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**Datasheet for the decision
of 30 September 2022**

Case Number: T 1473/19 - 3.2.02

Application Number: 11749363.5

Publication Number: 2621341

IPC: A61B6/00, H01F38/18, H04B5/00

Language of the proceedings: EN

Title of invention:
CONTACTLESS ROTARY JOINT

Patent Proprietor:
Schleifring GmbH

Opponent:
Siemens Healthcare GmbH

Relevant legal provisions:
RPBA Art. 12(4)
EPC Art. 69, 123(2), 123(3)
EPC R. 139
EPC Prot. Interpretation Article 69

Keyword:

New evidence filed on appeal - admitted (yes)
Amendments - added subject-matter (yes) - inescapable trap
(yes)
Correction of error - (no)

Decisions cited:

G 0002/88, G 0011/91, G 0001/10, G 0002/10, G 0003/14,
G 0001/16, T 0006/01, T 0556/02, T 0081/03, T 1279/04,
T 0197/10, T 1646/12, T 1167/13, T 1360/13, T 1514/14,
T 0131/15, T 2365/15, T 0435/16, T 0506/16, T 1127/16,
T 0030/17, T 1776/18, T 2864/18, T 2007/19, T 3097/19,
T 0092/21

Catchword:

1.) 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 (Reasons 3.1-3.15).

2.) Although Article 69(1), second sentence, EPC requires that generally account be taken of the description and the drawings when interpreting a claim, the primacy of the claims according to Article 69(1), first sentence, EPC limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings (Reasons 3.16-3.16.2).

3.) Claim interpretation is overall a question of law which must as such ultimately be answered by the deciding body, and not by linguistic or technical experts. It does, however, involve the appraisal of linguistic and technical facts which may be supported by evidence submitted by the parties (Reasons 3.17).



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Case Number: T 1473/19 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 30 September 2022

Appellant: Siemens Healthcare GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 April 2019
rejecting the opposition filed against European
patent No. 2621341 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chair M. Alvazzi Delfrate
Members: N. Obrovski
S. Dennler

Summary of Facts and Submissions

- I. The appeal was filed by the opponent against the Opposition Division's decision to reject the opposition to the contested patent.
- II. In its decision, the Opposition Division held, among other things, that claim 1 as granted did not contain added subject-matter.
- III. The **appellant (opponent)** requested that the decision under appeal be set aside and that the patent be revoked.
- IV. The **respondent (patent proprietor)** requested, as its main request, that the patent be maintained as granted, or, as auxiliary measures, that the request for correction under Rule 139 EPC filed with the submission dated 3 December 2018 be granted, or that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 3 filed with the reply to the statement of grounds of appeal.
- V. Claim 1 of the **main request** (claim 1 as granted) reads as follows:

"Contactless rotary joint for a CT scanner having a stationary and a rotating part, at least the rotating part comprising: a rotary joint body (200) of a plastic material, said body having a free inner bore holding a capacitive data link having a data transmission line (110) for transmission of data, and holding a rotating transformer having a rotating transformer magnetic core (220), for transmission of electrical power, having at least one winding (221, 222); the contactless rotary

joint being **characterized by** at least one shield (141, 142) being provided for shielding electrical and/or magnetic fields generated by the rotating transformer, to reduce interference with the capacitive data link, and by at least one shield having a higher thermal conductivity than the rotary joint body (200) and adapted to help dissipating heat from the rotating transformer, said shield being thermally connected to the rotating transformer core."

- VI. According to the respondent's **request for correction under Rule 139 EPC** filed with the submission dated 3 December 2018, the expression in claim 1 as granted "*said body having a free inner bore holding a capacitive data link*" should be corrected as follows (amendments highlighted by the Board):

"said body having a free inner bore, said body holding a capacitive data link".

- VII. Claim 1 of **auxiliary request 1** is identical to claim 1 as granted, but with the correction as requested above.

- VIII. Claim 1 of **auxiliary request 2** is identical to claim 1 as granted with the expression above being amended as follows (amendments highlighted by the Board):

"said body, having a free inner bore for accommodating the patient, holding a capacitive data link".

- IX. Claim 1 of **auxiliary request 3** is identical to claim 1 as granted with the following amendments.

