

c) Generally accepted meaning of a term in the claims versus definition in the description

In T 177/08, with reference to Art. 123(3) EPC, the board referred to Art. 69(1), second sentence, EPC, which provides that the description and the drawings are to be used to interpret the claims. The board said that it had therefore to be decided whether said interpretation of the claims by the content of the description was limited to cases where the claims were in need of interpretation, e.g. because of functional or unclear features, or whether it also applied to the case at issue, where a **well-known and generally accepted meaning of a term** was overthrown and replaced by a new definition given in the description. The board was of the opinion that the second sentence of Art. 69 EPC did not apply to cases where an unambiguous and generally accepted definition of a term figuring in the claims was to be superseded by a different definition found in the description. If it was intended that a term which was in no need of any interpretation be given a new meaning, then the definition for this new meaning had to be put into the claims. Third parties could not be expected to check every single term of the claims for a potentially different meaning that might be hidden somewhere in the description.

In T 1172/08 the board stated that claim 1 as granted and claim 1 of the main request, when read on their own, provided protection for different subject-matter. The patent proprietor agreed that normally such a shift in the extent of protection would not be allowable. It argued, however, that the case at issue was very particular because the claims as granted did not embrace the subject-matter of the only example of the patent specification. The board had no doubts and the parties did not dispute that dendritic cells and monocytes were different cell types characterised by different features. Reading the patent proprietor's interpretation into claim 1 would require the skilled reader to completely ignore the wording of granted claim 1, which per se was not technically meaningless, with the consequence that the wording of claim 1 would merely serve as an empty shell. This was clearly not in the sense of Art. 69 EPC nor in the sense of the protocol on its interpretation. Moreover, the interest of third parties in legal certainty would be completely ignored, if the patent proprietor's interpretation were found to be acceptable.

In T 2284/09 the appellant (patent proprietor) had relied upon decision T 108/91 (OJ 1994, 228), according to which, in the case of inconsistency between the claim and the totality of the disclosure, it was permissible to refer to the description and, pursuant to Art. 69(1) EPC, to rely on the disclosure of the description to amend the claim. T 108/91 was however not applicable in the case at issue, since there was no inconsistency between the claim of the granted patent and the description. Furthermore decision G 1/93 (OJ 1994, 541) ruled that in the case of a non-disclosed limitation being introduced during examination proceedings (as was the case here), it was not permissible to remove it when so doing would extend the scope of protection. In G 1/93 the role of Art. 69(1) EPC was also considered and it was concluded that the description was to be used for assessing in particular sufficiency of disclosure and in determining the scope of protection conferred by the claims. However, there was no finding in G 1/93 that supported the position of the appellant that the description might be used as a repository from which amendments to the claims could be derived even if such amendments would contravene Art. 123(3) EPC.