



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee, Prague, Czech Republic, 7 to 9 October 2002

“Disclaimers”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Prague, Czech Republic, 7-9 October 2002, resolved that:

Noting with concern European Patent Office Technical Board of Appeal Decision T 323/97 which appears to rule that the introduction of a disclaimer having no basis in the originally-filed application is contrary to Article 123(2) EPC;

Noting with approval that a question addressing the allowability of such disclaimers is to be put to the Enlarged Board of Appeal;

Observing that many granted patents may become incurably invalid if T 323/97 is upheld;

Observing that the addition of a disclaimer may be the only way of excluding from the scope of a claim prior art previously unknown to the applicant;

Observing that a disclaimer introduced into an application during examination cannot be deleted during a subsequent opposition without the patentee falling into the "the inescapable trap" resulting from the combined effects of Articles 123(2) EPC and 123(3) EPC;

Expresses the opinion that the addition of a disclaimer that simply excludes subject matter from the scope of a claim does not result in any change to the objective technical problem addressed by the invention or to the subject-matter disclosed in the application and is hence not contrary to Article 123(2) EPC.