

## **The interpretation of patent claims by the UPC**

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Claim interpretation is often a major issue in patent infringement or invalidity litigation. After a year and a half of existence, the Unified Patent Court ("UPC") has published several decisions that provide a better understanding of its method of claim interpretation. It appears that the wording of the claim considered as a whole is decisive and that the description and drawings must always be taken into account. The question of whether the *file wrapper* should be *considered* is still awaiting clear arbitration by the Court of Appeal

### **Reference decisions of the UPC Court of Appeal regarding claim interpretation**

In the decision *NanoString Technologies v. 10xGenomics*<sup>1</sup>, the UPC Court of Appeal clarified the standard applicable for interpreting patent claims, based on Article 69 of the European Patent Convention ("EPC") and its Protocol, for the purposes of both infringement and validity assessments:

*" The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC.*

*The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.*

*This does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.*

*The patent claim is to be interpreted from the point of view of a person skilled in the art.*

*In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties."*

This decision, the first on appeal to address the scope of rights in both infringement and validity matters, has set a significant precedent, as it has since been consistently cited in on-the-merits decisions by local divisions.

The influence of this case law is expected to extend even to EPO practice. Indeed, the referral to the Enlarged Board of Appeal G 1/24 of 24 June 2024<sup>2</sup> (decision pending) specifically references this decision and raises the question of claim interpretation under Article 69 EPC for assessing a patent's validity under Articles 52 to 57 EPC (which cover aspects such as novelty and inventive step of the claims).

The referral concerns, among other things, whether it is necessary to systematically refer to the description or only when a claim term is unclear or ambiguous on its own. In its preliminary opinion, the Enlarged Board of Appeal of the EPO<sup>3</sup> recognises the importance of harmonizing practices of the EPO, the UPC and national Courts regarding the interpretation of claims. However, it qualified the decision in *NanoString Technologies v. 10xGenomics* by stating that the description and figures **may** (and not "always must") be considered when interpreting claims. This would finally confirm the EPO's abundant case law, which applies a case-by-case approach to the issue.

<sup>1</sup> "Headnote of CoA Luxembourg, 26 February 2024, *NanoString Technologies v. 10xGenomics*, UPC\_CoA\_335/2023, APL\_576355/2023 as rectified by CoA Luxembourg, 11 March, UPC\_CoA\_335/2023, APL\_576355/2023

<sup>2</sup> <https://www.epo.org/en/boards-of-appeal/decisions/t220439eu1>

<sup>3</sup> <https://register.epo.org/application?documentId=M6T4S2OLD02S340&number=EP14806330&lng=en&npl=false>

In addition to the *NanoString Technologies v. 10xGenomics* decision, the UPC Court of Appeal also completed its interpretation standard with the *VusionGroup v. Hanshow* decision. Referring to the standard in its first decision, the Court of Appeal stated that a feature of a claim must be interpreted in the light of the claim as a whole.<sup>4</sup>

While the standards established by the UPC Court of Appeal in these two rulings are clearly formulated, their application raises questions, particularly when complex questions of interpretation arise for the judges to decide? In the following sections, we examine various UPC's decisions at first instance and on appeal that provide insight into how these standards are applied in practice.

The following topics will be addressed:

- The predominant role of the claims;
- The impact of drafting errors in claims;
- The "*file wrapper estoppel*" and more broadly, the influence of the patent grant procedure;
- Infringement by equivalence.

### **The features of the claim must be interpreted as a whole**

In the *Novartis v. Genentech* decision, the Düsseldorf local Division reaffirmed that the claim must be assessed as a whole, in line with the previously mentioned *VusionGroup v. Hanshow* decision. In this case, claim 1 of the patent at stake, reproduced below, concerned a pharmaceutical formulation with two distinct characteristics: first, the presence of histidine (characteristic 3) and second, a pH of 6 (characteristic 6).

