

Contents

1. Summary	1
2. The questions referred (and the rephrasing of question 1)	2
3. Context and the determination of meaning	3
3.1 Context is essential	3
3.2 Ways in which context aids interpretation	4
3.3 How context is invariably used to interpret patent claims	4
4. The uniform concept of disclosure	5
5. Claim interpretations and the uniform concept of disclosure	6
5.1 Consequences of interpreting the claims in isolation	6
5.2 A non-uniform approach leads to absurd results	7
5.2.1 Where consulting the description makes a difference	8
5.2.2 Where amending the application makes a difference	8
6. Does interpreting the claims in isolation have a basis in law?	9
6.1 Article 84 does not justify interpreting the claims in isolation	10
6.1.1 No role for Article 84 EPC in the assessment of unamended, granted claims ..	10
6.1.2 No claim interpretation rules can be derived from Article 84 EPC	11
6.2 No basis in the EPC for other approaches to interpreting the claims in isolation ..	12
7. The relevance of Article 69 EPC and its Protocol	13
8. Key distinguishing features of the claims must be clear	14
9. A discussion of “the principle of the primacy of the claims”	14
10. Proposed answers to the questions referred	16
10.1 Question 1 (answered in rephrased form)	16
10.2 No need to answer Questions 2 and 3	16

1. **Summary**

I believe that Question 1 should be rephrased as follows.

When assessing the patentability of an invention under Articles 52 to 57 EPC, must the subject matter of the claims of the patent or application in question be determined in accordance with the general principle of law that a document must be interpreted as a whole?

This reformulated question should be answered in the affirmative.

Absurd results arise if the general principle of law that a document must be interpreted as a whole:

- is **not** used to interpret the *claims* of a patent or application that is the subject of proceedings before the EPO; but
- **is** used to interpret not only every other document in the proceeding, but also the originally filed description and drawings of the patent or application in question.

Section 5 below discusses various scenarios that lead to absurd results. Perhaps the most striking of those is the scenario pertaining to a patent application originally filed without claims. In that scenario, interpreting the claims in isolation (i.e. using an approach *not* in accordance with the above-mentioned general principle of law) leads to results that are **impossible to reconcile with the uniform concept of disclosure**.

An embodiment disclosed in the description of an application that is filed without claims will be interpreted by reference to the **whole** of the application as originally filed. If that same embodiment is then recited in *subsequently filed* claims, any interpretation of those claims that does not adopt the same (whole document) approach is liable to arrive at a meaning that **cannot be derived** “*directly and unambiguously, using common general knowledge, from the previous application as a whole*”.

Finally, I note that interpreting the claims in accordance with the above-mentioned general principle of law would:

- help to improve the level of harmonisation between the post-grant claim interpretation practices of the EPO and those of the national courts and the UPC;
- at least during pre-grant proceedings, still enable the EPO to raise objections (under Article 84 EPC, e.g. to missing essential features) in situations where a feature which provides a crucial distinction over the disclosures of the prior art is either not clear from the claims alone or is missing from the claims entirely; and
- ensure that the claims are not interpreted in accordance with a concept (the so-called “*principle of the primacy of the claims*”) that is **inconsistent with the uniform concept of disclosure**.

2. The questions referred (and the rephrasing of question 1)

In connection with appeal number T 439/22, Board 3.2.01 has referred the following questions to the EBA pursuant to Article 112(1)(a) EPC:

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?

Question 1 arises because the validity of Claim 1 as granted for of the patent which is the subject of appeal number T 439/22 hinges upon whether a term (“*gathered sheet*”) used in that claim is afforded:

- (a) a broad meaning if the claims are interpreted in context (i.e. in the light of the disclosures of the patent or patent application **as a whole**); but
- (b) a narrower meaning if the claims are interpreted either wholly or largely in isolation (e.g. according to principles of established EPO case law under which the description and drawings are not used to interpret the claims, or are only used under very limited circumstances).

The second sentence of Article 69(1) EPC states that:

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

Using the description and drawings to interpret the claims is nothing other than interpreting the claims in the light of the disclosures of the patent or patent application as a whole. Thus, whilst Question 1 refers to the second sentence of Article 69(1) EPC, it in fact addresses a broader point of law. That is, it raises the question of whether the claims, which form only *part* of a patent document, should be interpreted by considering the **whole** of that document, including the description and drawings.

It is settled case law of the EPO that a document must be interpreted **as a whole**. Indeed, according to T 556/02 (Reasons point 5.3), this is a general principle of law that is “*applied throughout the EPO*”. However, at least according to certain lines of case law, there is one exception to the application of this general principle. That exception relates to interpretation of the claims of a patent or application *that is the subject of proceedings before the EPO*.

Thus, the fundamental point of law underlying Question 1 of the referral is whether the above-mentioned general principle of law should be applied **without exception** throughout the EPO. For this reason, I believe that Question 1 should be rephrased as follows.

When assessing the patentability of an invention under Articles 52 to 57 EPC, must the subject matter of the claims of the patent or application in question be determined in accordance with the general principle of law that a document must be interpreted as a whole?

In other words, I believe that the fundamental point of law underlying Question 1 as referred can be settled without the EBA needing to determine whether Article 69 EPC is relevant to assessments of patentability.

Because the above, rephrased question engages the same fundamental point of law, it is admissible for reasons analogous to those outlined in the 24 June 2024 interlocutory decision in T 439/22.

3. Context and the determination of meaning

3.1 Context is essential

To understand the meaning of a statement or utterance, it is necessary to first determine the *context* in which that statement or utterance was made. Context is essential not only for determining who or what is the subject of a statement, but also for establishing whether a special meaning is to be afforded to any words within the statement.

The essential role that context plays in determining meaning is reflected in the general principle of law that a document must be interpreted **as a whole**. It is also reflected in settled case law of the EPO.

For example, Reasons point 2.2 of T 312/94 states that:

“it is a general legal rule for the interpretation of any document, in particular a patent application or patent, in order to determine its true meaning and thus its content and disclosure, that no part of such a document should be construed in isolation from the remainder of the document: on the

contrary, each part of such a document must be construed in the context of the contents of the document as a whole (emphasis added; see also T 56/87, T 556/02 and T 1658/12).

Moreover, as stated at Reasons point 5.3 of T 556/02, interpreting (patent) documents as a whole is a principle that is “*applied throughout the EPO*”.

3.2 Ways in which context aids interpretation

For patents and patent applications, the description and drawings provide context that is relevant to the interpretation of statements in any part of the specification, including the claims. As explained below, context can be provided in at least three different ways.

Firstly, the description and drawings help to determine the particular field(s) of technology to which the claimed invention relates. Such a determination can establish a unique context for the invention. For example, a particular field of technology may be associated with unique:

- person(s) of ordinary skill in the art;
- common general knowledge; and/or
- meanings ascribed to certain technical terms (which meanings may differ from those ascribed in related fields of technology to the same or similar terms).

The second and third ways that the description and drawings provide context is by either directly or indirectly providing a “custom” definition of certain terms.

A description might directly provide a custom definition of a particular term (“Term X”) by serving as a dictionary for the patent specification. For example, a description may provide a “custom” definition of Term X preceded by a statement such as “*By Term X we mean ...*” or “*As used herein, Term X refers to ...*”.

On the other hand, a description might indirectly provide a custom definition of a particular term (“Term X”). This can be done in more than one way.

For example, a description might indirectly define Term X by making it clear that:

- there are alternatives to Term X; and
- those alternatives are distinct from (i.e. mutually exclusive with) Term X.

In such scenarios, the identities of the alternatives can help the reader to determine what is not meant by Term X. In turn, this can provide information crucial to establishing what **is** meant by Term X.

Alternatively, a description might indirectly define one or more features of an invention by indicating the technical purpose(s) that those features serve, or specific technical effects achieved by the invention. In such scenarios, it might be possible to rule out interpretations of the claims in which the features in question do not serve the relevant purpose(s), or achieve the required technical effects.

3.3 How context is invariably used to interpret patent claims

Examination of a patent application by the EPO is always preceded by a search that is conducted on the subject matter of the claims of the application. Importantly, such a search is limited to those classifications that are deemed relevant (by the search examiner) to the subject matter of the claimed invention.

Determination of the relevant classifications requires consideration of the description and drawings, at least for the purpose of establishing the field(s) of technology to which the claimed invention relates. Indeed, a need to consider of the *technical* context provided by the description and drawings is reflected in the discussion of search strategies at B-IV 2.2 of the *Guidelines*:

*“There are usually various possible search strategies, and the search division, drawing on its experience and knowledge of the available search tools, will use its judgement to select the one most appropriate in the case in hand. The search division prioritises search strategies leading to those parts of the documentation where relevant documents are most likely to be found. It will usually give **the main technical field of the application** priority, first of all using the basic search means (see B-III, 2.2) most relevant to **the specific examples and preferred embodiments** of the claimed invention. It will always consider the results already obtained in deciding whether it needs to widen the search to include other, less relevant parts of the documentation”* (emphasis added).

Amongst other things, determination of the technical context of an invention leads to identification of matters that are pertinent to the *interpretation* of the subject matter of the claims, namely:

- the common general knowledge that is pertinent to the technical field in question; and
- the meanings which, in that technical field, are ordinarily ascribed to terms used in the claims.

As illustrated by the present referral to the EBA, there is no settled view across the EPO Boards of Appeal on the precise extent to which the description and drawings can be used to interpret the claims. Nevertheless, it is clear from the above that at least the *technical* context provided by the description and drawings is **invariably** used to “*interpret the claims*” in proceedings before the EPO.

In addition to the above, it is important to note that technical context provided by the description and drawings also comes into play during substantive examination. This is because it is often necessary to consult the description and drawings to determine the *purpose* of the claimed invention. Indeed, it is settled case law that the description and drawings should be consulted if the relevant purpose is not evident from the claims alone. See, for example, Reasons point 3.3 of T 14/17:

*“A central consideration in selecting the closest prior art is that it must be directed to the same purpose or effect as the invention. If this purpose is not explicitly set out or cannot be inferred from the claims, **the question to be answered is what, in the light of the application or patent as a whole, is to be achieved by the claimed invention**”* (emphasis added).

Determining the purpose of the invention can be a crucial first step in determining the meaning of terms used (in the claims) to describe that invention. It therefore represents a way of *interpreting* the claims.

4. The uniform concept of disclosure

In G 2/98, the Enlarged Board of Appeal (EBA) interpreted the concept of “*the same invention*” (for the purposes of assessing entitlement to priority) as being limited to subject-matter of a claim which the person skilled in the art can derive “*directly and unambiguously, using*

common general knowledge, from the previous application as a whole" (see the Headnote and point 9 of the Reasons of G 2/98).

The reference in G 2/98 to "*the previous application as a whole*" reflects the general principle of law discussed in section 3.1 above, namely that a document must be interpreted as a whole.

Thus, whilst a patent (application) may comprise different parts, it is nevertheless a single document that must be read and understood as such. This is reflected in principles of settled case law that are discussed in I.C 4.1 of the *Case Law of the Boards of Appeal of the EPO*:

*"According to the boards' settled case law, the technical disclosure in a prior art document must be considered **as a whole** (see T 56/87, OJ 1990, 188). **The individual sections of a document cannot be considered in isolation from the others but must be seen in their overall context** (T 312/94, T 452/05, T 456/10). In T 1321/04 the board found that **the terms used in patent documents should be given their normal meaning in the relevant art, unless the description gave the terms a special meaning**. The patent document might be its own dictionary (T 523/00, T 311/93). Thus, **if a special meaning could be derived from the patent document, only this meaning was ultimately decisive**" (emphasis added).*

The concept of "*the same invention*" set out in G 2/98 has since been held by the EBA to apply equally to assessments of novelty (under Article 54 EPC) and added subject matter (under Art. 123(2) EPC). This is because, in point 2.2.2 of the Reasons of G 1/03, the EBA emphasised that "*the European Patent System must be consistent and the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC*".

The EBA decisions in G 2/98 and G 1/03 therefore establish a **uniform concept of disclosure** that is based upon what the person skilled in the art can derive *directly and unambiguously*, using common general knowledge, from the relevant document as a whole.

For the sake of completeness, it is noted that the standard established in G 3/89 for the correction of obvious errors is consistent with this uniform concept of disclosure:

*"A correction under Rule 88, second sentence, EPC is of a strictly declaratory nature. The corrected information merely expresses **what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure**" (emphasis added; see Reasons point 4 of G 3/89).*

5. Claim interpretations and the uniform concept of disclosure

As discussed in section 3.1 above, a general principle of law that is applied throughout the EPO is the requirement to interpret a (patent) document *as a whole*.

However, at least under some lines of case law, this general principle is not applied to the claims of a patent or patent application that is the subject of proceedings before the EPO. For reasons outlined below, such lines of case law are **inconsistent with the uniform concept of disclosure**.

5.1 Consequences of interpreting the claims in isolation

For a patent or patent application that is the subject of proceedings before the EPO, certain lines of case law of the Boards of Appeal of the EPO indicate that the description and drawings

should either never be used to interpret the claims, or should be used only under limited circumstances (e.g. in the event of a lack of clarity).

Under these lines of case law, the claims of a patent or patent application that is the subject of proceedings before the EPO are therefore effectively interpreted in isolation (from the disclosures of the rest of the patent specification).

