

To:

The European Patent Office

Enlarged Board of Appeal in the matter G 1/24 (“Heated aerosol”)

14 November 2024

Enlarged Board of Appeal referral G 1/24 (“Heated aerosol”) **Amicus brief by EFPIA**

The **European Federation of Pharmaceutical Industries and Associations** (EFPIA) represents the biopharmaceutical industry operating in Europe. Through its direct membership of 36 national associations, 39 leading pharmaceutical companies and a growing number of small and medium-sized enterprises (SMEs), EFPIA’s mission is to create a collaborative environment that enables our members to innovate, discover, develop and deliver new therapies and vaccines for people across Europe, as well as contribute to the European economy. A list of EFPIA member companies and organisations can be found here: <https://efpia.eu/about-us/membership/>

It goes without saying that for EFPIA it is crucial that Europe has a balanced patent system to safeguard the very considerable investment that its members make in pharmaceutical research, both in terms of providing strong patent protection for innovations and effective mechanisms for challenging invalid patents. EFPIA recognises and welcomes the central role that the EPO plays in this system, and offers the following comments to explain the views of its members on this referral to the Enlarged Board.

1. Summary

It is appropriate for the EPO to look to the description to properly define the matter for which protection is sought under Article 84.

This approach, however, should not extend to nor affect determination of the extent of protection under Article 69 by national courts and the UPC. Article 69 is generally reserved for a competent Court and should remain generally outside the purview of the EPO, except for the isolated case of EPO having to implement Article 123(3) EPC.

2. Referred 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?
[see points 3.2, 4.2 and 6.1]”*

EFPIA believes that the description and figures should be consulted when determining the subject-matter that is to be considered in the EPO’s patentability assessment (see comments on Q2 below). Nevertheless, it would be legally flawed, and potentially problematic, to use Article 69 EPC as the legal basis for this approach. Therefore, the correct answer to question 1 is “no”.

Article 69 EPC relates to a different type of assessment that is not performed by the EPO

Article 69 EPC is not related to patentability, but instead outlines how the “*extent of protection*” is determined. There is a clear difference between: (i) the invention that an applicant has sought to protect in a patent (application) and (ii) the protective effects conferred by the patent (application) in the Contracting States. This difference was acknowledged by the EBA in G2/12:

“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”¹.

Consistent with this view, the EBA previously rejected the suggestion that there was a connection between the “*protection conferred*” by a claim and the patentability assessment of such a claim. In particular, in G1/98, the EBA referred to:

“the established case law according to which the protection conferred by a process patent is extended to the products obtained directly by the process, even if the products are not patentable per se”².

The EBA’s comments in G2/12 and G1/98 confirm that the “*extent of protection*” in Article 69 EPC is a different concept from the “*invention*” that the EPO is required to assess for patentability. Therefore, it would be legally unsound to extract the second sentence of Article 69 EPC (“*Nevertheless, the description and drawings shall be used to interpret the claims*”), and to apply that requirement to an unrelated context.

This is especially true given that Article 69 EPC is primarily directed to courts in the Contracting States, not the EPO. Indeed, the EPC does not require (or empower) the EPO to assess the scope of protection, beyond one exceptional circumstance. In particular, Article 123(3) EPC (and related Article 138(1)(d) EPC) requires the EPO to ensure that the scope of protection is not broadened after grant in opposition or limitation proceedings. Even in this narrow context, the EPO is not tasked with determining the scope of protection per se, but is instead required to consider whether a post-grant amendment has a broadening impact on the scope of protection. Therefore, Article 69 EPC is clearly a provision that is focussed on an assessment performed by courts in the Contracting States, not the EPO. It would be inappropriate to apply Article 69 EPC to the EPO’s patentability assessment for this reason as well.

There is a strong line of case law that rejects the application of Article 69 EPC to the EPO’s assessment of patentability

As explained above, there is clear legal basis for distinguishing between the “*extent of protection*” and the “*invention*” that the EPO is required to assess for patentability. Therefore, it is unsurprising that “*a strong line of case law has developed [...] that Article 69 EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC should, within the jurisdiction of the [EPO], exclusively be applied in the realm of Article 123(3) EPC that refers to the patent’s scope of protection*”. Thus,

¹ G2/12 point VIII.2.(6)(b) (fourth paragraph) of the reasons.

