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The UPC Court of Appeal dismisses appeal in *SES-Imagotag v Hanshow* – clarity on claim construction in the UPC?

Rebecca Daramola (Bristows) · Tuesday, May 21st, 2024

On 13 May 2024, the UPC Court of Appeal (**CoA**) upheld the Munich Local Division's decision in *SES v Hanshow* (UPC_CoA_1/2024) that a preliminary injunction should be refused on the basis that there was not sufficient certainty that certain models of Hanshow's electronic label products infringe SES' patent. SES is the registered proprietor of the EP 3883277 (**EP 277**), which relates to the spatial arrangement of components within electronic shelf labels that display price information in sales areas. SES applied for a preliminary injunction, requesting that Hanshow be prohibited from infringing EP 277. In resisting the application for a preliminary injunction, Hanshow argued that (i) claim features 1.1, 7 and 8.4 were not realised in the contested products, (ii) SES had not proved that Hanshow had offered or marketed these products, and (iii) EP 277 was invalid on the basis of obviousness and lack of novelty. On 20 December 2023, the Court of First Instance dismissed SES' application. In reaching this decision, the Court made reference to the prosecution history for the patent, holding that an earlier version of the claims could be used as an aid to the interpretation of the claims of the granted patent.

SES appealed this decision, arguing that (i) claim features 7 and 8.4 had been interpreted incorrectly, (ii) the Court of First Instance inadmissibly referred to the grant history of the patent as an aid to interpretation, (iii) the view that, according to the patent claim, a component to be assigned to the side of the front surface of the electronic label could not be assigned to the side of the rear surface of the housing was incorrect, and (iv) the contested products fell within the scope of EP 277.

Interpretation of the patent claims

To interpret EP 277, the CoA cited the principles set out in *10x Genomics and Harvard v Nanostring* (UPC_CoA_335/2023 App_576355/2023). Applying these principles, the CoA concluded that claim feature 8.4 must be read in conjunction with claim features 7 and 8.3.

“Feature 7: a printed circuit board (35) mounted in the housing (3) on the side of the rear surface of the housing is accommodated

Feature 8.3: wherein the electronic chip (37) of the radio frequency peripheral device is mounted on the printed circuit board (35) is arranged

Feature 8.4: the antenna (38) of the radio frequency peripheral device on or in the housing on the

side of the front surface of the electronic label is arranged.”

The CoA stated that the skilled person would understand that the chip and the antenna of the radio frequency peripheral device should not be located at the same place in or on the housing. The chip should be arranged on the printed circuit board on the side of the rear surface of the housing and the antenna on or in the housing on the side of the front surface. Accordingly, the skilled person would understand feature 8.4 to mean that the antenna is located on or in the housing at a position which is further towards the front surface of the electronic label than the printed circuit board and the chip. In light of this, the Court of First Instance had rightly held that claim features 7 and 8.4 exclude an arrangement of the printed circuit board and the antenna in the same plane. Claim feature 8.4 requires that the antenna is not arranged behind the screen. It was clear from the description that the side of the front surface of the electronic label is the plane of the screen and the patent description assumes that the front of the label is where the display screen is positioned. EP 277 also notes that the antenna should be placed towards the front of the housing (preferably around the screen), as placing the antenna on the back of the label is disadvantageous.

The CoA rejected SES’ argument that claim feature 8.4 only requires that the antenna is not located behind the printed circuit board, as it would mean that claim feature 8.4 would be realised if the antenna and the printed circuit board were in the same plane. SES also argued that failure to mount the antenna behind the circuit board is sufficient to prevent transmission through the circuit board. The CoA concluded that, although this argument may be correct, it does not follow that SES’ interpretation of the claim is correct. The CoA also ruled that SES’ position that claim 1 does not require a specific position of the antenna in relation to the screen was unfounded. It dismissed SES’ view that EP 277 merely represents the position of the antenna in relation to the screen as a preferred embodiment and concluded that figure 3 of EP 277 does not show an electronic label in which the antenna is arranged behind the screen.

Can infringement be established with a sufficient degree of certainty?

The CoA cited *10x Genomics and Harvard v Nanostring*, where it was held that a sufficiently certain conviction under Rule 211.2 Rules of Procedure and Article 62(4) UPC Agreement (provisional and protective measures) requires that the Court considers it at least predominantly probable that the patent is infringed. Based on this, the CoA concluded that there was not a sufficient degree of certainty that the contested products infringed EP 277. The antenna of the radio frequency peripheral device is arranged behind the screen in the contested products which contradicts claim feature 8.4, as it excludes the arrangement of the antenna behind the screen.

Secondly, claim feature 8.4 requires that the antenna is positioned further towards the front surface of the electronic label than the printed circuit board. The CoA was not convinced that the contested products fulfilled this requirement based on the technical drawings provided. It considered that the antenna and the front part of the circuit board lie side by side in the same plane.

Can the original wording of the patent claims be used as an interpretation aid?

In *10x Genomics v Curio* (UPC_CFI_463/2023), the Düsseldorf Local Division reiterated its position in *Ortovox v Mammüt* (UPC_CFI_452/2023) that statements made by the patentee in the patent granting procedure are not, by law, admissible material for interpretation and are generally not be taken into account in the context of patent interpretation. It also mentioned that the prosecution history is not referred to in Article 69 EPC (extent of protection). It cited the Munich

Local Division's decision in *SES v Hanshow* that the wording of the application as filed could be used to interpret the granted claims, but noted that this was irrelevant in *10x Genomics v Curio* and therefore required no decision.

In *SES*, the CoA noted that its interpretation of claim feature 8.4 is based on the wording of the claim, read in light of the description and drawings, from the point of view of a person skilled in the art with their general knowledge, without taking into account the prosecution history of EP 277. It stated that the documents of the EPO examination proceedings cited by the parties shed no new light on its interpretation. As a result, it did not need to address the question of whether the prosecution history can be taken into account when determining the scope of protection of a European patent.

It was hoped that the CoA would provide clarity on the conflicting approaches in the UPC regarding use of the prosecution history to interpret a patent. However, no further guidance was provided in its decision in *SES v Hanshow*. Given the rising caseload in the UPC, it is likely the CoA will, sooner or later, have to address the issue of whether the prosecution history of a patent can be used as an aid to its interpretation and, within that, whether and to what extent, a doctrine of file wrapper estoppel exists within the UPC framework.

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