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Claridad vs insuficiencia en el EPC

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1

Clarity vs Insufficiency in the European Patent Convention



- **Differences between Art. 83 and Art. 84 EPC and relevance thereof**
- **When does a lack of clarity lead to insufficiency?**
- **(Unclear) parameters in claims**

Art. 83 vs Art. 84 EPC

- Art. 83 EPC,

Disclosure of the invention

The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- Art. 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

Art. 83 vs Art. 84 EPC

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Art. 83 vs Art. 84 EPC

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- Art. 84 EPC
Claims

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Guidelines relating to Art. 83 EPC



- EPO Guidelines F-III 1: A detailed description of at least one way of carrying out the invention must be given.
- A single example may suffice, but where the claims cover a broad field, the application is not usually regarded as satisfying the requirements of Art. 83 unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts and evidence of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also F-IV, 6.3).

Case Law relating to Art. 83 EPC



- EPO Case Law Book II-C 4.4: The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed in the **whole range claimed** rather than only in some members of the claimed class to be obtained (T 409/91, OJ 1994, 653; T 435/91, OJ 1995, 188; and T 172/99). This is considered a question of fact. Sufficiency of disclosure thus presupposes that the skilled person is able to obtain **substantially all embodiments falling within the ambit of the claims**.

Guidelines relating to Art. 83 EPC and Art. 84 EPC



- EPO Guidelines F-III 11: An **ambiguity in the claims may lead to an insufficiency objection**. However, ambiguity also relates to the scope of the claims, i.e. Art. 84 (see F-IV, 4). Normally, therefore, **an ambiguity in a claim will lead to an objection under Art. 83 only if the whole scope of the claim is affected**, in the sense that it is impossible to carry out at all the invention defined therein. Otherwise an objection under Art. 84 is appropriate (see T 608/07, T 1811/13).
- In particular (see T 593/09), where a claim contains an ill-defined ("unclear", "ambiguous") parameter (see also F-IV, 4.11) and where, as a consequence, **the skilled person would not know whether he was working within or outside of the scope of the claim, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 83**.
- Nor is such a lack of clear definition necessarily a matter for objection under Art. 84 only.

Guidelines relating to Art. 83 EPC and Art. 84 EPC



- EPO Guidelines F-IV 4.11: The requirements of Art. 84 with regard to the characterisation of a product by parameters can be summarised as follows (see T 849/11):
 - (i) the claims must **be clear in themselves** when read by the skilled person (not including knowledge derived from the description);
 - (ii) the method for measuring a parameter (or at least a reference thereto) must appear completely in the claim itself; and
 - (iii) an applicant who chooses to define the scope of the claim by parameters needs to ensure that the skilled person can **easily and unambiguously verify whether they are working inside or outside the scope of the claim.**
- EPO Guidelines F-IV 4.11.1: Use of unusual parameters of type (ii) is allowable if it is evident from the application that the skilled person would face no difficulty in carrying out the presented tests and would thereby be able to establish the exact meaning of the parameter and to make a meaningful comparison with the prior art.

Guidelines relating to Art. 83 EPC and Art. 84 EPC



- EPO Guidelines F-III 11: What is decisive for establishing insufficiency within the meaning of Art. 83 is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures necessary to solve the problem underlying the application at issue, e.g. see T 61/14.
- There is a delicate balance between Art. 83 and Art. 84, which has to be assessed on the merits of each individual case. Care has therefore to be taken in opposition that an insufficiency objection is not merely a hidden objection under Art. 84, especially in the case of ambiguities in the claims (T 608/07). On the other hand, even though lack of support/clarity is not a ground for opposition (see also F-IV, 6.4), a problem related to it may in fact be of concern under Art. 83.

Relevance of distinction between Art. 83 and 84 EPC



- Before grant: Examiner might object under both Art. 83 and 84 EPC
- After grant:
 - lack of clarity / Art. 84 is not ground for Opposition (Art. 100 EPC, exhaustive list)
 - G3 / 14: in Opposition, claims may be examined for clarity only to the extent that a lack of clarity was introduced through an amendment of the claims during Opposition. Pre-existing lack of clarity cannot be examined
 - Nullity/revocation procedures of validated European patents: lack of clarity is not a ground (Art . 138 EPC)
 - Burden of proof for insufficiency is on Opponent
- Lack of clarity might be used to argue insufficiency or lack of novelty / inventive step

Clarity vs Insufficiency in the European Patent Convention



- **Differences between Art. 83 and Art. 84 EPC and relevance thereof**
- **When does a lack of clarity lead to insufficiency?**
- **(Unclear) parameters in claims**

When does a lack of clarity lead to insufficiency?



