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D E C I S I O N
of 14 March 2003

Case Number: T 0451/99 - 3.3.4

Application Number: 86902998.3

Publication Number: 0220273

IPC: C12Q 1/70

Language of the proceedings: EN

Title of invention:

Synthetic antigens for the detection of AIDS-related disease

Patentee:

GENETIC SYSTEMS CORPORATION

Opponents:

Roche Diagnostics GmbH
Dade Behring Marburg GmbH

Headword:

Synthetic antigens/GENETIC SYSTEMS

Relevant legal provisions:

EPC Art. 54(3), 84, 112(1), 123(2).

Keyword:

"Allowability of disclaimers - under Article 123(2) EPC -
delimitation against Article 54(3) EPC prior art - criteria to
be applied - referral to Enlarged Board of Appeal"

Decisions cited:

G 0001/93, G 0003/89, G 0002/98, T 0004/80, T 0433/86,
T 0124/87, T 0170/87, T 0288/92, T 0434/92, T 0597/92,
T 0653/92, T 0710/92, T 0426/94, T 0917/94, T 0982/94,
T 0596/96, T 0608/96, T 0863/96, T 0013/97, T 0323/97,
T 0934/97, T 1125/97, T 0318/98, T 0339/98, T 0351/98,

T 0043/99, T 0525/99, T 0664/00.

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Headnote:

The following questions are referred to the Enlarged Board of Appeal:

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?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?



Case Number: T 0451/99 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal
of 14 March 2003

Appellant I: GENETIC SYSTEMS CORPORATION
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted
9 February 1999 concerning maintenance of
European patent No. 0 220 273 in amended form.

Composition of the Board:

Chairwoman: U. M. Kinkeldey
Members: F. L. Davison-Brunel
V. Di Cerbo

Summary of Facts and Submissions

- I. European patent No. 0 220 273 entitled "Synthetic antigens for the detection of AIDS-related disease" was granted with 43 claims based on the international application No. WO 86/06414.

Claim 1 as granted read as follows:

"1. A method of detecting the presence of LAV/HTLV-III virus or antibody to LAV/HTLV-III virus where a sample is combined with a composition having epitopic sites immunologically competitive with LAV/HTLV-III epitopic sites, whereby antibodies bind to such protein composition to form a specific binding pair complex and the amount of complex formation is determined, characterized by:

employing in the assay medium as a reagent a composition containing at least one peptide which has at least six amino acids and fewer than 50 amino acids, at least six of those amino acids are contiguous and encoded for by part of the coding region of LAV/HTLV-III from bp 450 to bp 731 from the gag region or bp 900 to bp 1421 (from the gag region) or bp 7210 to bp 7815 (from the env region)."

- II. Oppositions were filed under Article 100(a) to (c) EPC (lack of novelty, lack of inventive step, lack of sufficient disclosure, added subject-matter). The opposition division decided to maintain the patent in amended form pursuant to Article 102(3) EPC on the basis of the third auxiliary request then on file.

III. The patent proprietor (appellant I) lodged an appeal against this decision, requesting that it be set aside and the patent maintained on the basis of a new main request, or a new first auxiliary request, both filed with the statement of grounds. A new set of claims, to be considered as a second auxiliary request, was filed with a letter dated 24 May 2002. As a third auxiliary request (referred to in the statement of grounds as the second auxiliary request) the patent proprietor requested that the patent be maintained in the form specified in the decision under appeal.

An appeal was also lodged by opponent 02 (appellant II), who requested that the decision under appeal be set aside and the patent revoked.

In a letter dated 29 December 1999, opponent 01, a party to the proceedings as of right pursuant to Article 107 EPC, filed his comments on appellant I's statement of grounds of appeal, requesting that this appeal be dismissed.

