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EPO DECISION CLARIFIES ADMISSIBILITY OF DISCLAIMERS NOT ORIGINALLY DISCLOSED

It is well known that the EPO has a very strict practice when it comes to amendments of the claims that do not literally correspond to wording found in the application as originally filed.

This applies both to positive amendments (e.g. introduction of features further defining the claimed subject matter) and to negative amendments (e.g. introduction of disclaimers aimed at excluding a part of the claimed subject matter). When such amendments are not literally based on wording already present in the application as originally filed, there is always the risk that the EPO will raise an objection of added matter.

A recent decision of the EPO's highest instance, i.e. the Enlarged Board of Appeal (EBA), has now shed some further light on the circumstances under which a disclaimer which is not already present in the original application can nevertheless be introduced into the claims without violating the added matter prohibition.

Specifically, in its decision G1/16 the EBA first confirmed the earlier finding contained in a previous EBA decision, G2/10, which had held that for a claim amendment in the form of a disclosed disclaimer to be allowable the gold standard entails the assessment of whether the subject matter remaining in the claim after the introduction of the disclaimer has been explicitly or implicitly, and directly and unambiguously, disclosed in the original application.

On the other hand, in G1/16 the EBA held that the above gold standard could not, by definition, also apply to undisclosed disclaimers. This is because, according to the EBA, *“where neither the disclaimer itself nor the subject-matter excluded by it is disclosed in the applications as filed, i.e. where an undisclosed disclaimer is introduced into the claim, it (almost) automatically follows that the subject-matter remaining in the claim after the introduction of such an undisclosed disclaimer literally can hardly be considered to have been explicitly or implicitly, and directly and unambiguously, disclosed in the application as filed.”*

As a first point, in decision G1/16 the EBA therefore found that the admissibility of disclaimers depends, in the first place, on whether the disclaimers are disclosed in the application as originally filed.

As a result, the EBA found that the admissibility of undisclosed disclaimers is not governed by EBA decision G 2/10, but rather is governed exclusively by another earlier decision of the EBA, namely decision G 1/03, in which the EBA had addressed precisely such admissibility and indicated the criteria that must be met for an undisclosed disclaimer to be admissible. These criteria are the following:

- i) the disclaimer must carve out subject matter that was already disclosed in an unpublished earlier EP/PCT application, or which represents an accidental anticipation of the claimed subject matter, or which is excluded from patentability for non-technical reasons, and
- ii) the disclaimer must not be related to the teaching of the invention.

But in decision G1/16 the EBA went even further, and provided the following additional clarification:

“The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.”

This new decision by the EBA will be most helpful for all users of the EPO system to determine when it is possible to introduce amendments in the form of disclaimers, and will therefore surely contribute to making the EPO system even more user-friendly.