

for the definition which belonged to the state of the art had to be sufficiently clear from the description. This principle has been upheld inter alia in T 269/84, T 120/86, T 137/86 and T 278/86. The latter two decisions stipulated that a two-part claim was not justified if it gave an incorrect picture of the state of the art (likewise T 181/95). In T 735/89 the board did not accept a one-part claim because it gave the impression that there was no closer state of the art.

In T 99/85 (OJ 1987, 413) the board held that in opposition proceedings there was no reason officially to insist on a change in the wording of the claim simply because one feature in the preamble to a two-part claim did not belong to the state of the art. Furthermore, the board saw R. 29(1) EPC 1973 as an implementing regulation which did not constitute a ground for opposition. A similar view was held in T 168/85, T 4/87, T 429/88, T 65/89.

In T 350/93 the patent application disclosed processes for the production of electro-active material and composite materials containing such material and included claims in one-part form. The board observed that the one-part form was justified because details in certain process steps distinguished the claimed processes from those in the prior art and the distinctive features were difficult to pick out in a simple and unambiguous form.

In T 121/06 the board found that the combination of features in claim 1 was not known from the prior art. It would thus be detrimental to the logic of the claim to split up its features (i) to (iii) into their basic building blocks merely to indicate which blocks happen to be known from the prior art, without having regard to their inter-relationships. Thus, the two-part form of the claim was found to be inappropriate (R. 29(1) EPC 1973).

For further instances in which a claim in two-part form was not regarded as appropriate, see inter alia T 345/89, T 378/92, T 723/93 and T 181/95.

2.1.2 Two-part claims: preamble and characterising portion

Which features are known and hence to be included in the preamble has to be decided in the light of the objective facts of the case (T 6/81, OJ 1982, 183).

In T 13/84 (OJ 1986, 253) the board considered it could not be accepted as a general rule that the piece of prior art used for the preamble of the claim should be concerned with the same problem as the invention (likewise T 287/02). Generally, the apparatus or process constituting the prior art which was nearest to the invention would have to figure in the preamble of the claim, stating such features of it as were necessary for the definition of the claimed subject-matter and which were in combination already part of this prior art (see also T 897/90). R. 29 EPC 1973 (like R. 43 EPC) made no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It was the subject-matter of the claim as a whole which embodied the invention and the inventive step involved. See also T 886/91, T 157/93.

T 850/90 confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole.