

# G 1/24 – Written Statement in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal

For the Attention of: Mr Nicolas Michaleczek

15 November 2024

## I. Legal Certainty and Consistency

Legal certainty about claim interpretation is vital both to patent proprietors / applicants and third parties, both pre-grant and post-grant.

This legal certainty requires a consistent approach to claim interpretation for a European patent (application) throughout its life, namely during the pre-grant examination procedure and the opposition procedure at the EPO, and infringement and validity proceedings for example at the UPC.

However the current approach by the different departments of the EPO is not consistent. As the referring decision T0439/22 demonstrates, the EPO opposition division follows the “principle of the primacy of the claims” approach, not consulting the description and drawings, whereas the examining division does consult the description and drawings (e.g. under Articles 84 & 123(2) EPC), as does the UPC Court of Appeal (see *VusionGroup v Hanshow* (APL\_8/2024, ORD\_17447/2024); & *Nanostring v 10x Genomics* (UPC\_CoA\_335/2023, App\_576355/2023)).

This inconsistent approach means that claims may be given a different interpretation depending on the stage of the patent (application) through its life. The resulting uncertainty is shown by the examples given in T0439/22, reason 4.1.2.

A consistent approach throughout the life of a patent (application) is necessary for legal certainty of both patent proprietors / applicants and third parties. A legal basis for such a consistent approach was given by the Enlarged Board of Appeal in its decision G6/88, reason 3:

*“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.” [underlining added]*

This passage was also cited in the referring decision T0439/22, reason 3.2.

## **II. How to achieve a consistent approach?**

A consistent approach requires that in all procedures throughout the life of the European patent (application) either the description and drawings should be used for claim interpretation, or they should not.

The choice between these two options is limited by law and practice. When determining the extent of protection, the EPC prescribes the use of the description and drawings in Article 69(1) EPC:

*“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.”*

The UPC Boards of Appeal apply Article 69 EPC both in validity and infringement procedures (see caselaw referred to above in section I, 3<sup>rd</sup> paragraph).

The option not to use the description and drawings at all to interpret claims thus conflicts with both the EPC and the practice of the UPC Boards of Appeal and should therefore be discarded.

The only possibility for a consistent approach is to use the description and drawings to interpret claims in all procedures throughout the life of the patent (application).

## **III. Proposed Answers to the referred questions**

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?

→ Yes

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?

→ *Yes, the consultation must be done generally. There is no choice – Article 69(1) EPC mandates that the description and drawings shall be used to interpret the claims. The provision leaves no room for a conditional use of the description and drawings.*

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?

→ *No. Under Article 69(1) EPC use of the description and drawings is compulsory. The provision leaves no room for a conditional use. Guidance may be required to resolve conflicts within the application as a whole.*

Yours faithfully,

//Matthew Blaseby//, European Patent Attorney

//Derk Visser//, European Patent Attorney