

THE CLARITY OF AMENDED CLAIMS DURING POST-GRANT PROCEEDINGS

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On March 24, 2015 the Enlarged Board of Appeal in decision *G3/14* gave its opinion on examining the clarity of amended claims during opposition and opposition appeal proceedings.

The legal authority for examining clarity at these post-grant stages is article 101(3) of the European Patent Convention (EPC), which states that the opposition division shall revoke the patent if “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 ... do not meet the requirements of this convention”.

The examination guidelines says that a clarity objection “can be made only if the deficiency ... is a consequence of the amendments made [during opposition or opposition appeal]”.

In *G3/14* the enlarged board took a narrow view on the matter by stating that certain types of amendments to claims are in fact not amendments in the sense of article 101(3) EPC, which means that examination of clarity should not be raised just based on arguments regarding the clarity of claims that have been amended.

The enlarged board has classified amendments as the literal insertion of either a complete dependent claim into an independent claim (type B amendment) or elements of a dependent claim into an independent claim (type A amendment). The decision is not concerned with claim amendments based on elements from the description or drawings.

For type B amendments the enlarged board began by pointing out that a literal insertion of a completely dependent claim into an independent claim in fact corresponds to deleting the original independent claim and then writing out the previous dependent claim in full, and that the new independent claim is therefore not an amended claim.

The enlarged board therefore concluded that article 101(3) EPC does not provide legal authority to examine the “amended” claims with respect to clarity for type B amendments, and at the same time mentions that this situation is not optimal.

Type A amendments have been further broken down into two sub-types. Type A(i) amendments is where the dependent claim contains alternative embodiments, one or more of which is combined with the independent claim.

The enlarged board sees type A(i) amendments as essentially the same as type B amendments. The reason is that a dependent claim with, for example, two alternative embodiments can be seen as two separate dependent claims. Hence, the enlarged board came to the same conclusion as for type B amendments.

Type A(ii) amendments, the second sub-type, is where one of a number of connected features of a dependent claim is inserted into the independent claim and thereby is disconnected from the other features of the previous dependent claim.

“IF THE ALLEGED CLARITY ISSUE EXISTED BEFORE THE POST-GRANT AMENDMENT, THERE IS NO LEGAL BASIS FOR EXAMINING THE CLARITY OF THE AMENDED CLAIMS.”

The enlarged board stated that it has never been doubted that the clarity of type A(ii) amendments may be examined if an alleged clarity issue arises due to such an amendment. On the other hand, if the alleged clarity issue existed before the post-grant amendment, there is no legal basis for examining the clarity of the amended claims.

Also, the enlarged board briefly stated that clarity should not be examined if the meaning of a claim becomes critical in view of a prior art document brought forth for the first time during the post-grant proceedings. Such a situation “has to be lived with”, according to the enlarged board.

In spite of the decision by the enlarged board, this author considers it appropriate for the European Patent Office (EPO) to examine the clarity of any claims during post-grant proceedings if a clarity issue is raised by any party or discovered by the EPO on its own motion.

It is in the interest of an opponent to be able to attack granted claims on as many fronts as possible, but it could also be in the interest of the applicant to resolve a clarity issue, as unclear claims are normally given a broad interpretation and therefore increase the success of a novelty or inventive step attack.

Also, national infringement proceedings and/or revocation proceedings that often follow opposition proceedings could potentially become smoother if doubts concerning the extent of protection are resolved at the centralised EPO stage.

Finally, the enlarged board pointed out that the decision is not concerned with the right of an opponent to argue that a claim lacks clarity, as lack of clarity may play a role in an argument regarding for example added subject matter or insufficiency of disclosure, which are two examples of allowed grounds for opposition that can be raised. ■

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