

in referral to the Enlarged Board of Appeal of the EPO

**G 1/24 ~ Claim interpretation**

Dear Chair and Members of the Enlarged Board of Appeal,

The following questions were referred by the Technical Board of Appeal in decision T439/22:

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?
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?

1. Treatises could be written about claim interpretation if not libraries. I do not intend to give an exhaustive treatment in the present *amicus* brief. I will discuss chiefly the scope of the referred questions (A) and discuss the ‘broadest reasonable interpretation’ rule in its historical context and analyse it in terms of proportionality (B). I will conclude with some secondary points concerning whether Question 1 is properly limited to Articles 52 – 57 EPC (C), the relation with G 2/88 (D), and the relation with G 3/14 (E).

*A. Scope of the referral*

2. For the decision of the Technical Board of Appeal (TBA) on the case at hand, the essential question appears to be whether the TBA may interpret the claim term in question in conformity with the *broadening* definition of the term that can be found in the description of the patent in suit.
3. However, the TBA points to the opposite case of *narrowing* definitions where it proposes, in point 6.2.3 of the reasons,  
“to construe the patent when in doubt in a way that the term used in the claim is understood in a broad sense, such as to include both potential meanings.  
Thus, where the information giving the terms in the claims the meaning as intended in the patent is not included in the claims even though it could have been by amendment of the claims, the share of prior art examined that is potentially novelty-destroying or could render an invention obvious is *increased* during examination and opposition proceedings” (emphasis added).
4. Hence, this proposal of the TBA deals with the case where some information is not included in the claims though it is included in the description of the application as filed (such that it could have been included in the claims through amendment, Article 123(2) EPC) and the share of relevant prior art is for that reason increased – relative to the case of a literal claim interpretation, I understand. This means that

the scenario addresses the possible effect of a *narrowing* definition in the description.

5. However, such is not the case in the patent in suit. The facts of the case are limited to a broadening definition given in the description. The TBA's framing of the matter by formulating the questions in an abstract way does not alter the legal issue to be resolved in the underlying appeal.
6. Assuming the referral is admissible, it seems that specifically addressing the matter of the possible effect of a *narrowing* definition, e.g. the effect as proposed in point 6.2.3 of the referral, is beyond the proper ambit of the referral as set by Article 112(1) EPC for the TBA does not need to decide on it.<sup>1</sup>

Notwithstanding this procedural limitation, general observations on claim interpretation in the light of the description can be given in the decision on the present referral, namely at an abstract level covering both narrowing and broadening definitions in the description. However, analysis at a very abstract level may also be dispensed with if it is unnecessary to give suitable guidance to the referring TBA that enables them to decide on the underlying appeal after considering the facts of the case in light of the guidance given by the Enlarged Board.

7. Turning to the actual issue of broadening definitions, it seems possible to conclude in the present referral that the TBA is *not precluded* from taking into account broadening definitions in the description without stating that such a broadening definition must always be considered as overriding the plain meaning of the claim.

How a broadening definition is to be considered precisely appears to be a fact-specific issue that can be best decided with regard to the circumstances of the case and may depend *inter alia* on the precise formulation of the definition at issue and the precision or ambiguity of the specific term used in the claim.

These considerations apply equally to other kinds of teachings in the description that impart a broader meaning to the terms of the claim, such as embodiments and general remarks.<sup>2</sup> Hence, although ideally, the answer in reply to the wish for 'conditions' expressed in Question 3 would be in the form of a clear-cut rule that *always* provides a combination of legal predictability *and* the right outcome in each and every case, in practice, formulating a flexible framework might be feasible.

8. At the same time, for the reasons given above, the answers given in the referral should not be strictly limited to definitions and other information that is explicitly

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<sup>1</sup> This observation is made without prejudice to the merits of the analysis in points 6-6.3.2 of the referring decision.

<sup>2</sup> As an example, the claim specifies "a solution of A", and the description explains for another solution B that it can also be a suspension or dispersion; or an embodiment is identified as inventive but is outside the plain meaning of the terms of the claim. Numerous variations are possible.

given in the description, a limitation suggested by Question 3, but could and ideally would extend to any teaching in the application documents that imparts a broader meaning to a term in the claims.