IV. Appellant I's new main request was the main request refused by the Opposition Division but its claim 1 was the same as claim 1 of the request accepted by the opposition division and read as follows:

"1. A method of detecting the presence of LAV/HTLV-III virus or antibody to LAV/HTLV-III virus where a sample is combined with a composition having epitopic sites immunologically competitive with LAV/HTLV-III epitopic sites, whereby antibodies bind to such protein composition to form a specific binding pair complex and the amount of complex formation is determined, characterized by:

employing in the assay medium as a reagent a composition containing at least one peptide which has at least six amino acids and fewer than 50 amino acids, at least six of those amino acids are contiguous and encoded for by part of the coding region of LAV/HTLV-III from bp 450 to bp 731 (from the gag region) or bp 900 to bp 1421 (from the gag region) or bp 7210 to bp 7815 (from the env region), **except for the following peptides:**

- a) peptides from the gag region defined starting from aminoacid 1 - Met coded by the ATG in position 336-338 in the LAV DNA sequence:

aminoacids 37-46 inclusive, ie Ala-Ser-Arg-Glu-Leu-Glu-Arg-Phe-Ala-Val;

aminoacids 49-79 inclusive, ie Gly-Leu-Leu-Glu-Thr-Ser-Glu-Gly-Cys-Arg-Gln-Ile-Leu-Gly-Gln-Leu-Gln-Pro-Ser-Leu-Gln-Thr-Gly-Ser-Glu-Glu-Leu-Arg-Ser-Leu-Tyr;

aminoacids 200-220 inclusive, ie Met-Leu-Lys-Glu-Thr-Ile-Asn-Glu-Glu-Ala-Ala-Glu-Trp-Asp-Arg-Val-His-Pro-Val-His-Ala;

aminoacids 226-234 inclusive, ie Gly-Gln-Met-Arg-Glu-Pro-Arg-Gly-Ser;

aminoacids 239-264 inclusive, ie Thr-Thr-Ser-Thr-Leu-Gln-Glu-Gln-Ile-Gly-Trp-Met-Thr-Asn-Asn-Pro-Pro-Ile-Pro-Val-Gly-Glu-Ile-Tyr-Lys-Arg;

aminoacids 288-331 inclusive, ie Gly-Pro-Lys-Glu-Pro-Phe-Arg-Asp-Tyr-Val-Asp-Arg-Phe-Tyr-Lys-Thr-Leu-Arg-Ala-Glu-Gln-Ala-Ser-Gln-Glu-Val-Lys-Asn-Trp-Met-Thr-Glu-Thr-Leu-Leu-Val-Gln-Asn-Ala-Asn-Pro-Asp-Cys-Lys;

aminoacids 352-361 inclusive, ie Gly-Val-Gly-Gly-Pro-Gly-His-Lys-Ala-Arg;

- b) peptides from the env region defined starting from aminoacid 1 = Lysine coded by the AAA at position 5746-5748 in the LAV DNA sequence:

aminoacids 466-500 inclusive, ie Leu-Thr-Arg-Asp-Gly-Gly-Asn-Asn-Asn-Asn-Gly-Ser-Glu-Ile-Phe-Arg-Pro-Gly-Gly-Gly-Asp-Met-Arg-Asp-Asn-Trp-Arg-Ser-Glu-Leu-Tyr-Lys-Tyr-Lys-Val;

aminoacids 510-523 inclusive, ie Pro-Thr-Lys-Ala-Lys-Arg-Arg-Val-Val-Gln-Arg-Glu-Lys-Arg;

aminoacids 551-577 inclusive, ie Val-Gln-Ala-Arg-Gln-Leu-Leu-Ser-Gly-Ile-Val-Gln-Gln-Gln--Asn-Asn-Leu-Leu-Arg-Ala-Ile-Glu-Ala-Gln-Gln-His-Leu;

aminoacids 594-603 inclusive, ie Ala-Val-Glu-Arg-Tyr-Leu-Lys-Asp-Gln-Gln;

aminoacids 621-630 inclusive, ie Pro-Trp-Asn-Ala-Ser-Trp-Ser-Asn-Lys-Ser;

aminoacids 657-679 inclusive, ie Leu-Ile-Glu-Glu-Ser-Gln-Asn-Gln-Gln-Glu-Lys-Asn-Glu-Gln-Glu-Leu-Leu-Glu-Leu-Asp-Lys-Trp-Ala."

As submitted in appellant I's grounds of appeal, the only difference between claim 1 as granted and this claim 1 was that all the peptides specified in document (1): WO 86/02383 - which has an earlier first priority date (18 October 1984) than the patent in suit (24 April 1985) but was published on 24 April 1986, ie after its filing date (21 April 1986), and thus was prior art in accordance with Article 54(3) EPC - had been excised from the latter claim, ie "disclaimed" in order to overcome an objection of lack of novelty.

