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**Datasheet for the interlocutory decision
of 29 July 2025**

Case Number: T 0697/22 - 3.3.02

Application Number: 07704142.4

Publication Number: 2124521

IPC: A01G24/00, A01G24/18

Language of the proceedings: EN

Title of invention:
HYDROPONICS GROWING MEDIUM

Patent Proprietor:
Knauf Insulation

Opponent:
ROCKWOOL INTERNATIONAL A/S

Headword:

Relevant legal provisions:
EPC Art. 54(2), 54(3), 56, 83, 84, 112(1)(a), 123(2)
EPC R. 42, 43, 48, 71(1)
RPBA 2020 Art. 12(2), 13(1), 13(2)
Guidelines for examination F-IV 4.4

Keyword:

Amendments - added subject-matter
Novelty
Inventive step
Sufficiency of disclosure
Late-filed request
Amendment to appeal case
Claims - adaptation of the description
Referral to the Enlarged Board of Appeal

Decisions cited:

G 0001/24, G 0003/14, G 0007/93, J 0014/19, T 0168/24,
T 1745/22, T 1571/22, T 1048/22, T 0736/22, T 0673/22,
T 0447/22, T 0438/22, T 1784/21, T 1695/21, T 1614/21,
T 1472/21, T 1452/21, T 1426/21, T 1018/21, T 0623/21,
T 0056/21, T 1516/20, T 1444/20, T 0454/20, T 0250/20,
T 0169/20, T 0121/20, T 3097/19, T 2685/19, T 2194/19,
T 0140/19, T 3003/18, T 2391/18, T 2293/18, T 1968/18,
T 1168/18, T 1024/18, T 2766/17, T 2498/17, T 2178/17,
T 1579/17, T 2641/16, T 1956/16, T 0237/16, T 2378/13,
T 1252/11, T 0073/04, T 0430/02, T 0619/00, T 0403/88,
T 0011/82

Final order of the Court of First Instance of the Unified
Patent Court, Local Division Hamburg:
AGFA NV vs Gucci Sweden AB, GG FRANCE SERVICES SAS, Marbella
Pellami S.p.A., Gucci France SAS,
Guccio Gucci S.p.A., G Commerce Europe S.p.A., GG Luxury Goods
GmbH, Gucci Belgium SA,
Gucci Logistica S.p.A. of 30 April 2025, ORD_598576/2023,
UPC_CFI_278/2023.

Catchword:

The following questions are referred to the Enlarged Board of Appeal for decision.

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?



Beschwerdekammern

Boards of Appeal

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Case Number: T 0697/22 - 3.3.02

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.3.02
of 29 July 2025

Appellant: Knauf Insulation
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
28 January 2022 concerning maintenance of the
European Patent No. 2124521 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
B. Burm-Herregodts

Summary of Facts and Submissions

- I. The appeals by the patent proprietor and the opponent lie from the opposition division's interlocutory decision that European patent No. 2 124 521 in amended form in accordance with the claims of auxiliary request 1E together with an amended description, both filed during the oral proceedings on 13 December 2021, met the requirements of the EPC.
- II. Since the patent proprietor and the opponent are both appellants and respondents in these appeal proceedings, they are referred to as the patent proprietor and the opponent in the following.
- III. The following documents were submitted before the opposition division and have been relied upon in the current appeal proceedings by the parties:
- | | |
|----|-------------------|
| D1 | EP 1 382 642 A1 |
| D2 | EP 1 038 433 A1 |
| D4 | WO 2007/014236 A2 |
- IV. In the impugned decision, the opposition division's conclusions included the following.
- The subject-matter of claims 6 to 8 of the main request and of claim 6 of auxiliary request 1 extended beyond the content of the application as filed (Article 123(2) EPC).
 - The claims of auxiliary requests 1B to 1E were admitted into the proceedings.

- The invention underlying claim 1 of auxiliary request 1B was not sufficiently disclosed (Article 83 EPC).
- The subject-matter of claim 1 of auxiliary request 1C was not novel in view of D4.
- The subject-matter of claims 1 and 8 of auxiliary request 1D did not involve an inventive step starting from D1 in combination with common general knowledge.
- The claims and an amended description of auxiliary request 1E as filed during the oral proceedings before the opposition division met the requirements of the EPC.

V. In its statement of grounds of appeal, the patent proprietor contested the opposition division's decision in as far as the claims of the main request and auxiliary requests 1, 1B, 1C and 1D were concerned. It argued that these requests were allowable, contrary to what was concluded in the impugned decision.

VI. In its statement of grounds of appeal, the opponent contested the opposition division's decision that the claims of auxiliary request 1E together with the amended description, both filed during the oral proceedings before the opposition division, met the requirements of the EPC. More specifically, it contested the admittance of the claims of auxiliary request 1E into the proceedings. Furthermore, it raised objections of added subject-matter, sufficiency of disclosure, novelty and inventive step against the claims of auxiliary request 1E and objected to the amended description of this auxiliary request for not meeting the requirements of Article 84 EPC.

- VII. In its reply to the opponent's grounds of appeal, the patent proprietor counter-argued the opponent's submissions on the admittance and the allowability of the claims of auxiliary request 1E filed during the oral proceedings before the opposition division. It also disputed the opponent's submissions made on the amended description of auxiliary request 1E filed during the oral proceedings before the opposition division.
- VIII. In its reply to the patent proprietor's grounds of appeal, the opponent objected to the allowability of the claims of the main request and auxiliary requests 1, 1B, 1C, 1D, 2 and 3. It also objected to the admittance of the claims of auxiliary requests 1B, 1C and 1D.
- IX. The board summoned the parties to oral proceedings as per their requests and issued a communication under Article 15(1) RPBA.
- X. In a further letter, the opponent provided further submissions on the inventive step of the subject-matter of the claims according to the main request.
- XI. Oral proceedings before the board were held by videoconference on 19 December 2024. During the oral proceedings, the patent proprietor withdrew the main request and auxiliary requests 1, 1B and 1C. It filed a new request consisting of the claims of auxiliary request 1E filed during the oral proceedings before the opposition division together with a newly amended description. At the end of the oral proceedings, the board decided that the proceedings would be continued in writing with a view to referring certain questions to the Enlarged Board of Appeal.

- XII. The board sent out a communication pursuant to Rule 100(2) EPC on 26 March 2025. In this communication, the board proposed four questions to be referred to the Enlarged Board of Appeal and set a time limit for the parties to reply.
- XIII. Both the patent proprietor and the opponent filed a reply to this communication on 26 May 2025. The opponent supported the board's intention to refer questions to the Enlarged Board of Appeal.
- XIV. A third party filed an observation with two annexes attached on 23 May 2025.
- XV. On 18 June 2025, the opponent filed a further submission in response to the patent proprietor's reply to the communication and the third-party observation.
- XVI. The parties' requests relevant to the decision were as follows.

The patent proprietor requested:

- that the decision under appeal be set aside and a patent be maintained in amended form on the basis of the set of claims of auxiliary request 1D filed during the oral proceedings before the opposition division or, alternatively
- that the amended description filed during the oral proceedings before the board be admitted into the appeal proceedings and a patent be maintained in amended form on the basis of a "new request", namely the set of claims of auxiliary request 1E having been filed during the oral proceedings before the opposition division and held allowable

by the opposition division together with the newly amended description filed during the oral proceedings before the board, alternatively

- that a patent be maintained in amended form on the basis of the set of claims of auxiliary request 1E having been filed during the oral proceedings before the opposition division and held allowable by the opposition division together with the amended description filed before and held allowable by the opposition division

The opponent requested:

- that the decision under appeal be set aside and that European patent No. 2 124 521 be revoked in its entirety
- that the opposition division's decision to admit the claims of auxiliary requests 1D and 1E into the proceedings be overturned
- that the proprietor's "new request", i.e. the set of claims of auxiliary request 1E having been filed during the oral proceedings before the opposition division and held allowable by the opposition division together with the newly amended description filed during the oral proceedings before the board, not be admitted into the proceedings

XVII. The patent proprietor's case and the opponent's case relevant to the present decision are summarised below.

Reasons for the Decision

Auxiliary request 1D

1. Inventive step - Article 56 EPC

1.1 Claim 1 of auxiliary request 1D reads as follows:

"1. A method of growing a plant, characterised in that the plant is grown in a hydroponics growing medium comprising mineral fibres and an organic binder, wherein the growing medium has a Weathered Interlaminar Strength of at least 4 kilopascals and a phenol content of less than or equal to 0.01 % by weight and in which the organic binder is based on a reducing sugar and comprises at least one Maillard reaction product."

1.2 The opponent objected to the inventive step of the subject-matter of claim 1 of auxiliary request 1D starting from D2 in combination with D1.

1.3 Disclosure of D2

Example 1 of D2 discloses a growing medium comprising rockwool ("laine de roche") and an acrylic polyester resin. Rockwool consists of mineral fibres, and the acrylic polyester resin is an organic binder. The growing medium is hydroponics (paragraph [0001] of D2). D2 (paragraph [0015]) refers to the growth of plants in the growing medium. Thus, D2 discloses a method of growing a plant in a hydroponics growing medium comprising mineral fibres and an organic binder, as required by claim 1 of auxiliary request 1D.

It was common ground between the parties that the above disclosure of D2 is a suitable starting point for

assessing the inventive step of the subject-matter of claim 1 of auxiliary request 1D. The board sees no reason to take a different view.

1.4 Distinguishing features

It was also common ground between the parties that the distinguishing features of claim 1 of auxiliary request 1D in view of the above disclosure of D2 are:

- the definition of the organic binder of the growing medium as being based on a reducing sugar and comprising at least one Maillard reaction product
- the growing medium's weathered interlaminar strength of at least 4 kilopascals

1.5 Objective technical problem

The patent proprietor defined the objective technical problem as how to obtain a hydroponics growing medium to grow a plant, the medium having a phenol content as claimed while still having good mechanical properties (see point 5.3 of the patent proprietor's statement of grounds of appeal).

