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Abstracts of decisions

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1. Article 024(3) EPC | T 0246/23 | Board 3.3.09

Article 024(3) EPC

Case Number	T 0246/23
Board	3.3.09
Date of decision	2026.03.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 024(3), 024(4), 104(1), 111(1), 114 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	suspicion of partiality (no) – prohibition of reformatio in peius – raised by the original board of its own motion – apportionment of costs (no)
Cited decisions	G 0009/91, G 0010/91, G 0009/92, G 0004/93, T 0882/17, T 1544/07, T 1472/21, T 1773/22
Case Law Book	III.J.5.3 , V.A.3.3 , V.A.3.1.5 , 11th edition

In [T 246/23](#) of 11 March 2026 the board rejected the objection under Art. 24(3) EPC and refused the opponent's request for cost apportionment.

During the oral proceedings in [T 246/23](#) of 7 August 2025, when the debate on auxiliary request 5 was opened, the board in its original composition (the "original board") had informed the parties of its preliminary view that the request contravened the principle of no reformatio in peius. The patent proprietor (respondent) had then raised an objection of suspected partiality against all board members, arguing that an objection based on this principle could only be raised by another party, not by the board. It submitted that, since the board had raised the objection ex officio, it was "on the side" of the opponent (appellant) and thus suspected to be partial. The original board had found the objection admissible and the composition of the board was changed for the purposes of a decision on the objection under Art. 24(3) EPC (the board in its new composition in the following referred to as "the board").

The board noted that, on the substance of the objection, the respondent relied on two core arguments, neither of which was convincing: (1) that the specific nature of the prohibition of reformatio in peius prevented the board from raising it ex officio, and (2) that established case law supported this view.

On (1), the board stated that the prohibition of *reformatio in peius* is not so exceptional as to completely escape the board's powers under Art. 114 EPC. It noted that any objection raised by the board *ex officio* in an inter-partes procedure can be perceived as being in a certain contradiction with the board's obligation to remain neutral towards the parties. However, if the parties were free to raise the objection of suspicion of partiality in all cases where a board exercises its powers under Art. 114 EPC, such powers would be effectively eliminated. The board also rejected the argument that raising the prohibition *ex officio* contradicts the principle of party disposition. This principle concerned the substantive outcome of proceedings, i.e. the scope of the legal effects sought, and did not extend to the legal arguments raised by either the parties or the court for achieving the requested legal effects. In the present case, the opponent requested the revocation of the patent, and the original board's finding that auxiliary request 5 was not allowable, for whatever reason, was clearly within the scope of the appellant's appeal request for revocation.

On (2), the board pointed out that there was no settled case law forbidding the board from raising the objection *ex officio*. It added that this could not even be derived from cited decision T 1544/07. In its view, T 1544/07 only found that the deciding board had no obligation to raise the objection under the special circumstances of that case, where the opponent itself had explicitly waived the right to raise it. The decision did not state that a board is prevented from raising the objection *ex officio* as a question of principle. Rather, it appeared to suggest that a board may, but need not, raise it where the affected party renounces this defence. A far stricter position was taken in T 882/17, cited by the opponent, where the deciding board disagreed with T 1544/07 and unambiguously stated that the board not just may, but must take the prohibition into account, and also *ex officio*. This decision was followed by other decisions (T 1773/22, T 1472/21).

The board explained that, to decide the issue before it (i.e. the objection of suspected partiality) it was sufficient to establish that, contrary to the proprietor's argument, case law was far from settled. The mere existence of another line of case law, T 882/17, recognising the board's entitlement to raise the prohibition objection, was sufficient to establish that the original board could not be considered partial solely for raising the objection. According to the board, a board of appeal is always entitled and in fact obliged to examine the boundaries of its own powers to raise an *ex officio* objection. If necessary, it is also entitled to question findings of previous decisions on the same issue. The original board was under no obligation to seek the proprietor's permission or to maintain the objection only contingent on the opponent's intention to pursue it.

The board concluded that the objection under Art. 24(3) EPC was unsubstantiated. It also refused the opponent's request for cost apportionment, noting that it could not qualify the procedural conduct of the proprietor as an abuse of procedure.

032-04-26

2. Article 052(c) EPC | T 0425/24 | Board 3.2.07

Article 052(c) EPC

Case Number	T 0425/24
Board	3.2.07
Date of decision	2025.11.17
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 052(2)(c) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	exceptions to patentability – mental acts
Cited decisions	T 0416/87, T 0717/98, T 0914/02
Case Law Book	I.A.6.6.2 , 11th edition

In [T 425/24](#) the claimed invention concerned a method for optimising a work cycle in a robot system comprising at least two manipulators with a common work area. The examining division had found that the subject-matter of claim 1 of the main request and auxiliary request 1 was excluded from patentability as it related to a method of performing mental acts (Art. 52(2)(c) EPC). The examining division reasoned that the method steps of claim 1 could be carried out exclusively mentally.

The appellant had argued that the description as filed clearly set out that the use of a computer was an "overriding requirement" of the claim as defined by decisions T 416/87 and T 717/98, so that the method did have a technical implementation due to the use of a computer.

The board however agreed with the examining division that claim 1 of the main request was excluded from patentability. As the examining division noted, it is established case law that if a method may be exclusively carried out mentally, i.e. if it is not confined only to a technical implementation, then it is not entitled to patent protection under the EPC (see CLB, 11th ed. 2025, I.A.6.6.2).

