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DECISIONS OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.3.5 dated 20 December 2002

T 507/99 - 3.3.5*

(Language of the proceedings)

Composition of the board:

Chairman: R. K. Spangenberg

Members: M. B. Günzel

M. M. Eberhard

Patent proprietor/Appellant 2: PPG Industries Ohio, Inc.

Opponent/Appellant 1: SAINT-GOBAIN GLASS FRANCE

Headword: Disclaimers/PPG

Article: 52(1), 54(2)(3)(4), 56, 112(1)(a), 123(2) EPC

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

Headnote

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

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?

Summary of facts and submissions

I. The present appeal proceedings concern the interlocutory decision of the opposition division of 11 March 1999 stating that, account being taken of the amendments made by the patent proprietor during the opposition proceedings,

European patent No. 536 607 and the invention to which it related were found to meet the requirements of the Convention. The decision was based on two different sets of claims for the Contracting States A (DE, FR, GB; IT) and B (CH, ES, LI, SE).

II. Appeals were lodged against this decision by both the opponent (appellant 1) and the proprietor of the patent (appellant 2). Several times in the course of the proceedings appellant 2 (proprietor) filed amended claims. The now valid claims on which the present decision is based were filed as appellant 2's main request on 12 June 2002 during the oral proceedings before the Board. As was the case in the previous requests filed before the Board and as in the claims defended by the appellant before the opposition division, these claims contain disclaimers. In a communication accompanying the summons to oral proceedings, the Board had *inter alia* drawn the appellant's attention to decision T 323/97 of 17 September 2001 (OJ EPO 2002, 476).

III. Independent claim 1 for the Contracting States A filed as main request at the oral proceedings before the Board reads as follows:

"1. A heat processable, metallic appearing coated article comprising:

(a) a transparent glass substrate;

(b) a metal compound film with metallic properties selected from the group consisting of metal borides, metal carbides, metal oxynitrides, chromium nitride, titanium nitride, zirconium nitride, hafnium nitride, tantalum nitride, niobium nitride; and

(c) a protective layer comprising a different metal from the metal compound film which minimizes oxidation of the metal compound film and is selected from the group consisting of chromium, titanium, and nitrides and oxynitrides of silicon-metal alloys **with the exception of silicon-zirconium nitride and silicon-tin nitride** (disclaimer (i), emphasis and parenthesis added by the Board),

with the proviso that if the metal compound film is titanium nitride the protective layer is not chromium" (disclaimer (ii), emphasis and parenthesis added by the Board).

Independent claim 17 of this main request for Contracting States A, concerning a method of making a heat processed metallic appearing article also contains disclaimer (i) and the additional process feature of heating the glass substrate on which are deposited the metal compound film and the protective layer to a temperature sufficient to bend the glass. Independent claim 17 does not contain disclaimer (ii).

Independent claim 1 of the main request for the Contracting States B differs from claim 1 for the Contracting States A by the deletion of disclaimer (i). It also contains disclaimer (ii).

IV. With regard to the admissibility of the disclaimers, appellant 1 (opponent) argued essentially as follows: The case law concerning disclaimers had been reversed by decision T 323/97 and the disclaimers were not acceptable. Moreover, the conditions laid down by established case law for the allowability of a disclaimer, i.e. that the disclaimer must be precisely defined and strictly limited to excluding the subject-matter disclosed in the state of the art and that said state of the art must be an accidental anticipation, were not met in the present case.

V. Appellant 2 (proprietor) argued essentially as follows:

Decision T 323/97 was in contrast to the common practice of the EPO and contradicted established jurisprudence, e.g. the decisions T 433/86, T 170/87, T 434/92, T 653/92, T 710/92, T 426/94, T 982/94 and T 318/98.

Alternatively to the grant of his main request, appellant 2 requested that the following three questions be referred to the Enlarged Board of Appeal in order to ensure uniform application of the law:

"Are disclaimers admissible to exclude any novelty-destroying state of the art according to Article 54(2) EPC?"

Are disclaimers admissible to exclude any accidental novelty-destroying state of the art according to Article 54(2) EPC?

Are disclaimers admissible to exclude any novelty-destroying state of the art according to Article 54(3) EPC?"

VI. At the end of the oral proceedings before the Board, which took place on 12 June 2002, the Board informed the parties that it would refer a point of law to the Enlarged Board of Appeal concerning the criteria to be applied for assessing the allowability of disclaimers, and that the decision would be given in writing.

