



G 1/16 (Disclaimer III)

Clarification of disclaimer practice at the EPO

Summary

In the recent G 1/16 decision, the Enlarged Board of Appeal has clarified how disclaimers should be examined at the EPO. “Undisclosed” disclaimers must meet the four-step test set out in G 1/03. In contrast, “disclosed” disclaimers must comply with the “gold standard” of G 2/10. Despite this clarification, disclaimers still present significant risks in Europe and should be used with caution.

Disclaimers

A disclaimer is a negative claim limitation, typically excluding specific embodiments or areas from the scope of a claim. An example of a claim that contains a disclaimer is: “A metal, wherein the metal is not steel”.

At the EPO, disclaimers are categorised as being either “disclosed” or “undisclosed”, depending on whether or not the disclaimed embodiment is mentioned in the application. The above example would be an undisclosed disclaimer if there was no mention of steel in the application. However, if the application did mention steel, for instance by stating that: “In some embodiments, the metal of the invention is not steel”, then the disclaimer would be a disclosed disclaimer. Under some circumstances, a disclosed disclaimer may also be based on a positive statement, such as: “In some embodiments, the metal of the invention is steel”.

G 1/03: Undisclosed disclaimers

In 2004, the Enlarged Board of Appeal in G 1/03 set out a four-step test for undisclosed disclaimers.

1. Is there a suitable reason for a disclaimer?
2. Does the disclaimer remove no more than is necessary?
3. Is the disclaimer unrelated to inventive step and sufficiency?
4. Is the disclaimer clear and concise?

In order for an undisclosed disclaimer to be permitted, the answer must be “yes” to each question.

Question 1 can be answered with “yes” if the need for the undisclosed disclaimer arises because of one of the three suitable reasons that are recognised in G 1/03. The first reason is removal of subject-matter excluded from patentability in Europe (e.g. methods of treatment). The second reason is establishing novelty over a novelty-only prior art document. At the EPO this would include an earlier-filed European patent application that was published after the effective filing date. The final reason is restoring novelty over “an accidental anticipation”. According to G 1/03, in order to qualify as “an accidental anticipation”, the prior art disclosure “must be so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention”.



Question 2 can be answered with “yes” if the disclaimer is no broader than is required to remove the subject matter excluded from patentability, to establish novelty over a novelty only prior art document or to restore novelty over an accidental anticipation (as appropriate).

Question 3 can be answered with “yes” only if the disclaimer does not impact on inventive step or sufficiency. Thus, for example, if an undisclosed disclaimer not only establishes novelty over an accidental anticipation, but also improves the position on inventive step relative to another piece of prior art, then the undisclosed disclaimer fails step 3.

Question 4 can be answered with “yes” if the disclaimer is drafted clearly and concisely. The requirements of steps 2 and 4 can sometimes be in conflict. For example, if a novelty only prior art discloses an embodiment in an unclear manner, then disclaiming no more than necessary (as required by step 2) could result in the disclaimer also being unclear, thereby falling foul of step 4. The EPO’s Guidelines for Examination suggest that, in some circumstances, it may allow an applicant to escape this trap by removing more than is necessary from a claim for the sake of clarity or conciseness.

G 2/10: Disclosed disclaimers

In 2010, the Enlarged Board of Appeal in G 2/10 was asked to consider whether a disclaimer adds matter if its subject matter was disclosed as a positive embodiment of the invention in the application. For example, would an applicant be able to disclaim “steel” from “metal” based on the following positive statement in the application: “In some embodiments, the metal of the invention is steel”.

The Enlarged Board of Appeal decided that a disclosed disclaimer is allowable if the subject matter remaining in the claim after the introduction of the disclaimer is explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed. This test is known as the “gold standard”.

Determining whether or not an amendment meets the gold standard 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, the nature and extent of the disclaimed subject matter and its relationship with the subject matter remaining in the claim after the amendment.

Does G 2/10 apply to undisclosed disclaimers?

G 2/10 contains several general statements that suggest that the gold standard test is not only applicable to disclosed disclaimers, but is also applicable to amendments in general. It was therefore unclear whether an undisclosed disclaimer must meet the requirements of: (a) the G 1/03 four-step test, (b) the G 2/10 gold standard, or (c) both tests. Divergent opinions were put forward by the Technical Boards of Appeal in subsequent decisions. The latest version of the EPO’s Guidelines for Examination appeared to endorse the application of both tests to undisclosed disclaimers.

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The Technical Board of Appeal in T 437/14 considered there to be enough uncertainty surrounding this issue to warrant a referral to the Enlarged Board of Appeal, which is how G 1/16 originated. The claim under consideration in T 437/14 contained two undisclosed disclaimers that addressed accidental anticipations. The Technical Board of Appeal thought that the disclaimers met the requirements of the G 1/03 four-step test, but that they failed the G 2/10 gold standard test because the subject matter remaining in the claim was not directly and unambiguously disclosed in the application as filed. Overall, the Technical Board of Appeal thought that it might need to apply both tests, but it was unsure how to do this. It therefore referred the following questions to the Enlarged Board of Appeal:

1. Is the gold standard referred to in G 2/10 applicable to claims containing undisclosed disclaimers?
2. If the answer to 1 is yes, is G 1/03 set aside?
3. If the answer to 2 is no, may the gold standard be modified in view of G 1/03?



In G 1/16, the Enlarged Board of Appeal decided that undisclosed disclaimers need to satisfy only the G 1/03 four-step test. The gold standard test of G 2/10 does not apply to undisclosed disclaimers (and so the answer to question 1 above is “no”).

The main reason for the Enlarged Board of Appeal's decision was that applying G 2/10 to undisclosed disclaimers would leave “virtually no chance of an undisclosed disclaimer being allowable”. This is because “where an undisclosed disclaimer is introduced into the claim it (almost) automatically follows that the subject matter remaining in the claim after the introduction [...] can hardly be considered to have been explicitly or implicitly, and directly and unambiguously, disclosed in the application as filed”.

Conclusion

The G 1/16 decision has clarified which test applies to each of the types of disclaimer recognised in Europe. Disclaimers should nevertheless still be used with great caution. If a disclaimer is judged to add matter post grant, it will often be impossible to remove the disclaimer without impermissibly broadening the scope of the granted claim.

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