



Reference: G 1/24  
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To the

Registry of the Enlarged Board of Appeal  
of the EPO

For the attention of  
Mr. Nicolas Michaleczek

Via E-Mail EBAamicuscuriae@EPO.org

## **Amicus curiae comments on Enlarged Board of Appeal Referral No. G 1/24**

Dear Members of the Enlarged Board of Appeal,

On behalf of Telefonaktiebolaget LM Ericsson (publ), Stockholm, Sweden, we herewith provide comments on the questions referred by the Board of Appeal in case T 0439/22 (Gathered Sheet), for the assistance of the Enlarged Board of Appeal in case G 1/24.

### **1. About Ericsson**

Ericsson is a leading provider of telecommunication equipment worldwide. Ericsson is advancing its vision of being the "prime driver in an all-communicating world" through innovation, technology, and sustainable business solutions. The company's portfolio comprises mobile and fixed network infrastructure, telecom services, software, broadband and multimedia solutions for operators, enterprises and the media industry.

Our world-leading technology is the result of substantial investments of well over \$100B in technology research and development over the last three decades. With these investments, Ericsson has been the driving force in the creation and evolution of cellular technology, one generation at a time, for high-performance networks. Ericsson's technology leadership has resulted in the highest-quality patent portfolio in the industry, with more than 60,000 granted patents worldwide, and the most valuable 5G essential

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patents. Thereby, Ericsson has over the last years constantly been among the Top 10 applicants at the European Patent Office.

## 2. Preliminary remarks

The referring Board found in decision T 0439/22 that in the past there had been a wide range of diverging views among the Boards of Appeal on whether, and under which circumstances, the description and drawings can, have to, or must not, be taken into account for interpreting the claims when assessing patentability of the claimed invention. It further found that, while often Art. 69(1) EPC was referred to when the description was considered, in many cases no specific legal basis was given when deciding on these questions.

We thus understand the referred questions such that it is not only asked whether Art. 69(1) EPC and Art. 1 of the Protocol on Interpretation of Art. 69 EPC (in the following: “the Protocol”) is to be applied when assessing patentability of an invention, but also implicitly the question is raised whether there could be another legal basis in the EPC for considering the description and drawings for interpreting the claims.

Before addressing the referred questions in detail, we herewith present our general view that in any case the description and drawings **shall** appropriately be taken into account for interpreting the claims when assessing patentability of an invention.

Given Art. 69 EPC and the Protocol, Courts in the EPC Member States, including the Unitary Patent Court and its Court of Appeal (e.g. in recent cases *10x Genomics and Harvard v. Nanostring* and *VusionGroup v. Hanshow*), do by default use the description and drawings for interpreting the claims when determining the extent of protection conveyed by the claims – and notably also when assessing patentability in case this is challenged, as e.g. done by the German Federal Patent Court and the German Supreme Court.

It is self-evident that the interpretation of claims of a particular patent should be consistent for assessing patentability as well as determining the extent of protection. This is a question of legal certainty, predictability, and fairness, from the perspective of a patent proprietor as well as from the perspective of third parties. As it is already required by the EPC, and done in the practice of the Courts in the member states, to consider the description and drawings when determining the extent of protection, this should also be done by the European Patent Office – and other authorities, notably national courts and



the UPC – when assessing patentability, be it in examination, opposition or other proceedings. Even if decisions of the Enlarged Board of Appeal are not binding for authorities outside the EPO, like national courts and the UPC, they are certainly considered.

From a practical perspective, it matters less which legal basis is applied for achieving a consistent interpretation of the claims in all proceedings, but that this is actually done. As indicated above, at least some national courts do consider the description and drawings for interpreting the claims also when assessing patentability if validity is challenged, despite not being explicitly required to do so by Art. 69 EPC, and we think that this is indeed adequate and reasonable, if not necessary.

