

Update – Outcome of the Enlarged Board of Appeal decision on disclaimers

The European Patent Office (EPO) has extremely strict rules regarding the addition of subject-matter to an application after the filing date. The EPO requires that any amendment is *directly and unambiguously derivable* from the original application.

One type of amendment that has caused particular controversy is a disclaimer, which is a statement, in a patent claim, that specific subject matter is not part of the claimed invention.

In May 2011 we reported that the Enlarged Board of Appeal (the highest appeal court at the EPO) were looking at a new aspect of this topic (<http://www.forresters.co.uk/news/110disclaimers.htm>)

This decision has now issued and can be viewed here in full ([http://documents.epo.org/projects/babylon/eponet.nsf/0/C777CFB3654BB240C12578FE00485B6C/\\$File/g2_10.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/C777CFB3654BB240C12578FE00485B6C/$File/g2_10.pdf)).

The Board decided that the correct approach is not to decide whether the disclaimed subject-matter is directly and unambiguously derivable from the application. The correct approach is to look at what subject-matter *remains* in the amended claim and determine whether this remaining subject-matter is directly and unambiguously derivable from the original application.

Therefore when an applicant wants to disclaim subject matter that was originally disclosed as part of the invention, the fact that the disclaimed subject matter is disclosed is not important. Instead, the *usual* added-subject matter test – is it unambiguously disclosed? – is applied to the subject matter of the amended claim.

The decision does not state that positively disclosed disclaimers are *never* allowable. It therefore *may* be possible to disclaim a single embodiment originally described as part of the invention.

Unfortunately, whether this is allowed depends on what is actually taught by the application in each case. In our opinion, such a disclaimer will not be allowed in the great majority of cases.

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The decision highlights the importance of carefully drafting the original application. It is very difficult, after filing, to add subject matter. It is vitally important that the original application contains as much subject matter as possible. That should include not only what the applicant already knows about the invention, but as much informed speculation as possible of variations that might be effective.