Interpreting the claims in isolation is clearly not the approach mandated by the uniform concept of disclosure, under which the claims “*must be construed in the context of the contents of the document as a whole*” (see T 312/94).

Thus, under such lines of case law, the same embodiment of the same invention (described using the same wording) will be afforded:

- (a) a first meaning (derived from interpreting the claims in isolation) when it appears in the claims of a patent (application) that is the subject of proceedings before the EPO; but
- (b) a second, **different** meaning (derived from a contextual interpretation) when it appears in any of
 - (i) the description of that patent (application),
 - (ii) the description or claims of a priority document for that patent (application) or
 - (iii) the description or claims of a prior art patent document.

5.2 A non-uniform approach leads to absurd results

It would be absurd for the meaning of a fixed set of words to change simply by virtue of either the location of those words within a single document or the status (in the proceedings before the EPO) of the document in which those words appear. However, such changes in meaning are the unavoidable consequence of using one interpretation method (the uniform concept of disclosure) in most scenarios, but a different interpretation method for the claims of a patent (application) that is the subject of proceedings before the EPO.

However, that it not the only absurd result of using different interpretation approaches in different scenarios. Indeed, the most absurd result arises where an EP patent application is filed without claims.

The ability to establish a filing (or priority) date by filing a patent application without claims is a feature common to numerous patent laws. Under the EPC, for example, this practice is explicitly permitted by Rule 40 EPC.

However, as will be evident from comparing and contrasting the interpretations under points (a) and (b)(i) in section 5.1 above:

- subject matter disclosed in the *original description* of an application filed without claims will be interpreted in context; but
- if the **same** subject matter is recited in *subsequently filed claims*, it will be interpreted in isolation.

In this scenario, interpreting the claims in isolation is therefore liable to arrive at a meaning that **does not correspond with the disclosure of the application as originally filed**.

Conversely, for EP applications filed with claims, an embodiment of the invention that appears in both the original description and the original claims will be afforded two different meanings. Having two different meanings ascribed to the same embodiment of an invention casts doubt upon which subject matter, if any, is **unambiguously** disclosed in the application in connection with that embodiment.

These examples illustrate why any approach that interprets the claims (wholly or largely) in isolation is **inconsistent with the uniform concept of disclosure**. Examples of further absurdities that can arise from interpreting the claims in isolation are outlined below.

5.2.1 Where consulting the description makes a difference

In the table below, “X”, “X1” and “X2” have the following meaning.

“X”: An embodiment of an invention that, wherever it appears, is defined using **identical** language.

“X1”: The subject matter encompassed by “X”, as determined by interpreting that embodiment by considering the **whole** of the document in which it appears.

“X2”: The (different) subject matter encompassed by “X”, as determined by interpreting that embodiment by considering only the claim set in which it appears.

Ex.	Where is “X” disclosed?	How is “X” interpreted?	Possible consequence of different interpretations
1	Priority document to Patent A	X1	(Full) priority denied: X1 and X2 are not " <i>the same invention</i> "
	Claim of Patent A	X2	
2	Original description of Patent Appl. B	X1	New matter added: no clear and unambiguous disclosure of X2 in application as filed
	Claim of Patent Appl. B added <i>after</i> filing	X2	
3	Original description of Patent Appl. C	X1	Enablement / support in doubt: if the (different) subject matter of X2 is arguably not enabled and/or not supported by the disclosures of the original description of Appl. C
	Claim of Patent Appl. C	X2	
4	Patent Appl. D (Article 54(3) EPC prior art to Patent Appl. E)	X1	X2 may be novel over X1: if features of X are given a “normal meaning” in the claims of Appl. E but a “special meaning” in Appl. D
	Claim of Patent Appl. E	X2	

Whilst absurd, these results are the logical consequences of determining the subject matter encompassed by “X” by using:

- one approach for the **claims** of the EP patent or patent application (A, B, C or E above), i.e. interpreting the claims either largely or completely in isolation; but
- a **different** approach for all other disclosures of “X” (whether in a priority document, a description as originally filed or an earlier patent application), i.e. interpreting each document as a whole.

5.2.2 Where amending the application makes a difference

Interpreting the claims in isolation can also give rise to absurd results when a patent application as originally filed *indirectly* provides a custom definition for a term, by way of defining an alternative to that term.

In this scenario, interpreting the claims in isolation can lead to the meaning ascribed to a term changing simply through the deletion from the claims of an alternative that previously helped to *indirectly* define that term.

