

example 4. Table 4 of D15 characterised this film unambiguously by a number of technical features. The skilled person was therefore able to determine simply by reading the comparative example in D15 which technical embodiment should be excluded from the scope of the claim.

(v) Disclaimed subject-matter not comprised by the claim

In T 1836/10 the examination division had based its refusal of the application on Art. 53(a) in conjunction with R. 28(c) EPC. The applicant attempted to disclaim the relevant subject-matter. The board considered that an applicant could not amend his claims at will, and that any disclaimer needed should not exclude any more than was necessary to disclaim subject-matter excluded from patentability for non-technical reasons. The same applied to a disclaimer which served to disclaim subject-matter that was not comprised by the claim in the first place (since the subsequent use of the stem cells had not been claimed as a method step).

c) Drafting of disclaimers – disclaimer shall not remove less than is necessary

In case T 440/04 the question was whether disclaiming example 1 of C63 was sufficient to restore novelty. Whereas on the one hand a disclaimer should not remove more than was necessary to restore novelty, it cannot, on the other hand, be considered to serve its intended purpose when it excises less than what is necessary to restore novelty. The disclosure in C63 of fibres having compositions and properties as required by the present claims 1 according to all requests was not limited to the fibres described in example 1 of C63. "Cutting out" the latter fibres was thus not sufficient to exclude from the said claims 1 all those fibres disclosed in C63 having a composition and the inherent properties according to said claims.

d) Drafting of disclaimers – delimitation against any potential prior art

In T 285/03 the board found that the interpretation offered by the appellant amounted to a disclaimer although it was not phrased in the usual form. However, that disclaimer was not based on a particular prior art disclosure, whether accidental or not, but tried to delimit the claim against any potential prior art disclosure, contrary to the principles set out in G 1/03.

e) Drafting of disclaimers – clarity

The Enlarged Board of Appeal stated in G 1/03 and G 2/03 (OJ 2004, 413 and 448) that the requirements of conciseness and clarity of Art. 84 EPC 1973 were also applicable to claims containing disclaimers. This meant that a disclaimer was not allowable if the necessary limitation could be expressed in simpler terms in positive, originally disclosed features in accordance with R. 29(1), first sentence EPC 1973 (R. 43(1) EPC). In addition, a plurality of disclaimers might lead to a claim drafting which put an unreasonable burden on the public to find out what was protected and what was not protected. A balance had to be struck between the interest of the applicant in obtaining adequate protection and the interest of the public in determining the scope of protection with reasonable effort.