



EPO CASE LAW · PAGE 2

European patents: Descriptions no longer need adapting just for form

The Enlarged Board sets a two-step test. We explain what changes for drafting, prosecution and opposition – and what still has to be amended.

UPC LITIGATION · 3

InterDigital v Disney: NDAs are no shield in FRAND disputes

UPC STATISTICS · 4

Düsseldorf overtakes Munich for the first time

BEST PRACTICE · 5

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EPO CASE LAW · ENLARGED BOARD OF APPEAL

G 1/25: Description amendments no longer needed just for form

On 3 September 2026, the Enlarged Board of Appeal decided when the description must be adapted to amended claims: only where an inconsistency actually breaches the EPC.

Background

The EPO has long required the description to be adapted to the claims as finally allowed – a requirement unknown at other major patent offices. After diverging Board decisions, T 697/22 (“Hydroponics”) referred the issue to the Enlarged Board.

A two-step test

Building on G 1/24 – the description is always consulted to interpret the claims (see our Q4 2025 issue) – the Enlarged Board asks two questions:

- 1. Is there an inconsistency?** Only if the description suggests an understanding of a claim that is incompatible with its apparent meaning and leaves the skilled person in real doubt. Examples outside the claims are not, in themselves, an inconsistency.
- 2. Does it breach the EPC?** Adaptation is needed only if the inconsistency breaches a specific

requirement: patentability, i.e. novelty and inventive step (Articles 52–57), clarity and support (Article 84), sufficiency of disclosure (Article 83) or the ban on added matter (Articles 76(1), 123(2) and (3)). The Board expects the last two to matter rarely, if ever. Formal concordance alone is not required.

An example

The description discloses feature A with optional features B or C, including examples A+B and A+C. The claim is limited to A+B. Example A+C can usually stay, as it is evidently not claimed. It must be adapted if the description still presents A+C as “the invention”, leaving real doubt about the claim’s scope – or if the claim was narrowed to overcome an inventive-step objection and the description still states that feature A alone achieves the effect.

Outlook

Next up is G 1/26 (“Coated steel strips”): how G 1/24 applies when assessing added matter.

TAKEAWAYS FOR PATENT PROSECUTION

- Embodiments and examples outside the amended claims need not be deleted or marked “not according to the invention” as a matter of routine, if they are evidently not claimed.
- Adapt them where the description presents them as “the invention” or it is otherwise unclear whether they are covered. Neutral wording such as “embodiments of the disclosure” reduces, but does not eliminate, this risk.
- Where claims were narrowed to overcome novelty or inventive-step objections, remove statements that still reflect the broader, pre-amendment teaching – we review this before grant.

UPC LITIGATION · LOCAL DIVISION DÜSSELDORF

NDA's are no shield: UPC shifts the risk of hidden FRAND negotiations

In *InterDigital v Disney*, the Düsseldorf local division turned a recurring problem in licensing disputes into a clear rule: whoever blocks the court's view of the negotiations bears the consequences.

The case

On 23 July 2026, the Düsseldorf local division enjoined Disney+ for infringing an InterDigital video coding patent (UPC_CFI_87/2025), following a Mannheim ruling on a parallel patent in June. Disney raised a FRAND defence under *Huawei v ZTE*.

The problem

A FRAND defence requires the court to review the negotiations, above all the licence offer and the response to it. Here, the negotiations were covered by an NDA concluded at Disney's request, which prevented InterDigital from submitting its own offer. InterDigital proposed amending the NDA so that both sides could present the history under a confidentiality order. Disney did not respond in substance.

The court's answer

Two headnotes: if an NDA prevents a party from producing documents and the other side refuses without good reason to amend it, this counts against the refusing party. Negotiation steps the court therefore cannot examine are deemed to comply with *Huawei v ZTE*. The court does not question NDAs as such – it allocates the risk of the evidential gap to the party that created it.

How far it goes

Mannheim had already treated the refusal as a sign of unwillingness; Düsseldorf has now stated the principle expressly. Two caveats: both courts first found the claims not standard-essential, so the NDA reasoning applies in the alternative, and both decisions are open to appeal.

