

WHEN IS A DISCLAIMER ALLOWABLE IN A EUROPEAN PATENT APPLICATION?

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The provision of Art 123(2) and (3) of the European Patent Convention (EPC) is to avoid that an applicant or proprietor improves the scope of the application or patent by way of amendments.

Various decisions of the European Patent Office (EPO) technical boards of appeal deal with this topic and have resulted in several referrals to the Enlarged Board of Appeal. A recent decision G2/10 of August 30, 2011 adds further case law and guidelines of how to comply with Art 123(2) and (3) EPC when amending the application during the substantive examination and the granted patent during opposition proceedings.

According to landmark decision G1/93 from the Enlarged Board of Appeal, a granted European patent, that contains subject matter which extends beyond the content of the application as filed and which subject matter also limits the scope of protection conferred by the patent, cannot be maintained in opposition proceedings unamended.

G1/93 provides generic guidance of how to make such amendments. In particular, G1/93 clarifies that if a limiting feature provides a technical contribution to the claims, the granted patent cannot be amended just by deleting the limiting features from the granted claims without violating Art 123(2) and (3) EPC. It is, however, allowable to replace the added subject matter with corresponding subject matter having proper basis in the application as filed.

If the added subject matter does not limit the scope of the claim it can be removed. If a limiting feature, which has not been disclosed in the application as filed, does not provide a technical contribution to the claimed invention and merely limits the protection conferred by the patent as granted by excluding protection for part of the subject matter of the claimed invention as covered by the application as filed, it can however remain in the granted claim. If any of this is impossible the patent is likely to be revoked.

Whereas G1/93 deals with the addition of undisclosed features, G1/03, G2/03 and G2/10 deal with various allowable and non-allowable approaches to use disclaimers in view of Art 123(2) and (3) EPC.

G1/03 and G2/03 found that a disclaimer could be allowable if it restores novelty by delimiting a claim against a prior right; if it restores novelty by delimiting a claim against an accidental anticipation that is unrelated and remote from the claimed invention; or if it serves to disclaim subject matter which is excluded by the EPC from patentability for non-technical reasons.

In G2/10 the referring technical board of appeal held that a disclaimer introduced to render the main claim novel over the prior art was not disclosed as such in the application as filed and that the criteria differ from those of earlier decisions G 1/03 and G 2/03.

“DISCLAIMING SUBJECT MATTER DISCLOSED IN THE APPLICATION AS FILED IS ALLOWABLE IF THE DISCLOSURE TEST AFFIRMS SO.”

In the application under appeal the prior art belonged to the same technical field and the examining division found that it was not so unrelated to and removed from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention. Moreover, the inventor and applicant were the same, and also the content of the application and the prior art were to a large extent identical.

The purpose of the referral was then to clarify diverging views and solutions and resulted in the general question below:

“Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?”

In the present application the excluded subject matter was already in the application as filed and the Enlarged Board of Appeal found G1/03 not to be applicable.

The referral was answered as follows:

“1a. An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

1b. Determining whether or not that is the case 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 as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.”

In conclusion, disclaiming subject matter disclosed in the application as filed is allowable if the disclosure test affirms so.

In the past the EPO has used a very strict practice not to allow the applicant to disclaim disclosed subject matter. In view of G2/10 we expect the EPO to allow these kinds of disclaimers in the future. ■

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