

G 1/03 did indeed not intend to give a complete definition of when a disclaimer violates Art. 123(2) EPC.

The Enlarged Board stated that neither decision G 1/93 nor decision G 1/03 intended to modify the general definition of the requirements of Art. 123(2) EPC established in opinion G 3/89 (OJ 1993, 117) and decision G 11/91 (OJ 1993, 125), which definition has become the generally accepted or "gold standard" for assessing any amendment for its compliance with Art. 123(2) EPC. As to the criteria to be applied, the principle that any amendment to an application or a patent, and in particular to a claim, must fulfil the requirements of Art. 123(2) EPC also applies to an amendment limiting the claim by disclaiming disclosed subject-matter. Therefore, as is the case for any other amendment, the test for an amendment to a claim by disclaiming subject-matter disclosed as part of the invention in the application as filed must be that after the amendment the skilled person may not be presented with new technical information. Hence, disclaiming subject-matter disclosed in the application as filed can also infringe Art. 123(2) EPC if it results in **the skilled person being presented with technical information** which he would not derive directly and unambiguously, using common general knowledge, from the application as filed.

The point of reference for assessing an amended claim for its compatibility with Art. 123(2) EPC is the subject-matter which the claim contains after the amendment. In other words, it is the subject-matter remaining in the claim after the amendment. The test to be applied is whether the skilled person would, using common general knowledge, regard the **remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed**. This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined. The Enlarged Board found that no convincing reason had been advanced for not applying the principles developed in the context of Art. 123(2) EPC for the assessment of amendments to claims by the introduction of positive limiting features in the same manner to limitations of claims by disclaimers which disclaim subject-matter disclosed in the application as filed. The Enlarged Board stressed in its decision **the importance of applying a uniform concept of disclosure** (with reference to Art. 54, 87 and 123 EPC; see G 2/10, point 4.6 of the Reasons, citing G 1/03, OJ 2012, 436).

The Enlarged Board in G 2/10 (OJ 2012, 376) answered the two questions referred to it by interlocutory decision in T 1068/07 (OJ 2011, 256) as follows:

(1) An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Art. 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

(2) Determining whether or not that is the case requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.