

Article 84 EPC- clarity or confusion...

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Clarity at the EPO

Patent prosecution is relatively straightforward. Pen a description with some relevant drawings, draft some claims identifying where you see your monopoly, and then send it to the patent office. If the Examiner does not find that someone has done what you claim before, then you get a patent. If she does, you don't....

If only it was that easy. The challenges often arise though due to specific idiosyncrasies that differentiate one patent office from the other. In the case of the European Patent Office, EPO, one of the main difficulties that US practitioners face is an understanding of how the EPO deal with clarity.

Article 84¹ EPC details:

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

It evidently has four requirements, that the claims:

- define the matter for which protection is sought;
- are clear;
- are concise; and
- are supported by the description

What this actually means in practice changes with time, and in this regard the Guidelines for Examination are useful in that they reflect the current practice of the EPO. Being aware of how the EPO interprets the clarity provisions are important, it shines a light into what could otherwise be a confusing aspect of prosecution before the EPO.

Define the matter for which protection is sought

This is probably the least controversial aspect of Article 84 in that most practitioners understand that claims define the matter for which protection is sought. It is supplemented, however, by [Rule 43\(1\)](#)² EPC that details:

The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate, claims shall contain:

¹ <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ar84.html>

² <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/r43.html>

(a) statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, form part of the prior art;

(b) a characterising portion, beginning with the expression "characterised in that" or "characterised by" and specifying the technical features for which, in combination with the features stated under **sub-paragraph (a)**, protection is sought.

The use of the two-part form is a particular bugbear for US practitioners who are loathe to acknowledge within a claim features that overlap with the prior art. In this regard, the Guidelines can be helpful as Guidelines F IV 2.2³ details:

Rule 43(1)(a) and **(b)** define the two-part form which a claim must have "**wherever appropriate**"

Guidelines F IV 2.3⁴ supplements this

*However, as is indicated by **Rule 43**, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art.*

F IV 2.3.2⁵ further provides the Applicant with the opportunity to push back on an Examiner's request for the use of the two-part form:

*When examining whether or not a claim is to be put in the form provided for in **Rule 43(1)**, second sentence, it is important to assess whether this form is "appropriate". In this respect the purpose of the two-part form is to allow the skilled person to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of **Rule 42(1)(b)**, the two-part form is not insisted upon.*

It can be seen from these examples, that the Guidelines can be of assistance when dealing with Art 84 EPC clarity objections.

The claims shall be clear

This requires the claims to be clear to the person skilled in the art from the wording of the claim alone. The Guidelines detail F IV 4.6.1⁶

Relative or similar terms such as "thin", "wide" or "strong" constitute a potentially unclear element due to the fact that their meaning may change depending on the context. For these terms to be allowed, their meaning must be clear in the context of the whole disclosure of the application or patent

The same would be true for terms such as "upper", "lower", "higher" and the like where two claim integers are differentiated by their descriptor. In these instances, it is better practice to refer to the integers as first and second, and then differentiate the first and second in a relative clause- for example, the first element being provided at a higher frequency than the second element.

It is also important to avoid terms such as "approximately", "substantially" and "about". If they are used, then preferably have a definition of what is meant by these terms in the description.

Claiming by the result to be achieved can also be problematic- although the Guidelines again provide guidance as to permissible use case scenarios- F IV 4.10⁷ details

³ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_2_2.htm

⁴ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_2_3.htm

⁵ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_2_3_2.htm

⁶ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_4_6_1.htm

⁷ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_4_10.htm

However, they may be allowed if the invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation (see [T 68/85](#)).

The claims are concise

This aspect of the article is used to enforce the EPO's preference for a reduced number of claims- albeit the financial implications of more than 15 claims are often justification in themselves. It also allows the EPO Examiner to object to multiple independent claims in the same category, the use of alternative within a claim, and repetition in wording of dependent claims. The Guidelines F IV 5⁸ provide some insight as to the rationale behind these types of objections, and expressly states that

What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. The interests of the relevant public must also be borne in mind. The presentation of the claims must not make it unduly burdensome to determine the matter for which protection is sought ([T 79/91](#) and [T 246/91](#)).

