

and its Protocol (G 2/88, OJ 1990, 93; see also e.g. T 81/03, T 547/08, T 1832/17 and T 970/17, all with reference to G 2/88, and in this chapter II.E.2.3.1b)).

In T 325/95 the board pointed out that the assumption that the extent of protection referred to in Art. 123(3) EPC 1973 would depend not only on the actual wording of the claims, but also on their validity in view of the prior art, was not supported by the explicit statement in Art. 69 EPC 1973 that "the extent of the protection conferred by a European patent ... shall be determined by the terms of the claims". The appellant's submissions also implied that claims amended in opposition proceedings should always have a counterpart in the set of claims as granted. The board noted that this was not in line with the consistent case law of the EPO either. Attention was drawn for instance to decision G 2/88 (OJ 1990, 93), which ruled that replacement of a granted claim to a compound or composition by a claim directed to a new use of the compound or composition was admissible under Art. 123(3) EPC 1973.

- b) Protection conferred within the meaning of Article 123(3) EPC not determined by subject-matter at issue in national infringement proceedings

As stressed in numerous decisions with reference to G 2/88 (OJ 1990, 93), it is unnecessary when deciding on admissibility of an amendment under Art. 123(3) EPC to consider the national laws of the contracting states relating to infringement and this issue is not relevant (see e.g. T 81/03, T 547/08 and T 970/17).

In T 81/03 the board stressed that the general, abstract concern that the addition of a feature to a claim after grant led to an extended scope of protection because the resulting combination of features might give rise to a different evaluation of **equivalents** in infringement proceedings was not in itself a sufficient reason for not allowing the addition of limiting features under Art. 123(3) EPC 1973.

In T 547/08 the board stated that the appellant's (opponent's) arguments relating to the rights of the patent proprietor to sue for **indirect or contributory infringement** were not relevant to the issue of extension of the scope of protection under Art. 123(3) EPC. With respect to the question of an extension of the scope of protection under Art. 123(3) EPC, it was, rather, appropriate to take into account the fact that the protection conferred by a patent was determined by the terms of the claims, and in particular by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its protocol (G 2/88, OJ 1990, 93). See also T 970/17 (which highlighted the difference between the "extent of the protection conferred" by a patent under Art. 69 EPC and the "rights conferred" by a patent under Art. 64 EPC).

The board in T 1832/17 likewise stressed that the scope of protection conferred by a patent within the meaning of Art. 123(3) EPC was not established by reference to the subject-matter that would be at issue in any national infringement proceedings. Art. 69(1) EPC and its Protocol stipulated that the protection conferred was determined by the terms of the claims, and in particular by the categories and technical features of those claims. Ascertaining whether an amendment extended the scope of protection thus meant comparing the granted claims with the amended ones (see also this chapter II.E.2.2).