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Case Law of the Boards of Appeal, 10th edition (update 2024) – references in issue 7/2024 and following

In the table summarising the decision data for an abstract, the links to the CLB, 10th edition, lead to the [HTML version](#), which was updated in June 2024. In the body of any given abstract, references to the CLB mirror those provided by the board in the underlying decision.

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Abstracts of decisions

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1. Article 054 EPC | T 0295/22 | Board 3.3.07

Article 054 EPC

Case Number	T 0295/22
Board	3.3.07
Date of decision	2024.11.20
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 054 EPC
EPC Rules	
RPBA	
Other legal provisions	Guidelines G-VI, 6.1.2 – March 2024 version
Keywords	novelty – second medical use – mode of delivery
Cited decisions	G 0002/08, T 0051/93
Case Law Book	I.C.7.2.4 , 10th edition

In [T 295/22](#) claim 1 of "Main request A" was formulated in the "compound for use" format of Art. 54(4) and (5) EPC, wherein the utility as a medicament was further specified as the use as a medicament which is administered orally. The Guidelines G-VI, 6.1.2 – March 2024 version (see example 2: "Composition comprising X for use in therapy by topical administration") suggest with reference to T 51/93 that in a claim which only defines the mode of delivery but no specific therapeutic effect, the definition of the mode of delivery is merely illustrative and not a restrictive technical feature capable of establishing novelty. However, the board in this case held that the requirement underlying the specificity of the use within the meaning of Art. 54(5) of the EPC 2000 was according to the explicit conclusion in G 2/08 (see point 5.10.3 of the Reasons) to be construed merely by contrast to the generic broad protection conferred by the first claimed medical application of a substance or composition, and was in principle not confined to a particular medical indication.

Contrary to the suggestion in the Guidelines, the board stated that the decision in T 51/93 actually recognized without reference to any requirement regarding the definition of a specific medical condition that the definition of the mode of administration of a medicament represented a characterizing feature of a claim formulated in the so-called "Swiss-type" format as approved according to G 5/83 for defining inventions relating to new medical uses of known pharmaceuticals under the provisions of the EPC 1973 (see T 51/93, point 3.1.2 of the Reasons).

According to the board, the decision in T 51/93 further confirmed that in a claim formulated as a "Process for making X for use Y comprising the steps of..." the definition of a specific medical purpose under Y illustrated what X could be used for, but did not further characterize the claimed subject-matter under the provisions of the EPC 1973 (see T 51/93, point 2.2.2 of the Reasons). However, the format of the claim discussed in this part of T 51/93 neither corresponded to the "Swiss-type" format as approved according to G 5/83 for defining inventions relating to new medical uses nor to the format outlined in Art. 54(5) EPC 2000.

In line with the considerations in G 2/08 (see point 5.10.3 of the Reasons) the board therefore considered that the oral administration as defined in claim 1 of "Main request A" represented, in accordance with Art. 54(5) EPC, a characterizing feature of the claimed subject-matter.

033-04-25

2. Article 054 EPC | T 1913/21 | Board 3.3.04

Article 054 EPC

Case Number	T 1913/21
Board	3.3.04
Date of decision	2024.10.17
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 064(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	novelty (no) – second non-medical use (no) – process for production (yes)
Cited decisions	G 0002/88, G 0006/88, T 0892/94, T 0189/95, T 0706/95, T 1049/99, T 0062/02, T 0684/02, T 1011/04, T 1343/04, T 1855/06, T 1179/07, T 0304/08, T 2215/08, T 1039/09, T 1822/12, T 0151/13, T 2170/13, T 0825/15, T 0308/17, T 0385/21, T 0023/22
Case Law Book	I.C.8.1.3 , 10th edition

[See also abstract under Article 12\(4\) RPBA.](#)

In [T 1913/21](#) claim 1 read: "Use of an inhibitor of cysteine degradation for reducing the formation of trisulfide bonds in proteins, wherein the inhibitor of cysteine degradation is selected from pyruvate, methyl pyruvate, ethyl pyruvate, glyceraldehyde, and glyoxylic acid; and wherein the use comprises: culturing cells expressing said proteins in the presence of an effective amount of the inhibitor of cysteine degradation, whereby trisulfide linkage formation in said proteins is reduced relative to cells cultured in medium without the inhibitor of cysteine degradation."

The parties disagreed about whether the stated effect of "reducing the formation of trisulfide bonds in proteins" was a functional technical feature limiting the claimed use.

In the decision under appeal, the opposition division had taken the view that the claim was formulated as a second non-medical use claim, namely as the use of a known compound for a particular purpose, which is based on a technical effect. In its view the claim was therefore subject to the rationale of decisions G 2/88 and G 6/88.

The board recalled that in G 2/88 the Enlarged Board distinguished between categories of claims, namely between a use of a physical entity for achieving an effect on the one hand and a process for the production of a product on the other. The Enlarged Board emphasised that a claim directed to the use of a known compound for a particular purpose is not a process claim within the meaning of Art. 64(2) EPC. While a process claim extended its protection to "the product directly obtained by such process" by virtue of Art. 64(2) EPC, a "use" claim of the type considered by the Enlarged Board did not result in a product and therefore no protection under Art. 64(2) EPC arose. The board emphasised that claims which when correctly construed are directed to processes resulting in products referred to in Art. 64(2) EPC are not subject to the special treatment established under G 2/88 and G 6/88, even if they contain the word "use".

The board had to determine whether or not the "use" of claim 1 was in fact a process to produce a product or if it was a use to achieve a (new) technical effect.

