

2.5.2 Reducing scope of claim by adding embodiments to a negative feature

In T 363/11 the board considered that the feature concerned was a negative feature, in the sense that it defined embodiments which were excluded from the claim. Since after the amendment more embodiments were excluded from claim 1 of the request than from claim 1 as granted, its scope was reduced vis-à-vis granted claim 1 and the requirements of Art. 123(3) EPC were satisfied.

2.6. Transposition of features within claims

In T 16/86 the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention. Therefore, in so far as a change in the position of a feature inside a claim did not alter its meaning, the extent of protection conferred remained unchanged and such an amendment contravened neither Art. 123(2) nor Art. 123(3) EPC 1973.

In T 160/83 the board had no objection to the appellants' amendment of the characterising clause so as to include a feature which was previously in the preamble but not shown in the document representing the closest state of the art.

In T 96/89 the board again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) EPC 1973 if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 29(1) EPC 1973 required that claims be delimited against the nearest prior art; before the preamble to an independent claim could be drafted at all it was often necessary to select from two restrictive terms (the subject-matter claimed and the closest prior art) a general term covering both.

In T 49/89 the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board held that the protection had not been extended because new claim 1 indicated all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of all claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3) EPC 1973 (T 579/01, T 411/02, T 250/02, T 1898/07).

2.7. Change of claim category

In G 2/88 (OJ 1990, 93) the Enlarged Board stated that a change of category of granted claims in opposition proceedings was not open to objection under Art. 123(3) EPC 1973, if it did not result in extension of the protection conferred by the claims as a whole, when