- Taking description into account for interpretation of claims, or not?
- Broad claims

Interpreting claims



- T 432/10: There is insufficiency of disclosure if the skilled person, taking into account the entire teaching of the patent, is not able to rework an invention which is defined in the claims in a **completely clear and comprehensible manner**, unless he disregards a meaningful feature thereof.

"1. A non-therapeutic process for improving the glucose metabolism of a companion animal comprising the steps of:
feeding said animal a diet containing from 1-11 weight percent of supplemental total dietary fiber,
said supplemental total dietary fiber consisting of a blend of beet pulp, fructooligosaccharides and gum talha or gum arabic; and
maintaining said animal on said diet for a sufficient period of time to allow said blend to ferment in the gastrointestinal tract of said animal."

Interpreting claims

- T 553/11: *A pulverized water-absorbant resin powder of irregular shape, of which the neighbourhood of the surface is crosslinked, of which the average particle diameter is in a range of from 150 to 600 μm , wherein ..., and which has a bulk density (measured according to JIS K-3362) of not lower than 0.74 (g/ml) and ...*
- 2.1.2 Independent claim 1 does not however contain the feature of the particle surfaces being ground and thus smoothed. This claim therefore also covers non-smoothed particles having inter alia a bulk density not lower than 0.74 g/ml.
- 2.1.3 As was not disputed by the respondent, there is no teaching in the patent as to how to prepare such non-smoothed particles; nor does such a teaching form part of the skilled person's common general knowledge. Therefore, on the basis of the patent and common general knowledge, **the skilled person is not able to prepare non-smoothed particles according to claim 1** having the required bulk density. This part of the invention is thus insufficiently disclosed.
- if the proprietor wishes to argue for a narrow scope of a claim, this should be on the basis of the ordinary wording of the claim, and not on the basis of something appearing only in the description (following T 1404/05).

Interpreting claims



- T 1404/05: Where a claim is vaguely formulated and leaves several constructions open as possibilities, and on one of these constructions part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Article 100(b) EPC. **The mere fact that the description makes clear that this latter construction is the one intended does not mean that the claim can be treated as being confined to this latter construction.** Article 69 EPC and its protocol were intended to assist a patent proprietor in contending for a broader interpretation of a claim than perhaps its wording warranted, not for cutting down the scope of a claim
- T 681/01: the normal rule of claim construction is that the terms used in a claim should be given their **ordinary meaning in the context of the claim** in which they appear. **The description may not be used to rewrite the claim** and redefine the technical features required by the claim in a way not warranted by the wording of the claim itself. In particular **the description cannot be relied on to exclude subject-matter from the claim which the ordinary meaning of the terms used would include** as part of what is claimed.

Interpreting claims



- T 430/10: if the alleged lack-of-clarity was that a feature could be interpreted narrowly or broadly, the sufficiency requirements were met if the skilled person, applying the broad interpretation, was at least able to carry out all embodiments covered by the claims.

Interpreting claims

- T 862/11: Assessment of an effect:
- (a) **Unclear** claims: Insofar as inventions are defined by claims that have unclear characteristics, e.g. contain unclear parameters, which are not clarified by the description, **the invention can possibly only be understood by the effect** to be achieved. This effect, which must therefore be taken into account, is then assessed under Article 83 EPC in order to assess the feasibility of the invention.
- (b) **Clear** claims:
 - (i) Effect in the claim: As far as the claim is clearly defined, the effect should only be considered when assessing the feasibility if it is **explicitly present in the claim**.
 - (ii) Effect not present in the claim: Insofar as the claim is clearly defined and the effect is not present in the claim, the question of whether the effect is achieved is not relevant for Article 83 EPC. Rather, the question of whether the effect is achieved then becomes relevant under Article 56 when assessing the success of the solution.