On the facts, the board held that the claimed subject-matter comprised carrying out process steps, which result in the production of a product. Following G 2/88 and G 6/88, the claimed subject-matter had to be regarded as a process for the production of proteins with a "reduced" number of trisulfide linkages, regardless of the fact that the claim was drafted as the "use" of a chemical compound. The technical effect stated in the claim of "reducing the formation of trisulfide bonds in proteins", could not occur except as part of a process for the production or manufacture of proteins and as such was inextricably linked to the production process. The new technical effect recited in the claim of reducing the formation of trisulfide bonds in proteins pertained to the product (the protein produced) and could not be considered a technical limiting feature of the "use" according to G 2/88.

Assessing novelty in this case therefore had to be done by answering the question of whether or not there was a disclosure forming part of the state of the art of a process having the same physical steps (culturing cells expressing said proteins in the presence of an effective amount of a compound that may act as an inhibitor of cysteine degradation) and leading to the production of the product defined in the claim. The board concluded that this was the case and claim 1 therefore lacked novelty over the prior art considered in the proceedings.

034-04-25

3. Article 054 EPC | T 1249/22 | Board 3.5.06

Article 054 EPC

Case Number	T 1249/22
Board	3.5.06
Date of decision	2025.01.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 054, 056, 111, 117 EPC
EPC Rules	Rules 103, 111(2) EPC
RPBA	Articles 11, 20(2) RPBA 2020
Other legal provisions	Guidelines G-VII, 3.1 – March 2021 version
Keywords	novelty – common general knowledge – proof – book with a single ISBN as evidence – each "chapter" a separate piece of prior art – book or chapters suitable evidence – principle of free evaluation of evidence – insufficient reasoning
Cited decisions	G 0002/21, T 0766/91
Case Law Book	I.C.2.8.5 , III.G.4.1 , 10th edition

[See also abstract under Article 56 EPC.](#)

In [T 1249/22](#) the application related to the development – including the training – of an analytical model (e.g. a machine learning model) and the deployment of the trained analytical model on a "compute engine" so as to process live incoming data. The examining division found that the independent claims of the main request lacked an inventive step in view of common general knowledge evidenced by D5.

D5 was a book comprising a collection of individual papers on grid computing, all from different groups of authors, referred to as "chapters" by the editors of the book. The appellant argued that D5 was not evidence of common general knowledge and that each of the chapters of D5 represented a separate piece of prior art; the examining division combined several distinct elements from these chapters without providing any reasoning. The board agreed with the appellant that each of the "chapters" represented a separate piece of prior art, as they appeared to be self-contained papers which did not build on each other, unlike chapters of a textbook. Definitions given in one of these papers did not necessarily apply to the others. D5 rather resembled a conference proceedings volume including a collection of separate papers on a common topic. The mere fact that the papers were published in the

same book with a single ISBN did not imply that the whole content of the book formed a single piece of prior art.

As to whether D5, or its individual chapters, were generally suitable as evidence for common general knowledge, the board noted that an allegation that a teaching was common general knowledge might be supported by specific evidence. The deciding body evaluates such evidence by applying the principle of free evaluation of evidence on a case-by-case basis (G 2/21). The board explained that while it might be relevant that the cited evidence was a "book" or a "textbook", this could not, on its own, be decisive, as no firm rules dictate which types of evidence are convincing.

The board further observed that information often appears in a textbook because it was common general knowledge when the book was drafted. However, this did not mean that all textbook content necessarily was common general knowledge or became so upon publication. In the decision under appeal, the examining division referred to Part G, Chapter VII, 3.1 of the Guidelines, in which it was stated that "[i]nformation does not become common general knowledge because it has been published in a particular textbook, reference work, etc.; on the contrary, it appears in books of this kind because it is already common general knowledge (see T 766/91). This means that the information in such a publication must have already become part of common general knowledge some time before the date of publication". The board noted however, that the cited decision T 766/91 only described what is "normally" accepted and what is "usually" the case. In a statement according to Art. 20(2) RPBA, the board explained that the Guidelines had lost this nuance when saying "must" in the passage cited above.

Regarding the examining division's reliance on chapters of D5 as evidence of alleged common general knowledge, the board considered the examining division's reasoning to be insufficient regarding what alleged common general knowledge it was relying on (R. 111(2) EPC). For instance, the examining division referred merely to the "known paradigm of message-based grid computing" without indicating which features of this paradigm were considered to be common general knowledge, despite appearing to rely on more than the knowledge of the existence of that paradigm when considering that all the features relating to the processing pipeline "form part of the common general knowledge of the skilled person".

Thus, the board concluded that the first-instance decision was not sufficiently reasoned within the meaning of R. 111(2) EPC. The case was remitted to the examining division for further prosecution under Art. 111(1), second sentence, EPC and Art. 11 RPBA and the appeal fee was reimbursed under R. 103(1)(a) EPC.

035-04-25

4. Article 056 EPC | T 1439/21 | Board 3.4.03

Article 056 EPC

Case Number	T 1439/21
Board	3.4.03
Date of decision	2024.11.12
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 56 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (no) – mixture of technical and non-technical features – fictitious business person – technical terminology did not confer technical character
Cited decisions	G 0001/19
Case Law Book	I.D.9.2.7 , 10th edition

In [T 1439/21](#) the application related to an automated elderly insurance scheme. The board emphasised that for deciding whether a feature is technical or not for assessing inventive step under the EPC, it is not relevant which person makes the contribution in real life. In real life, a person skilled in financial mathematics will have some notions of technical aspects, and the computer expert working for an insurance company will have some notions of business aspects of insurance schemes.

