



Session 4: Patents

Discussion on recent decisions of the Enlarged Board of Appeal,
including FICPI Amicus Brief.



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Revisiting G 1/92 and the Concept of “Availability to the Public”

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G 1/23 – The Stakes: Why This Matters

Central Question: What constitutes the "State of the Art" under Article 54(2) EPC?

Legal Consequences:

- **Novelty & Inventive Step:** If a product is "available," it can invalidate subsequent patent claims.
- **The "Social Contract":** Patents are granted in exchange for disclosure; if the public already has access to the info via a product, no monopoly should be granted.

Deep Dive – The Policy Shift:

- **Old View (G 1/92):** Knowledge is only "public" if you can physically replicate it.
- **New View (G 1/23):** Knowledge is "public" if you can extract information from it via analysis.

Practical Impact: Patent searches must now move beyond databases and include "teardown" analysis of existing market products.

What is “State of the Art”?

The Statutory Definition:

- Includes everything made available to the public by means of a written or oral description, by use, or in any other way.
- **G 1/92 Foundation:** "Everything made available to the public..." includes the internal structure of sold products.

The Three Pillars of Disclosure:

- **Written:** Patents, journals, manuals.
- **Oral:** Lectures, conferences.
- **By Use:** Products sold or displayed in public.

Key Legal Refinement:

- **Information vs. Object:** G 1/23 emphasizes that it is the *information* derived from the object that enters the state of the art, not just the physical item.

The Key Question: The “Black Box” Dilemma

Scenario: A company puts a sophisticated chemical compound or microchip on the market.

What becomes "Public Information"?

- **The Product Itself:** Clearly public.
- **External Properties:** Size, color, measurable weight (Extrinsic).
- **Internal Composition:** Chemical formula, layer structure (Intrinsic).
- **Manufacturing Process:** The "recipe" or hidden steps (Process).

The Conflict:

- If a product is sold but cannot be "decoded," is it actually part of human knowledge?
- **Practical Reality:** Modern reverse engineering (X-ray, Spectroscopy) makes almost every "Black Box" transparent.

G 1/92: The Traditional Rule (The Dual Test)

The Jurisprudence for 30 Years:

- A product is only "prior art" if a skilled person can:
 - **Analyze it:** Discover what it is.
 - **Reproduce it:** Make it again without undue burden.

The "Enabling Disclosure" Requirement:

- Borrowed from the rules for written descriptions: You must be able to "work" the invention.
- **Rationale:** If you can't build it, you don't "know" it in a way that benefits the public.

The Resulting Loophole:

- Complex materials (polymers, alloys) often escaped being "prior art" because their exact synthesis was a trade secret, even if the product was sold by the millions.

The Growing Problem: Reality vs. G 1/92

The Conflict with Modern Industry:

- In practice, many products are highly complex, proprietary, or even impossible to perfectly replicate without the original "recipe".
- **Examples:** Advanced polymers, complex pharmaceuticals, and high-tech alloys.

The Conceptual Tension:

- If a product is physically in the hands of the public, but the manufacturing steps are hidden, does it qualify as "known"?.
- **The Old Dilemma:** Under the strict G 1/92 rule, if you could not reproduce a marketed material, that material was legally "invisible" for novelty purposes.

Practical Insight: This created an "empty state of the art," where millions of sold products were ignored by patent examiners simply because the production method was secret.

G 1/23: The Modern Turning Point

Re-evaluating the "Reproducibility" Requirement:

- G 1/23 marks a significant shift: **Reproducibility is no longer a mandatory barrier** for a product to be considered prior art.
- The Enlarged Board of Appeal (EBA) ruled that a product cannot be excluded from the state of the art *solely* because it cannot be reproduced.

The "Absurd Result" Argument:

- If we required perfect reproducibility for everything, we would face an "infinite regress": every raw material used to make the product would also need to be reproducible.
- **Outcome:** The law now aligns with reality: knowledge equals **access**, not just the ability to manufacture.

