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G2/10 – DISCLAIMERS FOR DISCLOSED SUBJECT-MATTER

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G2/10 – DISCLAIMERS FOR DISCLOSED SUBJECT-MATTER

by Nadja Muncke and Klemens Stratmann

On August 30, 2011 the Enlarged Board of Appeal rendered its decision on the admissibility of a disclaimer whose subject-matter is disclosed as an embodiment of the invention in the application as filed. It can be expected that the EPO will change its current restrictive practice in view of this decision, again allowing disclaimers for disclosed subject-matter under certain conditions. However, the Enlarged Board of Appeal did not endorse the view that disclaiming disclosed subject-matter is always allowable. Hence, until further Board of Appeal decisions will bring more clarity as to the specific situations in which such disclaimers are allowable, there will remain a degree of uncertainty.

For many years, following decision T 4/80, it had been the practice of the EPO to accept that, if specific subject-matter was disclosed as an embodiment in the application as filed, a disclaimer could be introduced into the claim in order to exclude this embodiment from the scope of protection. This practice was not changed by G 1/03. However, after a number of decisions including T 1102/00 and T 1050/99 concluded that disclaimers based on embodiments which are disclosed in the original application as part of the invention have to be considered as “undisclosed disclaimers” to which the strict criteria set out in G 1/03 apply, the practice of the first instance EPO department was adapted to this new jurisprudence. This practice was not changed again when it was challenged by Board 3.3.04 in T 1107/06. Finally, it was Board 3.3.08 in T1068/07 which, in view of the diverging case law, referred the following question to the Enlarged Board of Appeal:

“Does a disclaimer infringe Art. 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?”

This question has now been answered by the Enlarged Board of Appeal in G 2/10 as follows:

la. 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.

lb. Determining whether or not that is the case 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 G2/10, the Enlarged Board of Appeal first confirmed that G1/03 only referred to the situation where neither the disclaimer nor the subject matter excluded by it have a basis in the application as filed, i.e. “undisclosed disclaimers”. Also, the Enlarged Board of Appeal rejected the argument that a disclaimer should not be allowable if the disclaimed subject-matter was not presented as subject-matter to be excluded from protection. In this connection, the Enlarged Board of Appeal acknowledged that the Applicant is, in principle, entitled not to claim protection for an embodiment or even a part of the disclosed invention if he wishes to do so.

These findings make it very likely that the first instance department of the EPO will change its current restrictive practice of not allowing disclaimers for disclosed subject-matter.

However, the Enlarged Board of Appeal did not endorse the view that all disclaimers for disclosed subject-matter are allowable under Art. 123(2) EPC. It will thus not be easy to determine to what extent a reversal of the current practice will occur. This can specifically be seen from the Enlarged Board of Appeal’s rejection of the “logical complement” approach of T 1107/06. Further, the Enlarged Board of Appeal did not acknowledge that there is an *a priori* principle to the effect that disclaiming disclosed specific embodiments or areas from a broader claim can never infringe Art. 123(2) EPC. According to G2/10, the test to be applied is 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.

It would appear from the detailed reasoning given in G 2/10 that at least the following guidance can be inferred on how Applicants can determine the allowability of a disclaimer for disclosed subject matter.

1) It seems to be allowable to disclaim one specific embodiment

The Enlarged Board of Appeal seems to see problems with the compatibility of disclosed disclaimers with Art. 123(2) EPC only for cases in which a whole area or subclass is disclaimed.

2) Care must be taken that the effect of the disclaimer is not to limit the claim to subject-matter, such as a subgroup, an intermediate generalization or something else, which cannot be regarded as disclosed in the application as filed

In the Enlarged Board of Appeal’s reasoning, there would (by analogy with T 615/95) be added matter where the insertion of a disclaimer would result in singling out any hitherto not specifically mentioned or at least implicitly disclosed individual compounds or group of compounds, or would lead to a particular meaning of the remaining claimed subject-matter which was not originally disclosed.

In view of these findings it should, for example, again be permissible in a pharmaceutical case to limit broad Markush formulae to the lead compound(s) or other concrete embodiments for which data supporting inventive step are available, thereby obtaining quick protection for these, while the remaining scope of the Markush formula, as defined by a disclaimer for the lead compound(s), can be pursued in a divisional application. However, some uncertainty remains and further Board of Appeal decisions will be required to address the allowability of disclaimers for disclosed subject-matter in concrete situations.

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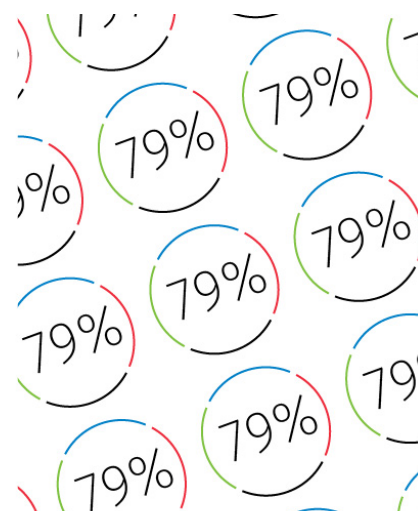
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This entry was posted on Tuesday, September 6th, 2011 at 11:58 am and is filed under [Art. 123\(2\) of the European Patent Convention \(EPC\)](#), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. ([G 1/93](#), OJ 1994, 541) The ‘gold standard’ of the European Patent Office’s Board of Appeal is that “any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed” ([G 3/89](#), OJ 1993,117; [G 11/91](#), OJ 1993, 125).“>Added matter, [G 1/93](#), OJ 1994, 541) The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed ([G 3/89](#), OJ 1993,117; [G 11/91](#), OJ 1993, 125).“>Amendments, [Disclaimer](#), [EPC](#), [Extension of subject matter](#)

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