

1.9.2 Examples regarding the requirement "no clearly recognisable functional or structural relationship"

In T 25/03 the board stated that extracting isolated features from a set of features which had originally been disclosed in combination would only be justified in the absence of any clearly recognisable functional or structural relationship among said features (see e.g. T 1067/97). The board concluded that since claim 1 at issue resulted from the extraction of isolated steps from the specific combination (here a sequence of steps) disclosed as **essential for obtaining the desired result in the embodiment** of Figure 4, and since the appellant had not referred to other parts of the application as filed that could support the proposed amendment, and no such parts had been identified by the board, claim 1 as amended in accordance with the first auxiliary request did not meet the requirements of Art. 123(2) EPC 1973. An example with the opposite conclusion, that is, in which the board held that the skilled person would consider the omitted features to be non-essential for the identified technical effects, can be found in T 1601/16 (albeit without reference to the criterion stipulated in T 1067/97).

In T 582/91, the respondent (opponent) was of the opinion that when restricting a granted claim by introducing subject-matter from the dependent claims all the **features of the dependent claims** in question should be incorporated in the new independent claim. Contrary to this opinion the board considered that one feature of a dependent claim could be readily combined with a preceding independent claim as long as the skilled person recognised that there was clearly no close functional or structural relationship between the one feature of that dependent claim and its other features, or between that one feature and the teaching of other dependent claims referred to in that dependent claim. If this was the case, no objections under Art. 123(2) EPC 1973 arose (see also T 938/95).

In the consolidated cases T 1500/07, T 1501/07 and T 1502/07, the board applied the established case law of the boards of appeal concerning Art. 123(2) EPC to the case of Art. 76(1) EPC 1973. The board stressed that where newly claimed subject-matter was based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a specific embodiment in the description) the criterion that this subject-matter had to be directly and unambiguously derivable by the skilled person from the original disclosure was met, if there was no clearly recognizable functional or structural relationship between the features, i.e. when they were not inextricably linked. What is decisive is determining which specific combinations of features were originally taught by the parent, and whether the skilled person recognises immediately and unequivocally from the totality of the disclosure when read contextually and using his common general knowledge that, and which, certain features are **incidental to the proper functioning of these specific embodiments**, and that these can be dispensed with without consequence for the remaining features. In the case before the board, the fact that the claimed features were not given any special prominence, and that they were functionally and structurally bound to the other, remaining features indicated that these criteria were not met.

In T 1469/15 the board saw no structural or functional relationship between the extracted feature and the remaining features of the combination. This conclusion was not invalidated by the appellant-opponent's observation that the claim covered **non-disclosed**