

In T. 661/09 the board found the remaining features of claim 1 expressed no more than a set of desiderata, without any indication of a causal link between the desired properties and the constitution of the claimed device. Insofar as the claim did not define any concrete measures on how to ensure that the claimed properties were effectively obtained, the claimed properties remained at an abstract or conceptual level. The issue of inventive step boiled down to the question of whether or not the skilled person, in view of the available prior art and his/her common general knowledge, would in an obvious way have envisaged the claimed set of desiderata. The board found this question must be answered in the affirmative, concluding that claim 1 lacked an inventive step.

9.21. Examples of lack of inventive step

9.21.1 Foreseeable disadvantageous or technically non-functional modifications

In some decisions the subject-matter was found not to involve an inventive step, when the invention was the result of a foreseeable disadvantageous modification of the closest prior art (T. 119/82, OJ 1984, 217; T. 155/85, OJ 1988, 87; T. 939/92, OJ 1996, 309; T. 72/95; T. 694/13).

The board in T. 119/82 (OJ 1984, 217) had already found that disadvantageous modifications did not involve an inventive step if the skilled person could clearly predict these disadvantages, if his assessment was correct and if these predictable disadvantages were not compensated by any unexpected technical advantage. More recently, the board in T. 2197/09 confirmed that inventive step cannot be acknowledged on the basis of a purely disadvantageous modification of the closest prior art.

9.21.2 Modifications to the closest prior art obvious to the skilled person

In T. 1862/15 the board accepted that an alternative means for achieving a known technical effect could, in some cases, be considered to involve an inventive step. However, achieving a known technical effect by means of modifications of the closest prior art which would be obvious to the skilled person could not be considered inventive.

9.21.3 Technical standards

In T. 519/12 the board held that it had to be expected of the skilled person that he would exercise his skills in the framework of technical standards in force in his field of activity. No inventive activity could be derived from a feature that simply reflected the contents of such a technical prescription.

9.21.4 Reversal of procedural steps

In T. 1/81 (OJ 1981, 439) the board held that in the absence of other features that from a technical point of view would contribute to patentability, the sequence in which the socket and pipe connection in the case in hand was made did not suffice to impart inventive step to the method claimed. The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step.