

EPO opposition amendments – about to become clearer

When the European Patent Office (EPO) grants a European patent, anyone who wishes can challenge that patent, within nine months of grant, in an opposition procedure.

It is very common for an opponent to produce new arguments and evidence to cause the EPO to reconsider the validity of the granted patent. In the interest of balancing the opponent's right to introduce new evidence and arguments, the EPO allows the patentee to amend the claims in response.

The opponent can challenge the patent on most of the grounds available to the EPO when examining a patent application. One ground that is not available, however, is that of lack of clarity of the claims. Therefore, once the EPO grants a patent, it presumes the claims to be clear.

However, if a patentee submits amended claims during opposition, those amended claims must meet all the legal requirements of the European Patent Convention (EPC), including clarity.

Until recently, the practice of examining amended claims for clarity was well settled. If the patentee attempted to make an amendment taken from the description of the patent, the opposition division would scrutinise that amendment very carefully, to ensure that it was clear and readily understandable. However, if the patentee made an amendment wholly within the claims (for example, incorporating a dependent claim into the independent claim upon which it depended), the division presumed that amendment to be clear, because the whole substance of the amendment was part of the granted claims.

Recently some Boards of Appeal have issued decisions opining that even such straight forward amendments should be subject to scrutiny for clarity.

Now a Board of Appeal has passed the question to the Enlarged Board of Appeal (EBA), the highest authority at the EPO.

This Board of Appeal agrees with the standard practice but, because other Boards have questioned it, believes that the EBA should give a definitive interpretation of the law.

The Board of Appeal has asked the EBA to decide whether or not an opposition division should - or even may- review the clarity of an amendment if it simply

combines a dependent claim with an independent claim. More worryingly for patentees, the Board has asked, if this is the case, to what extent should the opposition division review clarity? Should it review only the clarity of the dependent claim or does an amendment to an independent claim allow the opposition division to review the clarity of the whole new claim, including all the terms in the original granted claim? This referral has the potential to make opposition proceedings even more treacherous for patentees. Clarity is sometimes a difficult objection to overcome and, if the EBA decides that any amendment to the claims opens up the whole claim set for a clarity review, this will make keeping a patent at the EPO even more difficult after grant. Whilst there is nothing that we can do about it for now, the eventual decision may change patentees' attitudes towards amendment during opposition and, as a result, make them more cautious in the breadth of claims they try to have granted.

We do not expect the decision from the EBA for at least a year. We will let you know as soon as the EPO clarifies clarity