Accessibility vs. Analysability

The New Hierarchy of Disclosure:

- **Accessibility:** Is the product available to the public?.
- **Analysability:** Can a skilled person discover its features using modern tools?.

What Information is Released?

- **Public:** All analysable properties and measurable features (e.g., chemical composition, layer thickness, mechanical strength).
- **Not Automatically Public:** Hidden manufacturing processes or extrinsic characteristics that leave no measurable trace on the final product.

Deep Dive: The "Skilled Person" is now viewed as an **analyst**, not necessarily a **manufacturer**.

The "No Motivation" Principle Reconfirmed

Objective Availability:

- Information is considered "available" the moment there is **direct and unambiguous access** to it.
- There is no requirement to prove that anyone *actually* analyzed the product or had a reason to do so.

The Legal Fiction:

- If a product is on a shelf in a store, the law assumes the skilled person has already analyzed it.
- **Accessibility ≠ Intention:** The patent system focuses on the *potential* for knowledge, not the *history* of its use.

Information vs. Reproduction (The Key Distinction)

The Core Philosophy of G 1/23:

- **Information belongs to the public:** If you can see it or measure it, it is part of the "State of the Art".
- **Manufacturing ability is secondary:** You don't need to know *how* to build a car to know that a car with four wheels exists.

Impact on Patentability:

- **Novelty:** All measurable information counts toward destroying novelty.
- **Inventive Step:** While information is public, a skilled person might still disregard "impractical" or non-reproducible disclosures when looking for a solution to a technical problem.

Practical Impact: This distinction forces patent drafters to focus on "non-measurable" process steps if they want to avoid prior art rejections based on their own previous products.

Novelty vs. Inventive Step (The Practical Split)

How G 1/23 Impacts the Legal Test:

- **Novelty (Art. 54 EPC):**

- The "State of the Art" now includes all information that can be extracted from a product through analysis.
- The inability to reproduce the product is no longer a "shield" against a novelty rejection.

- **Inventive Step (Art. 56 EPC):**

- The skilled person remains a rational actor.
- If a disclosure is technically "public" but practically "impractical" or non-reproducible, the skilled person may disregard it as a starting point for further development.

Key Takeaway: G 1/23 broadens the pool for **Novelty** but allows for nuanced arguments regarding **Inventive Step**.

Beyond Coca-Cola: A Technical Example

Case Study: High-Performance Thermoplastics

- **The Scenario:** A specific grade of carbon-fiber-reinforced polymer is sold globally.
- **What is Analyzable (Prior Art):**
 - Fiber-to-resin ratio, fiber orientation, and chemical structure of the matrix.
 - These features are now "known" because they are measurable.
- **What Remains Secret (Not Prior Art):**
 - The exact cooling rate in the mold or the specific sequence of catalyst addition.
 - If these "hidden processes" are what the new patent claims, the patent may still be valid.

The Lesson: "Knowledge" is defined by what the lab can see, not what the factory hides.

Summary of the Shift (G 1/92 vs. G 1/23)

Feature	G 1/92 (Old Rule)	G 1/23 (New Rule)
Primary Requirement	Analysis + Reproduction	Accessibility + Analysis
Reproducibility	Mandatory Barrier	Not Required for Disclosure
Legal Philosophy	Knowledge = Ability to Make	Knowledge = Ability to See/Measure
Industry Impact	Favorable to "Secret Recipes"	Realistic and Pro- Transparency

Practical Consequences for Practitioners

Strategic Advice for Patent Prosecution & Litigation:

- **For Applicants:**

- Be aware that your own marketed products are now "stronger" prior art against your future filings.
- Focus claims on manufacturing "know-how" that cannot be detected in the final product.

- **For Opponents:**

- The "non-reproducibility" defense is significantly weakened.
- Invest in high-end reverse engineering; if you can measure a feature, you can kill a claim.

The Burden of Proof: The "skilled person" is now assumed to be equipped with the latest analytical tools.

