

9.19. Analogy processes

The effect of a process manifests itself in the result, i.e. in the product in chemical cases, together with its internal characteristics and the consequences of its history of origin, e.g. quality, yield and economic value. It is well-established that analogy processes are patentable insofar as they provide a novel and inventive product. This is because all the features of the analogy process can only be derived from an effect which is as yet unknown and unsuspected (problem invention). If, on the other hand, the effect is wholly or partially known, e.g. the product is old or is a novel modification of an old structural part, the invention, i.e. the process or the intermediate therefore, should not merely consist of features which are already necessarily and readily derivable from the known part of the effect in an obvious manner having regard to the state of the art (T 119/82, OJ 1984, 217; see also T 65/82, OJ 1983, 327).

According to T 2/83 (OJ 1984, 265), so-called analogy processes in chemistry are only claimable if the problem, i.e. the need to produce certain patentable products as their effect, is not yet within the state of the art.

In T 1131/05 the board found that the conditions for granting a claim to an analogous process defined in T 119/82 and T 2/83 applied to the subject-matter of claim 10. It thus deemed a process claim directed to an analogy process to be new and inventive.

9.20. Envisageable products

In T 595/90 (OJ 1994, 695) at issue was the inventiveness of a product which could be envisaged as such but for which no known method of manufacture existed. In its Headnote, the board noted that a product which could be envisaged as such with all characteristics determining its identity including its properties in use, i.e. an otherwise obvious entity, might nevertheless become non-obvious and claimable as such, if there was no known way or applicable (analogous) method in the art for making it and the claimed methods for its preparation were therefore the first to achieve this and do so in an inventive manner (see also T 268/98, T 803/01, T 441/02, T 1175/14).

In T 268/98 the board found that the prior art did not comprise any technical information as to how to obtain the "pinning centers" according to claim 1. Therefore, even if the claimed product were to be considered highly desirable, there was no obvious method in the art to make it. Thus the average skilled person not even could, let alone would, have been able to arrive at the claimed product. The board, therefore, held that the product according to claim 1 involved an inventive step.

In T 233/93 the combination of properties defining the claimed products had been a desideratum which the skilled community had striven to achieve. These properties, however had been considered to be irreconcilable. The board stated that such a desired product, which may appear obvious per se, may be considered non-obvious and be claimable as such, if there is no known method in the art to make it and the claimed methods for its preparation are the first to produce it and do so in an inventive manner (T 1195/00).