² G1/98 reasons 4 (fourth sentence).

“[o]f the 100 decisions found to deal with claim interpretation since 2008 [...], a majority of 52 decisions [...] fall into this category”³. Indeed, reasons 3.3.1 and 3.3.2(b) of T439/22 cite 22 decisions from twelve different Boards of Appeal, in which Article 69 EPC was held not to be applicable for assessing patentability⁴. Thus, this jurisprudence covers a wide range of technical areas. Excerpts from three exemplary TBA decisions are provided below:

“Article 69(1) EPC [...] relates only to the scope of protection of the patent, which in turn is only relevant with regard to Article 123(3) EPC and in national infringement proceedings”⁵.

“Article 69 EPC deals with the extent of protection conferred by a European patent. As such it is relevant only when compliance with Article 123(3) EPC or matters of patent infringement are to be examined”⁶.

“The Boards of Appeal have repeatedly pointed out that Article 69(1) EPC concerns only the scope of protection of the patent, which in turn is relevant only in the context of examination in the light of the requirements of Article 123(3) EPC and in infringement proceedings before national courts”⁷.

Therefore, there is “a strong line of case law” that considers Article 69 EPC to be concerned exclusively with the extent of protection, and therefore a provision that should only be used by the EPO in the narrow context of assessing compliance with Article 123(3) EPC.

Contrary to the referring Board’s suggestion in reasons 3.2.1 of T439/22, this “strong line of case law” did not arise from a misunderstanding of G2/88 and G6/88. None of the 22 TBA decisions cited in reasons 3.3.1 and 3.3.2(b) of T439/22 refers to G2/88 or G6/88. Therefore, there is no indication that any of these Boards applied either of these decisions when stating that Article 69 EPC was inapplicable to the assessment of patentability. Indeed, those Boards that explained the legal basis for their position on Article 69 EPC rely on other case law or reasoning. For example, T 169/20 referred simply to the “explicit wording” in Article 69 EPC in reaching the conclusion that “the provisions of Article 69(1) EPC do not apply to the interpretation of the claims for the purpose of assessing patentability”⁸. Therefore, it is wrong to characterize this “strong line of case law” as originating from a misunderstanding of G2/88 and G6/88.

In any event, as explained above, subsequent EBA decisions (e.g. G1/98 and G2/12) have unambiguously distinguished between the requirements for patentability from the effects of a patent (application). These later decisions carry more weight than the remarks in G6/88, since the EBA is permitted to develop its view of the EPC over time.

³ T439/22 reasons 3.2.1.

⁴ Boards 3.2.03 (T978/16), 3.2.04 (T1597/12), 3.2.05 (T1735/19), 3.2.06 (T2601/16, T1292/17, T1705/17, T2344/15, T1267/13, T580/13), 3.2.08 (T467/09), 3.3.03 (T353/18, T295/11, T1374/06), 3.3.04 (T494/09) 3.3.06 (T278/20), 3.4.01 (T843/06), 3.4.02 (T2600/17, T145/14), 3.4.03 (T1593/09, T964/07) and 3.5.03 (T30/17, T1391/15).

⁵ T2684/17 reasons 2.1.4(a) (last sentence), machine translation.

⁶ T2196/15 reasons 1.1 (second sentence).

⁷ T1646/12 reasons 2.1 (second paragraph).

⁸ T169/20 reasons 1.2.3.

If question 1 is answered ‘yes’, then there is a risk that the EPO will start opining on the “extent of protection” conferred by the patent

If a connection were artificially created between Article 69 EPC and the EPO’s assessment of patentability, then there is a risk of unintended consequences. In particular, the EPO might start to opine on the “*extent of protection*” conferred by a European patent, which would increase uncertainty, e.g., with respect to whether a company’s proposed activity is likely to be held to infringe a given patent, an assessment that the EPO is not equipped to make. Such opinions would be especially problematic if they involved an analysis of “*equivalents*” per Article 2 of the Protocol on the Interpretation of Article 69 EPC. This because an assessment of “*equivalents*” would generally require an alleged infringement as a point of reference. However, the EPO does not have that point of reference, and so cannot pre-empt how the “*extent of protection*” would be determined in the context of subsequent infringement proceedings.

