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Abstracts of decisions

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1. Article 053(b) EPC | T 2049/23 | Board 3.3.04

Article 053(b) EPC

Case Number	T 2049/23
Board	3.3.04
Date of decision	2025.07.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 052, 053(b) EPC
EPC Rules	Rules 027, 028(2) EPC
RPBA	
Other legal provisions	
Keywords	patentable invention – discovery – exceptions to patentability – claims comprising but not limited to plant varieties – essentially biological process for the production of plants
Cited decisions	G 0001/98, G 0002/07, G 0001/08, G 0002/12, G 0002/13, G 0003/19
Case Law Book	I.B.3.3.3b , 11th edition

In [T 2049/23](#) the patent related to seedless watermelons and their production. According to the description, seedless watermelons are produced on triploid, self-infertile, F1 hybrid plants. These triploid hybrids need to be pollinated by a diploid polleniser to produce watermelon fruit. To this end, triploid plants are interplanted with polleniser plants for fruit production. Triploid, F1 hybrid plants are generated using pollen from diploid male parent plants to fertilise flowers of tetraploid maternal parent plants. The invention claimed in the patent related to both triploid and tetraploid watermelon plants with a bush growth habit. The claims of the patent as granted fell into two categories, with claims 1 to 16 being for products and claims 17 to 19 being for processes. The patent application had been filed in 2013.

The appellants (joint opponents) argued among other things that the claimed plants were nevertheless excluded under Art. 53(b) EPC and stated that they did not primarily rely on opinion G 3/19 (and by extension R. 28(2) EPC) for their objection. As the board understood it, they were of the view that R. 27 EPC provides a closed list of patentable "biotechnological inventions" and that the claimed plants being "conventional" plants, do not fall under one of the categories set out in this list. In their view, all other inventions relating to plants are not biotechnological inventions within the meaning of R. 27 EPC and therefore excepted from patentability under the

exception to plant varieties. The board found that this reading of R. 27 EPC was however not correct. As can be taken from the use of the word "also", R. 27 EPC provides an open-ended list of types of patentable biotechnological inventions. This is seen in contrast to those biotechnological inventions defined in the open-ended list given in R. 28 EPC, which are expressly excepted from patentability. However, the fact that R. 27(b) EPC confirms that biotechnological inventions relating to plants are patentable, cannot be understood as implying that inventions relating to plants that are not biotechnological inventions are not patentable. Instead, the board held, that the exception to patentability of plant varieties set out in Art. 53(b), first half-sentence, EPC, is to be interpreted according to decision G 1/98. Thus, under Art. 53(b) EPC as interpreted by decision G 1/98, plants other than plant varieties are not excepted from patentability, regardless of whether or not they are considered to represent a "biotechnological" invention, that is to say, regardless of whether the plant is a conventional plant or results from genetic engineering.

In their submissions relating to the exception to patentability of plant varieties, the appellants also referred to decisions G 2/07 and G 1/08, to support the submission that "technical inventions" that "escape the ban on patenting" under Directive 98/44/EC should be based on genetic engineering or targeted modification of breeding traits, in which there was a clear characterisation of the relevant genetic information. However, the board held that decisions G 2/07 and G 1/08 were not relevant to the exception from patentability of plant varieties as they are concerned with the exception to patentability of essentially biological processes for the production of plants or animals in Art. 53(b) EPC.

Regarding the exception to patentability of essentially biological processes for the production of plants to products exclusively obtained by means of such a process and opinion G 3/19, the board found that it was common ground between the parties that a plant containing the bush allele as claimed will generally have to be produced by means of sexual crossing starting from a plant containing the relevant allele. The board observed that the application on which the patent in suit was granted was filed in the transitional period established in opinion G 3/19. Since it had been filed before 1 July 2017, the subject-matter of claims 1 to 16 was assessed for compliance with Art. 53(b) EPC as interpreted by the decisions G 2/12 and G 2/13. In view of this, the subject-matter of claims 1 to 16, was not excepted from patentability. The board noted that, under the legal framework currently in force (Art. 53(b), R. 28(2) EPC), the watermelon plants and the plant material capable of regenerating into plants, would likely be excluded from patentability because they arguably represent products exclusively obtained by means of an essentially biological process.

The appellants also submitted that the claimed watermelon plants having a bush growth habit constituted a discovery rather than an invention. In the present case, the board considered that the plants (and plant tissues) of claims 1 to 16 did not constitute a discovery (Art. 52(2)(a) EPC) because the claimed plants do not exist in nature.

