Europäisches Patentamt
European Patent Office
Office européen des brevets

# Abstracts of decisions

Selected case law of the Boards of Appeal
edited by the Legal Research Service
of the Boards of Appeal

Issue 02 I 2026

Boards of Appeal

**Disclaimer**
This publication is prepared by the Legal Research Service of the Boards of Appeal for information purposes only. Abstracts, no matter how carefully prepared, cannot serve as substitutes for the decisions themselves and should therefore not be relied upon as an authoritative source, in particular in proceedings before the EPO or the Boards of Appeal. Each abstract includes a direct link to the relevant full decision; decisions of the Boards of Appeal can additionally be found in the decisions database of the Boards of Appeal website.



**Edited by**
Legal Research Service of the Boards of Appeal

For comments and requests please contact: BOA_legalresearchservice@epo.org

# Abstracts of decisions

In this issue:

## 1. Article 024 EPC | T 1876/23 | Board 3.4.03

**Article 024 EPC**

| | |
|---|---|
| **Case Number** | **T 1876/23** |
| **Board** | 3.4.03 |
| **Date of decision** | 2025.12.10 |
| **Language of the proceedings** | DE |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 024, 116, 123(2) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | objective test – objectively justified fear of partiality – suspicion of partiality in first instance proceedings – substantial procedural violation (yes) – remittal (yes) |
| **Cited decisions** | G 0005/91, G 0001/05 |
| **Case Law Book** | III.J.1.5, III.J.4.1, III.J.4.2, 11th edition |

In T 1876/23 beantragte die Beschwerdeführerin (Patentinhaberin) unter anderem, das Verfahren an die erste Instanz zurückzuverweisen, sowie die Neubesetzung der Einspruchsabteilung für das weitere Verfahren. Sie begründete dies damit, dass die Einspruchsabteilung befangen gewesen sei und die Kammer deshalb die neue Zusammensetzung anordnen solle.

Unter Verweis auf die Rechtsprechung der Großen Beschwerdekammer erinnerte die Kammer daran, dass keine tatsächliche Befangenheit des Organs des EPA vorliegen muss. Es genügt, wenn eine begründete Besorgnis der Befangenheit besteht (G 1/05). Erfüllen nicht alle Mitglieder einer Abteilung das Erfordernis der Unparteilichkeit, so ist bei der Besetzung der Abteilung ein Verfahrensfehler begangen worden, der die Entscheidung in der Regel nichtig macht. Es fällt eindeutig in die Zuständigkeit der Beschwerdekammern, zu entscheiden, ob diese Anforderung erfüllt worden ist (G 5/91).

Die Beschwerdeführerin führte zahlreiche Gründe auf, die die Befangenheit der Einspruchsabteilung belegen sollten. Insbesondere wurde die Verzögerung bei der Zustellung der Niederschrift und der Entscheidung gerügt, die zu knappe oder fehlende Begründung der Entscheidung, falsches Ausüben des Ermessens, falsche Entscheidungen, neue Einwände während der mündlichen Verhandlung,

unberücksichtigte Tatsachen in den Bescheiden vor der Verhandlung, keine Ausführung eines obiter dictum, Verweigerung der Zulassung neuer Hilfsanträge trotz neuer Argumente und insbesondere die Gesamtheit all dieser Gründe.

Die Kammer konnte einerseits bei keinem Einzelnen der oben aufgeführten Gründe an sich einen schweren Verfahrensfehler feststellen, der als stichhaltiger Beweis für eine Befangenheit der Abteilung ausreichend wäre. Andererseits merkte die Kammer an, dass die Einspruchsabteilung Hilfsanträge während der Verhandlung nicht zugelassen hatte. Wenn aber neue Argumente während der mündlichen Verhandlung vorgebracht werden, muss der Kammer zufolge gemäß Art. 116 EPÜ der betroffenen Partei die Gelegenheit gegeben werden, auf diese Argumente zu reagieren.

Der Kammer zufolge hätte die Einspruchsabteilung der Beschwerdeführerin deshalb die Gelegenheit geben müssen, mindestens einen neuen Hilfsantrag als Reaktion auf die neuen, während der mündlichen Verhandlung vorgebrachten Einwände und Argumente einzureichen, bzw. hätte die neu eingereichten Hilfsanträge zumindest prima facie prüfen müssen. Dies wertete die Kammer als schweren Verfahrensfehler. Die Einspruchsabteilung scheint die Absicht gehabt zu haben, der Patentinhaberin nicht die notwendige Möglichkeit zu geben, die Einwände unter Art. 123(2) EPÜ auszuräumen. Dies erweckte bei der Kammer einen begründeten Zweifel an der Unparteilichkeit der Einspruchsabteilung. Außerdem hätte ein objektiver Betrachter angesichts der hohen Anzahl, Summe und Gesamtheit der genannten Einwände begründete Zweifel an der Unparteilichkeit der Einspruchsabteilung im vergangenen Verfahrensabschnitt und insbesondere für das weitere Verfahren. Die Kammer war daher der Meinung, dass eine begründete Besorgnis der Befangenheit der Einspruchsabteilung vorlag. Wenn eine solche Besorgnis der Befangenheit festgestellt werden kann, betrifft dies der Kammer zufolge auch die Entscheidung über den Hauptantrag. Deshalb war die Kammer der Meinung, dass alleine wegen der Besorgnis der Befangenheit auch schon bei der Entscheidung über den Hauptantrag ein schwerer Verfahrensfehler vorlag. Die Besorgnis der Befangenheit hat sich für einen objektiven Betrachter erst bei der Nichtzulassung weiterer Hilfsanträge trotz neuer Einwände manifestieren können.

