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T 2130/11 or how to escape the added matter – clarity trap for disclaimers

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The strict formalistic approach adopted by the EPO on many issues can easily lead to the applicant being trapped between various requirements of the EPC. One particularly well-known problem is the inescapable trap that arises if a patentee tries to remove a limiting feature that adds matter, contrary to Article 123(2) EPC, from a claim without contravening Article 123(3) EPC, i.e. the prohibition to extend the protective scope after grant. Another trap of practical significance can occur if an applicant tries to exempt novelty-destroying subject-matter from his claim by means of a disclaimer according to G 1/03 if the embodiment to be disclaimed is described in unclear terms. Such a case was decided by Board 3.3.07 in [T 2130/11](#) on 2 December 2014.

The applicant and appellant had tried to establish novelty over one prior art document under Article 54(3) EPC by disclaiming five relevant examples using the exact terms of said examples. However, these examples referred to trademarks and contained partially ambiguous references to preparation methods described in pre-published documents. Neither the use of trademarks nor references to prior art documents in the claims are normally considered by the EPO to fulfil the requirements of Article 84 EPC. On the other hand, according to G 1/03, it is one condition for a disclaimer to be allowable under Article 123(2) EPC that it does not remove more than is necessary to restore novelty. Any attempt of the applicant to avoid trademarks or references to the prior art were hence prima facie incompatible with G 1/03.

In T 2130/11, the competent Board has now shown applicants and patentees a way out of this dilemma. The Board held that the difficulty for the applicant or patent proprietor in formulating an allowable disclaimer cannot justify an exception in the application of Article 84 EPC which is not foreseen in the Convention. The requirements of Article 84 EPC must therefore apply for disclaimers as for any other feature in a patent claim. On the other side, the condition that a disclaimer should not remove more than is necessary to restore novelty should be applied while taking into consideration its purpose, namely that the “necessity for a disclaimer is not an opportunity for the applicant to reshape his claim arbitrarily” (G 1/03, point 3 in the reasons). In this respect, situations can be foreseen in which, while fulfilment of the condition taken in a strictly literal way would not be possible, a definition of the disclaimed subject-matter which satisfies the requirements of Article 84 EPC and fulfils the purpose of the condition (i.e. to avoid an arbitrary reshaping of the claim) may be achievable. In other words, a disclaimer removing more than strictly necessary to restore novelty would not be in contradiction with the spirit of G 1/03 if it was required to satisfy Article 84 EPC and it did not lead to an arbitrary reshaping of the claims.

This decision confirms one earlier decision (T 10/01, point 9 in the reasons) where the same issue had arisen and is to be welcomed for its pragmatic approach. It should hence be allowable to avoid unclear terms in the embodiment to be disclaimed by replacing them by slightly broader but clear terms. In view of T 2130/11, it appears for instance to be permissible to draft a disclaimer for an embodiment from which a reference to a prior art document is completely removed. Likewise, the use of trademarks for chemical compositions can be avoided by defining the chemical ingredients contained therein.

By Klemens Stratmann

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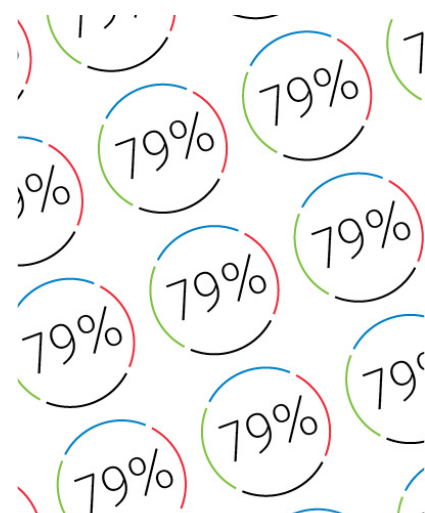
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