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**Datasheet for the decision
of 2 April 2014**

Case 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:

Examination of clarity of amended claims by opposition
divisions and boards of appeal

Relevant legal provisions:

EPC Art. 84, 112(1)(a), 100, 101

Keyword:

Referral to the Enlarged Board of Appeal
Authorisation of opposition divisions and boards of appeal to
examine clarity objections

Decisions cited:

G 0009/91, T 0301/87, T 0227/88, T 0472/88, T 0367/96,
T 0420/00, T 0681/00, T 0326/02, T 0381/02, T 1459/05,
T 1855/07, T 1440/08, T 0459/09, T 0409/10

Catchword:

The following questions are referred to the Enlarged Board of Appeal:

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?



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Case Number: T 0373/12 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 2 April 2014

Appellant: Freedom Innovations, LLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 December
2011 revoking European patent No. 1814480
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
C. Schmidt

Summary of Facts and Submissions

- I. By its decision given to the post on 19 December 2011 the opposition division revoked European patent No. 1 814 480.
- II. The appellant (patent proprietor) lodged an appeal against that decision on 20 February 2012, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 20 April 2012.
- III. Oral proceedings were held before the board of appeal on 12 December 2013.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, submitted with letter dated 20 April 2012, or one of the auxiliary requests 1 to 9, also submitted with letter dated 20 April 2012, or one of the auxiliary requests 10 to 13, submitted with letter dated 7 November 2013.
- V. The respondent (opponent) requested that the appeal be dismissed. It further requested that the following question be submitted to the Enlarged Board of Appeal:

"Does an amendment of an independent claim during opposition proceedings hinder the examination with regard to clarity (Art. 84 EPC), if the amended claim is a combination of an independent claim as granted with the elements of a dependent claim as granted? (Contrary to the decisions T 0459/09 and T 0409/10)."

VI. Claim 1 of the main request, which corresponds to claim 1 as granted, reads as follows:

"A prosthetic medical device, comprising:
a prosthetic liner comprising an umbrella attachment, characterised in that said liner comprising at least one layer (47) of a protective and lubricious coating being coated on the periphery of the liner (38) whereby owing to the lowered coefficient of friction, the liner may be donned and doffed by physically challenged users, or by a user with only one hand; and said umbrella attachment is an enhanced umbrella (17, 8, 9, 10) attachment which reduces pistoning between the bottom of the liner and re-inforced sections adjacent to and above the same, wherein the prosthetic further comprises at least one layer of coating (47) containing Parylene."

Claim 1 of the first auxiliary request differs from claim 1 of the main request by the addition of the feature of dependent claim 3 as granted, according to which:

"the prosthetic liner (38) is coated over substantially all of its surface area."

VII. The appellant's arguments with respect to the main request and auxiliary request 1 can be summarised as follows:

Both requests met the requirements of the EPC.

The objections under Article 100(a) and 100(b) EPC raised by the respondent with respect to the main request were not justified.

The first auxiliary request was submitted in response to the discussion during the oral proceedings before the opposition division concerning the meaning of the term "periphery", and should therefore be admitted into the appeal proceedings.

VIII. The respondent's arguments with respect to the main request and auxiliary request 1 can be summarised as follows:

The patent did not disclose the subject-matter of claim 1 of the main request in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Moreover the subject-matter of claim 1 did not involve an inventive step.

The first auxiliary request was not admitted into the proceedings by the opposition division, and should not be admitted into the appeal proceedings either.

If it were nevertheless admitted into the appeal proceedings, it should be refused for non-compliance with Article 84 EPC because the feature "the prosthetic liner is coated over substantially all of its surface area" was unclear in view of the term "substantially". It was argued, with reference to board of appeal decisions T 459/09 und T 409/10, that even features in an independent claim which have been taken literally from a granted dependent claim and inserted into the independent claim are to be examined as to clarity both in opposition proceedings and on appeal. As far as T 1855/07 came to a different conclusion, the jurisprudence of the boards of appeal was not uniform and the question proposed by the respondent (and as set out under V. above) should be referred to the Enlarged

Board of Appeal of the European Patent Office for the purpose of ensuring a unified jurisprudence.