Die Kammer hob die angefochtene Entscheidung auf und verwies die Sache an eine neu zusammen zu setzende Einspruchsabteilung zurück. Sie begründete dies damit, dass die Einspruchsabteilung im bisherigen Verfahren zumindest den Anschein der Befangenheit erweckt und durch Verletzung des rechtlichen Gehörs einen Verfahrensfehler begangen hat. Abschließend merkte sie an, dass sie selbst nicht über die Befugnis verfügt, die Ersetzung der Mitglieder anzuordnen und die Zusammensetzung der Einspruchsabteilung zu bestimmen.

011-02-26

## 2. Article 054(5) EPC | T 1898/23 | Board 3.2.02

**Article 054(5) EPC**

| | |
|---|---|
| **Case Number** | **T 1898/23** |
| **Board** | 3.2.02 |
| **Date of decision** | 2025.10.28 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 053(c), 054(4), 054(5) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | novelty – second (or further) medical use – substance or composition – group of patients |
| **Cited decisions** | G 0005/83, T 2003/08, T 1491/14, T 1252/20, T 0264/17 |
| **Case Law Book** | I.C.7.2.3, I.C.7.2.6b),11th edition |

In T 1898/23 claim 1 related to a cold atmospheric plasma (CAP) for use in the treatment of therapy-refractory actinic keratosis. It was undisputed that both CAP itself and its use in the treatment of actinic keratosis were comprised in the state of the art.

The first question addressed by the board was whether claim 1 concerned a substance or composition within the meaning of Art. 54(4) and (5) EPC. Regarding the interpretation of Art. 54(4) and (5) EPC, the board pointed out that the ordinary meaning of the wording "substance or composition" was broader than that of "medicament" or "pharmaceutical product". This understanding was confirmed by the Travaux Préparatoires EPC 1973, in which the drafters of the predecessor provision to Art. 54(4) EPC deliberately chose a wording which was less restrictive than the term "medicament" (see Travaux Préparatoires on Art. 52E EPC 1973, page 101).

The board saw no reason to deviate from the argument of the respondent that a substance or composition within the meaning of Art. 54(4) and (5) EPC had to be understood as a product which qualified as a chemical entity or a composition of chemical entities (T 2003/08 of 31 October 2012, referring to G 5/83). The board explained that while this subgroup of the larger group of "products" (see T 2003/08 of 31 October 2012) excluded medical devices (see T 1252/20), it did not seem justified to say that any product which did not qualify as a medical device because of, for example, a lack of shape automatically qualified as a substance or composition

within the meaning of Art. 54(4) and (5) EPC (contrary to what seemed to be indicated in T 1252/20). If that were so, any shapeless physical entity (for example, electromagnetic radiation or ultrasound waves) could qualify as a substance or composition, regardless of whether it is a chemical entity. Having said this, the current board agreed that whether something qualified as a substance or composition within the meaning of Art. 54(4) and (5) EPC should be decided, in the first place, on the basis of what was claimed as such and not on the basis of its mode of action (see T 1252/20; compare also T 264/17).

It was undisputed that the claimed plasma contained a variety of components. The board observed that, according to paragraph [0021] of the description, these components included reactive oxygen and nitrogen species, OH radicals, ions, electrons, photons and UV light. While some of these qualified as chemical entities and hence as a substance or composition (for example, reactive oxygen and nitrogen species, OH radicals and ions), others did not (for example, electrons, photons and UV light). On whether the alleged therapeutic effect could be ascribed to the chemical entities in the plasma or (only) to the other entities, the board referred to paragraph [0002] of the patent, which included both photons and UV light in the list of active species of the claimed CAP. In the absence of any further information, the biological mode of action remained "unclear". It could not be ruled out that it was the photons and/or the UV light, i.e. subject-matter other than a substance or composition, which were (exclusively) responsible for the alleged therapeutic effect. For the sake of argument, the board assumed that the alleged therapeutic effect was caused by the parts of the claimed plasma that qualified as a substance or composition under Art. 54(5) EPC.

As to whether the claimed use qualified as a specific use in a method referred to in Art. 53(c) EPC which was not comprised in the state of the art, the board agreed that a patient group fulfilling the three criteria in T 1491/14 would render the claimed subject-matter novel. The three criteria were that: (i) the patient group was not disclosed in the relevant prior art; (ii) the patients belonging to the group could be distinguished from those of the prior art by their physiological and pathological status; and (iii) there was a functional relationship between the characterising physiological or pathological status and the therapeutic treatment, and thus the selection of the patients was not arbitrary. With regard to criterion (i), the board agreed that the prior art (D22) did not disclose the treatment of patients diagnosed with therapy-refractory actinic keratosis. On criterion (ii), the board agreed that the actinic keratosis patients who were not successfully treated could be distinguished from patients who were successfully treated. As regards criterion (iii), the board explained that it could be assumed that the technical effect resulting from the treatment of therapy-refractory actinic keratosis with CAP was the successful amelioration of the symptoms in patients whose previous treatment by standard therapies had not resulted in satisfactory clearance. Hence, there was a functional relationship between the physiological or pathological status of the patient group and the CAP treatment. Furthermore, the board observed that it was not required that the technical effect be surprising for criterion (iii) to be fulfilled.

