

other words, in cases of conflict between Art. 123(2) and (3) EPC 1973 the **footnote solution is inadmissible** (see also T 307/05, T 614/12 and T 474/15).

### 3.2.2 Replacement of an added undisclosed feature by another feature disclosed in the application as filed without violating Article 123(3) EPC

In T 166/90 (decided before G 1/93, OJ 1994, 541, was issued) the board allowed an inadmissible feature in a granted claim to be replaced by other disclosed features, since this did not extend the scope of protection. The invention concerned an opaque plastic film. The product claim as granted contained a feature stating that the density of the film was less than the arithmetical density from the type and proportion of the individual components. In opposition proceedings the patent proprietor claimed a process for manufacturing the film, but without including in his process claim the density-related feature. The board examined whether this would broaden the scope of the patent, asking if the process claim features which replaced the deleted feature necessarily limited the claim to films – like that in the granted product claim – with a density less than the arithmetical one. The board concluded that, with a probability bordering on certainty, the process now claimed would produce an opaque film of a density less than that arithmetically derivable from the type and proportion of its individual components.

In T 250/05 the board, following the principles set out in G 1/93, came to the conclusion that the patent could not be maintained unamended and that the patent could only be maintained if there was a basis in the application as filed for replacing such subject-matter without violating Art. 123(3) EPC. The sixth auxiliary request met both prerequisites.

As noted in T 1127/16 (in which the board summarised "workarounds" for resolving the inescapable trap between the requirements of Art. 123(2) and (3) EPC), an added undisclosed feature, embracing one embodiment of the description, can be **replaced by a broader feature**, also covering an additional embodiment of the description, if the undisclosed feature is not so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the patent's description and the drawings and it is quite clear from the description and the drawings and also from the preceding examination proceedings that the further embodiment belongs to the invention (T 371/88).

In the following cases the exception set out in G 1/93, Headnote 1, was invoked by the patent proprietor, but the board found that the requested replacement was not allowable under Art. 123(3) EPC: T 729/11, T 108/12, T 1833/13 and T 469/14.

### 3.2.3 Deletion of added undisclosed feature, which has no technical meaning, without violating Article 123(3) EPC

In G 1/93 (OJ 1994, 541), point 4 of the Reasons, the Enlarged Board of Appeal noted with regard to previous decisions of the boards of appeal that it did not seem to be disputed that an added undisclosed feature without any technical meaning may be deleted from a claim without violating Art. 123(3) EPC, as held in case T 231/89.