



Registry of the Enlarged Board of Appeal  
European Patent Office  
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GERMANY

For the attention of: Mr Nicolas Michaleczek ([EBAmicuscuriae@epo.org](mailto:EBAmicuscuriae@epo.org)).

14 November 2024

Official Ref: G 1/24

Dear Members of the Enlarged Board of Appeal,

***Amicus Curiae Brief - G 1/24***

The IP Federation submits this written statement, in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal, for the assistance of the Enlarged Board in considering referral G 1/24 “Heated Aerosol”.

***Introduction***

The IP Federation represents the views of UK industry in IP policy and practice matters in the UK, Europe and Internationally. Its membership of influential IP intensive companies has wide experience of how IP works in practice to support the growth of technology-driven industry and generate economic benefit. Details of the IP Federation membership are given at the end of this letter. The IP Federation membership invest heavily in IP and are very active users of the European Patent Office (EPO). This submission follows a detailed consideration in the IP Federation of the questions referred in this case, and the views expressed are based on our members’ considerable experience of prosecuting European patent applications and the opposition procedure for European patents, including proceedings before the Boards of Appeal. That said, the members of the Pharma sector indicated by an asterisk (“\*”) in the membership list below are not supportive of this submission and prefer to make a submission individually or via a trade body instead. Additionally, British American Tobacco indicated by an “†” in the membership list below prefers not to make a submission in relation to this matter.

***Summary***

In summary, the IP Federation’s submission is that the answer to question 1) should be **yes**. A uniform approach to patent claim interpretation should be applied for both the protection of a patent (Art. 69 EPC) and in assessing the patentability of an invention under Articles 52 to 57 EPC. Such consistency of claim interpretation is required to ensure sufficient legal certainty for third parties and to maintain the high quality of patents granted by the EPO.

It is the IP Federation’s submission that the answer to question 2) should also be **yes**, the figures and description may be consulted when interpreting claims to assess patentability. It is the IP Federation’s further submission in relation to this question that this may be done **generally**, as the skilled person reads the disclosure of a patent as a whole.

Finally, it is the IP Federation’s submission that, following the answers above to questions 1) and 2), the answer to question 3) should be **no**, a definition or similar

information on a term used in the claims which is explicitly given in the description must be considered when interpreting the claims to assess patentability and infringement. However, as outlined below, ‘consideration’ of such a definition should not provide a patentee with the ability to completely redefine terms entirely contrary to an accepted meaning in the context of the relevant technical field/of the skilled person’s understanding at the filing date.

### ***The Questions***

Under Art. 112(1)(a) EPC, Technical Board of Appeal 3.3.03 has, by interlocutory decision T 0439/22, referred the following questions to the Enlarged Board of Appeal, assigned G 1/24:

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?*
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?*
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?*

The IP Federation respectfully submits the following observations as *amicus curiae*.

### ***Admissibility of the Referral***

1. The IP Federation agrees with the referring Board’s identification of a divergence of case law on these points as summarised at paragraphs 3.2 to 3.4 of the referring decision and considers that it is a point of practical significance, being relevant to the assessment of patentability of an invention under Articles 52 to 57 EPC, in particular for both novelty and inventive step. The referral should therefore be admissible.
2. In short, current case law appears to lead to three possibilities of claim interpretation when assessing patentability:
  - a. On one extreme, terms in claims are interpreted in isolation, with no reference to the description and their wider context;
  - b. On the other extreme, a patent specification can provide new definitions for claim terms even if these already have their own recognised meaning in the context of the relevant field/of the skilled person’s understanding at the filing date; and
  - c. In the middle ground, terms appearing in the claims that are clear are given their normal meaning, with the description playing no part, whilst the description is used to resolve any ambiguity regarding claim terms which might be otherwise be considered unclear.

