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**D E C I S I O N**  
**of 7 July 2005**

**Case Number:** T 0910/03 - 3.2.5

**Application Number:** 98100855.0

**Publication Number:** 0854027

**IPC:** B29C 45/27

**Language of the proceedings:** EN

**Title of invention:**

Insulated modular injection nozzle assembly

**Applicant:**

Husky Injection Molding Systems Ltd.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Added subject-matter: main request and auxiliary request -  
yes; second auxiliary request - no"

**Decisions cited:**

G 0003/89, G 0001/93, G 0002/98, G 0001/03, T 0331/87,  
T 0802/92

**Catchword:**

-



Case Number: T 0910/03 - 3.2.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.5  
of 7 July 2005

**Appellant:**  
(applicant)

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 7 March 2003  
refusing European application No. 98100855.0  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** H. M. Schram  
W. Widmeier

## Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division posted 7 March 2003 refusing the European patent application No. 98 100 855.0 (publication number EP-A 0 854 027).

The Examining Division held that there was no basis in the application as filed to omit the feature "[the injection nozzle system comprising ...] at least one heater element in thermal contact with said nozzle assembly and operable to maintain said resin in a molten state through said at least one inner melt channel" (henceforth referred to as the "heater element" feature) from the independent Claim 1 of the main request and the auxiliary request of the appellant (applicant). These requests therefore contravened the requirements of Article 123(2) EPC.

In arriving at the above conclusion, the Examining Division considered *inter alia* the test proposed in decision T 331/87 (OJ EPO 1991, 22 - Removal of feature/HOUDAILLE, reasons 6). In this decision it was indicated that a non-essential feature may be omitted provided the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change. The Examining Division held that the "heater element" feature did meet the third

criterion, but that it did neither meet the first nor the second criterion.

II. In a communication accompanying the summons to attend oral proceedings dated 11 April 2005, the Board made the following provisional observations. The "heater element" feature seemed to be a so-called "non-essential" feature in the sense of T 331/87 (loc. cit.), i.e. it appeared to meet the three criteria defined in said decision. However, it followed from opinion G 2/98 (OJ EPO 2001, 413 - Requirement for claiming priority of the "same invention", point 8.3 of the Reasons) of the Enlarged Board of Appeal that, in applying the disclosure test for deciding whether priority was validly claimed under Article 87 EPC, no distinction must be made between features that are related to the function and effect of the invention ("essential" features) and features which are not ("non-essential" features). This conclusion seemed to apply *mutatis mutandis* to the test for deciding whether amendments to the claims meet the requirements of Article 123(2) EPC as well, since the disclosure test for the purpose of Article 87 EPC and for the purpose of Article 123(2) EPC was the same. Since it seemed that in T 331/87 (loc. cit.) such a distinction was made, it appeared that the three criteria proposed in this decision should no longer be applied.

The subject-matter of Claim 1 of the main request and of the auxiliary request, viz. an insulated modular injection nozzle without a heater element, did not seem to be disclosed in the application as filed, contrary to Article 123(2) EPC, if the concept of disclosure as described in G 2/98 (loc. cit) was applied.

- III. Oral proceedings were held before the Board of Appeal on 7 July 2005.
- IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the following documents:
- (i) Claims 1 to 19 filed as main request on 7 June 2005; or
  - (ii) Claims 1 to 19 filed as auxiliary request on 7 June 2005; or
  - (iii) Claims 1 to 18 presented as second auxiliary request during oral proceedings.

The appellant further requested that, in case the main request and the auxiliary request were refused, the following questions be referred to the Enlarged Board of Appeal:

"1. Does G 2/98, relating to the consequences of the addition of a feature to the original disclosure of the invention, render redundant or modify the three-part test of T 331/87 that establishes the criteria for the omission of an essential/non-essential feature from a claim?

2. If question 1 is answered in the affirmative, in relation to the deletion of a feature from a claim, to what extent does G 2/98 eliminate any distinction between features which are related to the function and

effect of the claimed invention ("essential" features) and features which are not ("non-essential" features)?"

