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## Referral to the Enlarged Board of Appeal - G 1/24

### Amicus Curiae Brief by the Patentanwaltskammer according to Art. 10 (1) RPEBA

With its interlocutory decision T 0439/22 of June 24, 2024 (herein forth "referring decision"), the Technical Board of Appeal 3.2.01 has - in accordance with Art. 112 (1) (a) EPC - referred the following questions to the Enlarged Board of Appeal for decision:

- 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?*

## **I. Executive summary**

The position of the Patentamt regarding the referred questions can be summarised as follows:

Question 1 has to be answered clearly in the positive. No distinction may be made in the application of Art. 69 (1), second sentence EPC and Art. 1 of the Protocol on the Interpretation of Art. 69 EPC, on the one hand, for the determination of the scope of protection to be decided on in proceedings regarding infringement of a patent protecting a certain invention and, on the other hand, for the determination of the subject-matter to be considered for the assessment of the patentability of the same invention.

Question 2 has to be answered in the positive. Both the description and the figures are generally to be consulted for the interpretation of the claim to assess patentability. In principle, this should also be the case if the wording of the claim appears to be clear and unambiguous to a person skilled in the art, and not only in cases in which doubt arises concerning the meaning of terminology used in the claim.

Question 3 is answered as follows: In principle, a definition contained in the description or similar information on a term used in the claims must be taken into account when interpreting the claim in the context of the examination of patentability. An exception to this rule may only apply in rare cases if the term used in the claim clearly contradicts the information on this term given in the description.

## **II. The referred questions**

### **Question 1**

As in German case law, it is generally assumed in other jurisdictions that the interpretation of the patent claim is always required and may not be omitted even if the wording of the claim appears to be clear and unambiguous, since the description of the patent can provide an independent definition of terms used in the claim language. This requirement of mandatory interpretation applies irrespective of whether an infringement examination is carried out, patentability is assessed or the question of an inadmissible extension is to be assessed. Evidence of corresponding case law from different EPC member states is presented in detail under points 4.3.1 to 4.4.4 of the referring decision.

From a German perspective, particular reference should be made here to the long-standing case law of the Federal Court of Justice (Bundesgerichtshof - BGH). For example, according to its decision of July 17, 2012, X ZR 117/11, para. 27 (Polymerschaum I), in continuation of long-standing case law of the Federal Court of Justice, it is required that when examining novelty, statements are made based on the meaning of individual features. As part of the interpretation, the meaning of the patent claim as a whole and the contribution that the individual features make to the result of the invention are determined. This is because, at least in case of doubt, the function that the individual technical feature has on its own and in interaction with the other features of the patent claim in bringing about the success of the invention is decisive for the understanding. According to the established case law of the Federal Court of Justice, the description and drawings which explain and illustrate the technical teaching of the patent claim must be used not only to determine the scope of protection, but also to interpret the patent claim, irrespective of whether this interpretation is the basis of the infringement examination or the examination of the patentability of the subject-matter of the claim (BGH, decision of February

13, 2007, X ZR 74/05 - Kettenradanordnung; BGH, decision of April 17, 2007, X ZB 9/06 - Informationsübermittlungsverfahren).

Therefore, the German Federal Patent Court (Bundespatentgericht - BPatG) generally considers these principles to be applied also when assessing patentability in examination proceedings (BPatG, decision of September 27, 2022, 9 W (pat) 14/20, reasons no. II.5.1).

Initially, the case law of the Boards of Appeal of the European Patent Office also was based on this uniform interpretation practice (see decisions G 2/88, para. 2.5 and G 6/88, para. 3). As stated in the referring decision, it was only later that a different line of case law developed in some Boards of Appeal of the European Patent Office, according to which Article 69 (1) EPC was to be used only for determining the scope of protection, but not for the examination of the subject-matter of the claim under Articles 54, 56 and 83 EPC or for the comparative examination of the subject-matter of the patent in relation to the disclosure of the patent application pursuant to Article 123 (2) EPC.

This deviating interpretation practice developed by some of the Boards of Appeal contradicts not only the interpretation practice of national patent offices and courts but also the case law of the Unified Patent Court (UPC) which confirms the uniform interpretation practice described above.

The Court of Appeal of the UPC established that the basic rules for claim construction pursuant to Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC apply equally to the assessment of infringement and validity, as stated in the decision of March 3<sup>rd</sup>, 2024, UPC\_CoA\_335/2023 - 10x Genomics v. NanoString, headnote 2:

*“The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent under Art 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC.*

*The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.*

*However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.*

*The patent claim is to be interpreted from the point of view of a person skilled in the art.*

*In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.*

*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 approach was confirmed by the decision of May 13, 2024, UPC\_CoA\_1/2024 - VusionGroup SA v. Hanshow.

