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# Datasheet for the decision of the Enlarged Board of Appeal of 24 March 2015

**Case Number:** G 0003/14

**Appeal Number:** T 0373/12 – 3.2.08

**Application Number:** 05851833.3

**Publication Number:** 1814480

**IPC:** A61F2/78, B29C33/40, B28B1/00

**Language of the proceedings:** EN

**Title of invention:**
NOVEL ENHANCED COATING FOR PROSTHETIC LINERS PROCESSES, PRODUCTS AND IMPROVED UMBRELLAS

**Patent Proprietor:**
Freedom Innovations, LLC

**Opponent:**
Otto Bock HealthCare GmbH

**Headword:**
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**Relevant legal provisions:**
EPC Art. 54, 56, 64, 69, 82, 83, 84, 94, 97, 99, 100, 101(1), 101(2), 101(3), 105a, 111(1), 112, 114, 123(2), 123(3), 138(1), 138(2), 138(3)
EPC R. 43(1), 43(3), 43(4), 80, 86, 95(2), 100(1)
Rule relating to Fees, Article 2, item 15

**Relevant legal provisions (EPC 1973):**
EPC Art. 101(1), 101(2), 102(1), 102(2), 102(3)
EPC R. 29(4), 61a

**Conventions**
Vienna Convention on the Law of Treaties of 23 May 1969, Articles 31, 31(1), 32

**Keyword:**
"Amendments to claims made by proprietor during the opposition proceedings before the EPO"
"Whether claims as amended during opposition proceedings required to meet requirements of Article 84 EPC"
"Meaning of the term ‘amendments’ as used in decision G 9/91"
"Meaning of the term ‘amendments’ as used in Article 101(3) EPC"
"Whether combination of granted claims constitutes an amendment"
"General ambit of Article 101(3) EPC and the requirements of Article 84 EPC in the case of amended claims"
"Ambit of Article 101(3) EPC and the requirements of Article 84 EPC in the case of amended claims encompassing insertion of elements of dependent claims as granted into an independent claim as granted"
"Ambit of Article 101(3) EPC and the requirements of Article 84 EPC in the case of amended claims encompassing insertion of complete dependent claims as granted into an independent claim as granted"

**Decisions cited:**
G 0001/84, G 0002/88, G 0006/88, G 0001/91, G 0009/91, G 0010/91, G 0001/12, J 0009/84, J 0006/96, J 0006/12, T 0127/85, T 0009/87, T 0301/87, T 0227/88, T 0472/88, T 0684/89, T 0525/90, T 0892/90, T 0126/91, T 0522/91, T 0626/91, T 0759/91, T 0617/92, T 0057/94, T 0367/96, T 0433/97, T 0005/99, T 0698/99, T 0420/00, T 0681/00, T 0326/02, T 0381/02, T 0518/03, T 1459/05, T 0656/07, T 1484/07, T 1659/07, T 1855/07, T 2049/07, T 1440/08, T 0459/09, T 4093/09, T 0589/09, T 1033/09, T 0059/10, T 0409/10, T 0493/10, T 1577/10, T 0373/12

**Catchword:**
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.

**Case Number:** G 0003/14

# D E C I S I O N
## of the Enlarged Board of Appeal of 24 March 2015

| | |
|---|---|
| **Appellant:** (Patent Proprietor) | Freedom Innovations, LLC<br>7 Studebaker Road<br>Irvine CA 92618-2012 (US) |
| Representative: | Crease, Devanand John<br>Keltie LLP<br>No. 1 London Bridge<br>London SE1 9BA (GB) |
| **Respondent:** (Opponent) | Otto Bock HealthCare GmbH<br>Max-Näder-Str. 15<br>37115 Duderstadt (DE) |
| **Representative:** | Lins, Edgar<br>Gramm, Lins & Partner GbR<br>Theodor-Heuss-Strasse 1<br>38122 Braunschweig (DE) |
| **Referring Decision:** | **Interlocutory Decision of the Technical Board of Appeal 3.2.08 of the European Patent Office of 2 April 2014.** |

**Composition of the Board:**

**Chairman:** W. van der Eijk
**Members:** K. Garnett
I. Beckedorf
H. Meinders
U. Oswald
O. Spineanu-Matei
M.-B. Tardo-Dino

**Contents**

## Summary of Facts and Submissions

*Introduction*

I. During the appeal proceedings in the referring case (**T 373/12**) the proprietor filed an auxiliary request for maintenance of the patent which consisted of a combination of granted claim 1 and granted dependent claim 3. This granted dependent claim contained a lack of clarity, namely that the claimed article was coated "over substantially all its surface area". By its decision dated 2 April 2014 and in the light of what was seen as conflicting jurisprudence of the Boards of Appeal, the Board referred the following questions to the Enlarged Board of Appeal under Article 112 EPC (hereafter: "the referred questions"):

1. Is the term "amendments" as used in decision G 9/91 of the Enlarged Board of Appeal (see point 3.2.1) to be understood as encompassing a literal insertion of (a) elements of dependent claims as granted and/or (b) complete dependent claims as granted into an independent claim, so that opposition divisions and boards of appeal are required by Article 101(3) EPC always to examine the clarity of independent claims thus amended during the proceedings?

2. If the Enlarged Board of Appeal answers Question 1 in the affirmative, is then an examination of the clarity of the independent claim in such cases limited to the inserted features or may it extend to features already contained in the unamended independent claim?

3. If the Enlarged Board answers Question 1 in the negative, is then an examination of the clarity of independent claims thus amended always excluded?

4. If the Enlarged Board comes to the conclusion that an examination of the clarity of independent claims thus amended is neither always required nor always excluded, what then are the conditions to be applied in deciding whether an examination of clarity comes into question in a given case?

II. In deciding to refer these questions, the referring Board said:

(a) The legal framework within which clarity is to be examined in opposition and opposition appeal proceedings is on the one hand determined by the facts that (a) non-compliance with Article 84 EPC is not a ground for opposition within the meaning of Article 100 EPC and (b) the provisions of Article 101(1) and (2) EPC expressly limit the examination of the opposition to the grounds set out in Article 100 EPC. On the other hand, under Article 101(3)(b) EPC the opposition division must revoke a patent which has been amended in opposition if it comes to the conclusion that the patent does not meet the requirements of the Convention. This means that the power of examination conferred on the opposition division by Article 101(3) EPC is in principle more extensive than that provided for in Article 101(1) and (2) EPC. By virtue of Article 111(1) EPC, the same applies to the Boards of Appeal.

(b) In its decision **G 9/91**, the Enlarged Board had stated (point 19 of the Reasons):

> "In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)."

The referring Board noted that the Enlarged Board did not discuss whether the term "amendments" is to be understood as being any kind of alteration to a claim, or rather only modifications which are in some way qualitative in nature. Nor, in the view of the referring Board, could any further guidance be derived from the context of the decision. In **G 9/91** the Enlarged Board was concerned with a different issue, namely the grounds for opposition which the Opposition Divisions and Boards of Appeal have to examine in accordance with Articles 99(1) and 100 and Rule 55(c) EPC 1973 (cf. Rule 76(2)(c) EPC). Objections based on Article 84 EPC do not belong to the grounds for opposition listed exhaustively in Article 100 EPC (see also: **T 381/02**, point 2.3 of the Reasons).

(c) The Board then examined in detail the jurisprudence of the Boards of Appeal. It considered that according to one line of cases, starting from **T 301/87**, Article 101(3) EPC required it to be considered whether the amendments introduced any

contravention of any requirement of the Convention, including Article 84 EPC, but did not allow objections to be based on Article 84 EPC if such objections did not arise out of the amendments made. Against this, a second and diverging line, starting with **T 1459/05**, had emerged in which a broader approach had been taken. In the broadest approach, the power to examine an amended claim for clarity was virtually unrestricted.

(d) A referral was appropriate given this divergence and the importance of the question in practice.

III. In response to an invitation from the Enlarged Board, submissions, comments and third party (*amicus curiae*) briefs were filed respectively by:

(a) The proprietor (Freedom Innovations, LLC) and the opponent (Otto Bock HealthCare GmbH);

(b) The President of the European Patent Office;

(c) The Fédération Internationale des Conseils en Propriété Intellectuelle ("FICPI"), the American Intellectual Property Law Association ("AIPLA"), the Chartered Institute of Patent Agents ("CIPA") and the Institute of Professional Representatives before the EPO ("*epi*");

(d) Koninklijke Philips N.V., a number of individual European and US patent attorneys and a number of persons who remained anonymous.

IV. Oral proceedings were not requested by either party. The written submissions, summarised below, were divided

between those arguing for the "conventional" restricted answer to the referred questions (headed by the proprietor) and those arguing, in differing degrees, for a wider power to examine an amended patent for clarity (headed by the opponent).

V. *Submissions generally in favour of the conventional, restricted approach*

V.(a) *The proprietor*

– The statement in **T 1459/05** that the number of claims in recent years had grown (so that they were not and could not all be examined) was made before the present punitive additional regime of claim fees was established. Nowadays the number of patents with claims in excess of 15 is relatively low. In fact, in the present referral case only two independent and seven dependent claims were granted.

– The power of examination conferred by Article 101(3) EPC should only extend to matters occasioned by the opposition and not to identical matters that do not concern fundamental issues of patentability that were settled during examination proceedings.

– The licensing by the Enlarged Board of a wide power to examine clarity would give an incentive to opponents to introduce new issues. The provisions of Article 101(3) EPC should be construed narrowly, in line with the vast majority of Board of Appeal decisions to date.

– In the present referral the request in question was a straightforward combination of granted claims 1 and 3. This combination was considered by the Examining Division. The EBA is now being asked to sanction the making of an opposite decision. Article 84 EPC prevented the opponent from raising a clarity objection against either granted claim 1 or granted claim 3. Why should he be allowed to do so when they are simply combined?

– In **G 9/91** the Enlarged Board said: "The requirement of Rule 55(c) EPC to specify the extent to which the patent is opposed within the time limit prescribed by Article 99(1) EPC would obviously be pointless, if later on other parts of the patent than those so opposed could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC as outlined above."

– Question 1 can only be answered "yes" in the case of a qualitative change in the nature of the claim subject matter, such that there is a manifest difference in the mind of the skilled reader in the subject matter of the claims as a result of the amendment. If, on the other hand, the amendment represents nothing more than a linguistic consolidation of the scope of the granted claims, the *status quo* should prevail. Granting the EPO powers in opposition to overturn issues already settled before the Examining Division would undermine the principles of Article 100 EPC.

– The decision in **T 459/09** was an aberration. The Board there did not explain why the term "amendments" in Article 101(3) EPC should not be construed narrowly or why an amendment should be subjected to an examination to ensure compliance with all provision of the EPC. The approach in that case is considerably broader than that suggested in **G 9/91**.

V.(b) *Amicus curiae briefs*

V.(b)(i) *FICPI*

– The legal framework for answering the questions is wider than that suggested by the referring Board.

– It is not correct to say that the power of examination conferred by Article 101(3) EPC is in principle more extensive than that provided by Article 101(1) and 101(2) EPC. **G 1/91** generally discussed whether Article 101(3) EPC means that all requirements of the EPC are to be applied to amendments made in opposition proceedings but expressly left open the "justification of a certain applicability of clarity requirements in the sense of" Article 84, 2nd sentence, EPC. It was made clear that the applicability of the term "other requirements of this Convention" in Article 101(3) EPC cannot depend merely on the wording of the article but also depends on (a) the "*ratio legis*" of the relevant article (Article 82 EPC in that case) on the one hand and of opposition proceedings on the other, (b) the legal systematics and (c) potentially its historical intention.

– Articles 75 to 76 EPC relate to an application and not to a granted patent; Article 69 EPC distinguishes between the claims of the application and those of the granted patent. The reason is that they are different in nature. Because protection is granted thereby, the claim of a granted patent has the character of a legal norm, since national courts are bound by the wording. They have to interpret the intended meaning of an "unclear" claim in the same way as for an "unclear" legal norm; they cannot invalidate the claim otherwise than within the boundaries of Article 138 EPC (reference was made to the "*Straßenbaumaschine*" decision of the German Bundesgerichtshof – XZR 95/05).

– The *ratio legis* of opposition proceedings is to allow third parties to oppose and remove unjustified protective rights conferred by the granted patent (**G 1/91**). If, for example, a patent has been granted contrary to Article 83 EPC, Article 100(b) provides the corresponding ground for opposition. A reference to Article 83 EPC would not have been suitable as this article relates solely to a patent application. The same applies to Articles 123(2) / 100(c) EPC. Accordingly, Articles 100 and 101(1) and (2) EPC provide all the necessary and intended instruments to fulfil the "*ratio legis*" of opposition proceedings.

– The requirements of the Convention to be fulfilled as referred to in Article 101(3) EPC are found in Articles 52 to 74 EPC (substantive patent law),

Articles 99 to 105c EPC (opposition and limitation) and Articles 113 to 125 EPC (common provisions relating to applicants and granted patents). Thus **G 1/91** mentions Articles 123(2) and (3) EPC as examples of the applicability of Article 101(3) EPC. On its wording, Article 84 EPC on the other hand relates to the claims of patent applications. The purpose of this article (and all of Articles 75 to 86 EPC) have found their end with the grant of the patent.