The expression above is amended as follows (amendments highlighted by the Board):

"said body, having a free inner bore, holding a capacitive data link"

The expression *"characterized by"* is deleted and the following wording added at the end of the claim:

*"characterized by
the rotary joint body having a disk shape, and the rotating transformer magnetic core being held at one side of the disc, while a conducting backplane is mounted to the opposing side of the disc."*

- X. This decision refers to the following document, which the appellant filed with its statement of grounds of appeal:

016: expert opinion of Neil Thomas Simpkin

- XI. The **appellant's arguments** that are relevant for this decision can be summarised as follows.

Admittance of document 016

016 was an expert linguistic opinion on the wording of claim 1 as granted. This opinion did not raise any new issues but instead supported the interpretation of the expression in claim 1 as granted *"said body having a free inner bore holding a capacitive data link"* that the appellant had defended from the beginning of the opposition proceedings.

The submission of 016 had been a reaction to the Opposition Division's surprising change of view in this regard at the oral proceedings. Until then, the Opposition Division had agreed with the appellant's interpretation of claim 1 as granted, and thus filing

further evidence had not appeared necessary at the time.

"Exhibit A" mentioned in O16 was simply a freely available handbook on the basic conventions of the English language, especially with respect to punctuation. The fact that it was missing did not weaken the linguistic analysis presented in O16.

For these reasons, O16 should be admitted into the appeal proceedings.

Main request - added subject-matter

It was irrelevant that the first examiner of the Examining Division was an experienced examiner and an English native speaker.

The person skilled in the art reading claim 1 as granted would not have identified any ambiguity. As backed up by O16, they would have clearly and unambiguously understood from the expression in claim 1 "*said body having a free inner bore holding a capacitive data link*" that the body had a free inner bore and that this bore held a capacitive data link. The French and German translations of claim 1, which had been provided by the respondent itself, both supported this meaning.

This understanding of claim 1 was technically sensible and not illogical. In the context of the contested patent, the term "hold" indeed had a broad meaning. A bore was not limited to an empty space but necessarily included a physical boundary, which was itself able to "hold" a capacitive link. The contested feature made a technical contribution and could even be advantageous

in the context of a CT scanner, for example to minimise the size of the device.

Since claim 1 was clear, recourse to the description was neither needed nor justified. In particular, there was no legal basis for using the description to interpret claim 1, in particular under Article 69 EPC. In any event, according to Article 84, first sentence, EPC and Article 69(1), first sentence, EPC the matter for which protection was sought and the extent of the protection conferred by a European patent were both determined by the claims only.

It was undisputed that a configuration where the body had a free inner bore and the bore held the capacitive data link was not disclosed in the application as filed. It followed that claim 1 included added subject-matter, contrary to the requirements of Article 123(2) EPC.

Furthermore, in line with T 1127/16, the same conclusion would apply even if, as asserted by the respondent, the person skilled in the art had identified an ambiguity in claim 1, i.e. that more than one interpretation was allowed. Indeed, as a minimum the interpretation defended by the appellant had not been originally disclosed, which was sufficient for Article 123(2) EPC to be infringed.

Request for correction under Rule 139 EPC

The respondent's request for correction under Rule 139 EPC should be refused.

Auxiliary requests 1 to 3 - extension of the extent of protection

The appellant did not comment on these issues.

XII. The **respondent's arguments** that are relevant for this decision can be summarised as follows.

Admittance of document O16

O16 was late-filed. The appellant could and should have submitted it in the opposition proceedings. Indeed, the interpretation of the expression in claim 1 as granted "*said body having a free inner bore holding a capacitive data link*" had already been extensively disputed throughout the opposition proceedings. Moreover, the Opposition Division had never ruled out the interpretation that the respondent had defended in its written submissions in advance of the oral proceedings.

Furthermore, it was doubtful whether the expert opinion expressed in O16, requested by the appellant, was really an independent and credible opinion. In addition, O16 was incomplete as "Exhibit A" mentioned on page 2 was missing; thus, it was not possible to follow the opinion presented in O16.

For these reasons, O16 should not be admitted into the appeal proceedings.

Main request - added subject-matter

First, the first examiner of the Examining Division was not only an English native speaker like the linguistic expert of O16, but also an experienced examiner, and thus technically qualified. This supported the view, contrary to the linguistic opinion expressed in O16,

that the expression in claim 1 as granted "*said body having a free inner bore holding a capacitive data link*" was clear and to be understood in such a way that the requirements of Article 123(2) EPC were met, as the Examining Division had held.

