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Individualization – Where does it end?

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Fairly recent case law of the EPO suggests that the concept of individualized disclosure may reach further than many people think. This can have severe implications for the validity of patents and patent applications, especially in the field of chemistry and life sciences. In the following these decisions and their potential consequences are analyzed and some recommendations are given.

The concept of individualization, i.e. singling out a specific embodiment from a generic disclosure, in various instances is a key concept of the EPO for assessing the “quality” of disclosures. It is applied in the examination of novelty of selection inventions. If the features of the claim characterize an individualized embodiment, the claim is novel with respect to a generic prior art disclosure encompassing this embodiment. It is equally important for the comparison of claims with the disclosures of the application as filed or the priority document when examining added matter and entitlement to priority, respectively. A claim pertaining to an individualized embodiment contains added matter in respect of a generic original disclosure and it cannot validly claim entitlement to priority of a generic disclosure in the priority application. Of course, the situation is reversed if the claim and the respective other disclosure are both generic, or if both are individualized. The following tables summarize the different scenarios:



In the past, the author (and presumably other practitioners, too) relied on some simple rules when determining whether a contemplated amendment is “safe” in view of the risk of creating added matter or losing priority. For instance, it was considered that a single selection from a single list should be safe (relying on the *two lists theory* established in **T 12/81** and **T 7/86**), and that a shrinking of lists should also be safe, provided the majority of previously claimed embodiments is maintained in the amended claims (relying on **T 615/95**). In both cases it was thought that the amendment keeps the subject-matter of the amended claim at the same level of generality as in the claim before amendment, so that no individualization is created where there was none before.

The following decisions suggest that it may be time to reconsider whether such simple rules of thumb are generally applicable:

- The patent-in-suit in **T 98/09** was about compositions containing a fungicide in combination with an insecticide. During examination already, the main claim has been restricted to one single fungicide representing a member of a list of originally disclosed 47 individual fungicides. During opposition, the insecticide was restricted, starting from a generic formula (I) as granted, to all specific embodiments originally disclosed (i.e. 6 compounds). The Board held that the resulting

combination contains added matter in relation to the original disclosure. This finding was primarily based on the understanding that the 1×6 combination in the claim individualizes all six combinations claimed, while the original 47×6 combination was generic in nature. It is conspicuous that the reasons given by the Board would apply in exactly the same manner if the six specific insecticides had been present in the claim already at the time of filing, i.e. if only a single restriction of the claim had been effected.

- In **T 1808/08**, patentee amended a claim directed to a polymerization process by canceling four of the eight listed monomer types, and by deleting one of the three listed catalyst types. The Board found these deletions to give rise to a novel selection from the previous claim. In the absence of better support elsewhere, the amendment was not allowed. Whilst not being expressly stated in the reasons of the decision, it is apparent that the Board considered the 2×4 combination of the amended claim to individualize all eight combinations, whereas the previous 3×8 combination was apparently found to be a generic disclosure.
- **T 783/09** was in the field of pharmaceuticals. The claim at issue concerned a combination of a single dipeptidylpeptidase (“DPP”)-IV inhibitor with at least one of three listed antidiabetic agents. This feature combination was based on an original disclosure of preferred combinations of two DPP-IV inhibitors with 22 antidiabetic agents. The Board took the view that the amendment complied with Article 123(2) EPC mainly because all 44 combinations of the original disclosure were found to be disclosed in individualized form – just like the three combinations after the amendment.

The following table summarizes the rulings of the above decisions with respect to the concept of individualization.



The conclusions to be drawn from these decisions are:

- In some instances, an individualized disclosure may be created by a single selection.
- A presumed shrinking of lists risks may turn out to be an individualization of feature combinations even if only a minor part of the embodiments is deleted.
- An individualized disclosure may be found in (or created by) feature combinations covering far more than a simple 1×1 combination.

So, how may this affect our daily practice?

1. When **drafting** applications, it is recommended to expressly describe not only preferred and more preferred features, but also different combinations of such groups of preferred features. But beware, a mere listing of all conceivable permutations could be counterproductive if the total

number of listed combinations becomes too large: it has already happened in such cases that EPO examiners completely disregarded such disclosures of feature combinations as being of no technical significance.

2. When **amending** the claims – especially before grant – one should be even more careful not to delete alternative feature combinations from the claims if not strictly necessary in view of the raised objections.
3. When **defending** amended claims in opposition proceedings, **T 783/09** may prove to be helpful if there is a disclosure of a subgenus of comparable level of generality that could provide support for an amended claim.
4. When **attacking** in opposition proceedings, all of the above decisions may provide good ammunition for denying novelty by selection. Depending on the circumstances, these decisions may also be useful for attacking amendments, especially if they were justified by patentee as being a mere shrinking of lists in accordance with **T 615/95**.

Of course, each case is different and a variety of further factors will also have to be considered, such as the information content in the examples or the presence or absence of technical effects associated with the selection. Hence, the applicability of the above case law and conclusions should be checked on a case-by-case basis. Moreover, it is clear that there are many other decisions of the EPO, which apply different standards. Keeping the above decisions in mind may nevertheless be advantageous – especially when prosecuting important cases – to avoid unpleasant surprises after grant.

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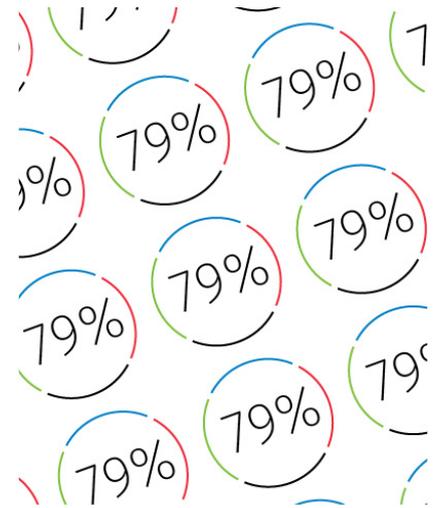
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