It would be detrimental to legal certainty and would also negatively affect public perception of the quality of European Patents granted by the EPO, if the Office would in examination or opposition proceedings apply an approach that is not consistent with the approach of the Courts in the member states that subsequently judge on validity and infringement of European Patents. We thus ask the Enlarged Board to provide guidance that is aligned with the practice of the Courts of the member states, and particularly that of the UPC.

### 3. The referred questions

#### 3.1. Question 1

With respect to 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?*

We have concerns regarding a direct application of Art. 69(1) EPC and Art. 1 of the Protocol, as will be elaborated below.

Nevertheless, despite these concerns, we do for the reasons stated above strongly support application and consistent use of the **principles, or the gist, of Art. 69(1) EPC**, second sentence, and Art. 1 of the Protocol, to the interpretation of claims when assessing patentability under Arts. 52 to 57 EPC.



#### A) Direct application of Art. 69 EPC

Regarding direct application of Art. 69 EPC, from a systematic perspective Art. 69 EPC is explicitly directed to determining the extent of protection conferred by a European Patent, which is determined by the claims. The only other provision of the EPC dealing with the extent of protection is Art. 123(3) EPC, which is explicitly only to be applied to a granted patent, but not during examination. There seems to be no link, at least no explicit link, in the EPC between determination of the extent of protection addressed by Art. 69 EPC – which is done based on the claims – and assessment of patentability, which is by provision of Art. 52 EPC to be determined for “the invention”, without any mentioning of the claims.

Further, Art. 69 EPC rather deals with the effect of a European Patent and not with requirements that should be fulfilled by a European Patent Application during examination. Therefore, a direct application of Art. 69 EPC and the Protocol in examination proceedings seems to be without immediate legal basis.

It is also debatable whether only parts from the provisions of the EPC can be applied as legal basis, like the referred Question 1 suggests, here Art. 69(1) EPC, second sentence, and Art. 1 of the Protocol. Normally, Article 69 EPC and the Protocol should, like any legal provision, be read as a whole, without picking out specific sentences from it. We understand that Art. 69(1) EPC first sentence has been left out because it restricts the applicability of Art. 69(1) EPC to determining the extent of protection; however by referring to Art. 1 of the Protocol, this restriction has anyway been reintroduced. Again the question arises how the application of Art. 1 of the Protocol, being explicitly limited to determination of the extent of protection, to the assessment of patentability can be justified.

Further, when applying Art. 1 of the Protocol on Interpretation of Art. 69 EPC when assessing patentability, one might be tempted, if not even be required, to also apply Art. 2 of the Protocol, stating that equivalents should be taken into account, which may result in unpredictable and undesired results.

Equivalence is usually not considered during examination proceedings by the EPO, and there is also no fully aligned practice of assessing equivalences throughout the Member States of the EPC. Thus introducing consideration of equivalences during examination



would much likely cause uncertainty for applicants. Particularly when application of Art. 2 of the Protocol would lead to considering equivalents as being literally encompassed by the claims, these would suddenly become relevant for novelty considerations. This kind of broadening claim construction would certainly be a dramatic shift of the EPO approach of determining novelty, and its consequences cannot be fully assessed at this point in time.

Based on the above, we propose that a direct application of Art. 69(1) EPC, second sentence, and the Protocol to the determination of patentability under Articles 52 to 57 EPC is not appropriate.

Should the Enlarged Board nevertheless come to the conclusion that such application is possible and appropriate, we suggest that it also provides explicit guidance on which parts of Art. 69 EPC and the Protocol are to be applied, and particularly which are not, even if this is not explicitly requested by the referring board.

To this end, the Enlarged Board may consider reformulating Question 1, e.g. to:

*Is Article 69 EPC and 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, and if yes, in their entirety or only parts thereof?*

#### B) Application of the principles, or the gist of Art. 69 EPC

Regarding an application of the **principles or gist of Art. 69 EPC** and Art. 1 of the Protocol, it seems that decision G 6/88, as cited by the referring board, follows a similar approach; its conclusion seems to be that the "*matter for which protection is sought*" as defined in Art. 84 EPC at examination should be in accordance with the "*extent of protection*" as defined in Art. 69 EPC at infringement. In other words, the "*matter for which protection is sought*" in Art. 84 EPC should conform, and not be at odds, with the "*extent of protection*" in Art. 69 EPC.