VII. In its interlocutory decision T 507/99 of 28 August 2002, the Board stated that the subject-matter of claims 1 to 22 according to the main request filed on 12 June 2002 during the oral proceedings before the Board for the Contracting States A (DE, FR, GB and IT) and the subject-matter of claims 1 to 21 filed simultaneously for the Contracting States B (CH, ES, LI and SE) met the requirements for patentability set out in Articles 52(1), 54 and 56 EPC. Assessing novelty and inventive step of the subject-matter of these claims as they stood, in order to determine whether the question of the allowability of the disclaimers contained in them was decisive for the outcome of the appeal; the board arrived at the following conclusions, which are reproduced here in so far as they are relevant for the present decision concerning referral to the Enlarged Board of Appeal. For further details of the Board's argumentation on novelty and inventive step with regard to appellant 2's main request, reference is made to the reasons set out in the Board's interlocutory decision of 28 August 2002.

The subject-matter of the claims of the main request for both Contracting States A and B was novel in relation to the state of the art. In particular:

The patent in suit claimed the priority dates of 30 September 1991 and 29 November 1991. In so far as the disclosure in D1, EP-A-0 546 302, which was published on 16 June 1993, was entitled to the claimed priority of 30 October 1991, D1 belonged

to the state of the art pursuant to Article 54(3) and (4) EPC in respect of Contracting States A for certain alternatives covered by claims 1 and 17 of the main request for these Contracting States and not entitled to the claimed priority of 30 September 1991. The subject-matter of claims 1 and 17 of the main request for Contracting States A was novel over D1, in particular as the silicon-zirconium nitride and silicon-tin nitride disclosed in D1 as the protective layer had been disclaimed by disclaimer (i) (points 5 and 5.1 of the reasons). Appellant 1's argument that D1 also disclosed silicon-aluminium nitride, silicon-metal nitrides and silicon-metal oxynitrides covered by claims 1 and 17, and thereby more than was disclaimed in the patent in suit, was rejected (point 5.1 of the reasons).

The subject-matter of claim 1 was also novel in relation to A8, US-A-4 900 630, because the combination of a TiN layer with a Cr layer disclosed in A8, which belonged to the state of the art pursuant to Article 54(2) EPC, was disclaimed by disclaimer (ii). Process claim 17 was also distinguished from the disclosure of A8 in that A8 did not disclose heating the coated glass substrate to a temperature sufficient to bend the glass (point 5.7 of the reasons).

For the Contracting States B, D1 was not comprised in the state of the art. With respect to A8 the same considerations as for claim 1 for the Contracting States A were applied. Therefore the subject-matter of claim 1 of the main request for these States, although not containing disclaimer (i), was considered novel (point 5.9 of the reasons).

With regard to inventive step, several alternatives were considered as the closest prior art, namely documents A7, A3 and A6. Starting from A7, A3 or A6 as the closest prior art, the technical problem underlying the patent in suit could be seen in the provision of further coated articles which substantially retained their metallic appearance and their reflectance and transmittance properties throughout high-temperature processing such as bending (points 6.1 and 6.5 of the reasons). The subject-matter of the independent claims for all Contracting States was considered to

involve an inventive step over the documents or combinations of documents cited by the opponent. In connection with A8 it was in particular pointed out that the coated glass plates disclosed in A8 were useful as a building material or ornamental material. The Ti or Cr layer overlying the TiN layer adhered strongly to the latter and afforded sufficiently high durability and wear resistance to the multilayer coating. This document did not address the problem of avoiding degradation of the optical properties when the coated glass was exposed to high temperatures during a bending process. It did not contain information suggesting that the deposition of a protective layer of chromium onto a TiN layer might have solved the said technical problem. Therefore, the skilled person faced with the problem stated above with respect to A7 would not have been encouraged by A8 to replace the aluminium protective layer taught by A7 by a chromium or a titanium layer, all the more so since A7 further taught that the attempts to replace the aluminium layer by other metals such as titanium were not successful (point 6.7 of the reasons).

Furthermore, without taking a decision on the compliance of the amended claims with Article 123(2) EPC as a whole, the Board pointed out that it had no objections under that article against the amendments other than the disclaimers made after grant in both sets of claims according to the main request for the Contracting States A and B. Disclaimer (i) was, however, not disclosed in the application of the patent in suit as filed and disclaimer (ii) did not seem to be disclosed therein. The subject-matter of disclaimers (i) and (ii) was disclosed in D1 and A8 respectively, in relation to which documents the disclaimers had been introduced into the claims of the patent in suit (point 3 of the reasons).

Reasons for the decision

According to Article 112(1)(a) EPC, in order to ensure uniform application of the law, or if an important point of law arises, the 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 for the above purposes.

1. As can be inferred from the reasons reported above under VII, given by the Board in its interlocutory decision of 28 August 2002, in the present appeal proceedings the allowability of the appellant's main request depends on whether or not the disclaimers introduced into some of the claims for both groups of Contracting States are allowable.