001-01-26

2. Article 054(5) EPC | T 1396/23 | Board 3.3.09

Article 054(5) EPC

Case Number	T 1396/23
Board	3.3.09
Date of decision	2025.11.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 054(5) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – medical use – claimed therapeutic effect – substance or composition – essential nutrient
Cited decisions	
Case Law Book	II.C.3.1 , II.C.4.1 , I.C.7.2.7 , 11th edition

In [T 1396/23](#) the appeal was filed by the opponent against the opposition division's decision rejecting the opposition. The appellant contested the opposition division's finding that the invention defined in claim 1 of the opposed patent was sufficiently disclosed. While the appellant did not dispute that claim 1 related to a medical use and was drafted as per Art. 54(5) EPC, it argued that the effect induced by whey protein micelle complexes (WPM complexes) described in the opposed patent was not therapeutic. According to the appellant, the claimed complexes provided nutrition but were unsuitable to prevent the claimed conditions, even less so to treat them.

The board was not persuaded by the arguments of the appellant. The board referred to the opposed patent, which explained that, prior to the filing date, whey protein isolates were considered not only to be essential nutrients but also to be beneficial in reducing the risk of, and treating, metabolic diseases associated with high-fat diets and/or elevated postprandial insulin levels, such as diabetes. On this basis alone, the board found it reasonable to assume that the claimed WPM complexes, which contained whey proteins, could likewise induce these effects.

The board observed that the opposed patent taught that using the claimed WPM complexes rather than conventional whey proteins was beneficial for subjects who were at risk of or suffered from the diseases indicated in claim 1. The board explained that it was immaterial what the underlying mechanism of action was, and also whether the complexes acted on a specific target and whether a comparator

such as whey protein isolate or uncomplexed WPM was explicitly mentioned in claim 1. The skilled person would appreciate that the claimed WPM complexes were intended to be incorporated into a nutritional composition in place of whey proteins in order to achieve the stated therapeutic effect. The board concluded that, in the context of the invention, the claimed compositions comprising WPM complexes could thus be regarded as "a substance or composition" within the meaning of Art. 54(5) EPC that was used to carry out the claimed therapeutic method.

002-01-26

3. Article 056 EPC | T 1044/23 | Board 3.3.03

Article 056 EPC

Case Number	T 1044/23
Board	3.3.03
Date of decision	2025.09.24
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054(2), 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – closest prior art – reproducibility of a product relevant for determining closest prior art (no)
Cited decisions	G 0001/23, T 1464/05, T 0660/16, T 2463/22
Case Law Book	I.D.3.8.1 , 11th edition

In case [T 1044/23](#) the opposition division found that commercial products DMDA resins were not prior art under Art. 54(2) EPC because the manufacture of these products was not enabled.

In the board's view, it was clear following the ruling of G 1/23 that the reproducibility requirement was no longer a valid condition to assess whether a product put on the market before the date of filing of the opposed patent was state of the art (Art. 54(2) EPC). As reproducibility is no longer a criterion, the board evaluated the public availability of the DMDA resins and the evidence on file clearly showed that the resins were commercialised before the priority date and therefore these resins were state of the art. Claim 1 of the main request lacked novelty.

As to claim 1 of the auxiliary request II where the density differed, the only objections were objections of lack of inventive step. The appellant (opponent) considered that D6, D7, and the DMDA resins could each be taken as the closest prior art.

The central point of dispute between the parties was whether a non-reproducible product could be selected as the closest prior art for assessing inventive step. In that regard, it was first assumed (for the benefit of the party arguing that the DMDA resins could not be selected as the closest prior art) that these resins could not be reproduced. It was not in dispute that a public prior use may be selected as the closest state of the art according to the case law, such as T 1464/05, T 0660/16 or T 2463/22. The question was, however, whether this also applied to commercial

products which could not be reproduced by the skilled person. The board stated that G 1/23 (points 95-96 of the Reasons) does not exclude that a non reproducible product can be selected as the closest prior art. Instead, the specific circumstances of the case should be analysed. In the case in hand the technical information in D1 and D9 about the DMDA resins made said commercial DMDA resins immediately relevant for the skilled person.

Even assuming that the skilled person would not know how to reproduce these resins, the board did not consider this point to be a sufficient reason to disregard them as closest prior art. First, the DMDA resins being commercially available, the skilled person could use them as such or modify these resins, within the limits of its competence, to obtain different properties. This situation essentially corresponds to the example in G 1/23 (point 96 of the Reasons). In any case there was no apparent reason why the skilled person would have excluded the product as a possible starting point. Accordingly, even if the DMDA resins were not fully reproducible, they were nevertheless a realistic starting point for further developments in the present technical field. In this regard, it should be noted that a non-reproducible commercial product was not comparable to a defective or speculative disclosure.

