



Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

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1st March, 2017

Amicus curiae brief of epi concerning case G 1/16

Dear Sirs,

Please find enclosed, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, an amicus curiae brief submitted by the European Patent Practice Committee of the Institute of Professional Representatives before the European Patent Office (**epi**) with regard to case G 1/16.

Yours sincerely,

A handwritten signature in blue ink, consisting of several loops and a long horizontal stroke extending to the right.

Antonius Tangena
President

Encl.: Amicus curiae brief of **epi** concerning case G 1/16

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Amicus curiae brief of **epi** concerning case G 1/16

Introduction

epi appreciates the opportunity to comment on the referral to the Enlarged Board of Appeal (EBoA) in the above indicated case in the present amicus curiae brief.

Before considering the details of the issue at hand, namely “undisclosed disclaimers”, **epi** would like to take the opportunity to briefly comment on the situation with regard to the assessment of Article 123(2) EPC in the EPO. **epi** notes that an unjustified restrictive and formalistic application of Article 123(2) EPC can drastically limit applicants’ options to amend European patent applications after filing so as to, for example, delimit the claimed subject-matter against prior art that is revealed during search, examination or opposition proceedings and thereby react to objections raised by the EPO. Fear that an application may be subject to an unjustified restrictive application of Article 123(2) EPC has, in the opinion of **epi**, also negatively impacted the way that some patent applications are drafted, thereby substantially raising costs for obtaining patent protection, in particular in the chemical and biotechnological arts.

It appears that when such an unjustified restrictive application of Article 123(2) EPC is used, it is based on the view that, when considering Article 123(2) EPC, the skilled person is an academic linguistic expert who takes a very literal view of the content of an application. Even though T190/99, which is frequently cited and is specifically referred to in Section 2.3.3 of the Case Law Book¹, indicates that the reader of an application must try to make technical sense of a disclosure, it still seems to be the case that, when such a restrictive application of Article 123(2) EPC is used, no account is taken of the technical knowledge of the skilled person reading the application. See also **T2619/11** which, as the Case Law Book says on page 403, indicates that:

The application was directed to a technical audience rather than to a philologist or logician ...

A restrictive application of Article 123(2) EPC is very different from the attitude taken by the EPO when considering other aspects of the EPC, such as Articles 83 and 56, where it is well-accepted in

¹ Case Law of the Boards of Appeal of the European Patent Office, 8th Edition 2016 – English language version

general that a person skilled in the art brings with him his common general knowledge when reading any document. This is made clear in Section 8.3 of the Case Law Book.

epi considers that the attitude taken under Articles 83 and 56 EPC is consistent with the view which should, and in many cases is, adopted when considering Article 123(2) EPC. If this attitude is taken, then it is accepted that the skilled person is able to apply his common general knowledge to determine the meaning behind the particular words used and is not limited to considering only the exact words used.

It is noted that **G2/10** appears to follow this approach as, in point 1a of the Order, it is stated that:

An amendment ... infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed (emphasis added).

It follows from this that, if the subject-matter is either explicitly or implicitly disclosed to the skilled person using common general knowledge, there is no infringement of Article 123(2) EPC.

The perceived collision between the earlier decisions of the EBoA, **G1/03**² and **G2/10**, which lies at the heart of the present referral, has made it rather difficult for applicants to use “undisclosed disclaimers” to react to developments during examination or opposition, for example, by limiting the claimed subject-matter against a prior right under Article 54(3) EPC. For reasons given further below, this negatively impacts in particular applicants in the chemical and biotechnological arts.

epi believes that the EBoA now has the chance to bring legal certainty with regard to the use of “undisclosed disclaimers”. In doing so, the EBoA will provide applicants again with the required means to identify and define their inventions in a reasonable manner during examination to obtain protection for their contribution to the art.