The term "disclaimer" has been used in some decisions of the boards of appeal not only in the sense of a negative feature excluding specifically defined embodiments from the scope of a claim, but also in relation to a "positive" wording leading to the same result. In the following, these decisions will also be considered to the extent that they are relevant for the definition of the requirements for the allowability of disclaimers, although in the present case the Board is only concerned with disclaimers in the classic sense, i.e. negative features excluding specifically defined embodiments from the scope of the claims.

2.1 The introduction of a disclaimer into a claim was allowed in the jurisprudence of the boards of appeal for the first time in decision T 4/80 (OJ EPO 1982, 149). In said decision a disclaimer in its negative form was held to be allowable, in order to delimit the claimed subject-matter against the disclosure in an earlier national patent application not belonging to the state of the art according to Article 54 EPC, if the subject-matter to be excluded was disclosed in the European patent application as filed and if further the subject-matter remaining in the claim could not be defined directly (positively) more clearly and concisely (Headnote I and points 2 and 3 of the reasons). In decision T 433/86 of 11 December 1987 the board of appeal allowed the exclusion of overlapping disclosure in a document belonging to the state of the art as defined in Article 54(2) EPC by the introduction of a disclaimer (which in this case was "positively" worded), although the disclaimer defined the excluded subject-matter by values which were not disclosed as such in the application as filed but

were disclosed in the prior art document against which the claim had to be delimited. According to the decision, where there is an overlap between the prior art and the claimed subject-matter defined in generic terms, a specific prior art may be excluded even in the absence of support for the excluded matter in the original documents.

2.2 This became established jurisprudence. Although, as will be set out below, certain limitations were subsequently developed in the case law of the boards of appeal where the disclaimer was introduced in order to delimit the claim against subject-matter belonging to the state of the art pursuant to Article 54(2) EPC, delimitation by way of a disclaimer defining subject-matter disclosed in a conflicting application under Article 54 (3) EPC had consistently been allowed by the boards of appeal where the subject-matter remaining in the claim could not be defined by positive technical features more clearly and concisely. In the literature, the justification for allowing such disclaimers from the point of view of Article 123(2) EPC was seen in that they did not change the given technical teaching but merely took into account the fact that different applicants were entitled to the patent in different areas and that there was a need for allowing disclaimers in this situation because it was not normally possible for an applicant, when preparing his application, already to be familiar with conflicting applications under Article 54(3) EPC (Teschemacher in *Singer/Stauder*, Europäisches Patentübereinkommen, 2nd edition, Cologne 2000, Article 84, Note 21).

This position was recently confirmed in decision T 351/98 of 15 January 2002 of Board of Appeal 3.3.4, points 11 and 45 of the reasons. In this decision the board, while aware of decision T 323/97 (see point 2.3 below), considered that it would be justified on a balanced interpretation of the EPC to allow a later applicant to limit his claims to what is novel over the Article 54(3) prior art by means of a disclaimer.

2.3 As is summarised in decision T 323/97 (OJ EPO 2002, 476), the boards of appeal have in the past also permitted the introduction of disclaimers unsupported by the application as filed into a claim in order to make a claimed subject-matter

novel by delimiting it against an "accidental" anticipation under Article 54(2) EPC (point 2.2 of the reasons, with references to a number of prior decisions). In this context an anticipation had been regarded as accidental if a skilled person would not take account of it when evaluating the inventive merit of the patent (or patent application), since it either belonged to a completely different technical field or in view of its subject-matter it would not help in solving the technical problem underlying the claimed invention. Reference was made there to decision T 608/96 of 11 July 2000, point 6 of the reasons. It appears to the present Board that in this decision a different definition of the expression "accidental anticipation" was given, at least as regards the language used. This aspect will be dealt with later (see point 7.3 below), since it is not relevant to the first and main issue of the present referral, which is the divergence between the principles for the allowability of disclaimers developed in the past jurisprudence of the boards of appeal on the one hand and in decision T 323/97 on the other.

The reasons given in the jurisprudence as justification for the allowability of disclaimers in relation to state of the art under Article 54(2) EPC are very similar to those previously cited for allowing disclaimers in relation to conflicting applications under Article 54(3) EPC.

In decision T 170/87, OJ EPO 1989, 441, which is often cited as having formed the basis for the later comprehensive body of jurisprudence on disclaimers, it is said under point 8.4.1 of the reasons, referring to decisions T 4/80 and T 433/86, that according to established Board of Appeal case law, in cases where what was claimed in general overlapped with the state of the art it was permissible to exclude a specific part of the 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. According to decision T 170/87, point 8.4.3 of the reasons, this practice is justified on the basis of the following considerations: "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... . 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."

