

THE CLARITY OF GRANTED CLAIMS

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Decision T 373/12 from the Technical Board of Appeal has asked the Enlarged Board of Appeal to give its opinion on the examination of the clarity of amended claims during opposition and opposition appeal proceedings, where the amendment is a literal insertion of an entire dependent claim or elements of a dependent claim are added to an independent claim.

The reason for the referral to the Enlarged Board of Appeal is that the case law is divided on whether such kinds of amendments are to be examined with respect to clarity.

The clarity of granted claims, not only independent claims but also dependent claims, is examined during the proceedings for grant (or at least is supposed to be). On the one hand this supports not repeating the same work during post-grant proceedings, at least in cases where an entire dependent claim is added to the independent claim. On the other hand, inserting an entire dependent claim or elements of it without first examining whether the amendment results in a lack of clarity—such as by leading to inconsistency—may harm the quality of the patent.

It all boils down to a battle between ensuring procedural efficiency, by not examining for a lack of clarity in such cases, and ensuring a high quality of patents maintained in amended form.

Article 101(2) of the European Patent Convention (EPC) states that the opposition division shall decide on the maintenance of an (unamended) patent using the limited grounds mentioned in article 100 EPC, which does not include the clarity of the claims.

Article 101(3) EPC states that the opposition division, when taking into consideration the amendments made during the opposition proceedings, shall decide on the maintenance of the patent as amended by examining whether the requirements of “this Convention” are met, which includes the clarity of the claims.

The author of this article considers it clear from the wording of articles 101(2) and 101(3) EPC that it is the duty of the opposition division to examine the clarity of an amended independent claim even if the amendment is a literal insertion of an entire dependent claim, as article 101(3) EPC refers to (any) amendments made during opposition proceedings and is not limited with respect to the requirements to be examined.

Consider the oversimplified case where the granted claim one reads: “A patch having a first layer, a second layer and an active ingredient there between,” and is amended by inserting all elements of dependent claim two: “The patch of claim one wherein the second layer is permeable to liquids and said layer is 2 mm thick.” The amended claim one becomes unclear because it is not clear whether “said layer” refers to the first or second layer.

Also consider a case where a relevant prior art document is not brought forth until during post-grant proceedings and contains information that changes the interpretation of a term in the opposed patent and thereby renders one or more of the claims unclear. In such a case it appears appropriate to examine the clarity of the claims, even if the claims are not amended.

“THE REMOVAL OF ANY DOUBT CONCERNING THE EXTENT OF PROTECTION IS OF PARAMOUNT IMPORTANCE FOR NOT ONLY THE PATENTEE BUT ALSO FOR THIRD PARTIES WHEN DECIDING INFRINGEMENT ISSUES.”

The removal of any doubt concerning the extent of protection is of paramount importance for not only the patentee but also for third parties when deciding infringement issues.

Further, it appears to be in the interest of not only the opponent but also the patentee to deal with any clarity issues at the centralised European Patent Office proceedings, rather than at the courts of the contracting states. ■

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