

lists can nevertheless be regarded for patent purposes as a selection and hence as new". The board noted that given the term "can" in this citation, the absence of a direct and unambiguous disclosure for individualised subject-matter was not a mandatory consequence of its presentation as elements of lists. Thus, the "disclosure status" of subject-matter individualised from lists had to be determined according to the **circumstances of each specific case** by ultimately answering the question whether or not the skilled person would clearly and unambiguously derive the subject-matter at issue from the document as a whole.

In T 1710/09 the board insisted, however, that, in line with established jurisprudence, "can" within the meaning of T 12/81, was to be taken as a "is to". In view of the implications of freely interpreting this word "can" as in T 783/09, there was deep concern that in this way the uniformity of the disclosure assessment process could not be warranted.

In T 1255/18, referring to T 783/09, the board emphasised that, while conditions had been developed by the case law, such as the so-called "two-lists principle", they were not meant to be additional or alternative conditions, but only a possible aid in certain cases to verify whether the gold standard was satisfied. The central question to be answered therefore was whether the claimed combination of features could be seen by the skilled person as directly and unambiguously derivable from the content as a whole of the parent application as filed.

In T 3035/19 the board was of the opinion that, while the notion of selection from two lists was not meant to take the place of the gold standard, it provided **valuable guidance** and found wide application in case law for the assessment not only of added subject-matter but also of novelty (see T 12/81, OJ 1982, 296, and Case Law of the Boards of Appeal, 9th ed., I.C.6.2). Consequently, in view of the importance of applying a uniform concept of disclosure for the purposes of Art. 54 and 123(2) EPC (see G 2/10, OJ 2012, 376, referring to G 1/03, OJ 2004, 413), and by the same token Art. 76(1) EPC, the board considered that a departure from this established criterion for selection inventions in the assessment of added subject-matter was not appropriate. The board emphasised that the combination of features resulting from selections from two or more lists, or pertaining to separate embodiments, only introduced added subject-matter in the absence of a pointer to that particular combination. In other words, the concept of selection from lists had to be applied with due regard to the whole content of the earlier application as filed.

b) Meaning of "selection from two lists"

The board in T 1374/07, referring to T 811/96, said that a selection of two components (here: fat and enzymes) from one list is in fact equivalent to a twofold selection from two identical lists (see also T 2375/09, T 1506/13). Thus, the board concluded that the addition of the feature "fat and enzymes" to claim 1 infringed Art. 123(2) EPC.

In T 197/08 the board observed that the feature "FIE as the sole active ingredient" was not as such mentioned in the original application. The respondent (opponent) had argued that the introduction of "as the sole active ingredient" in combination with FIE, which was selected from a group of compounds in which it was not its most preferred active