

# Amicus Curiae in case G 1/24

## by D.X. Thomas

### Table of contents

Summary off the replies	3
I. Admissibility of the referral	5
II. Art 69 EPC and the Protocol on interpretation	6
II.1. The purpose of Art 69(1) EPC	
II.2 Art 69(1) EPC and the validity of the patent	6
III. The origin of Art 69	
III.1 The various drafts for a Community/Union Patent system and the signature of the EPC	8
III.2 The resulting compromise	8
III.3 Art 8(3) of the Convention on the Unification of Certain Points of Substantive Law on Patents	9
III.4 The “Travaux Préparatoires” to the EPC 1973 and the Protocol on interpretation of Art 69(1) EPC	
III.4.1 The various texts leading to Art 69(1)	9
III.4.2 The various texts leading to the Protocol on Interpretation	14
III.5 Art 69(1) EPC and Art 123(3) EPC	25
III.6 The Protocol on the Interpretation of Article 69 EPC	26
III.7 Summary of the function of Art 69(1) EPC and of the Protocol on interpretation	
IV The referred questions	
IV.1 Question 1	27
IV.2 Question 2	27
IV.3 Question 3	27
IV.4 Some general considerations about the referred questions	

IV.4.1	Question 1	27
IV.4.2	Question 2	28
IV.4.3	Question 3	29
V.	The limitation of the referring board's questions to Art 52-57 EPC	31
V.1	The link between Art 54, 88 and 123(2) EPC	31
V.2	Correction of errors in documents filed at the EPO	32
V.3	Prior art represented by "interfering European applications"	32
V.4	Minutes of OP before the EPO and interpretation of the claims	33
V.5	Two examples which show how interpretation of the claims can vary	
V.5.1.	The "Improver" or "Epilady" case	34
V.5.2	The "pemetrexed" case	34
V.6	Impact on the "gold standard" according to G 2/10	35
V.7	Primacy of the claims	37
V.8	The proposed claim interpretation rule by the referring board	38
V.8.1	Comments on the proposed interpretation rule by the referring board	38
V.8.2	The claim interpretation rule by the German Federal Court (BGH)	39
V.9	G/12 and the application of Art 69 EPC and of the Protocol on interpretation	40
VI.	Proposed replies to the referred questions	
VI.1	No limitation of the replies to Art 52-57 EPC	41
VI.2	Question 1	41
VI.3.	Question 2	
VI.3.1	Sub question 2.1	41
VI.3.2	Sub question 2.2	41
VI.3.3	Conclusion for question 2	44
VI.4.	Question 3	
VI.4.1	What is to be understood under "definition or similar information on a term used in the claims"	44

## **Summary of the replies**

### **Admissibility of the referral**

The referral is admissible as the question raised is of general interest and potentially might have an influence in lots of cases.

### **Preliminary comment**

The decision of the EBA should not be limited to the application of Art 69(1) EPC and of Art 1 of the Protocol on Interpretation to Art 52-57, but also apply to in all circumstances in which the notion of directly and unambiguously derivable, taking into account common general knowledge” plays a role. This important in view of Art 123(2), validity of the priority, divisional applications, and evaluation of the prior art. .

Any reply to the questions should be such that the notion of “directly and unambiguously derivable, taking into consideration common general knowledge”, as set up in a series of decisions of the EBA, cf. **G 2/98**, **G 1/05** and **G 1/06**, **G 1/03**, **G 2/03**, **G 1/16** as well as **G 2/10**, should not be endangered or jeopardised.

### **Question 1** NO

Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC shall not to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC in procedures before the EPO.

Although it would be ideal to have the same way of interpreting claims in validity and in infringement, it should not be forgotten that the setting up of the EPC introduced a clear dichotomy between granting of a European patent and using the granted European patent in case of infringement.

National courts, have interpreted the claims according to Art 1 of the Protocol and this has led to a different appreciation of the scope of protection when it came to infringement. This should continue and applies mutatis mutandis to the UPC.

The EPO has no competence in interpreting the scope of protection besides when applying Art 123(3) in opposition.

In case of a claim or counterclaim for nullity, national courts and the UPC should interpret the claims as they see fit.

## **Question 2**

Question 2 should be subdivided in two sub-questions

### **Sub-question 2a**

May the description and figures be generally consulted when interpreting the claims to assess patentability?

In view of the reply to question 1 the answer to this sub-question is NO.

### **Sub-question 2b**

May the description and figures be consulted when interpreting the claims to assess patentability only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?

Only in such a situation description and figures should be consulted to assess patentability, whereby two situations have to be distinguished:.

- pre-grant, i.e. examination, and
- post-grant, i.e. opposition,

In the pre-grant situation, the description should only be consulted in order to verify clarity and support of the claims. In view of the primacy of the claims, and the fact that the claims ought to be clear at the end of the examination, there is no direct need to assess the patentability of the claims on the basis of the description.

In view of the cut-off for clarity induced by the grant, the description and figures may be consulted in opposition on the condition that the scope of protection of the amended claims is not enlarged.

A more restrictive feature from the description can be introduced in the claims. A broader feature from the description cannot be introduced in the claims as the proprietor has approved the text in which the patent has been granted, as it would only increase the scope of protection, cf. Art 123(3) EPC.

## **Question 3** YES, but with a reservation

In view of the primacy of the claims, a definition or similar information on a term used in the claims which is explicitly given in the description should be disregarded when interpreting the claims to assess patentability.

In view of the primacy of the claims, the description should, in principle not be used as a dictionary for the claims in procedures before the EPO.

The valid conditions are those expressed in the reply of Question II, whereby a distinction is to be made between pre- and post-grant situations.



## I. Admissibility of the referral

The referring board has shown that the case law relating to the application of Art 69(1) EPC and Art 1 of the Protocol on interpretation is clearly diverging.

It is thus necessary to ensure the uniform application of the law.

Furthermore, the diverging case law demonstrates that an important point of law of fundamental importance has arisen.

The admissibility of the referral is therefore plainly manifest and cannot reasonably be challenged.

### I.1 The situation created by T 56/21

There is a further reason for admitting the referral. In [T 56/21](#), contrary to what it had announced to the applicant, the board did not refer any question to the EBA about the adaptation of the description.

The board nevertheless held that “Art 69(1) EPC and the Protocol can also not be considered to provide, a general methodology for claim construction in grant proceedings. Applying the guidance of the Protocol in grant proceedings would amount to putting the cart before the horse. Indeed, the purpose of the grant proceedings is to arrive at an allowable definition in one or more claims of the matter for which protection is sought, rather than to establish before grant what the appropriate protection derived from such wording might be. Moreover, relying on the description to “interpret” the features in the claims before assessing their compliance with the requirements for patentability of the EPC would serve a different purpose than in the context of Article 69(1) EPC and would also have implications for the relationship between the claims and the description.”

In its decision, the board made clear in **T 56/21**, cf. inter alia Reasons 34 and 35, that Art 69(1) EPC and Art 1 of the protocol should not be used when interpreting the claims in view to assess their validity.

This is a position which is clearly at odds with the suggestion of the referring board in [T 439/22](#), Reasons 6.2.3 and 6.2.5, see below.

## II. Art 69 EPC and the Protocol on interpretation

### II.1. The purpose of Art 69(1) EPC

Art 69 EPC defines the extent of protection conferred by a European patent or a European patent application

- (1) 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.
- (2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the claims contained in the application as published. However, the European patent as granted or as amended in opposition, limitation or revocation proceedings shall determine retroactively the protection conferred by the application, in so far as such protection is not thereby extended.

Art 69(1) EPC, first sentence, states: "The extent of the protection conferred ..... shall be determined by the claims".

Art 69(1) EPC, second sentence states: "the description and drawings shall be used to interpret the claims".

As a whole, Art 69(1) EPC insists upon the primacy of the claims. This fact will be determining for the answers to be given to the questions referred.

### II.2 Art 69(1) EPC and the validity of the patent

Art 69(1) EPC does not state that the validity of the claim has to be assessed taking into account the description.

This is why some boards, see the referring decision, have considered that when a claim is clear and/or technically sound, there is no need to take into account the description and drawings.

Other boards, see the referring decision, have said that the description cannot be used to give a feature in a claim a more limited interpretation than that resulting from the plain meaning of the feature of the claim.

Another series of boards, see the referring decision, consider that taking into account the description and drawings might be necessary if features of claims are ambiguous. In case of an ambiguous feature, the broadest interpretation possible is then to be used. In this case, the description and drawings cannot be used to give an ambiguous feature a narrow interpretation.

A systematic interpretation of the claim according to Art 69 EPC and Art 1 of the Protocol, as it is done for instance in German procedures, [the well-know

“Auslegung”] before any decision on infringement or validity is issued, is not required by the EPC.