Background

Claims define the invention for which protection is sought in terms of technical features. Typically, these technical features are “positive” technical features that define elements of the claimed invention. The claimed invention may, however, also be limited in terms of “negative” features that

² For the purposes of this amicus brief, **epi** refers only to **G1/03**, even though an essentially identical decision was issued at the same time by the EBoA in case **G2/03**

describe what features the claimed invention does not have. These negative features are typically called “disclaimers” (**G1/03**, point 2 of the Reasons).

Typically, where subject-matter has been claimed in terms of broad generic features, “undisclosed disclaimers” are used to exclude specific embodiments which have not been disclosed in an individualized manner in the application as filed but which are, for instance, known from the prior art and which fall within the scope of the broad generic claims. In this way, these embodiments can be carved out very specifically from the claimed invention. Often, it is not possible to make such a specific amendment by the addition of positive technical features explicitly disclosed in the application as filed because the applicant was not aware of the prior art which gives rise to the novelty objection.

“Undisclosed disclaimers” are of particular importance in the chemical and biotechnological arts because otherwise, in many cases, no reasonable scope of protection can be obtained and competitors can easily work around the claimed invention. It is common practice in these technological areas to define the invention for which protection is sought in the form of so-called Markush type claims (Markush groupings), a type of claim that is rarely used in other technical fields. The issue with this type of claim is that individual compounds/molecules that fall within the Markush grouping are often disclosed in completely unrelated prior art documents or documents under Article 54(3) EPC. In many of these cases, there is no explicit individualized disclosure of these anticipating compounds/molecules in the application as filed. (Markush groupings may encompass thousands or millions of compounds and it simply would not be feasible to list them all individually in the application.) The only valid option to delimit the claimed invention from the conflicting prior art is using such an “undisclosed disclaimer”. If this option were not available, applicants would often not be able to delimit the claimed invention from the prior art at all or only at the cost of drastically cutting down the scope of protection, even though only one or a few compounds that fall within the scope of the claims are disclosed in the prior art.

Article 123(2) EPC

epi notes that it has been established practice in the EPO, whether before Examining Divisions, Opposition Divisions or Appeal Boards, to require applicants or proprietors to insert into the description acknowledgements of the prior art referred to during prosecution. This has always been regarded as being in conformity with Article 123(2) EPC and **epi** agrees that this is the case. It has

also been established practice that applicants or proprietors are allowed to add to a claim a disclaimer based on Article 54(3) EPC prior art or an accidental anticipation without infringing the provisions of Article 123(2) EPC and **epi** agrees that this is the case. **epi** is of the opinion that the case law of the EBoA in connection with Article 123(2) is consistent and shows that the established practice is in accordance with Article 123(2) EPC. In order to show this, **epi** considers below the relevant case law of the EBoA.

G3/89

epi considers that any discussion of Article 123(2) EPC must start with a discussion of **G3/89** and **G11/91**³. The relevant part from both **G3/89** and **G11/91** reads as follows:

1. The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. Such a correction is of a strictly declaratory nature and thus does not infringe the prohibition of extension under Article 123(2) EPC.

This has been referred to latterly as the “gold” standard and **epi** considers that this is the only over-riding standard which should be applied for deciding whether any amendment, be it by way of disclaimer or otherwise, meets the requirements of Article 123(2) EPC.

The quoted passage from **G3/89** is clearly a very broad statement of the requirements of Article 123(2) EPC and it is therefore not surprising that further guidance as to its application in different circumstances has appeared in decisions of the EBoA.

G1/93

In particular, **G1/93** gave some very helpful guidance as to the purpose of Article 123(2) EPC and **epi** is of the opinion that the EBoA has correctly defined the purpose of Article 123(2) EPC in the extracts from the Reasons for the decision in **G1/93** as set out below:

7. The patentee has also referred to the standing practice of allowing disclaimers in order to limit the protection conferred in view of prior art made known to applicants during examination, and submitted that it would be in line with this practice to allow a clearly limiting

³ Since G3/89 and G11/91 have the same relevance, for convenience, only G3/89 is referred to from now on.

feature of the kind under consideration in the present case to remain in a claim without invalidating the patent. A similar argument was brought forward by the Board of Appeal in case T 231/89, referred to above.

