22 February 2017

Registrar of the Enlarged Board of Appeals
European Patent Office
D-80298
GERMANY

Dear Sirs,

Re: Amicus Curiae Brief on questions referred to the Enlarged Board of Appeal in case G1/16

We are writing to provide Intellectual Property Owners Association (IPO)'s view on the question referred to the Enlarged Board of Appeal (EBA) in G1/16. IPO is pleased to be able to provide its opinion on the questions referred and thanks the EBA for its invitation to file amicus briefs in this case.

Intellectual Property Owners Association is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, executive, law firm, or attorney members.

The members of the IPO Boards of Directors, which approved the filing of this brief, are listed in the appendix of this letter. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

Legal Summary and Background

Following opposition and appeal proceedings relating to European Patent 1 933 395, the Technical Board of Appeal 3.3.09 of the EPO in its decision T 437/14 has decided that it is necessary to seek guidance from the EBA, because the patentees had introduced disclaimers in their main request, the content of these disclaimers not being disclosed in the application as such.

This Technical Board of Appeal now saw a discrepancy between two earlier decisions of the EBA, namely G1/03[1] and G2/10 and this gave reason for the referral, which has been designated G1/16, asking (summarized) whether G1/03 is still valid.

However, summarized, it is IPO's position that this discrepancy between G1/03 and G2/10 does not exist. Rather, a discrepancy has only been created by inconsistent applications of this case law by the different Technical Boards. Furthermore, an abandonment of G1/03 would,

[1] This decision issued together with the identical decision G2/03, but for sake of brevity it will only be referred to as G1/03, following the wording of the questions (cf. question 2).

without any proper reason, unduly limit the legitimate possibilities for applicants and patentees before the European Patent Office, especially in the fields of Chemistry, Pharma, and Biotech, where these disclaimers play an important role.

Summary of answers to questions:

IPO believes that the questions referred to the EBA should be answered as follows:

> **Question 1:** ***Is the standard referred to in G 2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?***

Answer 1: No.

The reason is that G1/03 and G2/10 refer to different scenarios, are independent from each other and thus may coexist. This is already indicated in G2/10, 3.5:

> *Point 2.5 of the Reasons of decision G 1/03 does not support the conclusion drawn from that passage by the technical board in decision T 1050/99 of 2 January 2005, points 6. and 7.(d) of the Reasons**, that G 1/03 also relates to disclaimers for disclosed subject-matter**. In point 2.5 of the Reasons of decision G 1/03 the Enlarged Board generally addresses the question as to whether, if a claim comprises non-working embodiments, such embodiments may be disclaimed. **It is nowhere mentioned that**, although the object of the said decision was disclaimers for subject-matter which was not disclosed in the application as filed, **the discussion in point 2.5 of the Reasons relates to the situation in which the non-working embodiments are disclosed in the application as filed**. The fact that the two decisions cited by the Enlarged Board in this context, i.e. T 170/87 (OJ EPO 1989, 441, point 8.4 of the Reasons) and T 313/86 of 12 January 1988, referred to in decision T 170/87, addressed the question of disclaimers in the absence of disclosure of the subject-matter to be excluded in the application as filed, also points away from the interpretation of that passage in the sense advocated in decision T 1050/99. [Highlights by IPO]*

We note that the EBA in its decision G2/10 did mention that the criteria outlined in G1/03 might not be exclusive and that there might be additional requirements for an undisclosed disclaimer to be allowed, c.f. 4.7. of the decision:

> *[The Enlarged Board] does not interpret decision G 1/03 to have intended, in its answer 2, to exhaustively determine the conditions under which, if fulfilled, an amendment by introduction of an undisclosed disclaimer was to be regarded as allowable under Article 123(2) EPC under all circumstances. As has already been set out in point 4.4.2 above, the gist of the questions referred to the*

> *Enlarged Board in cases G 1/03 and G 2/03, to which the Enlarged Board had to give an answer, was to establish whether and, if so, under which circumstances undisclosed disclaimers could be considered allowable at all, as a matter of principle, despite the absence of a basis in the application as filed. It is this question and no more the Enlarged Board has answered in*
>
> *answer 2. The wording the Enlarged Board chose in the starting line of answer 2, reading "a disclaimer may be allowable", indicates that with the criteria set up in answer 2 the Enlarged Board did indeed not intend to give a complete definition of when an undisclosed disclaimer violates Article 123(2) EPC and when it does not.*

However, this *obiter dictum* was in reaction to a submission of the President of the EPO in this procedure.

The interpretation by T 437/14 - which gave rise to G1/16 - that from G2/10 it would implicitly follow that the criteria developed in G2/10 for disclosed disclaimers also apply to undisclosed disclaimers, is too broad. Instead, as pointed out correctly by the EBA itself in G2/10, these are two different scenarios.

IPO notes that indirectly this view is backed by the just issued G1/15. In 6.2. of the reasons of the G1/15 the EBA has noted that the decisions G2/98, G1/03 and G2/10 so as to "consolidate the case law in order to create a consistent system", which means that the G1/03 and G2/10 are not in discrepancy to each other, rather they were issued to complement each other.

Therefore, the standard referred to in G2/10 does not apply to claims containing undisclosed disclaimers.

> **Question 2:** ***If the answer to the first question is yes, is G 1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?***

Answer 2: No answer needed because the answer to Question 1 is no.

> **Question 3:** ***If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in answer 2.1 of G 1/03 apply in addition to the standard referred to in G 2/10, may this standard be modified in view of these exceptions?***

Answer 3: No answer needed.

Because Question 3 relates to Question 2, which has become moot because the answer to Question 1 is yes, formally this Question 3 is moot, too.

However, IPO notes that it believes that the standard, sometimes referred to also as the "gold standard" (cf. T1363/12), does not need any modification, at least because – as discussed above – G1/03 and G2/10 are independent from each other.

More importantly, the standard mentioned in G2/10 was set much earlier than G1/03, namely it was established in G2/98, where the EBA decided that priority of a previous application can be validly claimed only if "the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole" (headnote of G2/98, cf. also 9. of the decision), a concept which was also transposed to amendments according to Art. 123 EPC.

Therefore, when issuing G1/03 nearly three years after the G2/98 decision, the EBA deliberately deviated from this standard to allow – for very restricted and well-identified situations – the inclusion of undisclosed disclaimers. However, would the EBA have considered it necessary to alter or set aside the standard of G2/98 in general, it could have easily done so in G1/03. Because this was not done, it necessarily follows that there is no need to do it now. Accordingly, the standard referred to in G2/10 does not need any modification.

IPO respectfully thanks the Enlarged Board of Appeal for the possibility to provide these comments for consideration.

Yours sincerely,

Kevin H. Rhodes
President

APPENDIX[1]

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[1]IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

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