By contrast, it was held that a disclaimer cannot be used to make a novel teaching inventive (T 170/87, point 8.4.4 of the reasons; T 597/92, OJ EPO 1996, 135, point 3 of the reasons). In that case the intention was not to excise something from an inventive teaching originally disclosed but to bestow inventive quality on a thoroughly obvious teaching by subsequently adding a feature which was not originally specifically disclosed. This would mean that the technical teaching contained in the original documents would be substantially modified (T 170/87, loc. cit.).

3. In the present case disclaimer (i) was introduced into claims 1 and 17 of the set of claims for the Contracting States A in order to establish the novelty of the claimed subject-matter over D1, a document constituting state of the art under Article 54(3) EPC for certain embodiments covered by these claims. Disclaimer (ii) was incorporated in claim 1 of both sets of claims in order to delimit their subject-matter against a disclosure in document A8, document A8 constituting state of the art under Article 54(2) EPC for both sets of claims for Contracting States A and B. Neither the disclaimers as such nor the excluded subject-matter have been regarded by the Board as being disclosed in the application as filed, but as excluding subject-matter disclosed in the respective documents D1 and A8. As can be immediately seen from the wording of the claims of the present main request containing the disclaimers, both disclaimers are narrowly defined so as to disclaim the specific materials forming the first protective layer disclosed in D1 and forming both layers in A8, respectively, out of the considerable number of materials encompassed by the claims of the main request for the respective layers. It is also clear that the restriction of the claims intended thereby could not be more precisely and concisely expressed in positive

terms, e.g. by listing all the remaining individual materials, without unduly restricting the scope of said claims.

As set out under point 6.7 of the reasons in the Board's interlocutory decision of 28 August 2002 and stated under point VII above, document A8 does not address the problem of avoiding degradation of the optical properties when the coated glass was exposed to high temperatures during a bending process. It does not contain information suggesting that the deposition of a protective layer of chromium onto a TiN layer might have solved the said technical problem. Therefore, the skilled person faced with the problem underlying the patent with regard to A7 would not have been encouraged by A8 to replace the aluminium protective layer taught by A7 by a chromium or a titanium layer, all the more so since A7 further taught that the attempts to replace the aluminium layer by other metals such as titanium were not successful. Therefore, although it might be questionable whether A8 would not be taken into account for the assessment of inventive step, the disclosure of A8 is in any case not of such significance that it would, alone or in combination with the disclosure in other cited documents, have rendered the claimed subject-matter obvious to a skilled person faced with the problem underlying the patent in suit.

4. The hitherto established practice and jurisprudence on disclaimers have now been fundamentally and very generally called into question, and more than that, their continuation has been described as unjustified in the above-mentioned decision T 323/97. In this decision Board of Appeal 3.3.6 dealt with a case in which the disclaimer introduced in claim 1 of the main request in order to exclude certain embodiments from its scope had no basis in the application as filed (point 2.1 of the reasons).

4.1 After having considered the existing jurisprudence on the requirements for the allowability of disclaimers, Board of Appeal 3.3.6 held that an amendment to a patent by the introduction of a negative technical feature into a claim resulting in the exclusion of certain embodiments was, regardless of the name "disclaimer"

nonetheless an amendment governed by Article 123(2) and (3) EPC. This meant that the amended claim had to find support in the application as filed (point 2.2 of the reasons). The Board then turned to decision G 2/98 (OJ EPO 2001, 413) and concluded, from the principles of legal certainty and consistency addressed in this decision in the context of the interpretation of the provisions on priority rights, that in the light of G 2/98 it could find no argument which would justify the maintenance of the practice of the earlier decisions to admit **disclaimers having no basis in the application as filed** (point 2.4 of the reasons, emphasis added by the present Board). Particular reference is made in point 2.4.1 of decision T 323/97 to decision T 433/86, point 2 of the reasons, and the following formulation used therein: "... a specific prior art may be excluded even in the absence of **support for the excluded matter** (emphasis added by the present Board) in the original documents". Thus, from a reading of points 2.4 and 2.4.1 in decision T 323/97, it can be derived that what the Board meant when it stated that, in the light of G 2/98, it could find no argument which would justify the maintenance of the practice of admitting disclaimers having no basis in the application as filed, is that either the disclaimer itself or the excluded subject-matter had to be disclosed in the application as filed.