- V. Oral proceedings took place on 28 May 2002. In the course of the discussion relating to whether or not the

"disclaimer" in claim 1 contained added subject-matter in contravention of Article 123(2) EPC, the parties' attention was drawn to decision T 323/97 of 17 September 2001 (now published in OJ EPO 2002, 476) concerning the admissibility of "disclaimers" under Article 123(2) EPC. All the parties then requested that question(s) be referred to the Enlarged Board of Appeal on this matter. They were given two months to file proposals.

All the parties submitted questions of law for the Enlarged Board of Appeal within the time limit.

VI. Appellant I requested that the following questions be referred to the Enlarged Board of Appeal:

"Can an amendment of a claim having no support in the application as filed, i.e. by way of a disclaimer, be admissible under Article 123(2) EPC when the purpose of the amendment is to exclude matter which is disclosed in a prior art reference, especially when the prior art reference is as defined in Article 54(3) EPC?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimers?"

VII. Appellant II requested that the following questions be referred:

"(1a) Does the requirement according to Article 123(2) EPC that a European patent application or a 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 mean that any disclaimer must be supported by

the application as filed?

- (1b) Or can a disclaimer be introduced, not having a basis in the application as filed, that is intended to establish novelty over an "accidental" anticipatory prior art document without causing a violation of Article 123(2) EPC?
- (2) If question (1b) is answered in the affirmative, what are the criteria to be applied in assessing whether or not the disclaimer in fact is limited to the establishment of novelty, i.e. the added negative feature does not involve any technical contribution to the claimed invention?
- (3) If question (1b) is answered in the affirmative, what are the criteria to be applied in assessing whether or not the anticipatory disclosure is really accidental?
- (4) If question (1b) is answered in the affirmative, is a disclaimer admissible that is intended to exclude subject-matter that is to be regarded as prior art under Article 54(3) EPC?
- (5) If question (1b) is answered in the affirmative, is a disclaimer admissible in a situation when novelty can still be established over an anticipatory prior art document by introduction of a positive feature?
- (6) If question (1b) is answered in the affirmative, which other criteria may be necessary to be fulfilled in order for such disclaimer to be

admissible?"

VIII. Opponent 1 proposed the following questions:

"Art. 123(2) EPC requires that a European patent application or a 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.

1. Does this requirement allow the admission of disclaimers having no basis in the application as filed in order to delimit the subject-matter of a European patent or a European patent application over an allegedly novelty-destroying prior art document, particularly a prior art document under Art. 54(3) EPC, as stated e.g. in the decisions T 0898/91, T 0526/92, T 0645/95, T 0608/96, T 0863/96 and T 0597/92 (OJ EPO 1996, 135)? Or, in the contrary, are disclaimers not admissible under Art. 123(2) EPC as stated in the decision T 0323/97?
2. If question 1 is answered such that disclaimers are admissible, what are the criteria to be applied in assessing the admissibility of a disclaimer?

Particularly, must an acceptable disclaimer meet the following criteria?

- a) The disclaimer must be precisely defined and limited to the prior art disclosure, i.e. if it is not allowed to disclaim some sort of generalized teaching based upon interpretation of the teaching of the prior

art disclosure.

- b) The allegedly novelty-destroying prior art document must be an accidental anticipation, this meaning that a disclaimer is only allowable, if the prior art document, containing the excluded disclosure, has no relevance for any further examination aspect of the claimed invention, and that, upon introduction of the disclaimer, this prior art document must disappear from the prior art field to be taken into consideration.
 - c) The disclaimer must be the only possibility for a delimitation over the allegedly novelty-destroying prior art document.
3. Do the criteria under 2a, 2b, and 2c also apply for a disclaimer art. 54(3) EPC?"

Reasons for the decision

1. Claim 1 of the main request for consideration by the board contains what is called a "disclaimer" which excludes from the claimed subject-matter 13 peptides specifically mentioned in the claim. These peptides are disclosed in document (1), which is prior art under Article 54(3) EPC (see section IV above). Claim 1 would not be novel if the "disclaimed" peptides were to remain. This is in line with the boards' established case law on this particular aspect of novelty, where the subject-matter of a claim overlaps with a prior-art disclosure (see, for example, decision T 124/87 (OJ EPO 1989, 491)). Thus, it is decisive for this case whether

the disclaimer is admissible or not under Article 123(2) EPC.