In decisions T 416/87 and T 717/98, referred to by the appellant, it was reasoned that if features are indicated in the description to be of overriding importance, they must be read into the claim, for the purposes of claim interpretation. The board however was of the view that these decisions were not relevant here because any conclusion on overriding importance has to be determined according to the circumstances of the specific case and neither of the two cases cited deals with exclusions to patentability.

In the present case a computer is not an overriding requirement, in simple cases the method steps can certainly be carried out purely mentally. The board noted further that even complexity of a solution may not necessarily be a bar to a finding that a method consists of performing mental acts, see for example decision T 914/02. If an appellant has no intention of seeking protection for purely mental implementations, then the technical implementation means should be included in the claim (see T 914/02).

The board held that the appellant had not convincingly demonstrated that the decision under appeal was incorrect on this point.

On auxiliary request 1 the examining division had found that the amendment made to claim 1 of auxiliary request 1 did not overcome the issue relating to the main request. The appellant had argued that the introduction of the feature "each of the at least two manipulators is allowed to operate only within that part of the common work area that is allocated to the respective manipulator" required technical means as it required control of the manipulators. This meant that the "work area division" could not be a purely mental idea. The board disagreed since this understanding of the newly introduced feature presupposes that a work cycle was actually implemented. Claim 1 of auxiliary request 1 however only required that cycle times are calculated, not that any cycle is in fact carried out. It is possible to mentally divide a layout into two areas, creating a work area division and then calculate cycle times. The appellant had therefore not convincingly demonstrated that the decision under appeal was incorrect on this point.

Claim 1 of auxiliary request 2 differed from claim 1 of auxiliary request 1 in that the feature "wherein the step of defining the layout (150) and/or the step of defining the work area division is executed by a computer" was introduced. The board held that this step now required technical means and the claim as a whole was no longer excluded from patentability under Art. 52 EPC.

033-04-26

3. Article 056 EPC | T 0610/24 | Board 3.5.01

Article 056 EPC

Case Number	T 0610/24
Board	3.5.01
Date of decision	2025.12.16
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Articles 056, 111(1) EPC
EPC Rules	
RPBA	Article 11 RPBA 2020
Other legal provisions	
Keywords	inventive step (no) – closest prior art (no, different purpose) – ex post facto analysis – remittal (yes, including a prior art search)
Cited decisions	G 0010/93
Case Law Book	I.D.3.4 , 11th edition

In [T 610/24](#) the invention in claim 1 concerned chemical pumps and their compatibility with chemical compositions. The examining division had considered document D5 to represent the closest prior art, which, the appellant argued, was concerned with a different purpose than the claimed invention, namely that of ensuring that the correct chemical was dispensed in the right container – a labelling issue rather than a compatibility issue. Nothing in D5 suggested analysing the chemical compatibility between the material of a pump or container and the chemical composition being in contact with such a material. Thus, the examining division had erred in its conclusion that D5 disclosed a chemical compatibility check between the chemical solution and the container.

The appellant furthermore argued that, starting from D5, the skilled person would not have recognised the problem of chemical damage to the pump, and would therefore not have sought a solution to such a problem.

The board agreed with the appellant that D5 does not disclose a compatibility check between a pump or container and the chemical composition that comes into contact with this component. Furthermore, the board considered that D5 does not disclose a pump at all. Accordingly, in order to arrive at the claimed subject-matter starting from D5, the skilled person would first have to add a chemical pump, then address the issue of chemical compatibility, and finally apply the automated compatibility check proposed in D5 for this purpose. Even if each of these steps were known or

individually trivial, a motivation would still be required for the skilled person to modify the prior art in the claimed manner. The board could not identify such a motivation when starting from D5 as the closest prior art.

The above raised the question whether D5 was an appropriate starting point for the assessment of inventive step. The board referred to the established case law on the problem-solution approach that the "closest prior art" should normally be a document that is directed to the same purpose or aims at the same objective as the claimed invention and that has the most relevant technical features in common, i.e. requiring the minimum of structural modifications. The board noted that while it is not mandatory to start from the strictly closest prior art when arguing a lack of inventive step, it is nevertheless recommended to start from prior art having a similar purpose and overall technical effect. Starting from a more remote document often leads to an ex post facto analysis, in particular to the formulation of a "hindsight problem" – a problem that the skilled person would not have realistically conceived.

In the present case, the board found that D5 neither pursued the same purpose nor disclosed the structurally most significant component – the pump – which was a prerequisite for the technical problem addressed by the invention to arise at all. In the board's view, a more suitable starting point would be a system comprising a chemical pump and addressing issues of chemical compatibility with the components of that pump. Such a starting point would require fewer structural modifications and would allow for the formulation of a more realistic technical problem, such as the automation of the compatibility check.

The board could not rule out that a more suitable document addressing the problem of chemical compatibility of pump components existed. It appeared that this aspect had not been covered by the search. The search report indicated the field of search as IP class "G06Q", which relates to information and communication technology (ICT) specially adapted for administrative, commercial, financial, managerial, or supervisory purposes. This field does not encompass liquid pumps, let alone issues of chemical compatibility of pumps.

The board noted that before granting a patent, the board of appeal, like the examining division, must ensure that the requirements for patentability are met (see G 10/93, point 3 of the Reasons). To that end, the relevant state of the art must be properly established. Since the search was incomplete in that it did not cover all the relevant aspects of the invention, the relevant state of the art had not been properly established in the case in hand. The board thus remitted the case to the examining division for further prosecution, including a search (Art. 111(1) EPC).

