



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Elia Sugrañes
Secretary General

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Registry of the Enlarged Board of Appeal
European Patent Office
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Attention: Mr. Nicolas Michaleczek

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RE // Case Number G 1/24

Dear Mr. Michaleczek

FICPI is pleased to have the opportunity to submit this Amicus Curia Brief and provide comments with respect to the Referral to the Enlarged Board of Appeal – G1/24 (“heated aerosol”).

Yours sincerely,

Elia Sugrañes
Secretary General

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Amicus Curiae Brief – Referral to the Enlarged Board of Appeal – G 1/24 (“heated aerosol”)

19 November 2024

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including European patent attorneys, national patent attorneys and patent agents in all EPC contracting and extension states.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its members’ experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have the opportunity to submit this Amicus Curia Brief and provide comments with respect to the Referral to the Enlarged Board of Appeal case G1/24 (“Heated aerosol”).

Technical Board of Appeal 3.3.01 has by interlocutory decision T 439/22 referred 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?

FICPI made clear in its Resolution of the Executive Committee, Singapore, 1 to 3 February 2004, “Harmonization not Centralisation”, (EXCO/SG04/RES/003(GB)) that harmonized rules for the drafting of patent specifications, and especially the claims, is a goal to be achieved for the practical benefit to the users and especially individual inventors, universities and SMEs. Furthermore, in its Resolution of the Executive Committee, Seoul, Republic of Korea, 1 to 3 February 2005, “Progress Towards Harmonization” (EXCO/KR05/RES/003(GB)) it was urged that in the process of harmonization clear definitions of novelty and inventive step should be implemented. FICPI also supports the current SPLH initiative.



It follows that FICPI supports an approach to the interpretation of patent claims when assessing the patentability, and the role of the description and drawings in this process, for European patent applications and patents that is as similar as possible to the approach in other jurisdictions.

We enclose an annex in which the approach to claim interpretation in a number of EPC jurisdictions is discussed, as well as referring to early cases of the UPC.

Art. 69 (1) EPC, second sentence, reads as follows:

“Nevertheless, the description and drawings shall be used to interpret the claims.”

Further, Art. 1 of the Protocol on the Interpretation of Article 69 EPC reads as follows:

Article 1

General principles

“**Article 69** should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.”

We note that Art. 69 EPC refers to the protection conferred by a European patent or a **European patent application** (cf. Art. 69 (1) EPC 1st sentence, emphasis added). No limitation is given by the EPC nor the protocol, that Art. 69 does only apply to infringement, but should not be applied in assessment of novelty and inventive step.

We interpret and understand Art. 69 EPC and its Protocol such that Article 69(1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC are to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC.

Decisions G 2/88 and G 6/88 support this view:

G 2/88 states re. Art. 69 EPC and the protocol in No. 4 of the reasons:

4. (...) Determination of the extent of protection has to be carried out in accordance with Article 69(1) EPC and its Protocol, which provides a guide to the manner in which the technical features of the claim are to be interpreted. The Protocol was adopted by the Contracting States as an integral part of



the EPC in order to provide a mechanism for harmonisation of the various national approaches to the drafting and interpretation of claims discussed in paragraph 2.1 above. The central role of the claims under the EPC would clearly be undermined if the protection and consequently the rights conferred within individual designated Contracting States varied widely as a result of purely national traditions of claim interpretation: and the Protocol was added to the EPC as a supplement primarily directed to providing an intermediate method of interpretation of claims of European patents throughout their life, as a compromise between the various national approaches to interpretation and determination of the protection conferred ("... so as to combine a fair protection for the patentee with a reasonable degree of certainty for third parties"). The object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition. (...). (emphasis added)

G 6/88 is consistent with G 2/88 in No. 3 of the reasons:

3. For the purpose of determining their technical features, the claims must be interpreted in accordance with Article 69(1) EPC and its Protocol. The Protocol was adopted by the Contracting States as an integral part of the EPC in order to provide a mechanism for harmonisation of the various national approaches to the drafting and interpretation of claims discussed in paragraph 2.1 above. The central role of the claims under the EPC would clearly be undermined if the protection and consequently the rights conferred within individual designated Contracting States varied widely as a result of purely national traditions of claim interpretation: and the Protocol was added to the EPC as a supplement primarily directed to providing an intermediate method of interpretation of claims of European patents throughout their life, as a compromise between the various national approaches to interpretation and determination of the protection conferred ("... so as to combine a fair protection for the patentee with a reasonable degree of certainty for third parties"). The object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition. (emphasis added)

We agree this approach and we believe that Case Law gives clear guidance how the raised questions should be answered.

