



Letter accompanying subsequently filed items

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The document(s) listed below is (are) subsequently filed documents pertaining to the following application:

Application number and/or Patent number

EP14806330.8 - EP3076804

Applicant's or representative's reference

Amicus Curiae G1/24 - GrK

	Description of document	Original file name	Assigned file name
1	Other Document	Amicus curiae brief G1 24 CPG.pdf	DG3OTHER-1.pdf

Signatures

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Function of person signing: European Patent Attorney

Amicus curiae brief regarding the matter of G 1/24

This brief relates to the referral to the Enlarged Board in accordance with Art. 112(1)(a) EPC by Board 3.2.01 regarding decision T 439/22 (assigned number G 1/24). The Board referred the following questions to the Enlarged Board of Appeal:

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?
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?

These questions should be answered as follows:

Question 1: YES

Question 2: YES (generally), except in case the description and/or figures imply a narrowing of the interpretation of the claim wording.

Question 3: NO, except in case the description and/or figures imply a narrowing of the interpretation of the claim wording.

Reasons

Question 1

The wording of Art. 69 EPC and Art. 1 of the Protocol do not justify any differentiation between the patent application and the granted patent.

Art. 69 EPC reads:

“The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.”

As Art. 69 EPC clearly encompasses the patent application and even puts it on the same level with the granted patent, there is no intention in the EPC to differentiate between the interpretation of the claims of a granted patent or a pending application. No distinction is made between the granted patent and the patent application regarding the scope of protection. Therefore, no distinction can be made when examining the patentability of the application under Art. 52 to 57 EPC. There is no justification for such a distinction, which also jeopardises legal certainty. In case interpretation is not congruent, an imbalance arises, which will only be rectified in the final instance of national proceedings: National courts must refer to the description and drawings when examining patentability in the context of nullity proceedings.

Boards which so far took the position that Art. 69 EPC is not to be applied when examining Art. 52-57 EPC very often referred to the principle of legal certainty for third parties (recently T 56/21 e.g. point 76). According to these Boards it would be necessary (and sufficient) that Art. 84 EPC which is to be applied during examination ensures that the description is to be adapted to fit to the extent of the wording of the patent claims (e.g. T 56/21 points 70 b) to d) with reference to T 113/92, T 996/92 and T 229/93).

According to T 56/21 *“[t]he policy consideration of ensuring legal certainty for third parties about the extent of protection links, and even subordinates, the assessment of Article 84 EPC (and patentability) to the determination of the extent of protection according to Article 69 EPC.”* (point 76).

While the third party of this amicus curiae brief does not disagree with the opinion that Art. 84 EPC (which is without doubt to be applied during examination of Art. 52-57 EPC) could and should ensure that a divergence between the wording of the claims and the content of the description is to be avoided, it needs to be taken into consideration that this is not always the case. One example among many is the referring decision T 439/22.

In case a European Patent is granted with claims which are not in complete conformity with the specification, it is no longer possible to apply the requirements of Art. 84 EPC. A contravention of Art. 84 EPC happening during examination cannot be reviewed in opposition proceedings. Consequently, the only EPC article which can be applied after grant of a patent to determine the scope of a patent claim is Art. 69 EPC. It would therefore counteract the requirement of legal certainty, if Art. 69 (1), second sentence EPC and Art. 1 of the Protocol on the interpretation of Art. 69 EPC would not be applied on the interpretation of patent

claims when assessing the patentability of an invention under Art. 52 to 57 EPC. This is even more true as Art. 1 of the Protocol requests “a reasonable degree of legal certainty for third parties”.

Question 2

The description and figures need to be consulted when interpreting the claims to assess patentability, except in case the description and/or figures imply a narrowing of the interpretation of the claim wording.

