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**Datasheet for the decision
of 15 November 2022**

Case Number: T 0088/21 - 3.3.05

Application Number: 16751065.0

Publication Number: 3325419

IPC: C03C3/091, C03C3/093,
C03C3/097, C03C21/00, B32B17/10

Language of the proceedings: EN

Title of invention:
GLASS ARTICLES EXHIBITING IMPROVED FRACTURE PERFORMANCE

Applicant:
Corning Incorporated

Headword:
Glass article/CORNING

Relevant legal provisions:
EPC Art. 54(2), 54(3), 87(1), 87(4), 112(1)(a), 123(2)

Keyword:

Priority not valid in so far as the claim covers subject-matter disclosed in an earlier application by the same applicant

Coherence with principles of claiming multiple priorities and partial priority

Undisclosed disclaimer based on a disclosure in an earlier application by the same applicant not allowed: basis for the assessment is the claim before the insertion of the disclaimer

Referral to the Enlarged Board of Appeal - (no) - uniform application of law

Decisions cited:

G 0002/98, G 0001/03, G 0002/10, G 0001/15, G 0001/16,
T 0248/88, T 0015/01, T 1843/09, T 1222/11, T 0282/12,
T 1872/14, T 0311/18

Catchword:

In view of the principles of multiple priorities and partial priority: undisclosed disclaimer based on a disclosure in an earlier application by the same applicant not allowed



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0088/21 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 15 November 2022

Appellant: Corning Incorporated
(Applicant) 1 Riverfront Plaza
Corning, New York 14831 (US)

Representative: Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks, Kent TN13 1XR (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 October 2020
refusing European patent application No.
16751065.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair R. Winkelhofer
Members: T. Burkhardt
S. Besselmann

Summary of Facts and Submissions

I. The applicant's (appellant's) appeal is against the examining division's decision to refuse European patent application No. 16 751 065.0.

II. The examining division came to the conclusion that the insertion of an undisclosed disclaimer in the claims of the (then and current) main request did not fulfil the requirements of Article 123(2) EPC.

III. The following documents were among those discussed at the examining stage:

D0 US 62/194,984 (a priority document of the current application, with a filing date of 21 July 2015)

D1 EP 3 204 338 A2 (published on 14 April 2016 as WO 2016/057787 A2 pursuant to Article 153(3) EPC)

D1a US 62/117,585 (a priority document of D1 with a filing date of 18 February 2015)

IV. Independent claim 1 of the main request reads as follows (emphasis added by the board):

"1. A strengthened glass article comprising:

a first surface (302) and a second surface (304) opposing the first surface defining a thickness (t) of 1.1 mm or less;

a compressive stress layer (315) extending from the first surface to a depth of compression (DOC) (330) of greater than $0.11 \cdot t$;

wherein, after the glass article (300) fractures according to a Frangibility Test, the glass article (300) includes a plurality of fragments, wherein at

least 90% of the plurality of fragments have an aspect ratio of 5 or less;

wherein the glass article (300) fractures into the plurality of fragments in 1 second or less, as measured by the Frangibility Test; and

wherein the glass article (300) comprises a stored tensile energy of greater than 15 J/m²,

with the proviso that the glass article (300) is not a glass article according to Examples 4A, 4B, 4C, 4D or 5A of EP 3 204 338 A2."

V. The appellant's arguments at the appeal stage relevant to the present decision can be summarised as follows.

The addition of the undisclosed disclaimer fulfilled the criteria of G 1/03, and priority from D0 was validly claimed.

When assessing the validity of the priority of the claimed subject-matter and the allowability of the undisclosed disclaimer, the claims currently on file had to be considered; not the notional claims before addition of the disclaimer. This was in line with G 2/98, G 1/03 and G 1/16.

T 1872/14 and T 1843/09 supported these conclusions.

A different approach had been taken in decision T 1222/11 but was rejected in T 1872/14. This different approach should not be followed.

