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Lack of Clarity of Granted Claims in EPO Opposition Proceedings

Thorsten Bausch (Hoffmann Eitle) · Thursday, July 7th, 2011

During EPO opposition proceedings, patentees have historically been able to avoid discussing clarity by combining granted claims rather than using the description as basis for amendments. The landmark cases T 227/88 and especially T 367/96 have been relied on to support this position.

However, some technical boards of appeal are now starting to engage in a discussion of clarity of amended claims arrived at by combining granted claims.

In T 1459/05, an amended claim arrived at by combining two granted claims was rejected by the board for lack of clarity in an opposition-appeal. The reasoning was that the ratio of T 367/96 is based on an assumption that may not be true, namely that EPO Examiners check even dependent claims for clarity during prosecution.

T 656/07 similarly departs from the prevailing case law. It also rejected an amended claim combining two granted claims for lack of clarity. Here the board went even further in its reasoning, stating that it considers that there is no general rule in the jurisprudence that a combination of granted claims should not be challenged for lack of clarity. In particular, it was noted that T 367/96 related to questions of support, not clarity.

It remains to be seen whether the established jurisprudence will be changed, so that clarity will play a greater role in EPO opposition.

Morten Garberg

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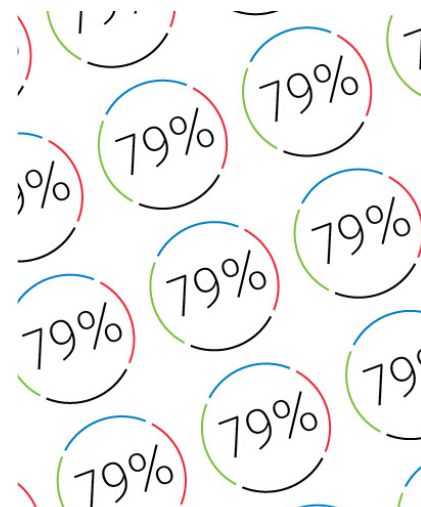
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This entry was posted on Thursday, July 7th, 2011 at 4:16 pm and is filed under [G 1/93](#), OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Amendments, [EPC](#), [Opposition](#)

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