

"The Language of Claims": The Secrets and Shallows of Claim Interpretation

(An Outline)

by Axel von Hellfeld

I. Introduction

The topic of this lecture is not a general discussion of how European Courts tend to construe patents to decide on a possible infringement under the doctrine of equivalency and related issues, as this will be addressed by more learned speakers later on. Rather, it will address some very specific terms and phrases which appear quite often in patents, in particular in patent claims.

The perspective of this lecture is from a position of drafting a patent application and, in particular, claims.

When drafting a patent application, it should always be kept in mind that patents are administered by two different authorities. They are examined and granted by a patent office, i.e. examiners having a technical background, and they are enforced by courts, i.e. judges having a legal background.

In the following, some typical "patentish" terms are reviewed in this regard. These terms may seem trivial and clear to a patent practitioner but, upon a closer look, questions arise which are worth considering when drafting a patent claim.

II. Some phrases most popular with patent practitioners

1. "Comprising"

Most patent claim draftsmen feel quite comfortable with the term "comprising" when describing constituents of an invention in a non-limiting manner. For example, it seems to be the general belief that describing a chemical substance as "comprising A, B, C and D" means that a substance can also additionally comprise component E without falling outside the scope of the claim. This understanding seems to be well-settled in the USA.

Nevertheless, it is questionable whether European judges will always apply such a simple and clear-cut understanding of "comprising", even if we assume that the patent is in the English language that this language is decisive regarding infringement, and that the judge is perfectly fluent in English.

In the GUIDELINES FOR EXAMINATION IN THE EPO, C, III, 4.21 it reads:

"While in everyday language the word "comprise" may have both the meaning "include", "contain" or "comprehend" and "**consist of**", in drafting patent claims, legal certainty normally requires it to be interpreted by the broader meaning "include", "contain" or "comprehend".

There is no doubt, that this statement in the GUIDELINES is correct. It is also, of course, correct that the GUIDELINES stipulate that the Examiner must give the broadest meaning to such wording, namely, a non-limiting meaning (the meaning of an incomplete listing).

However, in infringement litigation, a judge may very well apply "everyday meaning" to the word "comprise" in the sense of "consist of", without departing from correct English.

An Australian Court, some years ago, questioned the "classical" understanding of "comprising" in Patent Law, simply by applying plain English.

I faced a similar problem in the Munich District Court, some years ago, when the claim language was "...comprising a ring" and the accused device used several rings. The Judge asked: "Why didn't you say ...at least one ring?"

Therefore, it is preferable to use words like "including" even if that word, from a linguistic point of view, appears somewhat odd in the context of mechanical inventions and the like.

2. "Predetermined" and the like

Another word patent draftsmen seem to like very much is "predetermined" or "preset" or "pregiven" or the like.

This term, however, is absolutely meaningless in 99.9% of the cases. It can be omitted without amending the information conveyed by the sentence. There is no difference between "a distance" and a "predetermined distance". By the way: who is predetermining that distance?

The only exception may be in the field of cryptography or the like when e.g. a certain number is not random but "predetermined".

So, usually, the use of "predetermined", "pregiven", or "preset" may impress the client only. However, the client may be less impressed when it comes to infringement with such a claim.

Infringement is decided upon, as outlined above, by judges having a legal background, which means that they are trained to give meaning to terms and words in a provision like a claim. So, in infringement litigation, the question may very well be what the word "predetermined" in a claim shall mean. That discussion always aims at a limited understanding.

There is a case pending in first instance in a German Court where the defendant very heavily argues this way, namely that the word "predetermined format" in the claim (in the field of telecommunications) must have a certain meaning and cannot be ignored. It cannot be taken for granted that the judge will not listen to this kind of argument. All the patentee can forward as a response is to say that "predetermined" has no meaning and can be omitted. Not a very impressive submission!

3. "Means plus function"

Under the European Patent Convention, Art. 69, the scope of protection conferred by a "means plus function" feature like "means for biasing", "means for fastening", "means for pumping", etc. should usually cover what it says, i.e. the claim will cover regularly any means performing the function specified.

In the USA, the situation is quite different. A "means plus function" feature is seen rather as a mere reference to the specification. In § 112 of the Code it reads:

"An element in a claim for the combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim **shall be construed to cover the corresponding structure, material, or acts as described in the specification and equivalents thereof.**"

In other words, under US law, a "means plus function" feature does not normally cover any means which performs the specified function, but only those embodiments disclosed in the specification of the patent and equivalents thereof.

Therefore, "means plus function" wording is usually recommendable in Europe but not in the US.

4. "generally", "about", "approximately", etc.

The GUIDELINES FOR EXAMINATION IN THE EPO, C, III, 4.7 are by far not as strict as many EPO Examiners tend to believe. The GUIDELINES allow for such terms if the meaning is sufficiently clear in the context of the patent read as a whole.

Apart from such considerations which are essentially concerned with "lack of clarity" (Art. 84), such terms in claims need careful consideration with regard to their exact literal meaning in the respective context.

- a) Let us assume the claim wording "...from about 4 cm to about 6 cm". Let us also assume that the patent application, when originally filed, contained such wording only, i.e. never disclosed "4 to 6 cm".

Let us also assume that prior art is revealed during examination disclosing 3.9 cm. The Examiner will, most reasonably, argue that "about 4 cm" covers literally "3.9 cm". Will it be possible to delete in the claim and the specification "about" in order to establish novelty over the prior art? I see problems in the EPO!

