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# Abstracts of decisions

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## Abstracts of decisions

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## 1. Article 054 EPC | T 2192/22 | Board 3.3.04

### Article 054 EPC

|                                    |                                                       |
|------------------------------------|-------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 2192/22</b>                                      |
| <b>Board</b>                       | 3.3.04                                                |
| <b>Date of decision</b>            | 2024.11.28                                            |
| <b>Language of the proceedings</b> | EN                                                    |
| <b>Internal distribution code</b>  | D                                                     |
| <b>Inter partes/ex parte</b>       | Inter partes                                          |
| <b>EPC Articles</b>                | Article 054 EPC                                       |
| <b>EPC Rules</b>                   |                                                       |
| <b>RPBA</b>                        |                                                       |
| <b>Other legal provisions</b>      |                                                       |
| <b>Keywords</b>                    | novelty – second non-medical use – use claims         |
| <b>Cited decisions</b>             | G 0002/88, G 0006/88, T 0892/94, T 1179/07, T 1913/21 |
| <b>Case Law Book</b>               | <a href="#">I.C.8.1.3</a> , 11th edition              |

In [T 2192/22](#) the claims related to improved processes for purifying polypeptides of interest, by increasing the amount of a polypeptide of interest bound to a cation-exchange matrix relative to the amount of one or more impurities bound to the ion-exchange matrix.

The patent proprietor was of the view that the claim was such that its subject-matter should be recognised as novel under G 2/88 since it related to the use of a known compound for a new purpose not made available in the prior art – i.e. "the reduction of host cell proteins (HCPs) in the purification of a polypeptide of interest by cation-exchange chromatography".

The board however, concurred with the findings in T 892/94, that applying the concept of novelty developed in G 2/88 to claims for processes of producing a product, even when drafted as use for achieving a technical effect that results in an improved product could potentially result in a permanent monopoly of the use of a known substance for a known purpose. Such a permanent monopoly would arise from the repeated drafting of claims for a process of production including a new, possibly only subtly different, technical effect associated with this known process (T 1179/07).

In the present case, drafting the claim as a "use" of a chemical compound could not mask the fact that the claim defined a production/purification process and the new technical effect could only take place in the context of this process. The mere

formatting of the claim to give the appearance that its subject-matter falls under the principles established by G 2/88 could not circumvent the fact that on analysis, the claim was directed to a use or process for the production of a product, here one having the "improved" property of having "reduction of host cell proteins".

Moreover, the alleged new technical effect of reduction of host cell proteins pertained to the product (the polypeptide) and could not be considered a technical limiting feature of the "use" according to G 2/88. Indeed, where an invention relates to a new technical effect of a physical entity that can only occur as part of a process for the production or manufacture of a product, such that this effect is inextricably linked to and cannot occur in isolation from the production process, a claim directed to that "use" of the physical entity to achieve that effect must be regarded as directed to the production process per se (T 1913/21).

The assessment of novelty in the present case was therefore done by answering the question of whether or not there was a disclosure forming part of the state of the art of a process having the same physical steps as the claimed process, i.e. purifying a polypeptide of interest by CEX chromatography, wherein at least one of the equilibration, loading and/or washing fluids contained a chemical structure with amino groups and/or cationic amino acid polymers, in a concentration of at least 7 mM. No other features were explicitly or implicitly implied by the wording of the claim. The board found that the prior art anticipated the claimed subject-matter and denied novelty.

078-08-25

## 2. Article 056 EPC | T 0646/22 | Board 3.4.03

### Article 056 EPC

|                                    |                                                                       |
|------------------------------------|-----------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0646/22</b>                                                      |
| <b>Board</b>                       | 3.4.03                                                                |
| <b>Date of decision</b>            | 2025.01.21                                                            |
| <b>Language of the proceedings</b> | EN                                                                    |
| <b>Internal distribution code</b>  | D                                                                     |
| <b>Inter partes/ex parte</b>       | Inter partes                                                          |
| <b>EPC Articles</b>                | Article 056 EPC                                                       |
| <b>EPC Rules</b>                   |                                                                       |
| <b>RPBA</b>                        |                                                                       |
| <b>Other legal provisions</b>      |                                                                       |
| <b>Keywords</b>                    | inventive step – objective technical problem<br>formulation prior art |
| <b>Cited decisions</b>             |                                                                       |
| <b>Case Law Book</b>               | <a href="#">I.D.4.1.1</a> , 11th edition                              |

In [T 646/22](#), the invention concerned input/output circuits and devices having physically corresponding status indicators. It followed from the conclusions on novelty that claim 1 as granted differed from D7 in that the two status indicators were capable of displaying different statuses and that the second status indicator comprised a transparent or translucent portion which surrounded the terminal opening (feature [1.9]).

The parties did not agree whether or not these features provided together a synergistic technical effect over D7. The opponent was of the opinion that the features distinguishing claim 1 from D7 were to be assessed separately as no synergistic technical effect was apparent. It would have been obvious to the skilled person to provide an additional status indicator in D7 to display a second status, if they so desired.