Broad claims



- T 521/12: The skilled person wishing to implement the claimed invention reads the claims in a **technically sensible manner**. An objection of insufficient disclosure of the invention is therefore not to be based on embodiments that are meaningless and not consistent with the teaching of the application as a whole (cited in Guidelines).

- Examples: open-ended ranges T 487/89: "*1. Polyhexamethylene adipamide fiber having a tenacity of at least 883 mN/tex (10 g/d) and a **formic acid relative viscosity of at least 50**, characterized by (a) a formic acid relative viscosity of 70 to 150, (b) a coefficient of stability of tie molecule of at most 0.20, (c) a shrinkage percentage of at most 4% with no load at 160°C in dry heat for 30 minutes; and (d) **a toughness of at least 17.66 N/tex (200 g/d)%**."*

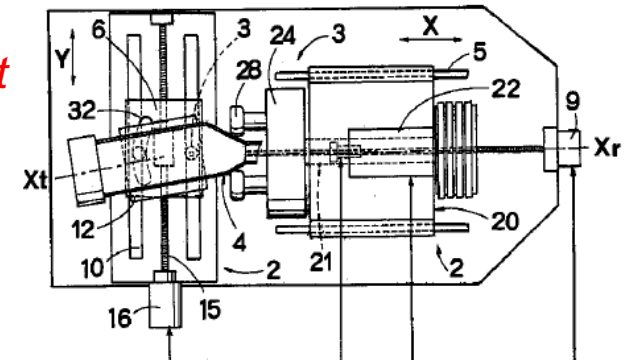
Broad claims



T 1018/05: 1. A method for forming an end portion of a cylindrical member (4) by spinning, said method comprising the steps of: supporting at least one roller (28) to be radially moved to and from a main shaft (21); supporting said cylindrical member (4) to position the central axis (X_t) thereof on a plane including the central axis (X_r) of said main shaft; and

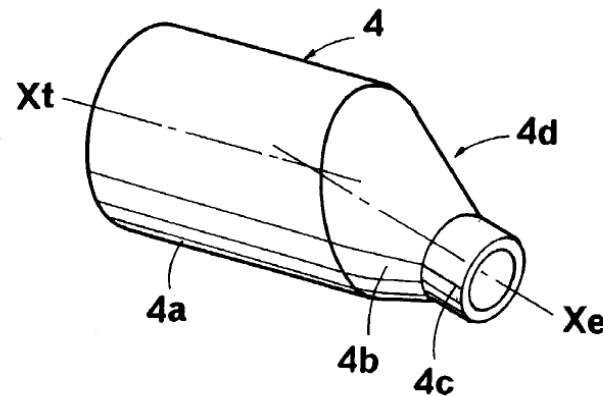
driving at least one of said cylindrical member (4) and said at least one roller (28) to be rotated relative to each other about a forming target axis (X_e) with said at least one roller (28) radially moved to be in contact with the outer side of one end portion of said cylindrical member (4), to form the one end portion into a reduced diameter portion (4d),

characterized in that forming target axis (X_e) is an oblique axis (X_e) inclined against the central axis (X_t) of said cylindrical member (4), so that said reduced diameter portion (4d) according to has the oblique axis (X_e) as its axis."



Broad claims

- T 1018/05 (cont.): Independent claim 1 covers three variants of rotating the cylindrical member and the roller relative to each other, namely: (a) the cylinder is fixed and the roller rotates; (b) the cylinder rotates and the roller is fixed; (c) both the cylinder and the roller rotate;
- It is not disputed that the embodiments of the invention described in the patent in suit only relate to variant (a). Working tables combining various linear and rotational axes were generally known in the technical field of machine tools and that variations from a specific design and adaptations to a particular use were matters of normal design procedure.



