consider is how it is to be determined whether there is an inconsistency of the first type or the second type. It is well accepted, in particular in the case law of the Boards of Appeal, that a patent application or granted patent is directed to the **skilled person** and that the skilled person has a mind willing to understand (see e.g. T190/99). The skilled person

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

does not carry out extensive verbal analysis of the disclosure in an application or patent but rather looks to understand its teaching. Such extensive verbal analysis is usually carried out by attorneys and lawyers in an attempt to persuade a deciding body to refuse an application or to have a patent revoked. Usually, deciding bodies are very astute in recognising that arguments based on such extensive verbal analysis would not be supported by a skilled person and therefore dismiss the arguments. It is therefore suggested that the Enlarged Board should support the case law set forth in T190/99 and indicate that there is only an inconsistency of the second type if that inconsistency would lead a **skilled person** to consider that there was non-compliance with the EPC.

It should also be borne in mind that the number of cases in which there is an inconsistency of the second type is rather very low. In the vast majority of cases, the description and the claims are each clear and the skilled person has no difficulty in understanding the scope of the claims, in some cases despite what is said in the description. Even in these cases, deciding bodies are perfectly able to determine the scope of the claims and provide well-reasoned decisions.

It is of utmost importance that the Enlarged Board provides guidance on how to determine whether or not there is an inconsistency of the second type.

Question 2

The Enlarged Board has indicated that, in its preliminary answer to Question 2, it is likely to follow the first line of case law referred to in the referring decision. **epi** considers that this is **not** the correct line to follow. In particular, **epi** considers that the first line of case law is **not** consistent with the legislative intent of the drafters of the EPC. On pages 41 and 42 of the referring decision, there are quotations such as “Article 84 EPC ... has been interpreted as requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC” and “the requirement in Article 84 EPC of the claims to be supported by the description includes the requirement that the description is consistent with the claims not only in some part but throughout”. However, as pointed out in the *amicus* brief filed by **epi**, the *Travaux Préparatoires* (attached as Annex I) show that the original version of what is now Article 84 EPC included the wording “fully supported”. If this were the present wording of Article 84 EPC, then there might be some justification for the quotations given above. However, during the development of what is now Article 84 EPC, the legislator of the EPC decided that the word “fully” should be deleted as the requirement for full support was “too onerous” (*sic!*). It is therefore clear that Article 84 EPC does **not** require the entirety of the description to be necessarily fully consistent with the claims, and does **not** require that the description is supported (much less fully supported) by the claims.

In this respect, following the first line of case law seems to be inconsistent with the Enlarged Board’s opinion on the answer to Question 1. If there are inconsistencies between the description and the claims which do not cause a non-compliance with the EPC, the claims are still supported by the description and so there is no requirement for the inconsistency of the first type to be the subject of amendment.

The Enlarged Board has indicated that it considers that the second line of case law, mainly based on T56/21, should not be followed because, in the view of the Enlarged Board, T56/21 is not consistent with G1/24. However, the Enlarged Board has not explained why it considers that this is the case. Indeed, **epi** cannot see any such inconsistency. G1/24 indicates that it is necessary to read the description as well as the claims in deciding on whether a claim is compliant with the EPC. T56/21 also requires the description to be read together with the claims. Thus, fully contrary to the Enlarged Board's preliminary opinion, T56/21 actually **is consistent** with G1/24.

T56/21 relates to a case in which the description contained a number of claim-like clauses. The Examining Division had found a set of claims allowable and had requested the applicant to delete the claim-like clauses. The Examining Division considered that the presence of the claim-like clauses meant that the requirements of Article 84 EPC were not met. When the applicant refused to delete them, the Examining Division refused the application. The Board in that case overturned the decision of the Examining Division, holding that Article 84 EPC did not require the deletion of material from the description which might be inconsistent with the allowable claims.

We would like to draw the Enlarged Board's attention to the fact that the references by the Technical Board on T56/21 to the use of the description for "interpreting" the claims are present in a section regarding whether the deciding bodies of the EPO are required to determine the "scope of the claims" or the "scope of protection". The Board decided that the deciding bodies of the EPO only needed to determine the scope of the claims and that determining the scope of protection was reserved for judicial instances deciding on infringement. However, there is nothing in the decision which indicates that the description must not be used to determine the scope of the claims. Thus, T56/21 can be regarded according to our view as being fully consistent with G1/24.

