A purposive construction of *Free World*

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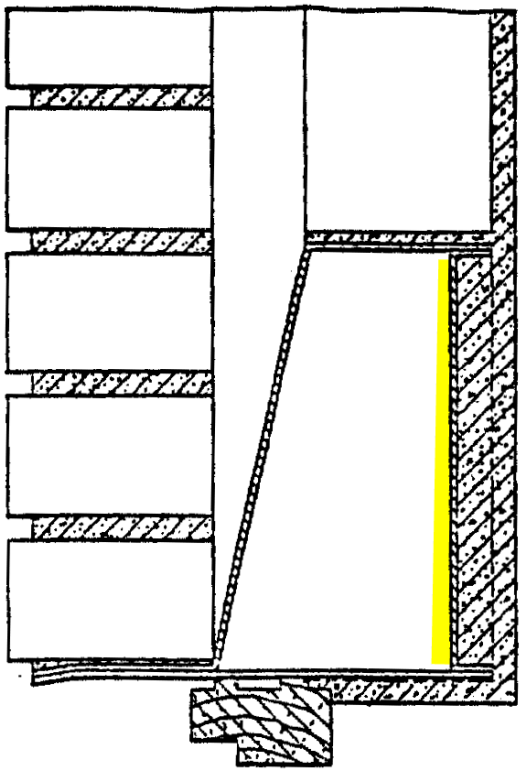
Bereskin & Parr

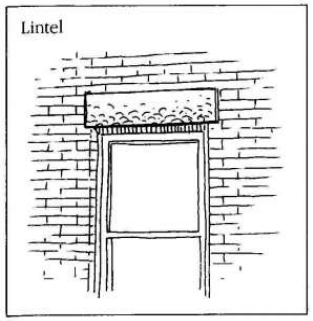
INTELLECTUAL PROPERTY LAW

Catnic v. *Hill* (UK H.L. 1982)

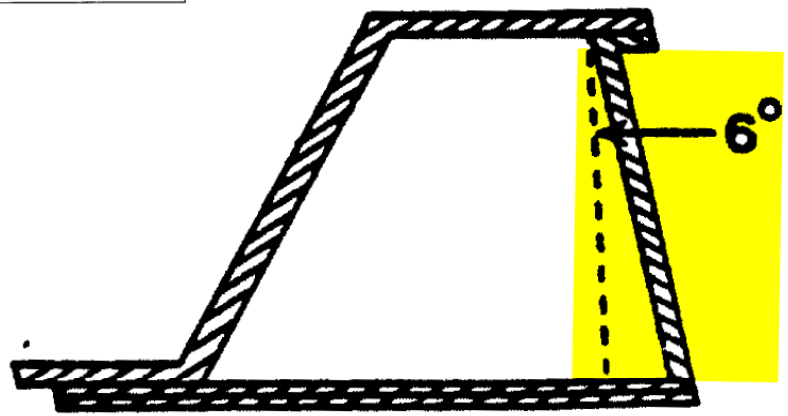
Catnic



having a rear wall member "extending vertically”



