



Examination of Clarity of Amendments in EPO Opposition Proceedings

In [G 3/14](#) the EPO Enlarged Board of Appeal ruled on the extent to which amendments made in EPO Opposition (and Opposition Appeal) proceedings may be examined for clarity, conciseness and support (Article 84 EPC). They confirmed that compliance with Article 84 EPC may be examined only when, and to the extent that, the amendment introduces non-compliance with Article 84 EPC. In particular an amendment which introduces the feature of a dependent claim may not be examined for Article 84 where the feature introduced corresponds to the complete dependent claim or is a simple alternative in such a claim.

Under Article 84 EPC, claims are required to be clear and concise and to be supported by the description. However lack of compliance with Article 84 EPC may not be used as a ground of opposition ([Article 100 EPC](#)). Nevertheless when an amendment is made in the course of opposition proceedings (or in the course of an appeal from an opposition) then the patent will be maintained only if the amended patent “meets the requirements of the EPC” ([Article 101\(3\) EPC](#)). This point was confirmed by the Enlarged Board of Appeal in [G 9/91](#) though that case was more concerned with the extent to which new grounds of opposition may be raised beyond those in the notice of opposition. Thus, when an amendment is made to the claims in the course of EPO opposition proceedings, then normally the requirement of clarity must be considered.

It has been less clear whether an amendment to incorporate the feature of a dependent claim into the independent claim should be examined for clarity. Such an amendment can be considered to be merely writing a dependent claim in independent form, and not therefore substantive. Also, the claims will have already been examined for clarity before grant. This point arose in decision [T 373/12](#) where the case related to “*a prosthetic medical device comprising a prosthetic liner comprising an umbrella attachment...*”. In the course of the appeal, an auxiliary request was filed incorporating an additional feature from claim 3 as granted that “the prosthetic liner is coated over substantially all of its surface area”. The Board was clearly concerned about the clarity of this feature and in view of a perceived conflict in the case law referred to the Enlarged Board of Appeal the issue of whether clarity can be looked at under such a circumstance.

In [G 3/14](#) the EPO Enlarged Board provided guidance on this issue. They considered that there were three approaches in the case law. The first, or ‘conventional’ approach goes back to cases [T 381/87](#) and [T 227/88](#) where clarity is only to be examined to the extent that the issue arises out of the amendment. The second approach expanded this by giving ‘arising out of’ an extended meaning, for example where the clarity problem was ‘concealed’ in a dependent claim and only ‘highlighted’ by its addition to an independent claim. The third strand took a diverging view

allowing a wider examination of clarity once an amendment had been made, particularly if an unclear feature was all that distinguished the subject matter claimed from the prior art.

The Enlarged Board, after a thorough analysis of the legal background, ruled that the ‘conventional’ approach was the correct one and that therefore the claims may be examined for compliance with Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC. The Board commented that it is not optimal that patents may be granted with claims which, even after amendment, do not comply with Article 84 EPC but that it cannot be ignored that the legislator chose not to make Article 84 EPC a ground of opposition. Amendment should not open a door to allow third parties to scrutinise a patent thoroughly for compliance with all the requirements of the EPC.

In relation to the specific issue of amendments introducing features from dependent claims the Board considered both the introduction of elements of dependent claims and introduction of the features of a complete dependent claim.

For the introduction of the features of a complete dependent claim, the Enlarged Board concluded such an amendment consists of striking out the original independent claim and then writing out the previous dependent claim in full. This should not be subject to any examination for clarity.

For amendments referring to elements of a dependent claim the position is more complex. The Board ruled that the same approach should be applied for amendments based on an embodiment expressed as an alternative in a dependent claim, or involving deletion of wording from a dependent claim thereby narrowing its scope, or involving the deletion of optional features. However, amendments which disconnect features from other features to which they were previously linked in a dependent claim are open to examination under Article 84 EPC.

Taking a simple example, if claim 1 includes reference to a surface and claim 2 specifies that the surface is “substantially flat” then amending claim 1 to say a “substantially flat surface” based on claim 2 cannot be examined for clarity (introduction of the feature of a complete dependent claim). Similarly if claim 2 specifies the surface is “substantially concave or convex, optionally having a radius of curvature of at least 10 mm”, then an amendment to specify a “substantially concave surface” will also avoid scrutiny under Article 84 (a simple alternative together with deletion of an optional feature from the dependent claim). However, if claim 2 specifies a “substantially concave surface having a radius of curvature of at least 10mm” then an amendment to specify a “substantially concave surface” (i.e.

without specifying the radius of curvature) will be open to examination for clarity as the newly introduced feature is no longer linked to the radius of curvature. (Depending on the circumstances, there could also be an added subject matter issue with such an amendment.)

Amendments do arise in approximately 70% of EPO Oppositions. It is therefore to be welcomed that the Enlarged Board has provided clarity in this area and in particular has limited the extent to which clarity can be raised. It should be noted however that where a Patentee seeks to rely on a feature from a dependent claim which is inherently unclear then, even if lack of clarity cannot be raised, the EPO is likely to give that feature a broad meaning which may not allow a useful distinction over the prior

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art to be established (see for example Decision T 1459/05¹, which was cited by the Enlarged Board as an example of such an approach).

Please do not hesitate to contact us if you would like more guidance in relation to a specific situation.

Footnotes

1. T1459/05 is an example of the ‘Diverging’ approach to examination of clarity. Although the Enlarged Board clearly did not agree with the approach to examination of Article 84 EPC taken there, it does appear to approve of this aspect of the Technical Board’s decision (Reasons 35 of G3/14).

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