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**Datasheet for the decision  
of 19 January 2026**

**Case Number:** T 0094/24 - 3.5.05

**Application Number:** 15197184.3

**Publication Number:** 3177039

**IPC:** H04R25/00

**Language of the proceedings:** EN

**Title of invention:**

Hearing aid with a flexible carrier antenna and related method

**Patent Proprietor:**

GN Hearing A/S

**Opponent:**

Oticon A/S

**Headword:**

Indentation in a hearing aid/GN HEARING

**Relevant legal provisions:**

EPC Art. 56, 100(a), 112(1)(a), 113(1)

EPC R. 106

RPBA 2020 Art. 12(3), 13(2), 15a(1), 21

**Keywords:**

Oral proceedings by videoconference (no): in-person hearing more appropriate in view of substantive amount of submissions  
Inventive step - main request (no): no technical effect credibly achieved over the whole scope claimed  
Admittance - auxiliary requests 1 to 3 (no): no "exceptional circumstances" and detrimental to procedural economy  
Referral of questions to the Enlarged Board of Appeal - (no): no "unique application" of the problem-solution approach by Board 3.5.05  
Objections under Rule 106 EPC - dismissed: no violation of proprietor's right to be heard

**Decisions cited:**

G 0001/03, G 0001/19, G 0002/21, G 0001/24, R 0004/09,  
R 0011/11, R 0005/16, R 0006/17, R 0008/19, R 0006/20,  
R 0004/22, R 0005/22, J 0005/81, T 0001/80, T 0024/81,  
T 0037/82, T 0198/88, T 0294/89, T 0144/90, T 0206/91,  
T 0574/92, T 0939/92, T 0912/94, T 0072/95, T 0015/97,  
T 0158/97, T 0176/97, T 0471/98, T 0641/00, T 1027/08,  
T 2044/09, T 1415/11, T 1841/11, T 1009/12, T 0488/16,  
T 1294/16, T 1190/17, T 1869/18, T 0466/20, T 0814/20,  
T 0885/20, T 1344/21, T 0687/22, T 0746/22, T 1289/22,  
T 1616/22, T 1628/22, T 0217/23, T 0287/23, T 0449/23,  
T 0969/23, T 1465/23, T 2027/23

Federal Court of Justice (BGH), X ZR 51/21, decision of 13 June 2023 - Schlossgehäuse

UK High Court, *Sandvik IP AB v Kennametal* [2011] EWHC 3311

UPC\_CoA\_464/2024 of 25 November 2025



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Case Number: T 0094/24 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 19 January 2026**

**Appellant:** Oticon A/S  
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**Representative:** GN Store Nord A/S  
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted on 16 November 2023 rejecting the opposition filed against European patent No. 3177039 pursuant to Article 101(2) EPC.**

**Composition of the Board:**

**Chair** K. Bengi-Akyürek  
**Members:** K. Peirs  
J. Hoppe

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division to reject the opposition (Article 101(2) EPC).

The opposition division found that neither the ground for opposition under Article 100(a) EPC in conjunction with Articles 54 and 56 EPC (in view of documents D1 and D2) nor the one under Article 100(c) EPC in conjunction with Article 123(2) EPC prejudiced the maintenance of the opposed patent as granted.

In the appealed decision, the opposition division took into account the following prior-art documents:

**D1:** WO 2011/137099 A1  
**D2:** US 2015/0036854 A1.

- II. Summons to oral proceedings before the board were despatched on 4 April 2025. The proceedings were scheduled to take place on 15 January 2026 by videoconference. A communication under Article 15(1) RPBA including the board's preliminary opinion was attached to those summons as an annex.

- III. With its letter dated 15 December 2025, the proprietor filed a written reply to the board's preliminary opinion. The written reply included, besides further arguments, auxiliary claim requests, precautionary objections under Rule 106 EPC and a request under Article 112(1)(a) EPC to refer the following questions to the Enlarged Board of Appeal:

*"1. In the absence of exceptional circumstances, may a Board of Appeals [sic] create its own approach to*

*inventive step deviating from the conventional problem-solution approach?*

2. *The 'no objective technical problem' approach cites G 1/19 as authority, for its reasoning that the lack of credible technical effect leads to the lack of a technical problem, with no limitations on the type of the inventions or exceptional circumstances that would lead to the application of such an approach. However, G 1/19 established the COMVIK approach as 'a special application of the problem-solution approach to inventions that contain a mix of technical and non-technical features' (G 1/19, paragraph 34) with a focus on the technical contribution of the distinguishing features. To what extent is this approach reconcilable with the interpretation and explanation provided in G 1/19?*

3. *Does 'credibility' of a technical effect have a different meaning than 'plausibility' of the evidence, as explained in G 2/21?"*

IV. On 17 December 2025, the parties were informed that the oral proceedings before the board would be held in-person rather than by videoconference as initially foreseen.

V. By letter dated 18 December 2025, the proprietor requested that the oral proceedings be held via videoconference. With its letter dated 5 January 2026, the proprietor proposed, as an alternative, hybrid oral proceedings.

VI. By a communication of the Registry dated 8 January 2026, the parties were informed that the in-person

format for the oral proceedings was maintained.

- VII. With its letter dated 14 January 2026, informing the board of a cancelled flight, the proprietor requested a postponement of the arranged oral proceedings and, as an auxiliary measure, that the format of those oral proceedings be changed to videoconference.
- VIII. With EPO form 3017 and a communication, both despatched on 15 January 2026, the parties were informed that the oral proceedings were rescheduled to 19 January 2026, that the proprietor's request for holding the hearing by videoconference or by a hybrid format was rejected and that the in-person format for the oral proceedings was upheld. In addition, reasons for the rejection of the proprietor's request as to the format of the oral proceedings were provided in that communication.
- IX. Oral proceedings before the board were held in-person on 19 January 2026.

The parties' final requests were as follows:

- The opponent requested that the decision under appeal be set aside and that the patent be revoked.
- The proprietor requested, in the given order, that the appeal be dismissed, i.e. that the patent be maintained as granted (**main request**), or as an auxiliary measure
  - that the patent be maintained in amended form based on one of **auxiliary requests 1 or 3**, filed with letter dated 15 December 2025,

- that questions 1 to 3 be referred to the Enlarged Board of Appeal as set out in the letter dated 15 December 2025.

During the oral proceedings, the proprietor also raised **two objections under Rule 106 EPC**. Moreover, it maintained its request for oral proceedings to be held by videoconference.

At the end of the oral proceedings, the board's decision was announced.

X. Claim 1 of the **main request** reads as follows (board's feature labelling):

- (a) "A hearing aid (1) comprising an electrical assembly (2, 2A, 102) comprising
- (b) - a printed circuit board (4, 4A, 4B) having a first board surface (8) and a second board surface (10),
- (c) the printed circuit board (4, 4A, 4B) having a first pad (12) in a first pad region on the first board surface (8), the first pad region having a first board normal (14);
- (d) - a flexible printed circuit board (18) comprising
- (e) an antenna (24) having a first terminal (26) in a first terminal region (28) on a first flexfilm surface (20) of the flexible printed circuit board (18), the first terminal region (28) having a first terminal normal (32);
- (f) wherein the electrical assembly (2, 2A, 102) comprises first electrically conductive

material (30) connecting the first pad (12) and

(g) the first terminal (26), and wherein the first terminal normal (32) and the first board normal (14) form a first angle ( $\alpha_1$ ) in the range from  $30^\circ$  to  $150^\circ$ ; characterised in that

(h) the printed circuit board (4, 4A, 4B) has a first indentation (31)

(i) in a first edge part of the printed circuit board (4, 4A, 4B),

(j) the first indentation (31) accommodating at least a part of the first terminal (26)."

XI. Claim 1 of **auxiliary request 1** differs from claim 1 of the main request in that it further comprises, at the end, the following feature (board's labelling):

(k) ", and wherein the first indentation has a maximum depth of 1 mm and a width of 2 mm to 8 mm".

XII. Claim 1 of **auxiliary request 2** differs from claim 1 of the main request in that it further comprises, at the end, the following feature (board's labelling):

(l) ", wherein the indentation is not located on a raised portion of the PCB".

XIII. Claim 1 of **auxiliary request 3** differs from claim 1 of the main request in that it further comprises, at the end, the following feature (board's labelling):

(m) ", wherein the first electrically conductive material is solder".

## **Reasons for the Decision**

1. *Format of the oral proceedings before the board*
  - 1.1 During the oral proceedings before the board, the proprietor maintained its request that the oral proceedings be held via videoconference (see also points V and VII above).
  - 1.2 Pursuant to Article 15a(1) RPBA, the board may decide to hold oral proceedings under Article 116 EPC by videoconference if it considers it appropriate to do so, either upon request by a party or of its own motion. This decision falls within the board's discretion.
  - 1.3 In exercising this discretion, the board must assess the suitability of the format in the light of the specific circumstances of the case. While the proprietor argued that the prior-art documents did not require physical inspection, the board observes that the procedural complexity of the case increased significantly due to the proprietor's written reply to the board's preliminary opinion.
  - 1.4 Specifically, in response to the board's concise preliminary opinion comprising only four pages and sent nine months ahead of the hearing before the board, the proprietor filed a 68-page submission only one month prior to the date on which the oral proceedings were originally scheduled, which additionally included a request for a referral to the Enlarged Board of Appeal (cf. point III above). Given the volume of this late submission and the proprietor's indication that it had difficulties following the reasoning set out in the

board's preliminary opinion, the board considered the interactive immediacy of a face-to-face hearing to be indispensable for an efficient and effective discussion in the present case.