Second, patents were actually directed not to native speakers or linguistic experts, but to technically qualified people. Reading claim 1 as granted, a person skilled in the art would have immediately identified an ambiguity in the expression objected to, namely that it did not clearly specify whether the capacitive data link was held by the free inner bore or by the body. Indeed, from a technical point of view, a free inner bore, i.e. an empty space, was itself not able to hold something; only what surrounded this empty space, in other words the surrounding body, could hold the capacitive data link.

The person skilled in the art would have therefore consulted the description and the drawings to resolve this ambiguity. Recourse to the description to interpret the claims was required by Article 69 EPC, which was supported by established case law, for example by T 131/15.

Since the description of the patent only disclosed that the body had a free inner bore to accommodate a patient and that it was the body which held the capacitive data link, the person skilled in the art would have necessarily concluded that the contested expression of claim 1 could only be interpreted in this way. Since this also corresponded to the original disclosure, it followed that claim 1 did not comprise added subject-matter, as required by Article 123(2) EPC.

Request for correction under Rule 139 EPC

The Opposition Division's reasoning for refusing the request for correction under Rule 139 EPC was incorrect. G 11/91 (Reasons 1) stipulated explicitly that a European patent could be corrected under Rule 88 EPC 1973, which corresponded to Rule 139 EPC. Moreover, the respondent had filed the request as soon as it had become aware of the error, prompted by the communication that opposition had been filed against the patent; hence, the request had been made promptly and without undue delay. Finally, as argued with respect to Article 123(2) EPC, it was obvious that claim 1 contained an error and what the correction should be. The Board should therefore grant the request for correction.

Auxiliary requests 1 to 3 - extension of the extent of protection

In claim 1 of each of auxiliary requests 1 to 3, the contested expression "*said body having a free inner bore holding a capacitive data link*" had been amended to exclude the appellant's interpretation and to clarify that it was the body which held the capacitive data link.

In accordance with T 131/15, assessing whether an amendment complied with Article 123(3) EPC first required determining the extent of protection conferred by the patent before this amendment. In turn, this required interpreting the claims using the description, as stipulated by Article 69 EPC. For the same reasons as argued in respect of Article 123(2) EPC, the person skilled in the art interpreting claim 1 as granted

using the description would have excluded the appellant's interpretation.

It followed that the amendments made in auxiliary requests 1 to 3 to clarify the contested expression did not extend the protection conferred by the patent. The requirements of Article 123(3) EPC were therefore met.

Reasons for the Decision

1. The contested patent

The contested patent relates to a contactless rotary joint for use, for example, in a CT scanner. In addition to a stationary part and a rotary part, this kind of rotary joint usually comprises a rotating transformer and a capacitive data link for transferring electrical power and data respectively through the joint without necessitating a contact between the stationary part and the rotary part (paragraphs [0001]-[0002]).

The patent aims to provide an improved contactless rotary joint which minimises the risk of interference between the rotating transformer and the capacitive data link by shielding electrical and/or magnetic fields generated by the rotating transformer (paragraph [0004]).

2. Admittance of document O16

- 2.1 Document O16 was not filed in the opposition proceedings. It was filed for the first time on appeal with the appellant's statement of grounds of appeal. The respondent contested the admittance of this document into the appeal proceedings.

2.2 O16 is an expert linguistic opinion on the wording of claim 1 as granted, and in particular on the expression "*said body having a free inner bore holding a capacitive data link*". This opinion is intended to support the appellant's view that this expression unambiguously defines that the body has a free inner bore and that this bore holds a capacitive data link.

2.3 This interpretation is consistent with the claim interpretation that the appellant put forward during the opposition proceedings (see point 4.1.1 of the decision under appeal). O16 therefore does not raise any new issues.

It also corresponds to the interpretation that the Opposition Division adopted in its preliminary opinion provided to the parties in advance of the oral proceedings (see point 7.1.1.1 of the communication annexed to the summons), until it changed its view at those oral proceedings. Accordingly, while it was arguably possible for the appellant to present O16 in the opposition proceedings, the appellant may not have considered it necessary at that stage to file further evidence in support of its view.

O16 was then filed with the appellant's statement of grounds of appeal, i.e. at the earliest possible stage of the appeal proceedings.