Reasons for the Decision

1. The appeal is admissible.
2. Conclusions of the board
 - 2.1 After deliberation during the oral proceedings the board came to the conclusion that the patent in suit discloses the subject-matter of claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, but that it does not involve an inventive step. Furthermore, the board admitted auxiliary request 1 into the proceedings.
 - 2.2 Claim 1 of auxiliary request 1 consists of a combination of the features of claim 1 as granted and of dependent claim 3 as granted, which refers back to it. As argued by the respondent, the jurisprudence of the boards of appeal indeed appears to be divided on whether the requirements of Article 84 EPC may be examined in such a case. The board has therefore decided to refer the case to the Enlarged Board of Appeal for clarification of this question.
3. Reasons for the referral to the Enlarged Board of Appeal
 - 3.1 Under Article 112(1)(a) EPC, the board of appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer specific questions of law to the Enlarged Board of Appeal if it considers that a decision of the

Enlarged Board is required in order to ensure a uniform application of the law or it considers that clarification of the referred questions is of fundamental importance.

3.2 Ensuring a uniform application of the law

A decision of the Enlarged Board is required to ensure a uniform application of the law if there are divergences between decisions of the boards of appeal and the application of the law is thus not uniform (see Benkard/Günzel, EPÜ, 2nd edition, Article 112, note 5). In the view of the present board, this is the case in the present context.

Different approaches have been taken by the boards of appeal in deciding on the issues which underlie the present referral. The first of these is whether or not the opposition divisions and boards of appeal of the European Patent Office may, or even must, examine the clarity of independent claims when elements of dependent claims as granted or complete dependent claims have been introduced into them. Secondly, if an independent claim is examined for clarity in these circumstances, this raises the questions of what the scope of the examination should be and what, if any, additional requirements, should apply.

- 3.2.1 The legal framework within which clarity is to be examined in opposition and opposition appeal proceedings is on the one hand determined by the fact that non-compliance with Article 84 EPC is not a ground for opposition within the meaning of Article 100 EPC and the fact that 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 (see also the early decision T 227/88 of 15 December 1988, OJ EPO 1990, 292, point 3 of the Reasons). 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.

Also to be taken into account for the clarification of the present questions of law is the requirement set out by the Enlarged Board in its decision G 9/91 of 31 March 1993 (OJ EPO 1993, 408). In point 19 of the Reasons, the Enlarged Board stated:

"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)."

However, 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 can any further guidance on this matter 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 55c) 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 of 26 August 2004, point 2.3 of the Reasons).

3.2.2 However, in a number of technical board decisions - some of which predate decision G 9/91 - it has been held that an examination of clarity is only possible in the case of amendments which are not mere literal insertions but result in a substantial in the sense of technically meaningful amendment of the claim's content.

3.2.2.1 In T 301/87 of 16 February 1989 (OJ EPO 1990, 335) the board set out the principle that, when amendments were made to a patent during an opposition, Article 102(3) EPC 1973 (cf. Article 101(3) EPC) required consideration by either instance as to whether the amendments introduced any contravention of any requirement of the Convention, including Article 84 EPC. However, Article 102(3) EPC 1973 did not allow objections to be based on Article 84 EPC if such objections did not arise out of the amendments made. It would seem to be somewhat absurd if the making of a minor amendment could enable objections outside Article 100 EPC 1973 to be raised which had no connection with the amendment itself (point 3.7 and 3.8 of the Reasons).

3.2.2.2 The distinction introduced in T 301/87 between clarity problems arising out of an amendment to a claim and those unrelated to the amendment itself was taken up again in later decisions.

Thus, following T 301/87, the board in T 367/96 of 3 December 1997 concluded (point 6.2 of the Reasons) that if a lack of support in the sense of Article 84 EPC for the patent maintained in amended form, said lack of support was already in the patent as granted and was not introduced after grant, Article 102(3) EPC 1973 did not allow objections to be based on Article 84 EPC if such objections did not arise out of the amendments made. Claim 1 before the board had resulted in substance from a combination of claims 1, 2 and 6 as granted in accordance with the cross-references stated therein; thus this combination concerned a process which was already claimed in the patent as granted (in this regard see also T 381/02 of 26 August 2004, point 2.3.5 of the Reasons).

The same conclusion was reached in decisions T 472/88 of 10 October 1990 (point 2 of the Reasons) and T 381/02 of 26 August 2004 (point 2.3 of the Reasons).

In T 326/02 of 11 May 2004, too, the board held, with reference to T 301/87, that Article 102(3) EPC 1973 required consideration as to whether the amendments introduced any contravention of any requirement of the Convention, including Article 84 EPC. Article 102(3) EPC 1973, however, did not allow objections to be based on Article 84 EPC, if such objections did not arise out of the amendments made (point 6.2 of the Reasons).