034-04-26

4. Article 081 EPC | T 0528/25 | Board 3.2.07

Article 081 EPC

Case Number	T 0528/25
Board	3.2.07
Date of decision	2026.02.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 060(1), 062, 081 EPC
EPC Rules	Rule 019(1) EPC
RPBA	
Other legal provisions	Articles 12(6), 13(2) RPBA 2020
Keywords	designation of inventor – artificial intelligence – DABUS
Cited decisions	J 0008/20, J 0009/20, T 0878/21 Bundesgerichtshof, X ZB 5/22
Case Law Book	IV.A.6.2 , 11th edition

In [T 528/25](#) the appeal was directed against the decision of the examining division to reject the European patent application, since none of the requests on file contained a designation of the inventor that met the requirements of Art. 81 and R. 19 EPC. In J 8/20 the Legal Board of Appeal had dismissed an appeal against the refusal by the Receiving Section of the parent application, in which the applicant had intended to designate the artificial intelligence machine "DABUS" as inventor.

In the case at hand, the board first considered the legal framework regarding the designation of an inventor in the context of inventions made by using artificial intelligence (AI) as well as the reasons provided in J 8/20 (and J 9/20). The board concluded that, in principle, the designation of an inventor under the EPC is also possible for inventions developed using AI.

In the main request, the appellant had designated himself as the inventor in EPO Form 1002. However, in the Addendum to this form he had stated that "A machine called "DABUS" conceived of the present invention" and that the appellant was "not an inventor under traditional criteria", because "in the case of the present invention, the machine only received training in general knowledge in the field and proceeded to independently conceive of the invention and to identify it as novel and salient. If the training Dr Thaler provided DABUS had been given to a person, that person would meet inventorship criteria as inventor. In the present case, DABUS was not created to solve any particular problem, was not trained on any special data relevant

to the present invention, and the machine rather than a person identified the novelty and salience of the present invention." The board held that the statements presented in EPO Form 1002, on the one hand, and in the Addendum, on the other, did not contain a clear and unambiguous designation of the inventor as required under Art. 81 EPC and R. 19 EPC. The formulations in the Addendum did not merely supplement the statement in EPO Form 1002 with information that the invention was devised by using an AI-machine, but rather called into question the statement in EPO Form 1002 that the appellant should be formally indicated as the (only) inventor. Therefore, the main request was not allowable.

The first and second auxiliary requests included the following information in the Addendum:

"A machine called "DABUS" had been caused to conceive of the present invention

Dr Thaler had caused a specific machine called DABUS to conceive of the invention disclosed and claimed in this European patent application. Dr Thaler owns DABUS, built DABUS, trained DABUS, and used DABUS. In the present case, DABUS was not created to solve any particular problem, was not trained on any special data relevant to the present invention, and DABUS identified the novelty and salience of the present invention. (...)"

The board noted that the decisive question was how the appellant's declarations as a whole were to be formally understood. In light of the explanations in the Addendum, it could not be established clearly and beyond doubt in the context of the formal examination under Art. 81 EPC and R. 19 EPC that (only) the appellant was to be designated as inventor.

Likewise, the board found that the third auxiliary request was not allowable under Art. 81 EPC and R. 19 EPC. This request comprised only EPO Form 1002 with the following wording: "Stephen L. Thaler der die künstliche Intelligenz DABUS dazu veranlasst hat, die Erfindung zu generieren." The board noted that EPO Form 1002 was to be used in cases where the applicant was not the (sole) inventor, i.e. where R. 19(1), second sentence, EPC applied. While this use of this form might be unobjectionable if only the name of the applicant appears, the use of EPO Form 1002 together with the statement "der die künstliche Intelligenz Dabus dazu veranlasst hat, die Erfindung zu generieren" made the designation of inventor unclear and inconsistent. The board further noted that the present case differed from the factual situation underlying the decision of the German Federal Court of Justice of 11 June 2024 (BGH X ZB 5/22), in which a corresponding wording on the form was accepted. The form "Erfinderbenennung", on which the German case was based, generally also applies if the applicant himself is the sole inventor. Furthermore, it was expressly added by filling in on page 2 of the form the statement that "Erfinder ist Anmelder", i.e. the inventor is the applicant.

The fourth auxiliary request was not admitted into the appeal proceedings according to Art. 13(2) and 12(6) RPBA, and the board dismissed the appeal.

035-04-26

5. Article 083 EPC | T 0048/24 | Board 3.5.06

Article 083 EPC

Case Number	T 0048/24
Board	3.5.06
Date of decision	2025.11.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	Rule 042(1)(e) EPC
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure (no) – machine learning
Cited decisions	T 0161/18, T 0149/21, T 1669/21
Case Law Book	II.C.6.1.1 , 11th edition

In [T 48/24](#) claim 1 as granted defined a device comprising a "training data generation unit", a "model construction unit" and an "estimation unit". The device was for training and using machine learning for obtaining a "value representing the composition of waste" in a waste pit upon inputting "data of" a captured image of the waste.

The board observed that sufficiency of disclosure had to be assessed for each case individually. The board saw no apparent reason to treat inventions in the field of machine learning differently from other inventions in this regard. According to the board, it went without saying that the implementation of a suitable machine learning model, its training, and whether the trained model can successfully estimate the specified output based on the input parameters as claimed may be important aspects of sufficiency of disclosure of machine learning inventions. However, there were no special requirements and no general rules for assessing whether these aspects were sufficiently disclosed.

