

## Clarity Before and After Grant

### Legal Background

Clarity is an important issue before and after the grant of a European Patent. The relevant provision relating to clarity is enshrined in [Art. 84](#) of the European Patent Convention (EPC), which reads: *"The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description."*

### Clarity Before Grant

The purpose of claims under the EPC is to enable the protection conferred to be determined ([G 2/88, OJ EPO 4/1990, pp. 99-100, reasons 2.5](#)). Art. 84 EPC signifies (i) that an independent claim should explicitly specify all of the essential features needed to define the invention, and that (ii) the meaning of these features should be clear for the person skilled in the art from the wording of the claim alone. These requirements serve the overriding purpose of legal certainty ([G 1/04, OJ EPO 5/2006, pp. 351-352 reasons 6.2](#)). In order to fulfil the requirements of Art. 84 EPC, applicants should keep in mind the following general principles as regards clarity:

- Claims must teach the exact distinctions delimiting the scope of protection;
- claims must not be contradictive;
- claims must be clear in themselves; and
- claims must indicate all the essential features of the claimed invention (essential features are all features necessary for solving the technical problem).

It is noted that complexity is not equivalent to lack of clarity. For instance a so-called Markush-formula describing numerous chemical compounds may be very complex, while it is still clear. Clarity merely requires that the scope of the claim is clear and unambiguous for the person skilled in the art. As regards the use of parameters, relative terms or words like "about" or "approximately", the following should be observed:

- Claims comprising parameters: Always include a reference to the method used to determine a parameter. Where several methods exist, choose a specific one, e.g. an industrial standard. If possible, the reference should be unambiguously determined (e.g. by referring to the publication date and/or version referred to).
- Claims comprising relative features: A relative feature may be admissible – "water-soluble" was more often considered admissible under Art. 84 EPC than not. However, an unclear term cannot be allowed in a claim if the term is essential having regard to

the invention. Equally, an unclear term cannot be used by the applicant to distinguish his invention from prior art. ([Guidelines, F-IV.4.6](#)).

- ➔ A word like "about" or "approximately" can only be admissible if it does not prevent the invention from being unambiguously distinguished from prior art ([Guidelines, F-IV.4.7](#)).
- ➔ The patent constitutes its own "word-book". It is therefore advised to define how the terms used in the patent should be understood somewhere in the description, in order to avoid or later be able to react to upcoming clarity objections.

## Clarity in Opposition Proceedings

Clarity is a prerequisite before grant, just like novelty, inventive step, sufficiency of disclosure, and disclosure in the application as filed. However, lack of clarity does not constitute a ground of opposition (contrary to lack of novelty, inventive step, sufficiency of disclosure, and disclosure in the application as filed).

If a claim gets amended during opposition proceedings, it may be examined for compliance with the requirements of Art. 84 EPC under Art. 101(3) EPC – but only when, and then only to the extent that the amendment introduces non-compliance with Art. 84 EPC ([G 3/14](#), catchword). The Enlarged Board at the European Patent Office made it clear that a granted patent claim may turn out not to comply with Art. 84 EPC, and that such non-compliance must be lived with. However, the Enlarged Board also pointed out that any lack of clarity of the claims may still be highly relevant in the opposition proceedings in that it can influence the decisions on issues under Art. 100 EPC, i.e. when novelty, inventive step, sufficiency of disclosure, and disclosure in the application as filed are disputed (cf. [G 3/14](#), reasons 55). Thus, clarity remains an important issue after grant, irrespective of whether the claims get amended or not.

## Clarity in German Nullity Proceedings

Clarity is not a nullity ground. It is accordingly not possible to invalidate a patent only because the claims are not clear.

The approach taken by the German Federal Court in one of its recent decisions (BGH X ZR 11/13 of 27 October 2015 – Fugenband) is comparable to that taken by the Enlarged Board of Appeal in its decision G 3/14 mentioned above. The corresponding guiding principle can be translated as follows: "*a) In the case of a limitation by the patent proprietor during nullity proceedings, an examination of clarity of the limited claim is, in any event, not allowable insofar as the possible unclarity was already comprised within the claims as granted*" (BGH X ZR 11/13 of 27 October 2015 – Fugenband, guiding principle a)). This means that a

feature comprised in a granted claim may not be examined for clarity in a nullity procedure, even if the claim is otherwise amended. The decision does not tell us, in how far clarity could be examined if a possible unclarity was introduced with an amendment. The decision, however, emphasizes, that the claim must *always* be interpreted, or construed, even if the wording of the claim appears to be unambiguous (cf. BGH X ZR 11/13 of 27 October 2015 – Fugenband, paragraphs 14, 15).

Another recent guiding principle in this respect can be translated as follows: *“One cannot desist from determining the subject-matter of the invention based on the ground that a feature is undefined and (therefore) unsuitable for delimiting the claimed invention from the prior art.”* (BGH X ZR 101/13 of 9 June 2015 – Polymerschaum II, guiding principle 2). What this means is that in a nullity procedure, the subject-matter of the claimed invention must be determined. The presence of an undefined (unclear) feature is no excuse for not doing so. In its reasoning, the German Federal Court made it clear that: (i) A granted patent claim has the character of a law; (ii) what falls under the scope of a granted claim is therefore a question of law; (iii) responding to a question of law is mandatory for the court concerned therewith, and the court may not desist from doing so only because the legal norm is unclear or its interpretation difficult (cf. BGH X ZR 101/13 of 9 June 2015 – Polymerschaum II, paragraph 25, with reference to further case-law).

In accordance with the foregoing, a German court must properly determine the subject-matter of a granted patent claim, before it can examine its validity. In doing so, the description is taken into account. This is a reason why it is generally advisable to define in the description how terms are to be understood.

## **Summary**

Claims giving rise to clarity objections may be refused during examination. In contrast thereto, lack of clarity in a granted claim does not constitute a ground for opposition or nullity. Clarity issues may nevertheless give rise to validity issues. Validity in opposition or nullity proceedings may depend on the meaning that is attributed to an unclear feature, which is considered a question of law in Germany. Courts concerned therewith will take the description into account. Applicants should bear this in mind when drafting their claims and description, and should aim at avoiding lack of clarity issues from the beginning.