

T 37/82 (OJ 1984, 71) The board held that in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also T 65/87, T 144/90, T 206/91, T 226/94, T 912/94, T 15/97, T 471/98, T 442/02). Therefore, only those claimed features are to be considered which contribute causally to the solution of the problem (T 285/91). In T 294/89 the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed.

In T 589/95 the terms of the solution of the technical problem extended into an area of use where it had been admitted that the relevant problem was known not to arise in practice. The board stated that, for such an area, the features of the solution did not contribute to the solution of the technical problem and could not be taken into account in the assessment of inventive step.

With reference to T 119/82, Board 3.3.05 held in T 72/95, T 157/97, T 176/97 and T 158/97 that similar considerations applied to technically non-functional modifications. An inventive step could not be claimed on the basis of a non-functional modification of a known device. If a known device was modified by adding a feature which had no technical function, this modification could not be inventive (see also in this chapter I.D.9.1. "Assessment of inventive step in the case of mixed-type inventions").

In T 1009/12 the board took the view referring to T 206/91 that an ineffective concentration of a compound was considered as an arbitrary feature not contributing to the solution of the underlying problem and therefore not further considered. Since there were no further distinguishing features it was not feasible to identify the technical problem to be solved and the claim lacked inventive step.

In T 2044/09 the board held that even if there was no pointer or suggestion in the prior art towards the addition of a distinguishing feature, if said modification was not linked to a particular functionality, then it could not per se constitute the basis for acknowledging an inventive step.

In T 2287/16 the board had no objection to the examining division ignoring, in an inventive-step assessment, a feature that it found to contravene Art. 123(2) EPC. The board considered that the examining division was not obliged to anticipate the replacement of such a feature with a similar one that might have been originally disclosed and to provide a speculative inventive step assessment of a so-amended claim.

9.7. Substitution of materials – analogous use

In T 21/81 (OJ 1983, 15) the board considered it as forming part of his normal activities for a skilled person to select, from the materials known to him as suitable for a certain purpose, the one which was the most appropriate. In T 324/94 the board held that the skilled person should therefore be at liberty, within the constraints of standard technical progress, to use