With regard to the decisions referred to by the appellant (opponent), the board considered that it was not possible to derive from T 161/18 any general criteria which might be applicable to the present case. Similarly, the board observed that T 1669/21 illustrated the glaring gap between the breadth of the claimed invention and the level of detail in the patent, but did not provide generally applicable criteria required for sufficiently disclosing a machine learning invention. Likewise, the board also pointed out that the considerations in the present case did not imply any universally applicable criteria for assessing sufficiency of disclosure of machine learning inventions.

In the case in hand, the board noted that the patent did not contain a specific example of the claimed invention. That is, it did not disclose any specific combination of certain "data of" captured images and a particular "value representing composition" of the waste in the images, nor did it provide any details on the implementation and training of an exemplary machine learning model, or any information on the achieved accuracy of estimation. In other words, the patent did not contain any concrete, reproducible example of implementation of the invention. Such a specific example was not in itself an absolute requirement for sufficient disclosure, provided that the skilled person was aware of "at least one way" of carrying out the invention in other ways, for example, through the generic disclosure in the patent or the common general knowledge (see R. 42(1)(e) EPC, "using examples where appropriate"). In the present case, however, providing such an example could have demonstrated that the invention was workable at all, at least in this specific case of the example. It could have served as a reference to better understand the claimed invention, its terms and purpose and the achievable or expected level of accuracy.

The board also explained that sufficiency of disclosure required that the invention could be carried out over the whole claimed breadth without undue burden. This requirement had been formulated in decisions across all technical fields (T 149/21). It reflected the general principle that the protection obtained with the patent had to be commensurate with the disclosed teaching. Even if "one way" of performing the invention was disclosed, this would only be sufficient if this disclosure enabled the skilled person to perform the invention over the whole claimed breadth. The patent in suit taught the general idea of using machine learning to infer properties of the waste composition that could be relevant for operating and controlling a waste incineration plant from images of the surface of the waste pit. However, the disclosure was mostly limited to stating a "result to be achieved". The patent left it to the skilled person to select and evaluate combinations of input data and machine learning models for different desired outputs. Each evaluation involved implementing, training and evaluating the selected models. Overall, this resulted in an enormous number of parameter combinations to choose from. Exploring all the possible combinations of these parameters would require a comprehensive research programme and would place an undue burden on the skilled person.

The board concluded that the maintenance of the patent as granted according to the main request was prejudiced by the ground for opposition under Art. 100(b) EPC. Auxiliary requests 1 to 7 were not allowable under Art. 83 EPC either.

036-04-26

6. Article 084 EPC | T 1096/23 | Board 3.4.03

Article 084 EPC

Case Number	T 1096/23
Board	3.4.03
Date of decision	2025.12.04
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – clarity – granted dependent claim incorporated into an independent claim of another category
Cited decisions	G 0003/14
Case Law Book	II.A.1.4 , II.A.3.10 , 11th edition

In [T 1096/23](#) opponent 1 (appellant) raised among other things a clarity objection against auxiliary request 2. In this request, features of granted claim 6, which had originally been disclosed only as a dependent method claim, had been included in the independent apparatus claim 11. Opponent 1 submitted that clarity of these features had to be assessed, since G 3/14 did not apply when the category of the (dependent) claim was changed. As there was no disclosure of an apparatus which was configured to carry out these method steps, it was unclear how the method steps were implemented in the apparatus. Therefore, the subject-matter of independent apparatus claim 11 did not meet the requirements of Art. 84 EPC.

The board agreed with the patent proprietor (appellant) that according to G 3/14, when "complete dependent claims" have been added to the corresponding independent claim, the patent must not be examined for compliance with the requirements of Art. 84 EPC. But the board agreed with the reasoning of opponent 1 that this did not apply in the present case to the implementation of the method of the dependent method claim in the apparatus defined in claim 11. However, when a complete granted dependent claim is incorporated into an independent claim of another category (here: method step -> method step carried out by an apparatus), then only the amendments related to the change of category can be examined for clarity under G 3/14.

The board held that in the case of a sub-step of a method, which was (implicitly) executed in a computer program, it made no difference for the purposes of clarity whether this method step was part of a (computer-implemented) method or was implemented in computational means in an apparatus claim, so that no ambiguity could arise. Consequently, adding the features of the original dependent method claim 6 to the wording of apparatus claim 11 did not result in any ambiguity for the skilled person. Claim 11 of auxiliary request 2 met the requirements of Art. 84 EPC.

037-04-26

7. Article 112a(2)(d) EPC | R 0016/23 | EBA

Article 112a(2)(d) EPC

Case Number	R 0016/23
Board	EBA
Date of decision	2025.11.21
Language of the proceedings	EN
Internal distribution code	B
Inter partes/ex parte	Ex parte
EPC Articles	Articles 112a(2)(c) and (d), 113(1), 116(1) EPC
EPC Rules	Rules 104(a), 109(2)(b) EPC
RPBA	
Other legal provisions	
Keywords	petition for review – failure to arrange oral proceedings – fundamental procedural defect (yes) – decision under review set aside – re-opening of proceedings
Cited decisions	J 0006/22, R 0003/10
Case Law Book	III.C.3.1 , III.C.3.1.2 , III.C.3.1.5 , III.C.5.3.2f , V.B.4.4 , V.B.4.4.1 , III.H.2.3.5 , III.H.7 , 11th edition

The petition in [R 16/23](#) concerned decision J 6/22 with which the Legal Board of Appeal (the "Legal Board") rejected the petitioner's request for re-establishment of rights and rejected the appeal as inadmissible. The petitioner argued that the Legal Board had failed, contrary to Art. 116 EPC, to arrange for the holding of oral proceedings requested by the petitioner, which represented a fundamental procedural defect within the meaning of Art. 112a(2)(d) EPC and R. 104(a) EPC. Furthermore, the decision was based on grounds or evidence on which the petitioner had not had any opportunity to comment, representing a fundamental violation of Art. 113(1) EPC within the meaning of Art. 112a(2)(c) EPC. The petitioner submitted, inter alia, that the conclusions in the decision under review that procedural economy had been a justification for denying the petitioner's right to an oral hearing were contrary to the established case law of the Boards of Appeal.

