

Enlarged Board of Appeal EPO, 11 December 1989, Mobil Oil – Friction reducing additive III



PATENT LAW

Change of category of claims

- A change of category of granted claims in opposition proceedings is not open to objection under Article 123 (3) EPC, if it does not result in extension of the protection conferred by the claims as a whole, when they are interpreted in accordance with Article 69 EPC and its Protocol. In this context, the national laws of the Contracting States relating to infringement should not be considered.

It is generally accepted as a principle underlying the EPC that a patent which claims a physical entity per se, confers absolute protection upon such physical entity; that is, wherever it exists and whatever its context (and therefore for all uses of such physical entity, whether known or unknown). It follows that if it can be shown that such physical entity (e.g. a compound) is already in the state of the art (for example in the context of a particular activity), then a claim to the physical entity per se lacks novelty. It also follows that a claim to a particular use of a compound is in effect a claim to the physical entity (the compound) only when it is being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore confers less protection than a claim to the physical entity per se. An amendment of a European patent during opposition proceedings simply by way of change of category from a claim to a physical entity per se (e.g. a compound or composition), so as to include a claim to a physical activity involving the use of such physical entity, therefore does not extend the protection conferred by the patent, and is admissible.

Second non-medical indication: new use of a known compound

- A claim to the use of a known compound for a particular purpose, which is based on a technical effect which is described in the patent, should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Article 54 (1) EPC provided that such technical feature has not previously been made available to the public.

In relation to a claim to a use of a known entity for a new purpose, the question initially arises: what are the technical features of the claim? If the claim includes as a technical feature a "new means of realisation" by which the new purpose is achieved, in the form of steps of a physical activity, which are not disclosed in the state of the art in association with the known entity,

then the claim is clearly novel because of the presence of that technical feature. In relation to a claim to a use of a known entity for a new purpose, the initial question is again: what are the technical features of the claimed invention? If the new purpose is achieved by a "means of realisation" which is already within the state of the art in association with the known entity, and if the only technical features in the claim are the (known) entity in association with the (old) means of realisation, then the claim includes no novel technical feature. In such a case, the only "novelty" in the claimed invention lies in the mind of the person carrying out the claimed invention, and is therefore subjective rather than objective, and not relevant to the considerations that are required when determining novelty under Article 54 (1) and (2) EPC.

- It follows that in the Enlarged Board's judgement, in relation to a claim to a new use of a known compound (the new purpose of such use being the only potentially novel feature), if on its proper construction the claim contains no technical feature which reflects such new use, and the wording of the claim which refers to such new use is merely mental in nature and does not define a technical feature, then the claim contains no novel technical feature and is invalid under Article 54 (1) and (2) EPC (because the only technical features in the claim are known).

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Enlarged Board of Appeal EPO, 11 December 1989

(P. Gori, G.D. Paterson, P. Ford, K. Jahn, C. Payraud, R. Schulte, P.K.J. van den Berg)

Decision of the Enlarged Board of Appeal dated 11 December 1989

G 2/88

Composition of the Board:

Chairman: P. Gori

Members: G.D. Paterson, P. Ford, K. Jahn, C. Payraud, R. Schulte, P.K.J. van den Berg

Patent proprietor/Appellant:

Mobil Oil Corporation

Opponent/Respondent: Chevron

Research Company

Headword: Friction reducing additive/MOBIL OIL III

Summary of the Procedure

I. In case T 59/87, Friction Reducing Additive (OJ EPO 1988, 347), Chemical Board of Appeal 3.3.1 in its Decision dated 26 April 1988 of its own motion referred three questions of law to the Enlarged Board of Appeal under Article 112 (1) (a) EPC:

(i) When amended claims involving a change of category (here: from a "compound" claim to "use of that compound in a composition for specified purpose") are proposed in opposition proceedings, what considerations should be taken into account when deciding on the admissibility of such amendments having regard to Article 123 (3) EPC? In particular, how far should the

national laws of Contracting States relating to infringement be considered?

(ii) Can a patent with claims directed to a "compound" and to a "composition including such compound" be amended during opposition proceedings so that the claims are directed to the "use of that compound in a composition" for a particular purpose?

(iii) Is a claim to the use of a compound for a particular non-medical purpose novel for the purpose of Article 54 EPC, having regard to a prior publication which discloses the use of that compound for a different non-medical purpose, so that the only novel feature in the claim is the purpose for which the compound is used?

