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Page 1 of 8

This is an amicus curiae letter made by BASF SE. In the context of claim interpretation, the Technical Board of Appeal 3.2.01 in its decision T 439/22 of 24 June 2024 referred three questions to the Enlarged Board of Appeal. BASF SE has an interest in maintaining a legally sound, predictable and consistent interpretation of patent claims. In particular, the principles of claim interpretation must be identical at the EPO including its Boards of Appeal and at the national of unified court level.

Hereinafter we first summarise the questions referred to the EBA to extract the respective specific legal topics. Afterwards, we will discuss the identified topics. In the end, we provide a suggestion how to answer the referred questions.

1. Analysis of the referred questions

The Technical Board of Appeal referred the following questions:

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 essence, question 1 asks if a specific provision of the EPC is to be applied to the interpretation of patent claims when examining the patentability criteria under Art. 52 to 57 EPC. Question 2 asks if (and under which conditions) the description and figures may be consulted when examining the patentability criteria under Art. 52 to 57 EPC, independent of a specific EPC article allowing or forbidding such consultation. Question 3 asks if (and under which conditions) information given in the description may be disregarded when examining the patentability criteria under Art. 52 to 57 EPC.

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It follows that question 2 is the most general question, such that deliberations on this question will yield most or all of the valuations and conclusions required for answering question 1 and 3.

The referring Board of Appeal has limited the questions to the assessment of patentability ("material patentability") and has excluded issues of "formal patentability" regarding the unity, identity and disclosure of an invention (Art. 82, 87, 83 EPC) and the formulation of patent claims (Art. 84, 123 EPC) from consideration. This may be due to the underlying case, in which no such formal issues arose (Art. 112 (1) EPC). Nevertheless, it is in the interest of users of the European patent system - applicants, patentees and opponents alike - that the principles of claim interpretation are clarified both for a "material" and "formal" patentability assessment. By elucidating the principles in general, the EBA would avoid inadvertently creating a gap in or even a disparate approach to the treatment of description, drawings and claims in the various stages of examination, limitation or revocation.

It is thus useful to discuss the role of description, drawings and claims when assessing material and formal patentability criteria in examination, opposition or limitation proceedings.

2. The interplay between claims, description and drawings

2.1 Applicable EPC provisions

The European Patent Convention refers to claims in few settings:

- a) **Content of a patent application**
According to Art. 78 (1) EPC, a European patent application must contain at least one claim. The claim may refer to drawings. Notably, claims are not required for according a filing date (R. 40 (1) EPC), they need to be added only during formality examination (R. 57 (c) EPC).
- b) **Claim function**
According to Art. 88 EPC, claims function to determine the cutoff dates of Articles 54 and 60 EPC (prior art, right to a European patent): Patent claims may benefit from one or more priorities, as long as the previous application as a whole specifically discloses all elements of the "invention for which priority is claimed".

According to Article 92 EPC, a European search report is drawn up "on the basis of the claims, with due regard to the description and any drawings"; where the original application documents did not comprise claims, these have been added during formalities examination. The European search report states the claims to which each document cited in the search report relates (R. 61 (2) EPC). The documents, in turn, are those which may be taken into consideration whether the "invention" to which the European patent application relates is new and involves an inventive step (R. 61 (1) EPC).

According to Art. 105a (1) EPC, a European patent may be limited by an amendment of the claims. For each contracting state, a European Patent can be limited by amendment of the claims (Art. 138 (2), (3) EPC).

- c) **Publications**
According to Art. 14 (6) EPC, a translation of the claims in the other two official languages of the European Patent Office must be published. Corresponding to this, Article 67 (3) EPC prescribes that where a contracting state does not have, as an official language, the language of proceedings, such state may prescribe that a translation of the claims in one of its official languages must be made available such that a European patent application enjoys provisional protection in this state.

d) Protection

According to Art. 69 EPC, the claims determine the extent of protection conferred by a European patent or patent application. The description and drawings must be used to interpret the claims. For European patent applications, the extent of protection is provisionally determined by the published claims; the extent of protection is retroactively limited by "the European patent" as granted, amended or revoked (Art. 69 (2) EPC). In this second paragraph of Art. 69 EPC, it is not literally the "claims" of the later patent that determine the protection conferred by the European patent application, but the patent in its entirety, including description and drawings.