The opponent considered the objective technical problem to be the provision of a method using a hydroponics growing medium with an alternative binder.

As regards the binder as defined in claim 1 of auxiliary request 1D, the board notes that neither the patent itself nor the patent proprietor's submissions contain any experimental data proving any effect linked to this binder. The board therefore shares the opponent's view that the binder as defined in claim 1 of auxiliary request 1D is merely an alternative to the one disclosed in D2.

As regards the phenol content of the growing medium as claimed, the board shares the view of the patent proprietor. The phenol content is indeed defined in claim 1 by a certain upper limit. The claimed hydroponics growing medium must thus have this phenol content and hence solves the problem of achieving it.

As regards the good mechanical properties of the growing medium as defined in claim 1 of auxiliary request 1D, the board shares the patent proprietor's view. More specifically, the statement made in paragraph [0006] of the patent can be accepted that the weathered interlaminar strength of at least 4 kilopascals as required by claim 1 of auxiliary request 1D reflects the ability of the claimed growing medium to remain intact as a block or mat when in contact with irrigation water in plant growing conditions, implying good mechanical properties.

Therefore, the objective technical problem resides in the provision of a method applying a hydroponics growing medium with an alternative binder having a phenol content as claimed and exhibiting good mechanical properties.

1.6 Obviousness

1.6.1 Obviousness of the organic binder and phenol content as required by claim 1 of auxiliary request 1D

Example 5 of D1 discloses binders comprising a mixture of one of binder components (A1) to (A3) (component (A) in the following) obtained in examples 1 to 3 of D1 (reaction product of diethanolamine and a carboxylic anhydride) and a binder component (B) which comprises glucose syrup (Cerestar® 01411, having a dextrose equivalent of 30) in a weight ratio of 3 parts (A) to 1 part (B), based on the solids content. 3-

aminopropyltriethoxysilane is added to this mixture as a coupling agent (paragraph [0053] of D1). Finally, a curing step of the binder mixtures is carried out (footnotes of the table on page 8 of D1).

The glucose syrup of D1 comprises dextrose, i.e. a reducing sugar as required for the binder of claim 1 of auxiliary request 1D. Dextrose is also a carbohydrate Maillard reactant. The 3-aminopropyltriethoxysilane of D1 is an amine compound and thus an amine Maillard reactant. Maillard reaction products (reaction products between a carbohydrate reactant and an amine reactant) must thus inevitably be produced upon curing in D1. The binder of D1 thus corresponds to the binder as defined in claim 1 of auxiliary request 1D.

D1 (paragraph [0040]) further teaches that the binders are applied in combination with mineral fibre products which find use, *inter alia*, as horticultural growing media. Such horticultural growing media comprise hydroponics growing medium.

The skilled person looking for an alternative binder in the method of D2 would thus have replaced the acrylic polyester resin of the hydroponics growing medium used as an organic binder in the method of D2 with one of those disclosed in example 5 of D1, thus arriving at a method applying a binder as defined in claim 1 of auxiliary request 1D.

Neither the binders of D1 nor the rockwool of D2 contain any phenol building blocks. The skilled person would thus have obtained a material devoid of phenol, thus having a phenol content as required by claim 1 of auxiliary request 1D.

The patent proprietor contested this conclusion. It submitted that claim 1 of auxiliary request 1D required that the organic binder be based on a reducing sugar. In contrast, the binders of example 5 of D1 only comprised a low amount of dextrose. A major part of the binders was composed of a binder component (A) different from a reducing sugar. The binders disclosed in example 5 of D1 were thus based on binder component (A) and not on a reducing sugar as required by claim 1 of auxiliary request 1D.

The board does not agree. As submitted by the opponent, a common meaning of the term "based on" for an entity comprised in a product does not exist, let alone with a certain minimum value for the amount of the entity in the product. It was the patent proprietor who chose to put the term "based on" in claim 1 of auxiliary request 1D. Any ambiguity as regards the minimum amount implied by this term must therefore be to its disadvantage. The term "based on" in claim 1 of auxiliary request 1D is thus to be interpreted broadly and not limited to a specific minimum amount of the reducing sugar in the organic binders. At best, it can be understood such that it excludes trace amounts. As set out above, the amount of glucose syrup in the mixture of (A) and (B) in example 5 of D1 is 25 wt.%, based on the weight ratio of 3 parts (A) to 1 part (B). The amount of reducing sugar in the mixture of (A) and (B), based on the dextrose equivalent of 30, is about 7.5 wt.% (25×0.30) and cannot be considered a trace amount. This was not disputed by the patent proprietor. Furthermore, dextrose is not consumed when mixed with binder component (A). It follows that the amount of dextrose before curing is significant, and it must be concluded that the binders disclosed in example 5 of D1 are based on a reducing sugar.

The patent proprietor also submitted that there was no evidence for the presence of a Maillard reaction product in the binders of example 5 of D1. In view of the low amount of reducing sugar and the undefined amount of aminopropyltriethoxysilane, example 5 of D1 did not directly and unambiguously disclose "an organic binder comprising at least one Maillard reaction product".

The board disagrees with the patent proprietor. As set out above, the binders of example 5 of D1 contain the two Maillard reactants aminopropyltriethoxysilane and dextrose. In the absence of any proof to the contrary, aminopropyltriethoxysilane must be assumed to be inevitably available as a reactant in the reaction mixture such that it reacts with dextrose to provide a Maillard reaction product during the curing step.

- 1.6.2 Obviousness of the weathered interlaminar strength of at least 4 kilopascals as required by claim 1 of auxiliary request 1D

As set out above, this feature reflects the ability of the growing medium to remain intact as a block or mat when in contact with irrigation water in plant growing conditions (paragraph [0006] of the patent). As discussed during the oral proceedings, the skilled person aiming for good mechanical properties would thus have chosen the weathered interlaminar strength as high as possible. The claimed weathered interlaminar strength of at least 4 kilopascals would thus have been arrived at by the skilled person in an obvious manner.

- 1.7 It follows that the subject-matter of claim 1 of auxiliary request 1D does not involve an inventive step in view of D2 in combination with D1.

- 1.8 Auxiliary request 1D is thus not allowable.
2. Admittance of auxiliary request 1D
- 2.1 Auxiliary request 1D was filed during the oral proceedings before the opposition division. The opposition division admitted this request into the proceedings.
- 2.2 The opponent requested that the opposition division's decision to admit auxiliary request 1D into the proceedings be overturned.
- 2.3 During the oral proceedings, the board decided that the opposition division's decision to admit auxiliary request 1D into the proceedings was not to be set aside and that therefore auxiliary request 1D remained in the appeal proceedings. Since the board concluded that auxiliary request 1D was not allowable in the opponent's favour, there is no need to give any reason why auxiliary request 1D remained in the appeal proceedings.

The claims of auxiliary request 1E

3. Claim 1 of auxiliary request 1E reads as follows:

"1. A method of growing a plant, characterised in that the plant is grown in a hydroponics growing medium comprising mineral fibres and an organic binder, wherein the growing medium has a Weathered Interlaminar Strength of at least 4 kilopascals and a phenol content of less than or equal to 0.01 % by weight and in which the organic binder is based on a reducing sugar and comprises at least one Maillard reaction product, and in which the binder is based on reaction products

obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose."

Claim 1 of auxiliary request 1E is thus identical to that of auxiliary request 1D, except that the binder is further required to be based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose.

4. Admittance of the claims of auxiliary request 1E
- 4.1 The oral proceedings before the opposition division were held on two days, 4 November 2021 and 13 December 2021. The claims of auxiliary request 1E were filed on the second day of the oral proceedings before the opposition division, and the opposition division decided to admit them into the proceedings (points 16.1 and 16.2 of the Reasons of the decision).
- 4.2 The opponent requested that this decision be overturned.
- 4.3 In the opponent's favour, the board assumes that it has the power to overturn the discretionary decision of the opposition division to admit the claims of auxiliary request 1E into the proceedings. By way of analogy with the established case law of the boards developed in view of decision G 7/93, in exercising this power, a board should only overrule the way in which an opposition division exercised its discretion if the board concludes that the opposition division has done so according to the wrong principles, without taking into account the right principles or in an unreasonable way.

4.4 As set out above, the claims of auxiliary request 1E were filed during the second day of the oral proceedings before the opposition division.

In point 16.2 of the Reasons (page 34), the opposition division held that the subject of the proceedings had changed and the claims of auxiliary request 1E could not have been filed earlier and constituted "*a fair attempt by the patentee to overcome all previous objections*". One of the "*previous objections*" was an objection of lack of sufficiency of disclosure. In the annex to the summons to attend oral proceedings (point 2), the opposition division had held that the requirements of sufficiency of disclosure were met. During the oral proceedings (point 6.7 of the Reasons), the opposition division changed its mind and concluded that the invention in claim 1 of auxiliary request 1B was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The reason was that claim 1 of auxiliary request 1B required a binder content in the range 2 to 10% by weight. There was, however, no teaching in the patent on how the skilled person, starting from the only example disclosed, having a binder content of 5% and a weathered interlaminar strength of 9.2, could achieve the claimed weathered interlaminar strength with a binder content of only 2%, the lower limit of claim 1 of auxiliary request 1B.

The opposition division further referred in point 16.2 of the Reasons to the Guidelines, E-III, 8.6. This paragraph of the Guidelines relates to facts, evidence or amendments submitted at a late stage, including during oral proceedings. This paragraph refers to the Guidelines E-VI, 2. This part of the Guidelines is concerned with amendments filed in preparation for or

during oral proceedings and mentions that the opposition division has the discretion to disregard amendments filed after the date set under Rule 116(1) EPC for being late filed unless they have to be admitted because the subject of the proceedings has changed. One example of a change of subject of the proceedings mentioned in the Guidelines is when the opposition division departs from a previously notified opinion - for example, if, contrary to its preliminary opinion set out in the annex to the summons, the opposition division concludes during oral proceedings that an objection prejudices the maintenance of the patent.