G 6/88 explicitly mentions “providing an intermediate method of interpretation of claims of European patents throughout their life”, which we believe includes also the application phase, and hence the examination of the application.

Consequently, we see no room for answering questions 1 and 2 with “NO”.



As questions 1 and 2 are answered with “YES”, we come to the conclusion that that question 3 must be answered with NO as a consequence of the previous answers. We believe that these answers are supported by the approach of the UPC and in the EPC member states discussed in the annex.

Answers to Referred Questions

In view of the discussion above, we come to the following conclusions:

Question 1:

FICPI is of the opinion that QUESTION 1 should be answered with YES.

Question 2:

FICPI is of the opinion that QUESTION 2 should be answered with YES.

Question 3:

FICPI is of the opinion that QUESTION 3 should be answered with NO.



IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Peru, Romania, ~~Russia~~^{*}, Singapore, South Korea, Spain, Turkey and the United States of America, a provisional national section in Poland and individual members in a further 41 countries and regions.

* Membership of the Russian Section in FICPI was suspended on 9 March 2022 by Resolution EXCO/EB22/RES/001 of FICPI's Executive Committee in response to Russia's invasion of Ukraine

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ANNEX to the AMICUS CURIAE provided by FICPI

Legal situation at the UPC

Due to Art. 24 UPC, UPC law is based on the EPC (amongst other things). This includes Art. 69 EPC, and the Protocol on the Interpretation of Art. 69 EPC (which is explicitly part of the EPC due to Art. 164 EPC). Art. 69(1) EPC and the Protocol require that when determining “*the extent of the protection conferred by a European patent or a European patent application*”, the description and drawings are used to interpret the claims.

UPC Court of Appeal decisions have confirmed that these principles of claim interpretation apply to both infringement and patentability (i.e. validity). In other words, the fact that Art. 69(1) EPC and the Protocol refer to “extent of protection” does not mean that the principles of claim interpretation they define apply to infringement only, but also to validity/patentability:

vii. These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent. This follows from the function of the patent claims, which under the European Patent Convention serve to define the scope of protection of the patent under Art. 69 EPC and thus the rights of the patent proprietor in the designated Contracting States under Art. 64 EPC, taking into account the conditions for patentability under Art. 52 to 57 EPC. VusionGroup v. Hanshow, UPC_CoA_1/2024, Court of Appeal 13 May 2024, para. 26; confirming NanoString v 10x Genomics, UPC_CoA_335/2023, Court of Appeal, 11 March 2024, para. 4aa, see also headnote 2.

A later Court of First Instance, Central Division, decision stated that:

When interpreting a patent claim, the person skilled in the art does not apply a philological understanding, but determines the technical meaning of the terms used with the aid of the description and the drawings.

and

The patent description may represent a patent’s own lexicon.

Sanofi v. Amgen, UPC_1/2023, Court of First Instance, 16 July 2024, headnote 1.

This decision was on revocation, so concerned patentability and not infringement.

In both decisions, the claims are construed in the light of the technical problem allegedly solved and refer frequently to the description to identify the technical effect.



Legal situation in EPC jurisdictions

AUSTRIA

The harmonisation of the Austrian Patent Act (APA) with the EPC which was performed by the APA Amendment 1984 (the "Harmonisation Amendment") which introduced new Sect. 22a into the APA: "Sec. 22a. The scope of protection of the patent and the laid-open patent application (Sect. 101, 2nd para) shall be defined by the contents of the claims. Nevertheless, the description and the drawings shall be considered when interpreting the claims. In doing so, the Protocol on the Interpretation of Article 69 of the European Patent Convention (Fed. Law Gaz. No. 350/1979) in its individually applicable version shall be applied mutatis mutandis."

