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ADMISSIBILITY OF DISCLAIMERS – NEW LESSONS FROM THE EPO TECHNICAL BOARDS OF APPEAL

Last year, the EPO Enlarged Board of Appeal (EBA) handed down its decision in case G2/10 relating to the admissibility of disclaimers whose subject matter was disclosed as an embodiment (i.e. 'positively disclosed' disclaimers) in the application as originally filed.¹

The EBA ruled that an amendment to a claim by the introduction of a disclaimer disclaiming from its 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 in the application as originally filed.

Determining whether or not that is the case requires an 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, the nature and extent of the disclaimed subject matter and its relationship with the subject matter remaining in the claim after the amendment. In other words, the examination of the admissibility of a disclaimer for compliance with Article 123(2) EPC has to be made separately for the disclaimer *per se* and for the subject matter remaining in the claim.

Two recent decisions of EPO Technical Boards of Appeal (TBA) 3.3.08 and 3.4.03, respectively, shed some light on how such technical assessment with respect to the admissibility of a disclaimer is to be performed.

¹ Cf. the newsletter issue of September 2011 entitled "EPO Enlarged Board of Appeal Ruling on Disclaimer Practice".



1. Case T1068/07

This is the final decision of the referral resulting in decision G2/10. The subject matter of the disputed application relates to catalytic DNA molecules capable of cleaving other nucleic acid sequences or molecules in a site-specific manner. Claim 1 according to the main request reads:

A catalytic DNA molecule having site-specific endonuclease activity specific for a nucleotide sequence defining a cleavage site in a preselected substrate nucleic acid sequence, said catalytic molecule having first and second substrate binding regions flanking a core region, said molecule having the formula:



wherein each X is any nucleotide sequence,

(X-R) represents said first substrate binding region,

(X) represents said second substrate binding region, [...]

with the proviso that the catalytic molecule is not a molecule in which the first and second binding regions can bind through complementary base-pairing to a substrate nucleic acid which is 5'-GGAAAAGUAACUAGAGAUGGAAG-3'. (emphasis added)

The Board noted that the application discloses – supported by experimental data – an *in vitro* evolution process for generating, selecting and isolating catalytic DNA molecules having site-specific endonuclease activity specific for a nucleotide sequence defining a cleavage site in a preselected substrate nucleic acid sequence, and having first and second binding regions flanking a core region, wherein said first and second substrate regions have sequences capable of binding through complementary base-pairing to a first and a second portion, respectively, of said preselected substrate nucleic acid sequence.

In particular, example 5 as well as Figures 8 and 9 of the application disclose a particular DNA clone ("10-23") having a substrate binding core region (SEQ ID NO: 122) as specified in claim 1 of the main request. The substrate nucleic acid sequence



(SEQ ID NO: 135) of this clone is identical to the sequence given in the disclaimer of claim 1 of the main request.

The Board thus concluded that the subject matter of the disclaimer in claim 1 of the main request is explicitly disclosed in the application as originally filed.² The decisive question now to be answered is whether the subject matter remaining in claim 1 after introduction of the disclaimer does extend beyond the original disclosure.

Example 6 of the application was found to be directed to the preparation of 'universal substrate enzymes' (*inter alia* based on the sequences of clone "10-23"). Here, it is explicitly stated that the sequence of the substrate can be changed without loss of catalytic activity, as long as the substrate-binding arms of the enzyme are changed in a complementary manner. Finally, the generic core region according to claim 1 of the main request is shown to be generalizable with respect to any substrate sequence.

The Board held that it is in fact this very specific subject matter, namely catalytic DNA molecules having the "10-23" core region and exhibiting site-specific endonuclease activity specific for any (preselected) substrate nucleotide sequence other than the substrate nucleotide sequence SEQ ID NO: 135, which actually remain in claim 1 of the main request after the introduction of the disclaimer in this claim.³

Hence, in view of the above, the Board concluded that the criteria set out in decision G 2/10 are met by the disclaimer present in claim 1 of the main request and, accordingly, that this disclaimer fulfills the requirements of Article 123(2) EPC.