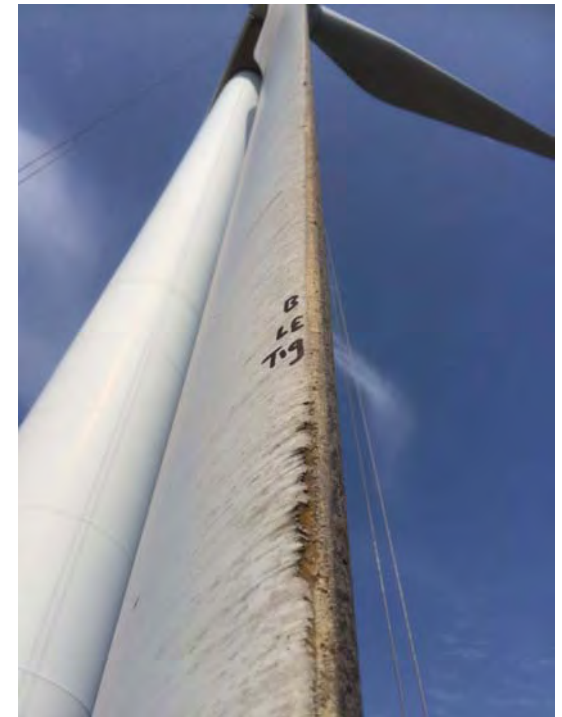
Broad claims

- T 1018/05 (cont.): The Opposition Division further held that the patent only disclosed how to carry out the first variant (a) for the particular case in which the forming target axis X_e and the main axis X_r have been set such that they coincide and that the invention could not be carried out when these axes were in the position according to Fig. 6, i.e. at a distance from each other.
- ...due to the limited number of variables involved in the process (in particular the tube specifications, namely material, wall thickness and diameter; inclination and position of the forming target axis; deformation speed; characteristics of the apparatus used), the skilled person only needs to apply straightforward considerations to understand what are the practical limitations of the claimed method and, as a consequence, to establish the range of application of the claimed method with sufficient certainty.
- This should not be understood as also referring to those variants falling under the literal wording of the claim but which the skilled person would immediately exclude as being clearly outside the scope of practical application of the claimed subject matter, for example, claims including an open ended range for a parameter where it was clear for a skilled person that the open-ended range was limited in practice. Values of the parameter not obtainable in practice would not be regarded by the skilled person as being covered by the claims and thus could not justify an objection of insufficiency of disclosure ().

Interpreting claims



- EP 2 818 698: Method of operating a wind turbine comprising a rotor with a plurality of blades, each blade having a default surface condition, ...
 - predefining a first and a second set of parameters, the first set of parameters being suitable for the default surface condition and the second set of parameters being suitable for **any other surface condition different from default surface condition**,
 - detecting a change in the surface condition of a blade from the default surface condition, and
 - changing from the first set of parameters to the second set of parameters of the blade such that the blade performs substantially according to the representative theoretical lift coefficient curve.
-
- Bullet hole, “single insect”?



When does a lack of clarity lead to insufficiency?



- Taking description into account for interpretation of claims, or not?
 - If claims are unclear and a feature can be interpreted in multiple ways, then skilled person should be able to practice the invention for all those ways
 - Art. 69 EPC and protocol were intended to allow proprietor to interpret claim broader, not narrower. If claims are clear, then don't interpret claims contrary to ordinary meaning, just to resolve insufficiency problem
 - If claims are clear, and effect not mentioned in claim: effect is irrelevant for Art. 83 EPC
 - If claims are not clear, it depends....
- Broad claims
 - Disclosure must allow the skilled person to practice the invention over breadth of the claims, but
 - Skilled person would disregard meaningless embodiments

Clarity vs Insufficiency in the European Patent Convention



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Unclear or exotic parameters in a claim

- Board 3.2.06 not knowing whether in the “forbidden area” of the claim or not leads to insufficiency of disclosure
- Board 3.2.05 “forbidden area” relates to Art. 84 EPC, not Art. 83 EPC
- Board 3.3.09, Guidelines, T 593/09: “whether the unclear parameter of the claim was so ill-defined that the skilled person would not have been able, on the basis of the disclosure as a whole and using their common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable compounds) necessary to solve the problem underlying the patent at issue”
- Board 3.3.03, “is not a suitable criterion for assessing sufficiency of disclosure when the problem or an effect derivable from it are not explicitly or implicitly part of the definition of the claimed subject-matter”

Sources: *Just Patent Law* blog; *Patent my French* blog

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Forbidden area, Board 3.2.06



