

5.2. Indication of at least 'one way'

An invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. If this is the case, the non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide the same effect for the invention (T 292/85, OJ 1989, 275). This has been confirmed by many decisions, for example: T 81/87 (OJ 1990, 250), T 301/87 (OJ 1990, 335), T 212/88 (OJ 1992, 28), T 238/88 (OJ 1992, 709), T 60/89 (OJ 1992, 268), T 182/89 (OJ 1991, 391), T 19/90 (OJ 1990, 476), T 740/90, T 456/91 and T 242/92.

If a claim comprises non-working embodiments, the consequences differ depending on the circumstances (G 1/03, OJ 2004, 413, point 2.5.2 of the Reasons, citing T 238/88, OJ 1992, 709; T 292/85, OJ 1989, 275, and T 301/87, OJ 1990, 335). This finding from G 1/03 is analysed in T 2210/16. See also T 875/16 (points 7 and 35 of the Reasons).

In T 941/16 (field of biochemistry) the board stated that the requirements of sufficiency of disclosure applied to all technical fields. Thus, depending on the individual case, inventions relating to a generic chemical formula comprising non-working embodiments with functional features contravened the requirements of Art. 83 EPC too.

In T 1809/17 the opponent argued that claim 1 was insufficiently disclosed in that it did not specify all essential features. For the board, however, the crucial point was not whether the independent claim defined all essential features but rather whether the patent specification as a whole provided the skilled person with at least one workable example of how the claimed invention could be implemented.

5.3. Examples

Whether or not the disclosure of the patent in suit is sufficiently clear and complete within the meaning of Art. 100(b) and 83 EPC must be decided by appraising the information contained in the examples as well as other parts of the description in the light of the common general knowledge of the skilled person at the priority date (T 322/93 and T 524/01).

However, where the application disclosed the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, it then necessarily disclosed at least one way of carrying out the invention disclosed in accordance with R. 42(1)(e) EPC, with the necessary details being derivable from the description including the prior art referred to therein (see e.g. T 389/87, T 561/96 and T 990/07). The board in T 990/07 pointed out that, although the case underlying decision T 561/96 differed from that in T 990/07 in that in T 561/96 the description and the drawings were not erroneous, the board in T 561/96 had also held that in cases where examples were not indispensable, their omission did not contravene R. 27(1)(e) EPC 1973 (R. 42(1)(e) EPC). This Rule only required the insertion of such examples "where appropriate". The jurisprudence of the boards of appeal thus drew a clear distinction between the concepts of "way of carrying