



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Abstracts of decisions

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

Issue 05 | 2025



Boards
of Appeal

Disclaimer

The summaries in this publication are prepared by the Legal Research Service of the Boards of Appeal for information only. They must therefore not be relied on in any way, in particular in proceedings before the European Patent Office or the Boards of Appeal. Summaries, no matter how carefully prepared, cannot serve as substitutes for the decisions themselves. The full decisions can be found in the [decisions database](#) of the Boards of Appeal website.

Copyright note

The abstracts included in this publication may not be reproduced or transmitted by any means or in any form or by any information storage and retrieval system, without the prior written permission of the editors.

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.

Edited by

Legal Research Service of the Boards of Appeal

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

Abstracts of decisions

In this issue:

1.	Article 054 EPC	T 1612/21 Board 3.2.07	1
2.	Article 056 EPC	T 0201/21 Board 3.5.01	3
3.	Article 056 EPC	T 0356/22 Board 3.3.07	5
4.	Article 056 EPC	T 0746/22 Board 3.4.02	7
5.	Article 056 EPC	T 1865/22 Board 3.3.02	9
6.	Article 083 EPC	T 1977/22 Board 3.3.06	11
7.	Article 104(1) EPC	T 0617/20 Board 3.3.10	13
8.	Article 112a(2)(c) EPC	R 0012/21 Board EBA	15
9.	Article 117 EPC	T 0449/23 Board 3.3.02	17
10.	Article 123(2) EPC	T 0298/22 Board 3.4.03	19
11.	Article 13(2) RPBA	T 1544/22 Board 3.4.03	21
12.	Article 13(2) RPBA	T 0449/23 Board 3.3.02	23

1. Article 054 EPC | T 1612/21 | Board 3.2.07

Article 054 EPC

Case Number	T 1612/21
Board	3.2.07
Date of decision	2024.12.19
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 054 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	novelty – state of the art – public prior use – obligation to maintain secrecy
Cited decisions	T 2273/11, T 2210/12
Case Law Book	I.C.3.2.4 , I.C.3.4 , 10th edition

In [T 1612/21](#) hatte die Einspruchsabteilung auf Grundlage der ihr zur Verfügung stehenden Beweismittel zutreffend festgestellt, dass es deutliche Hinweise auf das Bestehen einer Geheimhaltungsverpflichtung gab – insbesondere durch die Aussage des Zeugen der Beschwerdeführerin, Herrn Trick, wonach die Beschwerdeführerin grundsätzlich eine Geheimhaltung mit ihren Kunden vereinbart.

Der von der Beschwerdeführerin selbst angebotene Zeuge, Herr Trick, hatte vor der Einspruchsabteilung zudem ausdrücklich erklärt, dass die Generation 2 der CBC-200 für den Auftrag der Daimler AG entwickelt worden war. Dazu war die Maschine verändert worden. Dies möge vorrangig die Prozessentwicklung betroffen haben, wie es die Beschwerdeführerin vortrug, dies führte jedoch laut der Aussage des Zeugen auch zu Veränderungen an der Maschine. Es handelte sich bei der an die Daimler AG gelieferten Anlage CBC-200 also nicht von Anfang an um eine Standardmaschine der Beschwerdeführerin, sondern diese war das Ergebnis der Kooperation mit der Daimler AG.

Vor diesem Hintergrund ließ die Aussage des Zeugen, dass grundsätzlich eine Geheimhaltung mit den Kunden bestand, ob schriftlich oder üblicherweise in mündlicher Form zu den Verfahrensparametern, wie es die Beschwerdeführerin angab, ausreichend Zweifel an der Behauptung der Beschwerdeführerin entstehen, dass die Lieferung der Anlage CBC-200 nicht einer Geheimhaltungsvereinbarung

unterlag, so dass sich die Beweislast zur Existenz der Geheimhaltungsverpflichtung auf die Beschwerdeführerin verlagerte.

Vor diesem Hintergrund waren die von der Beschwerdeführerin angeführten Entscheidungen T 2210/12 und T 2273/11 für den gegebenen Fall nicht einschlägig, da diese jeweils Sachverhalte betrafen, in dem sich keinerlei Anhalt für eine Geheimhaltungsverpflichtung bot, bzw. eine solche explizit verneint wurde. Die Beschwerdeführerin war hingegen an der geltend gemachten Vorbenutzung als Verkäuferin beteiligt. Folglich lagen praktisch alle Beweismittel zu der Offenkundigkeit in ihrer Verfügungsmacht und ihrem Wissen. Es oblag auch deshalb im gegebenen Fall der Beschwerdeführerin, die durch ihren eigenen Zeugen aufgebrachten Zweifel an der Offenkundigkeit der Vorbenutzung in überzeugender Weise auszuräumen.

Da aber auch die weiteren im Verfahren befindlichen Beweismittel nicht geeignet waren, diese Zweifel auszuräumen, sondern im Gegenteil zu der Geschäftspraxis schwiegen und insbesondere der von der Beschwerdeführerin selbst angebotene Zeugenbeweis die Existenz einer Geheimhaltungsverpflichtung als geschäftsüblich nahelegte, schließt sich die Kammer der Feststellung der Einspruchsabteilung an, dass die geltend gemachte Vorbenutzung CDC-200 nicht offenkundig war und somit nicht dem Stand der Technik zugerechnet werden konnte.

045-05-25

2. Article 056 EPC | T 0201/21 | Board 3.5.01

Article 056 EPC

Case Number	T 0201/21
Board	3.5.01
Date of decision	2024.04.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (no) – technicality – one-time passwords
Cited decisions	
Case Law Book	I.D.9.2.11h , 10th edition

In [T 201/21](#), the prior art disclosed a system for verifying authentication and ownership of a physical article. Each article included a label having a unique authentication code, pre-stored on a server database. The authentication code can be used to verify authenticity of an item by sending a query to a manufacturer's server. When a transaction takes place, the merchant registers ownership of the item by sending a registration request to the server including the article's unique code and a generated unique number. The registration only takes place if the code and number are not already associated with another sale.