– Thus the *ratio legis* of opposition proceedings and of Article 84 EPC cannot justify a general power to examine clarity of amended claims.

– **G 1/91** left open the question of the justification of the EPO's practice of, to a certain extent, examining clarity in opposition proceedings. A direct application of Article 84, 2nd sentence, EPC is excluded by its wording and its position within the EPC, and by the legal nature of granted claims.

– The expression "patent as amended" in Article 101(3)(a) EPC must refer to the amended form as requested by the proprietor, and thus the essential question relates to the admissibility of the request rather than Article 84 EPC. As regards the admissibility of the request, Rules 80 and 86 EPC are potentially relevant. As regards Rule 86 EPC, Part III of the Implementing Regulations does not relate to clarity in the sense of Article 84 EPC (although it includes implementation of Article 84 EPC in Rule 43 EPC) and accordingly none of these procedural provisions explicitly or

implicitly relates to clarity of the claims which are requested to be maintained.

– It is nevertheless a general procedural principle that a procedural request needs to clearly identify the requested subject matter, even if some interpretation may be needed. This procedural principle may provide the necessary justification for the EPO practice of requiring clarity to a certain degree in opposition proceedings. However, this practice should not contravene the basic *ratio legis* of opposition proceedings and the legal nature of granted claims.

– A granted dependent claim and its granted independent claim each have the character of a legal norm. A dependent claim is essentially the result of the implementation of the conciseness requirement of Article 84 EPC as implemented by Rule 43(4) EPC. Any combination of granted claims merely represents the cancellation of a subset of granted claims and a restriction to the remaining granted claims. As a result, in such a case there is no room for an examination of clarity, whether of the procedural request or by analogous application of Article 84 EPC. If that amended claim could then be examined for clarity, then this would in effect be to accept Article 84 EPC as a ground for opposition. The meaning of the claim has to be determined by interpretation.

– As regards Question 2, examination for clarity in the case of the insertion of a feature from a dependent claim into the independent claim is not prohibited by the legal character of the granted

claim. Nevertheless, examination for clarity is not appropriate for all cases:

(a) There should be an entitlement to examine for clarity where the amendment results in a clarity problem which was not present in the granted claims. This is because, when considering the balance between legal certainty for the public and the justified interests of the proprietor, new clarity problems should be avoided.

(b) If, however, the clarity problem was already present in the granted claims, clarity should not be examined. The interests of the proprietor should prevail since the problem was already present and as regards the public legal certainty has not been changed by the amendment.

V.(b)(ii) *Other amicus curiae briefs*

– Claims should be so formulated that they define the matter for which protection is sought. The claims and description must or should correspond to each other such that the description supports the claims.

– A claim is unclear when for the skilled person at least two different meanings are possible, so that even when using the description and drawings as an aid he cannot tell which meaning is intended.

– The use of the description in the examination of the claims is required because Article 84 EPC requires a clear and concise formulation of the

claims, which means that the explanation in the description serves to help understand the claims, while at the same time the description must serve the function of supporting the claims.

– Claims which are unclear are not allowed in examination proceedings.

– While under German law lack of clarity is not a ground of revocation, German courts (the Bundespatentgericht and the Bundesgerichthof) apply Article 84 EPC in examination of amendments made during nullity proceedings and have not allowed unclear amendments to claims.

– The Boards of Appeal have repeatedly said that claims must be clear so that competitors can know without undue burden when they are working within or without the scope of the claims. The EPC transfers the determination of the scope of protection (of granted claims) to the EPO only when the claims are amended in opposition proceedings. It must then be examined whether the scope of protection extends beyond the application as filed (Article 123(2) EPC). Otherwise the exact scope of protection is left to the national courts.

– In infringement proceedings before national courts it may be disputed (but seldom is) what are the technical properties or features that the alleged infringement exhibits. Mostly, however, the dispute is about the interpretation of the claims according to Article 69 EPC. The defendant usually says that the claimant interprets the claims wider

than foreseen by Article 69 EPC, while the claimant usually says that the defendant interprets the claims too literally, which is forbidden by the Protocol to Article 69 EPC. Whether the relevant claim is clear within the meaning of Article 84 EPC in practice plays no role. History shows that a claim can be differently interpreted by different national courts.

– An examination of the scope of protection by the EPO is hopeless because it cannot be known how the national court will interpret the claims.

– If a claim is unclear, national courts will or may interpret the claim to the advantage of the defendant.

– Particularly when it comes to numbers or measurements, the infringement court may interpret the claim in a reasonable rather than a strict way.

– For the German courts, a granted patent has the character of a legal norm. This remains the case even when the claim is unclear or interpretation is difficult.

– Thus whether a claim is clear within the meaning of Article 84 EPC cannot be decided by reference to its wording alone.

– It is not possible to draw a dividing line between clear and unclear claims.

VI. *Submissions generally in favour of a wider power*

VI.(a) *The opponent*

– In the light of **G 9/91** it is clear that after grant a further examination of the patent is possible in respect of one or more of the grounds for opposition in Article 100 EPC. Where at least one ground for opposition is substantiated (and thus opposition proceedings opened), and amendments are proposed by the proprietor, the Opposition Division must examine whether the patent and the invention to which it relates satisfy all the requirements of the EPC.

– **T 409/10** and **T 459/09** conclude that an examination for clarity is permissible when an amendment of a substantial nature is made even when, according to **T 459/09**, this consists of a combination of granted claims. This recent jurisprudence, which diverges from the earlier case law, should be confirmed. Article 101 EPC does not justify the conclusion that an examination for clarity is never possible when the alleged lack of clarity was already present in the granted claims. The grounds for opposition merely limit the grounds on which opposition proceedings can be "opened". Article 100 EPC says nothing about the duty to examine under Article 101 EPC

– The referred questions take the position that a combination of granted claims constitutes an amendment. It cannot be doubted that the taking of features from a granted dependent claim into its independent claim constitutes a substantial

amendment ("*wesentliche Änderung*"), which is addressed in Article 101(3) EPC. This follows from the wording: "taking into consideration the amendments made by the proprietor of the European patent during the opposition proceedings". The starting point for this situation is Article 101(2) EPC and the fact that the unamended claims do not satisfy the requirements of the EPC ("at least one ground for opposition prejudices the maintenance of the European patent"), whereas perhaps the amended claims do. An amendment in the sense of Article 101 EPC is thus something which is suitable to help make the claims patentable, whether or not they in fact do so in the particular case. A combination of a dependent claim with its independent claim is therefore an amendment in the sense of Article 101(3) EPC and **G 9/91**.

– The distinction in the earlier jurisprudence of the Boards of Appeal, namely that the possibility to examine an amended claim for clarity depends on whether the lack of clarity was already present in the granted version, is in many cases hardly possible. By virtue of the incorporation of a feature from a granted dependent claim into its independent claim an existing lack of clarity may have a much greater importance than was the case for the granted dependent claim. Often such an incorporation involves not merely an aggregation of an additional feature but alters the whole teaching of the independent claim. To limit the ability to examine the claim for clarity would be to limit the ability of the Opposition Division to

examine in a way that makes no sense. The Examining Division would need the abilities of a prophet to evaluate the effect of adding any particular feature taken from interdependent claims.

– The limited grounds on which opposition proceedings can be "opened" have the purpose that opposition proceedings cannot be based on the grounds of purely formal defects in the examination procedure or the decision to grant. This does not exclude the possibility that clarity can be examined if an admissible opposition leads to an amendment in the subject matter claimed.

VI.(b) *The President*

– Article 101(3) EPC is the core provision so far as examination of amendments to patents is concerned. It is to be borne in mind that the elaborate provisions in the EPC for substantive examination and opposition are designed to ensure that only valid European patents should be granted and maintained in force by the EPO (**G 1/84**). The answers to the referred questions will thus have a large impact on the quality of European patents.

– The requirements of Article 84 EPC serve the purpose of ensuring that the public is not left in any doubt as to what subject matter is covered by a particular claim. It thus serves the paramount importance of legal certainty.

– Independent claims must contain the essential features of the invention; dependent claims

contain particular embodiments. The requirement of clarity applies to both types of claims.

– The requirement of clarity is not a ground for opposition and thus cannot be invoked against the claims of the granted patent. When, however, amendments are made, Article 101(3) EPC confers on the Opposition Division a broader competence, allowing it to examine the amended patent in the light of the requirements of the EPC. This broader competence is confirmed in **G 9/91** and **G 10/91**, point 19 of the Reasons. In contrast to unity of invention, clarity is required for texts amended in opposition proceedings: **G 1/91**.

– **G 9/91** and **G 10/91** do not say what kinds of amendments give rise to a requirement of a full examination in opposition. The same is true of Article 101(3) EPC. The case law of the Boards of Appeal is divided on the point. Although lack of support is not referred to in the referred questions, this also plays a role.

– The *travaux préparatoires* for the EPC 1973 do not give a direct answer to the referred questions. Nevertheless the importance given by the legislator to the requirements of Article 84 EPC can be inferred from the fact that they are found in an article rather than in the implementing regulations. The *travaux préparatoires* show that the decision not to make lack of clarity a ground for opposition or revocation was deliberate and, in the case of opposition proceedings, was taken with a view to streamlining opposition proceedings.

– The wording of the predecessor to Article 101(3) EPC was in fact changed to its present form during the preparatory work, showing that the initial intention of the legislator had been to limit the examination powers of the opposition division to the grounds for opposition, and that these powers were then broadened.

– The predecessor of Article 101(3) EPC was altered by the EPC 2000 to provide a clear legal basis for revocation if the patent as amended did not meet the requirements of the EPC. The working documents show that in the case of amendments during opposition proceedings, the conformity of the amended patent with all the provisions of the EPC is required.

– In the course of the revision for the EPC 2000 it was again proposed by a national delegation (the UK) that lack of support should be introduced as a ground for opposition and revocation to combat unduly broad claims. This was not accepted on the basis that the same objective could be achieved by applying either Article 83 or 56 EPC. A separate proposal by *epi* that lack of clarity should be made a ground for opposition was also rejected.

– From all this it can be concluded that a practical need was seen by users and that it was confirmed that the patent as amended during opposition proceedings is to be examined as to its conformity with all the provisions of the EPC and that Article 84 EPC can be a ground for revocation of a patent in amended form.

– In the context of negotiations on a Substantive Patent Law Treaty, a paper on practices under certain national / regional laws showed that in 2002 most systems under consideration had requirements comparable to those of Article 84 EPC and these constituted grounds for opposition and/or revocation.

– As to the case law of the Boards of Appeal, only some have allowed examination for clarity where features from dependent claims are introduced into the independent claim. The majority have not done so. The same is true for a combination of granted claims. The same type of argument is applied in each case, and is also partly relied on in cases where the added feature has been taken from the description. (The President's submissions contain a comprehensive review of the jurisprudence of the Technical Boards of Appeal. This is not repeated here but the case law, with the Enlarged Board's comments on it, is summarised by the Enlarged Board in Section E, points 18 to 43, below).

– Because of the existing divergence in the case law the present Guidelines for Examination say only that in the case of amendments Article 84 EPC objections can only be made if the alleged deficiency is a consequence of the amendment but not if it does not arise out of the amendment (citing **T 301/87**). A clarification of the law is of the utmost importance to the work of the Opposition Divisions. About 70% of opposition cases for which there were minutes in 2013 were

based on a patent as amended in the opposition proceedings.

– As to the interpretation of Article 101(3) EPC, the crucial question is where the limits of examination of amended claims are to be set. The wording of Article 101(3) EPC does not limit the power to examine but states that the patent as a whole and the invention to which it relates must comply with the requirements of the EPC. In this it corresponds to the wording of Article 97 EPC, relating to the examination proceedings and thus the intention of the legislator can be inferred to confer similar powers on both the Examination and the Opposition Divisions.

– The expression "the amendments made by the proprietor of the European patent during the opposition proceedings" in Article 101(3) EPC is of an absolute nature, neither qualifying the scope nor the nature of the amendment (**T 459/09**). Such an interpretation is in line with other provisions of the EPC governing the right to amend an application or a patent (Article 123 EPC and Rule 137 EPC). Under Rule 137(3), for example, the Examining Division is essentially required to consider and balance all relevant factors, in particular the interests of applicants in obtaining a valid patent and the interests of the EPO and the public in a simple and effectively conducted examination procedure; the nature of the amendment itself is not relevant. From **G 7/93** it follows that amendments which do not require

reopening of substantive examination may be allowable: nevertheless they are amendments.

– Even if it were to be accepted that the power to examine for clarity only applies in the case of "substantive" amendments, any admissible amendment must be substantive in the sense that by the incorporation of a technically meaningful feature it is designed to overcome an objection (Rule 80 EPC; **T 459/09**). This is in line with **G 9/91** and **G 10/91**, which refer to "amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings" without specifying the kind of amendment.

– The main reason given in the case law for the limit on the power to examine amended claims for clarity is that Article 84 EPC is not a ground for opposition. However, Article 101 EPC makes a clear distinction between cases where no amendments are made (Article 101(2) EPC) and where amendments are made (Article 101(3) EPC). In the latter case the power to examine is not limited to the grounds for opposition. The wording of the predecessor to Article 102(3) EPC was explicitly changed to make this clear. Any amendment made to an independent claim affects all dependent claims, so all dependent claims need to be examined for clarity. **G 9/91** and **G 10/91** state that all dependent claims may be examined, even if the opposition is only directed to the independent claims.

– Clarity or lack of support problems that were already present in the claims as granted must be objected to during examination proceedings under

Article 94(1) EPC (*sic*). Opposition proceedings are not to be seen as a continuation of examination proceedings and are conceived as a simple, speedily conducted procedure, where relevant objections should on the one hand be given appropriate consideration while on the other a decision should be reached as quickly as possible.

– While Article 84 EPC was not made a ground for opposition, the patent as amended during opposition proceedings has not yet been examined and could not have been examined by the Examination Division as to the requirements of the EPC. New clarity issues may arise even in the case of the incorporation of a dependent claim into the independent claim.

– A lack of clarity may also be highlighted in a case where there were multiple dependencies between claims which are now combined in a way that did not previously have the same importance.

– Clarity of the claims is of importance for the public and for the patentee. It is a prerequisite of legal certainty and avoids costly national infringement and revocation proceedings. Opposition proceedings are centralised, cost-effective proceedings in contrast to individual national nullity / infringement proceedings.

– The importance of clarity is underlined by the proposal to introduce clarity as a ground for opposition and revocation in the preparation for the EPC 1973. It must also be borne in mind that

other patent systems have such grounds for opposition or revocation. The fact that it was not introduced has been qualified as a "congenital defect of the EPC". The need for procedural efficiency in opposition proceedings should not override the necessity that the patent as amended and the invention to which it relates have to meet the requirements of Article 84 EPC.

– The further requirement of Article 84 EPC that the description should support the alternatives falling within the scope of the claims reflects the general principle that the claims should correspond to the technical contribution to the art (**T 409/91**). The repeated attempts to introduce lack of support as a ground of opposition and revocation show that a practical need is seen to make objections under Article 84 EPC in case the claims are not sufficiently supported by the description.

– If there is no power to object to amendments introducing clarity problems, the ambiguities have to be resolved by interpreting the claims during opposition proceedings. The same is the case during national infringement / revocation proceedings, possibly resulting in different interpretations of the claims. Even though file history is not accepted in all jurisdictions as a source of interpretation of a claim, national courts and the parties should benefit from a sound examination as to the clarity of a patent instead of being burdened by extensive research in the

examination or opposition file to be able to sort out inconsistencies.

– It is true that some issues of clarity or lack of support are in effect dealt with under Article 83 EPC (e.g. in **T 465/05**, **T 815/07**; but compare **T 593/09**, Reasons 4). This case law can be seen as supporting the idea that the power under Article 101(3) EPC should not be unnecessarily limited since there is a practical need for addressing such deficiencies in opposition proceedings.

– The referred questions should therefore be answered as follows:

(1) Yes. This answer should also be extended to the requirement under Article 84 EPC that the claims must be supported by the description.

(2) Yes. Examination should not be limited to the inserted features. An in-depth examination as to clarity is essential for the maintenance of valid patents in that it enhances legal certainty.

(3), (4). Examination as to clarity should not be restricted to exceptional circumstances. In any event an examination as to clarity is unavoidable if otherwise further examination of the amended patent would be considerably more difficult without such examination, for example where the technical significance of the added feature is decisive for distinguishing the claim over the prior art.

VI.(c) *Amicus curiae briefs*

VI.(c)(i) *General policy considerations*

– The clarity of claims is important for the patentee and third parties.

– It is particularly important for the EPO to require clarity at every step of the proceedings because Article 138 EPC does not permit revocation for lack of clarity by national courts, and appropriate procedures should therefore be adopted.

– Of three policy considerations relevant to the referred questions, namely (a) limiting obstacles to obtaining a patent, (b) avoiding greater complexity in opposition proceedings and (c) assuring the quality of European patents, consideration (c) is paramount. A patent with some possible clarity defects is worth more than no patent at all (especially in Europe, where clarity is not directly reviewable in national revocation proceedings).

– In the interests of undistorted competition, invalid intellectual property rights should be eliminated.

VI.(c)(ii) *Examination proceedings*

– There needs to be a sliding scale in terms of the strictness of the approach to clarity. For those technical features which are of decisive

importance, a level of clarity is needed which is adequate for the task of distinguishing the claimed subject matter from that which is not claimed. Otherwise, a lesser degree of clarity can be tolerated. Fair protection for the inventor should be balanced against legal certainty for the public.

– If during examination an independent claim is found to be, e.g. novel, it does not matter (for the purposes of novelty) that a dependent claim is unclear: it will still be new. Only if other prior art is cited during opposition proceedings may it then become critical whether the dependent claim clearly delineates the subject matter over this prior art. Indeed it may not have been possible to identify the lack of clarity during the examination proceedings, i.e. it will only have become apparent in the light of the newly cited prior art.

– The resources of the Examining Division to examine dependent claims are finite, and they must be prioritised. Independent claims will inevitably receive greater attention than dependent claims.

– Where in examination proceedings there is doubt about the clarity of a claim, it is reasonable for an Examiner to give the benefit of the doubt to the applicant.

– It is unlikely that giving greater attention to the clarity of dependent claims in examination would improve the quality of the granting process

as a whole. In any event it is now too late to affect granted patents.

– In reality, only the clarity of independent claims is strictly examined during examination proceedings. If at all, the wording of dependent claims in isolation may be examined for clarity but not taken in combination with the independent claim.

– It is not realistic to think that claims with multiple dependencies are examined for clarity in examination proceedings.

VI.(c)(iii) *Opposition proceedings*

– The reason why clarity is not a ground for opposition is that the claims were examined for clarity in examination proceedings. The same does not apply to claims amended during opposition proceedings.

– While it may make sense to limit the grounds for opposition (to prevent time-wasting and vexatious oppositions which quibble about clarity), this no longer applies once the claims have to be amended.

– Words can never define an invention with 100% clarity. Therefore if Article 84 EPC were a ground for opposition every granted claim would be attacked.

– **G 9/91** sets out a clear position based on a careful consideration of the provisions of the EPC as well as the intention of the drafters of the

EPC to impose a duty in post-grant proceedings to avoid the risk of maintenance of invalid patents, since this would make the EPC less attractive.

– A clear distinction is drawn between on the one hand Article 101(3) EPC (which refers to the requirements of the Convention) and on the other Articles 101(1) and 101(2) EPC (which only refer to the grounds for opposition). The difference must have been intentional. The "requirements of the Convention" (which clearly include Article 84 EPC) are broader than the grounds for opposition. Nothing justifies a narrow reading of Article 101(3) EPC or the word "amendment" or limiting the examination of issues relating to the amendment. The wording of Article 101(3) EPC does not permit the EPO to limit its examination for clarity depending on whether or not the alleged lack of clarity arises out of the amendments made.

– Where the amendment does not satisfy the requirements of the Convention, revocation is mandatory.

– The words "taking into consideration the amendments ... made during the opposition proceedings" only suggest something to be considered. If a limitation on the power to examine had been intended, words such as "based upon" would have been used instead of "taking into consideration."

– The assumption is that a granted patent meets all the requirements of the EPC, and thus that all dependent claims meet the requirements of

Article 84 EPC. The onus of proof should therefore be on an opponent to make a prima facie case that the incorporation of all the features of a dependent claim into an independent claim does not meet the requirements of Article 84 EPC. In this respect, merely pointing out that an amendment has been made should not be regarded as making out a *prima facie* case.

– Article 84 EPC issues should be examined when a dependent claim is either wholly or partially inserted into an independent claim. The suggestion that a dependent claim inserted into an independent claim is (still) a granted claim is not supported by Article 101(3) EPC.

– Nothing in the EPC justifies the conclusion that merely combining claims is not an amendment. Article 101(3) EPC does not distinguish between different types of amendment; it applies whatever the type of amendment. The conventional case law interprets the term "amendment" in Article 101(3) EPC and **G 9/91** in a way that is too restrictive. It is not supported by any specific provision of the EPC. It is pointless and not legally justified to distinguish between different types of amendments to justify whether a power to examine for clarity exists or not. Limiting the power to examine for clarity to amendments which are substantial is unclear since whether an amendment is substantial depends on the subjective opinion of the Opposition Division or Board of Appeal.

– While the referral is focused on clarity, if an amended claim violates Articles 83 or 123(2) EPC,

it should in the same way not be maintained even though the grounds for opposition under Article 100(b) or 100(c) EPC have not been invoked. In some decisions of the Boards of Appeal where the features of a dependent claim which is dependent on a number of higher claims have been incorporated into an independent claim, the amended claim has been examined to see if it meets the requirements of Article 123 EPC, on the basis that the dependencies lead to the need for such examination. If this is correct, then amended claims should also be examined for compliance with Article 84 EPC.

– The EPO's brand image is quality. Once it is established that a ground for opposition prejudices the maintenance of a patent, the EPO should not maintain it in amended form if it fails (for any other reason) to satisfy the requirements of the EPC. The fact that there are opposition proceedings indicates that the patent is important and that there may be litigation about it. Lack of clarity means legal uncertainty and litigation costs.

– The justification given in **T 301/87** for not examining clarity of amendments involving granted claims cannot be correct, since:

(a) Amendments made in opposition proceedings are never minor. They are made to overcome an objection.

(b) While it makes sense to provide that a granted patent should only be reviewed against a limited

set of opposition or revocation grounds so as not to disturb granted patents too easily, this no longer applies once it has been found that the patent cannot be maintained. Examination has to be reopened anyway.

(c) An opposition is not only limited to the opposition grounds in Article 100 EPC, it is also limited by the notice of opposition. Where an amended claim violates one of the opposition grounds which have not been invoked, the EPO should not maintain the patent where it knows of such a violation. There is no difference between a provision such as Article 84 EPC and provisions such as Article 83 and Article 123 EPC which have not been invoked by an opponent.

– A proprietor who in opposition proceedings combines a dependent claim with the independent claim should not be in a better position than an applicant who does the same thing in examination proceedings (when the amended claim will be examined for clarity).

– A feature taken from the description and inserted into a granted claim in order to save a patent will be subjected to the full rigour of examination for clarity; yet a feature taken from a granted dependent claim will not. This inflexible and unbalanced approach cannot be right.

– Rule 80 EPC should be interpreted such that the words "occasioned by" include the notion of "directly or indirectly", thereby allowing a

proprietor to further amend claims to meet valid Article 84 EPC objections following amendment to overcome a ground of opposition under Article 100 EPC.

– Thus (variously, according to the different submissions), on any amendment the whole patent should be examined for its compliance with the EPC, alternatively just the amended claims. Alternatively, the amended claims should be examined for compliance with Article 84 EPC in all circumstances, alternatively according to the criteria applied in one or more of the "diverging" decisions of the Boards of Appeal. Another suggested approach is that where it can be seen prima facie that a clarity issue has arisen as a result of an amendment, clarity should be examined on a reasonable but not open-ended basis. Alternatively, clarity of amended claims should be addressed but only to the extent of establishing whether an amendment to an independent claim would have the effect of rendering that claim as amended so unclear as to be on any reasonable view "insolubly ambiguous" (following the approach of the US Federal Circuit). A further submission was that as regards Question 4, the first condition should be whether there is a potential issue under Article 84 EPC in the independent claim as amended. A second condition should be that such potential Article 84 EPC issue does not entirely and exclusively reside in the set of features of the unamended claim. If the amended feature contributes to the issue under Article 84 EPC in any way or to any significant degree, the amended

patent should be examined for compliance with Article 84 EPC.

## Reasons for Decision

A. *Admissibility of the referral*

1. The referring decision draws attention to the divergence in the jurisprudence of the Boards of Appeal that has emerged, something which is confirmed by the submissions of the parties, the comments of the President and the *amicus curiae* briefs, and is discussed further below. It is also not in doubt that the referred questions raise a point of law of fundamental importance, since the answers will have an impact beyond the specific case at hand and will be relevant to a large number of similar cases. See **G 1/12** (to be published in OJ EPO), points 11 and 12 of the Reasons. An answer to at least some of the referred questions is also required to enable the referring Board to reach a decision on the appeal before it. The referral is therefore admissible.

B. *The referred questions: preliminary considerations*

2. The referring decision asks, in part (b) of Question 1, whether the term "amendments" as used in **G 9/91** is to be understood as encompassing a literal insertion of complete dependent claims as granted into an independent claim. Adopting the classification of the referring Board, this will be referred to as a Type B amendment. A simplified example is: granted claim 1, a product comprising X; granted claim 2, a product according to claim 1 wherein the amount of X comprised

in the product is substantial; amended claim 1: a product comprising a substantial amount of X.

The lack of clarity may of course already have existed in the independent claim, for example: granted claim 1, a product comprising a substantial amount of X; granted claim 2, a product according to claim 1 also comprising Y. See, e.g., **T 626/91**.

3. The referring decision also asks, in part (a) of Question 1, whether the term "amendments" as used in **G 9/91** is to be understood as encompassing a literal insertion of elements of dependent claims as granted into an independent claim. Again adopting the classification of the referring Board, this will be referred to as a Type A amendment. This class of amendments is not so straightforward as the Type B class of amendments. It includes:

(a) Cases where a dependent claim contains within it alternative embodiments (perhaps with one or more of them being preferred), one of which is then combined with its independent claim, for example: granted claim 1, a product comprising X; granted claim 2, a product according to claim 1, comprising also a substantial amount of either Y or [preferably] Z, the amended claim then being to a product comprising X and also a substantial amount of Z. Examples are **T 681/00** and **T 1484/07**. A similar example would be where a dependent claim requires a compound to be chosen from amongst a range of specified compounds, the amended independent claim then requiring the product to contain one such compound. See, e.g., **T 493/10**. The Enlarged Board will refer to these as Type A(i) cases.