II. In a communication dated 14 October 1988, preliminary views were expressed in relation to question (i), and the parties were invited to file observations on all the questions. As to question (iii), attention was drawn to co-pending appeal G 6/88 in which substantially the same question had been referred to the Enlarged Board (by Decision T 208/88 dated 20 July 1988). Both parties filed initial observations dated 1 and 23 February 1989, respectively, and further observations in reply dated 30 May and 5 June 1989. Both parties requested oral proceedings under Article 116 EPC.

III. As to question (i):

In the communication dated 14 October 1988, it was suggested that the "protection conferred" by a patent is to be determined in accordance with Article 69 EPC and its Protocol, and is distinct from the "rights conferred" by a patent which are to be determined by individual national laws of the designated Contracting States in accordance with Article 64 (1) EPC. Accordingly, under Article 123 (3) EPC the question to be considered is whether the matter which is protected by the claim, as defined by its technical features, is extended. The Appellant submitted that rigid lines of demarcation between categories of claims and the protection thereby conferred did not exist, and that the considerations under Article 123 (3) EPC were as set out by the Enlarged Board in the communication. The Respondent submitted that a "use" claim in respect of an article is narrower in scope than an original "article" claim; and that it was not necessary to consider national laws concerning infringement, for the reason set out in the above communication.

IV. As to question (ii):

The Appellant relied upon Decision T 378/86 (OJ EPO, 1988, 386) in support of his submission that the extent of protection conferred by a "product" claim encompasses that conferred by a "use" claim, and further submitted that amendment from a per se product claim to a use claim was therefore a disclaimer. The Respondent agreed that such an amendment did not contravene Article 123 (3) EPC, and was allowable provided that such use is disclosed in the patent specification as originally filed and as granted, and that the use is both novel and inventive.

V. As to question (iii):

(a) In his initial observations, the Appellant submitted that the intended use or purpose as expressed in the claims confers novelty on them, in accordance with a

line of authority developed by decisions of the Boards of Appeal, in accordance with the EPC. The submissions on behalf of the Appellant in case G 6/88 were adopted by the Appellant.

(b) In his initial observations, the Respondent submitted that the Board of Appeal in Decision T 231/85 (OJ EPO 1989, 74) was wrong in finding that the disclosure of a substance does not destroy the novelty of a previously unknown use of this substance, even if the new use does not involve any different technical measures. It was further submitted that Decision T 231/85 had failed to take account of the exclusion of "discoveries" from "inventions within the meaning of Article 52 (1) EPC", in Article 52 (2) EPC. With reference to the facts of the case under appeal, the Respondent further submitted that the previously described "use" had inherently given rise to the newly claimed use as well, so that the proposed claim could not be enforced. It was submitted to be in the legitimate interest of the general public that inventions of the kind in question should not be patentable, because the public should be free to make use of prior disclosures without risk of infringement of a later patent in respect of a mere discovery of a new property or use.

(c) In his reply, with particular reference to question (iii), the Appellant submitted that the referred question was concerned with novelty under Article 54 EPC, and not with patentability under Article 52 EPC.

(d) In support of his previous submissions concerning novelty, the Respondent expanded upon what was called the "doctrine of inherency". He submitted that the proposed claim is not novel because the new use does not involve any new means of realisation, and that a finding of lack of novelty would be in line with the law and practice of nearly all the Contracting States, the main reason being that the previously disclosed use of the additive, for the purpose of inhibiting rust formation, would inherently be a use as a friction reducing additive as well.

VI. (a) During the oral proceedings which took place on 26 June 1989, the Appellant emphasised that his request for amendment so as to include the "use" claim gave rise to the proceedings before the Enlarged Board (see Decision T 59/87), and was based upon what was set out in Decision G 5/83 especially paragraph 21 thereof. In relation to the question of novelty of purpose, he submitted that the decisive consideration was whether or not the purpose was technically-related: if yes, there was novelty, even if the means of realisation of that purpose is the same as previously known. The Respondent's previous observations in reply were generally contested under three headings:

(i) The relationship between "novelty of purpose" and "discovery";

(ii) the alleged difficulties of enforcement of a use claim having novelty of purpose;

(iii) the doctrine of inherency.

(b) In reply, the Respondent also relied upon Decision G 5/83. He emphasised the distinction between "new use of an old thing for a new purpose" and "old use of an old thing for a new purpose". The latter type of

claim was generally never allowable. Such a claim would confer protection on a subjective basis, which is not in accordance with the law on infringement. At the conclusion of the oral proceedings, the Board reserved its decision.

