

CIPA FOUNDATION LECTURES

Claim Construction & Scope of Protection

James St.Ville QC
30 March 2022

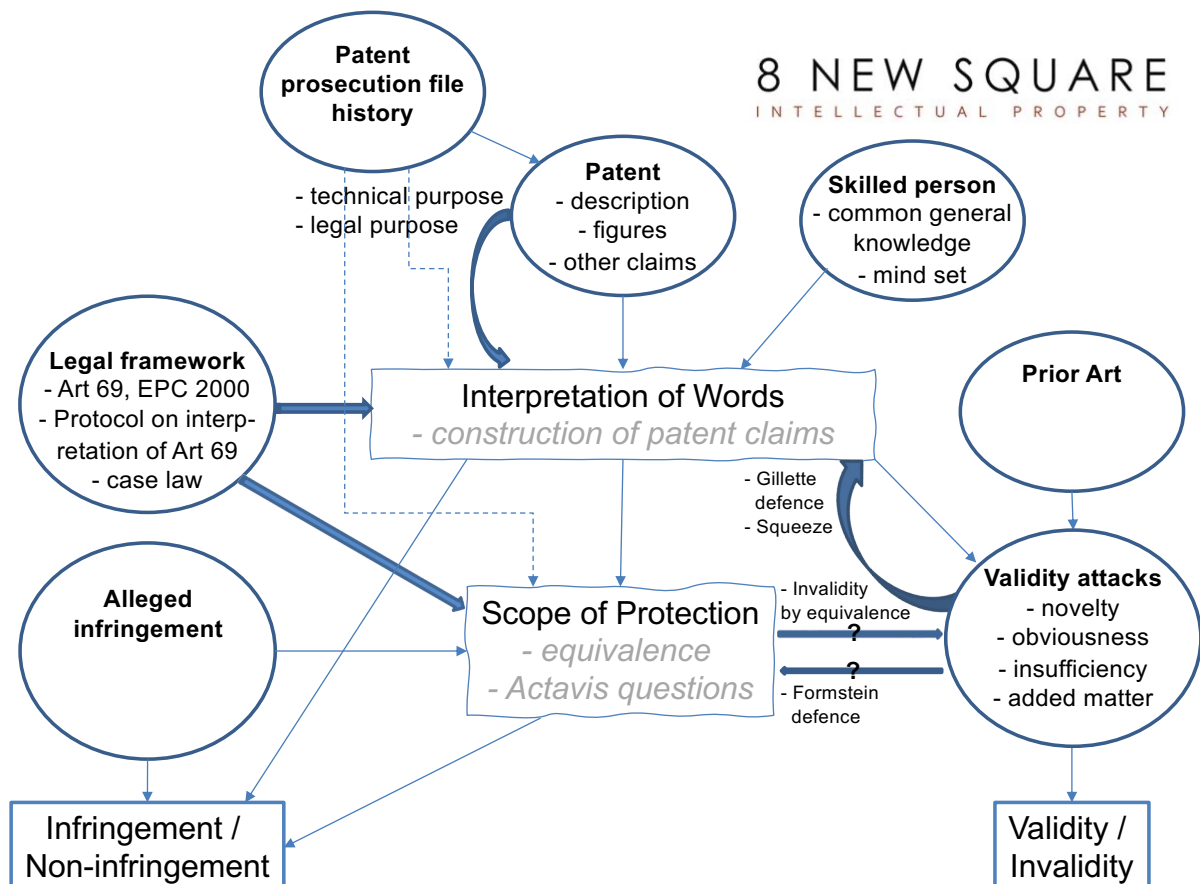
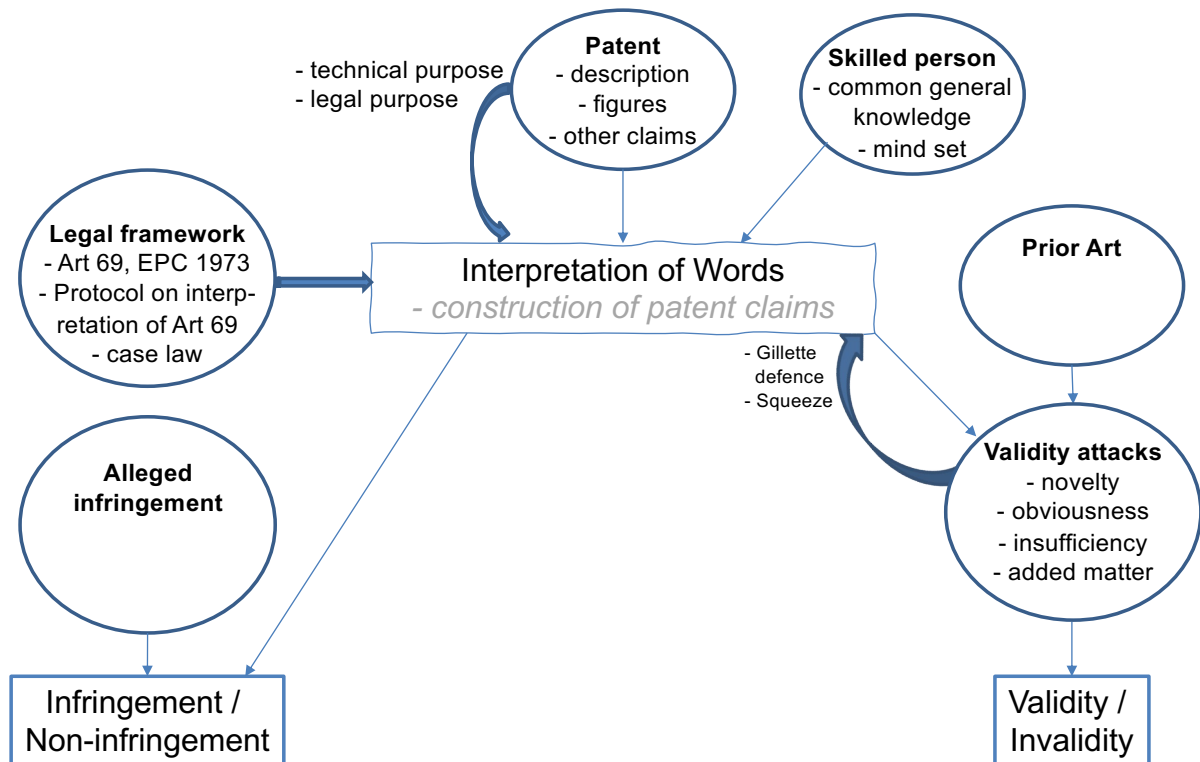
Interpretation and meaning of words

Living for Sabina meant seeing. ... Cemeteries in Bohemia are like Gardens. The graves are covered with grass and colourful flowers.