V. Claim 1 according to the main request reads as follows:

"1. An insulated modular injection nozzle (20, 20', 20'', 20''') for use in conjunction with an injection molding machine, the injection nozzle comprising:

    a removable mold gate insert (88, 88'', 88''') having a mold gate (92) therein;

    a nozzle assembly comprising a thermally conductive nozzle housing (40) and a thermally conductive nozzle tip (52), said nozzle assembly defining at least one inner melt channel (44) to receive, in use, molten resin and to direct said molten resin to said mold gate (92); and

    an insulating element (76) arranged between said mold gate insert (88) and said conductive nozzle housing (40) such that said nozzle tip (52) is maintained adjacent said mold gate (92) and said insulating element inhibits thermal transfer between the nozzle tip (52) and the mold gate insert (82);

    the injection nozzle characterized in that:

    said mold gate insert is removably connected to said nozzle housing (40) by means of said insulating element, which insulating element (76) is realised by an insulating sleeve having an exterior threaded surface, and said mold gate insert (88) includes an interior thread complementary to the exterior threaded surface of the insulating sleeve to allow the threaded and removable connection of the mold gate insert (88) to the sleeve."

Claim 1 according to the auxiliary request differs from Claim 1 according to the main request in that the expression "injection nozzle" is replaced by the expression "injection nozzle system".

Claim 1 according to the second auxiliary request differs from Claim 1 according to the auxiliary request in that the "heater element" feature is reinstated in the Claim before the expression "an insulating element (76) ..."

VI. The appellant argued in writing and during oral proceedings essentially as follows:

*What a skilled person directly and unambiguously derived from the application documents*

The issue of "disclosure of the invention", more particularly, the question what the application documents disclosed to the skilled person, boiled down to the question "What is the invention?" To answer this question, the skilled person would look for the technical contribution to the art made by the invention. In the paragraph describing whereto the present invention related, the skilled person was told that the invention was about a modular injection nozzle system, the key components of which being a removable mold gate insert attached to a nozzle tip by a thermal insulating element therebetween, see column 1, lines 5 to 12, of the application as filed (published version). The invention was about modularity. Heaters were not mentioned in this first paragraph of the description. In the final paragraph of the section entitled "Background of the invention" it was mentioned that is

was desirable to have an injection nozzle system with good thermal properties and which provided enhanced serviceability and relatively easy assembly and disassembly, see column 2, lines 41 to 44, of the application as filed (published version). The heater did not contribute to the problem the invention sought to solve, viz. to provide a novel insulated modular injection nozzle with a removable mold gate which obviates or mitigates at least one of the disadvantages of the prior art nozzles, see column 2, lines 48 to 52, of the application as filed (published version). Features which were not necessary for solving the technical problem with which the application was concerned had to be regarded as non-essential features. Heaters were nowhere in the application described as being essential to the invention. The skilled person knew that heaters were independent, standardized and replaceable parts, see e.g. US-A 5,558,888 and US-A 4,968,247. There was no interaction between the nozzle design and heater design. If optionally present heaters failed or otherwise required replacement, it would of course be advantageous if they could easily be replaced, see column 10, lines 2 to 5, of the application as filed (published version). The only function of the heaters was to maintain the resin in a molten state through the inner melt channel, see column 7, lines 1 to 4, and lines 22 to 27, of the application as filed (published version). In the section entitled "Detailed description of the invention" the nozzle was described as located in a mold bore of an injection mold, i.e. in its operational environment, as shown in Figures 1, 4, 6, 7 and 9 of the application as filed (published version). The skilled reader would readily recognize that nozzle



heaters were separate parts associated with the operational environment, rather than with the nozzle itself (similar as the stationary and moveable mold plates 28, 32 also shown in said figures and rightly not reiterated in the claim). The advantages provided by the use of a removable gate insert and the advantages of a modular system were respectively given in column 6, lines 2 to 51, and column 7, line 49 to column 8, line 20, of the application as filed (published version). Again there was no mention of heaters in these passages. A corresponding passage, wherein the advantages of the heater element were described, or its possible role in achieving the object of the invention, was absent in the description. In Figure 2 of the application as filed (published version), which showed the nozzle itself, no heater element was shown. From the totality of the application documents it was thus abundantly clear to the skilled person that the heaters did not provide a technical contribution to the subject-matter of the claimed invention. In decision T 802/92 (OJ EPO 1995, 379 - Photovoltaic cell/COLORADO, point 2 of the Reasons) it was held that, in pre-grant proceedings, the removal from a claim of a feature which does not provide a technical contribution to the subject-matter of the claimed invention, whose removal merely broadens the protection conferred by the claim, does not offend the requirements of Article 123(2) EPC (following decision G 1/93, OJ EPO 1994, 541, Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS). It followed that in the present case the "heater element" feature could be omitted without contravening Article 123(2) EPC.