It must generally be assumed that in case of a divergence between the literal interpretation of the wording of the claims or features contained therein and the discussion of these features or terms in the description and/or figures this divergence was intended by the applicant. The applicant voluntarily took the decision to include a deviation between the literal meaning of an expression in the claims according to the skilled person’s understanding and its definition in the specification when drafting the application text. As such deviations are part of the application they need to be taken into account when examining the application by the competent authority which is in case of examination of the patent application the EPO – not the national courts. Art. 94(1) EPC requires that the *“European Patent Office shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of this Convention.”*

This obligation does not only relate to the application of the requirements of Art. 84 EPC but of any provision available (“of this Convention”) which would ascertain legal certainty not only to third parties but also to the applicant or later patentee. Third parties need to be sure that a granted patent is a fully reviewed legal document which they need to respect in total and the patentee needs to be certain that he relies on a legally valid right in case he decides to claim infringement of the patent. If therefore the passages in the description discussing a feature or term contained in a patent claim are not amended during examination under Art. 84 EPC it is to be assumed that further information given by such passages is valid and has to be taken into account when interpreting the meaning and scope of the claims. This is not only the case throughout examination, but also in opposition proceedings, when assessing patentability according to Art. 52-57 EPC. This is even more plausible as any contravention of Art. 84 EPC cannot be raised as a ground for opposition.

The third party filing this amicus curiae brief however makes one distinction which only and solely ascertains that the principle of legal certainty is still predominantly observed: In case the description and/or figures imply a narrowing of the interpretation of the claim wording, the

broader wording of the claims should prevail. As a standard, a claim feature needs to be given the broadest reasonable interpretation during examination, opposition, nullity and infringement proceedings (Guidelines F IV 4.2, T 594/19 Reasons 4.2, T1553/19 Reasons 5.7). Reading restrictions only present in the specification jeopardize legal certainty. In case an applicant or patentee wishes to restrict the meaning of an expression below its literal meaning, the applicant or patentee must introduce this narrower meaning into the claims.

The rationale set out above needs to be applied generally and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation: The reason is again the principle of legal certainty and the priority examination of Art. 84 EPC during examination.

On the one hand, there is a legal fiction that the requirements of Art. 84 EPC have been complied with once an objection is no longer raised, has been overcome by amendment or has not been raised at all. For this reason alone, an ambiguous or unclear claim wording should not exist. The second part of question 2 should therefore be obsolete at least for these Boards which refer to Art. 84 EPC in this regard. On the other hand, whether or not a wording is ambiguous or unclear is – even from the perspective of a person skilled in the art – highly subjective. It would only increase uncertainty in case such a differentiation should be allowed to apply.

In case question 2 is not answered with a clear yes (with the exception of definitions which would narrow the scope of the claims) not only third parties but also the patentee would face the following consequences:

- Legal certainty of the validity of a patent would only be given at the end of the last instance of a national court.
- National courts will usually consult the description or figures during nullity proceedings (for reasons of legal certainty) and infringement proceedings (as asked to by Art. 69 EPC). One and the same patent might therefore be considered patentable by the EPO for the academic reason that Art. 69 EPC is not applied when assessing patentability and is considered not valid by national courts as they will and need to consult the definitions and figures.
- National courts might enforce a patent and authorise a monopoly right of embodiments which have not been examined by the EPO in case parallel nullity proceedings are not conducted.

Answering question 2 with “no” would not only increase legal uncertainty for third parties and the patentee, but also allow that national courts enforce a monopoly right for embodiments which have not been examined for patentability for academical reasons alone.

The description and figures have therefore generally to be consulted when interpreting the claims to assess patentability with the only exception that the description and/or figures imply a narrowing of the interpretation of the claim wording.

Question 3

A definition or similar information on a term used in the claims which is explicitly given in the description has to be taken into account when assessing the claims for patentability.

The reasons given with regard to Question 2 apply even more in case an explicit definition or similar information is given in the description.

A definition or similar information on a term used in the claims which is explicitly given in the description can therefore not be disregarded when interpreting the claims to assess patentability with the only exception that the definition or similar information implies a narrowing of the interpretation of the claim wording.

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Acknowledgement of receipt

We hereby acknowledge receipt of the following subsequently filed document(s):

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Documents submitted	package-data.xml epf1038.pdf (1 p.)	ep-sfd-request.xml DG3OTHER-1.pdfAmicus curiae brief G1 24 CPG.pdf (5 p.)
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