

In addition, the undisclosed disclaimer must not be related to the teaching of the invention, as already held in G 1/03 (point 2.3 of the Order; point 2.6 of the Reasons). In endorsing this concept, the Enlarged Board provided the following explanations:

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. And as a consequence, the technical teaching based on the amended claim, i.e. on the remaining subject-matter without the disclaimer, can no longer be considered as belonging to the invention as presented in the application as originally filed.

For the sake of completeness, the Enlarged Board added that the prohibition of a qualitative change in the original teaching applies in an absolute way, i.e. not only with regard to the prior art which provides the basis for the undisclosed disclaimer, but also to the entire prior art relevant for the assessment of inventive step. In practical terms, this means that the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer, as proposed in T 710/92. In this way, any unallowable modification of the original technical teaching in the assessment of inventive step is avoided.

The Enlarged Board concluded that the introduction of an undisclosed disclaimer must fulfil one of the criteria laid down in point 2.1 of the Order of decision G 1/03, but may not provide a technical contribution to the claimed subject-matter of the application as filed; in other words, the identity of the invention as originally filed must remain unchanged by the subject-matter remaining in the claim after the introduction of the undisclosed disclaimer.

The Enlarged Board answered the questions referred to it as follows:

For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Art. 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the Order of decision G 1/03.

The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

1.7.3 Decisions applying the criteria established by the Enlarged Board in G 1/03 and G 1/16

a) Accidental anticipation

In G 1/16 (OJ 2018, A70, point 45 of the Reasons) the Enlarged Board held with reference to G 1/03 (OJ 2004, 413, point 2.1 of the Order and point 2.2 and sub-points of the