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Unlocking Patent Strategies: Navigating "Non-disclosed Disclaimer" Practice in China and Europe

[Abstract]

The non-disclosed disclaimer (referred to as "disclaimer" here below) discussed in this article refers to a manner of claim amendment to exclude a technical feature(s) not disclosed in the present application, thereby limiting the claim's scope of protection. Such manner of amendment raises the concern of "extend-beyond-disclosure" and, thus, should be strictly applicable to limited specific situations. This article provides, from the perspective of an agent with practical experience in China ("CN") and Europe ("EP"), an introductory overview and comparative analysis on the practice of disclaimer in these two jurisdictions, based on relevant regulations and case studies.

[Keywords]

Disclaimer, Extend-beyond-disclosure, Patent Examination, CN, EP

[Introduction]

In February 2024, the Intellectual Property Court ("IPC") of the Supreme People's Court ("SPC") issued the Summary of Key Points of Judgments (2023). Within this summary, item 5, titled "determination of disclaimer on claims," is derived from the Administrative Judgment No. 44 (2021), IPC, SPC, and reproduced as follows.

"Disclaimer generally refers to the introduction of negative technical features when amending the claims, which excludes a certain subject matter from the protection scope of the original claim, thereby limiting the protection scope. Generally, disclaimer is only applicable in specific limited situations, for example, to a patent application which is not new over a conflicting application or not new due to accidental anticipation, or which includes a subject matter being non-patentable for non-technical reasons.

Disclaimer also needs to comply with the provisions of Article 33 of the Patent Law. Specifically, the content disclosed in the original claims and description, the content to be disclaimed, and the content retained after the disclaimer, as well as the relationship between the three, should be comprehensively considered. If a person of ordinary skill in the art can determine that the content retained after the disclaimer is directly or implicitly disclosed in the original claims or description, such amendment complies with the provisions of Article 33 of the Patent Law. "

In essence, the above-reproduced key point offers the general definition and outlines the applicable conditions of disclaimer.

In practice, it is found that the application of disclaimer also exists in the patent practice of other countries (e.g., EP and Japan ^[1]). The following is an introduction and comparative analysis on the application of disclaimer in CN and EP at the regulatory and case levels.

I. CN Practice

1.1 Relevant regulations

Section 5.2.3.3, Chapter 8, Part II of the Patent Examination Guidelines ("Examination Guidelines") issued by the China National Intellectual Property Administration ("CNIPA") provides rules and examples of disclaimer applicable for the numerical range:

"If no other numerical value within the initial numerical range of a certain technical feature is described in the initial

description and claims, while novelty and inventive step are prejudiced by the contents disclosed in reference documents, or the invention cannot be carried out when said feature adopts certain parts of the initial numerical range, in view of these two situations, the applicant has to use a specific 'disclaimer' to exclude said parts from the initial numerical range so that the numerical range of the claimed technical solution does not include said parts obviously as a whole, such amendment shall not be allowed because the amendment has gone beyond the scope of disclosure contained in the initial

description and claims, with the exception that the applicant can prove, in accordance with the contents described in the initial application, that the invention cannot be carried out when said feature adopts the 'disclaimed' numerical value, or the invention possesses novelty and involves an inventive step when said feature adopts the numerical value after the 'disclaimer'."

It is known that the disclaimer amendment is also provided in an internal examination regulation of the CNIPA. This provision is given substantially as follows ^[2]. (1) It is acceptable to render a claim novel by excluding therefrom relevant content of a conflicting application; (2) it is also acceptable to render a claim novel by excluding therefrom a prior art satisfying the following conditions: the technical field to which the prior art belongs is far from that of the present application, the prior art solves a completely different technical problem, and the inventive concept of the prior art is so different that it cannot provide any teaching or suggestion for the present application; (3) however, if the prior art to be excluded from the claim can be used to evaluate the inventiveness of the present application, then it can be directly determined that the disclaimer made based on the prior art do not comply with the provisions of Article 33 of the Patent Law.

