

Barcelona, 31 January 2005

## DISCLAIMERS

### What is a disclaimer?

Characteristically, it is a limitation in a claim which creates a hole in the claim rather than, as an ordinary limitation does, decreasing the circumference of the scope of the claim. Think in terms of an Emmental cheese.

It can usually be recognized by its negative or proviso form: “alkyl but not isopropyl” or “with the proviso that when R is methyl, X is (or is not) Chlorine”.

Both those examples are chemical, and it is in chemical and pharmaceutical as well as to a limited extent in metallurgical practice that disclaimers are almost always found. An example in the EQE is in Paper A, Chemistry, of the 1992 exam.

### What is all the fuss about?

The practice which has developed in the EPO (but not in the USPTO) of allowing under certain conditions the insertion into a specification of **disclaimers without basis in the application as filed**.

In this text we are concerned only with disclaimers of that type; it is quite clear that there is no problem at all where basis for a disclaimer exists in the form of one explicitly provided on filing, or can be provided by the deletion of one or more parts of the original disclosure.

Are “without basis” disclaimers contrary to Art.123(2) EPC?

This is essentially the question which was put to the Enlarged Board of Appeal. There were two referring interlocutory Decisions; T 507/99, case G 01/03 and T 451/99, case G 02/03.

### History

The history and jurisprudence are laid out very helpfully in Paragraph 2 of Decision T 507/99, but the most important earlier Decisions are T 4/80 and T 170/87.

As summarised in T 507/99:

“The introduction of a disclaimer into a claim was allowed in the jurisprudence of the boards of appeal for the first time in decision T 4/80 (OJ EPO 1982, 149). In said decision a disclaimer in its negative form was held to be allowable, in order to delimit the claimed subject-matter against the disclosure in an earlier national patent application not belonging to the state of the art according to Article 54 EPC, if the subject-matter to be excluded was disclosed in the European patent application as filed and if further the subject-matter remaining in the claim could not be defined directly (positively) more clearly and concisely (Headnote I and points 2 and 3 of the reasons).”

and

“In decision T 170/87, OJ EPO 1989, 441, which is often cited as having formed the basis for the later comprehensive body of jurisprudence on

disclaimers, it is said under point 8.4.1 of the reasons, referring to decisions T 4/80 and T 433/86, that according to established Board of Appeal case law, in cases where what was claimed in general overlapped with the state of the art it was permissible to exclude a specific part of the state of the art from the claimed invention by means of a disclaimer, even if the original documents gave no (specific) basis for such an exclusion. According to decision T 170/87, point 8.4.3 of the reasons, this practice is justified on the basis of the following considerations: “The inventive teaching originally specifically disclosed in the application is not changed as a whole merely by delimiting it with respect to the state of the art or with respect to what has proved not to be functional; rather through the disclaimer (or through a “positive” wording leading to the same result), only the part of the teaching which the applicant cannot claim owing to lack of novelty or reproducibility is “excised” in the sense of a partial disclaimer... . All that is necessary is to define appropriately what under the given circumstances is left of the inventive teaching originally disclosed that is still capable of being protected.”

By contrast, it was held that a disclaimer cannot be used to make a novel teaching inventive (T 170/87, point 8.4.4 of the reasons; T 597/92, OJ 1996, 135, point 3 of the reasons).”

This apparently settled law has been challenged by Decision T 323/97 which held, as summarized in T 507/99, that

“an amendment to a patent by the introduction of a negative technical feature into a claim resulting in the exclusion of certain embodiments was, regardless of the name “disclaimer” nonetheless an amendment governed by Article 123(2) and (3) EPC. This meant that the amended claim had to find support in the application as filed (point 2.2 of the reasons). The Board then turned to decision G 2/98 (OJ EPO 2001, 413) and concluded, from the principles of legal certainty and consistency addressed in this decision in the context of the interpretation of the provisions on priority rights, that in the light of G 2/98 it could find no argument which would justify the maintenance of the practice of the earlier decisions to admit disclaimers having no basis in the application as filed.”

Despite the fact that there were later Decisions (e.g T 351/98, T 525/99) that did not follow T323/97, it is not surprising that this evident conflict was referred to the Enlarged Board.

## **The Questions**

The Questions put were as follows:

In T507/99:

“1. Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?

2. If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?

(a) In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?

(b) Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?

(c) Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?

(d) Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental, or

(e) is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the presence of an inventive step has then to be carried out as if the disclaimer did not exist?"

and in T 451/99:

"Is the introduction into a claim of a disclaimer not supported by the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?"

