

patent application or European patent relates to such subject matter or activities as such". That no paradigm shift was intended may also be seen from the fact that e.g. Switzerland as a contracting state considered it unnecessary ("überflüssig") to include the contents of Art. 52(2) and (3) EPC 1973 in the national regulations when harmonising them with the EPC 1973 (see "Botschaft des Bundesrates an die Bundesversammlung über drei Patentübereinkommen und die Änderung des Patentgesetzes", 76.021, 24 March 1976, page 67).

Further, the board held that "technical character" was an implicit requisite of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 **did not exclude from patentability** any subject matter or activity having technical character, even if linked to items listed in this provision since these items are **only excluded "as such"** (Art. 52(3) EPC 1973). In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the technical features of the invention, i.e. the features which contribute to the technical character of the invention. These principles had indeed a clear and consistent basis in the EPC and in the case law of the boards of appeal and the Enlarged Board of Appeal, in particular (see also G 3/08, OJ 2011, 10; T 931/95, OJ 2001, 441; T 914/02; T 2383/10).

For further information on the technical character of the invention, see in this chapter I.A.1.1. "Technical character of an invention".

The issue of inventions with technical and non-technical subject-matter of an invention (mixed inventions) is analysed in detail in sub-chapter "Treatment of technical and non-technical features", within the chapter I.D.9. "Assessment of inventive step".

2.2. Discoveries, scientific theories and mathematical methods

Art. 52 EPC sets out in paragraph (2) (a)-(d) a non-exhaustive list of items which are not regarded as an invention. This includes "Discoveries, scientific theories and mathematical methods" in (a). These activities share the common feature that they do not aim at any direct technical result but are rather of an abstract and intellectual character (see T 22/85, OJ 1990, 12; T 854/90, OJ 1993, 669; T 338/00).

2.2.1 Discoveries and scientific theories

If a new property of a known material or article is found out, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1) EPC. If, however, that property is put to practical use, then this constitutes an invention which may be patentable. To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable. In addition, if a microorganism is discovered to exist in nature and to produce an antibiotic, the microorganism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy (Guidelines G-II, 3.1 – March 2022 version).