1.5 Furthermore, regarding the proprietor's objection to the change of format at a late stage, the board notes that the proprietor's extensive written reply was filed only one month before the scheduled date of the oral proceedings before the board.

1.6 The board acknowledges the proprietor's general arguments regarding environmental responsibility. However, the choice of the format of a hearing is a *judicial* decision guided primarily by the need to ensure a fair and effective conduct of the oral proceedings. In the absence of general travel restrictions or specific impediments preventing attendance, the board prioritised, for the present case, the format best suited to resolving the complex legal and technical issues raised by the proprietor's late submissions.

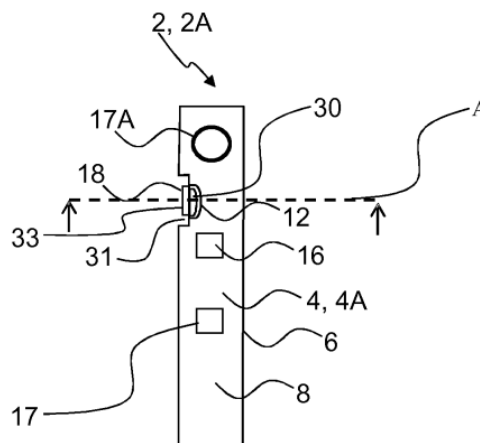
1.7 Consequently, the request to hold the oral proceedings by videoconference was refused.

## 2. *Opposed patent - technical background*

2.1 The opposed patent relates to a hearing aid comprising an antenna. As detailed in the patent description, a perennial challenge in this regard is the requirement to minimise the physical size of the hearing aid while ensuring robust mechanical and electrical connections between its components.

2.2 To address this, the patent proposes a specific assembly geometry between the hearing aid's main printed circuit board (PCB) and the antenna that is arranged on a separate flexible printed circuit board (FPCB).

2.3 This assembly geometry is illustrated in the perspective view of Figure 1 (reproduced below). The hearing aid comprises a rigid carrier substrate (PCB 4, 4A), which carries the signal-processing electronics. This substrate is provided with an "indentation" 31 (i.e. a recess or cut-out) located at its edge. The antenna is located on a flexible printed circuit board (FPCB 18), which includes an antenna terminal designed for electrical connections.



**Fig. 1**

2.4 The core technical concept of the invention underlying the patent is that the "indentation" of the carrier substrate is supposed to accommodate at least a part of the antenna terminal. According to the patent, this arrangement is intended to facilitate the mechanical and electrical connections (typically via solder) between the PCB and FPCB, purportedly allowing for a more compact internal assembly compared to traditional

surface-mount or wire-bridged connections (see patent specification, paragraph [0021]).

3. *Main request: claim 1 - inventive step*

3.1 *Claim interpretation*

3.1.1 Pursuant to **G 1/24**, the claims are the "starting point" and the "basis" for assessing the patentability of an invention under Articles 52 to 57 EPC. The description and drawings shall always be "consulted" to interpret the claims when assessing the patentability of an invention under Articles 52 to 57 EPC (cf. G 1/24, headnote).

3.1.2 Consulting the patent description, the board concludes that the technical field of the skilled reader from whose perspective the present claims are to be interpreted is *hearing aids using wireless technologies* (see e.g. paragraphs [0001] and [0002]). The board agrees with the proprietor that this skilled reader would understand that the claimed subject-matter refers to a "hearing aid" to be used by hearing-impaired persons whose components are limited to sizes, designs and structures that are apt to be used in a hearing aid.

3.1.3 However, this does not mean that a claim should be interpreted, based on features set out in embodiments of an invention, as having a meaning narrower than the wording of the claim as understood by the person skilled in the art (see e.g. **T 2027/23**, catchword). Hence, the specific sizes, designs and structures as reflected in the embodiments and in the figures of the patent specification as mere examples cannot be used to further limit the claimed subject-matter. This was also

agreed upon by the proprietor during the oral proceedings. As also correctly argued by the opponent in its statement of grounds of appeal, it is repeatedly indicated in the opposed patent itself that the embodiments of the patent specification are merely non-limiting examples which are not intended to be "*an exhaustive description of the claimed invention*" or "*a limitation on the scope of the claimed invention*" (see, for example, paragraphs [0008] and [0039]: "*the scope of the claimed invention being only defined by the appended claims*").

3.1.4 Therefore, the proprietor's assumption that the size, thickness, structure and design of the components of the claimed "hearing aid" were limited to the respective specification as disclosed in the description and the figures of the opposed patent cannot be accepted. Also, the proprietor's argument that requiring further details to be incorporated into the claimed subject-matter would be contrary to the EPC is unfounded and also contradicts the principles set out in **G 1/24** which rather requires the claims to be the "starting point" and the "basis" for assessing patentability.

3.1.5 Accordingly, as to **feature (d)**, also specific limitations on the thickness of the claimed "FPCB", which were addressed by the proprietor, are only presented as optional in the patent specification (see paragraph [0012]).

3.1.6 As to **feature (j)**, the proprietor further argued that it was derivable from the patent description that the "first terminal" had to rest inside the "indentation".

This is however not persuasive, since it is simply not

claimed that the "indentation" has to accommodate the entire "terminal" but only "at least a part of the first terminal".

3.2 *Starting point for the assessment of inventive step*

3.2.1 In the appealed decision (Reasons 5), the opposition division considered prior-art document **D2** to be a suitable starting point for the assessment of inventive step (Article 56 EPC). It also noted the agreement between the parties that document D2 did not disclose **features (h) to (j)**.

3.2.2 The parties did not dispute this in their submissions that form the basis for the appeal proceedings under Article 12(3) RPBA (cf. point 3.3 below). The board sees no reason to differ from the opposition division's assessment in this regard, either.

3.3 *Amendment of proprietor's appeal case: admittance (Article 13(2) RPBA)*

3.3.1 With its response to the board's communication under Article 15(1) RPBA, the proprietor submitted, for the first time, that document D2 did also not disclose **features (c), (e) and (f)**.

3.3.2 During the oral proceedings before the board, the proprietor further added **feature (g)** to the list of distinguishing features. In that regard, it argued that its submission regarding the disclosure in D2 of features (c), (e), (f) and (g) was not an "amendment" but merely an "elaboration" or "continuation" of its existing appeal case, justified by a shift in focus from document D1 (as referred to in the decision under appeal and the statement of grounds of appeal) to

document D2 (as referenced in the board's preliminary opinion).

- 3.3.3 The board considers that this submission does indeed constitute an "amendment" of the proprietor's appeal case within the meaning of Article 13(2) RPBA. This is mainly because the proprietor had not contested the disclosure of features (c), (e), (f) and (g) previously in the appeal proceedings. In general, the point of reference for assessing whether a respondent's appeal case had been amended within the meaning of Article 13(2) RPBA is the written reply to the statement of grounds of appeal (forming the basis of the respondent's appeal case under Article 12(3) RPBA). As is apparent from section 1.4.2 of its written reply, the proprietor did not contest the opponent's arguments as regards the disclosure of features (a) to (g) by document D2 but only considered features (h) to (j) to be distinguishing features within the framework of the inventive-step attack starting from document D2. This corresponds to the statement set out in Reasons 5 of the impugned decision where the opposition division held that there appeared to be agreement between the parties that these were the sole distinguishing features over document D2. The opposition division itself also considered D2 to disclose the remaining features, i.e. the features of the preamble of claim 1, in Figures 3 and 4 and the associated description (see Reasons 5, last sentence, of the impugned decision). The proprietor did not contest this finding in the appealed decision, nor the related arguments of the opponent in the statement of grounds of appeal, where the disclosure of the remaining features in D2 was explicitly addressed in section 4.1.2.2.

3.3.4 Article 12(3) RPBA demands the parties to specify *expressly* all their requests, facts, objections, arguments and evidence. Hence, if a proprietor intends to contest an opponent's arguments as regards the disclosure of features in a prior-art document, it needs to state this *expressly*. Thus, the introduction of factual challenges *after* the expiry of the time limit for filing the written reply to the statement of grounds of appeal constitutes a change in the factual basis of the appeal case. This cannot be regarded as a mere "elaboration" or "continuation" of a previous argument, but is rather to be considered an "amendment" of the proprietor's appeal case.

