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# Abstracts of decisions

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## 1. Article 083 EPC | T 0137/24 | Board 3.3.08

**Article 083 EPC**

| | |
|---|---|
| **Case Number** | **T 0137/24** |
| **Board** | 3.3.08 |
| **Date of decision** | 2026.01.22 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Article 083 EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | sufficiency of disclosure – non-working embodiments – functionally defined polypeptides – polypeptide variants – at least 90% sequence identity – routine task |
| **Cited decisions** | |
| **Case Law Book** | II.C.5.4a), II.C.6.6.2, II.C.7.6, 11th edition |

*See also abstract under Article 123(2) EPC*.

In T 137/24 the appellant (opponent 2) asserted that the claims of the patent as granted encompassed non-working embodiments because many polypeptide sequences falling under the definition in the claim did not have any enzymatic activity, as evident from Example 5 of the patent in which a number of truncated polypeptides had been tested unsuccessfully. A research project was hence required to test and identify functional polypeptides. Since the patent did not provide any guidance on how the sequences could be changed without losing enzymatic activity, it was an undue burden to find functional polypeptides.

The board observed that, firstly, since the claims required that the genetically modified yeast cells be suitable for producing a cannabinoid or a cannabinoid derivative and the recited polypeptides were also functionally defined by reference to their enzymatic activity, polypeptides without this enzymatic activity did not fall under the scope of the claims.

Secondly, as pointed out in the decision under appeal, generating polypeptide variants as recited in the claims, such as polypeptides comprising an amino acid sequence that has at least 90% sequence identity to SEQ ID NO:110 or SEQ ID NO:100, and testing them for their enzymatic activity, was disclosed in the

patent and only required the use of techniques that were routine for the skilled person working in the technical field of recombinant enzyme variants. No evidence to the contrary was submitted by the appellant. The board thus held that the identification of polypeptide sequences falling under the definitions recited in the claims was not an undue burden for the skilled person.

Therefore, the board concluded that the invention as defined in the claims of the main request was sufficiently disclosed in the patent (Art. 83 EPC).

043-05-26

## 2. Article 087(1) EPC | T 0378/24 | Board 3.3.02

**Article 087(1) EPC**

| | |
|---|---|
| **Case Number** | **T 0378/24** |
| **Board** | 3.3.02 |
| **Date of decision** | 2026.03.12 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Ex parte |
| **EPC Articles** | Articles 054(3), 087(1), 088(2), 088(3), 111 EPC |
| **EPC Rules** | |
| **RPBA** | Article 11 RPBA 2020 |
| **Other legal provisions** | |
| **Keywords** | priority – partial priority (yes) – application of G 1/15 |
| **Cited decisions** | G 0002/98, G 0001/15 |
| **Case Law Book** | II.D.6.3.3, 11th edition |

T 378/24 was an appeal against the examining division's decision to refuse the European patent application on the grounds that the subject-matter of claims 1, 3, 4, 5, 9, 14, 15 and 16 of the main request lacked novelty over document D5, which was prior art pursuant to Art. 54(3) EPC. The patent related to a method and system for pre-purification of a feed gas stream.

The board noted that, in accordance with G 1/15, the decisive issue was whether the subject-matter encompassed by the claims of the main request and corresponding to the novelty-destroying disclosure of D5 was entitled to the claimed priority date. In this regard, the board disagreed with the interpretation of G 1/15 set out in the decision under appeal. The board clarified that, for entitlement to partial priority pursuant to Art. 88(3) EPC, G 1/15 did not require a claim to spell out alternatives comprised within the claim as such, or to comprise the conjunction "or" separating alternatives therein. The referral leading to G 1/15 was prompted by divergent interpretations of Opinion G 2/98, in particular of the passage in point 6.7 of the Reasons according to which: "the use of a generic term or formula in a claim for which multiple priorities are claimed in accordance with Article 88(2) EPC, second sentence, is perfectly acceptable under Articles 87(1) and 88(3) EPC, provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters". Certain decisions issued after G 2/98 construed this latter requirement ("provided that...") restrictively and denied partial priority where such alternatives were not explicitly defined. This approach was expressly rejected in G 1/15.

The board referred to the Order of G 1/15 which explicitly states that no such limitations or conditions apply in this respect. It pointed out that further guidance was provided in point 6.4 of the Reasons: "In assessing whether a subject-matter within a generic "OR" claim may enjoy partial priority, the first step is to determine the subject-matter disclosed in the priority document that is relevant, i.e. relevant in respect of prior art disclosed in the priority interval ... The next step is to examine whether this subject-matter is encompassed by the claim of the application or patent claiming said priority. If the answer is yes, the claim is de facto conceptually divided into two parts, the first corresponding to the invention disclosed directly and unambiguously in the priority document, the second being the remaining part of the subsequent generic "OR"-claim not enjoying this priority but itself giving rise to a right to priority, as laid down in Article 88(3) EPC."

