

## Examination of clarity in EPO opposition proceedings

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While clarity (Article 84 EPC) is not a ground of opposition at the European patent office (EPO), the clarity of amended claims can sometimes be examined during opposition proceedings.

Conventionally, when amending an independent claim to incorporate the subject matter of a dependent claim, clarity of the amended claim could not be put at issue. However when amending claims using subject matter from the description the amended claims would be open to examination for clarity. The logic behind this settled approach is that dependent claims have already been examined for clarity and have been allowed, so that making the simple combination cannot introduce a new clarity problem. Matter taken from the description, however, was not part of an allowed claim so clarity ought to be assessed afresh.

Some recent EPO Technical Boards of Appeal decisions cast doubt on the conventional approach, however. In particular decision T459/09 decided that clarity of a combined dependent and independent claim should be examined, which goes directly against the established practice.

As we reported, the EPO Technical Boards of Appeal asked the Enlarged Board of Appeal (EBA) to review the circumstances when clarity can be examined during opposition. Decision G3/14 was placed on the European patent office register on 24 March 2015.

### The decision

The EBA answered the questions put to it in the following manner:

"In considering whether, for the purposes of [deciding on an opposition], 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 [clarity] only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC."

Additionally the EBA expressly approved the conventional approach, that when amending an independent claim to introduce the subject-matter of a dependent claim, this cannot introduce a lack of clarity and so clarity may not be examined.

On the other hand if a claim is amended to introduce subject-matter from the description or drawings, G3/14 only provides a very limited scope for examining

clarity, restricted to examining the amendment itself. Making such an amendment does not, for example, open up the entire claim set to a new clarity examination.

### **Effect of the decision**

The decision is good news at least because the question is now settled, providing legal certainty for proprietors and opponents. Any opposition proceedings which had been stayed while awaiting this decision may now proceed.

The examination of clarity during opposition proceedings will now reliably follow the conventional approach: combining a dependency will not open the door for a clarity assessment, whereas combining subject matter from the description will only permit a very limited clarity examination of the matter being introduced into the claim.

The decision itself is very lengthy, and it is impossible to explore all the findings and reasoning of the EBA in this short article. Therefore please contact your usual Forrester's attorney if you have any questions or concerns about particular cases.