2.4 "Exhibit A" mentioned in O16 is a handbook describing the basic conventions of the English language, especially with respect to punctuation. This handbook, freely available, is cited in O16 merely to illustrate that the use of commas in the English language follows specific, established rules which must be considered

when interpreting the contested expression, which does not contain any commas. The existence of punctuation rules is common ground. Contrary to the respondent's argument, the fact that this handbook has not been submitted therefore does not prejudice the understanding of the linguistic analysis detailed in O16.

2.5 Moreover, the question of whether the opinion expressed in document O16 is objective and credible, which the respondent contested, has no bearing on the admittance of this document. It concerns its probative value, which is only to be assessed if and once O16 is admitted.

2.6 For these reasons, the Board decided to admit O16 into the appeal proceedings under Article 12(4) RPBA 2007.

3. Principles of claim interpretation

3.1 The parties disagree on the principles of claim interpretation, in particular whether and, if so, to what extent the description should be taken into account for the interpretation of a patent claim.

3.2 In the present case, the claim to be interpreted is claim 1 of the patent as granted. This claim must be interpreted in the following contexts:

- firstly for the purposes of assessing whether it contains added subject-matter under Article 123(2) EPC;
- secondly for the purposes of assessing whether it has been amended in the auxiliary requests in such a way that its extent of protection has been extended under Article 123(3) EPC.

- 3.3 According to established case law, patent claims must be interpreted through the eyes of the person skilled in the art, who should try with synthetical propensity to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Case Law of the Boards of Appeal, 10th edition 2022, II.A.6.1, first paragraph). The whole disclosure of the patent includes the description and the drawings, which must therefore be taken into account for claim interpretation (T 2365/15, Reasons 4.3.1). Accordingly, in very many decisions the description and the drawings have been used to interpret the claims and identify their subject-matter (see, for example, T 1167/13, Reasons 2.2 and 2.3 and T 2773/18, Reasons 2.3; see also Case Law of the Boards of Appeal, 10th edition 2022, II.A.6.3.1, second paragraph, first sentence).
- 3.4 There is, however, also a significant body of case law according to which the description and the drawings should only be used to interpret claim features which are ambiguous; unambiguous terms in the claims should be interpreted without taking the description and the drawings into account (see, for example, T 197/10, Reasons 2.3 and T 1514/14, Reasons 12). It has also been stated that, for the purposes of assessing compliance with Article 123(2) EPC, the description and the drawings should not even be consulted in the case of ambiguous claim features (see T 1127/16, to which the appellant referred, Reasons 2.6.1).
- 3.5 As to the legal basis for interpreting patent claims, the only guidance provided by the Enlarged Board of Appeal is found in G 2/88. In this decision, the Enlarged Board stated that, for the purpose of assessing compliance with Article 123(3) EPC,

"[d]etermination of the extent of protection has to be carried out in accordance with Article 69(1) EPC and its Protocol, which provides a guide to the manner in which the technical features of the claim are to be interpreted" (Reasons 4).

3.6 There are different views in the case law of the technical boards of appeal on the extent to which Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC ("the Protocol") should be applied when interpreting patent claims. While these provisions have in some decisions been considered to be generally applicable, other decisions restrict their application in proceedings before the EPO to determining the extent of protection under Article 123(3) EPC (see the overview in Case Law of the Boards of Appeal, 10th edition 2022, II.A.6.3.2). A leading decision in favour of the latter approach is T 1279/04.

3.7 The Board in T 1279/04, Reasons 3, stated that the application of the principles of claim interpretation as laid down in Article 69 EPC and the Protocol was limited to the determination of the extent of protection, which was primarily of concern in infringement proceedings. It further indicated that in examination and opposition proceedings before the EPO Article 84, first sentence, EPC provided a legal basis for applying "a strict definitional approach" (see also T 30/17, Reasons 2.1.7). This approach to claim interpretation, in T 1279/04 also called "a strict literal definitional approach", seems to correspond to an approach based on the "strict, literal meaning of the wording used in the claims", i.e. an approach which is explicitly rejected under Article 1 of the Protocol.