3.3.5 In that regard, the board is not convinced by the proprietor's argument put forward at the oral proceedings before it that the proprietor only understood the opponent's allegedly "confusing" feature mapping based on the board's preliminary opinion. Yet, the board's preliminary opinion did not discuss this feature mapping at all. It merely stated (see point 6.1):

*"The opposition division also noted the agreement between the parties that D2 did not disclose features (h) to (j). The parties did not dispute this in appeal and the board will do so neither."*

Consequently, the preliminary opinion provided no new information regarding features (c), (e), (f) and (g) of claim 1 that could have triggered a new understanding or constituted an "exceptional circumstance" justifying admittance of a late-filed amendment within the meaning of Article 13(2) RPBA.

3.3.6 Moreover, the board's preliminary opinion as regards the alleged technical effects of the distinguishing features (see point 6.3) is not apt to justify the change of the proprietor's appeal case. In its preliminary opinion, the board has departed from the technical effects as underlying the parties' submissions because it was not persuaded that those technical effects were directly and causally related to the technical features of the claimed invention over the whole breadth of claim 1. In order to determine the objective technical problem, the technical effects achieved by the distinguishing features must be assessed and it rests with the proprietor to properly demonstrate that the purported advantages of the claimed invention have successfully been achieved (see **G 2/21**, Reasons 26). The identification of the alleged technical effects are not to be left solely to the parties but are subject to an examination by the board. The mere fact that a new aspect was raised in the board's preliminary opinion is not sufficient by itself to acknowledge the presence of "exceptional circumstances" and to admit any new submission made in response thereto at any time. For the "amendment" to be regarded as a *legitimate* response to a new development, it needs to be related to the new aspects introduced in the course of the appeal proceedings. In other words, the inclusion of a new argument in the chain of arguments (such as the absence of a credible technical effect) leading to the finding of lack of inventive step does not open the door to the introduction of "amendments" whose content would have gone well beyond that needed to refute the new argument (see e.g. **T 1190/17**, Reasons 8 and **T 1869/18**, Reasons 3.10).

In the present case, the board's preliminary opinion raised concerns as to whether the alleged technical

effects associated with the distinguishing features would be credibly achieved over the whole scope of claim 1. As this aspect is only related to the distinguishing features and the scope of the claim, the board considers that contesting *other* claim features, which are not related to this line of reasoning, goes beyond what would have been required to counter the board's reasoning within the framework of the proprietor's appeal case. Therefore, contesting the disclosure of additional features is not considered to be a *legitimate* response to the doubts raised in the board's preliminary opinion as regards the alleged technical effects. The board also considers the point in time where the proprietor's response was filed not to be justified by "cogent reasons". The proprietor did not submit its response immediately after having received the board's preliminary opinion, but rather only nine months later, i.e. shortly before the date of the arranged hearing before the board. This however cannot be considered *legitimate* since it confronts the other party and the board at a very late stage of the proceedings with a "fresh case" that would have led the discussion in a completely different direction. This in turn runs counter to the principles of fairness and procedural economy.

- 3.3.7 The board does also not accept the proprietor's argument that the opponent's submissions in its statement of grounds of appeal were unclear. Rather, the board sides with the opponent's view that the attack regarding the lack of inventive step over document D2 was substantiated comprehensively in section 4.1.2.2 of the opponent's statement of grounds of appeal. If the proprietor could not escape the impression that the feature mapping addressed there was confusing, it should have expressed this concern

already in its written reply to the statement of grounds of appeal. The failure to do so cannot give rise to "exceptional circumstances" at this late stage.

3.3.8 The board also does not find the proprietor's argument regarding the "shift in focus" from document D1 to document D2 convincing. The opponent's statement of grounds of appeal clearly contained two distinct lines of attack: one starting from document D1 and another one starting from document D2 (see sections 4.1.2.1 and 4.1.2.2 of the statement of grounds of appeal). Thus, contrary to the proprietor's allegations, it was apparent that the objection under Article 56 EPC, based on D2 as a starting point, would be relevant in the appeal proceedings. Pursuant to Article 12(3) RPBA, the proprietor could have reasonably been expected to provide a *complete* response to both attacks at the outset of these appeal proceedings. In other words and as also noted in **T 217/23** (Reasons 14), parties must submit their full case as early as possible and not in a "piecemeal manner" depending on how the case develops. The board's preliminary opinion (cf. point 6.1) merely identified document D2 as a "*suitable starting point*" based on the submissions already on file. It did not introduce new evidence that would justify a newly focused defence. Hence, this alleged "shift" likewise cannot qualify as an "exceptional circumstance" justifying admittance of the specific amendment as made by the proprietor.

3.3.9 Moreover, the board finds that section 4.1.2.2 of the opponent's statement of grounds of appeal makes, *prima facie*, a convincing case that features (a) to (g) are indeed already disclosed in document D2. Therefore, the amendment to the proprietor's submissions regarding the newly contested distinguishing features is apparently

not *prima facie* relevant to the outcome of the decision.

3.3.10 As a consequence, in the absence of any "exceptional circumstances" justified with cogent reasons and in the interest of procedural economy, the board exercised its discretion under Article 13(2) RPBA not to admit the proprietor's amendment of its appeal case – i.e. that document D2 fails to disclose features (c), (e), (f) and (g) – into the appeal proceedings. Hence, the assessment of inventive step is to be based on distinguishing features (h) to (j) only.

#### 3.4 *Technical effect*

Regarding the technical effect achieved in view of **distinguishing features (h) to (j)**, the board observes the following:

3.4.1 According to the established case law of the Boards of Appeal (see e.g. **G 2/21**, Reasons 26; **T 1616/22**, Reasons 26; **T 449/23**, Reasons 2.5.6), it rests with the proprietor to properly demonstrate that the purported advantages or effects of the claimed invention are successfully achieved.

3.4.2 In its written reply to the statement of grounds of appeal, the proprietor maintained that the "indentation" as per features (h) to (j) inherently provided "*simpler routing and/or reduced size*" of the PCB, referencing paragraph [0006] of the opposed patent. Relying on **G 1/24**, the proprietor asserted in its written response to the board's communication under Article 15(1) RPBA that the skilled reader would interpret features (h) to (j), in particular the expression "*accommodating at least a part*", in the

light of the patent description to relate to an "indentation" that is dimensionally commensurate with the "first terminal", thereby ensuring that the technical effect of size reduction is credibly achieved. During the oral proceedings before the board, the proprietor further refined this line of argument, stating that the skilled reader would understand the term "indentation" as meaning a "*recess without going all the way through*" and that features (h) to (j) provided the technical effects of *reducing the physical size of the hearing aid* and ensuring a "*correct placement and alignment*" of the "antenna" mentioned in feature (e). Consequently, the proprietor formulated the objective technical problem as "*how to achieve a reasonably small size of the electrical assembly of the hearing aid while enabling a correct placement of the antenna on the PCB*".

3.4.3 The board is not persuaded that these alleged technical effects are *credibly achieved* by the claimed features over the whole scope of claim 1, for several reasons:

- As to the meaning of "credibility", the proprietor presented several definitions. In section 6.4.1.4 of page 62 in its letter of 15 December 2025, the proprietor asserted that "*[c]redibility typically evaluates whether a technical effect exists*". The board notes in this regard that the concept of "credibility" relates indeed to a verification of whether the alleged technical effects were *objectively* achieved by the claimed subject-matter.
- Regarding the reliance on **G 1/24**, the proprietor's argument is not based on an interpretation of the terms present in claim 1 but effectively seeks to read unwritten limitations into the claim which are

only disclosed as non-limiting examples in the patent description (see point 3.1.3 above). The skilled reader in the field of hearing aids would rather glean from the wording of present claim 1 and in the context of the opposed patent that the express wording "*accommodating at least a part*" mentioned in feature (j) is quite broad. The phrase "*at least a part*" does not define the size or geometry of the part that is actually accommodated nor its relation to the size of the "indentation". It does not require the "commensurate" fit or abutment that the proprietor alleges. As correctly argued by the opponent and discussed in detail at the hearing before the board, claim 1 also covers "laterally unconstrained" or "floating" embodiments where the *indentation* is significantly larger than the "first terminal" (e.g. a 2-mm-wide notch accommodating a 0.5-mm-wide terminal). In such embodiments, the "terminal" acts as a pendulum; it can be displaced laterally without ever contacting the sidewalls of the rigid PCB. Since claim 1 does not define the precise position of the "first terminal" within the "indentation" according to features (h) to (j), no "*correct placement*" can inherently be achieved in these embodiments. In this context, the board agrees with the proprietor that technically non-sensical embodiments are not encompassed by the scope of a claim. Yet, in the present case, it is not discernible, nor is the board convinced by the proprietor's allegation that those "laterally unconstrained" or "floating" embodiments would indeed be technically unreasonable. Already for this reason, the proprietor's reference to decision **T 814/20** is not persuasive.

- Furthermore, regarding the proprietor's reference to a "[correct] alignment", claim 1 does not require the "first terminal" to be parallel to the "PCB surface" or flush with its edge. As illustrated by the opponent during the hearing before the board, a "terminal" accommodated at a significant skew angle (e.g. 30 to 150 degrees) would still fall within the broad terms of the claimed subject-matter. Such a configuration would however contradict any alleged benefit of "alignment".
  