012-02-26

## 3. Article 056 EPC | T 0558/21 | Board 3.5.06

**Article 056 EPC**

| | |
|---|---|
| **Case Number** | **T 0558/21** |
| **Board** | 3.5.06 |
| **Date of decision** | 2025.12.15 |
| **Language of the proceedings** | FR |
| **Internal distribution code** | C |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 052, 056 EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | inventive step – computer-implemented method – cryptography – technical character |
| **Cited decisions** | G 0001/19, T 0027/97, T 0641/00, T 0052/02, T 0619/02, T 0154/04, T 0756/06, T 1358/09, T 2230/10, T 0556/14, T 0697/17 |
| **Case Law Book** | I.D.9.2.2, 11th edition |

Dans l'affaire T 558/21 l'invention concernait un "procédé d'exécution d'un calcul cryptographique dans un composant électronique comprenant une étape d'obtention d'un point P(X,Y) à partir d'au moins un paramètre t secret, sur une courbe elliptique vérifiant l'équation $Y^2 = f(X)$" et défini sur un corps fini Fq avec q = 3 mod 4. Ledit procédé comprenait des étapes 1, 2 et 3 détaillées dans la revendication. Les étapes 1 et 2 calculaient les coordonnées du point P(X,Y) sur la courbe elliptique à partir d'un paramètre t donné ("obtenu"). L'étape 3 consistait à "utiliser le point P dans une application cryptographique de chiffrement ou de hachage ou de signature ou d'authentification ou d'identification".

La chambre a estimé que la conception d'une méthode mathématique permettant d'obtenir un point P(X,Y) sur une courbe elliptique $Y^2 = f(X)$ à partir d'au moins un paramètre t était, en tant que telle, un problème de nature non technique, appartenant au domaine mathématique de la théorie algorithmique des nombres. Le seul fait qu'une telle méthode pût trouver des applications techniques – fussent-elles nombreuses et connues – ne suffisait pas, en soi, à lui conférer un caractère technique (G 1/19). Les étapes 1 et 2, mises en œuvre par le composant électronique, réalisaient une partie de l'application cryptographique – à savoir la transformation d'un paramètre t, représentant un secret à protéger, en un point P sur la courbe elliptique – de manière efficiente, tout en empêchant que ce secret pût être compromis, au cours de cette transformation, par une attaque fondée sur le temps

d'exécution, ce que la chambre a considéré, en combinaison, comme constituant un effet technique (voir aussi T 556/14).

Concernant la séparation entre caractéristiques contribuant et ne contribuant pas au caractère technique de l'invention, la chambre a souligné que, pour parvenir à cette conclusion, elle n'avait pas eu à trancher définitivement la question de savoir si les étapes 1 et 2 contribuaient entièrement, dans tous leurs détails mathématiques, au caractère technique de l'invention. En théorie, il était toujours possible de déterminer si une caractéristique d'une invention contribuait ou non à son caractère technique indépendamment de toute comparaison avec l'état de la technique, car il s'agissait d'une propriété inhérente à l'invention (T 1358/09, T 2230/10, T 697/17, T 619/02, T 154/04, G 1/19).

En pratique, il peut toutefois s'avérer difficile d'identifier de manière exhaustive l'ensemble des caractéristiques d'une invention qui contribuent à son caractère technique et celles qui n'y contribuent pas. Une approche pragmatique dans de tels cas est de ne pas effectuer cette séparation technique/non-technique pour l'ensemble de l'objet revendiqué, mais à passer directement à une comparaison de l'invention avec l'état de la technique et de limiter ainsi cette séparation aux caractéristiques distinctives de l'invention par rapport à l'état de la technique "le plus proche", comme cela a été recommandé à plusieurs reprises dans la jurisprudence (T 756/06 et T 697/17). Cette approche n'est toutefois pas applicable lorsqu'il s'agit de statuer sur le bien-fondé d'une objection de manque d'activité inventive reposant essentiellement sur l'argument selon lequel la quasi-totalité des caractéristiques de l'invention ne contribuerait pas à son caractère technique, comme c'était le cas en l'espèce.

Une autre approche pragmatique est alors possible, consistant à n'effectuer la séparation technique/non-technique qu'à un degré de granularité suffisant pour pouvoir rejeter cette objection, sans pour autant exclure, à ce stade, que l'analyse de l'activité inventive à la lueur de l'état de la technique puisse révéler que certains aspects de l'invention ne contribuent pas à son caractère technique. Quelle que soit l'approche suivie, ce qui importe est que, si une caractéristique (ou une combinaison de caractéristiques) est finalement considérée comme justifiant une activité inventive de l'invention, il doit en principe être possible d'établir que cette caractéristique contribue au caractère technique de l'invention indépendamment de toute comparaison avec l'état de la technique (T 641/00). Concernant la notion de "domaine technique", la chambre a souligné que la considération de la division d'opposition selon laquelle "selon la pratique établie depuis longtemps à l'OEB, la cryptographie est un domaine technique" ne saurait en elle-même être suffisante comme argument pour conclure que toutes les caractéristiques d'une invention dans ce domaine contribuent nécessairement au caractère technique de cette invention (voir aussi T 27/97, T 52/02). Cette considération est valable pour tout "domaine technique" ou "domaine technologique" au sens de l'art. 52(1) CBE. La chambre a donc rejeté l'objection de la requérante, laquelle n'était fondée sur aucun document spécifique de l'état de la technique.

