

assessment of whether or not information was directly and unambiguously derivable from that previously presented in the originally filed application or in a prior document respectively. An amendment was not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, was novel when compared with the content of the original application or, looked at another way, if the said change in content would be novelty-destroying for a hypothetical future claim when the original content would not be.

T.133/85 (OJ 1988, 441) pointed out that care was necessary when applying the law relating to novelty to questions which arose in relation to Art. 123(2) EPC 1973. In T.177/86 the novelty test was described as "not very useful" for examining the admissibility of broadening a claim (see also T.150/07 for a case where the preferred embodiments of an invention were combined with the more general teaching thereof).

In T.187/91 (OJ 1994, 572) the board conceded that there was clearly a close conceptual correlation between the assessment of novelty and the assessment of what was an allowable amendment under Art. 123(2) EPC 1973. It further explained, however, that the considerations which underlay Art. 123(2) EPC 1973 were different from those that underlay Art. 54 EPC 1973: One consideration which underlies Art. 123(2) EPC is that the content of the application as filed and as published determines the matter for which protection may be sought in the claims of that application and accordingly gives an indication to the public of the protection which may be granted. A further consideration underlying the relationship between the claims and content of the European patent application is that, after appropriate amendment if necessary, the granted claims should give a fair protection for the inventive subject-matter contained in the application as filed.

In T.288/92 the board considered that the examination of the allowability of an amendment according to Art. 123(2) EPC 1973 was directed to the process of "derivation" (see also T.383/88), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. In the view of the board this provided a definitive method for deciding the allowability of an amendment. Any other "test", such as the "novelty test", necessarily posed hypothetical questions.

In T.873/94 (OJ 1997, 456) the board pointed out that where a proposal for amending an application involved the **addition of a limiting feature** to a claim, applying a "novelty test" was not appropriate for determining whether or not the amendment complied with Art. 123(2) EPC 1973.

1.3.8 Non-technical subject-matter

In case T.619/05 the amendment concerned a feature not contributing to the solution of any technical problem by providing a technical effect. It was thus non-technical subject-matter. The term "subject-matter" in Art. 123(2) EPC, without a qualifier, seemed to indicate that this article applied to non-technical as well as technical subject-matter. Thus, any amendments concerning non-technical subject-matter should also be derivable from the patent application as filed. A difficulty in this connection was that a technically skilled person might not have the knowledge necessary in order to determine whether non-