Likewise, the board in T 1855/07 of 7 September 2010 took the view that in principle an examination of clarity did not come into question where a dependent claim as granted was inserted literally ("satzbauliche Eingliederung") into the claim under scrutiny, whereas substantial amendments to it were to be assessed in accordance with Article 102(3) EPC 1973 to ensure their

compliance with the requirements of the Convention (see points 2.2 and 2.3 of the Reasons).

As a further reason, besides the arguments raised in the above-cited decisions, why literal insertion of a dependent claim into an independent claim could not occasion an objection under Article 84 EPC, the board in this case pointed out that it was in the very nature of a dependent claim within the meaning of Rule 29(4) EPC 1973 (cf. Rule 43(4) EPC) that it protected a further, specific embodiment of the invention already defined in the independent claim. A dependent claim which referred back to the independent claim reciting the essential features of the invention within the meaning of Rule 29(4) EPC 1973 (cf. Rule 43(4) EPC) protected exactly the same embodiment as one in which the reference was replaced by the inclusion of the complete content of the independent claim.

3.2.2.3 In conclusion, the present board agrees with Technical Board 3.3.03 in decision T 381/02 (point 2.3.7 of the Reasons) that the common line taken in the previously cited decisions to which it referred was that the term "amendment" as referred to in the Enlarged Board's decision in G 9/91 was always to be understood as a substantial amendment and not a mere combination of the respective wording of the independent and dependent claims as granted. Thus, according to these decisions, in opposition and appeal proceedings clarity is not to be examined as a matter of course. On the other hand, there is (exceptionally) a power to examine clarity if the adoption of a formulation from a dependent claim as granted gives rise to a new problem of clarity, that is it say one which did not previously exist in the adopted part.

3.2.2.4 According to T 1459/05, this conclusion is based on the understanding that all claims, both with regard to the claim wording itself and in relation to previous claims to which they refer back, are systematically examined by the examining division, and in particular that they have been examined with respect to the criteria of Article 84 EPC, before the application proceeds to grant. On this basis, it follows that in subsequent opposition and opposition appeal proceedings, the opposition divisions and boards of appeal - due ultimately to the limited number of grounds for opposition under Article 100 EPC - do not as a rule have the power to repeat this examination (cf. T 1459/05 of 21 February 2008, point 4.3.5 of the Reasons).

3.2.2.5 Decision T 1440/08 of 5 August 2010, taken by the present board in a different composition, adopts a similar approach (see point 4 of the Reasons).

In this case claim 1 was amended by the addition of features C to E, which corresponded to granted claims 6 to 8. The board held that the insertion of these features gave rise to a lack of clarity in claim 1, or more precisely to a contradiction between feature B and feature C. In the opinion of the board, the addition of a feature leads in itself to a contradiction in the wording of the claim, this lack of clarity is to be regarded as arising out of the amendment. Since, in this case, the lack of clarity was a direct result of the amendment, the board considered itself to be entitled to examine whether the claim meets the requirements of Article 84 EPC or not.

In other words, an examination of clarity should be permitted if it is directed to contradictions or ambiguity within a claim that have arisen out of amendments (as also held in T 472/88 of 10 October 1990, point 2 of the Reasons; T 420/00 of 21 January 2003, point 3.6.2 of the Reasons; T 681/00 of 26 March 2003, point 5.1 of the Reasons).

3.2.3 In the view of the present board, decision T 459/09 of Technical Board 3.4.01 of 13 December 2012, which has been cited by the respondent, diverges from the jurisprudence presented under point 3.2.2 above.

3.2.3.1 In T 459/09 (point 4.1.6 of the Reasons), the board stated:

"In view of the foregoing, 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."

According to the board's reasoning in this case, Article 101(3) EPC, in contrast to Article 100 EPC - and consequently also Article 101(1) and (2) EPC - confers on the opposition divisions and the boards of appeal extended powers when they are examining amended claims. Indeed, the formulation of Article 101(3)(a) EPC is clear in that it refers generally to "the requirements of this Convention". In the view of Board 3.4.01, 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 examined to ensure compliance with all the requirements of the Convention (see point 4.1.3 of the Reasons). Thus, the board distinguished between a power of examination which is restricted to the grounds for opposition under Article 100 EPC in cases where the claims are unamended and an unrestricted power to examine claims which have been amended during opposition or appeal.