If the legislator had, in general, wanted a systematic interpretation of the claims taking into account description and drawings during procedures before the EPO, it would not have limited taking into account description and drawings to the assessment of scope of protection. No other Article or Implementing Rule of the EPC, besides Art 69 EPC and Art 123(3) EPC, deal with assessing the scope of protection.

Assessing the scope of protection and the validity of the patent are two different tasks. Ideally they are decided by one and the same instance, but the setting up of the EPC has introduced a clear difference between the two tasks, see below here.

Assessing the scope of protection is primarily a task to be carried by a court having to decide upon infringement, not by the EPO as granting authority.



### III. The origin of Art 69

In order to correctly assess Art 69 EPC and the Protocol on interpretation of Art 69 will be analysed not only according to Art 31(1) of the Vienna Convention on the Law of Treaties of 1969 (VCLT) but also taking into account Art 32 VCLT by having recourse to supplementary means of interpretation, in the present case the preparatory work of the EPC and the circumstances of its conclusion.

#### III.1 The various drafts for a Community/Union Patent system and the signature of the EPC

It is often forgotten that the EPC is a follow-up to the four drafts for a European Patent under the umbrella of the then European Community, later the European Union. Those four drafts remained drafts as the then Contracting States could not agree on a common text.

The upcoming of the PCT has brought some EC/EU Contracting States to worry about being flooded with unexamined patents. This is why, still, some EPC Contracting States refuse a PCT direct access. All PCT applications designating those Contracting States have to be processed before grant by the EPO.

Those applications are commonly designed Euro-PCT in contrast to applications filed directly at the EPO, commonly designated Euro-Direct applications.

The negotiations reopened on the basis of those four drafts and ended up in 1973 with the EPC. Many references to those four drafts are to be found in the “Travaux Préparatoires”.

During the renewed negotiations, ending with the EPC, a compromise was achieved.

#### III.2 The resulting compromise

According to its fathers, the EPC is an open convention, i.e. not restricted to CE/EU Contracting States, but the EPO would only grant a patent after a common search and a common examination procedure in one of three official languages, English, German and French. .

The way the patent and the corresponding post grant rights are to be exercised was a matter for national courts, or now the UPC, in which the granted European Patent will have been validated.

We came thus from a fully integrated system, as foreseen in the four drafts, in which grant and the exercise of post grant rights were in the hands of a single unit, patent office and judicial institutions, like in any national system with examination, e.g. Germany, to a system in which grant and the exercise of post grant rights of the so granted title were separated.

In this situation, with a dichotomy between grant and the exercise of post grant rights of the patent, it was necessary to have a legal provision like Art 69(1) EPC about the interpretation of the claims, and hence also a Protocol on its interpretation.

This is by itself a reason good enough not to apply Art 69(1) EPC and Art 1 of the Protocol on interpretation in any procedure before the EPO, and especially not in examination.

### **III.3 Art 8(3) of the Convention on the Unification of Certain Points of Substantive Law on Patents**

It is interesting to note that Art 69(1) EPC corresponds word for word to Art 8(3) of the [Convention on the Unification of Certain Points of Substantive Law on Patents](#) for Invention, signed under the aegis of the Council of Europe in Strasbourg on 27.11.1963.

### **III.4 The “Travaux Préparatoires” leading to the EPC 1973**

When looking at the [“Travaux Préparatoires”](#) having led to the EPC, it is clear that it appeared unavoidable that different courts in different contracting states would interpret the claims in different ways, Cf. Art 21a and Art 90d,

This was not a problem as long as the interpretation of the claims remained in the hands of separate national systems.

With a European patent system it was thus necessary to ensure a uniform interpretation of the claims. In the various draft conventions, this topic could be found in cf. Art 20d, 21a, 67, 69, and 90d.

#### **III.4.1 The various texts leading to Art 69(1) EPC**

##### **III.4.1.a Art 90d**

Es ist offensichtlich, daß, gleichgültig, welche der vorgenannten Lösungsmöglichkeiten man wählt, eine mehr oder weniger große Unterschiedlichkeit der Auslegung des europäischen Patents innerhalb der Vertragsstaaten in Kauf genommen werden muß.

##### **III.4.1.b Art 21**

Die nationalen Gesetze der Staaten des Gemeinsamen Markts enthalten keine ausdrücklichen Vorschriften über die Auslegung des einzelnen Patents. Grundsätze für die Auslegung finden sich nur in der Rechtspraxis und in der Rechtsprechung. Diese Grundsätze sind von Staat zu Staat unterschiedlich.

Diese Rechtslage führt zu keinen nennenswerten Schwierigkeiten, soweit es sich um die Auslegung nationaler Patente handelt. Eine andere Lage ergibt sich jedoch für das europäische Patent, weil nach den Beschlüssen des Koordinierungsausschusses die Verletzungsklagen durch die nationalen Gerichte entschieden werden sollen und damit die Anwendung der unterschiedlichen nationalen Auslegungsgrundsätze zu einer unterschiedlichen Auslegung des europäischen Patents von Staat zu Staat führt.

Für das europäische Patentrecht ergibt sich daher die Notwendigkeit zu prüfen, welche Maßnahmen im europäischen Recht vorgesehen werden können, um eine möglichst einheitliche Auslegung des europäischen Patents in allen Vertragsstaaten zu erreichen. Die in der Studie Haertel (S. 62 ff.) zu diesem Zweck erwogenen prozessualen Möglichkeiten, wie Konzentrierung der gerichtlichen Zuständigkeit innerhalb der Vertragsstaaten, Anrufung eines europäischen Patentgerichts als Rechtseinheitsinstanz für europäisches Recht, besondere Klage auf Feststellung des

- 31 -

### III.4.1.c Art 21a

Artikel 21 a  
Schutzumfang des europäischen Patents

Für den sachlichen Schutzbereich des europäischen Patents ist der Inhalt des Patentanspruchs maßgebend. Zur Auslegung des Patentanspruchs kann die Beschreibung herangezogen werden.

Der Präsident erklärt, dass die Numerierung dieses Artikels nur auf materielle Schwierigkeiten zurückzuführen ist. Er habe die Bedeutung der Auslegung des europäischen Patentes nicht verringern wollen. Er weist darauf hin, dass der von ihm vorgeschlagene Text eine Mittellösung darstellt. Die Patentansprüche sind für die Auslegung des Patentes maßgeblich, aber zur Klärung von Ausdrücken in den Ansprüchen kann auf die Beschreibung Bezug genommen werden.

Die Arbeitsgruppe billigt den Grundsatz der in Artikel 21 a) enthaltenen Lösung.

Artikel 21 a  
Sachlicher Schutzbereich des europäischen Patents

Der sachliche Schutzbereich des europäischen Patents wird durch den Inhalt der Patentansprüche bestimmt. Jedoch dienen die Beschreibung und die Zeichnungen zur Klärung der Tragweite der Patentansprüche.

III.4.1.d A later version of Art 21

Artikel 21 (21a + 90a)

Sachlicher Schutzbereich des europäischen Patents

(1) Der sachliche Schutzbereich des europäischen Patents wird durch den Inhalt der Patentansprüche bestimmt. Jedoch dienen die Beschreibung und die Zeichnungen zur Klarstellung der Tragweite der Patentansprüche.

(2) Die Bestätigung des vorläufigen europäischen Patents als endgültiges europäisches Patent bestimmt rückwirkend den sachlichen Schutzbereich des europäischen Patents.

- 14 -

6551/IV/62

die Beschreibung und die Zeichnungen nur dann zum Zuge kämen, wenn die Patentansprüche nicht deutlich abgegrenzt seien. Nach dem Vorentwurf hingegen könnten die Beschreibung und die Zeichnungen auch dann berücksichtigt werden, wenn die Patentansprüche selbst zwar klar abgegrenzt seien, die Beschreibung und die Zeichnungen dagegen weiter reichen.

Nach Aussprache stimmte die Gruppe für Beibehaltung der gegenwärtigen Fassung des Vorentwurfs.

Der Vorsitzende ersuchte die deutsche Delegation, den fraglichen Satz so zu formulieren, daß er den Sinn des französischen Textes genauer wiedergibt.

Der zweite Absatz dieses Artikels wurde aus dem früheren Artikel 90 d übernommen, der dafür fortfällt. Der Artikel wurde angenommen.

Article 21 - Extent of the protection conferred by a European patent

44. For paragraph 1 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 an applicant can only draw up his claims for a European patent application if he knows exactly what the principles for their interpretation are.

III.4.1e Going from Art 21 to Art 20

Article 20 (former Article 21)

Extent of the protection conferred by a European patent

(1) The extent of the protection conferred by a European patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

Der Artikel wurde dem Redaktionsausschuß mit diesen Hinweisen übergeben.