The current version of Sect. 22a APA (after the amendment necessary due to EPC2000) reads: "Sec. 22a. (1) The scope of protection of the published patent application and of the patent shall be defined by the contents of the claims. Nevertheless, the description and the drawings shall be considered when interpreting the claims. In doing so, the Protocol on the Interpretation of Article 69 of the European Patent Convention shall be applied mutatis mutandis.

(2) For the period until the grant of the patent the scope of protection of the application shall be determined by the contents of the last filed claims, which are contained in the publication according to Sec. 101. However the patent determines in its granted version retroactive the scope of protection of the application."

The APA Amendment 1984 had a significant influence on the claim interpretation, both pre-grant (in examination proceedings) and post grant (in infringement proceedings and proceedings for declaratory judgement):

Before the APA Amendment 1984

In the practice before the APA Amendment 1984, the claims were regarded as the only and exclusive basis for determining the scope of protection of a patent. The specification and the figures were only consulted, if the claims were not - by themselves - sufficiently clear and unambiguous.

This was already clearly stated in very early decisions (the APA was established 1899) by the Patent Court and by the Supreme Court as well as by the Nullity Division of the Austrian Patent Office (APO), by the Boards of Appeal of the APO (responsible for hearing appeals to the rejection of patent applications) and even by the Austrian Administrative Court (PC of 20 November 1906, SC of 7 February 1910, ND of 15 February 1902, BA of 18 January 1910, AAC of 8 February 1966, and many more published decisions).

The specification (and drawing figures) was therefore only allowed to assist in interpreting the claims, if there were clear and significant doubts left after the reading of the claims.

The applicability of this principle was established case law in Austria taken by the highest instances, both for the examination proceedings before grant as well as in the proceedings after grant.



After the APA Amendment 1984

This situation significantly changed after the APA Amendment 1984. The claims remained the essential starting point for determining the scope of the patent, however, the courts made clear that the specification (including eventually any drawing figures) had to be taken into consideration when interpreting the claims.

This was - as before the APA Amendment 1984 - not only regarded as essential in infringement proceedings after grant but also during examination proceedings, because of the requirement for legal certainty of the patent proprietor as well as the public that the wording of the claims to be granted limits the scope of protection and that the scope of protection does not first (and only) have to be determined by interpretation of the specification (see e.g. the number of decisions quoted under the main commentary of the APA ("Stadler/Koller, PatG (2019)", Sect. 22a, Nr. 41: OPM 12.5.2004, Op 1/04, PBI 2004, 136; OPM 14.1.2004, OP 2/03, PBI 2004, 112; OGH 21.10.2003, 4Ob178/03k, Amlodipin; OPM 9.11.1994, Op 1/94, PBI 1996, 11).

This change in claim interpretation both, for the examination proceedings before grant as well as in the proceedings after grant were only due to the EPC harmonization wherein Art. 69 EPC and its Protocol were introduced in the APA.

FINLAND

§39 Finnish Patent Act states that "The scope of protection is determined by the claims. The specification may be used for understanding the claims".

There is a quite recent decision of the Supreme Administrative Court (KHO:2020:115) which confirms this. On the other hand, the Guidelines for Examination at the Finnish Patent and Registration Office explain the meaning so that the description also serves as an aid in interpreting potentially ambiguous expressions in patent claims or in interpreting expressions that are clear but that differ in meaning from normal usage. Thus, during the examination the description is considered when interpreting the claims.

FRANCE

Article L. 613-2 first two sentences of the French Intellectual Property code read as follows: "*The extent of protection conferred by the patent is determined by the claims. However, the description and drawings are used to interpret the claims.*" Also, the INPI (*Institut National de la Propriété Industrielle* – French Patent and Trademark Office) Guidelines for Examination mention in the introduction of Chapter IV: "*Since the content of the claims determines the extent of protection conferred, it is of the utmost importance that they are clear. However, the claims are not considered in isolation and should not be construed in a strictly literal sense. The description and drawings are used to interpret them.*"

The *Cour de Cassation*, the highest French Court in civil proceedings, has issued decisions in relation with this matter, notably, 253 Cass. Com ; July 1, 2003 Bull civ. IV. n. 112 p.124 « *by relying on the description of the invention to carry out the necessary interpretation of the patent claims, the*



judgment made an exact application » of articles L. 612-6 and L. 613-2, and also more recently Cass. Com ; November 23, 2010, No. 09-15.668 « under the terms of Article 69 of the Munich Convention of October 5, 1973, the extent of the protection conferred by the European patent or by the European patent application is determined by the claims, the description and the drawings used to interpret the claims; that under Article 1 of the interpretative protocol to said Article 69, this text must be interpreted as defining a position which ensures both equitable protection for the patent holder and a reasonable degree of legal certainty for third parties”.

