

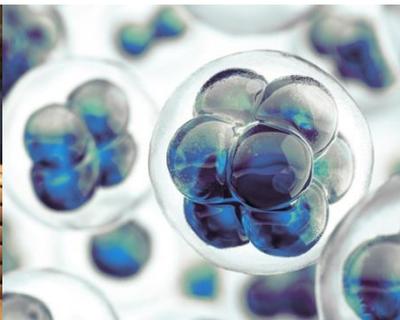


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7c. General clarity principles & claim interpretation

US Bar – EPO Liaison Council

Washington, DC, 24 September 2019

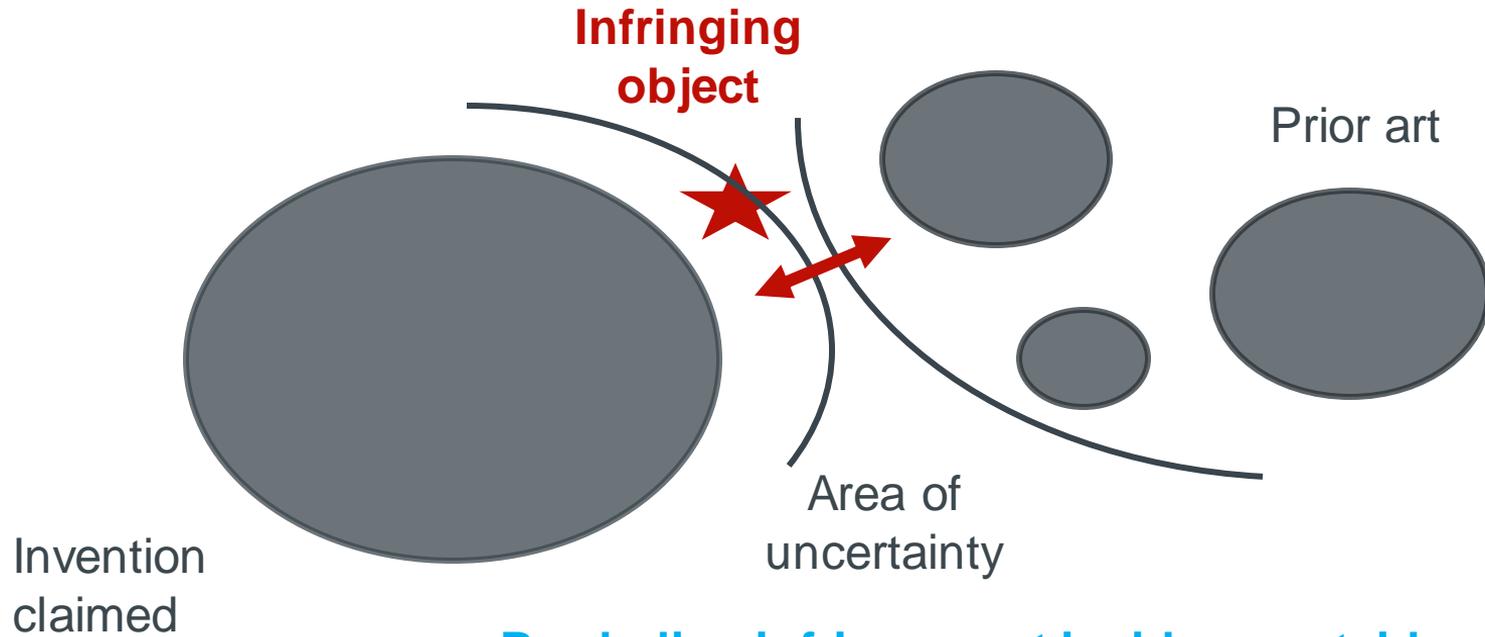


Article 84 EPC - Claims

- "The claims shall **define the matter for which protection is sought**. They shall be **clear** and **concise** and be **supported by the description**."
- Rule 43 EPC
 - Form and content of claims
- Guidelines:
 - F-IV, 4 Clarity
 - F-IV, 5 Conciseness
 - F-IV, 6 Support in description

Why do we need 'clear' claims?

'Good fences make good neighbours'



Borderline infringement inside or outside scope?