The main reason which led Board of Appeal 3.3.6 to regard the concept of allowing disclaimers not having a basis in the application as filed, if they relate to an accidental disclosure in the state of the art, as being irreconcilable with the principles of legal certainty and consistency addressed in decision G 2/98 (OJ EPO 2001, 413), seems to have to do with the rejection of the so-called "Snackfood" approach for determining the validity of a claimed priority by the said decision of the Enlarged Board of Appeal (see e.g. points II(iv) and 8.3 of the reasons in G 2/98, referring to T 73/88, OJ EPO 1992, 557). It would not be possible with certainty to assess once and for all at a single point in time whether or not the limitation achieved by the amendment involved a technical contribution to the claimed invention, and whether or not the anticipatory disclosure was really accidental. For example, it was always possible that, when a particular embodiment was disclaimed from the generic teaching of a patent application because it was accidentally disclosed in a technical

field completely outside that of the application, a further citation might later be found disclosing properties of the disclaimed embodiment within or relevant to the technical field of the application. This could necessitate a redefinition of the technical problem underlying the technical teaching originally considered, with all the negative consequences pointed out in G 2/98 (T 323/97, point 2.3 of the reasons).

In the view of Board 3.3.6, the amendment of a claim by incorporation of a disclaimer unsupported by the original application, could also not be allowed under Article 123(2) EPC in the light of decision G 1/93, OJ EPO 1994, 541, having said that the restriction of a claim by the addition of a feature not disclosed in the original application 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. Board 3.3.6 found that a disclaimer aiming at further distancing the patent from the state of the art which had to be considered when assessing inventive step could not be considered as a mere waiver of protection and would give the patent proprietor an unwarranted advantage within the meaning of decision G 1/93 (T 323/97, point 2.5 of the reasons).

4.2 Although in its decision Board of Appeal 3.3.6 had only to deal with a case where the disclaimer introduced was intended to delimit the claim against a document constituting state of the art under Article 54(2) EPC, its finding in point 2.4 that the practice of permitting disclaimers not having support in the application as filed cannot be maintained is of such generality that it also applies to - i.e. covers - the situation where a disclaimer not disclosed in the application as filed is introduced into a claim in order to delimit it against state of the art under Article 54(3) EPC. The present Board does not appear to be alone in understanding the implications of the cited finding in T 323/97 to be so far-reaching. Thus, in the already mentioned recent decision T 351/98 of Board 3.3.4, points 11 and 45 of the reasons, where the Board had to deal with a disclaimer in relation to a document pursuant to Article 54(3) EPC, the Board expressly referred to decision T 323/97 and emphasised that, in the case of Article 54(3) prior art, its own view that a disclaimer could be allowed even in the

absence of support for the excluded matter in the application as filed, was to be regarded as the more appropriate interpretation of the EPC than the view taken in decision T 323/97. The present Board takes the findings in T 351/98 as supporting its own view that the very general denial of the allowability of disclaimers not having support in the application as filed expressed in decision T 323/97, in view of the requirements of Article 123(2) EPC, also applies to an intended delimitation of subject-matter against a prior application pursuant to Article 54(3) EPC.

5.1 It is self-evident and therefore needs no further explanation that this drastically changed and very restrictive new concept of the conditions for the allowability of disclaimers constitutes an extremely important point of law within the meaning of Article 112(1)(a) EPC. It is of enormous importance for the scope of protection available to applicants or patentees who have to define or redefine their claimed inventions in relation to the state of the art under consideration. Particularly, but not exclusively, in the field of chemistry, disclaimers have become very important instruments for applicants seeking the best possible protection for their inventions and desiring not to limit the scope of their claims more than is necessary in view of the state of the art. Decision T 323/97 has led to uncertainty among applicants as to how they will in future be allowed to claim, depending on the position adopted by the board responsible for the individual case in question. There is therefore a need for clarification of the issue on a broader level.

5.2 Moreover, Board 3.3.6 also expressly acknowledged in its decision, see point 2.4 of the reasons, that its findings were at variance with the principles previously applied by the boards of appeal when assessing the allowability of the introduction of disclaimers into a claim. The present referral is therefore also made with a view to ensuring uniform application of the law within the meaning of Article 112(1)(a) EPC.

