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In accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal regarding the referral pending under G 1/24, a written statement is submitted.

**Introduction**

With decision T 439/22 of 24 June 2024, a referral was made to the Enlarged Board of Appeal, EBA, seeking to clarify the legal basis for interpreting patent claims for the purpose of assessing patentability, whether and under which circumstances the description and figures may be taken into account when interpreting a patent claim and, finally, the extent to which a patent can serve as its own dictionary. The referral is pending under G 1/24 - Heated aerosol.

The Questions referred to the EBA thus occasion to address the issue of the scope of application of Art 69(1) (second sentence). This is to be done in the framework of the general principles underlying patent protection, the EPC, EPC case law and accounting for legal certainty for all users of the EPC.

This analysis begins by establishing the core legal provisions of the EPC that underpin patent interpretation, focusing on Articles 69, 83, 84, and related boundaries defined in Article 123, which together create a unified framework that links claims with the description and drawings. This is followed by a discussion of legal certainty, emphasizing the importance of consistent interpretation practices to maintain the reliability of patent protection across both EPO and national proceedings. Key EPO case law, including decisions by the Enlarged Board of Appeal, is then examined to illustrate how these principles are applied consistently within the EPO. Finally, the analysis explores current practices in national courts, such as the German Federal Court of Justice and the Unified Patent Court, showing how these courts align with EPO principles to ensure coherence in patent interpretation across jurisdictions.

### **Core Legal Provisions**

In the following, some core legal provisions are discussed that establish the foundational framework for interpreting claims.

Patent protection provides exclusivity to the patent holder, but this is counterbalanced by the requirement to disclose the subject matter of the invention to the public. This disclosure encompasses the entire patent, including the claims, description, and drawings. Art. 84 EPC states that the claims shall define the subject matter for which protection is sought, and this must be supported by the description. Art. 83 EPC requires that the invention be sufficiently disclosed in the description so that a person skilled in the art can carry it out. Thus, both the claims and the description form a unified whole, together fulfilling the determination of the subject matter of the invention and the obligation of disclosing the invention to the public.

Furthermore, Art. 69 EPC establishes the rule for determining the extent of protection: *“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.”* This gives the public and the courts a framework to understand the scope of protection of the claims through the description and drawings, reinforcing the idea that the claims and description form a unified whole. It is evident that some level of interpretation is inevitable when determining the scope of protection, as natural language cannot fully encapsulate the technical content of an invention.

While the original invention is typically limited to specific embodiments that the inventor had in mind, the extent of protection is broader. It covers an infinite range of embodiments infringing the claim, including equivalent solutions that may evolve over time and could not have been foreseen at the time of filing. This flexibility allows the scope of protection to adapt to future technological developments.

However, the question arises to what extent claim interpretation is allowable. In addition to the general rule of Art. 69(1) EPC, the EPC provides clear boundaries to ensure legal certainty during interpretation:

The interpretation of patent claims is subject to specific limitations to ensure that protection does not extend to unpatentable subject matter. Under Articles 52, 53, 54, 56, and 57 EPC, the scope of interpretation must be confined to patentable subject matter only. This restriction helps maintain a clear boundary around what can legally be protected, ensuring that a patent does not inadvertently cover areas that are explicitly outside the scope of patentable inventions, such as prior art, abstract ideas or scientific theories.

Additionally, the interpretation of claims must not introduce any new subject matter that was not originally disclosed in the application. Article 123(2) EPC explicitly prevents the addition of any features or content beyond what was initially filed, which serves to protect the integrity of the original disclosure and uphold the principle that a patent applicant cannot later add elements that were not part of the initial filing. This limitation ensures that the scope of protection aligns with the invention as originally presented, thereby providing certainty to third parties about the boundaries of the patent.

Furthermore, there can be no extension beyond the claims as granted. According to Article 123(3) EPC, once a patent is granted, the proprietor cannot expand the scope to recapture any subject matter that was deliberately excluded or removed during the prosecution phase. This prevents patentees from broadening their claims after grant, thus offering stability in the interpretation of the patent's scope and protecting third parties from unexpected claim expansions.

