

## An introduction to clarity in EPO oppositions

In March 2015, the EPO's Enlarged Board of Appeal decided on the extent to which amendments made during opposition proceedings can be examined for clarity, following a referral from a lower Board.

In a referral to the Enlarged Board of Appeal, the referring Board asked the question: "Is the term 'amendments' as used in a previous Enlarged Board decision G 9/91 (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 opposition which gave rise to this referral involved the combination of granted independent claim 1 and granted dependent claim 3, but claim 3 contained a lack of clarity. Three further questions were referred, and their answers were dependent on the answer to the first question. In the end, these further questions were all dealt with by the Enlarged Board's answer to the first question.

The background to the case centred around Article 101(3) EPC which allows the proprietor of an opposed European patent to amend the claims: "If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the European patent during the

opposition proceedings, the patent and the invention to which it relates (a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that the conditions laid down in the Implementing Regulations are fulfilled". However, decisions of the Boards of Appeal have not been consistent regarding the extent to which the clarity of amended claims could be examined during oppositions in order "to meet the requirements of this Convention".

In G 9/91, it had been confirmed that amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings have to be fully examined as to their compatibility with the requirements of the EPC. However, this case was not specifically addressing the issue of clarity in opposition proceedings. The Enlarged Board had also previously decided that an Opposition Division or a Board of Appeal is not obliged to consider all the grounds for opposition going beyond the grounds covered by the statement of opposition; the Division or Board should examine only such grounds for opposition which have been properly submitted and substantiated, but could nevertheless consider other grounds for opposition which were prima facie relevant (see G 10/91). However, both G 9/91 and

G 10/91 were principally dealing with the extent to which an Opposition Division or a Board of Appeal could, and should, decide on the maintenance of a European patent in respect of the extent to which the patent has been opposed. There had also been a number of cases heard by the Boards of Appeal which had followed the so-called conventional approach when assessing the clarity of amendments, namely the clarity of an amended claim could not be examined if the lack of clarity did not arise out of the amendment (see T 301/87). However, there had been some divergence from this conventional approach, and reference to an assessment as to whether an amendment made during opposition proceedings is minor, substantive or substantial (see T 409/10 and T 459/09). The conventional approach had called for an assessment of whether a lack of clarity would "arise out of" the amendments made; a phrase which had been interpreted broadly (see T 472/88).

The Enlarged Board's present decision in G 3/14 is based in part on Article 84 EPC not being a ground for opposition - any suggestion or request that it should be a ground for opposition has been rejected by the legislator in this regard. According to the decision, about 70% of patents are amended during opposition proceedings, and

it was felt that examining clarity irrespective of the form of amendment made during opposition proceedings would go against the ethos of having a “streamlined opposition procedure”.

In its decision, the Enlarged Board answered: “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.” In essence, an amendment is taken to be any amendment including a combination of existing claims. The effect of this is that there is no requirement to consider if an amendment is minor, substantive or substantial. Once an amendment has been made, it is necessary to assess if that amendment introduces a lack of clarity that was not present in the granted claims.

In deciding on this, the Enlarged Board introduced the concept of different types of amendments, namely Type A and Type B amendments. Type A amendments are split into two further categories, namely Type A(i) and Type A(ii). This characterisation of claim type seems to have been an attempt to make it easier to determine if any amendments made during opposition proceedings should be examined for clarity.

Type B amendments comprise the literal insertion of the subject matter of a dependent claim into an independent claim. These amendments do not introduce non-compliance with Article 84 EPC and so clarity of these amendments should not be examined.

Type A(i) amendments comprise the insertion of one embodiment from a single dependent claim which comprised multiple alternative embodiments, and should be dealt with in the same manner as Type B amendments.

The Enlarged Board acknowledged that for Type B and Type A(i) amendments, the resultant amended claim may be unclear due to an existing lack of clarity. However, the Enlarged Board appears to say that, since national courts have mechanisms for dealing with this during national proceedings, any lack of clarity in the amended claims should be left to “smoulder”.

Type A(ii) amendments comprise the insertion of features which are, by virtue of the amendment, disconnected from other features of a dependent claim. There is no question that this type of amendment may be assessed for clarity, but only the amendment itself should be assessed.

The decision has provided a clear indication that Type A(i) and Type B amendments should not be assessed for clarity, but it still remains to be seen to what extent Type A(ii) amendments can and will be assessed for clarity in future cases.

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*This briefing note was first published in the IAM IP Newsletter.*