(b) Cases where a feature is introduced into an independent claim from a dependent claim, being a feature which was previously connected with other features of that dependent claim from which it is now disconnected. The referral is not really concerned with cases where the effect of an amendment is to introduce an alleged lack of clarity which did not previously exist. It has not been doubted in this referral and is the consistent jurisprudence of the Boards of Appeal that in such cases amended claims may be examined for compliance with Article 84 EPC. Rather, the referral is concerned with cases where the effect of an amendment is not to introduce a lack of clarity, i.e. it is concerned with cases where the alleged lack of clarity already existed in the granted claims. The point was well put in **T 589/09**, where a technical feature in dependent claim 4 was incorporated into the independent claim 1. The Board said that:

> "... the incorporated feature of granted claim 4 does not interact with the other features of claim 1 in a way that modifies the original meaning of the combination of features of granted claims 1 and 4."
> (See point 1.2.1 of the Reasons).

The Enlarged Board will refer to these as Type A(ii) cases.

4. The referring Board was confronted with a Type B case (see point I, above) and therefore an answer to the question concerning Type A cases is not required by the referring Board to reach a decision on the appeal

before it. Nevertheless the Enlarged Board considers that it is appropriate to deal with both types of cases in this decision.

5. Beyond these two general classes of amendments raised in the referral, other variants relating to granted claims are possible. Examples, not necessarily exclusive, are:

(a) Deletion of an entire independent claim (usually with any dependent claims) leaving other independent claims (and their dependent claims) untouched, e.g., **T 9/87** (OJ EPO 1989, 438).

(b) Deletion of some dependent claims entirely, e.g., **T 522/91** and **T 759/91**.

(c) An amendment consisting of deletion of wording from a granted independent or dependent claim, thereby narrowing its scope, but leaving a pre-existing unclear feature. See, e.g., **T 301/87** (granted claim amended by deletion of the phrase "exemplified but not limited to" various DNA inserts, thus limiting the claim to the previously exemplified DNA inserts).

(d) Deletion of optional features from a granted claim (whether independent or dependent).

The Enlarged Board considers that the answers to the referred questions should also take these other possible scenarios into account and be applicable to them.

6. The referral refers to the examination of amended claims for clarity. As pointed out in various submissions, however, Article 84 EPC, which is at the heart of the referral, concerns more than just clarity as such. Thus in **T 433/97** an inconsistency between an amended claim and certain parts of the description and drawings was alleged but this did not originate with the amended passages of the claim but was already present in the claim as granted. In **T 367/96** lack of support for an amended claim was alleged but such lack of support was already present as regards the granted patent. In **T 518/03** it was alleged that the independent claims lacked essential features, an objection usually dealt with as one of lack of clarity under Article 84 EPC in conjunction with Rules 43(1) and (3) EPC. In each of these cases the opponent's objections (based on Article 84 EPC) were disregarded in accordance with the "conventional" jurisprudence identified by the referring Board (i.e. that starting from **T 301/87**, OJ EPO 1990, 335 – see point 18, below). The Enlarged Board considers that the answers to the referred questions also need to take these kinds of situations into account.

7. In summary, and having regard to the purpose for which questions are referred to the Enlarged Board (as set out in Article 112 EPC), the Enlarged Board does not consider it appropriate to take too narrow a view of the referred questions, but that it should consider and answer them in such a way as to clarify the points of law which lie behind them. See **G 2/88** and **G 6/88** (OJ EPO 1990, 93 and 114), point 1 of the Reasons in both cases.

*C. The question of law*

8. The question of law turns on the correct interpretation of Article 101(3) EPC, which provides as follows:

> "If the Opposition Division [or Board of Appeal] is of the opinion that, 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
>
> (a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that the conditions laid down in the Implementing Regulations are fulfilled;
>
> (b) do not meet the requirements of this Convention, it shall revoke the patent."
>
> (Words in square brackets added by the Enlarged Board, based on Article 111(1) EPC and Rule 100(1) EPC).

9. Question 1 of the referral asks how the term "amendments" as used in **G 9/91** is to be understood. While the Enlarged Board understands why the question was framed in this way the relevant question of law is not how the statement of the Enlarged Board in **G 9/91** should be interpreted but rather how Article 101(3) EPC should be interpreted.

10. Put broadly, at one end of the spectrum it is argued that the article means that whenever an amendment is made to a granted patent, the whole patent, and not just the amended portions of the claims, must be examined for compliance with all the requirements of

the EPC. At the other end it is argued that an objection under Article 84 EPC can only be examined when an alleged lack of clarity has been introduced by the amendment, i.e., when it did not previously exist. There are also intermediate positions.

11. The Enlarged Board will return to the issue of interpretation but will first consider how the issue has been dealt with in the decisions of the Boards of Appeal.

*D. The existing jurisprudence of the Enlarged Board of Appeal*

12. In **G 1/91** (OJ EPO 1992, 253), the proprietor had amended the claims during proceedings before the Opposition Division, turning an independent claim and four dependent claims into three independent claims (plus one further dependent claim). In appeal proceedings the opponent raised an objection of lack of unity. Whether this was allowable was referred to the Enlarged Board, who said:

> "2.1 ... Article 102(3) EPC [1973, the predecessor of Article 101(3) EPC] ... stipulates that, when the patent is maintained as amended, "the patent and the invention to which it relates (must) meet the requirements of this Convention". This could at first be taken to mean that every single requirement of the Convention must be met. Such an interpretation is also borne out by the fact that Article 102(3) EPC [1973] contains exactly the same wording as that chosen for Article 94(1) EPC with regard to the European patent application.

> 2.2 The wording of the provisions referred to above, however, also gives grounds for concluding that the requirements which an amended patent must meet are not necessarily the same as those demanded of a patent application, although that only justifies excluding those "requirements" under Article 102(3) EPC which it would be unreasonable to apply to the patent as well as to the patent application. This cannot be said of the requirement for unity of invention." (Emphasis added by the present Enlarged Board).

The Enlarged Board went on to say that where a potentially relevant rule applied to opposition proceedings (in that case former Rule 61a EPC 1973, now Rule 86 EPC) such "a Rule can only be taken to refer to those requirements which it would still be reasonable to demand of the new documents relating to the amended patent". (The reference to "new documents" is clearly to the amended claims.) Since the requirement of unity was essentially an administrative requirement and had no relevance in opposition proceedings, it was not reasonable to require the amended claims to comply with Article 82 EPC.

13. In argument it had been pointed out that new documents filed in opposition proceedings were examined for clarity within the meaning of Article 84 EPC, so that the question arose of why Articles 82 and 84 EPC should be regarded differently in opposition proceedings. As to this, the Enlarged Board said (point 5.2 of the Reasons):

> "There is … no need to consider how to justify the fact that EPO practice attaches a certain degree of

importance to clarity within the meaning of Article 84, second sentence, EPC at the opposition stage, but none to unity under Article 82 EPC. Both regulations belong to a series of provisions - from Article 81 (Designation of the inventor) to Article 85 (The abstract) - which vary greatly in relevance to the granted patent, if they retain any relevance at all. There is therefore no contradiction in the fact that, when the patent is amended in opposition proceedings, unity no longer has any relevance, but the amended texts are still required to be clear. What exactly is to be understood by clarity within the meaning of Article 84, second sentence, EPC need not therefore be discussed in this context."

14. In **G 9/91** (OJ EPO 1993, 408) certain claims of the granted patent concerned compounds of Type X and other claims those of Type Y. In the grounds for opposition, revocation was sought only in so far as the patent concerned compounds of Type X. Claims to compounds of Type Y were not attacked. The patent was maintained in amended form with claims to both types. In the appeal the opponent then sought revocation of the patent as a whole, i.e., also in respect of claims to Type Y compounds. The Enlarged Board was asked by the referring Board whether the power of the Opposition Division and Boards of Appeal to examine and decide on the maintenance of the patent under Articles 101 and 102 EPC 1973 was dependent on the extent to which the patent is opposed in the notice of opposition. In a referral by the President of the Office in the consolidated case of **G 10/91** (OJ EPO 1993, 420) the President asked whether, in the examination of an opposition, the Opposition Division was obliged to

consider all the grounds of opposition referred to in Article 100 EPC or whether the examination was restricted to the grounds referred to in the statement of grounds for opposition. As to the reference in **G 9/91**, the Enlarged Board said (point 10 of the Reasons):

> "… The requirement of Rule 55(c) EPC to specify the extent to which the patent is opposed within the time limit prescribed by Article 99(1) EPC would obviously be pointless, if later on other parts of the patent than those so opposed could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC … ."

15. The answer to the referred question was therefore: no (subject to the point that where an independent claim fell, the subject matter covered by a dependent claim might under specified conditions also be examined). So far as the question in **G 10/91** was concerned, the Enlarged Board rejected the view that under Articles 101(1) and 102(2) EPC 1973 the Opposition Division had not only a power but also a duty to examine all the grounds for opposition, whether or not the notice of opposition was based on all such grounds. However, the Opposition Division did have a power under Article 114 EPC to raise a ground for opposition not covered by the notice of opposition under certain conditions (point 16 of the Reasons). In contrast, the Boards of Appeal had no such power unless the proprietor agreed to such ground being introduced (point 19 of the Reasons).

16. Having reached these conclusions the Enlarged Board then added (point 19 of the Reasons in both cases):

> "In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)." (Emphasis added by the present Enlarged Board).

It is to be noted that the Enlarged Board did not say that the patent as amended should be examined for its compatibility with the requirements of the EPC; only the "amendments" are referred to. However, as noted in point 3.2.1 of the Reasons in the referring decision, the Enlarged Board did not discuss whether the term "amendments" is to be understood as being any kind of alteration to a claim, or rather only modifications which are in some way qualitative in nature. Further, the Enlarged Board there was not directly concerned with the present issue.

17. Nevertheless, the claims in the case underlying **G 9/91** had been amended before the Opposition Division, something that the Enlarged Board was clearly aware of (see point 1 of the Reasons). The present Board considers it highly unlikely that the Enlarged Board did not have well in mind the provisions of Article 102(3) EPC 1973, not least because the words in the above-cited passage ("such amendments are to be fully examined as to their compatibility with the requirements of the EPC") echo the provisions of Article 102(3) EPC 1973 and were presumably the basis

for this statement. If the Enlarged Board had considered that Article 102(3) EPC 1973 gave the Opposition Division and the Boards of Appeal wide power to examine amended claims for compliance with the requirements of the EPC, including requirements corresponding to grounds for opposition which had not been raised in the notice of opposition, the present Board considers it inconceivable that the Board there would not have said so in the context of the referrals before it. The present Board therefore considers that the Enlarged Board used the word "amendments" in the above-cited passage in a limited sense such that the subject matter to be examined must have some direct nexus with the amendment.

E. *The existing jurisprudence of the Technical Boards of Appeal*

E.(i) *The "conventional" approach*

18. In **T 301/87** various granted claims were each amended by the deletion of the phrase "exemplified but not limited to" as it related to certain DNA inserts, so that the claims were now limited to the previously exemplified DNA inserts. Other parts of the (granted) claims, which were unaffected by the deletion, were alleged to be unclear. The Board said:

> "When amendments are made to a patent during an opposition, Article 102(3) EPC [1973] requires consideration by either instance as to whether the amendments introduce any contravention of any requirement of the Convention, including Article 84 EPC; however Article 102(3) EPC [1973] does not allow objections to be based upon Article 84 EPC, if such objections do not arise out of the amendments made.

In support of this conclusion, it would seem to be somewhat absurd if the making of a minor amendment could enable objections outside Article 100 EPC to be raised which have no connection with the amendment itself."
(Emphasis added by the Enlarged Board).

19. This case and the next discussed (**T 227/88**) can be taken as the origin of what the Enlarged Board will refer to as the "conventional" approach to the current issue, in particular the test of whether the amendment introduces any contravention of Article 84 EPC and the principle that Article 102(3) EPC 1973, now Article 101(3) EPC, does not allow objections to be based upon Article 84 EPC if such objections do not arise out of the amendments made. However, although the Board in **T 301/87** had earlier pointed out the distinction between Articles 102(1), (2) and (3) EPC 1973, the decision does not really explain why Article 102(3) EPC 1973 did not "allow" Article 84 EPC objections if they do not arise out of the amendments made. There is also a problem with the only justification given in the decision because, if the amendment saves the patent from revocation, it is hardly appropriate to describe it as "minor", if this is to be taken as meaning unimportant. Again, an argument that any other conclusion would be "somewhat absurd", although a useful indication that the conclusion is correct, is itself hardly a satisfactory juridical basis for a decision.