Tombstones are lost in the greenery. When the sun goes down, the cemetery sparkles with tiny candles. It looks as though the dead are at a children's ball. ...

For Franz a cemetery was an ugly dump of stones and bones.

A Short Dictionary of Words Misunderstood
The Unbearable Lightness of Being by Milan Kundera



European Patent Convention

Article 69(1), EPC 2000

- (1) 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***.

European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

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. ...

European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

... ***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. ...

European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

... 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.

European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

'Article 2 – Equivalents

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.*** '

Catnic v Hill and Smith [1982] RPC 183

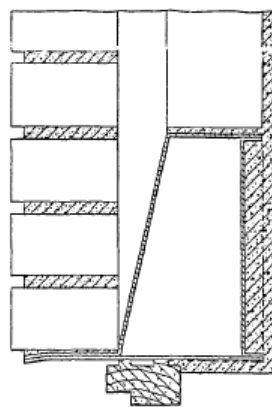
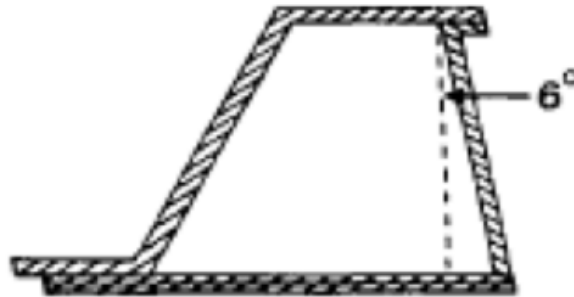


Figure 1.

A lintel for use over apertures in cavity walls having ...
... and a second rigid support member extending vertically
from or from near the rear edge of the first horizontal plate
or part to join with the second plate or part adjacent its rear edge.

Catnic v Hill and Smith [1982] RPC 183



Catnic v Hill and Smith [1982] RPC 183 (HL) - Lord Diplock

“Put in a nutshell the question to be answered is:

Would the specification make it obvious to a builder familiar with ordinary building operations that the description of a lintel in the form of a weight-bearing box girder of which the back plate was referred to as “extending vertically” from one of the two horizontal plates to join the other, **could not have been intended to exclude lintels** in which the back plate although not positioned at precisely 90° to both horizontal plates was **close enough to 90° to make no material difference** to the way the lintel worked when used in building operations?

No plausible reason has been advanced why any rational patentee should want to place **so narrow a limitation on his invention**. On the contrary, it would render his monopoly for all practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the exact vertical.”

Improver v Remington [1990] FSR 181

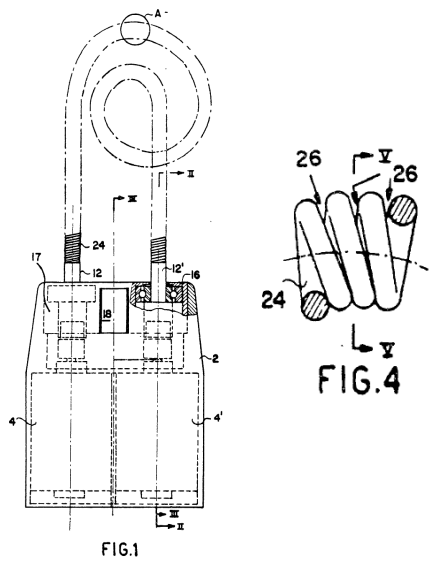


FIG. 1
Improver Patent

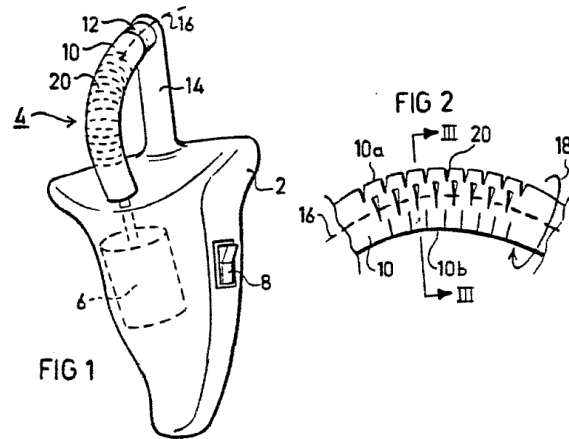


FIG 1
Remington Product

Improver v Remington [1990] FSR 181



Improver 'Epilady'

Remington 'Smooth & Silky'

Improver v Remington [1990] FSR 181 (Hoffmann J)

- (1) Does the variant have a material effect upon the way the invention works? If yes, 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 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, the variant is outside the claim.

Improver v Remington [1990] FSR 181 (Hoffmann J)

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a **figurative meaning** (the figure being a form of *synecdoche* or *metonymy*) **denoting a class of things** which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class.

Kirin Amgen v Hoechst Marion Roussel [2005] RPC 9 (HL) – Lord Hoffmann

There is only one compulsory question:

‘What would a person skilled in the art have understood the patentee to have used the language of the claim to mean?’ [69]

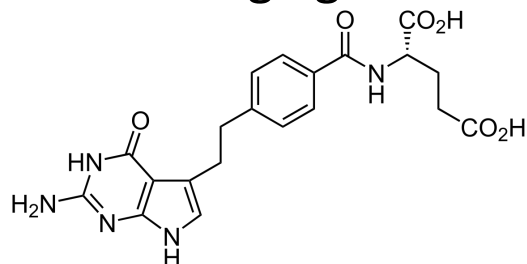
Equivalents as a guide to construction:

the Improver Questions were guidelines, more useful in some cases than in others, ... ‘which will in appropriate cases help to decide what the skilled man would have understood the patentee to mean’ [52].

Actavis v Eli Lilly [2017] RPC 21 (SC) – Lord Neuberger - EP 1 313 508

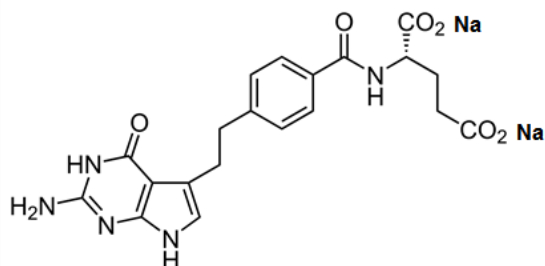
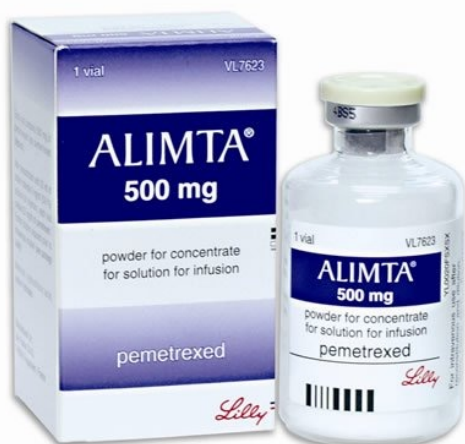
‘Combination containing an antifolate and methylmalonic acid lowering agent’

Particular antifolate
- Pemetrexed



Alimta

pemetrexed disodium and vitamin B12
for inhibiting tumour growth



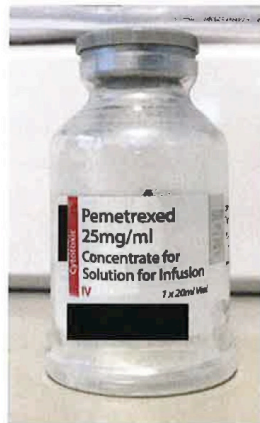
EP 1 313 508

Claim 1

1. Use of ***pemetrexed disodium*** in the manufacture of a medicament for use in combination therapy for inhibiting tumor growth in mammals wherein said medicament is to be administered ***in combination with vitamin B12*** or a pharmaceutical derivative thereof ...

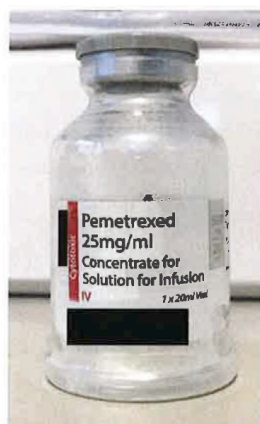
Actavis Proposed Products

pemetrexed *diacid*, pemetrexed *dipotassium*,
pemetrexed *ditromethamine* - with vitamin B12



Actavis's claim

for declarations of non-infringement (DNIs)
of UK, French, Italian and Spanish designations



Actavis v Eli Lilly in the Supreme Court

- Scope of protection – due account of equivalents
- Prosecution file history

Actavis v Eli Lilly in the Supreme Court

- EPC 2000 travaux préparatoires
- Comparative law – France, Italy, Spain, Germany, Netherlands, Switzerland, Ireland and AIPPI
- Academic and extra judicial analysis – Prof. Laddie, Dr Fisher, Dr Meier-Beck, AG van Peursen, Judge Kalden
- English case law - Walton v Potter & Horsfall (1843), Clark v Adie (1877), Beecham v Bristol Labs (1978), Catnic (1982), Improver (1990), Kirin Amgen (2005)

Actavis v Eli Lilly in the Supreme Court

The Key Question

Old

“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***”
(*Kirin-Amgen* at [34])

New

... a problem of infringement is best approached by addressing ***two issues***:

- (i) does the variant infringe any of the claims as a matter of ***normal interpretation***; and, if not
- (ii) 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 issue is "yes" there is infringement; otherwise, there is not.

(*Actavis v Eli Lilly* at [54] and [58])

Actavis v Eli Lilly in the Supreme Court

As to what is meant by “normal” interpretation, now see

- *Generics v Yeda* [2017] EWHC 2629 [2018] RPC 2, Arnold J [135]
- *Fisher & Paykel v Resmed* [2017] EWHC 2748, Richard Meade QC [82]
- *Illumina v Premaitha* [2017] EWHC 2930, Henry Carr J [202]
- *Liqwd Inc v L'Oreal (UK) Ltd* [2018] EWHC 1394, Birss J [58]
- *Icescape v Ice-World* [2019] FSR 5 (CA) [60]

- See also *Saab Seaeye v Atlas Elektronik* [2017] EWCA Civ 2175 Kitchin LJ, Floyd LJ at [18]-[19] - no dispute about principles which apply to the construction of patent claims – familiar 11 point summary in *Virgin Atlantic v Premium Aircraft* [2010] RPC 8 with point (ix) read in the light of *Actavis*

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

Old (*Kirin Amgen* at [51])

New (*Actavis v Eli Lilly* at [60] and [66],
Icescape v Ice-World at [66])

Q.1 Does the variant have a ***material effect on the way the invention works?***

If yes, the variant is outside the claim. If no -

Notwithstanding that it is not within the literal [that is to say ... normal] meaning of the relevant claim(s) of the patent, does the variant ***achieve substantially the same result in substantially the same way as the invention***, i.e. the inventive concept revealed by the patent?

(If yes -)

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

Old

New (*Actavis v Eli Lilly* at [61]-[64], [66])

Q.2 ***Would this*** (i.e. that the variant had no material effect on the way the invention works) have been ***obvious at the date of publication of the patent*** to a reader skilled in the art?

If no, the variant is outside the claim. If yes -

Would it be ***obvious to the person skilled in the art***, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, ***that it does so in substantially the same way as the invention?***

(If yes -)

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

Old

Q.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, the variant is outside the claim.

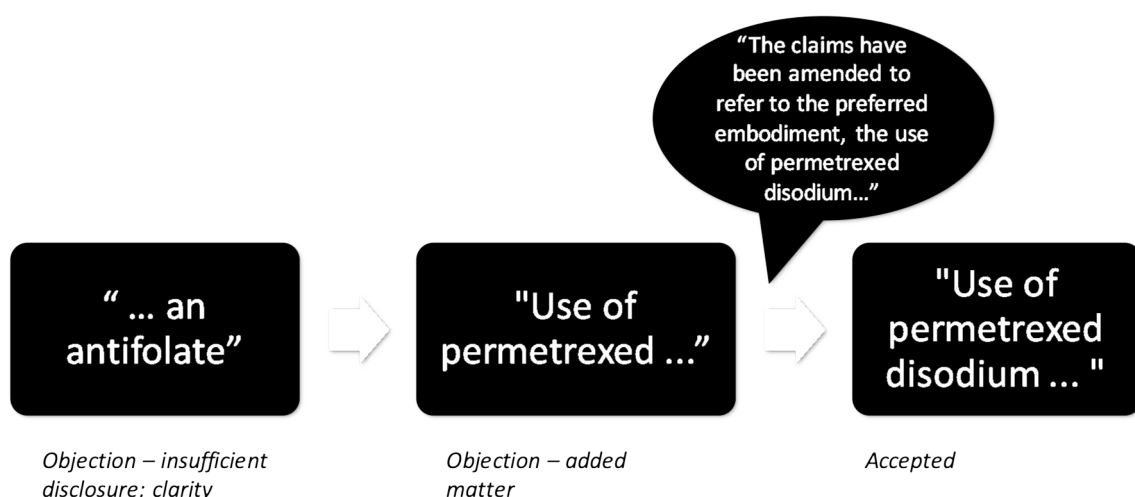
New (*Actavis v Eli Lilly* at [65], [66])

Would such a reader of the patent have concluded that the patentee ***nonetheless intended that strict compliance*** with the literal meaning of the relevant claim(s) of the patent was an ***essential requirement of the invention?***

(If 'yes', outside the claim; if 'no', may be infringement)

Actavis v Eli Lilly in the Supreme Court

Prosecution History



Actavis v Eli Lilly in the Supreme Court

Prosecution History

Old

‘The Courts of the United Kingdom, the Netherlands and Germany **certainly discourage, if they do not actually prohibit**, use of the patent office file in aid of construction’

(*Kirin Amgen* at [35])

New

‘it is appropriate for the UK courts to adopt a **sceptical, but not absolutist, attitude** to a suggestion that the contents of the prosecution file of a patent should be referred to when considering a question of interpretation or infringement, **along ... the same lines as the German and Dutch courts**’

(*Actavis v Eli Lilly* at [87])

Actavis v Eli Lilly in the Supreme Court

Prosecution History

Old

‘the **meaning of the patent should not change** according to whether or not the person skilled in the art has access to the file

and

in any case **life is too short** for the limited assistance which it can provide.’

(*Kirin Amgen* at [35])

New

‘... reference to the file would only be appropriate where

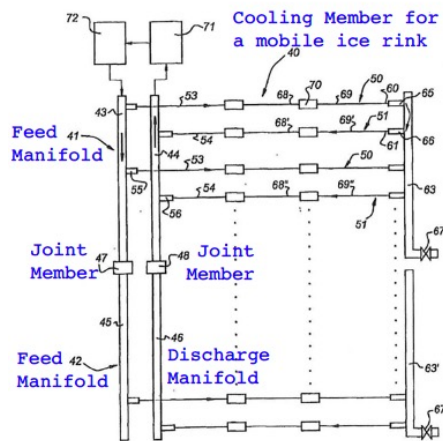
(i) the point at issue is **truly unclear** if one confines oneself to the specification and claims of the patent, **and the contents of the file unambiguously resolve the point**, or

(ii) it would be **contrary to the public interest** for the contents of the file to be ignored.’

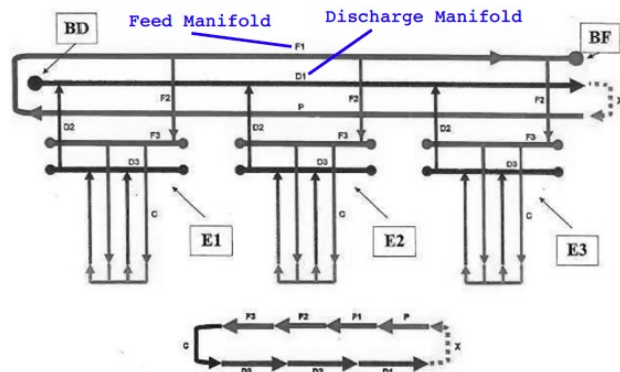
(*Actavis v Eli Lilly* at [88])

Icescape v Ice-World [2019] FSR 5 (CA)

Fig 8



The patent



Infringement

Icescape v Ice-World [2019] FSR 5 (CA)

Claim1

A cooling member for a mobile ice rink ...
characterised in that:

- the cooling member comprises at least two elements, each with a feed manifold (43, 45) and a discharge manifold (44, 46) ...
- two rigid sections ... connected by a joint member ([70])
- wherein by moving the joint members ([70]) a first series of parallel pipe sections can be placed in a transport position ... at an angle with respect to one another

Icescape v Ice-World [2019] FSR 5 (CA)

Lord Kitchen, Floyd LJ and Longmore LJ

- clear that the approach to infringement adopted by the Supreme Court in *Actavis v Eli Lilly* was markedly different from that which the courts had adopted since *Catnic v Hill & Smith* (which effectively conflated two issues into one single issue of construction)
- the first, whether variant infringed any of the claims of the patent as a matter of normal interpretation, was a problem of interpretation
- however, issue of equivalence was addressed in the second, was essentially what it was that made a variant immaterial

Icescape v Ice-World [2019] FSR 5 (CA)

Lord Kitchen, Floyd LJ and Longmore LJ

- it is appropriate to ask whether the component at issue is an “essential” part of the invention
- that is not the same thing as asking if it is an “essential” part of the overall product or process of which the inventive concept is part
- here regard must be had to the inventive concept or the inventive core of the patent

EValve v Edwards Life Sciences [2020] EWHC 514 (Birss J) at [315]

‘one should examine
what is the problem underlying the invention
and how does the patent solve the problem’

Akebia v Fibrogen [2020] EWHC 866

Arnold L J sitting at first instance [413-462]

- Actavis Q1 – partly a question of interpretation (inventive concept)
– partly a Q of fact (substantial same result in same way)
- Actavis Q2 – way formulated, rarely scope for negative answer
- Actavis Q3 – 7 factors
 - including principles from *Bundesgerichtsof*
(German Federal Court) X ZR 16/09 ‘Occlusion Device’
 - prosecution file history – limitation was to preserve
novelty - contrary to public interest to ignore

Person skilled in the art

8 NEW SQUARE
INTELLECTUAL PROPERTY

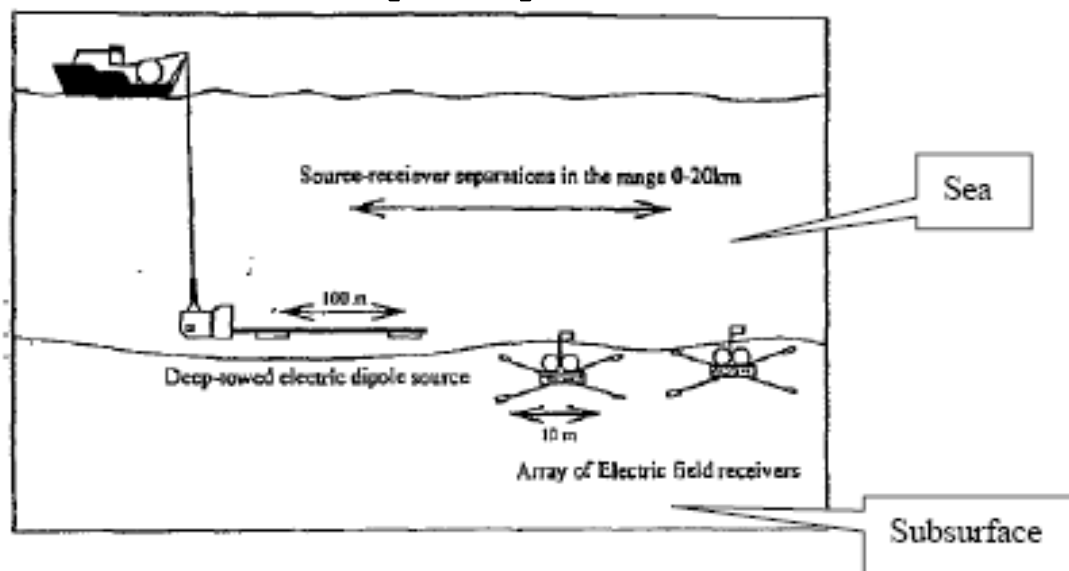
Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- Controlled Source Electromagnetic surveying – method of detecting hydrocarbon layers
- Is the skilled person the same for all purposes?
- Skilled team – geophysicists, controlled source electro-magnetism specialists or both?

Person skilled in the art

8 NEW SQUARE
INTELLECTUAL PROPERTY

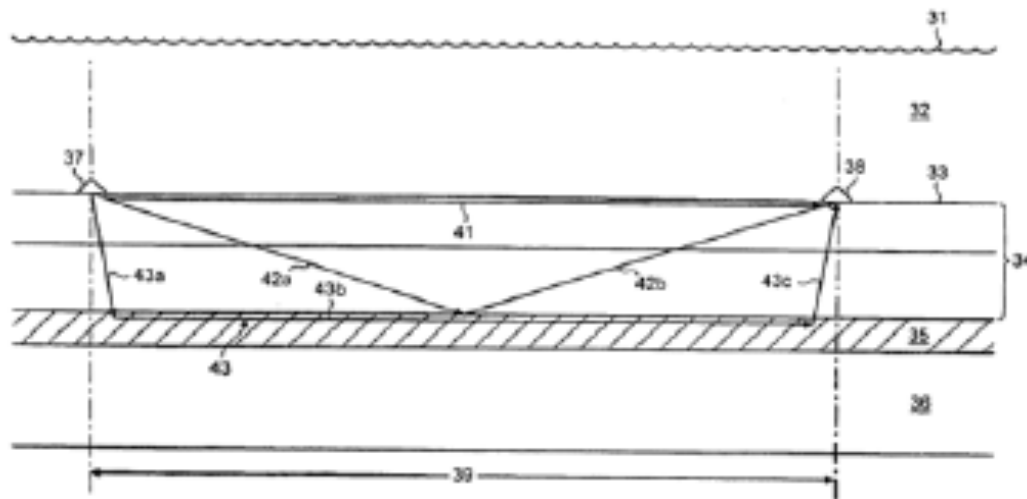
Schlumberger v. Electromagnetic Geoservices [2010] RPC 33



Person skilled in the art

8 NEW SQUARE
INTELLECTUAL PROPERTY

Schlumberger v. Electromagnetic Geoservices



Person skilled in the art

8 NEW SQUARE
INTELLECTUAL PROPERTY

Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

Mann J relied on Lord Diplock's speech in *Catnic*

"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 word [etc]'

Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

Jacob LJ

- ‘I do not agree that this well-known passage is relevant at all to the point in issue.’
- ‘The “person skilled in the art” is explicitly referred to three times in the European Patent Convention’
- ‘... the Protocol to Art. 69, Art 83 and Art 56’.

Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- ‘Art 69 and its Protocol are concerned with the scope of the claims – how they are to be interpreted’
- ‘Art 83 is concerned with sufficiency of description’
- ‘Art 56 is concerned with something different. The question it poses is whether there was an “inventive step”... “having regard to the state of the art” ... So Article 56 is about the position pre-patent.’

Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- Jacob LJ reviewed the English and EPO case law.
- ‘In none of these cases was it said that there was some sort of universal rule about the nature of the team. In each case it was treated as essentially one of fact depending on the problem in hand.’
- ‘for the purposes of obviousness [the Court] will have the regard to reality of the position at the time ... the ***combined skills (and mind-sets) of real research teams*** is what matters’

Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

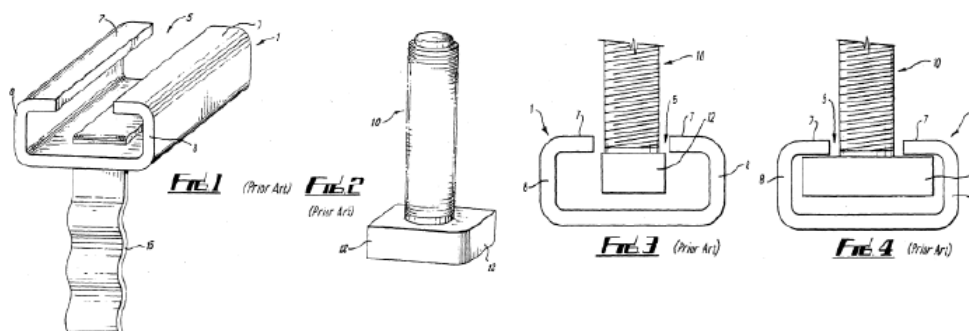
- This is not a different construction being given to the phrase “person skilled in the art” in different Articles of the European Patent Convention.
- The phrase is being applied to different situations.
- The flaw in that argument is to assume that ‘the art’ is necessarily the same both before and after the invention is made.
- ***Some inventions are themselves art changing.***

Virgin Atlantic v. Premium Aircraft Interiors [2010] RPC 8 (CA)

- How much patent law and practice is the skilled reader supposed to know?
- Reference numerals.
- Two-part claim.
- Divisional applications.

Construction

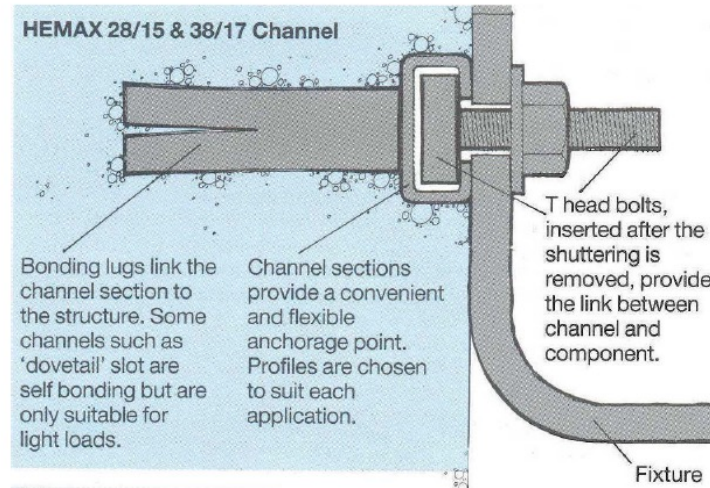
Ancon v ACS Stainless Steel Fixings [2009] All ER (D) 148 (CA – Jacob LJ)



Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

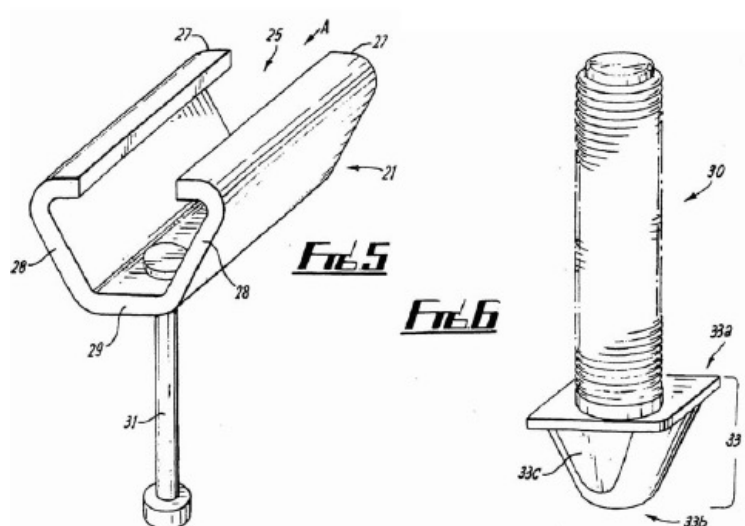
Ancon v ACS Stainless Steel Fixings



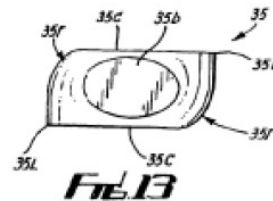
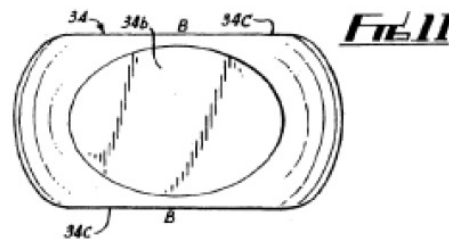
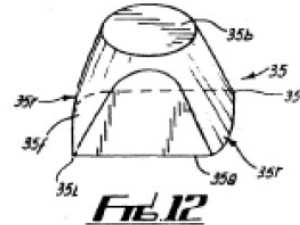
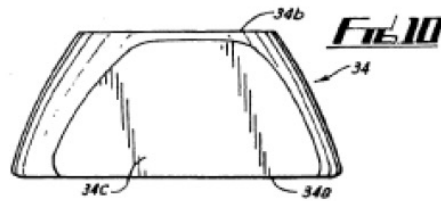
Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

Ancon v ACS Stainless Steel Fixings



Ancon v ACS Stainless Steel Fixings



Ancon v ACS Stainless Steel Fixings

Claim 1 – **Channel assembly** comprising

- [v-shaped channel]
- [fixing having a **head with inclined sides**]

'characterised in that
the **head** has a **generally elliptical cone shape**'

Ancon v ACS Stainless Steel Fixings

- alleged infringement



Ancon v ACS Stainless Steel Fixings

Cross examination of Ancon's Expert

Q. "...this cannot be a generally elliptical cone?"

A. "Yes."

Ancon v ACS Stainless Steel Fixings

Mr Justice Patten

‘the phrase “generally elliptical cone shape” is used to describe shapes, all of which retain the essential feature of an ellipse. ...’

‘Although construction is a matter for me, it is not without significance that **Mr Harrison was clear** in his evidence that what the Patent was teaching the skilled addressee was **that some form of elliptical head was required.**’

Ancon v ACS Stainless Steel Fixings

Arguments on appeal

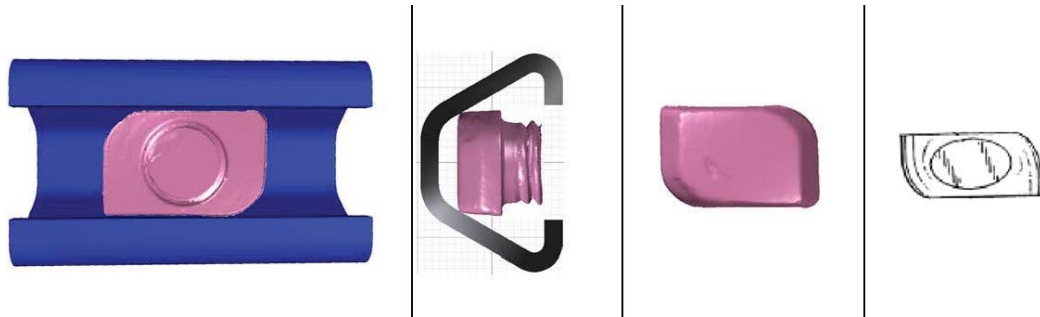
- What skilled addressee would have understood patentee to be using the words of the claim to mean
- Check that interpretation using Protocol Questions
- Take ‘due account’ of equivalents in accordance with Art 2 of the Protocol

all pointed in the same direction

Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

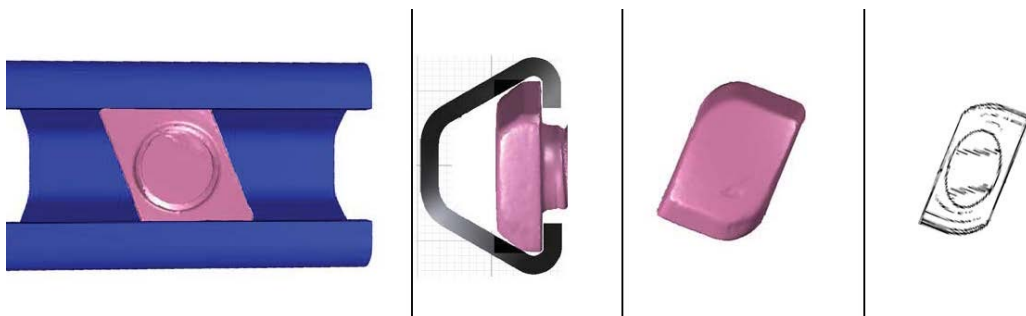
Ancon v ACS Stainless Steel Fixings



Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

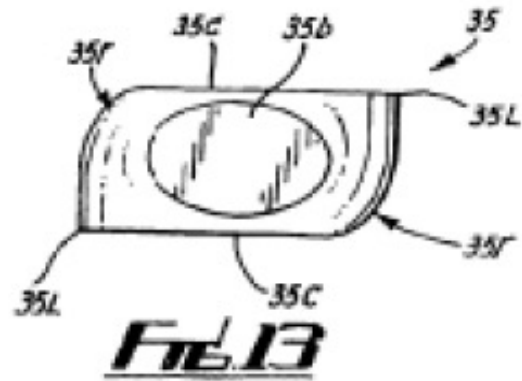
Ancon v ACS Stainless Steel Fixings



Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

Ancon v ACS Stainless Steel Fixings



Construction

8 NEW SQUARE
INTELLECTUAL PROPERTY

Ancon v ACS Stainless Steel Fixings

Lord Justice Jacob

‘it is just like an example of fig 13 of the patent but with the top of the head filed down so that there is no ellipse on the top.’

Ancon v ACS Stainless Steel Fixings

Lord Justice Jacob

‘All turns on what Lord Hoffmann called the compulsory question: “**what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?**” (*Kirin-Amgen* at [69]).’

Ancon v ACS Stainless Steel Fixings

Lord Justice Jacob

‘To gain an idea of what such a skilled reader would have understood the patentee to convey by “generally elliptical cone” one needs to think like him.’

Ancon v ACS Stainless Steel Fixings

Lord Justice Jacob

‘As the bolt is turned, two things happen ...

First the corners (particularly those of fig 13) ***would prevent the head simply rotating*** in the channel – like the rounded corners of the prior art.

Secondly as the head turned there would be the ***camming action*** by which it was forced forward against the inside of the channel.

He would never have seen anything like it before.’

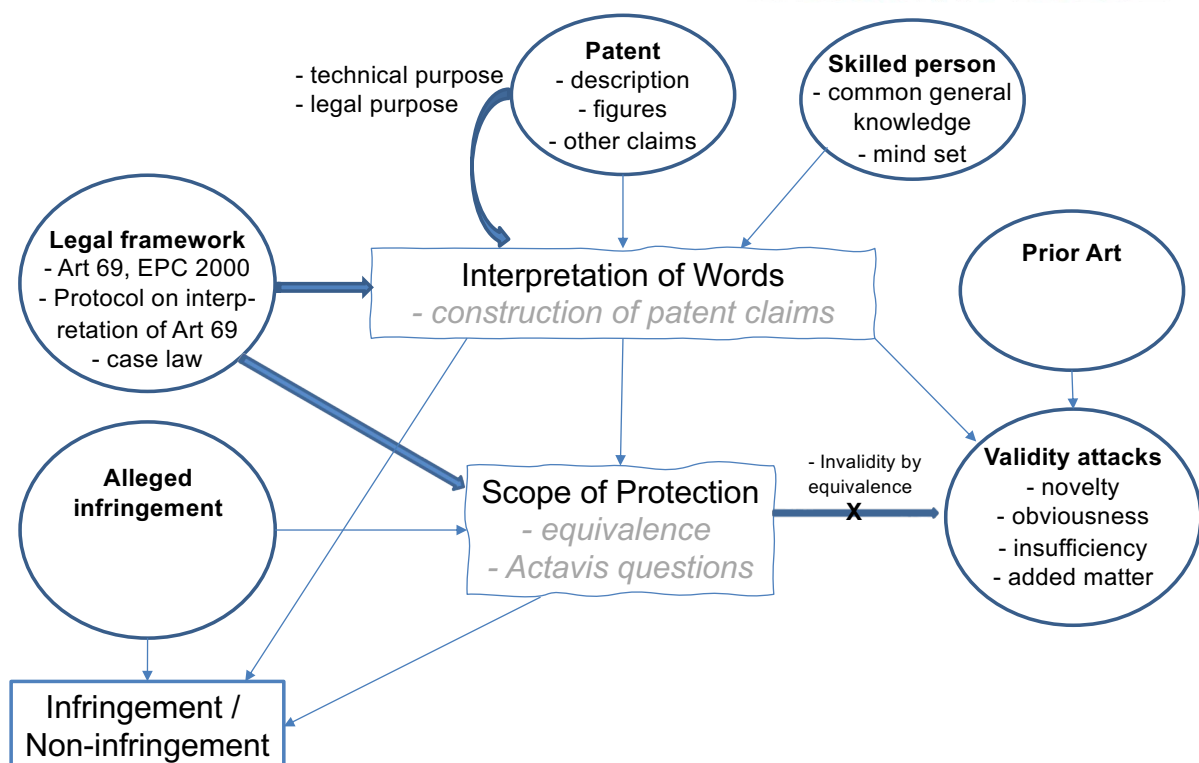
Ancon v ACS Stainless Steel Fixings

Lord Justice Jacob

‘Unlike the “Brighton Rock” of a seaside candy, the oval shape does not run through what is shown: save for very close to the top, the cross sections are not complete ovals – they have the vestiges of an oval.’

Fisher and Paykel v ResMed [2017] EWHC 2748 Richard Meade QC, 10Nov17 at [82]

- Arnold J considered in *Generics v Yeda* [2018] RPC 2:
 - (1) Prior to considering equivalents, the Court must apply purposive and not literal construction ([135] to [139]). ...
 - (2) There cannot as a matter of law be anticipation by equivalence ([161] to [167]). ...
- ‘Both these important points are arguable and I expect will be considered by the Court of Appeal and possibly the Supreme Court in due course’.
- ‘as matters stand I should follow ... Arnold J’



Equivalence & Validity

8 NEW SQUARE
INTELLECTUAL PROPERTY

- *Generics v Yeda* [2017] EWHC 2629 [2018] RPC 2, Arnold J
- *Fisher & Paykel v Resmed* [2017] EWHC 2748, Richard Meade QC
- *Eli Lilly v Genentech* [2018] 1 WLR 1755, Birss J
- *Liqwd Inc v L'Oreal (UK) Ltd* [2018] EWHC 1394, Birss J
- *Icescape v Ice-World* [2019] FSR 5 (CA – Floyd LJ)
- *Technetix v Teleste* [2019] FSR 19 (IPEC – HHJ Hacon)
- *Facebook Ireland Ltd v Voxer IP LLC* [2021] EWHC 1377 (Pat – Birss LJ)

Equivalence & Validity

8 NEW SQUARE
INTELLECTUAL PROPERTY

Technetix v Teleste [2019] FSR 19 (IPEC)

Squeeze arguments and historical limits on granted monopolies

- *Gillette Defence – Gillette v Anglo-American* (1913) 30 RPC 465
- *Merrell Dow principle - Merrell Dow v Norton* [1996] RPC 76

Potential Formstein defence

- *Case X ZR 28/25 Formstein* GRUR 1986, 803 – German FSC
- *Core Distribution v Lidl* – District Court of Hague, 14 March 2012
- *Jang v Boston Scientific* (Fed Circ 2017) Opinion No 16-1275 at 14-15

Facebook Ireland Ltd v Voxer IP LLC

[2021] EWHC 1377 (Pat – Birss LJ)

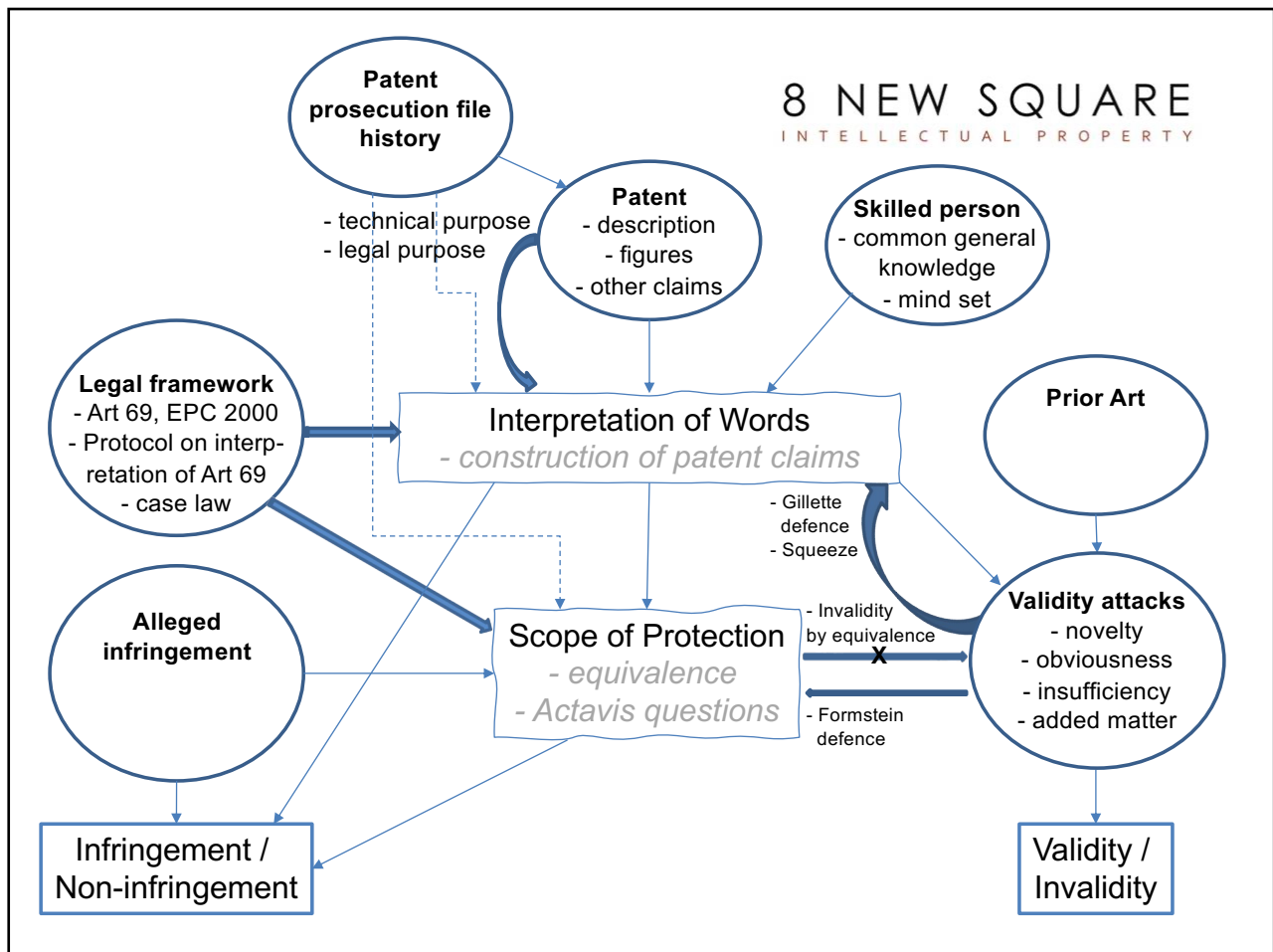
Potential *Formstein* defence

- ***Formstein*** is a **German case** in which the Gillette principle was applied in the context of an infringement case. The conclusion was that **in such a case the claim was to be held to its normal construction** rather than being invalid.
- *Formstein* has been **followed in the Netherlands Court of Appeal** in *Eli Lilly v Fresenius* (Case No C/09/541424). ... At para 4.11 the Dutch court in effect treated *Formstein* as a fourth question after the three equivalents questions which are more or less the same in every EPC jurisdiction.

Facebook Ireland Ltd v Voxer IP LLC

[2021] EWHC 1377 (Pat – Birss LJ)

- ... if I did have to decide the matter, I would hold that the right approach is the *Formstein* approach so that the conclusion if the equivalent device lacks novelty or is obvious is that the claim scope must be confined to its normal construction in that respect.
- I would do so for two reasons. If the claim on its normal construction is valid, then it seems **harsh to invalidate it on this ground**. What else could the patentee do but write their claim in a way which, normally construed, did not cover the prior art. So that approach promotes certainty.
- Secondly, since **it is clear that other EPC countries work that way**, this is a reason in itself for this EPC state to take the same approach.



8 NEW SQUARE
INTELLECTUAL PROPERTY

CIPA FOUNDATION LECTURES

Claim Construction & Scope of Protection

James St.Ville QC
30 March 2022