To illustrate, the following example will be based upon a claim that includes Compound Y as a limiting technical feature, wherein:

- Compound Y has alternative definitions Y1 (e.g. “*agonist*” of a certain receptor) and Y2 (e.g. “*partial agonist*” of the same receptor); and
- the interpretation of Y1 changes, depending upon whether it is interpreted in the context of Y2 (which is presented as a mutually exclusive alternative to Y1, e.g. by defining Compound Y as either “*an agonist or a partial agonist*” of a certain receptor).

In this scenario, interpreting the claims in isolation would then lead to the term “*agonist*” being afforded:

- a narrow meaning (i.e. limited only to full agonists) in an *original* claim in which Compound Y is defined as “*an agonist or a partial agonist*” of a certain receptor; but
- a broader meaning in an *amended* claim in which Compound Y is defined solely as “*an agonist*” of said receptor.

This absurd result might be avoided under claim interpretation approaches that permit consultation of the description for the purpose of clarifying the meaning of arguably unclear terms.

However, even such approaches would be incapable preventing different interpretations of the same term being applied between pre- and post-grant procedures before the EPO in circumstances where, prior to grant, the description is adapted to delete all references to Y2 (i.e. all references to Compound Y representing a “*partial agonist*”). In such cases, consulting the description of the granted patent would not provide any reason to afford the term “*agonist*” its original, narrow meaning.

6 Does interpreting the claims in isolation have a basis in law?

As discussed in section 3 above it is a general principle of law, applied throughout the EPO, that a document must be interpreted as a whole (i.e. in context). Further, at least the *technical* context provided by the description and drawings is invariably used to “*interpret the claims*” in proceedings before the EPO.

Of course, not all claim interpretation approaches adopted by Boards of Appeal of the EPO align with the above-mentioned general principle of law. It is therefore necessary to consider whether the EPC provides any legal basis for the EPO deviating from that general principle (only) when interpreting the claims of a patent or application that is the subject of proceedings before the Office.

For this reason, it is important to answer the following questions.

- Is there a legal basis in the EPC for making the claims of a patent or application that is the subject of proceedings before the EPO the sole exception to the general principle of law that a document must be interpreted as a whole?
- If so, is there a legal basis in the EPC for interpreting the claims by considering only the *technical* context provided by the description and drawings, but **not** any other forms of context (such as “custom” definition of certain terms that are clearly and unambiguously derivable from either the explicit or implicit disclosures of the description and drawings)?

As will be evident from the discussion below, the answer to both of these questions is “no”.

6.1 Article 84 does not justify interpreting the claims in isolation

In certain decisions of EPO Boards of Appeal, Article 84 EPC (either alone or together with Rules 42 and 43 EPC) has been argued to provide legal basis for certain approaches to claim interpretation that do not take account of the description and drawings.

However, no general rules for *interpreting* the claims can be derived from Article 84 EPC, let alone rules that specifically override the above-mentioned general principle of law.

6.1.1 No role for Article 84 EPC in the assessment of unamended, granted claims

Article 84 EPC is an inherently unsuitable candidate for a source of general rules for interpreting the claims in proceedings before the EPO. This is because its exclusion from the grounds of opposition listed in Article 100 EPC means that, as confirmed by the EBA's ruling in Reasons point 55 of G 3/14, Article 84 EPC plays no role in the assessment of **unamended** claims of a granted patent:

*“Thus as regards the context of Article 101(3) EPC and the object and purpose of the EPC as implemented by the article, while **the requirements of Article 84 EPC** play an important role in examination proceedings they **play no role in opposition proceedings where the proprietor seeks to have the patent as granted upheld**”* (emphasis added).

As Article 84 EPC plays no role in the EPO's assessment of such (unamended) claims, it follows that it also cannot play a role in the *interpretation* of such claims. Indeed, this was the conclusion of the Board at point 3.9 of the Reasons in T 1473/19:

*“Systematically, Article 84 EPC belongs to Part III of the EPC on the European patent application. Accordingly, “the requirements of Article 84 EPC [...] play no role in opposition proceedings where the proprietor seeks to have the patent as granted upheld” (G 3/14, Reasons 55). For this reason alone, the requirement under Article 84, first sentence, EPC **cannot constitute a generally applicable legal basis for the interpretation of patent claims, including granted claims, in opposition and opposition appeal proceedings**”* (emphasis added).

The Board in T 169/20 has disputed the validity of this conclusion (see Reasons point 1.2.2 of that decision). However, for the reasons discussed below, this appears to have been based upon a misinterpretation of commentary from point 55 of G 3/14.

The relevant commentary from point 55 of G 3/14 is as follows.

“A granted claim may turn out not to comply with Article 84 EPC but such non-compliance must be lived with. However, any lack of clarity of the claims may still be highly relevant in opposition proceedings in that it can influence the decisions on issues under Article 100 EPC”.

