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EPO DISCLAIMER PRACTICE AGAIN UNDER SCRUTINY

The EPO's Enlarged Board of Appeal (EBA), i.e. the EPO's body of highest instance, now has to decide again on the question of whether a disclaimer can be introduced into a claim, and if so under what circumstances this is possible.

The issue of disclaimers had already been addressed by two earlier decisions of the EBA.

In decision G 1/03, the EBA had held that the introduction of a disclaimer not already disclosed in the application as filed may not be considered to introduce subject-matter extending beyond the content of the application as filed 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. Specifically, in this decision the EBA identified the following as exceptional circumstances allowing for the introduction of a disclaimer not already disclosed in the application as filed, namely when the disclaimer is used for:
(i) delimiting a claim against prior art not published before the priority/filing date;
(ii) delimiting a claim against an accidental anticipation (i.e. an anticipation 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
(iii) disclaiming subject-matter which is non-patentable for non-technical reasons (e.g. aspects of biotechnological inventions that are not patentable under the European Patent Convention, such as human cloning processes).

However, in later decision G 2/10 the EBA established that a disclaimer excluding from a claim a certain subject-matter introduces subject-matter extending beyond the content of the originally filed application if the subject-matter remaining in the claim after the introduction of the disclaimer is not directly and unambiguously disclosed to the skilled person in the application as filed, even when the skilled person uses common general knowledge while reading the application as filed.

In a very recent case, one of the EPO Boards of Appeal had to decide on the admissibility of a disclaimer. In its decision of October 2016, the Board of Appeal acknowledged that while EBA decision G 2/10 was not limited to disclaimers not already disclosed in the application as filed, various statements in G 2/10 appear to indicate that the disclaimer admissibility standard set forth in that decision of the EBA applies to all disclaimers, regardless of whether they are disclosed in the application as originally filed. The Board of Appeal noted that the standard set forth in decision G 2/10 appears to contradict the one in (earlier) decision G 1/03, but in G 2/10 the EBA had not indicated that the principles established in G 1/03 were set aside. As a result, the Board of Appeal has now referred the following questions to the EBA:

"1. Is the standard referred to in G 2/10 for the allowability of disclosed disclaimers …, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?

2. If the answer to the first question is yes, is G 1/03 set aside as regards the exceptions relating to undisclosed disclaimers [set out in that decision]?

3. If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in … G 1/03 apply in addition to the gold standard, may this standard be modified in view of these exceptions?"

Since disclaimers are a very useful tool for obtaining patents in all fields of technology, the EBA's answers to the above new questions may have a significant impact on many pending and future cases. It is hoped that the EBA will answer these questions in a way that is of course fully respectful of the law, but which also takes into account the interests of patent applicants and of third parties.

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