VII. By letter dated 3 August 1989, the President of the European Patent Office presented to the Chairman of the Enlarged Board of Appeal a written reasoned request to be invited to comment upon some questions of general interest which arose in connection with question (iii), pursuant to Article 11a of the Rules of Procedure of the Enlarged Board of Appeal, which came into force on 7 July 1989 (OJ EPO 1989, 362). By letter dated 13 September 1989, the Chairman replied to the President that the Enlarged Board had decided not to invite him to comment, particularly having regard to the fact that the relevant question of law was first referred to the Enlarged Board on 26 April 1988, that oral proceedings took place on 26 June 1989, and that the Enlarged Board was at an advanced stage in its deliberations preceding the issue of its decision.

Reasons for the Decision

Background and introduction

1. In the present case, a Board of Appeal has referred three questions to the Enlarged Board for the reason that two important points of law have arisen during the proceedings on the case before it. The first point of law primarily concerns the proper interpretation of Article 123 (3) EPC, with particular reference to an amendment during opposition proceedings which involves a change of "category" of the claim; the second point of law primarily concerns the proper interpretation of Article 54 EPC with particular reference to a use claim where the only novel feature lies in the purpose of such use. Having regard to the purpose for which questions are referred to the Enlarged Board, as set out in Article 112 EPC, in a case such as the present, it is appropriate that the Enlarged Board should not take too narrow a view of the questions which have been referred, but should consider and answer such questions in such a way as to clarify the points of law which lie behind them.

2. Both points of law are concerned with the interpretation and effect of patent claims.

2.1 Prior to the entry into force of the EPC in 1978, the role of patent claims in determining the protection conferred by a patent had developed differently within the national patent systems of the countries that are now Contracting States. Such different development reflected somewhat different national philosophies underlying the concept of patent protection. In particular, the extent to which the wording of the claims determined the scope of protection varied considerably from country to country, and this factor significantly affected drafting practice. In some countries, in particular Germany, in practice the protection conferred by a patent depended more upon what was perceived to be the inventor's contribution to the art, as disclosed in the patent, by way of the general inventive concept, than upon the wording of the claims. In other countries, in particular the United Kingdom, the precise wording of the claims

was regarded as crucial, because the claims were required to define the boundary between what was protected and what was not, for purposes of legal certainty. The manner in which claims were drafted naturally developed differently in the different countries, depending upon the relative importance of their function. Clearly in a country such as the United Kingdom, the wording of a claim had to provide a much more precise definition of what was sought to be protected than in countries such as Germany, where a statement of the essence of the inventive concept was more appropriate.

2.2 There are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use). These two basic types of claim are sometimes referred to as the two possible "categories" of claim. In this decision, however, the word category is used to refer generally to the various different possible classifications of claim. Within the above two basic types of claim various sub-classes are possible (e.g. a compound, a composition, a machine; or a manufacturing method, a process of producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim.

2.3 All three questions which have been referred to the Enlarged Board are concerned with "use" claims: that is, with claims defining a "use of compound X for a particular purpose", or similar wording. The recognition or discovery of a previously unknown property of a known compound, such property providing a new technical effect, can clearly involve a valuable and inventive contribution to the art. In countries such as Germany, such inventions have for many years commonly been sought to be protected by means of "use" claims. In countries such as the United Kingdom, prior to 1978 such use claims were rarely found in patent applications and patents; a claim to an invention of such a character would normally have been defined in terms of the essential physical steps comprising the "activity" to be protected.

2.4 Despite the entry into force of the EPC, European patent applications originating in the different Contracting States have continued commonly to include claims drafted in accordance with the traditional practices of such Contracting States discussed above. However, the requirements for drafting and amending claims in respect of inventions which are the subject of European patent applications and patents, and the patentability of such inventions, are all matters which must be decided upon the basis of the law under the EPC. The function of the claims is central to the operation of the European patent system.

2.5 Article 84 EPC provides that the claims of a European patent application "shall define the matter for which protection is sought". Rule 29(1) EPC further requires that the claims "shall define the matter for which protection is sought in terms of the technical fea-

tures of the invention". The primary aim of the wording used in a claim must therefore be to satisfy such requirements, having regard to the particular nature of the subject invention, and having regard also to the purpose of such claims. The purpose of claims under the EPC is to enable the protection conferred by the patent (or patent application) to be determined (Article 69 EPC), and thus the rights of the patent owner within the designated Contracting States (Article 64 EPC), having regard to the patentability requirements of Articles 52 to 57 EPC. It follows that the technical features of the invention are the physical features which are essential to it. When considering the two basic types of claim referred to in paragraph 2.2 above the technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity. A number of decisions of the Boards of Appeal have held that in appropriate cases technical features may be defined functionally (see e.g. T 68/85, OJ EPO, 1987, 228; T 139/85 EPOR 1987, 229).