Finally, there is a primacy of claims in determining the extent of protection. Articles 69 and 84 EPC establish that the claims are the primary determinant of the scope of protection. Although the description and drawings provide context and help clarify the claims, they cannot independently define the extent of protection. According to established case law, content that appears only in the description or drawings cannot be read into the claims, which maintains the claims as the primary basis for interpreting patent scope. This approach ensures that the claims alone set the boundaries of protection, with the description and drawings acting only as interpretive aids rather than expanding the patent's reach.

In conclusion, the core legal provisions—Articles 69, 83, 84 EPC in combination with Art. 123 EPC—establish the foundational relationship between claims, description and drawings, emphasizing their unified role in defining the technical scope and resolving ambiguities.

## Legal Certainty

Legal certainty is essential in any legal system, as trust in valuable assets like patents forms the foundation of innovation and investment. For patentees, it is crucial to rely on consistent treatment of their inventions concerning patentability, both by the EPO during the examination phase and by national courts that may later assess the patent's validity. This consistency ensures that a patent's scope and protection remain stable and predictable, reducing the risk of differing interpretations that could undermine the patent's value.

Thus, for the sake of legal certainty, a patent claim must have an unambiguous basis from which its scope of protection is determined. Potential issues could arise if the European Patent Office (EPO) were to limit itself to examining the patentability requirements (Art. 52, 53, 54, 56, 57, and 123 EPC) only up to the grant stage, while national courts and the Unified Patent Court (UPC) additionally apply Art. 69 EPC during nullity proceedings. Differences in how the subject matter is determined pre- and post-grant would compromise legal certainty. It is therefore essential that the principles for determining the subject matter of the invention before grant and after grant (explicitly taking into account Art. 69 EPC) remain consistent.

Since the extent of protection is inherently based on the same originally disclosed invention, the principles for determining the subject matter of the invention before grant and after grant must lead to the same result when interpreting the patent's disclosure. The interpretation of a patent must therefore always consider the claims together with the description and drawings to ensure consistency in the protected subject matter while allowing for flexibility in covering future equivalents.

## Basis in EPO Case Law

While the previous sections have demonstrated, from both a legal provision standpoint and the perspective of legal certainty, that claims and descriptions should be interpreted together throughout the patent prosecution phase at the EPO, the following section delves into key EPO case law. This case law analysis illustrates how consistent interpretation principles are applied in line with Article 69 EPC, reinforcing a unified approach to claim interpretation and ensuring clarity within EPO proceedings.

The Enlarged Board of Appeal (EBA) in its decision G2/88 considers whether in opposition 'A change of claim category from a 'compound' to a use of the compound for a selective purpose complies with Art.123(3). In rn. 3.3 the EBA finds that Art. 69 EPC is to apply both in proceedings before the EPO and in national courts (and the UPC) when it is necessary to determine the protection which is conferred.

In G6/88, the EBA considers whether in examination, *'Use itself of a compound for a particular purpose constitutes a novel feature pursuant to Art. 54'*. In rn. 2.5 the EBA finds that *the purpose of Art. 84 is to enable determination of the protection, which is to be determined by the rule of Art 69, having regard to the patentability requirements of Art 52-57*. The EBA (rn. 3) finds that *'For determination of the technical features the claim must interpreted in accordance with Art. 69 EPC*. In rn. 7, the EBA expands this as *proper interpretation of the claim will normally be such that the attaining of a new technical effect which underlies the new use is a technical feature of the claimed invention*.

Thus, the EBA has held as its position since the early days of the EPC that the determination of the subject matter for which protection is sought (Art. 84) and the extent of protection (Art. 69) are linked and both to be applied in proceedings before the EPO.

The decision T1473/19 states: *'Article 69 EPC in conjunction with Article 1 of the Protocol thereto can and should be relied on when interpreting claims and determining the claimed subject-matter in proceedings before the EPO, including for the purpose of assessing compliance with Article 123(2) EPC'* (catchword 1). Further, *'Interpreting the claimed features for the purposes of establishing patent claim's extent of protection is thus not different from interpreting and determining the claimed subject-matter for the purposes of assessing compliance with Articles 54, 56, 83 and 123(2) EPC.'*(rn. 3.11.3). This approach strengthens legal certainty as this prevents the extent of protection to expand beyond what is defined by the features of the claim.