The board stated that, according to G 1/15, it was not necessary for alternatives within a claim to be individually spelt out or syntactically separated by "or"; it suffices that the claim can be conceptually or mentally divided into different subject-matters. Applying the principles set out in G 1/15 to the case in hand, the board found that independent claims 1 and 14 of the main request could be conceptually divided into two sets of alternative subject-matters, namely: (1) a first set corresponding to conceptual alternatives encompassed by the claim which were directly and unambiguously disclosed in the priority document and (2) a second set corresponding to the remaining alternatives encompassed by the claim but not directly and unambiguously disclosed in the priority document. The first set of alternatives was entitled to the claimed priority date, while the second set of alternatives was not.

It followed that partial priority could be acknowledged for the subject-matter of independent claims 1 and 14 insofar as this subject-matter was conceptually encompassed by the claims and directly and unambiguously disclosed in the priority document. Hence, in the present case, for D5 to be relevant state of the art pursuant to Art. 54(3) EPC, the novelty-destroying subject-matter disclosed in D5 had to fall into the second set of alternatives conceptually falling within the scope of independent claims 1 and 14 of the main request as set out above, namely those alternatives not entitled to the priority date. The board analysed the disclosure in D5 and found that claims 1 and 14 of the main request were entitled to the priority date of the present application, such that D5 was not state of the art pursuant to Art. 54(3) EPC for these alternatives. The board concluded that the subject-matter of independent claims 1 and 14, and by extension dependent claims 2 to 13, 15 and 16, were novel over D5.

The decision under appeal was set aside and the case was remitted to the examining division for further prosecution.

044-05-26

## 3. Article 112a(2)(c) EPC | R 0005/24 | EBA

**Article 112a(2)(c) EPC**

| | |
|---|---|
| **Case Number** | **R 0005/24** |
| **Board** | EBA |
| **Date of decision** | 2025.10.28 |
| **Language of the proceedings** | DE |
| **Internal distribution code** | B |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 112a(2)(c), 113(1) EPC |
| **EPC Rules** | |
| **RPBA** | Article 12(4) RPBA 2020 |
| **Other legal provisions** | |
| **Keywords** | petition for review – fundamental violation of Article 113 EPC (yes) – decision under review set aside – re-opening of proceedings |
| **Cited decisions** | |
| **Case Law Book** | V.B.4.3.2, V.B.3.5.3, V.B.4.3.11a), V.B.4.3.21, 11th edition |

Der Überprüfungsantrag in R 5/24 beruhte auf drei Gründen: (i) Die von der Kammer nicht zugelassenen Hilfsanträge 2, 3 und 4 seien bereits in der Verwaltungsinstanz in zulässiger Weise vorgebracht und aufrechterhalten worden und würden daher keine Änderung i.S.v. Art. 12(4), Satz 1 VOBK darstellen. (ii) Selbst wenn die Hilfsanträge nicht in zulässiger Weise vorgebracht worden wären und ihre Zulassung im Ermessen der Kammer gestanden hätte, sei die Grundlage für die Änderungen bereits in der Erwiderung auf die Beschwerdebegründung dargelegt worden. (iii) Selbst wenn die zuvor in der Beschwerdeerwiderung dargelegten Grundlagen als unzureichend zu erachten wären, so enthalte die Eingabe vom 19. Mai 2023 eine umfassende Begründung zur Basis der Änderungen. Die Kammer sei auf diese Darlegung jedoch überhaupt nicht eingegangen, was einen schwerwiegenden Verfahrensfehler darstelle und gegen die Begründungspflicht sowie das Recht auf rechtliches Gehör gemäß Art. 113 (1) EPÜ verstoße.

Die Große Beschwerdekammer merkte an, dass der Überprüfungsantrag darauf gerichtet war, die Nichtzulassung der Hilfsanträge auf ihre inhaltliche Richtigkeit zu überprüfen. Der Großen Beschwerdekammer zufolge sind diese Ermessensentscheidungen zwar im Überprüfungsverfahren überprüfbar, ihre Überprüfung ist jedoch eingeschränkt. Im Verfahren nach Art. 112a EPÜ soll und darf allenfalls geprüft werden, (i) ob der durch die Entscheidung beschwerte Beteiligte zur Frage der Zulassung gehört worden ist, und (ii) ob ein Ermessensfehler vorliegt.

