

# Clearly important? G 3/14 and Amendments in Opposition

A European patent cannot be opposed simply on the basis that the granted claims are not clear; clarity is not one of the grounds for opposition. But what about amendments made during opposition proceedings - can the clarity of those amendments be challenged, particularly when the amendment merely involves bringing a dependent claim feature into the independent claim(s)? When the Technical Boards of Appeal (TBA) have considered this in the past, they have arrived at conflicting conclusions. Therefore questions were referred to the Enlarged Board of Appeal (EBA) on this point, and the EBA has now published its answers in G 3/14<sup>1</sup>. This article provides a summary of that decision and considers the implications for European patent practice.

## The Background

Any person may file an opposition to a European patent in the nine months immediately following the grant of that patent. The grounds, as appropriate, on which they can base their opposition are listed in Article 100 EPC<sup>2</sup>; clarity is not one of those grounds as Article 84 EPC<sup>3</sup> is not listed. Therefore it is accepted that the clarity of granted claims cannot be challenged in order to oppose the patent.

Once a patent has been opposed though, the examination of the opposition is carried out according to Article 101 EPC<sup>4</sup>. Articles 101(1) and (2) EPC provide that the EPO Opposition Division will consider whether at least one ground for opposition prejudices the maintenance of the European patent, but Article 101(3) EPC requires that the Opposition Division come to an opinion as to whether the patent as amended, and the invention to which it relates, meets “*the requirements of this Convention*”, in which case it is to order that the patent be maintained as amended. Thus Articles 100 EPC and 101(1) and (2) EPC provide that granted claims are not to be challenged for clarity in opposition proceedings, whilst Article 101(3) EPC states that the Opposition Division should consider whether the patent as amended meets the requirements of the EPC, which includes Article 84 EPC and so clarity. So to what extent can the clarity of amended claims be challenged during opposition?

## Conflicting Case Law

When providing a review of the current state of the case law in its decision, the EBA in G 3/14 identified three different approaches that had been taken in cases when approaching the question of whether the clarity of amended claims could be challenged in opposition proceedings.

Firstly they said there were the “conventional” cases, following T 301/87 and T 227/88<sup>5</sup>, which held that the clarity of amended claims could be challenged only if it was *the amendment* that introduced

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<sup>1</sup> The decision can be read [here](#).

<sup>2</sup> Grounds include lack of novelty, lack of inventive step, excluded subject-matter, and sufficiency. See [here](#).

<sup>3</sup> Article 84 EPC provides “*The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.*”

<sup>4</sup> See [here](#).

<sup>5</sup> See [T 301/87](#) and [T 227/88](#). Examples of cases following this “established” jurisprudence include [T 381/02 \(in German\)](#) and [T 1855/07 \(in German\)](#).

the lack of clarity, so that the clarity objection could not be considered if the objection did not *arise out of* the amendments made. The EBA then identified a second approach developed as a consequence of an (unduly, in their opinion) wide interpretation of the “arises out of” language in the above-noted “conventional” cases, in which approach it was considered appropriate to consider a lack of clarity even though it had been present in the granted claims, because that lack of clarity had been *highlighted* by the amendments<sup>6</sup>. The third and final approach identified by the EBA was that of the “diverging” cases<sup>7</sup>, for example: T 1459/05, in which the TBA decided it had discretion to consider clarity following the combining of granted claims because the resultant combination was so important for distinguishing over the cited art and yet also so unclear; T 656/07, in which the TBA decided it had the power to apply the whole of the EPC including Article 84 EPC when considering amendments requested by a patentee in the course of opposition proceedings; and T 459/09 in which the TBA decided that any substantial amendment in opposition proceedings should be subjected to an examination to ensure compliance with *all* requirements of the EPC.

### The Referral

In the referring TBA case<sup>8</sup> for G 3/14, the proprietor of the opposed Patent filed an auxiliary claim request in which granted independent claim 1 was amended by the inclusion of features from granted dependent claim 3. Those features from granted claim 3 included a lack of clarity, namely that the claimed article was coated “over substantially all its surface area”. In light of the conflicting jurisprudence, the TBA referred questions<sup>9</sup> to the EBA to ask whether an Opposition Division or TBA is required to examine the clarity of amended independent claims when the amendment arises from a combination of features already present in the granted independent and dependent claims.

### The Answer

The EBA answered the referred questions as follows:

“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.”

Or, in other words<sup>10</sup>, the alleged lack of compliance with Article 84 EPC must have been introduced by the amendment.

It is obviously important to also consider the EBA’s reasoning, which is summarised in the following, in order to appreciate the full breadth and implications of its decision.

