

h) Negative feature implicitly disclosed in original application – G 1/03 not applicable

In T 1525/15 the appellant's objection related to a negative feature (or disclaimer) of both independent claims ("free of a micro-embossing design"). The board observed that there was no verbatim disclosure of this feature in the original application. The feature was added during the grant proceedings to establish novelty over document D1, which was state of the art according to Art. 54(3) EPC. The board emphasised that such an amendment was allowable: (i) if the negative feature was implicitly disclosed as such in the original application; or (ii) if the disclaimer was undisclosed in the original application but complied with the requirements formulated in decision G 1/03 (OJ 2004, 413) of the Enlarged Board of Appeal. In the case in hand the board came to the conclusion that the negative feature was implicitly but nevertheless directly and unambiguously disclosed in the original application. As the negative feature was disclosed as such in the original application, it was not necessary to examine whether the conditions set out in decision G 1/03 (and confirmed in G 1/16, OJ 2018, A70) were fulfilled.

1.7.4 Decisions applying the criteria established by the Enlarged Board in G 2/10 – remaining subject-matter test

The board in T 1224/14 found that an amendment designed to exclude a specific value from a range described as particularly preferred in the application as filed did not meet the G 2/10 criteria for an allowable disclaimer.

In T 2130/11 the disclaimer in the third auxiliary request excluded a disclosed embodiment **from a generic class**. The board considered that the remaining subject-matter was still generic and could not be considered as a non-disclosed subgroup which had been singled out by means of the disclaimer, so that the remaining general teaching could not be seen as being modified by the disclaimer. Whether the invention worked for the claimed subject-matter and what problem was credibly solved by it were questions which were not relevant for assessing whether this subject-matter extended beyond the content of the application as filed. See however also T 1441/13 and T 1808/13 according to which it had to be established whether the subject-matter of the invention remaining in the claim was available at the filing date.

1.7.5 Applicability of the decisions of the Enlarged Board to cases already pending

The board in T 500/00 and T 740/98 ruled that the principle of good faith could not be invoked against the application of the principles concerning the allowability of disclaimers laid down in G 1/03 to pending cases (see also T 1045/09 and chapter III.A.6.1. "Case law deviating from or overruling the practice").

1.7.6 No analogy with G 1/03 where a disclaimer already in the application as filed is deleted

In T 2327/18 the respondent (patent proprietor) submitted that the disclaimer at issue had been included in the original application for legal reasons only (namely to establish novelty over an Art. 54(3) EPC document cited in relation to the parent application). The board