Perhaps in tacit acknowledgement of the fact that “*equivalents*” cannot and should not be assessed by the EPO, question 1 refers to the application of “Article 1 of the Protocol” only. However, restricting the question in this way does little to mitigate the risk of the EPO attempting to opine on “*equivalents*” as part of an “*extent of protection*” analysis in the future.

In any event, if the EPO were to provide opinions on the “*extent of protection*”, this would be contrary to the established case law. As correctly noted in T 56/21: “*it is not the task of the EPO as a patent examining authority, but for the national courts (and other authorities) of the Contracting States, which are responsible for patent infringement proceedings, to determine the extent to which protection is to be conferred*”⁹. This view was partly based on some foundational case law from the early years of the EPO. Excerpts from three exemplary TBA decisions are provided below:

*“further determination of how this claim is to be interpreted with regard to definition of the extent of protection conferred in accordance with Article 69 EPC and the relevant Protocol is not a matter for the examining, opposition and appeal bodies of the European Patent Office”*¹⁰.

*“In opposition proceedings, the EPO deals with the scope of protection of a patent only within the framework of Article 123(3) EPC. Moreover, interpretations of the scope of a patent are not the responsibility of the EPO, but of the national courts responsible for patent infringement proceedings in accordance with Articles 64 and 69 EPC. The EPO will, of course, take great care in determining the wording of the allowable claims, since their content determines the scope of protection of the European patent under Article 69(1) EPC and, if necessary, clarifies how terms used in the claims are to be understood; beyond that, however, the EPO does not have to give any additional interpretations as to the future scope of protection of the granted or maintained patent, to which, moreover, no national infringement judge would be bound”*¹¹.

⁹ T56/21 reasons 32 (last sentence).

¹⁰ T175/84 reasons 5.2.

¹¹ T442/91 reasons 3.

“the appellant's intention was to obtain from the Board an opinion with respect to the extent of the protection of claim 1 [...] However, the extent of the protection of a patent is examined by the EPO in the opposition proceedings only within the framework of Article 123(3) EPC [...]. In principle interpretation of the extent of the protection of a patent is not the task of the EPO, but is, according to Articles 64 and 69 EPC, that of the national Courts competent in procedures on infringement cases”¹².

Therefore, the Boards of Appeal have long appreciated the fact that determining the “*extent of protection*” is a matter for the courts in the Contracting States, not the EPO.

This understanding was also clearly held by stakeholders when Article 69 EPC was in draft form. For example, several associations (ICC, COPRICE, CEIF, UNICE, UNEPA and FICPI) submitted a joint suggestion for a “*text to achieve a more uniform interpretation of Article [69]*”, noting that: “*it would be futile to attempt a definition ensuring absolute identical interpretation by the courts of law in all Contracting States*”¹³. Similarly, the Standing Conference of CPCCI filed comments suggesting that “*the expressions used in the three – English, French, German – version of the Draft [of Article 69] 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 [69], they will persist in their previous habits*”¹⁴. Accordingly, the “*extent of protection*” was clearly understood to be a matter for the exclusive consideration of the courts in the Contracting States.

Following stakeholder submissions, the Protocol on the Interpretation of Article 69 EPC was ultimately adopted to regulate the “*extent of protection*” analysis that would be performed by national courts. As explained in T 56/21: “*During the preparatory work for the EPC, interested non-governmental organisations expressed their concern that Article 69(1) EPC 1973 (at that time Article 20 of the draft) gave the national courts too broad a latitude in its interpretation and, consequently, also in determining the extent of protection. The ensuing discussions led to the Protocol on the Interpretation of Article 69 EPC 1973*”¹⁵.

Subsequently, the Protocol on the Interpretation of Article 69 EPC was amended in 2000. The underlying motivation was explained in the Administrative Council’s Basic Proposal for Revision of the EPC. In brief, the Administrative Council was concerned with the divergence in how equivalents and file wrapper estoppel were being treated by the national courts of the Contracting States. The Administrative Council noted:

“In applying these provisions in litigation concerning the infringement of European patents, the national courts of the EPC contracting states have tried since the beginning to develop as harmonised a practice as possible. However, despite some progress, not least due to regular European Patent Judges’ Symposia, case law has failed so far to develop Europe-wide uniform criteria and rules for the interpretation of European patents and the assessment of their extent of protection. [...]