Artikel 21 (21 a + 90 d)

Die Gruppe prüfte den zweiten Satz des ersten Absatzes: "Jedoch dienen die Beschreibung und die Zeichnungen zur Verdeutlichung der Tragweite der Patentansprüche" und verglich ihn mit dem Straßburger Entwurf, wonach Beschreibung und Zeichnungen zur Auslegung der Patentansprüche dienen. Nach Ansicht des Vorsitzenden ist die Fassung des Vorentwurfs geschmeidiger als die des Straßburger Entwurfs. Sie unterscheidet sich insofern wesentlich von letzterem, als nach dem Straßburger Entwurf die

.../...

Note to Article 20 (1) :

This paragraph corresponds to Article 8, paragraph 3, of the Strasbourg Convention.

*Article 20*

Extent of the protection conferred by a European patent

(1) The extent of the protection conferred by a European patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(2) The grant of a European patent shall determine retroactively the extent of the protection conferred by the European patent application.

**III.4.2 The various texts leading to the Protocol on Interpretation of Art 69(1) EPC**

102. The German delegation pointed out that in the English text particularly and in the two other versions to a lesser extent, the wording of this provision was too narrow. The present text could indeed be interpreted so as to limit the protection to the literal content of the claims, excluding their substance. Moreover, the word "nevertheless" would seem to indicate that the description and drawings would only be used by way of exception. It proposed that the wording of paragraph 1 would be made more flexible if it were to read: "... shall be determined by the claims. The description and ...".

In opposition to this proposal, it was said that the text in question was aligned on a provision of the Strasbourg Convention and was the result of a compromise between, amongst others, the German and United Kingdom delegations, being part of a version that had been even more precisely worded than the version eventually adopted. It was also pointed out that the proposal would result in a provision of such a general nature as to render it more or less superfluous.

Article 20 (Extent of the protection conferred by a European patent)

54. The Conference noted a general trend which emerged from the hearing with the interested circles towards a system of interpretation of claims situated half way between the "strict" British system and the "liberal" German system.

The Conference then examined two other proposals with a view to defining a middle-of-the-road interpretation: the proposal of some organisations (BR/165/72) to make an addition to the second sentence of Article 20 and the suggestion to leave the present text unaltered while leaving the task of reasonable interpretation to jurisprudence.

The ICC drew attention to the utility of a rule of interpretation, given that in the national context it was advisable for the judge to have a certain margin of discretion, because what may be evident at the time of an action for infringement may not have been evident at the moment when the patent was granted. CNIPA shared this point of view, although stated that it was not in favour of great latitude of interpretation.

BR/169 e/72 son/AV/prk

.../...



The Working Party finally decided against amending the present text of Article 20 which, moreover, corresponded to Article 8, paragraph 1 of the Strasbourg Convention; instead it followed the suggestion made by the United Kingdom delegation and adopted the text of a declaration of intent for possible adoption by the Diplomatic Conference (cf. BR/176/72, page 7).

BR/177 e/72 aut/KM/gc

.../...

III.4.2.a Art 67

M I N U T E S

of the

4th Meeting of the Inter-Governmental Conference

for the setting up of a European System

for the Grant of Patents

(Luxembourg, 20 to 28 April 1971)

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Article 67 (20)

Extent of protection

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

Note to Article 67:

It is suggested that the Diplomatic Conference should adopt the following declaration in respect of Article 67:

"Article 67 should not be interpreted in the sense 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. Neither should it be interpreted in the sense 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 patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties."

III.4.2.b The comments by various user groups on the then Art 67

COMMENTS BY

UNICE

Union des Industries de la Communauté européenne

**Article 67 – Extent of protection**

1 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.

- 8 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.
- 9 The STANDING CONFERENCE considers that in addition to a clear principle of interpretation being

PREPARATORY DOCUMENT

Drawn up by: Centre Européen de l'Entreprise Publique (CEEP)

Subject: Comments relating to the Draft Convention establishing a European System for the Grant of Patents

Article 67

5. The declaration to Article 67 should be amended to make it clear that the patentee should not be able to profit from obscurities in the patent claims. The reasons for this amendment are given in the document M 13. The following should therefore be added to the end of the declaration.
- " , avoiding that the patentee should be able to profit from obscurities in the patent claims."

CONFERENCE DOCUMENT

Drawn up by : Union of European Patent Agents (UNEPA)

Subject : Additional comments

Article 67

Proposal: Article 67 to be supplemented by an Article 67a or by two further paragraphs worded as follows:

- "(3) If the invention concerns a manufacturing process for a product, the protection shall also extend to the products directly obtained thereby
- (4) If the invention concerns a manufacturing process for a new product, every product of the same nature shall in the designated Contracting States be deemed to have been obtained by the same manufacturing process until proof of the contrary is supplied."

Reason: Although inventions of chemicals will be patentable under the Convention, it will not always be possible, particularly in the plastics industry, to define the product independently of the process for its manufacture. The applicant will therefore either opt for protection of the process or - if so allowed by the practice of the European Patent Office - define the material in terms of its method of manufacture.

Experience in most of the prospective Contracting States shows that such protection is only effective, especially as regards imports from countries where there is no patent protection, if it also comprises the products directly obtained by a protected manufacturing process (irrespective of whether or not the claim for the process is followed by a further patent claim for the product of the process) and if concurrently in respect of every designated State the Convention reverses the burden of proof in the case of new materials.

Our proposal is designed to supplement the Convention to this effect.

CONFERENCE DOCUMENT

Drawn up by : General Drafting Committee

Subject : Convention : Articles 55 to 83

***4. Effects of the European patent and the European patent application (Articles 61-68)***

The main subject of discussion in this respect was Article 67 which defines the protection conferred by the European patent and the European patent application.

The Main Committee adopted by a majority a provision which also occurs in the Draft of the Second Convention for the Community patent, whereby the protection conferred on a process is extended to the products directly obtained by that process. This provision, which was inserted in Article 62 and which is already known in the laws of several Contracting States, takes account of the fact that in certain branches of industry, such as the plastics industry, it is not always possible to define a material without reference to its means of production. At the same time, a similar majority of the Main Committee rejected a proposal that this extended protection be reinforced in the case of an invention relating to the manufacture of a new product by assuming, to the benefit of the proprietor of the patent, that any product of the same nature would be considered to be obtained by the protected process. This proposal to reverse the burden of proof was countered by the argument that it would constitute too great an inroad into the national law of the Contracting States.

Main Committee I also considered, in respect of Article 67, paragraph 2, that the concept of extending the protection conferred by the European patent application included the case of a shift in the protection as a result of an amendment to the claims. With regard to the interpretative statement proposed by the Inter-Governmental Conference in respect of Article 67, it considered that this should be officially adopted unamended by the Diplomatic Conference and should be annexed to the Convention in the form of a declaration.

As regards the right to continue to use the invention, which a third party who has been operating in good faith may invoke under Article 68, paragraph 4(b), where the proprietor of the patent has corrected the translation of the specification, the Main Committee decided by a majority to depart from the draft by providing that this right could be exercised without payment, by analogy with the comparable situation dealt with in Article 121, paragraph 6.

The Main Committee adopted by a majority a provision which also occurs in the Draft of the Second Convention for the Community patent, whereby the protection conferred on a process is extended to the products directly obtained by that process. This provision, which was inserted in Article 62 and which is already known in the laws of several Contracting States, takes account of the fact that in certain branches of industry, such as the plastics industry, it is not always possible to define a material without reference to its means of production. At the same time, a similar majority of the Main Committee rejected a proposal that this extended protection be reinforced in the case of an invention relating to the manufacture of a new product by assuming, to the benefit of the proprietor of the patent, that any product of the same nature would be considered to be obtained by the protected process. This proposal to reverse the burden of proof was countered by the argument that it would constitute too great an inroad into the national law of the Contracting States.

Main Committee I also considered, in respect of Article 67, paragraph 2, that the concept of extending the protection conferred by the European patent application included the case of a shift in the protection as a result of an amendment to the claims. With regard to the interpretative statement proposed by the Inter-Governmental Conference in respect of Article 67, it considered that this should be officially adopted unamended by the Diplomatic Conference and should be annexed to the Convention in the form of a declaration.

As regards the right to continue to use the invention, which a third party who has been operating in good faith may invoke under Article 68, paragraph 4(b), where the proprietor of the patent has corrected the translation of the specification, the Main Committee decided by a majority to depart from the draft by providing that this right could be exercised without payment, by analogy with the comparable situation dealt with in Article 121, paragraph 6.

141. In the view of the United Kingdom delegation, the question here was one of patent infringement, and everything relating thereto came under national law. Such a provision might, furthermore, prove rather dangerous, inasmuch as certain industrial undertakings might try to make use of proceedings against their competitors, who would bear the burden of proof, to engage on a "fishing expedition" into their state of development. There was also the subsidiary point that the proposed provision was worded too generally since, in the last resort, every product was new. The provision was presumably intended to cover compositions only.

142. The Finnish delegation shared the view that such provisions were a matter for the law of the individual Contracting States. It also doubted whether reversal of the burden of proof would be a fair way of dealing with every conceivable case.

