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The Enlarged Board of Appeal
Richard-Reitzner-Allee 8
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Attention: Mr. Nicolas Michaleczek
via email: EBAamicuscuriae@epo.org

Re: Enlarged Board of Appeal Case G 1/24

20 November 2024

***Amicus Curiae* Brief submitted by epi in respect of Case G1/24**

INTRODUCTION

The following *amicus curiae* brief is filed, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, on behalf of the Institute of Professional Representatives before the European Patent Office (**epi**). **epi** represents all ca. 14,500 professional representatives from all the EPC member states. They work in private-practice as well as employees at in-house IP-departments and represent a wide variety of users of the European Patent system, from individual inventors to multinational corporations.

epi presents this *amicus curiae* brief for the assistance of the Enlarged Board and would be pleased to provide any further explanation as would assist the Enlarged Board in considering the referred questions.

ADMISSIBILITY

epi considers that the referral is admissible under Article 112(1)(a) of the European Patent Convention (EPC). As shown in the referring decision, there are clearly two diverging lines of case law and the divergence needs to be resolved. Moreover, the questions relate to a point of law of fundamental importance and answers to the questions are required. Further, the answers to the questions will affect all instances in the EPO and are therefore required in order to ensure a consistent approach is taken at all instances of the EPO. Thus, the referral should be admitted.

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QUESTIONS REFERRED

The following questions have been referred to the Enlarged Board of Appeal by Board of Appeal 3.2.01 in T 0439/22:

1. Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?
2. May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?
3. May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?

in re. QUESTION 1

1. Question 1 is limited to Article 69(1), 2nd sentence EPC. This means that Question 1 is not to be construed as asking whether Article 69(1), 1st sentence EPC shall apply. Indeed, this clarifies Question 1 because the decision in G 1/24 is not intended to consider whether Article 69(1) EPC should be applied **in general** when assessing the patentability of an invention under Articles 52 to 57 EPC. Rather, the decision in G 1/24 is to be limited to answering the question of whether Article 69(1), 2nd sentence EPC and Article 1 of the Protocol are to be applied to the interpretation of patent claims when assessing patentability of an invention under Articles 52 to 57 EPC.

Article 69(1), 2nd sentence recites:

“... Nevertheless, the description and drawings shall be used to interpret the claims.”

Given that Question 1 limits the scope of the present discussion to Article 69(1) EPC, 2nd sentence, the word “Nevertheless” in the 2nd sentence is rendered redundant.

Similarly, Article 1 of the Protocol on the Interpretation of Article 69 EPC that is addressed with the question is also limited (because of the elimination of the extent of protection from the entire discussion by the limitation of Question 1) and recites:

*“Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that [the claims are] defined by the strict, literal meaning of the wording used in the claims, **the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims.** Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.” – emphasis added.*

2. From this limitation of Question 1 and the fact that Question 1 itself does not even seem to raise doubt about the need for interpretation of the claims **during assessment of the patentability of an invention**, it follows that the **fundamental** question is whether such interpretation is by using the description and the drawings, based on the same principles as used **during assessment of the extent of the protection**, i.e. throughout the entire lifecycle of a European Patent and its originating application.

In other words: **Does this principle apply for fundamental reasons** and irrespective of whether Article 69(1), 2nd sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC are to be specifically applied when assessing the patentability of an invention under Articles 52 to 57 EPC or not?

3. This question appears to have been addressed in the affirmative by G 6/88 (at least *obiter*):

G 6/88 Reasons 3 confirms that the purpose of Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC is to provide a mechanism for harmonisation of the approaches to the drafting and interpretation of claims. G 6/88, Reasons 2.5 and G 6/88, Reasons 6, last sentence provide a link between Article 69 EPC and the requirements of patentability under Articles 52 to 57 EPC. G 6/88 leaves no doubt that a claim must first be interpreted before it can be tested for novelty (G 6/88, Reasons 6, last sentence and Reasons 7, last sentence). Hence, the principles of Article 69(1), 2nd sentence EPC must also apply to the claims of a European patent application to determine **patentability**.
4. Travaux Préparatoires BR/7/69, no. 45 (see Annex 1) explicitly outline that Article 69 EPC is necessary because the *“applicant can only draw up his claims for a European patent application if he knows exactly what the principles for their interpretation are.”* If the extent of protection were to extend to subject-matter other than that intended for the patent claims as granted this would lead the patent system *ad absurdum*.