¹² T740/96 reasons 3.3.

¹³ BR/165/72.

¹⁴ M/18, 162, paragraph 7.

¹⁵ T56/21 reasons 23.

In order to strengthen and clarify the extent of protection under Article 69 EPC, and to contribute to a more uniform court practice in Europe, the Protocol on its interpretation should be supplemented by a few rules regarding the significance of equivalents and limiting statements in assessing the extent of protection”¹⁶.

As would be expected from the original purpose of Article 69 EPC, the Basic Proposal does not refer to this provision being applied by the EPO. It is clear that the legislators did not envisage Article 69 EPC being applied to the EPO’s activities (beyond assessing compliance with Article 123(3) EPC), and doing so was certainly not an established EPO practice when the Protocol was revised in 2000.

Finally, if the EBA is minded to answer ‘yes’ to question 1, EFPIA believes that it is important that the EBA confirm that EPO should still continue to refrain from conducting an “*extent of protection*” analysis. In the absence of such confirmation, there is a significant risk of a detrimental impact on legal certainty.

Conclusion

EFPIA believes that the answer to question 1 is ‘no’ because it would be legally unsound to apply a portion of Article 69 EPC (and the Protocol of its Interpretation) to an unrelated context. Indeed, the EBA itself has confirmed that the “*extent of protection*” in Article 69 EPC is a different concept from the “*invention*” that the EPO is required to assess under the requirements for patentability.

Conversely, if question 1 is answered ‘yes’, then there is a risk that the EPO will start opining on the “*extent of protection*” conferred by the patent. Such opinions would also go against well-established case law, and would increase uncertainty, e.g., with respect to whether a company’s activity would be held to infringe a patent in national post-grant proceedings.

3. Referred 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?
[see points 3.3, 4.3 and 6.2]”*

Using the description and figures to interpret the claims would improve legal certainty for patent proprietors and third parties

EFPIA believes that the description and figures should be consulted when the EPO interprets the claims, in order to be consistent with the standard of claim interpretation for national proceedings enshrined in Article 69. This would improve legal certainty for patent proprietors and third parties in national and UPC post-grant proceedings. As pointed out in various decisions of the Technical Boards of Appeal (e.g. T1871/09 reasons 3, T1646/12 reasons 2.1 and T620/08 reasons 3.17), this reflects the general principles of interpretation of texts, which include the fact that a term or a text component can only be interpreted in context.

¹⁶ MR/2/00, 59.

The description and figures should be consulted generally. The referring Board noted in reasons 4.3 that it was aware of no jurisprudence from national courts requiring a claim to be unclear before the description and figures are consulted¹⁷. Nevertheless, if not done generally, this should certainly be done at least as soon as a claim is unclear or ambiguous when read in isolation. The claims, of course, should be clear per se, and this can be achieved during prosecution by the application of Article 84 EPC.

Notwithstanding this, EFPIA recognises that, as expressed in T56/21 reasons 91, “[t]he idea that authorities, courts and the public should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter might be considered to represent an ideal-world situation”. In particular, the understanding of claims by the EPO does not benefit from knowledge of any alleged infringement. For this reason and those expressed in respect of question 1, although Article 69 has an indirect impact on the EPO’s practice because of the need to align with the approach taken by the national courts, the EPO should not determine the extent of protection under Article 69¹⁸.

Rather, interpretation of the claims by the EPO should be done only in the context of Article 84 to define the invention for which the applicant seeks to obtain a granted patent and assess patentability. The connection between Article 84 and patentability lies in the fact that clarity is a prerequisite for a patent to be granted: if the claims are ambiguous or unclear, it may lead to difficulties in determining whether the invention meets the required standards for patentability under Articles 52 to 57 of the EPC. Article 84 therefore plays a critical role in the overall assessment of patentability by ensuring that the invention is adequately defined, allowing for a proper evaluation against the criteria for patentability.