2. The peptides to be used as reagents in the claimed method (see point IV above) are defined by the number of amino acids they contain and which part of the genome of LAV/HTLV-III they are at least partly encoded from. Thus, they may contain between 6 and 49 amino acids, 6 of which must originate from any of three regions respectively comprising 93 amino acids (encoding DNA from base pair (bp) 450 to bp 731), 170 amino acids (encoding DNA from bp 900 to bp 1421) and 201 amino acids (encoding DNA from bp 7210 to bp 7815). The 6 amino acids must also be contiguous in the said regions. Thus, it is readily apparent that the claimed method may be carried out with a plethora of peptides. The "disclaimer" used to exclude from the claim the 13 peptides already disclosed in document (1) is the only expedient way to word the claim so that it does not have to contain a list of all the peptides, but not the 13 just mentioned, which would no doubt cover many pages but still not be complete.

3. In the board's judgment, the disclaimer in claim 1 therefore fulfils the clarity requirement (Article 84 EPC) which the early case law of the boards of appeal (eg decision T 4/80, OJ EPO 1982, 149) had already stated to be essential to the admissibility of disclaimers.

4. Claim 1 as now worded refers to two specific groups of peptides: those which possess the generically defined features, but of which 13 are excepted, and those 13 which, while also possessing these features, are nonetheless excluded from protection by means of a

disclaimer. Neither of these two groups is explicitly identified in the application as filed. The claim could thus be considered not allowable under Article 123(2) EPC in line with the established case law of the boards of appeal on how to apply Article 123(2) EPC when an amendment to a claim is a "selection", from a general disclosure, of specific embodiments not expressly disclosed in the application as filed (see, for example, decision T 288/92 of 18 November 1993). Nonetheless, it would be allowable under long-standing EPO practice based upon the established board-of-appeal case law on the admissibility of disclaimers, which will be summarised below.

5. Several decisions of the boards of appeal have considered the introduction of a disclaimer into a claim to be admissible under Article 123(2) EPC, even in the absence of any explicit support in the application as filed. The most relevant of these are mentioned below. Reference has also been made to decisions concerning disclaimers intended to avoid a novelty objection under Article 54(2) EPC, in so far as the principles stated therein may also be relevant to assessing the admissibility of disclaimers intended (as in the case in suit) to avoid a novelty objection under Article 54(3) EPC.

6. According to decisions T 433/86 of 11 December 1987 and T 170/87 (OJ EPO 1989, 441), it is permissible, in cases where what is claimed in general overlaps with the state of the art, to exclude a special state of the art from the claimed invention by means of a disclaimer, even if the original documents give no (specific) basis for such an exclusion. In particular, the second decision said that the inventive teaching

disclosed in the originally filed application was not changed as a whole merely by being delimited with respect to the state of the art; the effect of the disclaimer was to "excise" only that part of the teaching which the applicant could not claim owing to lack of novelty. It further pointed out that a considerable practical need existed for such an expedient. The only requirement was to define what was left of the inventive teaching originally disclosed that was still capable of being protected. In other words, it is assumed that the mere delimitation of a claim in order to overcome a novelty problem does not per se change the inventive teaching of the application and is therefore compatible with the ratio legis of Article 123(2) EPC.

7. It can be inferred from the decisions quoted above that, to be admissible, a disclaimer not supported by the original disclosure must fulfil only the following conditions:
 - (a) There must be an **overlap between the prior art and the claimed subject-matter** defined in generic terms.
 - (b) The **prior art** to be excised by means of a disclaimer must be "special" or, as more clearly stated in decision T 433/86 (see above), **specific**.
 - (c) The **disclaimer is necessary to establish novelty**.
8. In decision T 597/92 (OJ EPO 1996, 135) the board of appeal essentially confirmed the above principles, but added a further requirement: **a disclaimer may only be used by way of exception for avoiding claim**

anticipation, if the subject-matter of a claim cannot be restricted on the basis of the original disclosure in positive terms without unduly impairing its clarity and conciseness. The clarity requirement had already been established by decision T 4/80 (see above).