The Enlarged Board of Appeal (the "EBA") as composed under R. 109(2)(b) EPC held that, according to the wording of Art. 116 EPC, the aspect of expediency referred only to the first alternative, where oral proceedings take place at the EPO's own initiative. Thus, the department concerned with a request for oral proceedings made by a party to the proceedings had no discretion over whether oral proceedings take place.

The EBA also recalled that the right to request oral proceedings included the right for the party requesting them merely to present orally what it had already submitted in writing (see R 3/10). It held that Art. 116(1) EPC, taking into account the purpose of this provision, was thus intended to ensure that a party was entitled, upon request, to make oral submissions prior to a decision which adversely affected that party.

The EBA agreed with the decision under review in that the case law of the Boards of Appeal had established that, in specific situations which may be considered as covered by the wording of Art. 116(1) EPC, a decision taken without prior oral proceedings despite a request for oral proceeding having been made could be considered as not being in conflict with that provision. It found, however, that the situation underlying the decision under review did not fall under any of the categories established in the case law.

Furthermore, the EBA saw no indication that a dynamic interpretation could lead to the conclusion that Art. 116(1) EPC left room for weighing up, on the one hand, the petitioner's right to present the case orally before the adverse decision had been taken and, on the other hand, aspects relating to the expeditious conduct of the appeal proceedings, legal certainty or the prospects of success of the petitioner's appeal, or to a conclusion that the Legal Board had not been obliged to arrange for the holding of oral proceedings requested by the petitioner. The EBA was not persuaded that the considerations relied upon in the decision under review could lead to the result that the requested oral proceedings had not been mandatory under Art. 116(1) EPC, nor that the petitioner's right to oral proceedings could be balanced against considerations relating to the requirement of timely legal certainty or procedural economy.

The EBA concluded that the Legal Board's failure to arrange for the holding of the oral proceedings had been contrary to Art. 116 EPC and, in view of this, a fundamental procedural defect under Art. 112a(2)(d) EPC had occurred.

According to the EBA, in the case underlying the petition for review, the issues in relation to which oral proceedings had been requested and the final decision had been linked. Hence, the procedural defect of not arranging for the holding of oral proceedings, contrary to Art. 116 EPC, had been a fundamental one within the meaning of Art. 112a(2)(d) EPC in conjunction with R. 104(a) EPC. To arrive at this conclusion, the EBA, in particular, did not have to additionally assess whether the outcome of the decision under review could or would have been different if the procedural defect of not arranging for the holding of oral proceedings had not occurred. According to the EBA, this approach was in line with the case law of the Boards of Appeal, including the EBA (R 3/10).

As a fundamental procedural defect under Art. 112a(2)(d) EPC in conjunction with R. 104(a) EPC had been established, the petition for review was considered allowable. According to the EBA the further ground for the petition (fundamental violation of Art. 113(1) EPC) did not need to be addressed. The decision under review was set aside and the proceedings before the board re-opened.

038-04-26

8. Article 114 EPC

| T 0644/24

| Board 3.2.03

Article 114 EPC

Case Number	T 0644/24
Board	3.2.03
Date of decision	2026.01.22
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 100, 114(1), 123(2) EPC
EPC Rules	
RPBA	Article 12(4) RPBA 2020
Other legal provisions	
Keywords	grounds for opposition – fresh grounds for opposition (yes) – approval given (no) – amendments' compliance with EPC requirements
Cited decisions	G 0010/91, G 0003/14
Case Law Book	V.A.3.2.3h , 11th edition

In [T 644/24](#) hatte die Kammer zu prüfen, ob die von der Beschwerdeführerin erstmals im Beschwerdeverfahren erhobenen Einwände unzureichender Offenbarung und unzulässiger Erweiterung als neue Einspruchsgründe im Sinne von G 10/91, Nr. 3 des Tenors anzusehen waren.

Die Kammer erinnerte eingangs daran, dass im Beschwerdeverfahren neue Einspruchsgründe nur mit dem Einverständnis des Patentinhabers geprüft werden dürfen (G 10/91, Nr. 3 des Tenors). Zugleich sind Änderungen der Ansprüche oder anderer Teile eines Patents, die im Einspruchs- oder Beschwerdeverfahren vorgenommen werden, im Beschwerdeverfahren in vollem Umfang auf die Erfüllung der Erfordernisse des EPÜ wie z. B. des Art. 123 (2) EPÜ überprüfbar (G 10/91, Nr. 19 der Gründe). Die Kammer schlussfolgerte, dass Art. 100 c) EPÜ im Beschwerdeverfahren daher nicht angewendet und das Patent wie erteilt nicht auf eine unzulässige Erweiterung geprüft werden darf, wenn der Einspruchsgrund nach Art. 100 c) EPÜ im Einspruchsverfahren nicht erhoben wurde und der Patentinhaber der Prüfung nicht zustimmt. Änderungen des Patents im Einspruchs- und Beschwerdeverfahren können im Beschwerdeverfahren unter Anwendung von Art. 123 (2) EPÜ hingegen auch ohne Zustimmung des Patentinhabers bezüglich des Vorliegens einer unzulässigen Erweiterung geprüft werden.

