FEMIPI

Fédération Européenne des Mandataires de l'Industrie en Propriété Intellectuelle

Europäischer Verband der Industrie-Patentfachleute

European Federation of Intellectual Property Agents in Industry

Established in 1971

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Registry of the Enlarged Board of Appeal
Attention of Mr. Nicolas Michaleczek
(EBAamicuscuriae@epo.org)

Case: G 1/25

January 30, 2026

The following is a written statement by FEMIPI under Article 10 of the Rules of Procedure of the Enlarged Board of Appeal. The statement relates to referred questions 1, 2 and 3 of the case G1/25 (“Hydroponics”) currently pending at the Enlarged Board of Appeal.

FEMIPI is the European professional umbrella organization representing the interests of IP professionals, agents and IP owners in industry. FEMIPI has the objective of representing as many European professionals and agents active in industry as possible. The purpose of the Federation is the study, development and protection of the professional interests of intellectual property agents in industry with due consideration of the interests of the users of the IP systems in industry.

In the following, FEMIPI will present the organization’s view on the matter at hand. FEMIPI naturally agrees with the reasoning presented in T56/21.

1) No existing motivation for the new interpretation of A84

It is striking that the EPO does not provide a reasoning or motivation why a change in the practice and interpretation of A84 has been necessary. With the introduction in the Guidelines GL F-IV.4.3 in 2021 of the requirement to remove any inconsistencies between description and claims the only explanation given is that “The practice for adapting the description to follow in examination proceedings is set out in the Guidelines for Examination based on A84 EPC as interpreted and established in the predominant case law of the EPO’s boards of appeal” (EPO, Internal Procedural Instructions, 18. Nov. 2024). FEMIPI represents thousands of European patent professionals in industry practice and has never felt a need for changing the A84 interpretation and practice. It seems the desire for a new interpretation and practice has come from the EPO itself, and with no other motivation than the one cited above. Given the absence of a full and understandable reasoning, the new interpretation of A84 and new practice by the EPO appear unwarranted to FEMIPI.

2) The new interpretation of A84 is not harmonized with other jurisdictions, nor internally at the EPO

To the best of FEMIPI's knowledge none of the other big patent jurisdictions (USA, China, Japan, Korea) have implemented procedures and interpretations similar to EPO's new A84 interpretation. Thus, there can be no argument and motivation that the new procedure is caused by a requirement for international harmonization. Further, it is an open question where the national patent offices stand. Even further, practice until now has shown that the EPO internally has not been able to harmonize the new interpretation of A84 across its examiners. Members of FEMIPI have in recent years experienced very different procedural implementations from the examination divisions; some divisions applying the new interpretation of A84 often, others only seldomly.

3) EPO's new interpretation of A84 causes legal insecurity and weakens the patent

The (invented) requirement to bring the description into conformity with the claims leaves the applicant or patent holder with a job of limiting the scope of the patent even further. Not only have the requirements of novelty and inventive step limited the scope, now a further and more unclear restriction comes with the terms "not according to the invention". The clear cases where an embodiment obviously is not part of the invention are easy. The difficult cases, however, are the borderline cases where the applicant or patent owner must spend a considerable amount of time in evaluating the legal consequences of excising or exempting an embodiment from the description. Borderline cases exist: more than once have members of FEMIPI in an R71(6) response argued against A84 amendments in their new form as required by examiners, and more than once has the examiner conceded to the counter arguments and taken back the changes requested in the R71(3). For those applicants who accepted the first R71(3) because they wanted a fast patent, the text passages that were unnecessarily given up are then lost forever. The new interpretation of A84 causes legal insecurity in the examination phase ("did we excise too much?" or "did we introduce A123(2) violations?"), in the opposition phase (where it is unclear if one can reintroduce matter first deemed "not according to..." during the examination phase, and later during opposition found to be "according to"), and in the civil court, where statements and excisions under the new interpretation of A84 weaken the patent.

4) EPO's new interpretation of A84 causes extra work and unnecessary expenses

The new interpretation of A84 causes considerable extra work for the patent applicants and patent holders resulting in additional – and unnecessary - costs. In some cases, where the invention is important, some patent holders decide to file a divisional in order to safekeep the protection in case the mother application where the discussion about "not according to..." is ongoing, is rejected. This is a considerable extra cost incurred upon applicants by the EPO and in the view of FEMIPI unnecessary extra expenses. It cannot be ruled out that in extreme cases some patent applicants or patent holders might even consider seeking financial recourse against the EPO concerning such unwarranted extra costs. FEMIPI believes that the numbers of R71(6) communications and second R71(3)

communications have increased significantly and have led to delayed grants, higher workload at the EPO and more appeals.

5) No legal basis for the new interpretation of A84 by the EPO

The travaux preparatoire of the European Patent Convention does not support the interpretation by the EPO that the description must be amended to conform with the claims. At least FEMIPI has not found such support. If there is support in the travaux preparatoire FEMIPI asks the EPO to produce documentation. At the moment there is thus no reason to assume that the authors of the original EPC meant anything other than what A84 says today: that the claims shall be clear and concise and supported by the description. There is no mentioning or intent supporting the notion that the description shall be brought into agreement with the claims. The Guidelines for Examination in the EPO GL F-IV.4.3 do not constitute legally binding provisions. For proper legal basis reference to the EPC or case law is deemed mandatory. Further, the term “inconsistency” has been introduced by the EPO, but this word is not part of the EPC and certainly not part of A84. “Inconsistency” is mentioned in the Guidelines GL F-IV.4.3 iii: “... *the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description.”* In the eyes of FEMIPI there is no legal basis for this underlined interpretation.

6) Concluding answers to the three questions pending under G1/25 In short, FEMIPI answers the three questions under G1/25 accordingly:

1. No, the description should not be amended during opposition or opposition-appeal because the text elements in question might be important in a later civil court infringement case.
2. A84 and rules 42, 43 and 48 in their old interpretation cannot support the new interpretation of A84. The text of A84 is very clear, and if the new interpretation at the end should prevail, A84 needs to be amended because it clearly does not state and support the new interpretation in its current form.
3. No. The description should not be adapted to the claims in examination or examination-appeal proceedings because this causes unduly legal insecurity on the patent applicant.

FEMIPI is happy to elaborate on our arguments and recommendations if this is wished.

(Dr. Henning Lütjens)