

that any further component can be present ("comprises"), (ii) no further component can be present ("consists of") and (iii) specific further components can be present, namely those not materially affecting the essential characteristics of the texturizing agent ("consists essentially of"). Therefore the skilled person was not at liberty to choose whichever of the three terms he wished when reading the term "comprises". The board further refused the request for referral of questions to the Enlarged Board of Appeal. Although the board agreed with the appellant that the two boards in decisions T 472/88 and T 975/94 appeared to have considered the term "comprises" in itself to be a sufficient basis for the term "consists essentially of", the jurisprudence of the boards had further developed since these two decisions, in particular by way of the two later decisions of the Enlarged Board of Appeal in G 2/98 (OJ 2001, 413) and G 1/03 (OJ 2004, 413). In line with these decisions of the Enlarged Board of Appeal, more recent decisions of the boards of appeal, e.g. T 868/04, T 725/08 and T 903/09, had applied the criterion of clear and unambiguous disclosure to decide on the allowability of the amendment of the term "comprises" to "consists essentially of". These decisions had considered that this criterion is not automatically fulfilled by the term "comprising" alone. In the case at issue in T 759/10, the replacement of the word "comprising" by "consisting essentially of" was found to contravene Art. 123(2) EPC, but the replacement of the word "comprising" by "consisting of" was allowed.

According to T 1271/13 it is today settled that the term "comprising" is not generally accepted as direct and unambiguous basis for an amendment to "consisting essentially of".

In T 56/08 the board rejected the respondent's argument that the verb **"to contain"** had a more restrictive meaning than the verb "to comprise"; the board pointed out that the general meaning of the verb "to contain" was "to have in it", "to hold", "to include", "to encompass" or "to comprise".

In T 1170/07 "consisting essentially of" was substituted for "comprising". Before evaluating whether the original disclosure in its entirety specifically disclosed the claimed unit dosage form consisting essentially of tetrahydrolipstatin, it had to be established what the term "consisting essentially of", which could not be found in the original application, meant in the context. The board recalled on this occasion that claims should be read in a technically reasonable way. In the case at issue, the expression "consisting essentially of" excluded the presence of further active agents useful in the treatment of the specific disease concerned but allowed the presence of additional compounds forming the carrier for the active agent. The board concluded in this case that the substitution of "consisting essentially of" for "comprising" was allowable under Art. 123(2) EPC.

In T 108/14 the board distinguished the case at issue from the one in T 1170/07 because it was not directly and unambiguously derivable from the application as filed, which "active agents" were useful. Furthermore, the board referred to a line of jurisprudence (e.g. T 1095/09, T 759/91, T 522/91, T 472/88) according to which the expression "consisting essentially of" was found to be clear and to allow the presence of other components in addition to the components mandatory in the claimed composition, provided that the essential characteristics of the claimed composition were not materially affected by their