20. In **T 301/87** the earlier decision in **T 227/88** (OJ EPO 1990, 292) was cited, in which amended claim 1 was a combination of granted claims 1, 2, 3 and 4, with

deletion of various alternatives. The Board in **T 227/88** said:

> "3. The main claim having been amended, it is necessary to consider its validity in accordance with Article 102(3) EPC [1973]. In all cases in which amendments are requested by the patentee and are considered to be free from objection under Article 123(2) EPC, Article 102(3) EPC [1973] confers upon the Opposition Division and the Board of Appeal jurisdiction, and thus the power, to decide upon the validity of the patent as amended in the light of the requirements of the Convention as a whole. This jurisdiction is thus wider than the jurisdiction conferred by Articles 102(1) and (2) EPC [1973], which expressly limit jurisdiction to the grounds for opposition mentioned in Article 100 EPC. When substantive amendments are made to a patent within the extent to which the patent is opposed, both instances have the power to deal with grounds and issues arising from those amendments …
>
> 4. The abovementioned power must, however, be exercised in a manner that takes full account of the conflicting interests of two relevant sections of the patent community, namely, the patentee's need to have an opposition proceedings decided as swiftly as the procedure allows, and the certainty of other users or potential users of the inventions, the subject of European patents, that such patents are legally valid and enforceable."
> (Emphasis added by the Enlarged Board).

21. The Board did not explain in further detail how the power referred to was derivable from Article 102(3) EPC 1973. Again, just as with the word "minor", the word "substantive" can give rise to difficulties, and the Enlarged Board agrees with the criticisms made in this respect in various submissions made in the present referral. In some later decisions the word "substantive" has become "substantial", in respect of which the same criticism applies. Thus in **T 409/10** the Board said (point 3.1 of the Reasons), citing **T 459/09**:

> "… any amendment that can be qualified as being of a substantial nature would in principle justify an unrestricted exercise of the examination power derivable from Article 101(3) EPC, including the examination of clarity, independently of whether the amendment arises from the incorporation of a feature from the description or from the combination of claims of the granted patent."

22. The approach in **T 301/87** and **T 227/88** has been applied in many cases, as "established" jurisprudence of the Boards of Appeal, for example as follows.

23. In the frequently cited case **T 381/02**, where the amendment consisted of a simple combination of granted claim 1 and granted dependent claim 2, the Board emphasised that an amendment consisting of the mere combination of a granted independent claim with dependent claims ("*das Ergebnis einer nur satzbaulichen Umgestaltung des Anspruchssatzes*") did not give rise to a requirement to examine the amended claim for compliance with the requirements of Article 84 EPC; it was not a substantive amendment ("*sachliche Änderung*").

24. In **T 1855/07**, the amendment consisted of the combination (essentially) of a granted independent claim with a dependent claim. The Board based its reasoning on the fact that Article 84 EPC was not a ground for opposition which could be raised against a granted independent or dependent claim, and that a simple combination of independent and dependent claims ("*eine satzbauliche Eingliederung eines abhängigen in einen unabhängigen Anspruch*") could also not constitute grounds for such objection. In this context, the Board referred to Rule 29(4) EPC 1973, now Rule 43(4) EPC, which required dependent claims to be formulated in this way rather than as separate independent claims for reasons of conciseness. The Board said that **G 9/91** required amendments to be examined for compliance with the EPC but a combination of granted claims did not constitute such an amendment, not being a substantive amendment ("*sachliche Änderung*").

25. Other examples of decisions where this approach has been followed include **T 367/96**, where it was held that no objection of lack of support alleged for an amended claim was permissible where such lack of support was already present in the granted patent, and **T 326/02**, where a granted product claim was reformulated into a use claim.

26. In many cases which have followed this approach and in which the lack of clarity was already present in the granted claim, the amended claim has then had to be interpreted, if appropriate with the help of the description (see, e.g., **T 698/99**). This may result in it being given a broad meaning (see, e.g., **T 2049/07**, point 3 of the Reasons, and the further cases cited there) or in it being found to be meaningless (see,

e.g., **T 626/91**, where the Opposition Division had come to this view), with the result that the claim may not be apt to distinguish the subject matter over the prior art or establish an inventive step. Alternatively, the lack of clarity in the amended claim may mean that the skilled person may not know how to carry out the invention (Article 83 EPC - see, e.g., **T 626/91**, point 3.2 of the Reasons).

E.(ii) *Decisions interpreting "arising out of"*

27. The Enlarged Board considers that the meaning of the expression "arising" or "arise out of" as used in **T 301/87** and **T 227/88** was clear in the context of those cases: a lack of clarity "arises" from an amendment when it did not exist before, so that the effect of the amendment is to introduce or give rise to a lack of clarity for the first time. Nevertheless, the expression has subsequently been interpreted in a wider sense, as follows.

28. In **T 472/88** granted claim 1 (already containing an ambiguity: product "comprising" A and B) was amended by the introduction of feature C in stated ratios. The Board, having cited **T 227/88** and **T 301/87** and considered them to have been correct, said (point 2 of the Reasons):

> "... it is self-evident that an amendment wholly unconnected with, e.g. an Article 84 issue, could not, by its mere existence, legitimately invoke the operation of that Article in appeal or in opposition proceedings. It is equally self-evident that an amendment directly giving rise to an ambiguity

objectionable under Article 84 EPC will require to be dealt with by the Board."

However, the Board then continued:

"The word 'arise' in both the above decisions needs to be broadly construed, so as to cover any one of its normal acceptations in the English language. The Concise Oxford Dictionary defines 'arise' as follows: "originate, be born, result from, come into notice, present itself". In the present case the amendments clearly "bring into notice" (in the above sense) an ambiguity that had existed all along.

The specific inclusion of C, in the stated ratios in the Main Request, constitutes but one example of the inclusion of an ingredient which the granted claim already covered - since comprising A and B (functionally defined) in no way excludes C in any ratio or for that matter any other ingredient. The specific exemplification in the Main Request (amended claim) of C, therefore, highlights and focuses attention on the fundamentally open-ended nature (ambiguity) of the granted claim and, for the reasons stated above, gives rise ("arises") to that ambiguity for the reasons stated above, thereby enabling the Board to deal with the Article 84 EPC issue." (Emphasis added by the Enlarged Board).

29. This interpretation has been applied in a number of subsequent cases, using a variety of wording, for example **T 681/00** and **T 1484/07** (clarity problem "concealed" in dependent claim now "highlighted" and made "visible"). In the Enlarged Board's view, development of the jurisprudence of the Boards of

Appeal in this way is not legitimate. It is of course appropriate to use a dictionary when interpreting a statute to help elucidate its meaning, but statements in a decision of a court using ordinary words do not require further interpretation in this way: they are to be understood in their context. Given the facts of those cases (see points 18 and 20, above) the Enlarged Board does not consider that the Boards there intended these words to have the expanded meaning given to them in **T 472/88** and the later cases which followed this approach. In any event, it is unclear to the Enlarged Board what the test developed on the basis of this construction actually amounts to or when precisely an amendment can be said to bring into notice, highlight or focus attention on a previously existing ambiguity (see further, point 80(k), below). This line of cases has not generally been regarded as belonging to a diverging line of cases (although it was identified as such in **T 1577/10**).

*E.(iii) The "diverging" cases*

30. In **T 1459/05** granted claim 1 was combined with dependent claim 4 in an attempt to delimit the claim over the prior art by means of the feature in granted claim 4 (this feature then being alleged to be unclear). Having referred to the established jurisprudence of the Boards to the effect that examination for clarity was not permissible in the case of a combination of granted claims, the Board said that it exceptionally could not follow this line because the added feature was all that might distinguish the subject matter of the amended claim from the cited prior art but it was so unclear that for the skilled person the difference was not apparent or could not be

determined with reasonable certainty (see point 4.3.4 of the Reasons).

31. As justification for this approach, the Board said that the previous jurisprudence had proceeded on the assumption that the Examination Division examined all dependent claims for clarity, including the various interdependencies, and there was no power in opposition proceedings to carry out this exercise for the first time or to repeat it. In addition, the basis on which the earlier jurisprudence had been grounded had altered, not least because the number of claims in applications had steadily and rapidly increased, so that it was questionable whether in a complex case dependent claims could be adequately examined for clarity. The Board therefore considered that it had a discretion, which it could exercise on a case-to-case basis ("*von Fall zu Fall*"), to examine such combined claims for clarity, particularly where otherwise a further examination of the amended claims for, e.g., novelty or inventive step would be considerably more difficult or even not lead to a useful result. See point 4.3.5 of the Reasons.

32. It does not appear to the Enlarged Board that the earlier jurisprudence (see Section E(a), points 18 to 26, above) did in fact rest on the assumption that the practice of the Examining Division was to systematically examine all dependent claims, with all their interdependencies. It was certainly not so stated in **T 301/87** or **T 227/88**, the sources of this line of jurisprudence. Further, while the Enlarged Board is aware that there had been a steadily increasing number of claims in applications (see further, point 33, below) it does not necessarily follow that the

examination of all claims had thereby become unrealistic. In any event it is not clear to the Enlarged Board that there had been any change in practice by the Examination Division as a result (see further the comments in point 49, below). As an aside, the Enlarged Board would also point out that the claims in **T 1459/05** do not appear as a whole to have been technically or linguistically particularly complicated, and consisted only of two independent claims, with five and two dependent claims respectively.

33. In any event, in respect of an application filed on or after 1 April 2009 (and thus after the date of the decision in **T 1459/05**, namely 21 February 2008), claims fees were substantially increased to € 225 for the 16th and each subsequent claim up to the limit of 50, and to € 555 for the 51st and each subsequent claim (see Article 2, item 15 of the Rules relating to Fees, as amended by decision of the Administrative Council CA/D 15/07 of 14 December 2007 (OJ EPO 2008, 10)). The previous level of claims fees had been € 45 for the 11th and each subsequent claim. The background to this steep increase in claims fees is set out in CA/44/07 Rev. 1 e, (points 13 – 16). There it is explained that the number of claims (independent and dependent) in European patent applications had been rising substantially over the previous years and the existing claims fee arrangement no longer reflected the extra work involved in handling applications with an above-average number of claims. The new claims fee structure was intended to steer applicants' behaviour via fee incentives and disincentives, discouraging applicants from submitting applications with a large number of claims. The new measure was expected to

reduce the number of claims presented for search and examination and at the same time provide the necessary financial compensation for the extra work of examiners in handling applications with a large number of claims. The Enlarged Board has no reason to believe that this measure has not succeeded in its purpose (a point made by the proprietor in the present case). As was said in **J 9/84** (OJ EPO 1985, 233), point 4 of the Reasons:

> "… the main purpose of Rule 31 EPC 1973 is to induce the applicant to limit the protection sought to a certain number of claims, in the first instance for the purposes of the European search."

The same point is made in **J 6/96** (point 7 of the Reasons) and **J 6/12** (point 7 of the Reasons).

34. More importantly, it is not clear to the Enlarged Board what is the legal basis for the discretion which was said in **T 1459/05** to be exercisable on a case-by-case basis to examine amended claims for clarity.

35. The Enlarged Board would also comment that if the Board in **T 1459/05** was unable to understand how the subject matter of the amended claim could be distinguished over the prior art, it was presumably open to the Board to find that the amended claim was not distinguishable and thus not novel. Indeed it is to be noted that, having decided that the claim could be examined for clarity, the Board did not in fact disallow the request for non-compliance with Article 84 EPC but decided that the relevant feature was indeed vague and unclear, and therefore that it could not define any material or clear difference over the prior art or any necessary difference for the examination of novelty and inventive

step ("*so dass dieses Merkmal auch keinen wesentlichen, eindeutigen und für die Weiterprüfung unter Artikel 54 und 56 EPÜ notwendigen Unterschied gegenüber E1 definieren kann*."). See point 4.3.7 of the Reasons.

36. The decision has been followed a number of times, for example in **T 1440/08**, where granted claim 1 was combined with dependent claims 6, 7 and 8, a particular feature in granted claim 1 being inconsistent with another feature in granted dependent claim 6. The Board said that clarity could be looked at because of the inconsistent features which the amendment had brought into light ("*unter einem neuen Blickwinkel erscheint*"), applying cases such as **T 472/88**, **T 420/00** and **T 681/00**, particularly when the unclear feature was relevant for examination of novelty and inventive step, following **T 1459/05**.

37. Other decisions have distinguished **T 1459/05**, taking the line that the exceptional situation described there did not apply on the facts of the case, i.e., the introduction of the additional feature by a combination of claims had not by itself made further examination for clarity difficult or impractical. See, for example, **T 1033/09**, point 9.2 of the Reasons.

38. The case has also been subject to some critical comment in other cases. Thus in **T 1855/07**, the Board was asked to refer a question to the Enlarged Board on the grounds of the diverging jurisprudence (which the Board refused to do). As to **T 1459/05**, the Board said the reasoning was problematic from a logical point of view and difficult to understand, and the point that lack of clarity was not a ground for opposition had not been addressed by the Board. In **T 59/10** the Board,

commenting on **T 1459/05**, made the similar point that it is not the "general practice" which prohibits a review under Article 84 EPC, but rather that Article 84 EPC is not a ground for opposition within the meaning of Article 100 EPC.