9. Decision T 426/94 of 22 May 1996 seems to identify a new requirement to be fulfilled by a disclaimer intended to meet an objection under Article 54(2) EPC if it is to be allowable under Article 123(2) EPC: that the prior art which it excludes must be **accidentally novelty-destroying prior art**. It also states that a disclaimer introduced in order to establish novelty should exclude precisely that subject-matter which is disclosed in the state of the art.

10. In the board's view, the importance of this decision resides in the introduction of a new condition which a disclaimer must satisfy to be admissible: the prior art has to be accidentally novelty-destroying, whereas the decisions quoted under points 6 and 7 above refer to a special/specific state of the art. This principle, established within the framework of restoring novelty under Article 54(2) EPC, could also be relevant under Article 54(3) EPC.

11. **The meaning of the term "accidentally"** with reference to the prior art in this context has been explained, inter alia, in decision T 608/96 of 11 July 2000, according to which a disclosure would be regarded as accidentally novelty-destroying (zufällig neuheitsschädliche Offenbarung) if a skilled person took no account of it when evaluating the problem underlying the patent (or patent application), since it would either belong to a completely different technical

field or in view of its subject-matter would not help in solving the technical problem underlying the claimed invention. This means also, according to the decision in question, that a disclosure can be considered as accidentally novelty-destroying only when it is not at all relevant for the assessment of inventive step.

12. The principle set out under point 9 above was applied coherently in decision T 917/94 of 28 October 1999, which considered a disclaimer with no basis in the original application as inadmissible because the prior art document which gave rise to it related to the same field (as well as to the same technical problem) as the claimed invention. Moreover since this document disclosed the most relevant prior art, it should have been considered for the purposes of inventive step. Indeed, according to this decision, a disclaimer is not permissible if its introduction would render subject-matter inventive which is otherwise obvious. Since it would change the nature of the alleged invention, the disclaimer did not comply with Article 123(2) EPC.
13. Decision T 596/96 of 14 December 1999 also pointed out that the prior art document (on which the disclaimer is based) must be indisputably novelty-destroying. This means that a disclaimer cannot be allowed simply as a precautionary or auxiliary means of further clarifying the distinction between the claimed subject-matter and the prior art.
14. A precise and complete exposition concerning the admissibility of disclaimers was given in decision T 934/97 of 6 June 2001, according to which a disclaimer introduced into a claim does not infringe Article 123(2) EPC and can therefore be admitted as

long as the following stringent requirements are fulfilled:

- (i) There has to be novelty-destroying prior art, and the disclaimer must be precisely formulated on the basis of that art and limit the invention against it.
 - (ii) The said prior art has to be accidental.
 - (iii) The prior art excluded has to lie outside that to be considered for the purpose of assessing inventive step.
 - (iv) The introduction of the disclaimer must fulfil the further condition laid down in decision G 1/93 (OJ 1994, 541), point 9 of the Reasons, according to which, pursuant to Article 123(2) EPC, an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the originally filed application.
15. With specific reference to Article 54(3) EPC, the admissibility of a disclaimer has been affirmed *inter alia* in decisions T 318/98 of 8 August 2000 and T 1125/97 of 22 February 2001, where the disclaimer had been necessary to reinstate novelty *vis-à-vis* a document not yet published on the patent application's date of filing. These two decisions do not give any grounds for such an affirmation, but merely refer to the principles set out in the case law.

16. Decision T 351/98 of 15 January 2002 was reasoned in awareness of the view expressed in decision T 323/97 (see below) about the admissibility of disclaimers. It says that, when an overlap occurs between prior art pursuant to Article 54(3) EPC and the claimed subject-matter, the specific prior art may be excluded by a disclaimer to establish novelty even in the absence of support for the excluded matter in the application as filed. Where the prior art is in line with Article 54(3) EPC, the later applicant could not have known of its content and thus could not have formulated his original claims to avoid it, so it seems justifiable on a balanced interpretation of the EPC to allow him to introduce a disclaimer to limit his claims to what is novel vis-à-vis the Article 54(3) EPC prior art. In such a situation, where a too literal insistence on a precise basis in the original disclosure for the purposes of Article 123(2) EPC would have the effect of extending the deemed publication provisions of Article 54(3) EPC to matter which was actually not disclosed in the earlier applications, making a disclaimer admissible would seem to reflect a more appropriate interpretation of the Convention. (NB: the technical subject-matter in this case was also HIV peptides, as in the present case.)
17. A similar solution was adopted in decision T 664/00 of 28 November 2002, where the disclaimed subject-matter was part of the state of the art under Article 54(3) EPC. The board held that the introduction of disclaimers had to be seen as merely waiving protection, not as making any technical contribution to the subject-matter of the claimed invention. These disclaimers were therefore considered as admissible. Reference was made to the principles stated in G 1/93

(see above).

