

# ALLOWABILITY OF AMENDMENTS; RANGES AND DISCLAIMERS

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## ESSENTIAL ASPECTS

- Disclaimers
- Examples of disclaimers
- Article 123(3) EPC
- Example in chemistry
- Trap A123(3)/123(2) EPC
- Ranges

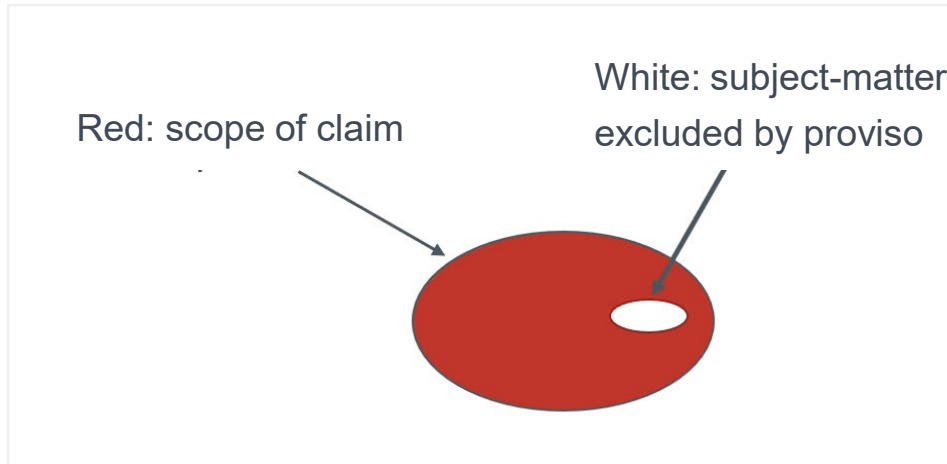
## DISCLAIMER (1/5)

- A disclaimer is a negative feature in a claim, expressly stating that a particular technical feature *is excluded* from the scope of the claim.
- Wherein ... it is not / is other than
- Excluding ...
- With the exception of ...
- With the proviso that Y is excluded

GL H-V, 4

## DISCLAIMER (2/5)

- Once a disclaimer has been introduced, the remaining subject-matter should be less than that of the unamended claim



GL H-V, 4

## DISCLAIMER (3/5)

- There are three categories of disclaimers:
  - The claims were already drafted with a disclaimer
  - **Disclosed** disclaimer (G 2/10)
  - **Undisclosed** disclaimer (G 1/03)
- Article 123(2) EPC?

- GL H-V, 3.5
- GL H-V, 4
- G 2/10
- G 1/03

## DISCLAIMER (4/5)

- Criteria for allowability of **disclosed** disclaimers:
  - the subject-matter remaining in the claim after the introduction of the disclaimer is **directly and unambiguously** disclosed in the application as filed to the skilled person, be it explicitly or implicitly, in light of their common general knowledge at the date of filing (or the date of priority)

GL H-V, 4.2

## EXAMPLE OF DISCLOSED DISCLAIMER (G2/10)

Claim 1

COX inhibitor for use in treating disease X

Claim 1 after amendment:

COX inhibitor for use in treating disease X **wherein the COX inhibitor is NOT celecoxib**

Example 7: Celecoxib in an in vivo model of the disease X

Other examples with etoricoxib, rafecoxib

## DISCLAIMER (5/5)

- Criteria for allowability of **undisclosed** disclaimers:
  - i. the disclaimer restores novelty over a disclosure under Article 54(3) EPC
  - ii. the disclaimer restores novelty over an accidental anticipation under Article 54(2) EPC or
  - iii. the disclaimer removes subject-matter which, under Articles 52-57 EPC, is excluded from patentability for non-technical reasons
- The disclaimer may not provide a technical contribution
- The disclaimer may not remove more than necessary

GL H-V, 4.1



## EXAMPLE OF UNDISCLOSED DISCLAIMER

Claim 1

COX inhibitor for use in treating disease X

Claim 1 after amendment:

COX inhibitor for use in treating disease X **wherein the COX inhibitor is NOT celecoxib**

Celecoxib not explicitly mentioned

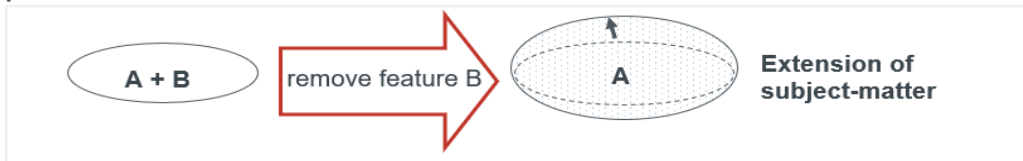
## EXTENDING THE SCOPE OF A PATENT

- A European patent may be amended in opposition or limitation proceedings
- Article 123(3) EPC:  
"The European patent may not be amended **in such a way as to extend the protection it confers.**"