Claim 1 of auxiliary request 1E differs from that of auxiliary request 1B in, *inter alia*, the deletion of the binder content. As set out above, the objection of lack of sufficiency of disclosure about which the opposition division had changed its mind was based on the binder content as defined in claim 1 of auxiliary request 1B. Auxiliary request 1E can thus clearly be considered to have been a response to the opposition division's change of mind on sufficiency of disclosure.

It thus follows that the opposition division used the right principles in a reasonable way, namely by concluding that it had departed from a previously notified opinion and that this represented a change of subject of the proceedings that justified the late filing of the claims of auxiliary request 1E.

The opponent also submitted that the claims of a previous auxiliary request 1E were filed after the final date for making written submissions pursuant to Rule 116(1) EPC. Thus, the claims of this previous auxiliary request 1E, and those of current auxiliary

request 1E, both submitted before the opposition division, were clearly late filed.

However, the filing of this previous auxiliary request 1E has no bearing on whether the claims of current auxiliary request 1E are a response to the opposition division's change of mind during the oral proceedings.

The board therefore decided at the oral proceedings that the opposition division's decision to admit the claims of auxiliary request 1E was not to be set aside, and these claims remained in the appeal proceedings.

5. Added subject-matter - Article 123(2) EPC
- 5.1 As set out above, claim 1 of auxiliary request 1E relates to a method of growing a plant, characterised in that the plant is grown in a hydroponics growing medium comprising mineral fibres and an organic binder.
- 5.2 The opponent contended that claim 1 of auxiliary request 1E added subject-matter beyond the content of the application as filed. According to the opponent, the application as filed did not disclose any method of growing a plant. Claim 12 as filed, relied on by the patent proprietor as a basis for claim 1 of auxiliary request 1E, related only to a plant grown in a hydroponics growing medium and not to a method of growing a plant as required by claim 1 of auxiliary request 1E. The application as filed therefore did not contain any basis for this new claim category.
- 5.3 The board does not find the opponent's submission convincing. While it is acknowledged that the application as filed does not refer *expressis verbis* to a method of growing a plant, the relevant question to be answered is whether such a method is directly and

unambiguously disclosed in the application as filed. For a feature to be directly and unambiguously disclosed, explicit disclosure is not necessarily required in the application as filed; implicit disclosure in the application as filed is sufficient. In the case at hand, the plant grown according to claim 12 as filed in a hydroponics growing medium according to any of claims 1 to 11 as filed cannot but imply that the plant has been grown in the hydroponics growing medium. Claim 12 as filed thus implicitly discloses a method of growing a plant in this hydroponics growing medium, as required by claim 1 of auxiliary request 1E.

Thus, claim 12 as filed represents a basis for the method category of claim 1 of auxiliary request 1E.

5.4 Therefore, claim 1 of auxiliary request 1E does not add any subject-matter beyond the content of the application as filed (Article 123(2) EPC).

6. Sufficiency of disclosure - Article 83 EPC

6.1 The opponent contended that the application as filed did not disclose the invention defined in claim 1 of auxiliary request 1E in a manner sufficiently clear and complete to be carried out by the person skilled in the art. The opponent raised four objections. Each of the objections are dealt with in turn in the following.

6.2 Insufficient teaching on how the mechanical properties claimed are to be achieved

Independent claim 1 of auxiliary request 1E refers to a hydroponics growing medium having a mechanical property defined as a weathered interlaminar strength of at least 4 kilopascals.

The opponent submitted that the invention underlying the subject-matter of claim 1 of auxiliary request 1E lacked sufficiency of disclosure since the claims were broadly defined in that the mechanical property of weathered interlaminar strength of the hydroponics growing medium was referred to without any relevant guidance on the nature of the binder to be used, the mineral fibres to be used, the method of manufacture to be used, and in particular with relatively low amounts of binder, or a relatively low amount of citric acid, ammonia and dextrose in the binder. Furthermore, the application as filed did not provide the person skilled in the art with any guidance on how to find an appropriate combination of these factors to achieve the desired mechanical property.

The board does not find the opponent's submission convincing.

As submitted by the patent proprietor, a successful objection of lack of sufficiency of disclosure presupposes that there are serious doubts substantiated by verifiable facts. In the case at hand, the opponent's assertion implies that with certain mineral fibres; binders; binder amounts; amounts of citric acid, ammonia and dextrose or certain methods of manufacture, it is impossible to obtain the claimed weathered interlaminar strength. This constitutes nothing but an unproven and unsubstantiated allegation.

Furthermore, the application as filed comprises one example disclosing the preparation of a binder as required by claim 1 of auxiliary request 1E and achieving a weathered interlaminar strength of 9.2 (table 1 on page 4 of the application as filed), which is far above the lower limit of 4 kilopascals required by claim 1. The table on page 3 discloses the amounts

of citric acid, ammonia and dextrose in the aqueous solution used to prepare the binder. The example of the application as filed also refers to the preparation of a growing medium having a specific thickness and density and a specific binder content of 5 wt.%. This, in combination with the description defining the mineral fibres (page 3, lines 8 to 10), provides sufficient guidance to the skilled person on how to prepare the hydroponics growing medium covered by claim 1 of auxiliary request 1E and achieve the required weathered interlaminar strength.

6.3 Insufficient teaching concerning the definition of the weathered interlaminar strength by an open-ended range

As set out above, claim 1 of auxiliary request 1E refers to a weathered interlaminar strength defined by a minimum value ("at least 4 kilopascals"). The weathered interlaminar strength in this claim is thus defined by an open-ended range.

The opponent submitted that hydroponics growing media having a weathered interlaminar strength of e.g. above 100 kilopascals were therefore covered by claim 1 of auxiliary request 1E. The application as filed did not teach how to achieve such a weathered interlaminar strength.

The board is not convinced. As submitted by the patent proprietor, the sole fact that the weathered interlaminar strength is expressed in terms of an open-ended range is not enough to support an objection of insufficient disclosure. The skilled person when considering a weathered interlaminar strength of at least 4 kilopascals, as defined in claim 1 of auxiliary request 1E, would rule out interpretations which are illogical or which do not make technical sense and

would only consider hydroponics growing media which are technically feasible, i.e. which have a weathered interlaminar strength that makes technical sense, taking into account the whole disclosure of the application as filed and common general knowledge. The skilled person would thus not consider technically nonsensical embodiments such as the one mentioned by the opponent with a weathered interlaminar strength of 100 kilopascals to be covered by claim 1 of auxiliary request 1E.

6.4 Lack of sufficient teaching on the method of measuring the weathered interlaminar strength

The opponent objected that the application as filed did not provide sufficient information on how to carry out the measurement of the weathered interlaminar strength to which claim 1 of auxiliary request 1E refers.

The board disagrees. As submitted by the patent proprietor, the passage of page 4, lines 3 to 24 of the application as filed discloses the preparation of the test material. It also refers to a standard ("European Standard EN1607 of November 1996", lines 12 and 13) for measuring the weathered interlaminar strength, with the details and/or variation used (lines 15 to 22). Thus, in the absence of any substantiated facts or evidence, the board concludes that the application as filed discloses how to measure the weathered interlaminar strength required by claim 1 of auxiliary request 1E in a manner sufficiently clear and complete. In any case, any ambiguity as regards the measurement results obtained for the weathered interlaminar strength would not be an issue under sufficiency of disclosure but would be related to a lack of clarity.

6.5 The opponent submitted that claim 1 of auxiliary request 1E contained unrelated features the relationship of which was not understandable. Claim 1 of auxiliary request 1E referred, on the one hand, to a "binder" and, on the other hand, to "an aqueous solution". It further referred to a binder "based on a reducing sugar" and to "dextrose", i.e. a reducing sugar. The claim further recited that the binder "comprises a Maillard reaction product" and, on the other hand, that the binder "is based on reaction products". The relationship between these features was not clear, and the resulting unclarity was present to such an extent that the skilled person was unable to carry out the alleged invention over the whole scope claimed. Furthermore, claim 1 of auxiliary request 1E required that the binder be based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. Curing the aqueous solution would result in a solid mass of the reaction products. It was not clear for the skilled person how to add such reaction products into the binder.

The board does not find the opponent's arguments convincing. As submitted by the patent proprietor, the opponent's submissions are related to clarity rather than sufficiency of disclosure.

Furthermore, the skilled person would understand from the wording of claim 1 of auxiliary request 1E that the binder comprises a Maillard reaction product obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose, as disclosed on page 3 of the application as filed or in PCT/US2006/028929 (D4), to which the application as filed refers (page 3, lines 1 and 2). Such a binder is thus based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. It

comprises at least one Maillard reaction product (resulting from the reaction of dextrose and ammonia) and is based on a reducing sugar (dextrose), as required by claim 1 of auxiliary request 1E. The lack of clarity referred to by the opponent hence does not exist.

In the application as filed, the binder comprising an aqueous solution comprising citric acid, ammonia and dextrose is sprayed onto the fibres before the growing medium is cured (page 3, lines 16 to 19 of the application as filed). In the application as filed, the step of curing the binder occurs after spraying the aqueous solution onto the fibres, and there is thus no formation of "a solid mass of the reaction products", contrary to the submissions of the opponent.

In D4 (cited on page 3, lines 1 and 2 of the application as filed), the aqueous solution comprising citric acid, ammonia and dextrose is cured in a first step (example 5 of D4) and is used in a second step as a solution comprising 15% solids in a soaking bath for impregnating glass fibres before curing the impregnated glass fibres (example 7 of D4, first paragraph on page 33). Thus, D4 teaches that the solid binder obtained from the aqueous solution comprising citric acid, ammonia and dextrose is used in a solution comprising 15% solid binder, and it cannot be concluded that the skilled person did not know how to "add such reaction products into the binder".