143. The Yugoslav delegation had no objections to the actual content of the Swiss proposal. However, it too considered that, legal procedure being an area for national law, it should not be dealt with by the Convention.

144. The Greek delegation felt that the problem of patent infringement which the proposed provision was intended to settle should be left to national law.

145. The French delegation did not deny that the proposed rules would affect the procedures of the Contracting States. It would nonetheless be prepared to agree to the proposal, provided that there were minor drafting changes.

146. The Netherlands delegation pointed out that the Swiss proposal would be of particular significance for those countries which were not envisaging the introduction, within the framework of the Convention, of any protection of substances or chemical and pharmaceutical products. It was doubtful whether the proposed provision would have any significance for countries which imposed absolute protection of substances. In the Netherlands, where protection of substances was certainly not yet absolute, the reversal of the burden of proof had not worked out badly in practice.

Such a rule seemed reasonable and was, in any case, desirable in the context of the Second Convention. The Netherlands



sentence proposed was inconsistent with the first sentence which stated that the description and drawings should be used to resolve any ambiguity.

107. Similarly, the EIRMA delegation stated that it was not in favour of the proposed addition.

108. In the opinion of the delegation of the Standing Conference of the Chambers of Commerce and Industry of the European Economic Community, the Swedish proposal would mean that the claims could no longer be interpreted at all. It thought that this would be regrettable and should be avoided. The European patent and especially its claims must be capable of being interpreted reasonably by the courts in the Contracting States. The Swedish proposal therefore should be rejected.

109. The UNION delegation thought that any amendment would tend to upset the general balance of the declaration, and that would be undesirable.

110. The IFIA delegation stressed the great importance for competitors of claims that are clearly stated, especially for private inventors and for relatively small undertakings. According to the present text of the declaration the claims were not to be taken literally nor merely as guidelines either. This gave rise to major problems especially for the private inventor.

111. Before a vote was taken on the proposed addition, the Swedish delegation stated that industrial and patent agent circles in Sweden attached great importance to the requested addition.

112. When the vote was taken 4 delegations were in favour of the Swedish proposal and 10 delegations against with 3 delegations abstaining.

113. As regards the form the declaration would take the Main Committee agreed that it should be annexed to the Convention — perhaps as a Protocol\*.

114. The Main Committee referred to the Drafting Committee a drafting proposal from the French delegation concerning the note to Article 67 (69) (M/58/1/11).

115. The Swiss delegation proposed substituting the clause "in so far as such protection corresponds with that of the patent" for "in so far as such protection is not thereby extended" at the end of *paragraph 2* (M/54/1/11/III, page 13). This was to make clear that retroactivity would apply only if and to the extent that the claims of the application coincided with those of the patent. A change in the protection consequent upon an amendment of a claim (shifting) should therefore also be excluded.

116. The Netherlands and Austrian delegations supported this proposal.

117. The delegation of the Federal Republic of Germany and that of the United Kingdom did not consider the proposed amendment necessary. In their opinion, a shift in protection would also represent a widening of such protection and therefore retroactivity would be excluded.

118. In the opinion of the UNICE delegation it would not be justified for the provisional protection conferred retroactively by the application to be granted in respect of a new element which was claimed as the result of a shift. If this was the aim of the Swiss proposal, it should be rejected.

Furthermore, it should also be considered whether the term "extension of the extent of protection" could be improved.

119. The FICPI delegation saw a certain amount of danger in the event of shifting being excluded. The applicant would have to try to make all claims as wide-ranging as possible from the outset. Otherwise, he could not receive any provisional protection retrospectively as regards the elements which were not claimed until a later date, even if they were covered by the original disclosure. If the procedure for publication of the

application were encumbered with claims which were in part superfluous this would not be a satisfactory solution for anyone.

120. The Main Committee concluded that, in the event of a shift in protection consequent upon amendment of a claim, provisional protection should not be granted retrospectively as regards the newly-claimed part.

The Committee referred to the Drafting Committee the Swiss proposal for examination whether it was necessary to amend *paragraph 2*, last sentence, in order to clarify the situation.

121. The Swiss delegation proposed including a new provision in a *paragraph 3* or in a separate Article to the effect that, if the invention concerned a manufacturing process for a product, the protection would also extend to the products directly obtained thereby (M/67/1). It pointed out, for example, that it was often not possible in the field of chemistry to secure protection for a substance because the substance could not be defined independently of the method of manufacture. In such cases the applicant had to choose between a process claim with, if necessary, a further claim for the product and a claim for the product in which the product was defined in terms of its method of manufacture (product by process claim). In both cases the Convention would have to be supplemented in the way proposed, if the applicant was to be afforded protection in all the Contracting States, in particular as regards imports from countries where there was no patent protection. Furthermore, almost all the prospective Contracting States had such a provision in their patent law.

122. At the beginning of the discussion the Chairman pointed out that, in his opinion, Article 67 (69) could be applied only in those States which, under the terms of the Convention, had to grant full protection of a chemical substance on the basis of Article 50 (52).

123. The Italian and Austrian delegations supported the Swiss proposal. The Italian delegation thought that it was in line with the maximum solution as set out in other parts of the Convention.

124. The United Kingdom delegation considered that the proposed rule did not concern the method of formulating the claims as much as the question of patent infringement, which came fully under national law. Indeed the EC States had also settled this matter in the Second Convention (Article 29, sub-paragraph (c) of the Draft Convention for the European Patent for the Common Market) in the way desired by the Swiss delegation. It added that it would abstain from voting on the proposal.

125. For the Netherlands delegation the proposal meant an extension of the maximum solution in so far as the effect of the patent in respect of the States designated was to be more closely defined. It had no hesitations about the proposal since the solution laid down in the Second Convention corresponded exactly to it. In addition, it considered that the Swiss proposal concerned not only the States which would table reservations under Article 166 (167).

126. The Netherlands delegation's view was also shared by the Finnish delegation.

127. The Swiss delegation said, in reply to some speakers' statements, that in its opinion the proposal did not mean an extension of the maximum solution in the sense of laying down in the Convention what constituted an infringement of a patent. The same effect could be achieved by laying down that, in addition to a process claim, a claim for the product obtained thereby was admissible, even if it did not contain any additional features.

128. The Chairman replied that, in his view, the Swiss proposal did in fact mean a widening of the Convention, since the matter had hitherto come under national law. There was

\* It was finally given the form of a Protocol with the title "Protocol on the Interpretation of Article 69 of the Convention".

### III.4.2.c The emergence of the protocol of interpretation of Art 69

*Article 67 (69) – Extent of protection*

100. The Swedish delegation, seconded by the Finnish delegation, requested that the *note to Article 67 (69)* be drafted in such a way that the patentee should on no account be able to profit from any ambiguity in the patent claims (M/53/1/II, point 5; see also M/13, point 7). The present version of the proposed declaration was not quite satisfactory in this respect. It also wished to point out that great importance had been attached to the wording in this respect when drawing up a Scandinavian patent law.

101. The Netherlands delegation opposed the request. In its opinion this addition would not improve the text. It wished, however, to point out above all that the declaration had been very carefully drafted after lengthy discussions.

102. In the considered opinion of the delegation of the Federal Republic of Germany the present text of the statement was very well-balanced. If the Swedish request were granted, a lack of balance, which nobody sought, might be created. It could therefore not support the proposed addition.

103. The United Kingdom delegation considered that the Swedish proposal might well be suitable for most cases of obscure claims but not for all. It was therefore not advisable to become committed to an interpretation of obscure claims in the way proposed. Furthermore, the delegation referred to the lengthy discussions there had been on this very declaration. It was therefore better to retain the present text.

104. The Swiss delegation said that it would be sorry if the present, very well-balanced text were amended.

105. The FICPI delegation stated that it was understandable that the Swedish delegation wanted, with its proposed addition, to afford the greatest possible certainty for competitors of the proprietor of the patent. However, the applicant could simply not be expected to foresee, in drawing up his claims, all the possibilities of infringement. If he did not foresee them, it would be to his disadvantage under the Swedish proposal. Considered in this way, the proposal was even likely to detract to a large extent from the European patent's appeal.

106. The delegation of the International Chamber of Commerce concurred in the statements of the Government delegations. In addition, it considered that the additional

Art. 69

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- 2 -

Entwurf, der dem nebenstehenden Dokument zugrunde liegt	Art. Nr. im Entwurf/ Dokument	Dokument, in dem der Art. behandelt wird	Fundstelle im Dokument
E 1972	67	M/22	S. 242
"	67	M/23	S. 292
"	67	M/30	S. 3
"	67	M/53/I/II	S. 22
"	67	M/54/I/II/III	S. 13
"	67	M/58/I/II	S. 1
"	67	M/62/I/II	S. 86
"	67	M/67/I	S. 1
"	67	M/146/R 3	Art. 69
"	67	M/PR/I	S. <del>31-33</del>
"	<del>67</del> 69	M/PR/G : Nicht	S. <del>200/201</del>

### III.5. Art 69(1) EPC and Art 123(3) EPC

That Art 69(1) EPC and Art 1 of the Protocol on interpretation are to be used when assessing the requirements of Art 123(3) EPC in opposition, i.e. in a post grant procedure is a direct consequence of the plain wording of Art 123(3) EPC.

