

EIP

Disclaimers (G 2/10)

The Enlarged Board of Appeal (EBoA) has ruled on the admissibility of disclaimers which disclaim subject-matter which is disclosed as an embodiment in the application as filed.

This decision follows several Technical Board of Appeal decisions which had diverged in regard to the admissibility of amending a claim by insertion of a disclaimer excluding disclosed subject-matter. The Technical Board of Appeal in T1064/07 referred this matter to the EBoA, which sought to answer the following question:

“Does an amendment to a claim by the introduction of a disclaimer infringe Article 123(2) EPC if the subject-matter of the disclaimer was disclosed as an embodiment of the invention in the application as filed?”

The EBoA answered this question as follows:

“An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if 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.”

The EBoA further clarified that determining whether the disclaimed subject-matter infringes Article 123(2) EPC requires “a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment”.

In reaching its conclusion, the EBoA held that the strict requirements for undisclosed disclaimers set out in decision G 1/03 (i.e. a disclaimer where neither the disclaimer itself nor the excluded subject-matter are disclosed in the application as filed) are not

applicable to disclaimers excluding disclosed subject-matter. According to the EBoA, any positive feature disclosed in the description may be used as subject-matter for a disclaimer. Moreover, following the wording of Article 123(2) EPC, a claim amendment introducing a disclaimer should be assessed for admissibility by examining whether the subject-matter remaining in the claim after the amendment is disclosed in the application as filed. In other words, the principles developed in the context of Article 123(2) EPC for the assessment of amendments to claims by the introduction of positive limiting features should be applied equally to amendments to claims which disclaim subject-matter.

The Board gave the following examples of an admissible and non-admissible amendment. Where an application as filed discloses and claims an invention in general terms and further describes a number of specific embodiments of the invention, the general teaching of the application will normally not be modified by a disclaimer which excludes one of the disclosed embodiments from the claimed subject-matter. In contrast, if the disclaimer would have the effect of confining the subject-matter remaining in the claim to a subgroup of the originally claimed subject-matter and the subgroup could not be regarded as disclosed in the application as filed, such a disclaimer would contravene Article 123(2) EPC.

In addition to answering the referred question, the EBoA drew some interesting parallels between the admissibility of disclaimers excluding disclosed subject-matter and the right of an applicant to divide an application, thereby splitting its subject-matter into different applications under Article 76(1) EPC. Similar considerations apply to the right to the priority of an earlier application claimed in a later application which omits subject-matter disclosed in the earlier application. The EBoA noted that both situations are in accordance with the applicant's right to choose the scope of protection they wish to pursue, providing that it doesn't contravene Article 123(2) EPC.

This decision confirms the admissibility of disclaimers excluding disclosed subject-matter at the EPO, subject to the normal requirements of Article 123(2), and as such will be particularly welcomed by practitioners in the chemical and pharmaceutical fields where it is common to claim ranges and selections. Nevertheless, some practitioners feel that the requirements "technical assessment" advocated by the EBoA remain opaque and further clarification in this regard is eagerly anticipated.