

applied in T 1906/12). This test is sometimes referred to as the essentiality test (see e.g. T 2359/09, T 2599/12, T 2489/13). Note that the Guidelines (H-V, 3.1 – March 2022 version) contain a modified three-point test.

In T 404/03 the board noted that, as far as the disclosure of a group of features was concerned, as distinguished from their scope, the generalisation of a feature in a claim and the isolation of features from embodiments in the description essentially both involved a deletion of a feature, namely the specific feature and the remaining features of the embodiment respectively. The board therefore considered that these cases could be subject to the same criteria as a pure deletion, and hence, in principle, the three-point test. Rather than requiring a specific statement or suggestion in the original disclosure, the three-point test was more generous to the applicant because it essentially allowed the deletion of a feature if the skilled person realised from the common general knowledge in that field that the feature had nothing to do with the invention. Moreover, in the board's view, the cases of deletion of features and addition of features had to be distinguished with respect to the allowability of amendments under Art. 123(2) EPC 1973, since the former only removed elements that were originally disclosed and hence might be judged by a skilled person to be inessential to the invention, whereas the latter added new elements lacking any basis whatsoever in the original disclosure.

In T 2300/12 the board held that the purpose of the essentiality test was to ascertain whether the replacement or removal of a feature in an originally filed independent claim resulted in an extension beyond the content of the application as originally filed. In the case at issue, however, the granted claim was for a process, whereas there had been no such process claim in the set of claims originally filed. For that reason alone, the essentiality test could not be directly applied to establish whether there had been such an inadmissible extension.

#### b) Mere aid in assessing the allowability of amendments

The board in T 1472/15, citing T 2311/10 and T 1852/13, held that, contrary to how T 331/87 had often been misinterpreted, the "essentiality test" was not absolute vis-à-vis the "gold standard" and could merely be used as an aid in ascertaining what had been originally disclosed (see also T 648/10, T 755/12, T 2095/12, T 2599/12, T 46/15, T 1420/15, T 85/16 and T 1189/16). 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) Art. 76(1) EPC (T 838/16 with reference to T 1852/13 and T 755/12; see also T 1462/14, T 71/19 and T 1270/20). The "essentiality test" cannot take the place of the gold standard (T 172/17).

#### c) No longer considered appropriate

According to T 1365/16, in the more recent jurisprudence of the boards of appeal, the so-called "essentiality test" (as set out in T 331/87, see point a) above) is no longer considered appropriate (cf. e.g. T 1852/13).