This is actually the only case in which Art 69(1) EPC and Art 1 of the Protocol on interpretation should play a role in procedures before the EPO.

### **III.6 The Protocol on the Interpretation of Article 69(1) EPC**

Art 1 of the Protocol on interpretation of Art 69 EPC made clear that the interpretation of the claims should not be as strict as the former English interpretation, but not as lenient as the former German interpretation. It should be somewhere in-between.

In its Art 2, the Protocol mentions equivalents, without however defining equivalents.

It is nevertheless manifest that interpretation of claims might be different when it comes to infringement, to be precise broader, than their interpretation during prosecution and in post grant centralised procedures like opposition and limitation. .

If the European legislator had intended that the same interpretation applied during prosecution before the EPO and in case of infringement, it would have said so and not indirectly referred to Art 69(1) EPC when setting up Art 123(3). After an opposition, third parties should not be surprised by a broader scope of protection. Extending the scope of protection in opposition is also a ground for which a patent opposed and maintained in amended form can be revoked, cf. Art 138(1,d).

### **III.7 Summary of the function of Art 69(1) EPC and of the Protocol on interpretation represent**

#### **III.7.1 Art 69(1) EPC**

Art 69(1) EPC defines that the scope of protection is determined by the claims and at the same time gives a rule of interpretation of the claims. This interpretation does, for example not depend on the file history, or from any other possible way of interpretation.

Art 69(1) EPC does not prescribe that in any situation, especially not in examination or opposition, the claims ought to be systematically interpreted before any decision on the validity of those. If an interpretation is necessary, said interpretation can only be made on the basis of the description and of the drawings.

#### **III.7.2 Art 1 of the Protocol of interpretation of Art 69**

Art 1 of the Protocol of interpretation of Art 69 is an interpretation is itself of Art 69 and it has been shown that Article 1 of the Protocol results from the fear of a too liberal or too rigid interpretation of the claims in case of infringement.

As the EPO is not concerned by infringement, it does not have the competence to interpret the claims as a national court would do in case of an infringement.

The EPO's duty is to grant claims which are clear, novel and inventive, and not to assess a possible infringement.

## **IV. The referred questions**

The following questions were referred by the Board 3.2.01 to the Enlarged Board of Appeal, both to ensure the uniform application of the law and because a point of law of fundamental importance arises:

### **IV.1. 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 to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?

### **IV.2. 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? [

### **IV.3 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?

## **IV.4 Some general considerations on the referred questions**

### **V.4.1 Some considerations relating to question 1**

For the referring board, in the early years case law was such that Art 69 EPC and the Protocol were to be applied not only when assessing Article 123(3) EPC, cf. **G 2/88**, Reasons 2.5) but also when assessing the prerequisites of patentability, such as Art 54, cf. **G 6/88**, Reasons 3; **T 16/87**, Reasons 6.

The referring board noted that over the years, a strong line of case law has developed that took **G 2/88** as an indication that Art 69 EPC and Article 1 of the Protocol should, within the jurisdiction of the EPO, exclusively be applied in the realm of Art 123(3) EPC that refers to the patent's scope of protection, while in the realm of provisions dealing with the invention, such as Art 54, 56 and 83 EPC, or with the patent/patent application, such as Art 123(2) EPC, these provisions should not be applicable. The fact that **G 6/88** was issued on the same day and that the EBA did not make this distinction in either of these decisions seems to have been lost over the years.

The EBA, clearly regarded Art 69 EPC and the Protocol as the relevant means of determining the technical features of a claim, expressly both in assessing patentability when comparing the invention with the relevant prior art and for the scope of protection when determining which rights are conferred by the patent (or patent application).

Thus, it can hardly be assumed that the EBA would have agreed with the development of diverging standards for assessing these two sides of the same coin, particularly given that the EBA always strove for consistency in its assessment of similar principles found across different provisions of the EPC.

The board referred to e.g. “the uniform concept of disclosure” with reference to Art 54, 87 and 123 EPC as developed in decisions **G 2/98**, Reasons 9; **G 1/03**, Reasons 2.2.2 and **G 2/10**, Reasons 4.6).

It is to be noted that those decisions are quite older than the decisions **G 2/88**, **G 6/88** and can be considered as having been replaced by the considerations expressed in **G 2/12**, see above.

## **IV.2 Some considerations relating to question 2**

The referring board referred to numerous decisions in which either

- The description and figures were taken into consideration in any case when construing the claim, but, as a second step, often give priority to the wording of the claim in case of divergence with information only found in the description
- The description and figures were taken into consideration irrespective of any ambiguity detected, either without indicating a legal basis or in cases where the contentious question did not need to be decided upon, e.g. because the claim language was found to be ambiguous
- Other decisions left the question unanswered because, even when applying Art 69, limiting features should not be read into the claim and existing features in a claim should not be disregarded with reference to information given only in the description
- Some decisions went so far as to state that the claims should essentially always be interpreted on their own merits, i.e. without consulting the description and figures at all

In the case at issue, the question cannot be left open since the claim language when read in isolation would not be considered ambiguous by the skilled person.

Therefore, whether the description and figures may be consulted when construing patent claims to assess patentability and whether this may be done generally or only if there are ambiguities in the claim language must be resolved.

### **IV.3 Some considerations relating to question 3**

The third point where the case law of the boards diverges is the extent to which definitions or similar information given in the description for certain terms may influence the interpretation of these terms when used in the claims.

Here again the referring board quoted a series of decisions

- Some decisions emphasise the autonomy of patents to define the meaning of terms used in patent claims and the need to read these terms in the context of the whole content, taking into account what is achieved by the invention. Thus, terms used in patent documents should be given their normal meaning in the relevant art unless the description gives the terms a special meaning. In that regard, the patent document may be its own dictionary.
- Other decisions refer to the need for legal certainty in the patent system and remind that it is the claims that primarily determine the subject-matter of the invention. Thus, many decisions underline that the support of the description should at least not be used for restricting or modifying the subject-matter of the invention beyond what a skilled person would understand when reading the wording of the claims. The majority of decisions seem to agree on this, many of which apply Article 69 and its protocol. The reasoning given for this in these cases is based on the wording of Art69(1), first sentence and has become known in the recent years, as the principle of the primacy of the claims.
- Some decisions postulate that the claims should always be construed on their own merits without taking anything from the description, including any definition found there, into account as a “supplementary-guidance tool”
- Decisions applying the principle of ambiguities as a prerequisite for claim construction disregard information, including definitions, in the description if the claim read on its own is found to be clear.
- Even where such a claim was found unclear, some decisions disregarded a definition or similar information found in the description if it might be used to restrict or modify the subject-matter of the invention beyond what a person skilled in the art would understand when reading the wording of the claims, for example, by excluding interpretations which are both reasonable and technically sensible within the relevant technical context.
- Several decisions hold that, at a stage of the proceedings where this is still possible, especially during examination but also in opposition proceedings, any mismatch between claims and a definition or the like in the description should be

resolved by amending the claims since this is where the invention should be defined. Thus, where the definition is not included in the claim but could have been, it seems that these decisions would disregard it.

To sum up, in any case and independent of the two other questions, the question whether and to what extent definitions and similar information found in the description may be disregarded must be answered before deciding the current case.



## V. The limitation of the referring board's questions to Art 52-57 EPC

Although Art 123(2) is mentioned 4 times in **T 439/22**, the referred questions have been limited to the application of Art 69 (1) EPC and Art 1 of the Protocol on Interpretation, when a claim has to be assessed with respect to Art 52-57 EPC.

The board did not bring in Art 123(2) EPC. Some decisions do however require that the claims ought to be interpreted taking into account of the description and of the drawings under Art 69 EPC and its protocol of interpretation. .

In **T 1473/19**, Reasons 3.15, the board found that

- Art 69 EPC in conjunction with Article 1 of the Protocol thereto can and should be relied on when interpreting claims and determining the claimed subject-matter in proceedings before the EPO, including for the purpose of assessing compliance with Article 123(2) EPC, cf. Reasons 3.1-3.15.

In **T 1473/19**, the board however added that

- Although Art 69(1) EPC, second sentence, requires that generally account be taken of the description and the drawings when interpreting a claim, the primacy of the claims according to Art 69(1)EPC, first sentence, limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. Cf. Reasons 3.16-3.16.2.

Following **T 450/20**, the proprietor requested in **T 1473/19** the board to refer to the EBA a question relating to the application of Art 69 EPC when assessing novelty under Article 54 EPC. In **T 1473/19**, the board refused to refer any question to the EBA.

