

August 29, 2014

Enlarged Board of Appeal
European Patent Office
80298 MÜNCHEN
Germany

**Re: Memorandum in re G 3/14: AIPLA Statement on Referral under
Art 112(1)(a) EPC by Technical Board of Appeal T 0373/12 - 3.2.08
(Appl. No. 05851833.3) (Examination of clarity objections)**

Dear Sirs,

I am writing on behalf of the American Intellectual Property Law Association (AIPLA) regarding the points of law referred to by Technical Board of Appeal 3.2.08 in case T 0373/12 (Appl. No. 05851833.3) in accordance with Article 112(1)(a) EPC. AIPLA appreciates the opportunity to present its views with respect to these important issues.

AIPLA is a United States-based national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA members represent a diverse spectrum of individuals, companies and institutions, and are involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property, in the United States and in jurisdictions throughout the world.

A. Clarity Policy

AIPLA supports the policy of requiring clarity in European patent claims. It is particularly important for the European Patent Office (EPO) to require clarity at every step of the proceedings, including oppositions, because Article 138 EPC does not provide for revocation by courts for lack of clarity. Therefore, consistent with Article 101(3) EPC, if an Opposition Division or Board of Appeal recognizes lack of clarity in a claim of an amended patent, it should revoke the patent. The EPO, including the Boards of Appeal, should adopt appropriate procedures for examination of claim clarity when amendments of patents are proposed.

AIPLA does not suggest that the Opposition Divisions and Boards of Appeal examine claims for clarity that were not amended during the opposition or appeal therefrom.

B. Recommended Responses to Questions

For the reasons elaborated below, we propose that the questions referred to the Enlarged Board of Review in T 0373/12 should be answered as follows:

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?

Yes for both Questions 1(a) and 1(b). Opposition divisions and boards of appeal should be required under Article 101(3) EPC to examine the clarity of independent claims that have been amended during the opposition 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?

Examination of the clarity of the amended independent claim in such cases should not be limited to the inserted features. Article 101(3) EPC requires the Boards to revoke amended patents that do not meet the all of the requirements of the EPC.

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?

No, because of the requirements of Article 101(3), as explained below.

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?

Not applicable, as explained below.

C. Reasons for Our Opinion

Our reasons for the above suggested answers are as follows.

1) Admissibility of the referral

We believe the present referral is admissible because there are diverging Board of Appeal decisions (*e.g.*: T 301/87 and T 459/09). A decision by the Enlarged Board of Appeal is needed to ensure a uniform application of the EPC. The referral also is admissible as provided in Article 112(1) EPC, because the points of law are of fundamental importance. An opposition is the last opportunity for review of the clarity of claims and the EPO has a duty to use every opportunity to avoid endorsing amended patent claims that are unclear in any respect.

2) Reasons for the Decision

2.1) Question 1

In oppositions there is an apparent tension between Article 100 and Article 101 EPC.

Neither the issue of clarity nor objections against Article 84 are included in the exclusive list of grounds for filing an opposition in Article 100 EPC. Therefore, there is no basis for clarity examination of unamended claims by the Opposition Divisions and the Boards of Appeals.

However, Article 101(3) EPC is very clear about claims amended during the opposition:

Article 101 Examination of the opposition - Revocation or maintenance of the European patent

...

(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.

The test mentioned in both subparagraphs (a) and (b) of Article 101(3) is whether, taking into account the amendments made by the proprietor of the European patent during the opposition proceedings, the patent meets the EPC requirements. Clarity (Article 84) is a requirement for patentability under the EPC. The revocation of amended Article 101(3) is not limited to the opposition grounds of Article 100; it refers to the EPC as a whole.

As far as question 1(b) is concerned, there is nothing in the EPC that would suggest that adding features of a dependent claim to an independent claim does not amount to an amendment.

Therefore, for both questions 1(a) and 1(b) the answer should be yes.

2.2) Question 2

The Opposition Divisions and the Boards of Appeal are required to approve claims amended during an opposition or an appeal. Article 101(3) unequivocally requires revocation of patents when the Opposition Division is of the opinion that the patent and the invention to which it relates “do not meet the requirements of this Convention.” Neither that Article nor any other part of the EPC would authorize Opposition Divisions and the Boards of Appeal to ignore any aspect of amended claims that fail to satisfy those requirements.

Therefore the answer to question 2 must be that the examination of the clarity of an amended independent claim is not limited to the inserted features and extends to features already contained in the unamended independent claim.

2.3) Questions 3 and 4

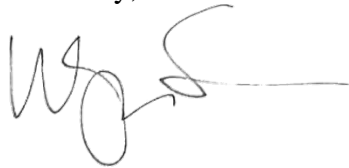
From the above discussion, Questions 3 and 4 should not be applicable, because of the requirements of Article 101(3).

While we believe that Article 101(3)(b) EPC should be literally applied, we also expect that the EPO, including the Boards of Appeal, will take steps to assure that no party will be prejudiced by the need to address lack of clarity of amended claims during an opposition or appeal. In particular, the Board should address clarity “taking into consideration the amendments made,” and where the amended claim’s “validity is prima facie in doubt on the basis of already available information.” Article 101(3) EPC; Decision G 9/91.

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AIPLA thanks the Enlarged Board for the opportunity to provide the foregoing comments on the examination of claim clarity when amendments of patents are proposed.

Sincerely,



Wayne P. Sobon
President
American Intellectual Property law Association

cc: President of the EPO, Vice-President DG-Appeals