The board understood from the respondent's (proprietor's) line of argument that the knowledge of the method used to obtain the DMDA resins would be essential in order to achieve a resin composition as defined in operative claim 1. While this may indeed be the case in the present context, the board did not regard this consideration as a valid criterion for the selection of the closest prior art. In this respect, the extent to which a non-reproducible product must be modified to obtain the claimed subject-matter, and the level of knowledge about that product and its manufacture required to achieve it, were not considered relevant for determining whether the product could be regarded as the closest prior art. These aspects instead related to later stages of the problem–solution approach, namely identifying the distinguishing features between the product and the claimed subject-matter and/or assessing whether the skilled person, starting from that product, would have been able to obtain the claimed one (see Catchword).

The question of reproducibility was central at a later stage, i.e. to the assessment of obviousness and the board in detailed reasons concurred with the respondent's conclusion that the invention was not obvious to a skilled person starting from any of the DMDA resins as closest prior art.

003-01-26

4. Article 069 EPC | T 2047/23 | Board 3.5.05

Article 069 EPC

Case Number	T 2047/23
Board	3.5.05
Date of decision	2025.10.23
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 069 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claim interpretation – using description and drawings to interpret the claims – all technically reasonable interpretations – specific embodiments in the description
Cited decisions	G 0001/24, T 0190/99, T 0367/20, T 0010/22, T 1465/23, T 0405/24 UPC_CFI_373/2023, Local Division Düsseldorf, 31 October 2024
Case Law Book	II.A.6.3.4 , II.A.6.1 , 11th edition

In [T 2047/23](#) the opposed patent concerned a hearing aid provided with an antenna to enable wireless communication with other devices.

Concerning the construction of the term "plane" used in claim 1 of the main request and of auxiliary request 13, there was, in the board's view and contrary to what the appellant (patent proprietor) suggested, no objective reason to restrict the interpretation of this term to a purely physical plane. Thus, several constructions of claim 1 would objectively occur to a skilled reader, including: a) the construction adopted by the opposition division in the appealed decision, involving mathematical "planes", and b) the appellant's preferred so-called "practical implementation" scenario where "planes" were defined by antenna segments.

The appellant argued that G 1/24 mandated that the description and drawings had to be referred to when interpreting a claim, which would thus lead the skilled person naturally to the appellant's "practical implementation" scenario. The board did not find this argument persuasive. Decision G 1/24 indeed required that the description and drawings be "consulted" or "referred to", but not that the scope of the claimed subject-matter be limited to the embodiments described therein. As confirmed in, for

instance, T 1465/23, the description could, for example, be consulted to define the skilled reader, but this did not preclude interpreting claim terms according to their common meaning in that field, nor did it invalidate broader, technically viable interpretations. Therefore, the "abstract, mathematical" construction remained an equally valid interpretation of the claim's language, even after "consulting" the description and the drawings.

In addition, the board found the appellant's reliance on T 190/99 to be misplaced. That decision concerned ruling out interpretations that were "illogical or which do not make technical sense" (cf. T 10/22). The "abstract, mathematical" interpretation was neither; it was rather a standard method of geometric definitions in engineering. The appellant's reference to the UPC decision of the Local Division Dusseldorf UPC_CFI_373/2023 was, if anything, counter-productive to its case, as Headnote 1 of that decision explicitly stated: "The claim must not be limited to the scope of preferred embodiments", which was precisely what the appellant's "practical implementation" scenario sought to do.

The appellant also argued that the board had to choose one interpretation, given that the two interpretations set out above could not co-exist.

The board was not convinced by this argument, either. It stated that the appellant's premise that a deciding body had to choose a single "correct" interpretation was flawed from the outset. Instead, the deciding body's duty was to assess a claim against all interpretations that were technically sensible to the skilled reader. The board was aware that other decisions, such as T 367/20, had suggested that a deciding body must choose a single "correct" interpretation where mutually exclusive interpretations exist. Yet, in line with its established jurisprudence (cf. T 405/24), the board found that the decisive criterion in this regard was what the reader skilled in the respective technical field would understand from the technical terms of a claim. As explained in T 405/24, an approach that forces a choice for a single "correct" interpretation, such as the one derivable from the description, would jeopardise legal certainty. Such an approach could lead to the untenable result that some provisions of the EPC, such as Art. 123(2) EPC, might be rendered ineffective. The board thus held that all technically reasonable interpretations were to be taken into account instead. In the present case, where both a broad (abstract) and a narrow (practical) interpretation of claim 1 were technically reasonable, the allowability of this claim had to be assessed also against the broader one. In that regard, the board did not accept that the "abstract, mathematical" construction was technically meaningless. The board was also unconvinced by the appellant's arguments based on the specific description.