39. In **T 656/07**, granted claim 1 was combined with a dependent claim, granted claim 1 already containing an unclear feature. It appears that further lack of clarity was introduced as a result of the amendment. Taking the view that a lack of clarity arises out of an amendment when the amendment brings into notice an ambiguity that has existed all along, this was held to be the position in the case before the Board with the aggravating circumstance that the lack of clarity already present in claim 1 had been extended and reinforced by the amendment. The Board said:

> "In the opinion of this Board it cannot be stated that there is a general rule in the jurisprudence that a combination of granted claims should not be challenged for lack of clarity."

And

> "... whenever amendments are requested by a patentee in the course of opposition proceedings, Article 101(3)(a) EPC (former 102(3) EPC 1973) confers upon both the opposition division and the Boards of Appeal jurisdiction and thus the power to apply the whole of the EPC including Article 84."

The Board held the amendments which had been introduced substantially affected the clarity of the claim as a whole, since its subject-matter was not clearly defined, making it impossible to compare the subject matter of the claim with the state of the art and to

proceed further with the substantive examination of the claim.

40. Again, **T 656/07** has been distinguished in later cases, e.g., **T 1659/07**, and in **T 59/10** the Board considered that **T 656/07** was consistent with the older jurisprudence because the unclear feature, although present in the granted claims, was present in another combination (see point 2.2 of the Reasons). The decision was thus considered to follow the conventional jurisprudence.

41. **T 459/09** is the most far-reaching of the diverging cases. Granted claim 1 was combined with its dependent claim 14. The Board said:

> "4.1.6. ... the present Board holds that clarity of an amended independent claim should, in principle, be examined, even if the amendment only consists in a mere literal combination of claims of the patent as granted. Any other approach would indeed entail the risk of unduly restricting the mandate for examination of an amended patent which Article 101(3) EPC imposes on an opposition division having to deal with an amended patent.
>
> In fact, the wording of Article 101(3) EPC qualifies neither the nature nor the scope of the amendments. After amendment of any kind, the opposition division may no longer decide to reject the opposition, as would have been possible, had, for example, a clarity objection been raised as the sole ground for opposition. Instead, the opposition division may only decide either to maintain the patent in amended form or to revoke the patent. Their decision is taken on

the basis of whether the patent and the invention to which it relates meet the requirements of the EPC. Article 101(3) EPC indeed defines in absolute terms that the requirements of the EPC shall be considered when amendments are made by the proprietor of the patent during opposition proceedings. Therefore, the term "amendments" in Article 101(3) EPC should not be construed narrowly and, irrespective of the manner in which the patent is modified, the amended patent should be subjected to an examination to ensure compliance with all requirements of the EPC. This approach is in agreement with **G 9/91** ... .

4.1.7 In this context, the Board notes that an amendment consisting of the incorporation of a technically meaningful feature in an independent claim of a granted patent does indeed represent an attempt to overcome an objection within the framework of Article 100 EPC against the patent as granted, the amendment having to be occasioned by a ground for opposition (Rule 80 EPC). It follows that such an amendment is of a substantial nature and will normally have an effect on the substantive examination, such as for example on the assessment of novelty and inventive step."

The Board concluded that any amendment which is intended to overcome an objection within the framework of Article 100 EPC would justify an unrestricted exercise of the examination power derivable from Article 101(3) EPC, irrespective of whether the amendment arose from the combination of a feature from the description with an independent claim, or from the literal combination of claims of the granted patent.

The amended patent should thus normally be examined so as to establish whether it met all the requirements of the EPC. This rule might, however, be deviated from in particular cases, to be judged on a case-by-case basis.

42. **T 409/10** is cited by the referring Board as being diverging on the basis of the statement (point 3.1 of the Reasons) that:

> "... any amendment that can be qualified as being of a substantial nature would in principle justify an unrestricted exercise of the examination power derivable from Article 101(3) EPC, including the examination of clarity, independently of whether the amendment arises from the incorporation of a feature from the description or from the combination of claims of the granted patent."

43. In **T 493/10**, granted claim 1 was amended by taking features from parts of dependent claims 6 and 7, i.e., the amendment was not a simple combination of granted claims 1, 6 and 7. The feature taken from granted claim 7 was alleged to be unclear. It was held that the jurisprudence (**T 1459/05**, **T 656/07**, **T 1484/07** and **T 1440/08**) showed that clarity could be examined even in the case of a combination of granted claims where the incorporation of a feature from a dependent granted claim revealed a lack of clarity which had been smouldering ("*couvant*") all along in a dependent claim.

F. *The interpretation of Article 101(3) EPC*

44. The crucial words in Article 101(3) EPC which require interpretation are:

> "If the Opposition Division is of the opinion that, 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 ... meet the requirements of this Convention, ...".

When the article speaks of amendments "made" by the proprietor and whether the "patent" and the invention to which it relates meet the requirements of the EPC, what are being referred to are clearly the proposed amendments to the patent, particularly the claims, put forward by the proprietor as part of a request to maintain the patent in amended form. The issue is then whether such a request (assuming it is admissible) is allowable having regard to the provisions of Article 101(3) EPC.

45. The EPC must be interpreted following the principles of interpretation enshrined in the Vienna Convention on the Law of Treaties of 23 May 1969 ("the Vienna Convention"). Article 31(1) of Convention provides that:

> "A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose."

Article 32 of the Convention provides that:

> "Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of article 31, or to determine the

meaning when the interpretation according to article 31:

(a) leaves the meaning ambiguous or obscure; or

(b) leads to a result which is manifestly absurd or unreasonable."

F.(i) *The context of Article 101(3) EPC and the object and purpose of the EPC.*

46. The Enlarged Board considers that the relevant context consists of the procedures for the grant of and opposition to a European patent, as well as the effect of a European patent as granted (where relevant, as amended). So far as the object and purpose of the EPC is concerned, what is of particular relevance is the object and purpose of the EPC as implemented by Article 101(3) EPC.

*F.(i)(a) Examination proceedings*

47. In examination proceedings, the EPO is required to examine whether the "application and the invention to which it relates meet the requirements of the EPC" (Article 94 EPC). If so, it shall decide to grant a European patent; if not, it shall refuse the application (Article 97 EPC). Article 84 EPC (which is contained in Part III, Chapter I, titled: "Filing and requirements of the European patent application"), states that:

"The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description."

In the German and French texts of the Convention the equivalent wording is, respectively:

"*Die Patentansprüche müssen den Gegenstand angeben, für den Schutz begehrt wird. Sie müssen deutlich und knapp gefasst sein und von der Beschreibung gestützt werden*."

"*Les revendications définissent l'objet de la protection demandée. Elles doivent être claires et concises et se fonder sur la description*."

48. In some respects these requirements can be regarded as administrative rather than substantive, for example insofar as they require claims to be concise (*knapp gefasst*; *concises*). Indeed, the *travaux préparatoires* indicate that an equivalent provision was originally intended to form part of the Implementing Regulations and was only at a later stage made part of the Convention itself. However, the requirement that a claim be clear is obviously fundamental to a well-functioning patent system, not least for the benefit of third parties, such as competitors of the proprietor. Applications for European patents are as a matter of course examined for compliance with Article 84 EPC and are regularly refused for non-compliance. The jurisdiction to do so has never been doubted and the basis of it can only be Articles 94 and 97 EPC. Although some submissions in the present referral argued otherwise, the Enlarged Board concludes that the requirements of Article 84 EPC are part of the requirements of the Convention within the meaning of Article 94 EPC that have to be fulfilled on grant.

49. Neither the EPC itself nor the Implementing Regulations make any distinction between independent and dependent claims when it comes to their compliance with the requirements of the EPC at the examination stage. Article 94 EPC requires that the application and the invention to which it relates, i.e., the whole content, must be examined for compliance with the requirements of the EPC. Although not part of the express legal framework of the EPC, the Guidelines for Examination also do not draw a distinction between independent and dependent claims when it comes to objections of lack of clarity. See, e.g., Part F, Chapter IV, 4.1 (as of November 2014):

> "The requirement that the claims must be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone. ...".

The Enlarged Board of course acknowledges that in the real world of an efficiently functioning patent-granting office it is inevitable that independent claims will be the subject of greater scrutiny than dependent claims, particularly where there are numerous dependent or interdependent claims. The Enlarged Board also acknowledges that it may only be later (in opposition proceedings or national proceedings), when new prior art is cited, that the precise meaning of a feature becomes critical for the first time.

*F.(i)(b) Post grant: opposition proceedings before the EPO*

50. As to the position after grant, within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent (Article 99 EPC). Opposition may be filed only on the grounds set out in Article 100 EPC. An objection that the patent, in particular the granted claims, does not comply with the requirements of Article 84 EPC is not such a ground.

51. Assuming the opposition is admissible, the Opposition Division is then to examine whether at least one ground for opposition under Article 100 EPC prejudices the maintenance of the European patent (Article 101(1) EPC). If the Opposition Division concludes that at least one ground for opposition does so, it shall revoke the patent; otherwise, it shall reject the opposition (Article 101(2) EPC, corresponding to Articles 102(1) and (2) EPC 1973).

52. In the course of such opposition proceedings the proprietor may file a request with amended claims, either as a main request (thus not requesting rejection of the opposition) or as an auxiliary request. Any such amendment must comply with Rule 80 EPC, which provides that:

> "The description, claims and drawings may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100, even if that ground has not been invoked by the opponent."

53. In relation to such a request for maintenance of the patent on an amended basis, if the Opposition Division is of the opinion that, 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 meet the requirements of the EPC, it shall decide to maintain the patent as amended (provided that the conditions laid down in the Implementing Regulations are fulfilled). If, on the other hand, the Opposition Division is of the opinion that, 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 the EPC, it shall revoke the patent. See Article 101(3) EPC.

54. The words used here in Article 101(3) EPC, namely "meet the requirements of this Convention" are the same as those used in Articles 94 and 97 EPC. The Enlarged Board has already concluded that the requirements of Article 84 EPC are part of the requirements of the Convention for the purposes of Articles 94 and 97 EPC. The Enlarged Board sees no reason to doubt that the requirements of Article 84 EPC are also part of the requirements of the Convention for the purposes of Article 101(3) EPC. For example, it has never been doubted that when features are taken from the description and are inserted into a granted claim by way of amendment, the amended claim must be examined for compliance with Article 84 EPC in the light of those new features, whether considered by themselves or in their combination with other parts of the claim as now amended. The basis for this can only be

Article 101(3) EPC. The Enlarged Board therefore disagrees with the submissions to the effect that the purposes of Article 84 EPC come to an end with the grant of the patent.

55. Thus as regards the context of Article 101(3) EPC and the object and purpose of the EPC as implemented by the article, while the requirements of Article 84 EPC play an important role in examination proceedings they play no role in opposition proceedings where the proprietor seeks to have the patent as granted upheld. A granted claim may turn out not to comply with Article 84 EPC but such non-compliance must be lived with. However, any lack of clarity of the claims may still be highly relevant in opposition proceedings in that it can influence the decisions on issues under Article 100 EPC: see **T 127/85** (OJ EPO 1989, 271), Headnote and point 2.1 of the Reasons. For example the lack of clarity of a claim may have a profound effect on the outcome of the grounds for opposition according to (i) Article 100(b) / sufficiency (see, e.g., **T 684/89**, point 2.1.2 of the Reasons; **T 5/99**, point 2 of the Reasons, **T 126/91**, point 2.1 of the Reasons; **T 59/10**, point 4 of the Reasons), (ii) Article 100(a) EPC / novelty (see, e.g., **T 57/94**, point 2.1 of the Reasons; **T 525/90**, point 2.1 of the Reasons; **T 892/90**, point 2 of the Reasons; **T 617/92**, point 2.2 of the Reasons), or Article 100(a) EPC / inventive step (see, e.g., **T 892/90**). The reasons why the claim is now considered to be unclear are irrelevant, for example whether it is because a closer consideration is now given to it than may have been given to it in the examination proceedings, or because different minds are now considering the issue, or because the lack of clarity has only become apparent in

the light of prior art cited for the first time in opposition proceedings.

56. So far as concerns amendments made during opposition proceedings, the position, when the procedure is played out to its fullest extent (i.e., the proprietor's first line of defence is the patent as granted), is as follows. Consideration is first given to the granted patent, in particular the claims. Only if one of the grounds for opposition is prejudicial to the maintenance of the patent do any proposed amendments then become relevant. Such amendments must comply with Rule 80 EPC, that is, they must be occasioned by a ground of opposition, usually one or more of those being advanced by the opponent. The question then is whether the amendments (assuming they comply with Articles 123(2) and (3) EPC) are adequate to overcome the objections. The focus is thus on how the amendments have changed the claimed subject matter *vis-a-vis* the previous claims, i.e., what is relevant at this stage are the amendments and not other aspects of the patent or the claims which remain unchanged. (Of course this procedure will often be truncated or take the form of a stepwise process to deal with the various grounds for opposition).

F.(i)(c) *Post grant: national proceedings*

57. A granted European patent (where relevant, as amended) confers on its proprietor in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State (Article 64 EPC). The extent of such protection is to be determined by the claims, as interpreted using the description and drawings (Article 69 EPC) and

taking into account the Protocol on the Interpretation of Article 69 EPC.