This "accordance" might in our view be achieved by an analogous application of Art. 69 EPC and Art. 1 of the Protocol (wherein it should be clarified which exact parts of these provisions are to be applied), by requiring it for securing legal certainty as a guiding principle, or by applying other provisions of the EPC, which will be further detailed when addressing Question 2 in the following.



### 3.2. Question 2

Regarding 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?*

Our answer to the first part of this question is “yes”, wherein the description and figures not only “may” be consulted when assessing patentability, but in our view rather “shall” be consulted.

This should be done generally and not only when the claims are considered unclear or ambiguous. A claim may be clear as such, when read in isolation, but still have a different scope, or encompass different subject matter, when read together with the description and the drawings. Not taking the description and drawings into account would lead to a higher degree of legal uncertainty as to what the claimed subject matter and scope really is.

The necessity therefore arises, from a practical perspective, and as already mentioned above, from the requirement of legal certainty in that a consistent interpretation of the claims should be ensured in all proceedings dealing with a European Patent, wherein Courts in the member states by default do consult the description and figures to interpret the claims, be it when assessing infringement / extent of protection or validity.

Furthermore, a requirement to consult the description and figures during assessment of patentability also arises directly from the EPC.

As required by Article 52 EPC, European patents shall be granted for “... *inventions [...] provided that they are new, involve an inventive step and are susceptible of industrial application*”. The subsequent Articles 53 to 57 EPC further detail the requirements mentioned in Art. 52 EPC and define exceptions to patentability.

Notably, none of these Articles mentions “claims”, but rather “inventions”, for which the assessment of patentability needs to be performed. Taken in conjunction with Article 83 EPC, stating that “*The European **patent application** shall disclose the invention ...*” (emphasis added) and Art. 97(1) EPC stating that “*If the Examining Division is of the*



*opinion that the **European patent application and the invention to which it relates meet the requirements of this Convention ...***" (emphasis added), this is already an indication that assessment of patentability according to Art. 52 to 57 EPC cannot be restricted to the claims alone but has to involve the entire patent application, including claims, description and figures.

Certainly the EPC foresees a particular role of the claims in this context, given by Art. 84, first sentence, and Rule 43(1) EPC, according to which "*The claims shall define the matter for which protection is sought in terms of the technical features of the invention*". Nevertheless, the description shall, according to Rule 42 (c) EPC, "*disclose **the invention, as claimed**, in such terms that the technical problem [...] and its solution can be understood*" (emphasis added). Thereby it is very much apparent that the claims should not be read in isolation, but for understanding the invention – for which patentability is to be assessed – a consultation of the description is required. When consulting the description, the drawings are included by virtue of Rule 42 (e) EPC.

From this it is apparent that the EPC requires consideration of all parts of an application, claims, description and drawings, in order to understand the invention for which patentability is to be assessed and protection is being sought. As the claims are a decisive part of the application which defines the matter for which protection is sought (Art. 84 EPC), it is appropriate to put an emphasis on these (namely "the invention as claimed" according to Rule 42 (c)). Nevertheless, the other parts must be considered when assessing patentability, despite the primacy of the claims.

Regarding the second part of Question 2, it is also apparent from the cited provisions of the EPC that there are, on the face of it, no restrictions as to the circumstances under which the description and drawings are to be consulted when assessing patentability.

We further observe in this context that it would also not make sense to restrict consultation of the description to cases where claims are unclear or ambiguous. As required by Art. 84 EPC, and set forth in the Office's Guidelines for Examination (F-IV 4.2), the claims must, as far as possible, be clear from the wording of the claims alone. This means that during examination proceedings any unclarity in the claims should be removed before a decision on patentability can take place, whereupon an interpretation of the claims in view of the description would never occur if it was only to be conducted on unclear claims.