*The three-fold test for deciding whether a feature may be removed from a claim according to decision T 331/87 (loc. cit.)*

The Examining Division had not contested that the removal of the heater did not require any modification of the other features (i.e. criterion (3) was met). However, the Examining Division had wrongly inferred from the passage in column 1, lines 46 to 54, of the application as filed (published version), describing the problems relating to the absence of an insulating element in the prior art nozzle system having a heater element, and from the passage in column 7, lines 22 to 39, of the application as filed (published version), describing the advantages of the insulating element, that heating was indispensable for the function of the invention in the light of the sub-problem it tried to solve, namely inhibiting thermal transfer between the mold gate insert and the nozzle tip (i.e. criterion (2) was not met). The Examining Division had then argued that if heaters were indispensable for solving the problem, the "heater element" feature had to be essential (i.e. criterion (1) was also not met).

However, heaters were nowhere in the application described as being essential to the invention, i.e. criterion (1) of decision T 331/87 (loc. cit.) was clearly met. Since the only function of the heaters was to maintain the resin in a molten state, and the heaters did not help to achieve the above described object of the invention, viz. providing a modular nozzle with increased serviceability, the heaters clearly were not indispensable for the function of the invention. It followed that the skilled person would

easily recognise that the three criteria indicated in decision T 331/87 (loc. cit.) were fulfilled.

*Referral to the Enlarged Board*

The provisional opinion of the Board that decision T 331/87 (loc. cit.) was no longer relevant cannot be accepted, since this would represent a step change in the established practice of the EPO. Said decision was cited in the current version (i.e. the version of December 2003) of the Guidelines for Examination in the European Patent Office, Chapter VI, 5.3.10. Should the Board be inclined to deviate, in the light of Opinion G 2/98 (loc. cit.), from the long established principles as set out in decision T 331/87 (loc. cit.) this should warrant consideration of the Enlarged Board. If the test proposed in decision T 331/87 (loc. cit.) could no longer be applied, it would become prohibitively difficult to delete features from claims as filed during examination proceedings. Applicants would be encouraged to file applications with extremely broad claims, which would be detrimental to the European patent system.

**Reasons for the Decision**

1. The main issue that is to be decided in the present appeal is whether or not the deletion of the "heater element" feature from Claim 1 as filed is allowable in view of Article 123(2) EPC. This so-called problem of "claim broadening before grant" is a well-known problem, both in pre-grant (appeal) proceedings and in opposition (appeal) proceedings in view of the fact

that "added subject-matter" is a ground of opposition under Article 100(c) EPC. This problem may also show up when a divisional application is examined for compliance with Article 76(1) EPC. It may be noted that "added subject-matter" is a ground for revocation as well, see Article 138(1)(c) EPC. In order to assess whether the subject-matter of an amended claim, wherein a feature is missing that was present in Claim 1 as filed, meets the requirements of Article 123(2) EPC, all that needs to be examined is whether the subject-matter of the amended claim has been disclosed directly and unambiguously in the application as filed as a whole.

2. The European patent system must be consistent and the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC (see G 1/03, OJ EPO 2004, 413 - Disclaimer/PPG, point 2.2.2 of the Reasons, ultimate paragraph). For example, it would be contrary to common sense if, in a case where the application as filed is identical to the priority application, amendments that are allowable under Article 123(2) EPC could result in a loss of priority. This consistency of the concept of disclosure also follows from the following considerations.

The purpose of Article 123(2) EPC, which prohibits amending a European patent application or a European patent in such a way that it contains subject-matter which extends beyond the content of the application as filed, and the purpose of Article 87 EPC, which prohibits claiming priority for a European patent application from a first application that does not relate to the same invention, are very similar. The

purpose of Article 123(2) EPC is that the applicant or patent proprietor shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal certainty of third parties relying on the content of the original application (see G 1/93, loc. cit., point 9 of the Reasons). The purpose of Article 87 EPC is that the applicant shall be protected from novelty destroying disclosures during a period of twelve months from the date of filing of the first application only if the subsequent application relates to the same invention, i.e. the applicant shall not be allowed to improve his position by adding subject-matter *to the claims* not disclosed in the earlier application on which the right of priority is based (cf. G 2/98, loc. cit., points 4 and 5 of the Reasons). In both cases the applicant shall only be rewarded with a backdated right for what has been disclosed at the earlier date.