Final Takeaways

Aligning Patent Law with Modern Reality:

- **Availability is Key:** If a product is in the public's hands, its analyzable secrets are no longer "new".
 - **End of the "Reproducibility Loophole":** Complex chemical or technical structures can no longer hide behind a "difficult to manufacture" excuse.
 - **Balanced State of the Art:** The EPO has moved toward a more realistic definition of what the "Public Domain" actually contains.
- "In patent law, access to the object is access to its information."**

Case Study A – The AI “Black Box” Chip

Scenario: A company releases a next-generation AI accelerator chip. The hardware architecture (gate density, transistor size) is visible under an electron microscope, but the **firmware-level routing logic** and **weight-optimization algorithms** are hidden.

The G 1/23 Analysis:

- **Prior Art (Disclosed):** Any physical feature detectable via high-resolution imaging or signal probing (e.g., the specific arrangement of processing cores).
- **The "Reproducibility" Trap:** Under G 1/92, the patent owner might argue, *"You can see the cores, but you can't manufacture this chip without our proprietary lithography recipe, so it's not prior art."*
- **The New Reality:** If a competitor can measure the electrical output or map the physical traces, that architecture is **public**. The difficulty of building a rival fab is irrelevant.

Strategic Takeaway: Hardware layout is now highly vulnerable. Protection must shift toward the software-hardware interface that cannot be "probed" without destroying the data.

Case Study B – The Self-Assembling Nano-Polymer

Scenario: A pharmaceutical company markets a drug-delivery coating made of a polymer that "self-assembles" into a specific lattice at room temperature. The final lattice structure is easily measurable via X-ray crystallography.

The G 1/23 Analysis:

- **The Conflict:** The exact concentration of the specialized "initiator" catalyst used during synthesis is a trade secret and cannot be detected in the final dry coating.
- **What is Prior Art?** The **final lattice structure** and its **chemical proportions**. Because a skilled person can "see" the lattice, it is now part of the state of the art.
- **What is NOT Prior Art?** The specific temperature-ramping sequence used to trigger the self-assembly.

Strategic Takeaway: If you are the patentee, you should claim the **process** of synthesis. If you are the challenger, you only need to prove the **end-state** was measurable to destroy the novelty of the material itself.

Does this mean trade secrets are dead?

No. G 1/23 clarifies that only the **information** you can extract from the product enters the state of the art. The 'how-to'—the specific pressures, temperatures, or catalyst sequences that don't leave a measurable fingerprint—remains a valid area for patenting or trade secret protection. The law has simply caught up with the reality of modern reverse engineering.

Thank you.

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***Chair, Group 4: European Patents
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G 1/24 – “Heated Aerosol”

Technical Board of Appeal 3.3.01 has by interlocutory decision T 439/22 referred the following questions to the Enlarged Board of Appeal (referral pending under G 1/24 "Heated aerosol"):

- Is Article 69(1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?
- May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?
- May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?



G 1/24 – “Heated Aerosol”

Article 69⁶¹, ⁶²

Extent of protection

- (1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.
- (2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the claims contained in the application as published. However, the European patent as granted or as amended in opposition, limitation or revocation proceedings shall determine retroactively the protection conferred by the application, in so far as such protection is not thereby extended.

⁶¹ Amended by the Act revising the European Patent Convention of 29.11.2000.

The Protocol on the Interpretation of Article 69 EPC is an integral part of the Convention pursuant to [Article 164, paragraph 1](#).

⁶² See decisions of the Enlarged Board of Appeal [G 2/88](#), [G 6/88](#), [G 1/24](#) (Annex I).