Die Große Beschwerdekammer kam zu dem Ergebnis, dass der Anspruch auf rechtliches Gehör bei der Nichtzulassung der Hilfsanträge 2 bis 4 verletzt worden war. Allein aus diesem Grund war die angefochtene Entscheidung aufzuheben. Ob und inwieweit darüber hinaus dabei auch ein Ermessensfehler vorgelegen hatte, war nicht relevant. Die Schlussfolgerung der Großen Beschwerdekammer, dass der Anspruch auf rechtliches Gehör verletzt wurde, beruht auf den nachstehenden Gründen:

Die Kammer hat die in der Beschwerdeerwiderung der Antragstellerin enthaltenen Angaben nicht als ausreichend angesehen, um die Grundlage der Änderungen in Hilfsantrag 2 zu substantiieren. Die Antragstellerin hatte jedoch mit der Eingabe vom 19. Mai 2023 diese Angaben ergänzt. Das Problem ist, dass die Kammer in der angefochtenen Entscheidung auf die relevanten Angaben in der Eingabe vom 19. Mai 2023 überhaupt nicht eingegangen ist. Der Sachvortrag der Antragstellerin in der Eingabe vom 19. Mai 2023 betrifft jedoch gerade den Punkt, den die Kammer für die Zulassung als entscheidungserheblich erachtet hat.

Die Große Beschwerdekammer konnte der angefochtenen Entscheidung nicht entnehmen, dass, wenn das Vorbringen des betreffenden Schriftsatzes berücksichtigt worden wäre, das Ergebnis des Verfahrens identisch geblieben wäre, weil die Kammer dieses als verspätet nicht zugelassen oder als unbegründet verworfen hätte. Der Großen Beschwerdekammer zufolge mag dies möglich oder gar wahrscheinlich sein. Diese Möglichkeit oder Wahrscheinlichkeit ist jedoch nicht geeignet, die Kausalität auszuschließen. Dies ist nur dann der Fall, wenn aufgrund der Begründung der angefochtenen Entscheidung selbst ein anderes Ergebnis denknotwendig ausgeschlossen bleibt. Eine solche Konstellation ist im vorliegenden Fall nicht gegeben. Im vorliegenden Fall ergibt sich daher aus der Entscheidung nicht, dass es auszuschließen wäre, dass die Kammer bei Berücksichtigung der in der Eingabe vom 19. Mai 2023 enthaltenen Substantiierung den Hilfsantrag 2 zugelassen hätte. Ebenso ist nicht auszuschließen, dass bei Zulassung des Hilfsantrags 2 eine technische Wirkung hätte anerkannt werden können, mit möglichen Auswirkungen auf die Bewertung der erfinderischen Tätigkeit, oder dass der Gegenstand des Hilfsantrags als nicht naheliegende Alternative betrachtet worden wäre. Für die Bejahung eines kausalen Zusammenhangs zwischen einem Verstoß gegen den Anspruch auf rechtliches Gehör und dem Verfahrensergebnis reicht die Feststellung aus, dass das Ergebnis anders hätte ausfallen können, wenn die relevante Eingabe vom 19. Mai 2023 berücksichtigt worden wäre.

Die für Hilfsantrag 2 gezogenen Schlussfolgerungen waren der Großen Beschwerdekammer zufolge auf die Hilfsanträge 3 und 4 übertragbar. Die Große Beschwerdekammer befand, dass die angefochtene Entscheidung aufzuheben und das Verfahren wieder aufzunehmen ist, weil bei der Nichtzulassung der Hilfsanträge 2 bis 4 der Anspruch auf rechtliches Gehör der Antragstellerin gemäß Art. 113 (1) EPÜ verletzt wurde.

045-05-26

## 4. Article 123(2) EPC | T 2488/22 | Board 3.4.03

**Article 123(2) EPC**

| | |
|---|---|
| **Case Number** | **T 2488/22** |
| **Board** | 3.4.03 |
| **Date of decision** | 2026.02.18 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 100(c), 123(2) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | amendments – added subject-matter (yes) – claim interpretation – consultation of the description and drawings – all technically reasonable interpretations – not reading limitations into the claims |
| **Cited decisions** | G 0002/10, G 0001/24, T 1473/19, T 0177/22 |
| **Case Law Book** | II.E.1.3.9, 11th edition |

In T 2488/22 the board recalled that the established criterion for assessing whether amended subject-matter extends beyond the original disclosure is the "gold standard". Regarding claim interpretation in the context of added subject-matter, the board was of the view that, notwithstanding the reference in the second sentence of the Order in G 1/24 to the specific context of assessing patentability of an invention under Art. 52 to 57 EPC, the description and drawings also had to be consulted when interpreting the claims for the purpose of assessing compliance with other requirements of the EPC. The board observed that, first, it did not seem logical to forbid the skilled reader from consulting the description and the drawings when interpreting claims in any context other than the assessment of patentability under Art. 52 to 57 EPC. Second, and more important, the claimed subject-matter had to be interpreted in a uniform and consistent manner. It could not be the case that claims were interpreted differently when assessing patentability under Art. 52 to 57 EPC on the one hand, and when assessing compliance with any of the remaining requirements of the EPC on the other (see e.g. T 177/22 or T 1473/19).

At the same time, the board noted that neither the Order nor the reasoning of G 1/24 contained any indication as to the possible outcome of consulting the description and drawings, or as to any impact such consultation might have on the interpretation of the claims. In particular, there was no basis in G 1/24 for concluding that a claim had

to be interpreted in a more limited manner on the basis of features found in the embodiments of the description. The board explained that it was established case law, both before and after G 1/24, that a claim should not be interpreted on the basis of features of embodiments in the description so as to give it a meaning narrower than the wording of the claims as understood by the skilled person (see CLB, 11th edn. 2025, II.A.6.3.4). In other words, "consulting" the description and the drawings should not result in reading limitations into a claim which were not included in, or could not be derived from, the wording of the claim.

The board pointed out that the skilled person read the claims (and any other parts of the application or the patent) with a mind willing to understand. Consulting the description and the drawings could result, for example, in setting the claimed subject-matter in a particular technical context. Based on this context, the skilled person could reject interpretations of the claims that did not make technical sense. What the proprietor suggested, however, was to limit the interpretation of granted claim 1 to the embodiment described in the description and the drawings, even if the wording of the claims left room for other interpretations. The board disagreed, explaining that the very essence of assessing added subject-matter consisted in determining whether it possibly comprised embodiments that were not derivable from the description, the drawings and the claims of the application as originally filed. The proprietor's argument led to a tautology: if an amended claim was interpreted so that its subject-matter was limited to what could be derived from the application as originally filed, the comparison of this claim to the content of the application as originally filed would inevitably lead to the conclusion that the claimed subject-matter did not extend beyond the content of the application as originally filed. The board observed that, in such a case, both Art. 123(2) and 100(c) EPC would be deprived of any meaning or purpose.

The board concluded that the skilled person, having consulted the description and the drawings, would interpret granted claim 1 based on what could be derived from the wording of the claim, excluding any interpretation that would not make sense in the technical context of the application/patent, but including all other technically reasonable interpretations encompassed by the wording of the claim.

046-05-26

## 5. Article 123(2) EPC | T 0137/24 | Board 3.3.08

**Article 123(2) EPC**

| | |
|---|---|
| **Case Number** | **T 0137/24** |
| **Board** | 3.3.08 |
| **Date of decision** | 2026.01.22 |
| **Language of the proceedings** | EN |
| **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 (no) – selections from lists – convergent lists |
| **Cited decisions** | T 2134/10 |
| **Case Law Book** | II.E.1.6.2b), II.E.1.6.2d), 11th edition |

*See also abstract under Article 83 EPC*.

In T 137/24 the board concluded that claim 1 of the main request did not contain subject-matter that extended beyond the content of the application as filed (Art. 123(2) EPC).

The board explained that claim 1 of the main request was based on claims 2 and 3 of the application as filed. Compared to the disclosure in claims 2 and 3 of the application as filed, claim 1 of the main request contained four additional features. The third of these features ("feature (iii)") was that the GOT polypeptide comprised an amino acid sequence having at least 90% (instead of at least 65%) sequence identity to sequence SEQ ID NO:110 or SEQ ID NO:100.

The appellant (opponent 2) asserted that feature (iii) constituted a selection from a list of independent alternatives. The board disagreed, observing that feature (iii) was disclosed in several paragraphs of the application as filed in a list of increasing amino acid sequence identities to SEQ ID NO:100 or SEQ ID NO:110, starting from at least 65% to at least 99.9% and ending with 100%. Selecting an amino acid sequence identity from such a list that was higher than the amino acid identity recited in the claims of the application did not constitute a selection from a list of independent alternatives.

The board explained that, instead, lists of increasing amino acid sequence identities to a given amino acid sequence – here SEQ ID NO:100 or SEQ ID NO:110 – were

convergent lists of preferred options from the lowest amino acid sequence identity to the given amino acid sequence (least preferred) to the highest amino acid sequence identity (most preferred). In addition to the identity with the most preferred amino acid sequence, the polypeptide recited in the claim was functionally defined in the claim by its enzymatic activity (a GOT polypeptide). This meant that the increase of the amino acid sequence identity to SEQ ID NO:100 or SEQ ID NO:110 from 65% to 90%, as recited in the claim, merely narrowed down the GOT polypeptides falling within the definition in the claim, without singling out specific polypeptides or conferring any new properties to these polypeptides.

The board pointed out that, in line with the considerations set out in T 2134/10, the selection of a degree of sequence identity with a given (most preferred) amino acid sequence from a convergent list for a functionally defined polypeptide did not single out a particular molecule or confer properties to this molecule that were not disclosed in the application as filed. Feature (iii) therefore had a basis in the application as filed.

047-05-26

## 6. Article 123(2) EPC | T 0241/25 | Board 3.2.02

**Article 123(2) EPC**

| | |
|---|---|
| **Case Number** | **T 0241/25** |
| **Board** | 3.2.02 |
| **Date of decision** | 2026.03.03 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 76(1), 100(c), 123(2) EPC |
| **EPC Rules** | |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | amendments – added subject-matter – intermediate generalisations – claim interpretation |
| **Cited decisions** | T 0367/20, T 1762/21, T 1888/22, T 0824/23, T 0873/23 |
| **Case Law Book** | II.E.1.9.1, II.E.1.3.9, 11th edition |

In T 241/25 the patent related to an apparatus for indicating flex of a distal end of a catheter, for example, for implanting a prosthetic aortic valve in a human heart.

The board agreed with the opposition division's conclusion that the feature of the flex activating member comprising an externally threaded portion in claim 1 of the main request extended beyond the content of the earliest application as filed. Considering the disclosure in the earliest application as filed, the board explained that, for the skilled person, it was the externally threaded surface portion of the rotatable member including the internally threaded surface portion, and not any externally threaded surface of the flex activating member, that had to cooperate with the flex indicating member in order to indicate flex. In other words, the earliest application as filed inextricably linked the externally threaded portion of the rotatable member with other claimed features. Not claiming this portion of the rotatable member amounted to a non-allowable intermediate generalisation.

The opponent also argued that claiming a pull wire in claim 1 of the main request was an unallowable intermediate generalisation because an adjustment knob and a resilient steerable section of the claimed elongated shaft had been impermissibly omitted. The board observed that merely referring to an embodiment of the original disclosure and stating that an unallowable intermediate generalisation of this embodiment had been added was not a substantiated objection. An objection to an intermediate generalisation in a claim required (i) identifying the features which were

impermissibly omitted from the claim and (ii) explaining why the omission introduced added subject-matter. According to established case law this explanation needed to show that the omitted features were inextricably linked with (some of) the claimed ones according to the original disclosure. Only in this way was it possible to (i) identify the objection and (ii) understand the reasoning supporting the objection (see CLB, 11th edn., 2025, II.E.1.9.1; as well as, for instance T 1762/21, T 824/23 and T 1888/22). The board did not find the objection convincing and it concluded that the definition of a pull wire in claim 1 of the main request did not amount to an unallowable intermediate generalisation. The board explained that the omitted features were not inextricably linked to the feature that the wire is a pull wire. Whether an adjustment knob and a resilient steerable section together with the pull wire might provide further advantages to effectively steer and then extract the catheter, as the opponent argued, was of no relevance.

In addition, the opponent argued that the omission in claim 1 of the main request that the movement of the flex indicating member relative to the handle portion was to indicate an amount of flex of the distal end portion of the elongated shaft was an impermissible intermediate generalisation. The board disagreed, observing that claim 1 of the main request recited that the flex activating member caused the flex indicating member to move relative to the handle. In the claim, the fact that this movement indicated flex was implied by the definition of the flex indicating member as part of an apparatus for indicating flex. No other movement of the flex indicating member was defined. Hence, the board concluded that no intermediate generalisation was present.

The opponent raised a further objection of added subject-matter against claim 3 of the main request. The board explained that claim 3 of the main request specified that "the flex activating member (154) and the flex indicating member (156) are separate members". It was common ground that the earliest application as filed did not provide a literal basis for this feature. The board observed that to assess whether the claim comprised added subject-matter, the feature had first to be interpreted in view of the patent as a whole (T 367/20, T 873/23). In view of what was already defined in claim 1, the board understood that the term "separate" in claim 3 had to mean something different from simply distinct. The technically meaningful interpretation was that, according to claim 3, the two members in question were held at a distance from one another, for example, by means of an intermediate element. With this construction, claim 3 found no basis in the earliest application as filed.

In conclusion, the feature of the flex activating member comprising an externally threaded portion in claim 1 and the feature of the flex activating member and the flex indicating member being separate members in claim 3 of the main request extended beyond the content of the earliest application as filed. Hence, the ground for opposition in Art. 100(c) EPC prejudiced the maintenance of the patent on the basis of the main request.

048-05-26

## 7. Rule 043(1) EPC | T 1471/24 | Board 3.2.04

**Rule 043(1) EPC**

| | |
|---|---|
| **Case Number** | **T 1471/24** |
| **Board** | 3.2.04 |
| **Date of decision** | 2026.04.13 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Ex parte |
| **EPC Articles** | |
| **EPC Rules** | Rule 043(1) EPC |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | claims – missing two-part form |
| **Cited decisions** | G 0001/24, T 0723/93, T 0181/95 |
| **Case Law Book** | II.A.2.1.1, 11th edition |

In T 1471/24 the appeal lay from the decision of the examining division refusing the European patent application. The examining division had found that D1 represented the closest prior art to the claimed invention and that the subject-matter of claim 1 was both novel and involved an inventive step over the cited art. Nonetheless, the requirements of R. 43(1) EPC were not fulfilled since claim 1 was not drafted in the two-part form, despite this being appropriate.

The board concurred with the examining division. It recalled that the purpose of the two-part form of claim is to allow the skilled person to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. The board noted that it is established practice before examining divisions not to insist on the two-part form if it is sufficiently clear from the indication of prior art made in the description which features of the claim under examination are known therefrom (see Guidelines F-IV, 2.3.2). However, this proviso regarding the features known from the prior art had not been satisfied in the present application. D1 was indeed acknowledged on page 1 of the description, but this acknowledgement failed to identify which specific features of claim 1 were known from D1. Fundamentally, therefore, in view of the two-part form not having been used in the independent claim, the requirement for the content of the description to include an indication of which features of claim 1 were known from the prior art was not fulfilled.

The board further clarified that the present case was different from T 181/95 and T 723/93, to which the appellant had referred. In the present case, claim 1 could reasonably be formulated in the two-part form with features known from D1 placed in

the preamble, features not known therefrom being placed in the characterising portion; such formulation was indeed expedient.

The appellant had further argued that the text proposed by the examining division to draft claim 1 in the two-part form was incorrect insofar as D1 disclosed a set of various flat mirrors rather than, as proposed by the examining division for inclusion in the preamble of claim 1, merely a set of various mirrors. The board noted that this argument was based on a misunderstanding. The preamble of a claim drafted in the two-part form should include those features of the claim known in combination from the prior art (R. 43(1)(a) EPC). In the present case, a set of various mirrors was indeed known from D1, albeit in D1 the various mirrors of this set were flat. That the mirrors of D1 were flat was however irrelevant; D1 without doubt disclosed a set of various mirrors, such that this feature could be included in the preamble of a two-part form. According to the board, the examining division's proposal as to how claim 1 could be drafted in the two-part form seemed wholly reasonable and in line with section F-IV, 2.3 of the Guidelines.

Likewise, the board disagreed with the appellant's contention that drafting the claim in the two-part form made it unclear and lacking in conciseness. None of the appellant's further arguments convinced the board that the examining division was wrong to insist on claim 1 being drafted in the two-part form. Hence, the board concluded that the appellant's sole request was not allowable and dismissed the appeal.

049-05-26

## 8. Rule 116 EPC | T 1731/23 | Board 3.5.01

**Rule 116 EPC**

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|---|---|
| **Case Number** | **T 1731/23** |
| **Board** | 3.5.01 |
| **Date of decision** | 2026.01.16 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | |
| **EPC Rules** | Rule 116 EPC |
| **RPBA 2020** | Article 12(6) RPBA 2020 |
| **Other legal provisions** | |
| **Keywords** | late-filed claim requests – filed before date set under Rule 116 – discretion of opposition division (not) to admit (yes) – oral proceedings (adjournment) |
| **Cited decisions** | |
| **Case Law Book** | IV.C.5.1.6, 11th edition |

In T 1731/23 the board expressed the view that there is no established principle that submissions filed before the date set under R. 116 EPC are generally admissible, just as there is no principle saying that a submission filed after that date is automatically inadmissible. According to the board, it is rather established case law that the opposition division has a discretion (not) to admit amendments filed after the period specified in the communication under R. 79(1) EPC.

In the case in hand, a first oral proceedings took place before the opposition division on 17 May 2023 ("the first leg of the oral proceedings"), during which the proprietor filed auxiliary request 1bis. As there was not enough time left to discuss the newly filed request, it was agreed that the oral proceedings be adjourned until 15 June 2023 ("the second leg of the oral proceedings"). A new summons was issued to that effect on 24 May 2023, indicating the final date for filing new submissions as 17 March 2023 – the same date as set in the first summons to oral proceedings on 17 May 2023.

On 14 June 2023, i.e. the day before the second leg of the oral proceedings, the proprietor filed a new auxiliary request 1. It differed from auxiliary request 1bis of 17 March 2023 by replacing the "grid code feature" with a feature taken from the description – "the individual WTC feature".

The opposition division considered that the new auxiliary request 1 was late, as it was filed after the final date for making submissions. Moreover, it was not considered to be a reaction to the course of the proceedings, and it involved a feature taken from the description.

In the grounds of appeal, the proprietor argued that the opposition division had not exercised its discretion correctly. According to the proprietor, it was established EPO case law that requests filed before the expiry of a R. 116 EPC time limit were generally admissible, and that this principle also applied for auxiliary requests with features taken from the description. Further, the proprietor argued that the opposition division had not set a valid final date for making written submissions in accordance with R. 116(1) EPC in respect of the (adjourned) second oral proceedings. The proprietor argued that, for these reasons, the board should admit auxiliary request 1 into the appeal proceedings.

The board did not concur, finding that, in exercising its discretion, the opposition division had considered, apart from the date of filing one day before the oral proceedings (which must be considered late by any standards), the nature of the amendments including their complexity and whether they were a reaction to the course of the proceedings. The board remarked that a feature taken from the description was naturally more complex to deal with as it might require an additional search. It noted that, indeed, the decision described that the opponent had objected that their search had not included the "individual WTC feature". Furthermore, the board noted that the amendments did not represent a convergent development, as the "individual WTC feature" replaced the previous "grid code feature" rather than building onto it. Thus, the opposition division had considered that it was not justified to admit this amendment at such a late stage of the proceedings. The board saw nothing wrong with this. In the board's view, the opposition division had exercised their discretion in a reasonable way.

Concerning the alleged failure to set a final date for making submissions under R. 116 EPC, the board pointed out that it was clear that the oral proceedings on 15 June 2023 were a continuation of the oral proceedings on 17 May 2023 and not a separate hearing to discuss new issues. The board highlighted that the adjournment of oral proceedings requires a new summons. This does not mean, however, that a new date for making submissions needs to be set (see also Guidelines E-III, 8.11.2 – March 2024 version).

The board did not see any errors in the opposition division's use of discretion or any other reasons justifying the admittance of auxiliary request 1 in the appeal proceedings. Consequently, it decided not to admit it under Art. 12(6) RPBA.

050-05-26

## 9. Rule 117 EPC | T 1283/22 | Board 3.4.03

**Rule 117 EPC**

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|---|---|
| **Case Number** | **T 1283/22** |
| **Board** | 3.4.03 |
| **Date of decision** | 2025.10.16 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 116, 117 EPC |
| **EPC Rules** | Rule 117 EPC |
| **RPBA** | |
| **Other legal provisions** | |
| **Keywords** | law of evidence – hearing of witnesses by videoconference |
| **Cited decisions** | G 0001/21, G 0002/21 |
| **Case Law Book** | III.G.2.4.1, 11th edition |

In T 1283/22 the board held that while the amending of R. 117 EPC to allow for hearing witnesses by videoconference may have been occasioned by a particular situation (in this case the pandemic), the wording of R. 117 EPC does not limit its application to a pandemic or similar exceptional situation. It thus applies irrespective of whether the situation which led to it being amended persists.

On the applicability of G 1/21, the board stated the following: The board is not aware of any statement by the Enlarged Board in G 1/21 that would be even indirectly – let alone directly – applicable to hearing a witness. G 1/21 examines parties' procedural rights, such as the right to be heard, and examines the definition of oral proceedings for the purposes of Art. 116 EPC. Its statement concerning the "gold standard" has to be taken in that context. The procedural situation of a witness is not comparable with that of the parties. As the witness is presumed to be unaffected by the outcome of the proceedings, their position in the proceedings is neutral. The purpose of hearing the witness is to obtain from them any relevant technical information, including any further information about them that may support (or undermine) the veracity of their statements.

As the board understood it, the appellant argued that any witness statements made during a videoconference that may leave room for doubt were inherently unsuitable as evidence, given that their veracity could not be judged in the same way as at an in-person hearing. This argument essentially boiled down to the frequently raised yet fundamentally flawed reasoning that some evidence submitted by a party was not

sufficiently convincing for the purposes of "up-to-the-hilt" proof, since better evidence was conceivable.

The proposition that a witness statement was inherently unsuitable as evidence unless the witness was heard in person was also plainly inconsistent with the principle of free evaluation of evidence. As the Enlarged Board set out in G 2/21, points 27 to 34 of the Reasons, this principle applies in proceedings before the EPO and implies that there are no formal rules excluding any admissibly raised evidence. In the case in hand, this would mean excluding the offered witness statement because the witness was heard by videoconference. This argument by the appellant would effectively imply the formal rule – without any basis in the EPC – that a witness statement could only serve as evidence if the witness is heard at an in-person hearing.

The board did not question that, in principle, witness statements must not be influenced in any way that may distort the truth, i.e. the facts sought to be proven with the witness. However, this was nothing more than an ideal that was practically impossible to achieve, regardless of whether the witness was heard by videoconference or in person. Thus, any expectation that the witness would take part in the proceedings with absolutely no idea about the subject of the proceedings and the relevant technical issues was wholly unrealistic, irrespective of how the witness was heard, i.e. by videoconference or in person. In summary, the board saw no reason why hearing witnesses by videoconference would be unsuitable or incompatible with the Convention. In view of the above, the board was of the opinion that, contrary to the appellant's submissions, there were no serious reasons that would have required the opposition division to grant the appellant's late-filed request to hold the oral proceedings and hear the witness in person on the premises of the EPO.