Claim 1 differed from the prior art essentially in that card numbers are pre-stored in the central database and provided to the merchant on a brand property card (BPC), in that the database is populated with point of sale data upon entry of the numbered cards at a point of sale, in that a BPC card is provided to the user and its number is combined by the merchant with the unique identifier code in a registration request, and in that the registration is only possible if both the BPC card number and unique identifier code match a number and a code stored on the server and not associated with a sold physical article.

The appellant had argued that these features increased the security of the authentication method by providing a second authentication factor. In particular, it was argued that "... the combination of ... pairing [of the unique card and article numbers] in the database and the use of numbered cards that are not initially paired with particular physical items, results in ... strong authentication of physical articles".

Moreover, they guarantee that the merchant has the authority to register the sold articles in the database.

The board found these arguments unconvincing. It regarded the general idea of protecting a transaction, here a registration, with a password as non-technical and also well known. The board further considered that the idea of using a predefined set of one-time passwords for user or merchant authentication also lacked technicality. Even when considered technical, this feature could not support an inventive step, as it corresponded to the well-known transaction authentication number (TAN) authentication procedure commonly used in online transactions. Making use of a server to store and verify the passwords or TAN numbers and of cards for distributing these to the merchant and customers was a straightforward implementation of this known procedure on well-known means.

The appellant had argued that the invention addressed the sales of luxury goods where customers appreciate tangible objects, such as certificates on elegant cards, and formulated the objective problem as "how to make the use of security tokens more attractive to a given population".

The board did not consider this an objective technical problem, as its formulation depended on the user's subjective preferences or expectations. From a technical point of view, the cards of claim 1 were merely a support for providing the merchant with the unique numbers to be used for the registration procedure. This was considered to be an obvious implementation possibility. Accordingly, the board concluded that claim 1 of the sole request lacked an inventive step over the prior art.

046-05-25

3. Article 056 EPC | T 0356/22 | Board 3.3.07

Article 056 EPC

Case Number	T 0356/22
Board	3.3.07
Date of decision	2024.12.20
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (no) – technical effect not credible – teaching of the prior art not limited to prepared and tested examples
Cited decisions	T 1193/18, T 2342/19, T 2200/17, T 1126/19
Case Law Book	I.D.3.1 , I.D.9.11 , 10th edition

In [T 356/22](#) the invention sought to provide dosage forms of pomalidomide having advantageous physical and pharmaceutical properties, amongst these being stability. Starting from the pomalidomide composition of claim 22 of closest prior art D1, the differentiating feature was the presence of both mannitol and starch. The decision under appeal was that of the opposition division finding that the patent in suit met the requirements of the EPC.

The respondent (patent proprietor) effectively considered that, since there were no stable dosage forms shown in D1 which could serve as comparator, the achievement of a certain level of stability independently of any comparison with the prior art could be taken into account for the assessment of inventive step. The board did not agree; the circumstances of the case did not justify that the respondent be exonerated from their burden to properly demonstrate that the purported technical effect of the claimed invention had successfully been achieved in comparison with the prior art. That the disclosure of D1 was generic in some respects did not mean that it was speculative or insufficient, nor allowed the assumption that the formulations of D1 suffered from a lack of stability. The mere fact that D1 did not contain any prepared and tested specific formulations of pomalidomide did not change this conclusion; for the purposes of inventive step, the teaching of the prior art is not limited to prepared and tested examples.

The board confirmed that an inventive step could be acknowledged to a selection if this selection was connected to a particular technical effect, and if no hints existed leading the skilled person to the selection. This however supposed that this particular technical effect was convincingly shown for the entire selected subset of formulations by a meaningful comparison with other formulations falling within the ambit of D1.

The respondent cited several decisions to support their view that, when the prior art was unspecific, the achievement of a technical effect per se could be taken into account for the assessment of inventive step. The board firstly noted that in all the cited cases, experimental data were presented in respect of a differentiating feature (citing T 1193/18, T 2342/19, T 2200/17, T 1126/19). But more importantly, the board did not agree that D1 was unspecific; the claimed active ingredient and two excipients were explicitly recited and part of a limited number of emphasised alternatives in D1.

It had to thus be assessed whether the evidence on file convincingly demonstrated that the selection was associated with a technical effect over the pomalidomide formulations of D1, and whether this effect credibly arose over the whole claimed scope. The board did not consider that the application as filed credibly demonstrated the technical effects of improved stability or improved suitability for clinical use for the claimed selected formulations in comparison with D1.

The problem to be solved was thus seen in the provision of an alternative pomalidomide oral dosage form. Since the claimed selection was not shown to be associated with any technical effect, the board found that this selection was arbitrary and did not involve an inventive step. The board noted that considering the problem was only formulated as the provision of an alternative, the lack of preference expressed in D1 for the features selected in present claim 1 did not establish an inventive step, because the chosen alternative was not shown to be any more suitable than the others considered in D1.

047-05-25

4. Article 056 EPC | T 0746/22 | Board 3.4.02

Article 056 EPC

Case Number	T 0746/22
Board	3.4.02
Date of decision	2025.02.06
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (no) – technical effect (no) – arbitrary modification (yes) – no inventive step where no effect beyond an arbitrary modification
Cited decisions	T 0176/97
Case Law Book	I.D.9.6 , 10th edition

In [T 746/22](#) both the opponent and the patentee had appealed against the interlocutory decision of the opposition division maintaining the European patent in amended form.

Regarding independent claim 15 of the main request, both parties agreed with the board's finding that feature F2 was the only distinguishing feature in view of the objective lens described in table 1 of D4 (closest prior art). F2 defined a mathematical relation between the focal length of a "first rear positive lens" (f3) and the total focal length (f) of the five lenses of the claimed objective lens system.

