



15 November 2024

Registry of the
Enlarged Board of Appeal of the
European Patent Office
Munich, Germany
Attn. Mr. Nicolas Michaleczek (via email: EBAamicuscuriae@epo.org).

Re: G 1/24

Dear Members of the Enlarged Board of Appeal,

Thank you for providing an opportunity to submit our views for your consideration.

Amicus curiae Intellectual Property Owners Association (IPO) represents some of the most innovative companies. IPO's almost 200 corporate members develop, manufacture, and sell technology-based products in a wide range of industries. IPO is committed to serving the interests of all intellectual property owners in all industries and all fields of technology.

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Introduction

In the case at hand, the referring board found that when assigning to "gathered sheet" its usual meaning, the subject matter of claim 1 must be regarded as novel in view of the distinguishing feature that the aerosol-forming substrate comprises a gathered sheet of aerosol-forming material.

However, if, as argued by the appellant-opponent, the term "gathered sheet" in claim 1 cannot be read in isolation but should be construed in light of the description (in particular, paragraph [0035]: "As used herein, the term 'gathered' denotes that the sheet of tobacco material is convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod"), the term would have a broader meaning which, however, still makes technical sense and is not in contradiction with but merely encompasses the usual meaning in the art.

The referring board concurred with the appellant that if the term "gathered sheet" is read in light of this definition and the following paragraphs as cited above, the subject matter of claim 1 lacks novelty.

In view thereof, the referring board saw a need to refer the following **questions** to the Enlarged Board of Appeal:

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?

Suggested reply

We suggest that you provide the following answers:

1. **Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC** shall be applied on the interpretation of patent claims by the EPO, not only when assessing whether subject matter has been added (**Article 123(2) EPC**), or whether the scope of the patent has been broadened after grant (**Article 123(3) EPC**), but also when assessing patentability (**Articles 52-57 EPC**).
2. As a result, the description and figures shall be generally consulted when interpreting the claims.
3. A definition or similar information on a term used in the claims that is explicitly given in the description should in general not be disregarded when interpreting the claims so long as the claims themselves remain clear (**Article 84 EPC**).

Our reasons for the above suggestions are as follows.

We believe that at least the first two questions have already been answered by the Enlarged Board of Appeal in decision **G 6/88**, Reason 3: “For the purpose of determining their technical features, the claims must be interpreted in accordance with Article 69(1) EPC and its Protocol.” References to Article 69 EPC + Protocol are also present in Reasons 6 – 7.1 of **G 6/88**. In **G 6/88**, this interpretation of the claims was for the purpose of determining novelty of the claims.

We see no reason for the Enlarged Board of Appeal to deviate from its previous decision **G 6/88**. We do not read the decision **G 2/88** as providing a result that points in the opposite direction. We do not read the referring decision as soliciting an answer opposite to that given in **G 6/88**.

We generally agree with the reasons provided by the referring board in paragraphs 4.1-4.4.4 of its [decision](#). It would be at odds with legal certainty if the EPO maintained the opposed patent in the case at hand, ignoring the broad definition in the description based on the argument that the claim seems to be clear and novel such that there is no need to consult the description, while the UPC would revoke the very same patent without any hesitation because in the light of the broad definition in the description, the claim clearly lacks novelty, as acknowledged by the referring board. The UPC and the EPO are both part of the European patent system, the UPC being based on [Article 149a\(1\)\(a\) EPC](#), and should have consistent approaches to claim interpretation.

If the Enlarged Board of Appeal answers the questions in a way that prevents the description from being used to interpret the claims, it will open up the possibility that an applicant may allow a broad definition in the description to be taken into account for patent infringement purposes, but disregarded when the EPO assesses the validity of the claims during examination and in opposition proceedings. The EPO should not allow the applicant to play such games.

The EPO strives for a high patent quality. A patent that will be immediately revoked by a court for an apparent lack of novelty clearly is of a low quality that the EPO should not want to maintain it.

According to the UPC Court of Appeal in its decision in [Nanostring v 10x Genomics \(UPC_CoA_335/2023, App_576355/2023\)](#), “The interpretation of a patent claim 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.” Note the word “always” (in the [German original](#): “stets”).

We strongly believe that the principle formulated in this UPC Court of Appeal decision is correct and should be applied by the EPO whenever in claim interpretation. This would improve consistency within the European patent system. Case law of various national courts of the EPC Contracting States as cited in paragraphs 4.1-4.4.4 of the [referring board’s decision](#) points in the same direction. That case law cited by the referring board also indicates that the variation between countries in determining the scope of protection that existed prior to the entry into force of the EPC, as mentioned in point 2.1 of G 2/88, has largely fallen away. The present referral presents an opportunity for the Enlarged Board of Appeal to harmonize the EPO approach with the approach of those national courts and the UPC.

According to the established case law of the EPO Boards of Appeal, a patent may be its own dictionary (see e.g. [T 311/93](#), [T 523/00](#), [T 1192/02](#), [T 61/03](#), [T 1321/04](#), [T 620/08](#), [T 2480/11](#), [T 1817/14](#)). Following that principle, it should be necessary to take the entire patent into account when deciding whether the claims are valid. This would harmonize with other important jurisdictions, such as the US, where the same principle is applied at least to some extent.

Regarding the 3rd question, the principle that the description and drawings should be considered when interpreting claims is not undermined by the requirement that claims themselves be clear ([Article 84 EPC](#)). In this regard, the UPC Court of Appeal first considered that “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.”

Finally, a patentee should not be able to rely on limitations of a described embodiment to argue patentability if those limitations are not yet included in the claim.

Thank you for considering our comments.

Sincerely,

A handwritten signature in black ink that reads "Krish Gupta". The signature is written in a cursive, slightly slanted style.

Krish Gupta
IPO President

APPENDIX

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