18. Several other decisions have essentially confirmed the above principles. See in particular decisions: T 525/99 dated 12 September 2002, T 339/98 dated 18 September 2001, T 43/99 dated 29 January 2001, T 13/97 dated 22 November 1999, T 863/96 dated 4 February 1999, T 982/94 dated 16 September 1997, T 653/92 dated 11 June 1996, T 434/92 dated 28 November 1995, T 710/92 dated 11 October 1995.

19. Decision T 323/97 (see above) stated principles which are expressly in contrast to the established case law referred to so far. This decision said that a disclaimer could not be introduced into a claim in order to meet an objection of lack of novelty when no support for it could be found in the application as filed. In the board's view this may be regarded as an obiter dictum because point 2.1 of the reasons clearly explained that no lack-of-novelty objection to the subject-matter of the patent in suit was based or could have been based on the prior art documents taken into consideration by the disclaimer, since their respective disclosures differed from that of the patent in suit even without the incorporation of a disclaimer into the latter. However, the board believes that this decision raises an important point of law (Article 112(1) EPC) taking into consideration, on the one hand, the EPO's established practice concerning the admissibility of introducing into a claim a disclaimer not supported in the application as filed and, on the other, the significance of the objections to this practice raised by the decision in question.

20. This point of law is to be considered as relevant for the present proceedings in so far as they entail a decision upon the admissibility of a disclaimer. In its decision T 323/97 (see above), the board of appeal held that an amendment to a patent through the introduction of a "negative" technical feature into a claim resulting in the exclusion of certain embodiments, ie the incorporation into the claim of a disclaimer, was, regardless of the name "disclaimer", nonetheless an amendment governed by Articles 123(2) and (3) EPC. This meant, as far as the requirements of Article 123(2) EPC were concerned, that the amended claim must be supported by the application as filed, a requirement which was mandatory if the amended patent or patent application was to be admissible, as explained in decision G 3/89 (OJ 1993, 117, point 1.3 of the reasons).

21. It was pointed out that the principles of legal certainty and consistency, which, according to decision G 2/98 (OJ EPO 2001, 413) had to be safeguarded in the assessment of priority rights, novelty and inventive step, had also to be taken into account when considering the admissibility of introducing a disclaimer not supported by the application as filed, in order to establish novelty vis-à-vis an allegedly "accidental" anticipatory document. Decision G 2/98 states in particular that the assessment of whether or not certain technical features of an invention are related to its function and effect may vary in the course of the proceedings, especially if additional prior art has to be considered, and that the technical problem solved by an invention might not be determinable once and for all at a single point in time but might have to be considerably redefined in the

course of the proceedings, or even later, in the light of new prior art. As a consequence, the validity of an existing right of priority might be put in jeopardy, which could be at variance with the requirement of legal certainty. Similarly, with reference to the admissibility of disclaimers, since it would in fact not be possible to assess with certainty whether or not the limitation achieved by the amendment, ie the added negative feature, involved a technical contribution to the claimed invention and whether or not the anticipatory disclosure was really accidental, the admissibility of a disclaimer not supported by the application as filed would be at variance with the above principles. Indeed it was always possible that, when a particular embodiment (eg a chemical compound) was disclaimed from the generic teaching of a patent application (eg a generic formula) because it had been accidentally disclosed in a technical field completely outside that of the application, a further citation might later be found which disclosed properties of the disclaimed embodiment within or relevant to the technical field of the application. This could imply the need to redefine the technical teaching originally considered, with all the negative consequences pointed out in decision G 2/98 (see above).