- Concerning the alleged "reasonably small size" of the respective hearing aid, the board identifies two distinct reasons why this effect is not credible over the whole scope claimed. First, claim 1 encompasses embodiments where the "indentation" as per features (h) to (j) is formed in a *raised portion* or a *protrusion* of the PCB. In such a configuration, the "first terminal", while accommodated in the "indentation", effectively sits at a level above the main surface of the PCB. Consequently, compared to a standard arrangement where the "terminal" is mounted directly on the main surface, the Z-height (i.e. the thickness) of the assembly is not reduced and could even be increased. Contrary to the proprietor's assumption, this configuration is not technically unreasonable. The proprietor argued in this respect that the claim language, the description and the figures of the opposed patent all pointed to a recessed "indentation" accommodating the "first terminal". This argument is however not persuasive since the claimed subject-matter only requires the "first indentation" accommodating "at least a part of" and not necessarily the *entire* "first terminal" (see

point 3.1.6 above). In as far as the proprietor relied on the patent specification in that context, the board reiterates that embodiments that are only disclosed in the patent description cannot limit the claimed subject-matter (see point 3.1.3 above). Secondly, creating an "indentation" at the PCB inherently reduces the available surface area of the PCB. As discussed during the oral proceedings before the board, if the "indentation" is angled or large (i.e. possibilities that are not excluded by claim 1 or by the patent description), the PCB might need to be enlarged in the X or Y dimension to compensate for the so-reduced board area required for other hearing-aid components. Thus, any potential gain in the Z-height could reasonably be negated by an increase in the assembly's footprint, and the overall physical size of the hearing aid would not necessarily be reduced.

- 3.4.4 Since the above-mentioned technical effects are not credibly achieved over the whole scope claimed, according to the jurisprudence of the Boards of Appeal relating to the application of the problem-solution approach, the next question would be whether a *less ambitious* technical effect or technical problem is achieved or solved in the present case (see e.g. **T 1841/11**, Reasons 7.6; **T 488/16**, Reasons 5.6).
- 3.4.5 However, the board could not discern which technical effect could in fact be credibly associated with features (h) to (j) over the whole scope claimed. While these features are without doubt *technical* in nature, it is not apparent to the board which concrete technical effect these features credibly achieve in the specific context of the claimed subject-matter (see also "Case (ii)" of **G 1/19**, Reasons 33).

3.5 *Obviousness*

3.5.1 In the absence of such a credible technical effect, the introduction of features (h) to (j) into the hearing aid of document D2 does not credibly contribute to solving a technical problem. In this regard, the board agrees with the opponent's submission that, as a matter of logic, if there is no technical effect, there is no technical contribution to the solution of a technical problem.

3.5.2 To explain this further in the light of the case law of the Boards of Appeal, and addressing the proprietor's extensive arguments as to the applicable terminology and methodology in that regard, the board notes that features providing no technical contribution are typically referred to as "*arbitrary features*" or, when viewed in the context of the change to the prior art, as "*arbitrary modifications*" of that prior art, which have generally to be considered *obvious* features.

3.5.3 In this respect, the board recalls that it is well-established jurisprudence of the Boards of Appeal (which is not limited to *non-technical* features) that, if a claim feature does not contribute to the solution of a technical problem, it may

(i) be *disregarded* right away in the assessment of inventive step without further qualification (see e.g. **T 37/82-3.5.01**, Reasons 3; **T 144/90-3.2.02**, Reasons 6.2; **T 574/92-3.4.01**, Reasons 1.5; **T 912/94-3.4.01**, Reasons 4; **T 15/97-3.3.01**, Reasons 4.10; **T 471/98-3.4.01**, Reasons 4; **T 1294/16-3.5.06**, Reasons 26.2; **T 687/22-3.5.05**, Reasons 2.3.4)

- (ii) be considered an *arbitrary feature* which cannot contribute to an inventive step (see e.g. **T 206/91-3.3.02**, Reasons 5.5; **T 15/97-3.3.01**, Reasons 4.10; **T 1009/12-3.2.07**, Reasons 2.7; **T 746/22-3.4.02**, Reasons 1.5; **T 1289/22-3.3.08**, Reasons 12; **T 1465/23-3.5.05**, Reasons 2.7)
- (iii) be considered a *non-functional feature* which cannot justify an inventive step (see e.g. **T 72/95-3.3.05**, Reasons 5.4; **T 158/97-3.3.05**, Reasons 2.3; **T 176/97-3.3.05**, Reasons 4.4; **T 2044/09-3.3.02**, Reasons 4.6; **T 885/20-3.5.05**, Reasons 5.6).

In particular, **T 176/97** (Reasons 4.4) emphasises that

"technically non-functional modifications are [...] irrelevant to inventive step, even if the skilled person would never think of such a modification"

and that

"if the modifications have no technical relevance and are, from a technical point of view, arbitrary, the new design is not patentable and does not involve an inventive step within the meaning of Article 56 EPC".

This principle has been consistently applied and was recently reaffirmed also by this board in decisions **T 287/23** (Reasons 2.8) and **T 1465/23** (Reasons 2.7 and 3.3.1), which clarify that, where no technical effect is credibly achieved over the whole scope claimed, the distinguishing features constitute merely an "*arbitrary modification of the prior art*" which can thus - as a matter of logic and as argued by the opponent - not contribute to an inventive step. This finding is also supported by the wording of Article 56 EPC itself which concerns non-obvious "inventions". In this respect, it needs to be stressed that an "invention" is not

supposed to be merely an *arbitrary* accumulation of "novel" features. Rather, an "invention" is typically characterised in that it provides a technical contribution to the state of the art. Hence, to establish an inventive step, the distinguishing features need to provide a technical contribution over the whole scope claimed. Accordingly, also in decision **T 72/95** (Reasons 5.4) it was held that

"[...] the notion of 'non-obviousness' is related to the concept of 'invention'. The concept of 'invention' implies a technical character. This follows directly from the wording of Article 56 EPC, wherein the expressions 'invention' and 'obvious' are linked with 'state of the art' and 'a person skilled in the art' [...] technically non-functional modifications are therefore irrelevant to inventive step, even if the skilled person would never think of such a modification."

3.5.4 The board notes in passing that the above conclusions are apparently also endorsed by national courts such as

- the German Federal Court of Justice (BGH) in its decision of 13 June 2023 - *Schlossgehäuse* (see BGH X ZR 51/21, headnote a): "*Eine erfinderische Tätigkeit kann nicht auf ein Merkmal gestützt werden, das eine beliebige, von einem bestimmten technischen Zweck losgelöste Auswahl aus mehreren Möglichkeiten darstellt.*" (board's emphasis)
- the UK High Court in *Sandvik IP AB v. Kennametal* [2011] (see point 185: "*An arbitrary selection from the prior art is not inventive, regardless of the field.*").

3.5.5 Hence, as features (h) to (j) do not credibly contribute to the solution of a technical problem over the whole breadth of claim 1, they are considered to be

*non-functional* or *arbitrary* features and thus to be obvious within the meaning of Article 56 EPC.

3.5.6 The proprietor's argument that "*if a feature does not solve the technical problem, the skilled person would not be motivated to adopt it. This lack of motivation supports inventiveness rather than obviousness*" plainly uncovers that applying such a logic would reward misconceptions, drawbacks or serendipity merely because the skilled person would not adopt them, and would thus jeopardise the concept of "invention" and "inventive step".

3.6 The board therefore agrees with the opponent that, contrary to the finding of the opposition division set out in Reasons 7 of the appealed decision, the subject-matter of claim 1 as granted does not involve an inventive step. Hence, the ground for opposition under Article 100(a) in conjunction with Article 56 EPC prejudices the maintenance of the patent as granted.

4. *Auxiliary requests 1 to 3: admittance (Article 13(2) RPBA)*

4.1 The proprietor filed **auxiliary requests 1 to 3** with its letter dated 15 December 2025, i.e. *after* the notification of the board's communication under Article 15(1) RPBA and one month before the date on which the oral proceedings before the board were originally scheduled (cf. point III above).

4.2 These claim requests constitute an "amendment" of the proprietor's appeal case pursuant to Article 13(2) RPBA. According to this provision, any "amendment" to a party's appeal case shall, in principle, not be taken into account unless there are "exceptional

circumstances", which have been justified with cogent reasons by the party concerned.

4.3 The proprietor argued that these auxiliary requests should be admitted because they were a direct response to "*concerns raised for the first time by the board*" in the board's communication under Article 15(1) RPBA, specifically regarding the *dimension* and *form* of the claimed "indentation". It suggested that the timing of the filing was necessitated by the board's preliminary opinion and maintained that filing new submissions one month before the hearing constituted "ample time" and adhered to a "customary practice".

4.4 However, the board cannot recognise the presence of "exceptional circumstances" within the meaning of Article 13(2) RPBA in the present case.

