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When is a sub-range novel?

Derk Visser (EIP) · Monday, January 13th, 2020

The December issue 4|2019 of the journal epi Information contains four interesting contributions to the discussion on the novelty test for sub-ranges as used by the EPO.

The EPO has a special novelty test to determine whether a claimed numerical sub-range of a known broad range is novel over the known range. A sub-range must comply with each of the three criteria of the test. The criteria are, that the sub-range (i) must be narrow compared to the broad range, (ii) be far removed from known examples within the broad range, and (iii) is not an arbitrary specimen of the prior art but another invention (purposive selection, new technical teaching).

The test was formulated in 1985 by the technical board of appeal in decision T198/84 and subsequently used broadly within the EPO. Recently, several articles have criticized the test. In 2013 Thomas Leber of the EPO regarded compliance of the three criteria with the EPC questionable (see JIPLP, vol. 8, issue 7, July 2013, pages 561-565). More recently, I argued that the three criteria are incompatible with recent EPO case law on novelty (epi Information, issue 4|2019, page 27-33).

The latest edition of the *Guidelines for Examination in the EPO*, which entered into force on 1 November 2019, has removed the purposive selection criterion from the test (see section G-VI, 8(ii)). However, the latest edition of the book *Case Law of the Boards of Appeal of the European Patent Office*, 9th edition, published July 2019, still mentions the three criteria of the test (see chapter I.C.6.3.1). In addition, the book mentions a large body of contradictory case law about the purposive selection. Roel van Woudenberg argues in his recent article, that the purposive selection criterion should be kept in the test, as being consistent with the disclosure test used for novelty (see epi Information, issue 4|2019, page 34-39).

On 17 October 2019 the President of the epi, Francis Leyder, sent a letter to the President of the EPO with a request to refer the question which criteria are to be used in assessing the novelty of a sub-range to the Enlarged Board of Appeal, in particular referring to the uncertainty about the applicability of the purposive selection criterion (see epi Information, issue 4|2019, page 9-12).

On 25 November 2019 Heli Pihlajamaa responded on behalf of the President of the EPO (see epi Information, issue 4|2019, page 13-14). According to the EPO, the development of case law on selection inventions shows that all technical boards that usually deal with this type of invention have adopted the two-criteria test for novelty of sub-ranges, thereby omitting the purposive selection criterion. A development of case law including a period in which decisions go in different

directions is a normal part of the application and development of the law, and does not require a review by the Enlarged Board of Appeal. The EPO has adapted the *Guidelines for Examination* to provide clarity on how to assess novelty of such inventions.

The purposive selection criterion will no longer be used by the examining and opposition divisions, because they follow the Guidelines. It will neither be used anymore by all technical boards that usually deal with selection inventions. However, it is possible that another technical board may still use the purposive selection criterion.

The removal of the purposive selection criterion will cause an increase in the number of sub-ranges that are regarded novel. The subsequent assessment of inventive step will apply criteria such as the presence of a new technical effect in the sub-range, probably resulting in a similar number of grants as when using the three criteria for novelty of sub-ranges.

However, if the closest prior art is a European prior right under Article 54(3) EPC, there is no assessment of inventive step and the larger number of novel subranges may form a problem, in particular in the field of chemistry.

The above course of events shows that only because the President of the epi had written a letter to the EPO, did users of the EPC learn about the development of the case law and the adoption of the two-part test by most boards of appeal. If the President of the epi had not submitted his request, the users of the EPC would still be unaware of the development of the case law and, as a consequence, would still be uncertain about what test for novelty of a sub-range to use in appeal cases.

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