- T 611/02: 1. *A dry, disposable skin cleansing article comprising a substrate having a major surface for rubbing on the skin, characterized in that said substrate is a non woven substrate hydroentangled throughout its whole thickness, having a basis weight of from 20 to 150 g/m², wherein **the tensile strength of said substrate is of no more than 45 N in any direction, as measured according to the method described herein**, comprising at least 60% of fibres that have a length of at least 2 cm, preferably 3 to 5 cm, and that extend from the surface plane of the substrate as a result of said rubbing whilst remaining attached to the substrate.*
- In the present case, this means that the skilled person must be in a position to establish whether the **tensile strength which is measured for a given substrate can be effectively correlated to the limit of 45 N referred to in claim 1**.
- In particular, there is no disclosure of the rate of extension to be applied during the test. It is undisputed that this parameter has an influence on the measured force, as indeed confirmed by D1 which indicates that the "edana" tensile strength test must be carried out at a specified constant rate of extension.

Forbidden area, Board 3.2.06

- T 252/02: 1. "A personal care article comprising a nonwoven fabric laminate (12;13;15), the nonwoven fabric laminate (12;13;15) comprising: a) a nonwoven component layer (32) ...and a nonwoven component layer (36) ..., wherein said layers (32;36) are intermittently bonded in a face-to-face relationship for a total basis weight not to exceed about 55 g/m² (gsm) and the percent of the weight of fine fibers layer to the laminate weight is at least 20%, and wherein said laminate (12;13;15) **has a cup crush peak load value of no more than 150 grams, a cup crush energy value of no more than 2250 g/mm**, a hydrostatic head of at least 15 cm, and a porosity of at least 0.0236 m³/s (50 scfm).".



Forbidden area, Board 3.2.06



•In order to carry out the invention, the skilled person must be in a position to establish whether a product falls within the area covered by the claim and to reliably prepare the claimed product (see e.g. T 256/87). In the present case, ... this means that **the skilled person must be in a position to establish whether the cup crush peak load value and the cup crush energy value which is measured for a given laminate can be effectively correlated to the respective limits of 150 grams and 2250 g/mm**. This presupposes that the skilled person utilizes a method for determining said values which is either the same or one that gives essentially the same results as the method which has been used as a basis for arriving at establishing these limits in the patent in suit (see also T 387/01).

•In accordance with this disclosure, when putting in practice the test procedure the skilled person must shape a piece of fabric into an approximately 6.5 cm diameter opening by a 6.5 cm tall inverted cup. However, no information is given in the patent in suit about how the piece of fabric is shaped. ... different geometrical forms are obtained (e.g. cylindrical, frustoconical, with rounded or flat top), with different amounts and arrangements of wrinkles and pleats in the walls of the cup (depending on how the fabric forming the walls is stretched and/or pleated). **Since these factors affect the strength of the cup, different results are obtained for a given fabric depending on the arbitrary choice made by the skilled person.**

Forbidden area only relates to Art. 84, Board 3.3.10



- T 347/10: One-component sealant based on a dispersion of polyacrylates in an aqueous medium, the sealant has 0 to 10 parts by weight in the wet state, volatile organic compounds (VOC) in 100 parts by weight of the sealant, and has a self-adhesive property in the dry state, in which **a running length of a ball when measured according to "Test Methods for Pressure-Sensitive Adhesives, 6**(th) Edition, Pressure sensitive tape counsel, Itasca III" is less than 30 cm.**"
- However, it should be noted that the question of whether the person skilled in the art knows whether he is working within or outside the claimed area is **NOT** a question of sufficient disclosure, but rather a matter of Article 84 EPC.
- **Even if the measurement results of the RBT test are uncertain in the border area of the claim, the skilled person can still produce the claimed sealing compounds,** especially since the patent in suit, specifies further process parameters for carrying out the RBT measurement method (see T 396 / 02, reasons for decision, points 4.8.2 and 4.8.3; not published in OJ EPO). The respondents' arguments I and II cannot therefore be accepted.

Board 3.2.05



- T 1811/13: It may be said that today there is agreement or at least a clearly predominant opinion among the boards **that the definition of the "forbidden area" of a claim should not be considered as a matter related to Article 83 EPC**. The present board shares this opinion.
- In other words, it is not sufficient to establish a lack of clarity of the claims for establishing lack of compliance with Article 83 EPC 1973; **it is necessary to show that the lack of clarity affects the patent as a whole (i.e. not only the claims)** and that it is such that the skilled person - who can avail himself of the description and his common general knowledge - is hindered from carrying out the invention. Appellant II has not shown that this is the case here.