Thus, it is believed that, according to French Patent Law and French Patent Practice, the description and figures may be consulted when interpreting the claims in order to assess patentability.

GERMANY

In the practice of the German Federal Court of Justice (Bundesgerichtshof, BGH), the significance of the description in a patent application when assessing the patentability of claims is a very important aspect that is regularly emphasized. The relevant case law of the BGH includes several decisions that establish fundamental principles regarding the interpretation of patent claims and the role of the description. Thereby, the same principle is applied to German and European Patents validated in Germany since § 14 PatG is literally equivalent to Art. 69 (1) EPC.

In general, it is a principle of the BGH to determine the scope of protection by interpreting the patent claim in view of the **true character of an invention**.

Therefore, the BGH has clarified that patent claims must be interpreted in light of the description and the drawings. This means that the description and drawings accompanying the patent application must be used to interpret the content of the claims. The BGH has emphasized in several rulings that the content of the description must be considered to determine the **technical substance** and scope of the claims. This approach ensures that the claims are not viewed in isolation but are understood in the **context of the entire disclosure** of the application.

In the following, key passages of decisions representing the BGHs view on claim interpretation are shown.

In the decision X ZB 13/06 (Momentanpol II; opposition) the following is clarified:

„Zwar teilen die Anmeldungsunterlagen nicht den Rechtsnormcharakter (vgl. BGHZ 164, 261 - Seitenspiegel; 172, 120 - Kettenradanordnung) des erteilten Schutzrechts. In ihnen offenbart sich jedoch die technische Lehre, die zur Schutzrechtserteilung angemeldet wird und unter Schutz gestellt werden soll. Welchen Inhalt sie hat, kann sachgerecht nur unter Anwendung der für die Auslegung des erteilten

*“It is true that the **application documents** do not share the legal standard character (see BGHZ 164, 261 - Seitenspiegel; 172, 120 - Kettenradanordnung) of the granted property right. However, they **reveal the technical teaching which is applied for the grant of the IP right and which is to be protected**. Its content **can only be properly determined** by applying the objective standards applicable to the interpretation of the granted patent (see*

Patents geltenden objektiven Maßstäbe (vgl. Melullis, FS für Ullmann, S. 503, 505) erfolgen“.	Melullis, FS für Ullmann, pp. 503, 505)“. (Machine Translation)
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In the decision X ZR 43/01 (Kunststoffrohrteil; infringement) the BGH elaborates with respect to Art. 69 EPC the following:

<p>„Nach dieser Vorschrift wird der Schutzbereich des Patents durch den Inhalt der Patentansprüche bestimmt, zu deren Auslegung die Beschreibung und die Zeichnungen heranzuziehen sind. Nach den Grundsätzen, die der erkennende Senat hierzu entwickelt hat, dient die Auslegung der Patentansprüche nicht nur der Behebung etwaiger Unklarheiten, sondern auch zur Erläuterung der darin verwendeten technischen Begriffe sowie zur Klärung der Bedeutung und der Tragweite der dort beschriebenen Erfindung (BGHZ 98, 12, 18 f. - Formstein; 105, 1, 10 - Ionenanalyse; 125, 303, 309 f. - Zerlegvorrichtung für Baumstämme; Sen. Ur. v. 5.5.1992 - X ZR 9/91, GRUR 1992, 594, 596 - mechanische Betätigungsvorrichtung). Abzustellen ist dabei auf die Sicht des Fachmanns, von dessen Verständnis bereits die Bestimmung des Inhalts der Patentansprüche einschließlich der dort verwendeten Begriffe abhängt und das auch bei der Feststellung des über den Wortlaut hinausgehenden Umfangs des von den Patentansprüchen ausgehenden Schutzes maßgebend ist“.</p>	<p>“According to this provision, the scope of protection of the patent is determined by the content of the patent claims, for the interpretation of which the description and the drawings are to be consulted. According to the principles developed by the recognizing Senate in this respect, the interpretation of the patent claims serves not only to eliminate any ambiguities, but also to explain the technical terms used therein and to clarify the meaning and scope of the invention described therein (BGHZ 98, 12, 18 f. - Formstein; 105, 1, 10 - Ionenanalyse; 125, 303, 309 f. - Zerlegvorrichtung für Baumstämme; Sen. - Cutting device for tree trunks; Sen. Ur. v. 5.5.1992 - X ZR 9/91, GRUR 1992, 594, 596 - mechanical operating device). The point of view of the person skilled in the art is to be taken into account, on whose understanding the determination of the content of the patent claims including the terms used therein already depends and which is also decisive in determining the scope of the protection conferred by the patent claims going beyond the wording“. (Machine Translation)</p>
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Following the principle of the true character of the invention, the interpretation of the claim by the skilled person should be based on the skilled persons **natural understanding of the claim language**, but **weighted by the disclosure of the invention** as a whole. Particularly, in the decision on validity X-ZR 101-13 (Polymerschäum; validity) the BGH elaborates the following.