### V.1 The link between Art 54, 88 and 123(2) EPC

It should not be forgotten that, as the referring Board did, that the EBA set up in various decisions to. “the uniform concept of disclosure” with reference to Art 54, 88 and 123 EPC as developed in decisions **G 2/98**, Reasons 9; **G 1/03**, Reasons 2.2.2, **G 2/03**, and **G 2/10**, Reasons 4.6, as well as in **G 1/16**, Headnote.

**G 1/05** and **G 1/06**, dealing with divisional applications. Art 76(1), provides that a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. This is tantamount of stating that the subject-matter of the divisional has to be derivable directly and unambiguously using common general knowledge from the earlier application as filed. .

This “uniform concept of disclosure” finds its expression in the formulation “directly and unambiguously derivable, using common general knowledge”, which is applied like an Ariadne's thread, in different situations like when assessing

- novelty under Art 54(2+3) EPC
- identity of the invention under Art 88, when a priority is claimed under **G 2/98**
- definition of the “golden standard” in **G 2/10** when it comes to added subject-matter.
- admissibility of a disclaimer, cf. **G 1/03**, **G 2/03** or **G 1/16**.

Depending on the reply of the EBA to the referred questions, the coherent line of case law established under those previous decisions which all refer to what is “directly and unambiguously derivable, using common general knowledge” could be endangered or jeopardised.

## **V.2 Correction of errors in documents filed at the EPO**

In **G 3/89**, OJ 1993, 117, as well as in **G 11/91**, OJ 1993, 125, the EBA held that, under R 88, second sentence, EPC1973 now R 139 EPC, a correction of the parts of a European patent application or of a European patent relating to the disclosure, can only be carried out within the limits of what a skilled person would “derive directly and unambiguously, using common general knowledge”, and seen objectively and relative to the date of filing, from the whole of these documents as filed.

Such a correction is of a strictly declaratory nature and thus does not infringe the prohibition of extension under Article 123(2) EPC.

in Reasons 7, of both decisions, the EBA added that as a result of the prohibition of extension under Article 123(2) EPC, documents other than the description, claims and drawings may only be used insofar as they are sufficient for proving the common general knowledge on the date of filing.

On the other hand, documents not meeting this condition may not be used for a correction under Rule 88, second sentence, EPC even if they were filed together with the European patent application. These include, inter alia, priority documents, the abstract and the like.

The clear lines of action defined in **G 3/89** and in **G 11/91** should not be watered down by allowing interpretations under Art 69(1) and Art 1 of the Protocol of interpretation of Art 69.

## **V.3 Prior art represented by “interfering European applications”**

In view of the dichotomy, introduced with the separation between grant and infringement, it was also necessary to take care of “interfering applications”, that is, applications filed or validly claiming a priority before the date of filing of a later European application, but published on the date of filing or after said filing date.

Under Art 54(3) EPC the effect of the prior art represented by “interfering European applications” has been limited. “Interfering European applications” can only be taken into account with respect of novelty and not for assessing inventive step.

In an integrated national granting system, each country might decide differently on national prior rights.

The fact that it is the “whole content approach” which has been retained and not the “whole claim approach” should not interfere with the notion of “directly and unambiguously derivable, using common general knowledge” as discussed.

The clear definition of the whole content of the application or of the interfering European application should not be watered down by allowing interpretations under Art 69(1) and Art 1 of the Protocol of interpretation of Art 69. It should not be forgotten that in its Art 2, the Protocol of interpretation includes equivalents into the scope of protection as defined in Art 1.

In numerous decisions on Art 123(2), the boards of appeal have made clear that the notion of “directly and unambiguously derivable, using common general knowledge” does not include what could be obvious to the skilled person and hence does not include equivalents.

#### **V.4 Minutes of OP before the EPO and interpretation of the claims**

It is established case law that it is not the function of the minutes to record statements which a party considers will be of use to it in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit.

This is because such statements are not "relevant" to the decision which the Board has to take within the meaning of R 124(1). Such matters are within the exclusive jurisdiction of the national courts. See **T 319/19**, **T 3272/19**, or **T 552/18**.

It is also not the function of the minutes to record statements relating to withdrawn requests which can be possibly relevant in any subsequent proceedings, like national infringement proceedings. . See **T 2545/16**, whereby this decision confirms **T 71/06**, **T 240/09** or **T 555/01**.

Should Art 69(1) and Art 1 of the Protocol on interpretation would become predominant, in procedures before the EPO, then it would not be possible to refuse to incorporate in minutes of oral proceeding and in the decisions of the EPO considerations which are reserved to national courts.

This is a further reason not to water down the present notion of “directly and unambiguously derivable, using common general knowledge” by first interpreting the claims and hence deciding on the scope of protection afforded by the claims at stake.

#### **V.5 Two examples which show how interpretation of the claims can vary in infringement**

Two examples allow to show how one and the same judicial body evolved in its interpretation of the claims: the “Improver” and the “Pemetrexed” case in the UK.

### V.5.1.The “Improver” or “Epilady” case

In the “Improver/Epilady” case, the patent [EP 0 101 656 B1](#) relates to an apparatus for hair removal. The apparatus essentially comprises a helical spring comprising a plurality of adjacent windings driven by a motor, whereby the helical spring is positioned along an arcuate hair engaging portion. The spring when rotated grips hairs between its coils and pluckes them from the skin.

The alleged infringement replaced the spring with a rubber rod having slits in its surface. The question was whether the slitted rubber rod could be considered as "a helical spring".

The UK decision by Lord Hoffmann can be summarized in the finding that the expert would have understood from the patent that the patentee meant to confine his claim to a "helical spring", in its primary meaning and not in a wide generic sense. For this last reason, the rubber rod did not infringe.

In Germany, the rubber rod with slits was considered infringing.

The rubber rod having slits it is surface performs the same function, but with different means, in order to obtain the same result as the coiled spring. Even in the absence of a definition of equivalents in Art 2 of the Protocol on interpretation, the coiled spring and the rubber rod with slits can thus be considered as being equivalent.

The proprietor of **EP0101656 B1** has only disclosed the helical spring and not the rubber rod with slits. He could thus not amend the description and the claims in order to cover the variant “rubber rod with slits”. The scope of protection might encompass the rubber rod with slits, but this rubber rod with slits was never envisaged by the applicant/proprietor.

Amending the claims and the description in order to include the rubber rod with slits would be manifestly contravening Art 123(2) EPC as the rubber rod with slits cannot be said to have been “directly and unambiguously derivable, using common general knowledge,” in the originally filed documents.

This position goes back to [T 167/84](#), Headnote, in which it was held that equivalents of features originally disclosed cannot be considered as “directly and unambiguously derivable, using common general knowledge” from the application as filed. Equivalents belong to the field of inventive step.

### V..5.2 The pemetrexed case

[EP 1 313 508 B1](#) relates to a Swiss type claim about the use of pemetrexed disodium in the manufacture of a medicament for use in combination therapy for inhibiting tumour growth in mammals. The Swiss-type claim is irrelevant in the present context; what matters is the main component pemetrexed disodium.

The original disclosure went on about the combination of any antifolate with vitamin B12. However, the only properly documented example in the application as filed, was

pemetrexed disodium. The examiner invited the applicant to limit its claims to pemetrexed disodium. In reply the applicant claimed pemetrexed in general. The examining division then raised an objection under Art 123(2) EPC as the only example was that of pemetrexed disodium. The granted claims were thus limited to pemetrexed disodium.

In various European jurisdictions products containing a different salt were considered infringing.

The potential infringer, Actavis, used instead of pemetrexed disodium either (a) pemetrexed itself i.e. the free acid, or (b) pemetrexed where the hydrogens on the two CO<sub>2</sub>H units had been replaced by either (i) tromethamine or (ii) potassium. The proprietor, Eli Lilly, contended that such a proposal would directly infringe the Patent

In the UK, the High Court, [2015] RPC 6, held that the Actavis products neither directly nor indirectly infringed the Patent. The Court of Appeal, [2015] EWCA 555, upheld the judge's decision on there being no direct infringement but did reverse the High Court with regard to indirect infringement. The case ended before the UK Supreme Court

In the decision [\[2017\] UKSC 48](#), the UK Supreme Court held that Actavis's products directly infringe Eli Lilly's patent,.

In this decision the chairman of the UKSCK criticised the Examining Division for having raised an objection under Art 123(2) EPC against a general claim relating merely to pemetrexed, cf. Reasons 79.

With due respect to the UKSC and its Chairman, it was wrong to criticise the Examining Division for having raised an objection under Art 123(2) EPC against this general claim. In view of the application as filed, the Examining Division had no other choice.