8. Both parties have referred to and commented comprehensively upon the purposes and functions of Article 123(2) and (3) EPC within the system of European patent law. It seems to the Enlarged Board to be common ground that the main purpose of these provisions is to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other, as reflected also in the Protocol on the interpretation of Article 69 EPC. The problem, however, is of course what constitutes such a fair balance in the circumstances of an individual case.

9. With regard to Article 123(2) EPC, the underlying idea is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. Article 123(3) EPC is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed (emphasis added).

10. ... if, on the other hand, the claims of the patent as granted are narrower than those of the application as published, third parties are benefiting from this as from the outset.

12. However, the point of law referred to the Enlarged Board in the present case does not concern the situation referred to above but the special case that an undisclosed technical feature, limiting the scope of protection of the claims of the patent as granted in comparison with the application as filed and published, has been added during examination. From the point of view of legal security for third parties, obviously this case differs fundamentally from the above situation in that third parties, having relied on the application as filed and published, are not being faced with a granted patent with a wider scope of protection than could be foreseen but with a patent conferring less protection and thus interfering to a lesser extent with their activities.

15. ... It remains, however, to be considered whether a limiting feature necessarily has always to be regarded as such subject-matter. This question must be answered in the light of the overall purpose of Article 123(2) and (3) EPC to create a fair balance of interests ...

16. Whether or not the adding of an undisclosed feature limiting the scope of protection conferred by the patent as granted would be contrary to the purpose of Article 123(2) EPC to prevent an applicant from getting an unwarranted advantage by obtaining patent protection for something he had not properly disclosed and maybe not even invented on the date of filing of the application, depends on the circumstances. If such added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to the patentee contrary to the above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter in the sense of that provision. A typical example of this seems to be the case, where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom. If, on the other hand, the feature in question merely

excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such feature cannot reasonably be considered to give any unwarranted advantage to the applicant. Nor does it adversely effect (sic) the interests of third parties (cf. paragraph 12 above). In the view of the Enlarged Board, such feature is, on a proper interpretation of Article 123(2) EPC, therefore not to be considered as subject-matter extending beyond the content of the application as filed in the sense of that provision. It follows that a patent containing such a feature in the claims can be maintained without violating Article 123(2) EPC ...

17. Whether or not a limiting feature is to be considered as added subject-matter in the sense of Article 123(2) EPC, can, of course, only be decided on the basis of the facts of each individual case.

It is clear from Reason 7 above that "*an undisclosed technical feature, limiting the scope of protection of the claims*" covers a disclaimer.

Thus, **epi** considers that **G1/93** concluded that, if a disclaimer does not provide the applicant or proprietor with an unwarranted advantage, in that it does not provide a technical contribution to the subject-matter of the claimed invention, it does not infringe Article 123(2).

Even though in decision **G1/93** the EBoA was concerned with the issue of the inescapable trap, the above passages and comments were clearly meant to be of a general nature and **epi** does not see any reason why this interpretation of the purpose of Article 123(2) EPC should be limited to the particular situation of the inescapable trap. (It has been argued that point 4.3 of the reasons in **G2/10** suggests that the EBoA considered that this interpretation of Article 123(2) EPC is somehow limited to the inescapable trap situation. **epi** does not agree with this argument.) Thus, the main purpose of Article 123(2) EPC is to prevent the applicant or proprietor from obtaining an unwarranted advantage whereby third parties are surprised by amended claims that are directed to subject-matter which could not have been anticipated from the application as filed, for instance by providing a different scope of protection (an *aliud*) or potentially a wider scope of protection than initially disclosed, explicitly or implicitly, by the application as filed.

Clearly, the addition of a disclaimer which merely limits the claims by excluding certain parts of the invention that was originally claimed, thereby reducing the scope of protection, cannot interfere with the interests and activities of concerned third parties. Thus, already from the purpose of Article 123(2) EPC, it is evident that the use of disclaimers should in principle be allowable under Article 123(2) EPC.

