

News from Abroad: Enlarged Board of Appeal Decides Again on Disclaimers

Background



The invention protected by a patent is defined in the claims. Those claims must be new -- they must not cover anything previously published. The applicant can amend the claims during prosecution of a patent application to grant, particularly to avoid newly-discovered earlier publications, covered by the claims. In doing so, the applicant can change the claims so that they no longer cover subject matter that the original application taught as part of the invention.

One way to amend claims is to add a disclaimer. A disclaimer is a negative limitation. For example, if a claim relates to treating a broad class of disease, a disclaimer would exclude a specific disease within that broad class.

Applicants do not often use disclaimers because the European Patent Office (EPO) has strict rules that an applicant cannot add subject-matter to the application after it is filed. Unless the disclaimer is, unusually, in the application on filing, the circumstances which allow an applicant to introduce a disclaimer are rare.

The current conditions, under which "undisclosed" disclaimers are allowable, were set out by the Enlarged Board of Appeal (EBA), the highest appeal body at the EPO, in the decision (G1/03).

There is growing uncertainty as to what needs to be included in the original application to provide basis for such a disclaimer. If the description states that the invention excludes the specific feature you want to disclaim, then there is clearly basis for disclaiming this feature.

The grey area arises if the original description teaches that the invention includes the specific feature to be disclaimed. Is positive disclosure of the feature adequate basis for disclaiming it? In other words, does just the subject-matter of the disclaimer need to be disclosed, or must the application also teach that the feature is not part of the invention?

The EPO has referred this question to the EBA. This decision has now issued.

The Decision

The Board decided that the correct approach is not to decide whether the disclaimed subject-matter is directly and unambiguously derivable from the application. The correct approach is to look at what subject-matter *remains* in the amended claim and determine whether this remaining subject-matter is directly and unambiguously derivable from the original application.

Therefore when an applicant wants to disclaim subject matter that was originally disclosed as part of the invention, the fact that the disclaimed subject matter is disclosed is not important. Instead, the *usual*

added-subject matter test -- is it unambiguously disclosed? -- is applied to the subject matter of the amended claim.

Practice points arising from the decision

The decision does not state that positively disclosed disclaimers are *never* allowable. It therefore *may* be possible to disclaim a single embodiment originally described as part of the invention.

Unfortunately, whether this is allowed depends on what is actually taught by the application in each case. In our opinion, such a disclaimer will not be allowed in the great majority of cases.

The decision highlights the importance of carefully drafting the original application. It is very difficult, after filing, to add subject matter. It is vitally important that the original application contains as much subject matter as possible. That should include not only what the applicant already knows about the invention, but as much informed speculation as possible of variations that might be effective.

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