

According to T.1676/08, the principles set out in decision G.2/10 with regard to the requirements to be met in order for amendments by the introduction of disclaimers for disclosed subject-matter to be allowable under Art. 123(2) EPC also apply with regard to the requirements for **divisional applications** under Art. 76(1) EPC; they also apply to the examination under Art. 100(c) EPC.

As in G.1/03 (and G.2/03), the Enlarged Board in G.2/10 identified board decisions which should no longer be applied. Thus, it criticised the approach taken in T.1050/99 and T.1102/00.

#### c) Explanations in G 1/16

In the case law that followed these decisions of the Enlarged Board of Appeal there was no uniformity of approach regarding the application of G.2/10 to "undisclosed disclaimers" (see Case Law of the Boards of Appeal, 8<sup>th</sup> ed. 2016, II.E.1.5.2(b) and the summary in G.1/16, point 24 of the Reasons). This led to the referring decision T.437/14 of 17 October 2016 asking in particular whether the standard referred to in G.2/10 for the allowability of disclosed disclaimers under Art. 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, was also to be applied to claims containing undisclosed disclaimers.

In G.1/16 (OJ 2018, A70) the Enlarged Board considered that the choice of the proper test for assessing the allowability of any disclaimer is determined by the fundamental distinction, in terms of their legal nature, between disclosed disclaimers and undisclosed disclaimers. That distinction necessitates providing **for each of the two classes of disclaimer a single specific test** for assessing whether the introduction of a given disclaimer is in compliance with Art. 123(2) EPC. Therefore, for undisclosed disclaimers the proper test is whether the criteria of G.1/03 (OJ 2004, 413) are fulfilled, and for disclosed disclaimers the proper test is the gold standard disclosure test of G.2/10 (OJ 2012, 376).

The assessment of the allowability of a claim amendment by an undisclosed disclaimer is governed exclusively by the criteria laid down in G.1/03. No modifications are to be made to, nor any conditions added which go beyond, the criteria of G.1/03.

The Enlarged Board confirmed that an amendment by an undisclosed disclaimer may be allowable in the three situations mentioned in G.1/03 (point 2.1 of the Order), i.e. in order to (1) restore novelty by delimiting a claim against state of the art under Art. 54(3) EPC; (2) restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC; or (3) disclaim subject-matter which, under Art. 52 to 57 EPC, is excluded from patentability for non-technical reasons.