013-02-26

## 4. Article 056 EPC | T 1719/21 | Board 3.3.03

**Article 056 EPC**

| | |
|---|---|
| **Case Number** | **T 1719/21** |
| **Board** | 3.3.03 |
| **Date of decision** | 2025.10.16 |
| **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 – non-reproducible but commercially available products |
| **Cited decisions** | G 0001/92, G 0001/23, T 0023/11, T 1833/14 |
| **Case Law Book** | I.D.3.8, 11th edition |

In T 1719/21 there was a focus on the extent to which commercial, non-reproducible products – particularly ENGAGE® 8400 – could belong to the closest prior art in the light of G 1/23 for the purposes of inventive step.

An object of the present invention was to provide an encapsulating material for a solar cell having excellent insulating properties. D11 was concerned with the same objective. Responding to an argument by the respondent submitted before issuance of G 1/23 that the example of D11 using a commercial polymer did not represent an enabling disclosure, as information on the physical properties of that polymer was missing and its synthesis was not described, the board noted the Enlarged Board in G 1/23 had rejected an interpretation of G 1/92 according to which a non-reproducible but otherwise existing and commercially available product would not belong to the state of the art. The respondent's view that it would be unrealistic and necessarily contaminated by hindsight to assume that a skilled person would start from a non-reproducible polymer was thus as a principle not accepted by the board. The exemplified encapsulating material described in D11 belonged to the state of the art and represented a suitable starting point for the skilled person aiming at providing an encapsulating material for a solar cell having excellent insulating properties.

The appellant objected in addition that the subject-matter of claim 1 of Auxiliary Request 2 lacked an inventive step over the disclosure of D4 (ENGAGE® 8400) taken as the closest prior art. As with D11, the respondent had contested before the issuance of G 1/23 that the commercial product ENGAGE® 8400 was not enabled

and thus should not be considered to have been made available to the public within the meaning of Art. 54(2) EPC. In view of decision G 1/23, however, the board found that ENGAGE® 8400 and all its analysable properties and structure did belong to the state of the art. The product was physically accessible, irrespective of whether or not particular reasons could be identified for analysing its composition and structure, also if the skilled person would not have been in the position to reproduce it on their own (see G 1/23, point 91 of the Reasons).

The respondent submitted that the Enlarged Board in G 1/23 had expressed serious concerns whether a product such as ENGAGE® 8400 could represent the closest prior art, despite the fact that this product and its analysable properties belonged to the state of the art within the meaning of Art. 54(2) EPC. It cited in particular point 47 of the Reasons: "When applying the problem-solution approach, it may well be a plausible argument that the skilled person faced with the objective technical problem of manufacturing a product with similar properties cannot be assumed to depart from the product ENGAGE 8400 because its method of manufacture is not in the public domain. It can be argued that a skilled person would turn to some other starting point, purely as a question of identifying the theoretical "closest prior art".

The board did not agree with the respondent’s interpretation of G 1/23. Reasons 45 to 48 of G 1/23 were concerned with the reproducibility requirement establishing a legal fiction and the analysis therein lead the Enlarged Board to the conclusion that the fiction of the exclusion of a product from the state of the art in view of the reproducibility requirement should be treated with serious reservations. The scope of the sections of G 1/23 relied upon by the respondent was to show that the assumption that a commercially available product was legally non-existing was artificial and manifestly contradicting notorious facts. The Enlarged Board expressly rejected the position that a non-reproducible, but otherwise existing and commercially available product, does not belong to the state of the art, as this interpretation leads to an absurd result and therefore cannot hold. ENGAGE® 8400 was taken as an example of a commercial product for the purpose of the reasoning. This, the board in the case in hand stated, was accidental due to the fact that ENGAGE® 8400 was also the product considered in the referring decision (T 438/19 of 27 June 2023).

Moreover, the board did not agree that a non-reproducible, but commercially available, product or a product difficult to reproduce could not constitute a promising starting point for evaluating the existence of an inventive step. When selecting a promising starting point for an invention, the skilled person will take into account relevant technical information on products put on the market. The Enlarged Board ruled that such technical information made available to the public before the filing date forms part of the state of the art within the meaning of Art. 54(2) EPC irrespective of whether the skilled person could analyse and reproduce the product and its composition or internal structure before that date (G 1/23, Headnote II). What needs to be modified, however, is part of the inventive thinking of the skilled person in order to solve the problem addressed, not a consideration concerning the selection of that starting point.

014-02-26

## 5. Article 056 EPC | T 1523/23 | Board 3.4.02

**Article 056 EPC**

| | |
|---|---|
| **Case Number** | **T 1523/23** |
| **Board** | 3.4.02 |
| **Date of decision** | 2025.10.13 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | C |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 054, 056, 111 EPC |
| **EPC Rules** | Rule 099 EPC |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | inventive step – problem-solution approach – defining the technical problem – technical effect achieved by the claimed subject-matter (no) – inventiveness inferred from the alleged inventiveness of the unclaimed manufacturing process (no) |
| **Cited decisions** | G 0001/21, T 0648/88, T 1089/15 |
| **Case Law Book** | I.D.4.1.1, 11th edition |

*See also abstract under Article 116 EPC.*

In T 1523/23, the invention concerned a display with reduced colour shift. Regarding feature M1.7 of claim 1 of the main request, the board noted that, for a given display, it was not apparent what the target colour was. Consequently, it was also not apparent whether a colour shift had occurred and whether it was reduced by the choice of the heights of the two uneven-structure-forming regions. The board found this feature attempted to define a technical effect of the manufacturing process in a claim directed to an individual display, which cannot limit the claimed product.