The importance of Article 84 EPC during prosecution

Article 84 is not a ground of opposition. Therefore, it is extremely important that examiners systematically consider the potential interpretation of the claims in light of the description and figures. The quality of the patents issued by the EPO depends on this¹⁹. If necessary, definitions from the description can be included in the claims to satisfy the requirements of Article 84²⁰. Thus,

¹⁷ Using the description and figures to interpret the claims for the purposes of examination is also consistent with the current Guidelines for Examination at the EPO and not linked to Article 69. This is made explicit at Part F – Chapter IV-4.2. Interestingly, in the same part of the Guidelines, we can read that “*Art. 69 and its Protocol do not provide a basis for excluding what is literally covered by the terms of the claims.*”. In other words, even though Article 84 is the basis for interpreting the claim under the EPC, the Guidelines instruct examiners when interpreting the claims to have in mind the impact of the wording of the granted claims when claims will be interpreted by a national court according to Article 69. However, Part E – Chapter XIII-2 warns that the examining division “*does not give any opinion on the extent of protection (Art. 69 and the accompanying Protocol)*”.

¹⁸ The lack of applicability of Article 69 EPC during examination is not inconsistent with a requirement to consult the description when interpreting the claims (see cases cited in T439/22 reasons 3.3.2(b)).

¹⁹ See T1279/04 reasons 3, recently excerpted in T56/21 reasons 93.

²⁰ The Guidelines also explain at Part F – Chapter IV-1 that “[s]ince the extent of the protection conferred by a European patent or application is determined by the claims (interpreted with the help of the description and the drawings), clarity of the claims is of the utmost importance”. This does not correspond to a general requirement for an adaption of the description to the claims, as explained in T56/21 reasons 91.

the requirement of Article 84 EPC serves the aim of ensuring legal certainty. Indeed, this formed part of the reasoning for the inclusion of this article in the EPC: the Sub-Committee of Working Party I considered that “[t]his provision seemed so important – particularly from the point of view of infringement actions”²¹.

This is also clear when considering Article 1, third sentence of the Protocol on the Interpretation of Article 69 EPC, which explains that Article 69 EPC is concerned with combining “a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties”: fair protection for the patent proprietor cannot be completely determined without knowledge of any alleged infringement.

Nevertheless, the EPO can reduce the likelihood of any inconsistency between the interpretation for validity before grant and the interpretation for infringement by the national courts by considering the description and figures when interpreting the claims for assessing validity. The referring board correctly noted in reasons 4.4 that, if the definition of the matter for which protection is sought during examination proceedings of a European patent by the EPO under Article 84 and the determination of the extent of protection during validity and enforcement of a European patent in front of national Courts under Article 69 “are considered two sides of the same coin, it is also of fundamental importance to have a harmonised view on the use of definitions or similar information found in the description²² when construing patent claims and on the limits of such use.” However, this should not equate to putting the description and claims on an equal footing, as warned against in T56/21 reasons 90.

The importance of harmonization has been emphasized by the opening of the UPC. This issue applies equally to the UPC and the national courts, but the application of the EPC by the UPC (including of Article 69 and the Protocol on its interpretation) is likely to set the direction of travel for European national courts within and without the UPC’s jurisdiction. The guidance laid down by the UPC Court of Appeal (CoA) in *Nanostring v 10x Genomics* (UPC CoA 335/2023) of course specifies that “the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim”.

A recent application of the CoA’s guidance by the Munich Local Division (LD) of the UPC illustrates the importance of Article 84 EPC. In *Philips v. Belkin* (UPC_CFI_390/2023), the LD interpreted the claims in light of an embodiment recited in the description (specifically, it found that the claim did not require a “reject” message to be sent)²³. This interpretation was broader than that asserted by the alleged infringer, and resulted in a finding of infringement. Notably, the patent proprietor had asserted a narrower interpretation (that the claim did require a “reject” message to be sent) during prosecution at the EPO²⁴, though said assertion was not determinative for validity.

²¹ BR51/70, point 18.

²² This should also refer to the drawings.

