

In T. 1149/97 (OJ 2000, 259) the board decided that, without opposition, issue of a decision to grant a European patent normally constituted a cut-off point for making amendments to the application documents in the European proceedings. If an opposition has been filed, cut-off effects due to the grant of a patent might be seen in the restrictions which R. 57a, R. 87 and Art. 123(3) EPC 1973 impose on further amendment of the patent specification. Although Art. 123(3) EPC 1973 addressed only the claims of the European patent, amendments to the description and the drawings might also extend the protection conferred in accordance with Art. 69(1) EPC 1973. If, in view of Art. 84 and Art. 69 EPC 1973, the application documents were adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason could not be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) EPC 1973. An analogous finding applied to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention. See also T. 37/99 and T. 684/02.

In T. 1481/05 the board distinguished the facts of its case from those underlying T. 1149/97. It agreed with T. 1149/97 that the "cut-off effect" finds its basis in Art. 123(3) EPC and that the test to be applied to determine whether this provision was infringed was the following: Is it possible to identify some subject-matter which did not fall under the scope of protection in the granted version of the patent, but would do so if the amendment in question (the reintroduction of the deleted features) was allowed? Applying this test the board was unable to identify abandonment of subject-matter.

Likewise in T. 81/03, the board detailed why it considered that the facts of the case dealt with in T. 1149/97 (OJ 2000, 259) differed from those of the case in point. The board also held that amendments to a European patent could be based on the whole reservoir of features originally disclosed in the corresponding application, provided that Art. 123(3) EPC 1973 was not infringed by such amendments, due account being taken of the provisions of Art. 69(1) EPC 1973.

In T. 241/02 in the board's view neither the fact that the appellant (proprietor) approved the text of the patent in suit nor considerations with respect to legal certainty added to the requirements relating to amendments in R. 57a or Art. 123(2) EPC 1973. The grant of a patent therefore did not necessarily constitute a final and automatic cut-off point ruling out any reinsertion of deleted subject-matter (in the case at issue, reinsertion of portions of the description relating to the process claimed). The opposition division had concluded on the basis of T. 1149/97 (OJ 2000, 259) that reinsertion would not be possible, but without referring to any specific parts or making any connection between parts to be reinstated and any concrete conclusion as to how the product claims would be extended in contravention of Art. 123(3) EPC 1973. The board decided that, by contrast with the situation in T. 1149/97, in the case in point the appellant had deleted too much of the description, overlooking the relevance of parts of it to these remaining claims. According to the board, T. 1149/97 did not lay down a strict rule. It required that an examination of a request for reinsertion be carried out with a view to establishing whether or not Art. 123(3) EPC 1973, on the facts of each case, was indeed infringed.