The board was unable to see any effect of feature F2 other than to arbitrarily define a mathematical relationship between the focal length f3 of one of the lenses of the objective lens system with respect to the total focal length f of the objective lens system. However, in the present case, where the optical parameters of the claimed objective lens system were only very incompletely defined, the selection of a maximum value of f3 when f was fixed, or the selection of a minimum value of f when f3 was fixed, did not provide a technical effect relevant to the claimed invention.

In view of the absence of any relevant technical effect related to the feature F2, the board found that no objective technical problem solved by feature F2 could be defined, and as was explained in T 176/97, if the distinguishing feature of a claim has no effect of technical relevance on the claimed subject-matter and does not

credibly solve an objective technical problem, then no inventive step can be based on it. In the present case, the objective lens system of claim 15 was considered to be no more than an arbitrary modification of the objective lens system of D4, which did not involve an inventive step within the meaning of Art. 56 EPC.

The patentee argued that starting from the precise lens design in Table 1 of document D4, a skilled person would have a “perfect” lens design and thus no reason to modify any parameters without using hindsight from the invention. However, the board found this argumentation unconvincing because it assumed that, starting from the objective lens system disclosed in table 1 of D4, the skilled person would need a concrete incentive to modify it in a certain direction. This overlooked the point that the difference between the lens systems of claim 15 and of D4 was only an arbitrary modification of the lens design of D4. The question of whether there was a motivation to change the lens design of D4 did not arise in the present case. An arbitrary change to the lens design resulting in no relevant technical effect was in itself devoid of any inventive step.

Claim 1 of the first auxiliary request also lacked an inventive step in view of D1 in combination with D4. The patentee had argued that D1 already disclosed a perfectly optimised lens system and that the objective lens system of D4 was no better than that of D1. Again, the board was unable to follow the patentee’s argument that only with hindsight would the skilled person consider replacing the lens of D1 with the lens of D4. D1 merely disclosed a general lens without further details of its optical characteristics. Thus, it was not hindsight, but simply the fact that the teaching of D1 was put into practice that leads the skilled person to search for a specific lens design and eventually find the objective lens system of D4. As with claim 15, the feature at issue in claim 1 provided no technical effect other than arbitrarily modifying the lens design of D4. Therefore, this distinguishing feature did not contribute to inventive step. The subject-matter of claim 1 of the second and the third auxiliary requests lacked an inventive step in view of D1 in combination with D4 for the same reasons.

048-05-25

5. Article 056 EPC | T 1865/22 | Board 3.3.02

Article 056 EPC

Case Number	T 1865/22
Board	3.3.02
Date of decision	2024.10.21
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	Article 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	inventive step (no) – obvious deterioration of the technical effect described in the closest prior art – amendment to appeal case taken into account (no) – amendment detrimental to procedural economy (yes) – exceptional circumstances (no)
Cited decisions	G 0002/21
Case Law Book	I.D.5 , V.A.4.5.6 , V.A.4.5.10f , 10th edition

In [T 1865/22](#) the board determined that the objective technical problem was to provide an alternative stripping composition.

Considering obviousness, the board found that arbitrarily varying the concentrations of components in a composition, including changing the concentration of one component in favour or to the detriment of the other components, was routine for the skilled person. Such a measure did not involve an inventive step.

The respondent (patent proprietor) had also argued that the skilled person would not have reduced the amount of the coupling agent monoethylene glycol in example 2 of D7, because according to D7 high concentrations of the coupling agent were essential for the stripping composition to have an appropriate tolerance to water. Mainly because of this argument, the opposition division had acknowledged an inventive step based on D7 as the closest prior art.

The board stated that the mere fact that claimed subject-matter excluded a technical feature (here: the higher concentration of the coupling agent monoethylene glycol) disclosed in the closest prior art as being essential or advantageous for a technical effect (here: the advantageous effect of the higher concentration of the coupling agent monoethylene glycol on the tolerance to water) could not in itself establish the

existence of an inventive step. Rather, in situations such as the present one, where the exclusion of the technical feature in question was the only feature distinguishing the claimed subject-matter from the closest prior art, it must be shown that the claimed subject-matter achieved said technical effect to an extent comparable to that of the closest prior art, even without this feature. Without such proof, the claimed subject-matter merely resulted in an obvious deterioration of the technical effect described in the closest prior art.

It followed that the subject-matter of claim 1 of the main request was not based on an inventive step over D7 alone and that the main request was not allowable.

At the oral proceedings before the board, the respondent had also submitted for the first time in the appeal proceedings that the distinguishing feature was associated with technical effects. The stripping composition (i) had a lower viscosity and, as a consequence of this, was easier to filter and (ii) caused less damage to the substrate upon incorporation of water during use. In other words, the stripping composition was more tolerant to water. The board decided not to admit these submissions (Art. 13(1) and (2) RPBA). The respondent's submissions at the oral proceedings constituted an amendment to its appeal case and there existed no exceptional circumstances in the case in hand (Art. 13(2) RPBA). The change of representative approximately three weeks before the oral proceedings does not qualify as an exceptional circumstance.

The board also noted that the respondent's submission raised a complex issue. The application as filed did not mention anything about a reduction in viscosity or an improvement in filterability raised by the respondent in its submission. Against this background, the complex issue arose as to whether the respondent could rely on these effects at all for the assessment of inventive step (in light of G 2/21). In the board's view, this and a further complex issue also clearly spoke against the admittance of the respondent's submissions (Art. 13(1) RPBA).

Lastly, the respondent should have filed its submissions on the additional distinguishing feature "non-aqueous" and the two technical effects much earlier and not only at the oral proceedings before the board, i.e. at the latest possible stage of the appeal proceedings. Admitting these submissions would clearly have been contrary to procedural economy (Art. 13(1) RPBA).

In addition to the above, the board found that none of the auxiliary requests were allowable. The board ordered that the decision under appeal be set aside and that the patent be revoked.