G1/03

epi considers that it is also necessary to look at the content of EBoA decision in **G1/03**. Answer 1 in **G1/03** reads as follows:

An amendment to a claim by the introduction of a disclaimer may not be refused 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 (sic) basis in the application as filed (emphasis added).

Early in its reasoning (see the first paragraph in Section 2 of the Reasons), the EBoA in **G1/03** stated that it would not use the term “unsupported disclaimer” in view of the use of the term “support” in Article 84 EPC, where it has an established meaning including use of implicit disclosure to support a claim. The EBoA wished to avoid using this established meaning and so used “basis” instead. In light of this, it can be seen that **G1/03** also considers that disclaimers can be based on wording which is not explicitly present in the application as filed, which is the same as was decided in **G2/10** (see below), and then goes on to explain how such disclaimers can be allowable even if there is no explicit disclosure on which they can be based. Thus, **G1/03** is also consistent with the **G3/89** “gold” standard and merely explains how to apply the **G3/89** “gold” standard in certain circumstances.

Thus, answer 2.1 given by the EBoA in **G1/03** indicates that additional criteria have to be taken into account for assessing the allowability of a disclaimer which uses wording which is not explicitly present in the application as filed in the specific circumstances to which the answers are relevant, as follows:

[a] disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state-of-the-art under Article 54(3) and (4) EPC;*
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; [...]; and*
- disclaim subject-matter which, under Article 52 to 57 EPC, is excluded from patentability for non-technical reasons (emphasis added).*

This does not detract from the fact that, even in these specific circumstances, the **G3/89** “gold” standard must apply and it does not detract from the fact that, in other circumstances, such as those in **G2/10**, other criteria may be used to assess the allowability of a disclaimer according to the **G3/89** “gold” standard.

G2/10

The first question in the present referral refers to **G2/10**. Further guidance on the application of the **G3/89** “gold” standard is provided in **G2/10**.

The question which was referred to the EBoA in **G2/10** was:

Does a disclaimer infringe Article 123 (2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?

Thus, the case which gave rise to the referral in **G2/10** revolved around whether a disclaimer based on words explicitly recited in the application as filed is allowable under Article 123(2) EPC. It is assumed that it is this sort of disclaimer which is termed a “disclosed disclaimer” in the first question in the present referral. However, the answers in **G2/10** do not refer to “disclosed disclaimers” as such. Answer 1a in **G2/10** is as follows:

An amendment to a claim by the introduction of a disclaimer disclaiming from its subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claims after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

The first question in the present referral refers to whether the subject-matter remaining after introduction of the disclaimer is explicitly or implicitly disclosed in the application as filed. This wording seems to be based on the wording of the second half of answer 1a in **G2/10**. However, the first question in this referral does not include all the wording of answer 1a of **G2/10** and, in particular, does not include the first part of the answer which requires a determination of the subject-matter disclosed in the application as filed as a first step.

epi considers that answer 1a in **G2/10** is not limited to (subject-matters remaining after introduction of) explicitly “disclosed disclaimers”. It may be that the case which gave rise to the referral in **G2/10** was concerned with a situation where wording explicitly used in the application as filed was used as the basis for a disclaimer. However, the answer given in **G2/10** is not limited to this situation. The first part of answer 1a in **G2/10** does refer to “disclosed disclaimers”: *An amendment to a claim by the introduction of a disclaimer disclaiming from its subject-matter disclosed in the application as filed*

...