### The Reasoning

The EBA explicitly stated<sup>11</sup> that it considered it inappropriate to take a narrow view of the referred questions, and that it intended to answer the questions not just for the specific cases of taking one, some, or all elements from a dependent claim and inserting them into the independent claim(s), but

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<sup>6</sup> The EBA identified [T 472/88](#), [T 681/00](#) and [T 1484/07](#) as cases following this second approach.

<sup>7</sup> See [T 1459/05](#), [T 656/07](#), [T 459/09](#), and also the other “diverging” cases mentioned by the EBA, [T 409/10](#) and [T 493/10 \(in French\)](#)

<sup>8</sup> [T 373/12](#)

<sup>9</sup> See [G 3/14](#), “Summary of Facts and Submissions” section 1 for the exact referral questions.

<sup>10</sup> See [G 3/14](#) “Reasons for Decision” sections 81 to 85.

<sup>11</sup> See [G 3/14](#) “Reasons for Decision” sections 2 to 7.

also for cases with other possible amendments involving the granted claims, and that it also intended to clarify the points of law that lie behind the referral questions.

Also, the EBA's answer does not mention "clarity", but instead refers to Article 84 EPC<sup>3</sup>. The Board makes clear<sup>12</sup> that this is deliberate as the answer is also supposed to address other situations that could arise where amended claims appear contrary to Article 84 EPC<sup>3</sup>, such as where there appears to be a lack of support or where the claim lacks essential features<sup>13</sup>.

The EBA did not doubt that Article 84 EPC is part of the Convention for the purposes of Article 101(3) EPC, so that when features are taken from the description and inserted into a granted claim that amended claim must be examined to check for compliance of those features, both alone and in combination with the rest of the features in the claim<sup>14</sup>, with Article 84 EPC. However, it decided that it was not the legislator's intention that *any* amendment to the claims should lead to a *complete* re-examination of all the granted claims, not least because such an opportunity would allow an opponent to cause undesirable delays by raising "all kinds of Article 84 EPC objections"<sup>15</sup>. Therefore only new objections *introduced* by amendment(s) should be allowed to be raised; this may not be optimal<sup>16</sup>, and may mean that unclear granted claims must be lived with<sup>17</sup>, but it is consistent with earlier G decisions<sup>18</sup> and to decide otherwise would make Article 84 EPC a special ground under which to attack a Patent.

The EBA acknowledged<sup>19</sup> that its decision means it approves the "conventional" approach in the case law, "as exemplified by T301/87"<sup>5</sup>, and disapproves the second<sup>6</sup> and third<sup>7</sup> approaches identified above that attempted to expand on or diverge from that "conventional" approach, labelling<sup>20</sup> those alternative approaches as arbitrary and unpredictable. Similarly, the EBA was not persuaded by arguments put forward in support of a broader approach, such as the idea that the EPO Examining Division pre-grant would have given less attention to dependent claims so that it is appropriate to give the features of those claims extra attention during opposition proceedings<sup>21</sup>, or that opposition proceedings should be an opportunity to amend or revoke (important<sup>22</sup>) patents with any kind of defect<sup>23</sup>.

The EBA explained<sup>24</sup> that in its opinion no particular significance should be given to the fact that a feature was present in a dependent claim when granted rather than an independent claim. It was its considered view that each dependent claim could have been written and treated as a separate independent claim, and that it is only for the sake of conciseness and convenience that a claim dependency system is required by the EPO, rather than the EPO permitting multiple independent claims with each reciting the same essential features of the invention with alternative additional features. If multiple independent claims had been listed and allowed, in place of a claim dependency system, then crossing out an independent claim would not provide the opportunity to raise Article 84

<sup>12</sup> See [G 3/14](#) "Reasons for Decision" section 6.

<sup>13</sup> i.e. contrary to [Article 84 EPC](#) in conjunction with [Rules 43\(1\) and \(3\) EPC](#).

<sup>14</sup> See [G 3/14](#) "Reasons for Decision" section 54.

<sup>15</sup> See [G 3/14](#) "Reasons for Decision" section 71.

<sup>16</sup> See [G 3/14](#) "Reasons for Decision" section 80(g).

<sup>17</sup> See [G 3/14](#) "Reasons for Decision" section 55.

<sup>18</sup> [G 1/91](#), [G 9/91](#) and [G 10/91](#); see [G 3/14](#) "Reasons for Decision" section 74.

<sup>19</sup> See [G 3/14](#) "Reasons for Decision" section 87.

<sup>20</sup> See [G 3/14](#) "Reasons for Decision" section 80(k) and (l).

<sup>21</sup> See, for example, [G 3/14](#) "Reasons for Decision" sections 31 to 33 and 49.

<sup>22</sup> See [G 3/14](#) "Reasons for Decision" section 80(j).

<sup>23</sup> See [G 3/14](#) "Reasons for Decision" section 80(i).

<sup>24</sup> See, for example, [G 3/14](#) "Reasons for Decision" sections 80(a) to (c).

