

assessment under Art. 83 EPC. According to the established case law the requirement of sufficiency of disclosure defined in Art. 83 EPC was only complied with if the disclosure of the invention allowed the skilled person to perform, without undue burden, essentially all the embodiments covered by the claimed invention. This applied in particular to the specific particular embodiments of an invention defined in dependent claims pursuant to R. 43(3) EPC (T 1011/01) and, by the same token, to any optional feature defined in a claim, since such a feature also constituted, by its very nature, a particular embodiment of the claimed invention, irrespective of whether the optional feature was qualified as being "preferred" or not.

In T 797/14 the board came to the conclusion that the essential element of the claimed invention, namely the coating composition Flurotec (TM), was not of public knowledge and that there was also not enough information available to the skilled person for him to reliably determine the composition or structure of the product. The counterpart of a monopoly by a patent is however the disclosure of the invention, in particular of its essential elements, and not the provision or use of a commercial product whose structure and composition are not public. (On disclosure of a **starting material**, see T 1596/16, in which one of the parties had invoked T 2399/10 and T 797/14 but the board, having summarised the issues dealt with in those decisions, found that the case in hand was not comparable.)

Disclosure is insufficient if the skilled person, taking into account the entire teaching of the patent, cannot rework an invention which is defined in the claims in a completely clear and comprehensible manner, unless he disregards a meaningful feature (T 432/10, "Catchword").

3.2. Alleged effect not a feature of the claims

According to the case law of the boards of appeal, the requirement of sufficiency of disclosure relates to the invention defined in the claims, and in particular to the combination of structural and functional features of the claimed invention, and there is no legal basis for extending such a requirement also to encompass other technical aspects possibly associated with the invention (such as results to be achieved or technical effects) mentioned in the description but not required by the claimed subject-matter (principle reiterated in e.g. T 1900/17).

An objection of insufficient disclosure under Art. 83 EPC cannot legitimately be based on an argument that the application would not enable a skilled person to achieve a non-claimed technical effect (T 2001/12, citing mainly G 1/03 (OJ 2004, 413) but also T 1079/08, T 939/92 and T 260/98). Other decisions referring to this principle: T 1744/14, citing T 1345/14, point 9.8 of the Reasons; T 1311/15, point 5.2 of the Reasons; and T 2001/12, point 3.4 of the Reasons; T 1900/17, point 2.5 of the Reasons; T 1943/15; T 1502/16, citing T 862/11.

It is the board's settled case law that a technical effect is to be taken into account in assessing enablement only if it is explicitly claimed. If it is not claimed, it is irrelevant for enablement whether or not it is actually achieved. The question whether it is achieved