Seen in the light that the European patent system must be consistent, it is thus not accidental that the wording of the conclusion of the Enlarged Board of Appeal in its opinion G 2/98 (loc. cit.), viz. "The requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole" (emphasis added by the present Board) and the wording of the conclusion of the Enlarged Board of Appeal in

its opinion G 3/89 (OJ EPO 1993, 117, Correction of the parts of a European patent application or of a European patent relating to the disclosure), are substantially the same. The conclusion of the latter opinion, which dealt with the question whether corrections of the description, claims or drawings under Rule 88 EPC, being amendments of the disclosure, must meet the requirements of Article 123(2) EPC as well, read as follows: "The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed" (emphasis added by the present Board).

Summarizing, it can be concluded that the test for deciding whether amendments meet the requirements of Article 123(2) EPC and the test for deciding whether priority has been validly claimed (provided that certain other requirements specified in Articles 87 and 88 EPC are met) are the same: viz. the disclosure test. An amendment to a claim meets the requirements of Article 123(2) EPC if the skilled person can derive the subject-matter of the amended claim directly and unambiguously, using common general knowledge, from the totality of the application documents as filed. In other words, an amendment is allowable under Article 123(2) EPC if it does not change the technical information contained in the application as filed.

*Main request and auxiliary request*

3. *Deletion of the "heater element" feature*

3.1 Claim 1 as filed relates to an insulated modular injection nozzle system for use in conjunction with an injection molding machine, comprising *inter alia* "at least one heater element".

An insulated modular injection nozzle system in accordance with an embodiment of the present invention is shown in Figures 1, 4, 6, 7 and 9, see column 3, line 30 to column 4, line 12, of the application as filed (published version). That all of these Figures show a heater element 96 is by itself no indication that "at least one heater element" is mandatory. However, it can also not be concluded that the heater element shown is merely part of the operational environment and that it can thus be deleted.

Nowhere in the application documents as filed as a whole, viz. description, claims and drawings, it is stated, suggested, or hinted at, that the presence of a heater element is optional, or that the heater element, or heater elements, can be omitted.

3.2 In the judgement of the Board, that the heater element, or heater elements, is/are merely optional can also not be indirectly inferred from the application documents as filed.

The specification as filed starts with the following wording (see column 1, lines 3 to 12, of the published version of the application as filed):

"FIELD OF THE INVENTION

The present invention relates to an injection nozzle system. More particularly, the present invention relates to an injection nozzle system comprising modular components, one of which comprises a mold gate insert removably attached to a nozzle tip by a thermal insulating element therebetween, the injection nozzle system being particularly suited for molding relatively large products."

From the absence of a reference to a heater element in this passage it cannot be deduced that a heater element is merely optional. A statement at the beginning of the specification stating whereto the invention relates is normally held in general terms and cannot, in the opinion of the Board, replace the wording of the independent claims read in conjunction with the description and drawings, if any, for third parties seeking to be informed about the provisional protection conferred by the application (see Articles 67 and 69 EPC).

- 3.3 The Board has also examined whether the person skilled in the art would have derived from the application as filed, by using common general knowledge, that the presence of a heater element was merely optional. The appellant has argued in this respect that the only function of the heaters was to maintain the resin in a molten state in the inner melt channel.

In column 7, lines 1 to 4, of the application as filed (published version) it is stated that "In use .... the pressurized molten plastic resin is maintained in its



molten state by heater element 96". In column 7, lines 22 to 27, of the application as filed (published version) it is further stated that "... it is desirable to place heater element 96 as close as possible to the end portion 104 of the nozzle tip 52 and thus as close as possible to mold gate 92 to control the melt flow and to thus maintain the size of the residual gate vestige on the molded article at a minimum".

These passages suggest that the main reasons for equipping the nozzle with a heater is to ensure that, during operation, the resin is maintained in a molten state, and to control the melt flow. In the judgement of the Board, whilst it is possible that a person skilled in the art could imagine circumstances, wherein heaters may be dispensed with, for example if the throughput time of the resin is short, the resin is hot enough and/or the heat losses are small, this is not to say, however, that the person skilled in the art can derive from the application as filed directly and unambiguously, using common general knowledge, that the heaters may *in general* be dispensed with.

