

breach of Art. 123(2) EPC 1973. See also T.496/90, T.415/91, T.628/91, T.189/94, T.1032/96 (segment length parameters explained as essential), T.728/98 (OJ 2001, 319; concerning the deletion of the feature "substantially pure"), T.1040/98 (acoustic waveguide is described in the form of a bladder filled with a suitable material, throughout the description), T.1390/15 (consistent disclosure of solubility limit on the content of Mg and Cu) and T.1187/15 (consistent disclosure that heart rate can be derived from the blood pressure measurement).

In T.236/95 the board held that if the problem could not be solved without the features concerned, they could not be considered unimportant.

In T.784/97 the patent proprietor alleged that a prior art document would have made the skilled person aware that the disputed feature was not essential. The board held that whether or not a feature of an independent claim had to be seen as "essential" could **not be a question of the prior art disclosure**. Rather, what had to be decided was what a skilled person was taught by the originally filed documents.

In T.1515/11 the board confirmed that a feature could not be deleted from an independent claim if it had been consistently presented as an essential feature of the invention, since this would add subject-matter. In some cases there might be room for debate as to whether the application presents a feature as being essential to the invention or as being optional. However, there were also cases where, on purely formal grounds, the essentiality of a feature could not be doubted. One such case was where the applicant chose to include in an independent claim as filed a feature explicitly mentioning the problem, and affirming that the claimed subject-matter represents a solution to the problem. In particular, where a claim to a method included a feature explicitly defining that the method was carried out in a manner which solved the problem, to argue that this feature was not essential would be tantamount to arguing that in order to solve the problem, it was not essential to carry out the method in a way which solved the problem.

The board in T.648/10 confirmed the test set out in T.260/85. However, it observed that **the EPC does not require the use of any particular tests** when assessing whether subject-matter has been added. Instead, such tests are **tools** which may be helpful, in certain situations, in the assessment of whether subject-matter has been added.

#### 1.4.4 The essentiality or three-point test

##### a) Decisions setting out, applying and distinguishing the test

In T.331/87 (OJ 1991, 22) the board, building on T.260/85 (OJ 1989, 105) set out a three-point test. The board held that the replacement or removal of a feature from a claim might not be in breach of Art. 123(2) EPC 1973 if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change (frequently applied until 2012, see e.g. T.708/07, T.775/07, T.2359/09, T.747/10; more recently