European Infringement Clearance Searching – Claims Interpretation Issues

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Patent Claims – the Basics

• The claims define the scope of protection of the invention

• The claims are written in a very legalistic and stilted way

• Often short and terse with specific wording

• Although the claims define the invention, they should always be read in conjunction with the description.
Claims language - a foreign language?

• Patent attorneys are a cunning species
• Patent claims don’t necessarily mean what they appear to say
• Words in claims may not have their normal dictionary meaning
• Often necessary to look to the specification for a definition of a word in the claims
• Terms used in the claims may be also limited or broadened by “common sense”
• Claims must be “interpreted” or “construed”, and put into context

Legal Aspects of Claim Interpretation

• All interpretation is distilled down into a single question, which must be answered:
  • “What would a skilled person have thought the claim terms meant, at the priority date of the patent?”
Legal Aspects - History

• Historically:
  • UK – had a strict “literal” approach to interpretation; the claims must be read without help from the specification
    • e.g. “horizontal” would be interpreted as exactly 90° from the vertical – any slight deviation in angle would not be covered.
  • Germany – had a “purposive” approach; the claims must be interpreted by looking at the purpose of the wording, rather than the literal meaning
    • e.g. “horizontal” may be interpreted to include anything from 80° to 110° from the vertical.
• Now:
  • European Patents – “middle ground”, the claims must be interpreted using a middle ground between “literal” and “purposive”.
  • UK and Germany have followed suit

Legal Aspects - EPC – Article 69 and Protocol

• Article 69 EPC, which applies to infringement proceedings for a European patent in the domestic courts of all EPC Contracting States provides:

  • The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

• Protocol on the Interpretation of Article 69 EPC:

  • Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.
EPC Legal aspects cont.

Europe

EP Interpretation – EPO Examiner Guidelines; Section 3.2 - Interpretation of claims

• The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The examiner may need to consider the contents of the description and/or drawings when performing the search in order to:
  • (i) identify the technical problem and its solution;
  • (ii) establish definitions of unclear terms not defined in the claims;
  • (iii) establish definitions of clear terms given a definition different from their usual meaning;
  • (iv) ascertain the existence of a fall-back position.

• The objective of the search is to discover prior art which is relevant to novelty and/or inventive step (see B-ii, 2). The search should be directed to what appear to be the essential features of the invention and take into account any changes in the (objective) technical problem underlying the invention which may occur during the search as a result of the retrieved prior art (see B-IV, 2.3 and B-IV, 2.4, and G-VII, 5.2).

• When interpreting claims for the purpose of the search, the search will also take into consideration prior art incorporating technical features which are well known equivalents to the technical features of the claimed invention, which may undermine inventive step (see G-VII, Annex, 1.1(ii)).

EPC - Legal aspects cont.

EPC – very little case law to help!

T881/01 – relying on features not specified in the claims doesn’t constitute interpreting the claims, it constitutes re-writing them
T1321/04 – the patent may be its own dictionary (so if a special meaning is given in the specification for a claimed word, that is the true meaning)
T197/10 – if the claims are already concise and unambiguous, the description is not to be used to interpret them
T443/11 – “it is established case law that....the claims should be interpreted in the manner that they would be understood by a person skilled in the art”

Conclusion – it’s still a mess. We need further decisions which confirm under what circumstances it would be permissible to rely on the description to limit the interpretation of the claims
Legal aspects – attempting to define some ground rules of interpretation in Europe

- The patent claims are decisive.
- Each feature of the patent claim has to be interpreted in light of the overall context of the patent claim.
- All features of the claim are important. No distinction is made between the preamble and the characterizing part of the claim for European Patents.
- No “magic formula” interpretation of a claim. What works for one patent may not work for another, even when interpreting exactly the same term.
- Technical meaning has to be ascertained from the point of view of a person skilled in the art at the priority date.

Actavis v Lilly – UK Supreme Court Decision (2018)

Two major changes in determining infringement and claim interpretation in the UK:

- “Equivalents” can infringe, even when they are clearly outside the words of the claim; and
- Prosecution history can be referred to, but only in certain circumstances
**Actavis v Lilly – Equivalents**

- December 2007: EPC 2000 changed the law on interpretation of claims, adding Article 2 to the Protocol on Interpretation of Article 69 EPC:
  - “For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.”

- UK courts paid little attention to this:
  - The scope of the claims was interpreted by reference to the description and drawings, and if even on a broad interpretation, “equivalents” fell outside the meaning of the claim, they would not infringe.

- The UK High Court and Court of Appeal thus found that a claim to “pemetrexed disodium” could not be infringed by “pemetrexed dipotassium”
  - No reasonable interpretation of “sodium” can include “potassium”

**Actavis v Lilly – Equivalents**

- The UK Supreme Court has now added a second step to determine infringement, asking:
  1. Does the variant infringe any of the claims as a matter of normal interpretation; and, if not,
  2. Does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?

- If the answer to either question is YES → Infringement

- On this interpretation, since the choice of salt (potassium rather than sodium) made no difference to how the invention works, held to be an infringing variant.
**Actavis v Lilly – Prosecution History**

- Previously prosecution history was not referred to – the biggest previous UK court decision on the matter (*Kirin Amgen*), said:
  
  - "life is too short for the limited assistance which it can provide"
  
- The *Actavis v Lilly* Judgement has said:
  
  - While it would be arrogant to exclude the existence of any other circumstances, my current view is that reference to the file would only be appropriate where:
    
    i. the point at issue is truly unclear if one confines oneself to the specification and claims of the patent, and the contents of the file unambiguously resolve the point, or
    
    ii. it would be contrary to the public interest for the contents of the file to be ignored.

**Actavis v Lilly – Impact**

- The new law will be applicable for any future infringement actions, so...