Since there was contradicting case law, a referral to the Enlarged Board of Appeal should be made. The following questions were suggested:

"1) Is it allowable to restore both the right to priority and the novelty over the earlier application by the introduction of a non-disclosed disclaimer under the rules laid down in the decisions G 01/03 and G 02/03 of the Enlarged Board of Appeal, and

2. If the answer to the first question is yes, are there any further requirements going beyond the rules set out in the decisions G 01/03 and G 02/03 of the Enlarged Board of Appeal?"

VI. The appellant requests that the decision under appeal be set aside and amended such that a patent be granted on the basis of the main request or, subsidiarily, that the case be remitted to the examining division for further prosecution, if the main request was found to fulfil the requirements of Art 123(2) EPC.

Further, they request the referral of questions to the Enlarged Board of Appeal.

Reasons for the Decision

The (sole) main request is identical to the main request as discussed in the decision under appeal.

1. Article 123(2) EPC

1.1 The current application claims priority from **D0**, *inter alia*. Compared with the current application as originally filed, claim 1 of the main request contains an undisclosed disclaimer based on Examples 4A-D and 5A of **D1**.

D1 claims priority from, *inter alia*, unpublished **D1a**, which was filed prior to D0. It has not been contested that D1 validly claims priority from D1a in so far as the subject-matter of the disclaimer is concerned, i.e. Examples 4A-D and 5A.

D1 and the current application are both by the same applicant, the appellant. It has also not been contested that the documents forming the basis for claiming the respective priority rights (D1a and D0) belong to the appellant.

1.2 In G 1/03, OJ EPO 2004, 413, the Enlarged Board of Appeal held that the addition of an undisclosed disclaimer may be allowable under Article 123(2) EPC to:

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC [1973]
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC [1973]; an anticipation being accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention
- disclaim subject-matter which, under Articles 52 to 57 EPC [1973], is excluded from patentability for non-technical reasons (order 2.1)

This was confirmed and clarified in G 1/16, OJ EPO 2018, A70.

1.3 For the following reasons, the addition of the undisclosed disclaimer in this case does not fulfil the requirements of Article 123(2) EPC.

(a) The subject-matter of claim 1 of the current application before the addition of the disclaimer was anticipated by Examples 4A-D and 5A of D1, as acknowledged by the appellant.

(b) The effective date of these examples in D1 is the filing date of D1a, i.e. 18 February 2015. This is before the filing date of D0 on 21 July 2015.

As far as the subject-matter of Examples 4A-D and 5A of D1/D1a is concerned, D1a - and not D0 - is hence the first application within the meaning of Article 87(1) together with (4) EPC.

(c) Therefore, the current application cannot validly claim the priority of D0 for the subject-matter of these examples, and the effective date in this regard is the filing date of the current application (i.e. 22 July 2016).

(d) Since D1 was published prior to that filing date (namely on 14 April 2016), D1 is prior art under Article 54(2) EPC for this subject-matter.

(e) D1 is moreover not an accidental disclosure since it is directed to the same technical field as the current application, namely glass articles.

(f) Exclusion from patentability for non-technical reasons is irrelevant to this case.

Consequently, the criteria developed in G 1/03, together with G 1/16, are not fulfilled, and the disclaimer in claim 1 of the main request violates Article 123(2) EPC.

1.4 The appellant disagreed and argued as follows.

(a) The claim currently on file, i.e. the claim with the disclaimer, had to be considered; not a notional claim without the disclaimer.

(b) None of the subject-matter remaining in current claim 1 was disclosed in D1/D1a.

(c) Therefore, D0 was the first application within the meaning of Article 87(1) EPC for the remaining subject-matter.

(d) Consequently, the priority of the main request based on D0 was valid.

(e) D1 was hence prior art under Article 54(3) EPC, not under Article 54(2) EPC.