049-05-25

6. Article 083 EPC | T 1977/22 | Board 3.3.06

Article 083 EPC

Case Number	T 1977/22
Board	3.3.06
Date of decision	2024.11.13
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 083 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole scope claimed – open ended range – criteria to apply – extensive analysis of landmark BoA decisions
Cited decisions	T 0226/85, T 0292/85, T 0129/88, T 0487/89, T 0409/91, T 0435/91, T 1008/02, T 1018/05, T 0624/08, T 2213/08, T 1697/12, T 2344/12, T 1943/15, T 0113/19, T 0398/19, T 1942/21
Case Law Book	II.C.5.5.2 , II.C.5.4 , 10th edition

In case [T 1977/22](#), the opposition division revoked the patent arguing that the definition of certain parameters in terms of an open-ended range rendered the invention insufficiently disclosed, as these parameters could not be reproduced over the whole scope of the open-ended side.

The board addressed this question by first reviewing the landmark decisions which gave rise to the principle of "reproducibility over the whole claimed scope" (T 435/91, T 292/85, T 226/85, T 409/91, and G 1/03), then reviewing the case law specifically dealing with open-ended range desiderata and sufficiency of disclosure, before addressing the question of how to apply the general requirement of "reproducibility over the whole scope" to the specific case of inventions defined in terms of an open-ended range desideratum, and finally by applying the proposed criteria.

More specifically, the board stated that the main idea behind the principle of reproducibility over the whole scope is that where an invention is defined as a combination of process and/or structural features (A+B) to achieve a certain result or

desideratum (X), the skilled person should be enabled to achieve the result (X) over the whole scope of the claim, which is intended to ensure that the breadth of the claimed invention is commensurate with the teachings of the patent, i.e. that the scope of protection is restricted to the actual technical contribution of the patent. According to the landmark decisions, the assessment should be based on balanced criteria, avoiding unrealistic requirements, such as excluding all non-working embodiments or providing instructions to identify every possible working embodiment, while still ensuring that the claim includes all features essential to achieving the defined desideratum and that the breadth covered by the functional definition is commensurate with the teachings of the patent.

The board then turned to review in detail the case law dealing with "open-ended ranges desideratum and sufficiency of disclosure" (point 3 of the Reasons). Following this, the board dealt with the key question of the reproducibility over the whole scope of open-ended ranges (point 4 of the Reasons). It stated that where the desideratum was, as in the present case, defined in terms of an open-ended range for a physical parameter of a product, the problem of reproducibility over the whole scope was analogous to that addressed in the landmark decisions, with the key distinction being that the inclusion of non-working embodiments may also stem from the desideratum itself, as the open definition broadens the claimed scope in such a way as to implicitly encompass non-working embodiments, i.e. irreproducible parametric values (unrealistically high) and/or yet-to-be-discovered alternatives (values only achieved with inventive skill). That the claim covered non-working embodiments was not in itself sufficient to conclude that the invention would not be reproducible over the whole scope. The key issue was the burden to be applied for assessing whether the teachings in the patent would enable the skilled person to reproduce the open-ended range over the whole scope of the open-ended side. In this respect, the open-ended definition should not be interpreted literally as requiring teachings enabling the skilled person to achieve any parametric value in the upward direction; interpreting the concept literally would impose a technically unsurmountable burden and would be in contradiction with the landmark decisions that it was not required that all non-working embodiments be excluded or that every working embodiment be enabled. Instead the board concluded that open-ended ranges should be interpreted as equivalent to a directional requirement to adjust and increase the parameter to obtain values as high as achievable (beyond the lower end value) with the structural and/or process features defined in the claim (see details point 4.6.7 of the Reasons; also Catchword and conclusions point 4.13). By making routine adjustments within the scope of these features, it was possible to achieve parametric values exceeding the lower-end limits.

The differing outcomes in the case law (open-ended ranges) did not stem from any fundamental divergences.

050-05-25

7. Article 104(1) EPC | T 0617/20 | Board 3.3.10

Article 104(1) EPC

Case Number	T 0617/20
Board	3.3.10
Date of decision	2025.04.29
Language of the proceedings	EN
Internal distribution code	B
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	Rule 088 EPC
RPBA	
Other legal provisions	Article 16 RPBA 2020
Keywords	apportionment of costs – withdrawal of appeal – request filed after closure of appeal proceedings – admissible (yes) – allowable (no)
Cited decisions	R 0003/22, T 0765/89, T 0674/03, T 1556/14, T 0211/15, T 0695/18, T 1310/19, T 1484/19, T 1087/20, T 0433/21, T 1549/22
Case Law Book	III.R.4.1 , 10th edition

In [T 617/20](#) the board summoned the parties to oral proceedings in person for 10 October 2024. With a letter dated 1 October 2024 the patent proprietor (sole appellant) withdrew its appeal, which was communicated to the respondent opponents on 2 October 2024. The board cancelled the oral proceedings on 4 October 2024 and informed the parties about the termination of the appeal proceedings on 10 October 2024. Opponent 3 submitted a request for apportionment of costs together with the supporting evidence on 12 November 2024, i.e. about one month later.

The patent proprietor argued that according to the relevant case law such a request was only admissible as long as the proceedings were not closed. Only exceptionally may a request be admissible after the termination of the proceedings (T 1556/14). However, in the present case opponent 3 was timely informed and therefore was not prevented from submitting the request before the closure of the proceedings.

The board held that the wording of Art. 16 RPBA, Art. 104(1) or R. 88(1) EPC did not support the proposition that requesting cost apportionment after the closure of the proceedings should be normally excluded as a question of principle, contrary to the

findings of T 1556/14 (seemingly also approved by T 1484/19). At least since R 3/22 it had become clear that proceedings before a board of appeal may well come into existence also after the formal closure of the appeal proceedings. Decision T 695/18 found that the Enlarged Board's decision implied that such ancillary proceedings, though not re-opening the original appeal proceedings in substance, did in fact come into existence through a request submitted after the closure of the appeal proceedings (there a request for correction under R. 139 EPC). The same approach was confirmed in T 433/21.