58. In national proceedings in a Contracting State relating to a European patent, the patent may be revoked with effect for that State only on the grounds set out in Article 138(1) EPC. An objection that the patent, in particular the claims, do not comply with the requirements of Article 84 EPC is not one of these grounds. Article 138(2) EPC provides that where the grounds for revocation affect the patent only in part, the patent shall be limited by a corresponding amendment; Article 138(3) EPC confers on a proprietor a right to amend a European patent in national proceedings relating to the validity of the patent. This right of a proprietor in national proceedings to limit the European patent was introduced by the EPC 2000. See, for example, OJ EPO 2007, Special Edition No. 4, p. 168.

59. In national proceedings relating to a European patent, the position, so far as the Enlarged Board is aware, can be summarised as follows. Where one of the issues concerns the validity of the granted patent (i.e., in opposition, revocation or nullity proceedings, whether or not coupled with infringement proceedings), any lack of clarity in the claims may, as in proceedings before the European Patent Office (see point 55, above), impact on the grounds of invalidity alleged, possibly to the proprietor's disadvantage. When it comes to amendments, the Enlarged Board is aware of national decisions which state that amendments will only be allowed where the amended claim is clear. However, so far as the Enlarged Board is aware there are no decisions of national courts which reach any clear

conclusion about the present issue, in particular the allowability of amendments where they concern a mere combination of granted claims or of the incorporation of features from granted claims, i.e., where the alleged lack of clarity was already present in the claims as granted. So far as concerns infringement proceedings where the granted claims are unclear, the approach is first to construe the claims. In the case where an independent claim is invalid (e.g., for lack of novelty) but a dependent claim is valid and infringed, even though unclear as to its full scope, there will presumably be little point in a proprietor making an amendment to delete the independent claim (or combining the two), even assuming that such amendment is procedurally available.

F.(i)(d) *Limitation proceedings*

60. Article 105a EPC, introduced by EPC 2000, provides that, at the request of the proprietor, the European patent may be revoked or limited by an amendment of the claims. (Where there is a clash between opposition and limitation proceedings, Rule 93 EPC operates to give precedence to the opposition proceedings). If a request for limitation is admissible, the Examining Division is then to examine whether the amended claims (a) constitute a limitation vis-à-vis the claims as granted or amended in opposition or limitation proceedings and (b) comply with Articles 84, 123(2) and (3) EPC (Rule 95(2) EPC). Further provision is then made for what is to happen if this is not the case.

61. The nature of this procedure, which is ex parte, lies somewhere between that of examination and opposition proceedings. While the rules refer to a need for

compliance of the "amended claims" with Article 84 EPC, the Enlarged Board does not consider that it is possible to draw any conclusions from these provisions as regards the meaning of Article 101(3) EPC. In any event, the meaning can hardly have been altered by this separate amendment to the EPC.

*F.(i)(e) Conclusion*

62. The Enlarged Board concludes that neither the context of Article 101(3) EPC nor the object and purpose of the EPC as implemented by this article gives an unambiguous answer to the question of interpretation. Nevertheless, there is no indication that the object and purpose of the article is, on an amendment of the granted claim, to open up the patent to a complete re-examination, whether for clarity or the other requirements of the EPC. Rather, the indication is that what is relevant is the amendment itself and its effect as regards the ground for opposition which it is intended to overcome, rather than whether other parts of the patent also meet the requirements of the EPC. Whether the amendment achieves this will not of course be the only issue; self-evidently, the amendment must not itself give rise to new objections under the EPC.

F.(ii) *The travaux préparatoires*

63. According to Article 32 of the Vienna Convention recourse may be had to the *travaux préparatoires* in order to confirm the meaning resulting from the application of Article 31 (interpretation of the terms of the treaty in their context and in the light of its object and purpose), or to determine the meaning when the interpretation according to Article 31 leaves the meaning ambiguous.

F.(ii)(a) *Article 102 EPC 1973 EPC*

64. So far as the Enlarged Board is aware, there are no relevant *travaux préparatoires* regarding Article 102 EPC 1973 (successor of which is now Article 101 EPC) dealing with the present issue.

65. Some significance was attached in the submissions to the Enlarged Board (see section VI(b), above) to the fact that during the course of drawing up the original EPC the draft of what became Article 102 EPC 1973 was altered. The earlier draft read:

> "If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the grounds for opposition mentioned in Article 101a [subsequently Article 100 EPC] do not prejudice the maintenance of the patent, it shall decide to maintain the patent as amended, provided that ...".

This is to be compared to the final version:

> "If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that ..."

The relevant change is underlined. Again, so far as the Enlarged Board is aware, there is nothing in the *travaux préparatoires* explaining the reasons for this

change. It was submitted that this change shows the original intention of the legislator to limit the examination powers of the Opposition Division to the grounds for opposition but that these powers were later broadened. The Enlarged Board accepts this but does not consider that it is possible to draw any relevant conclusions from it. For example, as the draft article originally stood it would (arguably) not have been possible to raise any lack of clarity objection at all following an amendment, even where unclear subject matter was taken from the description. It seems likely that this type of consideration was the reason why the change was made.

F.(ii)(b) *EPC 2000: Article 101(3) EPC*

66. With the EPC 2000 an amendment was made to Articles 101 and 102 EPC 1973. The relevant provision of Article 101 EPC 1973 read:

> (1) ... the Opposition Division shall examine whether the grounds for opposition laid down in Article 100 prejudice the maintenance of the European patent.

Article 102 EPC 1973 read:

> (1) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 prejudice the maintenance of the European patent, it shall revoke the patent.
>
> (2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 do not prejudice the maintenance of the patent unamended, it shall reject the opposition.

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that ...

Article 101 EPC now reads, so far as relevant:

(1) ... the Opposition Division shall examine ... whether at least one ground for opposition under Article 100 prejudices the maintenance of the European patent. ...

(2) If the Opposition Division is of the opinion that at least one ground for opposition prejudices the maintenance of the European patent, it shall revoke the patent. Otherwise, it shall reject the opposition.

(3) If the Opposition Division is of the opinion that, 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

(a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that the conditions laid down in the Implementing Regulations are fulfilled;

(b) do not meet the requirements of this Convention, it shall revoke the patent.

67. Apart from a general re-structuring, the relevant change was the introduction of the express power to revoke the patent if, even as amended, the patent and the invention to which it relates do not meet the requirements of the EPC. As explained in OJ EPO 2007, Special Edition No. 4, p. 110, the reason for the change was the absence of any such express legal basis in the EPC 1973. It is to be noted that no changes were made with regard to the crucial words, "[whether] taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention ...". It can also be noted that in the process of drawing up these changes to the EPC, a process which ended in about 1999, no suggestion was made that any change was required to reverse the effect of what was then the established jurisprudence of the Boards of Appeal, i.e., that based on **T 301/87**. In **T 493/09** the Board, having cited the above explanatory statement, said:

> "4. Thus, Article 101(3)(b) EPC was not formulated to provide for a complete examination of the claims of a patent in opposition proceedings once claims are amended, as alleged by appellant I. Rather it was the intention of the legislator to provide with Article 101(3)(b) EPC a legal basis for revoking a patent if a specific amendment introduced into the patent during opposition proceedings did not meet the requirements of the EPC. This legal basis was missing in the EPC 1973. It was not the intention of the legislator to change the established principles laid down in the case law with regard to the examination of Article 84 EPC in opposition proceedings. These

> principles remain valid even after the entry into force of the revised EPC."

By "the established principles laid down in the case law" the Board was referring to the conventional line of jurisprudence, which it then went on to cite. The Enlarged Board agrees that it was not the intention of the legislator, judged from the textual changes made and the *travaux préparatoires*, to change the law so far as concerns the issue raised in the present referral.

68. In the submissions to the Enlarged Board it was also suggested that the working documents for EPC 2000 show that, in the case of amendments during opposition proceedings, the conformity of the amended patent with all the provisions of the EPC is required, and in this respect there is cited OJ EPO 2007, Special Edition No. 4, Article 101 EPC, point 6. This states:

> "New Article 101(3)(b) EPC adds a clarifying point. If the proprietor of the patent requests amendments during the opposition proceedings, the opposition division examines whether, with reference to all the provisions of the EPC, the substantive requirements for maintaining the patent are met." (Emphasis in the original).

Also cited were CA/PL 15/00, I.C. 8 and MR/2/00, page 113, point 6, which are both to the same effect. These materials were directed to explaining the relevant changes which are now found in Article 101 EPC (point 67, above); they do not indicate that any change in the law relating to the issues presently before the Enlarged Board was intended. The Enlarged Board

therefore does not consider that these materials take the matter any further.

F.(ii)(c) *Article 84 EPC: EPC 1973*

69. The Enlarged Board also considers it relevant to consider why non-compliance with the requirements of Article 84 EPC is not a ground for opposition. According to the *travaux préparatoires*, a proposal by the United Kingdom delegation to include such a ground for opposition was rejected (see **BR/87/71**, point 7):

> "Several delegations countered this by saying that deficiencies of this kind in the formulation of the claims were already largely covered by Article 133 paragraph 1(b), which provides that a European Patent may be revoked if it does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It would not be wise to introduce a more far-reaching ground for opposition, particularly as the carefully conducted procedure for grant might then be unfairly delayed, simply as the result of an assertion by a third party."

The statement that "the carefully conducted procedure for grant might then be unfairly delayed" should be understood in the context that at that point the opposition stage was conceived as taking place pre-grant, a concept which was later abandoned in favour of post-grant opposition. See van Empel, The Granting of European Patents, Leiden 1975, pp. 366, 374, 375. It can therefore be concluded that a ground of opposition based on Article 84 EPC was not included in the EPC 1973 at least partly because other grounds for

opposition (Article 100(b) EPC in particular) were considered largely adequate to deal with the problem. It seems likely that it was also thought unwise to enable an opponent to assert (perhaps numerous) clarity objections in opposition proceedings and thus delay them, although this cannot be said with quite the same degree of confidence. However, the President states in his comments that the reason for not introducing lack of clarity as a ground for opposition was "to streamline opposition proceedings", and in this the Enlarged Board considers he is likely to be correct.

F.(ii)(d) *Article 84 EPC: EPC 2000*

70. In the course of the revision for the EPC 2000, there was discussion on whether the requirements of Article 84 EPC should be incorporated as a ground for revocation, following a proposal to this effect by the UK delegation (see CA/PL 4/96). This discussion was, however, confined to whether the requirement of Article 84 EPC that the claims be supported by the description should also be included: see CA/PL 27/99 para 5. While one interested party, namely *epi*, had suggested at an earlier stage that lack of clarity should be made a ground of invalidity, this was not pursued. The objective of the UK proposal was to allow unduly broad claims to be attacked post-grant (CA/PL 27/99, para 2). There was, however, no substantial support for it from other delegations and it was not accepted. See CA/PL 27/99, para 29):

> "Calls for the inclusion of Art. 84 EPC as a ground for opposition and revocation may be partly based on a misapprehension of both the contents of the requirement of support of the claims by the

description and of the scope of possibilities for attacking unduly broad claims which exist under Arts. 83 and 56 EPC".

CA/PL 27/99 concludes:

"35. Consequently, it is proposed that neither clarity, nor lack of support under Art. 84 EPC should be added to the exhaustive list of grounds for opposition and revocation found respectively in Arts. 100 and 138 EPC." (Emphasis added by the Enlarged Board).

F.(ii)(e) *Article 84 EPC: Conclusion*

71. If follows that whenever the issue has been raised, the legislator has rejected any suggestion that the requirements of Article 84 EPC should be considered as a ground for opposition, whether concerning lack of support or clarity. The original justification for this in relation to the EPC 1973 has already been referred to (see point 69, above). While the issue of amended claims was not of course the subject of those considerations, it appears to the Enlarged Board that, by analogy, the fact that some means are at the disposal of the European Patent Office and national courts for dealing with unclear claims (see points 55 and 59, above) is a relevant consideration in relation to the issues raised by the present referral. The Enlarged Board also considers that it would be unsatisfactory if, whenever any amendment was made, an opponent was able to cause delays by raising all kinds of Article 84 EPC objections.

72. The Enlarged Board cannot agree with the submission that it can be concluded from the *travaux préparatoires* relating to the EPC 2000 that while a violation of Article 84 EPC was deliberately not added as a ground for opposition or revocation, a "practical need was seen by the users" for such a ground. While some users may have seen a need (initially as represented by *epi*) this was not generally accepted. Nor can the Enlarged Board agree that the *travaux préparatoires* confirm that a patent as amended during opposition proceedings is to be examined as to its conformity with all the provisions of the EPC and that Article 84 EPC can be a reason for revocation of a patent in amended form, if by this it is meant that on amendment all the parts of a patent are to be examined for compliance with the EPC, including Article 84 EPC.

G. *The answers to the referred questions*

*G.(i) Preliminary matters*

73. The possible suggested constructions include:

(a) The conventional interpretation (section E(a), points 18 to 26, above).

(b) The interpretation whereby an extended meaning is given to the expression "arising out of" (see section E(b), points 27 to 29, above).

(c) Examination for clarity is permissible in exceptional cases, the power to be exercised on a case-by-case basis as a matter of discretion when the added feature is all that may distinguish the subject matter of the amended claim from the prior art (**T 1459/05**).

(d) Unrestricted examination of the amended claims for lack of clarity is permissible on a case-by-case basis, irrespective of the kind of amendment (**T 459/09**).

(e) An interpretation whereby the amended patent as a whole must be examined for compliance with all the requirements of the EPC, alternatively for the requirements of Article 84 EPC.