(f) Since the disclaimer restored novelty over D1 as an Article 54(3) EPC document, the insertion of the disclaimer was allowable under the criteria set out in G 1/03 and G 1/16. The requirements of Article 123(2) EPC were hence fulfilled.

1.5 To support their argument, the appellant also pointed to T 1872/14.

In that case, the patent in suit originated from a divisional application (document (34)) of a root application (document (35)), which claimed priority from a US patent application (document (36)).

Prior-art document (1) by the same applicant validly claimed priority from US application (1a), which had an earlier filing date than document (36).

An undisclosed disclaimer based on an example with a compound disclosed in document (1) was added to the claim to restore novelty over that document.

Referring, *inter alia*, to G 1/03 and G 2/10, the board in T 1872/14 concluded that:

- the priority for the remaining subject-matter was valid since the identity of the invention had not been changed by the disclaimer (Reasons 5.3.3)
- document (1) was thus prior art pursuant to Article 54(3) EPC, and the inclusion of the disclaimer met the criteria of G 1/03 (see Reasons 5.4)

The appellant further referred to T 1843/09, where an undisclosed disclaimer based on an example in an earlier application had been allowed (see Reasons 3.1).

- 1.6 This line of argument is based on the incorrect assumption that the claim *with (i.e. after the inclusion of)* the disclaimer was decisive in the given context. This is, however, not in accordance with the principles developed in G 1/03 and G 1/16.

The first part of point 2.1 of the order of G 1/03 reads as follows (as already outlined above; emphasis added by the board):

"A disclaimer may be allowable **in order to:**
- **restore novelty** by delimiting a claim against state of the art under Article 54(3) [EPC] ..."

This means that adding the disclaimer and "restoring" novelty occur when a novelty objection under Article 54(3) EPC actually applies, i.e. when the novelty-destroying document is prior art under

Article 54(3) EPC against the notional claim without the disclaimer.

This was also the situation underlying the referral for G 1/03 (see point II of the Summary of Facts and Submissions, in particular the paragraph bridging pages 415 and 416 and the introductory sentence to point 2.1 of the Reasons). The insertion of the undisclosed disclaimer was occasioned by a lack-of-novelty objection pursuant to Article 54(3) EPC, meaning that the objection concerned the claim *without* (i.e. *before the insertion of*) the disclaimer.

By contrast, under the appellant's approach, the disclaimer would be added and novelty restored when a novelty objection under Article 54(2) EPC (still) applied. The disclaimer would have the effect of removing the subject-matter from the claim which was objectionable under Article 54(2) EPC. As a consequence, only subject-matter would remain in the claim for which D1 was state of the art under Article 54(3) EPC.

This confirms that there was at no time a lack-of-novelty objection under Article 54(3) EPC. The disclaimer thus cannot be said to fulfil the purpose of restoring novelty by delimiting a claim against state of the art under Article 54(3) EPC.

The appellant, in essence, argued as if the order of G 1/03 read as follows:

A disclaimer may be allowable ~~in order to:~~
- ~~restore~~ if it has restored novelty by delimiting a claim against state of the art which, following the

addition of the disclaimer, has become state of the art under Article 54(3) EPC

Such an understanding is, however, different from the actual language of the order of G 1/03, as set out above, and its rationale. In fact, the Enlarged Board of Appeal found that the privileged situation in the relation between conflicting applications did not exist for pre-published state of the art. Under G 1/03, the claimed invention as originally disclosed must meet the requirements of Article 54(2) EPC, and a disclaimer which would be allowable on the basis of the conflicting application alone cannot render the invention novel or inventive over prior art under Article 54(2) EPC unless the latter is an accidental anticipation and only novelty is at stake (Reasons 2.6.2).

1.7 Moreover, because of the principles established in G 1/15 (OJ 2017, A82, see below), the questions to be answered in the case at hand have to be seen in a different light compared to when T 1872/14 was handed down, and the assumptions on which it is based can no longer be made.

