

GROSSE BESCHWERDEKAMMER

Mitteilung der Großen Beschwerdekammer zu den Verfahren G 1/03 und G 2/03

In der Sache T 0507/99 (92116446.3) hat die Technische Beschwerdekammer 3.3.5 und in der Sache T 0451/99 (86902998.3) hat die Technische Beschwerdekammer 3.3.4 der Großen Beschwerdekammer Fragen zur Zulässigkeit von *Disclaimern* vorgelegt. Die Verfahren werden unter G 1/03 und G 2/03 geführt und sind miteinander verbunden.

Im Fall G 1/03 (T 0507/99) lauten die Vorlagefragen:

1. Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?

2. If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?

(a) In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?

(b) Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?

(c) Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?

(d) Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental, or

(e) is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the

ENLARGED BOARD OF APPEAL

Communication from the Enlarged Board of Appeal concerning cases G 1/03 and G 2/03

In decision T 0507/99 (92116446.3), Technical Board of Appeal 3.3.5 and in T 0451/99 (86902998.3), Technical Board of Appeal 3.3.4 referred questions relating to the allowability of disclaimers to the Enlarged Board of Appeal. The cases are being handled as case numbers G 1/03 and G 2/03 and are consolidated.

In case G 1/03 (T 0507/99) the questions referred are:

1. Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?

2. If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?

(a) In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?

(b) Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?

(c) Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?

(d) Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental, or

(e) is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the

GRANDE CHAMBRE DE RECOURS

Communication de la Grande Chambre de recours concernant la procédure G 1/03, G 2/03

Dans l'affaire T 0507/99 (92116446.3), la Chambre de recours technique 3.3.5 et dans l'affaire T 0451/99 (86902998.3) la Chambre de recours technique 3.3.4 ont soumis à la Grande Chambre de recours des questions sur l'admissibilité des *"disclaimers"*. Les affaires sont jointes et enrôlées sous le n° de référence G 1/03 et G 2/03.

Dans l'affaire G 1/03 (T 0507/99) les questions de la saisine sont les suivantes :

1. Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?

2. If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?

(a) In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?

(b) Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?

(c) Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?

(d) Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental, or

(e) is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the

presence of an inventive step has then to be carried out as if the disclaimer did not exist?

Im Fall G 2/03 (T 0451/99) lauten die Vorlagefragen:

Is the introduction into a claim of a disclaimer not supported by the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?

(Die Übersetzung der Vorlagefragen in beiden Fällen in die deutsche Sprache wird voraussichtlich im ABI. EPA Nr. 5/03 veröffentlicht werden)

Der Text der Vorlageentscheidungen in der englischen Verfahrenssprache kann von der Webseite des Europäischen Patentamts www.epo.org unter *New Boards of Appeal decisions – List of Cases of the Enlarged Board of Appeal – List of pending cases...* abgerufen werden. Die Veröffentlichung zusammen mit den vollständigen Übersetzungen in die beiden anderen Amtssprachen wird voraussichtlich im ABI. EPA Nr. 6/03 erfolgen. Es wird gebeten, bei Akteneinsicht von der Möglichkeit über Internet www.epoline.org Gebrauch zu machen.

Die Große Beschwerdekammer wird sich in der folgenden Besetzung mit den Vorlagen befassen: P. Messerli (Vorsitzender), R. Teschemacher, C. Andries, G. Davies, B. Jestaedt, A. Nuss, J.-C. Saisset.

Es ist damit zu rechnen, daß Dritte von der Gelegenheit Gebrauch machen wollen, schriftliche Stellungnahmen nach Artikel 11b der Verfahrensordnung der Grossen Beschwerdekammer (ABI. EPA 1994, 443) einzureichen. Damit solche Stellungnahmen in geeigneter Form berücksichtigt werden können, ohne daß dadurch das Verfahren mehr als notwendig verzögert wird, sollten sie **bis Ende Juli 2003** unter Nennung der Aktenzeichen G 1/03 und G 2/03 eingereicht werden.

presence of an inventive step has then to be carried out as if the disclaimer did not exist?

In case G 2/03 (T 0451/99) the questions referred are:

Is the introduction into a claim of a disclaimer not supported by the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?

The text of the referred decisions is available on the Website of the European Patent Office www.epo.org under *New Boards of Appeal decisions – List of Cases of the Enlarged Board of Appeal – List of pending cases...* . Publication of the decisions together with the translations into the two other official languages is expected to appear in OJ EPO No. 6/03. For file inspection, please make use of the EPO internet facility: www.epoline.org.

The Enlarged Board of Appeal considering the referrals will be composed as follows: P. Messerli (Chairman), R. Teschemacher, C. Andries, G. Davies, B. Jestaedt, A. Nuss, J.-C. Saisset.

It is expected that third parties will wish to use the opportunity to file written statements in accordance with Article 11b of the Rules of Procedure of the Enlarged Board of Appeal (OJ EPO 1994, 443). To ensure that any such statements can be given due consideration without holding up the proceedings more than necessary, they should be filed **by the end of July 2003**, quoting case numbers G 1/03 and G 2/03.

presence of an inventive step has then to be carried out as if the disclaimer did not exist?

Dans l'affaire G 2/03 (T 0451/99) les questions de la saisine sont les suivantes :

Is the introduction into a claim of a disclaimer not supported by the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC?

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer?

(La publication de la traduction en français des questions de la saisine pour les deux affaires est prévue au JO OEB n° 5/03)

Le texte des décisions de saisine dont la langue de procédure est l'anglais, peut être consulté sur le site internet de l'OEB sous www.epo.org *New Boards of Appeal decisions – List of cases of the Enlarged Board of Appeal – List of pending cases...* . La publication des décisions ainsi que les traductions complètes dans les deux autres langues officielles est prévue dans le JO OEB n° 6/03. Pour l'inspection publique, il convient de faire usage des fonctions prévues dans Internet sous www.epoline.org.

La Grande Chambre de recours qui examinera les questions de droit soumise sera composée de la façon suivante : P. Messerli (Président), R. Teschemacher, C. Andries, G. Davies, B. Jestaedt, A. Nuss, J.-C. Saisset.

Il est probable qu'à cette occasion des tiers voudront user de la possibilité de présenter des observations écrites conformément à l'article 11b du Règlement de procédure de la Grande Chambre de recours (JO OEB 1994, p. 443). Afin que ces observations puissent être dûment prises en compte sans retarder inutilement la procédure, elles devront être présentées **avant la fin juillet 2003**, sous le n° de référence G 1/03, G 2/03.