

European Patent Office
Registry of the Enlarged Board of Appeal
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AIPLA Amicus Curiae Brief

Re case G 1/25 (Adaptation of the Description)

in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal

In case G 1/25, arising from appeal proceedings in T 697/22, the Enlarged Board of Appeal of the European Patent Office has invited third parties to submit written statements pursuant to Article 10 of the Rules of Procedure of the Enlarged Board of Appeal (Official Journal EPO 2025, A59).

The American Intellectual Property Law Association (AIPLA) welcomes this opportunity and respectfully presents its observations on the questions referred. AIPLA represents a membership of approximately 6500 professionals - practitioners in private and corporate practice, government service, and academia - who are engaged both as applicants and as advisors to applicants and challengers within the international patent system. The Association's members work extensively with the European patent framework and share a strong interest in the clarity, consistency, and balance of its procedures.

I. Interest of AIPLA

The American Intellectual Property Law Association (AIPLA) is a national bar association including private practitioners, in-house counsel, government attorneys, academics, and judges. Its membership represents both creators and users of intellectual property—ranging from individual inventors and small businesses to multinational enterprises across fields such as biotechnology, electronics, software, and manufacturing.

AIPLA's mission is to promote innovation, creativity, and fair competition by supporting intellectual-property systems that are clear, balanced, and efficient. The Association regularly engages with patent offices and courts throughout the world, including the European Patent Office, to provide a practical user perspective. U.S. applicants constitute roughly one-quarter of all European patent filings, and AIPLA's members work daily with the European system both as applicants and as representatives of third parties assessing others' rights.

AIPLA previously participated as amicus curiae in G 1/24, where the Enlarged Board provided guidance on claim interpretation under Articles 84 and 69 EPC. The present referral, G 1/25 (Adaptation of the Description), concerns the text of the patent itself, and AIPLA submits their observations in a spirit of constructive engagement.

II. Answers to Referred Questions

Question 1 If the claims of a European patent are amended in opposition 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 EPC, to adapt the description so as to remove the inconsistency?

AIPLA respectfully suggests answering Question 1 with: “No”.

The EPC provides no statutory basis for this requirement. Nothing in its text imposes a general obligation or grants an express authority to compel adaptation of the description once the claims have been found allowable. Article 84 EPC ensures that the claims are supported by the description, and Rules 42 and 48 EPC specify how that description is to be presented.

The practice of “adaptation of the description,” rather seems to be an administrative construct, developed originally as a housekeeping measure to reconcile text. It was historically justified (for

example) on the loose premise that “*the relationship between the description and the claims is important, because, inter alia, the description shall be used to interpret the claims (Article 69(1) EPC) and because the claims shall be supported by the description (Article 84 EPC).*” [T11/82] (emphasis added). In practice, however, the “adaptation of the description” requirement has drifted from a perceived administrative formality (at one time often requiring merely the change of any statement of the invention in the description) into a substantive hurdle that frequently conflicts with the EPC itself. The administrative formality has hardened into a rigid practice whose requirements go beyond what can be seen as being supported in the EPC. The accumulated reasoning of the Boards of Appeal, reflected most comprehensively in decision T 56/21, shows that neither Article 84 EPC nor its implementing Rules provide a legal basis for a mandatory requirement to delete or adapt subject matter that was part of the original disclosure.

Excessive alterations of the description are indeed a minefield for inadvertently adding subject matter. Requiring such alterations creates an unnecessary burden on the applicant to verify each and every consequence they may have on the claim scope to avoid the risk of potentially adding matter, which – in the worst – case may maneuver them into an inescapable trap. And in some cases, it may practically be impossible to meet this burden, unduly disfavoring applicants and putting their investments in innovation at stake. Furthermore, alterations of the description encroach upon the judicial function mandated by Article 69 EPC and its Protocol, depriving national courts of the full technical context necessary to determine the extent of protection. This particularly applies in view of the case law established by the UPC and national courts of many member states of the EPC that the description must always be considered when interpreting the claims (see for example, Unified Patent Court in *Nanostring v 10x Genomics*, UPC CoA 335/2023, 26 February 2024).