The Board in T 169/20 appears to have interpreted the second sentence of this quote as meaning that, even where it does not play any role, Article 84 EPC is still highly relevant in opposition proceedings. However, what the second sentence of the above quote in fact says is that “**any lack of clarity**” may still be relevant. That is, it indicates that the practical consequences of non-compliance with (the clarity requirement of) Article 84 EPC “*may still be highly relevant in opposition proceedings*”.

A practical consequence of a lack of clarity is an impact upon claim scope. This is because a term whose meaning is not immediately clear might be interpreted as encompassing a broad range of potentially viable meanings. In general terms, it is easier to establish grounds of invalidity for broader claims than it is for narrower claims. The above quote from point 55 of G 3/14 therefore appears to have had *claim breadth* in mind when discussing the relevance of “*any lack of clarity*” to opposition proceedings.

6.1.2 No claim interpretation rules can be derived from Article 84 EPC

The wording of Article 84 EPC is as follows.

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

According to Article 31 of the Vienna Convention, this provision should be “*interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose*”.

Article 84 EPC has three distinct limbs, namely requirements for the claims to:

- define the matter for which protection is sought;
- be clear and concise; and
- be supported by the description.

According to their “*ordinary meaning*”, each of these three limbs defines properties that the claims must possess to satisfy the requirements of Article 84 EPC.

This conclusion is supported by considering the context in which Article 84 EPC appears. This is because Article 84 EPC:

- is one of the provisions of Part III of the EPC, entitled “*The European Patent Application*”; and
- forms part of Chapter I of Part III of the EPC, which is entitled “*Filing and requirements of the European Patent Application*” (emphasis added).

This context therefore confirms that Article 84 EPC is a provision which defines requirements of the claims of a European patent application (i.e. properties that those claims must possess).

Conspicuously absent from the “*ordinary meaning*” of each of the three limbs of Article 84 EPC (as determined “*in their context*”) is the suggestion of any kind of rule for *interpreting* the claims.

Taking account of the object and purpose of Article 84 EPC does not change this conclusion.

The first sentence of Article 84 EPC serves to distinguish the role of the claims from that of the description and drawings, which is to provide a disclosure of the invention in the sense of Article 83 EPC. However, all that can be deduced from this distinction is that claims which do not serve the purpose of defining “*the matter for which protection is sought*” will not meet the requirement of the first sentence of Article 84 EPC.

A further elaboration of the requirement set out in the first sentence of Article 84 EPC is found in the first sentence of Rule 43(1) EPC:

“The claims shall define the matter for which protection is sought in terms of the technical features of the invention” (emphasis added).

However, whilst this provision may indicate which *types* of features should be included in a claim, it says nothing about **how** those features should be interpreted.

To put it another way, there is a crucial difference between the objectives of:

- (A) ensuring that a claim defines the (essential) technical features of an invention; and
- (B) determining the *meaning* of the words used to define those technical features.

The object and purpose of the first sentences of Article 84 and Rule 43(1) EPC is solely (A) above, i.e. **not** the completely separate objective (B) above.

Turning next to the first limb of the second sentence of Article 84 EPC, a text that is both clear and concise is more readily understood than a text that has neither of these characteristics. It can therefore be deduced that the object and purpose of the requirement for clarity and conciseness is to ensure that patents are not granted with claims that are either difficult or impossible to understand. However, whilst this may require the claims to be *capable* of being interpreted, it says nothing about **how** they should be interpreted. Indeed no rules or principles for interpreting the claims are evident from that requirement, let alone rules that specifically override the general principle that a document must be interpreted as a whole.

As for the second (support) limb of the second sentence of Article 84 EPC, the object and purpose of this requirement is currently a hotly debated topic. Nevertheless, it is common ground that a requirement for the claims to be “*supported by the description*” implies a level of correspondence between the description and the claims, such that there is “*a basis in the description for the subject matter of every claim*” and the scope of the claims is not “*broader than is justified by the description and drawings*” (see paragraph 59 of the 2015 Study on Sufficiency of Disclosure¹ produced in connection with the 22nd session of WIPO’s Standing Committee on the Law of Patents).

Again, however, such an object and purpose says nothing about which principles should be applied when *interpreting* the claims. In particular, it does not in any way imply, let alone specifically provide, claim interpretation rules that should be used in place of the general principle that a document must be interpreted as a whole.

Consideration of the travaux préparatoires (TP) for Article 84 also does not lead to any different conclusion. This is because, with one possible exception, the TP provide little insight into the object and purpose of any of the limbs of Article 84.

