



Registry of the Enlarged Board of Appeal
European Patent Office
80298 Munich
Germany

For the attention of Mr. Nicolas Michaleczek
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**Re: Enlarged Board of Appeal case G 1/24 (Heated Aerosol)
Amicus brief from the Chartered Institute of Patent Attorneys**

About the Chartered Institute of Patent Attorneys (CIPA)

The Chartered Institute of Patent Attorneys (CIPA) is the UK's largest intellectual property membership association. CIPA is the professional body for the patent attorney profession in the UK, representing over 2,800 Chartered Patent Attorneys, 1,000 student patent attorneys, 700 IP Paralegals and other legal professionals specialising in intellectual property. In total, CIPA has over 4,800 members and the UK patent attorney profession generates in excess £1 billion annually for the UK economy.

CIPA represents its members' interests and the interests of users of the IP system to the government in the UK and to international stakeholders, including national intellectual property offices, the European Patent Office (EPO) and the World Intellectual Property Organisation (WIPO). CIPA has an unrivalled reputation as a trusted voice for policy formers and decision makers in the UK and internationally.

Questions

The following questions have been referred to the Enlarged Board of Appeal by Technical Board of Appeal 3.2.01 in case T 439/22 by interlocutory decision of 24 June 2024 ("the interlocutory 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?

Legal Context - EPO

The reasons for the referral are set out comprehensively in section 3 of the interlocutory decision. Section 3.2 of the interlocutory decision indicates divergence in case law as to whether Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC (hereafter "Article 69 and Protocol") should be applied by the EPO in assessing patentability, or only in assessing whether post-grant amendment had extended the scope of protection. The former position is suggested to be consistent with earlier Technical Board of Appeal decisions and G 6/88, whereas the latter position is suggested to be rooted in a line of cases originating from G 2/88. This gives rise to Question 1. Section 3.3 of the interlocutory decision relates to whether the description may be taken into account, or may only be taken into account, when the wording of the claim on its own remains unclear or ambiguous. The interlocutory decision notes that this question has not previously been determined by whether or not Article 69 and Protocol were used in assessing patentability, but does note that where Article 69 and Protocol have been used, the description and figures

have generally been taken into consideration in any case. A wide range of positions is identified in the Technical Board of Appeal decisions, and this leads to Question 2. Section 3.4 of the interlocutory decision relates to whether definitions or similar information given in the description for certain terms should influence the interpretation of those terms when used in the claims – in essence, whether a patent specification can be its own dictionary. The interlocutory decision again identifies a wide range of positions taken in Technical Board of Appeal decisions, some influenced by whether or not Article 69 and Protocol are applied, and others apparently not: whether the claims are clear in themselves; compatibility of the alternative definitions, for example whether the “in-specification” definition is consistent with the normal understanding of the term by the person skilled in the art; and opportunity to address any mismatch in prosecution have all been raised as factors. This leads to Question 3.

Legal Context – outside the EPO

As is noted in the interlocutory decision, claim construction by the European Patent Office has to be seen within the greater context of the patent protection system as a whole. There are two main considerations in considering the bearing of the wider legal context on these questions. One is the application of Article 69 and Protocol by national courts and most recently the Unified Patent Court. Another is the practice of patent offices worldwide in assessing patentability, particularly in relation to the Patent Cooperation Treaty (PCT).

It is not a matter of contention that national courts necessarily apply Article 69 and Protocol when determining the scope of protection provided by the claims. This is required for determination of patent infringement, but also for determination of patent validity. As noted in the interlocutory decision in section 4.3, decisions in the French, German and British courts involving the construction of patent claims generally either explicitly reference application of Article 69 and Protocol or otherwise refer to the need to interpret the claims in the light of the description. This approach has been followed in the early decisions of the Unified Patent Court.

National court decisions typically apply a common approach to interpretation of claims for assessing validity and for assessing infringement. In general, the only practical issue that creates a further consideration in determining the scope of protection is the doctrine of equivalents - however, interpretation of the claim arises before the doctrine of equivalents is considered.

Many European applications derive from international applications under the Patent Cooperation Treaty (PCT). The PCT was signed on 19 June 1970 and entered into force on 24 January 1978. This is broadly contemporaneous with the European Patent Convention (EPC), which was signed on 5 October 1973 and entered into force on 7 October 1977. Both the PCT and the EPC were considered to be steps along the way to harmonisation of patent law and practice using more efficient processes, promoting exchange and availability of technology and to enable applicants to secure stronger patents. Today an international application can result in a patent in up to 158 different countries, using a single patent specification with a common description, drawings and claims. Patentees have a strong interest and reasonable expectation that such a single patent specification will be interpreted using similar principles from jurisdiction to jurisdiction, and that convergence in interpretation will generally be preferred to divergence.

Suggested Responses to Questions

1. Yes.

We agree with the referring Board that there is a clear divergence in the EPO case law, and that it is appropriate for the Enlarged Board to rule on this question. We consider that G 6/88 indicates that the answer to this question should be “yes”, and that nothing in G 2/88 contradicts this view. While certain EPO case law – primarily G 1/98 and G 1/12 – does indicate a distinction between requirements for patentability and the extent of protection, nothing appears to provide a clear basis for establishing different rules for claim interpretation in determining patentability and in establishment of the scope of protection.