Further, travaux préparatoires M/18, nos. 7 to 9 (see Annex 1) outline that the principle for the interpretation of claims should not be confined to a literal interpretation of the claims, though without going so far as to include the inventive idea (as was the case in the German jurisprudence relative to the German Patent Act pre-1981). Instead, the principles for interpretation of claims should cover the actual substance of the claims.

5. The Reasons of G 6/88 are also consistent with the following generally accepted and established principles:
 - a. European patent applications and European patents are addressed to the person skilled in the art;
 - b. The reader of European patent applications and European patents reads **the entire specification thoroughly**;
 - c. European patent applications and European patents are read as documents inferring technical meaning and **not as a linguistic exercise**;
 - d. European patent applications and European patents are construed by a mind **willing to understand, not a mind desirous of misunderstanding**; and
 - e. Being a person skilled in the art, the **reader resolves contradictions and eliminates technically nonsensical disclosure**.

These principles can be found, for instance, in The Case Law of the Boards of Appeal (10th edition, 2022), II, A, 6.1 and II, E, 2.3.3. From these principles it follows that the description and drawings are inherently used to interpret the claims. Therefore, the claims cannot be interpreted other than in light of the description and drawings, which cannot be unseen once seen.

6. There is no basis for an assumption that, after having read the claims, the description and drawings are no longer relevant. Should the legislator have wished for such “amnesia”, patents would be granted without descriptions and drawings but with only claims.

E contrario, the description and drawings must have a meaning that is as relevant to a European patent application as it is to a European patent. Particularly, the patentability of a European patent application should generally not change upon grant in view of the same prior art.

7. Following all this, and because there was no change of the law that would require a change in how the law should be interpreted, the principles laid down in G 6/88 must persist.

8. This reasoning is also consistent with the fundamental aim of harmonisation of the European patent system. G 5/83, Reasons 6 reads:

“[...] it is incumbent upon the European Patent Office, and particularly its Boards of Appeal, to take into consideration the decisions and expressions of opinion of courts and industrial property offices in the Contracting States.”

Indeed, the relevant case law of the contracting states of the EPC as well as the UPC (CoA 335/2023) points towards interpreting the claims using the description and drawings for determining patentability and for determining infringement alike.

9. Accordingly, **Question 1 is to be answered in the affirmative by the Enlarged Board of Appeal**: “Article 69(1), 2nd sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC are to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC.”

in re. QUESTION 2

10. Question 2 does not consider whether or not interpretation of the claims may be required but, quite to the contrary, asks **how** a claim is to be interpreted (using the description and the drawings generally or only to resolve ambiguities) **when** it is interpreted.
11. The principles outlined in paragraphs 5 and 6 above are generally accepted and established. From these principles, it follows that the description and drawings are inherently used to interpret the claims. Therefore, the claims cannot be interpreted other than in light of the description and drawings.

Again, there is no basis for an assumption that, after having read the claims, the description and drawings are no longer relevant to the skilled person.

12. This reasoning is in line with the reasoning in re. Question 1 above. The only relevant mention of “interpretation” in the entire European Patent Convention is included in Article 69(1), 2nd sentence EPC, which defines **how** claims are to be interpreted, namely, by using the description and drawings.

Indeed, also resulting from the above general principles, Article 69(1), 2nd sentence EPC does not allow any discretion as to whether the description and drawings are to be consulted when interpreting the claims. This is because “shall” does not provide an option but means that the description and drawings **must** be used to interpret the claims. “Shall” is a strong word and thus defines a definitive rule to be applied under all circumstances.

13. It is noted that the equally authentic German and French recitals of Article 69(1), 2nd sentence EPC are entirely in line with the general use of the description and drawings when interpreting the claims, namely: “Die Beschreibung und die Zeichnungen **sind** jedoch zur Auslegung der Patentansprüche **heranzuziehen**” and “Toutefois, la description et les dessins **servent** à interpréter les revendications”, respectively (emphasis added).
14. Moreover, only using the description and drawings in cases of alleged ambiguity does not serve the principle of legal certainty, for example if this would result in a broader definition of a feature in proceedings before a national court. Such a situation might provoke invalidity proceedings that could otherwise have been avoided by the grant procedure at the EPO. Having a system in place that would allow certain patents, due to different standards applied during examination and post-grant procedures, being validly granted by the EPO and then immediately be regarded invalid before national Courts or the UPC, will ultimately, put at risk the reputation of the European patent system as a whole.
15. Accordingly, from our perspective, **Question 2 is to be answered in the affirmative by the Enlarged Board of Appeal**: “The description and drawings must be consulted generally when interpreting the claims and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation”.

in re. QUESTION 3

16. As outlined above, the general principles as well as the imperative of Article 69(1), 2nd sentence EPC require that the description and drawings **must** be used to interpret the claims at all times. This includes explicit definitions, or similar information, given only in the description and drawings, of terms used in the claims.
17. However, Article 84 EPC stipulates that:

“The **claims** shall **define the matter** for which protection **is sought**. **They shall be** clear and concise and be **supported by the description**.” (emphasis added).