<p>„Der Sinngehalt eines Merkmals ist mit Blick darauf zu ermitteln, was mit dem Merkmal aus der Sicht des Fachmanns im Hinblick auf die Erfindung erreicht werden soll. Dabei können der allgemeine wie auch der übliche fachliche Sprachgebrauch Anhaltspunkte für das Verständnis des Fachmanns geben. Mit Rücksicht darauf, dass Begriffe in einer Patentbeschreibung abweichend vom allgemeinen Sprachgebrauch benutzt werden können, ist letztlich aber der sich aus dem Gesamtzusammenhang der Patentschrift</p>	<p>“The meaning of a feature is to be determined with a view to what the feature is intended to achieve with regard to the invention from the point of view of the person skilled in the art. In this context, the general as well as the usual technical usage can provide clues for the understanding of the person skilled in the art. In view of the fact that terms in a patent description can be used in a way that differs from common usage, the content of the term resulting from the overall context of the patent specification is ultimately decisive. The</p>
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ergebende Begriffsinhalt maßgeblich. Für einen Rückgriff auf den allgemeinen Sprachgebrauch ist umso weniger Raum, je mehr der Inhalt der Patentschrift auf ein abweichendes Verständnis hindeutet (BGH, Urteil vom 2. März 1999 - X ZR 85/96, GRUR 1999, 909, 911 f. - Spannschrabe). Soweit es die Heranziehung der Beschreibung in ihrer Gesamtheit für die Anspruchsauslegung betrifft, ist grundsätzlich ein Verständnis des Anspruchs angezeigt, das im Einklang mit den Erläuterungen in der Beschreibung insgesamt steht. Nur wenn und soweit sich daraus ein Verständnis des Anspruchs ergeben würde, das eindeutig nicht dem entsprechen kann, was unter Schutz gestellt werden soll, ist der Schluss gerechtfertigt, dass aus Teilen der Beschreibung keine Schlussfolgerungen in Bezug auf den geschützten Gegenstand gezogen werden dürfen. Eine Auslegung des Patentanspruchs, die zur Folge hätte, dass keines der in der Patentschrift geschilderten Ausführungsbeispiele vom Gegenstand des Patents erfasst würde, kommt nur dann in Betracht, wenn andere Auslegungsmöglichkeiten, die zumindest zur Einbeziehung eines Teils der Ausführungsbeispiele führen, zwingend ausscheiden oder wenn sich aus dem Patentanspruch hinreichend deutliche Anhaltspunkte dafür entnehmen lassen, dass tatsächlich etwas beansprucht wird, das so weitgehend von der Beschreibung abweicht (BGH, Urteil vom 14. Oktober 2014 - X ZR 35/11, GRUR 2015, 159 Rn. 26 - Zugriffsrechte)“.