The board did not follow the opponent's argument, mainly because it did not accept the formulated technical problem. The formulation of the technical problem took for a given that the skilled person wished to display a second terminal status of the terminal in D7 and that the only problem was how to do that. However, D7 did not envisage the display of any second status different from the status it already displayed. Hence, it could not be accepted that the only problem the skilled person would be faced with was how to display such a second status. In the board's opinion, in order to arrive at the claimed invention the skilled person when starting from D7 would first have to find a motivation for displaying a second status of the terminal,

then to find a way to modify the described light sources such that they were capable of displaying different statuses and would only then have to start contemplating here to place an additional status indicator. The board considered that such activities went beyond what could be considered obvious for the skilled person in the present context.

Regarding feature [1.9], the opponent pointed to the description of D7, and argued that it would thus have been obvious for the skilled person to increase the size of given indicators if they wanted to improve visibility from all sides even further. The board did not follow the opponent in this respect, either. The formulated technical problem of improving the visibility of the status indicator was not related to the claimed invention.

The board stated that in the so-called "problem-solution-approach", the formulated objective technical problem should be one that corresponds to the technical effect obtained by the features distinguishing the claimed invention from the prior art. In other words, these distinguishing features should provide a technical advantage to the claimed invention that the prior art has not. In the present case, the terminal block of the claimed invention had no curved surface and there was no technical advantage related to the visibility of the status indicators from all sides. The problem of improving the visibility of the status indicators concerned only D7 and the I/O block it described, but was not a problem to be solved which related to any technical effect the distinguishing features provided to the claimed invention with respect to the prior art. The board, hence, found the opponent's argument not convincing.

The board proposed the following Catchword: The objective technical problem formulated in the context of the problem-solution approach should stem from a technical effect the distinguishing features provide to the claimed invention with respect to the closest prior art and not from a possible improvement of the prior art itself.

079-08-25

### 3. Article 056 EPC | T 1632/22 | Board 3.5.06

#### Article 056 EPC

|                                    |                                                                                                                         |
|------------------------------------|-------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1632/22</b>                                                                                                        |
| <b>Board</b>                       | 3.5.06                                                                                                                  |
| <b>Date of decision</b>            | 2024.12.10                                                                                                              |
| <b>Language of the proceedings</b> | EN                                                                                                                      |
| <b>Internal distribution code</b>  | D                                                                                                                       |
| <b>Inter partes/ex parte</b>       | Ex parte                                                                                                                |
| <b>EPC Articles</b>                | Article 056 EPC                                                                                                         |
| <b>EPC Rules</b>                   |                                                                                                                         |
| <b>RPBA</b>                        | Article 11 RPBA 2020                                                                                                    |
| <b>Other legal provisions</b>      |                                                                                                                         |
| <b>Keywords</b>                    | inventive step – closest prior art – skilled person – related technical area – any piece of prior art can be considered |
| <b>Cited decisions</b>             | T 1742/12, T 1294/16, T 0261/19, T 1737/21, T 0646/22, T 0454/23<br>BGH X ZR 60/19, UPC_CFI_501/2023                    |
| <b>Case Law Book</b>               | <a href="#">I.D.3.3</a> , <a href="#">I.D.4.1.1</a> , <a href="#">I.D.8.2</a> , 11th edition                            |

In ex parte case [T 1632/22](#), the application related to liveness detection in relation to authentication, e.g. when unlocking a phone based on a face image. The application proposed to categorise the images as a function of their "quality" and to use different liveness detectors for each quality type. The examining division concluded there was a lack of inventive step over D1 (face authentication).

With an amendment in substance to define the quality parameter used to define the quality type, the new feature of claim 1 was not disclosed in D1. The board saw only two differences between claim 1 and D1 which might support the presence of an inventive step, namely that the claimed method was used for liveness detection and that it considered also quality parameters other than those disclosed for the "specialized classifiers" of D1. For the appellant, D1 did not qualify as the closest prior art as it was concerned with authentication rather than with liveness detection.

In the board's view, the novelty requirement provides that no patent can be granted for anything that is already known. The inventive step requirement raises the bar to a patent by also excluding matter which is obvious over what is known. That which is obvious to the skilled person cannot depend on anything that the skilled person does not know yet. In particular, what is obvious at the filing date of a patent application cannot depend on the content of that patent application. Conversely, an argument

that a skilled person having regard to some piece of prior art will find something to be obvious cannot be rebutted on the basis of what the application says. In particular, the application cannot be invoked to limit the prior art under consideration or the expertise of the skilled person (their "art") on the basis of the stated "field of the invention". That essentially any piece of prior art can be considered in an inventive step analysis has been stated several times in the case law. The definite articles in the phrase "the person skilled in the art" in Art. 56 EPC are not meant to limit the relevant "arts". Any successful rebuttal of an inventive step objection must address the obviousness argument directly, without reference to the application.

It is a matter of efficiency when assessing inventive step to consider only persons skilled in arts related to the claimed invention, and, consequently, only prior art which such a person may have regard to. The board considered that a person skilled in some art may well have regard to prior art from a field which is not, in a narrow sense, their "own field". It is reasonable to assume, for instance, that persons skilled in one field will typically keep themselves informed about developments in related fields, and in this sense have regard to prior art in related fields. The board disagreed with T 646/22 and held that in principle, all problems which the skilled person would have addressed (or been asked to address) based on the prior art alone are valid ones. In the present case, the board assumed a person skilled in liveness detection methods. Such a person was, generally, interested in improving, or finding alternatives to, known liveness detection methods, based on the knowledge that known methods have known pitfalls. Liveness detection for authentication and authentication were closely related technical areas. The board noted that it was typical to try adapting developments in neighbouring fields to the own area of interest. It was certainly common practice in image processing, in particular when the images were of the same type. Thus, in the board's judgement, the person skilled in the art in liveness detection would have regard to D1 and would have reason to adapt its solution to liveness detection in a way leading to the invention according to claim 1 of the main request before the examining division. The current requests differed from that request ("quality parameter").

