

observed that the requirements of Art. 123(2) EPC differed from those of Art. 83 EPC. Art. 123(2) EPC aimed more particularly to prevent inventors from obtaining protection for inventions they had not thought of at the date of filing, respectively not put into their application as filed. Art. 83 EPC aimed more particularly to prevent them from obtaining protection for "theoretical" inventions which could not be carried out at the date of filing. While in some specific instances there might be a link between the two, in the case at issue, the manufacturing of the device using the specific fabric was clearly disclosed.

c) Limitation of scope of the original claim

In T 288/92 the appellant (applicant) contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) EPC 1973 prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so 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.

1.3.7 Novelty test

In T 201/83 (OJ 1984, 481) it was stated that the test for compliance with Art. 123(2) EPC 1973 was basically a novelty test, i.e. no new subject-matter may be generated by the amendment (see also T 136/88). T 17/86 (OJ 1989, 297, Corr. 415) added that novelty could be found in a limitation, the addition to a claim of a further feature, or even in the absence of one of the elements of a device. In G 2/10 the Enlarged Board held that after the amendment the skilled person "may not be presented with new technical information" and stressed the importance of applying a uniform concept of disclosure (with reference to Art. 54, 87 and 123 EPC).

The boards have highlighted the limitations of the novelty test (see T 194/84, T 133/85, T 177/86, T 118/89, T 187/91, T 288/92 and T 873/94 below). They have seldom expressly applied the novelty test in their recent case law, but it was referred to in e.g. T 60/03, T 1374/07, T 2202/08, T 2270/09 (see also T 1710/09 where the board referred to the test of T 12/81 which was developed for novelty). According to T 2537/10, the novelty test is no longer relevant for the assessment under Art. 123(2) EPC (see also T 1525/15). However, reference is still made to this test in the March 2022 version of the Guidelines (H-V, 3.2) for inclusion of additional features: If the resulting combination is novel over the application as originally filed, the amended claim does not fulfil the requirement of Art. 123(2) EPC.

Decision T 194/84 (OJ 1990, 59) related to amendments leading to the generalisation of the subject-matter of an application or to the omission of a feature. The patentee had taken the view that the amendment was admissible because the original application could properly be cited against the novelty of a more generic claim. The board took the view that this approach was based on a misapplication of the novelty test. The test for additional subject-matter corresponded to the test for novelty only in so far as both required