**Observations - Question 1**

3. There is no debate that Art. 69 EPC and its protocol is to be applied to construe the meaning of the claims of a European patent once it is in force.<sup>1</sup> National courts (including France, Germany and the UK) all construe claims in light of the disclosure of a patent as a whole, including the description and figures, and apply the same construction of the claims to the assessments of both validity and infringement. Question 1) is therefore asking whether a different approach might be taken in construing the meaning of a claim prior to grant by the EPO, when assessing whether the requirements of patentability are met.
4. It is the IP Federation's submission that a uniform approach should be taken to claim interpretation when assessing the scope of claim post-grant and the requirements of patentability pre-grant. This would require the application of the principles found in Art. 69(1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC when assessing patentability under Articles 52 to 57 EPC. It is only logical that the basis for interpretation of the claims and their scope should be the same for infringement and patentability. This is necessary to a) provide sufficient legal certainty to third parties, b) maintain the quality of European patents granted by the EPO and c) prevent divergent results.
5. In relation to point a), parties should not have to perform a different assessment of claim scope to determine validity (and possible infringement) of a European patent post-grant compared to that which the EPO performs during pre-grant examination. Parties should have sufficient confidence that the assessment of key patentability requirements has been performed by the EPO in a manner that reflects the scope of the claims post-grant. In particular, we submit that the pre-grant examination of clarity (Art. 84 EPC) may require more meticulous examination to enforce, where necessary, the introduction of definitions of unclear claim features from the description, thus reducing the possibility of scenarios such as in the referred case arising (See also reason 3.4.3(f) in the referred decision). Otherwise, the unclear claim definition may be so broad as to give rise to an objection under Articles 52 to 57 EPC.
6. Should a different post-grant claim interpretation from pre-grant be necessary, this potentially severely impacts third parties in their ability to obtain an acceptable level of legal certainty in regard to both the assessment of validity and infringement of a patent. For legal certainty, a third party should not be faced with the so-called "Angora cat" scenario referenced in paragraph 6.2.4 of the referred case where, pre-grant, an applicant argues a narrow claim interpretation, but post-grant seeks to assert a broader claim interpretation. Furthermore, this scenario even impacts patentees' own legal certainty as they may obtain a patent that was considered to meet the requirements of patentability by the EPO only to find that it clearly does not meet these requirements when assessed post-grant. Additionally, a patentee could be impacted financially by claiming infringement based on its own erroneous claim interpretation and a defendant could be impacted by the cost of defending the action.
7. Taking the referred case as an example, the referring Board has noted that applying approach a) outlined in paragraph 2 above and interpreting the claims

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<sup>1</sup> Paragraph 4.2 of the referring decision

in isolation, with no reference to the description and their wider context, would lead to the finding that the claims are novel over the prior art. However, applying approach c) and taking into account the description (similarly to national courts) would lead to the claim being found to lack novelty. This is a clear example of the lack of legal certainty outlined above. Furthermore, this demonstrates how performing different assessments pre- and post-grant would undermine the confidence in, and quality of, patents being granted by the EPO, as under approach a) the EPO would find the claim novel but the scope of protection interpreted by a national court would likely extend to subject matter that is part of the state of the art.

8. In addition to the national approaches to claim interpretation outlined in the referring decision that support the application of Art. 69 EPC and its protocol when assessing patentability pre-grant, the IP Federation also wishes to draw attention to case law from the Unified Patent Court (UPC), with the UPC Court of Appeal already having given guidance on Art. 69 EPC and the Protocol on Interpretation in *10x Genomics and Harvard v Nanostring*<sup>2</sup>, later confirmed in *VusionGroup v Hanshow*<sup>3</sup>. As stated in the referring decision "the CoA UPC has taken the first step in this direction by referring to the original case law developed by the Enlarged Board of Appeal..."
9. In particular, the UPC has made it clear that the interpretation of a patent claim for determining both patentability and infringement "...does not depend solely on the strict, literal meaning of the wording used. Rather, 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" (emphasis added). In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties, and these principles apply equally to the assessment of the infringement and the validity of a European patent.
10. Given that, following the transitional period, the UPC will have exclusive jurisdiction over unitary patents and patents designated to UPC participating EU Member States unless these European patents have been opted out, it would be illogical for the EPO to apply a different approach to the claim construction in assessing patentability of an invention to that applied by the UPC in assessing validity. As such, it is the IP Federation's submission that the Enlarged Board should reach a degree of harmonization with the UPC sooner rather than later to prevent undermining parties' confidence in both the EPO and the UPC.

