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# Allowability of disclaimers

**Reinhardt Schuster and Alexander Bach of Bardehle Pagenberg review two important European Patent Office decisions on the allowability of disclaimers in patent claims**

In two decisions dated April 8, 2004, the Enlarged Board of Appeal of the European Patent Office, its highest decision making body, settled a number of longstanding questions regarding the allowability of so-called disclaimers in patent claims (G01/03 and G02/03[1]).

Disclaimers in patent claims can be defined as amendments to a claim resulting in the incorporation of a "negative" feature, typically excluding particular embodiments or areas from a general feature.

Illustrating the use of disclaimers, claim 1 in the case G01/03 (referring case: T 0507/99) read as follows:

> *"1. A heat processable, metallic appearing coated article comprising:*
> *(a)…*
> *(c) a protective layer comprising a… metal… 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;*
> *with the proviso that if the metal compound film is titanium nitride the protective layer is not chromium."* (Disclaimers underscored by the author)

In the past, disclaimers have been widely used, in particular in applications regarding the field of chemistry, as a means to delimit patent claims with respect to previously unknown state of the art, in order to establish novelty without unduly limiting the range of a claim.

However, the use of disclaimers raises the following legal issues and questions:

- Regarding the clarity and conciseness of claims (Art. 84 EPC), unlimited use of disclaimers may lead to a claim drafting which puts an unreasonable burden on the

public in that it would become increasingly difficult to find out what is protected and what is not protected.

- With regard to priority rights (Art. 87(1) EPC), the introduction of a disclaimer may be conceived as changing the identity of the invention within the meaning of Art. 87(1) EPC.
- With regard to the prohibitions of amending a European Patent of a European Patent Application in such a way that it contains subject matter which extends beyond the content of the application as filed, Art. 123(2) EPC, it may be questionable whether disclaimers should be allowed in patent claims when neither the disclaimer nor the excluded subject matter are disclosed in the original application.
- With regard to novelty (Art. 54 EPC), it may be questionable whether disclaimers are generally allowable or that other conditions have to be met, eg, that the disclosure is accidental. In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Art. 54(3) EPC or against a state of the art according to Art. 54(2) EPC?
- With regard to the assessment of inventive step (Art. 56(e) EPC) it may be conceivable that a disclaimer that is allowable per se must generally be disregarded in the assessment of inventive step (Art. 54 EPC).

## Diverging case law

The matter was referred to the Enlarged Board of Appeal by the prior instances, because they perceived a divergence between established case law and the decision T 323/97 (OJ EPO 2002, 476).

Established case law allowed disclaimers in patent claims, even if they had no basis in the application as filed, under certain circumstances[2]. This practice was called into question in decision T 323/97 which, citing the principles of legal certainty and consistency, held that the introduction of a negative feature into a claim resulting in the exclusion of certain embodiments is, regardless of the name “disclaimer”, none the less an amendment governed by Art. 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 decision

The Enlarged Board of Appeal held both referrals to be admissible. With regard to the allowability of disclaimers, it took the following stance:

1) An amendment to a claim by the introduction of a disclaimer may not be refused under Art. 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. This clearly did away with the restrictive stance taken by the Board of Appeal in decision T 323/97.
2) A disclaimer was considered allowable in order to restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC.
   Taking into account the purpose of Art. 54(3) EPC, which is to avoid double patenting, the purpose of a disclaimer excluding a conflicting application is merely to take account of the fact that different applicants are entitled to patents in respect

of different aspects of inventive subject-matter and not to change the given technical teaching. The disclaimer splits the invention as a whole in two parts: in respect of the identical part, it preserves the rights of the first applicant; as to rest, disclosed for the first time in the later application, it attributes the right to the second applicant. This approach restricts the effects of Art. 54(3) EPC to resolving the problem of double patenting.

Such a disclaimer, only excluding subject-matter for legal reasons, is required to give effect to Art. 54(3) EPC and has no bearing on the technical information in the application. It is, therefore, not in contradiction to Art. 123(3) EPC.

3) A disclaimer may be allowable in order to restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC.

An anticipation is defined as being accidental by the Enlarged Board of Appeal if it is *"so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention"*.

This should be ascertained without looking at the available further state of the art because a related document does not become an accidental anticipation merely because there are other disclosures which are even more closely related. In particular, the fact that a document is not considered to be the closest prior art is not sufficient to constitute an accidental anticipation.

Accidental anticipation mostly occurs in the fields of chemistry and biotechnology but is not restricted thereto. In particular, it can also occur in the field of so-called software patents, since the state of the art is hard to research.

A typical situation occurs in the field of chemistry, when the claimed invention concerns a large group of chemical compounds with certain properties which are advantageous for a specific use. One single compound falling within the group turns out to be known for a completely different use and, therefore, only properties irrelevant to the new use are known.

In such situations it is considered to be unfair if, in the absence of a basis in the application as filed for a limiting amendment excluding the known compound, that single compound may represent a bar to patenting the entire group. Quite often a use claim may be a fallback position. Use claims, however, are a more limited form of protection compared to product claims, and in the field of pharmaceuticals they may be excluded under Art. 52(4) EPC.

4) A disclaimer may be allowable in order to disclaim subject-matter which, under Art. 52 to 57 EPC, is excluded from patentability for non-technical reasons. Examples are methods for medical treatment under Art. 52(4) EPC and the exploitation of inventions which are contrary to the "ordre public" under Art. 53(a) EPC.

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

6) A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC and is therefore not allowed.

7) A claim containing a disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC.

## Practical consequences

The diverging jurisprudence of the different boards of appeal in the question of disclaimers had led to considerable uncertainty among potential applicants as to how they would, in the future, be allowed to draft their claims. This uncertainty has only partly been remedied by the two long

awaited decisions of the Enlarged Board of Appeal, since the Board did not follow requests by practitioners and their professional organisations to allow disclaimers to overcome objections related to Art. 54(2) EPC in a general way, i.e. without the requirement of overcoming an accidental anticipation in the prior art. Instead, applicants and the Examining Divisions will now have to deal with the question of what constitutes an accidental anticipation.

When drafting claims containing disclaimers in the future, applicants will have to make it clear in the specification that there is an undisclosed disclaimer and why it has been introduced. The disclaimer should be explicitly designated as such. No undisclosed positive features should be used defining the difference between the original claim and the anticipation. The excluded prior art should be indicated in the description in accordance with Rule 27(1)(b) EPC and the relation between the prior art and the disclaimer should be known (G01/03, p. 39).

On the whole the decision strikes a very reasonable balance between the interests of applicants and the principle of legal certainty. It should therefore be welcomed by practitioners.

## About the authors

Reinhardt Schuster and Alexander Bach are attorneys-at-law with Bardehle Pagenberg Dost Altenburg Geissler in Munich and Düsseldorf.

Mr Schuster's areas of practice are patent litigation, further matters of trademark, unfair competition and antitrust. He is representing international clients in large scale infringement suits before German courts and has taken part in numerous cases of multinational patent litigation.

Mr. Bach holds a degree in computer science. His areas of practice are patent prosecution, litigation, licensing, antitrust and IT-law.

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**Notes**

[1] Both to be published in the Official Journal of the EPO.
[2] Cf. eg, the review of the established case law in the referring decision T 0507/99 with further references and Case Law of the Boards of Appeal of the EPO, 4th ed. 2001, Sections I.D.6.15, II.B.1.2.1 and, in particular, III.A.1.6.3.

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