²³ The Munich Local Division also gave guidance as to when an interpretation where an embodiment in the description is not covered by the patent claim could be taken: “*Allerdings darf ein Patentanspruch dann nicht nach Maßgabe einer weiter gefassten Beschreibung interpretiert werden, wenn die Beschreibung im Patentanspruch keinen Niederschlag gefunden hat*” (2.(5.)(f)(bb)).

²⁴ See point 2.(4.) of the LD decision

In this case, it can be conceived that a proper application of Article 84 EPC, taking into account the description, would have led to a broader interpretation of the claims during prosecution than that asserted at that time by the patent proprietor. In such a situation, an examiner might, under Article 84 EPC, require amendment of the claims to clearly reflect their appropriate interpretation in view of the description²⁵. Alternatively, should Article 123(2) EPC allow, an examiner might require amendment of the description such that the patent proprietor's asserted claim interpretation is correct²⁶. This type of situation is addressed in the cases discussed in reasons 3.4.3(f) of the referring decision²⁷ and endorsed in reasons 6.2.3-6.2.5.

Conclusion

EFPIA considers that the Enlarged Board should answer the question in the affirmative, finding that this approach should be applied generally. Further, formulation of this question using “should” rather than “may” in both instances would result in an answer giving more legal certainty.

Referred 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? [see points 3.4, 4.4 and 6.3]”

Since the description and drawings should be consulted when interpreting the claims (as explained in relation to question 2), any definition or similar information on a term used in the claims which is explicitly given in the description should be taken into account.

T1871/19 explains that this interpretation of the claims in view of the description must be done in consideration of the factors in the case in hand:

“Dans quelle mesure, cette particularité intervient dans l'exercice d'interprétation relève du cas d'espèce. À cet égard, certains aspects tels que le but recherché par l'invention et le nombre d'exemples de réalisation sont tout particulièrement pertinents. Il n'en demeure pas moins que les termes choisis dans les revendications sont supposés avoir été choisis pour servir cet objectif de généralisation des modes de réalisation particuliers. En conséquence, dès lors que le titulaire du brevet aura omis, sciemment ou non, de définir certains

²⁵ In a case where that interpretation arises in view of an embodiment in the description (as in the patent in suit in *Philips v. Belkin*), verbatim basis for such an amendment might not be available. However, such an amendment could be made without contravening Article 123(2) EPC because the amendment would reflect what a skilled person would derive directly and unambiguously from the application as filed, in accordance with the gold standard.

²⁶ EFPIA agrees with T56/21 reasons 90 that this does not however establish an “*elementary requirement*” under Article 84 EPC that the extent of protection of a patent can be determined precisely.

²⁷ This cites T2589/11 and T768/08, where amendment was a consequence of an Article 84 EPC objection before grant, and T1279/04, where amendment was a consequence of an attack under Article 54 EPC resulting from a broad interpretation of the claims.

concepts, ou aura accepté de laisser subsister certaines ambiguïtés dans la description du brevet inhérente à la requête considérée, celui-ci sera alors mal fondé à se retrancher derrière une interprétation limitative des termes de la revendication, tout au moins dans la mesure ou l'interprétation générale retenue est techniquement sensée et conforme à l'enseignement général du brevet.”
(reasons 3.4)

For example, it may be appropriate to consider but discard a definition or similar information in the description where the claims explicitly exclude or are necessarily inconsistent with said definition or information, or where a definition in the description would limit the scope of the claims. In such a case, the claims have primacy, because the claims define the subject matter for which protection is sought, in accordance with Article 84 EPC²⁸.

Considering the six apparent lines of case law discussed in the referring decision under reasons 3.4.3, (a), (b) and (c) should not be followed for the reasons expressed in relation to question 2. The lists of case law discussed under reasons 3.4.3 (d), (e) and the first sentence of (f) are consistent with our position.

Conclusion

EFPIA believes that a definition or similar information on a term used in the claims which is explicitly given in the description should not be disregarded when interpreting the claims to assess patentability unless the claims explicitly exclude or are necessarily inconsistent with said definition or information.

Thank you in advance for your time and consideration.

Sincerely,



Michael Swita, Director IP Policy - EFPIA

²⁸ See also the warning referred to above from T56/21 reasons 90, that the claims and description should not be put on equal footing.