

European Patent Office
Registry of the Enlarged Board of Appeal
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Amicus Curiae Brief

re case G 1/24

in accordance with Art. 10 Rules of Procedure of the Enlarged Board of Appeal

In case G 1/24, arising from appeal proceedings in T 439/22, the Enlarged Board of Appeal has given third parties the opportunity to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal (Official Journal EPO, 2024, A74).

The American Intellectual Property Law Association (AIPLA) thanks the Enlarged Board of Appeal for that opportunity and would like to present its view on the referred questions, representing the interests of its approximately 7000 members engaged in private and corporate practice, in government service, and in the academic community.

I. Interest of AIPLA

AIPLA's mission is to foster innovation, creativity, and fair competition by empowering IP professionals within an effective and balanced intellectual property system.

AIPLA's core values are deeply rooted in its commitment to advancing the field of intellectual property law through thought leadership and a steadfast championing of innovation and creativity.

AIPLA's mission is firmly based on its enduring belief in the critical importance of an intellectual property system that fosters and rewards innovation and creativity. This commitment underscores all of the Association's activities and advocacy efforts.

AIPLA strives to fulfill its commitment through collaboration and consideration of diverse perspectives, recognizing the power of a united community in addressing the complex challenges facing the IP system. The Association's diverse membership, which includes both owners and users of intellectual property, provides a balanced viewpoint on issues of patent claim construction and interpretation.

AIPLA has no stake in any of the parties to the underlying appeal proceedings. Rather, AIPLA's submission of this Amicus Brief thus aligns with its mission to provide the perspective of stakeholders who engage with the European patent systems as patent applicants and third parties. The correct and consistent application of European patent law is crucial for not just the European IP community but for international community at large.

AIPLA's submission of this Amicus Brief also aligns with its mission to contribute to the establishment and maintenance, for all stakeholders, of fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

In line with these principles, AIPLA submits this Amicus Brief to the Enlarged Board of Appeal of the European Patent Office, offering its perspective on the matters at hand.

II. Answers to Referred Questions

Question 1. Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?

AIPLA respectfully suggests answering Question 1 with: "Yes".

As laid out in the referring decision, Article 69 EPC seems to be the only provision of the EPC that deals with interpretation of the claims. More than 30 years ago, G 6/88 stated: "*For the purpose of determining their technical features, the claims must be interpreted in accordance with Art. 69(1) EPC and its Protocol.*" (G 6/88, Reasons 3). That statement did not distinguish between determining technical features of a claim for determining *the scope of protection* and determining technical features of a claim for assessing whether the claimed subject matter fulfils the *requirements for patentability* under Articles 52 to 57 EPC. The Enlarged Board of Appeal, at that time, added: "*The Protocol was adopted by the Contracting States as an integral part of the EPC in order to provide a mechanism for harmonisation of the various national approaches to the drafting and interpretation of claims ...*" (G 6/88, *Ibid.*).

A "*strong line of case law*" favoring the above approach has been established over the years by the Boards of Appeal since G 6/88 was issued (see referral decision T 439/22, section 3.2.1).

Following that strong line of case law in the present case would thus be a consistent development and, indeed, it would be favorable from the perspective of further harmonization of the European patent ecosystem, as it would bring the practice of the EPO closer to the case law of various important European patent courts.

For example, the Court of Appeal of the Unified Patent Court has outlined that the principles of claim interpretation based on Art. 69 EPC in conjunction with the Protocol on the Interpretation

of Art. 69 EPC apply equally to the interpretation of a patent claim concerning the assessment of infringement *and the validity* of a European patent (UPC_CoA_335/2023, order issued on February 26, 2024, headnote 2).

The German Federal Supreme Court (“BGH”) has taken a similar view over the last decades. For example, the decision *Polymerschaum* (X ZR 117/11) of July 17, 2012 states that, when interpreting claims for assessing patentability, the description and claims have to be taken into account just as when determining the scope of protection according to Article 69 EPC (see, margin no. 27).

As further summarized by the referring decision T 439/22 (see, section 4.3.1, and section 4.3.2), the French and UK perspectives on claim interpretation when assessing patentability also take a similar approach.

In view of the above, AIPLA respectfully suggest answering the Question 1 with: “Yes”.

Question 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?

Question 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?

AIPLA respectfully suggests answering Question 2 with: “Yes, they can always be consulted”. And regarding Question 3, AIPLA respectfully suggests the answer: “No”.

In case Question 1 is answered in the affirmative, the above answers to Questions 2 and 3 result from Article 69 EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC themselves. Because “*the description and drawings shall be used to interpret the claims*” (Art. 69 (1) EPC), and “*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 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.*” (Article 1 of the Protocol on the Interpretation of Article 69 EPC).