*"A pharmaceutical formulation of anti-IgE antibody rhuMAb E 25, characterized in that the formulation is: about 150 g/L of the anti-IgE antibody in 0.02 M histidine, 0.2 M arginineHCl, 0.04% polysorbate 20, pH 6."*

The defendant argued, on the basis of an expert's report, that the term "histidine" would be understood by the person skilled in the art to refer to histidine in its basic form and that, for example, the pH value targeted by the claim could be achieved in two different ways.

The Düsseldorf Local Division rejected the defendant's argument, stating that a person skilled in the art would interpret the claim as a whole rather than focusing strictly on the literal meaning of isolated features. Consequently, a skilled person would infer from the specified pH of 6 and the well-known buffering function of histidine that it was present in equal proportions in its neutral and protonated (1+) forms, accompanied by a counterion (histidine salt). In addition, the presence of HCl mentioned in the claim confirms the Court's view that histidine is present in the form of a histidine salt.

Thus, the Düsseldorf Local Division considered that the pH feature of the pharmaceutical formulation implicitly determined certain characteristics of another feature in the claim, namely the presence of histidine salt<sup>5</sup>.

### **Claims remain the "decisive foundation" of patent interpretation**

In the *Dexcom v. Abbott* decision of 11 December 2024, Paris Local Division had to interpret the terms "*rules*" and "*settings*" in claim 1 of the patent in dispute. The Court found that while the interpretation of these terms by one of the parties was consistent with the description, it was not consistent with the features of the claim considered as a whole. However, since claim 1 is clear and unambiguous, there is no reason to modify its scope with the aid of the description, as it would go beyond the use of the description as an "explanatory aid" and thus run counter to the Court of Appeal's decision *NanoString Technologies v. 10xGenomics*. It also recalled that the scope of a claim was not that which appeared to be intended by the patentee on reading the description. It therefore did not accept the patentee's interpretation, which confirms the "decisive" nature of the terms of the claim.<sup>6</sup>

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<sup>4</sup> CoA Luxembourg, 13 May 2024, *VusionGroup v. Hanshow*, UPC\_CoA\_1/2024, APL\_8/2024 ORD\_17447/2023, "headnote" and § 29 to 31

<sup>5</sup> LD Düsseldorf, 6 September 2024, *Novartis v. Genentech*, UPC\_CFI\_166/2024, ORD\_50565/2024, p. 12.

<sup>6</sup> LD Paris, 11 December 2024, *Dexcom v. Abbott*, UPC\_CFI\_395/2023, ORD\_63909/2024, § [54].

This confirms that the description and drawings may only be used to interpret claim features insofar as such interpretation remains consistent with the claim's wording.

Similarly, in *Fujifilm v. Kodak*, the Local Division of Düsseldorf reaffirmed the primacy of claims, in line with the Court of Appeal's decision in *NanoString Technologies v. 10xGenomics*. While it recalled that Article 69 EPC and its interpretation protocol prevent the subject matter of a patent from being extended by means of the description beyond what is claimed, it also considered that the terms used in a claim should normally be considered according to their broadest technical interpretation.

The LD Düsseldorf concluded:

***“A narrowing interpretation of the claims which deviates from the broader general understanding of the terms used therein by a skilled person can therefore only be permitted if there are convincing reasons based on the circumstances of the individual case in question. Art. 69 EPC and its Protocol do not provide a justification for excluding what is literally covered by the terms of the claims by a narrowing claim construction based on the description or drawings.”***

The Court thus held that, as a general principle, restricting claim interpretation based on the description and drawings is not permitted.<sup>7</sup>

#### **Error correction - standard of rule 139 EPC and claim interpretation**

In *Alexion v. Amgen*, a decision relating to requests for precautionary measures under Article 62 UPCA, the Hamburg Local Division ruled on the interpretation of a claim in the event of an error in the description and/or the claim.