Instead, it is relevant whether the feature provides a technical effect and thus contributes to the solution of a technical problem or not or, in other words, whether it falls into the realm of the fictitious business person or the fictitious technically skilled person.

The board also noted that the use of technical terminology did not confer technical character. The terms "components", "measurement parameters" or "triggers" may sound technical. Similarly, the "dynamic monitoring" of these parameters or triggers by means of "measurement systems" conveys the impression that physical parameters are measured by technical devices.

In the context of the application, however, these terms did not represent any technical features. For instance, the "risk exposure components" were, in the context of the application, insured persons. In a similar manner, the "measurement systems"

were not technical measuring devices. Instead, they may simply be hospital entities reporting patient data to the insurer.

Thus, the terms used in the application that in a technical context would have had a technical meaning instead had, in the insurance context of the application, a non-technical meaning. Therefore, the "technical" terminology used in the application for some aspects of the insurance scheme did not lend any technical character to the respective features in substance. Instead, it only created a misleading appearance or perception of technical character.

As a result, the board could not see any interaction between the features defining the dynamic insurance scheme and the networked computer system used to automate it. However, an interaction between these features such that a technical problem is solved would have been required in order to acknowledge a contribution to technical character by non-technical features (G 1/19).

It followed from the above that the networked computer system was the only technical feature of claim 1.

036-04-25

5. Article 056 EPC | T 1249/22 | Board 3.5.06

Article 056 EPC

Case Number	T 1249/22
Board	3.5.06
Date of decision	2025.01.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	Rule 111(2) EPC
RPBA	
Other legal provisions	
Keywords	inventive step – assessment of a technical implementation of a non-technical method
Cited decisions	T 0641/00, T 1158/02, T 0688/05, T 1027/06, T 1325/17
Case Law Book	I.D.9.2.6 , 10th edition

[See also abstract under Article 54 EPC.](#)

In [T 1249/22](#) the application related to the development – including the training – of an analytical model (e.g. a machine learning model) and the deployment of the trained analytical model on a "compute engine" so as to process live incoming data. The examining division had not selected a particular piece of prior art as starting point for the assessment of inventive step. The board did not find fault with this and in the case of an invention that amounted to a technical implementation of a non-technical method (provided the "non-technical method" did not contribute to the technical character of the invention), considered it to be a valid approach to

- identify, on the one hand, the non-technical method underlying the invention, and, on the other hand, the features of its technical implementation,
- define as "technical problem" to provide a technical implementation of that non-technical method, provided to the (technically) skilled person as a "non-technical requirement specification" which is part of the technical problem,
- assess whether the skilled person would have solved this technical problem by providing the claimed technical implementation (if so, the claim is not inventive).

Such an approach had been applied in several decisions (e.g. T 1027/06). In this approach, the choice of the IT infrastructure on which the non-technical method is to

be implemented is considered to be part of the technical solution and the assessment of inventive step includes assessing whether it would have been obvious to the skilled person to select this IT infrastructure to implement the non-technical method. This is in contrast to starting from that IT infrastructure as "closest prior art" and formulating the (objective) technical problem as to provide an implementation of the non-technical method on that IT infrastructure.

In cases where the IT infrastructure used in the invention is a computer system that is commonly used to implement methods of the same kind as the non-technical method (e.g. a generic computer for most applications or a generic client-server architecture for e-business applications), there will be no difference in result between both approaches. There could however be a difference where the choice of a specific IT infrastructure might not have been a straightforward one for the given non-technical method (as noted in T 1325/17).

In any case, whichever approach is used, it was essential to be clear from the reasoning – at least implicitly – what the technical problem and the non-technical requirements included in it are. The examining division's argumentation was deemed deficient in this respect, mainly due to the fact that the examining division had identified "technical features" of the claimed subject-matter merely by underlining parts of the text of claim 5 and implying that the remainder of the claim were its "non-technical features". According to the board, this was normally not sufficient to clearly identify the technical and non-technical features of the claimed subject-matter. The board also considered the examining division's reasoning to be deficient, inter alia in respect of the technical features. It held that it is normally not possible to perform a meaningful obviousness analysis by completely disregarding the non-technical aspects of the claim, as they are normally the *raison d'être* for the claimed combination of technical features relating to their implementation. This is taken account of by including these non-technical aspects in the technical problem as non-technical requirements (in accordance with T 641/00, headnote II). In T 688/05 similar considerations were expressed by saying that features making no technical contribution "may well form the only logical link between technical features resulting from their implementation" and that "they must therefore be taken into consideration for the examination as to inventive step while at the same time not being permitted to contribute to it" (see also e.g. T 1027/06).

In some cases, it is possible to treat groups of technical features separately from each other, but this requires a proper definition of the respective partial technical problems solved by them and an explanation of why this approach is justified in the case at hand. It may also be possible to argue that a skilled person confronted with the general technical problem of providing a technical implementation of a given non-technical method, after having selected a particular IT infrastructure in a first step towards a solution, would necessarily have been confronted with several separate sub-problems arising when having to implement the non-technical method on that IT infrastructure (see e.g. T 1158/02). But none of this had been argued by the examining division. In summary, the board considered that for these reasons inter alia, the decision was not sufficiently reasoned within the meaning of R. 111(2) EPC.