There is no reference here to subject-matter explicitly disclosed in the application as filed. The fact that the first answer in **G2/10** is not limited only to disclaimers based on explicit wording in the application as filed is made clear by the second part of answer 1a, where reference is made to:

*... if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or **implicitly**, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed (emphasis added).*

In **G2/10**, the EBoA itself defined the scope of the referred question as pertaining to the definition of the criteria that have to be considered under Article 123(2) EPC when disclaiming explicitly disclosed subject-matter. However, the EBoA then made it clear that the opinion in **G2/10** was not limited to considering only that narrow question. As is said at the end of point 4.1 of the Reasons in **G2/10**:

It is clear, however, that when considering and deciding the referred question ... the Enlarged Board cannot in any way be confined to deciding only on these two opposed alternative interpretations adopted by the boards of appeal. On the contrary, even though the Enlarged Board will consider what has been said on the matter in prior decisions, it is the Enlarged Board's role to define of its own motion the criteria determining when disclaiming disclosed subject-matter must be considered to infringe Article 123(2) EPC. (emphasis added)

It will again be noted that the EBoA in **G2/10** did not refer to explicitly disclosed subject-matter but referred only to disclosed subject matter in general.

It will be seen that **G2/10** also considered **G1/93** and **G1/03** in Section 4.3 of the Reasons. At the bottom of page 29 of the English-language version of **G2/10**, it is stated that:

It can thus be stated that neither decision G1/93 nor decision G1/03 intended to modify the general definition of the requirements of Article 123(2) EPC established in opinion G3/89 and decision G11/91, which definition has become generally accepted, one could also say the "gold" standard, for assessing any amendment for its compliance with Article 123(2) EPC. Therefore, that definition also applies to the kind of cases underlying the present referral (emphasis added).

It can be seen from this that the EBoA in **G2/10** did not disagree with the **G3/89** "gold" standard. Rather, it is clear that the decision in **G2/10** merely applies the **G3/89** "gold" standard to the particular area of disclaimers. In fact, answer 1a in **G2/10** appears to be a re-statement of the **G3/89** "gold" standard in the context of disclaimers in general.

In point 7.6 of the Reasons in the referring decision, **T437/14**, it is suggested that "... *only one test* ..." should be applied, "... *namely the gold standard* ...". However, there then appears to be an argument that, for all amendments, including "undisclosed disclaimers", there should be a combined

application of the standards of **G1/03** and **G2/10** as well as the **G3/89** “gold” standard. This seems to imply that the referring BoA in this case saw a conflict between **G1/03** and **G2/10**. However, **epi** considers that there is no such conflict. In fact, **G2/10** specifically refers to **G1/93** and **G1/03** (see the quotation from **G2/10** above). The passage in **G1/93** "... where the limiting feature is creating an inventive selection ..." is reflected in **G2/10**, in particular in point 2.3 of the Reasons (page 18, first complete paragraph), where it is stated that:

The main problem of the compatibility of “disclosed disclaimers” with Article 123(2) EPC does not lie in one specific “embodiment” of an invention being disclaimed from a broad generic claim. Rather, it arises in those cases in which a whole area or subclass is disclaimed. It is cases of this kind that have given rise to doubts whether, after the introduction of such a broad disclaimer, the subject-matter remaining in the claim is still the same as that formerly claimed ...

epi agrees that all amendments, including disclaimers, should be assessed using the **G3/89** “gold” standard. However, **epi** considers that this is not in conflict with the answers given in **G1/93**, **G1/03** and **G2/10** and that there is no conflict between these three later decisions. Rather, **G1/93**, **G1/03** and **G2/10** should be seen as providing guidance as to how the **G3/89** “gold” standard should be applied in particular circumstances. There is no need to modify the **G3/89** “gold” standard.

BoA Case Law

The referring decision **T437/14** discusses multiple decisions that applied what it calls the standard of **G1/03** in addition to the **G3/89** “gold” standard for assessing the allowability of an “undisclosed disclaimer” and arrived at the conclusion that an “undisclosed disclaimer” is allowable under Article 123(2) EPC (**T2464/10**, **T1176/09** and **T1872/14**). All of these decisions have in common that they interpret the above-recited **G3/89** “gold” standard to mean that no new technical information or no new technical teaching should be derivable from the subject-matter remaining in the claim after the introduction of the “undisclosed disclaimer”. It therefore appears that these decisions also support the view that the over-riding standard for determining whether the requirements of Article 123(2) EPC are satisfied is the **G3/89** “gold” standard and that other guidance may be required in certain circumstances.