- Old infringement opinions should be reviewed, because
  
  i. A patent may be infringed by what previously seemed to be an effective design-around; and
  
  ii. A patent that was previously considered infringed, may not be infringed, if comments made in prosecution are taken into account

- Reasonable degree of legal certainty for third parties (Protocol Art. 1)?

- Remains to be seen how this approach works in practice in the UK
Claims Interpretation Problems – Example 1

• Your client/company wants to bring out a product which has two curved surfaces (with shallow curves) and two flat surfaces.

• You find a patent which claims:

  “A plate having substantially curved surfaces”

• Does “substantially curved” mean “a large curve”? Or...

• Does “substantially curved surfaces” mean that some, or all, of the surfaces must have at least some degree of curvature?

Claims Interpretation Problems – Example 2

• Your company or client wants to bring out a cyan coloured squash ball.

• You are asked to search for infringement and find GB1538860:

  WHAT WE CLAIM IS:—
  1. A squash rackets ball having a matt surface of a blue colour as hereinbefore defined.
  2. A squash rackets ball having a matt surface of the colour Flander's blue as hereinbefore defined.

• On the face of it, a clear enough claim.

• Your company/client’s ball isn’t blue. Or is it?
Blue Squash Ball – GB1538860

• The definition of blue in the patent is:

  By the colour blue is herein meant that one of the four psychological primary hues that is evoked in the average normal observer of <i>homo sapiens</i> under normal conditions by radiant energy of the wavelength of about 475 millimicrons in the electromagnetic spectrum.

• Since “blue” is defined as having a wavelength of “about” 475 nm, does it cover cyan (about 488 nm) or even turquoise, indigo, violet or purple (all within 20-30 nm of 475 nm)?

• Can you confidently tell your client there’s no infringement?

Claims Interpretation Problems - Example 3

• Your company/client intends to manufacture and sell a new ice-cream with a coating of confectionery icing which consists of sugar, a small amount of cocoa butter and milk.

• You find a patent which claims:

  “An ice cream confection comprising ice cream coated in a layer of chocolate”

• You’re OK, aren’t you – your coating is not chocolate?

• BUT – what is the meaning of the term “chocolate”? 

• Normally “chocolate” is at least cocoa solids, cocoa butter (or fat) and sugar, optionally with milk

• The description may define ‘chocolate’ in such a way that no cocoa solids need be present and/or that the fat content can be less than 25 wt%.

• In fact, many patents relating to chocolate do just that – and cover “chocolate” that consists of cocoa butter and sugar, or cocoa butter, milk and sugar only (so-called “white chocolate”) – exactly what you intend to make.
Claim Interpretation Problems – Example 4

• Your company/client wants to use a new process:
  • A) granulating cartilage
  • B) removing cells from the cartilage
  • C) making a paste from the decellularised cartilage

• You find a patent which claims:
  • A method of manufacturing a decellularised tissue, comprising A) removing cells from a tissue; B) granulating the tissue; and C) pasting the granulated tissue.

• Is there an infringement risk?
• Don’t assume the steps of the claimed method has to be performed in the claimed order, unless the patent as a whole states that it does
• The description may well state that “steps a) and b) may be performed in any order”, and often does

Attempting to define some ground rules of interpretation

Based on the issues shown in the previous examples:

• Searchers should ensure a patent claim is interpreted taking into consideration the description (state of the art, problems underlying the invention, advantages of the invention) and the drawings (which may illustrate the state of the art and the invention).
• The patent specification can be its own dictionary.
• Always review the description, even if only briefly, when a term may have more than one meaning, or is unclear. Don’t assume your “common sense” definition is correct.
• Example embodiments in the description don’t restrict the scope of claims in the majority of cases.
Attempting to define some ground rules of interpretation

- Other potential factors:
  - File wrapper estoppel – generally the prosecution history will not be used to interpret the claims, although some weight may be given to statements made during prosecution
  - Prosecution as an indication as to what a skilled person would think of a term in the claims – again, some weight may be given, but not a point of law that this is so

Claims Interpretation – Example of Non-Standard Meaning

- Claim: “A closed container...”
- You may dismiss the claim on the basis that your product has an open top, or all the sides are a wire mesh
- BUT – the description may state: “a closed container may include vents, apertures or holes, or one or more sides may be open so long as the container is capable of retaining a object.”
- A “closed container” here is broadened from its usual meaning of “fully enclosed receptacle”
- The “closed container” in these claims would include a container having no lid, or made from wire mesh sides
- These different meanings would all need to be taken into account in any infringement clearance search
- (Arguable that this claim lacks clarity, and that the term “closed” should be disregarded as a non-technical feature of the claim)
Legal Aspects – other major jurisdictions

• USA – rather complex including:
  • doctrine of equivalents
  • file wrapper estoppel

• China – has aspects from Europe and the US
  • Can use patent as its own dictionary
  • If the patent specification gives a meaning to a term, that meaning will prevail over anything else
  • Prosecution history (arguments about terms) will be used by courts to interpret
  • Common sense meaning to terms if no other guidelines
  • File wrapper estoppel
  • Limited doctrine of equivalents

Key points to take away

• There is no body of case law to help in interpreting patents – it’s done on a case by case basis
• However, the principles are clearly set out:
  • The claims must be interpreted neither strictly literally, nor with too much emphasis on extending protection to equivalents – we need to use a middle ground
  • The description should be used to help interpretation, but not relied on conclusively
  • The patent can be it’s own dictionary
  • Don’t dismiss a patent claim because you think a term is clear – always check the description for the meaning
• Interpretation is a skill that can be learned by anyone, and is a very useful skill in all fields of patent work. No harm in anyone trying to interpret a claim and putting their views forward.
• If in doubt – flag the patent as a potential risk
Thank you for listening

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