

EPO Enlarged Board of Appeal rules on disclaiming “positive embodiments” of an invention

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In Decision G2/10 the Enlarged Board of Appeal of the European Patent Office (EPO) dealt with the question of whether a disclaimer infringes Article 123(2) of the European Patent Convention if its subject matter was disclosed as an embodiment of the invention in the application as filed.

In earlier Decision G1/03 the board held that the introduction of a disclaimer not disclosed in the application as originally filed into a claim may be allowable if it is made under one of the following conditions:

- In order to restore novelty by delimiting a claim against the state of the art under Article 53(3) of the convention.
- In order to restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) of the convention, whereby 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.
- In order to disclaim subject matter which, under Articles 52 to 57 of the convention, is excluded from patentability for non-technical reasons.

The term "disclaimer", as used in Decision G1/03, refers to an amendment to a claim that results in the incorporation of a "negative" technical feature. Typically, specific embodiments or areas are excluded from a more general feature ("negative embodiment"). Following Decision G1/03, different opinions have been expressed in decisions of the EPO Technical Boards as to whether the findings of Decision G1/03 also apply to disclaimers disclaiming embodiments which had originally been disclosed in the application as filed as being part of the invention ("positive embodiments").

The patent application in question in Decision G2/10 related to catalytic DNA molecules that are capable of cleaving nucleic acid sequences, in particular RNA, in a site-specific manner. The claims according to Auxiliary Requests II and III included a disclaimer whose subject matter had been originally disclosed as an embodiment of the patent application. The Examining Division rejected the auxiliary requests on the grounds that the disclaimer contained therein had not been disclosed as such in the application as filed, and furthermore the requirements of Decision G1/03 were not met. The disclaimer served to render the subject matter novel under Article 54(2) of the convention over Document D1, however, Document D1; belonged to the same technical field as it also dealt with catalytic DNA molecules. Thus, 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.

In the subsequent appeal proceedings the Technical Board concluded that it made a decisive difference whether earlier Decision G1/03 would also relate to disclaimers disclaiming embodiments which had originally been disclosed in the application as filed as being part of the invention. In the first case, Auxiliary Requests II and III would have to be rejected under Article 123(2) of the convention (added matter), whereas in the second case, these requests would be considered not to offend against Article 123(2) and the decision under appeal could be set aside.

The Enlarged Board of Appeal argued that cases of added matter to a claim would be possible where the insertion of a disclaimer into a claim would result in singling out any hitherto not specifically mentioned or at least implicitly disclosed individual compounds, or would lead to a particular meaning of the remaining claimed subject matter which was not originally disclosed.

Following referral by the Technical Board of Appeal, the Enlarged Board of Appeal had to answer the following questions:

- Whether an amendment to a claim by the introduction of a disclaimer would infringe Article 123(2) of the convention if the subject matter of the disclaimer was disclosed as an embodiment of the invention in the application as filed.
- Whether Decision G1/03 was applicable to such cases.

In Decision G2/10 the board first clarified that Decision G1/03 did not decide the issue of disclaimers disclaiming subject matter disclosed in the application as filed. The board went on to confirm that any



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amendment to a claim is presumed to have a technical meaning, as it would otherwise be useless to have it in the claim. Hence, a disclaimer cannot merely be regarded a voluntary restriction by which the applicant abandons part of the claimed subject matter, and therefore, the disclaimer *per se* is not a technical feature of a claim that cannot violate Article 123(2) of the convention and should always be allowed. If, under Article 123(2), a positive feature which defines subject matter that is actually claimed is introduced into a claim, it should be examined whether the subject matter of that feature was disclosed in the application as filed. By contrast, a disclaimer does not as such define a feature of the claimed invention, but something that is not claimed. However, the test to be applied in the examination under Article 123(2) was whether the skilled person would, using common general knowledge would, regard the remaining claimed subject matter as directly and unambiguously disclosed in the application as filed. This test is the same as that for the examination of admissibility of a limitation by including a positive feature in the claim. Hence, when it comes to the inclusion in a claim of a disclaimer whose subject matter is disclosed in the application as filed, no principles must be taken into account other than those considered for the inclusion of a positive feature into a claim.

Accordingly, in the headnote of Decision G2/10, the board answered the question referred to it 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 Art 123(2) [of the convention] if the subject matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly or unambiguously disclosed to the skilled person using common general knowledge, in the application as filed; and
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 amendment."

There remains a degree of uncertainty as to when a "disclaimer for disclosed subject matter" is allowable under G2/10. From the detailed reasoning given in the decision, it appears that the board sees no problem with the allowability of disclaimers relating to a specific embodiment of the invention (eg, a specific example or a specific chemical compound disclosed in the application). However, problems may arise in cases where the disclaimer results in the singling out of an individual compound or group of compounds that is not specifically mentioned or at least implicitly disclosed in the application, or would lead to a particular meaning of the remaining claimed subject matter which was not originally disclosed.

In view of this, it should, for example, be permissible in a pharmaceutical case to limit broad chemical Markush formulae to the lead compound(s) or other specific embodiments for which data-supporting inventive steps are available, thereby obtaining quick protection for these, while the remaining scope of the Markush formula, as defined by a disclaimer for the lead compound(s), can be pursued in a divisional application. However, some uncertainty remains and further Board of Appeal decisions will be required to address the allowability of disclaimers for disclosed subject matter in concrete situations.

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