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**Datasheet for the decision  
of the Enlarged Board of Appeal  
of 18 December 2017**

**Case Number:** G 0001/16  
**Appeal Number:** T 0437/14 – 3.3.09  
**Application Number:** 08003327.7  
**Publication Number:** 1933395  
**IPC:** H01L51/30, C09K11/06, H05B33/14  
**Language of the proceedings:** EN

**Title of invention:**  
Complexes of form L2IrX

**Patent Proprietor:**  
The Trustees of Princeton University  
The University of Southern California

**Opponents:**  
Merck Patent GmbH  
BASF SE

**Headword:**  
Disclaimer III

**Relevant legal provisions:**  
EPC Art. 52, 53, 53(c), 54, 54(2), 54(3), 54(4), 56, 57, 69(1),  
84, 87, 87(1), 100(a)-(c), 112(1), 112(1)(a), 123(1), 123(2)  
EPC R. 115(2)  
EPC 1973 Art. 52(4), 54(3), (4)  
RPEBA Art. 9, 10, 13, 14(2), 14(4)  
Vienna Convention on the Law of Treaties of 23 May 1969  
Art. 31(1), 32  
Bundesgesetz über die Erfindungspatente (Swiss Patent Law) of  
25 June 1954 (2017) Art. 24(1)c.

**Keyword:**

"Allowability of undisclosed disclaimers"  
"Applicability of the gold standard disclosure test as defined in decision G 2/10 to undisclosed disclaimers - no"  
"Applicability of criteria as defined in decisions G 1/03 and G 2/03 - yes"  
"Drafting of undisclosed disclaimers - no technical contribution to the claimed subject-matter of the application as filed may be provided"

**Decisions cited:**

G 0003/89, G 0011/91, G 0001/93, G 0002/98, G 0001/03,  
G 0002/03, G 0001/07, G 0002/10, G 0001/15,  
T 0004/80, T 0080/85, T 0313/86, T 0433/86, T 0155/87,  
T 0170/87, T 0296/87, T 0003/89, T 0012/90, T 0124/90,  
T 0172/90, T 0857/91, T 0434/92, T 0436/92, T 0597/92,  
T 0653/92, T 0710/92, T 0448/93, T 1050/93, T 0098/94,  
T 0426/94, T 0673/94, T 0917/94, T 0982/94, T 0645/95,  
T 0915/95, T 0596/96, T 0608/96, T 0863/96, T 0871/96,  
T 0893/96, T 0013/97, T 0323/97, T 0308/97, T 1071/97,  
T 1125/97, T 0318/98, T 0339/98, T 0351/98, T 0043/99,  
T 0201/99, T 0525/99, T 0451/99, T 0507/99, T 0525/99,  
T 1049/99, T 1050/99, T 1086/99, T 0285/00, T 0500/00,  
T 0664/00, T 0747/00, T 1102/00, T 0010/01, T 0014/01,  
T 0134/01, T 0584/01, T 1146/01, T 0067/02, T 0161/02,  
T 0506/02, T 0217/03, T 0285/03, T 0788/05, T 1559/05,  
T 0286/06, T 1107/06, T 0008/07, T 1068/07, T 1695/07,  
T 0761/08, T 0923/08, T 1049/08, T 1870/08, T 2018/08,  
T 0477/09, T 0678/09, T 0748/09, T 1045/09, T 1176/09,  
T 1487/09, T 1843/09, T 2102/09, T 0447/10, T 1836/10,  
T 2464/10, T 0074/11, T 2130/11, T 0336/12, T 0632/12,  
T 1297/12, T 0850/13, T 1441/13, T 1808/13, T 2502/13,  
T 0075/14, T 0287/14, T 1224/14, T 1872/14

**Decision of national courts cited:**

Germany:

*Bundesgerichtshof* X ZR 75/08, X ZR 54/09, X ZR 161/12, X ZR 5/16, Xa ZB 14/09,  
*Bundespatentgericht* 3 Ni 19/13, 7 Ni 41/14, 14 W (pat) 30/13, 20 W (pat) 314/03, 19 W (pat) 5/08, BlPMZ 1989, 53, BPatG, BPatGE 42, 57, BPatG, BPatGE 45, 80

United Kingdom:

*Court of Appeal of England and Wales: LG Philips LCD Co Ltd v Tatung (UK) Ltd & Ors* [2006] EWCA Civ 1774, *Napp Pharmaceutical Holdings Ltd v Ratiopharm GmbH* [2009] EWCA Civ 252, *Sudarshan Chemical Industries Ltd v Clariant Produkte (Deutschland) GmbH* [2013] EWCA Civ 919  
*Patents Court: Abbott Laboratories Ltd v Evysio Medical Devices ULC* [2008] EWHC 800 (Pat), *Ratiopharm GmbH v Napp*

*Pharmaceutical Holdings Ltd* [2008] EWHC 3070 (Pat), *Nicocigs Ltd v Fontem Holdings 1 BV* [2016] EWHC 2161 (Pat)

**France:**

*Tribunal de Grande Instance de Paris*: 09/56031, 09/12706, 10/05718, 14/15459,  
*Cour d'Appel de Paris*: 12/07203, 12/23743

**The Netherlands:**

*Rechtbank Den Haag*: IEPT20050715, ECLI:NL:RBSGR:2006:BA1058, IEPT20060808, BIE 2010 nr. 37, IER 2020 nr. 59, IEPT20120220, IEPT20130605  
*Rechtbank Utrecht*: IER 2013/9

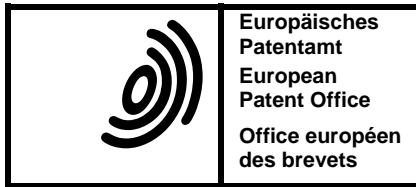
**Switzerland:**

*Bundespatentgericht*: O2012 030  
*Bundesgericht*: 4A 541 / 2013

**Headnote:**

For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Article 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03.

The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.



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Case Number: G 0001/16

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 18 December 2017**

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**Referring decision:** Interlocutory decision of Technical Board of Appeal 3.3.09 of the European Patent Office dated 17 October 2016.

**Composition of the Board:**

**Chairman:** C. Josefsson  
**Members:** I. Beckedorf  
R. van Peursem  
M.-B. Tardo-Dino  
C. Vallet  
G. Eliasson  
A. Lindner

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## SUMMARY OF FACTS AND SUBMISSIONS

*The referred questions*

I. By interlocutory decision T 437/14 dated 17 October 2016 (OJ EPO 2017, A50, hereinafter: the referring decision), Technical Board of Appeal 3.3.09 (hereinafter: the referring board) referred the following questions of law to the Enlarged Board of Appeal (hereinafter: the Enlarged Board) for decision:

*1. Is the standard referred to in G 2/10 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 G 1/03 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 G 1/03 apply in addition to the gold standard, may this standard be modified in view of these exceptions?*

*The patent in suit*

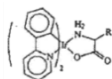
II. European patent No. 1 933 395 is based on European patent application No. 08003327, filed as a divisional application of European patent application No. 00980863, which claimed the priority of US 452346. It was opposed on the grounds under Article 100(a), 100(b) and 100(c) EPC. Claim 1 of the patent as granted reads:


*"Phosphorescent organometallic compound of formula  $L_2IrX$ , wherein L and X are inequivalent bidentate ligands, X is a monoanionic bidentate ligand, and the L ligands are monoanionic bidentate ligands each coordinated to Ir (iridium) through an  $sp^2$  hybridized carbon and a heteroatom."*

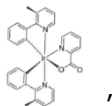
*The appeal proceedings*

III. During the appeal proceedings the patent proprietors filed *inter alia* a (new) main request for maintenance of the patent in amended form. Claim 1 of this request reads as follows:

*"Phosphorescent organometallic compound of formula  $L_2IrX$ , wherein L and X are inequivalent bidentate ligands, X is a monoanionic bidentate ligand, and the L ligands are monoanionic bidentate ligands each coordinated to Ir (iridium) through an  $sp^2$  hybridized carbon and a heteroatom, excluding the compounds having formula*



*wherein the ligand  is an  $\alpha$ -amino acid residue selected from glycine, L-alanine, L-valine, D-leucine, L-proline, or L-phenylalanine and excluding the following compound:*





The two disclaimers were introduced into claim 1 in order to restore novelty over the content of two prior art documents (D5 and D7). Compliance of the disclaimers with Article 123(2) EPC was disputed by the opponents in view of decisions G 1/03 and G 2/03 of the Enlarged Board of Appeal (OJ EPO 2004, 413 and 448; hereinafter, unless otherwise indicated, reference is made only to G 1/03, to which G 2/03 is identical).

IV. The Enlarged Board notes the following points from the referring decision:

- (1) According to the referring board, the disclaimers in claim 1 of the main request were "undisclosed", and their compliance with Article 123(2) EPC depended on the applicability of the principles - in combination, in part or in modified form - established in Enlarged Board decisions G 1/03 and G 2/10 (OJ EPO 2012, 376).
- (2) Only the referred questions and the answers given in G 1/03 concerned undisclosed disclaimers, whereas the referred question and the answers given in G 2/10 addressed disclosed disclaimers. However, there were numerous passages in G 2/10 suggesting that the gold standard disclosure test applied in the assessment of any amendment, including undisclosed disclaimers, for compliance with Article 123(2) EPC.
- (3) The referring board thus deduced that the gold standard was the only test to be applied in this assessment. If followed, this conclusion would leave no room for the exceptions defined in G 1/03, because then for undisclosed disclaimers too the relevant standard would be whether the skilled

person, using common general knowledge, would regard the subject-matter remaining in the claim after the introduction of the disclaimer as being explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed.