The possible exception mentioned above is the agreement reached regarding the use of “*a less restrictive wording*” for the support requirement. However, this change of wording, from “*fully supported*” to “*supported*”, only has a bearing on determinations of the level of correspondence required between the description and the claims. It is of no assistance whatsoever to the task of determining whether any provisions of Article 84 are intended to serve as rules for interpreting the claims.

6.2 No basis in the EPC for other approaches to interpreting the claims in isolation

An approach adopted by some Boards of Appeal is to interpret a claim by affording the “*broadest technically sensible meaning*” to each of the terms used therein. This is not necessarily an approach under which the claims are interpreted in isolation. Indeed, the first mention of this approach (in T 79/96) is ambiguous as to its relevance to the question of whether the claims should be interpreted in the light of the description and drawings. This is

¹ Document SCP/22/4 (https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=307341), which is relevant in view of the close correspondence between the support requirement under Article 84 EPC and that under Article 6 PCT.

because the Board in that case was not considering whether to interpret a term in the light of the description, but instead whether to afford that term the same definition as provided in a prior art document.

However, in more recent cases, a “*broadest technically sensible meaning*” approach has been used to aid interpretation of claims in isolation. For example, T 1266/19, at Reasons 11.4 states that:

“terms in a claim must be given their broadest technical sensible meaning, and that a definition in the description which is absent from a claim cannot give these terms and, hence, the claim as a whole a more narrow/restrictive meaning”.

Conspicuously absent from the case law applying this approach is a relevant legal basis. Indeed, no such basis is apparent. This is not least because such an approach is contrary to the general principle of law that a document has to be interpreted as a whole.

Moreover, unless supported by evidence, such as textbook definitions or declarations from persons skilled in the relevant art, there is a risk that any “*broadest technically sensible meaning*” selected by the relevant deciding body at the EPO could lead to the problems highlighted in Reasons point 4.2.2 of T 1513/12, namely:

“Mit solchen Auslegungen könnte nämlich der Gegenstand des Patents entgegen Art. 123(2) EPÜ mittelbar über den Inhalt der Anmeldung in der ursprünglichen eingereichten Fassung hinaus geändert werden oder der Schutzzumfang entgegen Art. 123(3) EPÜ erweitert werden”
(which roughly translates as “*Such interpretations could indirectly change the subject matter of the patent beyond the content of the application in the originally filed version, contrary to Art. 123(2) EPC, or extend the scope of protection contrary to Art. 123(3) EPC*”).

Such risks are, of course, avoided by interpreting terms in the claims by reference to the **whole** disclosure of the patent application as originally filed.

7 The relevance of Article 69 EPC and its Protocol

I will refrain from providing a direct answer to original Question 1 of the referral to the EBA, which asks whether the 2nd sentence of Article 69(1) EPC (and Article 1 of the Protocol on the Interpretation of Article 69 EPC) should be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC.

It is not necessary for the EBA to answer that question in order to decide that, in common with (any part of) any other document, the claims of a patent or application that is the subject of proceedings before the EPO should be interpreted in accordance with the general principle of law that a document must be interpreted **as a whole**.

In this respect, my only comments in connection with original Question 1 are that:

- the 2nd sentence of Article 69(1) EPC appears to be entirely consistent with the above-mentioned general principle of law; and
- it is at least arguable that Article 1 of the Protocol on the Interpretation of Article 69 EPC is also consistent with that general principle; but
- Article 2 of the Protocol on the Interpretation of Article 69 EPC is **not** consistent with that general principle.

8 **Key distinguishing features of the claims must be clear**

Whilst I disagree with the claim interpretation approach adopted by the Board in T 1266/19, I understand their concerns regarding the absence from the claims of definitions that:

- provide a crucial distinction over the disclosures of the prior art; but
- are found only in the description of the patent as granted.

However, at least during examination proceedings, I believe that such concerns can be addressed using an approach that does not involve departing from the general principle of interpreting a document as a whole.

That is, an objection could be raised under Article 84 EPC (e.g. to missing essential features) when a feature which provides a crucial distinction over the disclosures of the prior art is either not clear from the claims alone or is missing from the claims entirely.

Such an approach would be entirely consistent with the object and purpose of Article 84 EPC, as discussed at section 6.1 above. This is because one way for applicants to address such objections under Article 84 EPC would be, where possible, to amend the claims to include clear(er) definitions of the key distinguishing feature(s). Such amendments would then ensure that there is “*a basis in the description for the subject matter of every claim*” and the scope of the claims is not “*broader than is justified by the description and drawings*”.

