

**EIP**

# Claim construction at the UPC

For a European patent to be granted, the claims must be “clear and concise”. However, some ambiguity or lack of clarity may be identified in granted claims, during infringement or invalidity proceedings.

In these cases, the scope of the claim was at issue in decisions regarding provisional measures (preliminary injunctions). Different approaches were taken regarding whether or not arguments or amendments made during prosecution could be referred to.

## Electronic Label: UPC\_CFI\_292/2023 (regarding EP3883277B1)

The patent in this case is directed to electronic labels that can be mounted on supermarket shelves. Claim 1 is for an electronic label having (amongst other features) a display screen and a case. The patent includes a figure showing the case from behind. This figure is reproduced below, with highlighting added to show a printed circuit board (green), parallel to and close to (but not touching) the rear of the case, a display screen (blue), an antenna (yellow) and a chip associated with the antenna (orange).

According to claim 1, the printed circuit board is “on the side of the back of the case” (French: du côté de la face arrière du boîtier) and the antenna (yellow) is “on or in the case on the front side of the electronic label” (French: sur ou dans le boîtier du côté de la face avant ladite étiquette électronique). The judgment seems to consider the case and the electronic label (or at least their respective front and back sides) to be the same thing.

An electronic label sold by the respondent (Hanshow), shown opened up in the figure below, was alleged to fall within the scope of the claim. The figure is reproduced from the judgment, with green marking added to show the location of the printed circuit board. The display screen is mounted at the front of the case (to the left of the figure), and the printed circuit board (green) is mounted on the rear of the case (to the right of the figure). The antenna (mounted on the flexible plastic, within the yellow rectangle) is not rigidly fixed to either the front part or the back part, but is shown ‘floating’ just in front of the rear of the case, and beside (i.e. neither in front of nor behind) the printed circuit board. It was considered possible that the antenna would touch the back part of the case when the case was closed.

Hanshow argued that the claim language precluded placement of the antenna behind the screen. The patent description set out various technical considerations for the placement of the antenna:

- Mounting the antenna and its associated chip on the front face of the label would reduce the amount of space available for the display screen;
- the chip should be mounted on the printed circuit board, for ease of manufacturing;
- to avoid interference, the chip and the antenna should be separated; and
- the antenna should not be mounted on the internal rear face as this would impair the range of the antenna because it would be behind the screen.

These considerations appear to support Hanshow’s position. Indeed, the preferred solution in the patent description (but not a limitation of claim 1) was for the antenna to be embedded in the front of the case encircling the display screen, as shown in the figure from the patent above.

The court concluded that, in fact, the claim did not specify anything about the spatial relationship between the screen and the antenna.

During prosecution, the EPO Examiner objected to claim language stating that the chip was placed “at a distance” from the antenna, as being vague and unclear. In response, the ‘at a distance’ language was removed, and the limitation that the antenna was “on or in the case on the front side of the electronic label” was inserted. The application proceeded to grant.

The UPC judges appear to have understood the amendment (referring to the ‘front side’) to import a further limitation to the ‘at a distance’ language of the unamended claim (understood to mean ‘separated in space’), so that the antenna could not be at the (claimed) ‘front side’ and ‘back side’ simultaneously because this would imply that the antenna and the chip might not be separated.

In the respondent’s devices, the antenna was undoubtedly “at the back side of the case”. Therefore, there could be no infringement and no injunction was ordered.

## Commentary:

It is not clear that it was necessary for the court to refer to the prosecution history in the way it did. It could likely have reached the same conclusion by reference to the patent specification, which states that the chip and the antenna are in different locations, and suggests that having the antenna on the front side of the electronic label, and the chip (on the printed circuit board) at the back side of the case is how this is achieved.

Instead, the court seems to have relied on the interpretation of claim language which was considered by the Examiner to be vague and unclear, and appears to have considered that the replacement text had the effect of being a narrowing amendment in a technical sense. However, not all amendments are necessarily narrowing in scope: as well as those addressing clarity objections, those which resolve, for example, added matter problems may not necessarily narrow the scope of the claim.



# Avalanche Transceiver – UPC\_CFI\_452/2023 (regarding EP3466498B1)

A preliminary injunction was sought in respect of avalanche transceivers having a loudspeaker that could emit a voice message or another audio signal. The patent claim recited that “[an] audio signal during the output of [a] voice message is suppressed or output with a reduced volume”.

The respondents argued that their device did not infringe the patent because their device did not perform simultaneous generation of the audio and voice messages, with one being suppressed. They argued that this was a requirement of the claim, based on statements the patentee had made during prosecution.

The court referred to Article 24, paragraph 1(c) of the UPCA, which specifies that the court shall base its decisions on the EPC. Article 69 EPC states that

“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.”

Following this (and thus taking a different approach from the court in the Electronic Label case), the court considered that any statement made during prosecution was not relevant in understanding the scope of the claim.

## Commentary:

Practice within European national courts differs regarding reference to the prosecution history (or ‘file wrapper’) of a European patent when assessing the scope of protection of a claim. The approach taken in the ‘avalanche’ case appears to be consistent with the applicable law of the UPC and minimises uncertainty for all parties.

Both of these cases were regarding provisional measures (i.e. preliminary injunctions), and we could expect that the extent of the analysis by the court will be greater in substantive hearings on infringement and validity. The approach to claim construction at the UPC is thus an area which will continue to develop and which we will continue to monitor.