037-04-25

6. Article 084 EPC**| T 0325/23****| Board 3.4.02****Article 084 EPC**

Case Number	T 0325/23
Board	3.4.02
Date of decision	2024.12.10
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	claims – claim interpretation – file wrapper estoppel (no) – all technically reasonable interpretations (yes) – broadest technically sensible meaning (no) – amendments – added subject-matter (yes)
Cited decisions	
Case Law Book	II.A.6.1 , II.E.1.3.9 , 10th edition

In [T 325/23](#) the board agreed with the appellant (patent proprietor) that in general there exists no file wrapper estoppel in proceedings under the EPC. A file wrapper estoppel is a concept in US patent law. It refers to the doctrine that the patent proprietor may be estopped from enforcing an interpretation of patent claims that is inconsistent with statements made during the patent prosecution process. This concept does not exist in the EPC. However, the fact that the appellant had argued during the prosecution of the patent application that the limitation "single row" added to claim 1 was made in order to limit the subject-matter of claim 1 against prior-art document D9 which disclosed "multiple rows", could be taken as an indication that a narrow interpretation of the term "single row" was at least not technically unreasonable. It was therefore appropriate, at a later stage of the proceedings, to follow such a narrow interpretation, which had even been adopted by the appellant during earlier proceedings. Such an interpretation did not correspond to a "file wrapper estoppel" because it did not limit the interpretation of a certain feature to what was argued by the then applicant for all future proceedings. Rather, the consideration of such events in the file history was used to determine whether an interpretation was technically reasonable or not, without excluding other interpretations.

The board did not agree with the appellant's assumption that once an interpretation of a feature was determined, it could only be assessed whether this interpretation contravened Art. 100(c) EPC. Other interpretations were, according to the appellant, no longer relevant for the assessment of the admissibility of amendments.

According to settled case law of the boards of appeal, all technically reasonable interpretations of an ambiguous claim have to be considered. If one of those interpretations contains matter that extends beyond the content of the application as originally filed, it has to be concluded that there is added subject-matter (CLB, 10th edn. 2022, II.E.1.3.9e)).

In the context of claim interpretation the appellant further argued that a non-specific definition in a claim should be given its broadest technically sensible meaning and referred inter alia to the chapters II.A.6.1 and I.C.4.1 of CLB, 10th edn. 2022. The board disagreed. While it is true that according to these two chapters a non-specific definition in a claim should be given its broadest technically sensible meaning, none of these citations refer to the interpretation of claims in the context of assessing the admissibility of amendments under Art. 100(c) EPC or Art. 123(2) EPC. The board therefore concluded that all technically reasonable interpretations of the disputed feature had to be taken into account for the assessment under Art. 100(c) EPC.

In the case in hand, the disputed feature was feature (h). The board assessed whether the (narrow) interpretation of feature (h), according to which "single row" meant a single connector line, was already encompassed by the content of the application as filed and it concluded that the ground for opposition pursuant to Art. 100(c) EPC prejudiced the maintenance of the patent as granted (main request). The same reasons applied to auxiliary requests IA and IB and I to XXIII.

038-04-25

7. Article 116(1) EPC | T 1874/23 | Board 3.3.05

Article 116(1) EPC

Case Number	T 1874/23
Board	3.3.05
Date of decision	2025.03.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 116(1), 125 EPC
EPC Rules	Rule 136(1) EPC
RPBA	
Other legal provisions	Article 6(1) ECHR
Keywords	oral proceedings – no "absolute" right to oral proceedings – re-establishment of rights (no) – "Eventualmaxime" principle – interpretation of the EPC – dynamic interpretation of Article 116(1) EPC
Cited decisions	G 0002/19, J 0019/05, J 0011/09, J 0006/22, T 1573/20
Case Law Book	III.C.2.1 , III.C.4.3.3 , III.E.4.4 , III.H.1.2.5 , III.H.3 , 10th edition

In [T 1874/23](#) the board refused the request for re-establishment of rights and, as a consequence, rejected the appeal as inadmissible. The appellant's request for oral proceedings was found to be obsolete.

The board recalled R. 136(1) EPC and noted that it corresponded to the principle of "Eventualmaxime" under which the request for re-establishment of rights must state all grounds for re-establishment and means of evidence without the possibility of submitting these at a later stage. Only if this requirement for immediate and complete substantiation within the time limit has been fulfilled, it might be permissible to complement the facts and evidence in later submissions, and provided that they do not extend beyond the framework of the previous submissions (e.g. J 19/05). According to the board, this was not the case for the request for re-establishment in the proceedings at hand. As a consequence, no further procedural steps were permissible, notably no further communication by the board and no appointment of oral proceedings. Neither would serve any legitimate purpose. It was not the purpose of oral proceedings in the context of proceedings for re-establishment to give the appellant a (further) chance to substantiate their factual assertions or to provide evidence despite the absence of factual assertions (e.g. J 11/09).

The board stated that it was undisputed that the right to oral proceedings as guaranteed by Art. 116(1) EPC was a cornerstone of proceedings before the EPO. The jurisprudence of the boards generally even followed the assumption of an "absolute" right to oral proceedings upon request as a rule, without room for discussion by the board, and without considering the speedy conduct of the proceedings, equity or procedural economy. However, even this "absolute" right to oral proceedings upon a party's request was subject to inherent restrictions by the EPC and procedural principles generally recognised in the contracting states of the EPO (Art. 125 EPC and J 6/22). Limits to the "absolute" right to oral proceedings had also been recognised in the jurisprudence of the boards (e.g. G 2/19, T 1573/20). Moreover, the boards' jurisprudence had repeatedly emphasised that the requirement of timely legal certainty, in particular in the context of intellectual property rights, was also recognised as a fundamental principle of the EPC. The parties' rights to a fair hearing within a reasonable time, in the context of the RPBA, had also been explicitly underlined by the boards' jurisprudence. In summary, where, as in the present case, oral proceedings served no legitimate purpose, the need for legal certainty in due time trumped and even prevented a board from appointing oral proceedings (J 6/22).

