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**Written Statement in accordance with article 10 of the
Rules of Procedure of the Enlarged Board of Appeal**

Introduction

UNION of European Practitioners in Intellectual Property (UNION-IP) is an association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related questions and who carry on their profession independently or as employees. UNION-IP aims on the one hand to work continuously on current developments in intellectual property in Europe, especially by making submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European practitioners in the intellectual property field in different countries and different branches of the profession.

The Reference to the Enlarged Board of Appeal

UNION-IP welcomes this referral to the Enlarged Board of Appeal (EBA) and trusts that this will increase legal certainty and improve clarity regarding the question of whether to consult the description and figures during interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC. UNION-IP considers that the reference to the EBA is admissible. UNION-IP files the present amicus curiae brief in order to assist the EBA in its deliberations.

The referred point of law

In T 439/22 (24 June 2024) a Technical Board of Appeal (TBA) decided to refer the following questions to the EBA, both to ensure the uniform application of the law [see point 3] and because a point of law of fundamental importance arises [see point 4]:

Question 1

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?* [see points 3.2, 4.2 and 6.1]

Question 2

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?* [see points 3.3, 4.3 and 6.2]

Question 3

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?* [see points 3.4, 4.4 and 6.3]

The referral is based on conflicting decisions T 1473/19 and T 169/20.

Position of UNION-IP

The referred questions led to healthy discussions between the members of UNION-IP. While a significant majority of the members of the Patent Commission and the Software commission support the following position, it should be noted that some members have provided strong arguments in favour of a positive answer to Question 1.

All questions

As Lord Justice Jacob said obiter dictum in *European Central Bank v DSS* [2008] EWCA Civ 192: *“Professor Mario Franzosi likens a patentee to an Angora cat. When validity is challenged, the patentee says his patent is very small: the cat with its fur smoothed down, cuddly and sleepy. But*

when the patentee goes on the attack, the fur bristles, the cat is twice the size with teeth bared and eyes ablaze.”

UNION-IP believes this angora cat situation should be avoided at the EPO vs national courts. In order to provide legal certainty, any result relating to the interpretation of patent claims when assessing the patentability of an invention should ideally not differ during any of examination, opposition, validity or infringement proceedings. In other words, any difference in the basis for the evaluation of validity before the EPO or a court, be it a national court or the UPC should be avoided.

Whilst the situation should not arise where taking the description and drawings into account results in the extent of protection including subject matter which has not been assessed for patentability, this would only be a potential situation in those Contracting States with bifurcated patent systems and that is not a concern of the EPO.

Question 1

No, Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC is not to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC.

Whilst courts across Europe, now including the UPC, need to be aligned as far as possible with how they interpret granted patents for infringement as well as validity, Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC should not be of primary concern when assessing the patentability of an invention under Articles 52 to 57 EPC.

Article 69 EPC was drafted to harmonise possible divergent interpretations of a European patent by National courts, giving guidance for claim interpretation during national proceedings so as to give the Applicant legal certainty.

Article 69(1) EPC provides that *'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.'* It is noted that this Article does not differentiate between the extent of protection for a European patent application and the extent of protection for a European patent. Therefore, when asserting a European patent application with provisional

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protection in national court proceedings, this provision could and should be relied on for both infringement and validity. This does not, however, mean that Article 69 EPC applies to patent applications during examination of the patentability requirements by the EPO.

That being said, the 'extent of protection' relates to the scope of a patent (or of provisional scope in the case of a published application), not to the question of patentability.

As noted in the recent Decision T 56/21, it is not the task of the EPO as a patent examining authority, but for the national courts (and other authorities) of the Contracting States, which are responsible for patent infringement proceedings, to determine the extent to which protection is to be conferred.

In this Decision, the Board gave a clear steer away from use of Article 69 EPC in interpreting the claims for the purpose of examining an application. For example, in paragraph 30: *"In fact, the assessment of patentability, which is a task entrusted to the examining divisions of the EPO alone, should be kept separate from the determination of the extent of protection conferred by a patent, which is a matter for consideration by national courts in infringement proceedings."* and in paragraph 32: *"Hence, outside of Article 123(3) EPC (and Article 138(1)(c) EPC) there is no justification for applying Article 69 EPC and the Protocol in respect of any requirement of the Convention to be met by a European patent application."*

This Decision also points to the obiter dictum in decision G2/12: *"A distinction needs to be made between, on the one hand, the aspects of patentability and, on the other hand, the (protective) effects of European patents or patent applications. The EPC clearly provides for such a clear division, as the requirements for patentability are governed by Articles 52 to 57, 76, 83, 84 and 123 EPC whereas the extent of protection and the rights conferred by European patents or patent applications are specified in Articles 64(2) and 69 EPC in particular."*

The majority of the members of UNION-IP agree with this stance and believe the Angora cat may instead be prevented by the answers to Q2 and Q3. However, a minority does consider the application of Article 69 EPC in the assessment of patentability under Articles 52 to 57 EPC to be the best way to ensure uniform claim interpretation before the EPO and the Unitary and national courts.

