

5.5.3 Unusual parameters

Where unfamiliar parameters have been used to define the solution to a technical problem, the patentee is under a particular obligation to disclose all the information necessary to reliably determine the new parameter, in accordance with T.172/99, T.815/07, and T.593/09 (as recapitulated in T.1845/14).

In T.172/99 the board found that in the case of claimed subject-matter relying on a newly formulated and hence unfamiliar parameter to define the solution of a technical problem by which a relevant effect is achieved, the patentee is under a particular obligation to disclose all the information necessary reliably to define the new parameter not only (i) in a formally correct and complete manner such that its values can be obtained by a person skilled in the art without undue burden, but also (ii) in a manner which reliably retains the validity of the parameter for the solution of the technical problem for the application or patent in suit as a whole in the sense that the values routinely obtained will not be such that the claimed subject matter covers variants incapable of providing the relevant effect or, therefore, of solving the associated technical problem (followed in numerous decisions; see, for example, T.914/01, T.179/05, T.75/09 and T.1287/15 (dispute whether unfamiliar parameter (yes) – patentee's particular obligation identified in T.172/99 not met)).

The board in T.54/17 cited the settled case law that two requirements had to be met for the purposes of Art.100(b) EPC: the skilled person had to be able, firstly, to derive from the patent specification at least one way of carrying out the claimed invention and, secondly, to carry out the invention over the whole range claimed. The board held that the (second) requirement was particularly important, especially where a claim contained unusual parameters (parameters "operational result" and "reaction pattern" – certain meaning in German – not readily understood here as having a technical meaning). The board referred to the conditions listed in T.172/99. The board concluded that the skilled person was unable to carry out the invention.

The board in T.602/10 found that the proprietor had deliberately decided to use a method for determining rugosity which was different from the one commonly used in the state of the art. It was therefore its duty to provide full information with regard to the means and the procedures for implementing said method. In general terms, when the issue of sufficiency concerned the description of a method for determining a parameter, the less common the method the more accurate the information provided in the description should be. In the case at issue, in the absence of any known prior-art work applying the same method used in the patent for measuring the rugosity, the skilled person had to rely primarily on the teaching of the patent to put the method into practice.

In T.131/03 the board observed that, once an opponent had established a strong presumption that unusual parameters used to define the claimed subject-matter were inherently disclosed in the prior art, the patent proprietor could not simply claim the benefit of the doubt. It was instead incumbent on it to establish to what extent the parameters it had chosen to use to define its invention actually distinguished the claimed subject-matter from the prior art.