As to the interpretation of Art. 116(1) EPC, the board noted that the jurisprudence of the boards had reiterated the importance of a "dynamic" interpretation of the EPC in light of its object and purpose. In this context, the board referred, inter alia, to the development of the case law of the ECtHR on Art. 6(1) ECHR, where the ECtHR had also identified occasions where oral proceedings could or even should be dispensed with in pursuit of a party's right to a fair trial. In the board's view, a literal interpretation of Art. 116(1) EPC conflicted with the legislature's aims when oral proceedings would serve no purpose and thus only prolong proceedings to no one's avail. A literal interpretation of Art. 116(1) EPC thus had to make way for a dynamic and evolutive understanding instead, in light of the provision's object and purpose. The very purpose of Art. 116(1) EPC could be summarised as providing for the essential right to be heard in oral proceedings only in so far as these served a legitimate purpose and thus did not run counter to the need for legal certainty in due time, as a further essential element of a fair trial for all parties.

The board concluded that, at least in the specific circumstances of the case in hand, legal certainty in due time, just as procedural economy, as further essential cornerstones of a fair trial, had to prevail (for essentially the same circumstances see J 6/22). In light of the principles of a fair trial and legal certainty in due time, there was no absolute right to oral proceedings under all circumstances (J 6/22). No oral proceedings had to be appointed in re-establishment proceedings where the "Eventualmaxime" principle would deprive oral proceedings of its very function as a further cornerstone of a fair trial and even run counter to it.

039-04-25

8. Article 117 EPC | T 0733/23 | Board 3.3.06

Article 117 EPC

Case Number	T 0733/23
Board	3.3.06
Date of decision	2025.01.15
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 113(1), 114(2), 117 EPC
EPC Rules	Rules 103(1)(a), 116(1) EPC
RPBA	Article 12(4), (6) RPBA
Other legal provisions	
Keywords	law of evidence – standard of proof – public availability of products in brochure and data sheets – publication or distribution date – exercise of first-instance discretion not to admit documents – submitted in due time according to the board – no discretion – relevance
Cited decisions	T 0287/86, T 0743/89, T 0804/05, T 0278/09, T 2139/09, T 0146/13, T 1138/20 Re B (Children) [2008] UKHL 35
Case Law Book	I.C.3.2.1b), III.G.4.3.4a), IV.C.4.3.3 , IV.C.4.5.2 , 10th edition

In [T 733/23](#) the opposition division had concluded that there had been insufficient evidence to prove that the data sheets D2, D4, and D7 to D9 had been made available to the public before the filing date. Rather than concluding that, as a result of the data sheets not being considered state of the art under Art. 54 EPC, the subject-matter of the claims was novel, the opposition division decided not to admit them into the opposition proceedings. The board concluded that not admitting these data sheets, filed in due time, constituted a substantial procedural violation (see details as from point 4 of the Reasons including discussion on D19, an affidavit).

The board, in support of its decision, presented some key considerations on public availability of advertising brochures and data sheets, as well as the standard of proof to be applied. The board stated that when a document was clearly intended to be publicly distributed, as was the case with advertising or commercial brochures, the absence of a specific publication or distribution date, a situation quite common in this

type of document, was not in itself sufficient to conclude that the document did not constitute prior art. As with any other type of evidence, the key question was not whether the exact date of publication could be determined, but whether it could be established that the relevant subject-matter was made available to the public before the priority or filing date.

Data sheets often represent an intermediate case between internal documents and advertising brochures. Where no publication date is present, the board held it should first be assessed whether the document was intended for public distribution. If so, additional sources must be examined to establish whether the relevant subject-matter was publicly accessible before the patent's filing or priority date. Here, the opposition division had failed to provide a reasoned decision on public availability, giving no weight to the dates printed on their front pages.

As to the standard of proof, the present board concurred with the position in T 1138/20 that there is only one standard of proof: the deciding body must be convinced, based on the underlying circumstances.

According to the present board, this did not imply that all cases were to be treated identically, as in practice the degree of proof required to establish credibility (i.e. to persuade the board) might vary depending on the specific circumstances. In other words, it was not the standard of proof that adjusted with the circumstances, but rather the credibility of the arguments made by the different parties. For example, when the evidence was exclusively controlled by one party, any gaps in the relevant information might significantly undermine that party's credibility. Conversely, when the information was equally accessible to both parties but only one party submitted evidence, merely raising doubts might not be sufficient to challenge the credibility.

In the present case, the conclusions of the opposition division suggested that the standard of proof "up-to-the-hilt" was applied to determine the public availability of the data sheets. Even if the board agreed that different standards should be applied, this would not be justified in the case in hand, as the relevant information to prove the public availability of the data sheets was not within the exclusive sphere of the appellant (opponent). In this instance, the relevant information would more likely be within the sphere of the patentee. Therefore, there was no basis for applying the strict standard of "up-to-the-hilt" or for questioning the credibility of the appellant solely on the grounds that some information was missing.

The patentee argued that, when in doubt, the patent should be upheld. The board disagreed. Fact-finding boiled down to a binary exercise: either something had been proven, or it had not. In addition, there was no presumption of patent validity in proceedings meant to re-assess the validity of this very patent.