Therefore, the skilled person is able to prepare and use the binder defined in claim 1 of auxiliary request 1E based upon the disclosure of the application as filed.

6.6 Thus, the board concludes that the invention defined by claim 1 of auxiliary request 1E is sufficiently disclosed.

7. Novelty - Article 54 EPC

7.1 The opponent raised two objections of lack of novelty of the subject-matter of claim 1 of auxiliary request 1E, one in view of D1 and one in view of D4.

These objections are considered in turn in the following.

7.2 Novelty in view of D1

As set out above, claim 1 of auxiliary request 1E relates to a method of growing a plant, characterised in that the plant is grown in a hydroponics growing medium comprising mineral fibres and an organic binder based on a reducing sugar and comprising at least one Maillard reaction product, the growing medium having a specific weathered interlaminar strength and a low phenol content. The binder is also characterised in that it is based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose (a reducing sugar).

As set out above for the assessment of inventive step of the subject-matter of claim 1 of auxiliary request 1D, example 5 of D1 discloses binders comprising a Maillard reaction product, and paragraph [0040] of D1 discloses that the binders are used in combination with mineral fibre products which find use, *inter alia*, as horticultural growing media.

D1 does not disclose a weathered interlaminar strength of at least 4 kilopascals for the hydroponics growing medium.

Furthermore, D1 does not disclose a binder based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose.

The opponent argued that a binder based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose was disclosed in view of claim 13 and paragraphs [0025] and [0026] of D1.

The board acknowledges that claim 13 of D1 discloses that binder component (B) may comprise glucose, which is a synonym of dextrose.

The board also acknowledges that paragraph [0026] of D1 discloses acid monomers such as citric acid to be employed in the preparation of binder component (A).

The board lastly acknowledges that paragraph [0025] of D1 refers to a base such as ammonia (line 21 on page 4). But the board notes that ammonia in that paragraph is disclosed to obtain a certain pH causing at least a partial neutralisation of unreacted acid present after the preparation of binder component (A). As set out by the patent proprietor and held by the opposition division (point 18.1 of the Reasons), the ammonia will have evaporated before the curing temperature is reached. Hence, even when considering this disclosure of D1, the binder is not based on reaction products obtained by curing an aqueous solution comprising ammonia, let alone a combination of ammonia and citric acid as required by claim 1 of auxiliary request 1E.

For these reasons, the subject-matter of claim 1 of auxiliary request 1E is novel in view of the disclosure of D1.

7.3 Novelty in view of D4

D4 is a PCT application published on 1 February 2007, i.e. after the filing date of the patent (25 January 2007). The filing date of D4 is 26 July 2006, i.e. prior to the filing date of the patent. It was undisputed that D4 represents prior art under Article 54(3) EPC.

Example 7 of D4 (page 32) discloses glass fibre-containing mats comprising binders prepared with ammonium polycarboxylate-sugar binders. Such binders are prepared in example 5 of D4 (page 28) from an aqueous composition comprising citric acid, ammonia and dextrose. The binders of D4 are thus based on a reducing sugar (dextrose) and reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. The binders of D4 thus comprise at least one Maillard reaction product and correspond to the binder defined in claim 1 of auxiliary request 1E.

However, as submitted by the patent proprietor, there is no disclosure of a method for growing a plant in D4.

Therefore, the subject-matter of claim 1 of auxiliary request 1E is novel in view of the disclosure of D4.

7.4 In view of the above, the subject-matter of claim 1 of auxiliary request 1E, and by the same token of dependent claims 2 to 5, is novel in view of D1 (Article 54(2) EPC) and D4 (Article 54(3) EPC).

8. Inventive step - Article 56 EPC

8.1 The opponent submitted that the subject-matter of claim 1 of auxiliary request 1E did not involve an inventive step starting from D1 or D2. These objections are addressed in turn in the following, starting with the objection based on D2.

8.2 Starting from D2

As set out above for the assessment of the inventive step of the subject-matter of claim 1 of auxiliary request 1D, D2 discloses a hydroponics growing medium comprising mineral fibres in an organic binder (abstract of D2). The organic binder is an acrylic polyester resin. D2 refers to the growth of plants in the growing medium (paragraph [0015] of D2).

8.2.1 Distinguishing features

It was common ground in the assessment of the inventive step of the subject-matter of claim 1 of auxiliary request 1D that the distinguishing features of claim 1 of auxiliary request 1D in view of D2 are the growing medium's weathered interlaminar strength of at least 4 kilopascals and the definition of the organic binder as being based on a reducing sugar and comprising at least one Maillard reaction product. The same distinguishing features are present in claim 1 of auxiliary request 1E.

As set out above, compared to claim 1 of auxiliary request 1D, claim 1 of auxiliary request 1E contains the additional feature that the binder is based on reaction products obtained by curing an aqueous

solution comprising citric acid, ammonia and dextrose. This feature is also not disclosed in D2.

The distinguishing features of auxiliary request 1E over D2 are thus:

- the growing medium's weathered interlaminar strength of at least 4 kilopascals
- the definition of the organic binder as being based on a reducing sugar and comprising at least one Maillard reaction product
- the definition of the binder as being based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose

8.2.2 Objective technical problem

As set out above when discussing inventive step of claim 1 of auxiliary request 1D, the objective technical problem in view of the first two distinguishing features is the provision of a method applying a hydroponics growing medium with an alternative binder having a phenol content as claimed and exhibiting good mechanical properties.

The patent proprietor did not rely on any effect linked to the third distinguishing feature, i.e. the definition of the binder as being based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. Therefore, it can be assumed that the objective technical problem solved by claim 1 of auxiliary request 1E is the same as that defined for auxiliary request 1D, i.e. the provision of a method applying a hydroponics growing medium with an alternative binder

having a phenol content as claimed and exhibiting good mechanical properties.

8.2.3 Obviousness

As set out above when discussing inventive step of auxiliary request 1D, it would have been obvious to use one of the binders of example 5 of D1 in the method of D2. In example 5 of D1, as set out above, binder component (A) and binder component (B) comprising the reducing sugar dextrose are cured in the presence of 3-aminopropyltriethoxysilane, resulting in a Maillard reaction product. However, this binder is devoid of citric acid and ammonia. Thus, by using one of the binders of example 5 of D1 in the method of D2, the skilled person would not have arrived at the subject-matter of claim 1 of auxiliary request 1E.

As set out above in the discussion of novelty in view of D1, even when considering the additional passages cited by the opponent, namely claim 13 and paragraphs [0025] and [0026] of D1, a binder as defined in claim 1 of auxiliary request 1E, i.e. based on reaction products obtained by curing an aqueous solution comprising ammonia, dextrose and citric acid, is not disclosed in this document.

Thus, the skilled person applying the binder as disclosed in D1, be it in example 5 or claim 13, in conjunction with paragraphs [0025] and [0026] of this document in the method of D2 would not have arrived at the subject-matter of claim 1 of auxiliary request 1E.

8.2.4 It follows that the subject-matter of claim 1 of auxiliary request 1E involves an inventive step in view of D2 alone or in combination with D1.

8.3 Starting from D1

8.3.1 Distinguishing features

As set out above for the assessment of novelty in view of D1, the distinguishing features of claim 1 of auxiliary request 1E in view of D1 are:

- a binder based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose
- a weathered interlaminar strength of at least 4 kilopascals

8.3.2 Objective technical problem

As set out above for inventive step of claim 1 of auxiliary request 1E starting from D2, the patent proprietor did not rely on any effect linked to the definition of the binder as being based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose. The problem solved by this distinguishing feature is thus the provision of a method using an alternative binder.

In the same way as set out above for auxiliary request 1D, the hydroponics growing medium as defined in claim 1 of auxiliary request 1E solves the problem of achieving a phenol content as claimed.

As also set out for auxiliary request 1D, the weathered interlaminar strength of at least 4 kilopascals of claim 1 of auxiliary request 1E implies good mechanical properties.

In the same way as for auxiliary request 1D and auxiliary request 1E when starting from D2, the objective technical problem is thus the provision of a

method applying a hydroponics growing medium with an alternative binder having a phenol content as claimed and exhibiting good mechanical properties.

8.3.3 Obviousness

As submitted by the patent proprietor and as set out above for the assessment of inventive step of the subject-matter of claim 1 of auxiliary request 1E starting from D2, there is no suggestion or motivation in D1 which would have led the skilled person to prepare a binder based on reaction products obtained by curing an aqueous solution comprising ammonia and citric acid and to use this binder in a method to grow a plant in a hydroponic growing medium. No other document was cited by the opponent containing any such suggestion.

Thus, the subject-matter of claim 1 of auxiliary request 1E involves an inventive step starting from D1.

8.4 In view of the above, the subject-matter of claim 1 of auxiliary request 1E, and by the same token of dependent claims 2 to 5, involves an inventive step starting from D1 or D2 (Article 56 EPC).

New request - claims of auxiliary request 1E with the description amended during the oral proceedings before the board

9. Admittance

9.1 Up to the oral proceedings, the patent proprietor took the position that the description as amended before the opposition division did not need to be further amended since no such amendment would be needed even if the amendment in claim 1 of auxiliary request 1E introduced an inconsistency between this claim and the amended

description. Initially at the oral proceedings, the patent proprietor maintained this position. Only at a later stage during the oral proceedings did the patent proprietor file a new request containing the claims of auxiliary request 1E and a description which, compared to the description as amended during the oral proceedings before the opposition division, contained further amendments to adapt it to the claims of auxiliary request 1E. The description amended during the oral proceedings before the board is based on the description amended during the oral proceedings before the opposition division, but with paragraphs [0013] and [0016] deleted.

- 9.2 The opponent requested that the patent proprietor's new request not be admitted under Article 13(1) and (2) RPBA.
- 9.3 The first question to be discussed in relation to admittance of the new request is whether this new request represents an amendment to the patent proprietor's appeal case.