Finally, the board noted that during examination a relatively large number of documents were cited, some of them concerned with liveness detection, but were not discussed in the decision. A positive decision on inventive step could not be issued before at least these documents have been discussed (Remittal).

080-08-25

## 4. Article 056 EPC | T 1650/23 | Board 3.5.07

### Article 056 EPC

|                                    |                                                                     |
|------------------------------------|---------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1650/23</b>                                                    |
| <b>Board</b>                       | 3.5.07                                                              |
| <b>Date of decision</b>            | 2025.04.15                                                          |
| <b>Language of the proceedings</b> | EN                                                                  |
| <b>Internal distribution code</b>  | D                                                                   |
| <b>Inter partes/ex parte</b>       | Ex parte                                                            |
| <b>EPC Articles</b>                | Article 056 EPC                                                     |
| <b>EPC Rules</b>                   |                                                                     |
| <b>RPBA</b>                        |                                                                     |
| <b>Other legal provisions</b>      |                                                                     |
| <b>Keywords</b>                    | inventive step – graphical user interfaces – display of information |
| <b>Cited decisions</b>             | T 0641/00                                                           |
| <b>Case Law Book</b>               | <a href="#">I.D.9.2.11</a> , 11th edition                           |

In [T 1650/23](#), the invention concerned controlling the display of content items provided by a website or an application. In the system according to the invention, the content of a content item to be displayed is reduced to an amount that enables a user "to understand the target content item within the display duration".

According to the board, the distinguishing features related in part to the way information was displayed (i.e. presented) to the user. Presentation of information is as such not patentable under Art. 52(2) and (3) EPC. According to the case law of the Boards of Appeal, presentation of information as such, as non-technical subject-matter, cannot contribute to inventive step. Where a claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met (T 641/00).

The appellant had argued that the distinguishing features related to technical concepts directed at determining in advance how and which information to provide in accordance with the display duration. Hence, these features were directed at the internal processing of the claimed information processing system and not at the mere presentation of information. The distinguishing features achieved the technical effect of reducing processing loads, quickly changing the content amount of the target content item, and causing the target content item to be displayed, as was recited in the description. By storing in advance multiple content variants corresponding to possible display durations, the processing was improved.

The appellant had further argued that all the distinguishing features contributed to these technical effects, since they were involved in the steps leading to the improved processing. They could thus not be considered to be mere "constraints" included in the objective technical problem. The objective technical problem had to be formulated as how to improve the processing of displaying a target content item, possibly with the addition of "such that it enables the visitor to understand display content thereof" to take into account the board's assessment that the present invention contained a part that was based on non-technical considerations.

The board could not recognise any improved processing compared to the conventional prior-art system, since changing the displayed information involved additional processing. The only effect of this additional processing was in the mind of the user, who was presented with different information than in the conventional prior-art system.

The concept of the invention was that of displaying, for a display duration below a threshold, a version of the target content item with a reduced content amount that enabled the visitor to visually understand the target content item within the display duration. The versions to be displayed should be "mutually related in display content but mutually different in content amount". This concept of the invention was based on non-technical considerations about a reduction of the cognitive burden of the user. It was thus a non-technical concept that could be included in the formulation of the technical problem.

In view of this, the distinguishing features solved the technical problem of modifying the conventional prior-art system to display, for a display duration below a threshold, a version of the target content item with a reduced content amount that enabled the visitor to visually understand the target content item within the display duration. The board held, that the skilled person facing the above formulated technical problem would immediately recognise the need to estimate the display duration and change the version of the target content item to be displayed if the estimated display duration is below a threshold. The board found that this was obvious and the subject-matter not inventive within the meaning of Art. 56 EPC.

081-08-25

## 5. Article 056 EPC

| T 0095/23

| Board 3.4.03

## Article 056 EPC

|                                    |                                                                 |
|------------------------------------|-----------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0095/23</b>                                                |
| <b>Board</b>                       | 3.4.03                                                          |
| <b>Date of decision</b>            | 2025.06.05                                                      |
| <b>Language of the proceedings</b> | DE                                                              |
| <b>Internal distribution code</b>  | D                                                               |
| <b>Inter partes/ex parte</b>       | Inter partes                                                    |
| <b>EPC Articles</b>                | Article 056 EPC                                                 |
| <b>EPC Rules</b>                   |                                                                 |
| <b>RPBA</b>                        |                                                                 |
| <b>Other legal provisions</b>      |                                                                 |
| <b>Keywords</b>                    | inventive step – assessment starting from a concrete embodiment |
| <b>Cited decisions</b>             |                                                                 |
| <b>Case Law Book</b>               | <a href="#">I.D.3.7.1</a> , 11th edition                        |