It might be true that, although the acidic parent molecule could be administered in its free acid form, it was often necessary for various reasons, including solubility, to change from the free acid to the salt form. Various salts other than sodium, like potassium, could also be envisaged, but only the use of pemetrexed disodium was directly and unambiguously derivable from the original disclosure taking into account common general knowledge.

By the way, the German Federal Court (BGH) came to the same conclusion, on the basis of Art 69(1) and Art 1 of the Protocol, as far as infringement was concerned, cf. [X ZR 29/15](#).

## **V.6 Impact on the “gold standard” according to G 2/10**

Although the referring board limited its questions to the relation between Art 69(1) EPC and Art 1 of the Protocol, by mentioning Art 54, the answer of the EBA will have a direct impact on the “golden-standard” established by the EBA and all decisions of the boards applying this standard.

Both examples, “Improver/Epilady” and “Pemetrexed” show that the interpretation of the claims during infringement can go way further than what has been “directly and unambiguously derivable, using common general knowledge” from the originally filed specification.

Applying Art 69(1) and Art 1 of the Protocol in order to interpret the claims would bring an end to the coherent line of case law developed by the EBA in decisions **G 2/98**, **G 1/03**, **G 2/03**, **G 1/05**, **G 1/06**, **G 1/16** and **G 2/10** as well as **G 3/89** or **G 11/91**. This coherent line of case law should be kept for the sake of legal certainty.

The EPO and its Boards of Appeal have been often criticised for their though stance on added-matter, but, in the end, this has been to the benefit of not only the users of the EP system, but also for third parties.

Any more lenient approach on added subject-matter and on the concept of “directly and unambiguously derivable, using common general knowledge” would make life difficult not only for first instance deciding bodies of the EPO, but also for non-proprietors of European Patent Applications or Patents.

It would lead to the EPO having to decide on possible infringement which was not foreseen by the legislator when the EPC was set up.

The strict stance of the EPO in the matter of “directly and unambiguously derivable” has not hindered national Courts to decide upon infringement and have devised their own theory of equivalents.

As far as equivalents are concerned, [T 1168/22](#) reminded that “Firstly, equivalence of a claimed feature with parts of the original disclosure is not sufficient to provide for such a feature a direct and unambiguous disclosure according to the so-called gold standard” The board referred to **G 2/10**, reasons 4.3”.

#### **V.6.1 Scope is not content**

In [T 2310/22](#), the board held that contrary to the opposition division claim 1 as granted did not infringe Art 123(2) EPC and remitted the case for further prosecution to the first instance. Remittal was based on a set of claims in which granted claims infringing Art 123(2) were deleted.

The original claims were all directed to a method for operating a medical system. The claims of the granted patent were directed to a medical system. In the Reasons, Point 4, the board held that scope of protection is not the same as content. A claim that defines a method might well, for example, set out a system in terms of all its essential features, while only defining a method of using, or operating, such a system.

In [T 426/89](#), the board held that a “Method of operating a pacemaker for stopping tachycardia” was a non-patentable medical method, then under Art 52(4) EPC 1973, now Art53(c).

The board did however allow a change of category from “Method of operating a pacemaker for stopping tachycardia”, to “Pacemaker” as it considered that the granted claim was a actually a claim, which in functional terms referred to structural features of a pacemaker.

Those two decisions allow to differentiate between the scope of protection under Art 123(3) EPC and Art 69(1) EPC by concentrating on the content of application as filed and not on the granted claims.

Such an approach might allow to keep the notion of “directly and unambiguously derivable” as established by a long line of case law of the EBA shown above, without being spoiled by an interpretation valid in case of infringement. .

## **V.7 Primacy of the claims**

The notion of primacy of the claims is an important notion in the EPC.

For this reason alone, the description should not be taken as allowing either a much broader definition or a much more limited definition of a feature in a claim or of the whole claim. In view of the principle of party disposition, it is the applicant/proprietor which is responsible for the drafting of the claims. He has thus to bear all the consequences of this principle.

Furthermore, any independent claim has to be commensurate with the contribution to the art and every third party should know whether it is infringing or not. Clarity of the granted claims is thus of utmost importance.

In order to obtain the grant of European patent, claims have to be filed in the two further official languages other than the language of proceedings, cf. R 71(3) EPC.

According to R 71a, the decision to grant the European patent is only issued if all fees have been paid, a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings has been filed.

In view of all those requirements, the primacy of the claims in procedures before the EPO cannot be challenged.

Even taking into account the requirements for translations imposed by the contracting states under Art 65 EPC, national legislations have made clear that if the translation of the claims (and of the description) is more restricted in scope than the claims (and the description) in the language of proceedings, then the limited scope prevails.

There as well, it is difficult not see the primacy of the claims.

If the description implies a much more limited interpretation of the claim, this more limited interpretation should find its way in the claim during examination. In comparing the claim with the prior art, the examiner cannot read in the claim as it stands a more limited interpretation.

If the description allows a more general interpretation of the feature in a claim, the applicant/proprietor having defined the wording of the claim, he cannot benefit from a more general definition of this feature in the description when comparing the claim with the prior art.

In case of infringement, the national judge is then free to use any interpretation he thinks fit. This cannot be requested from an examining or opposition division.

## **V.8 The proposed interpretation rule by the referring board**

In Reasons 6.2.3 and 6.2.5 the referring board suggests not to totally disregard the description.

To this effect the referring board considered that the fact that patent proprietors “apparently willingly refrained from including information from the description and drawings that give the term an alternative meaning compared to the one ordinarily linked to it may be taken into account” should not deprive the applicant/proprietor from an alternative meaning compared to the one ordinarily linked to it.

In support of this statement, the board considers that where the information giving the terms in the claims the meaning as intended in the patent is not included in the claims even though it could have been by amendment of the claims, the share of prior art examined that is potentially novelty-destroying or could render an invention obvious is increased during examination and opposition proceedings.

For the referring board, there is still the risk that the skilled person reading the patent and giving considerable weight to the claims as the place where the invention is defined and the extent of protection conferred by the patent is determined might understand the term in its ordinary meaning.

Therefore, the referring board suggests a reversal of the order of legal examination. First, the meaning of a term is to be determined in the context of the claims, description and drawings. Second, whether this meaning is sufficiently reflected in the claim is double-checked. If it is found not to be sufficiently reflected in the claim, a broader understanding encompassing all potential understandings derivable from the claim wording might be indicated.

### **V.5.1 Comments on the proposed interpretation rule by the referring board**

The way of interpretation of the claim and the change of the order of examination as suggested by the referring board is however not reconcilable with the principle of party disposition and of the primacy of the claims.

The skilled person should, in absence of any ambiguity in the claim, take the wording of the claim at face value, i.e. understand the term in its ordinary meaning.

It is only in case of an ambiguity in the claim that the ambiguous feature should be given its broadest interpretation possible, taking into account the definition of the feature in the description.



By allowing the applicant/proprietor to give in the description an alternative, i.e. either a much broader or a more limited, interpretation of an ordinary term in a claim during examination, it is possible to consider that the applicant/proprietor wants to conceal the real scope of the claim. It might well be that more prior art could become relevant, but this would be detrimental to the overall efficiency of the EPO.

Why should an applicant/proprietor benefit from a broader interpretation of a claim during examination or opposition if he has willingly restricted the scope of protection of the claim by using in the latter a more restricted feature?

In the opposite case, an applicant/proprietor might want to give in the description a more restricted meaning to a feature in claim which has in its wording a more general meaning. In **T 2548/19**, the board has made clear that “According to established case law, for the purposes of judging novelty and inventive step, Art 69 and its Protocol cannot be relied on to read into a claim an implicit restrictive feature that is not suggested by the explicit wording of the claim”.

What works in this direction, should as well work in the other direction. Otherwise no claims are needed as it was the case in France under the patent law of 1844. This allowed a late, well known, French litigation lawyer to say that the proprietor will discover his patent on the day of the infringement. This is far from any legal certainty.

What the referring board suggests in Reasons 6.2.5 is a change of paradigm. It suggests that first, the meaning of a term is to be determined in the context of the claims, description and drawings. Second, whether this meaning is sufficiently reflected in the claim is then double-checked. This means that the description is to be taken into account irrespective of the fact of whether the claim as such is clear.

Contrary to what the referring board claims, legal certainty would not be increased, but the interpretation of the claim would vary depending on the supposed interpretation given on the claims. It is well known that national jurisdictions might come to similar results, but they might have different interpretations of the claims. Why should in this situation one interpretation be better than another one?

#### **V.5.2 The claim interpretation rule by the German Federal Court (BGH)**

The proposed reversal of the order of legal examination by first, establishing the meaning of a term in the context of the claims, description and drawings and only then secondly double-check whether this meaning is sufficiently reflected in the claim boils down to adopting the position of German case law.

According to the principles set up by the German Federal Court (BGH), description and drawings “must always” be used for claim interpretation. Claim construction considering the description can however lead to a different understanding than the wording of the claim (BGH - Spanschraube). It can even in extreme cases lead to the wording of the claim being turned into its opposite (BGH - Rotorelemente).

