



Institut der beim Europäischen Patentamt zugelassenen Vertreter
 Institute of Professional Representatives before the European Patent Office
 Institut des mandataires agréés près l'Office européen des brevets

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Mr António Campinos
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17th October 2019

Dear Mr Campinos,

Re: Request for referral to the Enlarged Board of Appeal – Selection Inventions

This letter is sent on behalf of the Institute of Professional Representatives before the European Patent Office (**epi**). **epi** presently has about 12,300 members spread across the 38 member states of the EPC. Its members work mainly in industry or private practice and represent the vast majority of applicants, proprietors and opponents in proceedings before the EPO.

epi requests that you refer a question to the Enlarged Board of Appeal under Article 112(1)(b) EPC. The reasons for this request are set out below.

It has come to the attention of **epi** that there is a clear divergence in the case law of the Boards of Appeal with respect to the treatment of novelty with respect to selection inventions. This is most clearly illustrated with respect to the selection of a sub-range from within a range disclosed in the prior art. For instance, a prior art document, which we will call D1, discloses a composition comprising component X wherein component X comprises from 10 to 90% by weight of the composition. A later patent application claims a composition which comprises from 30 to 40% by weight of component X but which in all

other respects is identical to the composition disclosed in D1. In such circumstances, it is necessary to consider whether the claim lacks novelty over the disclosure in D1.

This question has been addressed in the case law of the Boards of Appeal and the leading case was T 198/84. The principles established by T 198/84 were summarised in T 279/89. This case has been followed by numerous subsequent decisions. This was referred to in the 8th Edition of the Case Law Book. According to T 279/89, there was a three-fold test to determine whether the selection of a sub-range was novel. For there to be novelty, it had to be proved that:

- (a) the selected sub-range is narrow compared to the broad range of the prior art;
- (b) the selected sub-range is sufficiently far removed from the point values within the broad range specified in the examples; and
- (c) the selected sub-range is not be an arbitrary selection from the prior art but is another invention, i.e. the selection is purposive.

There have recently been a number of cases where the Board has decided that criterion (c) is not a matter to be taken into account when considering novelty. These cases have held that criterion (c) relates to inventive step, not novelty. A recent case which took this view is T 0261/15 and other decisions which follow this line include T 1233/05, T 1131/06, T 230/07, T1130/09, T 2041/09, T492/10, T 1948/10, T 423/12, T 378/12 and T 1404/14.

However, this line is not universally accepted. For instance, T66/12 and T 673/12, which were decided after many of the decisions referred to in the previous paragraph, still regard criterion (c) as part of the test for novelty.

It is clear from the above that there are clearly two incompatible lines of Board of Appeal decisions as to what are the criteria to be used in deciding whether a sub-range is novel.

The fact that there are two lines is clearly shown by the 9th Edition of the Case Law Book, which sets out the two lines but fails to indicate which is the correct line.

This is also illustrated by developments in the Guidelines. In the November 2018 version of the Guidelines (G-VI, 8(ii)), all three criteria are referred to. However, in the November 2019 version of the Guidelines, the reference to the three criteria has been removed, despite the fact that there is no clear basis from the decisions of the Boards of Appeal for this deletion.

There is lack of clarity about the criteria to be used in assessing the novelty of a sub-range. There is a distinct possibility that a claim might be refused by the first instance for lack of novelty, because the first instance took into account all three criteria, but held to be

novel by a Board following the line that criterion (c) does not need to be considered for novelty. The alternative possibility, that the first instance finds the claim to be novel but a Board overturns this finding by relying on criterion (c), could also occur. This lack of clarity is detrimental to users of the EPO.

This lack of clarity is particularly relevant where there is a novelty-only citation, for instance a co-pending European patent application under Article 54(3) EPC. In such cases, Article 56 EPC (inventive step) is not to be considered. However, if criterion (c) is applied, then it may be argued that matters relating to inventive step are being taken into account.

In the circumstances outlined above, where there are two clearly diverging lines of decisions from the Boards of Appeal regarding the assessment of novelty as regards sub-ranges, it is **epi**'s view that the President of the Office should refer a question to the Enlarged Board of Appeal under Article 112(1)(b) EPC.

epi suggests that the question should be:

"What are the criteria to be used in assessing the novelty of a claim where the allegedly distinguishing feature of the claim relative to a prior art document is a sub-range of a broader range disclosed in that prior art document."


epi appreciates that you may wish to formulate the question in a different way and would be pleased to discuss the way in which to formulate the question if this would be of assistance.

It is also possible that a subsidiary question could be included in the reference. This could be in the form:

"If any one of the criteria is not relevant for novelty, how do(es) that(those) criterion(criteria) relate to inventive step?"

If **epi** can be of any further assistance, please let us know.

Yours sincerely



Francis Leyder
President