The Protocol on the Interpretation of Art. 69 EPC in its first paragraph prescribes that the extent of protection is neither to be determined by the strict, literal meaning of the wording of the claims, nor is it to be determined what the patent proprietor has contemplated (taking the claims merely as a guideline). Instead, a fair protection for the patent proprietor combined with a reasonable degree of legal certainty for third parties must be found.

e) Claim requirements

While Art. 82 EPC does not as such refer to the patent claims, the subject matter of all claims must be unitary. This follows from R. 44 EPC, according to which "inventions" are claimed (in separate claims or as alternatives in a single claim).

According to Art. 84 EPC, the claims must define the matter for which protection is sought. This definition must be accomplished using exclusively the "terms of the technical features of the invention" (R. 43 (1) EPC).

The claims must be clear and concise and be supported by the description (Art. 84 2nd sentence EPC).

Indirectly, the EPC regulates how claims may be amended. According to Art. 123 (2) EPC, a European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. This provision applies to all parts of a European patent application or patent alike and thus also to the claims. Furthermore, the extent of protection of a European patent may not be extended (Art. 123 (3) EPC).

2.2 Literal and systematic interpretation

2.2.1 From the above it follows that claims are not autonomous sequences of words, separate from the description and drawings. Instead, claims have to reflect "inventions", i.e. technical teachings (cf. G 1/08, point 6.4.2.1), disclosed in the original European patent application as a whole. This reflection is accomplished exclusively by reciting the technical features of the respective invention. It is "inventions" that are claimed (R. 44 (1) EPC), not arbitrary subject matter.

Correspondingly, material patentability is not assessed in a vacuum. It hinges entirely on the question if the "invention" (or inventions) is new, involves an inventive step and is susceptible of industrial application (Art. 52 (1) EPC). Novelty and inventiveness are analysed in view of the prior art (Art. 54 (2), (3) EPC), and each prior art document can - and must - clearly relate to at least one claim (R. 61 (2) EPC). If there were no necessary correspondence ("Entsprechung") between "inventions", which have to be novel etc., and "claims", to which prior art documents relate, the provisions of the European patent convention would comprise an absurdly glaring lacuna. Assuming such lacuna is contrived, to say the least.

It is thus not tenable to limit the principles of claim interpretation merely in view of one of the claims' function, namely the definition of the scope of protection. Instead, for an assessment of patentability all claim functions have to be addressed.

2.2.2 Given that a claim defines at least one invention (G 2/88, point 7), claims must be interpreted when material patentability is to be assessed. The goal of this interpretation is to allow a comparison of the invention with the prior art (and an assessment of the invention's industrial applicability). Any comparison presupposes that the subject matter to be compared must be ascertained before any conclusions can be drawn.

Turning first to the claimed invention, it is to be noted that the description discloses the invention as claimed (R. 42 (1) (c) EPC) and describes in detail at least one way of carrying out the claimed invention (R. 42 (1) (e) EPC). Thus, the description must be taken into account when interpreting the claims. The same applies to the drawings, because the description describes the figures in the drawings (R. 42 (1) (d) EPC), such that the figures may be required for a full disclosure of the technical features of the claimed invention (see also Art 78 (1) (d) EPC). The definition of what constitutes the subject matter of a claim therefore depends on an assessment of the whole content of the respective patent application, including the description and drawings. An invention, by way of legal fiction, cannot be understood other than along the explanations of the description and drawings (R. 42 EPC). Once the invention is understood, the technical features of the invention have become clear. In particular, any interpretation of the "terms of the technical features of the invention" (R. 43 (1) EPC) must be excluded that would be illogical or run contrary to what the invention aspires to achieve (a principle routinely referred to by the Boards of Appeal under the caption "mind willing to understand").

