

1.11. Additions

1.11.1 Addition to the claim of a feature taken from drawings

For examples concerning the insertion of additional features to the claim taken from **drawings**, see below in this chapter II.E.1.13. "Disclosure in drawings".

1.11.2 Addition to the claim of an isolated feature taken from description

For examples concerning the insertion of an **isolated** feature to the claim taken from the **description**, see above in this chapter II.E.1.9. "Intermediate generalisations".

1.11.3 Addition to the claim of features originally presented as prior art

In T.912/08 the board held that an amendment that resulted in features originally presented as part of the prior art, being then presented as the invention could be damaging to the legal security of third parties relying on the content of the original application and added subject-matter contrary to Art. 123(2) EPC.

In T.1652/06 the board drew a distinction as to whether in the application as originally filed the feature in question was disclosed as part of the background art or as part of the invention. In the case at issue, the feature was taken from the background art and could not serve as basis for the amendment (see also T.626/11).

However, in T.293/12 the board distinguished its case from T.1652/06 and underlined that a case-by-case analysis of the structure and content of the description was necessary in order to come to a conclusion for a particular case. In the case in hand, a sentence under the heading "State of the art" was clearly intended to provide the skilled person with a definition of the disease to be treated and therefore related to the teaching of the invention.

1.11.4 Addition to the claim of features previously described as non-essential

In T.583/93 (OJ 1996, 496) the board held that any attempt to interpret Art. 123(2) EPC 1973 such that the introduction into a claim of features previously described as non-essential would not be permissible, had to fail. The Convention contained no requirement that forbade the redefinition of an invention provided that Art. 123(2) and (3) EPC 1973 were complied with. Such a redefinition was often necessary in order to take into account prior art not known to the applicant at the priority date. It was therefore possible that features described as optional at the priority date later became essential in the sense that they were necessary to delimit the invention from the prior art. The introduction of such features was permissible provided that, first, the application as originally filed contained an adequate basis for such limitations and, second, the resulting combination of features was still in line with the teaching of the application as originally filed.