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G1/24		FK23180-02-ACT		2024-11-13

**Fresenius Kabi - Amicus Curiae brief relating to case G1/24 "Heated aerosol"**

Dear Members of the Enlarged Board of Appeal,

We appreciate the opportunity to provide comments to the pending referral G1/24.  
Please find our detailed position attached.

Best regards,


**Fresenius Kabi Deutschland GmbH**



ppa. Dr. Corinna Sundermann  
Senior Vice President  
Intellectual Property




i.V. Dr. Sabrina Duschner  
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**Enclosure**

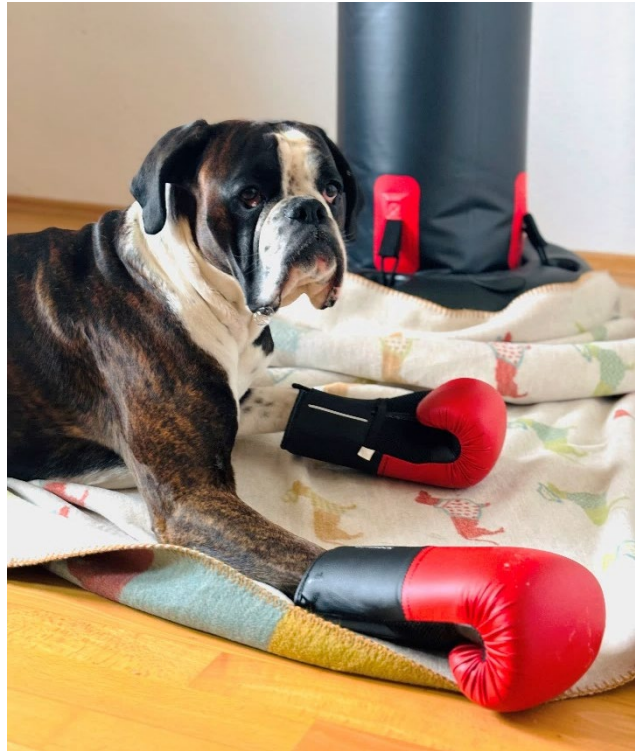
Fresenius Kabi - Amicus Curiae brief relating to case G1/24

## G 1/24 “Heated aerosol” - Amicus Curiae brief by Fresenius Kabi

### Summary

The questions referred to the Enlarged Board of Appeal must be answered:

1. **Yes**
2. **Yes, generally**
3. **Yes, under the proviso that the interpretation of the claims and the description cannot be conciliated**, i.e., where the claims when construed in isolation inevitably contradict the claims when construed in the context of the description, e.g., because the definition provided in the description technically does not make sense, is scientifically incorrect and/or runs contrary to the laws of nature.



*Figure 1 - "Boxer"*

## Detailed discussion

### Referred Questions and proposed answers

The below questions were referred to the Enlarged Board of Appeal:

#### **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]*

#### **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]*

#### **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]*

We propose that these questions be answered as follows:

#### **Question 1**

**Yes.**

#### **Question 2**

**Yes, generally.**

#### **Question 3**

**Yes, under the proviso that the interpretation of the claims and the description cannot be conciliated, i.e., where the claims when construed in isolation inevitably contradict the claims when construed in the context of the description, e.g., because the definition provided in the description technically does not make sense, is scientifically incorrect and/or runs contrary to the laws of nature.**

## Question 1

We fully endorse the considerations of the referring board and agree in that Article 69(1) EPC, second sentence, and Article 1 of the Protocol on the Interpretation of Article 69 EPC shall be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC.

Explicit support for this approach can be found e.g., in **G2/88** and **G6/88**.

In both decisions, **G2/88** and **G6/88**, reasons 2.4 and 2.5 are identical. In reasons 2.4, last paragraph, the Enlarged Board of Appeal stated that

*“the **requirements for drafting and amending claims** in respect of inventions which are the subject of European patent applications and patents, and **the patentability of such inventions**, are all matters which must be decided **upon the basis of the law under the EPC**”.*

Further, according to Reasons 2.5:

*“The **purpose of claims** under the EPC is to **enable the protection conferred by the patent (or patent application) to be determined (Article 69 EPC)**, and thus the rights of the patent owner within the designated Contracting States (Article 64 EPC), **having regard to the patentability requirements of Articles 52 to 57 EPC**” (emphasis added).*

Thus, the Enlarged Board of Appeal already stated in **G2/88** and **G6/88** that the claims of a European patent or patent application are to be interpreted not only to assess the protection conferred by them, but also having regard to the patentability requirements of Article 52 to 57 EPC.