It is worth appreciating that this aspect of the clarity provision can be used by the EPO in justifying a requirement for additional searches- the same passage of the Guidelines details:

Where it is found that the claims lack conciseness under [Art. 84](#), this may lead to the issuing of a partial European or partial supplementary European search report under [Rule 63](#) (see [B-VIII, 3.1](#) and [3.2](#)).

It is important therefore that when considering compliance with this requirement, that attention is made to both the form and the substance of the claims as presented.

Are supported by the Description

The interpretation of the above three aspects of Art 84 have been relatively consistent in recent times. What has changed recently are Art 84 objections pertaining to a lack of consistency between the claims and the description. Examiners are now pushing heavily that any inconsistency between what is claimed and what is described is removed. We are now consistently seeing objections based on the use of wording such as "embodiment" to describe aspects that may not necessarily describe all features of the independent claims. Objections based on the use of the words "may" and "can" are becoming commonplace. This shift in focus reflects internal policy at the EPO which is informed by the Board of Appeal Decision [T1808/06](#) which details:

*2. In order to meet the requirement of Article 84 EPC that the claims have to be supported by the description, the adaptation of the description to amended claims must be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear. **Any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised. Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated.***

This is currently cross-referenced in the Case Law II A 5.3⁹ and therefore represents a high ranking decision. The EPO have this month released a preview of their amended Guidelines¹⁰ that will enter into force March 1, 2021 and it

⁸ https://www.epo.org/law-practice/legal-texts/html/guidelines/ef_iv_5.htm

⁹ https://www.epo.org/law-practice/legal-texts/html/caselaw/2019/e/clr_ii_a_5_3.htm

¹⁰ <https://www.epo.org/law-practice/legal-texts/guidelines/guidelines-preview.html>

is clear that its significance is increasing. New Guidelines F-IV 4.3(iii)¹¹ explicitly cross references this decision, and details

(iii) that, embodiments in the description which are no longer covered by the independent claims must be deleted unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated (T 1808/06).

As further detailed in the additional amendments to the Guidelines, Examiners will now be obliged to be more stringent in their assessment of compliance with this aspect of the Article. For example, the same passage (F IV 4.3 (iii)) details that the use of generic statements are not sufficient:

It is not sufficient to use generic statements such as "embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention" without indicating which parts of the description are no longer covered. In addition, merely changing the wording "invention" to "disclosure" and/or the wording "embodiment" to "example", "aspect" or similar is not sufficient to clearly state that this part of the description does not fall under the scope of the claimed invention. It has to be explicitly specified that this part of the description does not describe part of the claimed invention.

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Part **H-V, 2.7**¹² further outlines that failure to amend the description per the above can, in itself, result in a summons to attend at oral proceedings:

If the applicant does not amend the description as required despite being asked to do so, the examining division's next action will be to issue summons to oral proceedings; for the time limit, E-III, 6(iii) applies.

It is evident that the use of Art 84 to enforce amendment to the description will only become more commonplace. With lengthy applications with complex subject matter and multiple aspects, this is not necessarily a trivial task.

Conclusion

Despite the apparent simplicity of what needs to be achieved in order to get a patent grant, there are sufficient challenges in convincing an Examiner on the substantive merits of an application on novelty and inventive step grounds, without falling foul of what could be considered formalistic objections. Unfortunately, it appears that the use of Art 84 objections is to become more and more common and the need to ensure that your application is in conformity with these requirements requires foreknowledge – if the application is drafted in anticipation of the potential objections then prosecution should be easier.

¹¹

[http://documents.epo.org/projects/babylon/eponet.nsf/0/379A5B17BA2DCE90C12586700048EB43/\\$File/epo_guidelines_for_examination_2021_part_f_draft_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/379A5B17BA2DCE90C12586700048EB43/$File/epo_guidelines_for_examination_2021_part_f_draft_en.pdf)

¹²

[http://documents.epo.org/projects/babylon/eponet.nsf/0/379A5B17BA2DCE90C12586700048EB43/\\$File/epo_guidelines_for_examination_2021_part_h_draft_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/379A5B17BA2DCE90C12586700048EB43/$File/epo_guidelines_for_examination_2021_part_h_draft_en.pdf)

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