Des Weiteren stellte die Kammer fest, dass in G 10/91 nicht erörtert wird, ob ein geänderter Patentanspruch im Einspruchs- oder Beschwerdeverfahren nach

Art. 123 (2) EPÜ zur Gänze bezüglich einer unzulässigen Erweiterung geprüft werden darf oder nur bezüglich unzulässiger Erweiterungen, die von der Änderung herbeigeführt wurden. Nach Ansicht der Kammer ist Letzteres der Fall. Zum Einen spricht G 10/91, Nr. 19 der Gründe, nicht von "geänderten Ansprüchen", sondern von "Änderungen der Ansprüche", die auf die Erfüllung des Erfordernisses von Art. 123 (2) EPÜ zu prüfen sind. Zum Anderen greift das in G 10/91, Nr. 18 der Gründe genannte Verbot der Einführung neuer Einspruchsgründe im Beschwerdeverfahren ohne Zustimmung des Patentinhabers.

Ähnliche Überlegungen gelten für den Einspruchsgrund nach Art. 100 b) EPÜ, der nach Ansicht der Kammer als eigenständige materiellrechtliche Norm für das Erfordernis der ausreichenden Offenbarung bzw. der Ausführbarkeit bezüglich des Patents wie erteilt anzusehen ist. Unter Berücksichtigung des für das gesamte Patentsystem grundlegenden Zwecks von Art. 83 EPÜ muss in teleologischer Hinsicht davon ausgegangen werden, dass das Erfordernis der ausreichenden Offenbarung auch für das geänderte Patent gelten muss. Die Große Beschwerdekammer stellte dies im Rahmen von G 3/14, Nr. 77 fest, wo Art. 83 EPÜ unter den Erfordernissen des EPÜ genannt wird, "die eindeutig unter Art. 101 (3) EPÜ fallen". In Nr. 76 der Gründe stellte sie unter Verweis auf G 10/91 zudem klar, dass ein Einwand nicht ausreichender Offenbarung im Beschwerdeverfahren ohne Einverständnis des Patentinhabers nur im Hinblick auf die Änderung im engeren Sinn, nicht aber im Hinblick auf "das gesamte Patent [...] oder [...] den [gesamten] geänderten Anspruch" geprüft werden darf. Der Kammer zufolge entspricht diese Überlegung auch der Kernaussage zur Auslegung von Art. 101 (3) EPÜ und Art. 84 EPÜ in G 3/14. Die Zusammenschau von Tenor und Nr. 76 der Gründe zeige auf, dass die Große Beschwerdekammer den Umstand, dass Art. 84 EPÜ kein Einspruchsgrund ist und den Umstand, dass ein zuvor nicht erhobener Einspruchsgrund nach Art. 100 b) EPÜ gemäß G 10/91 im Beschwerdeverfahren ohne Einverständnis des Patentinhabers nicht geprüft werden darf, für das Beschwerdeverfahren im Ergebnis gleichgesetzt hat. Die Kammer befand daher, dass das Ausmaß der Prüfungsbefugnis bezüglich unzureichender Offenbarung beim geänderten Patent dem Ausmaß bezüglich unzulässiger Erweiterung entspricht. Wurden die Einspruchsgründe nach Art. 100 b) und c) EPÜ im Einspruchsverfahren nicht erhoben und erteilt der Patentinhaber nicht sein Einverständnis zu deren Prüfung, darf der Kammer zufolge im Beschwerdeverfahren das Patent im Fall einer Änderung im Einspruchs- oder Beschwerdeverfahren daher nicht in seiner Gesamtheit, sondern nur insoweit auf unzureichende Offenbarung und unzulässige Erweiterung geprüft werden, als die Änderung diese herbeiführt.

Im Übrigen hob die Kammer hervor, dass im Einspruchsverfahren zu berücksichtigen ist, dass die Einspruchsabteilung die Möglichkeit hat, ausnahmsweise auch neue Einspruchsgründe in das Einspruchsverfahren einzuführen. Da dies bereits für das Patent wie erteilt gilt, ist die Einspruchsabteilung in Anwendung des Art. 114 (1) EPÜ nicht darin gehindert, das geänderte Patent in seiner Gesamtheit zu prüfen.

039-04-26

9. Rule 080 EPC

| T 0561/23

| Board 3.5.01

Rule 080 EPC

Case Number	T 0561/23
Board	3.5.01
Date of decision	2026.02.26
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 080 EPC
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment occasioned by a ground for opposition (yes) – replacement of one independent claim by several independent claims – subject-matter already defined in granted dependent claims
Cited decisions	G 0009/92, T 0181/02, T 1138/02, T 1416/04, T 0263/05, T 0993/07, T 1679/09, T 1025/14, T 1191/22, T 1772/23
Case Law Book	IV.C.5.1.2d , 11th edition

In [T 561/23](#) wies die Kammer darauf hin, dass es laut Rechtsprechung der Beschwerdekammern grundsätzlich zulässig ist, einen erteilten unabhängigen Anspruch, der im Einspruchsverfahren als nicht neu oder nicht erfinderisch angesehen wurde, durch mehrere unabhängigen Ansprüche zu ersetzen, sofern diese jeweils auf Gegenstände gerichtet sind, die bereits in den erteilten abhängigen Ansprüchen definiert waren.

