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## Disclaimers at the EPO following G 2/10

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RSC Law Group Case Law Seminar

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## Disclaimers at the EPO

- EPO considers a “disclaimer” to be:
  - an amendment to a claim resulting in the incorporation therein of a “negative” technical feature, typically excluding specific embodiments or areas from a general feature (G1/03)

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## Disclaimers at the EPO

- EPO considers a “disclaimer” to be:
  - an amendment to a claim resulting in the incorporation therein of a “negative” technical feature, typically excluding specific embodiments or areas from a general feature (G1/03)
- Applicant may want to use a disclaimer, e.g.,:
  - to achieve novelty; or
  - to avoid “double patenting”

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## Background to referral

- Application refused by EPO examining division for added subject-matter because of amendment to add a disclaimer
- The disclaimer excluded from the claim a molecular motif described in the present application as part of the invention
- Disclaimer required to achieve novelty (A.54(2) EPC) over disclosure in applicant’s previous application

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## Background to referral

- Examining division followed the EPO Guidelines and T1050/99 and considered that
  - an embodiment in the application “is present as part of the invention, not as an area to be excluded”
- Examining division considered such a disclaimer to be an “undisclosed disclaimer” and so should follow criteria set out in EPO Board of appeal co-joined decisions G1/03 and G2/03

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## EPO Guidelines

- April 2010
  - “Disclaimers excluding embodiments that were disclosed in the original application as being part of the invention are considered as undisclosed disclaimers (see T1102/00, T1050/99, T236/01, T 868/04)...”

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## EPO Guidelines

- April 2010
  - “Disclaimers excluding embodiments that were disclosed in the original application as being part of the invention are considered as undisclosed disclaimers (see T1102/00, T1050/99, T236/01, T 868/04)...”
- June 2005:
  - “Subject-matter may be restricted using a negative limitation... This may be done e.g. to remove non-patentable embodiments disclosed in the application as filed (see T4/80)...”

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## Criteria of G1/03 and G2/03

- According to G1/03 and G2/03, where a disclaimer is not disclosed in the application as originally filed, the disclaimer may be allowable in order to:

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  - restore novelty over subject-matter that is an “accidental anticipation”; or
  - disclaim subject-matter which is excluded from patentability for non-technical reasons, such as methods of medical treatment.

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## Referral

- On appeal, the Appeal Board agreed with the examining division’s reasoning, but referred the following question to the EBA:

Question referred to the Enlarged Board of Appeal:  
"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?"

- Poorly phrased referral, and in fact there are several questions that need to be considered.

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## Questions to be considered

- Before oral proceedings, the Enlarged Board identified key questions to be considered:

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  - Do decisions G1/03 and G2/03 also concern disclaimers which disclaim subject-matter disclosed as part of the invention in the application as filed?

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## Questions to be considered

- Before oral proceedings, the Enlarged Board identified key questions to be considered:
  - Do decisions G1/03 and G2/03 also concern disclaimers which disclaim subject-matter disclosed as part of the invention in the application as filed?
  - Is it to be concluded from G1/03 and G2/03 that the introduction of a disclaimer cannot *a priori* modify the subject-matter remaining in the claim?

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## Questions to be considered

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  - Do decisions G1/03 and G2/03 also concern disclaimers which disclaim subject-matter disclosed as part of the invention in the application as filed?
  - Is it to be concluded from G1/03 and G2/03 that the introduction of a disclaimer cannot *a priori* modify the subject-matter remaining in the claim?
  - If not, what are the criteria to be applied in assessing the allowability of disclaiming disclosed subject-matter?

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## The decision

- G1/03 and G2/03 only relate to disclaimers where both:
  - (i) the disclaimer is not disclosed in the application; and
  - (ii) the subject-matter to be disclaimed is not disclosed in the application.