Im Fall [T 95/23](#), ging es um eine Durchgangsschleuse mit einem Eingang und einer Ausgangstüre, sowie einem Display und einer Aufnahmevorrichtung zur Erfassung biometrischer Merkmale einer Durchgang begehenden Person, die frontal gegenüber dem Eingang in der Ausgangstüre integriert sind. Die Beschwerdeführerin (Einsprechende) hatte Argumentationslinien vorgebracht, die von D1 bis D6 als nächstliegendem Stand der Technik ausgingen. Die Kammer befand, dass ausgehend von D1, D3, D2 oder D5 der Gegenstand des Anspruchs 1 jeweils erfinderisch sei. In Bezug auf D4 führte sie aus, dass sich der beanspruchte Gegenstand von der aus D4 bekannten Vorrichtung dadurch unterscheide, dass die Kamera und ein Bildschirm in die Türe integriert seien.

Die Beschwerdeführerin hatte zur Frage des Naheliegens argumentiert, dass die Fachperson von einem allgemeinen generischen Ausführungsbeispiel ausgehen würde, das nicht unbedingt zwei separate Ausgänge hinter den Türen (von D4 Figur 1) haben müsse. In D4 werde die Erfindung sehr allgemein dargestellt und insbesondere beschrieben, dass die Ausgänge zu Zoll/Sicherheitskontrolle bzw. direkt zum Flugzeug verschiedene, rein optionale Varianten seien. Folglich könnten beide Türen auch zu ein und demselben Raum führen. Die Fachperson würde die allgemeine Lehre der Dokumente D1 und D2 aufnehmen und kleine Kameras und Displays in den Türen integrieren. Die Beschwerdegegnerin hatte argumentiert, dass dies nicht möglich sei, weil dann eine zu schleusende Person nicht wisse, durch welchen Durchgang sie zu gehen habe, während sich in D4 nach der Kontrolle nur die "richtige" Türe abhängig vom Ergebnis der Zugangskontrolle öffne.

Die Kammer war der Meinung, dass die Fachperson die Lehre der D1 und/oder D2 zwar in Betracht ziehen, aber aus folgenden Gründen nicht implementieren würde:

Bei der Prüfung der erfinderischen Tätigkeit sollte vorzugsweise von einem konkreten Ausführungsbeispiel ausgegangen werden, da die Fachperson bei einem generischen und unspezifischen Ausführungsbeispiel noch zusätzlichen technischen Aufwand für eine spezifische Ausarbeitung dieses Ausführungsbeispiels aufwenden müsste. Bei dieser Ausarbeitung würde der Fachmann letztendlich doch wieder auf die konkrete Lehre der detaillierten Ausführungsbeispiele im selben Dokument zurückgreifen. Die Fachperson würde sich also in der Regel für ein detailliertes Ausführungsbeispiel als Ausgangspunkt für die Prüfung der erfinderischen Tätigkeit entscheiden (s. Orientierungssatz). Die Kammer analysierte das einzige in D4 in den Figuren gezeigte und in der Beschreibung behandelte spezifische Ausführungsbeispiel und kam zu dem Schluss, dass der Durchgang eher verlangsamt würde, wenn der biometrische Abgleich durch Kameras (und Bildschirme) in jeder der beiden Türen stattfände, da die zu kontrollierende Person nicht im Voraus wüsste, bei welcher der beiden Türen sie herausgelassen werde.

Ferner sei es nicht unbedingt ohne technische Schwierigkeiten möglich, eine Kamera und einen Bildschirm, wie sie in D1 (bzw. D2) gezeigt sind, in die schwenkbaren Türen (von D4 Fig. 1) zu integrieren. Die in D1 gezeigten Kameras seien in den Zeichnungen relativ voluminös dargestellt. Die Kamera könne zwar in ein Display integriert werden, zum relevanten Zeitpunkt der Beurteilung der erfinderischen Tätigkeit (Anmeldetag des Patents im Jahre 2009) seien jedoch Kameras und Displays noch deutlich voluminöser und schwerer gewesen als zum Zeitpunkt der mündlichen Verhandlung vor der Kammer. Die Türen von D4 ließen die Fachperson darauf schließen, dass es sich um rahmenlose Türen handele. Eine Befestigung von Kameras und Displays in solchen rahmenlosen Glastüren sei technisch nicht einfach. Die Kameras und Displays in D1 hätten einen anderen technischen Kontext (massive Türen) und seien nicht unbedingt für die in D4 gezeigten Türen geeignet.

In Anbetracht der komplexen Umsetzung und insbesondere in Anbetracht der spezifischen Ausführungen in D4, die bei einer Integration von Kameras/Displays in die Türen den Durchgang eher schwieriger machen würden als vereinfachen, würde die Fachperson von solch einer Lösung absehen, insbesondere, da Komplikationen und Konfusion an einem Flughafen vermieden werden sollten. Der Gegenstand von Anspruch 1 sei erfinderisch gegenüber D4 in Kombination mit D1 oder D2. Gleiche Argumente gelten ausgehend von D6.