Further, in line with the above observations, the national courts and the UPC do use description and drawings for interpretation of the claims, no matter whether they are considered clear, unclear, ambiguous or unambiguous. It is therefore not reasonable to impose any restriction in this regard for examination or opposition proceedings.

Accordingly, this restriction appears to be not appropriate.

As a conclusion, the answer to Question 2 is “yes” and “this [consulting the description and figures] may (or rather: shall) be done generally”.

### 3.3. Question 3

Regarding 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?*

We are of the opinion that, given the above considerations with respect to Questions 1 and 2, definitions or similar information explicitly given in the description shall generally be considered when interpreting the claims for both assessment of patentability and determining infringement resp. scope of protection.

However, we concede that there may be exceptions to this principle. Also based on the considerations under Question 2, as the claims have a particular significance under the EPC, their wording, as deliberately chosen by the applicant, should in cases of doubt have a primacy over information provided in the description.

While we are aware that the Examining Divisions usually require to resolve such inconsistencies by means of amending the wording of the claims or description to bring them into alignment, this may not necessarily be required, and in some proceedings not even possible. For example, in opposition proceedings, the Opposition Division or Board of Appeal has to deal with the patent as granted, and thus has to interpret the claims based on the wording “as is”, even if they consider that there is an inconsistency that has been overlooked or judged differently during examination. The same applies for Court proceedings. Then it appears appropriate to give more weight to the claim wording and disregard inconsistent or contradicting information in the description.





We believe that this would be in line with the principle of Art. 69 EPC and Art. 1 of the Protocol, according to which the extent of protection is a position between the extremes of taking the claims literally or only as a guideline. Also here, contradictions would have to be resolved by finding a position closer to the literal meaning of the claims which have, according to Art. 69 EPC, the principal role.

If one applies this principle to examination proceedings, also here such contradicting information may be disregarded or at least given less weight.

Just as well, an applicant should not have the freedom to entirely redefine a technical term that has an established meaning for the skilled person. This approach, sometimes referred to as “patent as its own dictionary”, might in effect lead to legal uncertainty as a skilled reader may be confused as to the actual subject matter that is protected. Thus, also in such cases the primacy of the claim wording should apply such that a definition given in the description that is not at all compliant with the accepted meaning may be disregarded.

On the other hand, if a claim feature is given an explicit definition in the description (or drawings), this must be assumed to be a deliberate decision by the patentee. Then it should be taken into account at examination by requiring amendments of the claims such that the claims reflect the definition, or that the definition in the description is amended to align with the claim wording, especially if the definition would broaden the scope of protection. Otherwise, third parties would be in a disadvantageous position where they are forced to assess the risk for infringement by interpreting and construing all claims by reading a potentially extensive and elaborate description, even if the claims may be clear to a person skilled in the art when read in isolation. Also, without requiring such amendments and instead relying on the description, applicants may be incited to hide potentially broadening definitions to clear terms in the description, which would also negatively affect third parties.

All in all, it is our opinion that disregarding a definition or similar information in the description should be restricted to exceptional cases, like contradictions that cannot be resolved by mutual interpretation. In such cases also amendments to the description or the claims would be appropriate in order to bring them into alignment, even if we generally think that requiring amendments to the description should also be restricted to such exceptional cases.



#### 4. Concluding remarks

From the above it follows that it is necessary to consider the description and drawings when interpreting the claims for the purpose of assessing patentability, for reasons of legal certainty, to inhibit potential misuse of the patent system, and to maintain the high quality of patents granted by the EPO. In this connection we do strongly support using the principles, or the gist, of Art. 69(1) EPC, second sentence, and Art. 1 of the Protocol, to the interpretation of claims when assessing patentability under Arts. 52 to 57 EPC.

Yours faithfully,

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