1.2 Related case

General definition and application situations of disclaimer are clearly

indicated in the Administrative Judgment No. 44 (2021), IPC, SPC as mention above, which is to be summarized below.

The decision of rejection made to the application No. 201480035281.2 was upheld by CNIPA in its re-examination decision No. 172070.

The applicant appealed to the Beijing Intellectual Property Court against the re-examination decision. After hearing the case, the Court issued Administrative Judgment No. 7568 (2019), upholding the re-examination decision No. 172070. The applicant then appealed to the SPC against the first instance judgment.

One of key arguments in the second instance lies in whether the amendment made by the applicant to claim 1 (introducing therein a feature of "the first mixture does not contain copper oxide powder") upon filing the reexamination request is an acceptable disclaimer.

The CNIPA adopts the examination approach regarding disclaimer provided in the Examination Guidelines. Specifically, it is stated in the re-examination decision that the applicant makes the forgoing amendment by excluding a feature (i.e., copper oxide powder) disclosed in the prior art D1 from the original claim, such amendment exceeds disclosure of the application as filed and, thus, belong to a disclaimer. It is further stated, since the amended claim 1 still lacks inventive step compared to the prior art D1, the forgoing

amendment does not comply with the provisions of Article 33 of the Patent Law.

In the judgment of the second instance, although reaching at the same result that the applicant's amendment exceeds disclosure of the application as filed, the SPC withdraws the re-examination decision No. 172070 and holds, after hearing, that " (the applicant) amended claim 1 during the reexamination procedure and further limited that 'the first mixture does not contain copper oxide powder' . This amendment does not exclude a certain subject matter from claim 1, but introduces a further limitation to the overall technical solution of claim 1, thereby failing to meet the formal requirements of disclaimer. Also, this amendment is necessitated neither by restoring novelty over a conflicting application or accidental anticipation of prior art, nor by excluding therefrom a subject matter that is non-patentable for non-technical reasons. Therefore, this amendment does not meet the requirements on specific situations of disclaimer. Accordingly, the defendant should make re-examination based on those claims reviewed in the decision of rejection, rather than reviewing the inventiveness step of the claims amended upon filing the reexamination request."

II. EP Practice

2.1 Relevant regulations

The Guidelines for Examination ("EPO Guidelines") issued by the European Patent Office ("EPO") provide rules and examples of disclaimer in section 4.2.1, Part H, Chapter V as follows.

"Limiting the scope of a claim by using a 'disclaimer' to exclude a technical feature not disclosed in the application as filed may be allowable under Art. 123(2) in the following cases (see G 1/03 and G 1/16 and F-IV, 4.20):

- (i) restoring novelty over a disclosure under Art. 54(3);
- (ii) restoring novelty over an accidental anticipation under Art. 54(2)...
- (iii) removing subject-matter which, under Art. 52 to Art. 57, is excluded from patentability for non-technical reasons.

...An undisclosed disclaimer is, in particular, not allowable if:

- (i) it is made in order to exclude non-working embodiments or remedy insufficient disclosure;
- (ii) it makes a technical contribution.
- (iii) the limitation is relevant for assessing inventive step;
- (iv) the disclaimer, which would otherwise be allowable on the basis of a conflicting application alone (Art. 54(3)), renders the invention novel or inventive over a separate prior art document under Art. 54(2), which is a not accidental anticipation of the claimed invention;
- (v) the disclaimer based on a conflicting application also serves

another purpose, e.g. it removes a deficiency under Art. 83..."

It can be seen from the forgoing provisions that the EPO Guidelines not only list acceptable disclaimers in purposes of restoring novelty over a disclosure under Art. 54(3) EPC (i.e., a conflicting application) and an accidental anticipation under Art. 54(2), and removing subject-matter excluded from patentability for non-technical reasons, but also list unacceptable disclaimers in purposes of excluding non-working embodiments, remedying insufficient disclosure and the like.