*B. Broadest reasonable interpretation in context*

9. In the event a broader discussion of claim interpretation will be given, I submit the following on the ‘broadest reasonable interpretation’ (BRI) rule.
10. This rule appears to form a part of the established case law of the Boards of Appeal.<sup>3</sup> For example, T2133/21 held that: “according to the legal approach to claim construction, it is a well-established principle laid down by Board of Appeal case law that a non-specific definition in a claim (...) must be given its broadest technical sensible meaning taking into account the context in which it appears, which also includes linguistic considerations”.
11. Considering a claim in context and through the eyes of a person skilled in the relevant technical field seems reasonable and in line with, e.g., Article 31 of the Vienna Convention on the Law of Treaties 1969. I consider the description and any drawings to be part of the context.
12. However, why should the *broadest* reasonable (or *broadest* technical sensible meaning) be adopted? Especially for opposition proceedings, such a rule seems biased: it advantages the opponent and disadvantages the proprietor and, therefore, requires a special justification. I will discuss the historically given justification hereinafter.

However, as a preliminary matter, I observe that this question of the justification of the rule presupposes that there is an alternative to it. I assume that this alternative rule seeks the ‘most reasonable’ interpretation, wherein there must be some rule to define the ‘most reasonable’ interpretation other than by reference to the broadest reasonable interpretation.

Secondly, the rule seems to assume that there are multiple reasonable interpretations of a claim. Practical experience shows that this is indeed possible.

Thirdly, I understand the rule to mean that novelty must be tested against every reasonable interpretation of the claim. Just as a proprietor cannot defend a patent against an inventive step attack starting from D1 by pointing out that the claimed invention is non-obvious over D2, an objection of lack of novelty under a reasonable claim interpretation A cannot be refuted by arguing that the claim is novel under claim interpretation B.

Finally, the requirement is that the proposed interpretation is reasonable, not that the proprietor must show that it is unreasonable.

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<sup>3</sup> Without prejudice to your power to revise in the present procedure.

13. The rule seems to originate from U.S. patent practice. In particular, the Court of Appeal for the Federal Circuit explained that:

“the broadest reasonable interpretation standard has been applied by the [Patent Office] for more than 100 years in various types of [Patent Office] proceedings. A 1906 [Patent Office] decision explained, “[n]o better method of construing claims is perceived than to give them in each case the broadest interpretation which they will support without straining the language in which they are couched.”<sup>4</sup>

14. The 1906 decision of the U.S. Patent Office is *Podlesak v. McInnerney* of 19 April 1906 which was published in the Official Gazette.<sup>5</sup>

The procedural background is perhaps not essential for understanding the quote below, but a summary seems still useful. The decision concerned an interference procedure between two patent applications (of different applicants) with identical claims. In the initial patent office procedure, the Examiner-in-Chief had found the claim to be novel in each case over some prior art reference based on how a particular term of the claim was explained in the respective specifications (i.e. the descriptions); the two applications explained the term differently. An interference procedure was declared to determine to which applicant the patent was to be granted,<sup>6</sup> and an appeal to the court of appeals followed. The court suggested that each party should be given a narrow claim, in particular, that the claims “should be so re-formed [i.e. amended] [so] that each [party] should have a specific [i.e. different] claim ... that avoids the [prior art] reference”. The court then remanded to the Patent Office.

The Commissioner, on remand, came to the following analysis:

“No better method of construing claims is perceived than to give them in each case *the broadest interpretation* which they will support without straining the language in which they are couched.”<sup>7</sup>

This method would seemingly give more uniform and satisfactory results than are obtained by methods largely in vogue – such, for example, as that of *importing limitations from the specification* according to the exigencies of the particular situation in which the claim may stand at a given moment.<sup>8</sup>

The method suggested also seems to have the advantage according in its results with the probable intentions of the inventor at the time when the claim is drawn. In presenting claims to the Office the object constantly sought is breadth. Where a limited meaning is intended when a claim is drawn, what possible objection can there be to imposing that meaning unmistakably upon the claim by its express terms? That a claim which does not carry its true meaning on its face *misleads those affected by the patent*

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<sup>4</sup> *In re Cuozzo Speed Technologies*, 778 F.3d 1271 (Fed. Cir. 4 February 2015). A petition for *en banc* review was denied on 8 July 2015 (793 F.3d 1297). On the same day, a version of the initial decision with minor revisions and corrections was published (793 F.3d 1268). The Supreme Court affirmed (579 U.S. 261).

<sup>5</sup> Official Gazette of the United States Patent Office, volume 123, part 2, page 1989 (issue 7 August 1906), accessible here: <https://babel.hathitrust.org/cgi/pt?id=pst.000064089683&seq=321>

<sup>6</sup> Cf. Art. 60(2) EPC

<sup>7</sup> This resembles ‘not unreasonable’ rather than ‘reasonable’ and could be quite different from current EPO case law.

