

ES – SHARK HELMETS, S.A.S. v. TECH DESIGN TEAM, S.L., Commercial Court no. 5 of Barcelona, 28 October 2021, Docket No. 729/2020

In this decision issued on 28 October 2021, Barcelona first instance Patent Courts examined the question of interpreting the extent of protection of the claims in view of the patent description and drawings.

The plaintiff, SHARK HELMETS S.A.S (SHARK HELMETS), filed a patent infringement action against TECH DESIGN TEAM, S.L. (TECH DESIGN), alleging infringement by TECH DESIGN's motorbike helmets "Convert", "Valiant I" and "Valiant II" of European patent EP1806986 "*Protective helmet with movable chin guard, which is particularly suitable for motorcycling*", validated in Spain as ES2329494 (hereinafter, "ES494"), whose claim 1 protects:

1. A protective helmet (1), in particular for motorcycling, the helmet comprising a shell (2) having side walls (21, 22) with a visor (3) secured thereto that is capable of pivoting relative to said shell, and having a movable chinguard (4) suitable for being raised over said visor and tilted towards the rear (23) of said shell over the top of said shell from a closed position to an open position, characterized in that, in said closed position, said visor is suitable for resting against an outer top rim (43) of said chinguard, and in that said shell and said chinguard include complementary guide means (51, 52, 61, 62) suitable for ensuring that the path of said chinguard between said closed position and said open position is a path that is not entirely circular, along which said chinguard begins by moving away from said shell, is then raised and tilted over said visor, and finally moves back towards said shell at the rear thereof.

Both parties agreed that the core of the patented invention with respect to the prior art was: guide means (distributed between the body of the helmet and the chinguard) allowing the chinguard to perform a complex displacement consisting of [c1] a path that is not entirely circular according to which [c.2] said chinguard first moves away from the shell, and [c.3] is then raised and tilted over the visor and [c.4] finally moves back towards said shell at the rear thereof, i.e., the technical feature identified as feature [c] of claim 1:

[c] in that said shell and said chinguard include complementary guide means suitable for ensuring that

*[c1] the path of said chinguard between said closed position and said open position is a path that is not entirely circular,
[c2] along which said chinguard begins by moving away from said shell,
[c3] is then raised and tilted over said visor,
[c4] and finally moves back towards said shell at the rear thereof.*

Having agreed on that, the parties differed on the interpretation of these technical elements and, ultimately, on the scope of protection of claim 1.

Indeed, SHARK HELMETS and TECH DESIGN interpreted the scope of protection of feature [c] of claim 1 differently. TECH DESIGN alleged that the “Convert”, “Valiant I” and “Valiant II” helmets did not fall within the scope of protection of the patent, as they did not meet the above-mentioned features [c1], [c2] and [c3] of claim 1 of the patent.

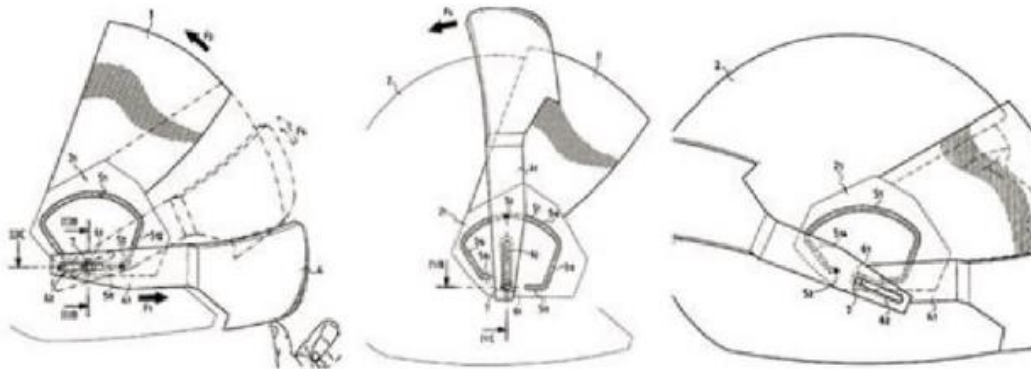
The main argument put forward by the defendant, TECH DESIGN, was that feature [c] of claim 1 (the path or movement during which the chinguard of the helmet moves from a closed position to an open position) consisted of a three-stage sequential movement: first, there is a separation between the chinguard and the helmet’s shell (see feature [c2] “along which said chinguard begins by moving away from said shell”); secondly, the chinguard is raised and titled over the visor (see feature [c3] “is then raised and tilted over said visor”); and, finally, according to feature [c4] the chinguard “[c4] moves back towards said shell at the rear thereof”.