- 3.8 In the present Board's view, Article 69 EPC and the Protocol are the only provisions in the EPC containing rules for the interpretation of patent claims. Article 84, first sentence, EPC does not contain any such rules. Rather, the rationale underlying both the specific requirements under Article 84, second sentence, EPC (as to clarity see, for example, T 6/01, Reasons 14) and the general requirement under Article 84, first sentence, EPC (see T 3097/19, Reasons 28 and 28.1) is to enable a clear delimitation of the extent of protection. In other words, claims must satisfy the requirements under Article 84 EPC so that they can fulfil their purpose of enabling the protection conferred by the patent to be determined under Article 69 EPC (cf. G 2/88, Reasons 2.5). Article 84 EPC, however, says nothing about how to interpret patent claims. At most, it defines the standard to be applied when assessing clarity.
- 3.9 The Board disagrees with the statement in T 1279/04, Reasons 3, that Article 84, first sentence, EPC is generally applicable in opposition (appeal) proceedings. Systematically, Article 84 EPC belongs to Part III of the EPC on the European patent *application*. Accordingly, "the requirements of Article 84 EPC [...] play no role in opposition proceedings where the proprietor seeks to have the patent as granted upheld" (G 3/14, Reasons 55). For this reason alone, the requirement under Article 84, first sentence, EPC cannot constitute a generally applicable legal basis for the interpretation of patent claims, including granted claims, in opposition and opposition appeal proceedings.
- 3.10 In T 1279/04, Reasons 3, it is also stated that "[a]mendment [...] should be the answer to genuine

difficulties of interpretation in all aspects of the examination and opposition procedure". The present Board notes that it is up to the patent proprietor whether or not to file amended claim requests, and that its procedural behaviour in this regard has no bearing on the duty of the deciding body to interpret the claims before it. The Board further notes that the possibility of amending patent claims is not a unique feature of proceedings before the EPO but also exists in national court proceedings where, contrary to what is indicated in T 1279/04, the claim wording is not "set in stone" either.

3.11 However, the main rationale underlying T 1279/04, Reasons 3, seems to be that there is a difference between the subject-matter of a patent claim, which is determined in proceedings before the EPO and assessed under Articles 54(2), 56, 83 and 123(2) EPC, and its extent of protection, which is assessed under Article 123(3) EPC and in national infringement proceedings. While, as explained hereafter, the present Board acknowledges a difference, it does not consider this difference a convincing reason not to apply Article 69 EPC and the Protocol when determining the claimed subject-matter in proceedings before the EPO. As an initial remark, the Board notes that determining a patent claim's subject matter, i.e. establishing the meaning of the claimed features, is not distinguishable from interpreting that claim and its features. Understood this way, it is always necessary to interpret a patent claim in the proceedings before the EPO.

3.11.1 In G 1/16, Reasons 12, the Enlarged Board of Appeal stated that "[p]atent claims define the subject-matter for which protection is sought in terms of the

technical features of the claimed invention", referring to both Article 69(1), first sentence, EPC and Article 84 EPC as a legal basis for this statement. The Enlarged Board thereby confirmed that there is a close link between the claimed subject-matter and the extent of protection (which is the term actually used in Article 69(1), first sentence, EPC). The nature of this link will be explained in the following.

- 3.11.2 The extent of protection of a patent claim can be understood as the (infinite) set of embodiments which infringe that claim. This set can conceptually be divided into two distinct subsets, the first formed by embodiments which infringe the claim by realising the elements specified in the claim (i.e. the claimed features), and the second formed by embodiments which infringe the claim by equivalent means (i.e., in the words of Article 2 of the Protocol, by an element equivalent to an element specified in the claims). The first subset of a patent claim's extent of protection is directly defined by its subject-matter.
- 3.11.3 When assessing whether an embodiment falls under the first subset of a patent claim's extent of protection, it is assessed whether that embodiment can be subsumed under the claimed features. To this end, the claimed features must be interpreted - and the claimed subject-matter thereby determined - in accordance with the rule on how "to interpret the claims" given in Article 69(1) EPC in conjunction with Article 1 of the Protocol. Interpreting the claimed features for the purposes of establishing the first part of a 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. Accordingly, national courts apply

the rules for the interpretation of claims in Article 69 EPC and the Protocol in both infringement and revocation proceedings as a matter of course.