5.3 Under point 2.6 of decision T 323/97, Board of Appeal 3.3.6 also explained briefly that the disclaimer introduced into claim 1 of the main request would also not be admissible, according to the previously established principles of the jurisprudence

of the boards of appeal, because the documents forming the basis for the disclaimer were not accidental anticipations. However, in the view of the present Board, Board 3.3.6's findings in decision T 323/97 on the requirements for the allowability of disclaimers cannot be regarded as obiter dicta, since they constitute the very essence of the reasons given in that decision for the non-allowability of the appellant's main request. Therefore, the present Board does not share the view expressed in "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001, II.B.1.2.1. Findings in a decision are not obiter dicta for the sole reason that the decision is based on several grounds which would each in isolation justify the decision taken. It is quite evident from the comprehensive reasoning given in decision T 323/97 that Board 3.3.6 wanted to base its decision primarily on its new view that claims amended by the introduction of a disclaimer having no basis in the application as filed contravened Article 123(2) EPC, thereby denying the justification for further maintaining the previously established jurisprudence. Moreover, it is the present Board's opinion that obiter dicta can concern important points of law within the meaning of Article 112(1)(a) EPC, as is the case here. According to opinion G 3/93, OJ EPO 1995, 18, point 2 of the reasons, they can even justify referrals on the ground that two boards of appeal have given different decisions on the question concerned, since even an "obiter dictum" may give rise to legal uncertainty.

6. Clarification of the criteria to be applied for assessing the allowability of introducing a disclaimer not having a basis in the application as filed is not only needed in view of the new and fundamentally opposed approach to the disclaimer issue adopted in decision T 323/97. Looking more closely at the formulations hitherto used in the jurisprudence of the boards of appeal to define the requirements for a disclaimer to be allowable, it is apparent that the terminology used is not always identical. The present Board has doubts whether the different formulations used necessarily mean the same, as will be further explained in the following considerations.

7.1 First of all, the case law of the boards of appeal is ambiguous in respect of the question as to whether or not a disclaimer not disclosed in the application as filed and aiming at excluding novelty-destroying subject-matter, including such matter belonging to the state of the art pursuant to Article 54(3) EPC, must be strictly confined to disclaiming subject-matter disclosed in the prior art document, in order to make its introduction into a claim allowable under Article 123(2) EPC.

7.1.1 Some decisions have allowed disclaimers excluding more than what was disclosed in the prior art document. Reference may be made in this respect to T 296/87, OJ EPO 1990, 195, point 3.3 of the reasons, and to T 12/90 of 23 August 1990, point 3.1 of the reasons. In these decisions it was considered that such a disclaimer had the advantage of being considerably clearer. In T 12/90 a further reason for the allowability of such a disclaimer was that the disclaimer was considered not to make the remaining subject-matter different from the original disclosure so as to produce a different technical teaching (*aliud*).

On the other hand, e.g. decision T 1071/97 of 17 August 2000 explicitly requires as a prerequisite for allowing the introduction of a disclaimer that the subject-matter disclaimed must be precisely defined and strictly limited to the actual scope of the anticipation. This requirement is also stipulated in decision T 43/82 of 16 April 1984 (point 9 of the reasons) and might be inferred from decision T 434/92 of 28 November 1995, point 5.3 of the reasons, as well as from decision T 982/94 of 16 September 1997, point 2.1 of the reasons (see in this respect also T 898/91 of 18 July 1997, point 2.1.1, where, however, the disclaimer was found to be too narrowly drafted).

An intermediate position seems to be taken in T 426/94 of 22 May 1996, where the disclaimer contained in the granted claim was modified afterwards to the effect that its wording was as close as possible to the wording of the disclosure of the anticipation (see point 3 of the reasons).

7.1.2 In the present case, it was argued (see point IV above) that disclaimer (i) is not strictly limited to the exclusion of subject-matter forming part of the state of the art. This question has not yet been decided; however, the facts of the case are the following:

D1 can only be regarded as belonging to the state of the art pursuant to Article 54(3) EPC in so far as its subject-matter corresponds to that disclosed in the Japanese patent application No. 311723/91 from which it claims priority (see point VII above). This Japanese patent application, however, discloses according to its claim 1 a method for making a bent coated glass comprising the steps of forming a solar control layer (which may consist of some of the materials forming the metal compound film according to claims 1 and 17 for the Contracting States A of the patent in suit) on a glass substrate, forming a first and a second protective layer to provide a glass coated with a multi-layer coating comprising at least **three layers** and bending the said coated glass. This subject-matter corresponds to the embodiment of dependent claim 2 of D1 requiring that a second protective layer be present and wherein the coated glass is bent, as disclosed on page 2, line 24, of D1. By contrast, claim 17 for the Contracting States A relates to a method of making a bent coated glass which comprises the steps of depositing **two layers** so that the deposition of a third layer is only optional. In claim 1 for the Contracting States A, the heat-processable coated glass comprises **two layers**, the presence of a third layer being thus optional, and the heat process for which that product must be suitable may, according to the patent, be a bending process.

Therefore, this question may become relevant in the present appeal, if disclaimers did not already have to be declared unallowable for other reasons. The Board observes in this context that it may be difficult to find a clear and concise wording for disclaimer (i) which would be strictly (or more literally) confined to excluding the subject-matter belonging to the state of the art.