<https://www.epo.org/en/legal/epc/2020/a69.html>



G 1/24 – FICPI Amicus Curiae Brief



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INTERNATIONALE VERBANDUNG
VON PATENTANWÄLTEN

Elia Sugrañes
Secretary General

15 November 2024

Registry of the Enlarged Board of Appeal
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
Germany

Attention: Mr. Nicolas Michaleczek

Via email: EBAamicuscuriae@epo.org

RE // Case Number G 1/24

Dear Mr. Michaleczek

FICPI is pleased to have the opportunity to submit this Amicus Curia Brief and provide comments with respect to the Referral to the Enlarged Board of Appeal – G1/24 ("heated aerosol").

Yours sincerely,

Elia Sugrañes
Secretary General

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15 November
2024

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G 1/24 – Heated Aerosol

Decision of the Enlarged Board of Appeal – G 1/24 (“Heated Aerosol”)

- The Enlarged Board issued its decision in case G 1/24 on June 18, 2025. It concluded that the claims are the starting point and the basis for assessing the patentability of an invention, and that the description and drawings must always be consulted to interpret the claims for this assessment.
- The Enlarged Board also referred to the harmonisation philosophy behind the EPC and noted that the case law of the UPC Court of Appeal on claim interpretation appeared to be consistent with its conclusions.
- This decision and its reasoning are in line with the position of FICPI, as outlined in its Amicus Curiae Brief.
- Further, FICPI welcomes the commitment of the EPO to patent law harmonization in patent law and also has an active role in the Substantive Patent Law Harmonisation (SPLH).



Robert Watson

Mewburn Ellis, UK

***President
Study & Work Committee***

G1/25 – Description Amendments

Background

- **Referral number:** G 1/25
- **Referred on:** 29 July 2025
- **Referring Board:** Technical Board of Appeal 3.3.02
- **Underlying case:** T 697/22 (opposition appeal)
- **Patent:** EP 2124521 (hydroponic growing medium)

- Auxiliary request 1E (claims and amended description) were filed in opposition oral proceedings and allowed by Opposition Division
- In Appeal Oral Proceedings, proprietor filed different amended description for AR 1E, as well as maintaining the original amended description
- Opponent pointed to inconsistency between the claims of AR 1E and the amended description, caused by the amendments filed

Diverging case law – First Line

- Most cases studied
- E.g. T1024/18 and T438/22

- Legal basis that requires description to be consistent with the amended claims
- Consistency can be achieved by deletion or insertion of additional statement

- Various legal basis cited, but no consensus!
 - Article 84 EPC
 - Article 84 EPC + another provision
 - Rule 42 EPC
 - General reference to requirements of EPC
 - Reference to general requirement of consistency

Diverging case law – Second Line

- A few cases studied
- All examination-appeal proceedings
- E.g. T56/21

- No Legal basis that requires description to be consistent with the amended claims

- Any inconsistency and possible consequences are applicant's responsibility

Diverging case law – Case law from other courts

- Early UPC case
- AGFA NV v Gucci Sweden AB (30 April 2025)
- Claims must always be interpreted with the aid of the description and drawings
- Inconsistency between description and claims – can't use broader description to interpret a limited claim

Need for a referral

- The referring board considered that the answer to the first question from the Enlarged Board would be decisive for the outcome of the referral case
- Depending on Enlarged Board decision, is AR 1E with initial amended description allowable?
- Clearly divergent case law
 - EB decision needed to ensure uniform application of the law
- 3rd question
 - Looks at exam appeal question

Referred questions

Question 1

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?

Questions 2 and 3

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?

FICPI Amicus Brief

- FICPI had already considered the issues at the heart of this case
- **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
- **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)),n proceedings) subject-matter which is not specifically recited by the claims,

- **OBSERVING** 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,
- **FURTHER OBSERVING** 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, and thus 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 stage, in particular in court proceedings,
- **FURTHER 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 and that users benefit from harmonisation of practices and procedures at the IP5 and EPC national Offices,

- **EMPHASING** that decisions T1444/20 and T1989/18 made clear that no provision of the EPC requires the deletion or marking of subject-matter which is not covered by the claims,
- **FURHTER NOTING** that these decisions are contradicted by T1024/18, T121/20, T2293/18 and T2766/17,
- **BELIEVING** that decision T1989/18 supersedes decision T1808/06, which does not contain any thorough analysis of Article 84 EPC and justifies the deletion of unclaimed subject-matter with reference to the Guidelines,
- **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,

- **URGES** the EPO to refrain from insisting on 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 by clearly contradicting the claims.