#### 3.4 Function and effect of the heater element

In order to show that the presence of a heater element was not related to the function and effect of the invention, the appellant relied on the following passage in the description, stating the object of the invention as follows: "It is desired to have a injection nozzle system with good thermal properties and which provides enhanced serviceability and relatively easy assembly and disassembly" (see column 2, lines 41 to 44, of the published version of

the application as filed; see also the passage in column 2, lines 48 to 52, of the published version of the application as filed, wherein the object of the invention is stated to be "to provide a novel insulated modular injection nozzle system with a removable mold gate which obviates or mitigates at least one of the disadvantages of the prior art nozzle systems").

The appellant further argued that the heater element did not contribute to the problem the invention set out to solve. This was *inter alia* clear from the fact that any special advantage of providing a heater element was not mentioned in the description at all, whereas many passages in the description emphasized the advantages of the modular design, of the removable mold gate insert and of the location of the insulating element, see column 6, lines 2 to 51, column 7, line 49 to column 8, line 20, of the published version of the application as filed. By way of contrast, the only function of the heater element was to maintain the resin in a molten state through the inner melt channel, see column 7, lines 22 to 27, of the published version of the application as filed.

In the judgement of the Board, this approach is tantamount to making a distinction between technical features which are related to the function and effect of the invention and technical features which are not.

However, in opinion G 2/98 (*loc. cit.*) the Enlarged Board of Appeal has warned, for reasons of legal certainty, against an approach, whereby a distinction is made between technical features which are related to the function and effect of the invention and technical

features which are not (see point 8.3 of the Reasons). The answer to the question whether the claimed invention remains the same if one of its features is modified or deleted, or a further feature is added, should not depend on the assessment of which features are related to the function and effect of the invention and which features are not.

This implies that, in applying the disclosure test for deciding whether amendments to the claims meet the requirements of Article 123(2) EPC, no distinction must be made between features that are related to the function and effect of the invention ("essential" features) and features which are not ("non-essential" features). All features of an independent claim are by definition essential features, cf. Rule 29(3) EPC.

In the judgement of the Board, the argument of the appellant that the "heater element" feature can be omitted, because it does not relate to the function and effect of the invention, cannot be accepted.

### 3.5 Decision T 331/87

In decision T 331/87 (loc. cit.) a distinction is made between features that are not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve and features that are indispensable. The Board in that case concluded that it was therefore necessary to examine whether the person skilled in the art reading the application as filed would consider the contested feature "as essential or not to the function of the machine as

described in the application", see decision T 331/87 (loc. cit.), point 7 of the Reasons.

It follows that in decision T 331/87 (loc. cit.) a distinction is made between essential features and non-essential features, a distinction that should not be made according to opinion G 2/98 (loc. cit.).

The present Board therefore concludes that the test for deciding whether a feature can be removed from a claim proposed in decision T 331/87 (loc. cit., see point 6 of the Reasons) should no longer be applied.

- 3.6 The appellant further relied on decision G 1/93 (loc. cit), arguing that this decision condoned the practice of deleting a feature from a claim, as long as this feature did not provide a technical contribution to the subject-matter of the claimed invention.

However, this decision does not concern the problem of claim broadening before grant, it deals with the following, distinctively different legal problem. If the subject-matter of a granted patent extends beyond the content of the application as filed, i.e. contains an undisclosed feature, whilst at the same time the undisclosed feature limits the scope of protection of the claims of the patent as granted, a conflict arises. The conflict is that the undisclosed feature must be deleted, because it is in breach of Article 123(2) EPC, but to do so would broaden the scope of the patent and thus contravene Article 123(3) EPC. The Enlarged Board showed two possible exceptional situations, wherein this conflict may be resolved. On the one hand, if the undisclosed feature can be replaced by an originally

disclosed feature without violating Article 123(3) EPC, the patent can be maintained in this amended form. On the other hand, if the undisclosed feature does not provide a technical contribution to the subject-matter of the claimed invention, but merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the undisclosed feature cannot reasonably be considered to give any unwarranted advantage to the applicant/patentee and can be maintained.

The appellant cannot derive support for his position from decision G 1/93 (loc. cit.) that technical features that do not provide a technical contribution to the subject-matter of the claimed invention may be removed from a claim before grant. The potential conflict that is dealt with in decision G 1/93 (loc. cit.) stems from the fact that an undisclosed feature has been added. Omitting the "heater element" feature cannot be said to have the effect that merely protection for part of the subject-matter of the claimed invention as covered by the application as filed is excluded, on the contrary, the scope of protection is extended. For these reasons the argument of the appellant must fail. There is hence no need to examine whether the "heater element" feature provides a technical contribution to the subject-matter of the claimed invention.