Hill

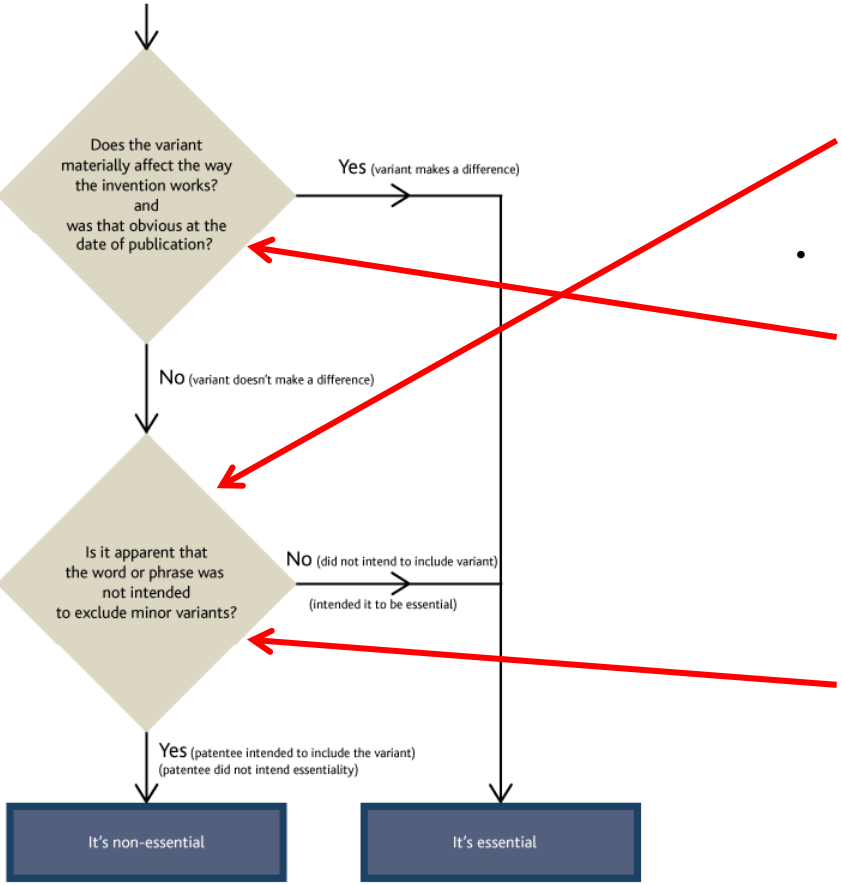


Catnic v. *Hill*

The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that **strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed**, even though it could have no material effect upon the way the invention worked.

The question, of course, does not arise where **the variant would in fact have a material effect upon the way the invention worked**. Nor does it arise unless **at the date of publication of the specification it would be obvious to the informed reader that this was so**. Where it is not obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only **when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by the patentee, who was also skilled in the art, to exclude minor variants** which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked."

Catnic v. *Hill*



- The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that **strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed**, even though it could have no material effect upon the way the invention worked.
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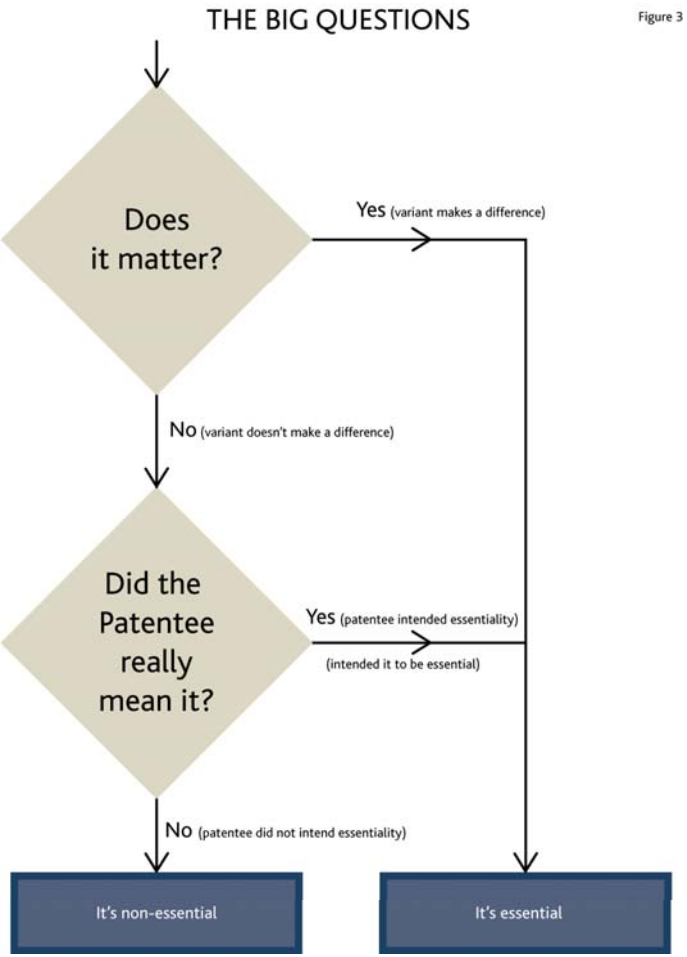
Catnic: The Big Questions