Therefore, the board concluded that the appellant's argument that the term "plane" in the context of claim 1 could only be understood as a "physical plane" had to fail.

004-01-26

5. Article 069(1) EPC | T 0837/24 | Board 3.5.05

Article 069(1) EPC

Case Number	T 0837/24
Board	3.5.05
Date of decision	2025.12.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069(1), 123(2), 123(3) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claim interpretation – omission of technically meaningful claim feature – consultation of the description and drawings – all technically reasonable interpretations – amendments – added-matter (yes) – extension of the protection conferred (yes) – inescapable trap
Cited decisions	G 0001/24, R 0025/22, R 0014/23, T 0010/22, T 0423/23, T 0405/24
Case Law Book	II.A.6.1 , II.A.6.3.1 , II.E.1.3.9 , 11th edition

[See also abstract under Article 13\(2\) RPBA.](#)

In [T 837/24](#) claim 1 of the main request related to a method of providing presence information for use in a personal communications system comprising a headset and an interface unit. It included among other features, the provision of a presence message indicating whether the mobile telephone was involved in a phone call (F1.3) with or without using the headset (F1.3.1) or indicating whether the desktop telephone was involved in a phone call (F1.4) with or without using the headset (F1.4.1).

In the decision under appeal, the opposition division had construed the expression "with or without using the headset" of features F1.3.1 and F1.4.1 as meaning that the respective telephone was involved in a phone call "regardless of the use of the headset". The proprietor argued before the board, by referring to Art. 69(1) EPC and G 1/24, that this interpretation was the only technically sensible and thus "correct" one in view of the patent description and drawings.

The board recalled that claim interpretation as such is a matter of law and may change as the proceedings evolve (see R 25/22, R 14/23). The board considered that the above interpretation constrained the "presence message" to only indicating an ongoing "phone call". Doing so amounted virtually to ignoring features F1.3.1 and F1.4.1 altogether. This, however, did not constitute a good-faith interpretation of the claim, since a technically meaningful feature would then be omitted: when construing a claim, the skilled reader typically makes use of a "mind willing to understand". Therefore, a technical meaning was typically given to each claim feature when construing the subject-matter of a claim in an objective manner (T 423/23, T 10/22).

The board concurred with the opponent that the wording of claim 1 allowed for another claim construction where the "presence message" contained specific information (e.g. via a message flag) whether or not the "headset" was used for the respective "phone call". The board considered this to be a technically meaningful interpretation, as it gave a technical meaning to each feature of claim 1. This claim construction was equally valid, if not preferable, to the interpretation of the opposition division, and had therefore also to be considered when determining compliance with Art. 123(2) EPC.

The board stated that a patent, and specifically a claim, has to be interpreted according to the technical information it provides, and all interpretations that are technically valid must be considered as technically meaningful interpretations, and neither of these interpretations may extend beyond the content of the application as filed within the meaning of Art. 123(2) EPC. There was however no indication in Art. 69(1) EPC or in G 1/24 that "using", "consulting" or "referring to" the description and drawings would mandate a claim interpretation that necessarily complies with Art. 123(2) EPC, irrespective of whether that interpretation is preferable or more likely (see also T 405/24 and the decisions cited therein). The aspect of an indication whether the "phone call" was actually performed by the "use of a headset" was not derivable from the description as filed. Therefore, the board decided that the main request was not allowable under Art. 123(2) EPC.

In claim 1 of auxiliary requests M-A and M-B the specific "presence message" indicating whether a "headset was used" was no longer required. The board found that such amendment extended the protection conferred by the patent as granted, since such feature was a mandatory feature of claim 1 as granted according to the "opponent's claim construction". According to the board, by analogy, the same applies to compliance with Art. 123(3) EPC as has been set out above for the compliance with Art. 123(2) EPC: If a granted claim allows for several technically meaningful interpretations, it has to be ensured that according to neither of these interpretations the protection conferred by it is extended. In that context, it is immaterial which of these technically meaningful interpretations may be preferable or more likely. In the present case, on the basis of the "opponent's claim construction", a mandatory feature of claim 1 as granted had been removed. Hence, claim 1 of auxiliary requests M-A and M-B extended the scope of protection vis-à-vis claim 1 as granted.