2.6 It is apparent from the above that the subject-matter of a claimed invention involves two aspects: first, the category or type of the claim, and second, the technical features, which constitute its technical subject-matter.

3. Questions (i) and (ii)

Since one point of law is common to the first two questions which have been referred to the Enlarged Board, these will be considered together.

3.1 The first question relates to a proposed amendment of claims involving a "change of category". The question uses the word "category" to distinguish between a "compound" or "composition" claim on the one hand, and a "use" claim (of a composition including such compound) on the other hand; and the reference to a "change" of category is a reference to the fact that the proposed amendment introduces into the patent a type of claim, namely a "use" claim, which was not previously present.

3.2 Article 123 (3) EPC provides that "The claims of the European patent may not be amended ... in such a way as to extend the protection conferred"; in other words, it is the totality of the claims before amendment *in comparila son* with the totality of the claims after the proposed amendment that has to be considered. It is further to be noted that there is nothing in Article 123 EPC to suggest that an amendment involving a change of category is to be considered differently from any other proposed amendment during opposition proceedings. On the contrary, when deciding upon the admissibility of an amendment involving a change of category, the considerations are, in principle, the same as when deciding upon the admissibility of any other proposed amendment under Article 123 (3) EPC.

3.3 Question (i) asks in particular how far should the national laws of Contracting States relating to infringement be considered, when deciding upon admissibility under Article 123 (3) EPC. As touched upon previously in paragraph 2.5 above, the protection conferred by a patent is to be determined by interpretation of the terms of the claims, and the rights of the

patent proprietor flow from the protection which is conferred. There is a clear distinction between the protection which is conferred and the rights which are conferred by a European patent, however. The protection conferred by a patent is determined by the terms of the claims (Article 69 (1) EPC), and in particular by the categories of such claims and their technical features. In this connection, Article 69 EPC and its Protocol are to be applied, both in proceedings before the EPO and in proceedings within the Contracting States, whenever it is necessary to determine the protection which is conferred. In contrast, the rights conferred on the proprietor of a European patent (Article 64(1) EPC) are the legal rights which the law of a designated Contracting State may confer upon the proprietor, for example, as regards what acts of third parties constitute infringement of the patent, and as regards the remedies which are available in respect of any infringement. In other words, in general terms, determination of the "extent of the protection conferred" by a patent under Article 69 (1) EPC is a determination of what is protected, in terms of category plus technical features; whereas the "rights conferred" by a patent are a matter solely for the designated Contracting States, and are related to how such subject-matter is protected. It follows that when deciding upon the admissibility of any amendment to the claims of a patent which is proposed in opposition proceedings (whether or not such amendment involves a change of category of claim), what has to be considered and decided is whether the subject-matter which is protected by the claims, as defined by their categories in combination with their technical features, is extended. It is not necessary to consider the national laws of the Contracting States in relation to infringement when making such a decision, however.

4. When considering whether a proposed amendment to the claims is such as to extend the protection conferred, a first step must be to determine the extent of protection which is conferred by the patent before the amendment: it is necessary to be quite clear as to what is the protection conferred by the patent without amendment, before one can decide whether a proposed amendment is such as to extend it. Determination of the extent of protection has to be carried out in accordance with Article 69 (1) EPC and its Protocol, which provides a guide to the manner in which the technical features of the claim are to be interpreted. The Protocol was adopted by the Contracting States as an integral part of the EPC in order to provide a mechanism for harmonisation of the various national approaches to the drafting and interpretation of claims discussed in paragraph 2.1 above. The central role of the claims under the EPC would clearly be undermined if the protection and consequently the rights conferred within individual designated Contracting States varied widely as a result of purely national traditions of claim interpretation: and the Protocol was added to the EPC as a supplement primarily directed to providing an intermediate method of interpretation of claims of European patents throughout their life, as a compromise between the various national

approaches to interpretation and determination of the protection conferred ("... so as to combine a fair protection for the patentee with a reasonable degree of certainty for third parties"). The object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition. This approach to interpretation of claims must be adopted by the EPO when determining the protection conferred for the purpose of Article 123 (3) EPC.