<sup>8</sup> *Viz.*, the methods used by the Examiner-in-Chief in the procedure leading to the court appeal.

instead of guiding them to its true scope is alone sufficient reason why the Patent Office should refuse to recognize proposed limitations of claims which have not been clearly expressed therein.” (emphasis added)

15. Hence, the ‘broadest reasonable interpretation’ was adopted, and the previous practice of importing limitations from the specification was abolished in 1906. The reason for doing so was to avoid the risk of third parties being misled by the claims.
16. To formulate that risk of misleading third parties more precisely, if a patent is granted with a claim that includes unpatentable embodiments when interpreted in a broad manner without importing limitations from the specification, the patent is predisposed to dissuade potential competitors from competing with the patent’s proprietor with respect to those non-patentable embodiments, thereby unduly limiting fair competition. This goes against the general interest of free trade and fair competition in embodiments that are not patentable, e.g. for lack of novelty or inventive step, an interest of not only the possible competitors but also, and more importantly, the general public. Preventing patents from stifling legitimate competition appears to be the rule's main objective.

The BRI rule of claim interpretation (concerning narrowing statements in the description) is, therefore, grounded on a legislative choice for strong patents, creating a context wherein patents, just by being granted and in force, *should* affect the behaviour of competitors by deterring them from working in the scope of the patent. This policy choice, in turn, imparts an obligation for enterprises (including SMEs) to identify and monitor competitors’ patents. The BRI rule then acknowledges that competitors will navigate around competitors’ patents based on the claims of those patents; in other words, the narrowing statement in the description will not (or insufficiently) annul the deterring effect of the broad claims of the patents, an effect that is undesirable to the extent the claim encompasses non-patentable subject-matter.

Admittedly, the deterrent effect of the claims, relative to the off-setting effect of any narrowing statement in the description, will be stronger the more they define the scope of protection exclusively. Here, it may be argued that the situation under US and European patent law differs. Nevertheless, even given the role Article 69 EPC assigns to the description when interpreting the claims, the claims of a European patent will have a deterrent effect, at least in practical terms, even in case of a narrowing statement that can be found in the description.<sup>9</sup>

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<sup>9</sup> It could be argued that in a formal freedom-to-operate (FTO) search, the description of any patent identified as relevant should be studied in depth (as follows from Art. 69 EPC). While not incorrect, this is an incomplete picture. Enterprises navigate competitors’ patents not only by way of formal FTO searches. See, illustrative, M. Marcolongo, *Academic Entrepreneurship: How to Bring Your Scientific Discovery to a Successful Commercial Product*, 2017, p.146: “you [as an

17. The BRI rule should not be understood as an instruction to read the claims in isolation (which would be a neutral rule) but as an instruction against “importing *limitations* from the specification”. Indeed, my analysis started in §12 from the observation that the BRI rule is biased against the proprietor. As we will see, this bias is seen as justified in the US case law and can be seen as a proportional measure in European patent law (§19).
18. US case law explains that “claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified”.<sup>10</sup>

However, “in district court adjudications [*viz.* infringement cases], where the [proprietor] lacks the ability to correct errors in claim language and adjust the scope of claim protection as needed, the broadest reasonable interpretation standard does not apply.”<sup>11</sup>
19. If we frame the broadest reasonable interpretation rule as applied by the EPO as a limitation – i.e. not necessarily a violation – of the procedural principle of equal treatment of the parties in opposition proceedings before the EPO<sup>12</sup> and apply a proportionality test,<sup>13</sup> the arguments given in the U.S. case law correspond to the

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academic entrepreneur] may be asked about competing IP and it is good to have a general background, even informally by your own doing, to minimize your risk of infringement”. Marcolongo mentions this directly after describing an FTO as a “pricey endeavor” that is done “later, as your product gets closer to commercialization”. Thus, informal patent landscaping exercises will impact the entrepreneur's allocation of time and resources (Marcolongo recommends informal patent landscaping to ‘minimize your risk’, implying that the entrepreneurs adapt their strategy). Ideally, the deterrent effect of patent *claims* on resource allocation is confined to patentable subject-matter, even at the early stages of product development, notwithstanding the possible argument that the actual scope of protection of the patent (i.e. as determined by a national court in infringement proceedings under Art. 69 EPC), is possibly already limited to the patentable subject-matter because of the narrowing statement in the description.

