

The European Patent Office  
Enlarged Board of Appeal  
For the attention of Mr. Nicolas Michaleczek

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4<sup>th</sup> November 0224

## In the matter of G1/24 “Heated aerosol”

This is an *amicus curiae* brief made by the European patent attorneys at Greenwoods Legal LLP.

### 1. BACKGROUND TO G1/24

1.1 The referring decision T0439/22 has referred three questions to the Enlarged Board of Appeal and notes there are diverging strands of case law concerning whether, and how, the description should be taken into account when interpreting the claims.

1.2 These strands could loosely be characterised as:-

- **The Never Strand:** The claims must be construed on their own with no reference to the description whatsoever.
- **The Sometimes Strand:** The claims must be construed on their own unless the result is unclear or ambiguous, in which case the description may be referred to resolve any unclarity or ambiguity.
- **The Always Strand:** The context of the description is essential to properly construing the claims, and one must always read the terms used in a claim in the context of the specification as a whole, including the description and drawings.

All strands assess patentability against the claims, they differ in how one construes the claims.

1.3 In the case referred, the referring Board notes that applying the Never Strand would mean that the EPO would find the claim new, even though the scope of protection might extend to what was not new and inventive.

1.4 The referring Board note the importance of determining the correct method of construing claims.

*4.1.1 The extent of protection conferred by a European patent is determined by the claims (Article 69 EPC), and the claims of an application define the subject-matter of the invention for which protection is sought (Article 84 EPC). Thus, it is the subject-matter of these claims defining the invention that is examined for sufficiency of disclosure, novelty and inventive step under Articles 83, 52, 54 and 56 EPC. As a consequence, it is of utmost importance that the subject-matter examined by the European Patent Office during grant and opposition proceedings be identical to the subject-matter taken as the basis for allowing monopoly protection by the national courts of the member states once the European patent is in force.*

4.1.2 Otherwise, **subject-matter of prior art can be taken as a reason to deny the grant of a European patent even though its scope of protection did not encompass such subject-matter. Or European patents are granted that give protection for subject-matter that was already known in or rendered obvious by the prior art.** Both scenarios would be detrimental to either the well-acquired rights of applicants and patent proprietors or the freedom to operate in the public domain, respectively. Thus, **everything seen as an apple after grant should only be compared with the apples in the state of the art, but everything that might turn out to be both an apple and an orange in the post-grant world should not only be compared to apples but also to oranges during examining and opposition proceedings.**

## 2. ARGUMENT

It may help in addressing this referral to go back to some basic points concerning the European Patent Convention.

2.1 The EPC is helpfully divided in parts, including Part II “Substantive patent law” and Part III “The European patent application”, declaring the function of the provisions in those parts. Part III is not substantive patent law but expresses requirements of the application.

2.2 Article 69(1) EPC (Part II of the EPC - Substantive patent law) states:

*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.*

“Shall” is a strong word: “shall” cannot be ignored.

2.3 Article 78(1) EPC (Part III of the EPC - The European patent application) requires that the application comprises

....  
*(b) a description **of the invention**;*  
*(c) one or more claims;*

2.4 Article 83 EPC requires that

*The European patent **application** shall disclose **the invention** in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.*

2.5 Article 84 EPC addresses the content of the patent application, is formal in nature, and does not mention the “**invention**” at all, only about what the contents should comprise.

*The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.*

2.6 Article 84 thus provides no guidance as to how to interpret claims, only an instruction to the drafter of what needs to be in the claims, and an instruction to the EPO to determine whether the claims meet that purpose. The matter for which protection is sought is the scope of protection that might be granted - i.e. the scope of protection which is provided by Article 69 (1) EPC. One could reasonably call that scope of protection “the invention”.