The board in T 1872/14 did not describe the underlying situation as one in which the document forming the basis for the disclaimer was prior art under Article 54(2) EPC for the disclaimed subject-matter. Whether the document at issue would be prior art under Article 54(2) EPC for a notional claim without the disclaimer was explicitly left open (Reasons 5.5, page 50).

Applying the principles established in the later decision G 1/15, however, the disclaimed subject-matter

in such a situation does have a different effective date than the subject-matter remaining in the claim. The pertinent question in this context is whether the claim without the disclaimer already encompassed alternative subject-matter in the meaning of G 1/15 having different effective dates.

In a situation such as the one at issue, inserting a disclaimer has the effect of limiting the claim to subject-matter having a different (earlier) effective date and thus changing the status of the prior-art document from being relevant under Article 54(2) EPC, in the absence of the disclaimer, to Article 54(3) EPC, following the inclusion of the disclaimer.

As explained above, this consideration is decisive when determining whether the disclaimer fulfils its purpose of restoring novelty by delimiting a claim against state of the art under Article 54(3) EPC.

- 1.8 The conclusions as set out above are supported by further case law of the boards.
- 1.9 In T 1222/11 (Reasons 5, 6, 7, 9.2 and 12), a case similar to the one at hand, the inclusion of several undisclosed disclaimers on the basis of exemplified compositions in an earlier application by the same applicant (comparable to D1 in the current case) was held not allowable under Article 123(2) EPC. The board considered that the earlier application was the first application within the meaning of Article 87(1) EPC for these compositions and that the priority as claimed by the application was in so far not valid.

With the claim without the disclaimer being the relevant yardstick, these compositions in the earlier

application were prior art under Article 54(2) EPC and not Article 54(3) EPC. The addition of the disclaimers thus did not fulfil the criteria of G 1/03.

The reasoning of T 1222/11 was explicitly rejected by T 1872/14 (Reasons 5.5), as cited by the appellant, claiming that it was not in accordance with G 2/10, *inter alia*.

As set out above, the reasoning of T 1872/14 is not persuasive either in this regard.

Moreover, the board does not agree with the conclusion in T 1872/14 (Reasons 5.3.3 with reference to G 1/03 Reasons 2.1.3) that the disclaimer does not change the technical information (the identity of the invention within the meaning of Article 87(1) EPC) in such general terms. In line with G 2/98, OJ 2001, 413 (Reasons 9, see also below as to the narrow concept of the "same invention" it is advocating), G 1/16 (Reasons 46.2) explicitly states that the language in the cited passages in G 1/03 bore the potential of being understood too broadly and thus misleading because inserting any disclaimer into a claim necessarily changes the technical information in quantitative terms. The question (see G 1/16, Reasons 46.4) is if the technical teaching of the claims after the inclusion of the disclaimer changes also in qualitative terms and can thus no longer be considered to belong to the invention as presented in the application as originally filed, thus infringing Article 123(2) EPC.

1.10 Subsequent case law is in line with T 1222/11.

G 1/16 (in particular, Reasons 43 ff) confirms that only the criteria of G 1/03 are to be considered when

the allowability of an undisclosed disclaimer is assessed, while the gold standard test of G 2/10 has no relevance under these circumstances. G 1/16 explicitly cites T 1872/14 as thus incorrectly applying the gold standard test (in a modified form) to undisclosed disclaimers (see Reasons 24(2) (a) and (b) of G 1/16).

G 1/15 moreover confirms the conceptual identification of alternative subject-matter when assessing partial priorities and endorses the approach of T 1222/11 in determining the relevant disclosure of a priority document vis-à-vis a subsequent application (see Reasons 6.6 and also 2.4).

Furthermore, in T 282/12 (Reasons 2, in particular Reasons 2.5), the board held that, for reasons of consistency, the rationale of G 1/15 must also apply for deciding whether an application from which priority is claimed is the first application within the meaning of Article 87(1) EPC. Indeed, just as a priority application and a patent claiming priority from it may partially relate to the same invention, the priority application and an earlier application filed by the same applicant may also do so. In this case, the priority application would be the first application for only the part of the invention which is not the same as in the earlier application.

