

As highlighted by numerous decisions, it is the requirements of the "gold standard", which ultimately must be met when assessing **any** amendment for its compliance with Art. 123(2) EPC and by analogy with Art. 76(1) EPC (T 838/16 with reference to T 1852/13 and T 755/12; see also T 1462/14, T 1869/17 and T 71/19). Several decisions have concluded that the essentiality test set out by decision T 331/87 was moot and should not be applied (T 2311/10, regarding intermediate generalisation; T 2599/12, T 830/16, T 1365/16, T 437/17; see also the further decisions cited in this chapter in II.E.1.4.4e)).

d) Necessary but not sufficient condition

In T 437/17 the board, in line with several decisions such as T 1472/15 and T 1852/13, held that fulfilling the three criteria of the "essentiality test" as set out in T 331/87 (OJ 1991, 22) was a necessary requirement but not a sufficient one for compliance with Art. 123(2) EPC. The board further underlined that, in any case, this test could not replace the "gold standard" and should not lead to a different result than when applying the "gold standard" directly. The board agreed with the finding in T 2599/12 that the "essentiality test" set out in T 331/87 was moot and should not be applied.

e) Decisions criticising the essentiality or three-point test

In T 910/03 the board criticised the second condition of the essentiality test (omitted feature not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve). The board criticised this approach in the light of G 2/98 (OJ 2001, 413) for being tantamount to making a distinction between technical features which were related to the function and the effect of the invention and, on the other hand, technical features which were not.

In case T 2311/10 which concerned an intermediate generalisation, the board expressed the view that the three-point or essentiality test was unhelpful or even misleading (see also T 1840/11, T 2095/11, T 2095/12). In particular, the board highlighted, with regard to the second criterion, that the test of T 331/87 necessarily had to relate to the problem derivable from the application as it concerned the disclosure of the application. This was however not always observed.

In T 1852/13 the board concluded that the three-point essentiality test developed in T 331/87 should no longer be used (similarly T 830/16): in view of that earlier decision's wording ("may not"), logic alone dictated that it could not be congruent with the "gold standard" (G 2/10). Indeed, even the board that had developed the test had acknowledged that it might be met, yet Art. 123(2) EPC still infringed. Although the essentiality test could be a useful indicator in certain cases, the "gold standard" was the only test that counted (see T 755/12). Moreover the Enlarged Board, in G 2/98, ruling on when a priority claim was valid, had rejected the essentiality-based approach taken in T 73/88 (Snackfood), laying down instead a condition analogous to the "gold standard", and its concern that evaluations of essentiality might be arbitrary applied to amendments too. The board therefore agreed with T 910/03 that the conclusion to be drawn from G 2/98 was that the essentiality test should no longer be applied. Another advantage of the "gold standard"