

I need you to oppose this patent! Here's some prior art! The claim says ›metal‹...

And your prior art says ›graphene‹.

Graphene isn't a metal though, right?

Unless it's *conductive*. See this definition in the patent?! And guess what graphene is...

So, the patent isn't novel then???

Well... It depends!



# Referral G 1/24

## ›Heated aerosol‹

### Claim interpretation and assessment of patentability

#### Introduction

*Picture this:* A patent attorney is sitting in the office. A client asking to oppose a patent that was recently granted by the EPO, providing a selection of prior art, and requesting an estimate of the chances of the patent being revoked by the EPO. The patent attorney studies the documents and the prior art ›kind off‹ anticipates the subject matter of the granted claims. Kind off – or as a patent attorney might more likely put it: »It depends!«

The patent claim relates to a component comprising a ›metal‹; a term that has a clear and defined meaning to the skilled person. On the other hand, the prior art component is made of graphene.

The specification of the patent to be opposed defines the term ›metal‹ as anything that is electrically conductive. Thus, the definition according to the specification includes materials such as graphene consisting of carbon (a non-metal) which – as the skilled person knows from the common general knowledge – is electrically conductive. On the other hand, such definition may be considered to exclude the metal bismuth, a rare metal which has a very low conductivity to electricity under standard conditions, from the claim.

Whereas the wording of the granted claim read in isolation may be clear and thus excludes a component made of graphene (rendering the claim novel), reading the claim in the light of the patent specification may cover such a component made of graphene.

The interpretation of the claim thus becomes crucial: If the specification of the opposed patent is taken into account (and thus, what might have been intended when the applicant filed the application), the prior art is novelty destroying for the opposed patent. If, on the other hand, the claim is interpreted in isolation accepting the common definition of the term ›metal‹, the subject matter may be novel.

So, what are the ›chances of the patent being revoked‹ in the opposition proceedings? – It depends?!

#### The case underlying G 1/24

The recent referral to the Enlarged Board of Appeal, G 1/24, addresses how inconsistencies between the skilled person's understanding of a term used in a claim and a definition of said term in the specification affect patent prosecution and opposition at the European Patent Office (EPO). The decision is anticipated to significantly affect daily practice, particularly in how claims are drafted, amended, and assessed.

The case underlying G 1/24 originates from T 0439/22, a case involving a patent on ›heat-not-burn‹ tobacco products (European Patent EP 3 076 804). The primary issue revolves around how patent claims should be interpreted in general and the term ›gathered sheet‹ used in the claims in particular.

In answering the question of how to interpret the term ›gathered sheet‹, the referring Board faced divergent interpretations regarding whether the term ›gathered sheet‹ should be understood strictly based on its literal meaning or interpreted in light of the description provided in the patent.

*The referring Board of Appeal considers that said interpretation is decisive for the case:*

In the first instance, the Opposition Division had interpreted the term ›gathered sheet‹ in view of the skilled person's common general knowledge as evidenced by an article in online encyclopedia Wikipedia with the title ›Gather (sewing)‹, i.e. that the term ›gathered sheet‹ had to be interpreted as a sheet that is geometrically modified into a complex shape in analogy to ›gathering‹ as used as a sewing technique (see Decision of the Opposition Division, item 7.2). In other words, a ›gathered sheet‹ is a sheet that has been given a three-dimensional structure, e.g. by being folded along lines to occupy three-dimensional space.

Applying said interpretation, the referring Board came to the conclusion that the subject matter of the opposed patent is novel and inventive over the prior art.

On the other hand, the referring Board observed that the patent specification contains a broader definition of the term ›gathered‹, supporting that a sheet of tobacco material is convoluted, forwarded, or otherwise compressed or constricted substantially transverse to the cylindrical axis of the rod. In other words, the definition of the term ›gathered‹ as used in the opposed patent is broader than what the skilled person would understand from the common general knowledge, i.e. the definition includes embodiments of a sheet being convoluted, such as spirally wound.

Applying said broader interpretation, the referring Board concluded that the subject matter of the opposed patent lacks novelty in view of prior art D1 as cited by the Opponent.

Therefore, the interpretation of the terms used in the claim of the opposed patent was considered to be decisive for the case: When considering the wording of the claim in isolation, the subject matter of the opposed patent is novel and inventive. When considering the definition of the term in the specification of the opposed patent, the subject matter of the opposed patent would lack novelty or inventive step.

**The referral questions and the Amicus curiae briefs**

The first issue as considered by the referring Board was whether the European Patent Convention (EPC) even provides a **legal basis that allows to interpret the claims of an application or patent beyond its literal meaning.**

*The referring Board concluded that there are two possible legal bases for interpreting the claims:*

One of the legal bases as identified by the EPO Boards of Appeal was Art. 84 EPC, which stipulates that the claims define the subject matter for which protection is sought. The second legal basis was found to be Art. 69(1) EPC, which is directed to the scope of protection conferred by a European patent or European patent application, whereas the latter article appeared to be favored by the referring Board. However, Art. 69(1) EPC and the Protocol thereon are directed to the scope of protection (which may cover equivalents), not to the assessment of patentability.