<sup>10</sup> *In re Prater*, 56 C.C.P.A. 1381, 415 F.2d 1393, 1405 (1969), cited in *In re Cuozzo*, 793 F.3d 1297 (Fed. Cir. 2015; denial of rehearing) (dissent of Prost et al.).

<sup>11</sup> *In re Cuozzo* 793 F.3d 1297 (Fed. Cir. 2015; denial of rehearing) (dissent of Prost et al.) citing *In re Yamamoto*, 740 F.2d 1569 at 1572 (internal quotations omitted). The relevant statutory provision was amended in 2018 (see 83 FR 51340).

<sup>12</sup> See G 1/86, point 13 of the reasons: “the general principle of equality before the law and thus before the courts which administer that law”, point 14: “The principle of equal treatment of parties to court proceedings must therefore also be applied to proceedings before the Boards of Appeal of the EPO.”

<sup>13</sup> I.e., a measure is proportional if it is (a) suitable to achieve the desired end, (b) is necessary to achieve the desired end, and (c) does not impose a burden on the individual that is excessive in relation to the objective sought to be achieved (proportionality in the narrow sense) (source: EU Glossary, <https://eur-lex.europa.eu/EN/legal-content/glossary/principle-of-proportionality.html>).

analysis that the rule is suitable and necessary to achieve the desired aim and, because of the possibility to amend the claims, does not impose a burden on the proprietor that is excessive in relation to that objective.<sup>14</sup>

20. The justifications given in the case law of the Boards of Appeal are essentially the same. As held in T 1208/21,

“in the context of the requirements of Article 54 and 56 EPC, a technically reasonable and not illogical understanding of the claim wording cannot be restricted by reference or an amendment to the description. In such a situation, it would, rather, be the claim wording that would require amendment” (referring to T 454/89, point 4.1(viii) of the reasons).
21. Similarly, T 2548/19 held that:

“according to established case law, for the purposes of judging novelty and inventive step, Article 69 EPC and its Protocol cannot be relied on to read into a claim an implicit restrictive feature that is not suggested by the explicit wording of the claim. In proceedings before the EPO, where the patentee has the opportunity of cutting down the claims to accord with stricter limits given in the description, the scope of a claim should not be cut down by implying into it features which appear only in the description, as this would deprive claims of their intended function”.
22. T 2081/22 held that (in the different context of Article 84 EPC):

“[...] due to the fact that in opposition and appeal proceedings before the EPO, the patentee has in principle - irrespective of the question of the admittance of late submissions - the opportunity to amend the claims to bring them into line with more specific passages of the description. Thus, a claim should not be interpreted in a specific sense by implying into it features which appear only in the description, as this would go contrary to the requirement of clarity and would deprive claims of their intended function.”
23. The above observations provide historical background to the matter of claim interpretation in patent office procedures where the applicant and proprietor can still amend the application, respectively, the patent. They may also help to translate the historically given reasons for the rule into a modern proportionality test.

### *C. Turning to the text of the EPC*

24. Article 52 EPC specifies that the “invention” must be new, involve an inventive step and be susceptible of industrial application. Article 97 EPC refers to “the invention to which [the European patent application] relates”. I suggest that your decision could recall that the term “invention” in this context refers to the invention as claimed (cf. G 2/98, point 2 of the reasons), albeit with some exceptions.

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<sup>14</sup> In my view, proportionality is the suitable test under the EPC to determine whether the bias of the BRI rule is acceptable. However, I wish to express no view on whether the BRI rule (always) satisfies the test: there can be substantive and procedural reasons why some language in the description can not be included in the claims by amendment (e.g., Article 84 and Article 123(2)).

In particular, a first exception applies to the assessment of inventive step: the description of the application as filed can be considered when examining inventive step (G 2/21) beyond its role for claim interpretation.

Moreover, some decisions considered the description as defining the invention in the context of Art. 53 EPC (e.g. T 775/97 (headnote), T 1731/12 (point 15 of the reasons) and T 944/15 (points 17-20 of the reasons)).

G 1/07, point 4.3.2, last paragraph, last sentence, also seems to instruct an examination of the description to determine whether the claimed method of operating a device has any functional link to the effects of the device on the body (in connection with Art. 53(c) EPC).