4.1 In general terms, the question to be considered under Article 123 (3) EPC is whether the subject-matter defined by the claims is more or less narrowly defined as a result of the amendment. A proposed amendment may involve a change of category, or a change in the technical features of the invention, or both. Each type of amendment requires separate consideration. In the case of a change in the technical features of the invention, if the technical features of the claimed invention after amendment are more narrowly defined, the extent of the protection conferred is less; and if such technical features are less narrowly defined as a result of amendment, the protection conferred is therefore extended. Clearly, if technical features are changed by an amendment, in that the technical subject-matter of the claims after amendment is outside the scope of the technical subject-matter before amendment, there is then necessarily an extension of protection. In the case of a change of category (in the sense discussed in paragraph 3.1 above), the protection conferred by the categories of claims in the patent before amendment must be compared with the protection conferred by the new category of claim introduced by the amendment. The considerations that are involved in deciding upon the admissibility of this type of amendment lie at the heart of the first two questions that have been referred to the Enlarged Board.

5. With reference to the factual situation which is referred to in question (ii), such a proposed amendment commonly arises in circumstances where the patent application has been drafted and granted on the basis that the compound is new per se. The claims of the patent therefore include claims to the compound, and (when appropriate) claims to a composition including such compound (i.e. claims to a physical entity). The discovered use of such compound or composition will normally be described in the patent, but may not be expressly claimed. If the grounds of an opposition then show that the compound per se is already within the state of the art but the use of the compound as disclosed in the patent is not within the state of the art, the patent proprietor may then propose an amendment involving a change of category, so as to include claims to the (disclosed) use of the compound (i.e. claims to an activity). In such circumstances the claims will include additional technical features of the claimed invention, as a

result of the change of category. An initial question to be considered in such a case is the protection which is conferred by a claim to a physical entity such as a compound, per se. It is generally accepted as a principle underlying the EPC that a patent which claims a physical entity per se, confers absolute protection upon such physical entity; that is, wherever it exists and whatever its context (and therefore for all uses of such physical entity, whether known or unknown). It follows that if it can be shown that such physical entity (e.g. a compound) is already in the state of the art (for example in the context of a particular activity), then a claim to the physical entity per se lacks novelty. It also follows that a claim to a particular use of a compound is in effect a claim to the physical entity (the compound) only when it is being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore confers less protection than a claim to the physical entity per se. An amendment of a European patent during opposition proceedings simply by way of change of category from a claim to a physical entity per se (e.g. a compound or composition), so as to include a claim to a physical activity involving the use of such physical entity, therefore does not extend the protection conferred by the patent, and is admissible.

5.1 The Board has considered the effect of Article 64 (2) EPC upon the question whether an amendment involving a change from, for example, a compound claim to a claim to a use of such compound will cause extension of the protection conferred. In particular, it could be considered that such a "use" claim is notionally equivalent to a claim to a "process including the step of using the compound", and that the effect of Article 64 (2) EPC is to extend protection to the "product" of such process (whatever it is); thus there would be extension of protection within the meaning of Article 123 (3) EPC by reason of the change from a claim to one physical entity (the compound) to a different physical entity (the "product" of the process of using the compound). In the Board's view, in relation to such a change of category to a "use" claim, Article 64 (2) EPC does not normally have such an effect, however, for the following reason. Article 64 (2) EPC is not directed to a patent whose claimed subject-matter is the use of a product to achieve an effect (this being the normal subject of a use claim): it is directed to a European patent whose claimed technical subject-matter is a process of manufacture of a product; the Article provides that for such a patent, protection is conferred not only upon the claimed process of manufacture, but also upon the product resulting directly from the manufacture. Thus, provided that a use claim in reality defines the use of a particular physical entity to achieve an "effect", and does not define such a use to produce a "product", the use claim is not a process claim within the meaning of Article 64 (2) EPC.