Amicus Brief - Inconsistency

- Definition of “inconsistency”
- Guidelines for examination, F-IV 4.3(iii) - *“Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought”*.
- Situation in which a hypothetical independent claim includes, e.g. the feature “A comprising B”, while the description discloses the features “A comprising B or C” or “A preferably comprising B”
- According to F-IV 4.3(iii), the description should be amended by deleting or disclaiming the unclaimed features (e.g. “A comprising B or C” or “A preferably comprising B”), otherwise the independent claim(s) would be “inconsistent” and thus not supported by the description.
- The presence of features or embodiments which are not encompassed by the wording of the claims would cause a lack of support also according to the first line of case law and to the objections of the opponent-appellant in case T 0697/22.

- Such as inconsistency cannot render a claim unclear, unless the description contains an explicit indication that a specific unclaimed subject-matter is covered by the claims, e.g. by using references such as “according to the claim” or “according to the claimed invention”. In this case, the description should be amended to remove any explicit reference to the claims, as it would throw doubt on their extent of protection.
- In all other cases, it is clear that, even in the most creative interpretation, unclaimed subject-matter (e.g. “A comprising C” and “A not comprising B”) is not encompassed by the wording of an independent claim (e.g. “A comprising B”), especially when the primacy of the claims is taken into account, as required by Art. 84 EPC, first sentence.

Amicus Brief - Clarity

- Therefore, unclaimed subject-matter in the description, as such, does not contradict the claims, so that it cannot throw doubt on their extent of protection.
- This is also indirectly confirmed by the fact that the first line of case law and the objections of the opponent-appellant in case T 0697/22 always indicate the support requirement, not the clarity requirement, as a basis for their objections.
- FICPI believes that the clarity requirement of Art. 84 EPC is not violated by the presence of unclaimed subject-matter in the description, provided that this subject-matter does not explicitly refer to the claims.

- Art. 84 EPC requires that the claims be supported by the description and there is no provision in the EPC requiring the description to be supported by the claims, i.e. requiring a one-to-one correspondence between description and claims.
- This is confirmed by the Guidelines for examination, F-IV, 6.1, which define the support requirement of Art. 84 EPC as follows:
- *“The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (see T 409/91). Regarding the support of dependent claims by the description, see F-IV, 6.6.”*

Amicus Brief - Clarity

- According to the Guidelines for examination, F-IV, 6.1, the support requirement of Art. 84 EPC is satisfied when claimed subject-matter is included in the description, not vice versa.
- This interpretation substantially corresponds with the “universal” interpretation adopted by the other patent offices, as explained e.g. at paragraphs 58-78 of the “Study on the sufficiency of disclosure” SCP/22/4 of WIPO :
- *“59. The meaning of the term “the claims shall be fully supported by the description” is largely similar in most jurisdictions. In general, the term means that there must be a basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than is justified by the description and drawings. The examination guidelines of some offices also add that the scope of the claims must not be broader than is justified by “the contribution to the art”.”*

- We observe that the same interpretation can be found in the first version (4419/IV/63D) of the support requirement discussed in 1963 during the Travaux Préparatoires of the EPC :
- *Art. 68 (5) No patent claim may contain any subject matter that is not disclosed in the description.*
- A second version (Art. 66(1), BR/68/70) corresponding to Art. 6 PCT, was proposed in 1970. However, at the beginning of 1972 (Art. 71(a) BR/169/72) it was considered “*whether, as most of the organizations proposed, the word “fully” should be deleted and whether it should be replaced by a less restrictive wording.*” (emphasis added). Soon after, (Art. BR/177/72) the term “fully” was deleted without any replacement, to arrive to the current version of Art. 84 EPC.
- Thus, this “less restrictive” interpretation of the support requirement can be found in:
 - a) the second line of case law mentioned in T 0697/22,
 - b) the EPO Guidelines for examination, F-IV, 6.1 and 6.6,
 - c) the “universal” interpretation adopted by the other patent offices, and
 - d) the Travaux Préparatoires of the EPC.