- (4) However, the referring board also noted that G 2/10 did not set aside or explicitly overrule G 1/03 in respect of the specific conditions under which an undisclosed disclaimer would be allowable.
- (5) In the referring board's view, this issue of whether the gold standard applies not only to disclosed disclaimers, as established by G 2/10, but also to undisclosed disclaimers, raises questions of law of fundamental importance. The referring board could discern no uniform approach in the case law after G 2/10 with regard to whether the gold standard was to be applied when assessing the allowability of undisclosed disclaimers under Article 123(2) EPC and, if it was, exactly how that standard had to be applied.
- (6) The referring board further noted that, if the gold standard was applicable, then in most cases an undisclosed disclaimer would not be allowable under Article 123(2) EPC.
- (7) With regard to the relevance of the referred questions for deciding the appeal case, the referring board took the view that the main issues had all been resolved to the patent proprietors' benefit, with only this one subordinate issue remaining open. Therefore, for the following reasons the outcome of the case depended upon the

answers which the Enlarged Board would give to the referred questions:

- (a) If the gold standard of G 2/10 was not to be applied at all, then the exceptions to the requirements of Article 123(2) EPC developed in G 1/03 would be applicable and would be assumed to have been met by claim 1 of the pending new main request, so that the amendment introduced into it by the two disclaimers would comply with Article 123(2) EPC.
- (b) If the gold standard of G 2/10 was to be applied in its strict sense, then the amendment introduced into claim 1 by the two undisclosed disclaimers would not be in compliance with Article 123(2) EPC.
- (c) If the gold standard of G 2/10 was to be applied in a modified form, as it had been in decisions T 2018/08, T 1870/08, T 2464/10, T 1176/09 and T 1872/14, the two disclaimers could be considered allowable, since they reduced only slightly the broad genus of compounds covered by claim 1.

*The course of the proceedings before the Enlarged Board*

V. The Enlarged Board invited all parties to the appeal proceedings and the President of the Office (hereinafter: the Office) to comment in writing on the points of law referred to it.

Comments were submitted by the appellants/patent proprietors (hereinafter: the patent proprietors) and

appellant/opponent 01 (hereinafter: opponent 01), and by the President of the Office in accordance with Article 9 RPEBA. Opponent 03 did not file any submissions, but withdrew its appeal. However, opponent 03 remains a party to the appeal proceedings and, consequently, a party to the proceedings before the Enlarged Board.

VI. By communication published in the Official Journal of the EPO (OJ EPO 2016, A96), the Enlarged Board gave third parties the opportunity to file written statements in accordance with Article 10 RPEBA and received eleven *amicus curiae* briefs:

- (1) K.H. Rhodes, IPO - Intellectual Property Owners Association;
- (2) G. Kiesel, CNCPI - Conseils en Propriété Industrielle;
- (3) B. Carion-Travarelle, ASPI - Association française des Spécialistes en Propriété Industrielle de l'Industrie;
- (4) R. Pistolesi, FICPI - Fédération Internationale des Conseils en Propriété Intellectuelle;
- (5) M. Grammel, Grünecker Patent- und Rechtsanwälte PartG mbH;
- (6) L. Davies, CIPA - The Chartered Institute of Patent Attorneys;
- (7) C.P. Mercer;
- (8) A. Tangena, epi - Institute of Professional Representatives before the EPO, and F. Leyder, epi;
- (9) R. Jorritsma;
- (10) D.X. Thomas;
- (11) The International Association for the Protection of Intellectual Property, AIPPI.

VII. Oral proceedings were held before the Enlarged Board on 16 October 2017 in the presence of the patent proprietors and opponent 01 as well as representatives of the Office. Opponent 03 did not attend the oral proceedings. The proceedings were continued without that party in accordance with Article 14(4) RPEBA and Rule 115(2) EPC.

VIII. In preparation for the oral proceedings, the Enlarged Board issued a communication pursuant to Articles 13 and 14(2) RPEBA on 16 August 2017. That communication was intended to draw the parties' attention to certain potentially significant legal issues with regard to the referred questions and to afford them an opportunity to comment on these. The Enlarged Board indicated in particular that there were several conceivable approaches to examining whether a claim amendment by an undisclosed disclaimer complies with the requirements of Article 123(2) EPC. Those different options were presented as scenarios 1 to 5, along with some sub-groups (communication, point 4.7).

The patent proprietors and opponent 01 replied to the Enlarged Board's communication with a second round of the written submissions. At the oral proceedings, oral submissions were made by them and by the Office.

IX. At the end of the oral proceeding, the Chairman announced that the Enlarged Board would issue its decision in writing in due course.

*Arguments generally in favour of applying the gold standard to undisclosed disclaimers - affirmative answer to question 1*

X. Submissions were made by opponent 01, by the Office and in some *amicus curiae* briefs in favour of applying the gold standard to undisclosed disclaimers of any kind in the same way as it is applied to a disclosed disclaimer.

The disclosure test based on the gold standard was the generally accepted standard for examining any claim amendment for compliance with Article 123(2) EPC. That standard constituted a uniform concept of disclosure with respect to Articles 54, 56 and 123(2) EPC.

G 1/03 did not define exceptions to that standard, and was not intended to do so. The intention was rather to limit (further) the range of undisclosed disclaimers by considering such an undisclosed disclaimer in terms of its admissibility. Once the admissibility of such an undisclosed disclaimer had been established, its allowability was then to be examined in accordance with the gold standard.

Since the Enlarged Board in G 2/10 did not see any justification for not applying the gold standard to undisclosed disclaimers, this standard was to be applied as a further, additional standard when assessing any amendment to a claim, including an undisclosed disclaimer, for compliance with Article 123(2) EPC.

In another submission a more differentiated approach was presented to the effect that the gold standard should not be applied without distinction to all

undisclosed disclaimers meeting the criteria laid down in G 1/03. It should not be applied to undisclosed disclaimers intended to restore novelty under Article 54(3) EPC or to restore novelty with respect to an accidental anticipation under Article 54(2) EPC. It should, on the other hand, be applied to undisclosed disclaimers intended to disclaim subject-matter excluded for non-technical reasons under Articles 52 to 57 EPC. This last type was similar to disclosed disclaimers as referred to in G 2/10.

Opponent 01 argued that G 1/03 did not deviate from the gold standard but added to it. Thus, the gold standard should be applied in addition to the criteria mentioned in answer 2.1 of G 1/03, and a restrictive approach should be taken, in particular with regard to the criterion of accidental anticipation. When applying the gold standard to an undisclosed disclaimer it was essential to examine whether the subject-matter remaining in the claim after the introduction of the disclaimer was disclosed in the application as filed, whether the original technical teaching had been changed by that disclaimer, and whether the introduction of negative, rather than positive, features had given an unwarranted advantage to the applicant or patent proprietor.

*Arguments generally in favour of not applying the gold standard to undisclosed disclaimers - negative answer to question 1*

XI. The majority of submissions favoured not applying the gold standard according to G 2/10 to undisclosed

disclaimers. This was the view taken by the patent proprietors and in some *amicus curiae* briefs.

The essential arguments can be summarised as follows:

The relevant (original) gold standard for assessing any amendment for compliance with Article 123(2) EPC was defined by the Enlarged Board in G 3/89 (OJ EPO 1993, 117) and G 11/91 (OJ EPO 1993, 125). The "guidance" provided in G 1/93 (OJ EPO 1994, 541), G 1/03 and G 2/10 was only to be used in appropriate circumstances to assist in determining whether the gold standard according to G 3/89 and G 11/91 had been applied correctly. According to the patent proprietors, that standard served as the general disclosure test and was not appropriate for assessing the allowability of a claim amendment by an undisclosed disclaimer. The types of disclaimer dealt with in G 1/03 and G 2/10, respectively, were completely different and mutually exclusive.

For legal reasons, the Enlarged Board in G 1/03 - in the light of the gold standard and also the object and purpose of Article 123(2) EPC - allowed a specific, narrow exception to the requirements of Article 123(2) EPC in the case of an undisclosed disclaimer that did not contribute to the technical teaching of the claimed subject-matter. An undisclosed disclaimer did not meet the disclosure requirements of Article 123(2) EPC because, by definition, it did not have a basis in the application as filed. Once the criteria of G 1/03 were fulfilled, an undisclosed disclaimer was legally deemed to comply with Article 123(2) EPC *per se*. Since such a disclaimer was introduced solely for legal, non-technical reasons and had no effect on the technical information in the application as filed, there was no



need to apply further criteria for the purpose of construing the subject-matter remaining in the claim after the amendment by that disclaimer.

However, other undisclosed disclaimers - that is, ones which did not meet the specific, exceptional criteria of G 1/03 (*e.g.* because they were introduced to address an issue of inventive step or sufficiency of disclosure) - needed to meet the general disclosure requirements of Article 123(2) EPC and therefore were not allowable due to non-compliance with Article 123(2) EPC.

In other words, while the general disclosure test was not a sound basis for assessing the allowability of an undisclosed disclaimer, G 1/03 provided a full set of criteria for that assessment, point 2.1 of the order giving the "primary" criteria and point 2.2 to 2.4 the "secondary" criteria. Once all the criteria were fulfilled, the requirements of Article 123(2) EPC were deemed to be met in respect of both the undisclosed disclaimer and the subject-matter remaining in the claim, and so there was no need to apply an additional test.

G 2/10 confirmed the application of the gold standard in the contexts of both disclosed disclaimers and those undisclosed disclaimers which were not allowable according to the criteria of G 1/03. However, G 2/10 stopped short of declaring that the gold standard also applied to those undisclosed disclaimers which fulfilled the criteria of G 1/03.

Since G 1/03 and G 2/10 were concerned with mutually exclusive situations for mutually exclusive types of

disclaimer, the first question was to be answered in the negative.

Apart from their arguments concerning the conceptual difference between undisclosed disclaimers and disclosed disclaimers, the patent proprietors, with reference to points 3 and 4.4 of the Reasons of G 2/10, even considered this decision to have confirmed that undisclosed disclaimers were to be examined for compliance with Article 123(2) EPC according to the criteria of G 1/03 only. From this it could be deduced that an undisclosed disclaimer meeting the criteria of G 1/03 could thereby also be deemed to be in full compliance with Article 123(2) EPC, without the need for any additional test.