3.11.4 Assessing whether a certain embodiment falls under the second part of a patent claim's extent of protection, i.e. the part concerning equivalents under Article 69(1) EPC in conjunction with Article 2 of the Protocol, is a second step in the determination of the extent of protection which follows claim interpretation. It mainly consists in assessing whether a feature of an allegedly infringing embodiment is equivalent to an element specified in the claims, i.e. to one of the features defining the claimed subject-matter. As the "invention" in Articles 54, 56 and 83 EPC (see T 92/21, Reasons 3.2, last sentence) and, with regard to claim amendments, also the "subject-matter" under Article 123(2) EPC (see G 2/10, Reasons 4.5.2, last paragraph) refer to the claimed subject-matter only, equivalents are not to be taken into account when compliance with these provisions is assessed. Under Article 123(3) EPC too, it is mainly "the technical subject-matter of the claims" before and after the amendment which is considered (see G 2/88, Reasons 4.1), although equivalents may theoretically play a role under this provision as it refers to the extent of protection (see T 1360/13, Reasons 4.13; see, however, also T 81/03, Reasons 3.7). In conclusion, equivalents are the part of the extent of protection which is indeed primarily relevant for infringement proceedings.

3.12 The general application of Article 69 EPC and the Protocol in proceedings before the EPO is also required to ensure uniform and consistent claim interpretation. In G 2/88, Reasons 4, the Enlarged Board held that "the

guide on the manner in which the technical features of the claim are to be interpreted" provided by the Protocol must be applied when interpreting a claim for the purposes of Article 123(3) EPC. However, the features which define a certain patent claim's subject-matter may need to be interpreted not only under Article 123(3) EPC but - as in the present case - for example also under Article 123(2) EPC. In order to avoid contradictions, the same principles of claim interpretation must be applied in both instances.

3.12.1 In this regard, it is immaterial that the tests to be carried out under these provisions are different. Under Article 123(2) EPC, an amended patent claim's subject-matter is compared with the content of the application as filed under the gold standard (G 2/10, Reasons 4.3), and under Article 123(3) EPC a possible extension of protection is assessed by comparing the totality of the claims before and after the claim amendment (G 2/88, Reasons 3.2). Despite these differences, the subject-matter of a given patent claim must be interpreted and determined in a uniform and consistent manner, and this all the more so if that claim is afterwards subject to both of these tests.

3.13 In T 556/02, Reasons 5.3, it was stated that Article 69 EPC is a specific application of the general principle that the claims of a patent, being a part of a document as a whole, always need to be construed in their context. Likewise, in T 1646/12, Reasons 2.1, it was held that a patent claim must, like any text, be interpreted in its context, which includes the description. In T 2007/19, Reasons 2.1.3, the Board held with reference to T 1646/12 that there was no general principle of claim interpretation according to which claim features always had to be given the

broadest meaning irrespective of the context in which they were used. The present Board agrees with these statements and adds that the description and the drawings provide context-specific information about the claimed subject-matter. Taking this information into account when interpreting a patent claim from the perspective of the person skilled in the art makes claim interpretation more accurate, which contributes to legal certainty; all the more so if, as is often the case, patentees use terms idiosyncratically in the claims.

- 3.14 The Board further notes that the EPO opposition divisions and Boards of Appeal on the one hand, and the national courts of the Contracting States to the EPC and, soon, the Unified Patent Court on the other, have concurrent jurisdiction on the validity of European patents. Against this background, a common approach to claim interpretation based on the principles set out in Article 69 EPC and the Protocol also serves the legitimate interests of the users of the European patent system.
- 3.15 In view of all of the above considerations, the Board holds that Article 69 EPC in conjunction with Article 1 of the Protocol can and should be relied on when determining the claimed subject-matter in proceedings before the EPO.
- 3.16 Nevertheless, contrary to what was implied by the appellant, one must not deduce from the applicability of Article 69 EPC in conjunction with Article 1 of the Protocol that the description has the same weight as the claims. According to Article 69(1), first sentence, EPC only the claims determine the extent of protection. The Board notes that there is no contradiction on this

issue between Article 69(1), first sentence, EPC and Article 84, first sentence, EPC.

3.16.1 Hence, although Article 69(1), second sentence, EPC requires that generally account be taken of the description and the drawings when interpreting a patent claim, the primacy of the claims under Article 69(1), first sentence, EPC limits the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. The established case law of the Boards of Appeal that limiting features which are only present in the description but not in the claim cannot be read into a patent claim is thus fully compatible with relying on Article 69 EPC in conjunction with Article 1 of the Protocol as a legal basis for determining a patent claim's subject-matter.

3.16.2 Moreover, while it cannot be ruled out *ab initio* that a certain claim feature may, when interpreted in light of the description and the drawings, have a different meaning than it would have when interpreted in isolation, it would be at odds with the principle of the primacy of the claims if this allowed claim features to be defined in the description at will, including in ways which are not at all compatible with the feature's ordinary meaning. The primacy of the claims therefore also limits the extent to which the description may serve as a dictionary for the terms used in the claims.

