

Disclaimers at the EPO

Introduction

Enlarged Board of Appeal ("EBA") decision G 2/10 (August 2011) sought to clarify a previously existing divergence of interpretation as to the general question of when a disclaimer may be validly introduced into a claim. The EPO Boards of Appeal were split as to whether a difference existed in determining the allowability of a disclaimer for purposes of:

- (1) disclaiming subject-matter disclosed in the application as filed ("disclosed disclaimers"); and
- (2) disclaiming subject-matter when neither the disclaimer nor the subject-matter excluded by disclaimer is disclosed in the application as filed ("undisclosed disclaimers").

G 2/10 provided guidance as to whether an amendment to a claim by the introduction of a disclosed disclaimer infringes Article 123(2) EPC. Subsequent cases have further developed the EPO's approach on how to evaluate the admissibility of both disclosed and undisclosed disclaimers and this note summarizes the current position of the EPO.

Background

Prior to EBA decision G 1/03 (April 2004), it had been common to introduce a disclaimer for the purposes of establishing novelty with respect to either a prior application or an accidental anticipation, or for purposes of excluding non-patentable subject-matter. It was also generally allowable to introduce a disclaimer if the subject-matter of the disclaimer was a specific embodiment expressly disclosed in the application as filed (Technical Board of Appeal Decision T4/80).

G1/03

A split arose, however, after EBA decision G 1/03, a decision addressing the allowability of a disclaimer when neither the disclaimer nor the subject-matter excluded by the disclaimer are disclosed in the application as filed ("undisclosed disclaimers").

G 1/03 provided that an undisclosed disclaimer may be allowable in order to:

- restore novelty over Article 54(3) EPC prior art;
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; and
- disclaim subject-matter excluded from patentability for non-technical reasons.

Several EPO decisions that followed applied the undisclosed disclaimer principles of G 1/03 to situations in which the applicant had introduced a disclaimer excluding subject-matter disclosed in the original application ("disclosed disclaimer". Others, however, adopted the pre-G 1/03 approach and found that if the subject-matter excluded by the disclaimer was disclosed in the application as filed, the disclaimer was generally allowable. Thus, the fate of the claims was dependent upon the approach that was adopted and applicants were left unsure as to how the law was to be interpreted.

Resolving the inconsistencies

"Disclosed disclaimers"

In Technical Board of Appeal Decision T 1068/07 (June 2010), the Board adopted the decision of G 1/03 and refused the applicant's claims on the basis that the disclaimer introduced into the claim (in an attempt to overcome a novelty objection) constituted a selection that lacked direct and unambiguous support in the application as filed. The disclaimer at issue disclaimed subject-matter disclosed in the application as filed.

In their decision, the Board acknowledged the differing opinions expressed in the jurisprudence of the Boards of Appeal and referred the following question (referred by the EBA) to the EBA for a definitive interpretation of the law:

"Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?"

In summary, the G 2/10 EBA decision provided:

- "the introduction of a disclaimer disclaiming a disclosed embodiment" is not per se allowable;
- Article 123(2) EPC is not automatically fulfilled as a consequence of a limitation having been performed by a disclaimer for disclosed subject-matter;

- "the Enlarged Board did not intend to give a complete definition of when a disclaimer violates Article 123(2) EPC and when it does not" in G 1/03;
- G 1/03 does not relate to the disclaiming of subject-matter disclosed as part of the invention in the application as filed; and
- the subject-matter remaining in the amended claim, i.e. the claim containing the disclaimer, must meet the requirements of Article 123(2) EPC.

Impact of G 2/10

G 2/10 provided the test for determining when a "disclosed disclaimer" meets the requirements of Article 123(2) EPC.

When using a disclosed disclaimer, it should be determined whether "the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed."

"Undisclosed disclaimers"

Technical Board of Appeal decision T 1870/08 (March 2012) addressed the admissibility of an undisclosed disclaimer that had been introduced in order to avoid Article 54(3) prior art. Again, as was held in G 2/10, the Board found that the Enlarged Board in G 1/03 did not intend to give a complete definition of when a disclaimer violates Article 123(2) EPC and when it does not.

In order to determine whether an admissible undisclosed disclaimer, i.e. a disclaimer introduced in an attempt to exclude material solely for legal reasons, infringes Article 123(2), it must be determined whether or not the disclaimer has any bearing on the technical information in the application. Such an analysis hinges on the distinction between "legal subject-matter" and "technical subject-matter".

As is provided by the Board, "legal subject-matter" is the legal scope of protection, i.e. what others are excluded from exploiting, whereas "technical subject-matter" relates to the features of the invention as taught. When determining whether a claim including a disclaimer is in compliance with Article 123(2), "one must always keep in mind that the purely legal subject-matter of the disclaimer cannot by definition modify the original technical-subject matter." Claimed subject-matter will not be considered to extend beyond the application as filed if the disclaimer is not part of the definition of the invention, but rather serves to provide a limitation that is intended to "play a role when the scope of protection needs to be determined."

Impact of T 1870/08 and the relevant test to apply

The Board held that application of the test set out in G 2/10 should be applied in combination with the requirements provided in G 1/03 when assessing an amended claim including an undisclosed disclaimer.

The assessment should begin with determining whether "the formal conditions for the use of an undisclosed disclaimer as laid down in G 1/03" are met.

Next, the test provided in G2/10 should be applied, but only after (1) examination of the legal preconditions for admitting the use of an undisclosed disclaimer; and (2) the disclaimer has been inserted into the claim.