- First, the board's preliminary opinion addressed an existing inventive-step attack applying the problem-solution approach to the claims as granted. The board's observation that the broad wording "*accommodating at least a part*" used in feature (j) failed to achieve a technical effect over the whole scope claimed was a standard assessment of the causal link between the claimed features and the alleged technical problem. Such an assessment is necessarily required (see again **G 2/21**, Reasons 26: "*[...] in order to determine the objective technical problem, the technical results and effects achieved by the claimed invention as compared with the closest prior art must be assessed*") to ensure that the determination of the alleged technical effects is not left to the parties alone but is subject to an examination by

the board.

- Secondly, regarding the timing, the board emphasises that the preliminary opinion had been issued nine months before the hearing. Waiting eight months to respond and filing amendments only one month before the date on which oral proceedings were originally scheduled, is contrary to the requirement of procedural economy and cannot be regarded as a legitimate response. Contrary to the proprietor's argument, it is neither discernible, nor has it been argued for which specific reasons the proprietor was indeed deprived of the ability to submit the amended claim requests at an earlier stage of the proceedings, i.e. at least shortly *after* having received the board's communication under Article 15(1) RPBA, such that the opponent would have had enough time to consider the arguments and to prepare a corresponding reply. Moreover and as clarified during the hearing before the board, there is no "*customary practice*" in appeal proceedings that would grant a party the right to have submissions that are filed one month before the oral proceedings automatically admitted into the appeal proceedings. The proprietor was not able to give a single example that could underpin such an alleged "*customary practice*" which would anyway contradict the provision of Article 13(2) RPBA.

4.5 Furthermore, *prima facie* allowability (as mentioned in Article 13(1) RPBA) is also a relevant criterion which can be applied when exercising a board's discretion with respect to amendments submitted at the third level of the convergent approach governed by Article 13(2) RPBA. Hence, even if the board were to consider

auxiliary requests 1 to 3 in these proceedings, the amendments underlying these auxiliary requests are not *prima facie* allowable at least under Article 56 EPC since they fail to overcome the inventive-step objection raised against the main request in point 3 above and even give rise to new objections for the following reasons.

4.5.1 Auxiliary request 1 - claim 1 - feature (k): *dimensions of the "indentation"*

Added **feature (k)** of present claim 1 specifies a "*maximum depth of 1 mm*" and a "*width of 2 mm to 8 mm*" for the "first indentation". This amendment defines the dimensions of the "hole" (i.e. the "indentation") but remains silent on the dimensions of the "peg" (i.e. the "first terminal") accommodated therein.

- Regarding inventive step (Article 56 EPC), the board notes, referring to point 3.4.3 above, that, absent any specification of the width of the "first terminal" relative to the "indentation", claim 1 still covers embodiments where a "narrow" terminal (e.g. 0.5 mm) is placed in a much "wider" indentation (e.g. 7.5 mm). In such embodiments, there is however no mechanical support or "snug fit". Furthermore, claim 1 allows for the "first terminal" to be significantly longer than the "indentation", meaning that it could in fact protrude significantly. Thus, the dimensions specified in feature (k) are merely *arbitrary* values that cannot guarantee the alleged technical effect of *size reduction* over the whole scope claimed.

- Moreover, concerning clarity (Article 84 EPC), the opponent rightly pointed out during the hearing before the board that the term "*maximum depth*" according to feature (k) introduces ambiguity, potentially covering a ramped depth ranging from, for instance, 0.01 mm to 1 mm, the technical contribution of which being unclear in the context of a 3D-structure.

4.5.2 Auxiliary request 2 - claim 1 - feature (l): *negative limitation regarding "raised portion"*

Added **feature (l)** of present claim 1 specifies that "*the indentation is not located on a raised portion of the PCB*".

- Even with this negative limitation, the board's concern regarding the breadth of the expression "*at least a part*" according to feature (j), as set out in point 3.4.3 above, still applies. The "first terminal" can still "dangle" loosely or protrude significantly from an "indentation" located on a non-raised portion. Thus, the amendment underlying feature (l) does not establish a credible technical effect over the whole scope claimed, either. Consequently, *prima facie*, no inventive step can be acknowledged (Article 56 EPC).
- Moreover, the opponent convincingly argued at the hearing before the board that the present auxiliary request constituted a "random" attempt, i.e. a "*pick and mix*", to address isolated concerns, and noted that the proprietor had conceded in writing that there was no direct and unambiguous disclosure for feature (l) in the underlying application as

originally filed (Article 123(2) EPC).

- Lastly, the board also recalls that a negative limitation in a claim (i.e. a "disclaimer") is generally not allowable if the necessary limitation can be expressed in simpler terms using positive, originally disclosed features (see **G 1/03**, Reasons 3). When asked by the board during the hearing before it why a positive limitation was not introduced, the proprietor provided no substantiated justification for resorting to such a negative limitation.

#### 4.5.3 Auxiliary request 3 - claim 1 - feature (m): "solder"

Present claim 1, by virtue of **feature (m)**, specifies that the first electrically conductive material is "solder".

As the opponent argued during the oral proceedings before the board, "solder" is a standard, well-known material in the art. Hence, its selection is an *arbitrary choice* from known, equally likely alternatives and provides no synergistic effect linked with the "indentation" in accordance with features (h) to (j) that would, *prima facie*, contribute to an inventive step (Article 56 EPC).

- 4.6 As a consequence, the board exercised its discretion not to admit auxiliary requests 1 to 3 into the appeal proceedings (Article 13(2) RPBA).

#### 5. *Objections under Rule 106 EPC*

During the oral proceedings before the board, the proprietor raised two objections under Rule 106 EPC

alleging a violation of its right to be heard under Article 113(1) EPC.

5.1 *First objection*

5.1.1 The **first objection under Rule 106 EPC** has the following text (transcribed from the original handwritten text by the board):

*"We formally raise an objection pursuant to R. 106 EPC, in relation to Art. 113's right to be heard, and Art. 112a(2)(c).*

*As Art. 113 requires an opportunity to present our core arguments, prohibiting to admit elaborations of existing arguments of the parties is a violation of the right to be heard.*

*Adding details to an existing argument is not a new argument under Art. 13 RPBA. The matter of the distinguishing features of claim 1 over D2 is a core part of the dispute, and a natural extension of earlier arguments. Further, these elaborations and developments of the argument are in response to the preliminary opinion of the Board of Appeals [sic] shifting the focus of the dispute from D1 to D2.*

*We also note that the written submissions were made in a timely manner, one month before oral proceedings, which has been the customary time for filing written submissions to the Board of Appeals [sic]. A change to this customary deadline would be a surprising change to procedure. We also note that allowing written submissions after the preliminary opinion is crucial to preserving the right to be heard."*

5.1.2 Hence, the first objection under Rule 106 EPC concerns the board's decision not to admit the proprietor's submission invoking the presence of additional distinguishing features (i.e. features (c), (e), (f) and (g): see point 3.3 above and the minutes of the oral proceedings before the board, page 3/8, third paragraph) over the disclosure of document D2. In that context, the proprietor argued that its submission was merely an "elaboration" or "continuation" of its existing appeal case, that the focus on document D1 in the opponent's statement of grounds of appeal had been shifted to document D2 in the board's preliminary opinion and that this shift justified the filing of new submissions within a "customary" one-month deadline prior to the date for oral proceedings before the board.

5.1.3 The board dismissed the first objection based on the following grounds:

(a) The first objection is unfounded as it effectively aims to achieve a review of the criteria to be applied for exercising a board's discretion as to admittance of late-filed submissions. Rule 106 EPC, however, relates only to *procedural* defects. As to matters concerning the admittance of late-filed submissions, the right to be heard is generally safeguarded if the party concerned has had sufficient opportunity to express itself, if the board weighed the relevant criteria and considered the parties' relevant arguments (see e.g. **R 4/22**, Reasons 2.1; **R 11/11**, Reasons 8; **R 6/17**, Reasons 3.1; **R 6/20**, Reasons 3.1.2).

(b) In the present case, the proprietor's right to be heard was not violated because, at the oral

proceedings before the board, the relevant issues as regards admittance were clearly announced by the board and discussed with the parties. The discussion of admittance issues under Article 13(2) RPBA included in particular the question whether the new submissions were to be considered as an "amendment" of the proprietor's appeal case, whether "exceptional circumstances" were present and whether the submissions were *prima facie* relevant (see minutes of the hearing before the board, page 2/8, last paragraph to page 3/8, second paragraph). In this respect, the parties had ample opportunity to present their comments and did so. Moreover, as set out in point 3.3 above, the board's conclusions are based on the relevant provisions of the RPBA, on established criteria relevant for exercising the board's discretion as regards admittance of late-filed submissions and on the consideration of the parties' arguments.