As set out in J 14/19 (points 1.4 and 1.5 of the Reasons) and followed in T 1968/18 (point 7.4 and 7.5 of the Reasons), the question of whether a submission results in an "amendment to a party's appeal case" within the meaning of Article 13(1) and (2) RPBA has to be answered using the list of possible components of an appeal case in Article 12(2) RPBA as a reference point. Based on this consideration, any submission not directed to requests, facts, objections, arguments or evidence relied on in the statement of grounds of appeal or in the reply amounts to an amendment to the appeal case.

In the case at hand, the description amended at the oral proceedings before the board did not form part of the requests, facts, objections, arguments or evidence relied on in the patent proprietor's statement of grounds of appeal or its reply to the opponent's statement of grounds of appeal.

Rather, the new request with the newly amended description was submitted for the first time during the oral proceedings before the board. This new request diverges completely from the position taken by the patent proprietor in its reply to the opponent's grounds of appeal (point 6 on page 12, in particular the last sentence) that the amended description filed before the opposition division, and paragraphs [0013] and [0016] still forming part of it, did not result in any deficiency in view of Article 84 EPC.

The new request, in which the two paragraphs are deleted, thus results in an amendment to the patent proprietor's appeal case, in line with J 14/19.

The patent proprietor relied on T 2178/17 and disputed this conclusion. It submitted that, in accordance with this decision, filing an amended description did not represent an amendment of the appeal case, in particular if just deletions were made.

The board does not agree.

In T 2178/17 (point 6.3.3 of the Reasons), during oral proceedings before the board, the patent proprietor filed a description adapted to a set of claims filed in appeal and found by the board to meet the requirements of the EPC. The board in that case held that the filing of the amended description does not generally

constitute an amendment to the patent proprietor's appeal case.

The situation in the current case is different from that of T 2178/17. In the case at hand, the claim request, i.e. the claims of auxiliary request 1E, were not filed in appeal but were already on file before the opposition division. Furthermore, in the current case, an amended description had already been filed before the opposition division in an attempt to adapt it to the claims of auxiliary request 1E. This amended description was objected to by the opponent in its statement of grounds of appeal under Article 84 EPC. This situation is completely different from the case underlying T 2178/17, where a potential problem with an amended description was not known to the patent proprietor from the start of the appeal proceedings.

The board thus remains of the view that the new request represents an amendment to the patent proprietor's appeal case.

- 9.4 Since this new request was filed only during the oral proceedings before the board, its admittance is governed by Article 13(1) and (2) RPBA. Under Article 13(1) RPBA, any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the discretion of the board. The board will exercise its discretion in view of, *inter alia*, the current state of the proceedings and whether the amendment is detrimental to procedural economy.

Under Article 13(2) RPBA, any amendment to a party's appeal case made after notification of a summons to oral proceedings must, as a rule, not be taken into

account unless there are exceptional circumstances justified with cogent reasons by the party concerned.

As set out above, the objection under Article 84 EPC against the amended description filed during the oral proceedings before the opposition division was raised in the opponent's statement of grounds of appeal (point VIII starting on page 21). The board does not see any reason, and none was provided by the patent proprietor, why it waited until the oral proceedings before the board to attempt to overcome the objection and to submit the new request.

The new request should thus have been filed at an earlier stage in the appeal proceedings, and submitting it only during the oral proceedings is detrimental to procedural economy and not in accordance with Article 13(1) RPBA.

Furthermore, no cogent reasons which justified exceptional circumstances for filing the new request only at the oral proceedings before the board can be recognised. The patent proprietor's new request thus cannot be admitted in view of Article 13(2) RPBA either.

For these reasons, the board decided not to admit the new request.

Claims of auxiliary request 1E with the description as amended during the oral proceedings before the opposition division

10. Article 84 EPC

10.1 The opponent objected that the description filed during the oral proceedings before the opposition division was not adapted to and thus inconsistent with claim 1 of auxiliary request 1E, and thus this claim was not

supported by the description as required by Article 84 EPC.

- 10.2 The binder in independent method claim 13 as granted, by way of its back-reference to claim 1 as granted, is defined as comprising at least one Maillard reaction product. Compared to this definition of the binder in claim 13 as granted, the binder in independent method claim 1 of auxiliary request 1E has been amended to be "based on a reducing sugar" and "based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose". This definition now present in claim 1 of auxiliary request 1E can only be found in dependent claims as granted, namely claims 7 and 11. Hence, while according to claim 1 of auxiliary request 1E it is mandatory that the binder be based on a reducing sugar and on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose, this was optional according to the claims as granted.
- 10.3 In line with the order of G 3/14, an amended claim of a patent may be examined for compliance with the requirements of Article 84 EPC if the amendment in the claim introduces non-compliance with Article 84 EPC.
- 10.4 Article 84 EPC reads as follows: "*The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.*" Hence, in the case at hand, it can be examined whether the above-discussed amendment of the binder definition in claim 1 of auxiliary request 1E (point 10.2) introduces a deficiency under Article 84 EPC in that in view of this amendment, claim 1 of auxiliary request 1E is not supported by the

description as amended during oral proceedings before the opposition division.

- 10.5 The amended description as filed during the oral proceedings before the opposition division comprises paragraphs [0013] and [0016], which are identical to the corresponding paragraphs of the granted patent and which read as follows:

"[0013] The binder may be based on a combination of a polycarboxylic acid, for example citric acid, a sugar, for example dextrose, and a source of ammonia, for example ammonia solution. It may be based on a combination of ammonium citrate and dextrose. Where the binder is based on sugars and/or citric acid and or comprises significant -OH groups, it is particularly surprising that such levels of Weathered Interlaminar Strength can be achieved ..."

"[0016] The binder may be one of those disclosed in International patent application n° PCT/US2006/028929."

As submitted by the opponent, the binders disclosed in paragraph [0013] are based on a polycarboxylic acid, a sugar and a source of ammonia. In this paragraph, citric acid, ammonia and dextrose are only given as examples of these more general classes of compounds and are indicated as optional.

Paragraph [0016] refers to binders disclosed in PCT/US2006/028929, which corresponds to document D4. The binder of claim 1 of D4 only requires the presence of Maillard reactants including an amine and a carbohydrate in the binder.

It follows that the binders disclosed in paragraphs [0013] and [0016] of the amended description filed during the oral proceedings before the opposition

division are not limited to binders based on reaction products obtained by curing an aqueous solution comprising citric acid, ammonia and dextrose, as required by claim 1 of auxiliary request 1E, but are defined in a much broader way.

Therefore, in view of this amendment of claim 1 of auxiliary request 1E, an inconsistency has been introduced between the binder as defined in this claim and the disclosure in paragraphs [0013] and [0016] of the amended description as filed during the oral proceedings before the opposition division.

- 10.6 If this inconsistency between the amendment of claim 1 in auxiliary request 1E and paragraphs [0013] and [0016] of the description as amended during the oral proceedings before the opposition division is considered to be in contravention of the requirement in Article 84 EPC that the claims must be supported by the description, or any other requirement of the EPC, the request based on the claims of auxiliary request 1E and the description as amended during the oral proceedings before the opposition division is not allowable.

If this inconsistency between the amendment of claim 1 in auxiliary request 1E and paragraphs [0013] and [0016] of the description as amended during the oral proceedings before the opposition division is considered not to be in contravention of the requirement in Article 84 EPC that the claims must be supported by the description, or any other requirement of the EPC, the request based on the claims of auxiliary request 1E and the description as amended during the oral proceedings before the opposition division is allowable.

The following question is thus decisive for the outcome of the current case:

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?

11. In the following, the board will analyse the case law that might answer the above question.
12. A search of case law was conducted. The current case is an opposition-appeal case. To have a complete picture, the board also included in the search decisions in examination-appeal cases. This search yielded 115 relevant decisions issued between 15 April 1983 and 14 February 2025. A total of 86 decisions in opposition-appeal proceedings and 29 decisions in examination-appeal proceedings were retrieved.
13. On the basis of the decisions found, in the board's view, there are two lines of case law that are clearly diverging, one line answering the above question in the affirmative, and a second line answering the above question in the negative. The first line of case law is discussed below followed by a discussion of the second line.
14. The first line of case law
 - 14.1 The first line of case law is followed in most of the cases studied and is referred to in numerous decisions as the established line of case law, see e.g.

T 1024/18, point 3.1.1 of the Reasons and T 438/22, point 4.6 of the Reasons. The first decision concerns opposition-appeal proceedings; the second one, examination-appeal proceedings.

14.2 In the decisions under the first line of case law, the common underlying principle is that there is a legal basis that requires the description to be consistent with the amended claims. Under this line of case law, the applicant or proprietor is or should be invited to amend the description so that any inconsistency caused by the amendment of the claims is removed. The removal of an inconsistency may, for example, take the form of a deletion of subject-matter or an insertion of an additional statement in the description. Cases in which the inconsistency between an amended claim and the description was removed by deletion of subject-matter are T 403/88, point 3 of the Reasons; T 1252/11, point 34 of the Reasons; T 1956/16, point 4 of the Reasons; T 623/21, point 2 of the Reasons and T 447/22, point 75 of the Reasons (all opposition-appeal proceedings) and T 2641/16, point 5 of the Reasons and T 438/22, catchword and point 5.7.2 of the Reasons (both examination-appeal proceedings). Cases where the inconsistency between an amended claim and the description was removed by adding a statement that an embodiment of the description was not covered by the claims include T 438/22, point 3 of the catchword (examination-appeal proceedings).

14.3 The decisions that follow the first line of case law cite as a legal basis parts of the EPC or its Implementing Regulations. There is no consensus in these decisions on one precise legal basis. Indeed, five different subordinate lines can be distinguished: cases in which Article 84 EPC alone serves as the legal

basis (section 14.3.1 below), cases in which Article 84 EPC is combined with other provisions of the EPC as the legal basis (section 14.3.2 below), one case in which Rule 42 EPC alone is cited as the legal basis (section 14.3.3 below), cases containing a general reference to the requirements of the EPC as a legal basis (section 14.3.4 below) and cases with a reference to the requirement of consistency as a general (legal) principle (section 14.3.5 below).