005-01-26

6. Article 084 EPC | T 1775/23 | Board 3.5.06

Article 084 EPC

Case Number	T 1775/23
Board	3.5.06
Date of decision	2025.10.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – clarity – main request (no) – claim interpretation – referring to the description and drawings to interpret the claims
Cited decisions	G 0001/24, T 3097/19, T 1561/23
Case Law Book	II.A.6.3.5 , II.A.3.1 , 11th edition

In [T 1775/23](#) the appeal lay from the decision of the examining division to refuse the application for lack of novelty of claim 1 of the main request. The appellant submitted that the examining division had used claim interpretation principles which were not, or at least no longer, correct in view of G 1/24, which decided that the description and drawings should always be consulted for claim interpretation. In its view, the examining division had interpreted the claims "on their own".

According to the board, the description itself could indeed be said to support, generally, the interpretation of the appellant. But even the description remained ambiguous. The appellant did not provide passages with clear definitions, and the board did not see any either, of the terms "request that points to a service", "intercepting", or "determining" used in claim 1, to mean what the appellant apparently intended them to mean. This intended meaning could only be gleaned, in the board's view not unambiguously, or at least not exclusively, from the text of the application.

The board further stated that, even if the description were clear about the intended meaning of those terms, the relatively large discrepancy between the straightforward interpretation of the wording of the claim (on its own), and the apparent intended meaning would already be a problem of clarity. It is the applicant who chooses the wording of the claim, and it is reasonable to think that the applicant may aim for a broad scope of protection. Thus, if the wording of the claim allows for different,

broader interpretations, then the question arises whether matter covered by such broader interpretations is protected or not – which is an issue of clarity (see also T 3097/19).

According to G 1/24 the description and drawings are always referred to when interpreting the claims. But, in the board's view, this does not mean that in all cases definitions or meanings of the terms that may be implied by the description must necessarily be adopted (see also T 1561/23 from the same board in a different composition). Instead, the assessment will depend on the circumstances of the specific case. Furthermore, as also stated in G 1/24 (point 20 of the Reasons), the correct answer to an objection of lack of clarity is, in examination, amendment, in order to remove any ambiguities as to what the intended protection may be.

Since the act of interpretation did not lead to a clear understanding as to for which matter protection was sought (see G 1/24, point 17 of the Reasons), the board concluded that claim 1 of the main request lacked clarity (Art. 84 EPC).

006-01-26

7. Article 122 EPC | T 2615/22 | Board 3.2.02

Article 122 EPC

Case Number	T 2615/22
Board	3.2.02
Date of decision	2025.07.24
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 016, 087(1), 089, 090(1), 100, 122 EPC
EPC Rules	Rules 010, 052(2), 136(4) EPC
RPBA	Article 11 RPBA 2020
Other legal provisions	Rule 320(7) RoP-UPC, § 238(3) German ZPO, § 123(4) German PatG
Keywords	re-establishment of rights – competence of the Receiving Section with regard to the priority period (yes) – Receiving Section's decision to be reviewed in subsequent opposition appeal proceedings (no)
Cited decisions	G 0001/97, G 0001/09, G 0003/14, T 0167/93, T 1099/06, T 0079/07, T 1495/09, T 1316/20, T 1482/21
Case Law Book	III.E.6.1 , IV.A.2 , 11th edition

In case [T 2615/22](#), the parent application of the contested patent was filed on 10 March 2015, i.e. more than twelve months after the filing dates of the priority applications P1 and P2. Upon a request for re-establishment of rights by the then applicant of the parent application, the Receiving Section decided on 14 January 2016 to restore the priority period.

The opponent-appellant argued that the patent was not entitled to the priority of P1 and P2. It considered that the Receiving Section was not competent to take that decision and that it did not correctly apply the all-due-care criterion in its decision. It contended this decision in the application proceedings should be set aside in the opposition appeal proceedings.

The present board did not see any reason to deviate from T 1482/21 (relating to the patent granted on the parent application) according to which the Receiving Section was competent to take the decision of 14 January 2016, and that this decision was final and that this prevented other departments of the EPO such as an opposition division or a technical board of appeal which decide on questions of priority in other, subsequent proceedings from reviewing and overturning the Receiving Section's

decision. In accordance with these conclusions, the present board agreed that the opposition division had to acknowledge the Receiving Section's decision to grant the request for re-establishment of rights in respect of the priority period.