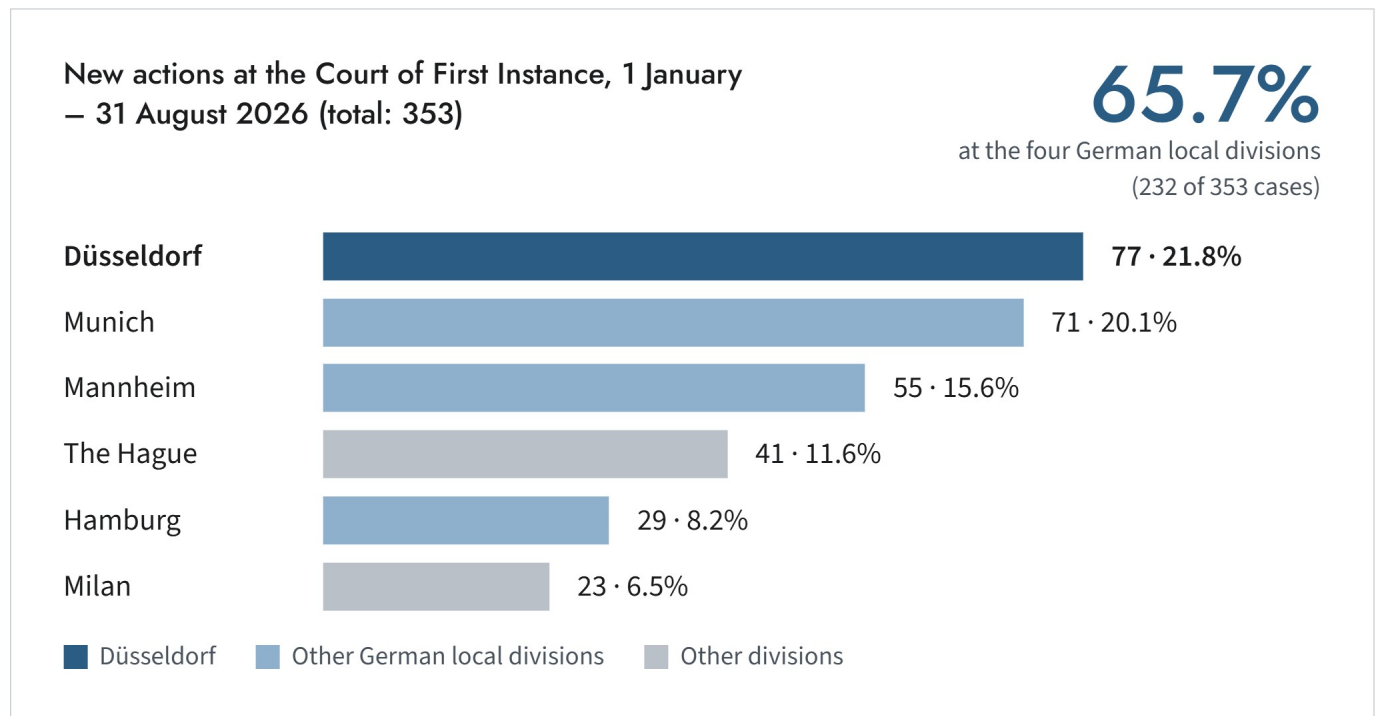
TAKEAWAYS FOR SEP HOLDERS AND IMPLEMENTERS

- Include a clause in NDAs allowing disclosure to courts under a confidentiality order.
- If the other side proposes such an amendment, refusing it is a litigation risk.
- Keep a complete, dated record of offers, counteroffers and correspondence.

UPC STATISTICS

Düsseldorf overtakes Munich for the first time

New UPC figures for January to August 2026 show a shift among the busiest local divisions – and confirm Germany as the centre of UPC litigation.



For the first time, Düsseldorf received more new cases than Munich. Together with Mannheim and Hamburg, the German local divisions handled around two in three new cases. The Hague has overtaken Hamburg, and Milan is also growing. English remains the main language: about 62% of first-instance and 67% of appeal proceedings.

These figures cover 2026 only; our Q4 2025 issue showed cumulative figures since June 2023.

GULDE AT THE GERMAN UPC VENUES

With offices in Düsseldorf, Munich and Hamburg, we are on site at three of the four German local divisions – including what is now the UPC's busiest.

GULDE BEST PRACTICE

EPO filing fee optimisation: Pay for content, not for layout

The EPO charges EUR 17 for the 36th and each further page. For translated Euro-PCT applications, these fees add up quickly – so we have automated a tool that keeps them to a minimum.

How pages are counted

On entry into the European phase, the page fee is generally based on the international application as published – even if it was published in a non-EPO language such as Japanese, Chinese or Korean. This changes when amended documents are filed on entry: their pages replace the corresponding published pages. If the application was not published in an EPO language, the fee for an amended description is based on the translation filed.

Automated format optimisation

Whenever amended documents or translations containing amendments are filed, we format them to make full use of the margins, line spacing and character sizes permitted under Rule 49 EPC – whatever format our clients supply. The content stays the same; the official fees go down.

Timing matters

Amendments filed after the page fee has been paid – for example in response to the (supplementary) European search report – are not counted, and fees already paid are not refunded. We therefore check for each case whether minor amendments are needed on entry or can wait.

EXAMPLE (ILLUSTRATIVE)

International application published in Japanese: 40 pages, 30 of them description. The English translation of the description runs to 70 pages.

No amendments on entry: 40 pages counted, 5 of them fee-bearing	EUR 85
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Minor description amendment filed on entry: the 70-page translation replaces 30 published pages – 80 pages counted, 45 fee-bearing	EUR 765
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Same amendment filed later, in response to the (supplementary) European search report: 40 pages counted, 5 fee-bearing	EUR 85
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Difference: **EUR 680** for exactly the same amendment – simply by choosing the right moment.

Talk to us before entering the European phase – we review which amendments are needed on entry and which can wait.



Let's talk about your IP

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