14.3.1 Article 84 EPC alone as a legal basis

In the decisions relying on Article 84 EPC alone as a legal basis, the decisions in which reference is made to T 1024/18 as a guiding decision can be distinguished from those relying on Article 84 EPC alone not citing T 1024/18 as a guiding decision.

(a) Article 84 EPC alone as a legal basis: T 1024/18 or decisions using this case as a guiding decision

In T 1024/18 (opposition-appeal proceedings), an appeal was filed by the opponent. The patent proprietor had requested, *inter alia*, that the appeal be dismissed or that the patent be maintained according to auxiliary requests 1 to 3.

The deciding board concurred with the first line of case law that considers Article 84 EPC to be the legal basis requiring adaptation of the description to amended claims to ensure that the description is consistent with the claims.

Although the patent proprietor (respondent) had been given the opportunity to adapt the description, it had not done so. The deciding board found that therefore

the sole description on file was not consistent with the claims of the relevant claim request, meaning that the claims were not supported by the description as required by Article 84 EPC.

The deciding board held in points 3.1.1, 3.1.2, 3.1.7 and 3.1.9 of the Reasons that:

"One of the requirements of Article 84 EPC is that the 'claims ... shall be ... supported by the description'. According to long established case law of the Boards of Appeal, this has been interpreted as requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC. In this context see, for example: T 0977/94, Reasons 6.1; T 0300/04, Reasons 5; T 1808/06, Reasons 2, first paragraph.

That this is the established case law of the Boards can also be gleaned from the Rules of Procedure of the Boards of Appeal (RPBA 2020) where, with regard to Article 11 thereof, the explanatory remarks (see the second paragraph thereof) deal with the case where remittal to the department of first instance is still provided for the purpose of adaptation of the description.

[...]

The present Board concurs that according to Article 84 EPC, claims must be clear in themselves. However, it is important to note that Article 84 EPC is not entitled 'clarity of the claims', on which the Board in case T 1989/18 however put its emphasis, but simply 'claims'. Thus the provision relates to claims in general and actually covers three distinct requirements

on claims, namely their clarity, their conciseness and their support by the description. According to the present Board, the criterion that the claims be 'supported by the description' is not in any way subordinate to the requirement of 'clarity' of the claims, but is a requirement of its own (as is conciseness of the claims).

[...]

*Hence, **the Board finds that 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.** Considering also Article 84 EPC in the wider context of the EPC, this understanding of the provision seems to be in line with the standard of claim interpretation for national proceedings enshrined in Article 69(1) EPC, according to which the description is also to be taken into account when interpreting the claims."* (Emphasis in bold added by the current board.)

T 1024/18 has been cited in other decisions that agreed with and explicitly referred to T 1024/18. For instance, in both T 447/22 and T 2685/19 (both opposition-appeal proceedings), the description contained an embodiment that, after the relevant claim had been amended, no longer fell within the claim. In each case, the deciding board referred to Article 84 EPC as the legal basis for bringing the description in line with the amended claim to avoid inconsistencies between the description and the amended claim (see T 447/22, point 75 of the Reasons and T 2685/19, point 6 of the Reasons). Further examples of decisions in opposition-appeal proceedings include T 1516/20,

point 5.3 of the Reasons; T 121/20, point 10.2 of the Reasons; T 2293/18, point 3.3.5 of the Reasons; T 1968/18, point 7.10 of the Reasons; T 2766/17, point 6 of the Reasons and T 2378/13, point 6 of the Reasons. An example of examination-appeal proceedings is T 3097/19, point 34 of the Reasons.

(b) Article 84 EPC alone as a legal basis: decisions not relying on T 1024/18 as a guiding decision

Decisions relying on Article 84 EPC alone as a legal basis without referring to T 1024/18 include T 169/20. In this decision, which was taken in opposition-appeal proceedings, the deciding board explicitly referred to Article 84 EPC, the second sentence in particular, as the legal basis. The deciding board held that the function of the description is to disclose the claimed invention in such terms that the technical context can be understood. Inconsistencies between the description and the claims would prevent a correct understanding and therefore needed to be removed. The deciding board held that:

*"In the board's view, **the requirement in Article 84 EPC, 2nd sentence that the claims shall be 'supported by the description'**, as well as the corresponding expressions in the other official languages ('[Die Patentansprüche müssen] von der Beschreibung gestützt werden' in German or '[les revendications doivent] se fonder sur la description' in French), provides a direct and unambiguous **indication of the description's function as a support for understanding the subject-matter of the claims.***

While this provision is primarily applied to require that the claims be brought in line with the technical

teachings of the description (i.e. due to an essential feature missing from the claim), or that the description be adapted to disclose the same invention as the claims, these issues ultimately seek to eliminate inconsistencies in order to enable the supporting function of the description as an aid for understanding the claims.

[...]

The board thus considers that the condition 'supported by the description' in Article 84 EPC provides a legal basis for determining how and when claims should be interpreted in the light of the description. In particular, the wording of this provision explicitly limits the role of the description to an aid for understanding the subject-matter to be assessed under patentability, while implicitly confining this role to the exceptional cases where such support is both necessary and possible. The support of the description should be resorted to only in case of need, since it is the wording of the claims which defines the matter for which protection is sought (i.e. the invention) and it would not be justified to seek help in understanding a subject-matter which is in itself clear. Moreover, this support is only possible to the extent that there is a correspondence between the description and the subject matter of the claimed invention, so that the technical explanations in the description can serve to illustrate the meaning of the claimed features and not to limit or modify their scope with respect to what a person skilled in the art would understand when reading them." (Point 1.2.5 of the Reasons, emphasis in bold added by the current board.)

Further decisions dealing with opposition-appeal proceedings and without citing T 1024/18 referring to Article 84 EPC alone include T 673/22, point 6.3.1 of the Reasons; T 1784/21, point 5.1 of the Reasons; T 1695/21, point 4.2 of the Reasons; T 623/21, point 2.2 of the Reasons; T 454/20, points 6.4 and 6.5 of the Reasons; T 2391/18, point 3.3.5 of the Reasons; T 1579/17, point 12.5 of the Reasons; and T 2498/17, point 6.2 of the Reasons. A decision dealing with examination-appeal proceedings is T 1048/22, point 2.11 of the Reasons.

14.3.2 Article 84 EPC in combination with other legal provisions of the EPC as a legal basis

This section deals with case law under which Article 84 EPC is not a standalone requirement but has to be read together with other legal provisions.

(a) Article 84 EPC in combination with Article 94(3) EPC and Rules 42, 48 and 71(1) EPC as a legal basis

In T 438/22 (examination-appeal proceedings), an appeal was filed against the decision of the examining division to refuse a European patent application. The examining division had decided that the main request was unallowable since the description comprised claim-like clauses and therefore did not comply with the Guidelines F-IV, 4.4.

The deciding board found that the description, including the claim-like clauses it contained, must support the claims under Article 84 EPC. Although in this case the deciding board aligned itself with, *inter alia*, T 1024/18 (which gave Article 84 EPC alone as the legal basis), it held that Article 84 EPC alone was not

sufficient legal basis to require the removal of inconsistencies between the description and the amended claims. The deciding board read Article 84 EPC together with Article 94(3) EPC and Rules 42, 48 and 71(1) EPC. In point 2 of the catchword and point 5.5.3 of the Reasons, the deciding board stated:

*"It is a general and overarching objective, and as such also a 'requirement' of the Convention, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective is the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contains subject-matter which manifestly impedes a common understanding, **it is legitimate to insist on its removal under Articles 84 and 94(3) EPC and Rules 42, 48 and 71(1) EPC.**"* (Emphasis in bold added by the current board.)

(b) Article 84 EPC in combination with Rule 42 EPC as a legal basis

In T 1452/21 (examination-appeal proceedings), an appeal was filed by the applicant against the decision of the examining division.

In appeal, the deciding board found that the adaptation of the description complied with Article 84 EPC and Rule 42(1)(b) EPC. The deciding board considered that

several inconsistencies caused by the amendment of claims had been removed by the appellant's adaptation of the description (see point 5 of the Reasons).

Different boards also referred in other decisions to a combination of Article 84 EPC and Rule 42 EPC or the corresponding Rule 27 EPC 1973. In some cases, reference was made to Rule 42 EPC; in others, the deciding board specifically referred to Rule 42(1) (b) or (c) EPC as the legal basis. By way of example, reference is made to T 3003/18, point 4.2 of the Reasons; T 2414/18, point 8 of the Reasons; T 73/04, points 4.1 to 4.2 of the Reasons; T 430/02, point 7 of the Reasons; T 619/00, point 7 of the Reasons (all opposition-appeal proceedings) and T 1745/22, point 3.2 of the Reasons; T 1426/21, points 2.3, 2.6 and 2.7 of the Reasons; T 237/16, point 4 of the Reasons; T 13/84, point 20 of the Reasons; T 11/82, point 5 of the Reasons (all examination-appeal proceedings).

14.3.3 Rule 42 EPC alone as a legal basis

In T 140/19 (opposition-appeal proceedings), the deciding board held that adaptation of the description was needed and exclusively cited Rule 42 EPC. The case was remitted to the opposition division for adaptation of the description (see point 13 of the Reasons).

14.3.4 The requirements of the EPC as a legal basis

In a few cases, the deciding boards referred in very general terms to the requirements of the EPC to support the requirement to adapt the description to the amended claims.

In T 1472/21, the deciding board found that it was unnecessary to further adapt the description after an amended claim was limited by replacing a "water sensor" (Wassersensor) with a "humidity sensor" (Feuchtigkeitssensor). The water sensor in the original description was found not to contradict the humidity sensor in the claimed subject-matter. It was decided that the adapted description met the requirements of the EPC and that there was therefore no need for further adaptation (see T 1472/21, point 4 of the Reasons).