In other words, the description and figures must always be consulted when interpreting the claims to assess patentability and not only if the claims are unclear or ambiguous when read in isolation. Also, a claim term definition or similar information explicitly given in the description cannot be disregarded *per se* when interpreting the claims.

However, AIPLA respectfully submits that the same answers to Questions 2 and 3 should be provided, even if the Enlarged Board Appeal were to find a negative answer to Question 1. That

is, whether Article 69 EPC and Article 1 of the Protocol on the Interpretation of Article 69 are directly applicable for interpreting patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC should not change the answers to Questions 2 and 3.

Indeed, Article 69 EPC and Article 1 of the Protocol on the Interpretation of Article 69 refer to the “extent of protection”, whereas Articles 52 to 57 EPC refer to the “invention”. However, if the term “invention” was interpreted by the EPO based on a standard that differs from that according to Article 69 EPC, and thus different from that which national courts and the UPC must apply, this could easily lead to a situation in which claims are maintained by the EPO based on a narrow interpretation, whereas their extent of protection (even without considering equivalents) would be broader. It does not seem adequate to derive such an approach from the provisions of the EPC. For that reason alone, the standard according to Article 69 EPC should be applied to determine the “invention” and whether or not it is patentable according to Articles 52 to 57 EPC. Only then it can be ensured that European patents are maintained by the Boards of Appeal for patentable “inventions” that, apart from equivalents, are commensurate with the “extent of protection” conferred by the patent. For any other approach, there is a greatly increased risk of an imbalance between the test on patentability and the later scope of protection for which there does not seem a clear basis in the EPC.

As a result, AIPLA derives that, if not Article 69 EPC itself, at least its underlying principles shall be applied for interpreting the claims when assessing patentability under Articles 52 to 57, as well, such that the technical features required by the claimed “invention” can be determined.

Apart from that, AIPLA believes that, regardless of the answer to Question 1, the suggested answers to Questions 2 and 3 would be in line with the findings of G 6/88 and bring the EPO’s practice closer to the case law of important European patent courts. For example, the Court of Appeal of the UPC states that “... *the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.*” (UPC_CoA_335/2023, order issued on 26/02/2024, headnote 2). Similarly, according to the German Federal Court of Justice, the interpretation of the patent claim is always required and may not be omitted even if the wording of the claim appears to be unambiguous (judgement *Rotorelemente* issued on May 12 2015, X ZR 43/13, margin number 15). Similar case law can be found in decisions of French and UK Courts, as summarized by the referring decision T 439/22 (see, section 4.3.1, and section 4.3.2).

Therefore, AIPLA respectfully suggests answering Question 2 with “Yes, they can always be consulted”, and Question 3 with “No,” regardless of how the Enlarged Board of Appeal answers Question 1.

III. Importance and Impact of this Decision

The outcome of this case is of critical interest to the global intellectual property community. AIPLA wishes to present to the Board the perspective of its diverse membership, that such a decision would enhance predictability and improve the legal framework not only for US innovators but in general for all stakeholders engaging with the European patent system, whether they are applicants, patentees, or third parties at least for the following reasons.

Harmonization and Predictability The decision would enhance harmonization between EPO proceedings and those in national courts and the Unified Patent Court (UPC). By consistently using patent descriptions and drawings to interpret claims, the EPO can align its decisions with those of national courts and the UPC.

Guidance for International Stakeholders A unified approach to claim interpretation reducing discrepancies between the EPO and national courts will provide clearer guidance for U.S. and other non-European stakeholders protecting their intellectual property in Europe and minimizing their need to seek clarification in appellate proceedings. This clarity will thus help those innovators navigate the European patent system more effectively, fostering targeted investment and promoting innovation.

Legal Certainty for applicants and third parties: Consistent claim interpretation across European jurisdictions will enhance legal certainty for stakeholders with respect to patent enforcement. This stability will help European, U.S., and other international stakeholders make informed strategic decisions regarding intellectual property investments in Europe.

Encouragement of Cross-Border Collaboration: A consistent legal framework will support existing innovators and encourage greater engagement by U.S. stakeholders with the European market. This will attract investment and stimulate cross-border collaborations in research and development, creating an environment conducive to addressing important global challenges.

AIPLA respectfully requests that the Board take into account the aforementioned considerations when evaluating the various factors influencing this decision, given the significant implications of the Board's choice. A decision fostering harmonization, predictability, and legal certainty will not only resolve inconsistencies within the case law of the Boards of Appeal, but also establish a strong foundation for a robust innovation ecosystem in Europe that benefits all stakeholders.

The President of AIPLA

Kimberly Van Voorhis
