

b) Erroneous delimitations from the relevant prior art

In the above-mentioned decision T 11/82 (OJ 1983, 479), the board also held that the (added) delimitations from the relevant prior art should not be incorrect or misleading, otherwise they could indeed alter the subject-matter of the patent. In T 2450/17, the board cited T 11/82, concluding (with reference to T 889/93 and T 1039/93) that remedying this kind of error therefore did not contravene Art. 123(2) EPC.

1.11.6 Addition of advantages and effects to the description

In T 11/82 (OJ 1983, 479) the board stated that the addition of a discussion of the advantages of the invention with reference to the prior art did not necessarily constitute a contravention of Art. 123(2) EPC 1973. Whether Art. 123(2) EPC was infringed depended on the actual language used and on the circumstances of the individual case. See also T 725/05 where the addition of an analysis and discussion of a prior art document which went far beyond the disclosure of said document was considered contrary to Art. 123(2) EPC.

In T 37/82 (OJ 1984, 71), for example, a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully. It could however be deduced from the original application on the basis of normal expert considerations. T 434/97 stated that when introducing features not explicitly disclosed, it was necessary that such features could be unmistakably and fully derived from the original text (in this case the parent application); this corresponded to the opinion in T 37/82. In the case at issue the added effect could not be derived from the original text.

1.11.7 Addition/change of claim category

In T 243/89 the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Since the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

In T 49/11 the board found that it is well-established that subject-matter is not added by a change of claim category per se. The relevant question to be answered was whether there was a basis for the new claim category. In the case in issue the originally filed product claims were changed to claims to a method of treatment. The board, after analysing the disclosure of the application as filed, concluded that this change of category complied with Art. 123(2) EPC.

1.11.8 Insertion of an ambiguous feature in the claim

In T 792/94 the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC 1973), allowing scope for an interpretation which extended beyond the