

## GERMANY



**Maiwald Patentanwalts  
GmbH  
Munich**

*Stefanie Parchmann*

## Uncertainty over disclaiming positively disclosed embodiments

The admissibility of disclaimers in European patents has been an ever-popular subject, and it appears that the next wave is about to start.

In a recent EPO Board of Appeal decision (T 1107/06), it was decided that a disclaimer does not infringe Article 123(2) EPC (that is, there is no new matter) if its disclaimed subject-matter was positively disclosed as an embodiment of the invention in the application as filed. The decision contradicts recent case law and returns to earlier standards.

The claim in question pertained to the use of botulinum toxin for modulating secretion and contained a disclaimer “wherein the secretion is not lacrimation”. A specific disclosure of the use of botulinum toxin in the treatment of lacrimation was present in the application as filed. However, this use was described in positive terms as part of the invention, not in negative terms as subject-matter to be excluded.

In earlier case law, it was widely accepted that a disclaimer could in principle be allowed when the subject-matter to be excluded was disclosed as an embodiment of the invention. This principle emerged from the very first decision allowing the introduction of a disclaimer into a claim (T 4/80).

However, a more restrictive approach has recently been taken by several Boards of Appeal. According to this approach disclaimers that exclude positively disclosed subject-matter are regarded as non-disclosed disclaimers and held to be unallowable, unless they fall under one of the exceptions laid down in decision G 1/03.

This restrictive attitude has now been refuted in T 1107/06, which followed the prior case law instead. According to the Board, the mere fact that an amended claim encompassed less than what was originally disclosed as the subject-matter of the invention did as such not justify an objection under Article 123(2) EPC. To hold otherwise was in sharp contrast to the

established case law which accepted deletions if they did not generate another invention.

Interestingly, the disclaimer in this case removed exactly the subject matter that would have prevented acknowledgment of inventive step. According to G 1/03, an undisclosed disclaimer which is relevant for the assessment of inventive step adds subject-matter contrary to Article 123(2) EPC. Hence, when following T 1107/06, a disclaimer excluding positively disclosed subject-matter might be privileged over a completely undisclosed disclaimer.

With this decision, the Board has not only renounced recent case law. It has also added to the already existing imponderabilities when drafting applications and especially disclaimers. It remains to be seen whether other Boards will follow T 1107/06 and whether a referral to the Enlarged Board of Appeal will be necessary to clarify the situation.