- (c) The proprietor's argument that not accepting the alleged "*customary time limit*" for filing new submissions one month in advance of the oral proceedings would be a "*surprising change to the procedure*" cannot substantiate a procedural violation either. Firstly, upon being questioned by the board at the oral proceedings before it, the proprietor could not provide any factual basis for the alleged "*customary time or deadline*". Secondly, in as far as the proprietor's surprise might have been caused by ignorance of the relevant provisions of the RPBA, namely Article 13 RPBA here, such a subjective surprise does not imply that the right to be heard had been violated (see e.g. **R 6/17**, Reasons 3.12; **R 5/16**, Reasons 19).

5.2 *Second objection*

5.2.1 The **second objection under Rule 106 EPC** has the following text:

*"We formally raise an objection pursuant to Rule 106 EPC, in relation to Art. 112a(2)(c) as a violation of out [sic] Art. 113 right to be heard. As Art. 113 requires an opportunity to meaningfully respond to arguments. The idea of credible technical effect and the absence of an objective technical problem was initially raised by the Board of Appeals [sic] briefly in its preliminary opinion, and did not form part of the arguments of the proceedings prior to the preliminary opinion. Nor was the reasoning in the preliminary opinion sufficiently detailed to permit a real response. The opponent for the first time in oral proceedings provided some arguments on the matter, but they simply stated that as there was no credible technical effect, there was no objective technical problem. Again, the lack of detail in the allegations means that it cannot be refuted.*

*Throughout the course of the proceedings, the Board has been very focused in guiding the discussion. During oral proceedings, we engaged in a constructive dialogue regarding possible objective technical problems, including one proposed by the Board. We therefore found it unexpected when the Board's decision concluded that the proposed objective technical problems were not valid and that no objective technical problem could be established.*

*Surprised, we requested that proceedings be re-opened to address the issue, particularly as*

*there had been no opportunity to comment on the application of G 1/19 to purely technical matters rather than mixed type invention. The Board declined.*

*We also note that that Board did not explain its decision, merely instructing us to read a case law section. We invited them to elaborate on their decision making, and they declined. Mere reference to jurisprudence cannot substitute for legal decisioning, and therefore, as do not have the opportunity to understand the Board's legal reasoning, we do not have the opportunity to comment on the matter.*

*We also note further that the Board has not addressed the issue of what they mean by credibility. As their definition in the preliminary opinion departs from the established 'plausibility' standard in G 2/21, it would not be possible for us to comment without further elaboration on their reasoning.*

*Therefore, our right to be heard has been violated."*

- 5.2.2 It follows from the above that the second objection under Rule 106 EPC essentially relies on an alleged violation of the right to be heard pursuant to Article 113(1) EPC which provides that decisions may only be based on "grounds or evidence" on which the parties concerned had an opportunity to present their comments. In that context, the expression "grounds or evidence" is conventionally understood as being the essential legal and factual reasoning on which a decision is based (see e.g. **R 5/22**, Reasons 9). The

proprietor contended in essence that it was surprised by the board's assessment regarding the "*credible technical effect*" and the related conclusion that no objective technical problem could be formulated. It further asserted that it was unable to meaningfully respond to what they termed a "*novel doctrine*" or "*departure from G 1/19*" and that the board had failed to explain its reasoning. Moreover, regarding the aspect of "*credibility*", the proprietor alleged that the board's definition of this term in its preliminary opinion departed "*from the established 'plausibility' standard as explained in G 2/21*" and that it was not possible for the proprietor to comment without further elaboration on the board's reasoning.

5.2.3 The board dismissed this second objection based on the following grounds:

- (a) The right to be heard is observed if a party had the opportunity to present its arguments on all decisive aspects of the case in issue, i.e. to comment on the decisive considerations relating to the case. This principle also applies to the application of the problem-solution approach (see **R 5/16**, Reasons 18 and 19). In that regard, the requirement of Article 113(1) EPC is fulfilled if - as in the present case (see minutes of the hearing before the board, page 3/8, last paragraph to page 4/8, first paragraph) - there had been a discussion of (i) the relevant prior art, (ii) the differences between the prior art and the claimed invention, and (iii) the technical relevance of these differences (as to these aspects, see **R 8/19**, Reasons 7). Moreover, it is settled case law that parties are not entitled to advance indications of all reasons for a decision in detail since this is

part of the reasoning provided retrospectively in the written decision.

- (b) The proprietor also indicated that the absence of a credible technical effect achieved over the whole scope claimed was initially raised by the board and not by the opponent. It is however not discernible that this would in any manner violate the proprietor's right to be heard. Rather, the respective technical effects are subject to an assessment to be conducted by the board. Hence, they have to be objectively established and are not to be left to the parties' submissions alone. Therefore, if the parties' respective submissions are not convincing, the board may introduce such an issue by itself into the proceedings and communicate its reservations to the parties. In fact, the board has informed the parties about the outcome of its preliminary assessment in its communication under Article 15(1) RPBA, which was issued nine months in advance of the oral proceedings before the board, and the matter of technical effects achieved was discussed in detail during the oral proceedings such that the parties' right to be heard was respected.

In view of the principles set out above, the arguments provided by the proprietor are not persuasive.

- 5.2.4 Moreover, the proprietor's arguments are partially also based on incorrect factual allegations.

- (a) First, the board's assessment that features (h) to (j) do not contribute to a "*credible technical effect*" was explicitly communicated to the parties in the board's communication under Article 15(1)

RPBA (see points 6.2 and 6.3). In particular, the board explained its reservations and provided examples of embodiments which were encompassed by the claimed subject-matter but did not credibly achieve the alleged technical effects. The proprietor therefore had sufficient opportunity to comment on this assessment and indeed availed itself of this opportunity by filing a 68-page response addressing these specific points. Furthermore, during the oral proceedings before the board, the opponent reiterated the board's assessment in this regard and the proprietor was given repeated opportunities to present its arguments to demonstrate that the alleged technical effect had been achieved over the whole scope claimed and to formulate a valid objective technical problem. The mere fact that the board did not accept the alleged technical effects and the proprietor's formulation of the objective problem does not constitute a violation of the right to be heard. As the opponent correctly stated during the oral proceedings before the board, the "*right to be heard*" cannot be equated with a "*right to succeed*".

- (b) Secondly, the proprietor's assertion that it was unaware of the board's approach or that this approach constituted a "*novel doctrine*", for which the preliminary opinion provided insufficient detail, is not correct and is refuted by the proprietor's own submissions. As demonstrated in point 3.5.3 above, the approach applied by the board for cases where the distinguishing features do not achieve a credible technical effect over the whole scope claimed is in line with the established jurisprudence of the Boards that is also summarised in the Case Law Book of the Boards of Appeal (see

*Case Law of the Boards of Appeal, 11th edition, section I.D.9.6*). Hence, as professional representatives are required to be familiar with the case law of the Boards of Appeal, including the methodology for assessing inventive step (see e.g. **R 4/09**, Reasons 2.3.3: "*ignorantia legis non excusat*"; **R 5/16**, Reasons 18), no further explanations other than those provided in writing and during the oral discussions were required in this respect. In addition, the proprietor was indeed aware of the jurisprudence applying some modified steps for the problem-solution approach. For example, the proprietor itself cited decision **T 1344/21** on page 57 of its letter of 15 December 2025, where the competent board did not acknowledge any technical effect associated with the distinguishing features over the whole range claimed, but nevertheless formulated an objective technical problem and then classified the features as "*arbitrary*" due to their lack of a credible technical effect and therefore concluded that these features did not contribute to an inventive step (see **T 1344/21**, Reasons 7.4.1 to 7.4.3). Hence, the proprietor was well aware of decisions applying the problem-solution approach in that way. In this context, the board also notes that on page 58 of the letter dated 15 December 2025, the proprietor explicitly listed six decisions of this board, i.e. Board 3.5.05, and one decision of Board 3.5.03 to support its argument that the "*No credible technical effect' approach in recent cases is unique to Board 3.5.05*". This prominently demonstrates that the proprietor was fully aware of the board's consistent jurisprudence and the legal principles applied. Furthermore, one of the proprietor's two professional representatives was

involved in a recent appeal case before this board (i.e. **T 1465/23**) where exactly the same legal principles regarding the "*credibility of technical effects*" were discussed in detail, and where the board provided a detailed reasoning in its written decision citing a large number of decisions in that respect. Consequently, the allegation that the proprietor was surprised by the board's assessment due to a lack of detail is factually untenable.

(c) Thirdly, the second objection under Rule 106 EPC contained several factual misrepresentations which were already pointed out by the board during the oral proceedings before it (see minutes of the hearing before the board, page 5/8, fifth paragraph):

1) Contrary to the proprietor's allegation, the board did not propose a *binding* objective technical problem but rather invited the proprietor, in its favour, to formulate one based on the alleged technical effects it relied upon. The initial problems proposed by the proprietor were not consistent with the purported technical effects it had relied upon. Therefore, in the course of the hearing before the board, the board asked for clarification, without however indicating that it would adopt one of the problems indicated by the proprietor during the discussion or the problem finally relied upon by the proprietor. Rather, the board conducted the required legal assessment and sought to clarify the vague technical effects asserted by the proprietor who was explicitly reminded by the board that the burden to demonstrate that the purported effects were

indeed achieved over the whole scope claimed lay upon the proprietor. In this context, the proprietor was free to answer the board's questions as it saw fit, to present its arguments as regards the alleged technical effects as well as the application of the problem-solution approach, and it also had ample opportunity to rebut the board's and the opponent's arguments provided in this respect.