22. Decision T 323/97 (see above) also emphasised that, in the light of decision G 1/93 (see above), the incorporation of a disclaimer not supported by the original application could not be allowed under Article 123(2) EPC. According to decision G 1/93, which deals with the possible conflict between paragraphs (2) and (3) of Article 123 EPC, arising from the introduction of an inadmissible amendment during examination proceedings, such an addition could be

accepted if it merely amounted to an exclusion of protection for part of the invention as covered by the application as filed and did not provide a technical contribution to the claimed subject-matter.

23. In decision T 323/97 (see above) the board therefore concluded that any amendment of a claim by means of a disclaimer not supported by the application as filed, and intended to distance the claimed subject-matter further from the state of the art, contravened Article 123(2) EPC and was consequently inadmissible.
24. Thus, following decision T 323/97 (see above), the disclaimer in claim 1 now under consideration would not be allowable, because, as already mentioned in point 4 above, there is no specific mention in the application as originally filed of two groups of peptides: the 13 peptides of document (1), now disclaimed, and the remaining peptides embraced by the generic definition of the class of peptides.
25. The above survey of board of appeal case law and of the different solutions thereby adopted shows that a referral to the Enlarged Board of Appeal is necessary pursuant to Article 112(1) EPC. The wording of the request (as stated in the Order below) was arrived at, on the one hand, in the light of the proposals of the parties to the proceedings (see sections VI to VIII above) and on the other, of the fact that the present case only concerns disclaimers in relation to novelty objections under Article 54(3) EPC.
26. In the board's view, for a proper consideration of the problems concerning the admissibility of disclaimers under Article 123(2) EPC, the following points may be

taken into consideration:

i- Of all the possible meanings of the word "disclaimer", the only one to be considered is that indicated in decision T 323/97 (above), according to which a disclaimer is an amendment to an already existing claim resulting in the incorporation into the claim of a "negative" technical feature. Like all amendments, disclaimers are governed by Article 123(2) EPC.

ii- To assess the admissibility of a disclaimer one may take into consideration the principles set out in decision G 1/93 (see above) (point 16 of the reasons). Given that the purpose of Article 123(2) EPC is to prevent an applicant from securing an unwarranted advantage by obtaining patent protection for something he had not properly disclosed and maybe not even invented on the date on which the application was filed, **an added feature is not to be considered as subject-matter extending beyond the content of the application as filed within the meaning of this provision if it merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed without providing any technical contribution to it.** Indeed the addition of a feature fulfilling these requirements cannot reasonably be considered to give any unwarranted advantage to the applicant, nor does it affect the interests of third parties. Whether or not these principles can apply, *mutatis mutandis*, to the admissibility of a disclaimer having the characteristics described above is a problem that the Enlarged Board of Appeal may consider relevant to its decision on the present referral.

iii- If the Enlarged Board of Appeal were to confirm decision T 323/97 (see above), this would invalidate under Article 123(2) EPC granted claims incorporating a disclaimer in accordance with earlier case law. This could not be remedied by simply deleting the disclaimer (assuming that the novelty objection which prompted the introduction of the disclaimer could be overcome by other means than a disclaimer) without falling into the so-called "inescapable trap" situation (G 1/93, see above), since a disclaimer by its very nature restricts the scope of a claim and its removal would thus unavoidably broaden the scope of the protection after grant in contravention of Article 123(3) EPC.

iv- With reference to Article 54(3) EPC, the particular situation of the applicant has to be taken into consideration. As made clear in decision T 351/98 (see above), he cannot be aware of the potentially novelty-destroying prior art in an earlier application published only after the filing of his own application. He cannot therefore draft his application in such a way as to avoid an overlap with such prior art. That Article 54(3) EPC is intended to prevent double patenting (see, for example, Singer/Stauder, Europäisches Patentübereinkommen, 2. Auflage, Artikel 54 Rdn 90) may suggest an interpretation of Article 123(2) EPC in accordance with decision G 1/93 (see para. 26. ii- above). An amendment by disclaimer is then nothing more than a waiver of protection for the subject-matter already disclosed in a piece of prior art under Article 54(3) EPC.

v- The answers to the questions referred to the Enlarged Board of Appeal in this decision will have a

significant impact on quite a number of patents already granted, since the use of disclaimers is a widespread practice within the EPO under its established case law.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

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?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey