

EPO Enlarged Board Decision G1/16 - Disclaimers and Added Matter

The inclusion of a disclaimer, where subject matter is carved out from the scope of a patent claim by means of a negative feature is not explicitly allowed for in the European Patent Convention (EPC). In most circumstances, the subject matter of amendments to European patent applications must be derivable from the application as filed. However, Enlarged Board decision G1/03 and G2/10 allowed disclaimers in some circumstances. G1/16 confirms that the criteria for the allowability of an undisclosed disclaimer set out in G1/03 remain applicable and it is not also necessary for the subject matter of the disclaimer to be derivable from the application as filed.

“Undisclosed Disclaimers” and the G1/03 Criteria

In 2004, Enlarged Board referral G1/03 dealt with the situation of “undisclosed disclaimers”, those which seek to carve out from the scope of a claim subject matter of an earlier disclosure which the applicant could not have been aware of at the time of filing or subject matter that could not be covered for non-technical reasons, e.g. because it relates to unpatentable subject matter. G1/03 set out strict criteria when such “undisclosed disclaimers” were permissible. That decision has been interpreted as exempting disclaimers that meet the criteria from the need to be derived from the application as filed.

To illustrate, if the application as filed claims “fruit” as a genus, and an earlier novelty-only citation disclosed “apple”, G1/03 may allow a disclaimer to “apple” to be inserted even though “fruit other than apple” was not disclosed in the application as filed.

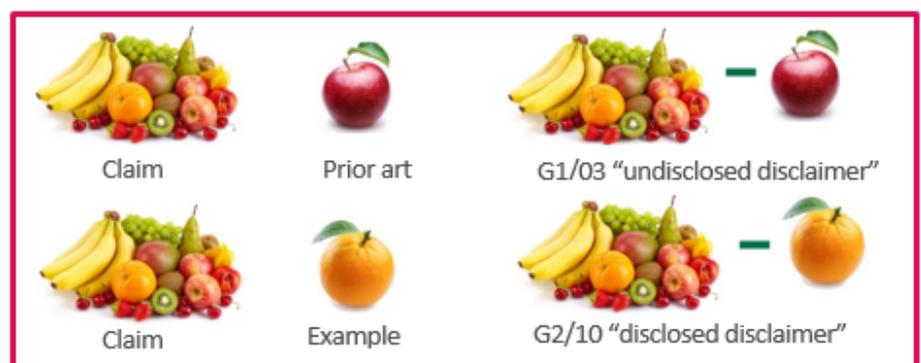
G2/10: “Disclosed Disclaimers” derivable from the application

In 2011, G2/10 dealt with the situation where subject matter disclosed in an application, e.g. as a possible embodiment, is removed from the scope of the claim. In order to comply with the requirements of Article 123(2) EPC it was held that such disclaimers must meet the “gold standard” of resulting in a claim, the subject matter of which is derivable from the application as filed, e.g. because the skilled person would have understood that the subject matter lacking the embodiment disclaimed is a possible alternative.

Continuing with the illustration, if the application disclosed the genus “fruit” with “orange” as an example, there may be an implicit disclosure of “fruit other than orange” enabling the addition of a disclaimer.



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The Question asked: Did G2/10 Supersede G1/03?

In essence, the issue to be decided was “Do all disclaimers have to fulfil the requirements laid out in G2/10 to comply with Article 123(2) EPC restricting the inclusion of new, undisclosed subject matter; or is the test laid out in G1/03 an alternative that permits “undisclosed disclaimers” that do not find basis in the application as filed in certain circumstances?”.

The Enlarged Board’s answer

The Enlarged Board clarified that the undisclosed disclaimers that meet the requirements of G1/03 do not also have to meet the “gold standard” added matter test of G2/10 in order to comply with Article 123(2) EPC. That is because the disclaimers allowed for under G1/03 do not provide a technical contribution to the subject matter disclose because those disclaimers by definition may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. Furthermore, the disclaimer may not remove more than necessary either to restore novelty or to disclaim subject matter excluded from patentability for non-technical reasons.

The technical contribution

To illustrate, when the claim before the amendment claimed “fruit” as a genus and the novelty-only citation earlier unpublished European application discloses “apple”, it must be considered whether the removal of “apple” from the scope of the claim provides a technical contribution. For example, if the technical effect is related to the

presence of citric acid, then removing apples, which contain some citric acid, from the claim does not make a technical contribution and the addition if the disclaimer is allowable under the G1/03 criteria. If the technical effect requires substantial levels of citric acid, then apples may have insufficient levels of citric acid to achieve the effect and their deletion from the claim as a non-working embodiment makes a technical contribution and the addition of the disclaimer must instead result in a claim that is derivable from the application as filed in accordance with G2/10.

Impact of the decision

The Enlarged Board’s answer clarifies that undisclosed disclaimers meeting the G1/03 criteria remain a possibility to avoid the prior art effect of unpublished application and accidental anticipations, and to carve out unpatentable subject matter. That confirmation is particularly important for those seeking to patent inventions in the life sciences area where the need to disclaim subject matter excluded from patentability for non-technical reasons is important. Predicting what will be considered patentable subject matter in the future is difficult and the ability of an Applicant to add an undisclosed disclaimer is often essential to enable them to adapt to shifting legal requirements.

The criteria under which disclaimers can be introduced remains restrictive and Applicants should continue to include fall back positions in their applications that allows scope for future amendments that meet the strict added matter test without needing to rely on

the availability of undisclosed disclaimers.

If you have any questions about matters in the Newsletter, please get in touch with the author, your usual Abel & Imray contact, or e-mail to ai@abelimray.com

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