As an auxiliary argument, it is to be noted that the claims can be derived solely from the description and drawings of the original application documents; no claim has to be present at the filing date. Where a claim is created by "extraction" from the description and drawings, its subject matter must be compared to the whole contents of the original application documents to prevent an extension of subject matter (Art. 123 (2) EPC). In such a case, the subject matter of the claim can only be assessed, *inter alia*, on the basis of the original description and drawings. It would be illogical to attach a meaning to the claim and the terms therein that is independent of the direct and unambiguous disclosure it is taken from. Thus, for amended claims it is mandatory to interpret them also in the light of the description and drawings. On the other hand, there is no literal or systematic basis for any differentiation in claim interpretation according to the genesis of claims. When the subject matter of amended claims can only be analysed on the basis of the whole contents of the original application documents, the same applies to the determination of the subject matter of claims that have not been amended.

Turning then to the prior art, it must be kept in mind that the prior art can be anything made available to the public without limitation to prior patent documents (Art. 54 (2) EPC), the prior art does not have to comprise any claims. Thus, the technical features disclosed by the prior art must be compared to those of the claimed invention. The technical features of a prior art document are only understood in view of the whole context in which they are described. No prior art document is interpreted based on a presupposed general understanding of the skilled person. Instead, any *a priori* understanding is to be corrected in view of the whole prior art document; the skilled person corrects errors and tries to make best sense of the prior art. The EPC does not provide a literal or systematic basis for a differentiation of the skilled person's approach to claim interpretation.

Furthermore, a patent publication may become prior art for the assessment of a later patent or patent application. In such a case, no differentiation is allowable between the description and drawings on one side and the claims of the earlier patent publication. The earlier claims are not viewed in isolation but are instead interpreted in the context of the entire document. This includes considering the description and drawings to understand the full meaning and intent of the claims. This contextual interpretation is crucial for determining whether the earlier document discloses the same invention as the later application, thereby affecting its patentability. Now, if one were to hold the position that during examination of patentability, claims must be considered out of their context, then a logical inconsistency arises: If the same claim can be interpreted both acontextually for patentability assessment and contextually when serving as prior art, the meaning ascribed to that

claim can shift depending on the procedural context in which it is being examined. This variability is illogical. An objective claim interpretation would no longer be possible, because the same term could yield different meanings based solely on the procedural circumstances surrounding its analysis.

In summary, both the subject matter of a claim, like the subject matter of a prior art document, can only be ascertained in its full context.

2.2.3 The above conclusion is also consistent with the function of claims when assessing the validity of a claimed priority. According to Art. 87 (1) EPC, a priority can be validly claimed only if the earlier application discloses, in its entirety, the same invention. If the later application is a verbatim repetition of the earlier application, then the meaning of the claims of the later application must be identical to the meaning of the claims in the earlier application. However, if one were to hold that in examination proceedings, claims must be construed independently of their accompanying description and drawings, then the subject matter of the earlier and later applications' claims could be construed differently. Thus, where the earlier application discloses an invention directly and unambiguously in the claims when read together with the description, then a situation could arise such that despite identical wording of the claim and description in the later application, the claim may be accorded a differing meaning simply because the description and drawings are not taken into account. This result would be absurd. Instead, for assessment of the validity of a claimed priority, the claims must be interpreted in the context of the application as a whole.

2.2.4 In support for the theory that an acontextual claim interpretation for the purposes of assessing material patentability would be mandated, the wording of Art. 84 EPC has been (ab)used. According to this Article, the claims shall define the subject matter for which protection is sought. This expression has been construed to mean that the definition of protection is the only function of the claims, or that at least the definition of the scope of protection is such a predominant function that no other part of a patent or patent application would be allowed to influence the definition of the scope of protection. It was feared that if the acontextual meaning of a claim differs from an unambiguous definition given in the description, the claims could no longer perform their function of defining the subject matter for which protection is sought. The following scenarios are cited in support of the aforementioned theory:

- a) If the description were allowed to redefine a term used in the claims, then an assessment of clarity would not have a well-defined basis. As Article 84 EPC only requires that the claims must be clear (and the description can remain unclear), then it would be allegedly inconsistent to extend the requirement of clarity also to the description. Alternatively, clarity could always be argued on the basis of the description, such that even claims written in confusing language would have to be treated as clear if the description would provide a clear technical teaching.
- b) If the description were allowed to redefine a term used in the claims to give it a broader or more narrow meaning than commonly understood by the person skilled in the art, then assessment of material patentability and potential infringement would be extremely complicated. The principle of "claim precedence" would be allegedly intolerably tainted.
- c) If the description were allowed to redefine a term used in the claims to mean its exact opposite, the claims could no longer be taken at face value. Allegedly, this would create an intolerable deterioration of legal certainty for third parties.

