

In T.477/09 board observed that two conditions relating to the wording of disclaimers had been established in points 2.2 (disclaimer should not remove more than is necessary) and 2.4 (clarity and conciseness) of the Order made in G.1/03 and that those two conditions were equally applicable. The patent proprietor therefore could **not** be considered to have any **room for manoeuvre** in wording the disclaimer and thereby defining its scope: to satisfy the conditions set out in G.1/03, a disclaimer could not remove more than was necessary to restore novelty.

In T.2130/11 the board held that the requirements of Art. 84 EPC must apply for a disclaimer as for any other feature of a patent claim. However, the condition that the disclaimer should not remove more than is necessary to restore novelty (G.1/03) should be applied while taking into consideration its purpose, namely that the "necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily" (G.1/03). In this respect situations could be foreseen, in which, while fulfilment of the condition taken in a strictly literal way would not be possible, a definition of the disclaimed subject-matter, which satisfied the requirements of Art. 84 EPC and fulfilled the purpose of the condition (i.e. to avoid an arbitrary reshaping of the claims), might be achievable. In other words, a disclaimer removing more than was strictly necessary to restore novelty would not contradict the spirit of G.1/03, if it were required to satisfy Art. 84 EPC and it did not lead to an arbitrary reshaping of the claims. In T.1399/13 the board concurred with the approach taken in T.2130/11.

f) Undisclosed disclaimer must not be related to the teaching of the invention

According to G.1/03 (OJ 2004, 413), a disclaimer which makes a technical contribution, in particular which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure, adds subject-matter contrary to Art. 123(2) EPC (point 2.3 of the Order; point 2.6 of the Reasons). In G.1/16 (OJ 2018, A70) the Enlarged Board endorsed the concept that the undisclosed disclaimer may not be related to the teaching of the invention and provided the following clarifications: Introducing any disclaimer into a claim necessarily changes the technical information. The question to be asked in this context is not whether an undisclosed disclaimer quantitatively reduces the original technical teaching – this is inevitably the case – but rather whether it **qualitatively changes** it in the sense that the applicant's or patent proprietor's **position with regard to other requirements for patentability** is improved. If that is the case, then the original technical teaching has been changed by the introduction of the disclaimer in an unallowable way.

In T.788/05 the undisclosed disclaimer was introduced by the appellant during the examination procedure with the purpose of establishing the novelty of the claimed subject-matter with respect to D1, which was then considered as a prior art document relevant under Art. 54(3) EPC 1973. In the case at issue, the relevant prior art was represented by documents D1 and D5. To be allowable the disclaimer had to fulfil the conditions in relation to both documents. As far as D1 was concerned, the disclaimer appeared to be appropriate. D5 represented the state of the art under Art. 54(2) EPC 1973. As D5 was not state of the art under Art. 54(3) and (4) EPC 1973 and was not an accidental disclosure, the disclaimer would only be allowable if it did not add subject-matter within the meaning of Art. 123(2) EPC 1973, i.e. if the disclaimer did not become relevant for the