In the present case, the issue was to interpret claim 2 of the patent at stake, which corresponded to a pharmaceutical composition comprising an antibody according to claim 1. The antibody comprised a "light chain" according to the sequence ID NO: 4 described in paragraph [0134] of the patent and corresponding to Eculizumab. However, this sequence did not match the Eculizumab sequence as recorded in the 'CAS' database, as it included 22 additional amino acids at the beginning of the chain.

During the patent granting procedure, the applicant, namely Amgen, filed a request to amend claim 1 on the basis of rule 139 EPC because it wished to exclude the first 22 amino acids of sequence ID NO:4 in paragraph [0134]. Therefore, Amgen argued that claim 1 contained a manifest error. The EPO's Board of Appeal ruled that the error was not obvious but instead raised a "doubt" for a person skilled in the art and therefore rejected the request. As a result, the patent was granted as originally filed.

In the litigation between Alexion and Amgen, Alexion argued that Amgen was infringing claim 2 of the granted patent. The interpretation of sequence ID NO: 4 was therefore important. The Hamburg Local Division ruled in favour of Alexion on this point.

The Hamburg Local Division<sup>8</sup> first considered that the standard for interpreting a claim is not the same as the standard for correcting an error under Rule 139 EPC. It noted that a person skilled in the art would have implemented the invention in a way that ensured it worked. Secondly, the Court considered that it had in its possession additional evidence compared to the Board of Appeal at the time of its decision. The Hamburg Local Division concluded that a person skilled in the art would have recognized that sequence ID NO: 4 was not correctly reproduced in paragraph [0134] of the patent. Therefore, the Court interpreted claim 2 of the patent in a manner favourable to the patentee. However, considering that the validity of the patent at stake was not certain, it dismissed Alexion's appeal. The decision has been appealed.

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<sup>7</sup> LD Düsseldorf, 28 January 2025, *Fujifilm v. Kodak*, UPC\_CFI\_355/2023, ORD\_598539/2023, "headnote" and p. 27

<sup>8</sup> LD Hamburg, 26 juin 2024, *Alexion v. Amgen*, UPC\_CFI\_124/2024, ORD\_38032/2024, p. 18 et 19.

The Court of Appeal<sup>9</sup> overturned the Hamburg Local Division's interpretation of error corrections, holding that the standard of rule 139 EPC (obvious error and correction) also applies to the interpretation of patent claims. In line with the interpretation of the EPO Board of Appeal, it stated that it was not obvious to a person skilled in the art that the decisive passage of the description contained an error but that, at best, the person skilled in the art could have a doubt on the matter. The Court therefore considered that the subject matter of claim 2 was "probably" insufficiently described and rejected Alexion's appeal but based its decision on a different issue.

### **Consideration of the granting procedure and the cited prior art documents**

As the case law stands, it would appear that the use of the patent grant procedure to interpret the claims is prohibited, particularly from a "file wrapper estoppel" perspective, but that it is possible to exploit the declarations made by the patent proprietor during this procedure as one indication, among others, of the point of view of the person skilled in the art at the priority date of the patent.

For example, in *Ortovox Sportartikel v. Mammut Sports Group* (2023), which predates the Court of Appeal's decision in *NanoString Technologies v. 10xGenomics*, the Düsseldorf Local Division (LD) responded to the defendant, who was relying on the patent granting procedure to interpret the claims, by stating that both Article 24(1)(c) UPCA and Article 69 EPC strictly referred to the documents used to interpret the claims, specifically the description and drawings. It indicated that the statements made during the grant procedure could, **at best**, be indications of how the person skilled in the art would understand the feature which was the subject of those statements<sup>10</sup>. In 2024, in the same case, and subsequent to the *NanoString Technologies v. 10xGenomics* decision, the LD Düsseldorf reiterated its assessment.<sup>11</sup>

