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EPO's Enlarged Board clears up clarity

Thorsten Bausch (Hoffmann Eitle) · Monday, March 30th, 2015

On 24 March, 2015, the Enlarged Board of Appeal of the EPO, the final judicial arbiter of the interpretation of the European Patent Convention, issued Decision [G 3/14](#) addressing the question of when, and to what extent, clarity objections could be raised by a party challenging the validity of a patent through the EPO's Opposition procedure. The Decision concludes that granted claims, including combinations of independent claims and their proper dependent claims, cannot be formally challenged for a lack of clarity. Rather, a formal objection of lack of clarity can only be made when the substance of a granted claim, dependent or independent, is changed by an amendment to that claim, and then only to the extent that the lack of clarity is introduced by the amendment.

The Enlarged Board was required to address the question because one of the Technical Boards of Appeal (hearing an appeal from a decision of an Opposition Division of the EPO) was called upon by an opponent of the patent to find inadmissible an amendment of a granted claim to include the whole subject-matter of one of its dependent claims. Article 101(1) EPC and 101(2) EPC expressly limit the extent to which a patent may be opposed to specific grounds: patentability, insufficiency and impermissible extension of subject-matter. However, Article 101(3) EPC requires that, where an amendment to the patent is requested by the proprietor in the Opposition proceedings, the EPO must confirm that the patent as amended meets all the requirements of the EPC, which include that of clarity according to Article 84 EPC. The Enlarged Board, in Decision G9/91, had previously acknowledged that certain requirements of the EPC, such as that of unity of invention, were essentially administrative requirements in the context of examination rather than substantive requirements of validity as such. Therefore, compliance with such requirements was not necessary during Opposition proceedings. However, the same decision had confirmed that the requirement of clarity was substantive and not administrative, and should form part of the examination under Article 101(3) EPC.

The referring Technical Board took a view that there had been at least two approaches to this question established in the jurisprudence of the Boards of Appeal, one (exemplified by Decision T1459/05) in which the incorporation of the further features of a dependent claim in an independent claim should be considered as an amendment as a matter of fact, and permitted the clarity of the whole new independent claim to be assessed, and one (exemplified by Decision T301/87) in which such an amendment

could be regarded as formal, rather than substantive, and in which the clarity of such a claim could as a matter of law not formally be considered, even when the subject-matter thereby defined gave rise to problems of interpretation. Having identified such divergent views, the Technical Board called upon the Enlarged Board to indicate the correct approach to be adopted in such cases.

The Technical Board, as is usual, referred a specific question to the Enlarged Board, as follows:

“Is the term “amendments” as used in decision G 9/91 of the Enlarged Board of Appeal (see point 3.2.1) 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?”

The Technical Board also referred three additional questions exploring the consequences of the answer to the first question.

The referral generated substantial interest in the EPO practitioner community and beyond. Submissions were filed not only by the proprietor and the opponent in the original proceedings but also by patent law associations FICPI, AIPLA, CIPA and EPI, the President of the EPO, as well as numerous individual amici curiae (third parties having an interest in the question). Justifications advanced for a restrictive scope of the ability to investigate clarity of subject-matter already defined in a dependent claim included legislative intent, efficiency of proceedings and legal certainty for the proprietor. Justifications advanced for an extensive scope of such an ability included the fact that features considered of importance for delimiting against relevant prior art may be different in opposition as compared with during examination, the perceived difficulty of examining every possible combination of independent and dependent claims for clarity during the examination proceedings, and the need for legal certainty for third parties.

The Enlarged Board, in a 93-page reasoned decision, went somewhat beyond addressing the specific questions as raised. After surveying the developed jurisprudence of the Boards of Appeal, the travaux préparatoires (working documents) of the drafters of the EPC, the general principles applicable in various national revocation proceedings, and policy considerations which might affect the answer to the questions, the Board identified two classes of amendment which could be legally distinguished in terms of whether the clarity of the patent as thereby amended could be subjected to an enquiry as to clarity under Article 84 EPC.

