

does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed (T 686/99, T 1853/13, T 1252/13). The fact that features in question have been mentioned in the description as **"preferred"** may act as a pointer (T 68/99, T 1869/11, T 394/11, T 1799/12; for counter-examples, see however T 2118/08 and T 1306/12). In T 1728/16 the fact that two of the features introduced in the claim at issue were disclosed as being preferred was seen as a pointer to their combination with the third amendment which introduced generally disclosed percentage ranges.

In T 524/17 appellant 2 had argued that the features of claim 1 were picked from different embodiments. The board however pointed out that in the application at issue the expression "in one embodiment" referred to general teachings of preferred features which were combinable without going beyond the content of the application as filed. See however also T 1442/16.

In T 3142/19 the examining division considered that in the absence of a positive hint to a combination of features that are otherwise presented as optional, any such combination was new technical information. In the board's view however, this argument was valid only in its positive form: if the description indicated that some combination was desirable, or necessary to solve a technical problem, then a clear pointer to disclosure of the combination was provided. If not, however, it did not automatically mean that the skilled person could not derive the combination from the application as filed. But an excessive number of optional features could have an impact on the assessment of compliance with Art. 123(2) EPC, in that, in a forest of optional features, a singled-out individual combination may not be clearly and unambiguously derivable by the skilled person. Whether this was indeed the case depended on the specifics of the case, e.g. on the level of complexity caused by the optional features.

For examples where the above principles were applied in the case of divisional applications in respect of the earlier application as filed, see T 2118/08, T 961/09, T 1581/12; see also the reference in chapter II.E.1.1. to G 1/05 (OJ 2008, 271).

b) Examples of cases where the combination was held to be unallowable

In T 389/13 the composition of claim 1 was defined on filing in a broad manner, its definition including a few structural features as well as two ranges of parametric values, with an indication in the rest of the application of preferences for said structural features and a definition of additional parameters which might be used to characterise the composition, as well as corresponding ranges of values. Subsequently some limits were introduced on the basis of said preferences or on the basis of said additional parameters and corresponding ranges of values. The board emphasised that allowing those various restrictions without there being any – even implicit – indication in the application as filed that the specific combination was envisaged would be unfair to third parties. It would give an applicant who filed a broad speculative claim an unwarranted advantage over other applicants who were the first to attribute any significance to a specific combination of parameters and their ranges of values encompassed by said broad original claim.