040-04-25

9. Article 123(2) EPC | T 0518/22 | Board 3.3.08

Article 123(2) EPC

Case Number	T 0518/22
Board	3.3.08
Date of decision	2024.10.30
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – disclaimer – undisclosed disclaimer – priority – partial priority
Cited decisions	G 0001/03, G 0001/15, G 0001/16, G 0001/22, G 0002/22, T 0521/18, T 1975/19
Case Law Book	II.D.2.2 , II.D.5.3.3 , II.E.1.7.2a , II.E.1.7.2c , II.E.1.7.3 , 10th edition

In [T 518/22](#) the board established that the "A3" mutant disclosed in D2 anticipated the subject-matter of claim 1 of auxiliary request 1 at least under Art. 54(3) EPC.

Claims 1 and 9 of auxiliary request 2 differed from the respective claims in auxiliary request 1 in that an undisclosed disclaimer had been introduced to exclude the A3 mutant disclosed in D2 from the subject-matter claimed.

The board explained that, according to G 1/03, an amendment to a claim by the introduction of a disclaimer may not be refused under Art. 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed. G 1/03 defines the criteria when such an undisclosed disclaimer is allowable, stipulating that it can be introduced into a claim inter alia to restore novelty by delimiting a claim against the state of the art under Art. 54(3) EPC but not under Art. 54(2) EPC (except for a so-called accidental disclosure).

In order to determine whether D2 was prior art under Art. 54(2) or (3) EPC for the claimed subject-matter, the board assessed whether the subject-matter of claim 1 as a whole was entitled to claim priority from P and whether D2 was entitled to claim priority from P1.

The board found that D2's priority based on P1 was valid. Appellant I had objected to D2's formal entitlement to priority because the applicants of P1 and those of the international patent application D2 were not the same. The board explained that G 1/22 and G 2/22 established that a presumption exists that a claim to priority is valid by way of an implicit agreement on the transfer of the right to claim priority in the absence of evidence that such an agreement (implicit or explicit) did not exist. This presumption applies to any case where the subsequent applicant is not identical with the priority applicant. On account of this general teaching, the board understood that the presumption applied also to patent applications cited as prior art, as in the present case (see also T 521/18).

This presumption could be rebutted to take into account "rare exceptional cases" where the subsequent applicant could not justifiably rely on the priority (G 1/22). This, however, involved the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's priority entitlement (here appellant I) had to prove that this entitlement was missing. Merely raising speculative doubts was not sufficient. Instead, evidence was required that specific facts supported serious doubts about the subsequent applicant's entitlement to priority (G 1/22). In the absence of evidence suitable to establish that the alleged real priority right holder did not allow the subsequent applicant to rely on the priority (see also T 1975/19), appellant I's objection against D2's formal entitlement to priority from P1 was not sufficient to rebut the presumption of validity, which always existed on the date on which priority was claimed (G 1/22). Hence, D2 validly claimed priority from P1.

As regards the validity of the patent's priority claim based on P, the board established that the relevant date for the subject-matter of claim 1 in several embodiments concerning SEQ ID NOs: 5 to 8 was the filing date of the patent application, whereas several embodiments of claim 1 in relation to SEQ ID NO: 4 were entitled to claim partial priority from P (G 1/15).

Therefore, D2 was prior art under Art. 54(2) EPC for the subject-matter of claim 1 not enjoying priority, i.e. in relation to several embodiments concerning SEQ ID NOs: 5 to 8, and prior art under Art. 54(3) EPC for the subject-matter of claim 1 enjoying priority, i.e. in relation to several embodiments concerning SEQ ID NO: 4.

Since the undisclosed disclaimer added to claim 1 in auxiliary request 2 removed embodiments of D2 which belonged to the state of the art pursuant to Art. 54(2) EPC and were not an accidental disclosure, such amendment was not allowable under Art. 123(2) EPC. Auxiliary request 2 comprised added subject-matter (G 1/03 and G 1/16) and did not fulfil the requirements of Art. 123(2) EPC.

041-04-25

10. Article 12(4) RPBA | T 1913/21 | Board 3.3.04

Article 12(4) RPBA 2020

Case Number	T 1913/21
Board	3.3.04
Date of decision	2024.10.17
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 116(2) EPC
RPBA	Article 12(3), 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – requests – requirements of Article 12(2) RPBA met (no) – admissibly raised and maintained (no) – substantiation requirement
Cited decisions	T 0095/83, T 0364/20, T 1800/20, T 0246/22, T 0446/22, T 0731/22, T 2395/22
Case Law Book	V.A.4.2.1c , 10th edition

[See also abstract under Article 54 EPC.](#)

In [T 1913/21](#) auxiliary requests 4 and 5 were filed during the proceedings before the opposition division, but not dealt with because a higher-ranking request was held allowable, and later re-filed with the statement of grounds of appeal. The respondent (patent proprietor) referred to different approaches outlined in the jurisprudence of the boards of appeal with regard to the interpretation of the requirement "admissibly raised and maintained" (inter alia T 364/20, T 1800/20 and T 246/22). The board considered that it was not necessary to go into the details of the different approaches because auxiliary requests 4 and 5 did not meet a common requirement in these decisions, namely that an explanation needed to be given as to why the amendments have been made and how they are intended to overcome the objections raised.