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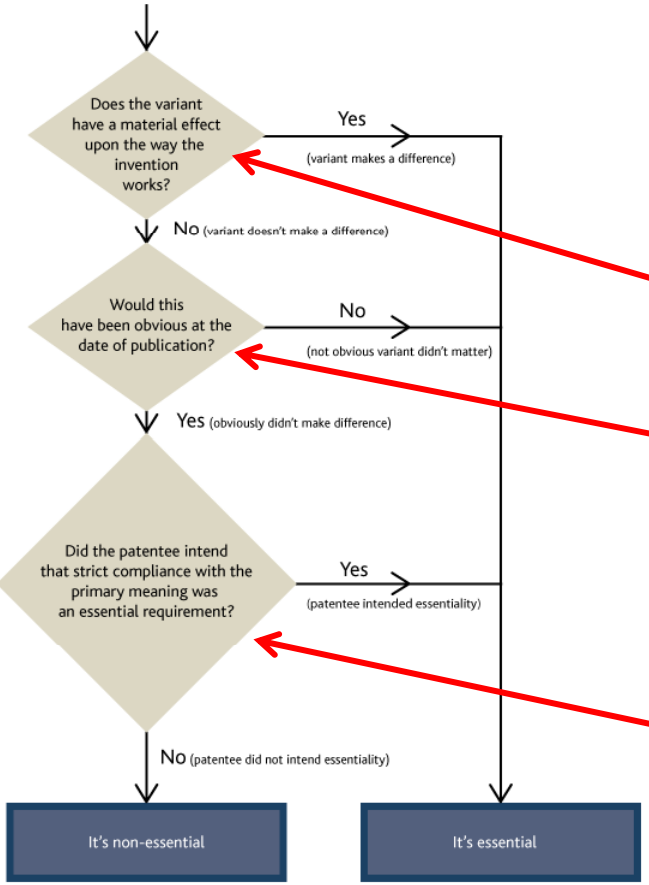
Improver (UK 1990)



- "If the issue was whether **a feature** embodied in an alleged infringement which **fell outside the primary, literal or acontextual meaning of a descriptive word or phrase** in the claim ["a variant"] was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:
- **1.Does the variant have a material effect upon the way the invention works?** If yes, then the variant is outside the claim. If no?
- **2.Would this (i.e. that the variant had no material effect) have been obvious** at the date of publication of the patent to a reader of the patent skilled in the art? If no, the variant is outside the claim. If yes?
- 3.Would the reader skilled in the art nevertheless have understood from the language of the claim that **the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention?** If yes, then the variant is outside the claim."

The "principles" from *Free World*

"Adhere to the language"
(Invention limited to what has been claimed)

(a) The *Patent Act* promotes adherence to the language of the claims.

(b) Adherence to the language of the claims in turn promotes both fairness and predictability.

(d) The language of the claims thus construed defines the monopoly. There is no recourse to such vague notions as the "spirit of the invention" to expand it further.

Essential & Non-Essential

(e) The claims language will, on a purposive construction, show that some elements of the claimed invention are essential while others are non-essential. The identification of elements as essential or non-essential is made:

(iii) having regard to whether or not it was obvious to the skilled reader at the time the patent was published that a variant of a particular element would not make a difference to the way in which the invention works; or

(iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect;

The “principles” from *Free World*

The *Catnic* questions:

#1 Does it matter as to how it works?

and

#2 Does inventor really mean it?

