



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee Cannes, France, 25 to 29 September 2022

“Compulsory Amendment of Description and Drawings”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee at the World Congress held in Cannes, France, 25 to 29 September 2022, passed the following resolution:

CONSIDERING the practice of the European Patent Office (EPO) to require applicants and proprietors to remove from the description and drawings of European patent applications or patents (e.g. at the end of opposition proceedings) subject-matter which is not specifically recited by the claims,

NOTING that the Guidelines for examination in the EPO (“Guidelines”) allow applicants and proprietors to either remove from the description and drawings subject-matter which is not covered by the claims, or to alternatively present such subject-matter not as embodiments of the invention but as background art or examples useful for understanding the invention, in order to avoid potential inconsistencies between the claims and the description/drawings (Guidelines F-IV.4.3(iii)),

NOTING that there is a critical difference between subject-matter that falls outside the wording of the claims on the one hand and subject-matter that falls within the wording of the claims but is not explicitly recited as such in the claims on the other,

NOTING that, pursuant to Article 69 (1) of the European Patent Convention (EPC), while the extent of the protection conferred by a European patent or a European patent application shall be determined by the claims, the description and drawings shall be used to interpret the claims,



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NOTING that the practice of the EPO is inconsistent with all of the other IP5 Offices, as well as the vast majority of the Offices of the EPC Contracting States,

NOTING that decisions T1444/20 and T1989/18 made clear that no provision of the EPC, not even Art. 84 EPC, requires to delete or mark subject-matter which is not covered by the claims, however not followed by decisions T1024/18, T121/20, T2293/18, T2766/17 (as also mentioned in the Case Law of the Boards of Appeal 2022, II. A. 5, 5.3),

NOTING that decision T1989/18 supersedes decision T1808/06, which does not contain any thorough analysis of Art. 84 EPC and justifies the deletion of unclaimed subject-matter only in view of the guidelines (“to avoid inconsistencies”),

AFFIRMING that users benefit from harmonisation of practices and procedures at the IP5 and EPC national Offices,

ACKNOWLEDGING the position of the EPO in its press release of July 7, 2022 and the reference to T1024/18, T121/20, T2293/18, T2766/17 and T1516/20, which is confirming the current practice of the EPO,

WELCOMING that the EPO has conducted and established various discussions and user interactions to discuss the topic of adaptation of the description and within these discussions also the topic of compulsory amendments of descriptions and drawings,

WELCOMING that the EPO has invited FICPI in the bilateral meeting in July 2022 to prepare and provide a list of examples, which should be allowable under Article 84 EPC, where no compulsory amendments of descriptions and drawings are required,

ADVISING that amendment of the description and drawings can require substantial additional work by applicants, proprietors and/or their representatives, leading to significant increased costs,

ADVISING that the removal of subject-matter from the description and the drawing may adversely affect the position of an applicant or a proprietor at a later state, in particular in court proceedings,



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URGES the EPO to refrain from requesting the removal of any subject-matter from the description and the drawings of European patent applications or European patents, provided that the presence of such subject-matter does not throw doubt on the extent of protection.