The board explained that under the problem-solution approach, a technical effect can only be taken into account if it is achieved by the claimed subject-matter. In the present case a technical effect achieved by the manufacturing process could not be relied upon when assessing inventive step of the display of claim 1. Even if the process produced an ensemble of displays whose standard deviation from the mean (target) colour was reduced, for an individual display neither the target colour nor the deviation or reduction thereof was recognisable.

The patent proprietor (respondent) contended that a technical effect need not be directly derivable from the claimed subject-matter, referring to decisions T 648/88 and T 1089/15. Those cases showed that a technical effect achieved by an inventive chemical process may be relied upon when assessing inventive step of a new intermediate product occurring in that process. It was therefore argued that, for a new product with distinguishing features, one could rely on effects of the improved manufacturing process, without requiring the effect to be directly produced by the claimed product.

This argument did not persuade the board in substance. The cited decisions concerned inventions in the field of chemistry, where the inventive concept lies in a new and non-obvious reaction pathway whose non-obviousness can "carry over" to intermediate products. The present invention, by contrast, concerns a display device, viz. a physical artefact, as the end product of a manufacturing process, not an intermediate compound in a chemical process. The proprietor had not shown why the relationship between manufacturing method and physical end product was comparable to that between a chemical process and an intermediate product. These relationships are fundamentally different.

The board stated that the chemical case law invoked by the proprietor did not establish a general rule that a new (within the meaning of Art. 54 EPC) product made by an inventive process is itself inventive. This would contradict established case law and examination practice on product-by-process claims. It held that the inventiveness of the present display could not be inferred from the alleged inventiveness of the manufacturing process, which was neither claimed nor examined.

For these reasons, the technical effect of a reduction in chromaticity deviation was found to be a feature of the manufacturing process or of an ensemble of displays. It was not produced by the distinguishing feature of claims 1 and 6 and therefore could not be taken into account. The objective technical problem of claim 1 was therefore to provide a display with an alternative mixed colour.

015-02-26

## 6. Article 056 EPC | T 0185/25 | Board 3.4.03

**Article 056 EPC**

| | |
|---|---|
| **Case Number** | **T 0185/25** |
| **Board** | 3.4.03 |
| **Date of decision** | 2025.10.30 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Article 056 EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | inventive step – computer-implemented method – gaming – synchronising a live game video stream |
| **Cited decisions** | |
| **Case Law Book** | I.D.9.2.15, 11th edition |

In T 185/25, the claimed invention related to a computer-implemented method for facilitating a player's device to execute an interactive live game. A key aspect was the synchronisation between a live game video stream (including video from a live studio), and game events generated by server logic in response to player inputs. The opposition division had revoked the patent for lack of inventive step, and the proprietor had appealed. At the request of the Unified Patent Court, where parallel proceedings involving the opposed patent were pending, the board accelerated these appeal proceedings. The prior art showed a gaming system including a live gaming studio capturing video streamed to players, game events and gaming activity information also distributed to players. Cuepoints in the video stream were used to aid synchronisation between video and game events at the player's device. In comparing the claimed invention with the closest prior art document D5, the board identified two distinctive features of claim 1:

(i) The game display data sent from the server related to the executed game, rather than generic operator content.

(ii) Synchronisation using timestamps attached to both the live video stream and game events, instead of using cuepoints as in D5.

Regarding distinguishing feature (i), the opposition division and the parties agreed that the effect provided by this feature was that it enhanced the user experience in playing the game as it amplified the sensation that they participate in a live game.

The board had doubts whether this could be considered a technical effect. This effect was obtained by the content of the game display data, i.e. that the game display data are related to the game being executed (as in claim 1) in contrast to operator specific data unrelated to the played game (as in D5). The only difference lay in the cognitive content of the game display data. In the board's view, this feature related to presentation of information as such and therefore could not be considered to contribute to an inventive step within the meaning of Art. 56 EPC.

Even if the identified effect were to be considered a technical effect, the board agreed with the opposition division that it would be obvious for the skilled person to replace the displayed operator specific content with content related to the game being executed in order to enhance the player's experience.

Regarding feature (ii), the board held that synchronisation as such is a technical problem, i.e. aligning asynchronously received game events and video. The claimed use of timestamps (event timestamps and video timestamps) is a method to solve this synchronisation problem. However, the board found that there was no particular technical advantage of using timestamps over the cuepoint method in the prior art. Both ways result in the player’s device synchronising game events with video. Therefore, the only technical effect of distinguishing feature (ii) was to provide an alternative way of facilitating the synchronisation of the live game video stream and the game events at the player's device. According to the board, there was no particular technical advantage by using the solution of the claimed method rather than the one of prior art D5. The parties did not identify any such advantages, either. The board saw the only technical effect of this feature as offering an alternative synchronisation method – not a technical improvement over the prior art.

The board upheld the opposition division’s finding that the claimed subject-matter lacked inventive step (Art. 56 EPC).

