



Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
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Amicus curiae brief of epi concerning case G 3/14

Dear Sirs,

Please find enclosed, in accordance with Art 10 of the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, an amicus curiae brief with regard to case G 3/14 of the European Patent Practice Committee of the Institute of Professional Representatives before the European Patent Office (**epi**).

Yours sincerely,

Antonius Tangena
President

Encl.: Amicus curiae brief of **epi** concerning case G 3/14



Amicus curiae brief of epi concerning case G 3/14

Summary

epi generally agrees with the position of the President of the EPO expressed in his comments of 11 August 2014, but has some additional points regarding the application of Article 84 EPC and Rule 80 EPC in opposition proceedings.

G3/14

In Decision T 373/12 Technical Board of Appeal 3.2.08 ("the TBA") referred to the Enlarged Board of Appeal ("the EBA") the four following 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?*



Background

The questions raised by the TBA relate to Articles 100 and 101 EPC. Article 100 EPC limits the grounds on which a patent as granted may be attacked and excludes any ground equivalent to Article 84 EPC. Article 101(2) EPC confirms that an (unamended) patent can only be revoked on the basis of the grounds set out in Article 100 EPC and thus cannot be revoked for failure to meet the requirements of Article 84 EPC.

However, Article 101(3)(a) EPC provides that, if a patent is amended during opposition proceedings, the patent shall be maintained if "... *the patent and the invention to which it relates ... meet the requirements of this Convention ...*". Article 103(3)(b) EPC provides that the patent will be revoked if "... *the patent and the invention to which it relates ... do not meet the requirements of this Convention ...*".

It is noticeable that, whereas Article 101(2) EPC refers to the grounds set out in Article 100 EPC, Article 101(3)(a) and (b) EPC refer to meeting the requirements of "*this Convention*".

The question which then arises is whether the reference to "*this Convention*" in Article 101(3) EPC includes a reference to Article 84 EPC and thus requires the Opposition Division to consider whether a patent which has been amended during opposition proceedings meets the requirements of Article 84 EPC.

epi considers that the wording of Article 101 EPC is clear and thus requires that, once a patent is amended during opposition proceedings, it has to be examined to see whether it meets the requirements of Article 84 EPC.

This is consistent with the *obiter dictum* made by the EBA in Section 19 of the Reasons in Decision G9/91, which appears to indicate that, in principle, once a patent is amended in opposition proceedings, the amended patent should be examined to see whether it meets the requirements of the Convention. Section 19 refers to Article 123(2) and (3) EPC, but this appears to be an example of the Articles in the Convention which need to be considered.

As the referring TBA has made clear, there is also a question as to what constitutes an amendment. Article 101(3) EPC itself does not indicate that there may be different types of amendments. In **epi's** view, in principle, the requirement to examine whether the amended patent meets the requirements of the Convention applies whatever the amendment may be.

Certainly, if an independent claim is amended by the incorporation of part of a dependent claim or a feature from the description, then the Opposition Division or the TBA dealing with an appeal is presented with a new constellation of features not contemplated by the claims as granted. In such a case, **epi** considers that it will be necessary to determine whether the amended independent claim meets the requirements of the Convention.



It could be questioned whether this applies to dependent claims. Should the totality of a dependent claim be incorporated into an independent claim on which it was originally dependent, the question comes up whether this requires an examination of whether the amended independent claim fulfils the requirements of the Convention. As a dependent claim necessarily incorporates all the features of the claim on which it is dependent, it could be said that incorporating the features of the dependent claim into the independent claim merely makes explicit what was already implicit in the dependent claim. If this view is taken, there has been no effective amendment to the dependent claim and so it could be argued that Article 101(3) EPC does not apply.

However, in other Decisions of TBAs, incorporation of the features of a dependent claim which is dependent on a number of higher claims into an independent claim has been examined to see whether the new independent claim meets the requirements of Article 123 EPC, on the basis that the dependencies led to the need for such examination. If this approach is correct, it would appear that such new independent claims should also be examined to see whether they meet the requirements of Article 84 EPC.

Thus, in **epi's** view Article 101(3) EPC applies to all amendments, even if they constitute the incorporation of all the features of a dependent claim into an independent claim.

In going beyond the opinion of the President of the EPO, **epi** draws the attention to the assumption that a patent granted by the EPO meets all the requirements of the Convention. It is therefore expected that all the dependent claims meet the requirements of Article 84 EPC. For this reason, the onus of proof in opposition proceedings should rest on the opponent to make a *prima facie* case that the incorporation of all the features of a dependent claim into an independent claim on which it depends does not meet the requirements of Article 84 EPC. Merely pointing out that an amendment has been made should not be regarded as making a *prima facie* case.