The rest of the decision includes a cogent argument as to why Article 84 EPC does **not** require adaptation of the description to the extent apparently required by the first line of case law. This argument is found in Section D of the Decision which refers to the *Travaux Préparatoires* and many decisions of other Boards and shows that the claims are "supported" by the description as long as the subject matter of the claims is derivable from the disclosure in the original application, whether or not the application also contains subject matter which is not covered by the claims. **epi** considers this interpretation being sound and proposes the Enlarged Board to follow this cogent reasoning.

Such position is consistent with Article 84 EPC as developed during the drafting of the EPC (see the *Travaux Préparatoires*) because it indicates that Article 84 EPC does **not** require that everything in the description needs to be consistent with the claims. As the Enlarged Board itself has said in connection with Question 1, there can be inconsistencies which do not lead to non-compliance with the EPC and so these do not need to be deleted.

The Enlarged Board also indicates to disregard the line of argumentation in T56/21 on the ground that it addresses matters of policy. If that is a reason for dismissing the relevance of that decision, it would also be a reason for dismissing most of the decisions in the first line of case law as they also relate to matters of policy. **epi** considers that it is the general task of the Enlarged Board, and therefore also in the present case, to take into consideration matters of policy: the present EPO

practice in examination and opposition is often in our view wasteful of examiner time, expensive for applicants and reduces the overall quality of processing before the EPO without having any appreciable benefit. As shown in the case law cited in **epi's amicus brief**, courts are perfectly capable of dealing with patents where there is subject matter in the description which is inconsistent with the claims. The Enlarged Board should therefore consider whether such an onerous policy can be enforced on the basis of a reading of Article 84 EPC contrary to the express reasoning of the *Travaux Préparatoire* (which is a very relevant source of interpretation of the EPC according to many previous Enlarged Board decisions, as it often indicates the intention of the legislator).

In other *amicus* briefs, there seems to be a discussion regarding legal certainty compared to reasonable prosecution. The purpose of the EPC is, as set forth in Article 1 EPC, to set up "A system of law ... for the grant of patents for invention ...". There is no mention here, or in any other part of the EPC, setting up a requirement for absolute legal certainty. **epi** considers that absolute legal certainty is impossible to achieve. A patent as granted may appear to be fully compliant with the EPC at the time of grant but, as the Enlarged Board knows very well, that appearance can be shattered by the activities of a potential infringer, the presentation of new evidence regarding prior art cited against the claims, by the discovery of new prior art, a change of the legal framework, or simply by parties raising more or less applicable arguments in their own favour. Thus, in the view of **epi**, the search for absolute legal certainty should not be made a requirement relating to amendment of the description. It is certainly not present in Article 84 EPC and so the Enlarged Board should indicate that this policy issue should not be used as the basis for adopting an interpretation of Article 84 EPC for which there is no basis. Rather, the aim should be a reasonable degree of certainty for third parties and a fair protection for the applicant/proprietor, as is said in Article 1 of the Protocol on the Interpretation of Article 69 EPC.

Regarding "reasonable prosecution", the whole purpose of the system as set out in Article 1 EPC would be frustrated if a requirement for absolute legal certainty were newly-established, as this would result in the costs of obtaining the grant of patents or defending patents becoming so large that the EPO could not be sustained and applicants would choose to not use the EPO because of the unjustified cost incurred by the newly-established requirement for absolute legal certainty. A broad requirement for the description to be amended increases the burden on Examining Divisions, Opposition Divisions and Boards of Appeal, with increasing costs for the EPO and parties appearing before the EPO. Especially at the examination stage, this can lead to significant delays to grant and a significant burden on the examiners. It also significantly adds costs for the applicants. In particular, if there were a requirement for applicants and patent proprietors to provide an amended description with every set of claims which is filed, the costs escalate enormously to no benefit for either the EPO, the applicant or third parties. **epi** would again point out that Opposition Divisions and Boards of Appeal are perfectly able to make decisions regarding many sets of claims without requiring an amended description for each set of claims. There seems to be nothing within the EPC requiring mandatory amendment to the description. It is finally the applicant's/patentee's responsibility to bear any consequences, e.g. in later enforcement or revocation actions, from not adapting the description during proceedings before the EPO.



epi therefore considers that the second line of case law should be followed.

Question 3

epi agrees with the Enlarged Board as expressed in the preliminary opinion that the answers to Questions 1 and 2 should apply to applications as well as patents, as noted above.

Yours sincerely

A handwritten signature in blue ink, appearing to read 'Peter R. Thomsen'.

Peter R. Thomsen

President of **epi**

Annex I - Travaux Préparatoires Article 84 EPC