In T 250/20, it was decided that the requirements of the EPC were not contravened, and therefore no adaptation of the description was needed because there was no contradiction between the amended claims and the description (see point 13.4 of the Reasons).

14.3.5 For reasons of consistency - general rule of law

In T 1571/22, the board considered that the adaptation of the description had brought the description in line with the claims in accordance with auxiliary request 3 and was therefore considered to meet the requirement of consistency. The board found that it was not necessary to delete from the description an embodiment which was not excluded by the claimed process and was not in contradiction with the interpretation of the relevant claim.

14.4 In the first line of case law, when a deciding board considered inconsistencies to be present and no adaptation of the description was made, the deciding board held that the request was unallowable and that the non-compliance led to the revocation of the patent or the refusal of the patent application.

For instance, in decision T 1024/18, discussed above, the deciding board observed the following (point 3.1.12 of the Reasons):

"The Board thus finds that, at least due to the identified inconsistency between the claims and the description, the claims are not supported by the description. Consequently the requirement of Article 84 EPC that the claims be supported by the description is not met. Auxiliary request 2 is therefore not allowable." (See point 3.1.12 of the Reasons.)

In T 3097/19, also discussed above, the appeal of the applicant against the decision of the examining division refusing the application was dismissed. The deciding board held that (point 38 of the Reasons):

"As stated above, in the case at hand the way the invention is described in the description is inconsistent with the wording of the claims. As a consequence, the Board is convinced that the scope of protection cannot be determined precisely, due in particular to conflicting statements as to which features constitute the invention (see point 23a) and b)) and to the sweeping statement that new embodiments of the invention can be obtained by combining technical means (see 23 c)). Therefore, in the absence of an adapted description, the requirements of Article 84 EPC are not met."

In T 2685/19, discussed above, the appeal was dismissed. Auxiliary request IIIbis was found not to comply with Article 84 EPC since the description submitted for this auxiliary request was in

contradiction with the claims and therefore did not support the claims (see point 6 of the Reasons).

Lastly, in T 1579/17, discussed above, the patent was revoked. It was held that auxiliary requests 7 and 8 were not supported by the description (point 12.1 of the Reasons):

" [...] Since the respondent did not file an adapted description, the Board had to use the description as granted when deciding whether the patent could be maintained in amended form.

[...]

In detail, paragraph [0011] states that 'the present invention relates to an inserter (100) ...' according to claim 1 as granted. **This is in contrast with the claims** of auxiliary requests 7 and 8, which are directed to a method of priming an inserter.

Paragraphs [0019] and [0020] describe the features of a longitudinal groove in the plunger, and of the tube having a central lumen, as being optional. However, these features form part of the invention according to auxiliary requests 7 and 8. Furthermore, paragraph [0025] describes the T-shaped IUD as being optional, and paragraphs [0053] and [0106] state that the inserter of the invention may be used for a wide range of IUDs.

Yet the independent claims identify a specific (T-shaped) IUD as forming part of the invention.

Due to these contradictions between the claims and the description, the claims of auxiliary requests 7 and 8 are not supported by the description as required by

Article 84 EPC." (Emphasis in bold added by the current board.)

- 15. The second line of case law
 - 15.1 A few recent decisions are clearly divergent from the first line of case law. In these decisions, which were all taken in examination-appeal proceedings, it was decided that there is no legal basis for the refusal of a patent application if there is an inconsistency between any amended claims and the description caused by the claim amendment.
 - 15.1.1 The most recent decision, T 56/21, might be regarded as the most prominent decision of the second line of case law, having received much attention. However, this is not an isolated decision: it was preceded by T 1444/20 and T 1989/18, which seem to have paved the way for it. A third case, T 2194/19, following the same line, also preceded T 56/21.
 - 15.1.2 The decisions under the second line of case law share the underlying idea that there is no legal basis in the EPC or its Implementing Rules to refuse an application when an amendment of claims has caused an inconsistency with the description and the description is not adapted.

Under this second line of case law, the inconsistent description and the possible consequences are the applicant's responsibility. As a consequence, it was held by the deciding boards in this line of case law that it is the applicant that remains responsible for the wording of the application and for defining the subject-matter for which it seeks protection.

15.1.3 The decisions that follow this line of case law reject that Article 84 EPC, alone or combined with other legal provisions, can be relied upon to serve as a legal basis for adaptation of the description.

The first decision of this line of case law is T 1989/18, which served to inspire a new and diverging line of case law.

In this decision, the applicant filed an appeal against the examining division's decision to refuse the European patent application. The examining division had refused the application because it considered the set of claims of the main request to be allowable but that the amendments of the description adapted to those claims did not comply with the requirements of Article 84 EPC, in particular because they related to subject-matter which was broader than the subject-matter of claim 17 of the request (see point 2 of the Reasons).

The deciding board held that if claims were clear in themselves and supported by the description, their clarity was not affected if the description contained subject-matter which was not claimed. Article 84 EPC could not serve as a legal basis for a refusal in such instances (point 7 of the Reasons).

The deciding board turned to the *Travaux Préparatoires* (Minutes of the proceedings of Main Committee I of the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents, document M/PR/I, No. 2225 to 2236), in which it found a general acceptance that a patent application should not be refused even if the application contained statements or matter contrary to "l'ordre public" or morality. The

board then decided that this meant that if an application could not be refused under these circumstances, it could not have been the intent of the legislator that applications could be refused for less severe reasons consisting in a description inconsistent with the claims (point 11 of the Reasons).

The deciding board therefore held that there was no legal basis to require an applicant to adapt a description such that it is consistent with amended claims. It was decided that none of Article 84 EPC, Rule 42(1)(c) EPC and Rule 48 EPC could serve as a legal basis for the refusal of an application if the description affected by an inconsistency with the claims was not adapted.

The deciding board justified this decision as follows:

"Article 84 EPC only mentions the description in the context of the additional requirement that it must support the claims. Under this requirement, the subject-matter of the claim must be taken from the description, it being inadmissible to claim any subject-matter which is not described. However, when assessing clarity, the description cannot be relied upon to resolve a clarity issue in a claim, nor can it give rise to any such issue if the definition of the subject-matter in a claim is clear per se. In particular, if the claims are clear in themselves and supported by the description, their clarity is not affected if the description contains subject-matter which is not claimed." (Emphasis in bold added by the board, point 5 of the Reasons.)

"[...] However, in the absence of an objection of lack of unity under Article 82 EPC, the board fails to see how

the above-mentioned provision [Rule 42(1)(c) EPC] could be the legal basis for requiring the applicant, as a general rule, to bring the description in line with claims intended for grant, and to remove passages of the description that disclose embodiments which are not claimed." (Text in squared brackets added by the current board, point 8 of the Reasons.)

"As set out in point 9, according to the wording and history of Rule 48 EPC, it does not pertain to patent specifications. Furthermore, points (a) to (c) of Rule 48(1) EPC are in the order of their offensiveness, ranking from high to low. This is reflected in paragraphs (2) and (3) of Rule 48 EPC. At the Munich diplomatic conference, there was general acceptance that the application should not be refused even if the application as filed contained statements or other matter contrary to 'ordre public' or morality. Moreover, Rule 48(3) EPC remained optional (see Minutes of the proceedings of Main Committee I of the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents, document M/PR/I, No. 2225 to 2236). It is therefore difficult to conceive that the legislator intended to impose more severe sanctions on less offensive matter, in particular to provide a ground for refusal based on the inclusion of merely 'irrelevant or unnecessary' matter (see also the doubts expressed in decision T 1065/99, point 7)

Therefore, Rule 48 EPC cannot serve as a legal basis for the refusal either." (Emphasis in bold added by the current board, points 11 and 12 of the Reasons.)

In T 1444/20, the deciding board agreed with T 1989/18. The board held that none of Article 84 EPC, Rule 42(1)(c) EPC and Rule 48(1)(c) EPC could serve as a legal

basis to require the applicant to adapt the description to remedy any inconsistency. The board decided as follows (points 2.1, 2.6 and 3.3. of the Reasons):

"The claims of a patent application define the matter for which protection is sought. Article 84 EPC requires this definition to be clear. This means that the claims must be clear in themselves for a person skilled in the art with common general knowledge of the technical field in question, without the need to refer to the description (T 412/03, Reasons 2.4.1). Article 84 EPC also requires the claims to be concise and be supported by the description."

"As an additional remark, the Guidelines for Examination in the EPO (version of 11 November 2019), in point F-IV, 4.4, are inconsistent in that they acknowledge, on the one hand, that claim-like clauses may (or may not) give rise to a lack of clarity, but require, on the other hand, that such claim-like clauses must always be removed. If claim-like clauses in the description do not result in a lack of clarity of the actual claims, Article 84 EPC cannot provide the justification for removing them."

"Nevertheless, on closer analysis, the wording and history of this provision suggest that this was not its intended purpose. The board agrees in this regard with the analysis provided in decision T 1989/18, Reasons 9 and 10."

A second decision in which the deciding board concurred with T 1989/18 was T 2194/19. Both Article 84 EPC and Rule 42(1)(c) EPC were rejected as a basis for a mandatory adaptation of the description. The board held that deciding otherwise would go against the scope of

application of either Article 84 EPC or Rule 42(1)(c) EPC.

More specifically, the board held (points 6.2.2 and 6.2.3 of the Reasons):

"Secondly, this board takes issue with the conclusion that the requirement that the claims are to be supported by the description (Article 84, second sentence, EPC) necessarily means that all the 'embodiments' of the description of a patent application have to be covered by the (independent) claims, i.e. that all the embodiments must fall within the scope of those claims. This conclusion cannot be derived from the EPC. It can also not be derived from the jurisprudence of the Boards of Appeal, according to which merely inconsistencies or contradictions between the claims and the underlying description are to be avoided in that context (see e.g. T 1808/06, Reasons 2; T 2293/18, Reasons 3.3.5)."

