

of other decisions (T.740/90, T.406/91, T.1712/09) and to the established case law reported in chapter II.C.5.4.

5.4. Invention to be performed over whole range claimed

Under the established case law of the boards of appeal, the requirements of sufficiency of disclosure are met if a person skilled in the art can carry out the invention as defined in the independent claims over the whole scope of the claims without undue burden using their common general knowledge (e.g. T.409/91, OJ 1994, 653; T.435/91, OJ 1995, 188).

The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed** rather than **only in some** members of the claimed class to be obtained (T.409/91, OJ 1994, 653; T.435/91, OJ 1995, 188; and T.172/99). This is considered a question of fact. Sufficiency of disclosure thus presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of the claims. This view has been taken by the board in numerous decisions, for example T.19/90 (OJ 1990, 476), T.418/91, T.548/91, T.659/93, T.435/91 (OJ 1995, 188) and T.923/92 (OJ 1996, 564; even more recently, issue discussed in detail in T.1727/12 ("Biogen Sufficiency")). This principle applies to any invention irrespective of the way in which it is defined, be it by way of a functional feature or not. The peculiarity of the functional definition of a technical feature resides in the fact that it is defined by means of its effect. That mode of definition comprises an indefinite and abstract host of possible alternatives, which is acceptable as long as all alternatives are available and achieve the desired result; it therefore has to be established whether or not the patent discloses a technical **concept fit for generalisation** which makes the host of variants encompassed by the functional definition available to the skilled person (T.1121/03 (no technical concept fit for generalisation – undue burden in carrying out the invention over the whole scope claimed – research programme) and T.369/05; see also T.2128/13). With respect to a claimed process defined in a functional manner, i.e. by its outcome, the board in T.1051/09 concluded that what was lacking was a generalisable teaching applicable within the scope of the claims, i.e. beyond the specific examples.

More technical details and more than one example may be necessary in order to support claims of a broad scope (T.612/92, T.694/92, OJ 1997, 408; T.187/93). This must be decided on a case-by-case basis. The board must also be satisfied firstly that the patent specification put the skilled person in possession of at least one way of putting the claimed invention into practice, and secondly that the skilled person could put the invention into practice over the whole scope of the claim. If the board was not satisfied on the first point that one way existed, the second point did not need to be considered (T.792/00).

According to the decision in T.517/98 (grains of superconductor material – density) the patent in suit had only shown the way of achieving the goal to some extent and within set limits, but certainly not over the whole ambit of the claim. In the board's judgement, broad protection such as that claimed was therefore unjustified since such a claim encompassed **speculative subject-matter** which could not be produced by the skilled person without inventive ingenuity (see also T.409/91). The main request failed (Art. 83 EPC).