

assessment of inventive step. Going into details, the board concluded that the subject-matter of claim 1 of the main and the first auxiliary requests was not acceptable under Art. 123(2) EPC 1973 (see also T 761/08).

In T 660/14 claim 1 of auxiliary request 4 contained two additional features according to which the operating and control members of the claimed bicycle control device were pivotable about non-common offset axes and were not pivotable commonly about either of the offset axes. The board, applying the criterion of G 1/03 (OJ 2004, 413) as interpreted by G 1/16 (OJ 2018, A70), considered that the disclaimers provided a technical contribution to the subject-matter disclosed. Claims 7 and 8 as filed addressed the operating member and the control member being arranged to be pivotable about parallel and/or offset axes. As indicated in the description, this may be seen as providing ergonomic advantages. The board concluded from this that the disclaimers introduced a technical difference to the amended claim when compared to the content of the original application. The pivotable arrangement of the operating and control members about the axes was of a technical nature, not least through the disclosure of the ergonomic benefits; the board concluded the disclaiming of this arrangement would have to be as well. The board held that this finding was furthermore confirmed by considering whether merely a quantitative change to the original technical teaching had occurred or indeed whether a qualitative change had resulted from the introduction of the undisclosed disclaimers (G 1/16). By disclaiming both common offset axes and common pivoting about either of the offset axes, the ergonomic considerations identified in the application as filed had been modified, resulting in a **qualitative change** to the originally disclosed technical teaching in the sense that the proprietor's position with regard to inventive step would be changed. See also T 2000/14, in which the board also found that the disclaimer led to a qualitative change to the originally disclosed technical teaching.

In T 437/14 of 12 March 2019, taking into account the answers to the questions on undisclosed disclaimers which it had referred to the Enlarged Board in case G 1/16 (OJ 2018, A70), the board considered that there was no evidence that the limitation of the genus of compounds covered by the formula in claim 1, which resulted from the excision of the seven specific compounds defined in the disclaimer, became relevant for establishing inventive step or sufficiency of disclosure.

In T 1984/15 the board pointed out that under decision G 1/03 a disclaimer that would be allowable solely on the basis of a conflicting application could not render the invention novel or inventive over state of the art under Art. 54(2) EPC. Since the new disclaimer in this case had, as asserted by the patent proprietor itself, rendered the subject-matter of the claim inventive over the closest prior art D10 (a document as per Art. 54(2) EPC), precisely that was the scenario here. The disclaimer was therefore an unallowable amendment under Art. 123(2) EPC.

g) Positive features – G 1/03 not applicable

In T 2502/13 the applicant sought to apply G 1/03 to a positive feature in order to restore novelty over a document under Art. 54(3) EPC. The board held, however, that G 1/03 did not apply in this situation.