In the board's view, the wording of Art. 12(4) RPBA by reference to "the proceedings leading to the decision under appeal" should be construed in the present case with regard to the opposition proceedings and the criteria applicable to them. This required an assessment of whether the opposition division had discretion not to admit a request, and how that discretion should have been exercised in the circumstances if a decision on admittance had been required. This approach had also been adopted in other decisions (explicitly e.g. in T 364/20, T 2395/22, implicitly in T 446/22, T 731/22). The board considered it inappropriate to apply the criteria in Art. 12(4),

third sentence, RPBA, as they were specific to the appeal proceedings and could not have been considered by the patent proprietor at the time of filing the auxiliary requests. For this reason, a reference to the relevant EPC provisions and the Guidelines applicable at the time when the auxiliary requests were filed was appropriate, since they contained the criteria that an opposition division would apply. In addition, the Guidelines reflected the consolidated jurisprudence of the boards of appeal on the criteria for admittance of requests to be applied in opposition proceedings.

The board observed that a principle consolidated in the jurisprudence of the boards of appeal (e.g. T 95/83), adopted in the first instance and consistently reflected in the Guidelines (H-II, 2.7 and E-III, 8.6 – March 2021 version) was that auxiliary requests were not inadmissibly filed simply because they were filed after a period or date specified, but only if in addition they were filed without proper justification. A proper justification was normally considered to be present when the subject of the proceedings had changed, e.g. because of a changed opinion of the opposition division (see also E-III, 8.6), or due to a new document or a new objection submitted/raised by the opponent(s)/the opposition division. Auxiliary requests filed after the period or date specified and absent a proper justification were considered "late" and their admittance was subject to the discretion of the opposition division (Guidelines H-II, 2.7.1 – March 2021 version). In the case in hand, auxiliary request 4 was timely filed (before the date specified under R. 116(2) EPC) and auxiliary request 5 was a legitimate reaction to a change in the subject of the proceedings.

The board then pointed out that the Guidelines contained a substantiation requirement similar to the one in Art. 12(3) and 12(4), fourth sentence, RPBA, namely that an explanation must be provided as to why the amendments have been made and how they are intended to overcome the objections raised (Guidelines H-II, 2.7.1 – March 2021 version). When filing auxiliary requests 4 and 5 in opposition proceedings, as auxiliary requests 14 and 15, the respondent merely submitted that the amendments further limited the scope of the granted claims and therefore further distinguished the claimed subject-matter from the prior art. No reason was submitted as to why the new features introduced in claim 1 would overcome the objections raised. In the board's view, this was sufficient to conclude that auxiliary requests 4 and 5 would not have been admitted in the opposition proceedings.

They were thus not admissibly raised in the proceedings leading to the decision under appeal and did constitute an amendment within the meaning of Art. 12(4) RPBA, the admittance of which was subject to the board's discretion. The board decided not to admit the claim requests into the proceedings, due to the lack of any substantiation of these auxiliary requests in appeal and particularly the fact that it was not straightforward how the amendments could overcome the objections raised.

042-04-25

11. Article 12(4) RPBA | T 0823/23 | Board 3.2.03

Article 12(4) RPBA 2020

Case Number	T 0823/23
Board	3.2.03
Date of decision	2025.01.14
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 114(2) EPC
EPC Rules	
RPBA	Article 12(2), 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – objection – requirements of Article 12(2) RPBA met (no) – admissibly raised and maintained (no) – perspective of the first-instance department – Guidelines
Cited decisions	G 0010/91, T 0937/09, T 0573/12, T 1930/14, T 0084/17, T 1042/18, T 1776/18, T 0364/20, T 1088/20, T 1990/20, T 0435/21, T 0446/22, T 0731/22, T 0924/22
Case Law Book	V.A.4.2.1c , 10th edition

In [T 823/23](#) the board decided on the admittance of a "carry-over objection", i.e. – as explained by the board – an objection which was raised and maintained in the opposition proceedings but which was not decided upon in those proceedings, neither with regard to its admittance nor in substance, due to the allowability of a claim request that ranked higher than the claim request against which the objection had been raised.

The board noted that, in the case in hand, the applicability of G 10/91 to raising the objection at issue in the appeal proceedings could be left open. Restrictions on new submissions pursuant to G 10/91 and a board's discretionary power not to admit late-filed party submissions under Art. 114(2) EPC, Art. 12 and 13 RPBA had to be applied in a cumulative manner (T 1042/18). In the board's view, the objection at issue was not admissibly raised within the meaning of Art. 12(4) RPBA and the board decided not to admit the objection into the appeal proceedings.

The board pointed out that the purpose of the mechanism of Art. 12(4), first sentence, RPBA was to ensure that submissions on which the decision under appeal was not based were (i) neither automatically subject to the board's discretion

regarding admittance, (ii) nor automatically part of the appeal proceedings simply because they were raised and maintained in the proceedings leading to the decision under appeal (even though they might not have been admitted into those proceedings had it been necessary to decide on their admittance). Considering the provision's wording, context and purpose, the board held that a submission was admissibly raised in the proceedings leading to the decision under appeal if it would have been admitted into those proceedings had a decision on its admittance been taken. A board first had to assess whether the first-instance department had discretion not to admit a submission. If this was the case, in a second step, the board had to assess how a department of first instance, assuming legally correct and reasonable conduct, would have exercised that discretion.

