

and not substantially all claimed compounds exhibited a particular technical effect, the conclusion had to be that the invention as broadly defined in the independent claim was not a solution to the technical problem of achieving the given technical effect, with the consequence that the alleged technical effect of some of the claimed compounds was to be disregarded when determining the objective problem underlying the invention and thus when assessing inventive step.

In T. 942/98 the problem as per the application was the preparation of improved selective herbicides. With reference to T. 939/92 (OJ 1996, 309), the board did not agree with the applicant that, in the case in hand, he merely had to show an improved effect at the direct interface between prior art and the application in order to demonstrate, without providing further details, that such an improvement applied without qualification for the entire breadth of the claim. The appellant's position, in the board's view, amounted to allowing the applicant to decide how broad a claim could be, whether or not an improvement in the effect of all the compounds claimed was actually credible.

In T. 415/11 the board stated when the credibility that a technical effect is achieved by substantially all claimed compounds is at issue and in a situation where, it is prima facie unlikely that this is credible, it is not the opponent, but the patentee who has the burden of proving that the effect is achieved (referring to T. 939/92, OJ 1996, 309; T. 97/00).

In T. 41/16 the board observed that it was the boards' established case law that a technical effect on which inventive step was based had to be achieved over substantially the whole of the claimed range (see e.g. T. 939/92, OJ 1996, 309). However, that did not mean that every composition encompassed by a claim had to show an improvement over any composition comprised in the prior art, or even just over the one closest to the claim. What was required instead was that each composition according to the invention that differed from an equivalent composition in the closest prior art only in that it had the feature distinguishing the claim from the prior art showed the alleged improvement.

In T. 1296/13 the board stated that Art. 69 EPC and its Protocol did not provide a basis for excluding from a claim embodiments that fell within the wording of the claim (referring to T. 223/05).

9.9.4 Intermediate products

In decision T. 22/82 (OJ 1982, 341) the board ruled that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was inventive.

Again in T. 163/84 (OJ 1987, 301) intermediate chemical products were held to be patentable on the grounds that their further processing to the known end products involved an inventive step. The board however held that a new chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end-product; there had to be other factors as well, such as that the process for preparing the new intermediate had enabled it to be