Der Hilfsantrag XIb' wurde während der mündlichen Verhandlung vor der Kammer eingereicht, nachdem die Kammer im Verlauf der Diskussion ihre vorläufige Auffassung geändert hatte. Die Kammer hielt dies für eine angemessene Reaktion der Patentinhaberin auf den Verfahrensverlauf und entschied, den Antrag gemäß Art. 13(2) VOBK in das Beschwerdeverfahren zuzulassen.

Die Kammer stellte zunächst fest, dass Anspruch 1 dieses Antrags auf Anspruch 1 des Hilfsantrags I basiert, und dahingehend geändert wurde, dass mindestens eines der Merkmale (a) und (b) erfüllt sein muss. Diese Merkmale entsprachen den Alternativen (c) und (d) des im Beschwerdeverfahren zurückgezogenen Hilfsantrags III. Sie gingen auf den erteilten abhängigen Anspruch 7 bzw. auf die

letzte Alternative des erteilten abhängigen Anspruchs 12 zurück. Damit definierte Anspruch 1 im Grunde zwei unabhängige Ansprüche. Der erteilte unabhängige Anspruch 1 wurde im Einspruchsverfahren als nicht neu im Sinne von Art. 54(3) EPÜ angesehen. Die Kammer erachtete es daher für zulässig, diesen durch mehrere unabhängige Ansprüche zu ersetzen, die unterschiedliche, bereits in den erteilten abhängigen Ansprüchen definierte Ausführungsformen betreffen. Zudem waren die Ansprüche 7 und 12, auf denen die Alternativen (a) und (b) beruhen, in der erteilten Fassung als parallel zu Anspruch 1 abhängige Ansprüche formuliert. Damit entsprach die vorliegende Situation der Kammer zufolge der in T 181/02 beschriebenen Ausnahme, in der eine erhöhte Anzahl unabhängiger Ansprüche durch die Einspruchsgründe veranlasst sein kann.

Demgegenüber stellt die von der Einspruchsabteilung herangezogene Entscheidung T 1138/02 nach Ansicht der Kammer eine Einzelfallentscheidung dar, der generell nicht zu folgen ist. Die Kammer führte aus, dass R. 80 EPÜ lediglich verlangt, dass eine Änderung durch einen Einspruchsgrund veranlasst ist, d. h. darauf abzielt, einen solchen Einwand auszuräumen und damit den Widerruf des Patents zu vermeiden. Aus der fehlenden Neuheit von Anspruch 1 kann sich zwar ein Einwand mangelnder Einheitlichkeit ergeben. Mangelnde Einheitlichkeit stellt jedoch keinen Einspruchsgrund dar. Zudem hat die Patentinhaberin im Einspruchsverfahren nicht die Möglichkeit, unterschiedliche Erfindungen durch Teilanmeldungen weiterzuverfolgen. Die Kammer befand daher, dass unter diesen Umständen kein Anlass besteht, die Patentinhaberin zu verpflichten, zwischen mehreren parallel zu Anspruch 1 abhängigen Ansprüchen auszuwählen.

Die Kammer stellte ferner klar, dass auch die Verwendung von "und/oder"-Formulierungen in abhängigen Ansprüchen der Vereinbarkeit von Hilfsantrag XIb' mit R. 80 EPÜ nicht entgegenstand. Eine "und/oder"-Formulierung kann zwar dazu führen, dass mögliche Rückzugspositionen im erteilten Anspruchssatz schwer vorhersehbar sind und Fragen hinsichtlich der ursprünglichen Offenbarung aufwerfen. Solche Fragen betreffen jedoch gegebenenfalls Art. 84 oder Art. 123(2) EPÜ und sind für die Beurteilung nach R. 80 EPÜ ohne Bedeutung.

Auch hinsichtlich des Anspruchs 12 folgte die Kammer der Argumentation der Beschwerdeführerin. Dieser Anspruch betraf ein Fenster mit einem Jalousiesystem entsprechend Anspruch 1 des Hilfsantrags I, welches dem Jalousiesystem der erteilten Ansprüche 1, 2 und 4 entsprach. Die vorgenommenen Änderungen bestanden lediglich darin, dass Merkmale, die zuvor durch Verweis auf andere Ansprüche einbezogen waren, nun ausdrücklich im Anspruch wiedergegeben werden.

Die Kammer gelangte daher zu dem Ergebnis, dass die im Hilfsantrag XIb' vorgenommenen Änderungen durch die Einspruchsgründe veranlasst waren und den Anforderungen der R. 80 EPÜ entsprechen. Die Angelegenheit wurde an die Einspruchsabteilung zur weiteren Prüfung zurückverwiesen.

040-04-26

10. Rule 137(5) EPC | T 1176/24 | Board 3.2.07

Rule 137(5) EPC

Case Number	T 1176/24
Board	3.2.07
Date of decision	2026.02.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	Rule 137(5) EPC
RPBA	
Other legal provisions	
Keywords	amendments of application – amended claims relating to unsearched subject-matter – error in the application of R. 137(5) EPC
Cited decisions	T 0613/99, T 0708/00
Case Law Book	IV.B.5.3.1 , 11th edition

[T 1176/24](#) was an appeal against the examining division's decision not to admit the main request under R. 137(5) EPC.

The sole independent claim 1 of the main request was a combination of original claim 90 (with reference to original claim 1) and the features of original claim 93. The examining division had agreed with the competent search division that the common concept between original claim 1 and original claim 93 was the friction coefficient increasing treatments, which was known from D1. Since this concept was known, it could not serve as a single general inventive concept, so that the original application did not fulfil the requirement for unity of invention under an a posteriori analysis. Furthermore, the applicant had not paid the requested additional search fee in time and the invention of original claim 93 had therefore not been searched. The examining division had concluded that claim 1 of the main request related to unsearched subject-matter which did not combine with the originally claimed group of inventions to form a single general inventive concept.

