

European Patent Office
Registry of the Enlarged Board of Appeal
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**AIPLA Response to the Enlarged Board of Appeal Preliminary Opinion
Re case G 1/25 (Adaptation of the Description)**

I. Introduction

The Enlarged Board of Appeal's preliminary opinion of 11 March 2026 sets out an analytical framework that AIPLA respectfully submits is consistent with the position advanced in its amicus brief of 28 January 2026. This response is filed pursuant to the deadline of 17 April 2026 to complete AIPLA's position along the lines the preliminary opinion has indicated.

AIPLA writes as the representative of a community with a stake in this outcome. US applicants account for approximately one quarter of all European filings, and for those applicants a practice that forces deletion of embodiments at the EPO does not remain isolated in the European register: it propagates into national courts and the UPC, permanently removing material relevant to equivalents analysis without a provision of the Convention directing that result.

When the provisions where the description and the claims are at the center of the analysis are read on their face — Articles 52 to 56, Article 83, Article 84, and Article 123(2) — none of those contemplates adaptation of the description as a remedy. The choice of governing provision does not change the outcome. It reveals, rather, that the mandatory adaptation practice has no textual home in the Convention regardless of where one looks for it.

AIPLA respectfully invites the Enlarged Board to follow that framework's own logic to the conclusion it points toward.

II. The Preliminary Opinion's Own Framework Points to a Single Logical Consequence

The preliminary opinion's two-category distinction contains, within its own terms, the answer to the question it leaves open. Once it is accepted that First Type inconsistencies are real inconsistencies that require nothing, the operative standard cannot be inconsistency itself — it must be the violation of a specific EPC provision that the inconsistency triggers. The two subsections below establish that premise and identify its consequence.

A. First Type Inconsistencies Confirm That Inconsistency Per Se Is Not the Operative Standard

The preliminary opinion distinguishes First Type inconsistencies (no EPC non-compliance, no adaptation required) from Second Type inconsistencies (EPC non-compliance, adaptation potentially required). The logical consequence is that the inconsistency itself is not the non-compliance. It is a factual precondition that may trigger a non-compliance located elsewhere, in some specific EPC provision being violated independently. First Type inconsistencies confirm this: they are real inconsistencies, yet the opinion holds they require nothing. Inconsistency per se is not the operative standard.

B. For Second Type Inconsistencies, a Specific EPC Provision Must Be Identified

On Question 2, the preliminary opinion states that the relevant provisions are "those Articles and Rules of the EPC that are not being complied with."

T 0697/22 identified five distinct subordinate lines of legal basis that different decisions have invoked — each a separate attempt to locate a textual anchor. If the answer were apparent from the Convention, the case law should have converged on it. The proliferation of incompatible rationales in the pro-adaptation case law is itself clear indication that no consistent answer can be found in the EPC.

III. None of the Relevant EPC Provisions Requires Adaptation of the Description

The group of provisions where the description and the claims are at the center of the analysis — Articles 52 to 56, Article 83, Article 84, and Article 123(2) — has been the subject of extensive case law. When their text is read on its face, none of these provisions says anything about adapting the description to match amended claims.

Each candidate provision operates through a specific examination standard. Where the standard is not satisfied, an objection is raised and the applicant responds. That is the complete picture each provision presents. None of them adds modification of the description as either a precondition for compliance or a remedy for non-compliance.

Articles 52 to 56 address patentability and say nothing about the description beyond the extent to which its content bears on novelty and inventive step. Article 83 requires that the invention be disclosed in a manner sufficiently clear and complete for it to be carried out — a requirement addressed to enablement, not to consistency between claims and description. Article 84 requires that the claims be supported by the description, in that direction and no other; where an

inconsistency renders the claims unclear, Article 84 is directed at the claims and it is the claims that must be brought into compliance. Article 123(2) prohibits amendments extending beyond the content of the application as filed — a constraint on what may be added, not generally a mandate to remove; mandatory adaptation does not cure an Article 123(2) concern but generates one, since describing adapted-out embodiments as 'not part of the claimed invention' introduces matter with no basis in the application as filed, and features deleted and later reintroduced via claim amendment risk extending protection under Article 123(3).

IV. When Performing the Analysis Under the Relevant EPC Provisions, Apparent Inconsistencies Are Resolved in the Reading Process, as G 1/24 Has Confirmed

The analysis in Section III establishes that none of the relevant provisions requires adaptation of the description. A question follows naturally: if a division or board encounters an apparent inconsistency between the claims and the description while performing the analysis those provisions require, what does the EPC provide for addressing it? The answer is already in the case law, and G 1/24 has now confirmed its legal basis.

A. G 1/24 Identified the Principles to be Applied to Claim Interpretation

G 1/24 confirmed that the interpretive principles of Article 69 — applied not to determine the scope of protection, which is a matter for courts after grant, but as the methodology for reading claims in context during prosecution and opposition — provide the legal foundation for how the EPO approaches claim interpretation.

Namely, the skilled person reads the claims in light of the description and drawings, with a mind willing to understand, building up rather than tearing down, and arriving at a technically sensible interpretation of the whole disclosure. This standard, confirmed across more than two decades of decisions since T 190/99 (see also Case Law of the Boards of Appeal, II.A. 6.1), is what a division or board exercises — not departs from — when it applies it to a description-claim inconsistency. It is equally the instrument through which clarity under Article 84 is assessed when claims and description diverge.

B. Under That Methodology, Apparent Inconsistencies Are Resolved in the Reading Process and Generate No Further Obligation to Amend the Document

Under the interpretive methodology G 1/24 confirms, an apparent inconsistency between amended claims and a broader description is addressed in the reading process itself. The skilled person consulting the description to interpret the claims does not encounter an irreconcilable contradiction — they arrive at a technically sensible understanding of what the claims cover. The inconsistency does not survive the reading. It does not generate a residual obligation to modify the document so that a future reading produces the same result more conveniently.

The decisions that invoked Article 69 directly to compel adaptation were reaching for the same provision but at the wrong level and for the wrong purpose. They used it as a source of procedural obligation — on the theory that a description broader than the claims makes scope of protection indeterminate — rather than as the interpretive methodology G 1/24 has confirmed it supplies.

The result was both textually incorrect, since Article 69 addresses scope of protection rather than examination standards, and unnecessary, since the methodology Article 69 principles provide already resolves the inconsistency without requiring the document to be changed. Those decisions fall away on both grounds, and they do so on the authority of G 1/24 itself. A description progressively adapted to track successive claim versions cannot serve as the stable anchor that methodology presupposes.

C. T 56/21's Textual Conclusion Appears Consistent With G 1/24

The preliminary opinion states that many of the conclusions of T 56/21 are inconsistent with G 1/24. AIPLA respectfully notes that T 56/21's central analysis — that Article 84 does not supply a legal basis for requiring adaptation of the description — addresses a question G 1/24 did not address. G 1/24 Reasons 8, which characterizes Article 84 as directed at the claims, appears to support rather than contradict T 56/21's reading on that specific point.

The post-G 1/24 divergence adds a further dimension. Two incompatible interpretive lines have emerged within months of the decision — the holistic approach of T 439/22 and the claims-primary approach of T 2027/23 and its line. Mandatory adaptation would not resolve that divergence; it would determine which version of the description future boards consult, while leaving the underlying interpretive question unanswered.

V. The Principles AIPLA Invites the Enlarged Board to Articulate

AIPLA respectfully submits that the most useful outcome of G 1/25 would be a decision articulating the following principles with sufficient precision to be applied consistently by examining divisions, boards of appeal, national courts, and the UPC alike. Each principle follows from the analysis above. Taken together, they provide the settled answer that the system — applicants, proprietors, the EPO, and the courts downstream of it — has not yet had.

First: An inconsistency between the claims and the description does not constitute non-compliance with any provision of the EPC unless it renders the scope of the claims unclear to the willing, skilled reader applying the standard confirmed in T 190/99 and its progeny. The mere presence of unclaimed embodiments, broader disclosure, or prior-art passages does not, of itself, constitute such non-compliance.

Second: Assessment of whether an inconsistency rises to the level of non-compliance must be conducted from the standpoint of the skilled person seeking to understand, not a person seeking grounds on which to object. This is the synthetic propensity the willing reader standard requires, and the posture G 1/24's interpretive framework presupposes.

Third: Where an inconsistency of the Second Type is established on the willing-reader standard, the appropriate remedy is generally amendment of the claims, not of the description, save where the description requires supplementation to support them.

Fourth: Article 69 EPC has no role in examination or opposition proceedings as a source of procedural obligation. Its interpretive principles, as confirmed by G 1/24, operate as the

methodology for reading claims in context. Decisions that invoked Article 69 as a direct basis for mandatory description adaptation cannot be relied upon following G 1/24.

VI. Proposed Answers to the Referred Questions

Question 1

Where an amendment to the claims introduces an inconsistency between the amended claims and the description, adaptation of the description is not necessary unless the inconsistency renders the claims unclear to the willing, skilled reader in a manner that constitutes non-compliance with a specific provision of the EPC. The mere presence of unclaimed subject-matter in the description does not constitute such non-compliance.

Where an inconsistency does rise to that level, it must be addressed during examination under the specific provision it implicates and through the remedy that provision supplies.

Question 2

No Article or Rule of the EPC independently requires adaptation of the description. Each provision that could plausibly be engaged — Articles 52 to 56, Article 83, Article 84, and Article 123(2) — already provides for examination through its own standard, and none of those standards prescribes description adaptation as a remedy. Article 69 has no institutional role at the EPO stage as a source of procedural obligation.

Question 3

There is no principled basis for treating examination and opposition proceedings differently in this context. The answer to Questions 1 and 2 is the same in both settings. AIPLA agrees with the Enlarged Board that the answer to Question 3 is "No," though for the reasons set out above rather than by reference to any mandatory adaptation obligation.

Respectfully submitted,

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