- 2) The proprietor's insinuation that the "*opponent provided some arguments on the matter, but they simply stated that as there was no credible technical effect, there was no objective problem*" is not correct, either. Rather, the opponent presented detailed and extensive arguments to counter the presence of the alleged technical effects. In particular, it identified specific embodiments (including those presented during the hearing before the board via drawings on a flip chart) as being encompassed by the claimed subject-matter, and explained why the alleged effects would not be achieved in this respect. These embodiments were discussed in detail by both parties. The fact that those aspects had been discussed during the oral proceedings was also explicitly confirmed by the proprietor (see the respective confirmation indicated in the minutes of the hearing before the board, page 4/8, last paragraph).
- 3) Furthermore, regarding the alleged deviation of the board's way of assessing inventive step from decision **G 1/19**, the request to discuss **G 2/21** and the "correct" application of the problem-solution approach, the proprietor had

already addressed these points extensively in writing and had sufficient opportunity to present further arguments during the oral proceedings before the board. As can be seen from the reasons above (see in particular points 3.4 to 3.6), the respective arguments were considered by the board but not found to be convincing. In view of the board's preliminary opinion and the discussion during the oral proceedings, including the arguments set out by the opponent, neither the board's assessment nor the conclusion as regards lack of inventive step can (objectively) be regarded as a "surprise" that would have required further explanations in advance. Rather, the board's conclusion as regards lack of inventive step as to granted claim 1 was based on the legal and factual framework as presented by the parties in writing, in the board's preliminary opinion and during the discussion at the oral proceedings where the proprietor had ample opportunity to provide its comments. The outcome was thus not unexpected but in fact objectively foreseeable.

- 4) Contrary to the proprietor's allegation that the board "*declined to explain*", the chair of the board did indeed provide an explanation of *why* the distinguishing features failed to solve the technical problem proposed by the proprietor (i.e. the lack of limitations ensuring a "*correct placement and alignment*"). Moreover, already from the board's preliminary opinion and the opponent's arguments, including the discussion of the drawings on the flip charts (showing various embodiments covered by the claimed subject-matter), it was clearly

derivable for a reasonable, objective and informed person that the credibility of the alleged technical effects was at stake due to the breadth of the claimed subject-matter.

Despite being confronted with these incorrect assertions during the hearing before the board, the proprietor did not provide any arguments to substantiate its allegations or refute the board's clarification as set out in the minutes of the hearing (see page 5/8, fifth paragraph).

5.3 *Referral of questions to the Enlarged Board of Appeal*

5.3.1 The proprietor requested that three questions be referred to the Enlarged Board of Appeal regarding the application of the problem-solution approach (see point III above). Specifically, the proprietor argued that the board's conclusion, i.e. that no objective technical problem could be formulated if no technical effect was credibly achieved, constituted a "new take" that deviated from the principles established in **G 1/19** and **G 2/21** and that this was a doctrine "*unique to Board 3.5.05*".

5.3.2 Pursuant to Article 112(1)(a) EPC, the board shall refer a question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure a "*uniform application of the law*" or if a "*point of law of fundamental importance*" arises. The requirement to ensure a "*uniform application of the law*" is met if in a particular case the board deems it necessary to deviate from the interpretation or explanation of the EPC contained in another decision of a Board of Appeal, or if there are diverging decisions

of different Boards.

5.3.3 In the present case, a referral of **questions 1 to 3** to the Enlarged Board of Appeal is not required, neither to ensure a *uniform application of the law* nor in view of a *point of law of fundamental importance*. The board does also not deviate from an interpretation or explanation contained in a decision of the Enlarged Board of Appeal within the meaning of Article 21 RPBA, for the reasons set out below.

5.3.4 *Question 1 - alleged deviation from the conventional problem-solution approach*

First of all, the proprietor did not substantiate that a referral would be required to ensure a uniform application of the law. In particular, the proprietor's assessment of inventive step is based on four approaches as identified by itself in sections 1.3.1 to 1.3.4 of its letter dated 15 December 2025. This assessment is based on the assumption that the distinguishing features of the claimed subject-matter vis-à-vis document D2 were indeed apt to provide a credible technical effect. Since this assumption is - as set out in point 3.4.3 above - not correct, it cannot serve as a basis to demonstrate that the outcome of the present case would depend on the respective approaches identified by the proprietor. For the same reasons, decisions **T 1628/22** and **T 969/23**, which were cited by the proprietor, cannot demonstrate that the use of *different* approaches would result in *different* conclusions, as also in those decisions it was acknowledged that a technical effect was indeed achieved (see **T 1628/22**, Reasons 4.2 and **T 969/23**, Reasons 2.2.4).

Furthermore, question 1 is based on the assumption that the board had created its "own approach" for the application of the problem-solution approach. This is however not correct. Rather, as set out above (see point 3.5.3) and further illustrated in the following, it is established case law of the Boards of Appeal that subject-matter that is distinguished over the prior art only by *arbitrary* or *non-functional* features, which do not contribute to a technical effect over the whole breadth of a claim, cannot be considered to involve an inventive step (see again the *Case Law of the Boards of Appeal, 11<sup>th</sup> edition, section I.D.9.6*, including numerous citations of decisions in that respect). Hence, the board's assessment cannot be regarded as an unexpected or unknown alteration of fundamental standards that could give rise to legal uncertainty as indicated by the proprietor. As set out in point 3.5.3 above, some boards terminate the problem-solution approach immediately after having established the lack of a credible technical effect, other boards continue the assessment based on a "*less ambitious*" objective problem (i.e. providing an alternative or a further solution), without however necessarily reaching a different conclusion. Rather, also these Boards finally held that an inventive step could not be acknowledged on the basis of *arbitrary* or *non-functional* features which do not contribute to the solution of a technical problem. Thus, despite some variations in the steps applied within the framework of the problem-solution approach, the conclusions are identical such that a referral on this matter is not required. In this respect, the board agrees with the proprietor that the "*problem-solution approach occupies a central position within this system, serving as the framework within which other legal doctrines - such as the assessment of technical character under the COMVIK approach, the*

*evaluation of the technical effects, the formulation of the objective technical problem, and the application of the could-would approach - operate and interact with one another*". Accordingly, also the UPC recently held that the different *approaches* applied in the EPO and the EPC Contracting States were just *guidelines* to assist in assessing inventive step and should - if properly applied, generally lead to the same conclusion (see UPC\_CoA\_464/2024, fifth headnote). In view of this, the existence of slight variations in applying the problem-solution approach as such would not be sufficient to establish that there is no "*uniform application of the law*" in this regard.

The proprietor further argued that the so-called "*no objective technical problem*" approach was unique to present Board 3.5.05 and that this "divergence" resulted in procedural unfairness, as it effectively made the applicable legal standard a matter of chance depending on the assignment of an appeal case to a Board of Appeal. This argument is unconvincing, either. While different Boards of Appeal may apply the problem-solution approach with slight variations depending on the specifics of the case at hand, the core principle - i.e. that *arbitrary modifications* are obvious and cannot support an inventive step - is a fundamental tenet of the case law applicable across diverse technical fields. As evidenced by the decisions cited in point 3.5.3 above, this principle is applied by the Boards across all technical fields, namely *mechanics, chemistry, physics and electricity*. Consequently, it goes without saying that the approach is not unique to Board 3.5.05. Furthermore, the proprietor itself provided a list of decisions, including **T 687/22** and **T 287/23**, which clearly articulate the legal reasoning behind this board's

practice. By doing so, it demonstrated that the present board consistently adhered to the principle that a technical effect must be credibly achieved over the whole scope claimed. Far from creating uncertainty, this consistency ensures that parties know exactly which legal standard applies: *a technical effect must be credibly achieved to be taken into account*. The fact that the proprietor disagrees with the outcome of this approach does not elevate the matter to a *point of law of fundamental importance*.

5.3.5 However, regardless as to whether the ("correct") application of the problem-solution approach is a method or guideline rather than a matter of application of the law, i.e. Article 56 EPC, it is settled case law that, if - as in the present case - a Board of Appeal is itself able beyond doubt to answer the questions to be referred to by reference to the EPC and the established jurisprudence, there is no need to refer those questions to the Enlarged Board of Appeal in order to clarify a "*point of law of fundamental importance*" (see e.g. **J 5/81**, Headnote 2; **T 198/88**, Reasons 2.3; **T 466/20**, Reasons 8.1). Since the board answered the questions as regards inventive step based on established principles derived from the settled case law of the Boards of Appeal (see point 3.5.3 above), there is indeed no need to refer questions for further clarification purposes.