This understanding has been confirmed by the Court of Appeal of the Unified Patent Court, see, UPC\_CoA\_335/2023, Headnote 2 (emphasis added):

*“The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC.*

*[...]*

*These **principles for the interpretation of a patent claim** apply **equally** to the assessment of the **infringement** and the **validity** of a European patent.”*

In addition, in **G6/88**, reasons 3 (emphasis added), it is stated that

*“For the purpose of determining their **technical features**, the claims must be interpreted in accordance with Article 69(1) EPC and its Protocol”*

*“Die Auslegung der Ansprüche zur Bestimmung ihrer **technischen Merkmale** ist gemäß Artikel 69 (1) EPU und dem dazu ergangenen Protokoll vorzunehmen”.*

It is noted that the Enlarged Board of Appeal intentionally did not use the term “*extent of protection*” as used in Article 69 (1) EPC but chose the term “*technical features*” as used in Article 84 EPC together with Rule 43(1) EPC (Rule 29(1) EPC 1973) and thereby referred to patentability requirements during prosecution of a European patent application.

The Enlarged Board of Appeal, thus, clearly applied Article 69 EPC and the protocol on its interpretation for both, assessing patentability and scope of protection.

Further, the same standard on interpretation of the technical features, i.e., the subject matter of a claim must be used, whether examined by the European Patent Office during grant and opposition procedures or by national courts once the European Patent is in force. If technical features were interpreted differently, this would be detrimental to adequate protection for the patent proprietor and to legal certainty – both patent proprietors and third parties.

Accordingly, we propose to answer question 1 with “yes”.

In this context it is important that the examination of a patent application is conducted in awareness of the potential negative consequences - especially for third parties - arising from inconsistencies or incompatibilities between the language used in the claims and the description to define the scope of the claimed invention in a granted patent. Legal uncertainty regarding the scope of a granted claim may add a further layer of protection to the scope of a granted patent by complicating the risk assessments for competitors regarding potential infringement. Legal uncertainty may force competitors to allocate financial reserves to cover the respective risk. This additional layer of protection is not justified by the disclosure of the invention to the public and was not intended by the legislator when devising the *quid-pro-quo* system of granting a temporary monopoly on the commercialization of an invention in return for the disclosure of the invention to the public. Consequently, special attention should be paid during examination to the issue of consistency of definitions of terms in the description and the claim wording to avoid such unnecessary legal uncertainty.

## Question 2

It is our opinion that the description and figures shall be generally consulted when interpreting the claims to assess patentability, i.e., explicitly not only where the person skilled in the art finds a claim unclear or ambiguous when reading it in isolation.

Otherwise, this would lead to situations where definitions in the patent, which for example differ from the usual definition in the technical field (deliberately added by the patent proprietor), would have to be ignored if a claim is not unclear or ambiguous.

If a claim comprises a technical feature which has a specific meaning in the art and is thus not unclear or ambiguous as such when read in isolation and the same technical feature is defined in a different (but still technically meaningful) way in the description, it is our

opinion that the technical feature should be interpreted based on an understanding that conciliates the claims and the description, i.e. such that both definitions are covered.

If, for example, the description comprises a (a still technically meaningful) definition of a technical feature in the claim, which is narrower than the definition common in the technical field but still encompassed by the latter, in our opinion, the technical feature in the claim must be interpreted based on the (broader) definition commonly known in this technical field.

If, however, the description comprises a (still technically meaningful) definition, which is broader than the definition common in the technical field, the technical feature in the claim must be interpreted based on the broader definition in the patent (which has been deliberately added by the applicant/patent proprietor).

Another point of relevance for this question is the harmonisation of the interpretation of technical features during examination and opposition procedures before the EPO and national procedures after grant.

As summarised by the referring Board in **T439/22**, see reasons 4.3, none of the national jurisdictions of the member states of the European Patent Organisation takes the description and figures into account when interpreting a claim only if a claim is unclear or ambiguous. This case law of the national courts of European Patent Organisation member states has been confirmed by the Court of Appeal of the Unified Patent Court (see UPC\_CoA\_335/2023, grounds 4.d)aa)).

Thus, as already discussed with respect to question 1 above, as the interpretation of technical features must be the same no matter if claims are being examined by the European Patent Office during grant and opposition procedures or by national courts after grant, the same standard must also be applied with respect to the question of when the description and the drawings are to be consulted when interpreting a claim: generally and irrespective of whether a claim is unclear or ambiguous.

Accordingly, we propose to answer question 2 with "yes, generally".

### Question 3

It is our opinion that a claim – be it during examination, in opposition/appeal or in the course of infringement proceedings – should be interpreted in light of the description, irrespective of whether the claim wording as such appears to be clear in the first place, and that further, if in doubt, this interpretation should be based on an understanding – both of the claims and the description – that does not render the claims and the description contradictory.