Moreover, it should be noted that a negative answer would create several practical problems. Firstly, it creates a divergence between claim interpretation at the patent granting stage and the patent litigation stage – which generally use Article 69 and protocol to determine the scope of protection - that will increase uncertainty and cost both to patentees and third parties. Secondly, this would result in divergence in the pre-grant processes between issues that require the assessment of the description to determine the intended meaning of the applicant (such as Articles 92 and 123(2) EPC) and issues that must be assessed according to the claim language without reference to the description where possible (which would here be Articles 52 to 57 and 84). This inconsistency in procedure creates genuine difficulty for the applicant. In

consequence, thirdly, the central importance of the literal wording of the claim would make resolution of any issues relating to clarity of the claims pre-grant critical – however, as Article 84 is not a ground of opposition, this widens what may already be considered a lacuna in the ability of third parties to challenge European patents without using the national courts. Fourthly, if the claims are to be interpreted differently in determining patentability and in determining the scope of protection, this in itself creates uncertainty for third parties – in determining what is available for use, their reliance on the findings of the EPO must necessarily be limited, and they will need to focus primarily on the findings of the national courts. In summary, a positive answer appears consistent with the general structure of the EPC and allows for procedural consistency and reasonable certainty for both the applicant and third parties. A negative answer would lead to greater uncertainty for all stakeholders in the patent process.

2. Generally, but the significance of the description and figures in the assessment of patentability must be considered case-by-case.

If the answer to question 1 is “yes”, then the only logical answer to this question is “generally”. As noted in section 4.3 of the interlocutory decision, case law throughout the national courts of France, Germany and the United Kingdom, and now in the Unified Patent Court, supports the position that in application of Article 69 and Protocol the claims and description should be considered generally. This is clearly expressed in Article 1 of the Protocol. This is clearly present in the leading United Kingdom cases of *Kirin Amgen Inc. v Hoechst Marion Roussel* and *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd*, and now in the decision of the Court of Appeal of the Unified Patent Court in *Nanostring v 10x Genomics*. Consideration of the description and figures is necessarily intertwined with considerations relating to assessment of patentability – for example, understanding of the full patent specification may be necessary to determine the identity of the person skilled in the art, which is a necessary prerequisite to assessment of Article 56 EPC. These considerations arise through the whole life of the patent application and granted patent, from search (where Article 92 EPC – used by the Search Division to determine the parameters of the search - indicates explicitly that due regard should be given to the description and any drawings) through examination and grant.

“Generally” however, requires some qualification. As noted in the interlocutory decision in section 3.3, there is a wide diversity in the case law as to the effect of considering the description and drawings in interpretation of the claims. This is to be expected, as there are a wide range of factors to be considered, in particular in the interpretation that would be given to the claims, the description and the drawings by the person skilled in the art, in the light of their existing skills and knowledge. Consequently the actual extent to which the description and figures should be considered, and the extent to which they can be used to clarify, modify or otherwise interpret the literal wording of the claim should be considered case-by-case considering all relevant factors.

3. A definition or similar information given in the description on a term used in the claims should generally be considered, but the weight given to it must be considered case-by-case.

The position here is similar to that for question 2 – if the answer to question 1 is “yes”, then again the only logical answer to this question is that such a definition should generally be considered, but qualification is again required. As noted in section 4.4 of the interlocutory decision, decisions in the French and German courts explicitly allow for the description to act to some degree as a dictionary, and leading decisions in the United Kingdom and the recent decision of the Court of Appeal of the Unified Patent Court in *VusionGroup v Hanshow* emphasise that interpretation of terms used in claim wording, as considered from the perspective of the person skilled in the art based on their common general knowledge, should take into account the reading of those terms in the light of the description and drawings. The recent Dusseldorf Local Division case of *SodaStream v Aarke* in reciting the case law of the UPC on interpretation at the time of the decision stated that “the description and the drawings may show that the patent specification defines terms independently and in this respect may represent a patent’s own lexicon. Therefore, even if the terms used in the patent deviate from common usage, it may therefore be that the meaning of the terms resulting from the patent specification is ultimately authoritative”.

Question 3 is similar to question 2, in that application of this finding in practice again requires the consideration of a wide range of factors, not least establishing the common general knowledge of the person skilled in the art and the extent to which there is a recognised meaning to the term at issue, and the extent to which any definition from the description differs from such a recognised meaning. Consequently the actual extent to which any definition or similar information given in the description for a term may be used to interpret that term in the claims should be considered case-by-case considering all factors relevant to interpretation. It should be noted that it is not apparent that this question needs to be answered to address the issue arising in T 439/22. In T 439/22, the definition given in the description does not *require* that rolled configurations are included. It merely fails to exclude them *explicitly*. The definition in the

specification therefore only requires interpretation, and there is no need for the definition, as being part of the description, to be ignored.

International considerations are particularly relevant here. As noted, many European applications are derived from International applications. In filing a patent application under the PCT, an International patent applicant has a legitimate expectation that having only a common description will not compromise protection in any jurisdiction. In a number of different jurisdictions strong patents are more likely to be achieved should the description feature definitions, either in view of local case law (e.g. the US) or in the light of local clarity requirements and local linguistic considerations (e.g. China). Complete disregard of definitions in the specification would not only lead away from patent harmonisation, but would lead to a divergence in interpretation across jurisdictions that would increase uncertainty for patentees and third parties alike.

This referral does not explicitly relate to the question of amendment of the description for conformity with the claims, though paragraph 4.1.1 of the interlocutory decision does state that “it is of utmost importance that the subject-matter examined by the European Patent Office during grant and opposition proceedings be identical to the subject-matter taken as the basis for allowing monopoly protection by the national courts of the member states once the European patent is in force.” Here we would note that amendment to the description after the examination process has established claims, but before grant, risks changing the subject-matter in the granted patent from the subject-matter examined. Such a change may not only constitute added matter, but also lead to differences in determination of the extent of protection of claims between prosecution and post-grant proceedings.



Lee Davies
Chief Executive