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**Using AI to redefine patent
quality and service delivery**
PAGE 7

**An interview with the EAPO
President Grigory Ivliev**
PAGE 46

**Patent strategies for mitigating
the impact of the UPC**
PAGE 69

Inventing unclarity: the expanding reach of Article 84 EPC

Jan Goering of Boehmert & Boehmert argues that Article 84 EPC clarity objections have expanded beyond their intended procedural role in European patent examination. Drawing on the EPC's legislative history and international patent frameworks, Jan contends that clarity should facilitate examination rather than operate as a substantive tool for narrowing otherwise allowable claims. He warns that overuse of clarity objections risks shifting attention from technical contribution to semantic precision, and might even breach the institutional division between examiners and judges.



Jan Goering

“The EPC entrusts examining divisions with deciding whether an invention merits a patent, while leaving the ultimate determination of the patent’s scope to the courts.”

For decades, the European patent system has been admired for its rigorous and technically sophisticated examination. The European Patent Office's (EPO) reputation rests on its ability to distinguish genuine innovation from the prior art through a careful assessment of novelty and inventive step. However, one requirement that occupies only a modest place in the legal framework has gradually assumed a disproportionate importance during prosecution.

Clarity under Article 84 of the European Patent Convention (EPC) has gained an ever more prominent presence in the dialogue between applicant and examiner, often at the expense of attention to the underlying technical contribution. For many applicants familiar with prosecution before the IP5 group, including the USPTO, the JPO, the KIPO, and the CNIPA, this emphasis is difficult to understand. European examination practice appears to be drifting away from that of many other major patent offices.

Applicants are often surprised that

objections based on Article 84 EPC can become a major issue during prosecution, even where the invention itself is technically sound and encounters little difficulty elsewhere. The result is increased prosecution costs and the perception that formal issues are being elevated above substantive patent law.

The perceived imbalance is increasingly difficult to justify and to reconcile with the practical realities of patent litigation, where courts routinely interpret claims through the eyes of the skilled person rather than demanding semantic precision.

What Article 84 EPC was meant to do

This raises an obvious question. Was Article 84 ever intended to carry such weight?

History offers little support for that proposition.

The EPC was developed in parallel with the Patent Cooperation Treaty (PCT). Drafts for the EPC, according to which “the specification

must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art," resemble the wording of Article 5 PCT, further elaborating that "The specification shall conclude with one or more claims defining the protection applied for."

The requirement ultimately set out in Article 84 EPC was derived from initial drafts of the implementing regulations "regarding formal requirements of different parts of a patent application" in various articles concerning "form of the request for grant of a patent," "form of the drawings," or "form and content of claims."

It is evident regarding the conception of Article 84 EPC that its authors intended to draw a line between the different parts of a patent application, namely the claims, the description and drawings, and the request. Initial precursors of Article 84 EPC essentially consist of the requirement that claims should not contain references to the description and drawings. As the Travaux Préparatoires show, it was agreed that the article concerning the form and content of the claims should not immediately jump to this issue but rather commence with a general definition of what "patent claims" entail. It was initially suggested that "The patent claims embody the fundamental principle of the invention and, where applicable, the secondary aspects that characterise that principle."

To achieve a more general definition, "to state the essential purpose of the patent claims, which is to specify the element for which the inventor seeks protection," the redactional sub-committee was tasked with additional polishing due to the farsighted concern that "A definition that goes into too much detail would lead to numerous difficulties."

Against this background, the following wording was eventually adopted in the preliminary draft of April 1971, corresponding to Article 6 PCT: "The claims shall define the matter for which protection is sought. They shall be clear and concise and be fully supported by the description."

Subsequent discussions in the legislative bodies were focused on the relevance of the claims' support through the description. The term "fully" was deleted prior to ratification. Before the revision of the Convention, concerns were found to be adequately covered through Article 83 EPC. The conclusion of the legislative discussion rejects giving Article 84 EPC a more important role, finding that "the potential for abuse would be considerable."

Nothing in the Travaux Préparatoires of the original EPC or its revision suggests that the

provision of Article 84 EPC was intended to become a substantive hurdle comparable to novelty or inventive step.

The international benchmark

An examination of the international framework is likewise instructive.

The Paris Convention and the TRIPS Agreement, the major international treaties forming the foundation of the modern patent system, contain no independent requirement for patent claims to satisfy a "clarity" standard comparable to that set out in Article 84 EPC. They require disclosure sufficient to enable the invention and recognize the traditional conditions for patentability, but they do not elevate linguistic precision to an independent legal principle. The focus remains technical. The benchmark is whether the skilled person can practice the invention – not whether every linguistic ambiguity has been eliminated. This reflects an important policy choice. Patent law is concerned with the communication of technical knowledge. Language is merely the vehicle through which that knowledge is conveyed – the international standard concerns technical understanding rather than semantic perfection.

The implementation of Article 6 PCT in accordance with paragraphs 9.34 – 9.39 of the PCT International Search and Preliminary Examination Guidelines maintains the treatment of clarity subordinate to the substantive requirements of patentability.

The "clarity" requirement serves an important but limited procedural function. It ensures that the applicant defines the matter for which protection is sought with sufficient precision to enable the examination to proceed and the public to understand.

Lack of clarity is excluded from the grounds on which a granted European patent may be revoked. A patent remains enforceable even though its claims could, in hindsight, have been drafted more elegantly. This was no legislative oversight. It reflects a deliberate choice during both the conception and the revision of the EPC that clarity should facilitate examination rather than determine the validity of granted rights.