In the board's opinion, there was no apparent reason why the same findings would not be transferable to the present issue. Thus, a request for apportionment submitted after the closure of the appeal proceedings would open ancillary proceedings, and there was no apparent reason why such ancillary proceedings would not be suitable to resolve also the issue on the merits, i.e. to decide whether a cost apportionment was equitable in the circumstances. Hence, the board concluded that the request was not inadmissible for the sole reason that it had been filed after the closure of the appeal proceedings.

Moreover, the board found that the request for apportionment of costs had been filed within a reasonable time. In this respect the board noted that it seemed sufficient to orient the expected reasonable time limit for filing a request for apportionment along the usual time limits applicable to proceedings before the EPO, namely the standard two months of R. 132(1) EPC. Questions should be asked only if the request is submitted after a reasonable period of time.

According to the board, beyond the general obligation to inform the other parties as soon as possible, a party had no formal obligation to take more active steps merely to avoid such costs which were already foreseen by the other parties. At most, in procedural situations such as the present case, the parties must endeavour to avoid additional costs, typically by informing the other parties as soon as the firm decision to withdraw the appeal has been taken. To recognise such a formal obligation (i.e. to take active steps already before the decision to withdraw has been taken, in order to avoid costs for the other party) seemed to place an unrealistic burden on parties to proceedings before the EPO.

For these reasons, the board concluded that the parties were to bear their own costs (Art. 104(1), first half-sentence, EPC). The request for a different apportionment of costs was not belated but there were no apparent reasons of equity that would justify a different apportionment.

051-05-25

8. Article 112a(2)(c) EPC | R 0012/21 | Board EBA

Article 112a(2)(c) EPC

Case Number	R 0012/21
Board	EBA
Date of decision	2025.01.22
Language of the proceedings	DE
Internal distribution code	B
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a, 112a(2)(c), 113(1) EPC
EPC Rules	Rule 106 EPC
RPBA	Articles 12(2), 13(1) RPBA 2007
Other legal provisions	
Keywords	petition for review – fundamental violation of the right to be heard (yes) – opportunity to comment (no)
Cited decisions	R 0006/20
Case Law Book	V.B.3.4.3 , V.B.4.3.8a , V.B.4.3.19 , 10th edition

In [R 12/21](#) prüfte die Große Beschwerdekammer (GBK), ob die Kammer entsprechend dem seitens der Antragstellerin geltend gemachten sechsten bis achten Verfahrensmangel gegen das Recht auf rechtliches Gehör verstoßen hatte (Art. 112a (2) c) i.V.m. Art. 113 (1) EPÜ). Diese Mängel betrafen die Nichtzulassung des Hilfsantrags. Die Nichtzulassung des Hilfsantrags wurde in der angefochtenen Entscheidung auf zwei Gründe kumulativ gestützt: Fehlen der Voraussetzungen von Art. 12 (2) VOBK 2007 und eine prima facie fehlende Neuheit des Gegenstands von Anspruch 1 des Hilfsantrags.

Die GBK merkte an, dass zur Frage der Zulassung neuen Vorbringens in einem Teil der Rechtsprechung der GBK zu Art. 112a EPÜ verlangt wird, dass der Beteiligte zu dessen Zulassung (lediglich) ausreichend zu hören ist, nach einem anderen Teil der Rechtsprechung ist darüber hinaus die Ausübung des Ermessens im Rahmen der Zulassung nicht nur auf Willkür, sondern auch auf offensichtliche Unrichtigkeit zu überprüfen (R 6/20). Der GBK zufolge stellte sich vorliegend bereits die Frage, ob die Antragstellerin ausreichend gehört worden war, und darüber hinaus ggf., ob die zutreffenden Rechtsgrundlagen für die Ausübung des Ermessens zu Grunde gelegt und das Ermessen damit nicht offensichtlich unrichtig angewandt worden war. Nur bei positiver Beantwortung beider Fragen könne der Überprüfungsantrag unbegründet sein.

Da die GBK die erste Frage negativ beantwortete und der Überprüfungsantrag aus diesem Grund bereits Erfolg hatte, kam es auf die zweite Frage nicht an. In der Entscheidung der GBK wurde daher lediglich die Frage des ausreichenden Gehörs der Antragstellerin im Hinblick auf die Nichtzulassung des Hilfsantrags vor dem Hintergrund der geltend gemachten fehlenden Möglichkeit, zur prima facie-Neuheit Stellung zu nehmen, erörtert. Den Vortrag der Antragstellerin verstand die GBK dahingehend, dass diese sich bei der Erörterung der Zulassung des Hilfsantrags 1 während der mündlichen Verhandlung nicht zum Aspekt, auf den sich die Kammer in der Entscheidungsbegründung stützte, hatte äußern dürfen, nämlich dazu ob der "hinzugefügte Schritt [...] prima facie die Neuheit gegenüber D2 herstellt und damit dem Anspruch zu einer prima facie Gewährbarkeit als Zulassungskriterium unter Art. 13 (1) VOBK 2007 verhilft".

Wenn die Kammer, so die GBK, der Auffassung gewesen wäre, die technische Debatte zum hinzugefügten Merkmal in Anspruch 1 des Hilfsantrags sei bereits im Rahmen des Hauptantrags vollumfänglich geführt worden und eine weitere Debatte im Rahmen des Hilfsantrags überflüssig, hätte die Kammer die Patentinhaberin auf eben diese Auffassung hinweisen und ihr Gelegenheit zur Stellungnahme geben müssen. Dies folge bereits aus dem Wortlaut von Art. 113 (1) EPÜ, wonach Entscheidungen des EPA nur auf Gründe gestützt werden dürfen, zu denen die Beteiligten sich äußern konnten.