*Arguments in favour of regarding G 1/03 as having been set aside by G 2/10 or in favour of G 1/03 now being set aside - affirmative answer to question 2*

XII. No submission was made that the Enlarged Board in G 2/10 set aside G 1/03 or the criteria laid down in it in respect of the allowability of an undisclosed disclaimer, or that G 1/03 should now be formally set aside.

*Arguments in favour of a continued application of the exceptions relating to undisclosed disclaimers defined in G 1/03 - negative answer to question 2*

XIII. The statements filed were unanimous in proposing that question 2 should be answered in the negative. However, the submissions made in respect of a continued application of the criteria of G 1/03 relating to

undisclosed disclaimers varied. In some it was argued that those criteria were to be applied to undisclosed disclaimers in addition to the gold standard (point XIII.1 below). Others advocated applying solely the criteria of G 1/03 (point XIII.2 below).

XIII.1 Opponent 01, the Office and some *amici curiae*, all of whom proposed answering question 1 in the affirmative, submitted that the Enlarged Board had not in the past - and should not now - set aside the exceptions relating to undisclosed disclaimers established in G 1/03, but should rather combine them with the gold standard of G 2/10. Thus, first the criteria laid down in G 1/03 were to be applied and then, for those undisclosed disclaimers meeting the requirements of that decision, the gold standard referred to in G 2/10 was to be applied.

However, it was also argued that this should only be done for those cases in which the undisclosed disclaimer disclaimed subject-matter for non-technical reasons under Articles 52 to 57 EPC. For undisclosed disclaimers that were introduced to restore novelty over an earlier application under Article 54(3) EPC or over an accidental anticipation under Article 54(2) EPC, only the criteria of G 1/03 were to be examined. No undisclosed disclaimer of the latter two kinds would be allowable otherwise.

Opponent 01 argued in favour of a restrictive application of the criteria set out in G 1/03 and, thus, in favour of a restrictive approach to allowing undisclosed disclaimers, in particular with regard to the requirement of clarity under Article 84 EPC.

XIII.2 Although there was no need to propose an answer to question 2, those parties in favour of not applying the gold standard of G 2/10 to undisclosed disclaimers (patent proprietors and several *amici curiae*) argued that, regardless of their view that question 1 should be answered in the negative, question 2 should be answered in the negative as well.

The Enlarged Board in G 1/03, in allowing undisclosed disclaimers, did not deviate from the gold standard as established in G 2/98 (OJ EPO 2001, 413); it just followed a different approach for exceptional circumstances. From this, it could be deduced that there was no need now to modify the gold standard referred to in G 2/10. That standard was simply not applicable, in either an unmodified or a modified form, to undisclosed disclaimers falling within the exceptions under G 1/03.

Some *amici curiae*, however, considered G 1/03 to be in line with the (original) gold standard which the Enlarged Board had defined in G 3/89 and G 11/91. G 1/03 provided useful guidance as to how that gold standard should be applied in particular circumstances. The Enlarged Board in G 2/10 did not set aside G 1/03; if the Enlarged Board had intended to do so, it should and would have stated this explicitly.

*Arguments in favour of applying the gold standard in a modified form - affirmative answer to question 3*

XIV. Regardless of whether question 1 was to be answered in the negative (point XI. above and point XIV.1 below) or

the affirmative (point IX. above and point XIV.2 below), according to some submissions the gold standard was to be applied with modifications.

XIV.1 Although suggesting that question 1 should be answered in the negative, the patent proprietors and several *amici curiae* proposed that, if question 3 was considered at all, it should be answered in the affirmative.

With regard to the subject-matter that remained in a claim after the introduction of a disclaimer, the patent proprietors argued that it was irrelevant whether the disclaimer was disclosed or undisclosed. However, the "legal status or quality" of the disclaimed subject-matter, whether taken from the application as filed itself (as in G 2/10) or from the prior art (as in G 1/03), became decisive for the application of the remaining subject-matter test of G 2/10 to a claim with an undisclosed disclaimer. This was illustrated by the example of an identical disclaimer introduced into two identical claims. The result would differ, depending on whether the disclaimer was disclosed or undisclosed. Where, before the introduction of a disclosed disclaimer, the subject-matter of the claim was originally disclosed within the meaning of Article 123(2) EPC, it remained disclosed after the introduction of the disclaimer. However, in the case of an undisclosed disclaimer introduced into the claim, the originally disclosed subject-matter as amended contravened Article 123(2) EPC because what remained of the subject-matter after amendment by the disclaimer had never been disclosed. Even so, since the legal character of the disclaimer

itself - disclosed or undisclosed - should not make a difference to the subject-matter remaining after the amendment, the remaining subject-matter test of G 2/10 needed to be modified. It should be modified in such a way that a claim which included an undisclosed disclaimer allowable according to the criteria of G 1/03 should, as a legal fiction, be treated in the same way as a claim containing a disclosed disclaimer.

One *amicus curiae* favoured modifying the gold standard so as to take into account whether or not any new technical information or new technical teaching could be derived from a claim as amended by an undisclosed disclaimer. This question had to be assessed on a case-by-case basis, considering all the technical circumstances, the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship to the subject-matter remaining in the claim after amendment. Thus, for instance, the exclusion of individual embodiments from a generic group, e.g. the disclaiming of individual compounds or a small group of individual compounds from a generic Markush grouping, did not lead to new technical information.

It was also argued that the gold standard defined in G 3/89 and G 11/91 should be considered fulfilled if the subject-matter remaining after the introduction of an undisclosed disclaimer or a disclosed disclaimer did not provide new technical information or a new technical teaching.

XIV.2 Opponent 01, although in favour of an affirmative answer to question 1, argued that the gold standard

should be modified, or rather applied case by case, in such a way as to avoid an "automatic" exclusion of undisclosed disclaimers for non-compliance with Article 123(2) EPC in a strict sense.

*Arguments in favour of applying the gold standard without modification - negative answer to question 3*

XV. Regardless of whether question 1 was to be answered in the affirmative (point X. above) or in the negative (point XI. above), in some submissions it was argued that the gold standard should be applied without modification.

XV.1 Developing their argument that the gold standard of G 2/10 should also be applied to undisclosed disclaimers, the Office and several *amici curiae* submitted that this should be done in the same way as for disclosed disclaimers. G 2/10 was to be understood as meaning that the Enlarged Board refused any modification of the gold standard. Any modification of the gold standard for undisclosed disclaimers could compromise the need for a uniform concept of disclosure under Article 123(2) EPC. This had also been confirmed by the Enlarged Board in G 1/15 (OJ EPO 2015, A82). A modification of the standard for one area would have (negative) consequences for the others. The gold standard set out in G 2/10 did not need to be amended. A disclaimer excluding certain subject-matter from a claim complied with that standard (and with Article 123(2) EPC), provided that it satisfied all the criteria of G 1/03. This held true irrespective of whether the excluded subject-matter and the remaining

subject-matter were disclosed in the application as filed.

However, it was argued that a distinction should be made between disclaimers which made a technical contribution and those which did not. For the latter, the analogy of an apple could be used, the disclaimer consisting in the removal of the apple's stalk. This disclaimer might be undisclosed, *i.e.* if the stalk as such was not disclosed in the application as filed and the apple without its stalk was not either. The apple minus its stalk was nevertheless the same apple.

XV.2 Some *amici curiae* pointed out that, since the gold standard of G 2/10 was not applicable to undisclosed disclaimers as such, that standard did not need any modification.

A similar argument, but one limited to the specific kinds of undisclosed disclaimers defined in G 1/03, was that the exceptions of G 1/03 were applicable only to those undisclosed disclaimers meeting the specific criteria set out in that decision, thus leaving the gold standard of G 2/10 applicable to all other disclaimers, disclosed or undisclosed.

*Further arguments*

XVI. The Office questioned the admissibility of the referral because it considered that the Enlarged Board had already answered all the referred questions in G 1/03 and G 2/10, namely question 1 in the affirmative and questions 2 and 3 in the negative.



XVII. Opponent 01 submitted that, if multiple disclaimers in one claim were to be allowed at all, they should not be allowed to restore novelty over more than one accidental anticipation because the subject-matter of the claim could rather be delimited by way of additional positive features.

*Answers proposed by the parties and the Office to the referred questions in the light of the Enlarged Board's communication*

XVIII. The parties to the appeal proceedings and the Office each identified as their preferred approach one of several scenarios described under point 4.7 of the Enlarged Board's communication of 16 August 2017, and suggested answers to the referred questions in line with that particular scenario:

XVIII.1 The patent proprietors chose a scenario (scenario 1) according to which the allowability of a claim amendment by an undisclosed disclaimer was to be assessed in accordance with the criteria of G 1/03 only. Once those requirements were met, the undisclosed disclaimer was considered allowable under Article 123(2) EPC, without prejudice to the other requirements of the EPC. There were no additional conditions going beyond the criteria of G 1/03, in particular no gold standard test.

Thus, the patent proprietors suggested that question 1 should be answered in the negative, with no need for the other questions to be answered.

XVIII.2 Opponent 01 preferred a scenario (scenario 4c)

according to which an undisclosed disclaimer was to be examined according to the gold standard defined in G 2/10, in addition to the criteria of G 1/03. However, in the application of the gold standard, the allowability of a claim amendment by an undisclosed disclaimer was to be assessed on a case-by-case basis, considering all the technical circumstances, the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship to the subject-matter remaining in the claim after the amendment.

As a consequence, opponent 01 proposed that the referred questions should be answered as follows: question 1 in the affirmative, question 2 in the negative, and question 3 in the affirmative or the negative, depending upon whether the gold standard defined in G 2/10 is to be applied in a manner which, in principle, allows a claim amendment to be made by an undisclosed disclaimer without further modification of that standard.

XVIII.3 The Office favoured a scenario (scenario 3a/b) in which the limiting criteria of G 1/03 were relevant for the admissibility of an undisclosed disclaimer. The gold standard test of G 2/10 was then to be applied in assessing the allowability of any such admissible undisclosed disclaimer.

Hence the Office advocated an affirmative answer to question 1 and negative answers to questions 2 and 3.