The board 3.4.01 considered its approach to be in agreement with G 9/91. By its formulation "*such amendments are to be fully examined as to their compatibility with the requirements of the EPC*", the Enlarged Board recognised in principle the competence of the opposition divisions and the boards of appeal to examine the clarity of amended claims (cf. point 4.1.3 of the Reasons).

The board pointed out in addition that the distinction made in the decisions cited in point 3.2.2 above between "substantial amendments" and "non-substantial amendments" was problematical. The incorporation of a technically meaningful feature in an independent claim commonly occurred in opposition and appeal proceedings in an attempt to overcome an objection within the framework of Article 100 EPC. According to Board 3.4.01, all amendments made in opposition or appeal proceedings are substantial and permit an unrestricted examination of clarity. Specifically, it was immaterial in this context 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 (point 4.1.7 of the Reasons).

3.2.3.2 In its decision T 409/10 of 8 October 2013, Board 3.3.10 stated, citing from T 459/09, "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." (T 409/10, point 3.1 of the Reasons).

3.2.3.3 In T 1459/05 of 21 February 2008, too, Board 3.2.03 considered that it had the power - even if only in the case in hand - to examine the clarity of a feature introduced in literal terms during the proceedings into the independent claim from a dependent claim as granted. In the board's view there could no longer be an unqualified assumption that all the features of the dependent claims of a granted patent had already been systematically examined during the grant procedure for compliance with Article 84 EPC - both as to their wording and in relation to references back to previous claims, comprising technically meaningful features. Bearing in mind the steep rise in recent years in the numbers of claims contained in applications, it was more appropriate to ask to what extent the clarity aspects of all possible claimed combinations in a complex set of claims are or can be examined in such detail before grant that it may be assumed that all clarity problems have been solved (point 4.3.5 of the Reasons).

The board therefore considered itself, in the exercise of its discretion, to be empowered to examine clarity in that case, because otherwise a situation would have

arisen in which the subsequent examination of the patent documents, e.g. for the purpose of novelty and inventive step, would be seriously hampered or even could not yield any meaningful result (loc. cit.; see also T 1440/08 of 5 August 2010, point 4 of the Reasons).

3.3 Requirement of "fundamental importance"

The question under what circumstances and to what extent an opposition division or a board of appeal are empowered, or required, to examine the clarity of claims which are amended during opposition or opposition appeal proceedings arises frequently in practice. It is therefore a point of fundamental importance within the meaning of Article 112(1) EPC.

3.4 Necessity for a decision by the Enlarged Board of Appeal

The respondent (opponent) has submitted that the formulation "*substantially all of its surface area*" is not clear within the meaning of Article 84 EPC. The appellant (proprietor) adopted this wording verbatim from dependent claim 3 as granted. The present board, too, is of the opinion that the use of the term "substantially" is problematical in view of the requirements of Article 84 EPC. However, the problem, which is confined to this feature, was not created by the amendment: original dependent claim 3 is affected by the same clarity objection. Following the jurisprudence cited in point 3.2.2 above, there is no possibility in the present case of dealing with the lack of clarity of the term "substantially". By contrast, according to the decisions cited in point

3.2.3 above, there would be such a possibility, at least under certain conditions.

- 3.5 In view of the fundamental importance of the question raised by the respondent (opponent) whether and, if so, to what extent the opposition divisions and the boards of appeal have the power to examine the clarity of amended claims, the board has decided to frame the referral in broad terms. It is not only the matter of whether an examination of clarity is always required or always excluded when amendments are made to the claims during opposition and appeal proceedings that is of general importance (Questions 1 to 3). At least as important is the question as to which of the criteria developed in the boards' jurisprudence should be applied in deciding whether an examination of clarity is to be carried out, even if only by way of exception (Question 4).

The present board considers that the criteria applied in the jurisprudence of the boards may be grouped as follows:

New clarity problems arise as a result of a feature which in itself is (a) clear or (b) unclear being moved from a dependent claim as granted to an independent claim, for instance through interaction with other features (cf. approach in, for example, T 367/96 and T 1440/08).

A feature which is moved in this way is relevant for the examination of novelty or inventive step (cf. approach in decisions T 1459/05 and T 1440/08).

It has become common practice for European patent applications to contain large numbers of dependent

claims and/or complex dependent claims. It therefore cannot be taken for granted, either in general or in a particular case that a comprehensive examination of clarity will have been carried out during the grant procedure. In view of this, an examination of clarity in opposition and appeal proceedings may be appropriate (cf. approach of T 1459/05).

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

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?

The Registrar:

The Chairman:



K. Boelicke

T. Kriner

Decision electronically authenticated