*more the content of the patent specification indicates a deviating understanding, the less room there is for recourse to common usage (BGH, judgment of March 2, 1999 - X ZR 85/96, GRUR 1999, 909, 911 f. - Spannschrabe). As far as the use of the description in its entirety for the interpretation of the claim is concerned, an understanding of the claim that is **consistent with the explanations in the description** as a whole is generally appropriate. Only if and to the extent that this would result in an understanding of the claim that clearly cannot correspond to what is to be protected is the conclusion justified that no conclusions may be drawn from parts of the description with regard to the protected subject-matter. An interpretation of the patent claim which would have the consequence that none of the embodiments described in the patent specification would be covered by the subject matter of the patent can only be considered if other possible interpretations leading to the inclusion of at least some of the embodiments are necessarily ruled out or if sufficiently clear indications can be inferred from the patent claim that something is actually claimed which deviates so widely from the description (BGH, judgment of 14 October 2014 - X ZR 35/11 - X ZR 35/11). October 2014 - X ZR 35/11, GRUR 2015, 159 para. 26 - Zugriffsrechte)“.*
(Machine Translation)

The principle discussed in the above-mentioned decision (Polymerschaum) is also repeatedly implemented by the German Patent Court (Bundespatentgericht, BPatG) in regards of patentability (for example decision 9 W (pat) 14/20 of BPatG).

As can be seen, the understanding of the disclosure of the German jurisprudence is essentially governed by the **technical understanding** of the teaching of the application/patent documents itself. It can be summarized that the German jurisprudence provides a **heavy weight to the true will of the inventor(s)** when assessing the claim language.

With the “Formstein” decision, it was also clarified that in questions of equivalence the scope of protection of a claim cannot be interpreted such that subject-matter will be covered by the claim under the doctrine of equivalence, where such subject-matter would be no invention with respect to the prior art (e.g. because it is already public domain and there for “free prior art”).



ITALY

Two decisions of the Corte di Cassazione (the Italian Supreme Court) are considered most relevant to the raised questions.

There is no discussion as to whether to apply the interpretation of the claims provided in Art. 52.2 CPI (Italian Intellectual Property Code), whose content corresponds to that of Art. 69 EPC, to the assessment of the validity of the claims. The discussion is how to apply it.

Decision No. 9248 (of 05.03.2024) explains clearly that the scope of protection is defined by the claims, which however are to be interpreted in view of the description and the drawings (see for example lines 23-28 of page 6). Please note that it directly cites decision 335/2023 of the Court of Appeal of the UPC (also enclosed), which at the very top of page 25 indicates the interpretation applies “equally to the assessment of the infringement and the validity of a European patent”.

Decision No. 9248 does not cite explicitly which ground of invalidity it addresses. However, it seems to relate to insufficiency of disclosure (lines 4-7 of page 3).

In decision No. 22079 (of 04.09.2019) the Supreme Court held that the second instance court exceeded (lines 2-7, page 11) in applying the principles of Art. 52.2 CPI in the assessment of novelty and inventive step (lines 18-20, page 3). However, the Court has explicitly indicated that interpretation of the claims has to be carried out using the indications of such Art. 52.2 CPI (for example lines 3-11 of page 8).

Switzerland

As Swiss national patent applications are not examined for novelty and presence of inventive step during the grant procedure (Art. 59(4) of the [Federal Act on Patents for Invention](#) [PatA]), examination of patentability in Switzerland is solely a matter of jurisdiction of the competent courts applied to granted patents¹.

Art. 69(1) EPC and the Protocol on its Interpretation align with the national Swiss patent law and are binding for all patents taking effect in Switzerland/Liechtenstein².

¹ The Federal Patent Court [Bundespatentgericht, BPatGer] is the court of first instance, the decisions of which can be appealed at the Federal Supreme Court [Bundesgericht, BGer] being the highest judicial authority in Switzerland.

² Art. 51(2) PatA (“The claims of the patent shall determine the scope of protection conferred by the patent”) and Art. 51(3) PatA (“The description and drawings must be used to interpret the patent claims”) reflect Art. 69(1) EPC, 1st and 2nd sentence, respectively; BGer, decision of October 31, 1990, E. 4c - “Rohrschelle” in: Schweizerische Mitteilungen über Immaterialgüterrecht [SMI 1992](#), S. 287 ff.