This required the board to take on the perspective of a department of first instance and use the criteria which this department would have had to apply. The case law of the boards on reviewing the exercise of discretion in examination proceedings (e.g. T 937/09, T 573/12) and opposition proceedings (e.g. T 1930/14, T 84/17) could provide guidance for assessing how a department of first instance would have exercised its discretion. A board could also take account of the Guidelines. In the board's view, this, in principle, was no different from a board taking account of the Guidelines when reviewing the actual exercise of discretion by a department of first instance in the context of Art. 12(6), first sentence, RPBA (see T 435/21, T 1088/20) or Art. 12(6), second sentence, RPBA (see T 1990/20). The board observed that the Guidelines were – as general instructions pursuant to Art. 10(2)(a) EPC – to be taken into account by the departments of first instance. However, as stated in the Guidelines, they did not constitute legal provisions and, for the ultimate authority on the practice in the EPO, it was necessary to refer to the EPC and to its interpretation by the boards of appeal and the Enlarged Board of Appeal. As only the circumstances of the proceedings leading to the decision under appeal mattered in the assessment of whether a submission was "admissibly raised", the version of the Guidelines in force at the relevant time in those proceedings was pertinent for this assessment (see T 446/22, T 731/22).

In the case in hand, the appellant (then opponent 2) did not raise the objection under Art. 100(b) EPC in the opposition proceedings until after the board had remitted the case to the opposition division, i.e. long after the end of the opposition period and therefore not in due time within the meaning of Art. 114(2) EPC (see T 1776/18). Accordingly, the opposition division had had discretion not to admit this objection. The Guidelines (March 2022 version) stated that in deciding whether to admit grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for the belated submission were to be considered, with particular emphasis on *prima facie* relevance (see E-VI, 2). This was in line with what was stated in G 10/91 (point 16 of the Reasons). The board concluded that the objection was not admissibly raised in the opposition proceedings. Since the objection still suffered from a lack of *prima facie* relevance, exercising its discretion under Art. 12(4) RPBA, the board decided not to admit it into the appeal proceedings.

043-04-25

12. Article 12(4) RPBA | T 1178/23 | Board 3.2.05

Article 12(4) RPBA 2020

Case Number	T 1178/23
Board	3.2.05
Date of decision	2024.12.16
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 116 EPC
RPBA	Article 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – requests – requirements of Article 12(2) RPBA met (no) – admissibly raised and maintained (yes) – perspective of the first-instance department – Guidelines
Cited decisions	T 0364/20, T 1800/20, T 0309/21, T 0246/22, T 0446/22, T 0731/22, T 1749/22, T 2395/22, T 0823/23
Case Law Book	V.A.4.2.1c , 10th edition

In [T 1178/23](#) auxiliary request 4 filed with the reply to the statement of grounds of appeal had the same wording as auxiliary request 2 in opposition proceedings, filed as auxiliary request 1 on the final date set by the opposition division under R. 116 EPC and renamed when a new auxiliary request 1 was filed at the oral proceedings. The decision under appeal was not based on auxiliary request 2, as the opposition division had held auxiliary request 1 to be allowable.

The board held that for the assessment of the condition under Art. 12(4), first sentence, RPBA ("admissibly raised"), the decisive question is whether the first-instance department would have admitted the request had a discretionary decision on admittance been required (T 364/20; see also T 2395/22 and T 246/22). In the board's view, the explicit use of the past tense ("was admissibly raised") and the reference to the proceedings leading to the decision under appeal implied that the perspective of the first-instance department was addressed. In other words, it needed to be determined how the first-instance department would have proceeded in reliance on the provisions and practice that applied at the time. This view was supported by the consideration that, without the first-instance perspective, a decision on the "admissibly raised" condition might lead to a different assessment of the admittance of a request that was filed but not decided on in first-instance proceedings compared

to another, higher-ranking request that was filed under the same circumstances but was admitted and held allowable by the first-instance department. Setting minimum requirements post factum in appeal for determining whether a request was admissibly raised before the opposition division (T 364/20, T 1800/20, T 309/21, T 246/22, T 1749/22) was tantamount to applying different admittance criteria for auxiliary requests filed at the same time and under the same circumstances in first-instance proceedings. Arguably, such an approach would compromise legal certainty. Moreover, replacing the first-instance perspective with what essentially was an exercise of discretion on the part of the board would render the discretionary decision of Art. 12(4), second sentence, RPBA redundant.

The board explained that, to assess whether the first-instance department would have admitted a request, it had to be established whether this department had discretion not to admit the request and, if so, which practice applied at the time when the decision on admittance would have been taken. As a general rule, parties could expect first-instance departments of the EPO to act in accordance with the Guidelines in the version valid at the relevant time (T 446/22, T 731/22, T 823/23). The board addressed the "moving target" argument in T 246/22 by pointing out that the amendments to the Guidelines often reflected developments in the case law of the boards of appeal. They therefore could not constitute an impediment for the board in considering the Guidelines when determining how the opposition division would have proceeded at the relevant time.

In the case in hand, the board concurred with the respondent (patent proprietor) that, at the time of the oral proceedings on 14 March 2023, the opposition division would have considered the March 2023 version of the Guidelines had a discretionary decision on the admittance of that auxiliary request been required. The relevant section E-VI, 2.2.2 of the March 2023 version of the Guidelines included the provision that "amendments submitted before the date set under R.116(1) EPC cannot, as a rule, be considered as being late-filed". In view thereof, the board was satisfied that the respondent had demonstrated that auxiliary request 4 at issue was admissibly raised in the proceedings leading to the decision under appeal.

The fact that, according to the minutes of the oral proceedings held before the opposition division, the respondent had renumbered the auxiliary request 1 filed on the final date set under R. 116 EPC at the end of the oral proceedings, implied that this claim request was not withdrawn but maintained in the proceedings leading to the decision under appeal. The board concluded that auxiliary request 4 was not an amendment of the respondent's appeal case but was part of the appeal proceedings (Art. 12(4), first sentence RPBA).

044-04-25

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