However, there may be rare cases in which it turns out to be impossible to conciliate the interpretation of the claims and the description, i.e., the claims when construed in isolation inevitably contradict the claims when construed in the context of the description. In our

view, under these conditions (only!), a certain definition provided in the description may be disregarded.

Such a situation may occur where a definition of a claim feature explicitly given in the description technically does not make sense, is scientifically incorrect and/or runs contrary to the laws of nature.

1) An example for a definition that technically does not make sense

**Definition according to the description: "the transparent matter is made of stainless steel."**

In a situation like this, where the claim contains the feature "transparent matter" and where the description contains a definition describing the transparent matter as being made of stainless steel, for assessing patentability, the prior art would need to be searched for subject matter involving stainless steel if the claim was interpreted in view of the description and for transparent materials (e.g. plastic or glass) when interpreted in isolation. As stainless steel is not transparent, contradiction is inevitable. Given the fact that the claims define the subject matter for which protection is sought and that the definition provided in the description technically does not make sense, it is our opinion that in such a case the flawed definition provided in the description may be disregarded.

2) An example for a scientifically incorrect definition

**Definition according to the description: The term "milk protein" refers to proteins that have been isolated from plant material.**

In such a case, where the claim contains the feature "milk protein" and the description defines "milk protein" as plant protein, for the assessment of patentability, the prior art would need to be searched for subject matter involving plant proteins if the claim was interpreted in view of the description and for milk protein when interpreted on its own merits. As milk protein is not plant protein and as milk protein as such does not even comprise plant protein, contradiction is inevitable, and either the claims or the description will have to be disregarded. As in the context of example 1 above, it is our opinion that in this situation the incorrect definition provided in the description may be disregarded.

3) An example for a definition running contrary to the laws of nature

**Definition according to the description: Pressure = force times area** [ $p = F \times A$  rather than  $p = F / A$ ]

In such a situation, considering the definition provided in the description, no prior art at all would be pertinent, simply because one would need to search for something that does not exist. Even more it is our opinion that the untenable definition provided in the description may be disregarded in this case.

In rare cases like the ones illustrated above, we believe it is fair to disregard the respective passage of the description, first, because of the "natural" primacy of the claims. The claims define the subject matter for which protection is sought, and accordingly the claims simply

cannot be disregarded when assessing patentability (while a “defective” definition provided in the description can).

Second, the applicant is obliged to exercise due care when drafting the patent application. Legal certainty must not be jeopardized.

Furthermore, an applicant will only suffer incurable negative consequences where the description contains an untenable definition while at the same time lacking suitable supplementary definitions.

In most other cases potential contradictions (being subject to respective objections under Article 84 EPC) may be overcome during examination by amending the claims, adapting the description to bring it into conformity with the claims considered allowable and/or by correcting obvious mistakes (according to Rule 139 EPC) in the first place.

— If during examination (or when introducing new features from the description during opposition/appeal) claims are found unclear, they can be amended such that they make technical sense and do not contradict the description.

While during opposition/appeal the granted claims are not open to clarity objections, they should, according to our opinion, (still) be interpreted in light of the description and – if consequently found unpatentable over the prior art – the patentee may file auxiliary requests addressing the respective objections.

Where the description contains a (technically meaningful) definition rendering the claim narrower than when construed in isolation and the proprietor wishes to restrict the subject matter accordingly, the applicant is free to incorporate this definition into the claim.

Also, where – as in the case underlying the referring decision – the description contains a (still technically meaningful) definition rendering the claim broader than when interpreted in isolation and where, consequently, the claims are considered unpatentable over the pertinent prior art, the patent proprietor may retract to a narrower definition by amending the claim respectively.

Only where such a narrower definition is not available in the description, may the applicant have to bear the negative consequence of having the patent application rejected. However, in our opinion, this must be accepted because (in these – very rare – cases) the proprietor’s negligence must not be remedied to the disadvantage of third parties and at the expense of legal certainty.

Therefore, we propose to answer question 3 in the affirmative:

Yes, a definition or similar information on a term used in the claims which is explicitly given in the description may be disregarded when interpreting the claims to assess patentability – under the proviso that the interpretation of the claims and the description cannot be conciliated, i.e., where the claims when construed in isolation inevitably contradict the claims when construed in the context of the description, e.g., because the definition of a claim feature explicitly given in the description technically does not make sense, is incorrect and/or runs contrary to the laws of nature.



## Conclusion

Therefore, the questions referred to the Enlarged Board of Appeal should be answered:

1. **Yes.**
2. **Yes, generally.**
3. **Yes, under the proviso that the interpretation of the claims and the description cannot be conciliated, i.e., where the claims when construed in isolation inevitably contradict the claims when construed in the context of the description, e.g., because the definition provided in the description technically does not make sense, is scientifically incorrect and/or runs contrary to the laws of nature.**