6. Question (iii)

6.1 The legal problems associated with the patentability of claims to the new use of a known compound provided the subject-matter for the first seven Decisions to be

issued [by the Enlarged Board of Appeal, namely G 1- 7/83](#) (three of which, G 1/83, G 5/83 and G 6/83 in German, English and French respectively, are published in OJ EPO 1985, 60, 64, 67). Such Decisions were all concerned with the patentability of further medical uses for a substance already known to have one medical use; and with the appropriate form of claim in respect of such an invention. All such Decisions have essentially the same content. In this Decision, it is only necessary to refer to [the relevant English language Decision, G 5/83](#). Since both parties referred to and relied upon G 5/83, the present Enlarged Board has considered how far the reasoning there set out bears upon the point of law to be decided in the present case. The question of law which was referred to the Enlarged Board in G 5/83 arose essentially because of the particular exclusion from patentability in relation to "methods of treatment of the human or animal body" set out in the first sentence of Article 52 (4) EPC, and the exception to that exclusion set out in Article 54 (5) EPC. The reasoning in [G 5/83](#) is therefore primarily directed to answering a question of law concerning the allowability of claims whose subject-matter is a particular kind of medical or veterinary invention. The *ratio decidendi* of that Decision is essentially confined to the proper interpretation of Articles 52 (4) and 54(5) EPC in their context. In that field of technology, the normal type of use claim is prohibited by Article 52 (4) EPC, but Article 54(5) EPC expressly provides for an exception to the general rules for novelty (Articles 54 (1) to (5) EPC) in respect of the first medical or veterinary use of a substance or composition, by allowing a claim to the substances or compositions for that use. [G 5/83](#) was concerned with making a limited exception to the general rules for novelty in cases of second and subsequent therapeutic use, but expressly indicated that such a special approach to the derivation of novelty could only be applied to claims to the use of substances or compositions intended for use in a method referred to in Article 52 (4) EPC. The present Enlarged Board of Appeal endorses that view and for that reason does not accept the arguments of the Appellant based on [G 5/83](#). [G 5/83](#) has the effect of giving to the inventor of a new use for a known medicament a protection analogous to but restricted in comparison with the protection normally allowable for a new non-medical use. The patentability of a second non-medical new and non-obvious use of a product is clearly recognised in principle (see Reasons 21). The patentability of "the (second or subsequent) use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application" was accepted, because although the exclusion of therapeutic methods from patentability provided in Article 52 (4) (on the ground that then these are not susceptible of industrial application) has the effect of excluding from patentability a claim directed to the use of a substance for therapy (see Reasons 13), this type of claim would be clearly allowable (as susceptible of industrial application) for a non-medical use. Compare: "The use of X for treating disease A in mammals" (not allowed),

with "The use of X for treating disease B in cereal crops" (allowed). In contrast, the question of law which has been referred to the Enlarged Board in the present case is not related to medical inventions but is of a general nature, being primarily concerned with the question of interpretation of Article 54 (1) and (2) EPC.

6.2 Question (iii) assumes that the only novel feature in the claim under consideration is the purpose for which the compound is to be used. However, insofar as the question of interpretation of Article 54 (1) and (2) EPC and the question of the allowable scope of protection (if any) of inventions concerning a further non-medical use are matters of general importance, it will be appropriate for this Board to consider the question raised more generally, and in particular to consider other possible constructions for such use claims.

7. As discussed in the Introduction at paragraphs 2 to 2.5 above, the claims of a European patent should clearly define the technical features of the subject invention and thus its technical subjectmatter, in order that the protection conferred by the patent can be determined and a comparison can be made with the state of the art to ensure that the claimed invention is *inter alia* novel. A claimed invention lacks novelty unless it includes at least one essential technical feature which distinguishes it from the state of the art. When deciding upon the novelty of a claim, a basic initial consideration is therefore to construe the claim in order to determine its technical features.

7.1 The Appellant submitted (see paragraph VI (a) above) in relation to the type of claim in question that if the alleged new purpose is "technically related", then even if the means of realisation (i.e. the method steps) of the alleged new purpose were the same as the means of realisation previously known for a previously known purpose, the claim should be held to be novel. In reply, the Respondent submitted (paragraph VI (b) above) that a distinction should be drawn between a claim for "a new use of an old thing for a new purpose" and a claim for "an old use of an old thing for a new purpose". While the former kind of claim could be novel, the latter kind of claim should never be held to be novel, because the only novel "feature" of such a claim was a "mental novelty" devoid of technical effect. In the Enlarged Board's view, the distinction drawn by the Respondent is a fundamental one, and can be developed as follows. In relation to a claim to a use of a known entity for a new purpose, the question initially arises: what are the technical features of the claim? If the claim includes as a technical feature a "new means of realisation" by which the new purpose is achieved, in the form of steps of a physical activity, which are not disclosed in the state of the art in association with the known entity, then the claim is clearly novel because of the presence of that technical feature. In relation to a claim to a use of a known entity for a new purpose, the initial question is again: what are the technical features of the claimed invention? If the new purpose is achieved by a "means of realisation" which is already within the state of the art in association with the known entity, and if the only technical features in the claim are

the (known) entity in association with the (old) means of realisation, then the claim includes no novel technical feature. In such a case, the only "novelty" in the claimed invention lies in the mind of the person carrying out the claimed invention, and is therefore subjective rather than objective, and not relevant to the considerations that are required when determining novelty under Article 54 (1) and (2) EPC.