5.3.6 *Question 2 - alleged deviation from decision G 1/19*

The proprietor argued that **G 1/19** affirmed the "*conventional*" *problem-solution approach* and that the so-called "*no objective technical problem*" *approach* was restricted solely to mixed-type inventions (i.e. to the

application of the well-established *COMVIK* approach).

Yet, contrary to the proprietor's assertion, the board does not deviate from decision **G 1/19**. In that regard, the board observes that **G 1/19** does not mandate the formulation of an objective technical problem in the absence of a credible technical effect. In other words, it is entirely silent as to a formal obligation to always and in any case frame an objective technical problem. Thus, in particular the second question blatantly demonstrates the proprietor's misconception as regards the application of the problem-solution approach at the EPO. The so-referred *no objective technical problem approach* neither relies for authority solely on **G 1/19** nor is inspired by it. Instead, the conclusions drawn in **G 1/19**, Reasons 49, constitute the inevitable consequence and confirmation of the established jurisprudence as regards the application of the problem-solution approach, as initially conceived at the EPO in the early 1980s (see **T 1/80**, Headnote I and **T 24/81**, Reasons 4) and summarised in **T 641/00** (see e.g. Reasons 5: "*as a test for whether an invention meets the requirements of Article 56 EPC the Boards of appeal have developed and applied a method known as the 'problem-and-solution approach' [...] according to which an invention is to be understood as a solution to a technical problem*"; this board's emphasis).

Concerning the proprietor's query as to where the "guidance" for the board's *no objective technical problem approach* can be found, if not in **G 1/19**, the board pointed to the established jurisprudence of the Boards of Appeal as set out in *section I.D.9.6 of the Case Law of the Boards of Appeal (11th edition, July 2025)*.

For example, **T 574/92-3.4.01** (Reasons 1.5) concluded

that, according to the established case law of the Boards of Appeal,

*"features which do not contribute to the solution of the problem set in the description, are not to be considered in assessing the inventive step of a combination of features".*

The same or similar conclusions can be found in other decisions cited in that section, such as (board's emphasis):

- **T 144/90-3.2.02** (Reasons 6.1; see point 3.5.3(i) above):

*"Ein darüber hinausgehender unvorhersehbarer Effekt, der einen Hinweis auf das Vorliegen einer erfinderischen Tätigkeit geben könnte, konnte von der Beschwerdeführerin nicht benannt werden und ist auch für die Kammer nicht erkennbar. [...] Der Gegenstand des Patentanspruchs 1 [...] beruht somit nicht auf einer erfinderischen Tätigkeit."*

- **T 206/91-3.3.02** (Reasons 5.5; see point 3.5.3(ii) above):

*"Consequently, the oxidizing conditions mentioned in combination with these two particular thickness values are nothing else than a series of arbitrary features because it is not credible that they contribute to the solution of the underlying technical problem. The said features are therefore of no relevance for the question of inventive step"*.

- **T 15/97-3.3.01** (Reasons 4.10; see point 3.5.3(i) above):

*"Gemäß der Rechtsprechung der Beschwerdekammern bleibt ein Merkmal, das nicht erfindungswesentlich ist im Sinne, daß es zur Lösung der gestellten Aufgabe beiträgt, bei der Beurteilung der erfinderischen Tätigkeit außer Betracht"*.

- **T 158/97-3.3.05** (Reasons 2.3; see point 3.5.3(iii) above):

"Likewise, a technically non-functional modification cannot render a known device inventive."

- **T 294/89-3.4.01** (Reasons 6.2):

"Moreover, said additional feature provides no surprising advantage and, above all, it does not make any contribution to solving the problem [...]. Hence, said additional feature [...] is not relevant for assessing the inventive step of the combination of features [...]".

In addition, the board refers to **T 746/22-3.4.02** (Reasons 1.5, referencing **T 176/97-3.3.05** mentioned in point 3.5.3 above), which found that

"if the distinguishing feature of a claim has no effect of technical relevance on the claimed subject-matter and does not credibly solve an objective technical problem, then no inventive step can be based on it".

Moreover, in **T 1415/11-3.5.01** (Reasons 8), a similar principle was adhered to, where the board held the following:

"Thus, the limitations in claim 1 [...] do not have any technical contribution. Even if this choice made a technical contribution, [it] would for this reason be an arbitrary feature, which cannot have any positive implications for inventive step".

Consequently, the board's approach is a consistent application of the acknowledged principle that a patentable invention requires a technical contribution (see e.g. **T 471/98**, Reasons 4.1; **T 1009/12**, Reasons 2.7; **T 1294/16**, Reasons 26.2; **T 885/20**, Reasons 5.6, where no objective technical problem could be formulated, i.e. corresponding to the so-framed no

*objective technical problem approach*). This approach is therefore neither based upon a misinterpretation of the EPC (i.e. Article 56 EPC) nor irreconcilable with the jurisprudence of the Boards of Appeal. Furthermore, **G 1/19**, Reasons 49, states that

*"[w]hether a simulation can solve a technical problem by producing a technical effect which goes beyond the simulation's implementation on a computer, can be understood only in the context of the COMVIK approach. Starting from the closest prior art, the invention has to fulfil these criteria (or have 'technical character') to qualify as a technical invention. The features distinguishing the **claimed invention** from the closest prior art need to contribute to such technical character in order to be considered under Article 56 EPC. If the **invention** does not solve a **technical problem**, it has no **distinguishing features** which could contribute to inventive step" (board's emphasis).*

Although, in the above passage, the terms "*simulation*" and "*technical character*" indeed obviously relate to computer-implemented simulations, the terms "*invention*", "*distinguishing features*" and, above all, "*technical problem*", as used in its last sentence, apparently applies to all claimed "inventions" and not only to computer-implemented inventions, i.e. mixed-type inventions having technical and non-technical features and being subject to the application of the mentioned *COMVIK approach*. In other words, said last sentence virtually means that, if a claimed (technical) "invention" with its totality of claim features, i.e. a claim having technical character as a whole under Article 52(1) EPC, cannot solve any (objective) "technical problem", then there cannot be any inventive step, and, as a corollary, there is then effectively no "distinguishing feature" of that claim which may contribute to an inventive step within the meaning of Article 56 EPC. In that regard, the

proprietor obviously jumbles up the general statements on the application of the *conventional problem-solution approach* provided in **G 1/19** (see e.g. Reasons 26 and 82, even citing a chemistry case **T 939/92**) and in **T 641/00** underlying the *COMVIK approach* (see Reasons 5 and 6: "[...] where a feature cannot be considered as contributing to the solution of any technical problem by providing a technical effect it has no significance for the purpose of assessing inventive step") with the statements on its specific application to mixed-type inventions. Yet, as the opponent appositely indicated at the hearing before the board, if the claimed subject-matter does not solve any technical problem, it cannot be rewarded by a grant of a patent on the basis of that subject-matter (see in that regard also **T 1027/08**, Reasons 2.2.1, fourth paragraph: "[...] *Rechtsprechung, die auf dem nachvollziehbaren Grundsatz beruht, dass eine als nicht naheliegend beanspruchte Lösung nur dann die Patenterteilung rechtfertigen kann, wenn sie auch erzielt wird*").

#### 5.3.7 Question 3 - "credibility", "plausibility" and G 2/21

The proprietor alleged that the terms "credibility" and "plausibility" are applied inconsistently across Articles 52(2), 56 and 83 EPC, thereby creating legal uncertainty.

In that context, the board first notes that the Enlarged Board of Appeal has already addressed this issue in **G 2/21** (Reasons 92), stating that

*"the term 'plausibility' [...] does not amount to a distinctive legal concept or a specific patent law requirement under the EPC, in particular under Article 56 and 83 EPC. It rather describes a generic catchword seized in the jurisprudence of*

*the boards of appeal, by some national courts and by users of the European patent system".*

Hence, a decision of the Enlarged Board of Appeal which unmistakably emphasises that the concept of "*plausibility*" does not constitute a "legal concept" but only a "catchword" cannot lend itself to define or distinguish the concept of "*credibility*". This is even more so when considering that the latter term had been used for decades in the Boards' jurisprudence without any specific further qualification (see e.g. **T 37/82**, Reasons 3; **T 206/91**, Reasons 5.5; **T 939/92**, Reasons 2.6; **T 1009/12**, Reasons 2.7; **T 488/16**, Reasons 4.5; **T 746/22**, Reasons 1.5). Rather, the board's assessment in the present case regarding the concept of "*credibility*" relied on a standard verification of whether the alleged technical effects were *objectively* achieved by the claimed subject-matter in line with Reasons 25 of **G 2/21**. This verification is no doubt intrinsic to the problem-solution approach and does not constitute a divergence or uncertainty requiring a referral of questions to the Enlarged Board of Appeal pursuant to Article 21 RPBA.

5.3.8 In view of the above, this board is able beyond doubt to answer the questions posed by the proprietor by reference to the EPC and the established jurisprudence.

5.3.9 Hence, the board refused the request to refer the posed questions to the Enlarged Board of Appeal (Article 112(1)(a) EPC).

## Order

### For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated