

Enlarged Board of Appeal
European Patent Office
80298 Munich
Germany

CIPA
The Chartered Institute of Patent Attorneys

95 Chancery Lane
London WC2A 1DT
T: 020 7405 9450
F: 020 7430 0471
E: mail@cipa.org.uk
w: cipa.org.uk

PATENTS
TRADE MARKS
DESIGNS
COPYRIGHT

***Amicus curiae* brief in case G 1/16 (Disclaimers)
by The Chartered Institute of Patent Attorneys**

1st MARCH 2017

RESPONSE BY THE CHARTERED INSTITUTE OF PATENT ATTORNEYS

About CIPA

The Chartered Institute of Patent Attorneys (CIPA) is the United Kingdom professional body which represents over 2000 UK patent attorneys. Most of our UK patent attorney members are also European Patent Attorneys. We also have a number of other members who are European Patent Attorneys while not fully qualified as UK patent attorneys. Our members play major roles not only in representing clients before the European Patent Office but also in advising clients about the effects of European patents after grant.

Reply to Lee Davies, CEO, CIPA

leedavies@cipa.org.uk

Introduction

The present referral seeks to clarify apparent contradictions between previous Enlarged Board decisions G1/03 and G2/10. The board in the current referring decision, T0437/14, considers that although at first glance the previous decisions appear to apply to different situations, it concluded that on further analysis G2/10 required Article 123(2) EPC to be applied to any amendment of a claim, without exception, and hence to disclaimers apparently permitted under G1/03 (*inter alia*, to deal with Article 54(3) issues and accidental anticipations under Article 54(2) EPC). The consequence of this, according to the referring board, is that any disclaimer excluding undisclosed subject matter “almost by definition” contravenes Article 123(2) EPC because what remains cannot be regarded as having been explicitly or implicitly, but directly and unambiguously disclosed.

The questions referred:

1. Is the standard referred to in G2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?
2. If the answer to the first question is yes, is G1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?
3. If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in answer 2.1 of G1/03 apply in addition to the gold standard, may this standard be modified in view of these exceptions?

Proposed answers

CIPA considers that the reference in Question 1 to ‘undisclosed disclaimers’ is somewhat ambiguous. It would appear that the question concerns undisclosed disclaimers in all circumstances, and not only those limited circumstances in which G1/03 held undisclosed disclaimers to be allowable. Furthermore the answer to Question 1 depends at least in part on how the standard referred to in G2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC (i.e. whether the skilled person would, using common

general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed) is interpreted and applied.

In view of the ambiguities present in Question 1 it is necessary to provide more than a simple 'yes' or 'no' answer. In CIPA's view Question 1 can be answered as follows:

Insofar as an undisclosed disclaimer meets the strict criteria set out in G1/03, i.e.

- It is introduced for the purposes of restoring novelty in respect of document cited under Article 54(3) EPC or an accidental anticipation under Article 54(2) EPC, or is to remove subject matter which is not eligible for patent protection e.g. under Article 53 EPC or Article 57 EPC,
- It does not remove more than necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons;
- It does not become relevant for inventive step or sufficiency of disclosure; and
- it meets the requirements of clarity and conciseness of Article 84 EPC;

then it is not necessary additionally to consider the test referred to in G2/10.

In the light of this answer, it is clear that the answer to question 2 would be that G1/03 is not set aside.

Where, however, an undisclosed disclaimer does not meet the criteria of G1/03, (for example because it is relevant to the determination of inventive step or sufficiency of disclosure) then it is necessary to consider whether the amendment contravenes Article 123(2). In this situation the correct test for added matter is the 'gold standard' as set out in G3/89.

If it becomes necessary to answer question 3, we contend that in view of the above answers there is no need to modify the gold standard, but only to apply the test set out in G3/89 in the correct manner, namely to consider the **technical content** rather than the literal wording of the amended claim.

Undisclosed disclaimers should be permitted in the circumstances laid down in G1/03

G1/03 made a comprehensive review of the various situations where undisclosed disclaimers may be used and concluded that in the case of 'undisclosed disclaimers' i.e. where there was no basis in the application as filed for the disclaimed subject

matter, these could be permitted in very limited circumstances, namely for the purposes of restoring novelty in respect of a document cited under Article 54(3) EPC or an accidental anticipation under Article 54(2) EPC, or to remove subject matter which is not eligible for patent protection e.g. under Article 53 or Article 57 EPC.

Such disclaimers are important to enable an applicant to delimit an application from prior art which s/he was not (or was deemed not to be) in a position to know about at the time of preparing and filing their own application (namely a prior disclosure under Article 54(3) EPC or an accidental anticipation under Article 54(2) EPC) or to take account of different laws in different jurisdictions (Article 53 EPC and Article 57 EPC). This provides a fair outcome for the applicant as well as certainty for third parties, and enables the proper functioning of the patent system.

If these disclaimers are considered to be 'almost by definition' in contravention of Article 123(2) EPC, as suggested in the current referring decision, it will result in an unfair outcome for many applicants. For example, in the case of a conflicting application under Article 54(3) EPC, if the later applicant is not able to disclaim the overlapping subject matter without contravening Article 123(2) EPC (as considered by the referring decision) then s/he will lose protection for subject matter to which s/he is entitled. Even if the applicant is in a position to adopt a narrower fall-back position, it is likely that this will nevertheless result in exclusion of some subject matter which is not anticipated by the earlier application, and which the later applicant should be entitled to claim.

In coming to its conclusions in G1/03 the Enlarged Board certainly did not ignore the effect of the disclaimer in relation to Article 123(2) EPC, but on the contrary considered whether specific types of disclaimer would contravene Article 123(2) EPC as will be discussed in more detail below. The Enlarged Board reasoned that in certain situations the disclaimer was made for a legal, or non-technical reason and thus has no bearing on the technical information in the application or does not contribute to the invention (Paragraphs 2.1.3 and 2.6.4 of the reasons). Hence it concluded that such disclaimers do not contravene Article 123(2) EPC.

In considering the possibility of disclaimers making a technical contribution, G1/03 states:

“ In defining the situations in which a disclaimer may be allowed in order to overcome an objection as indicated in points 2.1, 2.2 and 2.4, care has been taken to make

sure that the reason justifying a disclaimer is not related to the teaching of the invention.” (Paragraph 2.6 of the reasons)

and

“Only the approach restricting disclaimers to limitations not contributing to the invention and thereby taking the decisive criterion from Article 123 (2) EPC rather than Article 56 EPC complies with the Convention”. (Paragraph 2.6.1 of the reasons).

Thus, G1/03 sets out clearly and with detailed reasoning, the circumstances in which undisclosed disclaimers should be allowed in accordance with Article 123(2) EPC and when they should not. The Enlarged Board in that case also set out clear guidance for the drafting of disclaimers, namely that they should not remove more than is necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons (Order, 2.2). Furthermore, the decision made it abundantly clear that the disclaimer may serve exclusively the purpose for which it is intended and nothing more, so that a disclaimer must not be relevant for the assessment of inventive step or sufficiency, noting that:

“A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds matter contrary to Article 123(2) EPC” (Order 2.3).

How should Article 123(2) EPC be applied to claims including a disclaimer?

According to Article 123(2) EPC: The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

EPO jurisprudence has determined that ‘subject matter which extends beyond the content of the application as filed’ can be introduced not only by addition of features, but also by deleting features in such a way that the subject matter remaining provides a new teaching, such as an intermediate generalisation of features that would not have been evident from the application as filed.

In the referring decision, T0437/14 the Board is of the opinion that any disclaimer excluding ‘undisclosed’ subject matter ‘almost by definition’ contravenes Article 123(2) EPC. They argue that ‘If a whole is reduced by an undisclosed first part, the present board fails to see how the remaining second part could ever be regarded as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed.’ This would appear to be construing the amended claim in an extremely literal manner. The Board

illustrated their point by reference to a bite taken out of an apple, concluding that 'what remains is recognisably no longer the same apple as the original one'. However, what is presented to the skilled person in a claim containing a disclaimer is the whole of the apple, unchanged, together with the 'bite'. The claim does not present only the 'remaining second part' i.e. the apple minus the bite, and should not be viewed in this way. It is further noted that the 'bite' is of course provided by the prior disclosure and so is already known. The skilled person will thus readily be able to ascertain for themselves the difference between the prior and subsequent disclosures, even absent the disclaimer.

Consideration of Art 123(2) in G1/03

An 'undisclosed disclaimer' according to G1/03 is one made, usually in relation to a prior disclosure under Article 54(3) EPC or an 'accidental anticipation' under Article 54(2) EPC where there is no (explicit) basis in the application as filed for the necessary disclaimer. In view of the nature of these prior art disclosures it is of course to be expected that no basis will have been provided at the time of filing, as by their very nature, the applicant could not be (or is deemed not to have been) aware of the prior disclosure and was therefore unable to draft the specification and claims so as to avoid it.

G1/03 considered the effect of Art 123(2) in relation to such disclaimers in some detail:

*For the interpretation of Article 123(2) EPC, it may be concluded from the foregoing (point 2.1.1) that the purpose of a disclaimer excluding a conflicting application is merely to take account of the fact that different applicants are entitled to patents in respect of different aspects of inventive subject matter and **not to change the given technical teaching**. The disclaimer splits the invention as a whole into two parts: in respect of the identical part, it preserves the rights of the first applicant; for the rest, disclosed for the first time in the later application, it attributes the right to the second applicant. This approach restricts the effects of Article 54(3) EPC to resolving the problem of double patenting.*

*Such a disclaimer, **only excluding subject matter for legal reasons**, is required to give effect to Article 54(3) EPC and has no bearing on the technical information in the application. **It is, therefore, not in contradiction to Article 123(2) EPC**. Applied in this sense, the term disclaimer is justified also in its literal meaning. An invention comprising different specific embodiments or groups thereof has been disclosed in the application as filed, a part of which is excluded from the requested protection, i.e. no longer claimed. **The remaining subject***

matter is not modified in any way. (Paragraph 2.1.3 of the reasons; emphasis added)

This suggests that there is no need to construe the ‘remaining subject matter’ in respect of disclaimers which are made solely for legal, non-technical reasons and which have no other effect.

Consideration of Article 123(2) in G2/10

In **G2/10** the purpose of the referral was to clarify whether the conditions set out in G1/03 apply also to the disclaiming of disclosed subject matter. The Enlarged Board concluded they did not, but also considered more broadly whether a claim including such ‘disclosed disclaimers’ infringe Article 123(2) EPC. It considered that, in accordance with the principle that any amendment must fulfil the requirements of Article 123(2) EPC, the test for allowability of a **disclosed** disclaimer is that the skilled person must not be presented with any new technical information (paragraph 4.5.1). It further stated, in the context of disclosed disclaimers, that whether the skilled person is presented with new information depends on how he or she would understand the amended claim, i.e. the subject-matter remaining in the amended claim, and further that ‘no convincing reason has been advanced for not applying the principles developed in the context of Article 123(2) EPC for the assessment of amendments to claims by the introduction of positive limiting features in the same manner to limitations of claims by disclaimers which disclaim subject-matter disclosed in the application as filed.’ (paragraphs 4.5.2 and 4.5.5)

G2/10 discusses the basic principle underlying Article 123(2) EPC in the jurisprudence of the Enlarged Board (paragraph 4.3) with reference to G3/89 and G11/91 concerning amendments made by way of correction under Rule 88 EPC. In those decisions it was stated that:

*The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may therefore be corrected under Rule 88, second sentence, EPC only within the limits of what a **skilled person would derive** directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, **from the whole of these documents as filed.** (emphasis added).*

G2/10 notes that this has become the generally accepted ‘gold standard’ for assessing

compliance with Article 123(2) EPC, and goes on to apply this to disclaimers, as follows:

*“From these rulings it follows that **any** amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents, as filed..”(paragraph 4.3 of the reasons)*

“Therefore, as is the case for any other amendment, the test for an amendment to a claim by disclaiming subject matter disclosed as part of the invention in the application as filed must be that after the amendment the skilled person may not be presented with new technical information.” (paragraph 4.5.1 of the reasons)

“Whether the skilled person is presented with new information depends on how he or she would understand the amended claim, i.e. the subject matter remaining in the amended claim and on whether, using common general knowledge, he or she would regard that subject matter as at least implicitly disclosed in the application as filed.” (paragraph 4.5.2).

G2/10 further notes that this requires a **technical assessment**, where the test to be applied is: *“whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim [after the introduction of the disclaimer] as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed. “ (Paragraph 4.5.4 of the reasons)*

It is therefore quite clear from G2/10 that what is important in relation to an amendment by way of disclaimer is not the literal wording of the claim *per se*, but the technical content or subject-matter and the meaning it conveys to the person skilled in the art. This is also made clear by the current Guidelines for Examination, according to which:

“Literal support is, however, not required by the wording of Art. 123(2) (see T 667/08)”

Interpretation of G2/10 in relation to undisclosed disclaimers

As discussed above, G2/10 was fundamentally considering ‘disclosed disclaimers’ and set out the aforementioned tests for compliance with Article 123(2) EPC in that context. The

conclusions of G2/10 do not refer to undisclosed disclaimers; crucially G2/10 did not set aside G1/03.

Nevertheless, G2/10 has subsequently been applied to cases involving undisclosed disclaimers. However, the interpretation and application of the test set out in G2/10 by different Technical Boards of Appeal appears to have been somewhat inconsistent, as discussed in the referring decision, T0437/14. In some cases, e.g. T2464/10 and T1872/14 the respective TBA's considered whether the technical information presented to the skilled person had been modified, and concluded it had not, whereas in T0748/09 the Board held that by introducing restrictions which were exclusively based on a cited document rather than the technical disclosure of the application, the skilled person is confronted with new subject matter that cannot be derived clearly and unambiguously from the application as originally filed. This latter approach appears to be an incorrect application of the test as set out in G2/10, looking only at the literal wording of the claim in a formalistic manner and not at its technical teaching as it would be understood by the person skilled in the art. It is to be noted that here the 'person skilled in the art' is skilled in the relevant technical field, and not in the art of drafting or interpreting patent specifications.