7.2 It follows that in the Enlarged Board's judgement, in relation to a claim to a new use of a known compound (the new purpose of such use being the only potentially novel feature), if on its proper construction the claim contains no technical feature which reflects such new use, and the wording of the claim which refers to such new use is merely mental in nature and does not define a technical feature, then the claim contains no novel technical feature and is invalid under Article 54 (1) and (2) EPC (because the only technical features in the claim are known).

7.3 In relation to such a claim having no novel technical feature, there is of course no need to consider whether the claimed invention is in respect of a discovery (as argued by the Respondent - see paragraph V (b) above) or is otherwise excluded from patentability by virtue of Article 52 (2) EPC.

8. Depending upon the particular wording of a particular claim, the above construction is not the only possible construction of a claim concerning the new use of a known compound, however. In particular cases it may clearly be necessary to consider and decide whether a claimed invention is a discovery within the meaning of Article 52 (2) (a) EPC. An essential first step in such consideration is to construe the claim so as to determine its technical features. If, after such determination, it is clear that the claimed invention relates to a discovery or other excluded subject-matter "as such" (Article 52 (3) EPC), then the exclusion of Article 52 (2) EPC applies. In this connection, as was recognised in Decision T 208/84 (OJ EPO 1987, 14) (dealing there with a mathematical method rather than a discovery, but the same principle applies), the fact that the idea or concept underlying the claimed subject-matter resides in a discovery does not necessarily mean that the claimed subject-matter is a discovery "as such". In a particular case, it is possible that there may be concurrent objections under Article 54 (1) and (2) EPC and under Article 52 (2) and (3) EPC. They are distinct objections, however.

9. In relation to a claim whose wording clearly defines a new use of a known compound, depending upon its particular wording in the context of the remainder of the patent, the proper interpretation of the claim will normally be such that the attaining of a new technical effect which underlies the new use is a technical feature of the claimed invention. In this connection, and with reference to the discussion in paragraphs 2.1 and 2.2 above, it is necessary to bear in mind the Protocol to Article 69 EPC, as discussed in paragraph 4 above. Thus with such a claim, where a particular technical effect which underlies such use is described in the patent, having regard to the Protocol, the proper

interpretation of the claim will require that a functional feature should be implied into the claim, as a technical feature; for example, that the compound actually achieves the particular effect.

9.1 An example of such a claim which should be so interpreted can be given by reference to the facts in Decision T 231/85 (OJ EPO 1989, 74). The claims in question define "Use of (certain compounds) ... for controlling fungi and for preventive fungus control" - and the application contained teaching as to how to carry this out so as to achieve this effect. Prior published document (1) described the use of the same compounds for influencing plant growth. In both the application in suit and document (1), the respective treatments were carried out in the same way (so the means of realisation was the same). The Examining Division held that the claimed invention lacked novelty, apparently on the basis that the means of realisation was the same in document (1), and so the claimed effect underlying the use for fungus control must have been achieved in the treatment described in document (1). The Board of Appeal on the other hand held that the claimed invention was novel, on the basis that the technical teaching ("Lehre") in the application was different from that in document (1), and that the use was hitherto unknown, even though the means of realisation was the same. In the view of the Enlarged Board, with reference to the discussion concerning the interpretation of claims in paragraph 9 above, the claim in question should properly be construed, having regard to the Protocol to Article 69 EPC, as implicitly including the following functional technical feature: that the named compounds, when used in accordance with the described means of realisation, in fact achieve the effect (i.e. perform the function) of controlling fungus. Such a functional feature is a technical feature which qualifies the invention: and the use claim is properly to be considered as a claim containing technical features both to the physical entity (the compound and its nature), and to a physical activity (the means of realisation). In other words, when following the method of interpretation of claims set out in the Protocol, what is required in the context of a claim to the "use of a compound A for purpose B" is that such a claim should not be interpreted literally, as only including by way of technical features "the compound" and "the means of realisation of purpose B"; it should be interpreted (in appropriate cases) as also including as a technical feature the function of achieving purpose B, (because this is the technical result). Such a method of interpretation, in the view of the Enlarged Board, is in accordance with the object and intention of the Protocol to Article 69 EPC. If the proper construction of such a claim in the context of a particular patent is such as to include such a functional technical feature, the question which remains to be considered is whether such claimed invention is novel.

