

In the interest of transparency of the patent, it should be clear from the specification that there was an undisclosed disclaimer and why it had been introduced. The excluded prior art should be indicated in the description in accordance with R. 27(1)(b) EPC 1973 (R. 42(1)(b) EPC) and the relation between the prior art and the disclaimer should be shown.

The following rulings on the clarity of claims including a disclaimer were handed down after the decisions in G 1/03 and G 2/03:

(i) Combination of features taken from different documents

In T 161/02 the board pointed out that the disclaimer combined features which arose from two different documents of prior art, the combination of these features resulting in a disclaimer that corresponded to neither the disclosure of the first nor that of the second document, and which did not make any technical sense. The board held that such a disclaimer rendered the claim unclear within the meaning of Art. 84 EPC 1973, as it did not allow the public to find out what was protected and what was not protected.

(ii) Disclaimer excluding treatment by surgery or therapy

To justify the exclusion expressed by the formulation "non-therapeutic use" at the beginning of the disputed claim, the appellant in T 67/02 had cited G 1/03 and G 2/03 (OJ 2004, 413 and 448), which had ruled that disclaimers were admissible for subject-matter not patentable under Art. 52 to 57 EPC 1973. However, the board found that in the present case it was not possible to identify a clear distinction between cosmetic use and therapeutic treatment. The board therefore took the view that the exclusion rendered the claimed subject-matter unclear.

In T 1695/07, claims 1 to 8 of the main request were found by the board to be directed to a method for treatment of the human body by surgery which is excepted from patentability under Art. 53(c) EPC. Claim 1 of auxiliary request 2 included the feature "wherein the process is not a method for treatment of the human or animal body by surgery". Concerning the admissibility of a disclaimer excluding subject-matter not eligible for patent protection, the board in this case first stressed with reference to G 1/03 (OJ 2004, 413) that the requirements of Art. 84 EPC are also applicable to claims containing disclaimers. A clear delimitation and distinction between excepted surgical applications and possibly allowable non-surgical applications of the claimed process requires that the two methods be distinct, i.e. **separable**, which means that they must be of a different nature and may be carried out in different ways. In the board's view, it could not be seen how the claimed process would work without the surgical steps involved.

In T 1487/09 the board observed that the uses excluded (namely, uses that "comprise or encompass an invasive step representing a substantial physical intervention on the body of a human or an animal which requires professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise") were not explicitly defined, but rather must be derived from a condition which was to be fulfilled. Whether this condition was fulfilled or not would