### **The President's Comments:**

According to the rules of procedure of the Enlarged Board the President of the Office may be invited to comment on questions. That happened here, and the President made in effect two submissions:

That it would be only fair to allow disclaimers where the applicant could not have known of the existence of the prior art, i.e. of the unpublished earlier application,

and

That there was a further possibility, namely that a disclaimer might be allowable to remove a "non-technical" bar to patentability. Here, the President gave examples of objections arising under Articles 53, particularly Article 53a, and 57.

### **The Answers:**

The headnote to the Decision says:

"I. An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.

II. The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:

II.1 A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is 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
- disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.

II.2 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.

II.3 A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter to Article 123(2) EPC.

II.4 A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC."

### Discussion:

It is easier to re-state the questions somewhat for the purposes of discussion:

1. Is such a disclaimer allowable at all?
2. If it is, is it only to distinguish for novelty under Art.54(3) or may it also be permissible when Art. 54(2) prior art is being distinguished from?
3. Are there other situations in which a disclaimer may be permissible?
4. What basis, if any, in the prior art is to be used for a disclaimer?
5. What material from the application is to be used in establishing whether a claim containing a disclaimer is allowable?

As to 1: First, note the general principle expressed in Art. 113 that the applicant or proprietor is responsible for what he puts forward. He is free to claim his invention as narrowly as he wishes, even if undue limitations are made. It follows that a limiting amendment should be allowed in the absence of any overriding prohibition.

Secondly, it has been consistent since the very early T 11/82 that Art.123(2) does not prohibit all additions to the specification but only those which increase the **subject-matter** ( *objet; Gegenstand* ) of the application. In that case the applicant had objected to a requirement under Rule 27 to insert an acknowledgment of the prior art into his specification, saying that this would add to its "content" and therefore be a ground for revocation. The Board disagreed; what was in the prior art could not be the subject-matter of the application. Likewise, in G 1/93, the Enlarged Board held that an insertion in Claim 1 which was not disclosed could be accepted if it merely amounted to an exclusion of protection for part of the invention as covered by the application as filed and did not provide a technical contribution to the claimed subject-matter.

It follows that a non-disclosed disclaimer must be allowable **if it does not add to the subject-matter of the application**; alternatively stated, as suggested by the wording used in T 170/87, must be allowable **if it results only in the limitation of a claim already having inventive activity**, as distinct from the creation of an inventive claim.

It also follows that a disclaimer is allowable if it is to remove an objection arising under Art 54(3) EPC, that is to remove an objection of lack of novelty only, when the prior art is an earlier-dated but not prior published EP application.

As to 2: If the principle in 1 above is correct, then in theory disclaimers should be allowable when proposed to overcome Art. 54(2) prior art, that is, prior art which is applicable in the consideration of both novelty and obviousness. But how are we to apply the tests (either of them) put forward at the end of 1? We must assume that the claim without its disclaimer lacks either novelty or inventive activity.

If the former, then, although the lack of novelty has (presumably) been cured by the amendment, we are left in the mentally confusing situation of having to assess the inventiveness (or subject-matter) of an application which actually includes the prior art. This is what has in fact been faced in the past in the case of a so-called “**accidental anticipation**”. This is one where broadly speaking the technical field of the prior disclosure is so remote from that of the application that it can be said that it would not have been considered by one skilled in the art as having any relevance to the invention, and yet includes “accidentally” a piece of identical disclosure; characteristically a disclosure of one or a few identical chemical compounds as having properties quite different from those shown in the application or patent. Apart from the difficulty of deciding how “accidental” is to be defined in this context, one would seem inevitably to be driven to the conclusion that dealing with an “accidental anticipation” by disclaimer cannot be allowable since the whole purpose is to permit a distinction of technical field, which must make a “technical contribution” and thus be unallowable. If the latter, to the extent that the disclaimer has conferred invention it is *ex hypothesi* unallowable.

Decision T 323/97 reached that result by arguing from the point of view of “**legal certainty**”, basing on the Enlarged Board Decision G 2/98, and said (again as summarised in T 507/99)

“It would not be possible with certainty to assess once and for all at a single point in time whether or not the limitation achieved by the amendment involved a technical contribution to the claimed invention, and whether or not the anticipatory disclosure was really accidental. For example, it was always possible that, when a particular embodiment was disclaimed from the generic teaching of a patent application because it was accidentally disclosed in a technical field completely outside that of the application, a further citation might later be found disclosing properties of the disclaimed embodiment within or relevant to the technical field of the application.”

However, the Enlarged Board disagreed.