The board, however, was of the view that the examining division had erred in its application of R. 137(5) EPC by merely finding that original claim 93 did not meet the requirements of unity when assessed a posteriori. This criterion was irrelevant in the context of the case at hand when applying R. 137(5) EPC.

The board recalled that, according to well-established case law, R. 137(5) EPC did not apply when the applicant has not paid the search fee in respect of a non-unitary invention relating to the originally filed claims. Furthermore, the examining division had not established whether the features of original claim 93 as basis of the amendment to claim 1 of the main request could be subordinated to the original general inventive idea underlying original claim 90 with reference to original claim 1. The subject-matter of claim 1 of the main request as well as the subject-matter of original claim 90 were directed to a threaded fastener, i.e. an assembly of a nut or a stud-head and a reaction washer for receiving counter torque generated due to tightening or loosening of the threaded fastener. The feature added by original claim 93 related to a further and more specific implementation of the interplay between the nut or stud-head and the reaction washer in defining a bond that connects said elements and breaks at or prior to a predetermined pre-torque.

The board was therefore convinced that claim 1 of the main request merely constituted a restriction to a particular embodiment of the subject-matter as claimed in the original claim 90 (with reference to original claim 1) and could be subordinated to the original general inventive idea. This applied as well if the general inventive idea relating to original claim 90 (with reference to original claim 1) was to be seen in an improvement in the friction between the workpiece and the reaction washer, as it was defined by the examining division. In this context, the board pointed to the features of original claim 93, which established a connection between the breaking point of the connection between the nut/stud-head and the reaction washer in dependence of the existent friction forces.

The board concluded that claim 1 of the main request did not fulfil the conditions required for the application of R. 137(5) EPC and that the examining division's decision not to allow the amended claims under that provision was incorrect.

In its decision, the board stressed that a supplementary search concerning the aspects arising from original claim 93, then reflected in claim 1 of the main request, would be in accordance with due process should the examining division deem it necessary. Moreover, such supplementary search appeared to be highly appropriate in the light of the examining division's findings.

041-04-26

11. Article 13(2) RPBA 2020 | T 1296/23 | Board 3.5.06

Article 13(2) RPBA 2020

Case Number	T 1296/23
Board	3.5.06
Date of decision	2025.12.18
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(1)(a), 12(2), (3), 12(4), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment to appeal case – submissions at first instance not automatically part of appeal case – request on which decision under appeal was not based – express maintenance on appeal required
Cited decisions	T 1309/16, T 1943/16
Case Law Book	V.A.4.2.3b), 11th edition

In [T 1296/23](#) the board pointed out that requests filed during the first-instance proceedings on which the department of first instance had taken no decision were not automatically part of the appeal proceedings. The board had an obligation to review the decision under appeal (Art. 12(2) RPBA; see also T 1309/16 and T 1943/16). This obligation, however, did not extend to auxiliary requests, which were not amongst the requests on which the decision under appeal was based (Art. 12(2) RPBA). That some of these requests might have been "admissibly raised" within the meaning of Art. 12(4) RPBA was immaterial in this regard, unless they had also been expressly maintained on appeal.

In the case in hand, the decision under review was the interlocutory decision of the opposition division to maintain the patent on the basis of auxiliary request 2. Auxiliary requests 3 to 9 filed before the opposition division were only mentioned in the facts and submissions of the decision under appeal. The respondent (proprietor) made no specific requests. Since it countered the appellant's arguments why auxiliary request 2 did not comply with the EPC, the board understood the respondent's (sole) request to be that the appeal be dismissed. This was also noted in the communication under Art. 15(1) RPBA. The board's assessment of the respondent's request(s) remained uncontested until the oral proceedings. In the board's view, the absence of such an objection could be considered as a silent acknowledgment that,

when filing its response to the appeal (and in fact at any time before the oral proceedings took place), the respondent only requested maintenance of the patent on the basis of auxiliary request 2. As noted by the board, auxiliary requests 3 to 9 were at the very least not expressly part of the reply to the statement of grounds of appeal and therefore not amongst the requests defining the respondent's case according to Art. 12(3) RPBA.

Only at the oral proceedings did the respondent submit that they had considered auxiliary requests 3 to 9 to be part of the appeal proceedings given that they were mentioned in the decision under appeal and in the appellant's rejoinder. The board did not agree. It pointed out that it was apparent from the summary of facts and submissions and the absence of reasons given in the decision under appeal in respect of those requests that they did not form part of the basis for that decision within the meaning of Art. 12(1)(a) and 12(2) RPBA. The board also noted that nothing in the appellant's rejoinder indicated that the appellant would have understood that said requests were also part of the appeal proceedings.

The board concluded that auxiliary requests 3 to 9 were made for the first time in the oral proceedings before the board. They therefore constituted an amendment under Art. 13(2) RPBA. The board did not consider the explanation given by the respondent for filing these requests only at the oral proceedings to identify exceptional circumstances. It further explained that the re-introduction of said requests and any reasons relating to such requests at such a late stage of the appeal proceedings would contravene the principle of procedural economy, if only because their admittance would have required either a postponement of the oral proceedings or a remittal to the department of first instance. The board decided, therefore, not to take into account auxiliary requests 3 to 9 in the appeal proceedings.

042-04-26

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