T 163/85 and **T 190/94**, a technical effect **on a physical entity** in the **real world** was required. This was, however, not the case in **T 125/01** and **T 424/03**. In these decisions the technical effects were essentially confined to the respective computer programs.

The Enlarged Board of Appeal stated in Opinion **G 3/08** (OJ 2011, 10) that the case law of the boards of appeal as a whole is consistent in considering all the features that are claimed. The boards have always avoided approaches which involve weighting of features or a decision which features define the "essence" of the invention. It is true that the COMVIK/Hitachi (**T 641/00**, **T 258/03**) approach to deciding whether there is an inventive step may involve ignoring some features, but the method starts with a consideration of all the features together to determine whether the claimed subject-matter has a technical character. Only once this determination has been made can the board turn to the question of which claimed features contribute to that technical character and therefore should be taken into account for the assessment of whether there is an inventive step (see also **T 528/07**).

The Enlarged Board of Appeal went on and stated that it is in fact a well-established principle that features which would, taken in isolation, belong to the matters excluded from patentability by Art. 52(2) EPC may nonetheless contribute to the technical character of a claimed invention, and therefore cannot be discarded in the consideration of the inventive step. This principle was already laid down, albeit in the context of the so-called "contribution approach", in one of the earliest decisions of the boards of appeal to deal with Art. 52(2) EPC, namely **T 208/84**.

The second problem with the alleged divergence was that the decisions **T 163/85** and **T 190/94** said in the referral to require a technical effect on a physical entity in the real world, simply did not do so. They merely accepted this as something sufficient for avoiding exclusion from patentability; they did not state that it was necessary.

Dealing with this issue again in **G 1/19**, the Enlarged Board found as follows: beyond those considered in **G 3/08**, the referring board identified cases apparently requiring a technical effect directly linked to physical reality, but also others which suggested that a potential technical effect, i.e. an effect achieved only in combination with non-claimed features, was taken into account (**T 1351/04**, **T 625/11**, see points 36 and 37 of the reasons of **T 489/14** of 22 February 2019, OJ 2019, A86). Following existing case law and taking into account the relevant legal provisions, the Enlarged Board in **G 1/19** (OJ 2021, A77) did not see a need to require a direct link with (external) physical reality in every case. On the one hand, technical contributions might also be established by features within the computer system used. On the other hand, there were many examples in which potential technical effects - which could be distinguished from direct technical effects on physical reality - had been considered in the course of the technicality / inventive step analysis. While a direct link with physical reality, based on features that per se are technical and/or non-technical, was in most cases sufficient to establish technicality, it could not be a necessary condition, if only because the notion of technicality needs to remain open.