In more detail, the most notable legal consequence of adaptations of the description is the conflict it creates with Article 123(2) EPC. Article 123(2) EPC prohibits amendments that extend beyond the content of the *application as filed*. The description as filed provides the essential definition and technical context of the invention. Compelling the deletion of specific embodiments or technical passages—merely because they are deemed “inconsistent” with the final claims—forces the applicant to manipulate the original disclosure and so change the basis of interpretation of the claims. Such deletions are rarely neutral. Removing specific embodiments or technical definitions can inadvertently alter the teaching of the remaining text, resulting in the singling out of specific

combinations, or creating an "intermediate generalization" that was not originally disclosed in the *application as filed*. This may create an inescapable trap for the patentee, if an adaptation of the description forced by an administrative requirement for "consistency" is later found to violate Article 123(2) EPC; yet, attempting to re-instate the original text post-grant to cure the defect would violate Article 123(3) EPC by extending the protection conferred. The "consistency" achieved by adaptation may therefore lead to the invalidity of the "consistent" patent.

Additionally, the requirement for continuous adaptation creates a shifting interpretive reference that undermines the legal certainty required by G 1/24 which mandates use of the description to interpret the claims. If the description must be adapted at every procedural stage—from Examination to Opposition to Appeal—the interpretive context mandated by G 1/24 mutates over time. A claim interpreted against a description containing 'Embodiments A+B+C' may have a different scope than the same claim interpreted against a redacted description containing only 'Embodiment A'. This risk extends also to the prior art section of the description: modifying or adding prior art statements may inadvertently alter the context in which the invention is understood, potentially affecting how the claims are interpreted. To ensure that the function of the description affirmed in G 1/24 remains stable, it should function as a fixed historical record, without adaptations to amended claim which may bear unforeseeable consequences.

Further, if adaptation of the description post-grant affects the interpretation of the claims, that too could violate Article 123(3) EPC if that extends the scope of protection.

In short adaptation of the description presents a range of traps that could irretrievably damage the patent which unduly disfavors innovators and puts their innovations at stake. The EPO should not enforce a practice under Article 84 EPC that sets up such traps without any clear basis in the EPC.

Also, adaptation of the description is unnecessary, since the downstream institutions (be it of the EPO itself or downstream courts) in any case need to interpret the claims taking into account the description and are well equipped to assess the correct extent of protection accordingly based on Article 69 EP and the Protocol on its Interpretation.

Instead, the requirement for strict adaptation further undermines the function of Article 69 EPC and the Protocol on its Interpretation. Article 69 EPC charges the courts—not the Examining Division—with the task of determining the extent of protection by interpreting the claims in light of the description and drawings. The Protocol on the Interpretation of Article 69 EPC mandates a

delicate balance: the claims must be interpreted to combine fair protection for the patentee with a reasonable degree of legal certainty for third parties. To perform this function, courts require the full technical context of the patent specification to understand the terms used in the claims. By preemptively excising technical context to achieve textual symmetry, the Office deprives national courts of the "interpretive reference" necessary to interpret the claims. Deleting "inconsistent" embodiments effectively treats the description as a contractual definition that must be identical to the claims, rather than as an explanatory aid. This preempts the judicial assessment of equivalents and scope, substituting an administrative formality for the substantive claim interpretation envisioned by the Protocol.

As confirmed by the Enlarged Board itself in G 1/24, the description "shall always be consulted" to interpret the claims—a principle reinforced by the Unified Patent Court in *Nanostring v 10x Genomics* (UPC CoA 335/2023, 26 February 2024), which held that the description "must always be used as explanatory aid," a function that is severely compromised if the text is aggressively pruned during examination.

These consequences concern both principal groups of users—applicants and third parties—whose interests AIPLA collectively represents. In addition to validity risks, the effects of the adaptation requirement extend to claim interpretation. Applicants may find that compelled deletions or re-labelling of examples introduced for reasons of consistency later influence national interpretation of their patents. If descriptive matter is deleted to satisfy procedural expectations, those deletions may later be read as disclaimers, effectively creating a prosecution history estoppel that was never intended by the EPC. European judicial practice already offers a clear approach that functions without compulsory adaptation.

Consequently, in the absence of explicit legal provisions supporting the extent and boundaries of this administrative procedure, the applicant should not be forced—nor practically compelled—to alter the text of the description. Preserving the integrity of the original disclosure is paramount because the description serves as the fundamental reference point for both the Office and the Courts in their duty to fairly administer the EPC to all involved parties, comprising both applicants and third parties. A mandatory modification of this reference point disrupts the balance of the EPC by placing administrative consistency above substantive validity.

We therefore recommend answering **'No' to Question 1**, restoring the description to its proper role as an interpretive aid, reducing the burden and risk on the applicant or proprietor, and thereby

contributing to securing a patent system that is fair, legally robust, and fully aligned with the judicial reality of the Unified Patent Court.

Question 2 If Question 1 is answered in the affirmative, which provisions of the EPC necessitate such adaptation?

This question does not need to be answered, if Question 1 is not answered in the affirmative.

Nevertheless, AIPLA respectfully suggests answering Question 2 with: “None”.

AIPLA understands that the current debate arises from differing readings of Articles 84 and 69 EPC and their implementing rules. However, there is no provision in the EPC that authorizes the refusal of a patent application solely on the grounds that the description contains subject matter not covered by the claims.

Article 84 EPC is a requirement for the claims, not the description. Similarly, Rule 48 EPC concerns prohibited matter such as morality and public order rather than technical inconsistencies. Furthermore, Article 69 EPC governs the extent of protection for infringement proceedings and cannot be repurposed as a pre-grant examination requirement that mandates adaptation of the description.

Question 3 Would the answer differ between examination and opposition proceedings?

AIPLA respectfully suggests answering Question 3 with: “No”.

The principles of legal certainty, procedural fairness, and statutory interpretation apply equally in examination and opposition proceedings. Whether in examination or opposition, the burden of extensive, line-by-line adaptation of the description adds significant cost and delay without adding value to the assessment of substantive patentability. Furthermore, the inescapable trap of Article 123(2) and 123(3) EPC is particularly acute in opposition proceedings. If a patent proprietor is forced to adapt the description to maintain a patent in amended form, and that adaptation is later found to add matter, the patent must be revoked.

III. Perspective on the Importance and Impact of this Referral

AIPLA submits these observations with respect for the European Patent Office and for the Enlarged Board's essential role in ensuring coherence and predictability in European patent law. Clarifying the scope and purpose of the adaptation requirement offers an opportunity to reinforce that. A decision confirming that the description need not be mechanically adapted to the claims would prioritize substantive validity over formal consistency.

AIPLA respectfully invites the Enlarged Board to consider that validity is paramount; the practice of adaptation risks creating invalid patents under Article 123(2) EPC.

Furthermore, as noted in our previous submission to the Enlarged Board, legal certainty is key for pre- and post-grant proceedings before the EPO and the Courts. In G 1/24, this Board affirmed that the description serves as the interpretive reference for claim interpretation. However, true legal certainty requires a stable foundation. If this "interpretive reference" is forced to mutate at every stage of the proceedings—from Examination to Opposition to Appeal—to match the changing claims, the scope of the patent becomes a moving target. A "shifting interpretive reference" serves no one: it may confuse third parties, deprive the judiciary of their role in claim interpretation, and may trap applicants in a cycle of administrative requirements that put their innovations at stake.

A single, consistent patent text, identical at examination, grant, and enforcement, would strengthen confidence in the European patent as a reliable legal instrument for applicants and third parties alike.

A single, consistent patent text functioning as a fixed historical record would enable applicants to understand clearly what has been examined and granted and allow third parties to assess the limits of protection with greater certainty. This approach would also simplify EPO procedure by reducing the need for extensive post-allowance correspondence on purely editorial matters. Further, when foreign counterpart applications—such as those before the USPTO—are examined alongside a European patent application, a stable and unaltered description provides a common interpretive foundation. This uniformity allows applicants to demonstrate precisely what was disclosed and examined across all jurisdictions, reducing the risk that the scope or meaning of the claims will be interpreted differently by various patent offices or courts.

The questions in front of the Enlarged Board provide the opportunity to affirm the quality and consistency of the European System and signal a decisive commitment to substance over form. A decision confirming the importance of the description as a reference point for claim interpretation, without requiring the deletion of inconsistent matter, will align EPO practice with the pragmatic, context-based approach applied by national courts and by the Unified Patent Court, fostering a system where legal certainty springs from the integrity of the original disclosure

AIPLA respectfully invites the Enlarged Board to consider these observations when weighing the broader implications of this referral. By clarifying that the description serves as a permanent repository of technical context rather than a target for formalistic policing, the Enlarged Board has the opportunity to simplify the European patent and enhance its role as a predictable legal instrument. A decision rejecting mandatory adaptation will do more than resolve a procedural conflict; it will harmonize the EPO's administrative practice with the judicial reality of the Unified Patent Court, ensuring that the patent granted is the patent enforced. It will signal a commitment to substance over form, fostering a system where legal certainty springs from the integrity of the original disclosure creating a robust, future-proof foundation for innovation across Europe.

Respectfully submitted,

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President

American Intellectual Property Law Association