Article 84 EPC, being in Part III of the EPC, stipulates that the claims of a European Patent Application shall define the matter for which protection **is sought**, unlike another part of the application. This represents the matter that is being subjected to examination. The description must support the definition of the matter for which protection is sought. However, the opposite is not true: it is not required by Article 84 EPC that the claims support the description.

18. If the description includes definitions or similar information on a term in excess of what supports the claims, that is, definitions or similar information on a term unrelated to or in contradiction with the matter for which protection is sought, such unrelated definitions or similar information may be disregarded when interpreting the claims, for lack of supporting the claims thereby inconsistent with Article 84 EPC.

Definitions or similar information on a term are unrelated to or in contradiction with the matter for which protection is sought if they are technically meaningless in the eyes of the skilled person vis-à-vis the matter for which protection is sought.

19. Consequently, from our perspective, Question 3 is to be answered by the Enlarged Board of Appeal as follows: **“An explicit definition or similar information on a term used in the claims that is given in the description may be disregarded if it is technically meaningless vis-à-vis the matter for which protection is sought”**.

Additional comment in re. Question 3

While, as a consequence of the answer to Question 3, there may be a presumption that the description and the drawings were completely considered during examination, the patent proprietor cannot rely on a purely formalistic reference to this presumption, for example, during infringement proceedings, to broaden the extent of protection as determined by the claims.

In cases where definitions or similar information on a term in the description result in an expanded interpretation of this term in a claim, the suggested answers to Question 1 and 2 ensure that, should such a claim be asserted against a party, the party can rely on the same expanded interpretation for testing the claim's compliance with Articles 52 to 57.

We trust that the Enlarged Board will find this *amicus brief* useful and would be pleased to provide further submissions should the Board require them.

Yours sincerely,



Peter R. Thomsen
President

Annex 1 - Travaux Préparatoires (with added emphasis)

“**M/18, nr 7-9**: The STANDING CONFERENCE supports the principle, contained in the Strasbourg Convention, that the extent of the protection conferred by a patent is determined by the terms of the claims. However, it would point out that the expressions used in the three — English, French, German — versions of the Draft do not have the same meaning and are likely to encourage the adherence by the States in question to traditions of interpretation which are very different from one another. Since national courts will be responsible for the interpretation of the European patent, there is a danger that, even if they observe the letter of Article 67, they will persist in their previous habits. This would mean that one and the same activity of a competitor of a patent proprietor may or may not be deemed to constitute an infringement depending on the country since the courts have different definitions of what is meant by the extent of the claims. This is a situation which might conceivably arise. It is however contrary to the “maximum” approach, applied since the drafting of the First Preliminary Draft with the support of the STANDING CONFERENCE, which was necessary on some important points. In addition, it would also be regrettable if this situation arose as the result of an erroneous translation.

The STANDING CONFERENCE therefore requests that the three versions of the Convention should be standardised; it will not be enough to simply delete the expression at issue since this would still leave room for differences of interpretation. The STANDING CONFERENCE considers that the Convention itself or, failing this, the Implementing Regulations, should lay down a principle for the interpretation of claims. This principle, whilst being sufficiently precise to be clear, should not be confined to a literal interpretation of the claims but, without going so far as to include the inventive idea as in the case of German jurisprudence, should cover the actual substance of the claims.

The STANDING CONFERENCE considers that in addition to a clear principle of interpretation being given in the Convention, there should be a mechanism for harmonising the interpretation of European patents by national courts. The STANDING CONFERENCE is fully aware that in a matter involving the sovereign rights of States it would be difficult to find a solution and that the latter cannot be achieved in the Convention at the present stage of drafting. It would however point out that a general solution must be sought as of now either by providing, as in the case of the 1962 Draft, for consultation with the European Patent Office or by arranging for the intervention of a common regulating court.

“**BR/7/69, nr 44, 45**: 44, For paragraph I the Working Party adopted the text of Article 8, paragraph 3, of the 1963 Strasbourg Convention.

45, The question arose of whether, in accordance with the general aims of the Convention, this Article, which applied to the European patent after grant, should not be deleted. **The Working Party nevertheless considered that it was necessary to insert this Article into the Convention, since**



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