Die GBK kam zu dem Schluss, dass in Ermangelung des vorgenannten ausdrücklichen Ansprechens die Antragstellerin erst der schriftlichen Entscheidung entnehmen konnte, dass die Kammer die Nichtzulassung auch auf eine fehlende prima facie-Neuheit des Gegenstands von Anspruch 1 gestützt hatte. Daher sei der Patentinhaberin auch eine diesbezügliche Rüge nach R. 106 EPÜ nicht möglich gewesen. Sie sei damit daran gehindert gewesen, ihrer grundsätzlich bestehenden Pflicht nachzukommen, von sich aus im Verfahren ihre Interessen aktiv wahrzunehmen.

Im Umstand, dass die Kammer die prima facie-Neuheit des Gegenstands von Anspruch 1 des Hilfsantrags bei der Debatte über die Ausübung des Zulassungs-Ermessens im Rahmen von Art. 13 (1) VOBK 2007 nicht ausdrücklich angesprochen hatte und dazu nicht hatte vortragen lassen, sah die GBK einen schwerwiegenden Verstoß gegen das Recht auf rechtliches Gehör der Patentinhaberin (Art. 113 (1) EPÜ). Es könne nämlich nicht von vornherein ausgeschlossen werden, dass die Ermessensentscheidung im Falle eines Ansprechens und damit einhergehend der Gelegenheit zur Stellungnahme zur prima facie-Neuheit des Gegenstands von Anspruch 1 des Hilfsantrags anders ausgefallen gewesen wäre.

052-05-25

9. Article 117 EPC | T 0449/23 | Board 3.3.02

Article 117 EPC

Case Number	T 0449/23
Board	3.3.02
Date of decision	2024.12.12
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 056, 117 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	law of evidence – burden of proof – inventive step – credibility of the alleged technical effect and burden of proof – distinction legal burden of proof and probatory burden of proof
Cited decisions	T 0020/81, T 0859/90, T 0741/91, T 0912/94, T 0355/97, T 0097/00, T 1392/04, T 0692/09, T 1097/09, T 1797/09, T 2179/13
Case Law Book	I.D.4.3.1 , III.G.5.1.2b , III.G.5.2.1 , 10th edition

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

In [T 449/23](#), regarding claim 1 of auxiliary request 1 (claims 1 and 2 being identical to claims 2 and 3 of the main request, after claim 1 of the main request was deleted following a finding of lack of inventive step over D5), the board came to the conclusion that the alleged effects of the distinguishing features were not credible, contrary to the arguments of the patent proprietor. Hence, any alleged effects arising from this comparison could not be taken into account in the formulation of the objective technical problem. The patent proprietor also argued that the burden of proof lay with the opponent to demonstrate that the alleged technical effects were not present. The board disagreed, stating:

(a) that the legal burden of proof was the duty of a party to persuade the deciding body of allegations of facts on which the party's case rested. In principle, a party must prove alleged facts (assertions) from which it infers a legal consequence, i.e. which establish the basis for the party's legal claims. Thus, the allocation of the burden of proof depends on a party's substantive case.

(b) that to discharge its legal duty of persuasion, a party must prove the alleged facts by appropriate evidence to the required standard of proof. The party with whom the legal burden of proof lies therefore bears the risk that the alleged facts remain unproven, and thus that the deciding body will decide against that party and reject its legal claims. Thus, the legal burden of proof requires the production of appropriate evidence to persuade the deciding body to the required standard.

(c) that in principle the legal burden of proof does not shift. References in the case law to a shift of burden of proof relate to the so-called evidentiary/evidential burden of proof (see for this distinction T 741/91), the notion of which relates to the state of the evidence produced in the course of proceedings. Once the party bearing the legal burden of proof has adduced sufficient evidence to support its allegations of facts to the required standard of proof, the onus is on the adverse party to rebut the asserted facts with appropriate evidence. Otherwise, the adverse party risks that the deciding body is persuaded of the existence of the facts and allows the claims. Thus, if the party having the legal burden of proof has made a "strong case" by filing convincing evidence, the onus of producing counter-evidence shifts to the adverse party. However, this does not mean that the legal burden of proof is on the adverse party to prove the non-existence or the contrary of asserted factual allegations. It is sufficient that the adverse party raises substantiated doubts that prevent the deciding body from being persuaded of the existence of the alleged facts.

(d) that in opposition and opposition-appeal proceedings, each of the parties carries the legal burden of proof for the asserted allegations of facts on which their respective substantive case rests. As regards an alleged lack of inventive step, the burden is on the opponent to adduce appropriate prior art which – when following the established substantive test, i.e. the problem-solution approach – persuades the opposition division or the board of the obviousness of the solution provided by the subject-matter claimed. On the other hand, if the patent proprietor asserts that, in comparison to the prior art, there is an advantage or effect giving rise to a more ambitious formulation of the objective technical problem than that presented by the opponent and hence to an inventive step, the burden of proving this advantage or effect to the required standard of proof is on the patent proprietor. The mere assertion in the patent specification of an advantage or effect cannot be regarded as evidence of such an assertion.

The board listed a number of decisions (T 97/00, T 355/97, T 1097/09, T 1392/04), in which the underlying circumstances were comparable, confirming these principles. The board also observed that T 1797/09 submitted by the patent proprietor remained a singular decision not followed. The subject-matter of claim 1 of auxiliary request 1 lacked inventive step.

