

# Specification may not normally be used to restrict the scope of protection of claims

Kluwer Patent Blog  
September 9, 2019

Miquel Montañá (Clifford Chance)

Please refer to this post as: Miquel Montañá, "Specification may not normally be used to restrict the scope of protection of claims", *Kluwer Patent Blog*, September 9 2019, <http://patentblog.kluweriplaw.com/2019/09/09/specification-may-not-normally-be-used-to-restrict-the-scope-of-protection-of-claims/>

As readers are well aware, one of the difficult tasks when applying article 69 of the European Patent Convention ("EPC") and its Protocol of Interpretation is to strike the right balance between "interpreting" the claims in the context of the specification, while, at the same time, avoiding "importing" features of the specification into the claims. A judgment of 12 February 2019 from the Barcelona Court of Appeal recently published has warned against the risk of using specification for the purpose of unduly restricting the scope of protection of the claims. The facts of the case may be summarized as follows:

The complainant filed a patent infringement action against the defendant alleging infringement of patent EP 1.489.342 ("EP '342"). In particular, it alleged that the latter was marketing certain valves that fell within the scope of protection of that patent. Claim 1 reads as follows:

"1. A three-way valve, comprising:

an inlet channel (1);

a first outlet channel;

a second outlet channel (6);

a first independent, quarter-turn valve (2) situated at an intersection of said inlet channel (1) and said first outlet channel and comprising a plug (3) provided with channels (4, 5) for regulating fluid communication between said inlet channel (1) and said first and second outlet channels; and a second independent, quarter-turn valve (7) situated intermediate said first independent valve (2) and said second outlet channel (6), wherein a longitudinal axis of said first outlet channel is orthogonal to a longitudinal axis of said inlet channel and a longitudinal axis of said second outlet channel is orthogonal to said longitudinal axis of said inlet channel such that said longitudinal axis of said inlet channel, said longitudinal axis of said first outlet channel and said longitudinal axis of said second outlet channel are arranged in a generally T-shaped configuration, said inlet channel (1), said first outlet channel and said second outlet channel (6) are unitarily formed, said first independent, quarter-turn valve (2) is axially aligned with said inlet channel (1), and an axis of said second independent, quarter-turn valve (7) is perpendicular to said longitudinal axis of said second outlet channel,

characterized in that

said plug (3) and said inlet channel (1) are configured and adapted such that said plug (3) can be assembled into said three-way valve via said inlet channel (1)."

The defendant acknowledged that its valves reproduced all the technical features of the claim, except the last one. So, the dispute revolved around whether or not the product marketed by the defendant presented the following feature: "said plug (3) and said inlet channel (1) are configured and adapted such that said plug (3) can be assembled into said three-way valve via said inlet channel".

The main argument of defence used by the defendant, which was accepted by the Court of First Instance to deny infringement, is summarised in paragraph 11 of the judgment:

"11. The claim textually requires that "the plug (3) [can be assembled into said three-way valve via said inlet channel (1)", despite which, according to the defendant, a person skilled in the art would understand that the plug can only be introduced into the inlet channel from below, an argument that was accepted by the judge at first instance."

However, the Court of Appeal considered that this interpretation would amount to using the drawings to unduly restrict the scope of protection of the claims. In particular, the Court found that said interpretation would amount to unduly using a preferred embodiment of the specification to limit the scope of protection of the claims:

"12. We cannot accept that conclusion as it is based on what we believe is a mistaken interpretation of the function of the drawings of the patent. The defendant maintains that, according to the drawings, the plug cannot be introduced from above as there is simply no space, therefore, it can only be introduced via the lower part of the inlet channel (or central channel).

13. This means using a preferred embodiment, which is the one portrayed in the drawings, to limit the scope of protection of the patent, which infringes article 69.1 of the Convention, according to which "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". The drawings or the description should be used to interpret the claims and, in general, not to limit the scope of protection by adding characteristics to the claims in this way."

Interestingly, the Court of Appeal relied on the case law from the European Patent Office ("EPO") Boards of Appeal (for example, T 1018/02, T 1395/07, T-544/89 and T-681/01) noting that, although they do not decide infringement cases, they do have to interpret the scope of protection of the claims when they examine validity.

Finally, the Court of Appeal added that, although in the past the Court had "read" in the claims features mentioned in the specification which were not explicitly mentioned in the claims, this was done in exceptional cases only, when the feature omitted in the claim was essential for the functioning of the invention. The Court of Appeal added that "But this is not the case, because the interpretation of the defendant and its expert relies solely and exclusively on the preferred embodiments disclosed in the drawings."

All in all, the main teaching of this interesting judgment is that when applying article 69 of the EPC and its Protocol of Interpretation, care must be applied to avoid "importing" features of the specification into the claims.