3.17 In view of the parties' various submissions on linguistic matters in the present case, the Board further points out that claim interpretation is overall a question of law which must as such ultimately be answered by the deciding body, and not by linguistic or technical experts. It does, however, involve the

appraisal of linguistic and technical facts (see T 1776/18, Reasons 4.5.5), which may be supported by evidence submitted by the parties.

3.18 In line with Article 70(1) EPC a patent claim must be interpreted in its authentic text, which is the text of the patent in the language of the proceedings. Moreover, the material which can and must be taken into account for claim interpretation under Article 69 EPC - in addition to the claims themselves (in their authentic text) - is limited to the description and the drawings. Therefore, in the present case the German and French translations of claim 1 cannot be relied upon for its interpretation. At most, it is possible to deduce from these translations how the translators responsible for them understood the English version of claim 1.

3.19 In the following, the Board will apply the aforementioned principles of claim interpretation to assess the compliance of claim 1 of the patent as granted with Article 123(2) EPC and to assess the compliance of claim 1 of auxiliary requests 1-3 with Article 123(3) EPC in view of claim 1 as granted. Both assessments concern the same feature of claim 1 as granted. The Board will interpret this claim feature under Article 123(2) EPC and under Article 123(3) EPC uniformly and in accordance with Article 69 EPC and the Protocol.

4. Main request - added subject-matter (Article 123(2) EPC)

4.1 The parties submitted the following two different interpretations of the expression in claim 1 as granted

"said body having a free inner bore holding a capacitive data link":

(a) *the body has a free inner bore and this bore holds a capacitive data link, as asserted by the appellant, and*

(b) *the body has a free inner bore and, additionally, the body holds a capacitive data link, as asserted by the respondent and ultimately accepted by the Opposition Division after it resorted to the description (point 4.1.1 of the decision under appeal).*

4.2 Grammatically, the contentious expression is constructed as a series of noun groups ("said body", "a free inner bore", "a capacitive data link") separated by present participles ("having", "holding"). In the absence of any comma and any coordinating conjunction separating the various terms, the person skilled in the art, on a plain reading of this expression, would simply consider the subject governing each present participle to be the noun group immediately preceding it, following the usual rule that modifiers are generally placed next to the word they modify. In this way, the person skilled in the art would arrive at the construction that the body has a free inner bore and that this bore holds a capacitive data link: hence, interpretation (a) defended by the appellant.

4.3 Interpretation (a) is technically sensible and plausible. A "free inner bore" formed in a body, in the context of a rotary joint as defined in claim 1, is not limited to an empty space or hole, but includes the physical surface that surrounds and defines the hole. It is therefore not illogical that a bore may "hold" a

component via the interaction between this component and this physical surface, even if this surface is at the same time an inner surface of the body in which the bore is formed. Thus, contrary to the respondent's argument, there is no contradiction in the fact that the free inner bore may "hold" a capacitive data link. This was also acknowledged by the Opposition Division in the decision under appeal (last paragraph of point 4.1.1).

Hence, contrary to the respondent's argument, the person skilled in the art faced with this expression would have no reason to depart from interpretation (a) for technical reasons.

- 4.4 Referring to Article 69 EPC, the respondent argued that the description had to be used to interpret the claims. Reading claim 1 in the context of the description, in which a free inner bore in the rotary joint body is only disclosed for accommodating a patient and in which it is the body which holds a capacitive data link (paragraph [0024]), the person skilled in the art would, according to the respondent, necessarily reject interpretation (a) and instead adopt interpretation (b).

While it follows from the considerations in section 3. above that the description and the drawings should indeed be taken into account when interpreting claim 1, the Board disagrees with the respondent's conclusion that doing so would lead to rejecting interpretation (a) and adopting interpretation (b) instead.

The mere fact that the contested claim feature as understood in accordance with interpretation (a) is not disclosed in the description or drawings does not speak

against this interpretation. Neither the description nor the drawings exclude the presence of a (further) capacitive data link positioned in accordance with interpretation (a). Moreover, there is no principle of claim interpretation according to which a claim should be interpreted in a manner which makes it compliant with Article 123(2) EPC. Furthermore, contrary to the description and the drawings, the application as filed is not referred to in Article 69(1), second sentence, EPC either.