2.2 Related cases

In the book "Case Law of the Boards of Appeal" published by the EPO, section 1.5, Part E, Chapter II provides several decisions related to disclaimer, some of which are reproduced partially as follows^[3].

In G 1/03, the Enlarged Board held that, when anticipation was taken to be accidental, this meant that it appeared from the outset that the anticipation had nothing to do with the invention. Only if this was established could the disclaimer be allowable.

In T 500/00, the amendment was an undisclosed disclaimer introduced by the appellant into claim 1 during the examining proceedings in response to an objection of lack of novelty based on prior art document D1. The question that arose was whether or not the disclosure of D1

was accidental. In the case in point, D1 and the application in suit concerned the same technical field and related to the same purpose. Therefore, the disclosure of D1 could not be considered as being accidental within the meaning of G 1/03.

In T 788/05, the undisclosed disclaimer was introduced by the appellant during the examination procedure with the purpose of establishing the novelty of the claimed subject-matter with respect to D1, which was then considered as a prior art document relevant under Art. 54(3) EPC. In the case at issue, the relevant prior art was represented by documents D1 and D5. To be allowable the disclaimer had to fulfil the conditions in relation to both documents. As far as D1 was concerned, the disclaimer appeared to be appropriate. D5 represented the state of the art under Art. 54(2). As D5 was not state of the art under Art. 54(3) and was not an accidental disclosure, the disclaimer would not be allowable.

III. Comparative Analysis

In view of above, from the perspective of statutory provisions and judgement, the amendment manner of disclaimer has been applied in patent practice in CN and EP. The following attempts to proceed with the comparative analysis therebetween in four aspects.

3.1 Jurisprudential basis

The establishment intention of disclaimer is aimed at "expanding" protection for the legitimate interest of patentees.

The reason it is a legitimate interest ^[1] lies in that most of the content sought to be protected by the application may make creative contributions relative to the prior art. If the entire claim is denied merely because some technical solutions within its scope are not implementable or lack novelty, it would not be conducive to providing reasonable protection for inventive creations.

The reason it is "expanding" protection lies in that in cases where a disclaimer is needed for a claim, if such disclaimer is not accepted, the claim would not be protected due to lack of novelty. On the other hand, excluding features only disclosed in prior art from the present application also raises concerns about "extend-beyond-disclosure".

The above theories have been affirmed to varying degrees in practices of both CN and EP.

For example, the Administrative Judgment No. 44 (2021), IPC, SPC mentioned above states: "disclaimer... does not fully conform to the provisions of Article 33 of the Patent Law... However, if the subject matter to be protected after the disclaimer has been directly or implicitly disclosed in the original application, it may be acceptable based on the consideration of fair protection for the patentee interests. "

Similarly, the EPO's Board of Appeal also states in its decision of G 1/03 as follows. "Allowing unsupported disclaimers in exceptional cases would maintain the existing balance between the practical needs of applicants and the interests of third parties in legal certainty. The introduction of a disclaimer was legitimate, if the applicant encountered a situation which he could not have anticipated when he originally drafted his application... "

3.2 Legal Background

As mentioned above, relevant provisions on disclaimer are given in both CN and EP in their respective patent examination guidelines.

Taking CN as example, the disclaimer was initially regulated by section 5.2.2 "Acceptable Amendments" of the substantive examination part in the 2001 version of Examination Guidelines. It was later moved to section 5.2.3.3 "Unacceptable Amendments" starting from the 2006 version. As indicated in the revision explanation, the consideration for this section change is that, "disclaimer... as a special case of 'extend-beyond-disclosure' amendment, should be restricted...This situation is extremely rare, and the vast majority of such amendments do not meet this condition and cannot be accepted, therefore this part is moved to section 5.2.3.3 of this chapter... "

The EPO Guidelines provide detailed explanations and regulations on disclaimer

in Chapter V "Allowability of amendments – examples" of Part H "Amendments and Corrections". As mentioned earlier, not only are examples of acceptable disclaimers listed, but also examples of unacceptable disclaimers are listed. Therefore, in terms of the comprehensiveness of legal provisions, the EPO Guidelines provide more operational guidance for disclaimer, which also helps guide applicants to make amendments that are more likely to be accepted by examiners.