T0437/14 appears to follow this more literal approach in view of the statements in Paragraph 8.1:

“ If the gold standard of G2/10 were to be applied to claims containing undisclosed disclaimers... then an undisclosed disclaimer would in the present board's view in most cases not be allowable under Article 123(2) EPC. A disclaimer excluding undisclosed subject-matter almost by definition contravenes Article 123(2) EPC.”

and

“If a whole is reduced by an undisclosed first part, the present board fails to see how the remaining second part could ever be regarded as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed.”

These statements suggest that what is being considered is the literal wording of the claim rather than the technical content as it would be understood by the person skilled in the art. Indeed, the Board in T0437/14 appears to consider this literal, formalistic approach, for example as applied in T0748/09 to be the 'gold standard'; in contrast the Board referred to the approach adopted in T2464/10 and T1872/14 (in which the respective boards considered whether the amendment presented new technical information) as a 'modified gold standard' (paragraphs 9.1.3 and 9.1.4).

This is confirmed in paragraphs 10.2 to 10.4 of the present referring decision, where the Board contrasts the 'gold standard applied as outlined in point 7.4 in conjunction with point 8.1' with 'the gold standard applied in modified form'.

In our view the gold standard as perceived by T0437/14 goes beyond the tests set out in G3/89 and G2/10 which made it abundantly clear that what matters is the technical information that the skilled person can derive using common general knowledge from the whole of the application as filed. Thus the 'gold standard' inherently requires an assessment of the technical information presented in the claim and does not require modifying.

The referring decision also argues that excluding subject-matter from a claim by way of an undisclosed disclaimer does change the technical content of the claim, based on a statement in G1/03 that 'Any amendment to a claim is presumed to have a technical meaning'.

This cannot have been the outcome intended by the Enlarged Board in G1/03. There would have been little point in setting out in detail the types of undisclosed disclaimers allowable, the restrictions on drafting them, and the restrictions on their effect, if the 'remaining subject matter' will in practice always contravene Article 123(2) EPC. Of course, G1/03 did not say that all undisclosed disclaimers were *a priori* allowable; it imposed very stringent criteria as set out in points 2.2 -2.4 of the Order. And it made it very clear that a disclaimer which is relevant for inventive step or sufficiency does add subject matter contrary to Article 123(2) EPC. Thus G1/03 is also in line with G3/89.

However, G1/03 also makes it clear that a disclaimer only excluding subject matter for legal reasons, to give effect to Article 54(3) EPC (and Article 54(2) EPC in relation to accidental anticipations) has no bearing on the technical information in the application and is therefore not in contradiction to Article 123(2) EPC.

In CIPA's view the approach adopted in G1/03 in relation to undisclosed disclaimers is the correct one. Thus, G1/03 has interpreted Article 123(2) EPC in relation to the *technical teaching* of the claim including an undisclosed disclaimer. As noted above, the Enlarged Board in that case set out limited circumstances in which a disclaimer can be made for a legal, or non-technical reason and has provided clear guidance as to the circumstances in which a disclaimer has no bearing on the technical information in the application or does not contribute to the invention and thus is in compliance with Article 123(2) EPC.

There is thus no need to apply the test of G2/10 to such disclaimers, as they are already regarded as complying with the requirement that the skilled person is not presented with any new technical information.

In relation to undisclosed disclaimers that do not meet the criteria of G1/03 the allowability of the amendment should be assessed according to the 'gold standard' of

G3/89, i.e. by determining whether the skilled person is provided with any new technical information. An assessment based only on the literal wording of the claim, as appears to be suggested in the referring decision, goes beyond the 'gold standard' and is not the correct approach.

Conclusions

- Undisclosed disclaimers should be permitted in the circumstances laid down in G1/03.
- Providing it meets the criteria of G1/03 a disclaimer does not modify the technical teaching of the application in any way.
- In these circumstances there is compliance with Art 123(2).
- G1/03 and G2/10 concern different situations and they are not in conflict with each other, nor with G3/89. Rather these decisions are complementary.
- For disclaimers which do not meet the criteria of G1/03, the standard for compliance with Article 123(2) is the gold standard set by G3/89, and requires an assessment of whether the skilled person is presented with new technical information which cannot be derived from the application as filed.