2. Case T1870/08

This case is interesting in that the competent Board raised the question whether and, if so, how EBA decision G2/10 which relates to (positively) disclosed

² Cf. T1068/07, points 6 to 8 of the reasoning.

³ Cf. T1068/07, points 9 and 10 of the reasoning.



disclaimers also applies to undisclosed disclaimers as dealt with in previous EBA decisions G1/03 and G2/03. The subject matter of the disputed patent relates to superconducting wires. Claim 1 according to the main request reads:

*A superconducting wire comprising:
a tubular sheath member (2); and an oxide superconductor (1) filled in
said sheath member,
said sheath member being formed of a material resistant in an oxidizing
atmosphere to oxidation at the temperature of heat treatment used to
form said superconducting wire,
said material being selected from Au, Ag or an alloy thereof and
**when said sheath is Ag or an alloy thereof, said oxide
superconductor is not of the K₂NiF₄ type.** (emphasis added)*

The Board initially noted that the combination of an oxide superconductor of the K₂NiF₄ type and a sheath made of Ag or an alloy thereof is not disclosed as such in the application as filed. The latter feature of claim 1 is therefore regarded to be an undisclosed disclaimer.

However, by means of this disclaimer the claimed subject matter was rendered novel over document D1 which represents prior art under Article 54(3) EPC, that is, a European patent application ("conflicting application") having an effective date that is earlier but a publication date that is later than the effective date of the disputed patent. According to EBA decisions G1/03 and G2/03, a undisclosed disclaimer is admissible *inter alia* in order to restore novelty by delimiting the claimed subject matter from prior art under Article 54(3) EPC provided that the disclaimer (i) does not remove more than is necessary to restore novelty and (ii) is not relevant for assessing inventive step or sufficiency of disclosure.

The Board considered the disclaimer included in claim 1 to comply with the criteria defined in decisions G1/03 and G2/03, and thus to be admissible.⁴

⁴ Cf. T1870/08, points 4.2 and 4.3 of the reasoning.



However, the opponent argued that the introduction of the disclaimer into claim 1 contravened Article 123(2) EPC in view of EBA decision G2/10.

Initially, the Board held that the present case relates to an undisclosed disclaimer while the case underlying decision G2/10 concerns a disclosed disclaimer. Therefore, G2/10 is, *prima facie*, not concerned with the same situation as in the present case, so it may be questioned whether that decision is applicable at all to the present case.

The Board went on with a detailed analysis of the reasoning of the EBA in decisions G1/03 and G2/03. In particular, it was noted that point 4.7 of this reasoning was evidently intended to mean that even if the formal criteria for the allowability of an undisclosed disclaimer (cf. headnote 2) are fulfilled an amendment involving such undisclosed disclaimer would always be admissible under Article 123(2) EPC. Accordingly, the subject matter remaining in the claim after the amendment – but not the undisclosed disclaimer itself – would need to be examined for its compatibility Article 123(2) EPC. The disclaimer does not form part of the remaining subject-matter, in the sense that its technical effects must simply be disregarded when the claim is compared with the original teaching in the application as filed.⁵

The Board considered it unproblematic to read the concepts 'subject matter remaining in the claim' and 'subject-matter disclosed in the application as filed' in the headnotes of decision G 2/10 as technical subject-matter, i.e. the features of the invention as taught. This also holds true for the concept 'disclaimed subject-matter'. If, on the other hand, decision G 2/10 had to be read as also applying to a claim which has been amended by means of an (admissible) undisclosed disclaimer, as apparently suggested by the EBA, then the meaning of 'subject-matter remaining in the claim after the introduction of the disclaimer' must inevitably change to legal subject-matter in certain instances, namely whenever the effects of the disclaimer are examined. That is, one must always keep in mind that the purely legal subject-matter of the disclaimer cannot by definition modify the original technical subject-matter.⁶

⁵ Cf. T1870/08, points 4.5.4 and 4.5.5 of the reasoning.