Other variations are also possible.

74. At the end of the spectrum represented by (e), it is argued essentially that Article 101(3) EPC is perfectly clear on its ordinary reading and that thus no, or no further interpretation is required. Thus all that has to be asked is whether the patent as amended (and the invention to which it relates), i.e., the whole patent, meets all the requirements of the EPC. The Enlarged Board considers that such a reading of Article 101(3) EPC cannot be correct, at least for the following two reasons.

75. The first is that in **G 1/91** the Enlarged Board has already decided otherwise (see point 12, above). There the Enlarged Board in effect held that Article 102(3) EPC 1973, now Article 101(3) EPC, did not apply to those requirements of the EPC which it would be unreasonable to apply to the patent as well as to the patent application. The present case is of course not the same because, as the Enlarged Board in the present case has already concluded, the requirements of Article 84 EPC are one of the requirements of the EPC for the

purposes of Article 101(3) EPC. See point 54, above. Nevertheless, **G 1/91** demonstrates that Article 101(3) EPC is not to be read literally, as required by approach (e), above.

76. The second reason is that if this reading were correct, or even if it were to be applied in a more limited way so as to apply only to the amended claims rather than to the patent as a whole, it would mean that for example the decision and opinion in **G 9/91** and **G 10/91** respectively were no longer good law, at least not to their full extent. This is demonstrated by considering the example of a case where (a) a patent is opposed on the grounds of lack of novelty and/or inventive step (Article 100(a) EPC), (b) the proprietor then makes an amendment to overcome these objections, (c) the opponent then objects for the first time that the invention is insufficiently disclosed (Article 100(b) / 83 EPC), this objection having nothing to do with anything introduced by the amendment, the opponent arguing that by virtue of Article 101(3) EPC any amendment opens the door to the whole patent (alternatively perhaps just the amended claim) being examined for compliance with the EPC. If the argument succeeded, it would thus mean that examination of the (amended) claims would now be possible in respect of any objection which could have been raised as a ground for opposition but which was not so raised, something which the Enlarged Board has decided in the above cases is in principle not allowable. The Enlarged Board of course held that the Opposition Division has a discretion under Article 114 EPC to introduce new grounds for opposition, but this is a separate point and in any event the Boards of Appeal do not have such

a discretion, at least not unless the proprietor agrees (**G 10/91**, point 18 of the Reasons). The present Board has already commented on **G 9/91** and **G 10/91** (points 14 to 17, above). It has no reason to consider that what was said there was wrong or that the conclusions should be modified in some way.

77. The second alternative to (e), above, an interpretation whereby the amended patent as a whole must be examined for compliance with the requirements of Article 84 EPC, suffers from the problem that it makes a seemingly unwarranted distinction between Article 84 EPC and other requirements of the EPC which are clearly within the scope of Article 101(3) EPC, for example Articles 123, 54, 56 and 83 EPC. Leaving this point aside, however, the issue can nevertheless be examined by considering the case of an amendment consisting of the striking out of one or more independent claims (with any dependent claims), leaving other independent claims and their dependent claims intact, or of the striking out of one or more dependent claims, leaving the independent claims and other dependent claims intact (see points 5(a) and 5(b), above). In these cases, the Enlarged Board considers it would be unreasonable (using the language of **G 1/91**) if these other claims could now be examined for compliance with the requirements of Article 84 EPC. To do so would be to open Pandora's Box, enabling an opponent to raise any number of clarity objections against these other granted claims, even though they are untouched by the amendment. It would in effect make Article 84 EPC a ground for opposition in a large number of cases, something which would be go against the underlying reason why the requirements of Article 84 EPC do not

form a ground for opposition (see point 69, above). In this it should be borne in mind that a large percentage of patents are amended in opposition proceedings (about 70%, according to the comments of the President). The Enlarged Board reaches the same conclusion in the case of an amendment to a claim, falling short of its complete deletion, but where some other claim, untouched by the amendment, contains a possible lack of clarity.

78. The answers to the referred question should take these conclusions into account.

G.(ii) *Type B amendments*

79. Several submissions argue that a Type B amendment is not an amendment within the meaning of Article 101(3) EPC. The Enlarged Board does not agree. It appears to be unrealistic to say that a patent has not been amended when the whole purpose of the new wording is to save the patent from revocation. The wording of Article 101(3) EPC also expressly states that regard is to be had to the "amendments" in deciding whether the patent must be revoked or can be maintained. There appears to be no meaningful distinction in this context between an amendment which is substantive and one which is not. Whether the relevant claim is to be regarded as having been amended is a different issue, discussed below.

80. Several considerations lead the Enlarged Board to conclude that the conventional approach to the issue of construction is the correct one in the case of Type B amendments:

(a) This type of amendment, although often conveniently referred to (by the Enlarged Board

included) as a combination of claims, in reality consists of striking out the original independent claim and then writing out the previous dependent claim in full. In this respect it is to be noted that Rule 43(4) EPC prevents an applicant writing out the dependent claim as a separate independent claim:

> "Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features."

In the light of this it can be questioned whether it is appropriate, as the referring decision does, to speak of "a literal insertion of ... complete dependent claims as granted into an independent claim". But in any event, while the patent must be considered to have been amended, the claim which is in place after the amendment is in reality and substance not a new claim. It was already in the granted patent.

(b) If the patent had not been amended at all, the opponent would not have been able to raise an objection of lack of clarity against the relevant granted dependent claim. Also in the case where the alleged unclear feature was already contained in the independent claim which is now combined with a clear dependent claim, no clarity objection would have been possible against that independent claim. Yet this is now said to be possible as a result of the amendment. Such a result appears to be fortuitous and arbitrary so far as concerns the right to raise a clarity objection against the unclear feature.

(c) The Enlarged Board has already concluded (points 74 to 78, above) that the deletion of an independent claim with its dependent claims does not permit examination of the remaining claims for compliance with Article 84 EPC. Again, it appears to the Enlarged Board that it would be arbitrary and unjustified to reach a different conclusion for Type B amendments considering that, but for Rule 43(4) EPC, the dependent claim could have been formulated as a separate independent claim. Rule 43(4) EPC is not concerned with substantive patentability but with ensuring that patent claims are drafted concisely.

(d) The logic of the argument that in the case of a Type B amendment clarity should be examined when the meaning of the claim becomes critical because of newly cited prior art, because the Examining Division was unaware of it, is weak when the case of the unamended patent is considered. Thus if the patent is defended as granted, the fact that new prior art is cited which demonstrates that a granted claim is unclear has to be lived with.

(e) The Enlarged Board's conclusion is in line with the earlier conclusions which it has reached about the interpretation of Article 101(3) EPC having regard to:

(i) The cases **G 9/91** and **G 10/91** (point 17, above);

(ii) the context of the article and the object and purpose of the EPC as implemented by it (point 62, above); and

(iii) the *travaux préparatoires* (points 67, 69 and 71, above).

(f) In particular the Enlarged Board finds it significant that with the implementation of EPC 2000 no change was made in what became Article 101(3) EPC relating to the present issue. The legislator must be taken to have been aware of what was the established jurisprudence of the Boards of Appeal up to and including 1999, when the preparatory work was finalised.

(g) It should be emphasised that the present referral is not concerned with whether an opponent has the right to argue that a claim is unclear or (in effect) lacks support. Thus, for example, just as the uncertain boundaries of a claim or lack of support may play a role when arguing the various grounds for opposition in cases where the patent as granted is defended, so may they do so following any amendment. Methods are therefore available to both the EPO and national courts to mitigate the effects of lack of compliance with Article 84 EPC, both in relation to an unamended patent and one which has been amended (see points 55 and 59, above, respectively). The Enlarged Board accepts that it is not optimal that there may be granted claims, even after amendment, which do not comply with Article 84 EPC but it cannot be ignored that the legislator has deliberately chosen not to make Article 84 EPC a ground for opposition, or for revocation or nullity in national proceedings.

(h) In this respect, the Enlarged Board also wishes to reiterate what was said in **G 9/91** and **G 10/91** (point 16 of the Reasons), endorsing the practice of the Opposition Division in raising *ex officio* a ground for opposition not covered by the statement of grounds for opposition, this practice being "aimed at avoiding the maintenance of European patents which are invalid". Thus where in relation to an amended claim and in the light of its apparent non-compliance with Article 84 EPC, prima facie there are clear reasons to believe that one or more grounds for opposition are relevant and would in whole or in part prejudice the maintenance of the European patent, there is a route to either not admitting or not allowing the request for amendment. The Enlarged Board of course acknowledges that this consideration is not relevant where none of the grounds for opposition comes into play in such a case or in the case of amendments made in the course of appeal proceedings (unless the proprietor consents).

(i) The Enlarged Board does not find the various counter-arguments persuasive. The Enlarged Board of course accepts that ideally only valid patents should be granted and maintained. However, the Enlarged Board cannot go as far as the submission (point VI(b), above), citing **G 1/84** (OJ EPO 1985, 299), at point 3 of the Reasons, that "the elaborate provisions in the EPC for substantive examination and opposition are designed to ensure that only valid European patents should be granted and maintained in force" by the EPO, not least because the Enlarged Board added "... so far as it lies within the power of the European Patent Office to achieve this". Opposition

proceedings are not designed as a procedure for generally amending (or revoking) patents which contain any kind of defect. This is amply demonstrated by the fact that failure to satisfy the requirements of Article 84 EPC is not a ground for opposition. As has been said many times (e.g., **G 1/84**, point 9 of the Reasons), opposition proceedings are not designed to be a continuation of examination proceedings.

(j) The same applies to submissions to the effect that once it is established that a ground for opposition prejudices the maintenance of a patent, so that an amendment becomes appropriate, a door is opened which then enables the EPO in cases where third parties have an interest to scrutinise the patent thoroughly for compliance with all the requirements of the EPC. While the fact that there are opposition proceedings may indicate that the patent is important to the parties, opposition proceedings are not examination proceedings.

(k) As to the suggested solution that examination for clarity is permissible when the amendment brings a previously dormant lack of clarity out into the light (or equivalent formulations), it seems that this could mean that such examination is permissible when:

(i) By writing out the dependent claim for the first time in full, attention is drawn to an inconsistency between the originally granted claims which had not previously been observed, for example because of complex interdependencies; and/or

(ii) It becomes important for the first time to know the precise limits of a claim because of newly cited prior art.

In both cases this amounts to little more than saying that on any amendment a claim may be examined for clarity when its meaning becomes critical. Such a construction is not supported by the actual wording of Article 101(3) EPC, which does not indicate the existence of such a power. Further, to use a test based on an assumption that the lack of clarity was not previously noticed (or equivalent formulations) appears to the Enlarged Board to be arbitrary, not least since it often will not be known whether the Examining Division did consider Article 84 EPC but took the view that the particular claim was unobjectionable. Under the practice of the EPO, a decision to grant is not accompanied by a reasoned decision that the application satisfies all the requirements of the EPC.

(l) Formulations whereby the examination for lack of clarity is to be carried out on a discretionary basis, and/or only in exceptional cases are again not supported by the actual wording of Article 101(3) EPC. Such a conclusion would also result in an arbitrary system whereby it could never be predicted by parties with any confidence what the result of the opposition proceedings would be if the proprietor chooses to amend the patent.

81. Therefore the Enlarged Board's answer to part (b) of the referred question 1 is, no. 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.

G.(iii) *Type A amendments*

82. As explained in point 3, above, this type of amendment can be broken down into sub-types. As to Type A(i) cases (alternative embodiments), the Enlarged Board does not see these cases as being in substance different from Type B amendments. The granted dependent claim could (but for the requirement of conciseness) have been written out as two (or more) separate dependent claims. So far as concerns claims of this type, therefore, the answer which the Enlarged Board gives is the same as for Type B amendments.

83. Although not the subject of the referred questions, the same result follows, for the same reasons, in the case of:

(i) Amendments consisting of deletion of wording from a granted claim (whether independent or dependent), thereby narrowing its scope, but leaving intact a pre-existing lack of compliance with Article 84 EPC (as exemplified by **T 301/87**).

(ii) Deletion of optional features from a granted claim (whether independent or dependent).

84. As regards Type A(ii) amendments (features disconnected by the amendment from other features of the dependent claim), it has never been doubted that where an alleged lack of compliance with Article 84 EPC is introduced by such an amendment, the claim may be examined for such

compliance. Where the alleged lack of compliance has not been introduced by the amendment, the Enlarged Board considers that the question should be answered in the same way as for Type B amendments. This is not only for reasons of uniformity and consistency, but because it is difficult to see how a logically consistent yet different answer could be formulated.

85. Therefore the Enlarged Board's answer to part (a) of the referred question 1 is: 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.

*G.(iv) Final remarks*

86. The above answers also deal with referred questions 2, 3 and 4.

87. The Enlarged Board thus approves the conventional line of jurisprudence as exemplified by **T 301/87** (section E(a), points 18 to 26, above), and disapproves the line of jurisprudence as exemplified by **T 472/88** (explained in section E(b), points 27 to 29, above), and also the line of "diverging" jurisprudence (as exemplified in the cases set out in section E(c), points 30 to 43, above).

## Order

## For these reasons it is decided that:

The questions referred to the Enlarged Board of Appeal are answered 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.**

The Registrar: The Chairman:

W. Crasborn W. van der Eijk