Amicus Brief - Clarity

- On the other hand, as mentioned before, the Guidelines for examination, F-IV, 4.3, propose a stricter interpretation requiring description amendments.
- However, F -IV, 4.3 does not explain why unclaimed subject-matter in the description would violate the support requirement, since this violation is already taken for granted, as follows:
- *“According to Art. 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description.”*
- Also the decisions cited by the first line of case law (see e.g. T 1024/18, point 3.1.1., and T 0438/22, point 4.6) do not provide any proper explanation on why claims which are supported by subject-matter included in the description are no longer supported when the description also contains unclaimed subject-matter.
- In view of the above, FICPI believes the support requirement of Art. 84 EPC means that claimed subject-matter must be present in the description and nothing else, so that that the presence

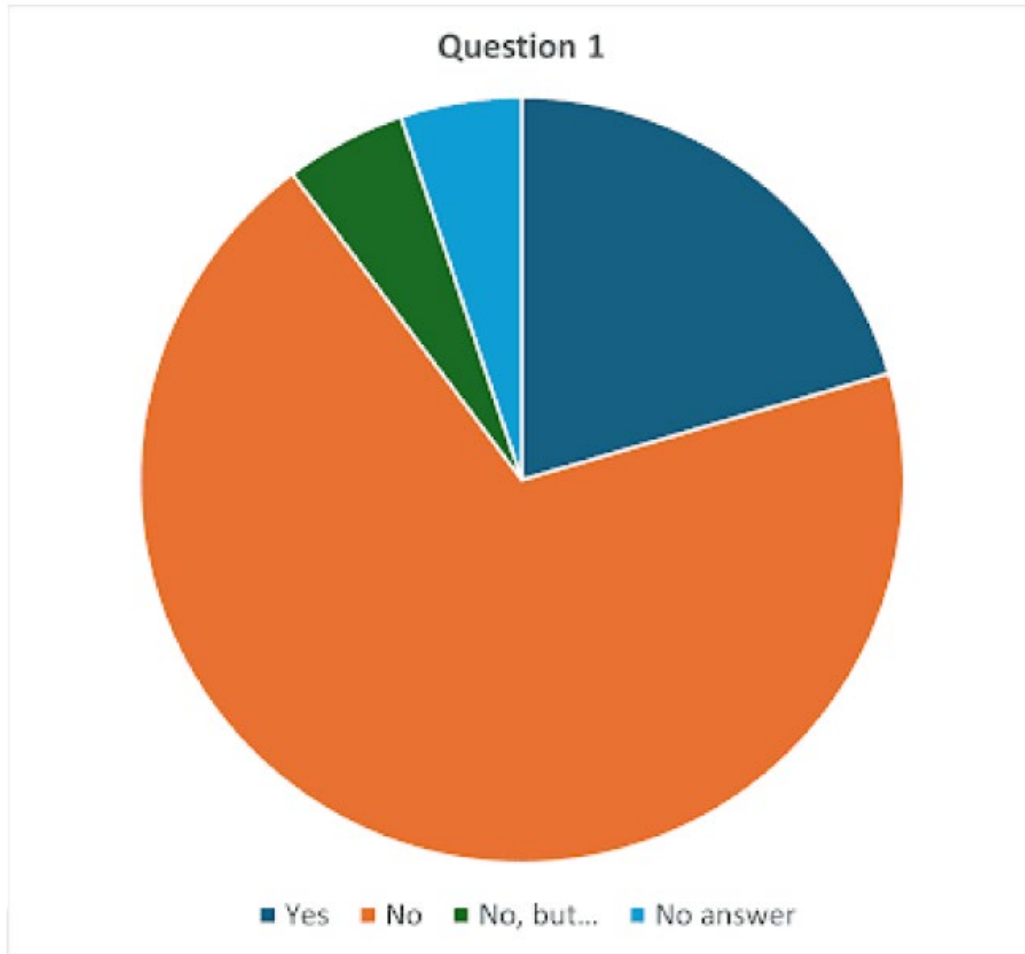
Amicus Brief – Rule 42

- T 140/19 invoked Rule 42 instead of or in addition to Art 84 EPC.
- Seems to be irrelevant, since it does not provide any explanation, apart from the need to remit the case *“to the opposition division for adaptation of the description, particularly since a large number of adaptations appear to be necessary.”*
- Guidelines F-IV, 4.4 are also cited in the interlocutory decision, in particular with reference to the “clauses”, as follows:
 - *“Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought.*
 - *“Claim-like” clauses are clauses present in the description which, despite not being identified as a claim, appear as such and usually comprise an independent clause followed by a number of clauses referring to previous clauses.”*
- FICPI believes that the requirement of deleting claim-like clauses is unjustified, since features or embodiments included in the description cannot be confused with the claims, irrespective of the form in which these features/embodiments are presented in the description, provided that there is no explicit reference to the claims.

1. **No**, it is not necessary to adapt the description to the claims to remove an inconsistency consisting of the presence of unclaimed subject-matter in the description, since no requirement of the EPC necessitates such an adaptation.
2. There is no need to answer to question 2 in view of the answer to question 1.