- 3.7 Since the subject-matter of Claim 1 of the main request and of the auxiliary request is no longer directed to an injection nozzle (system) *inter alia* comprising "at least one heater element", these requests do not meet the requirements of Article 123(2) EPC.

*Second auxiliary request*

4. *Allowability of the amendments (Article 123(2) EPC)*

Apart from the inclusion of reference signs, the introduction of the two-part form (cf. Rule 29(1) (a), (b) EPC) and a few minor editorial amendments, Claim 1 according to the second auxiliary request differs from Claim 1 as filed in that:

- (i) the expression "a mold gate insert" is replaced by "a **removable** mold gate insert"; see also the first characterizing feature "said mold gate insert is **removably** connected to said nozzle housing (4) by means of said insulating element", wherein the word removably has been added;
- (ii) the expression "to receive molten resin" is replaced by "to receive, **in use**, molten resin";
- (iii) the second characterizing feature of the claim, viz. "which insulting element (76) is realized by an insulating sleeve having an exterior threaded surface, and said mold gate insert (88) includes an interior thread complementary to the exterior threaded surface of the insulating sleeve to allow the threaded and removable connection of the mold gate insert (88) to the sleeve", has been added.

A basis for amendments (i) and (ii) is column 2, line 50 and column 7, line 1, of the application as filed (published version), respectively. A basis for

amendment (iii) is column 5, lines 11 to 21, column 5, lines 33 to 40, and Figure 2, of the application as filed (published version).

It follows that Claim 1 of the second auxiliary request meets the requirements of Article 123(2) EPC.

5. *Remittal to the Examining Division for further prosecution*

The sole objection for the refusal of the application was non-compliance with Article 123(2) EPC. This objection has now been overcome by Claim 1 of the second auxiliary request. Since compliance with other provisions of the EPC has not yet been examined, and in order to maintain the appellant's right to appeal to a department of second instance, the Board exercises its discretion given to it under Article 111(1) EPC and remits the case to the Examining Division for further prosecution.

6. *Request for referral of questions to the Enlarged Board of Appeal*

Article 112(1)(a) EPC provides that the Board of Appeal shall, during appeal proceedings relating to a particular case and either of its own motion or following a request from a party to the appeal proceedings, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for ensuring uniform application of the law or if an important point of law arises.

In the present case, the interpretation of an Article or a Rule of the EPC is not in dispute. The appellant concurs with the Board that the test for deciding whether an amendment meets the requirements of Article 123(2) EPC amounts to examining if the skilled person can derive the subject-matter of the amended claim directly and unambiguously, using common general knowledge, from the totality of the application documents as filed.

The appellant, however, does not agree with the present Board that it follows from the reservation made in opinion G 2/98 (loc. cit.) to make a distinction between technical features which are related to the function and effect of the invention and technical features which are not, that the three criteria proposed in decision T 331/87 (loc. cit.) should no longer be applied to decide whether a feature can be omitted from an independent claim.

Despite the use of the word "shall", it is clear from the wording of this Article "... if it considers that a decision is required ..." that it is within the discretion of a Board of Appeal to refer a question to the Enlarged Board or not. However, if a Board of Appeal should consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal, it is no longer up to the discretion of a Board. In such a case the question must be referred to the Enlarged Board of Appeal (Rules of Procedure of the Boards of Appeal, OJ EPO, 2003, 89, see Article 16).



The present Board agrees with the appellant that the examination of claim broadening before grant is an issue of fundamental importance. However, in the judgement of the present Board, the Enlarged Board of Appeal has in its opinion G 2/98 (loc. cit.) clearly stated that the disclosure test in the framework of claiming priority of "the same invention" is the same for any amendment (whether by way of addition, alteration or excision). Making a distinction between features that are "indispensable for the function of the invention in the light of the technical problem" and features that are not (as done in T 331/87 (loc. cit.)) should be refrained from. Moreover, the Enlarged Board of Appeal has stated in its decision G 1/03 (loc. cit.) that the European patent system must be consistent and that the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC (see point 2.2.2 of the Reasons).

The present Board thus takes the stance that the Enlarged Board of Appeal in its opinion G 2/98 (loc. cit.) and in its decision G 1/03 (loc. cit.) has already ensured a uniform application of the law. The request to refer questions to the Enlarged Board of Appeal has therefore to be refused.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of claims 1 to 18 of the second auxiliary request.
3. The request to refer questions to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:

M. Dainese

W. Moser