To support this interpretation of feature [c] of claim 1, TECH DESIGN alleged that in accordance with Article 69.1 of the European Patent Convention (EPC), the extent of protection conferred by a patent shall be determined by the claims, but using the description and drawings to interpret the claims. To that end, the defendant TECH DESIGN referred to various paragraphs of the patent description, for example:

*[0021] To do this, the guide means confer a complex movement of said chin guard, according to which the latter **initially deviates** from the shell forwards in a longitudinal direction, as well as on the sides in a transverse direction, to pass over the visor **then, hereafter**, pivots above the top of the shell backwards, then **finally approaches** said shell in said longitudinal and transverse directions.*

As argued by TECH DESIGN, the patent description would thus help to interpret the words “begins”, “then” and “finally” contained in features [c2], [c3] and [c4] as referring to a sequential movement divided into three different stages. Moreover, this interpretation of a three-stage sequential movement at the time the chinguard moves from a closed position to an open position in accordance with feature

[c] of claim 1, implying an initial separation of the chinguard with respect to the helmet's shell, would be further supported by figures 3A, 4A and 5 of the patent:



According to TECH DESIGN, figures 3A and 4A clearly showed a distinction between two different movements of “moving away” [c2] and then “raising and tilting” [c3], implying a separation between the chainguard and the shell at the beginning of the three-stage movement.

On the other side, the plaintiff, SHARK HELMETS, maintained that feature [c] of claim 1 of the patent did not protect a three-stage movement since the movement comprising a first stage of “moving away” [c2] and then “raising and tilting” [c3] was not sequential but rather simultaneous. The plaintiff further supported this interpretation of the scope of protection of claim 1 with references to the patent description, for example:

[0061] Said guide means are adapted to allow a movement of simultaneous displacement in translation and in rotation of the chin guard relative to the shell of the helmet from said closed position to said open position and vice versa.

[0077] At the same time as they cause the tilting by simultaneous translation and pivoting of the chin guard, said groove 6₂ and said ball joint 6₁ also cause a separation of the side branches 4₁, 4₂ with respect to the side walls 2₁, 2₂ of the shell in order to allow the passage of said chin guard above the screen of the helmet.

In view of the above, the Court had to achieve the right balance between interpreting the extent of protection of the claims in view of the patent description and drawings, but avoid restricting the patent's scope of protection by adding features of the patent specification to the claims.

In this sense, the Court quoted a decision recently issued by Section 15 of the Court of Appeals of Barcelona dated 12 February 2019, in which that Court stated that a preferred embodiment of the patent specification could not be used for the purposes of limiting the patent's scope of protection. In

that case, the Barcelona Court of Appeals found that the defendant (and contrary to what was decided by the first instance Court, whose judgment was reversed), by adding technical features of preferred embodiments of the patent description to the claims, was unduly restricting the patent's scope of protection and thus infringing Article 69.1 EPC.

In the same way, in the present case the Court found that the defendant TECH DESIGN was carrying out a restrictive interpretation of the patent's scope of protection by relying on the patent description and drawings to limit the scope of protection of feature [c] of claim 1.

In its judgment, the Barcelona Commercial Court stated that "*the literal wording of the technical features c2 and c3 do not exclude the simultaneity of the movements*", thus considering that TECH DESIGN wrongly relied on certain paragraphs and drawings of the patent description to limit the scope of protection of patent ES494.

Having said that, the Court went on to assess SHARK HELMET's infringement action, against which TECH DESIGN alleged that the "Convert", "Valiant I" and "Valiant II" helmets did not meet feature [c] of claim 1.

Concerning the "Convert" helmet, TECH DESIGN argued that this product had no initial separation between the chinguard and the helmet shell (there was no "moving away" of the chinguard from the shell), then followed by a different movement of raising and titling over the visor, as required by features [c2] and [c3] of claim 1 of the patent. As explained by TECH DESIGN's expert, in the "Convert" helmet, once the chinguard started the opening movement, there was an angle change, thanks to which the chinguard was immediately moved and titled upwards, whilst according to the patent, when the chinguard started the path from the closed position to the opened position, there was an increase in the distance range between the chinguard and the helmet's shell (i.e., an initial separation), which was essential in order to unlock the chinguard from the helmet's shell.

However, as explained above, this allegation was based on an incorrect interpretation by TECH DESIGN of the patent scope of protection. Thus, the Court found that since the patent did not exclude (contrary to what was defended by TECH DESIGN) the fact that the path or movement from the separation of the chinguard from the shell [c2] to its raising and titling [c3] could be simultaneous (as was the case in the "Convert" helmet), TECH DESIGN was infringing feature [c] of claim 1 of SHARK HELMET's patent.

The same reasoning applied to the "Valiant I" and "Valiant II" helmets.

Additionally, the Court noted that this same conclusion on the interpretation of the patent's scope of protection and infringement of SHARK HELMET's patent by TECH DESIGN's "Convert" helmet had

been reached in a judgment handed down by the Paris Court of Appeals one year earlier, on 26 February 2018, in parallel proceedings initiated by SHARK HELMET against TECH DESIGN in that country concerning this same patent.

In conclusion, this judgment rendered by the Barcelona first instance Patent Court illustrates one of the recurring controversies in the application of Art. 69.1 EPC. More specifically, it represents a further example of the case-law doctrine according to which the patent specification should not be used for the purposes of limiting the scope of protection of the patent claims.

