

jurisprudence; for cases delimiting implicit subject-matter from merely obvious subject-matter, see also in this chapter II.E.1.3.4.a)).

In T.917/94 the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC 1973, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

In T.1171/08 the board found that **indicating the purpose** as a functional feature in a use claim limited the claim to those embodiments whereby the purpose could be achieved. Only to that extent could the indication of purpose implicitly comprise features essential to achieving the desired selectivity. By no means, however, could the indication substitute the essential features specifically disclosed in that connection in an application. In the end, the board held that the skilled person could not derive the new combination of features directly and unambiguously from the application as filed.

1.3.4 Subject-matter not implicitly disclosed

a) Subject-matter merely rendered obvious by the content of the application

In T.329/99 the board stated that a clear distinction had to be made between the questions whether a particular embodiment was disclosed by an application, be it explicitly or implicitly, or/and whether that embodiment was merely rendered obvious by the application's disclosure (referring to T.823/96; see also T.1171/08). A particular technical embodiment might be rendered obvious on the basis of the content of an application as filed without, however, belonging to its explicit or implicit disclosure and therefore without serving as a valid basis for amendments complying with the requirements of Art. 123(2) EPC 1973.

In T.598/12 the board had to assess whether the skilled person using his **common general knowledge** would regard the additional technical information encompassed by the claims after the amendment as directly and unambiguously implicitly disclosed in the parent application as filed. The board stressed that it was not to be investigated whether this technical information derived from the prior art knowledge in the field. What had to be assessed was whether the notional skilled person working in the field would consider something as directly and unambiguously disclosed in the light of this common general knowledge. It recalled that the assessment of what information was implicitly disclosed in an application could not go beyond the limits of what the skilled person would objectively understand to be a direct and unambiguous consequence of the explicit disclosure in the particular case. Moreover, when performing this assessment, the common general knowledge could not serve to enlarge or replace, in a subjective or artificial manner, the actual content of the specification. The investigation of the actual disclosure in a patent application as filed could not turn into an investigation of obviousness or a search for obvious alternatives of the actual disclosure in the light of general prior art documents. See also T.3035/19.