JONES DAY

COMMENTARY

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Disclaimers Double Standard Acknowledged by European Patent Office

IN SHORT

The Situation: A recent decision by the Enlarged Board of Appeal of the European Patent Office confirmed that a 2011 ruling dealing with disclosed disclaimers does not overrule its 2004 decision applying to undisclosed disclaimers.

The Double Standard: The conflict between the two EBA decisions pertains to situations where an undisclosed disclaimer is introduced into the claim. In those cases, the subject matter remaining in the claim most likely cannot be considered to have been explicitly or implicitly—and directly and unambiguously—disclosed in the application as filed.

Looking Ahead: "Undisclosed disclaimers" fulfilling the criteria set out in the 2004 decision are allowable under the assessment for added matter.

With its decision in G 1/16, the Enlarged Board of Appeal ("EBA") of the European Patent Office ("EPO") clarifies that its 2011 decision in G 2/10 dealing with disclosed disclaimers does not overrule its 2004 decision in G 1/03 that applies to undisclosed disclaimers.

According to the practice of the EPO, the claimed subject matter may be defined in terms of "negative" claim features that describe elements and characteristics that the claimed subject matter does not have. Such features are called "disclaimers." The term "undisclosed disclaimer" is applicable when neither the disclaimer itself nor the subject matter excluded by it is disclosed in the application as filed, whereas the term "disclosed disclaimer" relates to the situation in which the disclaimer itself might not have been disclosed in the application as filed, but the subject matter excluded by it has a basis in the application as filed, e.g., in an embodiment.

According to G 1/03, an undisclosed disclaimer may not be refused for introducing added matter under Article 123(2) EPC if it:

1. restores novelty against an Article 54(3) prior art (i.e., prior art filed before, but published after, the effective date of an application in question);
2. restores novelty against an accidental anticipation under Article 54(2) EPC; or
3. disclaims subject matter that is excluded from patentability under Articles 52 to 57 EPC;

under the condition that it:

(i) does not remove more than what is necessary to restore novelty or to exclude nontechnical subject matter;

(ii) is irrelevant for assessing inventive step or sufficiency of disclosure; and

(iii) is clear under Article 84 EPC.

However, according to the later decision G 2/10, which confirms the "gold standard" set by previous EBA decisions G 3/89 and G 11/91 for assessing whether a claim amendment introduces added matter under Article 123(2) EPC, if the subject matter remaining in the claim after the introduction of a disclaimer is not (explicitly or implicitly) directly and unambiguously disclosed to a skilled person using common general knowledge in the application as filed, such a disclaimer is unallowable under Article 123(2) EPC. Furthermore, it is suggested in G 2/10 that the gold standard should be applied to any amendment to a European patent application or patent that includes an amendment by way of introducing an undisclosed disclaimer, and that G 1/03 may not have intended to exhaustively define the conditions that an undisclosed disclaimer needs to fulfill in order to be allowable under Article 123(2) EPC.

Therefore, there appears to be a conflict between the two EBA decisions. Particularly, where an undisclosed disclaimer is introduced into the claim, the subject matter remaining in the claim most likely cannot be considered to have been explicitly or implicitly, and directly and unambiguously, disclosed in the application as filed. Should the gold standard in G 2/10 be applied to both undisclosed and disclosed disclaimers? If yes, should G 2/10 overrule G 1/03 and hence put an end to undisclosed disclaimers? If no, should the gold standard be modified in view of the exceptions for undisclosed disclaimers? These questions were referred to the EBA by a Technical Board of Appeal in the case T 0437/14.

The respective EBA decision G 1/16 has been recently issued. In this decision, EBA analyzes both G 1 /03 and G 2/10, and explains that the principle enshrined in Article 123(2) EPC, namely a European

patent application or patent may not be amended to contain subject matter extending beyond the content of the application as filed, is confirmed by G 2/10 and is not contradicted by G 1/03. Particularly, the EBA emphasizes that the introduction of an undisclosed disclaimer may not qualitatively change the invention as originally filed in the sense that the applicant's or patentee's position would be improved. However, the EBA acknowledges that G 2/10 leaves virtually no room for an undisclosed disclaimer being allowable and concludes that "proper tests" need to be applied depending on the nature and type of disclaimers introduced. Particularly, the EBA holds that while the gold standard test of G 2/10 is the only test applicable for a disclosed disclaimer, an undisclosed disclaimer is governed exclusively by the criteria set out in G 1/03.

It seems that life after G 1/16 goes on as we know it. Particularly, when introducing a "disclosed disclaimer," caution should be taken to ensure that the remaining subject matter in the claim is (explicitly or implicitly) directly and unambiguously disclosed to a skilled person in view of his/her common general knowledge, whereas when an "undisclosed disclaimer" is introduced, attention needs to be paid to the criteria laid down in G 1/03 in order not to change the identity of the invention as filed.

ONE KEY TAKEAWAY

1. The G 1/16 decision confirms that "undisclosed disclaimers" fulfilling the criteria set out in G 1/03 do not introduce added matter.

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