

might then become relevant when assessing inventive step, namely for the purposes of formulating the objective technical problem (T.1216/12, citing T.862/11 and T.2001/12).

T.1311/15 the parties did not dispute that claim 1 did not include any flammability requirement in its wording. It was however also undisputed that the invention aimed at providing non-flammable refrigerant compositions. The question arose whether, when examining the ground of opposition under Art. 100(b) EPC, the intended effect of the claimed subject-matter should be taken into account (issue dealt with by reference to the aforementioned settled case law).

T.2001/12 dealt with the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC) and inventive step (Art. 56 EPC). That decision was cited in T.862/11, in which the board addressed the relevance of the technical effect for the purposes of Art. 83 EPC and concluded that a distinction had to be made between how the effect was to be considered in that context and how it was to be considered for the purposes of Art. 56 EPC (see T.2210/16 for an analysis of these decisions). On the relationship between an objection under Art. 56 EPC and one under Art. 83 EPC, see also T.1099/16 (use of a known compound performing a new function), in which it was held, in line with G.1/03, that, if an effect is expressed in a claim [as in the case in hand, adhesion enhancer], there is a lack of sufficient disclosure [which was not a ground for opposition in the case in hand]. Otherwise, i.e. if the effect is not expressed in a claim but is part of the problem to be solved, there is a problem of inventive step.

T.206/13 also applied T.2001/12, in so far as the examining division, in the context of the assessment of sufficiency of disclosure of claims 1 and 11, had referred to technical aspects which, in its opinion, were not sufficiently disclosed. The board pointed out that these technical aspects were not defined in claims 1 and 11 and, consequently, were not to be considered in the assessment under Art. 83 EPC of the invention defined in claims 1 and 11. The requirement of sufficiency of disclosure related to the invention defined in the claims, and in particular to the combination of structural and functional features of the claimed invention, and there was no legal basis for extending such a requirement also to encompass other technical aspects possibly associated with the invention (in particular, technical features or effects mentioned in the description) but not required by the claimed subject-matter. Such technical aspects might be pertinent in the assessment of other requirements of the EPC (in particular, the requirements of Art. 84 and 56 EPC).

In T.1744/14, the problem set out in the contested patent and the effect(s) underlying it were not part of claim 1. The board acknowledged that in e.g. T.593/09, the subjective problem to be solved according to the patent, even though not part of the claims, had been taken into account when deciding on sufficiency of disclosure. However, the question in that case was not whether the claimed products objectively actually solved the technical problem, i.e. demonstrated the technical effects mentioned in the patent, but rather whether, in view of the ill-defined parameter present in the claim, products according to the claim could be selected by the skilled person without undue burden, such that a solution to the alleged problem set out in the patent would have been provided. In case T.1744/14, however, the skilled person was able to obtain polymorph II as defined in