The Questions

As to Question 1, **epi** does not see a fundamental difference between "*elements of dependent claims as granted*" and "*complete dependent claims as granted*" when inserted into an independent claim. The possibly implied suggestion that inserting a complete dependent claim into an independent claim would qualify the dependent claim as being a granted claim and thus being protected from an Article 84 EPC attack, does not appear to be supported by Article 101(3) EPC. The only question is whether partial or complete introduction of a dependent claim is an effective amendment of what has already been examined prior to grant and further allows Article 84 EPC issues to be raised in opposition. In **epi's** view both partial and complete introduction allow this.

With regard to Question 2, it should be considered that a claim is either clear or it is not. It cannot be partly clear. Obviously, a clarity problem may originate from a certain term or feature, but it is only in the context of the entire definition of the claim to be decided whether the claim is clear or not. An inserted feature, which itself may or may not be clear, can and usually will have an



interaction with a feature already present in the independent claim. For example, an inserted functional feature may qualify an existing structural feature to the extent that the structural feature becomes unclear or inconsistent, rendering the claim as such unclear - see also Decision T1459/05, item 4.3, where the Board decided it should examine clarity of a claim amended by the introduction of a feature from a dependent claim, for essentially this same reason.

The question about where the limits of the examination required by Article 101(3) EPC should lie (Question 4) is an important question. First of all, the law has to be complied with. Second, care should be taken that opposition proceedings are not overly complicated with matters that could disproportionately detract from a swift and effective process to the benefit of all parties and the public at large.

The law, in the form of Article 100 EPC, states that an unamended patent cannot be examined for clarity, it being understood that such examination has been done during pre-grant examination and that this should suffice compared to the higher ranked opposition grounds of Article 100(a),(b) and (c) EPC. As noted above, it can be argued that the fundamental rule of Article 100 EPC should extend to claims which are amended with a feature or all features from a dependent claim, where such a dependent has clearly been effectively examined under Article 84 EPC during pre-grant examination and that combinations of such effectively-examined claims might therefore be considered to be unamended claims not open to examination under Article 84 EPC.

It can also be argued that the presumption of meeting the requirements of Article 84 EPC should extend to claims which are amended by incorporation of a feature from a dependent claim, where the basis for the introduced feature is already present in the same context in the unamended claim and the amendment is a straightforward limitation. For example, if the independent claim has the option of A or B, and the dependent claim limits this to A, without changing the context of A, or where the independent claim defines a numerical range and the dependent claim merely narrows the same numerical range, it could be argued that examination under Article 84 EPC is inappropriate.

It could further be argued that qualifications of the extent to which examination as to whether an amended patent meets the requirements of the Convention may be necessary so as to prevent opposition proceedings from being disproportionately burdened with formality issues. In this respect, the extent to which added matter issues under Article 100(c) EPC in conjunction with Article 123(2) EPC have grown to become a laborious and sometimes dominant element in opposition proceedings, not mirrored by its position in other jurisdictions, is an example to be taken into account.

However, since pre-grant examination under Article 84 EPC is not consistent, and is not feasible for all combinations of mutually dependent claims in many cases, it could be questioned whether there is any basis not to apply Article 101(3) EPC to even the complete introduction of a dependent claim into an independent claim. epi considers that the latter situation more often applies and that this is a further reason why the scope of Article 101(3) EPC should not be construed narrowly.



epi acknowledges that, while Article 101(3) EPC requires a consideration as to whether an amended patent meets the requirements of the Convention, the Opposition Divisions and the TBAs at the EPO should take into account, *inter alia*, the situations referred to above when considering whether there is a *prima facie* relevant objection under Article 84 EPC so as to ensure that the proceedings are not burdened with clearly unsustainable objections which would unnecessarily complicate the proceedings.

Further to the comments by the President of the EPO, **epi** would also like to draw attention to Rule 80 EPC. This provides that amendments are only allowed if they are occasioned by a ground for opposition under Article 100 EPC. A strict interpretation of this provision would mean that, if a valid objection under Article 84 EPC is raised against an amended claim, it would not be possible to amend the claim to meet such an objection as such an objection would not have been occasioned by a ground of opposition. **epi** submits that such a strict interpretation should not be followed and that the wording "occasioned by" of Rule 80 EPC should be interpreted to include the notion of "directly or indirectly" so as to allow patent proprietors to further amend claims to meet valid Article 84 EPC objections following amendments made for overcoming a ground of opposition under Article 100 EPC.

The Answers

Question 1

epi considers that either type of amendment can potentially introduce or enhance issues under Article 84 EPC of an amended independent claim. Therefore, amended claims of either type should in principle be open to examination under Article 84 EPC.

Question 2

epi considers that the second option is correct: examination may extend to features already contained in the unamended independent claim.

Question 3

epi considers that this is not applicable: categorically not examining amended claims based on dependent claims is contrary to the duty under Article 101(3) EPC (which is consistent with the obiter dictum in Decision G9/91).



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Question 4

epi considers that the first condition would be that there is a potential issue under Article 84 EPC in the independent claim thus amended. A second condition would 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 any significant degree, the amended patent should be examined under Article 84 EPC, as required by Article 101(3) EPC.