The description and the drawings do not contain anything which makes interpretation (a) appear technically nonsensical or incompatible with the claimed invention. The description does not contain a definition of the contested feature either. The mere mention, by way of example, of an embodiment which comprises a capacitive data link not arranged in accordance with interpretation (a) is not a sufficient reason to apply interpretation (b) instead of interpretation (a).

4.5 The situation in T 131/15, to which the respondent referred, was different. In that case, the dispute concerned an expression in a granted claim which, taken literally and in isolation, would have had the effect of excluding all of the disclosed embodiments from the extent of protection (Reasons 5.10 to 5.12). This is not the case in the present proceedings.

4.6 It is common ground that the description as filed does not disclose a rotating joint body having a free inner bore, wherein this bore holds a capacitive data link.

Consequently, claim 1 as interpreted by the Board in accordance with interpretation (a) presents the person

skilled in the art with new information which extends beyond the content of the application as filed. The requirement of Article 123(2) EPC is therefore not met.

5. Request for correction under Rule 139 EPC

- 5.1 According to the respondent's request for correction under Rule 139 EPC, claim 1 as granted should be corrected by replacing the contentious expression above with the corrected expression "*said body having a free inner bore, said body holding a capacitive data link*" (amendments highlighted by the Board).

Due to the additional comma and noun group "said body", the corrected expression contains two distinct participial phrases which both describe the body. It is common ground that the person skilled in the art would understand this expression in line with interpretation (b) above.

- 5.2 The Board disagrees with the respondent that Rule 139 EPC is applicable to correct claim 1 of the patent as granted.

Rule 139 EPC only allows correction of linguistic errors, errors of transcription and mistakes "in any document filed with the European Patent Office".

As noted by the Opposition Division (point 3.1 of the decision under appeal), the addition of the expression "having a free inner bore" in claim 1, i.e. the amendment that the request for correction aims to correct, was made by the Examining Division in the text intended for grant sent with the communication under Rule 71(3) EPC (see point 10.1 of annexed Form 2906). The respondent approved the proposed text including

this amendment by filing the translations of the claims and paying the prescribed fee. However, this approval does not mean that the amendment was submitted by the respondent "in [a] document filed with the European Patent Office" (see T 506/16, Reasons 5, second paragraph).

This requirement for a correction under Rule 139 EPC is therefore not met. Accordingly, the request for correction must be refused for this reason alone.

5.3 The Board also refers in this regard to G 1/10, Reasons 9, according to which a mistake in a document filed by an applicant can be corrected under Rule 139 EPC "before grant". Rule 139 EPC therefore cannot be applied to a granted patent (T 2864/18, Reasons 4). Furthermore, the Enlarged Board in G 1/10, Reasons 11, stated that if, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure its approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be its alone, whether the error was made (or introduced) by it or by the examining division. Although made in the context of Rule 140 EPC, this statement is also relevant for the application of Rule 139 EPC (see T 435/16, Reasons 48 to 50).

5.4 The Enlarged Board also stated in G 1/10, Reasons 13, that it is always open to a patent proprietor to seek to amend its patent during opposition proceedings and that such an amendment could remove a perceived error. However, it was also stressed by the Enlarged Board that such an amendment must satisfy all the legal

requirements for amendments, including those of Article 123 EPC.

6. Auxiliary requests 1 to 3 - extension of the extent of protection (Article 123(3) EPC)

6.1 Claim 1 of auxiliary request 1 is identical to claim 1 as granted, but with the correction requested in the request for correction discussed above. In auxiliary requests 2 and 3, the disputed expression in claim 1 is amended to include a first comma after the first noun group "said body" and a second comma before the participle "holding". It is common ground that the person skilled in the art unambiguously understands the amended expressions in line with interpretation (b) above.

6.2 By bringing the disputed expression of claim 1 into line with interpretation (b), the limitation defined in claim 1 as granted that the free inner bore holds a capacitive link, as interpreted by the Board as discussed in section 4. above, has been removed. The protection conferred by claim 1 as granted has thus been extended in all of auxiliary requests 1 to 3. These auxiliary requests therefore do not meet the requirement of Article 123(3) EPC.

7. It follows from the above considerations that none of the respondent's claim requests is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar:

The Chair:



A. Chavinier-Tomsic

M. Alvazzi Delfrate

Decision electronically authenticated