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Finally, More Clarity from the Boards of Appeal of the EPO

Thorsten Bausch (Hoffmann Eitle) · Tuesday, July 14th, 2015

No, not what you might perhaps have hoped for. A lot is currently ongoing at the European Patent Office about the status, the independence, the future location and the (self-)administration of the EPO's Boards of Appeal, but this blogger is neither sufficiently well-informed nor competent to comment on the big picture. So let's stick to our guns and praise Board of Appeal 3.3.07 for a little ex-parte appeal decision ([T 1882/12](#)) that combines clarity with common sense in an admirable fashion.

The decision relates to a problem that many patent practitioners have been encountering for a number of years. Rule 162 EPC along with the EPO's Rules relating to Fees definitely discourage applicants from filing more claims than 15, for understandable public policy reasons. Quite a few applicants have therefore been trying to circumvent the consequences of these rules on extra claims fees by pyramiding their claims. So did Henkel, the applicant of the application at stake. Claim 2 of Henkel's application as pursued before the Board of Appeal read (in my English translation) as follows:

"2. A mouth and tooth care and purification agent according to claim 1, characterized in that it contains 12 to 60 wt.-%, preferably 15 to 50 wt.-%, more preferably 17 to 40 wt.-% and particularly 20 to 35 wt.-% of sorbitol and/or glycerol and/or 1,2 propylene glycol."

The question then arose whether such pyramid-like claims satisfy all the requirements of the EPC. The Examining Division denied that, arguing that such pyramid claims would violate Rules 43(3) and 43(4) as well as Art. 84 EPC. The application was therefore refused and Henkel appealed bravely.

TBA 3.3.07 allowed applicant's appeal and held that neither Rules 43(3) and 43(4) EPC nor Art. 84 EPC prevented such claims from being granted. Rule 43(3) and (4) reads as follows:

(3) Any claim stating the essential features of an invention may be followed by one or more claims concerning particular embodiments of that invention.

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features. A dependent claim directly referring to another dependent claim shall also be admissible. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

The Board held that nothing in these two Rules puts optional features in a claim in question. The only potential problem might be a contravention against clarity and/or conciseness under Art. 84 EPC. So much is also conceded in the Guidelines for Examination, C-III, 4.9 (2010) as referred to by the TBA, which is now Chapter F-III, 4.9:

4.9 Optional features

Expressions like “preferably”, “for example”, “such as” or “more particularly” should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional.

The Board took from these Guidelines, however, that there is no rule that such claims are generally inadmissible. If clarity is not compromised, they are fine. Moreover, the Board saw no clarity problem in the present case. It acknowledged that the preferred concentration ranges might have also been recited in separate dependent claims. However, the existence of such an alternative cannot give rise to concrete doubts with regard to the number of the dependent claims.

The Board also rejected the Examining Division’s argument that thus-formulated claims are not concise, since they arguably contained superfluous, non-limiting features. The TBA argued that from the applicant’s perspective such optional preferred features serve the purpose to provide fallback positions in the further proceedings or later in opposition proceedings. It held it conceivable that there could be instances where convoluted pyramid-like claims might be less clear and easy to understand than several dependent claims avoiding optional features. However, the Board was of the view that the use of optional preferred features was reasonably confined in the case at stake, that the understandability of the claims was not compromised thereby and that the effort required to analyze claims was not unduly raised by the presence of these features.

All in all, a very reasonable and well-reasoned decision that will (hopefully) make an end to the practice of some EPO examiners to reject all claims with optional, preferred features from the outset, owing to an alleged contravention of the formal requirements of the EPC. As TBA 3.3.07 held, there is nothing in the Articles or Rules of the EPC that stands *a priori* in the way of such claims. This does not preclude clarity objections on a case-by-case basis.

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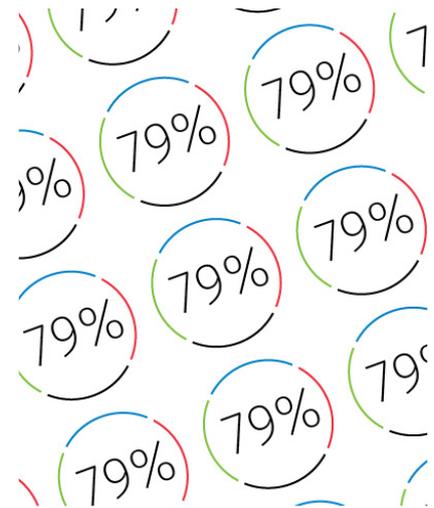
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