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## The decision

- G1/03 and G2/03 only relate to disclaimers where both:
  - (i) the disclaimer is not disclosed in the application; and
  - (ii) the subject-matter to be disclaimed is not disclosed in the application.
- This is clear from referring questions
- So, the criteria of G1/03 and G2/03 do not apply in this case

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## The decision

- Found that still need to apply the “standard” A.123(2) test, namely:

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## The decision

- Found that still need to apply the “standard” A.123(2) test, namely:
  - Does the disclaimer result in the skilled person being presented with new technical information?
  - Must consider whether the skilled person would, using common general knowledge, regard the remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously disclosed in the application as filed.

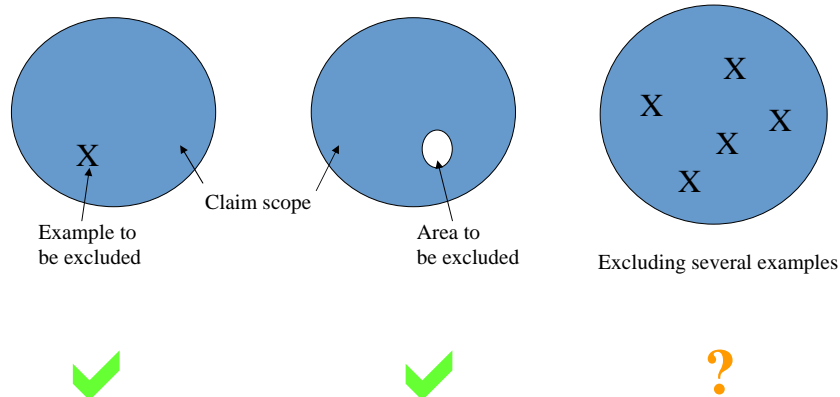
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## Allowable disclaimers

- Where an invention has been disclosed in general and specific embodiments or groups, a disclaimer to one of the specific embodiments or groups should be allowable because the remaining subject-matter is implicitly disclosed.
- Consistent with T4/80, which states “(n-1)” type disclaimers do not add subject-matter as the remaining claimed matter is implicitly disclosed

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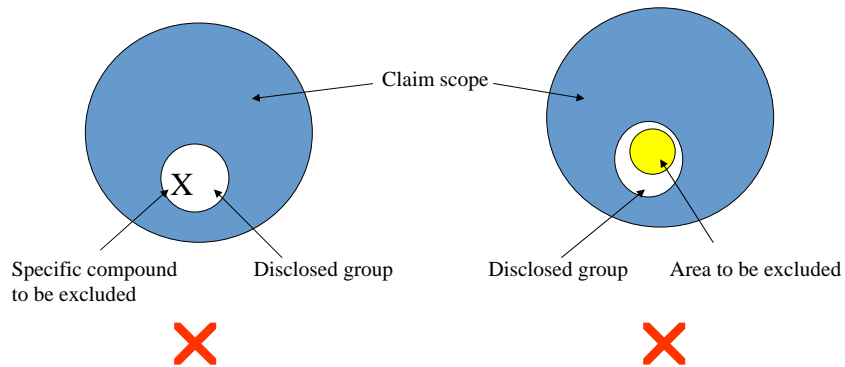
## Disclaiming specific “embodiments”



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## Unallowable disclaimers

- A disclaimer confined to a sub-group of an originally disclosed specific group would not be allowable



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## Further Comments

- EPO president considered that if the remaining claimed subject-matter could not be derived from the application, then the applicant one could still add a disclaimer if it satisfied the criteria of G1/03
- The Enlarged Board “fails to see any justification for adopting such an approach”

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## Further Comments

- This doesn't sit very easily
  - an applicant disclosing more information (in the form of, say, examples) is in a worse position than an applicant disclosing less information
- Reasoning of Enlarged Board is unclear, and so this point may be tested more in the future

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## Conclusions

- Disclaiming subject-matter disclosed in the original application is in principle allowable
- Such disclaimer does not have to follow G1/03 and G2/03 criteria
- The remaining claimed subject-matter must be derivable (either explicitly or implicitly) from the application as filed

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## QUESTIONS?

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