016-02-26

## 7. Article 083 EPC | T 0709/23 | Board 3.3.04

**Article 083 EPC**

| | |
|---|---|
| **Case Number** | **T 0709/23** |
| **Board** | 3.3.04 |
| **Date of decision** | 2025.06.17 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Article 083 EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | sufficiency of disclosure (no) – functionally defined antibody – proof of claimed therapeutic effect – post-published evidence |
| **Cited decisions** | G 0002/21, T 0609/02 |
| **Case Law Book** | II.C.7.2.3, II.C.7.3, 11th edition |

In T 709/23 the board explained that claim 1 was drafted as a purpose-limited product claim under Art. 54(5) EPC. The therapeutic indication "for use in treating a pruritic or allergic condition in cats" constituted a functional technical feature of the claim. The antibody was defined solely by two functional features: its specific binding to feline IL-31 and its inhibition of IL-31-mediated pSTAT signalling. However, the board noted that defining the antibody in terms of functional features did not, in itself, establish a credible link to the claimed therapeutic indication. The application as filed had to provide clear and direct disclosure demonstrating that the functionally defined antibody was indeed suitable for achieving the claimed therapeutic effect.

The board observed that, while the extrapolation of the therapeutic effect from dogs to cats was disputed, its assessment under Art. 83 EPC was based on the objection that the claimed invention could not be carried out across the entire scope claimed. Accordingly, it was not necessary for the board to decide whether the skilled person would have credibly extrapolated the data on IL-31 in dogs to cats.

The board explained that while the patent application showed that feline IL-31 could activate pSTAT in canine DH-82 cells, it did not demonstrate that antibody 11E12 or 34D03 inhibited IL-31-mediated pSTAT signalling in feline cells or was effective in treating pruritic or allergic conditions in cats in vivo. A person skilled in the art attempting to carry out the invention in cats as claimed, would have selected one of the few antibodies disclosed, which were described as binding to an epitope

conserved between canine and feline IL-31 and felinised it as disclosed for antibody 34D03 in Example 11. The skilled person would have expected that each of the disclosed antibodies, i.e. both 11E12 and 34D03, would be capable of achieving the claimed effect in cats. Whether the approach would have worked with antibody 34D03 remained speculative. However, in post-published document D51, an in vivo effect in cats was demonstrated only for antibody 15H05, which binds to a distinct epitope on IL-31. Contrary to the central teaching of the patent application that inhibition of feline IL-31- mediated pSTAT signalling correlated with therapeutic efficacy in vivo, the data generated in D51 using 11E12 antibody variants showed that an antibody targeting the conserved antigenic region on IL-31 according to the patent application, while being able to inhibit feline IL-31- mediated pSTAT signalling in cat cells, failed to achieve significant therapeutic effects in cats.

The board found that, as shown by document D51, additional research was necessary to arrive at an anti-IL-31 antibody capable of treating a pruritic or allergic condition in cats. Hence, there were serious doubts substantiated by verifiable facts whether, following the teaching of the patent application, a skilled person would arrive without undue burden at an antibody suitable for treating a pruritic or allergic condition in cats.

The board concluded that the patent application did not disclose the invention as defined in claim 1 of the main request in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art (Art. 83 EPC). The reasons provided for the invention according to claim 1 of the main request applied mutatis mutandis to the invention according to claim 1 of auxiliary requests 1 to 20 which also failed to fulfil the requirements of Art. 83 EPC.

017-02-26

## 8. Article 083 EPC | T 1489/23 | Board 3.5.06

**Article 083 EPC**

| | |
|---|---|
| **Case Number** | **T 1489/23** |
| **Board** | 3.5.06 |
| **Date of decision** | 2025.10.02 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 083, 100(b) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | sufficiency of disclosure (no) – burden of proof – serious doubts – undue burden (yes) |
| **Cited decisions** | T 0019/90 |
| **Case Law Book** | II.C.5.1, II.C.9.1, 11th edition |

In T 1489/23 the patent related to additive manufacturing process control, in particular for Selective Laser Sintering (SLS). The patent proposed "real-time statistical process control monitoring and control". It relied on monitoring the "spark plume" created during sintering.

Regarding the particular way in which sufficiency of disclosure had been challenged by the appellant (opponent), the board observed that an objection to sufficiency had to be reasoned. This burden was with the party raising the objection. According to the board, to justify an objection to sufficiency, one may contest factual allegations in the disclosure (for example, that certain things can be done in a certain way or that a technical effect is effectively achieved), or one may point out gaps in the disclosure, i.e. to information, which is missing from the disclosure but required for the skilled person to carry out the invention over the full scope of the claims. For either argument to be convincing, it must raise "serious doubts". It cannot be limited to mere allegations of insufficiency, but has to be reasoned in a way that allows the deciding body to evaluate, i.e. "verify" its merit.

The board explained that to make an objection of the "first type", it may be appropriate to submit evidence showing that an alleged fact was actually incorrect. It may be less straightforward to provide evidence to substantiate an objection of the "second type", because establishing a gap in the disclosure was similar to "proving a negative". For the same reason, it was unclear to what extent an objection of the latter type could be based on "verifiable facts".

In the case in hand the appellant had pointed to specific information missing from the disclosure and the common general knowledge. The corresponding arguments were in part verifiable and otherwise sufficiently substantiated for the board to assess them. In the board's judgement, therefore, the appellant had provided sufficient reasons to substantiate its objection of insufficient disclosure.

