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Non-disclosed Disclaimers and the "Remaining Subject-Matter Test" of G 2/10

Thorsten Bausch (Hoffmann Eitle) · Thursday, June 27th, 2013

The main principles applicable for assessing whether a non-disclosed disclaimer meets the requirements of Article 123(2) EPC have been laid out in the decision G 1/03 of the Enlarged Board of Appeal (EBA) of the EPO. In the recent decision G 2/10 dated September 19, 2011 a new test for assessing the allowability of non-disclosed disclaimers, the so called “Remaining Subject-Matter Test”, has been established. In applying this test, disclaimers which in the past would have been considered to be allowable in view of G 1/03 may now be found to actually be in violation of Article 123(2) EPC. Herein, we will evaluate the impact this new test has had on the decisions of the Technical Boards of Appeal (TBA) of the EPO to date.

The Principles established in G 1/03

According to the definition provided in G 1/03, a disclaimer is “an amendment to a claim resulting in the incorporation therein of a “negative” technical feature, typically excluding from a general feature specific embodiments or areas”. G 1/03 established the tenet that a disclaimer which is not disclosed in the application as filed does not automatically contravene Article 123(2) EPC merely because of not being explicitly disclosed in the application as filed. In expanding on this thought, G 1/03 identified the following main scenarios where such a non-disclosed disclaimer would be allowable:

- (i) for restoring novelty by delimiting a claim against state of the art under Article 54(3) EPC;
- (ii) for restoring novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC, wherein an anticipation is considered to be 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
- (iii) for disclaiming subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for nontechnical reasons.

Also, G 1/03 rules that “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.”

What is new in G 2/10?

In G 2/10 it was held that the guiding principles of G 1/03, while working well when assessing the

allowability of disclaimers excluding individual embodiments from a claim, could run into problems when multiple or entire groups of embodiments are to be disclaimed, because this could result in the singling out of specific subject matter. This could e.g. happen where ranges in composition claims are disclaimed so as to create previously undisclosed (remaining) ranges.

G 2/10 therefore concluded that a more elaborate test would be needed for assessing the allowability of non-disclosed disclaimers under Article 123(2) EPC and came up with the following, which is nowadays referred to as the “Remaining Subject-Matter Test”:

“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.

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.”

While this wording is somewhat cryptic and leaves the patent practitioner in doubt as to what to do, Section 4.5.4 of the Reasons of the Decision brings it to the point:

“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. This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined.”

The “Remaining Subject-Matter Test” in the Practice of the TBAs

After G 2/10 having become public in September 2011, the “Remaining Subject-Matter Test” has been invoked in a handful of decisions of the TBAs, i.e. in T 2464/10, T 1176/09, T 1870/08, T 0748/09 and T 1170/07:

(i) T 2464/10 and T 1176/09 relate to cases where non-disclosed disclaimers were used to exclude non-patentable subject matter relating to human embryos/stem cell lines. They both have been handled by the TBA 3.3.08, which also was responsible for the decision T 1068/07, the referral of which to the EBA led to the decision G 2/10. Therefore, not surprisingly, the two decisions follow the scheme outlined in G 2/10 by firstly assessing whether the disclaimer under examination meets the criteria as set forth in G 1/03, and then determining whether the limitation of the disclaimer leads to a singling out of specific embodiments or to the introduction of a new technical teaching. Having answered the latter in the negative, the disclaimers in question were then deemed to be in compliance with Article 123(2) EPC.

(ii) T 1170/07 concerned the introduction of a disclaimer excluding a certain subgroup of patients into a medical use claim. The decision makes no reference whatsoever to G 1/03, but rather exclusively relies on the new test of G 2/10 in coming to the conclusion that the disclaimer was not allowable. This, however, is likely attributable to the fact that from the TBA’s reasoning it was easily recognizable that the disclaimer would not comply with the requirements of G 2/10, so that a discussion of whether the prerequisites according to G 1/03 might have been met became obsolete.

(iii) In the case underlying T 1870/08, a non-disclosed disclaimer was used to establish novelty over a prior art disclosure under Article 54(3) EPC. Thus, the decision relates to a situation where, in the light of G 1/03, a disclaimer always would be considered allowable.

T 1870/08 starts out by testing whether (and confirming that) the requirements according to G 1/03 were met. Then, after a lengthy discussion of the intentions of both G 1/03 and G 2/10 (sections 4.3-4.6 of the Reasons of the Decision), T 1870/08 comes back to the merits of the case, acknowledging the compliance of the disclaimer with G 2/10 by stating:

“Thus it is clear that there are genuine and realistic embodiments still encompassed by the amended claim. Furthermore, there is no pointer in the application or any evidence on file that the embodiments still covered by the claim would not provide the advantages of the invention or that the skilled person could not have reproduced them at the priority date. Put differently, there is no pointer in the application for not considering these embodiments as belonging to the invention. (...) Accordingly, the board is satisfied that the technical subject-matter remaining in the claim has been properly disclosed to the skilled person in the application as filed.”

In our view, these considerations might not exactly be those which the EBA might have had in mind when establishing the “Remaining Subject-Matter Test” in G 2/10. Thus, T 1870/08 does not seem to provide solid guiding principles with regard to assessing compliance with the requirements of G 2/10.

(iv) T 0748/09 also concerned a disclaimer serving to establish novelty over prior art under Article 54(3) EPC. With the disclaimer, certain compositional ranges from an alloy composition were removed from the claim. While the requirements of G 1/03 were considered to be met, the TBA came to the conclusion that, with the introduction of the disclaimer, the teaching remaining within the scope of the claim could not have been clearly and unambiguously derived from the application as filed, and that new subject-matter thus had been introduced. The disclaimer was therefore rejected as being inadmissible under Article 123(2) EPC, following the “Remaining Subject-Matter Test” pursuant to G 2/10.

Conclusion

The “Remaining Subject-Matter Test” established in G 2/10 introduces a new requirement for the admissibility of non-disclosed disclaimers under Article 123(2) EPC which adds to the requirements set out in G1/03. The test is recognized in the practice of the TBAs of the EPO. In applying the test, disclaimers which in the past would have been considered to be allowable by default in view of G 1/03 may be found, and actually have been found, to be in violation of Article 123(2) EPC. Consistent principles for applying the “Remaining Subject-Matter Test” of G 2/10 cannot be distilled from the few decisions which have applied this test so far, and therefore have still to emerge.

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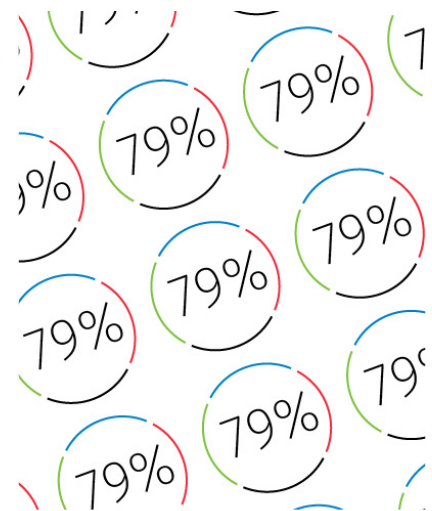
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