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The EPO clears things up

A decision has been issued by the Enlarged Board of Appeal concerning whether clarity should be considered in opposition and opposition appeal proceedings.

A decision¹ has now been issued by the European Patent Office's Enlarged Board of Appeal on referral G3/14. This concerns whether and when clarity should be considered in post-grant opposition and opposition appeal proceedings.

Background

Article 100 EPC lists the grounds for opposition of a European patent as patentability, sufficiency of disclosure, and added subject matter. An alleged lack of clarity of a claim (Article 84 EPC) is not a ground for opposition.

However, Article 101(3) EPC states that, following amendment of a European patent during opposition proceedings, if the Opposition Division is of the opinion that the patent and the invention to which it relates do not meet the requirements of the EPC, it shall revoke the patent. An equivalent provision applies to the EPO Boards of Appeal.

Two contrasting lines of case law have evolved. The first is the "conventional" approach (see [T301/87](#)), in which it is considered that post grant amendments which merely combine granted claims are not examined for clarity on the basis that the amendment does not introduce a new clarity problem (and the EPO should have assessed the clarity of claims before granting the patent). The second is the "divergent" approach in which the examination of clarity was at the discretion of the Boards of Appeal (see [T1459/05](#)) and further that the clarity of an amended claim should be examined even if the amendment concerned merely the combination of claims (see [T459/09](#)), on the

basis that the amended specification must satisfy all requirements of the EPC.

Summary of decision

The Enlarged Board came down clearly on the side of the "conventional" approach.

The Enlarged Board also took the opportunity to go beyond the circumstances of the case referred and discuss the boundary between claims that should and should not be examined for clarity.

Detail

The main question to be decided by the Enlarged Board was as follows:

1. *Is the term "amendments" as used in decision G9/91 of the Enlarged Board of Appeal to be understood as encompassing a literal insertion of*

- (a) *elements of dependent claims as granted and/or*
- (b) *complete dependent claims as granted into an independent claim,*

so that opposition divisions and boards of appeal are required by Article 101(3) EPC always to examine the clarity of independent claims thus amended during the proceedings?

In order to answer this question, the Enlarged Board considered that there were two types of amendment; **Type A** and **Type B**.

¹ Decision of the Enlarged Board of Appeal – [see here](#)

Type A (arising from option 1(a) above)

“Elements of dependent claims as granted”, was considered by the Enlarged Board to comprise:

- (i) cases where the dependent claim comprises alternative embodiments and the amendment covers one of them (**Type A(i) amendment**), and
- (ii) cases where a feature is introduced into an independent claim from a dependent claim, the feature being previously connected to other features of that dependent claim from which it is now disconnected (**Type A(ii) amendment**).

Type B (arising from option 1(b) above)

This consists of literal insertion of complete dependent claims into the existing independent claim.

To address the case at issue the Enlarged Board only needed to address **Type B** amendments. However, to remove legal uncertainty, the Enlarged Board also addressed **Type A** amendments.

Enlarged Board conclusions

Type B should be treated as per the “conventional” approach.

Type A(i) amendments are of no material difference to **Type B** amendments. These should also, therefore, follow the “conventional” approach. Furthermore, amendments comprising deletion of claim wording that narrowed claim scope but left intact a pre-existing lack of compliance with Article 84 EPC, and deletion of optional features from a granted claim, should also follow the “conventional” approach.

Type A(ii) amendments may be examined for clarity under Article 84 EPC if an alleged lack of compliance with

Article 84 EPC has been introduced by the amendment. There should not, however, be examination of clarity if the alleged lack of compliance has not been introduced by the amendment.

In summary, the Enlarged Board concluded that:

“In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC.”

Comment

G3/14 sets out very clearly that the “conventional” approach is to be followed when an independent claim is amended after grant to include a complete dependent claim or all features of one of the alternatives set out in a dependent claim. This will make it easier to defend European patents during opposition proceedings.

The EPO’s pre-grant assessment of the clarity of dependent claims is variable. Post-grant amendment of an independent claim to include the features of a dependent claim can result in claims of unclear meaning and scope.

Following this decision, however, EPO Opposition Divisions will not assess the clarity of amended claims that are simple combinations of the as-granted claims. This removes a potential line of attack for opponents, and will leave the courts of EPC states (national courts or the new Unified Patent Court) to interpret unclear amended claims.

For any further information, please contact your usual A.A. Thornton & Co. advisor or one of our [patent attorneys](#) via our website at www.aathornton.com.

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