It held, as we have seen, that a disclaimer for accidental anticipation **is** allowable. This is on the basis that in its opinion only novelty is at stake, since “the exclusion of such prior art does not contribute to the inventive merit of the technical teaching given” (Para 2.2.1). The Board noted that in most cases the applicant or patentee will be able to deal with the difficulty in quite a different way, namely by going to “use” or method

claims, but nevertheless felt it would be “unfair” to the applicant to restrict him in that way.

There is then lengthy discussion of the test for “accidental” in the Decision, the gist of which is that even if the skilled person had known of the document he would have disregarded it “either because it belonged to a remote technical field or because its subject-matter suggested it would not help to solve the problem. Thus....the disclosure has to be completely irrelevant for assessing inventive step.” (Para 2.2.2).

The problem is that the question of degree of relevance is a classic test of inventive merit! The Board was also influenced by the “unfairness” argument; but is it not equally “unfair” to have as full prior art a Doctoral thesis in Mongolian deposited, uncatalogued, in the library of the University of Ulan Bataar? How in the real world could the applicant have known of this?

As to 3: The Board recognized that the “non-technical” exclusions had nothing to do with inventiveness. It was logical that disclaimers to remove objections based on them should be permissible, even though the examples given in Paras 2.4.1 and 2.4.2 of the Decision are less than totally convincing.

As to 4: No basis seems to be given in the referring Decisions for asserting that the disclaimer must be limited to what is relevantly disclosed in the prior art. At least during the prosecution of an application the applicant may amend voluntarily – and see 1 above—and provided that the disclaimer is sufficient for its purpose there seems to me to be no reason why the applicant should not disclaim more widely. The position is different in opposition proceedings since according to Rule 57a EPC any amendment must be responsive to a ground of opposition, and an excessive disclaimer would not meet that test. (The attention of the Enlarged Board was not drawn to the fact that the referring Decisions were both in opposition appeals.)

However the Enlarged Board decided that this almost voluntary amendment should not be allowed since it would alter the way that applicants approached the problem of drafting their applications (Para 2.3.3)! They might have (too much) freedom to amend “arbitrarily” (Para 3)! No distinction was made between pre-grant and post-grant stages. So at the moment we are fixed with a strict restriction to what was in the relevant prior art together with a requirement, which the Board says arises under Art 84, for the prior art to be identified and the relationship between it and the disclaimer to be shown.

As to 5: One suggestion has been that the prior art distinguished from should be disregarded as prior art. There seems to be no support for this either in the Convention or in any general principle of law.

So the comparison must be made with the actual state of the prior art; but what is it that is to be compared? Art. 123(2) refers to the subject-matter of the “application”. But this is inchoate until the applicant tells us what it is that he regards as the invention. We can only equate that subject-matter with what is from time to time claimed in the application or patent. It seems to follow that the comparison must be made with the notionally unamended claim, before the insertion of the disclaimer. This gives a result consistent with the discussion under 2 above, since if the disclaimer is allowable in accordance with this decision no change can have been made in the inventive merit of what is claimed.

## Postscripts

1. All the above rightly requires that the claim both before and after disclaimer meets the clarity requirements of Art.84. There seems to be no reason why, as seems to be demanded in some of the earlier Decisions, the disclaimer *per se* need be clear.
2. Before grant the claim having the disclaimer must have unity of invention. This will be fulfilled if the test above is adopted, despite the claim lacking what we might call unity of novelty.
3. As already mentioned, although the Enlarged Board did not deal with the point since both references were in opposition proceedings, there seems to be no reason why the extent of disclaimers before grant need have any necessary relationship with the prior art. However the terms of the Decision are all-embracing.
4. Paradoxically, once voluntary amendment after grant will be possible under EPC2000 the criteria will apparently revert to those permitted before grant (subject always to Art.123(3)) and as far as is known at present the substantive allowability of the changes will not otherwise be examined by the EPO.
5. Rule 57a EPC is without prejudice to Rule 84 (different sets of claims for different countries when an earlier national right exists), so in oppositions disclaimers will presumably also be allowed, in order to avoid such national rights.
6. The Enlarged Board specifically recognizes that in some circumstances e.g. the discovery of new prior art, the disclaimer may be found to have in fact added subject matter. In that case the patentee may very well find himself in the "black hole"; he cannot maintain the disclaimer because it contravenes Art 123(2) and cannot delete it because that would contravene Art 123(3), and the patent is incurably invalid. (So much for the unchangeable legal certainty insisted upon in G2/98).
7. The Board did not deal with another possibility; prior art apparently having an earlier priority is found after grant not to be entitled to it. A disclaimer made during the application stage because of that prior art is therefore one which should not have been made and removal of it would contravene Art 123(3).