

not an opportunity for the applicant to reshape his claims arbitrarily (G 1/03, point 3 of the Reasons). Therefore, the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. From that the board found that it could not be derived from the reasoning of G 1/03 that a patent proprietor was permitted a degree of **discretion or latitude** concerning the "border" within which the disclaimer should be drafted with respect to the subject-matter to be excised. On the contrary, the existence of any discretion regarding the extent of the disclaimer as compared to the subject-matter to be excluded would inevitably introduce a degree of arbitrariness in the drafting of the disclaimer. This would conflict with the express findings of G 1/03. See also T 2277/18 (with reference to T 8/07 und T 795/05).

In T 477/09 claim 1 was modified by addition of an undisclosed disclaimer with a view to restoring its novelty over document D1. The 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. In the case at hand, the board found that the scope of the disclaimer was greater than the actually novelty-destroying disclosure in D1.

In T 2130/11 the board dealt again with these two conditions and held that 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). 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 (for more details see chapter II.E.1.7.3.e) below).

In T 1354/15 the appellant had argued that, since the disclaimer at issue specified not merely the specific L-dsRNA sequence disclosed in D7, but also the C18 linker group between the two strands, it removed more than was necessary to restore novelty. In the board's view however, the RNA described in D7 was characterised also by the C18 linker. The fact that the application as filed did not contemplate such linkers did not result in the skilled person being presented with new technical information. Excluding the specific RNA having a C18 linker did not provide any technical contribution to the subject-matter disclosed in the application as filed.

(iv) Reference to a comparative example in prior art

In T 1843/09 (OJ 2013, 508) the opponent argued that the disclaimer contravened Art. 123(2) EPC because the wording of the disclaimer that the claimed film "is other than a film of Comparative Example 4 of EP-A 0546184" did not represent a technical feature. The board did not accept this argument. Although it was true that technical information could not directly be extracted from the wording of the disclaimer as such, it should be noted that the disclaimer did not merely cite a published patent document, but clearly referred to a specific disclosure in D15, namely a single film described in comparative