## REASONS

### *Admissibility of the referral*

1. According to Article 112(1)(a) EPC, a board of appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law or to clarify a point of law of fundamental importance.
  
2. The Office considers the present referral inadmissible because, in its view, the referred questions have already been answered by the Enlarged Board in earlier decisions G 1/03 and G 2/10 (see point XVI. above).
  
3. In G 1/03 the Enlarged Board dealt with the allowability of undisclosed disclaimers introduced into a claim. It is true that the particular type of undisclosed disclaimer there in issue was similar to the one with which the present referring decision is concerned.

G 1/03 did not explicitly address the matter of the relevance of the gold standard test to undisclosed disclaimers, as applied to disclosed disclaimers by the Enlarged Board in G 2/10 (for the definition of the gold standard test, see points 17 to 20 below). In deciding on the questions referred to it in G 1/03, the

Enlarged Board rather developed (other) specific criteria to be applied in determining the allowability of such undisclosed disclaimers.

Referral case G 2/10 concerned the allowability of disclosed disclaimers under Article 123(2) EPC, and here the Enlarged Board did discuss the issues involved against the background of the gold standard test.

4. The questions referred to the Enlarged Board in the present case address the issues of whether the standard developed in G 2/10 for disclosed disclaimers is to be applied to undisclosed disclaimers as well and, if so, what the effect of this could be on G 1/03. In essence the referring board seeks clarification as to the method and criteria which are to be applied in assessing the allowability of a claim amendment by an undisclosed disclaimer according to the requirements of Article 123(2) EPC.
  
5. In its reasoning, the referring board sets out in detail why an answer to the referred questions is indispensable for its decision on the appeals before it, since, in its view, those questions cannot be decided on the basis of the Enlarged Board's answers in cases G 1/03 and G 2/10.

The Enlarged Board is satisfied that an answer to at least the first of the referred questions is necessary for the referring board to dispose of the appeals before it using the correct legal test for determining whether the introduction of an undisclosed disclaimer

into a claim is in compliance with Article 123(2) EPC. The referred questions are moreover not only relevant to the appeal case in hand. The answers will also affect similar cases before the boards of appeal and before the examining and opposition divisions and will therefore serve to bring about a uniform application of the law. In this respect, the Enlarged Board takes note of the Office's decision that all proceedings before the examining and opposition divisions in which the decision depends entirely on the outcome of the referral are stayed *ex officio* until the Enlarged Board issues its decision (OJ EPO 2016, A105).

Therefore, the referred questions raise a point of law of fundamental importance within the meaning of Article 112(1) EPC.

6. There is, furthermore, a divergence of views within the jurisprudence of the boards of appeal with respect to the correct standard to apply to undisclosed disclaimers, namely whether this should be the criteria laid down in G 1/03 and/or the gold standard of G 2/10.

Hence, answering the referred questions will ensure a uniform application of the law within the meaning of Article 112(1) EPC.

7. Consequently, the referral fulfils the requirements of Article 112(1)(a) EPC and is admissible.

*Preliminary considerations on substantive aspects of the referred questions*

8. All three questions now referred are concerned with the applicability to undisclosed disclaimers of the general standard which is used to determine whether a claim amendment meets the requirements of Article 123(2) EPC. This is the standard which the Enlarged Board held in G 2/10 to apply to disclosed disclaimers and which it referred to there as the "gold standard". More particularly, the Enlarged Board is asked to clarify whether the gold standard applies to undisclosed disclaimers at all and, if so, whether it applies alone or in combination with the specific criteria developed in G 1/03, and, finally, if in combination with these, whether it needs to be applied in a modified form.

The referral therefore goes beyond the issues decided upon in G 1/03 and G 2/10. Accordingly, the present proceedings under Article 112(1)(a) EPC are neither aimed at, nor would they allow, a "rectification" or even a review of either of those earlier decisions.

Put in more general terms, the referred questions seek clarification as to the proper standard or standards to be applied when examining a claim amendment by the introduction of an undisclosed disclaimer for its allowability according to the requirements of Article 123(2) EPC.

9. Based on the understanding of the referred questions outlined in point 8., the Enlarged Board will first analyse the Enlarged Board's two earlier decisions G 1/03 and G 2/10, which are mentioned in the referred questions (see points 10 and 11), set out definitions

of the terms "disclaimer" (see points 12 to 16) and "gold standard" (see points 17 to 20), and provide an overview of the jurisprudence of the technical boards of appeal (see points 21 to 24) and of some national courts of EPC contracting states (see points 25 to 30).

Within this context, the Enlarged Board will go on to consider the referred questions of law on their merits by interpreting Article 123(2) EPC (see points 31 to 36), identifying different types of undisclosed disclaimers (see points 37 and 38), and establishing and evaluating the aspects and standards which are relevant in assessing the allowability under Article 123(2) EPC of a claim amendment by an undisclosed disclaimer (see points 39 to 48). The referred questions will then be answered on the basis of this discussion (see point 49), followed by some final remarks (see points 50 to 52).

*Decisions G 1/03 and G 2/10*

10. G 1/03

In case G 1/03 the Enlarged Board dealt with questions of law referred to it by decision T 507/99 (OJ EPO 2003, 225) in respect of the allowability under Article 123(2) EPC of an amendment to a claim by the introduction of a disclaimer, where neither the disclaimer nor the subject-matter excluded by it from the scope of the claim had a basis in the application as filed.

Parallel case G 2/03 concerned a referral by decision T 451/99 (OJ EPO 2003, 334).

10.1 In G 1/03 the Enlarged Board was concerned with the following questions:

1. *Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?*
2. *If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?*
  - (a) *In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?*
  - (b) *Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?*
  - (c) *Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?*
  - (d) *Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental, or*
  - (e) *is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the presence of an inventive step has then to be carried out as if the disclaimer did not exist?*



In case G 2/03, the following (additional) questions were referred to the Enlarged Board:

1. *Is the introduction into a claim of a disclaimer not supported by the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC?*
2. *If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?*

In addition to these questions on disclaimers in cases of conflicting applications and accidental anticipation, the Enlarged Board, following a comment made by the Office, raised a third issue: the disclaiming of subject-matter excluded from patentability for non-technical reasons under Articles 52 to 57 EPC.

10.2 The answers given by the Enlarged Board were the following:

1. *An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.*
2. *The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:*
  - 2.1 *A disclaimer may be allowable in order to:*
    - *restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;*

- *restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; 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; and*
- *disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for nontechnical reasons.*

2.2 *A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.*

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

2.4 *A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.*

10.3 The Enlarged Board reasoned as follows:

- (1) In respect of the allowability of a disclaimer not disclosed in the application as filed, the argument that a disclaimer *per se* is not a technical feature of the claim was not accepted. Rather, any amendment to a claim is presumed to have a technical meaning, otherwise it would be useless to have it in the claim (*supra*, Reasons, point 2).
- (2) The allowability of an undisclosed disclaimer was affirmed in different circumstances (cases of conflicting applications pursuant to Article 54(3) EPC - *supra*, Reasons, points 2.1., 2.1.1 and 2.1.3; cases of accidental anticipation pursuant to

Article 54(2) EPC - *supra*, Reasons, points 2.2 and 2.2.2; and cases of exceptions to patentability pursuant to Articles 52(4), 53 and 57 EPC - *supra*, Reasons, point 2.4). In respect of cases of non-accidental anticipation (Article 54(2) EPC) and non-working embodiments, the allowability of a disclaimer (*supra*, Reasons, point 2.3.3, and points 2.5.2 and 2.5.3) was rejected.

- (3) Only disclaimers directed to limitations not contributing to the invention - in which regard the decisive criterion is to be taken from Article 123(2) EPC rather than from Article 56 EPC - comply with the EPC (*supra*, Reasons, point 2.6.1).
- (4) A disclaimer may only serve the purpose for which it is intended and nothing more. If it has effects going beyond its purpose, it is or becomes inadmissible (*supra*, Reasons, point 2.6.5).

11. G 2/10

11.1 In case G 2/10 the Enlarged Board was concerned with the following question referred to it by decision T 1068/07 (OJ EPO 2011, 256):

*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?*

11.2 The answers given by the Enlarged Board were the following:

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.*

11.3 The Enlarged Board reasoned as follows:

- (1) The expression "disclaimer which is not disclosed in the application as filed" in answer 2 given by the Enlarged Board in G 1/03 was not meant to apply to all cases in which the disclaimer as such was not disclosed in the application as filed. That answer did not relate to the disclaiming of subject-matter disclosed as part of the invention in the application as filed (*supra*, Reasons, point 3 *et seq.*, in particular point 3.9).
- (2) The criteria set up in answer 2 of G 1/03 were not intended to give a complete definition of when a disclaimer violates Article 123(2) EPC and when it does not (*supra*, Reasons, point 4.4.2). It was not decided in G 1/03 that, once the requirements of answer 2 are fulfilled, an undisclosed disclaimer will always be allowable under Article 123(2) EPC (*supra*, Reasons, point 4.7).

- (3) The principle that any amendment to an application or a patent, and in particular to a claim, must fulfil the requirements of Article 123(2) EPC also applies to an amendment limiting the claim by disclaiming disclosed subject-matter (*supra*, Reasons, point 4.5.1).
- (4) In the assessment of an amended claim, after the introduction of the disclaimer, for its compatibility with Article 123(2) EPC, the decisive question is how the subject-matter remaining in the amended claim would be regarded by the skilled person, using common general knowledge, as explicitly or at least implicitly, but directly and unambiguously, disclosed in the application as filed (*supra*, Reasons, point 4.5.2). This requires an assessment of the overall technical circumstances of the 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 (*supra*, Reasons, point 4.5.4).

*Disclaimer - definition*

12. Patent claims define the subject-matter for which protection is sought in terms of the technical features of the claimed invention (Articles 69(1), first sentence, and 84 EPC). These technical features define the elements and characteristics of the claimed subject-matter and, usually, are phrased as "positive"

technical features. However, the claimed subject-matter may also be defined in terms of "negative" claim features which describe elements and characteristics that the claimed subject-matter does not have.