Of course, such an approach could only be applied during opposition proceedings in circumstances permitted by the ruling in G 3/14. However, this merely reflects long-standing EPO practice in view of the deliberate choice of the legislator not to include Article 84 EPC as a ground of opposition.

Relying upon Article 84 EPC during examination proceedings to deal with the above-mentioned concerns of the Board in T 1266/19 would also have the advantage of improving the level of harmonisation between the post-grant claim interpretation practices of the EPO and those of the national courts and the UPC. That is, it would lead to an approach that is harmonised at least in the sense that the description and drawings are always used to interpret the claims.

9. **A discussion of “the principle of the primacy of the claims”**

Whilst described in Reasons point 1.3.4 of T 169/20 as a “*well-established principle*”, it appears that the concept of “*primacy of the claims*” was unknown prior to 30 September 2022, which is the date of the decision in T 1473/19. Reasons point 3.16.1 of T 1473/19 introduces the concept as follows.

*“although Article 69(1), second sentence, EPC requires that generally account be taken of the description and the drawings when interpreting a patent claim, **the primacy of the claims under Article 69(1), first sentence, EPC limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings**” (emphasis added).*

However, as will be explained below, there is no basis in the EPC to afford the claims any kind of “*primacy*” that goes beyond the object and purpose of the first sentence of Article 69(1) EPC or the first sentence of Article 84 EPC (as read in conjunction with first sentence of Rule 43(1) EPC). As outlined in Reasons point 12 of G 1/16, the purpose of those provisions is as follows.

“Patent claims define the subject-matter for which protection is sought in terms of the technical features of the claimed invention (Articles 69(1), first sentence, and 84 EPC)”.

Thus, the object and purpose of the first sentence of Article 69(1) EPC is ensuring that the subject matter of a claim is defined by the technical features of that claim. This mirrors the object and purpose of the first sentence of Article 84 EPC which, as discussed in section 6.1.2 above, is ensuring that a claim defines the (essential) technical features of an invention.

Defining the technical features of a claim is not the same as determining the *meaning* of the words used to define those technical features. Determining meaning is, in fact, the object and purpose of the second sentence of Article 69(1) EPC.

The wording of the claims is crucial to the process of interpreting (i.e. determining the meaning of) the claims. However, this is because the wording of the claims provides both the starting point and the boundaries for that process. That is, to quote principles summarised at paragraph 45 of the UK High Court’s decision in *Saab Seaeye Ltd v Atlas Elektronik GmbH & Anor* ([2015] EWHC 3163 (Pat)):

“It is the terms of the claims which delineate the patentee’s territory”; and

“if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements”.

However, it is impossible to determine the subject matter encompassed by a claim without engaging in the separate step of determining the *meaning* of the words used (i.e. interpreting those words). As discussed in section 6.1.2, no rules or principles for determining the meaning of the words of the claims can be gleaned from either the first sentence of Article 84 EPC or first sentence of Rule 43(1) EPC. The same can be said for the first sentence of Article 69(1) EPC.

For the purpose of interpreting the claims, decisions that apply the “*principle of the primacy of the claims*” ignore, to a greater or lesser extent, context provided by the description and drawings of a patent or application. Thus, in essence, those decisions override, to a greater or a lesser extent, the general principle of law that a document must be interpreted as a whole. However, discussed in section 6 above, there are no provisions in the EPC which justify overriding that general principle (whether by interpreting the claims in isolation or otherwise).

Further, as illustrated in section 5 above, interpreting the claims without taking account of context provided by the description and drawings leads to results that are not only absurd but that conflict with the uniform concept of disclosure. Thus, to the extent that the “*principle of the primacy of the claims*” overrides the general principle of law that a document must be interpreted as a whole, that principle is **inconsistent with the uniform concept of disclosure**.

10. *Proposed answers to the questions referred*

10.1 Question 1 (answered in rephrased form)

I propose that Question 1 should be rephrased as follows.

When assessing the patentability of an invention under Articles 52 to 57 EPC, must the subject matter of the claims of the patent or application in question be determined in accordance with the general principle of law that a document must be interpreted as a whole?

This rephrased question should be answered in the affirmative.

10.2 No need to answer Questions 2 and 3

In the light of the proposed answer to (rephrased) Question 1, I do not believe that it is necessary to answer Questions 2 and 3. This is because it is clear from the proposed answer to Question 1 that terms used in the claims must always be interpreted in the light of the disclosures of the description and drawings.

Yours faithfully,

SNODIN, Michael David