Question 2

Yes, the description and figures may be consulted when interpreting the claims to assess patentability, particularly if doing so broadens the interpretation when compared to what is arrived at when the claim is read in isolation.

By way of a hypothetical example, if a claim has wording that on the face of it would appear to be clear to the skilled person but the supporting description provides a broadening interpretation by way of a range of examples intended to be covered by the claim wording, it would not be correct to take only the narrow wording of the claim and ignore the broader interpretation from the description because this would enable the applicant/proprietor to argue for a narrow interpretation to obtain grant or maintenance of the patent, following which they could argue for a broader interpretation for infringement. File wrapper estoppel would not be an appropriate counter to this, because this is not uniformly applied across Europe. The converse, however, should not be a problem because, if a term in a claim is broad and would clearly be understood as such by the skilled person but the description imparts an unambiguously narrower interpretation on the term, granting such a claim would not adversely affect third parties because any infringement issue is for the national (or UPC) courts to decide, i.e. whether such courts interpret the term for infringement broadly or narrowly.

In line with the German Federal Court of Justice (for example BGH decision of 29th June 2010 – X ZR 193/10, GRUR 2010, 858 marginal no. 13f which states that according to established case law, the objective on patent interpretation requires that no distinction be made as to whether the interpretation is made to assess patentability or to examine whether the patent is infringed), the description and drawings must always be considered in order to arrive at an understanding of the claims because the description and drawings **may** contain definition of terms and **may** indicate how certain language might need to be interpreted. This does not imply limitations from the description and drawings must necessarily be read into the claims, but that the description and drawings **may** be relevant for the understanding of the claimed matter. This is a case-by-case assessment that the skilled reader must exercise to understand a claim.

Furthermore, it is noted that the situation may arise where the description provides for specific definitions of terms used in the claims, even in such cases where the claims are apparently clear. Therefore, a term in a claim that is *prima facie* clear and seems to have a well-defined meaning, may be re-interpreted in the light of a definition provided for that term in the description. As a result,

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in order to correctly interpret the claims in all possible situations, the description may be consulted and definitions used to interpret the claims if the claim is held to be novel without doing so.

UNION-IP submits that Article 84 EPC provides basis for the principle that the description should be consulted for the sake of claim interpretation to assess patentability. However, we appreciate this is only the case during examination, not during opposition.

Article 84 EPC defines that the claims shall 'be supported by the description' and refers to the description for a reason. The reason is *not* that the inventor needs to disclose the invention as a trade-off to obtain a monopoly; that is already covered by Article 83 EPC and the legislator would not have the same requirement in two different articles. Thus, the reference to the description in an article which defines the claims can only mean that there is a relation between the definition by the claims and the explanation of that in the description.

Question 3

Yes, a definition or similar information on a term used in the claims which is explicitly given in the description may be disregarded when interpreting the claims to assess patentability provided the claim is clear by itself and still patentable under Articles 52 to 57 EPC.

If, however, a definition or similar information on a term used in the claims would change or modify the meaning of a term (as understood by the person skilled in the art), or would restrict the meaning of a term, it may not be disregarded, since in that case the Applicant intended to create a special dictionary for that term used.

In other words, if the claim is unclear without the explicit definition or similar information from the description, this explicit definition or similar information should be incorporated into the claim to overcome the issue under Articles 52 to 57 EPC.

This answer to Question 3 is based on the same test applied in Question 2.

In conclusion, UNION-IP is of the opinion that the description and drawings should always be taken into account when interpreting the claims for patentability of an invention under Articles 52 to 57 EPC, especially if the resulting interpretation is a broadening one.



This Amicus Curiae letter is submitted on behalf of UNION-IP and has been drafted by its Patents Commission and Software Commission.

Signed at Brussels on 14 November 2024

Handwritten signature of Reinier Wijnstra in black ink.

Reinier Wijnstra
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Handwritten signature of Rui Gomes in blue ink.

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