13. Generally speaking, a disclaimer in a patent claim consists of words, terms, formulae, compounds or other elements which identify subject-matter specifically not claimed.

The term "disclaimer", as used in G 1/03 (*supra*, Reasons, point 2), means an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a generally defined subject-matter specific embodiments or areas. However, the Enlarged Board limited the definition in that decision to the extent that a disclaimer which contributes to the technical teaching and adds subject-matter within the meaning of Article 123(2) EPC is not a disclaimer within the meaning of decision G 1/03 (*supra*, Reasons, point 2.6.1).

This definition of the term "disclaimer" was also used in G 2/10 (*supra*, Reasons, point 2.2).

The Enlarged Board concurs furthermore with decision T 1870/08 (Reasons, point 4.6.7, not published in the OJ EPO) that a disclaimer is only a proper disclaimer if the remaining legal subject-matter is less than that of the unamended claim. If any subject-matter can be identified which falls within the scope of the claim after amendment by the proposed disclaimer, but which did not do so before the amendment, the disclaimer is improper and, as a consequence of this, unallowable under Article 123(2) EPC.

This understanding of what constitutes a proper disclaimer is also reflected in the present decision.

14. The term "undisclosed disclaimer" relates to the situation in which neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed.
15. The term "disclosed disclaimer" relates to the situation in which the disclaimer itself might not have been disclosed in the application as filed, but the subject-matter excluded by it has a basis in the application as filed, e.g. in an embodiment.
16. Thus, undisclosed disclaimers and disclosed disclaimers can be distinguished according to whether the subject-matter on which the respective disclaimer is based is explicitly or implicitly, directly and unambiguously, disclosed to the skilled person using common general knowledge, in the application as filed.

*The gold standard - definition*

17. As a general definition of the requirements of Article 123(2) EPC for assessing any amendment for compliance with that Article, the gold standard was established by the Enlarged Board in opinion G 3/89 and decision G 11/91. This test has become the standard approach which is applied in the assessment of aspects of added subject-matter (Article 123(2) EPC), of

novelty (Article 54 EPC), and of the validity of a claimed priority (Article 87 EPC) (see G 2/98, *supra*, Reasons, point 9; G 1/03, *supra*, Reasons, point 2.2.2; G 2/10, *supra*, Reasons, point 4.6; G 1/15, *supra*, Reasons, point 6.2).

18. In G 3/89 (*supra*, Reasons, point 3) and G 11/91 (*supra*, Reasons, point 3), the Enlarged Board, in the context of a request for a correction of the parts of a European patent application or of a European patent relating to the disclosure, defined the limits of such a correction in terms of its compliance with Article 123(2) EPC as being

*"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."*

According to the gold standard established in these terms, 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 prohibition on extension laid down in Article 123(2) EPC, and can therefore, irrespective of the context of the amendment, only be made within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the filing date, from the whole of the documents of the application as filed.

19. The aforementioned definition also applies to the kind of cases underlying the present referral.



20. As stated in G 2/10 (*supra*, Reasons, points 4.3 and 4.5.1),

*"[t]he importance and the applicability, without exception, of Article 123(2) EPC was underlined in the jurisprudence of the Enlarged Board of Appeal as early as in its opinion G 3/89 and decision G 11/91 (OJ EPO 1993, 117 and 125, relating to amendments by way of correction). 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, points 1., 1.3 and 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. Hence, disclaiming subject-matter disclosed in the application as filed can also infringe Article 123(2) EPC if it results in the skilled person being presented with technical information which he would not derive directly and unambiguously, using common general knowledge, from the application as filed."*

*The existing jurisprudence of the technical boards of appeal on disclaimers*

21. For a proper understanding of the background to the current referral as well as the background to decisions

G 1/03 and G 2/10, it is essential to look at the decisions of the technical boards which led to G 1/03 (see point 22), the relevant decisions issued following G 1/03 but prior to G 2/10 (see point 23), and those coming after G 2/10 but preceding the referring decision (see point 24).

22. The case law leading to G1/03

22.1 The case law on disclaimers originated in the three technical board decisions T 4/80 (OJ EPO 1982, 149), T 433/86 (not published in the OJ EPO) and T 170/87 (OJ EPO 1989, 441).

T 4/80 was the first decision to allow a disclaimer. The case concerned a negatively worded disclaimer, the subject-matter of which was disclosed in the application as filed but had to be excluded so as to delimit the subject-matter claimed from a disclosure in an earlier national patent application not already published at the date of filing. The board stated that such subject-matter could subsequently be excluded from the protection sought by a wide claim by means of a disclaimer, if the subject-matter remaining in the claim could not be defined more clearly and concisely directly, *i.e.* by positive technical features (Article 84 EPC).

Decision T 433/86 referred to decision T 4/80. It was this decision which for the first time stated that when there was an overlap between the prior art and the claimed subject-matter defined in generic terms, a specific piece of prior art could be excluded even in the absence of support for the excluded matter in the original documents. It concerned a case in which the

excluded subject-matter was defined by values which were not disclosed as such in the application as filed but were disclosed in prior art document 1 (state of the art as defined in Article 54(2) EPC) against which the claim had to be delimited in order to restore novelty: the claim was restricted from "600 to 10 000" (as claimed originally and in the patent as granted) to "above 1500 to 10 000" (as in the claim before the board). This restriction was necessary in order to distinguish the claimed subject-matter from document 1, in which a molecular weight range of between 240 and 1500 had been disclosed. The amendment was allowed.

In decision T 170/87, the board referred to the "established Board of Appeal case law", citing the above-mentioned decisions T 4/80 and T 433/86, and held that in cases in which what was claimed in general overlapped with the state of the art it was permissible to exclude a special state of the art from the claimed invention by means of a disclaimer, even if the original documents gave no (specific) basis for such an exclusion. This practice was justified for the following reasons (Reasons, point 8.4.3):

*"The inventive teaching originally specifically disclosed in the application is not changed as a whole merely by delimiting it with respect to the state of the art or with respect to what has proved not to be functional; rather through the disclaimer (or through a "positive" wording leading to the same result), only the part of the teaching which the applicant cannot claim owing to lack of novelty or reproducibility is "excised" in the sense of a partial disclaimer. A considerable practical need for this exists. All that is necessary is to define appropriately what under the given circumstances is left of the inventive teaching originally disclosed that is still capable of being protected."*

22.2 In the ensuing years, the line of jurisprudence beginning with these three decisions became established case law (T 4/80 was cited over 40 times, T 433/86 over 30 times, and T 170/87 over 50 times) - until it was called into question by decision T 323/97 (not published in the OJ EPO - see point 22.3 below).

The principles developed in this line of cases may be categorised as follows:

- (1) Disclosed disclaimers were considered allowable if the subject-matter remaining in the claim after the introduction of the disclaimer could not be technically defined directly (*i.e.* positively) more clearly and concisely (*e.g.* T 80/85, T 1050/93, T 98/94, T 673/94, none published in the OJ EPO).
- (2) Undisclosed disclaimers were often assessed in the same way as disclosed disclaimers, under either Article 123(2) EPC (*e.g.* T 155/87, T 3/89, T 172/90, T 434/92, T 448/93, T 982/94, none published in the OJ EPO) or Articles 54, 56 or 84 EPC (*e.g.* T 710/92, T 871/96, none published in the OJ EPO).
- (3) Clarity and conciseness were used as limitations on the allowability of disclaimers (*e.g.* T 597/92, OJ EPO 1996, 135).
- (4) Disclaimers were allowed in order to exclude accidentally novelty-destroying prior art (*e.g.* T 433/86, T 857/91, T 653/92, T 426/94, T 917/94, T 645/95, T 596/96, T 608/96, T 863/96, T 13/97, T 339/98, T 43/99, none published in the OJ EPO). However, a merely hypothetical or potential prior

art disclosure was held not to justify a disclaimer (e.g. T 597/92, OJ EPO 1996, 135, T 596/96, not published in the OJ EPO).

- (5) In several cases, the admissibility of a disclaimer was affirmed where the disclaimer had been necessary in order to restore novelty vis-à-vis a European patent application not yet published on the application's date of filing (Article 54(3), (4) EPC 1973; e.g. T 1125/97, T 318/98, T 351/98, T 525/99, OJ EPO 2003, 452, T 664/00, none except T 525/99 published in the OJ EPO)
- (6) The introduction of a disclaimer should not have a bearing on the other patentability requirements, in particular on the assessment of inventive step (e.g. T 857/91, T 597/92 (OJ EPO 1996, 135), T 710/92, T 917/94, T 645/95, T 13/97, T 308/97, none except T 597/92 published in the OJ EPO).
- (7) A disclaimer to exclude "non-functioning" subject-matter might exceptionally be allowable (T 313/86 and T 436/92, neither published in the OJ EPO).
- (8) A disclaimer should exclude no more than necessary (e.g. T 296/87, OJ EPO 1990,195, T 12/90, and T 124/90, the latter two not published in the OJ EPO).
- (9) A disclaimer did not necessarily have to be a literal wording of the excluded prior art (e.g. T 434/92, T 426/94, neither published in the OJ EPO) but should be precisely defined and limited to the prior art disclosure (e.g. T 915/95, T 863/96, T 893/96, T 1071/97, none published in the OJ EPO).

22.3 However, decision T 323/97 (OJ EPO 2002, 476) raised fundamental doubts as to the established practice and jurisprudence on disclaimers which had originated in T 4/80, T 433/86, and T 170/87. In the case underlying this decision the disclaimer had been introduced into claim 1 of the main request in order to exclude certain embodiments from its scope. The board's view was that an amendment to a patent by the introduction of a "negative" technical feature into a claim which resulted in the exclusion of certain embodiments (*i.e.* by the incorporation into the claim of a "so-called disclaimer") was, regardless of the name "disclaimer", none the less an amendment governed by Article 123(2) and (3) EPC. This meant - as far as the requirements of Article 123(2) EPC were concerned - that the amended claim had to find support in the application as filed, a requirement which was mandatory for the allowability of the amended patent or patent application as explained in G 3/89 (T 323/97, *supra*, Reasons, point 2.2).