A claim's meaning is construed as it is understood by a person skilled in the art, **both in infringement tests and in validity tests**, cf. the decision of the Federal Supreme Court, [BGE 132 III 83](#), E. 3.4 – "Dispersionsdichtmasse", emphasis added:

<p>3.4 Die in den Patentansprüchen umschriebenen technischen Anleitungen sind so auszulegen, wie der Fachmann sie versteht (BGE 122 III 81 E. 4a S. 83; BGE 107 II 366 E. 2 S. 369, je mit Hinweisen; BLUMER, in: Bertschinger/Münch/Geiser [Hrsg.], Schweizerisches und europäisches Patentrecht, Basel 2002, Rz. 14.29 ff. und 14.35; SCHAREN, in: Benkard [Hrsg.], Europäisches Patentübereinkommen, München 2002, N. 6 ff. zu Art. 69 EPÜ; H.P. WALTER, Zwischen Skylla und Charybdis - zur Auslegung der Patentansprüche nach Art. 69 EPÜ, GRUR 1993 S. 351). Dies gilt vornehmlich für die Beurteilung des Schutzzumfangs, in gleicher Weise aber auch etwa für die Neuheitsprüfung (A. TROLLER, Immaterialgüterrecht, Bd. I, 3. Aufl., Basel 1983, S. 480/483; BLUMER, a.a.O., Rz. 14.15 ff.). [...]</p>	<p>3.4 The technical instructions described in the patent claims are to be interpreted as understood by a person skilled in the art (BGE 122 III 81 E. 4a p. 83; BGE 107 II 366 E. 2 p. 369, each with references; BLUMER, in: Bertschinger/Münch/Geiser [eds.], Schweizerisches und europäisches Patentrecht, Basel 2002, recital 14.29 ff. and 14.35; SCHAREN, in: Benkard [ed.], Europäisches Patentübereinkommen, Munich 2002, N. 6 ff. on Art. 69 EPC; H.P. WALTER, Zwischen Skylla und Charybdis - zur Auslegung der Patentansprüche nach Art. 69 EPÜ, GRUR 1993 p. 351). This applies primarily to the assessment of the scope of protection, but in the same way also to the novelty test (A. TROLLER, Immaterialgüterrecht, vol. I, 3rd ed., Basel 1983, p. 480/483; BLUMER, loc. cit., recital 14.15 et seq.). [...]</p> <p>(translated by Deepl.com)</p>
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In fact, in the decision [O2013 008](#) of August 25, 2015, E. 4.2 – "elektrostatische Pulversprühpistole", the Federal Patent Court held that a claim should "always" be given its "broadest interpretation". In the later decision [O2016 009](#) of December 18, 2018, E. 25 – "Durchflussmessfühler", the Federal Patent Court provided more specific explanations with regard to the "broadest interpretation", **tying in the description and drawings for interpreting the claims**. Also, the court emphasized the **functional** interpretation of a claim with regard to a claim feature's intended purpose within the context of the invention (emphasis added):

<p>25. Patentansprüche sind aus der Sicht des massgebenden Fachmanns im Lichte der Beschreibung und der Zeichnungen auszulegen (Art. 51 Abs. 3 PatG). Das allgemeine Fachwissen ist als sogenannter liquider Stand der Technik ebenfalls Auslegungsmittel. Definiert die Patentschrift einen Begriff nicht</p>	<p>25 Patent claims must be interpreted from the point of view of the person skilled in the art in the light of the description and the drawings (Art. 51 para. 3 PatA). General knowledge in the art is also a means of interpretation as so-called liquid prior art. If the patent specification does not define a term differently, the usual</p>
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abweichend, so ist vom üblichen Verständnis im betreffenden technischen Gebiet auszugehen.

*Patentansprüche sind **funktional auszulegen**, d.h. ein Merkmal soll so verstanden werden, dass es den vorgesehenen Zweck erfüllen kann. Der Anspruch soll so gelesen werden, dass die im Patent genannten Ausführungsbeispiele wortsinngemäß erfasst werden; andererseits ist der Anspruchswortlaut nicht auf die Ausführungsbeispiele einzuschränken, wenn er weitere Ausführungsformen erfasst. Wenn in der Rechtsprechung von einer „**breitesten Auslegung**“ von Anspruchsmerkmalen gesprochen wird, so **muss das derart verstandene Merkmal immer in der Lage sein, seinen Zweck im Rahmen der Erfindung zu erfüllen**. D.h. der Anspruch ist grundsätzlich nicht unter seinem Wortlaut auszulegen, aber auch nicht so, dass Ausführungsformen erfasst werden, die die erfindungsgemässe Wirkung nicht erzielen.*

understanding in the relevant technical field is to be assumed.