As to whether a positive decision of the Receiving Section on re-establishment of rights was open for review in subsequent opposition/appeal proceedings, the board did not consider convincing the opponent's arguments. As set out in T 1482/21 if the Receiving Section grants a request for re-establishment of rights in respect of the priority period, the applicant is not adversely affected under Art. 107 EPC. As the applicant is the only party to the proceedings before the Receiving Section, a favourable decision on such a request is not appealable and becomes final immediately.

The nature of opposition proceedings and the case law on *res judicata* were discussed in detail during the oral proceedings before the board. The board recalled that opposition proceedings are not designed to be a continuation of examination proceedings (G 3/14). This also meant that, legally speaking, opposition proceedings must not be understood as any kind of appeal proceedings in relation to the proceedings before the Receiving Section and the examining division. Accordingly, an opposition division does not have the power to review and set aside a procedural decision taken in these proceedings. Opposition is not a legal remedy in the classical sense and it does not have the effect of transmitting the case to a superior tribunal. Not all possible irregularities in an application can be reviewed in opposition proceedings, not even all substantive ones, but only those which are listed as grounds for opposition in Art. 100 EPC. An examination of the same substantive patentability requirements – which qualify as grounds for opposition – may be undertaken by different departments in different proceedings, and there is indeed no binding effect in that regard. The Receiving Section's decision on re-establishment of rights does not concern the assessment of a substantive requirement which qualifies as a ground for opposition. It concerned a purely procedural matter decided in *ex parte* proceedings in the then applicant's favour.

The fact that a purely procedural matter may have ramifications on whether a patent exists, does not change its qualification as a procedural matter. This may result in a patent coming into existence which may otherwise not have been granted. Nevertheless, such possible irregularities in the patent grant procedure do not qualify as a ground for opposition and therefore cannot be reviewed in opposition proceedings or subsequent opposition/appeal proceedings.

007-01-26

8. Article 13(2) RPBA | T 0691/24 | Board 3.5.05

Article 13(2) RPBA 2020

Case Number	T 0691/24
Board	3.5.05
Date of decision	2025.10.21
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(1) EPC
EPC Rules	Rules 079(1), 081(3), 116(2) EPC
RPBA	Article 12(6) RPBA 2020
Other legal provisions	
Keywords	late-filed claim requests – error in first instance exercise of discretion not to admit (no) – convergence criterion
Cited decisions	R 0006/19, T 0966/17, T 0256/19, T 3097/19, T 0364/20, T 0847/20, T 0868/20
Case Law Book	IV.C.5.1.7a , IV.C.5.1.7b , 11th edition

In [T 691/24](#), the board had to address the issue of the late filing of claim requests in opposition proceedings and whether the first instance had exercised its discretion correctly in not admitting them. The main request and the first auxiliary request were filed during the oral proceedings before the opposition division (as auxiliary request 9a1 and 9b, respectively) and were not admitted into the opposition proceedings for being late-filed and non-convergent (main request) and for having been filed "without prior authorisation" (first auxiliary request).

In the appeal proceedings, the patent proprietor contested the finding that the requests had been late-filed, arguing that they had been submitted in response to an objection under Art. 123(2) EPC that had been newly raised during the second oral proceedings before the opposition division, after it had departed from its previous preliminary opinion. The patent proprietor further argued that the opposition division should have applied the criterion of "prima facie allowability" instead of the "convergence criterion".

The board held that the requests had indeed been filed late, as they had not been submitted within the time limit set by the invitation under R. 79(1) EPC issued following opponent 2's notice of intervention. The board stated that the opposition division had the discretion pursuant to Art. 123(1) EPC in conjunction with R. 81(3), 79(1) and/or 116(2) EPC not to admit them (R 6/19, T 256/19). This

discretion existed independently of the provisions of R. 116 EPC and of whether the opposition division deviated from its provisional opinion (T 966/17). Nor could such a deviation as such justify an automatic admittance of a claim request (T 868/20, T 847/20). A positive preliminary opinion on auxiliary request 9a – already admitted into the proceedings at the opposition division's discretion – could not guarantee per se the admittance of a further filing of claim requests. Nor did such a positive opinion "reset" the application of the "convergence criterion".

