

Art. 123(2) EPC 1973, but to do so would broaden the scope of the patent and thus contravene Art. 123(3) EPC 1973 (see G 1/93, OJ 1994, 541).

This problem had been extensively discussed for the first time in T 231/89 (OJ 1993, 13), where the board held it to be inappropriate to take Art. 123(2) and 123(3) EPC 1973 as independent of each other while applying them in conjunction to revoke the patent.

In G 1/93 (OJ 1994, 541) the Enlarged Board of Appeal ruled as follows:

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973 and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) EPC 1973 prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited by Art. 123(3) EPC 1973. Therefore, in principle, if the European patent as granted contained a "limiting extension", it had to be revoked. Art. 123(2) and 123(3) EPC 1973 were mutually independent of each other (T 1736/09: by analogy, Art. 76(1) EPC and Art. 123(3) EPC must also be regarded as mutually independent of each other). In this sense, it had to be admitted that Art. 123(2) EPC 1973 in combination with Art. 123(3) EPC 1973 could operate rather harshly against an applicant, who ran the risk of being caught in an **inescapable trap** and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, this hardship was not per se a sufficient justification for not applying Art. 123(2) EPC 1973 as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

3.2. Attempts to resolve the conflict

3.2.1 General

The Enlarged Board in G 1/93 (OJ 1994, 541) mentioned three instances where the patent could be maintained:

- If the added undisclosed feature could be **replaced** by another feature disclosed in the application as filed without breaching Art. 123(3) EPC 1973, the patent could be maintained in amended form (G 1/93, Headnote 1). See below in this chapter II.E.3.2.2.
- An added undisclosed feature **without any technical meaning** could be **deleted** from a claim without violating Art. 123(3) EPC 1973 (G 1/93, point 4 of the Reasons, citing T 231/89). See below in this chapter II.E.3.2.3.
- An added undisclosed feature, which **did not provide a technical contribution** to the subject-matter of the claimed invention but merely limited the protection conferred by the