Consequence: Whenever words like "about" are used, the disclosure should always be such that such terms can be deleted, as a fall-back position.

- b) Patent draftsmen often also use the term "approximately" and they see no danger of a pitfall with it. That may be dangerous. The strict literal meaning of "approximate" is "near by" but not "exactly identical". Of course, the interpretation must always be

contextual, but to repeat my point: "approximately 5" does not mean "exactly 5", but something more like "4.9".

If an inner tube shall fit without friction into an outer tube, the outer diameter of the inner tube must be approximately the same as the inner diameter of the outer tube, actually somewhat smaller. In this situation the term "approximately" is correct in its strict literal meaning.

Of course, "everyday English" gives a broader meaning to "approximately" but a very strict literal understanding may be different from "everyday English". Therefore, wording like "at least approximately" is usually preferable.

5. Apparatus Claims comprising an Activity

Very often apparatus claim comprise a feature describing an activity. For example:

"...a pump (for) pumping a liquid from a first chamber into a second chamber..."

Such "activities" cannot be avoided in apparatus claims, because most advanced technical machines are not artificial sculptures, but they do something. A combustion engine cannot be described correctly without referring to activities of e.g. valves, pistons, etc.

For several years, many EPO Examiners, if not most of them, object to such wording because, allegedly, it is not appropriate to refer to activities in an apparatus claim. They request to use the following wording:

"...a pump **adapted to** pump a liquid from a first chamber into a second chamber..."

The "rationale" underlying that request is that there must be clarity regarding the category of the claim (apparatus, not method).

I am not sure whether the EPO really knows what they are requesting. The invention, in technical terms correctly described, teaches a pump doing something, namely pumping the liquid from the first chamber into the second chamber. The invention is not about "adapting something".

Let us assume that the infringing device uses a pump which pumps a gas (not the liquid) from the first chamber into the second chamber. That pump may be also suitable to pump a liquid, but it actually does not do that.

The above-cited first wording is not literally infringed by the gas pump, but the above-cited second wording, requested by the EPO, is broader in scope of protection as it covers literally also the pump of the accused device which is "adapted to pump a liquid" as well, even if it actually pumps a gas.

The EPO practice ignores that the claim must describe the invention correctly in technical terms and that formalities (regarding e.g. category) should not be the driving criteria. Case

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Law, both of the EPO Appeal Boards as well as national Case Law, has acknowledged for a long time that technology cannot always be pigeonholed into the categories of patent law. Even with a wording like "...means (for) pumping..." the category of the claim is clear, namely an apparatus.

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Topic of this lecture:

Typical “patentish” terms, namely:

1. “Comprising”
2. “Predetermined”
3. “Means plus function”
4. “generally”, “about”, “approximately”

“comprising”:

General belief:

In patent law, “comprising” is non-limiting, i.e. covers incomplete or complete listings

GUIDELINES FOR EXAMINATION IN THE EPO, C, III, 4.21:

"While in everyday language the word "comprise" may have both the meaning "include", "contain" or "comprehend" and "**consist of**", in drafting patent claims, legal certainty normally requires it to be interpreted by the broader meaning "include", "contain" or "comprehend".

Infringement litigation:

A judge may apply “everyday meaning”, i.e. it cannot be excluded (in Europe) that “comprise” will be understood to mean “consist of”.

- Australian Court
- Munich District Court

“predetermined”:

a) Thesis:

In 99% of the cases “predetermined” is meaningless, i.e. it does not add anything to the information conveyed by a sentence.

Example:

What is the difference between “a distance” and “a pre-determined distance” ?

Judges, well-trained in exegesis, try to give meaning to words in a provision.

Giving meaning to “predetermined” can result in a limitation of the claim.

Case pending in German Court:

Claim language:

“predetermined format”

“Means plus function”:

Examples:

- means for biasing,
- means for fastening,
- means for pumping, etc.

Under the European Patent Convention, Art. 69, the scope of protection conferred by a “means plus function” feature will regularly cover what it says, namely any means performing the function specified.

In the U.S., however, § 112 of the Code:

“An element in a claim for the combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim **shall be construed to cover the corresponding structure, material, or acts as described in the specification and equivalents thereof.**”

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Therefore, “means plus function” wording is usually recommendable in Europe but not in the US.

“generally”, “about”, “approximately ”, etc.

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EPO, C, III, 4.7 allow for such terms if
the meaning is sufficiently clear in the
context of the patent read as a whole.

Subject of this discussion:

Not clarity but literal meaning.

Let us assume a claim wording:

“...from about 4 cm to about 6 cm.”

Further assumption: the application as filed nowhere discloses “4 to 6 cm”.

Prior art: 3.9 cm

Problem ?

“approximately”

What is the exact strict literal meaning of
“approximate” ?

Example:

Inner tube shall fit without friction into an outer tube.

Apparatus Claims comprising Activity

Apparatus, comprising

“...a pump (for) pumping a liquid from a first chamber into a second chamber...”

EPO Examiner's request:

“...a pump **adapted to** pump a liquid from a first chamber into a second chamber...”

The infringing (accused) apparatus:

A pump pumping a gas (not a liquid) from the first chamber into the second chamber, however,

The pump is also adapted (suited) to pump a liquid from the first chamber into the second chamber.

Compare literal content of both formulations!

Question of Disclosure!