

comparison with the cited prior art documents. The board explained that the term "invention" did not necessarily imply the presence of novelty and inventive step, as was apparent from the wording of Art. 52, 54 and 56 EPC 1973. The board concluded that there was no need to take into account the prior art documents, but that the assessment of whether the exception for mere limitations applied in a particular case should depend only on the **technical relationship** of the added feature to the content of the application as originally filed, as understood by a skilled reader. At the least, a feature went beyond providing a mere limitation not involving a technical contribution to the invention if it interacted with the way in which the other features of the claim solved the technical problem, as it was understood from the application as originally filed.

In case T 64/96, a patent relating to a cover for automobile sun visor mirrors comprising rectangular plates overlapping and connected together in chain-like succession was revoked by the opposition division. The third auxiliary request of claim 1 was amended in that it was included as an additional feature that lugs were "integrally formed in said plates". The board came to the conclusion that applying the criterion, as set out in G 1/93 (OJ 1994, 541) and T 384/91 (OJ 1995, 745), to the case at issue, it could be seen that the feature in question did indeed make a technical contribution to the subject-matter of the claim since forming the lugs integrally with the plates led to a simpler and cheaper construction of cover which, at least by implication, was the technical problem which the invention set out to solve.

In T 518/99 the board held that the technical significance of a feature in a claim was not governed by its relevance for the assessment of novelty and inventive step vis-à-vis the available prior art, as had been argued by the appellant, but by its **contribution to the technical definition** of the claimed subject-matter, to be assessed by the skilled person in the light of the original disclosure. Otherwise, the decision about the technical significance of a feature would be subject to different interpretations dependent on the respectively available prior art. The board also rejected the appellant's argument that the disputed feature was technically meaningless because it was unrelated to the essence of the claimed invention. In this context the board referred to G 2/98 (OJ 2001, 413) where the Enlarged Board had found it problematic to try to distinguish between technical features which were related to the function and effect of an invention and technical features which were not, because there were no clear and objective criteria for making such a distinction, which could thus give rise to arbitrariness.

In T 1779/09 the board considered that a limiting feature which generally would not be allowable under Art. 123(2) EPC could, under certain conditions, nevertheless be maintained in the claim of an opposed patent in the particular situation addressed in decision G 1/93. It then complied with Art. 123(2) EPC by way of a legal fiction. In the case at issue, the term "only" was introduced during the examination proceedings and successfully objected to under Art. 100(c) EPC in proceedings before the opposition division by the former respondent. Since the board considered the term to be truly limiting, its deletion would extend the protection conferred and thereby infringe Art. 123(3) EPC. However, the board held that the exclusive limitation did not influence the solution of the technical problem as understood from the application as originally filed, and hence provided no technical contribution to the claimed invention (see also T 384/91). It merely