The LD Düsseldorf confirmed this position in its *SodaStream v. Aarke* decision, in which the defendant used the famous "Gillette defence". The Court reiterated that one of the merits of referring only to the claims, description and drawings to interpret the patent is that it guarantees legal certainty for third parties. The patent itself is sufficient to interpret its scope. However, if the description refers to a prior art document, that document may be used to interpret the claims: if the subject matter of the patent differs from the cited document in a certain way, an interpretation of the claims that would run counter to that way must be avoided.<sup>12</sup>

In summary, the Local Division of Düsseldorf generally excludes the use of the file wrapper and prior art documents for interpreting the scope of a claim. However, it acknowledges that the file wrapper may provide indications of how a feature is interpreted by a person skilled in the art. Additionally, once a prior art document is cited in the patent, it can be used to interpret the patent.

On the other hand, in *SES-Imagotag v. Hanshow*, the Munich LD used the file wrapper - in this case the application as filed - to interpret the scope of the claim. It stated that the claims of the application as filed, in conjunction with the amendments made during the granting procedure, could be of assistance in interpreting the claims. In this case, the debate concerned the relative positions of an antenna and a printed circuit board. The Court explicitly stated that the as-filed version of a claim can be used as an aid to interpretation. This was used by the judges to confirm the interpretation of the claim as issued: the antenna and the printed circuit board must be diametrically arranged in relation to each other.<sup>13</sup>

It therefore appears that there is currently a discrepancy between the Düsseldorf Local Division, which avoids using the grant procedure to interpret the scope of the claims, and the Munich Local Division, which has used it.

This question was not decided by the Court of Appeal. Although the decision of the Munich Local Division was upheld on appeal, the Court of Appeal indicated that it did not need to rule on whether the granting procedure

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<sup>9</sup> CoA Luxembourg, 20 December 2024, *Alexion v. Amgen*, UPC\_COA\_405/2024, APL\_40553/2024, ORD\_60221/2024, "headnote" and § 35 to 39 and 48.

<sup>10</sup> LD Düsseldorf, 11 December 2023, *Ortovox Sportartikel v. Mammut*, UPC\_CFI\_452/2023, ORD\_592936-2023, end of page 4, beginning of page 5.

<sup>11</sup> LD Düsseldorf, 9 April 2024, *Ortovox Sportartikel v. Mammut*, UPC\_CFI\_452/2023 ORD\_13918/2024, "headnote" and p. 15

<sup>12</sup> LD Düsseldorf, 31 October 2024, *SodaStream v. Aarke*, UPC\_CFI\_373\_2023, ORD\_598499/2023, "headnote" and p. 23

<sup>13</sup> LD Munich, 20 December 2023, *SES-Imagotag v. Hanshow*, UPC\_CFI\_292/2023, ORD\_596193/2023, "headnote" and p. 20

should be considered, as it considered that the procedure did not provide any additional insight on the matter to decide the case.<sup>14</sup>

In 2024, in the aforementioned *Alexion v. Amgen* decision, the Court of Appeal, following example of the Düsseldorf Local Division, confirmed that the statements made by the patent proprietor during the granting procedure can be an indication of the point of view of a person skilled in the art at the filing date<sup>15</sup> and in particular in this case that they confirmed that for a person skilled in the art the error in question was not obvious<sup>16</sup>. On the other hand, the Court of Appeal did not take a position on the possibility of using file wrapper estoppel in interpreting the scope of the claim.

Thus, while the Court of Appeal has confirmed the approach of the Düsseldorf Local Division's approach of considering the patentee's declarations during the grant procedure as an indication of the interpretation of a feature by a person skilled in the art at the priority date of the patent, it has not yet formally taken a position on whether or not the grant procedure should be taken into account when interpreting the scope of a patent's claims, particularly from a file wrapper estoppel perspective

### **Interpretation of claims and infringement by equivalence**

The interpretation of the claims is essential to determine the scope of the protection conferred by the patent, including by equivalence.