7.2 When disclaimers have been allowed in the past in order to delimit a claim from the subject-matter disclosed in a conflicting application under Article 54(3) EPC or in a prior national application (see 2.1 above), the question as to whether the requirement that only an accidental disclosure justifies the introduction of a disclaimer when its subject-matter was not disclosed in the application as filed, has, as far as the Board is aware, never been posed, because in these cases only the novelty of the claimed subject-matter is at issue. Reference may be made here to T 653/92 of 11 June 1996, point 2 of the reasons, where the admissibility of a disclaimer made in relation to state of the art under Article 54(3) and (4) EPC is discussed and express reference is made to the purport of decisions T 170/87 and T 597/92 that a disclaimer may not be used to render a claim inventive, without however any discussion of this issue as a - possible - requirement for the allowability of a disclaimer in relation to state of the art under Article 54(3) and (4) EPC; see also decisions T 351/98 of 15 January 2002, points 11 and 45 of the reasons, and decision T 318/98 of 8 August 2000, point 2.2 of the reasons.

7.3 For disclaimers in relation to documents forming part of the state of the art according to Article 54(2) EPC, the established jurisprudence that disclaimers not originally disclosed in the application as filed may also be introduced into a claim in order to delimit the claim over an "accidental anticipation" of claimed subject-matter has been addressed above under 2.3. To illustrate the differences in the language used, the board refers to the following:

In T 323/97, point 2.2 of the reasons, Board 3.3.6 inferred from the case law it analysed that an anticipation would be regarded as accidental if a skilled person would not take account of it when evaluating the inventive merit of the patent (or patent application), since it either belonged 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. The Board referred in this respect also to T 608/96 of 11 July 2000, point 6 of the reasons.

In decision T 608/96, written in German, a disclosure is regarded as "accidentally novelty-destroying" if a person skilled in the art, confronted with the technical problem to which the application or patent relates, would not take it into account, for instance (in the German text: "etwa") because this prior art belongs to a remote technical field or, according to its subject-matter, does not contribute at all to the solution of the technical problem. According to that decision this also means that the requirement "accidental destruction of novelty" can only be met if the said disclosure is completely irrelevant (in the German text: "ohne **jede** Bedeutung") for the assessment of the inventive step involved by the claimed invention (point 6 of the reasons).

7.3.1 As regards the criterion that an anticipation is accidental when the skilled person would not take account of it in view of a different technical field, it is questionable whether the existing differences in wording are indicative of any substantive difference in the approach taken. In decision T 323/97 it is said that an anticipation is accidental if it "belongs to a completely different technical field". However, decision T 608/96 speaks instead of a remote technical field. The authentic German text is "weitab liegendes Fachgebiet". There may, in individual cases, be situations in which the skilled person would consult a document belonging to a field which would normally have to be regarded as remote from the subject-matter with which the claimed invention is concerned. It is therefore not automatic that a document concerning a remote technical field is not to be considered for the assessment of inventive step of the subject-matter claimed. Moreover, it may be inferred from the wording used in T 608/96 that the two criteria mentioned there are in fact only examples of what may be an "accidental anticipation", and that the more general definition would be that the prior art under consideration should be completely irrelevant for the assessment of inventive step.

7.3.2 As regards the second criterion formulated in T 323/97, it may also be questionable whether or not there is correspondence as to substance, since in T 323/97, point 2.2 of the reasons, the wording used is that the disclosure would be

accidental if it would not help in solving the technical problem underlying the claimed invention, whereas in T 608/96 it is indicated that a disclosure is accidental e.g. if, according to its subject-matter, it does not contribute at all to the solution of the problem to be solved by the application or patent. This also means, according to T 608/96, that the prior art under consideration should be completely irrelevant for the assessment of inventive step.

7.3.3 In decision T 863/96 of 4 February 1999, point 3.2 of the reasons, Board of Appeal 3.3.2 did not use the specific criteria mentioned in T 323/97 but defined the requirements for allowing disclaimers as follows:

"In accordance with the case law of the Boards of Appeal, it would be allowable under Article 123(2) EPC to formulate a disclaimer which is precisely defined and limited to the prior art disclosure, provided this disclosure is an accidental novelty-destroying disclosure. From the jurisprudence of the Boards of Appeal dealing with this exceptional means for reinstalling novelty, it clearly appears that the disclaimer to be formulated on the basis of this disclosure is only allowable if the cited document containing the said disclosure has no relevance for any further examination of the claimed invention and it must then disappear from the prior art field to be taken into consideration."