### ***Observations - Question 2***

11. The answer to question 2) should follow similar reasoning and should also be "yes", the figures and description may be consulted when interpreting claims to assess patentability. It is the IP Federation's further submission in relation to this question that this should be done generally, as the skilled person reads the disclosure of a patent as a whole. This is once again reflected in the practice of national courts and the UPC, as outlined above. The alternative of referring to the description and figures only if the claim is unclear or ambiguous would appear to be contrary to Article 1 of the Protocol on the Interpretation of Article 69 EPC.

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<sup>2</sup> UPC\_CoA\_335/2023, Order of 26 February 2024)

<sup>3</sup> UPC\_CoA\_1/2024, Order of 13 May 2024

12. From a practical perspective, there are certain “patent-heavy” industries where the nature of the complex technology involved means that a skilled person might often struggle to determine the meaning of some claim features in isolation, regardless of how carefully the claims were drafted, or where terms are used inconsistently within the same industry. A prime example of where both of these instances may occur is in the telecommunications field. Excluding the possibility of consulting other elements of a patent such as the description and figures would unfairly prejudice those wishing to patent inventions in these fields.
13. Having made these submissions, the IP Federation would also like to make it clear that the consultation of the figures and description is not a substitute for the requirement of clarity under Art. 84 EPC.

### ***Observations - Question 3***

14. Following the affirmative answers to questions 1) and 2) above, it is the IP Federation’s submission that the answer to question 3) should be “no”, a definition or similar information on a term used in the claims which is explicitly given in the description must always be considered when interpreting the claims to assess patentability and infringement. If a claim feature is given an explicit definition in the description (or drawings), this is typically a deliberate decision by the patentee and accordingly, it should be taken into account.
15. This is also similar to national law approaches and the UPC has noted in *Sanofi Aventis v Amgen*<sup>4</sup> and *Regeneron v Amgen*<sup>5</sup> that the description and the drawings may show that the patent specification defines terms independently and, in this respect, may represent a patent’s own lexicon. Even if terms used in the patent deviate from general usage, it may therefore be that ultimately the meaning of the terms resulting from the patent specification is authoritative.
16. However, it is the IP Federation’s submission that whilst the definition or similar information on a term used in the claims which is explicitly given in the description must always be considered when interpreting the claims, this should not give patentee the ability to completely redefine terms entirely contrary to their accepted meaning in the context of the relevant technical field/of the skilled person’s understanding at the filing date, as the claims must still be interpreted through the eyes of the skilled person. For example, T 2221/10 at r.33 decided:

“if a term used in a claim has a clear technical meaning, the description cannot be used to interpret such a term in a different way. In case of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description.”
17. Additionally, we approve the line of case law referenced in r. 3.4.3 (c) of the referred case.

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<sup>4</sup> UPC\_CFI\_1/2023, Order of 16 July 2024

<sup>5</sup> UPC\_CFI\_14/2024, Order of 16 July 2024

18. In short, consideration of a definition or other information in the description should not take primacy over the claim itself, particularly if the claim when properly construed would be entirely contrary to the definition, as this results in a danger to the public for legal certainty if the description must always be checked for illogical results<sup>6</sup>. As noted by the UPC Court of Appeal in *10x Genomics and Harvard v Nanostring*<sup>7</sup>, the patent claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent under Art. 69 EPC in conjunction with the Protocol. As submitted above, during pre-grant examination, the EPO should, when considering a definition or information given in the description, raise objections to any unclear features under Art. 84 EPC (for a lack of clarity or support).

Yours faithfully,

/Andrew Nunn/  
Andrew Nunn  
Chair, Patents Committee, The IP Federation

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<sup>6</sup> For example, if a claim required a “black element” but the description defines “black” as being “black or white”.

<sup>7</sup> UPC\_CoA\_335/2023, Order of 26 February 2024)



## **IP Federation members 2024**

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the UK, Europe and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

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