This decision was taken into account in the referring decisions leading to G 1/03 and G 2/03 (T 507/99 and T 451/99, respectively).

23. The case law after G 1/03 and before G 2/10

The criteria laid down in G 1/03 for undisclosed disclaimers were applied in numerous decisions in the period up to the handing down of G 2/10 (with over 270 decisions of technical boards of appeal citing G 1/03). The main issues discussed were:

- (1) the scope of accidental anticipation (cases finding an accidental anticipation: T 14/01, T 1049/99, T 217/03; cases denying an accidental anticipation: T 1086/99, T 1050/99, T 285/00, T 500/00, T 1102/00, T 134/01, T 584/01, T 1146/01, none published in the OJ EPO);
- (2) that a disclaimer should have no bearing on other patentability requirements, in particular on the assessment of inventive step (*e.g.* T 506/02, T 788/05, T 761/08, none published in the OJ EPO);
- (3) that a merely hypothetical or potential prior art disclosure could not justify a disclaimer (*e.g.* T 285/03, not published in the OJ EPO);
- (4) that a disclaimer should not exclude more than necessary (*e.g.* T 747/00, T 10/01, T 8/07, T 477/09, none published in the OJ EPO);
- (5) that a disclaimer should not be positively worded (*e.g.* T 201/99, not published in the OJ EPO);
- (6) that the introduction of a disclaimer into a claim should not render the claim unclear (*e.g.* T 67/02, T 161/02, T 286/06, T 923/08, none published in the OJ EPO);
- (7) that a disclaimer might be introduced to avoid exclusion from patentability for non-technical reasons (*e.g.* G 1/07, OJ EPO 2011, 134, Order, point 2b);
- (8) that the criteria of G 1/03 were not applicable to disclosed disclaimers (*e.g.* T 1050/99, T 1102/00, T 1559/05: all discussed the issue of the disclosure of the excluded subject-matter in the application as filed but finally found the

disclaimers to be undisclosed; see, however, *e.g.* T 1107/06: here the board extended the criteria of G 1/03 to a disclosed disclaimer. None of these decisions was published in the OJ EPO).

24. The case law after G 2/10

Developments in the case law since G 2/10 which relate to the applicability of the criteria of G 1/03 to disclosed disclaimers on the one hand and to the applicability of the requirements of G 2/10 to undisclosed disclaimers on the other can be summarised as follows:

(1) The criteria of G 1/03 have been considered not to apply to disclosed disclaimers (*e.g.* T 1049/08, T 850/13, neither published in the OJ EPO).

(2) However, there has been no uniformity of approach regarding whether G 2/10 is applicable to undisclosed disclaimers.

(a) Decisions T 1870/08, T 2464/10, T 1176/09, T 748/09, T 336/12, T 2018/08, T 2102/09, T 1224/14 and T 1872/14 (none published in the OJ EPO) applied the gold standard test of G 2/10 to undisclosed disclaimers in addition to the criteria set out in G 1/03.

(b) Of the decisions mentioned under point (a) above, decisions T 1870/08, T 2018/08, T 1176/09, T 748/09, T 2464/10, T 1224/14 and T 1872/14 appear to have applied the gold standard test of G 2/10 in a modified form.



- (c) Decisions T 1441/13 and T 1808/13 (neither published in the OJ EPO) examined the undisclosed disclaimers in issue primarily on the basis of the gold standard test of G 2/10.
- (d) Decisions T 678/09, T 1843/09 (OJ EPO 2013, 508), T 1487/09, T 1695/07, T 1045/09, T 447/10, T 1836/10, T 74/11, T 2130/11, T 632/12, T 1297/12, T 75/14 and T 287/14 (with the exception of T 1843/09, none published in the OJ EPO) continued to apply the requirements of G 1/03 to undisclosed disclaimers as they were applied following that decision (see point 23. above). In decision T 2502/13 (not published in the OJ EPO), the board rejected the applicant's request to apply G 1/03 to a positive feature in order to restore novelty over a document under Article 54(3) EPC.

*National jurisprudence on disclaimers*

25. The issue of disclaimers has been dealt with by a number of courts of the EPC Contracting States. The main approaches followed in the respective case law in Germany, the United Kingdom, France, The Netherlands and Switzerland are summarised below.
26. In Germany the term "disclaimer" is used to refer to the solution found by the German courts to overcome the problem of what is known as the "inescapable trap" of Article 123(2) and (3) EPC. Such a "disclaimer" is a text added to the patent indicating that the feature

included in the claim (which may also be a negative feature) violates the prohibition on added matter but that no rights can be derived from it (e.g. BPatG, BlPMZ 1989, 53 "*Flanschverbindung*"; BPatG, BPatGE 42, 57 "*Fernsehgeräatbetriebsparameteranzeige*"; BPatG, BPatGE 45, 80 "*Automatische Umschaltung*", BPatG, 19 W (pat) 5/08, GRUR 2011, 40, headnote "*Winkelmesseinrichtung*"). This "disclaimer" is not to be equated with the concept of disclaimer forming the subject of the present referral, namely the introduction of a negative feature into the claim - although these two issues may be connected in certain cases.

The *Bundesgerichtshof* has referred to the issue of disclaimers within the meaning of G 1/03 and G 2/10 only in passing, that is, without any detailed discussion (e.g. BGH, decision of 17 April 2012, X ZR 54/09; BGH, decision of 21 October 2010, Xa ZB 14/09 "*Winkelmesseinrichtung*"). In its decision "*Wundbehandlungsvorrichtung*" of 17 February 2015 (X ZR 161/12, GRUR 2015, 573), the *Bundesgerichtshof* held that, in principle, a feature which was not originally disclosed but merely restricted the claimed subject-matter might remain in the claim, but could not be used to support the patentability of the subject-matter claimed. In a more recent decision of 25 July 2017 (X ZB 5/16 - "*Phosphatidylcholin*", not published at the date of the present decision), the *Bundesgerichtshof*, referring to decisions G 1/03 and G 2/10 without further qualification, held that the introduction of a feature according to which the claimed preparation may not contain a certain substance does not of itself automatically constitute an unacceptable extension (thereby diverging from *Bundesgerichtshof* judgment of

12 July 2011 X ZR 75/08, GRUR 2011, 1109

"Reifenabdichtmittel"). However, it is not evident from the reasons of the decision whether the disclaimer examined in that case was an undisclosed or a disclosed disclaimer.

The *Bundespatentgericht*, although it has cited G 1/03 in the context of undisclosed disclaimers (e.g. decision of 7 May 2015 (7 Ni 41/14 (EP); decision of 20 May 2015 (3 Ni 19/13 (EP) and decision of 10 April 2006 (20 W (pat) 314/03)), does not seem to have adopted the principles of that decision, or at least not expressly so. In its decision "Kosmetische Zubereitung" of 11 September 2011 (14 W (pat) 30/13), the Court held:

*"Grundsätzlich können Anmelder die in den ursprünglichen Anmeldeunterlagen formulierten Ansprüche im Laufe des Erteilungsverfahrens noch anpassen bzw. ändern. Dies gilt grundsätzlich auch für die Aufnahme eines Disclaimers, mit dem ein bestimmter Teil des ursprünglich beanspruchten Gegenstands vom Schutz ausgenommen werden soll, indem ein (negatives) technisches Merkmal in den Anspruch aufgenommen wird. Derartige Änderungen müssen sich allerdings stets im Rahmen der ursprünglichen Offenbarung halten. Eine unzulässige Erweiterung ist dann gegeben, wenn das Patentbegehren auf einen noch nicht in den ursprünglich eingereichten Anmeldeunterlagen enthaltenen Gegenstand erstreckt wird (...)."*

*(translation provided by the Enlarged Board: "In principle, applicants can still adjust or amend the claims formulated in the original application documents in the course of the granting procedure. This also applies in principle to the inclusion of a disclaimer by which a certain part of the originally claimed subject-matter is to be excluded from protection by incorporating a (negative) technical feature into the claim. Such changes, however, must always be kept within the scope of the original disclosure. There is*

*an unallowable extension of subject-matter if the patent claim is expanded to encompass subject-matter which was not included in the application documents as originally filed (...)."*

In its decision of 16 February 2017 (11 W (pat) 8/13), the *Bundespatentgericht* appeared to apply (some of) the criteria of G 1/03 without referring to that decision (*i.e.* "exclusion from patentability" and "accidental anticipation").

27. In the United Kingdom, the test in G 1/03 has been endorsed in several judgments of the Court of Appeal of England and Wales and of the Patents Court (*e.g.* *LG Philips LCD Co Ltd v Tatung (UK) Ltd & Ors* [2006] EWCA Civ 1774, *Abbott Laboratories Ltd v Evysio Medical Devices ULC* [2008] EWHC 800 (Pat), *Ratiopharm GmbH v Napp Pharmaceutical Holdings Ltd* [2008] EWHC 3070 (Pat), *Napp Pharmaceutical Holdings Ltd v Ratiopharm GmbH* [2009] EWCA Civ 252, *Sudarshan Chemical Industries Ltd v Clariant Produkte (Deutschland) GmbH* [2013] EWCA Civ 919, *Nicocigs Ltd v Fontem Holdings 1 BV* [2016] EWHC 2161 (Pat)). In the leading case of *Napp Pharmaceutical Holdings Ltd v Ratiopharm GmbH* Lord Justice Jacob stated in respect of G 1/03:

*"The key to the reasoning is at the end of 2.6.1 '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 from Article 56 EPC complies with the Convention.' This amounts to saying that the key question in every case is the Article 123(2) question. There is no additional criterion, only a question as to how that is to be applied in the case of disclaimers."*

28. The French Tribunal de Grande Instance de Paris (TGI) and the Cour d'Appel de Paris (CA) have been concerned with the issue of disclaimers in European patents in a number of cases but have not discussed it in any detail with reference to the case law of the boards of appeal and the Enlarged Board of Appeal (e.g. TGI 09/56031, decision of 12 January 2010, *Aventis v Teva*; TGI, 09/12706, decision of 20 March 2012, *Teva v Eli Lilly*, on appeal: CA, 12/07203, decision of 12 March 2014; TGI, 10/05718, decision of 21 December 2012, *Alkermes v Ethypharm*, on appeal: CA, 12/23743, decision of 3 November 2015; TGI, 14/15459, decision of 18 May 2017, *Lohman v Novogen*). However, the TGI in the case of *Alkermes v Ethypharm* appeared to rely on G 1/03 in respect of subject-matter which was excluded from patentability under Article 53(c) EPC.