- 1.11 The appellant agrees with the partial priorities concept of G 1/15 but alleged that this decision had no bearing on the current case.

This view is likewise not convincing. G 1/15, together with T 282/12, clarifies that it has to be decided *for each subject-matter* whether it is the first application under Article 87(1) EPC.

Regarding the case at hand, T 282/12 thus also supports the finding that the claims of the main request cannot validly claim the priority of D0 for the subject-matter of Examples 4A-D and 5A since it had already been disclosed in D1/D1a.

- 1.12 The current board's reasoning is also in line with T 311/18, which is directed to a similar situation and subsequent to G 1/15 and G 1/16.

Under Reasons 4, T 311/18 explains why the priority of certain subject-matter was not valid in view of a disclosure (D5) and why the addition of a corresponding undisclosed disclaimer was not allowable:

- D5 was the first application in the case within the meaning of Article 87(1) EPC.
- The priority was consequently not valid for the disclaimed subject-matter.
- The addition of the undisclosed disclaimer was thus not allowable since document D5 was prior art under Article 54(2) EPC for the disclaimed subject-matter.

- 1.13 This case law subsequent to T 1872/14 thus also shows that the assumptions made in it are outdated. There has been no further case law following the approach of T 1872/14 since.

- 1.14 T 1843/09 also does not support the appellant's view as it does not address the situation in the case at hand and is thus not comparable. The question of the first application was not posed. Moreover, it precedes G 1/15 and G 1/16.

- 1.15 The appellant finally argued that the line taken here, in particular following T 1222/11, would amount to an

unfair disadvantage for applicants because of "self-collision"; under the same circumstances a third party would be allowed to insert a disclaimer.

However, as indicated above, G 2/98 advocates a "narrow or strict interpretation" of the concept of the same invention and the right to priority (see Reasons 9 and T 1222/11, Reasons 9.1).

Moreover, the appellant already knew the content of their documents D1a/D1 at the time of filing the current application, and it was in their hands for the current situation not to occur. It rests with an applicant to manage their patent portfolio in line with the provisions of the EPC they want to avail themselves of, however large this portfolio may be, not least in the interest of legal certainty for third parties.

Besides, it is an inherent peculiarity of the patent system of the EPC that an applicant and a third party cannot always be treated the same as their roles are fundamentally different. Sometimes - in the words of the appellant - there will thus be a "disadvantage" on the side of an applicant, and sometimes on a third party's side:

- The concept of G 1/15 that alternative subject-matter encompassed by a generic claim may enjoy partial priority is beneficial in some situations, namely when it is to be assessed whether a priority document relates to the same invention. But it may be disadvantageous in other situations, namely when the nature of a priority document as the first application is at stake in view of an even earlier application by the same applicant.

- While G 1/15 protects an applicant from a "poisonous priority" when they file a subsequent application within the priority period, a third party filing the same subsequent application would have to add an undisclosed disclaimer with all the related risks (e.g. that a disclaimer is not allowable if too much subject-matter is removed or if the inclusion of the disclaimer makes a technical contribution).

2. Article 112(1)(a) EPC

The appellant requested referral of questions to the Enlarged Board of Appeal.

However, as the board has followed G 1/15 and G 1/16 and the relevant case law (also) subsequent to these Enlarged Board of Appeal decisions, and as there was no subsequent contradicting case law under comparable circumstances, there is no room for a referral to the Enlarged Board of Appeal to ensure uniform application of the law, which in any case would not be necessary in view of an isolated non-uniform decision (see T 15/01, Reasons 40 and T 248/88, Reasons 3.3 holding that a single and isolated non-uniform decision does not qualify under Article 112(1)(a) EPC).

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chair:



C. Vodz

R. Winkelhofer

Decision electronically authenticated