The EPO has lived well for over 40 years with the way the primacy of the claim has been considered and any change does not appear justified as it is not the role of the EPO to determine possible ways of infringing granted claims.

Should necessity arise, the EPO and its boards of appeal have developed a proper way to interpret claims. There is thus no reason to adopt the approach adopted by courts of a single member state.

#### **V.9. G/12 and the application of Art 69 EPC and of the Protocol on interpretation**

In [G 2/12](#), OJ EPO 2016, A27, Reasons VIII.2. 6.(b), the EBA held that:

“A distinction needs to be made between, on the one hand, the aspects of patentability and, on the other hand, the (protective) effects of European patents or patent applications. The EPC clearly provides for such a clear division, as the requirements for patentability are governed by Articles 52 to 57, 76, 83, 84 and 123 EPC whereas the extent of protection and the rights conferred by European patents or patent applications are specified in Articles 64(2) and 69 EPC in particular.”

**G 2/12** has not been mentioned by the referring board in **T 439/22** and followed **G 2/88** and **G 6/88** by a number of years. It can thus be concluded that **G 2/12** represents a more modern view of the EBA when it comes to Art 69(1) EPC and Art 1 of the Protocol.

## **VI. Proposed replies to the referred questions**

### **VI.1 No limitation of the replies to Art 52-57 EPC**

The replies should not be limited to the application of Art 69(1) EPC and of the Protocol on Interpretation should not be limited to Art 52-57, but also apply to Art 123(2) EPC.

It has been shown above here that the application of Art 69(1) EPC and of Art 1 of the Protocol on Interpretation could have a negative impact on the established line of case law relating to what is to be understood under is “directly and unambiguously derivable, using common general knowledge”.

### **VI.2 Question 1**

Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC applied systematically in procedures before the EPO?

In view of the above considerations the answer should be NO.

If the claims would be interpreted under Art 69(1) EPC and Art 1 of the Protocol, the EPO and its Boards of Appeal would also take over the prerogatives of national (or regional Courts) having to assess infringement. This possibility was not foreseen by the legislator when the EPC was set up..

Applying Art 69 (1), and Art 1 of the Protocol should be limited to assessing the conformity of amendments of the claims in opposition under Art 123(3).

Before applying Art 123(3) EPC, the claims should be first assessed with respect of Art 123(2). Any interpretation of the claims under Art 69 (1), and Art 1 of the Protocol, so as to include possible interpretations leading to infringement of the claims could in any case not be exhaustive, and could even be held as being biased.

In view of the clear stance taken by the EBA in decisions **G 2/98**, **G 1/03** and **G 2/10**, **G 1/16**, as well as **G 3/89** and **G 11/91** or **G 2/12**, any interpretation of the claims under Art 69 (1) and Art 1 of the Protocol, would be detrimental to the legal certainty resulting from the clear notion of “directly and unambiguously disclosed, using common general knowledge”.

### **VI.3 Question 2**

May the description and figures be generally consulted when interpreting the claims to assess patentability?

Question 2 can be divided in two sub-questions

### **VI.3.1 Sub-question 2.1**

May the description and figures be generally consulted when interpreting the claims to assess patentability?

In view of the reply to question 1 the answer to this sub-question is **NO**.

### **VI.3.2 Sub-question 2.2**

May the description and figures be consulted when interpreting the claims to assess patentability only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?

This question has to be answered differently depending on the state of the procedure, in other words in pre-grant or post grant procedure.

#### **VII.3.2.a Pre-grant**

.At the end of the examination procedure a patent can only be granted if all the requirements of the EPC are fulfilled.

This implies that not only the subject-matter of the claim has to be, inter alia, novel, inventive, does not comprise added-subject-matter but it also has to be clear.

A further requirement is that the claims ought to be supported by the description. This topic will not be discussed here.

As long as an Examining Division considers that some features of a claim are unclear, this ought to be objected before grant.

Any amendment to the claim can only be based on what is “directly and unambiguously derivable, using common general knowledge” by the skilled person from the originally filed documents.

Provided an unclear feature can be replaced by an originally disclosed feature, the amendment can and has to be carried out.

If a claim lacks clarity due to the absence of essential features, an amendment including the essential features is allowable within the limits of what has been “directly and unambiguously derivable, using common general knowledge” in the original disclosure.

If in examination, an unclear feature in a claim cannot be amended by features “directly and unambiguously derivable, using common general knowledge”, the application has to be refused.

There is thus no reason during examination to consult the description and figures when interpreting the claims to assess patentability.

#### **VII.3.2.b Post-grant, opposition and limitation**

What is said for opposition applies mutatis mutandis for limitation under Art 105a EPC

#### **VII.3.2.b.1** Scope of protection

Following an opposition, according to Art 123(3) the scope of protection cannot be enlarged.

In this situation a reference to Art 69(1) and its Protocol on interpretation appears necessary.

However, any interpretation under Art 69(1) and its Protocol on interpretation shall not lead to an amendment or an interpretation going further than what has been claimed at grant.

As the scope of protection cannot be enlarged, any interpretation of a claim based on the description and the drawings allowing to give a broader meaning to an unclear feature, is not allowable as it would increase the scope of protection than that of the granted claim.

This means that a feature from the description limiting the meaning of an unclear feature can be read into the granted claim, as it does not enlarge the scope of protection.

In view of Art 123(3) and the primacy of the claims, a broader feature cannot be read in the claim as this would enlarge the scope of protection.

#### **VII.3.2.b.2** Clarity

Lack of clarity is not a ground of opposition under Art 100 EPC.

The granting of a patent creates a cut-off point in terms of clarity. According to **G 3/14**, OJ 2015, A102, the claims of a patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC.

It can well happen, that a lack of clarity has escaped examination and an unclear feature has remained in a granted claim.

In such a situation, the question arises whether the description and the drawings can be used in order to interpret the claims.

As explained above here, a lack of clarity cannot lead to an enlarged scope of protection with respect to the granted claim. It can at best allow a more limited scope of protection in view of the description.

It can in no case allow introduction in the description and in the claims of equivalents, which could possibly fall under a broad interpretation of the claims

### **VI.3.3 Conclusion for question 2**

The second sentence of Art 69(1) “ the description and drawings shall be used to interpret the claims” should be interpreted as follows: “ should the necessity arise, the description and drawings shall be used to interpret the claims”.

The present formulation respects the primacy of the claims and excludes any systematic interpretation of the claims before any decision of the EPO in matters of validity, be it in first instance or in appeal.

One example of necessity could be a lack of clarity in appeal after opposition, as in appeal the granted claims cannot be checked as to their clarity under **G 3/14**.

The interpretation should however not mean that the notion of “directly and unambiguously derivable, using common general knowledge” is to be ignored.

### **VI.4 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?

#### **VI.4.1 What is to be understood under “definition or similar information on a term used in the claims”**

The question should actually read “ definition or similar information OF a term used in the claims”

#### **VII.4.1.a The description is a dictionary for the claims**

One possibility is to use the description as a dictionary for features of the claims.

Using the description as a dictionary for the claims is problematic as it conceals in the description a definition of a feature of the claims. Any feature in an claim, and especially in an independent claim, is to be considered as an essential feature.

Such a definition could be used in assessing the scope of protection, but not for assessing the validity in procedures before the EPO.

##### **VII.4.1.a.1 One example**

The description might define a ventilator as a device for exclusively blowing hot air.

The claim merely mentions the feature “ventilator”. This feature is clear for the skilled person, as for the skilled person, a ventilator is a device blowing air, and hence not necessarily blowing hot air.

The description gives thus a more restricted definition of a ventilator.

Allowing to interpret the feature ventilator in the claims as being restricted to a device blowing hot air defeats clearly and unambiguously the primacy of the claims.

Any definition of feature in the description should be apparent from the wording of the claim.

#### **VI.4.1.a.2. Essential features**

The same applies to essential features. Essential features, i.e. features allowing to achieve the effect of the invention, should not be confined to the description, but should appear in the claim.

If a claim defines a certain yield of a chemical reaction, but that yield can only be achieved under certain conditions of temperature and/or pressure, the independent claim defining said yield should imperatively include the conditions of temperature and/or pressure allowing to achieve said yield.

In view of the primacy of the claims, a definition or similar information on a term used in the claims which is explicitly given in the description should be disregarded when interpreting the claims to assess patentability as the examination as to essential features should have been carried before grant.

Essential features kept in the description and not incorporated in an independent claim boils down to allow a more limited meaning to a feature in a claim.

In view of the primacy of the claims, the description should, in principle not be used as a dictionary for the claims in procedures before the EPO.

#### **VI.4.2 Further comments on question 3**

Further conditions or comments like those distinguishing between pre-grant and post-grant procedures are those valid for Question II.

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