In *Plant-e Knowledge v. Arkyne*, the Hague Local Division found that the patent in dispute was infringed by equivalence. To reach this conclusion, it applied the national "Dutch test," answering four key questions in the affirmative:<sup>17</sup>

- *“Technical equivalence: does the variation solve (essentially) the same problem that the patented invention solves and performs (essentially) the same function in this context?”*
- *Is extending the protection of the claim to the equivalent proportionate to a fair protection for the patentee: in view of his contribution to the art and is it obvious to the skilled person from the patent publication how to apply the equivalent element (at the time of infringement)?*
- *Reasonable legal certainty for third parties: does the skilled person understand from the patent that the scope of the invention is broader than what is claimed literally?*
- *Is the allegedly infringing product novel and inventive over the prior art? (i.e. no successful Gillette/Formstein defence.)*

It remains to be seen what impact this decision will have on the approach of the various local divisions. For example, they may be inclined to apply their own national tests while awaiting a potential future decision by the Court of Appeal, which could propose a unified approach specific to the UPC. Alternatively, they may choose to apply the test that seems most relevant to the case at stake, selecting from those proposed by the parties, particularly when the alleged acts of infringement were not committed in a single country.

In any case, at this stage, it may be in the interest of the parties involved in UPC disputes not to restrict themselves to the national test of the country where the local division is situated, but to analyse the situation of the case in detail.

In *M. X v. OrthoApnea and Vivisol*<sup>18</sup>, the plaintiff argued that the contested product reproduced by equivalence the subject matter of the patent on the basis of the "mean-function-result" test and that of non-substantial differences.

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<sup>14</sup> CoA Luxembourg, 13 May 2024, SES-Imagotag v. Hanshow, UPC\_CoA\_1/2024, APL\_8/2024, ORD\_17447/2023, §37

<sup>15</sup> CoA Luxembourg, 20 December 2024, *Alexion v. Amgen*, UPC\_COA\_405/2024, APL\_405/2024, ORD\_60221-2024, §42 to 46 and "headnote".

<sup>16</sup> CoA Luxembourg, 20 December 2024, *Alexion v. Amgen*, UPC\_COA\_405/2024, APL\_405/2024, ORD\_60221-2024, §42

<sup>17</sup> LD The Hague, 22 November 2024, *Plant-e Knowledge v. Arkyne*, UPC\_CFI\_239/2023, § [86] to [88].

<sup>18</sup> LD Brussels, 17 January 2025, *M. X v. OrthoApnea and Vivisol*, UPC\_CFI\_376/2023, ORD\_598478/2023, "headnote" and § [97] to [102].

In the decision, the Brussels Local Division referred to the *Plant-e Knowledge v. Arkyne*. It considered the identity of functions between the claimed element and the equivalent element is an essential (but not sufficient) criterion for qualifying as an infringement by equivalence. Insofar as it did not identify this identity of functions in the case in point, the Court did not assert on the test for infringement by equivalence to be applied, leaving the question open from Brussels Local division point of view.

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After a year and a half of existence, it is now possible to identify the main lines of the UPC's interpretation of claims. In particular, the predominant aspect of the wording of claims is now well established. As such, it is risky for parties involved in UPC proceedings to deviate from this approach, such as by placing too much emphasis on the description in their arguments.

In short, based on these initial examples, the application of the position taken by the Court of Appeal as to the role of the description in interpretation seems to be reducible to this notion of aid to interpretation in relation to the decisive role of the claims. If the description does not assist (as when it points in a direction contradictory to the interpretation of a claim taken as a whole by the person skilled in the art) then the description should generally take a back seat to the decisive role of the claims. To counterbalance this decisive role of the claims in the interpretation by an interpretation with the description that would exclude an embodiment, it would seem that at least "*convincing reasons based on the circumstances of the particular case in question*" would be required.

Other debates remain open, notably on file wrapper estoppel and infringement by equivalence. On these two subjects, the parties can no doubt be more creative while awaiting firm decisions from the Court of Appeal.