

determination; it did not depend on any variable or feature characterising the process claimed.

In T 808/09 (cartridge for use in a beverage preparation machine / liquid chocolate ingredient), the board considered that the patent failed to enable the measurement of the essential parameter of the invention, i.e. the viscosity of the liquid chocolate ingredient. Even if this viscosity feature had been shifted into a preamble of method claim 1 and supposing this preamble had been directed to the prior art, this shifting of the feature would still not have solved the problem of insufficiency. For a reference to prior art in the preamble to adequately serve this purpose the patent in suit still needs to contain all the necessary information in sufficient detail in order to enable the person skilled in the art to perform the invention. In the case before the board this would require information as to the viscosity measurement device to be used and the parameters to be observed. All this information was missing.

T 1845/14 decided that in case of an unclear parameter defined in a claim whose values required in the claim are indicated in the specification to be essential to solving the problem underlying the patent at issue, the ability of the skilled person to solve that problem by reproducing what is claimed is **not a suitable criterion** for assessing sufficiency of disclosure when the problem or an effect derivable from it are not explicitly or implicitly part of the definition of the claimed subject-matter (point 9.8 of the Reasons). T 1845/14 addressed the rationale of T 593/09, T 815/07, T 172/99 and T 608/07 ("promise of the invention" is rather an issue of inventive step) and stated that all the decisions cited above relating to a parameter mentioned in a claim whose definition was ambiguous are based on a definition of the term "invention" which does not refer to the combination of features defined by the terms of the claim under consideration but rather to the inventive idea or concept the inventor had in mind that led the patentee to seek protection for what is claimed. The board in T 1845/14, making detailed reference in its reasons to landmark decisions such as T 435/91 (OJ 1995, 188) and T 939/92 (OJ 1996, 309), was convinced that, provided that the problem indicated in the patent in suit was not implied by the wording of the claims in terms of, for example, an effect or a functional definition, there was no apparent justification to deny a contribution to the art justifying a patent monopoly merely because the claimed subject-matter could not be considered to solve a problem initially indicated in the description. The term "invention" corresponds, in accordance with R. 43(1) EPC, to the specific combination of features in the claim, as was reminded in G 2/98 (OJ 2001, 413), whose definition is used when issues of priority, novelty and inventive step are considered. The board in T 1845/14 did not see any reason to consider a different meaning of the term "invention" in relation to the issue of sufficiency of disclosure. There is no reason to define the invention on the basis of an effect alleged in the patent to be achieved by the claimed subject-matter or on the basis of specific conditions for measuring a parameter when the wording of the claim does not require this. The invention is defined by the terms of the claims, which should be given their broadest technical sensible meaning in the context they appear. The board said that its position was also supported by G 1/03 (OJ 2004, 413 – concerning non-working embodiments).

The decision in T 1845/14 was endorsed on this point by the subsequent case law in T 1900/17, T 409/17, T 1260/16, T 189/16, T 1744/14. No decision taking issue with