General principles and claim interpretation

- The meaning of the terms of the claim should be clear:
 - **for the person skilled in the art**
 - from **the wording of the claim alone**, without reference to the description
- The claim should be read with an attempt to **make technical sense** out of it (with good will)
- The claims must be **free of contradiction**

T 2/80

GL F-IV, 4.1 and 4.2

Article 69(1) EPC vs. clarity

- "The **extent of the protection** conferred by a European patent or a European patent application shall be **determined by the claims**. Nevertheless, the description and drawings shall be used to interpret the claims."
- **Art. 69 EPC and its Protocol do not provide a basis**
 - for excluding what is literally covered by the terms of the claims GL F-IV, 4.2
 - A claim must be clear, i.e. must fulfil the requirements of Art. 84 EPC, **on its own**
 - for reading limitations derived from the description into claims in order to avoid objections based on lack of novelty or inventive step; this is **incompatible** with the EPC T 223/05, T 681/01



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Specific concepts

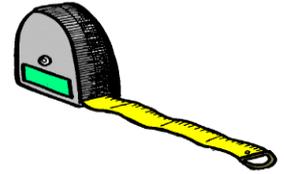


Functional features



- Are allowable, if:
 - they provide a **clear instruction to a skilled person** to reduce them to practice without undue burden T 1048/10
 - such features cannot otherwise be defined more precisely without restricting the scope of the invention T 68/85
- **T 979/11** (clarity - no)
 - "A probe for the treatment of glaucoma" [... the probe tip being ...] "configured to access the trabecular meshwork"
- **T 1098/14** (clarity - yes)
 - "A (balloon) catheter" [... the balloon in its inflated state being ...] "suitable for conforming to the irregular shape and structure of a vessel to provide flow occlusion and/or attenuation to said vessel without appreciably deforming or stressing the vessel"

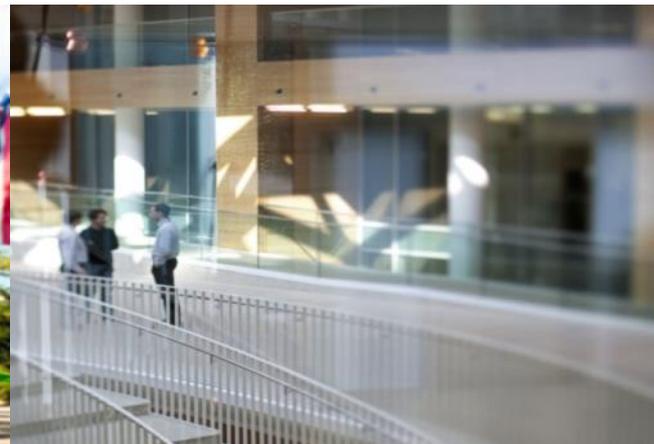
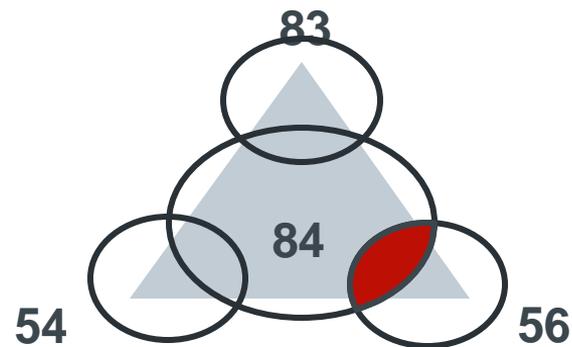
Relative terms



- Should not be used, unless they have a well-recognised meaning in the particular art and this is the meaning intended
 - An unclear term cannot be allowed in a claim if the term is essential having regard to the invention
- **T 445/12** (clarity - no)
 - "substantially non-polymerisable"
- **T 610/13** (clarity - yes)
 - "middle polyhedron" has a well-recognised meaning in the relevant art (mathematical theory)



