

whereas the amended product claims defined an apparatus (artificial kidney). The board considered that there had been a shift of the definition of the invention from a physical entity to a more complex physical entity which was not encompassed by the terms of the claims as granted. That shift implied that further components of an apparatus were encompassed by the terms of the present claims. This extended the protection conferred by claim 1 as granted to subject-matter which was foreign to that as granted (*aliud*), and so violated Art. 123(3) EPC. Likewise in T 1321/05 the board saw the combination of two physical entities ("graphic marking film bonded to a vehicle") as a new physical entity different from the previously claimed entity ("graphic marking film"), considered this subject-matter as an *aliud* and the amended claim thus contrary to Art. 123(3) EPC.

In T 547/08 the granted claim was directed to a user interface and screen display apparatus for a dialysis machine, the claim as maintained by the opposition division to a dialysis machine comprising user interface and screen display apparatus. In the board's view the scope of the claim as maintained had been **restricted** vis-à-vis that of the claim as granted since the subject-matter upheld explicitly comprised the dialysis machine as an additional feature. The board did not accept the appellant's arguments relating to the rights of the patent proprietor to sue for indirect or contributory infringement. In G 2/88 (OJ 1990, 93) it was clearly ruled that it was not necessary to consider the national laws of the contracting states in relation to infringement and that this issue was not relevant when deciding upon admissibility of an amendment under Art. 123(3) EPC. With respect to this question, it was rather appropriate to take into account that the protection conferred by a patent is determined by the terms of the claims, and in particular by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its Protocol (G 2/88). The board distinguished its case from those of T 352/04 (change from a substance to a combination of the substance and a device) and T 867/05 (change from a substance A for use in a method X to a combination of a device B and the substance A) and rejected the appellant's argument that the scope of protection had been shifted to an "*aliud*" in breach of Art. 123(3) EPC.

The board in T 1296/11 held that – in contrast to, for example, T 352/04, T 867/05 and T 321/07 – there had been no change of claim category because the same electro-mechanical device was claimed after the amendment as before. Citing the conclusion reached in T 547/08, which had likewise involved the replacement of a specified purpose in the granted claim by a mandatory combination, it held that the protection conferred had not been extended within the meaning of Art. 123(3) EPC; on the contrary, the added features limited the protection.

For further cases, where the boards considered the amended claim to define an *aliud*, see e.g. T 1675/08, T 1779/09, T 1701/10, T 1578/13 and T 2181/13; conversely for cases where the boards saw no shift to an *aliud*, see e.g. T 820/98, T 1818/11 and T 1646/12.

2.4.13 Narrowing down a generic class or list of chemical compounds; open claims ("comprising"); sequential drafting ("cascade")

As summarised in e.g. T 1384/16, the problem underlying the Art. 123(3) objection dealt with in the following decisions arises when a granted claim directed to a composition