"Thirdly, the board considers that in particular Rule 42(1)(c) EPC cannot be the legal basis for establishing such a general and broad requirement for an adaptation of the description to the claims. It is simply not what this provision says. Rule 42(1)(c) EPC requires that the description discloses the invention, as claimed, in such terms that the technical problem and its solution can be understood, and that it states any advantageous effects of the invention with reference to the background art. These requirements set out in Rule 42(1)(c) EPC, however, cannot be taken to mean that all the embodiments described in the description of a patent application have to fall within the scope of the claims."

In the most recent decision of the second line of case law, T 56/21, the applicant filed an appeal against the examining division's decision to refuse the European patent application. The examining division based its decision on the presence of claim-like clauses in the description that rendered the application unclear contrary to the requirements of Article 84 EPC and held that the description contained numbered embodiments in a form as used for claims that had to be removed under the Guidelines, F-IV, 4.4 and in line with decisions under Article 84 EPC. The description further included matter repeated elsewhere in the application and was therefore contrary to the requirements of Rule 48(1)(c) EPC.

The deciding board, in setting this decision aside, held that: *"In examination of a patent application, neither Article 84 nor Rules 42, 43 and 48 EPC provide a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter."* (See catchword.)

In this decision, the board referred explicitly to T 1989/18, with which it fully agreed.

According to the deciding board, *"[...] the practice for requiring the description to be aligned to the more restricted subject-matter of claims, which are found allowable, is based on the view that Article 84 EPC is linked or even subordinate to Article 69 EPC"* (point 27 of the Reasons). More specifically, *"[t]he requirement for the description of an application or a patent to be adapted to claims of restricted subject-matter before grant or maintenance of a patent appears to have its origin in the policy consideration of ensuring a reasonable degree of certainty for third parties in*

determining the extent of protection as set forth in the Protocol 1973" (point 69 of the Reasons).

The deciding board expressed reservations about this practice. It saw an important distinction between the functions of Articles 84 and 69(1) EPC (point 15 of the Reasons) and observed: *"In fact, the assessment of patentability, which is a task entrusted to the examining divisions of the EPO alone, should be kept separate from the determination of the extent of protection conferred by a patent, which is a matter for consideration by national courts in infringement proceedings"* (point 30 of the Reasons).

Furthermore, in the deciding board's view, the requirement of support in the description as contained in Article 84 EPC only meant that the subject-matter of a claim must be taken from the description and that it is not admissible to claim subject-matter which is not described. But this, the deciding board underlined, did not support a requirement to bring the description into agreement with claims intended for grant by deleting or disclaiming subject-matter in the description which is not claimed (point 53 of the Reasons).

- 15.2 In the above-discussed second line of case law, the deciding boards considered that an inconsistency between an amended claim and the description was no impediment to grant a patent.
- 15.3 In the decisions in accordance with this second line of case law, the cases were remitted to the examining division with the order to grant a patent on the basis of the non-adapted description (T 1989/18, T 1444/20 and T 56/21) or for further prosecution (T 2194/19).

16. Case law from other courts

- 16.1 In a recent case from 30 April 2025, AGFA NV v Gucci Sweden AB et al., the local division of the Unified Patent Court in Hamburg (in the following, the local division) held that the claims must always be interpreted with the aid of the description and drawings.
- 16.2 The case concerned AGFA's European patent No. 3 388 490 B1. This patent, with the title "*Decorating Natural Leather*", covers a manufacturing method allowing natural leather to be embellished with a decorative image. The patent was granted, and no opposition was filed.
- 16.3 AGFA NV sued the defendants for infringement before the local division. The defendants filed a counterclaim for invalidity of the patent.
- 16.4 During proceedings before the examining division of the EPO, the patent proprietor had deleted the feature "chromatic colour" from the wording of claim 1 as filed to distinguish the invention from the prior art. The local division found that the proprietor had not adapted the description to this amended claim.
- 16.5 In its decision, the local division held that the description and the drawings must always be considered, even when the claims seem to be clear.
- 16.6 The local division further held that the deletion of the feature "chromatic colour" in claim 1 during examination proceedings while the description remained the same had created an inconsistency between the granted claims and the description. The passages in the

description mentioning "chromatic" should therefore have been deleted (point IV.2 c) bb) of the Final Order of the Court of First Instance of the Unified Patent Court, 30 April 2025).

- 16.7 More specifically, the local division decided as follows in point IV.2 c) bb) of the decision:

*"As a consequence, the embodiment described in para. [0029] has fallen out of the granted claim 1, because it would have led to a chromatic colour in the sense of the patent. The same applies for example 3, which is clearly no longer a part of the invention as the base coat would be 'pale yellow' and therefore cannot be achromatic, either. The unchanged remainder of para. [0029] apparently is a mistake like the similar one in claim 10. **The inconsistency is also evident in other parts of the description. There are several passages mentioning 'chromatic' in the specification of the patent that should have been deleted: page 3, line 56 in the first definition of the invention and page 6 lines 17 and 45. It is immediately apparent that the specification is not consistent with the granted claims.**"* (Emphasis in bold added by the current board.)

- 16.8 The claims for infringement and invalidity were both rejected. The local division did not see any legal impediment to upholding a patent with a broader description inconsistent with a limited claim and merely decided that a patent proprietor cannot rely on such an inconsistent description to interpret the limited claim.

17. *Travaux Préparatoires*

Incidentally, the board also looked at the *Travaux Préparatoires* but could not find any guidance on how the above question should be answered. It does not find the view expressed in T 1989/18 convincing that since according to the *Travaux Préparatoires* an application should not be refused even if it contains statements or matter contrary to "l'ordre public" or morality, it cannot have been the intent of the legislator that applications could be refused for less severe reasons consisting in a description inconsistent with the claims. More specifically, in the current board's view, "l'ordre public" or morality are governed by Article 53(a) EPC, which is unrelated to the legal requirements potentially relevant to an inconsistency between a description and amended claims.

18. The need for a referral

19. The first referral question is the one addressed above (see section 10.6). For the sake of convenience, this question is reiterated here:

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?

20. For a referral to be admissible, it is generally considered necessary that the decision of the Enlarged

Board on the referred question(s) be decisive for the outcome of the referral case.

20.1 As set out above (section 10.6), in the case at hand, the answer to the above question is needed to decide whether the request based on the claims of auxiliary request 1E with the description as amended during the oral proceedings before the opposition division is allowable.

21. Article 112(1)(a) EPC provides that a board, during proceedings on a case and either of its own motion or following a request from a party to the appeal, must refer any question to the Enlarged Board of Appeal if it considers that a decision is required to ensure uniform application of the law or if a point of law of fundamental importance arises.

21.1 As set out above, the case law of the boards relevant to answer the above question is clearly divergent. The divergence concerns both whether the above question has to be answered in the positive (first line of case law) or negative (second line of case law) and, if it is to be answered in the positive, what the legal basis is. In view of this divergence as regards the legal basis, the board refers a further question to the Enlarged Board of Appeal:

If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?

21.2 Since, on both questions, the case law is divergent, answers by the Enlarged Board of Appeal are needed to ensure uniform application of the law.

- 21.3 As stated above, the current case is about opposition-appeal proceedings. Nevertheless, since the same divergence of case law exists for examination-appeal proceedings (see sections 14 and 15 above), the board considers it useful to refer the following further question to the Enlarged Board of Appeal:

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?

- 21.4 These questions are not only decisive for the current case, they are also fundamental questions of law that affect the practice of the boards and all other departments of the EPO.

The fundamental character of these questions is reinforced by the order in G 1/24, which states that "*[t]he description and drawings shall **always** be consulted to interpret the claims when assessing the patentability of an invention under Articles 52 to 57 EPC, and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation*" (see G 1/24, order, emphasis in bold added by the current board).

Following G 1/24, the question whether an application can be granted or a patent can be upheld if there is an inconsistency between an amended claim and the description has become of even greater significance.

22. The board sent out a communication pursuant to Rule 100(2) EPC on 26 March 2025 communicating four

provisional referral questions to the parties for comment.

22.1 In deciding to refer the questions contained in the order below to the Enlarged Board of Appeal, the board did not take the patent proprietor's comments into account. These comments all concerned the question of under which circumstances something is an inconsistency. This is not what the current referral is about. In the case at hand, the board has come to the conclusion that an inconsistency is present between the description as amended during the oral proceedings before the opposition division and the claims of auxiliary request 1E (point 10.5 above). When discussing this issue with the parties, no divergence as regards this question was pointed out by the parties, and none is known to the board. Therefore, this issue has been decided in this case without any need for a referral to the Enlarged Board of Appeal. Furthermore, whether an inconsistency is present in a certain case between a certain passage of the description and a certain amendment in a claim is a case-specific question and may depend on questions of fact. It therefore is not an issue that can and should be referred to the Enlarged Board of Appeal.

22.2 Question 3 has been amended along the lines proposed by the opponent in its submission dated 26 May 2025.

22.3 The board had proposed in its communication to refer also the following question to the Enlarged Board of Appeal:

If the first question cannot be unconditionally answered in the affirmative, what are the conditions

under which adaptation of the description is necessary to comply with the requirements of the EPC?

Upon further reflection, the board takes the view that this question does not need to be referred to the Enlarged Board of Appeal since the board assumes that if the Enlarged Board of Appeal should be of the view that the first question can only be answered in the affirmative if certain conditions, apart from the inconsistency referred to in the first question, are fulfilled, it will state so in its decision.

Furthermore, none of the decisions found by the board referred to any such additional condition, apart from the inconsistency referred to in the first question.

For the same reason, the board decided not to refer the question proposed by the opponent on the last page of its submission of 26 May 2025 to the Enlarged Board of Appeal.

- 22.4 The board does not find the third-party observation filed on 23 May 2025 relevant since it does not relate to or at the very least is not relevant for the formulation of the referral questions.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal for decision:

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?

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated