

T 1621/16: A handy decision, not only for dishwashing

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by Sabine Möhle, Klemens Stratmann and Thorsten Bausch

Decision T 1621/16 of Technical Board of Appeal 3.3.06 deals with a patent concerning a liquid hand dishwashing detergent composition. In a broader context, T 1621/16 will be of interest for practitioners struggling with the allowability of amendments under Article 123(2) EPC based on multiple selections from lists of converging alternatives. By "list of converging alternatives", the Board understands lists of options ranked from the least to the most preferred, wherein each of the more preferred alternatives is fully encompassed by all of the less preferred and broader options in the list.

The current approach of the EPO seems to be to allow such amendment, if at all, only if alternatives having the same degree of preference (e.g. "most preferably") are combined with each other (see item 1.5.1 of the decision). In T 1621/16, after a thorough case law review (see item 1.6 of the decision), Board 3.3.06 challenges this approach and expands Patentee's options to make amendments based on combinations of more and less preferred ranges. This decision may have significant practical significance and is likely to be welcomed particularly by patent owners and applicants.

With reference to G 1/93, the Board first clarifies that the idea underlying Article 123(2) EPC is that the applicant or patent proprietor should not be allowed to improve their position by adding subject-matter not disclosed in the application as filed, as this would give rise to an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. The Board further agrees with the established case law, according to which multiple arbitrary selections from lists, mainly based on non-converging alternatives, are considered as an extension of the content of the application as filed which contravenes Article 123(2) EPC (e.g. T 727/00).

However, analysing decisions T 812/09, T 2273/10, T 2237/10 and T 27/16, the Board notes that the jurisdiction is not consistent in cases where the amendments are based on selections from lists of converging alternatives, which leads them to the following questions (see item 1.7 of the decision):

- 1) *Should the selection of elements from lists of converging alternatives be treated in the same way as the selection of elements from lists of non-converging alternatives?*
- 2) *Which conditions must be met for amendments based on multiple such selections (i.e. selections from lists of converging alternatives) to meet the requirements of Article 123(2) EPC?*

In the Board's view, selections from lists of converging alternatives have to be treated differently than selections from lists of non-converging alternatives. The Board understands that in a non-converging list of alternatives each individual element represents a distinct feature and thus selecting a specific element from a non-converging list of alternatives leads to a singling out of an invention from among several distinct alternatives, which might result in an unwarranted advantage.

In contrast, the Board states that the elements of converging lists do not represent distinct features, but more or less restricted versions of one and the same feature. In view thereof, they set forth that amending a claim by selecting one element from a converging list of alternatives does not lead to a singling out of an invention from among a plurality of distinct options and should therefore not be treated as an arbitrary selection. In the Board's view, such amendments simply lead to a subject-matter based on a more or less restricted version of said feature.

Furthermore, the Board sees an analogy between the selection of an element from a converging list of alternatives and the deletion of options from a longer list of non-converging alternatives. The latter is permissible according to T 615/95, if it does not single out specific feature combinations, but only leads to a restriction of the scope of protection. Nevertheless, in item 1.7.3 of the decision, the Board points out that, also in case of multiple selections from converging lists of alternatives, it has to be assessed whether the resulting specific combination of features is supported by the application as filed. It concludes that such amendments might only be allowable under Article 123(2) EPC, if:

- a) the subject-matter resulting from the multiple selections is not associated with an undisclosed technical contribution, and
- b) the application as filed includes a pointer to the combination of features resulting from the multiple selections.

Thus, since the applicant/patent proprietor shall not obtain an unwarranted advantage, an amendment based on multiple selections from converging lists shall not be considered to comply with Article 123(2) EPC, if the specific combination of more or less preferred alternatives results in a beneficial technical effect not derivable from the application as filed. This can be seen as an interesting mix-up of principles of disclosure (Art. 123(2) EPC) and inventive step (Art. 56 EPC).

A "pointer" would exist if specific embodiments/examples, which are considered to represent the most detailed and preferred form of the invention, fall within the scope of the amended claims. Such a "pointer" might indicate that the combination resulting from the multiple selection was made purposeful and does not represent an arbitrary selection.

Taking the above considerations into account, in the case at stakes (see grounds 1.8 and 1.9 of the decision), the Board found an amended claim to comply with Article 123(2) EPC, whereby the amendments are based on a combination of:

- i) a single selection of a preferred element from a list of non-converging alternatives,
- ii) multiple selections from lists of converging alternatives on different levels of preference, and
- iii) claims as originally filed.

The Board considered the single selection from a list of non-converging alternatives (i) to be not arbitrary, since the selected alternative was realized in all examples of the application as filed, thus indicating that this alternative of the respective feature is indeed preferred. The lists of converging alternatives (ii) were at least partly not disclosed in the claims as filed but only in the description of the application.

Concerning the requirement of a "pointer" to the specific combination of features of the amended claims (see condition b) above), in item 1.8.7 of the decision, the Board considers the specific combination of features defined in amended claim 1 to be a result of a purposeful (i.e. non-arbitrary) restriction of the claimed subject matter, since it converges towards the most preferred forms of the invention as provided in seven out of 21 examples. In the Board's view, these seven examples thus provide a pointer to the respective combination. However, it is noteworthy that, in the case now decided, it was evidently not derivable from the application as filed whether the seven examples falling within amended claim 1 achieve an improvement of the technical effect (shine) compared to the remaining examples.

Altogether, T 1621/16 could prove very helpful in everyday practice defending amendments based on multiple selections from converging lists of alternatives. However, it remains to be seen whether, in order to fulfil conditions a) and b) above, it is sufficient that some examples fall under the more restricted version of the claim irrespective of whether they show any improved technical effect over the examples now lying outside the claim.