082-08-25

## 6. Article 069 EPC | T 1193/23 | Board 3.2.06

### Article 069 EPC

|                                    |                                                 |
|------------------------------------|-------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1193/23</b>                                |
| <b>Board</b>                       | 3.2.06                                          |
| <b>Date of decision</b>            | 2025.04.15                                      |
| <b>Language of the proceedings</b> | DE                                              |
| <b>Internal distribution code</b>  | C                                               |
| <b>Inter partes/ex parte</b>       | Inter partes                                    |
| <b>EPC Articles</b>                | Article 069 EPC                                 |
| <b>EPC Rules</b>                   |                                                 |
| <b>RPBA</b>                        |                                                 |
| <b>Other legal provisions</b>      |                                                 |
| <b>Keywords</b>                    | claims – claim interpretation – chatbot chatGPT |
| <b>Cited decisions</b>             | T 0206/22                                       |
| <b>Case Law Book</b>               | <a href="#">II.A.6.1</a> , 11th edition         |

In [T 1193/23](#) hatte die Beschwerdegegnerin (Patentinhaberin) zu verschiedenen im Anspruch 1 des Hauptantrags verwendeten Begriffen, insbesondere "Lageregelung" sowie "überprüfen" im Vergleich zu "überwachen", Bezug auf Antworten des Chatbot ChatGPT genommen.

Die Kammer merkte an, dass die Antwort von ChatGPT an sich irrelevant war, da es bei der Auslegung des Anspruchs um das Verständnis der Fachperson geht (s. auch T 206/22). Allein die allgemein zunehmende Verbreitung und Nutzung von Chatbots, die auf Sprachmodellen ("large language models") und/oder "künstlicher Intelligenz" beruhen, rechtfertigt noch nicht die Annahme, dass eine erhaltene Antwort – die auf dem Nutzer unbekannten Trainingsdaten beruhen und zudem empfindlich vom Kontext und der genauen Formulierung der Frage(n) abhängen kann – notwendigerweise das Verständnis der Fachperson auf dem jeweiligen technischen Gebiet (zum relevanten Zeitpunkt) richtig abbildet. Der Nachweis, wie bestimmte Begriffe im Anspruch eines Patents (oder einer Patentanmeldung) durch die Fachperson ausgelegt werden, kann zum Beispiel durch geeignete Fachliteratur belegt werden. Für die behaupteten unterschiedlichen Bedeutungen der oben genannten Begriffe im relevanten technischen Gebiet war kein derartiger Nachweis eingereicht worden.

Die Kammer prüfte die anderen Argumente der Parteien und kam zu dem Schluss, dass die strittigen Merkmale in einem breiteren Sinne von der Fachperson verstanden werden, als die Beschwerdegegnerin argumentiert hatte. Da sämtliche

Merkmale des Anspruchs 1 des Hauptantrags in D3 offenbart worden waren, entschied die Kammer, dass sein Gegenstand nicht neu war.

083-08-25

## 7. Article 087(1) EPC | T 0195/23 | Board 3.2.04

### Article 087(1) EPC

|                                    |                                                                                                                                  |
|------------------------------------|----------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0195/23</b>                                                                                                                 |
| <b>Board</b>                       | 3.2.04                                                                                                                           |
| <b>Date of decision</b>            | 2025.06.13                                                                                                                       |
| <b>Language of the proceedings</b> | EN                                                                                                                               |
| <b>Internal distribution code</b>  | D                                                                                                                                |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                     |
| <b>EPC Articles</b>                | Article 087(1) EPC                                                                                                               |
| <b>EPC Rules</b>                   |                                                                                                                                  |
| <b>RPBA</b>                        |                                                                                                                                  |
| <b>Other legal provisions</b>      |                                                                                                                                  |
| <b>Keywords</b>                    | priority – basis in priority document (no) – same invention (no) – negative feature – implicit feature of priority document (no) |
| <b>Cited decisions</b>             |                                                                                                                                  |
| <b>Case Law Book</b>               | <a href="#">II.D.4.5.2</a> , <a href="#">II.E.1.13.3</a> , 11th edition                                                          |

[T 195/23](#) was an appeal against the interlocutory decision of the opposition division concerning the maintenance of the patent in amended form. The opponents disputed the decision's finding that the priority claim was valid. In particular, they challenged the validity of the priority claim for the alternative "wherein the smoke modifying additive is disposed only in said axial region of the filter material of the first filter section" in the feature directed to the location of the smoke modifying article in claim 1 of auxiliary request 3.

The board concurred with the proprietor that the drawings in the priority document were specifically intended to show the location of the smoke modifying additive. In fact, figures 1-5 of the priority document depicted various types of additive located in the central region of a filter section. For example, in figures 1 and 4, a capsule was located in an axial region of a first filter section. In figures 2 and 5, the absorbent material had an additive carrying thread disposed therein in an axial region. In figure 3, the absorbent material 47 had a plurality of microcapsules disposed therein in an axial region thereof. However, none of these passages contained a statement to the effect that the depicted smoke modifying additive was the only additive in the filter. In the board's view, these drawings therefore could only serve as a basis for a positive feature directed to the presence of such additive in a central region of the filter. Such a positive feature did not rule out the presence of some further, non-depicted additive in another region of the filter.

In contrast, the board construed the feature "only in the axial region" as a negative feature which was directed to the absence of any smoke modifying additive from other regions of the filter, e.g. its peripheral region. The board referred to established jurisprudence (see CLB, II.E.1.13.3, 10th edition) according to which, a negative feature, i.e. the absence of not depicted elements, usually cannot be derived from drawings. This was aggravated in the present case by the disclosure in the priority document, which explicitly stated that there could be additive – though at a lower concentration – in non-axial regions of the filter. In light of this explicit disclosure in the priority document, which did not contradict the drawings and the corresponding explanations to the drawings in the description, the board was not convinced by the respondent's argument that the skilled person would interpret the drawings as such, rather than entertaining the notion that they did not illustrate some smoke modifying additive. As a consequence, the board did not consider the feature directed to the smoke modifying additive being disposed only in the axial region of the first filter section to be an implicit feature of the priority document.

The board concluded that the application underlying the patent in suit was not filed in respect of the same invention for the alternative "wherein the smoke modifying additive is disposed only in said axial region of the filter material of the first filter section" of claim 1 of auxiliary request 3, and thus, the patent proprietor should not enjoy a right of priority for this alternative.

The above conclusions also applied to independent claim 1 of auxiliary requests 5 to 18, which also contained the alternative "wherein the smoke modifying additive is disposed only in said axial region of the filter material of the first filter section".

084-08-25

## 8. Article 112(1)(a) EPC | T 0697/22 | Board 3.3.02

### Article 112(1)(a) EPC

|                                    |                                                                                                                                                                                                                                                                                                                                                   |
|------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0697/22</b>                                                                                                                                                                                                                                                                                                                                  |
| <b>Board</b>                       | 3.3.02                                                                                                                                                                                                                                                                                                                                            |
| <b>Date of decision</b>            | 2025.07.29                                                                                                                                                                                                                                                                                                                                        |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                                                                                                                                                |
| <b>Internal distribution code</b>  | A                                                                                                                                                                                                                                                                                                                                                 |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                                                                                                                                      |
| <b>EPC Articles</b>                | Articles 084, 112(1)(a) EPC                                                                                                                                                                                                                                                                                                                       |
| <b>EPC Rules</b>                   | Rules 042, 043, 048, 071(1) EPC                                                                                                                                                                                                                                                                                                                   |
| <b>RPBA</b>                        |                                                                                                                                                                                                                                                                                                                                                   |
| <b>Other legal provisions</b>      | Guidelines F-IV, 4.4                                                                                                                                                                                                                                                                                                                              |
| <b>Keywords</b>                    | referral to the Enlarged Board of Appeal – adaptation of the description – legal basis                                                                                                                                                                                                                                                            |
| <b>Cited decisions</b>             | G 0003/14, G 0001/24, T 1024/18, T 1989/18, T 0140/19, T 2194/19, T 2685/19, T 3097/19, T 0169/20, T 1444/20, T 0056/21, T 1452/21, T 1472/21, T 0438/22, T 0447/22, T 1571/22<br>Final order of the Court of First Instance of the Unified Patent Court of 30 April 2025, Local Division Hamburg, ORD_598576/2023 – AGFA/Gucci, UPC CFI 278/2023 |
| <b>Case Law Book</b>               | <a href="#">II.A.5.3</a> , 11th edition                                                                                                                                                                                                                                                                                                           |

In [T 697/22](#) the board agreed with the appellant-opponent that there was an inconsistency between claim 1 of auxiliary request 1E, which required that a specific feature was mandatory, and the amended description as filed during the oral proceedings before the opposition division, according to which said feature was optional.

According to the board, if this inconsistency was considered to be in contravention of the requirement in Art. 84 EPC that the claims must be supported by the description, or any other requirement of the EPC, the request based on the claims of auxiliary request 1E and the description as amended during the oral proceedings before the opposition division was not allowable. Otherwise, it would be allowable.

The board analysed the case law relating to the requirement to adapt the description to amended claims, and concluded that there are two diverging lines of case law. The first line of case law is followed in most of the cases studied and is referred to in numerous decisions as the established line of case law, see e.g. T 1024/18 and

T 438/22. The common underlying principle is that there is a legal basis that requires the description to be consistent with the amended claims. Under this line of case law, the applicant or proprietor is or should be invited to amend the description so that any inconsistency caused by the amendment of the claims is removed. The removal of an inconsistency may, for example, take the form of a deletion of subject-matter or an insertion of an additional statement in the description. The decisions that follow the first line of case law cite as a legal basis parts of the EPC or its Implementing Regulations, but there is no consensus on one precise legal basis.

Regarding the second line of case law, the board noted that a few recent decisions (T 56/21, T 1444/20, T 1989/18 and T 2194/19) are clearly divergent from the first line of case law. In these decisions, which were all taken in examination-appeal proceedings, it was decided that there is no legal basis for the refusal of a patent application if there is an inconsistency between any amended claims and the description caused by the claim amendment.

The board noted that the divergence in the case law concerns both whether it is necessary to adapt the description to the amended claims (to be answered in the positive in the first line or in the negative in the second line of case law) and, if it is to be answered in the positive, what the legal basis is. Therefore, to ensure uniform application of the law, the board referred the following questions to the Enlarged Board (referral pending under G 1/25 – "Hydroponics"):

1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?
2. If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?
3. Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?

085-08-25

## 9. Article 117 EPC

| T 0535/21

| Board 3.5.06

## Article 117 EPC

|                                    |                                                                                                  |
|------------------------------------|--------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0535/21</b>                                                                                 |
| <b>Board</b>                       | 3.5.06                                                                                           |
| <b>Date of decision</b>            | 2024.10.11                                                                                       |
| <b>Language of the proceedings</b> | DE                                                                                               |
| <b>Internal distribution code</b>  | D                                                                                                |
| <b>Inter partes/ex parte</b>       | Ex parte                                                                                         |
| <b>EPC Articles</b>                | Article 117 EPC                                                                                  |
| <b>EPC Rules</b>                   |                                                                                                  |
| <b>RPBA</b>                        |                                                                                                  |
| <b>Other legal provisions</b>      |                                                                                                  |
| <b>Keywords</b>                    | law of evidence – admissible evidence – other documents – AI generated evidence – inventive step |
| <b>Cited decisions</b>             |                                                                                                  |
| <b>Case Law Book</b>               | <a href="#">III.G.2.6</a> , 11th edition                                                         |

Im ex parte Fall [T 535/21](#), richtet sich die Beschwerde gegen die Entscheidung der Prüfungsabteilung, die Anmeldung mangels erfinderischer Tätigkeit zurückzuweisen. Die Kammer teilte der Beschwerdeführerin mit der Ladung zur mündlichen Verhandlung ihre vorläufige Meinung mit, dass die Entscheidung zu bestätigen sein würde. In Reaktion darauf legte die Beschwerdeführerin in der mündlichen Verhandlung vor der Beschwerdekammer einen Auszug aus einem Dialog der Beschwerdeführerin mit dem "Microsoft Copilot" vor (Auszug als A1 bezeichnet).

Die Beschwerdeführerin und die Prüfungsabteilung waren sich darüber einig, dass sich Anspruch 1 durch drei Merkmalsgruppen von D3 unterschied. Die Beschwerdeführerin vertrat aber die Ansicht, dass die Unterscheidungsmerkmale mit D3 die synergetische Wirkung hätten, die Gerätesicherheit zu erhöhen.

Was den ersten Unterschied betrifft, hatte die Beschwerdeführerin offengelassen, in welchem Sinne ein Mikrocontroller zur Sicherheit beiträgt.

Zu dieser Frage führte die Beschwerdeführerin aus, dass Mikrocontroller als sichere Steuerung für industrielle Prozesse fungierten, und dass sie echtzeitfähig und aufgrund ihrer geringen Komplexität zuverlässig seien. Die Beschwerdeführerin bezog sich in dieser Hinsicht auf A1. In der dort dargestellten Antwort des Microsoft Copilot auf die Frage "Bewirkt ein Mikrocontroller eine höhere Sicherheit als ein Mikroprozessor oder sind sie gleich bezüglich Sicherheit", wies die

Beschwerdeführerin selbst allerdings auf den Warnhinweis in A1 hin, dass "KI-generierte Inhalte [...] falsch sein" könnten.

Die Kammer bemerkte zunächst, dass die in A1 enthaltenen Aussagen per se richtig sein mochten, dass aber A1 kein geeignetes Beweismittel für diese Aussagen war. Zum einen, weil, wie A1 selbst warnte, "KI-generierte Aussagen [...] falsch sein" können. Die Aussagen hätten daher noch durch unabhängige Quellen überprüft werden müssen. Ob sich die in A1 angegebenen Quellen dafür eigneten, falls sie denn überhaupt existierten, hätte ebenfalls geprüft werden müssen. Die Kammer ließ diese Fragen offen, da der Vortrag der Beschwerdeführerin sogar dann nicht überzeugt hätte, wenn der Inhalt der A1 nicht bestritten worden wäre.

Selbst unterstellt, dass Mikrocontroller gegenüber Mikroprozessoren Sicherheitsvorteile hätten, bliebe offen, in genau welchem Sinne die Steuerung des beanspruchten Umrichters durch den verwendeten Mikrocontroller "sicherer" werde. So blieb undefiniert, welches Signal für einen Umrichter sicherheitsrelevant sei oder was im Einzelnen der Benutzer prüfen könnte oder sollte. Die behauptete Synergie war schon deshalb nicht erkennbar.

Das Vorbringen der Beschwerdeführerin reichte nicht aus, um eine Synergie der Unterschiede nachzuweisen. Die Kammer war weiter der Ansicht, dass die Unterschiede für den Fachmann ausgehend von D3 nahe lagen.

086-08-25

## 10. Rule 080 EPC

## | T 2108/22 | Board 3.4.02

## Rule 080 EPC

|                                    |                                                                                                                                                                                                                         |
|------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 2108/22</b>                                                                                                                                                                                                        |
| <b>Board</b>                       | 3.4.02                                                                                                                                                                                                                  |
| <b>Date of decision</b>            | 2025.03.18                                                                                                                                                                                                              |
| <b>Language of the proceedings</b> | DE                                                                                                                                                                                                                      |
| <b>Internal distribution code</b>  | C                                                                                                                                                                                                                       |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                            |
| <b>EPC Articles</b>                |                                                                                                                                                                                                                         |
| <b>EPC Rules</b>                   | Rule 080 EPC                                                                                                                                                                                                            |
| <b>RPBA</b>                        |                                                                                                                                                                                                                         |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                         |
| <b>Keywords</b>                    | amendment occasioned by a ground for opposition – amendment comprising several individual amendments allowable (no) – conflicting interest of parties must be considered – each case to be considered on its own merits |
| <b>Cited decisions</b>             | T 0406/86, T 0937/00, T 0181/02, T 0263/05, T 0323/05, T 0993/07, T 0750/11, T 0428/12, T 0021/16                                                                                                                       |
| <b>Case Law Book</b>               | <a href="#">IV.C.5.1.2d</a> ), 11th edition                                                                                                                                                                             |

In der angefochtenen Entscheidung in der Sache [T 2108/22](#) wurde der damalige erste Hilfsantrag (jetziger Hauptantrag) nicht zum Verfahren zugelassen, "da er keine notwendige und zweckmäßige Antwort auf einen Einspruchsgrund sei (R. 80 EPÜ)". Der Anspruch 1 des Hilfsantrags 1 wurde im Vergleich zum erteilten Anspruch 1 mit zwei unterschiedlichen Alternativen eingeschränkt. Es war unstrittig zwischen den Parteien, dass jede der beiden Alternativen A und B des Anspruchs 1 für sich alleine betrachtet durch Hinzufügung von Merkmalen so geändert wurde, dass sie jeweils dem Erfordernis der R. 80 EPÜ genüge.

Nach Ansicht der Kammer, ergibt sich die Gesamtwirkung einer Änderung, die sich aus mehreren Einzeländerungen zusammensetzt, nicht nur aus der Summe der Wirkungen der Einzeländerungen für sich einzeln betrachtet, sondern es ist auch zu berücksichtigen, wie sich die Einzeländerungen im Zusammenhang mit dem insgesamt geänderten Anspruchssatz auswirken. Im vorliegenden Fall besteht diese Gesamtwirkung u.a. auch darin, dass anstelle eines einzigen unabhängigen Anspruchs, der eine einzige Erfindung definiert, nun zwei Alternativen A und B in dem Anspruch definiert sind, die zwei unabhängigen Ansprüchen entsprechen. Das Vorhandensein als solches von zwei Alternativen in Anspruch 1 erfüllt keine der

Anforderungen, die nach der Rechtsprechung an eine Änderung im Einklang mit R. 80 EPÜ zu stellen sind, und stellt daher einen Verstoß gegen R. 80 EPÜ dar.

Die Kammer kam zu dem Schluss, dass die Hinzufügung einer einzigen der beiden, den beanspruchten Gegenstand einschränkenden ODER-Alternativen, z.B. Alternative A, zum erteilten unabhängigen Anspruch 1 als ausreichende und abschließende Reaktion auf einen Neuheitseinwand zu werten sei. Diese Änderung entspreche dem Erfordernis der R. 80 EPÜ. Die Hinzufügung der Merkmale der zweiten Alternative B, die inhaltlich komplett unterschiedlich von der ersten Alternative A ist, kann jedoch nicht dazu beitragen, den Neuheitseinwand zu beseitigen, der zur Hinzufügung der ersten Alternative A geführt hat. Die Hinzufügung der Alternative B zum geänderten Anspruch 1 mit der Alternative A könne also nicht durch einen Einspruchsgrund veranlasst sein (R. 80 EPÜ), sondern nur durch den von der Patentinhaberin vorgebrachten Wunsch nach einem "angemessenen breitestmöglichen [Schutz]". Eine Änderung mit dem Ziel des Erreichens des größtmöglichen Schutzzumfangs ist jedoch nicht im Einklang mit dem Erfordernis der R. 80 EPÜ.

Eine zweite Alternative in Anspruch 1 führt zu einer erhöhten Komplexität des Verfahrens, zu einer Verzögerung des Verfahrens bei Zurückverweisung an die Einspruchsabteilung, zur weiteren Bearbeitung und zu einer Verschlechterung der Verfahrensökonomie. Die Einsprechende forderte daher eine ausgewogene und faire Abwägung zwischen ihrem eigenen und dem Begehren der Patentinhaberin.

Die Kammer kam unter Berücksichtigung des Umstands, dass die Hinzufügung eines oder mehrerer unabhängiger Ansprüche nach R. 80 EPÜ nicht ausdrücklich zulässig ist, und unter Abwägung der gegenläufigen Interessen der Beteiligten zu dem Schluss, dass der Anspruch 1 mit zwei Alternativen gegen die Vorschrift der R. 80 EPÜ verstößt.

Die Patentinhaberin zitierte mehrere Entscheidungen der Beschwerdekammern (z.B. T 937/00, T 181/02, T 263/05, T 428/12), wonach die Patentinhaberin ein Recht auf größtmöglichen Schutz habe und daher das Ersetzen eines einzigen unabhängigen Anspruchs durch mehrere unabhängige Ansprüche zulässig sei. Die Kammer überzeugte dieses Argument nicht. Keine der von der Patentinhaberin zitierten Entscheidungen der Beschwerdekammern besagt, dass eine Änderung eines Anspruchs, die darin besteht, einen einzigen unabhängigen Anspruch durch mehrere unabhängige Ansprüche zu ersetzen, in jedem Fall nach R. 80 EPÜ zulässig ist. Vielmehr besteht in der Rechtsprechung der Beschwerdekammern ein allgemeiner Konsens darüber, dass "jeder Fall für sich genommen betrachtet werden muss" (T 263/05).

087-08-25

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