

Kluwer Patent Blog

Alles klar in Germany? – Some musings about whether there is a clarity requirement in the German Patent Act

Thorsten Bausch (Hoffmann Eitle) · Monday, May 16th, 2016

Let's begin with the German statute and compare it with the EPC. Section 34 of the German Patent Act (GPA) stipulates the following:

(3) An application shall contain:

1. the name of the applicant;
2. a request for the grant of a patent, in which the invention shall be clearly and concisely designated;
3. one or more claims defining the subject for which protection is sought
4. a description of the invention;
5. the drawings referred to in the claims or the description.

(4) An 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.

While Sec. 34(4) GPA clearly correlates with Art. 83 EPC, Sec. 34(3) seems more akin to Art. 78(1) EPC, setting forth the requirements of a European patent application:

(1) A European patent application shall contain:

- (a) a request for the grant of a European patent;
 - (b) a description of the invention;
 - (c) one or more claims;
 - (d) any drawings referred to in the description or the claims;
 - (e) an abstract,
- and satisfy the requirements laid down in the Implementing Regulations.

Art. 78 EPC does not further specify any substantive requirements with regard to claims. They are, however, included in Art. 84 EPC:

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

Thus, according to the EPC claims must be clear, concise and supported by the description, and according to the GPA claims must “define” the subject for which protection is sought. What does “define” mean? Does it mean “define clearly”? Or does it mean “define somehow, perhaps even ambiguously, if only a reasonable judge is able to come to some sensible interpretation of the claim”? In other words, is there an implied clarity requirement in the German Patent Act?

This question has been under quite some debate among practitioners and judges in the recent years. Going back to 1988, the Federal Court of Justice stated in its landmark decision on clarity “Düngerstreuer”, X ZR 93/85, that “in examination proceedings claims have to be provided that clearly and distinctly define the invention to be protected”. However, this comment was made (a) without specifying its legal basis and (b) to distinguish the situation before grant from the situation in nullity proceedings which was what the Court had to deal with in the “Düngerstreuer” case. The FCJ at least clearly stated that for nullity proceedings, if a revocation action is unfounded, the court may not “clarify” the patent by an amendment to the description.

Conversely, if a patentee defends a European patent in a limited form, German courts must directly apply, and do directly apply, Art. 84 EPC. In its “Proxyserversystem” decision, Xa ZR 54/06, the FCJ held in the keynote that a European patent cannot be maintained on the basis of claims that do not meet the requirements of clarity and conciseness of Art. 84 EPC. A further FCJ decision from 2012, “Elektronenstrahlssystem”, X ZR 88/09, confirmed what was set down in the “Proxyserversystem” decision and also evaluated the clarity of a claim from a European patent that was defended in a limited form in nullity proceedings.

In its latest decision on clarity, i.e. “Fugenband”, X ZR 11/13, dated 27 October 2015, which was discussed [on this blog](#), albeit for a different reason, the FCJ further added that the requirement of clarity follows, for national law, from Sec. 34(3), no. 3, GPA in conjunction with Sec. 9 Regulation on Patent Applications (Patentverordnung). However, the FCJ added that the examination of **granted** claims is not stipulated either in the EPC or in the German Patent Act. With a decision on grant, the Court argued, the patentee obtains a legal position of which he can only be deprived should one of the stipulations provided in the law apply, i.e. if there is a ground for opposition or revocation. However, the numerus clausus of opposition and revocation grounds according to Art. 100 and Art. 138 EPC and Sec. 21, 22 GPA excludes clarity. Therefore, and in line with [G 3/14](#), an examination with respect to clarity is not allowable if the alleged lack of clarity already existed in the granted claims.

While the “Düngerstreuer” and “Fugenband” decisions seem to suggest that the FCJ would recognize that there is an implied clarity requirement in the German Patent Act for German patent applications, the FCJ has as of yet not had the opportunity to pass direct judgment on this question. In contrast, the Federal Patent Court (FPC) did have a few such opportunities – but it has not yet arrived at a unanimous viewpoint. The 20th, the 11th and the 15th Boards seem to be of the opinion that a lack of clarity is not a ground for rejection of an application at all (BPatG 20 W (pat) 71/04 of 15 April 2009; BPatG 15 W (pat) 33/08 of 16 December 2013 – “Batterieüberwachungsgerät”; BPatG 20W (pat) 8/14 of 7 April 2014 – “Elektrisches Steuergerät”; BPatG 11 W (pat) 32/13 of 15 December 2014 – “Gargerät”). However, at least the 21st Board holds the opposite view (BPatG 21 W (pat) 13/10 of 22 May 2014 – “Elektrochemischer

Energiespeicher”).

The 15th Board has therefore invited the President of the GPTO to intervene in the proceedings in one of its recent cases and granted leave for appeal (15 W (pat) 9/13). On the merits, the court argued as follows:

The legal question of whether Sec. 34 (3), no. 3, Patent Act is to be construed such that only clear and per se comprehensible claims that allow one to unequivocally identify what is to be supposed to be put under protection as patentable satisfy the requirements of this provision, with the consequence that an application (unless the lack of clarity is remedied) must be rejected according to Sec. 48 Patent Act in conjunction with Sec. 45 (1), Sec. 34 (3), no. 3, Patent Act, is therefore answered in the negative by the Board. Neither the wording of the law nor the legislative history of Sec. 34 (3), no. 3, (or Sec. 26 (1), no. 2, of the previous Act) provides an indication that further substantive requirements should be imposed on claims by the provision, in addition to the formal requirements, although the insofar different rule of Art. 84 EPC was known. The Board is also unable to derive from the supreme rule-of-law principle of legal clarity an additional ground of rejection on the grounds of “lack of clarity” and this also seems unnecessary. Namely, it can be ensured in a comprehensible manner by identifying and, where appropriate, documenting the skilled person’s general knowledge how terms that are evaluated as “unclear” in the examination proceedings are to be evaluated against the background of the relevant prior art and the skilled person’s expertise. Although such an approach will affect the extent of the examination, it does not stand in its way.