29. In The Netherlands the issue of disclaimers has been addressed in several decisions as well.

In both *pre-* and *post-*G 2/10 jurisprudence a distinction has been made between undisclosed disclaimers, which have to meet the criteria of G 1/03 in order to be allowable, and other disclaimers, which are judged by the yardstick of Article 123(2) EPC - the latter often called the "disclosure test" (*i.e.* the gold standard).

In the case of *Teva v Abbott* (preliminary injunction decision of 15 July 2005, IEPT20050715), the *Rechtbank Den Haag* referred to G 1/93 and G 1/03 and held that the feature "solvent free" was not allowable under the disclaimer case law since the relevant state of the art did not meet the conditions set out in G 1/03.

Reference was made to the "directly and unambiguously derivable" test of the EPO Examination Guidelines (*i.e.* the gold standard) and said disclaimer was held not to meet the requirements of Article 123(2) EPC.

In *Rechtbank Den Haag*, decision of 17 May 2006 (ECLI:NL:RBSGR:2006:BA1058, *Teva v MSD (alendronate)*), it was held that the undisclosed disclaimer in issue could not be regarded as an accidental anticipation as defined in G 1/03 and hence constituted added matter. The patent in suit in that case was not a European, but a Dutch national patent.

In preliminary injunction proceedings *Rechtbank Den Haag*, decision of 8 August 2006 (IEPT20060808 *Visser v Heto*), again a disclaimer was construed as undisclosed and it was held not to meet the "disclosure test" (*i.e.* the gold standard). The disclaimer therefore failed to meet the requirements of Article 123(2) EPC.

The same *pre-G 2/10* approach can be seen in *Rechtbank Den Haag*, decision of 7 April 2010, *Mundipharma v Sandoz*, BIE 2010 nr. 37, IER 2020 nr. 59. The Court made a detailed analysis along the lines of G 1/03 and T 1107/06 and concluded that the disclaimer in issue was not an undisclosed disclaimer since the subject-matter was disclosed positively in the original application. Hence the G 1/03 rules did not apply. The Court subsequently analysed whether this disclaimer was in accordance with Article 123(2) EPC. It was held to be so, since the sole reason for taking up this disclaimer was a purely legal one, *i.e.* avoiding double patenting. The Court found that the technical teaching of the patent was not changed by the disclaimer.

*Post* G 2/10, in its decision of 15 August 2012 (IER 2013/9 *Boehringer v Teva*) in preliminary injunction proceedings, the *Rechtbank Utrecht* held that the case related to disclosed disclaimers (G 2/10) rather than undisclosed disclaimers, so the party's reliance on G 1/03 was considered irrelevant.

In the preliminary injunction case, *Rechtbank Den Haag*, decision of 20 February 2012 (IEPT20120220 *SCA v MTS*), a case on priority, reference was made to G 2/98 and G 1/03 to stress the fact that the "disclosure" test (*i.e.* the gold standard) had to be interpreted in the same way under Article 87(1) and Article 123(2) EPC. In order to further explain why the deletion of a feature specification in the application that had, however, been contained in the priority document (so that the application constituted a generalisation) made the priority void, it was stated: Suppose the priority document were the application as filed; that would mean that the deletion of the specification would be considered added matter in violation of Article 123(2) EPC.

In its decision of 5 June 2013 in the case of *Enros v Smart Seal* (darts-211-365-B-nl, IEPT20130605), the *Rechtbank Den Haag* considered that, regardless of whether the disclaimer fulfilled the requirements of G 1/03 or G 2/10 (which was left open), the conditions of Article 84 EPC needed to be met (which was considered not to be the case).

30. In Switzerland the Swiss *Bundespatentgericht* has distinguished G 1/03, which it has held to apply to

undisclosed disclaimers, from G 2/10, which it has considered to apply to disclosed disclaimers.

In decision O2012 030 of 17 September 2013, the *Bundespatentgericht (CH)* (upheld by the Swiss *Bundesgericht*, 4A 541 / 2013, of 2 June 2014) distinguished between a non-manifest disclaimer (the exclusion of elements which were not disclosed in the application documents) and a disclosed disclaimer contained in the application documents. According to G 1/03, the allowability of the former was only possible in exceptional cases, in particular only if the disclaimer could not be relevant to inventive step, *i.e.* in cases concerning state of the art under Article 54(3) EPC or accidental anticipations. The admissibility of the latter type of disclaimer had been discussed in G 2/10.

In applying the principles of G 2/10, however, the Court took into account an additional criterion not provided for in the EPC but stipulated in Article 24 para. 1 lit. c Swiss Patent Law, which was also relevant to the limitation of the Swiss part of a European patent. According to this provision, for an amendment to be allowed, it should be supported not only in the documents originally filed, but also in the published patent. If subject-matter was deleted from a patent in the context of examination proceedings, opposition proceedings or subsequent partial revocation or limitation proceedings, such subject-matter could no longer be used as a disclosure to support a subsequent amendment.



*Interpretation of Article 123(2) EPC*

31. Article 123(2) EPC reads:

*"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."*

32. The interpretation of the EPC follows the principles of interpretation enshrined in the Vienna Convention on the Law of Treaties of 23 May 1969, in particular as laid down in Articles 31(1) and 32 of that Convention.

33. The Enlarged Board considers that, apart from the statutory wording itself, the object and purpose of Article 123(2) EPC merit particular attention in the present context.

34. The provision of Article 123(2) EPC has remained virtually unchanged since 1973. The revision of the EPC of 2000 introduced a purely editorial change to the wording of Article 123(2) EPC to bring it into line with Article 123(1) EPC.

35. The wording of Article 123(2) EPC is in itself clear and concise. It is focused on the subject-matter of the European patent application or patent. Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (*i.e.* the claims in particular, but also the description and any

drawings) is subject to the prohibition on extension of subject-matter laid down in Article 123(2) EPC.

Therefore, irrespective of its context, the amendment can only be made within the limits of what is objectively derivable from the whole of the application documents as filed, which means what a skilled person would derive from them directly and unambiguously, using common general knowledge relative to the date of filing. Thus the wording itself precludes a new technical contribution being added by the amendment.

This reading of Article 123(2) EPC was established by the Enlarged Board of Appeal in G 3/89 and G 11/91, and confirmed by it in G 2/10. It was not contradicted by G 1/03.

36. The idea underlying Article 123(2) EPC is that an applicant or patent proprietor should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, as this would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (see G 1/93, OJ EPO 1994, 541, Reasons, point 9).

*Different types of undisclosed disclaimers*

37. On the basis of the definitions of disclaimers in general and disclosed disclaimers and undisclosed disclaimers in particular which are set out in points

12 to 16 above, undisclosed disclaimers may be further categorised according to their purpose:

- (1) The claim is amended by an undisclosed disclaimer to restore novelty by delimiting the claim against state of the art under Article 54(3) EPC.

The Enlarged Board will refer to this as type A.

- (2) The claim is amended by an undisclosed disclaimer to restore novelty by delimiting the claim against an accidental anticipation under Article 54(2) EPC.

The Enlarged Board will refer to this as type B.

- (3) The claim is amended by an undisclosed disclaimer to disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.

The Enlarged Board will refer to this as type C.

- (4) The claim is amended by an undisclosed disclaimer which does not belong to any of types A to C and therefore does not come within the criteria laid down in answer 2.1 of G 1/03, in particular because

- the disclaimer is intended to overcome other objections to patentability than those mentioned in that answer, and/or
- the disclaimer removes more than is necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons within the meaning of answer 2.2 of G 1/03, and/or
- the disclaimer is or becomes relevant for the assessment of inventive step or sufficiency of

disclosure within the meaning of answer 2.3 of G 1/03.

The Enlarged Board will refer to such claims as type D. However, as an amendment falling into this category clearly goes beyond the criteria laid down in G 1/03, its introduction cannot be justified by that decision.

38. The referring board is concerned with two undisclosed disclaimers of type B. Although for the appeal proceedings before the referring board only the proper standard for examining this type needs to be determined, the Enlarged Board considers it appropriate, in the present decision, to deal with, and in particular to clarify the standard(s) for examining, all types of undisclosed disclaimers.

*Standards for examining undisclosed disclaimers*

39. In the light of the various decisions of the Enlarged Board (summarised in points 10. and 11. above), of the technical boards of appeal (summarised in points 21. to 24. above) and of national courts (summarised in points 25. to 30. above), and also taking into account the various submissions and statements by the parties to the appeal proceedings, by the Office and in the many *amicus curiae* briefs, the Enlarged Board has identified various possible approaches to examining whether a claim amendment by an undisclosed disclaimer complies with the requirements of Article 123(2) EPC. Those approaches, translated into a number of scenarios, were

mentioned in the communication of the Enlarged Board (point 4.7 of the communication of 16 August 2017) and discussed with the parties to the appeal proceedings and with the Office at the oral proceedings on 16 October 2017. All of them confirmed that they considered those scenarios to cover completely the essential aspects of the referred questions and the whole range of potential answers to them.

40. The conceptual differences which exist between disclosed and undisclosed disclaimers mean that the respective characteristics of disclosed and undisclosed disclaimers and of the different types of undisclosed disclaimer set out in the previous section must be taken into account in the examination of whether an amendment to a claim by the introduction of a disclaimer is allowable under Article 123(2) EPC.