In connection with Art. 53(a) EPC, G 2/06, headnote 2, refers expressly to “claims directed to products which - as described in the application - at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, even if the said method is not part of the claims”. The decision states in point 22 of the reasons: “what needs to be looked at is not just the explicit wording of the claims but the technical teaching of the application as a whole as to how the invention is to be performed”.

25. The opportunity may also be used to confirm the rule that equivalent embodiments in the sense of Article 2 of the Protocol to Article 69 (introduced by the EPC 2000) are not to be considered as part of the “invention” that is examined when assessing the compliance of a claim with (at least) Articles 54, 56, 83 and 123(2) EPC (T 1473/19, point 3.11.4 of the reasons).<sup>15</sup>

This rule about claim interpretation is distinct from the rule that ‘the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed’ – this latter rule is about the information content of the prior art (Case Law of the Boards of Appeal, 10<sup>th</sup> ed., I.C.4.5; T 167/84).

Confirming this rule about claim interpretation may help to avoid confusion as to why the referring Board limited Question 1 to Article 1 of the Protocol, leaving out Article 2 of the Protocol – especially considering that the Protocol had no separate Article 2 until 2007.

26. Any holdings on claim interpretation should logically extend to Article 83 and to Article 123(2) EPC. It is unclear to me why Question 1 is restricted to Articles 52 – 57 EPC.
27. It is often assumed that the EPO must apply Article 2 of the Protocol in opposition procedures in the context of Article 123(3) EPC (see T 439/22, point 3.2.1 of the reasons). However, this is not cast in stone, and an examination of Article 123(3)

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<sup>15</sup> Question 1 specifically refers to Art. 52 – 57 EPC, thereby adding Art. 52, 53, and 57 compared to T 1473/19 and omitting Art. 83 and 123(2). It is unclear to me if the difference is meaningful.

EPC in connection with the possible effect of post-grant amendments on the protection for equivalent embodiments under Article 2 of the Protocol could be more properly a role of national courts.

*D. The role of the description for second (non-medical) use claims*

28. Furthermore, the present referral may provide an opportunity to revisit the remark in G 2/88, point 9.1, that “the claim in question [*viz.*, “use of (certain compounds) for controlling fungi ...”] should properly be construed, *having regard to the Protocol to Article 69 EPC*, as implicitly including the following functional technical feature: that the named compounds, when used in accordance with the described means of realisation, in fact achieve the effect (i.e. perform the function) of controlling fungus” (emphasis added).
29. In particular, it may be useful to clarify whether the interpretation of a claim directed to the “use of [substance] for [purpose]” as implicitly including the functional technical feature of “in fact” achieving the effect or purpose recited in the claim (and not merely as “suitable for”) really depends on the specific contents of the description, as suggested by the reference to the Protocol to Article 69 EPC in said part of point 9.1 of the reasons of G 2/88.
30. It is submitted that, at least under the current case law of the Technical Boards of Appeal, the interpretation of the phrase “use of ... for ...” in a claim does *not* depend on the specific content of the description and, accordingly, said interpretation is not based on an application of Article 69 EPC (or the Protocol thereto), at least not in the same way as Article 69 EPC is applied in infringement proceedings (the latter usually being a highly fact-specific exercise). Rather, the functional technical feature is assigned to the specific claim wording “use of ... for ...” through legal fiction (*von Rechts wegen*).
31. On the other hand, the Enlarged Board, in the last sentence of point 9.1 of the reasons of G 2/88, concluded that “if the proper construction of such a claim in the context of a *particular* patent is such as to include such a functional technical feature, the question which remains to be considered is whether such claimed invention is novel.” (emphasis added).
32. Furthermore, whether or not the description teaches how to carry out the claimed use so as to achieve the effect recited in the use claim (cf. G 2/88, point 9.1 of the reasons, second sentence) appears to be relevant to Article 83 EPC, not to the patentability of the claim under Article 54 EPC or Article 56 EPC (cf. G 2/21, points 74 and 77 of the reasons for second medical use claims).

*E. An inconsistency between the claims and the description  
that has to be lived with*

33. Assuming that the Examining Division understood the term ‘gathered sheet’ according to its standard meaning in the relevant technical field, the broader definition of the term in the description is inconsistent with the claims as granted. However, Article 84 EPC is not a ground for opposition, and the inconsistency “has to be lived with” (G3/14, point 55 of the reasons). The present referral can be understood as an enquiry about the mode of doing so.

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34. The above observations are my personal views only.

Respectfully submitted,

*/ Peter de Lange /*

c/o V.O. Patents & Trademarks  
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