3. The answer to question 1 applies to all proceedings and also when the claims have not been amended. At any rate, irrespective of the answer to these questions, an applicant/proprietor should always be given at least one opportunity to amend the description after a set of claims has been approved by an examination/opposition division or a board of appeal.

Other Amicus Briefs

Q1 answers in Amicus Briefs



- 40 Amicus Briefs
- Q1 – Yes
 - Bugnion (law firm)
 - Daniel Thomas (ex-BoA member)
 - EP&C Patent Attorneys (law firm)
 - Patentwerk B.V.
 - Peter de Lange
 - Apple Inc.
 - EPO President

Preliminary Opinion

Preliminary Opinion

- Issued 11 March 2026
- **Question 1 – When is description adaptation required?**
- The EBoA distinguishes between:
 - inconsistencies between claims and description that do not cause non-compliance with the EPC, and
 - inconsistencies that **do** cause non-compliance with the EPC.
- They only consider the inconsistencies that do cause non-compliance with the EPC to be relevant. Where an inconsistency leads to EPC non-compliance, the EBoA's preliminary view is that **further amendment of the description and/or the claims is necessary** to restore compliance.

- **Question 2 – Which EPC provisions justify adaptation?**
- The EBoA explains that adaptation is required by whichever EPC provision is infringed by the inconsistency. While the referral refers to the EPC generally, the opinion focuses on Article 84 EPC.
- The EBoA states that it is currently of the view that the established line of case law allowing reliance on Article 84 EPC should be followed.
- It expressly distances itself from the approach adopted in T 56/21, which found description amendments to be unnecessary, noting that this approach appears inconsistent with G 1/24 and its underlying reasoning.
- **Question 3 – Is examination treated differently from opposition?**
- The Board sees no reason to distinguish between examination and opposition proceedings in the context of this referral. The same principles are considered to apply in both contexts.

What's next?

Next Steps

- Oral Proceedings – 8 May 2026
 - Live stream link will be published at <https://www.epo.org/en/case-law-appeals/communications/oral-proceedings-case-g-125-hydroponics-enlarged-board-appeal>
- Decision expected in 2026
- Possible amendment of EPO guidelines in 2027
- Get involved with FICPI and our European Study Group (CET 4) to help on this and many other issues



Thank you for listening!

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