41. The Enlarged Board in its present composition reaffirms the finding of decision G 2/10 that the gold standard disclosure test is the appropriate basis for assessing the allowability of a disclosed disclaimer under Article 123(2) EPC.

Thus, as held in G 2/10, for a claim amendment by the introduction of a disclosed disclaimer to be allowable under Article 123(2) EPC, the gold standard is the only test to be met. According to this standard, it has to be assessed whether the subject-matter remaining in the claim after the introduction of the disclaimer complies with the requirements of Article 123(2) EPC in the sense that it has been explicitly or implicitly, and

directly and unambiguously, disclosed in the application as filed.

42. On the other hand, as discussed by the referring board (referring decision, Reasons, point 8.1), the application of the gold standard disclosure test of G 2/10 when assessing whether a claim amended by the introduction of an undisclosed disclaimer complies with the requirements of Article 123(2) EPC leaves virtually no chance of an undisclosed disclaimer being allowable. Introducing any disclaimer *per definitionem* excludes subject-matter from a claim and, hence, changes the technical content of the claim. Where neither the disclaimer itself nor the subject-matter excluded by it is disclosed in the applications as filed, *i.e.* where an undisclosed disclaimer is introduced into the claim, it (almost) automatically follows that the subject-matter remaining in the claim after the introduction of such an undisclosed disclaimer literally can hardly be considered to have been explicitly or implicitly, and directly and unambiguously, disclosed in the application as filed.
43. It follows from the above that the choice of the proper test for assessing the allowability of any disclaimer is determined by the fundamental distinction, in terms of their legal nature, between disclosed disclaimers and undisclosed disclaimers. That distinction necessitates providing for each of the two classes of disclaimer a single specific test for assessing whether the introduction of a given disclaimer is in compliance with Article 123(2) EPC.

For undisclosed disclaimers the proper test is whether the criteria of G 1/03 are fulfilled, and for disclosed disclaimers the proper test is the gold standard disclosure test of G 2/10.

44. Thus, the assessment of the allowability of a claim amendment by an undisclosed disclaimer is governed exclusively by the criteria laid down in G 1/03. In other words, once an amendment by an undisclosed disclaimer has met the requirements of G 1/03, the introduction of such an undisclosed disclaimer for legal reasons may be considered allowable under Article 123(2) EPC, without prejudice to the other requirements of the EPC. No modifications are to be made to, nor any conditions added which go beyond, the criteria of G 1/03.

However, should those criteria not be met, the claim amendment by the introduction of an undisclosed disclaimer cannot be allowed as it does not comply with the requirements of Article 123(2) EPC. This leaves undisclosed disclaimers of type D (see point 37. above) outside the scope of potential allowability pursuant to G 1/03.

45. When examining the allowability of a claim amendment by the introduction of an undisclosed disclaimer for compliance with the requirements of Article 123(2) EPC, the following test based on decision G 1/03 is to be applied:

Such an amendment may be considered allowable under Article 123(2) EPC if the undisclosed disclaimer is introduced in order to

- (1) restore novelty by delimiting a claim against state of the art under Article 54(3) EPC within the meaning of G 1/03 (Order, point 2.1, first indent, Reasons, point 2.1 and sub-points);
- (2) restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC within the meaning of G 1/03 (Order, point 2.1, second indent, Reason point 2.2 and sub-points), an anticipation being 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; or
- (3) disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons within the meaning of G 1/03 (Order, point 2.1, third indent; Reasons, point 2.4 and sub-points).

46. These criteria notwithstanding, the undisclosed disclaimer must not be related to the teaching of the invention, as already held in G 1/03 (Order, point 2.3; Reasons, point 2.6 and sub-points).

In endorsing this concept, the Enlarged Board wishes to provide the following further clarification:

46.1 In G 1/03 it was held *inter alia* that a disclaimer only excluding subject-matter for legal reasons was not in



contradiction to Article 123(2) EPC because it had "no bearing on the technical information in the application" and because the remaining subject-matter was not modified by it (Reasons, point 2.1.3), whereas a disclaimer contributing to the technical teaching added subject-matter within the meaning of Article 123(2) EPC (Reasons, point 2.6.1). In point 2 of the Reasons of G 1/03, it is mentioned that

*"[a]ny amendment to a claim is presumed to have a technical meaning, otherwise it would be useless to have it in the claim."*

46.2 However, these passages bear a potential for being understood too broadly and in too undifferentiated a manner, because introducing any disclaimer into a claim necessarily changes the technical information quantitatively and often also qualitatively.

This can be illustrated by the following example:

A claim before amendment is directed to

*"a chemical compound characterised by formula X".*

That claim is then amended by the addition of the stipulation that

*"X is not A".*

The original technical information or technical teaching is

*"compounds of formula X achieve effect Y",*

which is then reduced by means of the disclaimer to

*"compounds of formula X - A achieve effect Y".*

The question of which compounds do achieve effect Y is an important aspect of the technical information. As a

consequence, the claim amended by a disclaimer contains different subject-matter based on different technical information.

46.3 Irrespective of the fact that the prior art triggering the introduction of the undisclosed disclaimer (be it as an accidental anticipation or in relation to documents according to Article 54(3) EPC) has no bearing upon the original technical teaching of the patent or the patent application as filed, and in that sense does not change it, in the above example the technical teaching based on the subject-matter of the amended claims has been changed by simply reducing the number of compounds now claimed to yield the desired effect Y. This difference is far from being trivial, as the information as to which compounds achieve effect Y constitutes an essential element of the technical teaching.

46.4 The question to be asked in this context is not whether an undisclosed disclaimer quantitatively reduces the original technical teaching - this is inevitably the case as was explained above - but rather whether it qualitatively changes it in the sense that the applicant's or patent proprietor's position with regard to other requirements for patentability is improved.

If that is the case, then the original technical teaching has been changed by the introduction of the disclaimer in an unallowable way. And as a consequence, the technical teaching based on the amended claim, *i.e.* on the remaining subject-matter without the disclaimer, can no longer be considered as belonging to the invention as presented in the application as originally filed.

It is noted for the sake of completeness that the prohibition of a qualitative change in the original teaching applies in an absolute way, *i.e.* not only with regard to the prior art which provides the basis for the undisclosed disclaimer, but also to the entire prior art relevant for the assessment of inventive step. In practical terms, this means that the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer, as proposed in T 710/92 (*supra*, Reasons, point 5). In this way, any unallowable modification of the original technical teaching in the assessment of inventive step is avoided.

47. With regard to the different types of undisclosed disclaimers (see point 37. above), the Enlarged Board concludes that a claim amendment by the introduction of an undisclosed disclaimer of one of types A to C only, which meets the relevant criterion of G 1/03 as clarified in points 45. and 46. above, is allowable under Article 123(2) EPC.

Hence, the introduction of an undisclosed disclaimer must fulfil one of the criteria laid down in point 2.1 of the order of decision G 1/03, but may not provide a technical contribution to the claimed subject-matter of the application as filed; in other words, the identity of the invention as originally filed must remain unchanged by the subject-matter remaining in the claim after the introduction of the undisclosed disclaimer.

However, any other undisclosed disclaimer not meeting any of these criteria, referred to as an undisclosed disclaimer of type D (see point 37. above), is not

allowable according to the standard of G 1/03, nor is it open to assessment under the gold standard disclosure test of G 2/10.

48. For the avoidance of doubt, any of the aforementioned considerations concern only the choice of the proper test or standard for the assessment of whether the introduction of an undisclosed disclaimer into a claim is in compliance with Article 123(2) EPC.

The application of the standard for the assessment of undisclosed disclaimers, as defined in points 45. and 46. above, does not in any way obviate the need for the subject-matter of the claim as amended to meet the other requirements of the EPC, in particular those of novelty and inventive step, sufficiency of disclosure, clarity and of the requirements of Article 123(2) EPC in respect of claim features other than the undisclosed disclaimer.

To this end, the Enlarged Board in its present composition endorses in particular the further requirements for undisclosed disclaimers as set out in points 2.2 to 2.4 of the Order and points 2.6 to 3 of the Reasons of G 1/03.

*Answers to the referred questions*

49. Based on its understanding of the referred questions as a request for clarification as to the proper standard or standards to be applied when examining whether a claim amendment by the introduction of an undisclosed

disclaimer complies with the requirements of Article 123(2) EPC (see point 8 above), the Enlarged Board answers the questions as follows:

- 49.1 In respect of question 1, the Enlarged Board, while confirming decision G 1/03, holds that the gold standard disclosure test referred to in decision G 2/10 is not the relevant test for examining whether a claim amendment by an undisclosed disclaimer complies with the requirements of Article 123(2) EPC.

However, rather than simply answering that question in the negative, the Enlarged Board considers it appropriate also to provide the following clarification of how the criteria laid down in G 1/03 are to be applied when assessing the allowability of an amendment to a claim by the introduction of an undisclosed disclaimer:

*For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Article 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03.*

*The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.*

49.2 In the light of the answer given to question 1, the other two questions do not need to be answered.

*Final remarks*

50. The standard for assessing the allowability of an undisclosed disclaimer as described in point 45. and further clarified in point 46. above, is neither intended nor to be interpreted as a departure from decision G 1/03. The Enlarged Board in its present composition understands the aforementioned standard to be already encompassed by the requirements of G 1/03.

51. The gold standard as defined in G 2/10 remains the relevant disclosure test for assessing the allowability of a claim amendment by the introduction of a disclosed disclaimer (see point 41. above).

52. It is the Enlarged Board's conviction that these answers to the referred questions of law will not only enable the referring board to take a final decision in the appeal case before it, but that they will also serve as guidance for a uniform approach to assessing the allowability of a claim amendment by the introduction of an undisclosed disclaimer in other cases before the boards of appeal or before the examining and opposition divisions of the EPO.

**ORDER**

**For these reasons, it is decided that:**

The questions referred to the Enlarged Board of Appeal are answered as follows:

For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Article 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03.

The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. 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 Registrar:

The Chairman:

W. Crasborn

C. Josefsson