In its decision of July 16, 2024, UPC\_CFI\_14/2023 - Amgen v. Sanofi/Regeneron (headnote 1), the Munich Central Division of the UPC further elaborates that the actual technical function of the claim features in question must be deduced from the function of the individual features in the context of the patent claim as a whole. The description and the drawings may serve as a patent's own lexicon. The meaning given to claim terminology by the patent as a whole therefore takes precedence over the common understanding of the respective terminology. Such a functional approach to claim interpretation has been recently confirmed by the BGH, decision of July 9, 2024, X ZR 72/22 (Waage).

There is no convincing reason for deviating from this uniform interpretation practice applied by the EPC member states.

In order to ensure uniform criteria and provide legal certainty in the assessment of the subject-matter of the invention, it is therefore appropriate that the assessment practice of the Boards of Appeal is also based on these assessment standards.

The Patentanwaltskammer emphasizes that it is of ultimate importance to ensure uniform interpretation of the claim wording in both validity and infringement proceedings, and therefore to apply, as a matter of principle, the same approach to claim interpretation in both proceedings. It is the inherent goal of every patent application to define, at the end of the examination procedure, an extent of protection. Therefore, the same principles have to be applied to claim interpretation in grant and validity proceedings on the one hand and infringement proceedings on the other hand. Both the German Federal Court of Justice and the UPC have acknowledged that the claims have to be interpreted in both proceedings in the light of the disclosure of the patent as a whole. The EPO should also interpret the claim wording in light of the patent as a whole. Otherwise, the risk might arise that the patent proprietor claims in infringement proceedings a large extent of protection resulting from claim interpretation by considering the description and figures as prescribed by Article 69 (1), second sentence EPC, but in concurrent validity proceedings before the EPO defends the patent only on the basis of narrower claim language, if the claim were not interpreted in the same way as in the infringement proceedings. This could lead to an imbalance between the proceedings and, therefore, unfairness between the parties.

The entering into force of the Agreement on a Unified Patent Court (UPCA) creates the necessity of adapting the approach to claim interpretation applied by the EPO to case law handed down by the UPC which is influenced by case law from different EPC member states. Such a harmonization would clearly increase the value and reputation of the European patent system.

It would be detrimental to legal certainty if different approaches to claim construction were to be applied in opposition proceedings before the EPO and in parallel proceedings before the UPC.

## **Question 2**

As already explained above, the description and figures must generally be used to interpret the claim. This includes the examination of patentability. In this context, the German Federal Court of Justice (BGH) convincingly stated in its landmark decision of March 2, 1999, X ZR 85/96 (Spanschraube) that the description and drawings must be used to interpret the patent claims. This principle has also been recognized by EPO Boards of Appeal decision T 0177/22, reasons no. 2.2.7. The decisive factor is the disclosure content of the patent claims and, in addition, the disclosure content of the description in the sense of an interpretation aid, insofar as this has been reflected in the claims. According to the BGH, claim interpretation serves not only to eliminate any ambiguities in the patent claims, but also to determine the meaning of the technical terms used therein, as well as to determine the meaning and scope of the invention.

## **Question 3**

In principle, a definition or similar explicit information about a term used in the claim contained in a description must be taken into account when interpreting the claim for assessing patentability. This is confirmed by the UPC in its decision of July 16, 2024, UPC\_CFI\_14/2023 - Amgen v. Sanofi/Regeneron by stating that the description and the drawings may serve as a patent's own lexicon. This is true irrespective of whether a definition given in the description and the drawings is broader or narrower than the usual meaning of the claim terminology, considering that – as mentioned above – the UPC requires a uniform approach in infringement and validity proceedings.

In case of doubt, the description and the claim should be understood in such a way that they do not contradict each other but constitute interrelated parts of the technical teaching provided to the skilled person by the patent as a meaningful whole (BGH, decision of July 7, 2015, X ZR 64/13, para. 13 - Bitratenreduktion).

Only in rare exceptional cases, in which a definition in the description is in unresolvable contradiction with the claim, it would be justified to disregard the definition in the description. In the event of contradictions between patent claims and the description, those parts of the description that are not reflected in the patent claims are not to be included in the patent protection (BGH, decision of May 10, 2011, X ZR 16/09 - Okklusionsvorrichtung). The description may, therefore, only be taken into account to the extent that it can be read as an explanation of the subject-matter of the patent claim.



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