Board 3.2.06 response

- T 626/14: "*An absorbent body (52, AB) of a body fluid absorbing article, ... the absorbent body has a density of not less than 150 kg/m³ and a thickness of 1.0 to 2.0 mm by performing the thinning by the pressurization after the accumulating and the forming, and*"
- Being easily compressible, the pressure used in any test method for measuring thickness of such fibrous composites is also of utmost importance, because the thickness varies inversely with the pressure applied. A requirement for repeatable thickness measurement is thus to have a predefined pressure applied to the specimen, ...
- Since the Board cites T464/05 above, it is perhaps important at this juncture to mention briefly that **two recent decisions** (T1811/13 and T647/15, albeit with essentially identical reasoning as regards objections made under Article 83 EPC) **have sought to question the way in which Article 83 EPC objections were reasoned in decisions such as T464/05** mentioned supra. Yet, T1811/13 and T647/15 themselves concentrate only on an individual aspect in e.g. T464/05, namely 'the area covered by the claim' without addressing the actual findings in that decision regarding the issue of Article 83 EPC.

Board 3.2.06 response

- T 626/14 (cont.): In fact, T464/05 draws a distinction between the two objections under Articles 83 and 84 EPC respectively and explains the significance thereof. For example, T464/05 considers in Reasons 3.3.2 not the boundaries of the claimed subject-matter which was the subject of T1811/13 and T647/15, but the lack of indications in the patent concerning the measurement of a particular parameter. This is stated in T464/05 as resulting in 'an undue burden for the skilled person trying to reproduce the invention'.
- Likewise, in Reasons 3.2, the crucial issue in respect of sufficiency of disclosure concerns the issue of whether a skilled person 'is capable of reliably measuring (the) parameter'. Thus, T1811/13 and T647/15 do not cause the present Board to see anything which would undermine the reasoning in T464/05 concerning Article 83 EPC.
- In the sense that a parameter to be measured was at issue in T464/05 with regard to Article 83 EPC, the Board in the present case is faced with the same issue, i.e. the undue burden created by the lack of any information allowing the skilled person to reliably measure the defined thickness. This, as explained *supra*, results in the skilled person being unable to know whether he has arrived at the invention or not, such that the invention is not sufficiently clearly and completely disclosed.

Board 3.2.05 counter

- T 250/15: "A method of manufacturing a composite article comprising at least: a step of impregnating a reinforcing fabric with a polyamide composition in the molten state, having a melt viscosity η of between 1 and 50 Pa.s, *the polyamide having a molecular mass M_n greater than 8000*; said reinforcing fabric being maintained at a temperature of plus or minus 50 ° C relative to the melting temperature of said polyamide; ...
- The patent in suit did not specify the method to be used to determine the molecular weight in the context of the present invention.
- In addition, it is not disputed that the person skilled in the art knows at least two methods generally used to determine this parameter, namely permeable gel chromatography (GPC) and terminal group analysis. In this regard, the number average molecular weight parameter greater than 8000, which, as such, is neither vague nor imprecise, does not preclude the execution of the invention by man of the job. *The possible uncertainties concerning possible deviations in the measurement results obtained by the various known methods do not affect the ability of a person skilled in the art to choose an appropriate polyamide on the basis of his knowledge and the information given in the patent.*

Board 3.2.05 counter



- T 250/15 (cont.): For the sake of completeness, it is noted that, unlike T 593/09, the parameter claimed in the present case is not obscure. In addition, and differently from T 466/05, the claim at issue clearly defines which molecular weight it is, namely the number average molecular weight M_n . With regard to decision T 225/93, it is clear that finding a polyamide of a number average molecular mass greater than 8000 does not require excessive effort or inventive step for the skilled person.
- The present chamber notes that decision T 626/14, like case T 464/05, concerns a particular constellation in a certain technical area. The case here is however different in that the parameter of the molecular mass in number M_n is aimed at a property clearly defined and inherent in the material. Furthermore, it has not been disputed that a person skilled in the art has a limited number of suitable and generally known measurement methods.
- Consequently, decision T 626/14 cannot call into question the conclusions set out above with regard to the sufficiency of the statement of the invention and the request for referral to the Enlarged Board of Appeal presented by the respondent I must be dismissed.