- Art. 123(3) EPC
- GL H-IV, 3
- G 1/93

## THE ARTICLE 123(2)/123(3) EPC TRAP

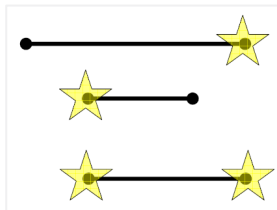
- Article 123(2): "The European patent application or European patent may not be amended in such a way that it contains subject-matter which **extends beyond** the content of the application **as filed**."
- Article 123(3): "The European patent may not be amended in such a way as **to extend the protection it confers**."
- "Inescapable trap": an **unallowable amendment** under Article 123(2) EPC cannot be removed without violating Article 123(3) EPC because it would cause the scope of protection to increase.



- Art. 123(2) EPC
- Art. 123(3) EPC
- GL H-IV, 3.5
- G 1/93

## AMENDMENT OF RANGES

- A range can either be a continuous range without specified members in-between end-points (e. g. "1-7 cm") or a range of discrete elements (e. g. "metals of the first to third main group of the periodic table").
- End-points of a broad general range and end-points of preferred sub-ranges can be combined:



- Creating a new range from a value disclosed in an example and an end-point of a general range is an intermediate generalisation

GL H-IV, 2.4

## SELECTIONS FROM LISTS

- The "two lists principle":  
A combination of single entries from each of two or more lists is generally not originally disclosed in the absence of a pointer to this particular combination (inadmissible "singling-out")
- Shrinking vs. selection

CL Book II.E.1.6

## RANGES (1/5)

- **Combination of the preferred narrower range and one of the part-ranges lying within the disclosed overall range**
- Original description: 30% to 60% and a preferred range of 35% to 50%  
→ Amended Claim: 30% to 50%?
- **Article 123(2) ok**

[T 925/98](#)

## RANGES (2/5)

- **Combination of the lower limit of the general range with the lower limit of the preferred range**
- Original description (parent): the inert particles have an average diameter (particle size) of 0.1 - 10 times, preferably 0.5 - 5 times, more preferably 1.1 - 3 times the thickness of layer A (page 5, second full paragraph).  
→ **Claim of divisional: 0.1-0.5 times**
- **Article 123(2) ok**

[T 1170/02](#)

## RANGES (3/5)

- **End points which are not part of a range**
- Original description: “A concentration of less than 900  $\mu\text{M}$ , preferably less than 500  $\mu\text{M}$ , and more preferably less than **200  $\mu\text{M}$** ” and “a concentration of at least 10 nM, preferably 100 nM, more preferably **1  $\mu\text{M}$** , and typically at 10  $\mu\text{M}$ ”  
→ Claim 1: concentration of at least 1 $\mu\text{M}$  to less than 200 $\mu\text{M}$
- **Article 123(2) not ok**

[T 1919/11](#)



## RANGES (4/5)

- **Combination of an end point of a range with a value from a list of individually disclosed values**
- Original disclosure: disclosure of the range "0.1 and about 1" in claim 5 in conjunction with the value "0.6" disclosed in a **list of individual values**, which read: "about 1.0, 0.9, 0.8, 0.7, 0.6, 0.5, 0.4, 0.3, 0.2, 0.1 or even 0, derivable therein"
  - Claim 1: between 0.6 and 1
- **Article 123(2) not ok**

[T 1320/13](#)

## RANGES (5/5)

- **Combination of end points of different levels of preference for several aspects of a composition**
- **Original description:** "The molar ratio of metal cation to carboxylic acid anion in the basic salts is usually from 0.4 to 10, preferably from 0.5 to 5, particularly preferably from 0.6 to 2.5, very particularly preferably from 0.8 to 1.2."
  - Claim 1: a) adding the molar ratio of trivalent metal cation to monovalent carboxylic acid anion in the basic salts from 0.6 to 1.2
- **Article 123(2) ok**

[T 2514/16](#)

## SELECTIONS FROM LISTS

- No reservoir
- Pointer

CL Book II.E.1.6

**THANK YOU FOR YOUR ATTENTION!**