In comparison, the guidance provided by the Examination Guidelines on disclaimer is limited. Although disclaimer is only regulated with numerical ranges as examples, practitioners implicitly apply such kind of amendments to those applications beyond numerical ranges. Although such applications account for a very small proportion, they still result in a considerable number of applications involving disclaimer given the large application base. In this case, insufficiently detailed provisions result in both applicants and examiners being unable to accurately grasp the extent of disclaimer. There may even be significant discrepancies in understanding and grasping disclaimer between the examination authority and the judicial authority, as illustrated by the Administrative Judgment No. 44 (2021), IPC, SPC as mentioned above.

3.3 Applicable Conditions

The EPO Guidelines provide relatively clear guidance on the applicable conditions for disclaimer. According to the provisions of section 4.2.1, Part H, Chapter V, acceptable disclaimers include those in purposes of excluding conflicting application, accidental anticipation, and non-patentable subject matter; while unacceptable disclaimers include those having the following effects: excluding non-working embodiments or remedying insufficient disclosure, making technical contributions, limiting aspects related to assessing inventiveness, having novelty or inventiveness compared to non-conflicting prior art, and the like.

In contrast, there is no unified guidance on the applicable conditions for disclaimer in Chinese examination practice. On one hand, based on the provisions of section 5.2.3.3, Chapter 8, Part II in the Examination Guidelines as cited earlier, the applicable conditions for disclaimer include: excluding features that render the invention impracticable; or rendering the technical solution, after the disclaimer, novel and inventive. On the other hand, based on the internal examination regulation mentioned above, the applicable conditions for disclaimer are, more similar to those in the EPO Guidelines, allowing disclaimer only aimed at excluding conflicting application or accidental anticipation. Furthermore, as can be seen from the judgment mentioned in the introduction, the SPC also adopts a viewpoint similar to that of the EPO, namely, that disclaimer should only apply

to exclude conflicting application, accidental anticipation, and non-patentable subject matter.

As a means of "expanding" protection for patentee interests, the applicable conditions for disclaimer should be clearly and strictly limited. Whether compared with the EPO Guidelines, or with the internal examination regulation and the viewpoints of the SPC, the current provisions in the Examination Guidelines regarding disclaimer are evidently too lenient. This not only hampers applicants from obtaining stable and effective protection, but also imposes unnecessary burdens on examiners.

3.4 Relationship with “extend-beyond-disclosure”

Article 33 of the Patent Law stipulates that "the amendment to the application for a patent for invention or utility model may not go beyond the scope of disclosure contained in the initial description and claims." Since disclaimer introduces negative technical features not disclosed in the original application, it undoubtedly raises concerns about "extend-beyond-disclosure" and, literally, should not comply with the provisions of Article 33 of the Patent Law. Therefore, disclaimer introduced for the fair protection of patentee interests clearly fall under the exception to the rule of "extend-beyond-disclosure."

This point is reflected in both the Chinese

and EPO examination guidelines.

For example, Section 5.2.3.3, Chapter 8, Part II of Examination Guidelines, as cited earlier, explicitly states that "If no other numerical value within the initial numerical range of a certain technical feature is described in the initial description and claims... the applicant has to use a specific ‘disclaimer’ to exclude said parts from the initial numerical range so that the numerical range of the claimed technical solution does not include said parts obviously as a whole... the amendment has gone beyond the scope of disclosure contained in the initial description and claims... "

Similarly, the opening paragraph of section 4.2.1, Part H, Chapter V in the EPO Guidelines explicitly states that “Limiting the scope of a claim by using a ‘disclaimer’ to exclude a technical feature not disclosed in the application as filed may be allowable under Art. 123(2) in the following cases...” Here, Art. 123(2) is well-known as an article for regulating the issue of "extend-beyond-disclosure" in the European Patent Convention ("EPC").