None of these considerations is convincing:

The claims address the skilled person. They are not directed to a moron in a hurry. The skilled person interprets any text diligently. He takes into account the context of each expression and does not rely exclusively on his pre-formed opinion of the meaning of terms. The skilled person is aware of the fact that in different contexts, the same term may have different meanings. It would

thus run counter to an objective, methodical interpretation to exclude the context in which an expression is used.

Article 84 EPC thus does not exclude taking into account the description and drawings when analysing the meaning of a claim. Nevertheless, the question whether a patent claim is clear must be answered on the basis of an evaluation ("wertende Betrachtung"). It is the task of the examining division to assess if the language of a claim as such is so incomplete or misleading that it would constitute an undue burden on the skilled person to fill in missing or misleading information from the description and/or drawings.

Regarding the assessment of material (and formal) patentability, we have shown above that an analysis of the claimed invention is only possible in the light of the accompanying description and drawings. Article 84 EPC and the principle of "claim precedence" are no excuse for making short work of examination.

Regarding the analysis of potential infringements, the fears expressed above are unfounded. The national courts in infringement and revocation proceedings have consistently ruled that there is no such thing as an acontextual claim. Instead, they routinely apply a two-step approach such that first the subject matter of the claim is construed in the light of the description and claims, and in a second step this subject matter is compared to the allegedly infringing embodiment or to the prior art. It is, for example, instructive to read the explanations given by the German Federal Court of Justice (BGH X ZR 43/13 - Rotor elements, point 16):

"According to the established case law of the 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. This is because the description of the patent can define terms independently and in this respect represent a "patent's own lexicon". The principle that in the event of contradictions between the claim and the description, the claim takes precedence because it is the claim and not the description that defines and thus also limits the protected subject matter, does not rule out the possibility that an understanding of the patent claim may emerge from the description and the drawings that differs from that conveyed by the mere wording of the claim. The function of the description is to explain the protected invention. In case of doubt, an understanding of the description and the claim is therefore required which does not bring the two parts of the patent specification into contradiction with each other, but rather understands them as interrelated parts of the technical teaching made available to the skilled person with the patent as a meaningful whole. Only if and to the extent that this is not possible is the conclusion justified that parts of the description may not be used for interpretation. An interpretation of the patent claim which would result in none of the embodiments described in the patent specification being covered by the subject-matter of the patent can therefore only be considered if other possible interpretations leading to the inclusion of at least part of the embodiments are necessarily ruled out or if sufficiently clear indications can be inferred from the patent claim that something is actually claimed which deviates so widely from the description."

Regarding legal certainty for third parties, this concern is served best if the EPO performs a diligent analysis of clarity requirements during examination and at any later claim amendment. This presupposes that an evaluation is done if the claim language to such an extent obscures the definition of the respective invention that it would constitute an undue burden on the skilled person.

In summary, no literal or systematic considerations contradict the conclusion that the description and drawings must be consulted when assessing material (and formal) patentability.

2.3 Historic interpretation

The travaux préparatoires of the EPC 1973 offer little evidence of the legislator's intent formulating Art. 84 EPC. It seems that the contracting states simply implied that claims define inventions.

When amending the EPC, the contracting states deliberated on the relationship between scope of protection, support by the description and sufficient disclosure (CA/PL 27/99, point 20):

"the requirements of support by the description and of sufficient disclosure are regarded in at least one case as sharing the same underlying purpose, namely to ensure that the extent of the patent monopoly claimed should be justified by the actual technical contribution to the art."