T 593/09 (cited in Guidelines) Board 3.3.09



- Claim 1: 1. *Polyethylene terephthalate resin covered metal sheet, wherein a biaxially oriented film consisting of polyethylene terephthalate having a **low temperature crystallization temperature** ranging from 130 to 165°C is covered at least on one side of a metal sheet by heat bonding.*“
- The board in particular observed that the skilled person would not know what heating rate to apply when determining the LTC temperature in the opposed patent and, depending on the heating rate, different LTC temperatures would be obtained. The board stated that in view of this, it would have to be discussed whether claim 1 covered embodiments that did not result in the effects aimed at in the opposed patent.
- 2.3 It thus follows from the opposed patent that an LTC temperature of 130-165°C, ie as required by claim 1, is crucial in order to solve the problem addressed in the opposed patent, ie to obtain a low-cost polyethylene terephthalate covered metal sheet suitable to be formed into a metal container and having excellent peel, permeation and impact resistance.

T 593/09 (cited in Guidelines) Board 3.3.09



- 2.5 As is evidenced by A3 (...), the values obtained for the LTC temperature shift by nearly 21°C if the heating rate applied to determine the LTC temperature (in the step denoted as "subsequent heating" above) is changed from 2°C to 16°C/min. **This implies that, depending on the heating rate applied, the LTC temperature can vary by more than 21°C for one and the same polyethylene terephthalate, which variation represents more than 60% of the LTC temperature range as claimed (130°C-165°C).**
- 3.5 In summary, neither from the opposed patent as filed nor on the basis of his common general knowledge at the filing date of the opposed patent, would the skilled person know what heating rate to apply when determining the LTC temperature.
- 4.1 Though arriving at the same conclusion as the opposition division (point 3 of the Reasons of the opposition division's decision), the board does not share the opposition division's reasoning that led to this conclusion, namely that claim 1 of the patent did not comply with Article 83 EPC because the skilled person did not have enough information when having to decide whether a specific polyethylene terephthalate **"falls into the claimed range or not"**.

T 593/09 (cited in Guidelines) Board 3.3.09



- 4.1.2 The requirement of sufficient or "enabling" disclosure in the sense of Article 83 EPC is, as such, **different from and independent from the clarity requirement** pursuant to Article 84 EPC, namely that the claims, which define the matter for which protection is sought, "shall be clear and concise".
- This distinction eg underlies decision T 1062/98: "Firstly, the question whether the skilled person is capable of determining whether a certain feature would be infringing a feature claimed is not a matter of sufficiency of disclosure as required by Article 83 EPC. ... Whether there is infringement is ... a matter to be decided by the national courts. Secondly, the determination of the scope of the claim ... relates in fact to the question whether the claims properly define the matter for which protection is sought."
- What is decisive for establishing insufficiency within the meaning of Article 83 EPC is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (eg selection of suitable compounds) necessary to solve the problem underlying the patent at issue.

T 1845/14 Board 3.3.03



- **Headnote:** In case of an unclear parameter defined in a claim whose values required in the claim are indicated in the specification to be essential to solving the problem underlying the patent at issue, **the ability of the skilled person to solve that problem by reproducing what is claimed is not a suitable criterion for assessing sufficiency of disclosure when the problem or an effect derivable from it are not explicitly or implicitly part of the definition of the claimed subject-matter** (point 9.8 of the Reasons).
- The ambiguous definition of a parameter in a claim may result in **the scope of the claim to be broader than the patentee might have intended**. In such a case the question arises whether the teaching of the patent in suit, which was directed to the claimed subject-matter having regard to a specific meaning of that parameter (which, however, was omitted), **would nevertheless have enabled the skilled person to carry out the invention** outside of the scope intended by the patentee, using common general knowledge and a reasonable amount of experimentation.

Conclusions exotic parameters



- Sufficient divergence for referral to Enlarged Board of Appeal?
- For unclear parameters, check your Board!

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