

THE EPO RULES THAT DISCLAIMERS ARE (SOMETIMES) ALLOWABLE

The EPO has finally restored some sense to the issue of disclaimers, and entirely overruled the adverse Unilever decision (T323/97).

The decision of the Enlarged Board of Appeal (under numbers G01/03 and G02/03) is multi-faceted and deals with almost all of the important issues relating to disclaimers.

Allowability of Disclaimers

It was ruled that disclaimers that are not disclosed in an application as filed (“undisclosed disclaimers”) do not necessarily add subject matter in contravention of Article 123(2) EPC. Disclaimers may now be allowable when the necessary limitation cannot be expressed more simply in positive, originally disclosed features **and** the purpose of the disclaimer is:

- (a) to provide novelty over pre-filed but post-published European patent applications (i.e. a document that represents prior art under Article 54(3) and (4) EPC only); **or**
- (b) to provide novelty over a pre-published (Article 54(2) EPC) document which represents an “accidental” anticipation in that it is so unrelated and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; **or**
- (c) to disclaim subject matter which is excluded from patentability for non-technical reasons, e.g. subject matter that is a “non-invention” (Article 52(2) EPC), which is deemed incapable of industrial application (Article 52(4) EPC, which excludes from patentability methods of medical treatment), or the exploitation of which would be contrary to “ordre public” or morality (Article 53(a) EPC).

The reasoning behind the decision on this point is that, in all of the circumstances outlined at (a) to (c) above, the disclaimer does not make a technical contribution to the claim.

This restores the *status quo* that existed before the Unilever decision, and also provides some useful clarification on issues such as what kind of document represents an “accidental” anticipation. Moreover, the Enlarged Board explained that, where a claim overlaps with two prior art documents, a disclaimer removing all overlap is only allowable if circumstances (a) or (b) are met for *both* documents.

Effect on Entitlement to Priority

The Enlarged Board ruled that, in circumstances where disclaimers are allowable (i.e. where they do not make a technical contribution to the claim), then the insertion of a disclaimer has no effect on entitlement to priority.

Relationship to Enablement / Sufficiency

The ruling expressly states that, although it may be possible to remedy a lack of novelty through insertion of a disclaimer, it is not allowable to overcome an alleged lack of sufficiency in the same way. Specifically, a disclaimer may not be used to exclude non-working embodiments falling within a generic claim.

Remaining Questions

The Enlarged Board did not specifically answer the question of whether the scope of the disclaimer must be based squarely on the disclosures of the prior art. However, the decision does indicate that the disclaimer:

- (i) may not go beyond the disclosures of the prior art; and
- (ii) must render the claim novel over those disclosures.

This could be interpreted as meaning that, where a disclaimer is used, it must exclude accurately all disclosures of the relevant prior art, in as far as those disclosures represent reproducible technical teachings. However, this is not yet certain, and later decisions may clarify this point.

Practical Considerations

Certain implications of the Enlarged Board decision mean that extreme care must be taken when using disclaimers. This is because, even in circumstances where the EPO initially determine that a disclaimer is allowable, it may later be found that the disclaimer is not allowable because:

- (I) the claim in question is not entitled to the priority date initially afforded to it (thereby turning a post-published prior art document into a pre-published one);
- (II) new prior art emerges which challenges the initial assumption that an anticipation in another (pre-published) document was “accidental”; or

(III) it is realised that the scope of the disclaimer goes beyond the novelty-destroying disclosures of the prior art.

After grant, it would not be possible to remove a disclaimer found unallowable for any of these reasons (since this would broaden the scope of protection, which is not allowable after grant). The only option open to the patent proprietor in such a situation would be to narrow the positive part of the claim so as to render the disclaimer unnecessary.

For this reason, we recommend using disclaimers only sparingly, and ensuring that, where possible, important subject matter is covered by at least one claim that is entirely unaffected by disclaimers.

The decision can be viewed at the EPO's web site (http://legal.european-patent-office.org/dg3/updates/2004_04_19.htm) or we should be pleased to e-mail it to you in pdf format on request to our information officer, Karen Pegg (kpegg@eric-potter.com).

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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