

# Bringing clarity to Opposition Proceedings

May 2015

**Although clarity is not a Ground of Opposition against a European patent, it has long been held that claims amended during opposition must be clear and concise, and the examination of such amended claims often gives opponents an opportunity to cause further headaches for the patentee. Recently, however, Boards of Appeal at the European Patent Office (EPO) have had some difficulty in applying this principle consistently. While it is well recognised that a claim amended during opposition by adding a feature from the description should be checked for clarity, what level of clarity examination should be undertaken where an amended claim is simply the combination of a granted independent claim with one of its granted dependent claims? Furthermore, does amending a claim by adding an extra feature to a multi-feature claim open the door to re-examination of all the other, unamended, features of the claim?**



**Tom Turner**  
Associate  
tom.tuner@abelimray.com

In a recently decided case, the Enlarged Board of Appeal of the EPO was asked to provide its guidance on the examination of clarity during Opposition proceedings. As mentioned above, although a lack of clarity is not a Ground of Opposition, established practice has been to examine amended claims filed by the patent proprietor for conformity with the requirements of the European Patent Convention (EPC), including whether such amendments are clear and concise, as required by Article 84 EPC.

However, in cases where a claim is amended during opposition merely to incorporate a dependent claim, the clarity of that amended claim was traditionally not examined. The view was that an objection that such a claim lacked clarity was an objection against the claims as granted, which as mentioned above cannot be opposed for lacking clarity. More recently, some Boards of Appeal have taken differing views on whether or not amendments should be examined for clarity, in some cases going so far as to allow a full examination of all claims for clarity following any amendment during opposition, however small. Such a divergence in practice presented both patentees and opponents with difficulties in choosing their best strategy for opposition proceedings, and led to the above referral to the Enlarged Board.

The referral asked the Enlarged Board to indicate whether or not amended claims filed during opposition and/or appeal proceedings should always be examined for clarity, regardless of whether or not the amendment is based on a dependent claim, and if that is the case whether or not all aspects of the claims as granted (including those parts not amended) should also be examined for clarity.

In its decision of 25 March 2015, the Enlarged board has ruled that, where a patent is amended during opposition proceedings, the claims should be examined for clarity, but only when and to the extent that the amendment itself introduces a lack of clarity. Thus, there should be no general examination of the clarity of all parts of the claims following an amendment, just an examination of the clarity of the amendment. The Enlarged Board has therefore ruled in favour of the more traditional, limited approach to examining for clarity during opposition proceedings, rejecting recent divergent Board of Appeal decisions which took any amendment as an opportunity to fully re-examine the clarity of all of the claims.

This decision is likely to be welcomed by patent proprietors who can be more confident that making an amendment to the claims during opposition will not give an opponent an opportunity to re-

open examination of all parts of the claims and draw out opposition proceedings. The decision also confirms to opponents that the clarity of claim amendments can indeed be challenged during opposition proceedings to the extent that the amendment itself introduces a lack of clarity.

If you have any questions regarding this decision by the Enlarged Board, or if you would like to discuss how it may influence opposition strategy, please do not hesitate to get in touch with your usual Abel & Imray contact, or send an email to [ai@abelimray.com](mailto:ai@abelimray.com)

**London**

20 Red Lion Street  
WC1R 4PQ, UK  
T +44(0)20 7242 9984  
F +44(0)20 7242 9989

**Cardiff**

3 Assembly Square  
Britannia Quay  
CF10 4PL, UK  
T +44(0)29 2089 4200  
F +44(0)29 2089 4201

**Bath**

Westpoint Building  
James Street West  
BA1 2DA, UK  
T +44(0)1225 469 914  
F +44(0)1225 338 098