Thus, the contracting states saw no reason to balance the extent of protection against the actual technical contribution (of the claimed invention) to the art. The contracting states demanded that an invention makes an actual contribution to the art. This actual contribution necessarily is not the mere disclosure of a claim text. Instead, what is required is that the skilled person, by putting the invention into practice, can achieve technical effects different from those obtainable in the prior art, e.g. by providing new products or processes. Conversely: If the skilled person would never have to rely on the description when trying to realise the technical contribution offered by the claimed invention, then the requirements of support and sufficient disclosure could not have been said to be needed for justifying the extent of the patent monopoly.

A historic interpretation thus does not rule out the conclusion that the description (and drawings) must be taken into account when assessing material (and formal) patentability.

2.4 Teleological interpretation

According to the preamble of the EPC it was the legislator's intention to strengthen co-operation between the States of Europe in respect of the protection of inventions. Consequently, the EPC establishes a "system of law, common to the Contracting States, for the grant of patents for invention" (Art. 1 EPC). Clearly, patents are granted not for nicely worded claims as such. Instead, the legislators tied the extent of protection to "inventions".

As described in section 2.1 d) supra, the extent of protection conferred by a European patent or a European patent application shall be determined by the claims, giving due consideration to the description and drawings (Art. 69 (1) EPC and its Protocol). The member states explicitly sought to avoid any implication that the extent of protection depends exclusively on the language of the claims. The description and drawings must be employed for more than "only for the purpose of resolving an ambiguity found in the claims" (Art. 1 Protocol on the Interpretation of Article 69 EPC). On the other hand, the description and drawings cannot serve as the sole basis for defining the extent of protection, degrading the claims to mere guidelines.

It follows that the legislator formulated the material provisions for obtaining patent protection on the concept of an "invention", and that the "invention" must be expressed both by the claims (which define the matter for which protection is sought, Art. 84 EPC) and the description and drawings (which explain the claimed invention and describe in detail at least one way of carrying it out, R. 42 EPC). Correspondingly, the extent of protection conferred by a European patent is derived from a complementary view of both the claims and the description/drawings.

Where the determination of the extent of protection requires that even claims clearly worded as such must be interpreted in light of the description and drawings, it would have been inconsistent to base the assessment of patentability on a divergent approach to claim construction. The *raison d'être* of a patent is to confer protection for defined subject matter. Material patentability cannot thus be considered independently of this purpose. If it were otherwise, then the future extent of

protection would not be reflected in the examination of novelty, inventive step and industrial applicability. There would be no guarantee that the protected matter would meet the material criteria of patentability; instead, for getting a patent granted it would only be required that an autonomous (claim) text is deemed patentable. This would create untenable legal uncertainty for patentees and third parties alike, because there would be no justified reason to suppose that any granted patent is valid.

Furthermore, all national courts in infringement and revocation proceedings are bound to consult the description and drawings to determine the protected subject matter (Art. 69 EPC). If material patentability at the EPO would be assessed using different criteria, then the EPO would act as a foreign body in the fabric of the European patent system. The very organisation established to grant European patents (Art. 4 (3) EPC) would, by definition, act contrary to the courts of the member states. This conclusion cannot be reconciled with the legislator's intention of strengthening cooperation in respect of the protection of inventions (EPC Preamble).

It follows that from a teleological analysis, it is untenable to hold that the basis for assessing material patentability and for determining the matter protected by a granted patent should be divergent.

3. Suggested responses

3.1 First question

We suggest to respond to the first question by pointing out that Article 69 (1) EPC and the Protocol on the Interpretation of Article 69 EPC are indirectly applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC. Article 69 EPC and the corresponding Protocol are not as such applicable in the assessment of material patentability, because "patentability and, on the other hand, the (protective) effects of European patents or patent applications" have to be distinguished (G 2/12, point VIII.2.(6)(b) 4th paragraph). Nevertheless, both Article 69 EPC and the Protocol are useful to determine the legislator's intention for setting up a European patent system including its material requirements for obtaining patent protection.

3.2 Second question

We suggest to respond to the second question by pointing out that the description and drawings must always be consulted when interpreting the claims to assess patentability.

3.3 Third question

We suggest to respond to the third question by pointing out that any definition or other information given in the description must be disregarded when interpreting the claims to assess patentability if and to the extent that it is not possible to reconcile the description and claims as parts of a meaningful whole.

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