A first class of amendment consisted solely of a restriction in scope of the patent as granted to a restricted domain, the subject-matter of which was already defined by one of the claims of the granted patent. This class of amendment included the limitation of the scope of a patent to that of one or more independent or dependent claims, potentially including the subject-matter of optional intermediate claims where multiple dependencies are present. Investigation into the clarity of the scope of the patent as defined by such amended claims could not in law be undertaken, since dependent claims present in the patent as granted must be considered as being substantively equivalent to granted independent claims including all features of the dependent claims and all claims from which they depend. In effect, restriction to one

or more dependent claims must be understood as the straightforward deletion of one or more granted claims together with necessary rewriting of certain of the maintained dependent claims in independent form. This followed at least from the definition of “dependent claim” in Rule 43(4) EPC, first sentence. The EPC and the developed jurisprudence does not permit the clarity of the claims of the patent as granted to be called into question. Even a case-by-case examination of thus amended claims for clarity is not permissible. If this approach were incorrect, then the degree to which the EPO could enquire into the clarity of subject-matter present in the claims of the patent as granted would be, in the words of the Board, “fortuitous and arbitrary”. The Enlarged Board sent a clear message concerning the clarity of such claims: even if new prior art is cited which demonstrates that a granted claim (dependent or independent) is unclear, then one must live with that situation without the possibility to invoke Article 84 EPC.

Other situations falling within the first class, by analogy thereto, included the limitation of the scope of a patent by means of an alternative contained within a claim defining a plurality of such alternatives and the deletion of optional features from a granted claim. In all such cases, the scope of the granted patent is restricted to a domain substantively equivalent to a granted independent claim.

A second class of amendment consists of those cases in which the scope of the patent as granted is restricted to a domain, the subject-matter of which was not already defined by one of the claims of the granted patent. This class of amendment included the situation in which the scope of an independent claim is limited by the inclusion of features isolated from remaining features of one or more dependent claims. In such a situation, if an alleged lack of compliance is introduced by the amendment, the claim may be examined for such compliance. However, in the exceptional case in which the alleged lack of compliance has not been introduced by the amendment, but was pre-existing in the claims as granted, the principles of the first class of amendment should be followed and no examination of clarity is permissible.

The Enlarged Board therefore decided 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 as granted may be examined for compliance with the requirements of the EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC.

The answer to the question has effect beyond the inclusion of features from dependent claims, since it now provides a test of universal applicability to determine when and to what extent clarity in the sense of Article 84 EPC may formally be called into question in Opposition proceedings. It also is apparently applicable to the inclusion into a granted claim of a feature taken from the description or (exceptionally) drawings, providing that compliance with Article 84 EPC can only be examined to the extent that the amendment introduces a lack of clarity not inherent in the claim before amendment. Therefore, where it has been the practice of some opponents to attack the clarity of features of such an amended claim inherited from the granted claim on which it was based, such opponents will now have to demonstrate that the alleged lack of clarity is consequent to the introduction of the introduced feature, and not inherent in the claim as granted.

The Decision therefore objectively provides an answer to a question of some importance to both proprietors and those who would seek to revoke or limit the scope of their European patents, the correct answer to which has been hotly debated wherever patent attorneys are gathered together.

The Decision, subjectively, also provides a relatively readable and instructive example of how the Enlarged Board addresses such questions, which will be of some interest to those who would understand how the Enlarged Board resolves contradictions between the law, the jurisprudence, the legislative history, and policy considerations.

Finally, however, and possibly most importantly, this Enlarged Board Decision implicitly provides a clear message to applicants before the EPO: when it comes to dependent claims, less is certainly not more. If only one message should be taken away from this Decision, it is that an amendment which introduces features not present in a granted dependent claim into an independent claim during Opposition proceedings can risk the clarity of the subject-matter thereby defined being called into question, while had the same subject-matter already been defined by a dependent claim or combination of dependent claims on grant, no such objection could have been made. For proprietors in Opposition-heavy technical fields, it may therefore be worth spending more in claims fees to place additional commercially important fallback positions into the dependent claims, since limitation to such dependent claims in Opposition proceedings cannot give rise to a formal clarity objection.