*Patent claims are to be **interpreted functionally**, i.e. a feature is to be understood in such a way that it can fulfill the intended purpose. The claim should be read in such a way that the examples of embodiments mentioned in the patent are covered by the wording; on the other hand, the wording of the claim should not be restricted to the examples of embodiments if it covers further embodiments.*

When case law speaks of a “broadest interpretation” of claim features, the feature understood in this way must always be capable of fulfilling its purpose within the context of the invention. In other words, the claim is, in principle, not to be interpreted under the aspect of its wording, but also not in such a way that embodiments are covered which do not achieve the effect according to the invention.

(translated by Deepl.com)

The above court ruling also stresses a non-divergent use of terms by the patent specification in order to rely on the common understanding in the relevant technical field as a means of claim interpretation. Indeed, the usual terminology in the art or the terminology in a citation must not be used indiscriminately (BGer, decision [4A 541/2013](#) of June 2, 2014, E. 4.2.2 – “Fugenband”). In claim interpretation, the description and the drawings take precedence over general knowledge in the art.

A patent proprietor bears the risk of incorrect, incomplete or contradictory definitions such that in case of doubt, the interpretation of a claim will be to the disadvantage of the patent proprietor – by analogy to the interpretation of a contract, which in case of doubt is to the disadvantage of its editor (BGer, decision of October 31, 1990, E. 4c – “Rohrschelle” in: Schweizerische Mitteilungen über Immaterialgüterrecht [SMI 1992](#), S. 287 ff.; [BGE 122 III 81](#), E. 4a – “Belegen nichttextiler Unterlagen”; [BGE 107 II 366](#), E. 2 – “Liegemöbel-Gestell”).

United Kingdom



Section 125(1) of the UK Patent Act sets out that the invention of a patent or application is that specified in a claim as interpreted by the description and any drawings containing in the specification, and the extent of protection shall be determined accordingly. Section 125(3) goes on to confirm that the Protocol on the Interpretation of Article 69 EPC applies to section 125(1) and Article 69 EPC together with the Protocol represents the true source of law on construction (*Schutz v Werit* [2011] EWCA Civ 303). There is no equivalent provision that expressly states how the scope of a claim should be determined for the purposes of assessing validity.

In the past, the UK courts have recognised the need for a uniform construction of the invention when considering both infringement and validity, and have held that a patent may not be granted which would enable the patentee to stop what another trader had been doing before (*Merrell Dow v Norton* [1996] RPC 76). The UK courts have recently changed their approach to considering whether variants of the claimed features infringe a patent (*Actavis v Eli Lilly* [2017] UKSC 48) and there have been no subsequent cases expressly confirming that an identical approach must also be taken when assessing validity. However, the UK courts have continued to consider “Formstein” defences that require a uniform construction to prevent patentees from alleging infringement based on a construction that would render the claims invalid if assessed for validity. The UK courts have also continued to apply a “validating construction” (*Warner-Lambert Co LLC v Generics (UK) Ltd* [2018] UKSC 56) under which the scope of a claim is interpreted as not encompassing prior art acknowledged in the description, thereby avoiding rendering it invalid (*Ultraframe v Eurocell* [2005] RPC 36). Thus, the UK courts remain willing to take account the content description when determining the scope of a claim for the purposes of validity.

The guidance issued to UK Patent Examiners is that when examining an application, the “Construction of the claims should be approached in the usual fashion (see s.125). This involves putting a purposive construction on the claims, interpreting them in the light of the description and drawings as set out in Section 125(1).” (Manual of Patent Practice (MOPP) 14.62 and 14.111). Accordingly, Examiners are instructed to bear in mind that the protection conferred may go beyond the literal wording of the claim when assessing whether a prior art document destroys the novelty of a claim (MOPP 2.11), to be aware that the *prima facie* meaning of terms in the claims may not be the true meaning in the light of a definition found elsewhere in the description and to take into account a specific indication in the specification of what is meant by a particular expression found in the claims (MOPP 14.112). Thus, the practice of the UK IP Office is that the description can be consulted to construe a claim for the purpose of assessing validity.