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Drawings cannot be used to limit scope of protection

Miquel Montaña (Clifford Chance) · Monday, March 18th, 2019

On 12 February 2019, the Barcelona Court of Appeal (Section 15) issued an interesting judgment clarifying the role played by “drawings” for the purpose of interpreting the scope of protection of a patent. This judgment has reversed a judgment of 12 December 2017 from Barcelona Commercial Court number 1 which, according to the Court of Appeal, unduly relied on a drawing illustrating a preferred embodiment of the invention to limit the scope of protection of the claims. In particular, in paragraph 12 of this recent judgment, the Court of Appeal concluded that:

“12. We cannot accept that conclusion, since it is based on an interpretation – incorrect, in our view – of the purpose of a patent’s drawing. The defendant claims that, according to the drawings, the plug stem or closure cannot be inserted through the upper part because there is simply no room; therefore, it can only be inserted through the lower part of the inlet channel (or central valve).

13. This entails using a preferred embodiment, which is the one represented in the drawings, to limit the patent’s scope of protection, which infringes Article 69.1 of the European Patent Convention (EPC), 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 must serve to interpret the claims and, in general, not to limit their scope of protection by adding characteristics to the claims in this way. “

Whereas the Court of Appeal accepts that there might be very specific cases where it may be warranted to rely on the description and the drawings to read in the claims characteristics not explicitly mentioned, this judgment clarifies that this is “absolutely exceptional” and that this may only be accepted when the element omitted in the claim is essential for the functioning of the invention:

“15. It is true that we have maintained in some cases, as an exception, that characteristics of the invention which are not expressly contained in the description can be inferred from the description and drawings, but that is an absolutely exceptional case and it requires that the element omitted from the claim be essential for the invention to function (Judgment no. 20/2008 of the Barcelona Court of Appeal, dated 24 January (ECLI:ES:APB:2008:13451). But this is not the case, since the interpretation made by the defendant and its expert are solely and exclusively supported by the preferred embodiments described by the drawings.”

All in all, this judgment will hopefully shed some light on where the sometimes very fine line

between “interpreting” and “limiting” lies.

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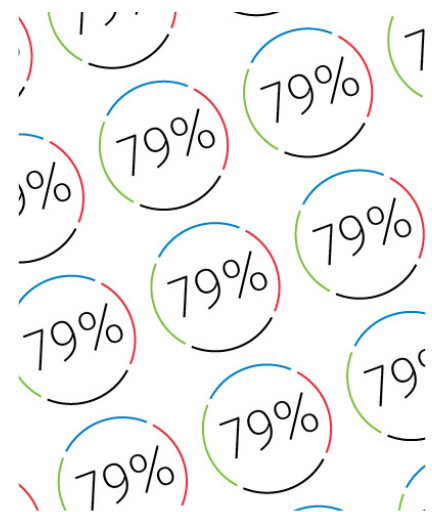
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