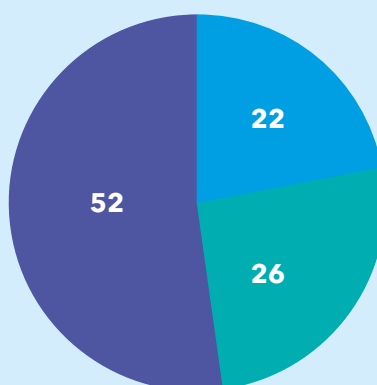
The referring Board faced divergent case law on the question of the correct legal basis for interpreting a claim and identified 100 decisions since 2008 dealing with the question of claim interpretation (cf. T 439/22, reasons 3.2 and 3.3). In essence, the following approaches were identified by the referring Board:

**No**

Art. 69(1) EPC and its Protocol are limited to *scope of protection!*

Decisions either

- refer to **Art. 84 EPC**  
e.g. T169/20
- or
- do not give legal basis



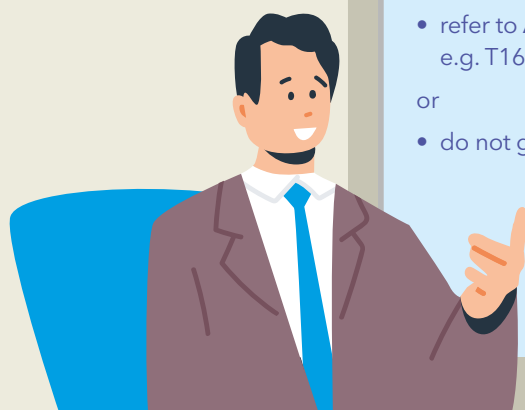
**Open**

No legal provision for claim interpretation given

**Yes**

Art. 69(1) EPC and its Protocol are applicable to *patentability!*

e.g. T1473/19  
T177/22



A total of 52 decisions found that Art. 69(1) EPC and its Protocol do not constitute a legal basis for claim interpretation. Instead, they either referred to Art. 84 EPC (e.g., T 169/20), or no legal basis was identified at all. Furthermore, 22 decisions were found to acknowledge the need for claim interpretation. However, said decisions allegedly do not give a legal basis for claim interpretation at all. Only 26 decisions were identified that actually found Art. 69(1) EPC to constitute a legal basis for claim interpretation given in the EPC.

The referring Board facing said diverging case law, hence, referred the following question to the Enlarged Board of Appeal to clarify the legal situation and to provide legal certainty from a dogmatic point of view:

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?*

Art. 69(1) EPC is the only provision within the EPC that would allow to interpret a claim in view of the specification. For further clarification of the case at hand underlying T 439/22, the referring Board also referred second and third questions to the Enlarged Board of Appeal as follows:

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?*

These referral questions underscore a fundamental tension: Balancing the plain language of claims with the broader context provided by the description and drawings.

The relevance of these questions is highlighted by the fact that several members of the public and institutions have formulated their opinion on these questions in the form of Amicus curiae briefs by the official term of 15 November 2024: A total of 26 amicus curiae briefs were received.

The majority of the European patent attorney community (as far as their opinion could be derived from the Amicus curiae briefs) might generally be of the opinion that the specification should be taken into account when interpreting the terms used in a claim, even when the person skilled in the art finds a claim read in isolation clear. As becomes apparent from the Amicus curiae briefs filed by numerous parties, it appears to be the majority's view that the specification (and figures) of the patent or patent application is to be considered when interpreting the claims.

However, it also becomes clear from the Amicus curiae briefs that the answer to the second and third questions may depend on the question whether a term in a claim is to be interpreted more narrowly or broader than its literal meaning.

There appears to be no dispute (neither in the case law nor in the Amicus curiae briefs) that a term as used in a claim may not be interpreted more narrowly than the understanding of the skilled person in view of the common general knowledge in view of the specification. If, however, an applicant/patentee chooses to define the term, such as the term "metal", in a way that is broader than the understanding of the skilled person in view of the common general knowledge, there appears to be no doubt that said applicant/patentee should be held to such interpretation when assessing patentability.

In other words, the patent attorney community (as far as their opinion can be derived from the Amicus curiae briefs on file) may favor taking the description into account when interpreting claim, at least in situations where the specification contains a definition that goes beyond the understanding of the skilled person in scope.

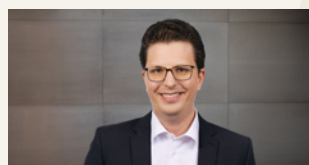
## Outlook

While the President of the EPO has recently decided that examination and opposition proceedings before the first instances of the EPO are not to be stayed in view of the pending referral G 1/24, several Boards of Appeal have decided to await the decision of the Enlarged Board of Appeal.

The Enlarged Board of Appeal recently summoned the parties to **oral proceedings on 28 March 2025**, which underlines its intention to clarify the situation quickly. A written decision may thus be expected in mid-2025.

The outcome of the referral G 1/24 will directly impact how patent applications are ideally to be drafted, examined, and opposed, with implications for both applicants/patentees and third parties.

Clearer guidelines on whether the description needs to be adapted to amended claims will streamline examination proceedings. Applicants may face more or fewer requests to amend the description, depending on the Enlarged Board's decision.



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