

# Kluwer Patent Blog

## Can the clarity of amended claims be challenged in an unrestricted manner in opposition proceedings? – T 373/12 refers four questions to the Enlarged Board of Appeal

Thorsten Bausch (Hoffmann Eitle) · Monday, April 7th, 2014

Rarely are questions referred to the EPO Enlarged Board of Appeal so fundamental for everyday practice as those referred by Board 3.2.08 in [decision T 373/12](#) of 2 April 2014. The Enlarged Board is asked to decide on the extent to which the clarity of claims amended during opposition proceedings and opposition appeal proceedings can be challenged when the amendments are based on dependent claims as granted.

When, during post-grant opposition proceedings at the EPO, the patent proprietor amends the claims of the opposed European patent, the Opposition Division has to assess whether all the requirements of the European Patent Convention (except unity of invention, see [G 1/91](#)) are complied with ([Article 101\(3\) EPC](#)), as confirmed 20 years ago by the Enlarged Board itself in [G 9/91](#), point 19:

“In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC).”

Over the years, doubts have arisen in the case law of the Boards of Appeal as to the extent to which the clarity, under [Article 84 EPC](#), of an amendment consisting in “merely” combining the features of an independent claim as granted with the features of a dependent claim as granted, which refers back to the independent claim, has to be examined in opposition proceedings (as discussed for example [here](#) on this blog). Since Article 84 EPC is not as such a ground for opposition under [Article 100 EPC](#), some Boards held that it would go too far to allow the clarity of all the features of an amended claim to be examined in opposition, particularly if only a relatively minor amendment is made to the claim. Other Boards (most notably in [T 1459/05](#) and [T 459/09](#)) called for an unrestricted power to examine amended claims during opposition and opposition appeal.

In [T 373/12](#), the proprietor incorporated into an independent claim the wording “substantially all of its surface area”, which was verbatim in dependent claim 3 as granted. The other party and the Board both considered the use of the word “substantially” to be particularly problematic. The Board then wondered whether it could at all assess the clarity of this problematic wording in the opposition proceedings, since the problem already existed in dependent claim 3 as granted.

The Board thus decided to refer the following questions to the Enlarged Board:

1. Is the term “amendments” as used in G 9/91 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 the 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?
2. If the Enlarged Board of Appeal answers Question 1 in the affirmative, is then an examination of the clarity of the independent claim in such cases limited to the inserted features or may it extend to features already contained in the unamended independent claim?
3. If the Enlarged Board answers Question 1 in the negative, is then an examination of the clarity of independent claims thus amended always excluded?
4. If the Enlarged Board comes to the conclusion that an examination of the clarity of independent claims thus amended is neither always required nor always excluded, what then are the conditions to be applied in deciding whether an examination of clarity comes into question in a given case?

The answers to these questions will not only impact the substantive issues that can be legitimately debated during opposition proceedings, but also, more generally, the importance of dependent claims in European patents. If no clarity objection can be raised following the literal combination of a dependent claim with the independent claim on which it depends, the fall-back positions defined by the dependent claims will remain largely immune to clarity challenges.

In the meantime, since these questions may be decisive in many pending opposition proceedings during which the patent proprietor has amended the claims, many proprietors and opponents alike may now consider requesting proceedings to be stayed until the Enlarged Board issues its decision ([Guidelines E-VI, 3](#)).

Nicolas Douxchamps

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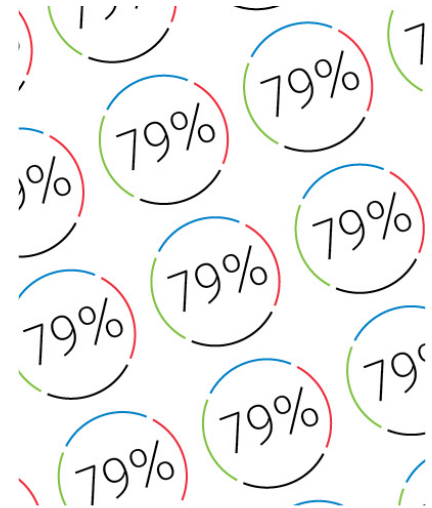
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This entry was posted on Monday, April 7th, 2014 at 1:23 pm and is filed under [G 1/93](#), [OJ 1994, 541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled 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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