

# Description amendment requirements at EPO

## Key messages:

At the conclusion of prosecution, the European Patent Office (EPO) reminds applicants to amend the description in line with the claims. Their aims are to:

- Improve clarity for third parties;
- Remove inconsistencies between granted claims and disclosure as filed.

Depending on the number and type of amendments required this could be potentially costly for the applicant and risks introducing other defects into the patent.

Description amendments are not new, but examiners are now directed to adopt a much stricter implementation. The issue is further complicated because EPO Examiners themselves have differing opinions on the subject. Examiners increasingly seek potentially problematic amendments, such as deletion of conflicting paragraphs, or even whole embodiments.

Any substantial amendments risk added matter, handing third parties grounds to attack the validity of a patent in opposition proceedings.

While wholesale deletion of embodiments can usually be avoided, compromises typically include statements in the description to disclaim embodiments “not in accordance with the claimed invention”.

## In practice:

The process of approving the text for grant with the EPO is not a formality and you should expect this step to have an impact on granting EP.

In extreme cases, the applicant may have to pursue oral proceedings. Or they may have to accept a rejection of their application in order to appeal the objections.

## Mitigation:

Applications should be drafted to avoid language that describes all figures as “embodiments of the invention” – simple “examples” is preferable

Include a comprehensive Summary of Invention to provide basis and arguments that every claimed feature is independent from other features

Include explicit statements, with examples, to point out which features of one example may be implemented with another