

Kluwer Patent Blog

Don't try to find in your usual dictionary what the terms of the claim mean

Miquel Montaña (Clifford Chance) · Monday, September 27th, 2021

In our blog of 27 August 2021, we explained that the Barcelona Appeal Court (Section 15), in a very interesting Ruling of 16 October 2020, decided that the claims as amended before the EPO Boards of Appeal should become the subject of the national proceedings in lieu of the claims asserted in the initial infringement action (i.e., the claims as granted) filed before the Barcelona Commercial Courts. We also explained that, to ensure that the parties had the opportunity to make allegations and file additional evidence on whether or not the claims as amended were infringed, the Court gave both parties a round of allegations. In addition, it called the parties to a “case management” hearing which took place on 9 February 2021, to establish which facts were disputed and decide on the admissibility of new evidence. The Court then called the parties to a second hearing, which took place on 19 April 2021, where the additional evidence admitted was heard and the parties set out their closing arguments.

What's next?

On 5 May 2021, the Court rejected Huawei's appeal against the judgment of 9 April 2018 from Barcelona Commercial Court number 4, which had found that Huawei's Fastconnect device fell within the scope of protection of patent EP 2772778 owned by Corning Optical Communication. In a nutshell, in its appeal, Huawei alleged that the questioned device missed four integers of claim 1 as amended. The Barcelona Appeal Court (Section) dismissed Huawei's arguments, relying mainly on the opinion of the experts heard, but also on some statements that Huawei had made when describing the technical characteristics of its product in a commercial context. One of the interesting aspects of this judgment is that the Court made it clear that the scope of protection of the claims may not be limited relying on the specification. Also, the Court hinted that, for the purpose of interpreting the meaning of a term mentioned in a claim, a general dictionary is less appropriate than a technical dictionary. Although this may sound trite to readers from jurisdictions such as Germany, where the Supreme Court already went along these lines in the *Spannschraube* judgment (1999), the clarification made in the judgment discussed in this blog is certainly of help.

In particular, the term in need of interpretation was “rotation” in the following paragraph:

"[...] wherein the pug body (14) includes a shaft (52, 54) and a collar (90) disposed upon the shaft (54,52) such that travel of the collar (90) in the lengthwise direction is limited even though rotation of the collar (90) about a longitudinal axis defined by the shaft (52, 54) is permitted:"

Huawei alleged that this characteristic dealing with the rotation on a longitudinal axis was not met by its Fastconnect connector. In particular, it argued that such connector only has an anti-clockwise quarter turn, while in claim 1 it is necessary that the threaded portion of the collar be able to rotate on the axis of the shaft. Huawei contended that the collar must be allowed to turn around the shaft because the specification of the patent (page 8, line 32) states as much: *"In this regard, the collar is preferably disposed upon the shaft such that the travel in the collar in the lengthwise direction is limited, while allowing the collar to rotate freely about the longitudinal axis relative to the shaft"*. Therefore, a threaded portion that turns 360° on its axis is required for the coupling of the collar and receptacle, with the 45° turn of Huawei's plug being insufficient.

On the contrary, Corning contended that the collar should rotate on its axis, but that claim 1 does not require a specific angle of rotation, far less that it be free or rotate at least 360°.

After considering the arguments of the parties and the opinions of their experts, the Court reached the following conclusion:

"14.3. Assessment of the Court. From the evidence examined, we can see how the characteristic (2d) of claim 1 does not require a 360° rotation, just that the collar rotate about its axis, apart from not claiming that it be on a threaded portion.

14.3.1. The parties agree that the collar of the Huawei connector only makes a quarter turn and it is discussed whether this is sufficient to meet the characteristic (2d) of claim 1, which claims the existence of the rotation of the collar about a longitudinal axis defined by the shaft.

14.3.2. The common definition of "rotate" in the Spanish Royal Academy dictionary implies turning on an axis, which could lead us to the defendant's interpretation, meaning that a full 360° turn on its axis is required; the defendant completes its arguments indicating that the working envisaged in the specification requires that it rotate freely or include a threaded portion.

14.3.3. As we know, our starting point must be an interpretation in line with the claims which are what define the object of the invention and the extent of the protection according to article 69.1 EPC, in addition to remembering that we should rule out both a strictly literal interpretation and a finalist or subjective interpretation. This means that based on the meaning of the text of the claims and with the description and the drawings, we reach an interpretation that ensures fair protection of the applicant and a reasonable degree of certainty for third parties, as we indicated in our Judgment of 30 January 2013 -ROJ: Appeal Court Judgment 2722/2013-, not carrying out an interpretation that is limited to the text of the claim.

14.3.4. We find that the interpretation proposed by the defendant constitutes limiting

the claim, given that, in reality, the characteristic (2d) is not claiming a free rotation or a threaded fastening, as these specifications are found in one of the possible workings envisaged in the specification of the patent. As such, we have to analyse the term claimed, rotate or rotation, from a technical perspective and use a specific definition from the sphere of engineering. In the Royal Academy of Engineering dictionary (area of mechanics) rotate or rotation means “the movement of a rigid body in which each of the points is fixed, or all the points are fixed on a straight line“. Therefore, rotation requires angular movement unlike driving where all the points move, as Mr Evaristo explained at the trial. As such, taking this definition of rotation into account, movement on its axis, and that claim 1 does not require a free turn, we should understand that the threaded portion is a coupling system, which is exemplified in the patent, but there may be others, such as a bayonet fitting, meaning that just a ¼ turn could be sufficient to attain the desired technical effect, which is the coupling of the plug and the receptacle, and which would fall within the scope of the patent.

15.3.5. Further to the above, we must conclude that the Huawei Fastconnect plug connector allows the rotation of the collar on a longitudinal axis defined by the shaft, meaning that it reproduces the characteristic (2d) of the claimant’s patent.”

All in all, the teaching of this judgment is clear: don’t try to find in your usual dictionary what the terms of the claim mean.

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