053-05-25

10. Article 123(2) EPC | T 0298/22 | Board 3.4.03

Article 123(2) EPC

Case Number	T 0298/22
Board	3.4.03
Date of decision	2025.03.20
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter – gold standard – intermediate generalisation – unallowable intermediate generalisation
Cited decisions	T 0714/00
Case Law Book	II.E.1.1 , II.E.1.9.1 , 10th edition

In [T 298/22](#) erläuterte die Kammer, dass für die Beurteilung, ob eine Änderung mit den Erfordernissen des Art. 123 (2) EPÜ in Einklang steht, der durch die ständige Rechtsprechung der Beschwerdekammern etablierte sogenannte "Goldstandard" gilt: Jede Änderung darf unabhängig vom Kontext der vorgenommenen Änderung nur im Rahmen dessen erfolgen, was die Fachperson der Gesamtheit der Unterlagen in ihrer ursprünglich eingereichten Fassung unter Heranziehung des allgemeinen Fachwissens – objektiv und bezogen auf den Anmeldetag – unmittelbar und eindeutig entnehmen kann (vgl. RBK, 10. Aufl. 2022, II.E.1.1).

Bei der Kombination der Merkmale (1.6) und (1.7b), stimmte die Kammer der Beschwerdeführerin dahingehend zu, dass das Merkmal (1.6) nur in Verbindung mit dem Ausführungsbeispiel der Figuren 1 bis 11 und somit nur im Zusammenhang mit Merkmal (1.7a) offenbart sei, aber nicht im Zusammenhang mit dem Ausführungsbeispiel der Figuren 12 bis 16 und somit im Zusammenhang mit Merkmal (1.7b). Die Kammer stellte fest, dass, bei der Prüfung nach Art. 123 (2) EPÜ, ob eine Merkmalskombination ursprünglich offenbart sei, der Goldstandard nicht erfordere, dass die Kombination der Merkmale durch den Fachverstand der Fachperson möglicherweise aus der Beschreibung ableitbar sei oder dass sich die Fachperson die beanspruchte Kombination aus möglichen Ausführungen der Offenbarung ableiten könne, sondern dass die Kombination unmittelbar und eindeutig offenbart gewesen sei. Im vorliegenden Fall lag weder eine unmittelbare noch eine eindeutige Offenbarung vor.

Hinsichtlich der Zwischenverallgemeinerung in Merkmal (1.6), erklärte die Kammer, dass in Beachtung des Goldstandards eine "Zwischenverallgemeinerung" (also eine Verallgemeinerung einer ursprünglich offenbarten besonderen Ausführungsform, wobei der Gegenstand der Verallgemeinerung zwischen dieser besonderen Ausführungsform und der ursprünglichen, allgemein gefassten Definition der Erfindung liegt) nach ständiger Rechtsprechung der Beschwerdekammern nur zu rechtfertigen sei, wenn keinerlei eindeutig erkennbare funktionale oder strukturelle Verbindung zwischen den Merkmalen der spezifischen Kombination besteht oder das herausgegriffene Merkmal nicht untrennbar mit diesen Merkmalen verknüpft ist (vgl. RBK, 10. Aufl. 2022, II.E.1.9.1; T 714/00).

Die Beschwerdegegnerin ging auf die funktionale Verknüpfung des Merkmals (1.6) mit anderen Merkmalen des ersten Ausführungsbeispiels ein. Sie argumentierte, dass die anderen in den Figuren gezeigten und in der zugehörigen Beschreibung beschriebenen Merkmale nicht in funktionalem Zusammenhang mit Merkmal (1.6) stünden. Diesbezüglich war die Kammer der Meinung, dass Figur 1 und das entsprechende Ausführungsbeispiel auf den Seiten 8 und 9 der ursprünglich eingereichten Beschreibung viele nicht-optionale Merkmale offenbart hätten, die alle im Zusammenhang mit dem Merkmal (1.6) stünden, da diese Merkmale in Summe zu dem gemäß Merkmal (1.6) zu erreichenden Resultat führten. Folglich stünden die Merkmale des in Figur 1 gezeigten Ausführungsbeispiels mit Merkmal (1.6) in funktionalem Zusammenhang und könnten von Merkmal (1.6) gemäß den durch die Rechtsprechung gestellten Anforderungen nicht getrennt werden. Somit könne Merkmal (1.6) nicht isoliert in den breiteren Zusammenhang des Gegenstandes des (ursprünglichen) Anspruchs 1 gesetzt werden (unerlaubte Zwischenverallgemeinerung).

Die Kammer kam daher zu dem Schluss, dass Anspruch 1 des Hauptantrags und der Hilfsanträge 1 bis 4 nicht die Erfordernisse des Art. 123 (2) EPÜ erfüllte.

054-05-25

11. Article 13(2) RPBA | T 1544/22 | Board 3.4.03

Article 13(2) RPBA 2020

Case Number	T 1544/22
Board	3.4.03
Date of decision	2025.02.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 116 EPC
EPC Rules	
RPBA	Articles 12(2), 12(3), 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Article 15(1) RPBA communication (no) – refinement of previously submitted arguments – oral proceedings – change of date of oral proceedings
Cited decisions	T 0247/20
Case Law Book	V.A.4.2.2 , III.C.2.1 , III.C.6.1.4 , III.C.6.4.2 , 10th edition

In [T 1544/22](#) the patent proprietor (respondent) submitted a letter, relating inter alia to auxiliary request 2, only two working days before the oral proceedings. They argued that this letter was a direct response to the board's preliminary opinion, which deviated from the impugned decision. According to the patent proprietor, the arguments presented in the letter only elaborated in more detail arguments that had already been presented before. Its aim was to facilitate discussing these arguments during the oral proceedings. Even if the letter had not been filed, its content could have been presented and discussed orally during the oral proceedings. The appellant (opponent 2) took the view that the letter contained a completely new set of arguments, which constituted an amendment to the patent proprietor's appeal case. This amendment would have necessitated contacting a technical expert, which was not possible due to the extremely late submission of the letter.