The opposition division's discretionary decision (see decision G 1/21, point 50 of the Reasons) to refuse the request for the oral proceedings by videoconference to be adjourned and for the oral proceedings to be held and the witness to be heard on the premises of the EPO was not at odds with decision G 1/21. The question of whether the principles laid out in G 1/21 also applied to a department of first instance could be left open. The above conclusions were reached on the assumption that G 1/21 was binding for the departments of first instance but would apply a fortiori if this were considered not to be the case. Thus, the opposition division's conduct of the proceedings was correct, irrespective of whether the principles laid out in G 1/21 also applied to an EPO department of first instance. The board considered that decision G 1/21 and the settled case law of the boards of appeal gave sufficient guidance for the case in hand, so the appellant's request for a referral to the Enlarged Board was refused.

051-05-26

## 10. Article 13(2) RPBA | T 0717/23 | Board 3.4.01

**Article 13(2) RPBA 2020**

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|---|---|
| **Case Number** | **T 0717/23** |
| **Board** | 3.4.01 |
| **Date of decision** | 2026.02.24 |
| **Language of the proceedings** | EN |
| **Internal distribution code** | D |
| **Inter partes/ex parte** | Inter partes |
| **EPC Articles** | Articles 064, 067, 068, 097(2), 100, 125 EPC |
| **EPC Rules** | |
| **RPBA** | Article 13(2) RPBA 2020 |
| **Other legal provisions** | |
| **Keywords** | amendment after notification of Art. 15(1) RPBA communication (yes) – late-filed objection of double patenting – exceptional circumstances (no) – admitted (no) |
| **Cited decisions** | G 0004/19, T 2907/19, T 0458/22 |
| **Case Law Book** | V.A.4.2.3a), II.G.3.1, II.G.4, 11th edition |

In T 717/23, during the oral proceedings before the board, the opponent raised, for the first time in the appeal proceedings, an objection of double patenting. It argued that the scope of claim 1 of auxiliary request 6 was identical, at least in part, to that of the patent that resulted from the parent application (the "parent patent"). In line with the prohibition of double patenting, the proprietor should not be allowed to request a patent based on the same subject-matter as that of the parent patent, even if, as in this case, the parent patent had later been revoked.

The board noted that the examining division had initially considered the subject-matter of claim 1, which was identical with claim 14 of the patent, to be different from claim 1 of the parent patent, and, for that reason, in compliance with the prohibition of double patenting. The examining division had found the difference to be due to the rotary joint, in present claim 1, not being contactless. However, since the board interpreted the rotary joint as a contactless rotary joint, there was in fact no difference from the claims of the parent patent. The opponent argued that, in such a situation, it had to be possible to address the prohibition of double patenting in appeal proceedings. The opponent added that the issue of double patenting was a formal one that had to be assessed at any time during the appeal proceedings. This constituted exceptional circumstances within the meaning of Art. 13(2) RPBA.

The board did not admit the objection of double patenting into the appeal proceedings under Art. 13(2) RPBA. Raising such an objection for the first time during the oral proceedings before the board constituted an amendment of the opponent's appeal case within the meaning of Art. 13(2) RPBA. Contrary to the opponent's submission, this objection was not to be treated differently from any other new objection raised for the first time at such a late stage. In this context, the board noted that, for example, an objection as to the admissibility of the appeal also qualified as an amendment within the meaning of Art. 13(2) RPBA (see T 458/22).

The board further observed that, if anything, it was questionable whether an objection of double patenting could be examined in opposition or opposition appeal proceedings at all. In G 4/19, the Enlarged Board did not address opposition proceedings and based the applicability of the prohibition of double patenting in examination proceedings on Art. 97(2) and 125 EPC, referring to the preparatory documents to the EPC and the legislator's intention. Since Art. 97(2) EPC was not applicable in opposition proceedings, and Art. 100 EPC provided an exhaustive enumeration of grounds for opposition which did not include double patenting, it seemed to the board that the Enlarged Board's reasoning could not simply be extended to opposition proceedings. The board noted that in the present case, however, this question could be left open.

In particular, apart from arguing that an objection of double patenting could per se not be late-filed, which was incorrect, the opponent did not provide any reasons as to why there were exceptional circumstances justifying the admittance of the objection of double patenting at such a late stage of the appeal proceedings. Considering that claim 1 was identical to claim 14 of the patent, the objection should, if at all possible, have already been raised earlier during the appeal proceedings.

Furthermore, the objection was, prima facie, not persuasive. Firstly, the issue of double patenting did not even arise in the present case, because the patent resulting from the parent application had been revoked. Under Art. 68 EPC, the effect of that revocation was that the revoked patent was deemed not to have had, from the outset, the effects specified in Art. 64 and 67 EPC. Secondly, the subject-matter which, according to the opponent, was allegedly subject to the prohibition of double patenting, only concerned at the very most claims with an overlapping scope rather than double patenting in the narrower sense (as to this distinction, see G 4/19, point 2 of the Reasons; see also T 2907/19).

052-05-26

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