The board agreed with the respondent that the patent taught that the spark plume may be an indicator for in-process quality factors and also that it provided a list of characteristics that may be useful as indicators. The board was of the opinion that the skilled person would be capable of extracting specifically given image characteristics from suitably "derived" image data using common-place image processing tools. This was part of the common general knowledge. Considering the cited prior art, the board was also convinced that at least some useful information existed in the image of the spark plume. For some instances, the success of the claimed method was predictable.

Regarding the alleged gaps in the disclosure, the board considered that the patent did not (a) define the intended meaning of the term "spark plume", i.e. which incandescent matter (plasma, spatter, condensate) was to be monitored; (b) disclose which characteristics of the so-defined spark plume were (not just might be) useful as indicators, and for which quality factors; or (c) provide any evidence to that effect. Based on the evidence on file, this missing information was not part of the common general knowledge. Because the patent provided no working examples, the skilled person had to make three choices without any guidance, namely which "plume" constituents to identify in the image, which characteristics to derive from that image, and in view of which quality factors to assess abnormality of the derived characteristics.

The complexity of the task that the skilled person had to accomplish was therefore of combinatorial nature, and without any guarantee of success. It did not appear trivial to make appropriate selections for a large number of quality factors, manufacturing processes and products. It was not even clear which quality factors may be reflected at all in any of the plume characteristics. It may be possible with reasonable effort to find parameter combinations which work for some cases, but it appeared difficult to identify such cases beforehand. In the board's judgment, the successful accomplishment of this task by the skilled person required a considerable effort and went well beyond routine experimentation. It therefore amounted to an undue burden.

The board concluded that the claimed invention was insufficiently disclosed for it to be carried out, over its full breadth, by the skilled person.

018-02-26

## 9. Article 087(1) EPC | T 0781/23 | Board 3.3.04

**Article 087(1) EPC**

| | |
|---|---|
| **Case Number** | **T 0781/23** |
| **Board** | 3.3.04 |
| **Date of decision** | 2025.01.30 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 054, 087(1), 088(1) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | priority (yes) – presumption of entitlement rebutted (no) |
| **Cited decisions** | G 0001/22 |
| **Case Law Book** | II.D.2.3, II.D.2.4.1, 11th edition |

In T 781/23 the opposition division had held that the patent was entitled to claim priority from the priority document, a US provisional patent application filed in the name of the inventors, with the consequence that documents D12 and D13 did not belong to the state of the art according to Art. 54 EPC. The appellant (opponent) argued that the applicant for the patent in suit was not the successor in title of the applicants for the priority document.

The board recalled that, in accordance with decision G 1/22, under the autonomous law of the EPC there is a rebuttable presumption that the applicant claiming priority is entitled to claim priority. Furthermore, the presumption of priority entitlement applies to any case in which the subsequent applicant is not identical to the priority applicant but receives the support of the priority applicant required under Art. 88(1) EPC. Thus, the presumption applied in the case in hand. The board explained that the existence of a presumption of validity implied that it was the burden of the party challenging the applicant's entitlement to priority to prove that this entitlement was lacking. Thus, the appellant's argument that it was on the proprietor to demonstrate that it had the right to claim priority had to fail.

Also referring to G 1/22, the board stated that the presumption was rebuttable, for example, in cases of bad faith behaviour of the subsequent applicant or as a result of other proceedings such as litigation before national courts concerning title to the subsequent application. It further stated that the presumption of entitlement existed

on the date on which the priority was claimed and the rebuttal of the presumption also had to relate to that date.

According to the board, in the case at hand, the appellant had not provided any such evidence to rebut the presumption of priority entitlement. Document D19 was an assignment by the inventors to the applicant of the patent in suit and could not rebut this presumption. The further evidence provided relied on requirements of national law, such as the distinction under French law between the right to the invention and the right to the priority claim. The board was of the view that, following the presumption of priority entitlement existing under the autonomous law of the EPC, considerations based on national law became irrelevant.

In light of the foregoing, the board came to the conclusion that the patent was entitled to the priority claimed.

019-02-26

## 10. Article 116 EPC | T 1523/23 | Board 3.4.02

**Article 116 EPC**

| | |
|---|---|
| **Case Number** | **T 1523/23** |
| **Board** | 3.4.02 |
| **Date of decision** | 2025.10.13 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | C |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 111(1), 113, 116 EPC |
| **EPC Rules** | |
| **RPBA** | Article 11 RPBA 2020 |
| **Other legal provisions** | Decision of the President of the EPO dated 22 November 2022 (OJ 2022, A103) |
| **Keywords** | oral proceedings – before opposition division – oral proceedings by videoconference – right to be heard – violation (no) |
| **Cited decisions** | G 0001/21 |
| **Case Law Book** | III.C.8.3.3, III.C.8.3.3e),11th edition |

*See also abstract under Article 56 EPC.*

In T 1523/23 the opponent (appellant) requested, as its main request, that the board set aside the decision under appeal and remit the case with the order that the opposition division hold the oral proceedings again, this time in person.

The board noted that, under Art. 11 RPBA, it should not remit the case unless special reasons presented themselves for doing so. As a rule, fundamental deficiencies which were apparent in the proceedings before the department whose decision was appealed constituted such special reasons.

The opponent alleged an infringement of its right to be heard, which may constitute a fundamental deficiency within the meaning of Art. 111(1) EPC. The opponent's argument in support of its main request rested on the premise that, according to G 1/21, in order to safeguard the right to be heard, oral proceedings were in principle to be held in person. This right could only be safeguarded if a party was denied its wish for in-person oral proceedings for good reasons. Such good reasons, for example travel restrictions, had been absent in the present case.