Interplay Art. 84 vs. Art. 56



Art. 56 vs. Art. 84 EPC

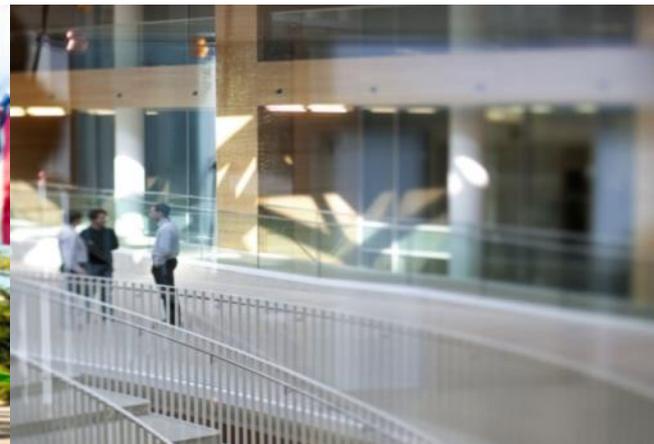
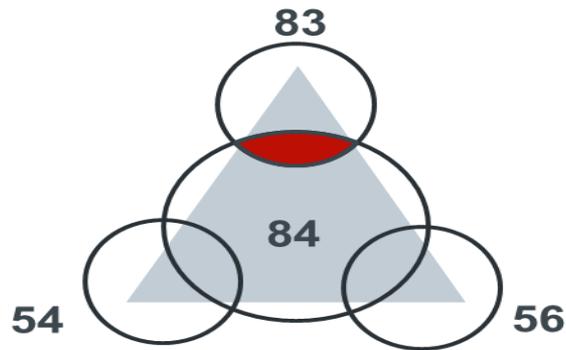
- If the features in a claim do not achieve the necessary technical effects underlying the solution of the objective technical problem with which the application is concerned, the subject-matter of the claim lacks inventive step Art. 56
- At the same time, such a claim may lack clarity because it does not define all the essential features of the invention Art. 84; GL F-IV, 4.5.1
- Furthermore a claim is not supported by the description if it does not contain features which are explicitly presented in the description as being essential for carrying out the invention GL F-IV, 4.5.1

Interplay Art. 56 and 84 EPC in examination

- If the examiner can derive from the description the remaining feature(s) needed to carry out the invention, an objection that an **essential feature is missing** will be raised Art. 84
- If not, an objection of **lack of inventive step** will be raised Art. 56



Interplay Art. 84 vs Art. 83



Art. 83 vs Art. 84 EPC

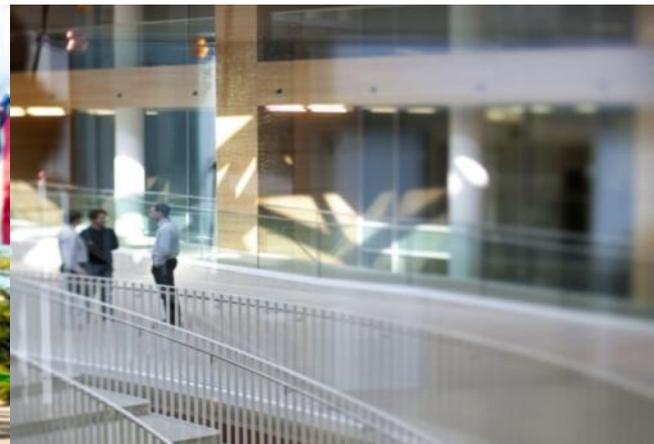
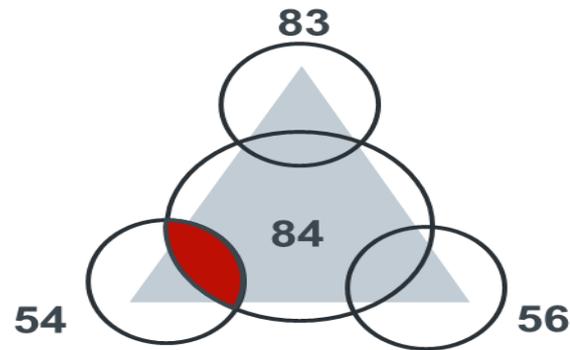
- The requirements of **Art. 83 EPC** are fulfilled if the application contains sufficient information to allow the person skilled in the art, using his common general knowledge, **to perform the invention over the whole area claimed without undue burden and without needing inventive skill** GL F-III, 1
- The requirements of **Art. 84 EPC** are fulfilled if the skilled person is able, on the basis of the information given in the application as filed, **to extend the particular teaching of the description to the whole of the field claimed** by using routine methods of experimentation or analysis GL F-IV, 6.3

Interplay Art. 83 and 84 EPC in examination

- Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with the invention's technical contribution to the art
- If, over the whole range claimed, the claim extends to technical subject-matter not made available to the person skilled in the art by the application as filed, **objections may be raised under both Art. 83 and 84 EPC** GL F-IV, 6.4
- In examination both objections could be raised at the same time



Interplay Art. 84 vs Art. 54



Art. 54 vs Art. 84 EPC

- The broader a claim, the easier
 - The claim is **not new** Art. 54
 - The claim is **not supported by the description** Art. 84
- Very broad claims are normally both not new and not supported by the description
- An examiner will raise an objection of novelty and/or an objection of clarity, depending on what is deemed more efficient to bring the examination procedure to a close

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