

have to be established by the reader of the claim. Leaving room for such an assessment by the reader inevitably introduced uncertainty as to the matter for which protection was sought. Hence a lack of clarity arose, which was in breach of Art. 84 EPC. Further, the fact that the wording chosen for the disclaimer was the same as the one used in decision G 1/07 for describing a surgical method did not mean that the claim fulfilled the clarity requirements of Art. 84 EPC. This had to be handled on a case-by-case basis.

In T 1916/19, which related to a non-therapeutic method of providing an anti-microbial effect to skin, the board considered that the claim was clear since such non-therapeutic methods existed and could be identified. In particular the claims were not self-contradictory and the claimed scope was not rendered void by the disclaimer, unlike in T 1635/09 or T 767/12.

(iii) Hiding a disclaimer

In the claim at issue in T 201/99 the appellants (patent proprietors) replaced the range of treatment times "1-10 minutes" by "1-6 minutes". They argued that the range of 1 to 6 minutes should be regarded as disclaiming a sub-range of more than 6 to 10. The board, however, emphasised that Enlarged Board of Appeal decisions G 1/03 and G 2/03 (point 3 of the Reasons) explicitly ruled out the possibility of hiding a disclaimer by using an undisclosed positive feature defining the difference between the original claim and the anticipation, since this would affect the transparency of the patent (Art. 84 EPC 1973).

(iv) Interpretation of terms

In T 286/06 the board held that it derived from the purpose of Art. 84 EPC 1973 to ensure legal certainty, that the wording of a claim could not be interpreted by taking into consideration the teaching of further publications not referred to explicitly in the original documents of the application as being relevant for the interpretation of terms used in the description or in the claims. This applied also in the case of a disclaimer, as the only justification for its introduction in a claim was to exclude a novelty-destroying disclosure and it did not represent an opportunity for the applicant or patent proprietor to reshape its claims arbitrarily (see G 1/03, OJ 2004, 413). The board evaluated the clarity of claim 1, considering what the skilled person would have understood in reading the claim only, taking into consideration common general knowledge. The board concluded that the wording of claim 1 was unclear.

(v) Reference to a trademark

In T 447/10, the board stated that according to the established case law of the boards of appeal, the characterisation of a product in a claim by reference to a trade mark lacked clarity because the product's composition could change over the term of the patent (see T 762/90, T 270/11, T 2030/13). In the case at issue, the disclaimer excluding a composition sold under a trade mark was of an uncertain scope, such that the subject-matter of claim 1 in the requests in question lacked clarity.

(vi) Disclaimer removing more than strictly necessary to restore novelty for clarity reasons