

patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973. In this case also the patent could be maintained (G 1/93, Headnote 2). See below in this chapter II.E.3.2.4.

In T 1180/05 the board, on the basis of decisions G 1/93 and G 1/03 (OJ 2004, 413) dealing with Art. 123(2) and (3) EPC 1973 and with disclaimers, came to the conclusion that the deletion of a feature in a granted claim, which feature extended beyond the content of the application as filed, and its reintroduction in the form of a disclaimer, so that the subject-matter of the claim remained the same, was not suitable to overcome the potential conflict between Art. 123(2) and (3) EPC 1973. The decision of the opposition division maintaining the patent in amended form was set aside and the patent revoked.

Further circumstances in which boards have found that the conflict could be solved were mentioned in T 1127/16:

- The added undisclosed, limiting feature in contravention of Art. 123(2) EPC 1973 could be maintained in the claim without violating Art. 123(2) EPC 1973 provided that a further limiting feature was added to the claim which further feature was properly disclosed in the application as filed, and deprived the undisclosed feature of all technical contribution to the subject-matter of the claimed invention (T 553/99).

- The added undisclosed feature **could effectively be ignored** if it did not add anything over the other features of the respective claim, such that it had to be considered **redundant** (T 310/13).

- If the added undisclosed feature – in T 131/15 an expression – taken literally and in isolation, had the effect of excluding all of the disclosed embodiments from the scope of protection, but a definition of this feature could be derived from the patent itself which would locate (at least some of) the disclosed embodiments within the ambit of the claim, and if this definition was not manifestly unreasonable, having regard to the normal meaning of the words used in the expression, then in judging compliance with the requirements of Art. 123(3) EPC, the scope of protection should normally be considered to include at least that which would fall within the terms of the claim understood according to this definition (T 131/15). The board in T 1127/16 expressed doubts about this test and distinguished its case from the facts underlying T 131/15. On these two decisions and on earlier decisions regarding inconsistencies and the inescapable trap between the requirements of Art. 123(2) and (3), see below in this chapter II.E.3.2.5.

- One further circumstance referred to in T 1127/16 (replacement of the added undisclosed feature by a broader feature) is presented below in chapter II.E.3.2.2 as a sub-case of the instance set out in G 1/93, Headnote 1.

The board noted in T 335/03 that, according to G 1/93, there was no basis in the Convention for providing a claim with a footnote to the following effect; "This feature is the subject of an inadmissible extension. No rights may be derived from this feature"; in