### **Current Practice in National Courts and the Unified Patent Court**

The principles of claim interpretation under the EPC are not only central to EPO proceedings but also play a crucial role in patent nullification and litigation before national courts and the Unified Patent Court (UPC). Thus, since Art. 69 EPC is also used in national and UPC nullification proceedings for claim interpretation, the outcome of EPO opposition proceedings and national (or UPC) nullification proceedings must remain consistent.

The German Federal Court of Justice (BGH) regularly applies Art. 69 EPC for claim interpretation in nullification proceedings. According to its decision **Polymerschaum-I** (BGH X ZR 117/11), the examination of patentability, especially in nullity proceedings, often requires an interpretation of the patent claim. The claim's meaning must be understood as a whole, and the contribution of the individual features to the purpose and outcome of the invention must be determined. A claim cannot be assigned a particular meaning simply to avoid inadmissible broadening beyond the original documents. The court clarifies in paragraph 27 of this decision: "In this context, the description and drawings must be considered, as they explain and illustrate the technical teaching of the patent claim. According to established case law, they are not only to be consulted for determining the scope of protection (Art. 69(1) EPC, § 14 PatG.), but also for the interpretation of the patent claim, regardless of whether this interpretation serves as the basis for an

infringement assessment or for examining the patent claim's patentability."

Similarly, the Unified Patent Court of Appeal applies Art. 69 EPC for claim interpretation in nullification proceedings. In the **10x Genomics** decision, the Court of Appeal emphasized that according to Art. 69 EPC and its Protocol, the patent claim is the starting point and the decisive basis for determining the scope of protection of a European patent: The interpretation of a patent claim is not limited to its exact wording in a linguistic sense. Instead, the description and drawings must always be used as explanatory aids for interpreting the patent claim. These aids are not only used to resolve ambiguities but to ensure that the claim reflects the inventor's intended scope of protection. However, this does not imply that the patent claim merely serves as a guideline, extending the scope to cover anything that appears in the description or drawings. The patent claim must be interpreted from the perspective of a person skilled in the art.

Hence, current practice of the German national court as well as the UPC, is that the description and drawings should be consulted for both determining the scope of protection as for examining patentability.

## **Conclusion**

Based on (i) the general principle that both the claims and the description form a unified whole, (ii) the EPC itself providing clear boundaries to ensure legal certainty during interpretation, (iii) the necessity of legal certainty, and (iv) various decisions of the EBA that confirm the applicability of Art. 69(1) EPC regarding both the extent of protection and the subject matter for which protection is sought, the interpretation of a patent must therefore always consider the claims together with the description and drawings.

From this conclusion, the following answers are formulated to the specific questions referred to the EBA in the case G1/24:

## Responses to Key Questions

1. **Is Article 69(1), second sentence EPC and Article 1 of the Protocol on Interpretation of Article 69 EPC applicable when assessing the patentability of an invention under Articles 52 to 57 EPC?**
  - **Answer:** Yes, this has already been established by the case law of the EBA (decision G6/88).
2. **May the description and figures be consulted when interpreting claims to assess patentability? If so, under what conditions?**
  - **Answer:** Yes, the description and figures may be consulted, but only to the extent that features not present in the granted claims cannot be read into them. Restricting the interpretation of the claims only in cases of ambiguity would upset the balanced relationship between claims and descriptions and harm legal certainty.
3. **May definitions or similar information in the description be disregarded when interpreting claims to assess patentability, and if so, under what conditions?**
  - **Answer:** No, definitions in the description cannot be disregarded. The applicant is responsible for the wording of the application, including the claims and the description. In case the applicant decided to give claims features a specific meaning via the description, this is to be respected. If there is an inconsistency between the claims and the description, this could result in a violation of Art. 83 EPC, which could form grounds for opposition under Art. 99 EPC.

Yours faithfully



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