The same approach was also applied in decision T 13/97 of 22 November 1999, point 2.3 of the reasons. In this decision the Board also relied on the concept that the excluded subject-matter does not contribute to the solution of the problem. In this context the Board referred to decisions T 313/86 unpublished, T 170/87 OJ EPO 1989,441, and T 623/91 unpublished).

7.3.4 Still another form of words is used in decision T 932/94 of 13 January 1998, point 6 of the reasons, which says that the expression "accidental novelty-destroying prior art disclosure" means prior art relating to a different purpose and solving a different problem. This decision does not appear to require that the prior art

disclosure be "completely irrelevant for the assessment of inventive step" (see T 608/96) or must "disappear from the state of the art" (see T 863/96 and T 13/97).

7.3.5 In decision T 934/97 of 6 June 2001, point 2.3 of the reasons, the Board set out the criteria to be applied when examining the allowability of a disclaimer. It considered, referring to a number of decisions, including T 13/97 and T 863/96, that a disclaimer not disclosed in the application as filed was only allowable pursuant to Article 123(2) EPC if there was a novelty-destroying prior art and if, *inter alia*, the following requirements were met:

(ii) the prior art was an accidental anticipation;

(iii) the "excluded" prior art disappeared (in the German text "ausscheidet") from the state of the art to be considered for the assessment of inventive step. Reference is made *inter alia* to the definition in "Singer, The European Patent Convention, revised English edition by Raph Lunzer (1995), page 735, stating that "a disclaimer can be used to distinguish from an accidental anticipation, such as where the citation in question is directed to a different purpose, solves a different problem and has no bearing on the problem and solution addressed by the invention".

In the last two paragraphs of point 2.6 of the reasons the Board then considered whether or not the two criteria (ii) and (iii) were met in this particular case. It concluded that the prior art related to the same purpose, the same problem and to a similar solution so that criterion (ii) was not met. Due to the similarity of the solution criterion (iii) was also found not to be met. Thus it is questionable whether or not in this case an "accidental anticipation" was considered to be equivalent to or something different from a disclosure which "disappears from the state of the art" for the assessment of inventive step.

7.3.6 In the opinion of the present Board, the case law of the boards of appeal referred to above does not provide a clear answer to the question which criteria must

be met by a disclosure belonging to the state of the art pursuant to Article 54(2) EPC in order to be accepted as an "accidental anticipation" and, accordingly, as a basis for an allowable disclaimer. The answer to this question may be relevant to the present case if this criterion were considered decisive, since disclaimer (ii) relates to a disclosure which may not be regarded as being completely irrelevant for the assessment of inventive step, but has eventually proved, after the consideration of its technical teaching in combination with other cited documents, not to render the solution of the problem addressed in the patent in suit obvious (see point 3 above).

7.4 Furthermore, not all decisions dealing with disclaimers aiming at the exclusion of state of the art pursuant to Article 54(2) EPC have applied the criteria discussed in the foregoing when examining the requirements of Article 123(2).

Some decisions, such as T 871/96 of 8 October 1998, points 2, 3.3 and 4.2 of the reasons, and T 710/92 of 11 October 1995, points 3, 4.2 and 5 of the reasons, accept the disclaimer under Article 123(2) EPC, even if it is not disclosed in the application as filed, if the disclaimer is limited to disclaiming the disclosure of the prior art document. The approach is then, however, that the claim is to be examined for inventive step, as if the disclaimer did not exist (see T 871/96, point 4.2 of the reasons, and T 710/92, points 5 and 7 of the reasons). Inventive step is accordingly assessed considering, in decision T 710/92, that the "disclaimer", which is formulated in the form of a positive feature, does not contribute to the teaching of the original application as a whole (see point 6.2 of the reasons), whereas in decision T 871/96 the disclaimer, in form of a negative feature, is considered not to contribute to the definition of the technical problem underlying the invention (point 4.4 of the reasons).

This approach appears to be quite different from that taken in the decisions referred to in point 7.3 above.

7.5 In decision T 982/94 of 16 September 1997, relied upon by appellant 2, the amendment resulting from the introduction of a disclaimer into a claim in order to overcome a novelty objection was considered as complying with the requirement of Article 123(2) EPC, since it was adequately supported by the disclosure in the prior art document (see point 2.1 of the reasons). Further conditions were not required.

8. The Board has considered the wording of the questions as they were formulated by appellant 1. In view of the cases to be distinguished in the body of jurisprudence discussed above and the definitions given in said decisions, and also in view of the circumstances of the case pending before the Board, the Board has come to the conclusion that the questions to be referred to the Enlarged Board of Appeal should be formulated as appears in the following order of this decision.

Order

For these reasons it is decided that:

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

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?

* The case is pending under reference No. G 1/03.