

ALLEN & OVERY

What claim construction means in Europe and why it matters
in international patent litigation

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The law

Article 69 of the European Patent Convention

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

Protocol to Article 69

Article 69 should not be interpreted as meaning 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. Nor should it be taken to mean 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 patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

Protocol to Article 69

Added para:

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

The UK purposive approach: Lord Hoffmann in *Kirin Amgen - 2004*

"The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean. And for this purpose, the language he has chosen is usually of critical importance. The conventions of word meaning and syntax enable us to express our meanings with great accuracy and subtlety and the skilled man will ordinarily assume that the patentee has chosen his language accordingly."

German approach and variants:

The Schneidmesser questions

1. Does the variant solve the problem underlying the invention with means that objectively have the same effect?
2. Would the person skilled in the art, using the common general knowledge, have realised at the priority date that the variant has the same effect?
3. Are the considerations which the skilled person takes into account for the variant in the light of the meaning of the invention close enough to the considerations taken into account for the literal solution protected by the claims, such that the skilled person will consider the variant as a solution which is equivalent to the literal one?

If all 3 questions are answered yes then a fourth question, the ***Formstein question*** is asked, this question must be answered NO for there to be infringement:

4. Does the variant, having regard to the state of the art, lack novelty or is the variant obvious to a person skilled in the art?.

Occlutech v AGA – litigated in UK, Germany and NL

Summary of AGA's patent claim:

- A collapsible medical device comprising
- metal fabric formed of braided metal strands
- the device having a generally dumbbell shape expanded configuration.....formed between opposed ends of the device
characterised in that
- clamps are adapted to clamp the strands at the opposed ends of the device

Points in issue were meaning of clamp and whether claim extended to an example where a single clamp is attached to opposite ends of the strands - as opposed to the ends of the device.

AGA's main embodiment

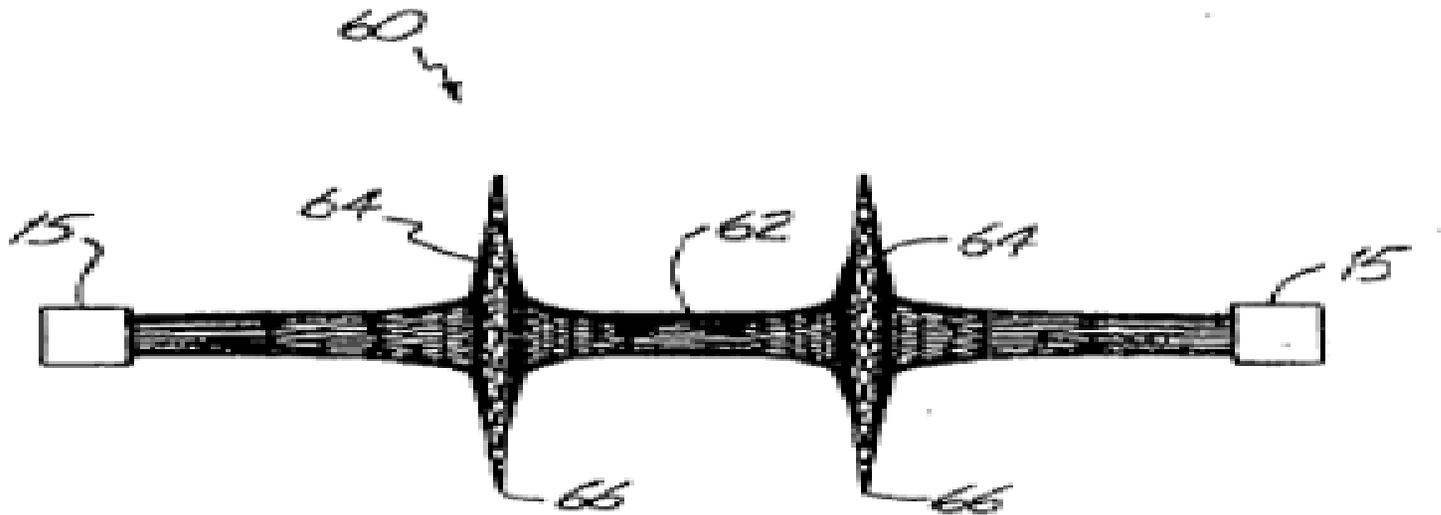


Fig. 50A

The Occlutech product

- Like a sock
- Open at one end only
- Open end sealed by weld not clamp

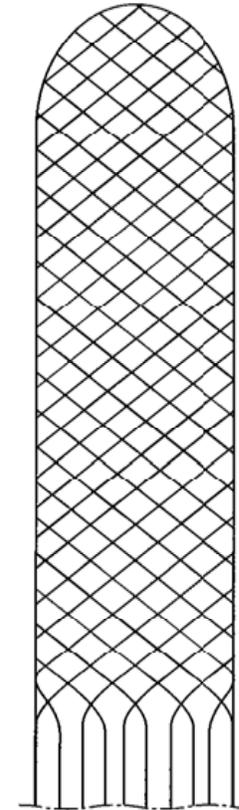


Fig.1

Meaning of “clamp” - UK

- Should be given ordinary meaning - something external to hold ends together
- Patent specification referred to use of clamps but added:
"Alternatively, one can solder, braze, weld or otherwise affix the ends....."
- UK High Court and Court of Appeal relied on this and other references to say that meaning of clamps excluded these *alternative* methods of affixing
- No infringement

Meaning of "clamps are adapted to clamp the strands at the opposed ends of the device" – is one clamp enough?

- Occlutech argued that "clamps" being in the plural meant that embodiments where only 1 clamp used were excluded.
- AGA argued an embodiment where 1 clamp used to clamp opposite ends of the strands was an immaterial variant and so covered by claim.
- UK Court agreed that the teaching covered such an embodiment but held that the skilled reader would understand the language used by the patentee was chosen to expressly limit the claim, as requiring clamps in plural not singular.
- No infringement

Meaning of clamps – German first instance and appeal – infringement held

- The technical function of the clamps was to hold the ends of the metal strands together.
- The skilled person would thus conclude that one clamp was sufficient to achieve this technical purpose where the ends of the metal strands were only present at one place.
- Both courts referred to a preferred embodiment described in the description which showed a loop-shape arrangement similar to that of the accused device.
- The fact that the literal wording of the claim required “two separate clamps at opposed ends” did not affect their findings.

German Supreme Court Decision - aligning with UK and NL – no infringement

- The earlier decisions from the lower Courts had looked to the essence or purpose of the invention being covered by the claim, as opposed to considering whether the patentee had deliberately chosen language to limit the claim
- German Supreme Court reversed the lower Courts and laid down rules for claim interpretation:
 - The claim takes precedence where inconsistencies exist: interpreting claimed features functionally does not overcome the inconsistency
 - Preferred embodiments in a description can only be used to interpret claims if they can be read as an explanation of the subject matter of the claims.
 - If the description offers several solutions to achieve a technical effect, but only one solution is claimed, then the other solutions in the description cannot be regarded as equivalents of the claimed solution
 - Infringement under the doctrine of equivalents in such cases should be ruled out

Why does it matter for international patent litigation?

- Consistency of decisions
- Potential for inconsistency may influence where you chose to sue
- Would a unified patents court address all this?
- Influence on other jurisdictions

Questions?

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