

invention. It was clear from the claims, when read in the light of the description, which peptides were suitable for the invention.

Likewise, in T. 860/93 (OJ 1995, 47) the board assumed that the description might be used to determine whether the claims were clear. In so doing it took its cue from the general legal principle whereby the best interpretation is that made from what precedes and what follows. It accepted the reasoning in T. 454/89 (see below), namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory, but not in general (see also T. 884/93, T. 287/97). In several decisions the boards stated that a patent may be its own dictionary (see in this chapter II.A.6.3.3).

However, a number of decisions point out the limits to the use of the description and drawings in the examination relating to the clarity requirement.

T. 2/80 (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also T. 412/03, T. 129/13). In decision T. 454/89 the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision T. 760/90.

In T. 1129/97 (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ("low alkyl") was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under Art. 84 EPC 1973 concerned only the claims, and therefore – according to the established case law of the EPO boards of appeal – required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC 1973 the description was to be used to interpret the claims. But Art. 69 EPC 1973 concerned only the extent of protection where this was at issue, e.g. with third parties, and not (as in Art. 84 EPC 1973) the definition of the matter to be protected by a claim. Confirmed in T. 56/04, T. 64/03, T. 1265/13.

In T. 49/99 the board held that since clarity was a claim requirement, a clarity deficiency in the claim wording was not rectified by the fact that the description and the drawings would help the reader to understand the technical subject-matter that the claim was intended to define. See also T. 623/13.