In summary, the 15th Board held that (a) a lack of clarity is no ground to reject a German patent application and, in any case, (b) the claim did not lack clarity. It therefore reversed the GPTO’s decision to refuse the application and remanded the case for evaluation of patentability. Leave for appeal on a point of law was granted to the President of the GPTO, who took the position that lack of clarity should be a ground of revocation under Sec. 34(3) GPA). However and perhaps unfortunately, the President did not avail herself of this opportunity to achieve a final clarification of this question by a decision of the Federal Court of Justice. It therefore remains a matter of speculation how the FCJ would have decided this case.

An educated guess at least can be taken from a footnote to an article by Presiding Judge Prof. Dr. Meier-Beck in [GRUR 2014, 1033-1040](#). The footnote related to the FCJ decision [Dipeptidyl-Peptidase-Inhibitors](#) discussed on this blog [here](#). In this decision, the FCJ decided, inter alia, that “avoidable unclarities” have to be removed during the examination proceedings. Apart from that, the fact that a multitude of substances is comprised by the term dipeptidyl peptidase inhibitors is no bar to clarity of the claim. Meier-Beck remarked:

Thereby, the problems of the present clarity discussions have been briefly addressed (cit. omitted). As the case in dispute shows, not everything that is discussed under the heading clarity of claims actually relates to this problem. Apart from that, clarity

is a relative category as a rule and thus no ground of revocation for a good reason; therefore the FCJ referred to “avoidable unclarities”. This also raises doubts whether an application can simply be rejected for lack of clarity of the claims. A lot speaks in favour for the position that this should only be possible if the applicant rejects a wording of the claims that is obviously in better agreement with the clarity requirement, without substantively taking part of the protection from the applicant. In such a case, however, a rejection should be possible if all else fails. For if avoidable unclarities have to (not: should better or can) be removed in examination proceedings, the examiner cannot be forced to grant the patent on the basis of unclear claims, if and to the extent this could be done on a clearer basis, thus improving legal certainty for third parties.

Hmm. Is lack of clarity now a ground for rejection or not? Perhaps ironically, it seems that Meier-Beck tries avoiding to answer this question with a clear yes or no. On the one hand, neither the FCJ nor the 15th Board of the FPC wish to see a lot of cases before them where an application is refused merely due to lack of clarity. Indeed, an unclear claim may often be vulnerable to insufficiency or – due to its arguable breadth – to patentability attacks. This might speak in favour of the 15th Board’s position not to admit lack of clarity as a ground for revocation at all. On the other hand, Meier-Beck (and the FCJ in Dipeptidyl-Peptidase-Inhibitoren and Düngerstreuer) also seem adamant that the GPTO must remove (and be empowered to remove) “avoidable unclarities”, whatever these may be, from an application. Thus, it seems that lack of clarity might be at least an “emergency ground of rejection” in the FCJ’s opinion. Which is probably quite a sensible solution, except that one might perhaps wonder where there is a legal basis for an “emergency ground of rejection” for an “avoidable lack of clarity” in the German Patent Act.

In this blogger’s opinion, neither Sec. 34(3) GPA nor Sec. 9 Regulation on Patent Applications (Patentverordnung) refer to either clarity or a lack thereof, let alone an “avoidable lack of clarity”. Perhaps we would be on safer ground if we were to argue that a claim must only be clear enough to perform the function provided in Sec. 34(3) GPA, i.e. to define the subject-matter for which protection is sought. If a claim defines subject-matter very broadly, this is no clarity problem. If a claim uses (arguably) vague terms but these terms can be reasonably clearly construed/interpreted by a skilled person on the basis of the description, using his/her common general knowledge, there is no clarity problem either. If a claim does not contain an important reference point (e.g. if the claim only mentions %, not wt.-% or mole-%), but if its subject-matter is patentable irrespective of which reference point is taken, it should be given the broadest possible interpretation for all purposes. Only if a claim is hopelessly contradictory or incomprehensible in itself and the description does not allow the skilled person to come to an unambiguous and consistent interpretation, then it might be arguable that such a claim cannot serve its function to “define” the subject-matter to be protected and should then be rejected, if there is no way to resolve the ambiguity or lack of comprehensibility by amendment.

For the time being, however, the short answer to the question asked in the headline is: “*Nein, noch nicht alles klar in Deutschland*” or in other words: No, all is not yet clear in Germany.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

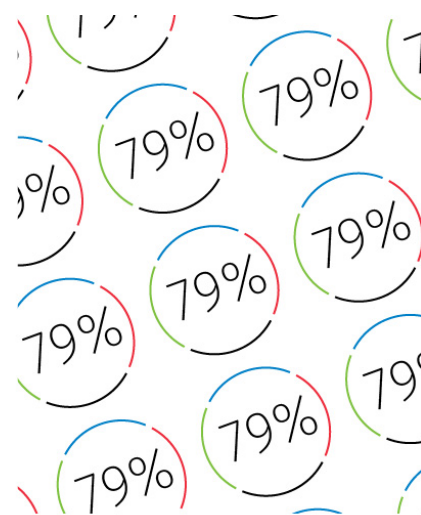
Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.
The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Monday, May 16th, 2016 at 11:12 pm and is filed under [Germany](#). You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.