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or

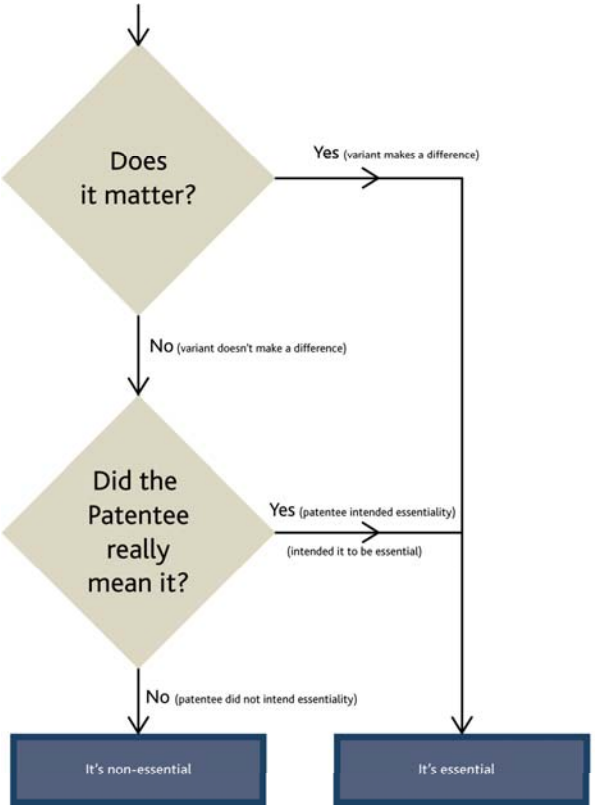
(iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect;

Did Binnie J. really mean “or”?

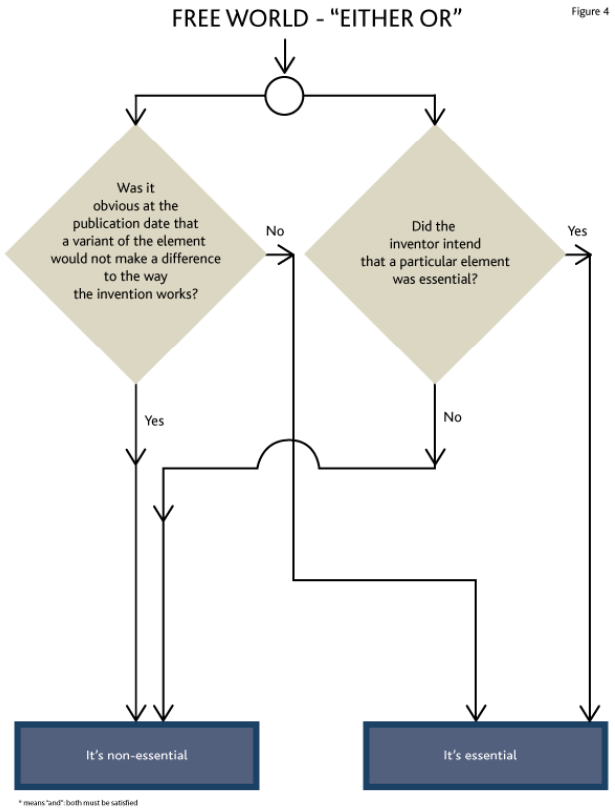
- “**For an element to be considered non-essential** and thus substitutable, **it must be** shown **either (i)** that on a purposive construction of the words of the claim it was clearly not intended to be essential, **or (ii)** that at the date of the publication of the patent, the skilled addressees would have appreciated that a particular element could be substituted without affecting the working of the invention…”

Free World's "or"

Catnic/Improver



Free World "or"



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Kirin-Amgen (UK H.L.) 2004

- "I am bound to say that the cases show a tendency for counsel to treat the Protocol questions as legal rules rather than guides which will in appropriate cases help to decide what the skilled man would have understood the patentee to mean."
- "The determination of the extent of protection conferred by a European patent is an examination in which there is only one compulsory question, namely that set out in article 69 and its Protocol: **what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?** …"

A "purposive construction" of *Free World*

(e) The identification of elements as essential or non-essential is made:

(iii) having regard to whether or not … a variant of a particular element would not make a difference to the way in which the invention works. If it makes a difference, then the element is essential; or

(iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect. If the inventor stated it to be essential, then it is essential.;

- If the element is not essential under both (iii) and (iv), then the element is non-essential.

Someday?

- **What would a person skilled in the art have understood the patentee to have used the language of the claim to mean?**

Thank You

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