As regards the use of the "convergence criterion" by the opposition division, the board noted that it is a well-established criterion that may legitimately be used by a first-instance department when exercising its discretion on the admittance of late-filed claim requests. The board agreed that the present main request was not convergent with auxiliary requests 5 and 6 and that the opposition division had indeed the discretion to use this criterion to not admit "auxiliary request 9a1", i.e. the present main request, into the opposition proceedings. The patent proprietor had noted that the criterion of "prima facie allowability" was used when considering admittance of other claim requests during the first-instance proceedings instead of the "convergence criterion". The board stated that the question of consistency in the application of criteria selected from the opposition division's legal toolbox when assessing admittance had little bearing on whether, in the present case, the opposition division rightly relied upon a particular criterion in relation to a particular claim request.

The board accepted that the "convergence criterion" represents only an "indicator" that procedural economy may be affected and that whether this is actually the case depends on the circumstances of a particular case. However, in the present case, the opposition division indicated precisely in view of which higher-ranking claim request the then "auxiliary request 9a1" did not converge and why this claim request went in a different direction, i.e. which features were in fact replaced. Hence, the implications for procedural economy were therefore considered and balanced. As a consequence, the opposition division did not use the "convergence criterion" in an unreasonable or erroneous way when disregarding the present main request.

With respect to the first auxiliary request, and the opposition division's decision not to allow it, the board found that there is no legal basis in the EPC for making a party's submissions subject to prior approval by the deciding body and that the limitation to one further request – ex ante and without any consideration as to their substance – was arbitrary. The board therefore acknowledged that this constituted a procedural, though not substantial, violation, since the auxiliary request, being a continuation of the main request, must likewise be "non-convergent".

Consequently, the board did not admit the main request and the first auxiliary request into the appeal proceedings (Art. 12(6), first sentence, RPBA).

008-01-26

9. Article 13(2) RPBA | T 1223/23 | Board 3.5.05

Article 13(2) RPBA 2020

Case Number	T 1223/23
Board	3.5.05
Date of decision	2025.07.01
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication – late-filed argument of proprietor on interpretation of prior art document – taken into account (yes) – technically correct interpretation of prior-art document takes precedence over procedural considerations – novelty of claim 1 of patent as granted (yes) – special reasons for remittal (yes)
Cited decisions	T 1914/12, T 1617/23
Case Law Book	V.A.4.2.3a), V.A.4.2.3l), V.A.4.5.1a), V.A.4.5.5 , 11th edition

In [T 1223/23](#) the opposition division had come to the conclusion that claim 1 of the patent as granted was not new in view of document D2. During the oral proceedings before the board, the appellant (proprietor) submitted for the first time in appeal proceedings that D2 based on a new interpretation could not be relevant to the novelty assessment of the subject-matter of claim 1. The respondent (opponent) requested that this fresh argument not be admitted into the appeal proceedings, because it was raised at a very late stage and should have been submitted earlier.

The board first pointed out that, while the appellant's submission did not introduce any new facts or evidence, Art. 12(3) RPBA made clear that arguments also formed part of a party's case, and that a late-filed argument could therefore qualify as an "amendment" under Art. 13(2) RPBA, the admission of which being at the board's discretion. The board then mentioned the case law denying discretion to disregard (certain) late arguments in view of the wording of Art. 114(2) EPC (T 1914/12 and the decisions cited therein as well as T 1617/23 concurring with this line with certain reservations) but could leave open whether this case law was persuasive.

The board held that even on the assumption that the board had discretion not to admit a late-filed argument, there would be no justification to exercise it here. Once the parties had submitted the relevant claim requests and documents and presented their arguments on them, the board had to resolve a number of legal issues falling under its judicial responsibility. These included the interpretation of the claims, the construction of the relevant (prior-art) documents and the proper assessment of their disclosure from the perspective of a skilled person in the respective field. If the board became aware, even at a late stage, that its previous interpretation of a (prior-art) document or a claim from the perspective of the skilled person, or its understanding of a prior-art technical teaching, was wrong, in the present board's view, it had a duty to correct that error. This applied irrespective of whether the new understanding arose from the board's own analysis or from a party's new submission.

As explained by the board, in the present case, to disregard the appellant's argument and keep its original understanding of the disclosure in D2 would have forced the board to base its decision on an interpretation which it considered erroneous. The procedural framework of the appeal proceedings aimed to secure efficient and fair proceedings, but also to guarantee that the decisions, based on the facts and evidence adduced, were substantively correct. In other words, a (technically) correct interpretation of a prior-art document took precedence over formal or procedural considerations here. For this reason, once convinced by the appellant's submission, the board adopted it in its assessment of the present case. In view of the above, the new argument was admitted into the appeal proceedings and the respondent's request in that regard rejected. The case is remitted to the opposition division for further prosecution.

