

An Ocean Apart – Differences in US and EPO claim interpretation

Recent cases from the US Federal Circuit and the EPO Boards of Appeal highlight how the two jurisdictions have reached strict, and completely opposite, approaches to interpreting claims in light of the description. These cases demonstrate the need for care when drafting and amending specifications during examination, and consideration of different practices in different jurisdictions.

We start in Europe, with decision T1628/21 (Nike Innovate C.V v Adidas AG), an appeal from an EPO Opposition about sports clothing that helps the wearer ‘feel’ body position, to help improve their form. Key to the case was a lower back position feedback system. To avoid prior art, Nike needed to argue that the feedback system was a separate component, distinct from the item of clothing itself.

Nike’s patent claimed: “An article of apparel, comprising a garment structure (200)... **characterised by a lower back position feedback system (202) engaged** with the garment structure at the lower back portion”. The question for the Board was whether this formulation was restricted to a separate lower back position feedback system, or whether it could include a feedback system integral with the garment structure.

To US eyes, this would be an easy question. Nike had explicitly stated in the description that integrally formed feedback systems “do not form part of the present invention”. Surely Nike’s claim could not encompass such disclaimed matter? Indeed, the EPO Board of Appeal did find this an easy question to answer, but reached completely the opposite conclusion. The Board stated that the “principle of primacy of the claims” excludes the use of the description and drawings for limiting the claims if an interpretation of the claim in the light of common general knowledge already leads to a

technically meaningful result. In other words, if the claim is clear on its face, the EPO will not even look to the description to help with interpretation. The Board found that both possible interpretations (distinct and integral) were clear and valid from the claim alone, and so the claim lacked novelty over the prior art. Nike may have tried to disclaim subject-matter in the description, but the Board would only consider a disclaimer in the claim itself.

It's worth noting that one of the reasons the Board gave for considering "engaged with" to encompass the 'integral' meaning was the use of "characterised by" in the claim, which the Board suggested can be understood as introducing further limitations to the garment structure, rather than defining a necessarily "separate" further component. The wording "characterised by" was actually added by the examiner, not Nike, just before grant of the patent. This is part of the EPO's insistence on using the "two-part form", a form similar to the US Jepson-style claiming (without the Jepson format's assumed admission of prior art). Although likely not decisive in this case, this is a reminder to at least consider arguing against use of the two-part form before the EPO.

Turning to the US, the Federal Circuit's decision in *Chewy, Inc. v. International Business Machines Corp.*, 2022-1756 (Fed. Cir. Mar. 5, 2024) makes clear that the wording of the description is very important to US claim interpretation. The patent here related to presenting "advertising objects" on a computer. The question was whether the claim limitation "selectively storing advertising objects" necessarily involved pre-fetching the objects. Pre-fetching was described in the description, but not included in the claim. The Federal Circuit concluded that pre-fetching was required, because the written description "consistently describe[d]" pre-fetching. The Court took particular aim at the "Summary of the Invention" section of the description, which included the pre-fetching feature. Judge Moore noted this did not say a "preferred embodiment", but rather "the invention". Judge Moore also highlighted that the method in this section was described as a "method for presenting advertising in accordance with this invention", which the Judge deemed to be "magic language...language that binds you, whether you like it or not". Thus, the claim had to be read as including the pre-fetching limitation from the written description.

In summary then, in Europe a patentee tried unsuccessfully to bind themselves with a disclaimer in the description. In the US, a patentee accidentally bound themselves by using, among other things, standard (at least in Europe) terms such as "summary of the invention". So what is the moral of this story? Perhaps "the grass is always greener on the other side"? The patentees here would likely have appreciated the other jurisdiction's rules. Or, more helpfully, ensure that your applications are drafted and prosecuted with an awareness of the conflicting rules on both sides of the Atlantic. And maybe even seek

the help of a friendly trans-Atlantic patent firm, like EIP.