2.7 In examination the EPO test whether the claims fulfil this purpose. As stated in Case Law of the Boards of Appeal [II-A 1.1. Purpose of claims under Article 84 EPC](#)

*In G 2/88 (OJ 1990, 93, Corr. 469) the Enlarged Board stated that **the primary aim of the wording used in a claim must be to satisfy the requirements under Art. 84 and R. 29(1) EPC 1973 (R. 43(1) EPC), having regard to the particular nature of the invention, and the purpose of the claims. The purpose of claims under the EPC is to enable the protection conferred by the patent or patent application to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC.***

- 2.8 If the protection granted is determined by substantive law in the form of Article 69(1) EPC, compliance with the formal requirements of Article 84 cannot be determined unless an Article 69(1) EPC analysis is undertaken to determine what the invention is. Further, if the protection conferred by the patent is significantly broader than the claims, then the claims do not meet the requirements of Article 84.
- 2.9 This is not a matter of putting “carts before horses”<sup>1</sup>. The claims provide a pointer to the protection sought. Whether that pointer is sufficiently clear to define the protection sought can only be determined by considering what protection would be provided under Article 69(1) EPC. The two horses of Article 84 and Article 69(1) EPC need to work together if the cart is not to end up in a ditch.
- 2.10 If Article 84 is used to determine an acontextual meaning divorced from the disclosure of the invention, then you cannot properly assess patentability of the invention - instead you are assessing patentability of a linguistic construct.
- 2.11 The national courts do not follow such a formalistic approach, and instead construe the claims in the light of the description and drawings to determine the invention: and measure **the invention** against the requirements for patentability. The claims have primacy, but what the claims mean **requires** interpretation.
- 2.12 Indeed, the national courts don't care about Article 84, as Article 138 EPC contains no equivalent provision.
- 2.13 Thus the invention to be assessed is present in the entire application, and it is a role of examination to test:-
- whether the disclosure of the invention is adequate (Article 83 EPC);
  - whether the claims properly define the matter for which protection is sought (Article 84 EPC); and
  - whether **the invention** present in the application (which includes the description and the drawings) meets the requirements of Article 52-57 EPC

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<sup>1</sup> T0056/21 reason 36 “Article 69(1) EPC and the Protocol can also not be considered to provide, by analogy, 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.”

- 2.14 After grant, Article 84 EPC only plays a role in assessing amendments - and even here there may reasonably be doubt as to whether Article 84 should play any part in assessing patentability - Article 84 is after all concerned with clarity of the claims of the patent application, not with patentability of the invention.
- 2.15 Assessment of patentability under Articles 52 to 57 EPC in each case relates to patentability of **the invention** and since the scope of protection of the invention is to be determined by the claims, as interpreted in the light of the description and drawings, assessment of patentability of the invention **must** have recourse to Article 69(1) EPC.
- 2.16 The consequences of **not** applying Article 69(1) EPC to assessment of patentability include:-
- The scope of protection may extend to matter that is not patentable under Articles 52 to 57 EPC.  
The EPC is a law for granting patents for invention (Article 1 EPC), **not for granting patents for non-inventions.**
  - The claims interpreted without reference to the description and drawings may be found unpatentable through overbroad interpretation if the loss of context leads to an unintended interpretation.  
The EPC is a law for granting patents for invention, **not for refusing patents for (properly interpreted) inventions.**
- 2.17 Looking to some of the parties involved in the life of a patent:-
- The drafter of a patent must be taken to be aware of Article 69(1) EPC when drafting claims.
  - The EPO are aware of the potential scope of the invention when searching and look to the content of the description when interpreting claims for search<sup>2</sup>.
  - The reader of a patent must be taken to be aware of Article 69(1) EPC when assessing the scope of an invention.
  - The question of what the EPO do in examination and post-grant is subject of this referral.
  - The national courts apply Article 69(1) EPC to the assessment of patentability.
- 2.18 Without overwhelming policy grounds dictating otherwise, it would be perverse for the EPO not to apply Article 69(1) EPC when considering patentability; particularly as every other party does so, and particularly as the EPO look to the description and drawings when conducting the search.

### 3. ANSWERS TO QUESTIONS

- 3.1 *Is Article 69(1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?*

Yes - both in examination and post-grant - to match the practice of the national courts.

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<sup>2</sup> Article 92 EPC *"The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, **with due regard to the description and any drawings.**"*

3.2 *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?*

They must be consulted, to ensure that the scope of protection provided under Article 69(1) does not extend to unpatentable matter, and that a technically reasonable interpretation is placed on the claims when assessing patentability.

3.3 *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?*

Yes, if the invention, when properly construed, unambiguously (explicitly or implicitly) excludes the definition or similar information<sup>3</sup>.

Otherwise, no.

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<sup>3</sup> As an example, a patent description may define a chair as having a seat supported by three to five legs, but if the claims are to a chair having first, second, third and fourth legs, a three legged chair can be discounted.