

applied for assessing the allowability of a disclaimer which was not disclosed in the application as filed:

A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC 1973;
- restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC 1973; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
- disclaim subject-matter which, under Art. 52 to 57 EPC 1973, is excluded from patentability for non-technical reasons.

In addition, a disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. On the other hand, a disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC 1973. And a claim containing a disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC 1973.

In G 1/03 (and G 2/03), the Enlarged Board, having regard to the law established by it in relation to disclaimers, expressly identified those board decisions which should no longer be applied. Thus, the Enlarged Board stated that the isolated decisions T 170/87 and T 313/86 were not to be followed, whilst also criticising T 323/97 in the light of the new law applicable.

b) Principles established in G 2/10 for disclosed disclaimers

The Enlarged Board in G 2/10 found that, subsequent to decision G 1/03 (and G 2/03), different opinions had been expressed in the jurisprudence of the boards of appeal on whether decision G 1/03 related to the disclaiming of embodiments which were **disclosed** as part of the invention in the application as filed or whether in that situation the jurisprudence as previously established following decision T 4/80 (OJ 1982, 149) continued to apply (see G 1/07, OJ 2011, 134, point 4.2.3 of the Reasons). In G 2/10 the Enlarged Board reformulated the question referred to it, stating that the question was construed as intending to ask whether an amendment to a claim by the introduction of a disclaimer infringes Art. 123(2) EPC if the subject-matter of the disclaimer was disclosed as an embodiment of the invention in the application as filed.

The Enlarged Board in G 2/10 stressed that decision G 1/03 did not support the conclusion drawn by T 1050/99 that G 1/03 also related to disclaimers for disclosed subject-matter. Further, in G 1/03 it was not decided that an undisclosed disclaimer would be always allowable under Art. 123(2) EPC. The wording of its answer, reading "a disclaimer may be allowable", indicated that with the criteria established in this answer the Enlarged Board in