

RESTORATION OF DISCLAIMER PRACTICE AT THE EPO

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Introduction

For patent applications in the chemical and biotechnology field, disclaimers are an important tool to distinguish the claimed subject matter from the prior art. This is due to the fact that in these technical areas many generic terms exist embracing specific embodiments and, thus, often the situation occurs that the prior art discloses one specific embodiment encompassed by a generic term used to define the claimed subject matter. In view of the general practice of the EPO that a specific disclosure is detrimental for a generic claim embracing said disclosure, novelty problems arise in these cases. Said novelty problems can frequently only be solved by amending the generic term to a more specific term. Such an amendment must, however, be supported by the original application in order to meet the requirements of Article 123(2) EPC.

For practical reasons, exceptions to the principle that the incorporation of a feature into a claim must be supported by the original application in order to comply with Article 123(2) EPC have, thus, in the past been permitted in the form of so-called "disclaimers". A disclaimer can, generally, be defined as the insertion of a negative technical feature into a claim in order to exclude specific embodiments which are known from the prior art. A disclaimer is, thus, not supported by the application, but disclosed as such in the prior art.

The allowability of disclaimers as such was challenged in decision T 323/97 of

2001 which held that a disclaimer having no basis in the application as filed, contravened Article 123(2) EPC. Upon two referrals, the Enlarged Board of Appeal issued decisions in consolidated cases G 1/03 and G 2/03 in April 2004, confirming the previous practice that a disclaimer may not be refused for the sole reason that neither the disclaimer nor the subject matter excluded by it from the scope of the claim have a basis in the application as filed.

If decision T 323/97 had been followed by the Enlarged Board of Appeal, granted claims incorporating a disclaimer in accordance with earlier case law, could have been invalidated.

History of disclaimer case law at the EPO

The first decision of the EPO relating to disclaimers dates back to 1981 (T 4/80) where it was stated that disclaimers are admissible if the subject matter remaining in the claim cannot technically be defined more clearly and concisely in positive terms. This principle was confirmed in decision T 433/86 of December 11, 1987. Disclaimers were also allowed in cases where a part of the claimed subject matter did not solve the technical problem posed in the application (see T 313/86).

In later decisions the Boards of Appeal clarified that the use of a disclaimer is only permissible in cases where there is a novelty problem between the prior art and the claimed subject matter. Specifically, in decision T 170/87 of July 5, 1988, the Board established that a

disclaimer could render novel a teaching which overlapped the state of the art, but could not impart an inventive step to a teaching which was obvious. This was confirmed by decision T 597/92 of March 1, 1995 wherein it was stated that there is no basis in the EPC for the substantiation of an inventive step by way of a disclaimer. A disclaimer could not be used to render a claim inventive since the introduction of a disclaimer in that case would amount to nothing else than the insertion of a new (negative) feature in terms of subject matter not present in the originally filed application, which would be contrary to the requirement of Article 123(2) EPC. However, decision T 426/94 of May 22, 1996 emphasised that a disclaimer comprising features not originally disclosed in the application in order to exclude an accidental anticipation does not contravene Article 123(2) EPC (see also G 1/93 of the Enlarged Board of Appeal dated February 2, 1994).

In the following years the Boards of Appeal, by defining the term "accidental anticipation", further limited the application of disclaimers to specific cases. In particular, in decision T 863/96 of February 4, 1999, it was confirmed that a disclaimer is only allowable if the cited document containing said disclosure has no relevance for the examination of an inventive step of the claimed invention with the consequence that said document must then "disappear" from the prior art field to be taken into consideration. Furthermore, in decision T 608/96 of July 11, 2000, the Board established that a disclaimer is only allowable according to Article 123(2) EPC, if the "accidental anticipation" in the prior art is such that the person skilled in the art would not consider the teaching of the prior art in view of the problem to be solved, for example because the prior art is in a different technical field or does not contribute anything to the solution of the

problem. This also meant that the prerequisite for an "accidental anticipation" is only fulfilled if the respective disclosure is of no relevance for the inventive step of the claimed subject matter.

These principles were given up in a decision of a Board of Appeal questioning in general the admissibility of disclaimers. According to decision T 323/97 of September 17, 2001, the practice of permitting disclaimers having no support in the application as filed to make a claimed subject matter novel by delimiting it against an accidental anticipation cannot be maintained in the light of the Enlarged Board of Appeal's opinion G 2/98.

In its reasoning, the Board stated that the definition of the technical problem underlying an invention in question was an important prerequisite in deciding the admissibility of a disclaimer under the previous practice. Since, however, the technical problem solved by an invention could not be determined once and for all, but might have to be considerably redefined during the course of the proceedings, or even later, in the light of new prior art, with all the negative consequences pointed out in G 2/98, a disclaimer might become inadmissible at a later stage. The Board thus concluded that any amendment of a claim not having support in the application as filed and aiming at distancing the claimed subject matter further from the prior art, in particular, by way of a disclaimer, contravenes Article 123(2) EPC and is consequently inadmissible.

According to Article 112(1) EPC, a Board of Appeal or the President of the EPO may refer a point of law to the Enlarged Board of Appeal in order to ensure uniform application of the law. In view of the inconsistent case law regarding the allowability of disclaimers, two Boards of Appeal referred similar

points of law to the Enlarged Board of Appeal (T 507/99 and T 451/99).

Decisions of the Enlarged Board of Appeal

The Enlarged Board of Appeal has now issued decisions in consolidated case G 1/03 and G 2/03 with respect to the question whether a disclaimer which has no basis in the application as filed is allowable under the EPC.

The Enlarged Board of Appeal answered the questions referred as follows:

1. An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject matter excluded by it from the scope of the claim have a basis in the application as filed.
2. The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:
 - 2.1 A disclaimer may be allowable in order to:
 - restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;
 - restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
 - disclaim subject matter which, under Articles 52 to 57 EPC, is

excluded from patentability for non-technical reasons.

- 2.2 A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject matter excluded from patentability for non-technical reasons.
- 2.3 A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject matter contrary to Article 123(2) EPC.
- 2.4 A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

Consequences of decisions of the Enlarged Board of Appeal:

Since the use of disclaimers was a widespread practice, it is good that the EPO has basically restored the previous case law to allow disclaimers inter alia

- 1) if the prior art document to be disclaimed is an intermediate document relevant for novelty only (Article 54(3)(4) EPC, or
- 2) if the disclosure in the prior art is "accidental", i.e. not relevant for the discussion of an inventive step.

Moreover, the Enlarged Board of Appeal confirmed the practice of the EPO to disclaim subject matter which is excluded from patentability for non-technical reasons, e.g. methods for medical treatment under Article 52(4) EPC and inventions the exploitation of which is contrary to "ordre public" or morality under Article 53(a) EPC.