Furthermore, the opponent submitted that the Decision of the President of the EPO dated 22 November 2022 concerning the format of oral proceedings before examining and opposition divisions, the Legal Division and the Receiving Section

(OJ 2022, A103; "Decision of the President"), which had made videoconferences the rule for oral proceedings before the opposition divisions and required parties to argue for exceptions, was not in line with the principles established in G 1/21. By relying on the Decision of the President rather than on G 1/21, the opposition division had infringed the opponent's right to be heard.

According to the board, there had been no infringement of the opponent’s right to be heard. The board recalled that oral proceedings in the form of a videoconference were oral proceedings within the meaning of Art. 116 EPC (G 1/21). This conclusion had been reached irrespective of any additional conditions. In particular, neither a general emergency, nor travel restrictions, nor the consent of the parties had been regarded as prerequisites. The Enlarged Board had considered that, while suboptimal, oral proceedings by videoconference as such did not impair the right to be heard or the right to fair proceedings. A videoconference was a suitable format for oral proceedings. A violation of the right to be heard may nevertheless occur in individual cases. However, it was clear that the Enlarged Board had not regarded the format of a videoconference as such to constitute a violation of the right to be heard.

The board held that it could not discern, and the opponent had not demonstrated, how the opponent's right to be heard had been infringed merely because a format of oral proceedings, which as such complied with Art. 113 and 116 EPC as well as with the right to fair proceedings, had been imposed against its will. No such conclusion could be derived from G 1/21. Accordingly, the board found no infringement of the opponent's right to be heard and consequently no special reasons within the meaning of Art. 11 RPBA to remit the case to the opposition division without reviewing the decision under appeal.

020-02-26

## 11. Article 123(2) EPC | T 0981/23 | Board 3.2.03

**Article 123(2) EPC**

| | |
|---|---|
| **Case Number** | **T 0981/23** |
| **Board** | 3.2.03 |
| **Date of decision** | 2025.09.22 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 084, 100(c), 123(2) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | amendments – added subject-matter (yes) – claim interpretation – primacy of the claims |
| **Cited decisions** | G 0001/04, G 0001/24, T 1473/19, T 1866/22, T 2048/22, T 0873/23 |
| **Case Law Book** | II.E.1.3.9, II.A.6.3.4, 11th edition |

In T 981/23 the board agreed with the opposition division that the meaning of the additional feature in claim 1 of auxiliary request 1 was ambiguous. This was because the order in which the condition ("when" clause) and the two activities (to supply power and activate) were presented in claim 1 had been reversed with respect to the original disclosure.

The board explained that in the original formulation with the structure "when X, then A and B", both "A and B" were presented as the consequence of the condition being fulfilled. In the reverse order "A and B when X", especially without a comma, the question of grouping arose, i.e. whether "and" separated the two parts "A" and "B when X" (such that the condition X only applied to B) or whether the condition "when" referred to both "A and B". This applied irrespective of the fact that "configured to" was only recited once before "supply power […] and activate".

In the board's view, it was a technically reasonable alternative to the original disclosure to keep the power supply to the controller unmanaged (continuous, uninterrupted) and to control only the activation of the controller (for example by an enable or wakeup signal to a pin of the microprocessor) by the power supply section according to the specified condition. Accordingly, this broader, alternative interpretation of the additional feature in claim 1 was not ruled out from a technical point of view.

The board held that Art. 84 EPC required claims to be clear, and that the meaning of a claim feature should be clear for the person skilled in the art from the wording of the claim alone (G 1/04). Furthermore, the board referred to point 20 of the Reasons in G 1/24, noting that the correct response to any lack of clarity in a claim is amendment. As the additional feature in claim 1 allowed for two different interpretations which were both technically reasonable for the person skilled in the art, the board established that its meaning was not clear from the wording of the claim alone. Accordingly, the board found that claim 1 did not comply with the requirements of Art. 84 EPC. Hence, auxiliary request 1 was not allowable and there was no need to address the further objection against claim 1 under Art. 123(2) EPC.

With regard to the latter, the board noted for completeness that according to the Order in G 1/24, the description and drawings are always to be consulted to interpret the claims, and not only if the person skilled in the art finds a claim to be unclear or ambiguous. The board considered this to be true not only for the question of "patentability of an invention under Articles 52 to 57" but also for the issue of Art. 123(2) EPC (T 873/23, T 2048/22). It further stated that G 1/24 otherwise confirmed most of the established case law, including the principle of the primacy of the claims (G 1/24, Order, first sentence: "the claims are the starting point and the basis"; T 1473/19), noting that the primacy of the claims prohibited a feature which was only disclosed in the description or the drawings from being read into a claim (T 1473/19).

In the present case, the expression incorporated in claim 1 was worded differently from the description. In the board's view, it would be inconsistent with the principle of the primacy of the claims to automatically give the claimed expression the exact same meaning as the expression in the description despite the appellant's different choice of wording in the claim. The board explained that, following the established practice to interpret a disputed claim more broadly rather than more narrowly (T 1886/22), it would, for the purposes of assessing Art. 123(2) EPC, have interpreted the feature in question such that the "when" condition was only required for the activation. The board concluded that this would have resulted in added subject-matter.

021-02-26

Contact
Legal Research Service of the Boards of Appeal
Boards of Appeal of the European Patent Office
BOA_legalresearchservice@epo.org