⁶ Cf. T1870/08, points 4.5.12 and 4.5.13 of the reasoning.



Furthermore, if the disclaimer was undisclosed, it would not find any support in the application as originally filed. Having anything undisclosed in a claim may not appear to comply with Article 123(2) EPC according to its usual interpretation. However, assuming that this provision only sets up a requirement for the technical subject-matter, while at the same time accepting that the disclaimer cannot modify the technical subject-matter, then it is not Article 123(2) EPC which is violated. Rather, claims containing (admissible) undisclosed disclaimers are exempted from complying with Rule 43(1) EPC, since the claim will contain features which might be technical *per se*, but they will not be those of the invention.⁷

The Board noted that the test as laid down in decision G2/10 should thus take place after an examination of the legal preconditions for admitting the use of undisclosed disclaimers according to G1/03 and after the insertion of the proposed disclaimer in the claim. Only at this stage, the examination of the 'subject-matter remaining in the claim' should be made. This procedure is not considered to be in any contradiction to the findings of G2/10: the subject-matter remaining in the claim 'after the introduction of the disclaimer' must be examined (see headnote 1a of G2/10), while the wording of the decision leaves it open whether the disclaimer *per se* must fulfill the requirements of Article 123(2) EPC or not. Put differently, the test of G2/10 can also be used for examining the remaining subject-matter with due regard to the fact that the disclaimer is an undisclosed one that, as such, does not add technical subject-matter as a matter of law.⁸

Applied to the present case, the Board noted that the application documents as originally filed disclose that the oxide superconductor may have a perovskite type crystal structure in the broad sense. This comprises structures which are not of the K₂NiF₄ type (i.e. the 'subject-matter remaining in the claim'), which was also known to the person skilled in the art of superconductor technology at the priority date. Furthermore, it is disclosed that the sheath member may contain a material selected from the group of: Ag, Au, Pt, Pd, and their alloys.

⁷ Cf. T1870/08, point 4.5.15 of the reasoning.

⁸ Cf. T1870/08, points 4.6.5 and 4.6.6 of the reasoning



Accordingly, the Board came to the conclusion that the amendment introducing the disclaimer into claim 1 of the main request is not contrary to the requirements of Article 123(2) EPC, and is allowable in the light of both G1/03 and G2/10.

3. Conclusions

When determining whether a disclaimer constitutes added subject matter and thus contravenes Article 123(2) EPC it is not only the particulars of the disclaimer *per se* that need to be examined. Instead, the overriding consideration is whether the "remaining" subject matter (i.e. after amendment) is also directly and unambiguously disclosed in the application as originally filed. Rather than simply endorsing or rejecting disclaimers, an assessment of the resulting subject matter is required in order to judge whether new subject matter is present.

As to (positively) disclosed disclaimers, applicants thus have to present convincing support in the original application documents for the subject matter that remains after introducing a disclaimer, rather than simply relying on the previously widely accepted argument "if it is disclosed, it can be disclaimed." As to undisclosed disclaimers, it remains to be seen whether there are loopholes in the approach proposed in decision T1870/08 and whether the conclusions drawn will be confirmed by other TBAs

In cases, where it is already conceivable when drafting an application that the disclaiming of one or more embodiments of a generic disclosure could, for instance, be required for delimiting the claimed subject matter or advantageous for arguing in favor of the involvement of an inventive step it appears advisable for applicants to include the "disclaimer embodiment" as such (i.e. in negative terms) in the original application documents in order to have an appropriate fallback position available, if applicable. Keeping in mind the very strict requirements that are applied at the EPO with respect to original disclosure such strategic forward planning might be pivotal for getting subject matter finally allowed.