IV. Case Studies

Based on the analysis above, it is considered that, regarding disclaimer existing in examination practices, the current Examination Guidelines convey to the public the principle that it belongs to exceptions to the rule of "extend-beyond-

disclosure". However, from the perspective of applicable conditions and operability, there is still a lack of more stringent and detailed guidance, which should be considered in future revisions of the Examination Guidelines. Both the internal examination regulation of CNIPA and the EPO Guidelines can serve as references for such revisions.

As to the application related to the Administrative Judgment No. 44 (2021), IPC, SPC, if the panel was to follow the internal examination regulation upon reviewing the amendment made by the applicant, it would lead to a different analysis in the reexamination decision. Specifically, the above-mentioned amendment, which excluded "copper oxide powder" not disclosed in the present application from the mixture of claim 1, formally constitutes a disclaimer amendment. However, since neither the prior art D1 belongs to a conflicting application nor accidental anticipation occurs, and the panel also believes that the prior art D1 can be used to assess the inventiveness of the present application, such amendment should not be treated as exceptions to the rule of "extend-beyond-disclosure". Moreover, there is no need to continue assessing the inventiveness based on the amended claim 1. Instead, it can be directly determined that the amendment does not comply with the provisions of Article 33 of the Patent Law.

Furthermore, it can be seen from the Administrative Judgment No. 44 (2021), IPC,

SPC that the SPC also reached the conclusion that the amendment does not comply with the provisions of Article 33 of the Patent Law. However, it is considered that there are still some viewpoints in the judgment that are worth discussing.

Firstly, the judgment states that the forgoing amendment "does not exclude specific subject matter covered by claim 1, but further limits the overall technical solution of claim 1, thereby failing to meet the formal requirements of disclaimer. "

Here, it seems that an attempt is made to introduce certain formal requirements for disclaimer, but the judgment does not provide further explanation on this.

Such viewpoint cannot be agreed. From the relevant provisions of the Chinese and EPO examination guidelines, it can be seen that any introduction of technical features not disclosed in the present application through negative limitation in the claims should be considered as a formal disclaimer. Additional formal requirements would introduce more uncertainty into the examination, resulting in additional burdens for both applicants and examiners.

Secondly, the judgment further states that "in addition to meeting the above formal requirements and specific situations, disclaimer also needs to comply with the provisions of Article 33 of the Patent Law... If a person of ordinary skill in the art can determine that the content retained after

the disclaimer is directly or implicitly disclosed in the original claims or description, such amendment complies with the provisions of Article 33 of the Patent Law."

Here, it explicitly requires that disclaimer should simultaneously meet the formal requirements, specific situations, and the provisions of Article 33 of the Patent Law, i.e., it requires that the disclaimer should be subject to the examination of whether it extends disclosure of the application as filed.

Such viewpoint can neither be agreed. As mentioned in Section 3.4 above, disclaimer amendments are clearly regarded as exceptions to the rule of "extend-beyond-disclosure" in both Chinese and European examination practices. Specifically, disclaimer amendments, made by introducing technical features not disclosed in the present application through negative limitation, literally raise the issue of "extend-beyond-disclosure". However, they are exceptionally regarded as not extending beyond the disclosure when meeting applicable conditions,

thereby ensuring fair protection of patentee interests. Introducing a rule to examine whether the disclaimer amendments extend beyond the disclosure not only contradicts the intention of applying disclaimer, but also lacks operability in examination practices.

Conclusion

Disclaimer amendments play an important role in ensuring fair protection of patentee interests. However, as exceptions to the rule of "extend-beyond-disclosure", they should be subject to strict limitations. In comparison to the EPO Guidelines, the Chinese Examination Guidelines should introduce more operationally feasible provisions regarding the disclaimer amendments. This would facilitate a more uniform understanding of this manner of amendment among practitioners, including applicants, patent agents, attorneys, examiners, and judges. Through this article, it is hoped that the disclaimer amendments would be paid more attention to in practice.

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