Question 1

Is the standard referred to in G2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would, using his 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 be applied to claims containing undisclosed disclaimers?

On the basis of the analysis of the EBoA case law given above, **epi** considers that the first question posed by the BoA in the present referral should be answered in the **negative**. The answer to the question should be that the over-riding requirement is that the **G3/89** “gold” standard should be applied and that the guidance provided in **G1/93**, **G1/03** and **G2/10** should be used in appropriate circumstances to assist in determining whether the **G3/89** “gold” standard has been applied correctly. **epi** considers that the most useful guidance is provided by **G1/93** where it sets out the purpose of Article 123(2) EPC, which is to prevent the applicant or proprietor from obtaining an unwarranted advantage.

Question 2

If the answer to the first question is yes, is G1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?

Although **epi** considers that the answer to Question 1 should be “no” and that Question 2 therefore does not require an answer, **epi** would make the following comments. **epi** considers that there is no need to set aside **G1/03**. As noted above, **epi** considers that **G1/03** provides useful guidance as to how the **G3/89** “gold” standard should be applied in particular circumstances and so should not be set aside.

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 G1/03 apply in addition to the gold standard, may this standard be modified in view of these exceptions?

Again, although **epi** considers that the answer to Question 1 should be “no” and that Question 3 therefore does not require an answer, **epi** would make the following comments. As is clear from the comments made above, there is no conflict between the **G3/89** “gold” standard and the other EBoA decisions mentioned above. It therefore follows that that standard does not need to be modified in light of **G1/03**. All that **G1/03** does is to provide guidance as to how, in particular circumstances, the **G3/89** “gold” standard is to be applied.

The **G3/89** “gold” standard, which **epi** considers is the over-riding test, begins with a determination of the content of the application as filed, as required by Article 123(2) EPC, and the content must be that which is disclosed both explicitly and implicitly to the skilled person using common general knowledge. Once the total content of the application as filed has been determined, it can then be determined whether any amendment adds subject-matter which is not within the content of the application as filed.

Provided Question 1 is answered in the negative, following the above-referenced EBoA decisions and the above-referenced decisions of the Boards of Appeal, **epi** is of the opinion that the **G3/89** “gold” standard should be considered fulfilled if the remaining subject-matter after introduction of an “undisclosed disclaimer” does not relate to new technical information or provide a new technical teaching. The question of whether this is the case has to be assessed on a case-by-case basis, taking into account all technical circumstances, the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship to the subject-matter remaining in the claim after the amendment. Typically, the exclusion of individual embodiments from a generic group does not lead to new technical information. For example, disclaiming individual compounds or a small group of individual compounds from a generic Markush grouping does not lead to a new technical teaching. Likewise, excluding embodiments relating to excluded subject-matter, for instance use in humans from a claim relating to, for instance, use in animals or mammals, also does not typically result in a new technical teaching.

In this connection, the referring Board referred to an apple with a bite out of it and said that such a bitten apple was no longer an apple. The Board might have difficulty in persuading the Apple Corporation of this view, since this company’s trade mark is an apple with a bite out of it. It is clearly still an apple. Of course, if the bite had been big enough to leave only the stalk, it might not be possible to determine whether the stalk was from an apple or a pear. Thus, whether a bite taken out of an apple changes the character of the apple will depend on the circumstances. This illustrates **epi**’s position, which is that Article 123(2) EPC does not prohibit the use of disclaimers in all cases. Whether any particular disclaimer is allowable depends on the circumstances of the case and account must be taken of explicit and implicit disclosure and the common general knowledge of the skilled person, which is consistent with all the EBoA decisions referred to above, including **G2/10**.

Conclusion



epi believes that Question 1 should be answered in the negative. If, however, the EBoA decides to answer Question 1 affirmatively, remaining Questions 2 and 3 should be answered as indicated above.

Oral Proceedings

If the EBoA were to summon to oral proceedings, **epi** would be pleased to elaborate on the arguments made above if the EBoA considers it helpful.