Yet examination practice has gradually moved in another direction. Over the past decades, Article 84 EPC has evolved from an auxiliary drafting provision into one of the most frequently invoked objections during prosecution. It is no longer unusual for applicants to spend considerably more effort defending the wording of otherwise patentable claims than addressing the substantive requirements of Articles 54 and 56 EPC.

The benchmark is whether the skilled person can practice the invention – not whether every linguistic ambiguity has been eliminated.

The Enlarged Board's decision in G 1/24 sent an encouraging signal by placing renewed emphasis on a technically meaningful interpretation of patent claims. However, early indications suggest that the underlying tendency has by no means disappeared. Recent decisions such as T 1420/24 appear to be indicative of a trend expand on T 68/85 in order to scrutinize functional claim language even more by considering functional features, as a matter of principle, as objectionable "results to be achieved."

If this tendency were to become established practice, it would represent more than a refinement of the clarity doctrine. Such an approach would constitute a significant departure from established case law, beginning with T 238/88, which has long recognized that broad, functional features are entirely appropriate when the skilled person is provided with sufficient technical information. It would alter the balance between legal certainty and effective patent protection that Boards of Appeal jurisprudence has developed over several decades.

Breadth is not unclarity

Breadth itself is not a defect. Patent law has always been intended to allow applicants to claim in proportion to their technical contribution. The relevant question is whether the limits of the claim can be understood – not whether they are commercially ambitious. Terms like "a vehicle" or "a fastening element" are extremely broad but nevertheless perfectly clear.

Moreover, the question is not whether an applicant *desires* broad protection, but whether the law *entitles* the applicant to it. That entitlement is determined through the substantive requirements of the EPC: novelty, inventive step, sufficiency, added matter. It is not determined through an assessment by the examining division of what might be considered an appropriate commercial monopoly.

The effective breadth of patent protection has always been governed by substantive patent law and, ultimately, by judicial claim interpretation – as confirmed by the answer of the enlarged Board of Appeal in G 1/24 with regard to the first referred question.

It has never been the function of examination proceedings, nor the mandate of the examining division, to reshape claim scope based on assumptions about future litigation or commercial strategy. It is questionable whether it has the mandate to decide whether the applicant is entitled

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to a broader or narrower formulation once the statutory requirements of patentability are met. That question concerns the extent of exclusive rights – a question that the EPC reserves for judicial interpretation and, limited to the prohibition of amendments according to Art. 123(3) EPC, to revocation proceedings based on the substantive grounds laid down in the Convention.

Examination under Article 84 EPC, therefore, serves a different purpose: ensuring that the claimed subject-matter can be identified for the purposes of grant, rather than anticipating every future question of claim construction.

The European patent system deliberately allocates different responsibilities to different institutions. Examining divisions determine whether an application satisfies the statutory requirements for the grant of a European patent. They assess novelty, inventive step, sufficiency, and the other conditions set out in the Convention.

The determination of the scope of the resulting rights is a different constitutional function. It arises only in concrete disputes, where the Unified Patent Court and national courts interpret the granted claims with respect to the allegedly infringing embodiment through the eyes of the skilled person in light of the specification and the prior art.

This division of responsibilities reflects the architecture of the EPC. Examination is conducted *ex ante*, before any commercial product or infringement dispute exists. Courts operate *ex post*, with the benefit of an actual controversy and adversarial proceedings. The examiner therefore asks whether the statutory conditions for grant are fulfilled. The court asks what protection the granted claims confer in the circumstances of a particular case. These are related but fundamentally different inquiries.

For that reason, breadth and clarity should not be conflated. Whether a claim is broad is a question of the extent of protection, not of clarity. A claim may deliberately encompass numerous technical embodiments while remaining perfectly intelligible to the skilled person. Whether such breadth is justified by the applicant's technical contribution is ultimately tested through the substantive requirements of patentability and, after grant, through judicial interpretation and revocation proceedings. If Article 84 EPC were instead used as an indirect mechanism for restricting otherwise comprehensible claim language, the examining division begins to perform a function that the EPC appears to reserve for the courts.

A means – not an end

Using clarity objections as an indirect mechanism to narrow otherwise allowable claims risks assigning Article 84 EPC a function that neither its wording, nor its legislative history, nor the architecture of the EPC appears to support. Read that way, the objection is itself the invention.

What emerges from this analysis – historical, structural, and comparative – is a straightforward conclusion: No patent system can function without claims defining the scope of protection. Yet their clarity is a means, not an end. The EPC entrusts examining divisions with deciding whether an invention merits a patent, while leaving the ultimate determination of the patent's scope to the courts.

Preserving that institutional balance is not a weakening of Article 84 EPC but rather a recognition of the limited but important role that its drafters intended it to play. If examination increasingly prioritizes semantic perfection over technological contribution, the balance envisaged by the EPC risks becoming skewed. The EPO was established to grant exclusive rights in exchange for the disclosure of technical contributions, not to police language.

RÉSUMÉ

Jan Goering is a German and European Patent Attorney, a Representative before the UPC, and a partner at BOEHMERT & BOEHMERT. He provides strategic counsel on intellectual property protection. He is experienced in adversarial patent proceedings and involved in prosecuting patents before patent offices. His career includes positions at the German Patent and Trademark Office, the Federal Patent Court, and a patent litigation division of the Düsseldorf Regional Court. He is a member of the Executive Board of the Bundesverband Deutscher Patentanwälte (Federal Association of German Patent Attorneys) and co-author of their amicus curiae brief in the G1/24 case.

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