In applying the test provided by G 2/10, one must determine whether or not the introduction of the disclaimer adds technical subject-matter as a matter of law, i.e. whether the technical subject-matter remaining within the legal scope of the claim has been properly disclosed. The Board further provided a helpful means for determining "how the requirement for the amended claim to meet the test of G 2/10 may possibly be satisfied", which includes the steps of:

1. determining if any subject-matter can be identified which falls within the scope of the claim after amendment by the proposed disclaimer, but which did not do so before the amendment (if such subject-matter can be identified, the disclaimer is improper)
2. determining whether there is any remaining subject-matter at all; and
3. examining whether the remaining subject-matter could plausibly be considered as belonging to the invention as presented in the application, i.e. would the skilled person have contemplated the remaining subject-matter as belonging to the invention from a technical point of view.

Where does the Board currently stand?*Use of undisclosed disclaimers for "strictly legal purposes"*

In Technical Board of Appeal decision T 2464/10 (May 2012), undisclosed disclaimers were introduced for purposes of excluding human beings in order to satisfy Article 53(a) EPC and for excluding non-patentable subject-matter under Article 53(b) EPC.

Much like in T 1870/08, the Board held that an application of the test set out in G 2/10 should be applied in combination with the requirements laid out in G 1/03 when assessing an amended claim including an undisclosed disclaimer.

In T 2464/10, the Board found that the disclaimers introduced by the applicant "only [served] the purpose of removing specific legal obstacles" and thus did not contribute to the invention because, with regard to the remaining subject-matter, the skilled person was not presented with any new disclosure that went beyond the application as filed. Further, the Board noted that the applicant reproduced the specific wording of Rule 28 EPC, and therefore did not remove more than was necessary to disclaim the subject-matter excluded from patentability for non-technical reasons.

Use of disclosed disclaimers for "strictly legal purposes"

Technical Board of Appeal decision T 1836/10 (April 2013) addressed the use of a disclaimer for purposes of disclaiming a future use of a product obtained by the claimed process, wherein the future use was explicitly disclosed as a preferred use of the product in the application as filed. The applicant had claimed a method for obtaining pluripotent embryonic stem cells and introduced a disclaimer that the cells obtained by the method were not used for industrial or commercial purposes if the blastocyst was a human blastocyst in an attempt to exclude subject-matter excluded from patentability.

The Board found that the applicant was disclaiming subject-matter, i.e. a use of the product, which was not covered by the claim. As provided in G 1/03 with regard to undisclosed disclaimers, the idea that a disclaimer should not exclude more than is necessary for excluding subject-matter excluded from patentability for non-technical reasons also applies when the disclaimer attempts to exclude subject-matter that the claim does not encompass. Such a disclaimer will be found to violate Article 123(2) EPC.

Use of undisclosed disclaimers for avoiding Article 54(3) prior art

The more recent Technical Board of Appeal decision T 1045/09 (January 2014) provides the following approach for assessing the allow ability of an undisclosed disclaimer that has been introduced for purposes of excluding the disclosure of an Article 54(3) prior art document:

1. identify the disclosure in the prior art that anticipated the subject-matter of the claim as originally filed;
2. determine whether the claim excludes more than is necessary in order to restore novelty over the prior art.

If it is found that the claim excludes more than is necessary (see step 2), the disclaimer will be considered broader than required and will be in violation of Article

123(2) EPC, much like the position taken by the Board in T 1836/10 with regard to excluding subject matter for strictly legal purposes

Rogue decision - undisclosed disclaimers for purposes of avoiding Article 54(3) prior art

While recent Boards of Appeal cases seem to provide consistency as to the approach taken with regard to the allow ability of undisclosed disclaimers for purposes of avoiding Article 54(3) prior art, it is important to note the outlying decision provided by Technical Board of Appeal decision T 0748/09.

T 0748/09 (November 2012) addressed a situation in which the applicant had introduced an undisclosed disclaimer in order to exclude the disclosure of an Article 54(3) prior art document. The Board found that the remaining subject-matter of the claim lacked original disclosure in the application as filed and thus violated Article 123(2) EPC.

The Board held that the EBA in G 1/03 "indeed did not intend to give a complete definition of when an undisclosed disclaimer violates Article 123(2) EPC and when it does not". Thus, the Board found that the "point of reference for assessing an amended claim for its compliance with Article 123(2) EPC, including amendments by introducing an undisclosed disclaimer, is the subject-matter which the claim contains after the amendment" and the test to be applied is that provided in G 2/10, i.e. whether the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed."

Conclusion

Practice points:

- The use of undisclosed disclaimers for "strictly legal purposes", e.g. excluding non-patentable and excluded subject matter, is still acceptable and its practice can be continued. Use of disclosed disclaimers for "strictly legal purposes" should not exclude more than is necessary for excluding subject-matter excluded from patentability for non-technical reasons.
- The use of undisclosed disclaimers for the avoidance of Article 54(3) prior art may pose problems if the disclaimer does not exclude exactly what is necessary and no more, i.e. the exact area of overlap between the invention and the Article 54(3) prior art, and thus one must be extremely

careful when amending a claim to include an undisclosed disclaimer for this purpose.

- Note: It is important to keep in mind that a claim containing a disclaimer may be challenged during opposition proceedings on the grounds that the disclaimer violates Article 123(2) EPC. Amending the claim to remove the disclaimer would extend the scope of protection the patent confers, contrary to Article 123(3) EPC.
- Therefore, we strongly recommend avoiding the use of an undisclosed disclaimer to circumvent Article 54(3) prior art and instead trying to find subject-matter for positive amendments in the application as filed.