009-01-26

10. Article 13(2) RPBA | T 0837/24 | Board 3.5.05

Article 13(2) RPBA 2020

Case Number	T 0837/24
Board	3.5.05
Date of decision	2025.12.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(6), 13(2) RPBA 2020
Other legal provisions	
Keywords	late-filed objection – admitted (yes) – admitted in first-instance proceedings (unclear) – circumstances of the appeal case justify admittance (yes) – amendment after notification of Art. 15(1) RPBA communication (yes) – new request – taken into account (yes) – exceptional circumstances (yes) – contradiction in the opposition division's written decision
Cited decisions	R 0025/22, R 0014/23, T 0614/21, T 0764/16
Case Law Book	V.A.4.3.6h , V.A.4.5.4c , 11th edition

[See also abstract under Article 69\(1\) RPBA.](#)


In [T 837/24](#) the board dealt with two issues of admittance, the first being the admittance of an objection under Art. 123(2) EPC against the main request on appeal (identical to the "first auxiliary request" maintained by the opposition division). In the proceedings before the opposition division the opponent had raised this objection for the first time in response to the communication under R. 115(1) EPC against features of claim 1 of the then main request (patent as granted). These features were partly present also in "auxiliary request 1", the later main request. This new objection was not admitted by the opposition division based on a prima facie assessment. With regard to the first auxiliary request (main request on appeal) the decision under appeal merely indicated that the opposition division considered the subject-matter of claims 1 and 7 to be "compliant with the requirement of Article 123(2) EPC [...] for the same reasons as already provided in the context of the claims 1 and 7 of the patent", thus suggesting that the opposition division had conducted an assessment on added-matter in full, without however providing a different reasoning on that issue.

The board pointed out that, since compliance of auxiliary request 1 could not have been established without admitting the objection with respect to the then "main request", the decision under appeal was manifestly inconsistent. Moreover, the minutes of the oral proceedings before the opposition division stated the same facts. It could thus not be determined with certainty whether or not the opposition division had indeed admitted the opponent's late-filed objection into the proceedings. The board held that, to ensure the parties' right to be heard, at the oral proceedings before it, it first had to discuss and decide on the admittance of the late-filed objection under Art. 123(2) EPC.

The board found that, regardless of whether the opposition division committed an "error" when exercising its discretion within the meaning of Art. 12(6), first sentence, RPBA and irrespective of whether the added-matter objection was indeed admitted by the opposition division into the opposition proceedings, at least the "circumstances of the appeal case" justified admitting the late-filed objection into the appeal proceedings, inter alia for the following reasons. The claim construction argued by the opponent was technically meaningful and when the claim was so construed there was indeed no basis in the application as filed. In consequence, the late-filed objection was indeed prima facie highly relevant to the appeal case. Moreover, both parties had already discussed that issue in full in their first submissions on appeal and were thus in a position to present their full case on this issue. Regarding the proprietor's argument that the opponent had not requested, during the appeal proceedings, admittance of this objection, the board considered that the opponent could have reasonably assumed that the objection was part of the proceedings. With regard to the proprietor's argument that the opposition division had based its prima facie assessment on an interpretation of claim 1 initially also accepted by the opponent, the board pointed out that claim interpretation as such was a matter of law and could change as the proceedings evolve (see R 25/22, R 14/23). Moreover, a technically meaningful claim interpretation should not be ignored by a deciding body.

The second admittance issue dealt with by the board concerned auxiliary requests M-A and M-B filed in reaction to the board's preliminary opinion issued under Art. 15(1) RPBA. The board first recalled that a party prevailing in opposition proceedings is not relieved from its duty to timely prepare its case for the event of subsequent appeal proceedings. Indeed, each party should take into account that a board may depart from the preliminary view or decision issued by the first-instance department (e.g. T 614/21 and T 764/16), in particular when it comes to claim construction. However, the board concurred with the proprietor that it could not be objectively taken from the appealed decision whether the added-matter objection had been admitted into the opposition proceedings. It held that a self-contradicting or inconsistent decision of an opposition division may in itself constitute "exceptional circumstances" within the meaning of Art. 13(2) RPBA. Furthermore, there was also a causal link between the filing of auxiliary requests M-A and M-B, i.e. the amendment of the proprietor's appeal case, and the contradictory information as contained in the decision under appeal. The board thus decided to admit auxiliary requests M-A and M-B into the appeal proceedings in view of these exceptional circumstances.

010-01-26



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