EPC objections against the other independent claims; thus the EBA decided it would be arbitrary to allow Article 84 EPC objections simply because the invention has been limited to features that had to be listed in a dependent claim rather than in an additional independent claim. So whilst the EBA acknowledged that combining the feature(s) of a dependent claim with the independent claim was certainly an amendment, a *new* lack of compliance with Article 84 EPC would be required to raise an objection.

One theme running through the decision<sup>25</sup> is that the EBA obviously thought that being able to challenge the clarity of a dependent claim feature that is introduced into an independent claim should not be necessary as such, particularly if the incorporated feature is relied on to overcome an objection made according to a ground of opposition (and, of course, any amendment made in opposition must be occasioned by a ground for opposition<sup>26</sup>). This is because if the lack of clarity causes a problem for the interpretation of the boundaries of the amended claim, then that amended claim can probably be attacked, for lack of novelty, lack of inventive step or for insufficiency for example, rather than the claim needing to be attacked for being unclear. In essence, the EBA was obviously of the opinion that the *consequences* of the lack of clarity should be attacked rather than the lack of clarity itself. For example, the EBA cited TBA decisions where the lack of clarity of a claim had influenced the outcome of grounds for opposition<sup>27</sup> and pointed out that an Opposition Division is able to raise *ex officio* a ground for opposition in order to not admit a claim where the lack of clarity makes the claim susceptible to that ground<sup>28</sup>. Similarly, the EBA did emphasise that their decision is not concerned with whether an opponent has the right to *argue* that a claim is unclear or lacks support, and it acknowledged that arguments about that lack of clarity or support may play a role in arguing one or more grounds for opposition<sup>29</sup>.

### Practice Points

Obviously the decision is going to be of greatest significance to opponents during opposition and subsequent appeal proceedings. A savvy opponent will want to explain the consequence of a lack of clarity or support for an amended claim and link it to a ground of opposition, rather than to try to pin their hopes on successfully using Article 84 EPC as a reason to revoke an amended patent. Any objection according to Article 84 EPC itself will need to be linked to a *new* lack of compliance *caused by the amendment*, and the Opposition Division and TBA are likely to take a strict view in that respect, following this decision, particularly considering the EBA's comments regarding opponents using such objections to delay proceedings.

However, applicants should also take note of this decision, particularly if oppositions are frequently filed for their area of technology. Whilst the decision does strengthen proprietors' protection against Article 84 EPC objections during opposition and subsequent appeal proceedings, at the same time it essentially instructs opponents and Opposition Divisions to carefully consider the *consequences* with respect to claim interpretation of a lack of clarity. Therefore applicants and their representatives should be aware of any potentially unclear language whilst drafting and prosecuting a patent application; although an arguably unclear term may be desirable in certain circumstances to provide the greatest breadth to a claim, applicants should make sure they have clearer definitions or limitations for the term on which they can "fall-back" if the term is argued to make a granted claim

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<sup>25</sup> See, for example, [G 3/14](#) "Reasons for Decision" sections 26, 35, 55 and 71.

<sup>26</sup> See [Rule 80 EPC](#).

<sup>27</sup> See, [G 3/14](#) "Reasons for Decision" section 55.

<sup>28</sup> See, [G 3/14](#) "Reasons for Decision" section 80(h).

<sup>29</sup> See, [G 3/14](#) "Reasons for Decision" section 80(g).

susceptible to a ground of opposition, and ideally that “fall-back” limitation should be present in a dependent claim when the patent grants.

One consequence of this decision is that it strengthens somewhat the importance of the granted dependent claims. The fact that it has been possible to take features from the description and use them to limit independent claims post-grant, with minimal examination, using the central EPO limitation procedure has meant that arguably dependent claims have had a less important role in recent years. In addition, the introduction and subsequent increase in the cost of EPO excess claims fees has reduced the desirability of having many dependent claims in an application and patent. But this decision increases the importance of the dependent claims again since such a clear distinction is made between Article 84 EPC objections being generally permitted when raised against limiting features taken from the description, and similar objections being restricted when raised against features taken from granted dependent claims.

Therefore this decision provides an incentive to the applicant to give careful consideration to the claims of any soon-to-be granted application when they receive notification of the text that the Examining Division is prepared to grant, so as to check the claims include any “fall-back” limitations that might be required, for example. This incentive is, of course, in addition to the incentive to carefully check the text of such an application that was provided in recent years by EBA decision G 1/10<sup>30</sup>.

**If you have any questions regarding this article, then please feel free to contact [Emma Longland](#) or [Jon Broughton](#). Similarly, contact Patent Boutique [here](#) if you would like to discuss our considerable experience with EPO oppositions.**

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<sup>30</sup> See [G 1/10](#).