

Disclaimers return to the limelight at the EPO

What is a disclaimer?

A disclaimer is a “negative” feature introduced into a patent claim that excludes a specific embodiment from the scope of the claim. In the life science and chemical fields, disclaimers are often used to exclude a specific gene sequence or chemical compound from the scope of a patent claim. Disclaimers have recently become a hot topic at the EPO, as various Technical Boards of Appeal have come to conflicting decisions as to when a claim may be amended by disclaimer. Indeed, the matter was first referred to the Enlarged Board of Appeal in 2003, which sought to clarify the circumstances in which an “undisclosed” disclaimer, i.e. one that had no basis in the original application, could be introduced into a patent.

G1/03 restricts the use of “undisclosed” disclaimers

In G1/03, the Enlarged Board of Appeal established criteria for assessing whether an undisclosed disclaimer could be introduced into a European patent application. In particular, the Enlarged Board held that an undisclosed disclaimer may be allowable:

- i) to distinguish a European patent or patent application from an earlier European patent or patent application that had not yet published when the former was filed,
- ii) to restore novelty over an “accidental” anticipation, i.e. one arising from prior art so unrelated and remote from the claimed invention that a skilled person would never have taken it into consideration when making the invention, and
- iii) to disclaim subject matter that was excluded from patentability for non-technical reasons (e.g. for moral reasons).

Is a disclaimer that excludes disclosed subject matter “undisclosed”?

G1/03 soon sparked a debate as to whether a disclaimer that excluded subject matter that was clearly disclosed constituted an “undisclosed” disclaimer within the meaning of G1/03. The question was highly relevant because G1/03 placed strict limitations on the circumstances in which an undisclosed disclaimer could be introduced into an application. These restrictions would not apply to disclaimers that were considered to have basis in the original application, allowing such disclaimers to be used more widely e.g. to establish both novelty and inventive step.

Do the rules of logic apply?

Many practitioners took the view that, if the subject matter disclaimed from the claim was disclosed in the original application, the disclaimer had, by logic, to have basis in the application as filed. By way of example, it can perhaps be argued that a disclosure of an alkyl group possibly being methyl is effectively an implicit disclosure of that alkyl group possibly not being methyl. Indeed, such arguments were consistent with the EPO’s traditional approach to disclaimers, whereby the exclusion of a disclosed embodiment by disclaimer had long been permitted (T4/80).

Belgrave Hall, Belgrave St,
Leeds, LS2 8DD, UK

Tel: +44 (0) 113 233 0100
Fax: +44 (0) 113 233 0101
Email: marketing@hgf.com

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This traditional approach was followed by the Technical Board of Appeal in T1107/06. Here, the Board held that, if a disclaimed embodiment was disclosed in an application as a preferred embodiment, the non-preferred embodiments would implicitly be disclosed as a logical complement to the disclaimed embodiment. Accordingly, the Board held that a disclaimer relating to a disclosed embodiment should not be considered as “undisclosed” within the meaning of G1/03. In T1102/00, however, the Technical Board of Appeal took the opposite view and held that a disclaimer could only be considered to have basis in the original text, if the original application clearly indicated that this subject matter of the disclaimer could be disclaimed.

G1/10 warns against over-simplistic rules of logic in favour of established tests for added matter

Faced with such conflicting decisions, the Technical Board of Appeal in T 1068/07 referred the matter to the Enlarged Board of Appeal. In their decision G1/10 (30 August 2011), the Enlarged Board dismissed the idea put forward in T1102/00 that, for a disclaimer to have basis, the disclaimer itself had to be disclosed in the original application. At the same time, however, the Enlarged Board emphasised that a disclaimer did not be automatically have basis solely because it excluded subject matter that was disclosed in the original text. In this regard, the Enlarged Board dismissed the so-called rules of logic as being overly simplistic. To support its position, the Enlarged Board referred to T615/95, which permitted an Applicant to delete specific chemical substituents from lists of possible chemical substituents covered by a claim. In that decision, the Technical Board of Appeal had held that such deletions were allowable because they merely shrunk the generic group of compounds covered by the claim and did not result in a previously undisclosed combination of chemical substituents being selected for protection. By way of analogy, the Enlarged Board of Appeal argued that a disclaimer could potentially have the effect of singling out compounds that were not contemplated by the original disclosure. This would result in the disclaimer adding subject matter, despite the fact that it excluded subject matter that had basis in the original text. In the Enlarged Board’s view, the definitive question was whether the skilled person would be presented with new information as a result of the disclaimer. The tests to be applied were no different to those used to determine whether a positive limitation introduced into a claim added subject matter.

Conclusions

- i) A disclaimer may be considered to have basis if it excludes subject matter that is clearly disclosed in the original application.
- ii) However, the disclosure of the disclaimed subject matter *alone* may not be sufficient basis for the disclaimer.
- iii) The critical question is whether what remains in the claim has basis in the application as originally filed. This is particularly important not least because the EPO takes a strict stance on added matter, but also because added matter is a ground of opposition before the EPO and invalidity before the national courts.

If you are considering an amendment by disclaimer, we suggest that you contact your usual HGF advisor for further advice.

Contributor: Hsu Min Chung

For further advice, please contact your usual HGF representative or email marketing@hgf.com with your query.