The board concurred with the patent proprietor that the part of the letter referring to auxiliary request 2 related to arguments considered in the decision under appeal and submitted by the patent proprietor during the written phase of the appeal proceedings (with its reply to the grounds of appeal of opponent 2). In fact, the patent proprietor had already addressed the issues explained in the letter, namely the technical effect of a certain feature and how it was advantageous over the prior art. The late-filed

letter merely elaborated these arguments in more detail, as submitted by the patent proprietor. The board held that such a refinement of previously submitted arguments which further illustrated a party's position had to be allowed, especially when, as in the case at hand, the refinement of arguments concerned points where the board's preliminary opinion differed from the impugned decision. Otherwise, the parties could only repeat their arguments put forward in the statement of grounds of appeal and the reply thereto. The board agreed with T 247/20 that oral proceedings, to which the parties had an absolute right under Art. 116 EPC, would serve no purpose if such refinements were not allowed.

The board concluded that the arguments discussed in the late-filed letter relating to auxiliary request 2 were not new arguments and did not represent a fresh case, contrary to opponent 2's submissions. Instead, they concerned further refinements of arguments already addressed in the impugned decision (Art. 12(2) RPBA) and previously presented during the appeal proceedings (Art. 12(3) RPBA). Thus, they did not constitute an amendment to the appeal case as referred to in Art. 12(4), 13(1) and (2) RPBA. Therefore these (very late) submissions had to be considered in the case at hand.

However, the board also stressed that the preliminary opinion of the board had been communicated to the parties more than four months prior to the oral proceedings. Given that the letter in question had been submitted/received in practical terms only two days before the oral proceedings (i.e. on Monday 3 February 2025), the board agreed with opponent 2 that it had been filed extremely late. In addition, the board was of the opinion that the patent proprietor could and should have presented the arguments contained in the late-filed letter earlier in the proceedings. By submitting late-filed arguments with such a high level of detail at such a short notice – two days before the oral proceedings – the patent proprietor had unfairly put opponent 2 in an unnecessarily unfavourable position.

In view of this particular situation, the board had given opponent 2 the opportunity to request an adjournment of the oral proceedings and indicated that it was favourably disposed towards such a request. After opponent 2 had not requested an adjournment of the oral proceedings but preferred to continue them, the board did not consider it necessary to discuss the original accusation of abuse of procedure submitted by this party.

055-05-25

12. Article 13(2) RPBA | T 0449/23 | Board 3.3.02

Article 13(2) RPBA 2020

Case Number	T 0449/23
Board	3.3.02
Date of decision	2024.12.12
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Article 15(1) RPBA communication (yes) – reference point for determining amendment within the meaning of Article 13 RPBA: earlier submissions in appeal – deletion of independent claims
Cited decisions	J 0014/19, T 1569/17, T 2091/18, T 2295/19, T 0246/22
Case Law Book	V.A.4.2.2 , V.A.4.5.4 , V.A.4.5.5g , 10th edition

[See also Abstract under Article 117 EPC](#)

In [T 449/23](#), the board rejected the patent proprietor's argument that auxiliary requests 2 to 8 were part of the appeal proceedings from the outset within the meaning of Art. 12 RPBA. These requests had not even been mentioned in their statement of grounds of appeal or their reply (to the opponent's statement of grounds of appeal).

Regarding the interpretation of "any amendment to a party's appeal case" in Art. 13(2) RPBA, the board pointed out that the reference point for determining an "amendment" under Art. 13(2) RPBA was not the same as under Art. 12(4) RPBA.

Art. 12(4) RPBA defined an "amendment", by way of reference to Art. 12(2) RPBA, as any matter departing from the framework of the decision under appeal (i.e. the requests, facts, objections, arguments and evidence underlying the contested decision), unless this matter had been admissibly raised and maintained in the proceedings leading to the decision under appeal. The reference point in Art. 13(1) and (2) RPBA, on the other hand, was the party's complete case as determined by Art. 12(1) to (6) RPBA.

Hence, the amendment referred to in Art. 12(4) RPBA was an amendment of the party's case relative to its requests, facts, evidence, arguments and objections on which the decision under appeal was based. This was distinct from "amendments to a party's appeal case" in Art. 13(2) RPBA, carried out at a later stage of the appeal proceedings relative to earlier submissions in appeal. The admissibly raised criterion of Art. 12(4) RPBA was not relevant to the question whether a claim request represented an amendment to a party's appeal case under Art. 13(2) RPBA.

Consequently, the board rejected the argument of the patent proprietor according to which auxiliary requests 2 to 8 were "carry-over" requests and therefore merely the criteria set out in Art. 12(4) RPBA had to be applied to determine whether these requests represented an amendment to the appeal case within the meaning of Art. 13(2) RPBA. The board distinguished the case in hand, where the relevant requests were submitted one day before oral proceedings before the board, from the procedural situation underlying T 246/22, where the relevant requests had been submitted with the statement of grounds of appeal.

Regarding auxiliary request 6, which differed from the claims of the main request (claims as granted) solely by the deletion of independent claims 1 and 2, the board agreed with the reasoning set out in T 2091/18 and J 14/19 and held that any new and amended claim request was to be considered as an amendment to the party's appeal case. In the board's view, the filing of a new claim request always had to have a substantive purpose related to the potential outcome of the patent proprietor's appeal case. The board concluded that if there was such a substantive reason for filing the new set of claims, there was an amendment to the party's case. The board also observed that even when following the line of case law that considered a deletion of (an alternative in) an independent claim to be an amendment in the sense of Art. 13(2) RPBA only if it altered the factual and legal framework of the proceedings, it came to the same conclusion. In fact, even if the remaining subject-matter was encompassed by the claims of previously pending claim requests, the deletion created a new object which shifted the discussion in that the amendment "moved the target" out of the focus of the objections that had been debated on appeal so far.

Since no justification for the late filing of these requests had been submitted by the patent proprietor, nor did the board see any, the board found that there were no exceptional circumstances within the meaning of Art. 13(2) RPBA. Based on a systematic interpretation of Art. 13(1) and (2) RPBA, the board did not agree with the approach taken e.g. in T 2295/19, according to which exceptional circumstances were present if allowing the amendment was not detrimental to procedural economy.

056-05-25

Contact

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