10. Article 54 (2) EPC defines the state of the art as comprising "everything made available to the public by means of a written or oral description, by use, or in any other way". Thus, whatever the physical means by which information is made available to the public (e.g.

written description, oral description, use, pictorial description on a film or in a photograph, etc., or a combination of such means), the question of what has been made available to the public is one of fact in each case. The word "available" carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, or laid open for inspection. In the case of a "written description" which is open for inspection, what is made available in particular is the information content of the written description. Furthermore, in some cases, the information which the written description actually contains, teaching the carrying out of a process for example, also makes available further information which is the inevitable result of carrying out such teaching (see in this respect Decision T 12/81 Diastereomers, OJ EPO 1982, 296, Reasons paragraphs 7 to 10, Decision T 124/87, Copolymers EPOR 1989, 33 and Decision T 303/86 Flavour concentrates, EPOR 1989, 95 for example). In each such case, however, a line must be drawn between what is in fact made available, and what remains hidden or otherwise has not been made available. In this connection the distinction should also be emphasised between lack of novelty and lack of inventive step: information equivalent to a claimed invention may be "made available" (lack of novelty), or may not have been made available but obvious (novel, but lack of inventive step), or not made available and not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious.

10.1 As mentioned in paragraphs V (b) and (d) above, the Respondent submitted that in cases where, for example, a compound has previously been described as having been used, but for a different purpose from the claimed use, and the previously described use had inherently had the same technical effect as the claimed use, on this basis there was lack of novelty (a so-called "doctrine of inherency"). In this connection, he also relied upon the problems involved in relation to infringement if there was no finding of lack of novelty in such circumstances: in particular, a user of the previously described use would risk infringement of a later filed patent. In respect of this submission, the Enlarged Board would emphasise that under Article 54 (2) EPC the question to be decided is what has been "made available" to the public: the question is not what may have been "inherent" in what was made available (by a prior written description, or in what has previously been used (prior use), for example). Under the EPC, a hidden or secret use, because it has not been made available to the public, is not a ground of objection to validity of a European patent. In this respect, the provisions of the EPC may differ from the previous national laws of some Contracting States, and even from the current national laws of some non-Contracting States. Thus, the question of "inherency" does not arise as such under Article 54 EPC. Any vested right derived from prior use of an invention is a matter for national law (see, in this connection, e.g. Article 38 of the Community Patent Convention, not yet in force). Furthermore,

as to the suggested problems concerning infringement referred to above, it is to be noted that analogous problems would result from G 5/83 in the medical area.

10.2 This point may be illustrated by a further reference to the facts of Decision T 231/85. If the claims are interpreted as discussed in paragraph 9.1 above, the question in relation to novelty is whether document (1) made available to the public the technical feature that the compounds, when used as described, achieved the effect of controlling fungus. The Board of Appeal there referred in its decision to the "hitherto unknown" use of such compounds for controlling fungi and the "unnoticed protective effect" (even though the means of application of such compounds to plants (the "technical realisation") was the same). Thus, although document (1) described a method of treating plants with compounds in order to regulate their growth which, when carried out, would inevitably have been inherently a use of such compounds for controlling fungi, nevertheless it appears that the technical feature of the claim set out above and underlying such use was not "made available" to the public by the prior written description in document (1).

10.3 The answer to question (iii) may therefore be summarised as follows: with respect to a claim to a new use of a known compound, such new use may reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim (e.g. the achievement in a particular context of that technical effect). If that technical feature has not been previously made available to the public by any of the means as set out in Article 54 (2) EPC, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public.

Order

For these reasons, it is decided that the questions of law which were referred to the Enlarged Board of Appeal are answered as follows:

(i) A change of category of granted claims in opposition proceedings is not open to objection under Article 123 (3) EPC, if it does not result in extension of the protection conferred by the claims as a whole, when they are interpreted in accordance with Article 69 EPC and its Protocol. In this context, the national laws of the Contracting States relating to infringement should not be considered.

(ii) An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims are directed to "the use of that compound in a composition" for a particular purpose, is not open to objection under Article 123 (3) EPC.

(iii) A claim to the use of a known compound for a particular purpose, which is based on a technical effect which is described in the patent, should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Article 54 (1) EPC provided that such technical

feature has not previously been made available to the public.