To opponents, also, an implicit message is given: that although the clarity of subject-matter present in the claims on grant cannot be the subject of a formal objection under Article 84 EPC, if a claim feature is indeed so vague that it cannot reasonably be determined whether or not it is disclosed in the prior art, an effective argument can be made that the feature provides no substantive limitation on the claim and hence should be interpreted so broadly as to render the feature irrelevant in assessing novelty or inventive step. Hence, where a clarity objection might formerly have been brought, opponents are reminded of an alternative tactic which has now received clear judicial approval.

This Decision will likely have a relatively significant effect on how many practitioners choose to prosecute and oppose patents before the EPO. However, in our view the balance between proprietor and opponent has not significantly shifted by reason of this Decision, since the Boards of Appeal, and by extension the Opposition Divisions who follow their guidance, will likely now scrutinise the scope of features which might formerly have been called unclear with increased care when considering other grounds of opposition expressly permitted by the EPC. The Decision might also serve to remind the examiners of the EPO that it is their duty to check all claims for clarity, not only the independent claims.

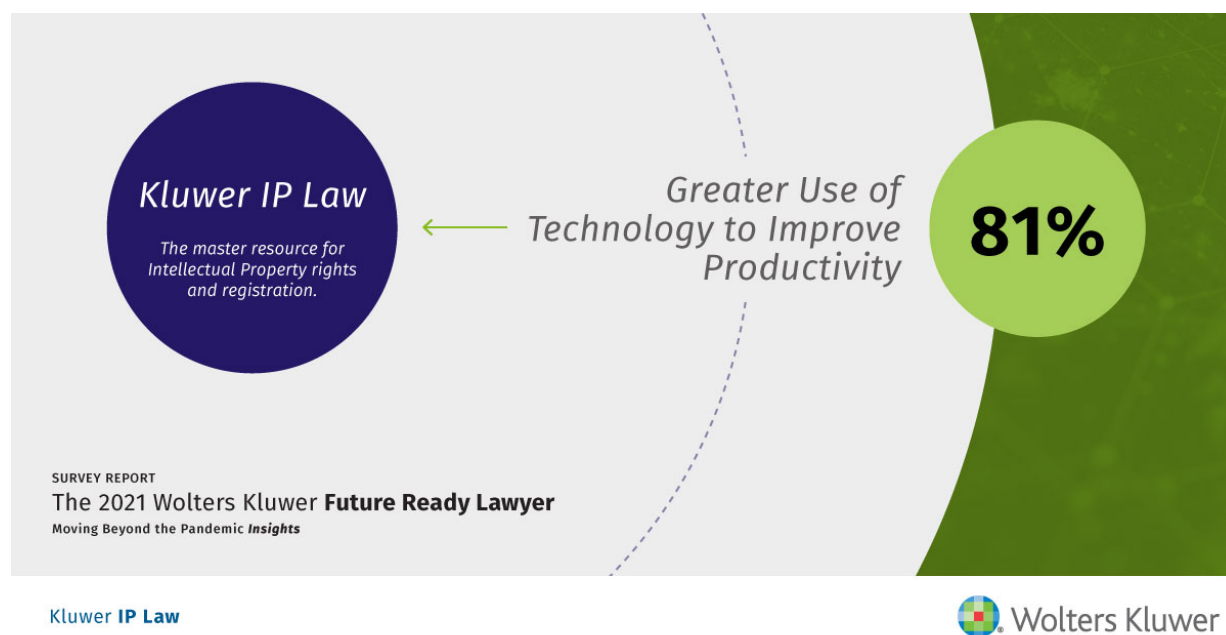
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This entry was posted on Monday, March 30th, 2015 at 7:07 pm and is filed under [Art. 123\(2\) of the European Patent Convention \(EPC\)](#), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. ([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).">Added matter, EPC

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