Article 69 EPC – the Scylla and Charybdis of the European Patent Convention –

Which route did the Dutch courts take?

(Rian Kalden, Senior Judge, Court of Appeal The Hague, Netherlands)

This symposium is about patent claim construction and the question I am supposed to answer today is whether that exercise boils down to determinism or crystal gazing.

As the distinguished former patent lawyer and Advocate General Toon Huydecoper has noted in his contribution to Willem Hoyng's Liber Amicorum, article 69 EPC and the Protocol to it – they go hand in hand – reminds of the mythical story of Scylla and Charybdis. They were sea monsters located on opposite sides of the Strait of Messina between Sicily and the Italian mainland. Scylla was a six-headed sea monster and Charybdis a whirlpool off the coast of Sicily. They were located close enough to each other that they posed an inescapable threat to passing sailors; avoiding Charybdis meant passing too close to Scylla and vice versa. Nowadays, the idiom ‘being between Scylla and Charybdis’ means ‘having to choose between two evils’. And that is exactly what article 69 EPC requires us judges to do.

The task of construing a patent claim is perhaps the most important and at the same time often the most difficult task that a judge has to deal with when deciding a patent case. Whether the dispute before him / her concerns validity or infringement, the first and foremost question the judge has to answer is how to construe the claim and therewith determine the scope of protection.

This exercise is important for the patentee, as it determines the scope of his monopoly as a reward for making available to the public – for free use after expiry of the patent – the contribution he has made to the state of the art in a technical field. It is also important for third parties, especially those active in the same technical field, because the scope of protection makes clear the extent of the monopoly claimed by the patentee and thus marks the line a third party should not cross.

Article 69 EPC starts off by providing that the extent of the protection conferred by a European patent shall be determined by the claims, but
article 69 EPC immediately adds that ‘nevertheless’ the description and
drawing shall be used to interpret the claims.

The Protocol makes it quite clear that neither England nor Germany, the
two most important patent law countries at that time, could have it his way:
"Article 69 should not be interpreted in the sense that the extent of the
protection conferred by a European patent is to be understood as that defined
by the strict, literal meaning of the wording used in the claims, the description
and drawings being employed only for the purpose of resolving an ambiguity
found in the claims." So the English approach was not the right one. But the
German was not either: "Neither should it be interpreted in the sense that the
claims serve only as a guideline and that the actual protection conferred may
extend to what, from a consideration of the description and drawings by a
person skilled in the art, the patentee has contemplated." What should the
courts do: define “a position between these extremes which combines a fair
protection for the patentee with a reasonable degree of certainty for third
parties.”

This is of course a hugely difficult task. You don’t have to be a patent expert
to understand that in many instances providing a protection to the patentee
commensurate to what he actually invented will be detrimental to third
parties and the other way around, protecting legal certainty for third
parties may result in a much smaller scope of protection than merited by
the advance to the state of the art made available by the invention. The
words ‘fair’ and ‘reasonable’ do not alter the fact that in practice it is
difficult to reconcile these two opposite interests and to find the right
balance, steering clear of the Scylla and Charybdis of article 69 EPC.

The task of striking the right balance required by 69 EPC was in particular
difficult for the national courts, not only because they came from quite
different backgrounds, but also because they had to find a balanced and
harmonised way of determining scope of protection, without there being a
higher court leading the way.

Before I will discuss how the Dutch courts found their way to the required
middle, avoiding both Scylla and Charybdis, I will first take you through a
bit of history – the time before the EPC came into force.

The Patent Act 1910, which came into force after the Dutch government had
abolished the patent system altogether in 1869, did not have a specific
provision stating how patents should be interpreted. The Dutch Supreme
Court decided in 1930, in its landmark Philips / Tasseron judgment, that
exclusively looking at the literal wording of the patent was not the right approach.
The Supreme Court held that importance should be attributed to what in essence the invention is really about. That approach became the leading one for the next 65 years.

That this approach reflected the generally held idea about patents and the way they should be interpreted at the time, is perhaps also illustrated by the fact that the Dutch Patent Act does not use the term “aanspraak”, which would be the Dutch word for “claim” or “Anspruch”. The use of such a term reflects the fact that the patentee claims something for himself, excluding it from the public domain, and the boundaries of that monopoly are set by him with the claim(s). The Dutch Patent Act however instead uses the word “conclusie” which may be translated as “conclusion” or “Konklusion” and has the meaning of ‘short summary of the foregoing’. If there is uncertainty about the exact meaning of a summary, one tends to not limit oneself to the text of the summary, but rather looks at the full text which was summarised for further explanation. Hence, not the “conclusies” as such were of overriding importance, but the patent description and the drawings the more so. And indeed, this was how patent claims were construed. And nothing changed much in the years following the coming into force of the EPC. When our Patent Act was amended, the Dutch government explicitly stated that as to the subject of claim construction nothing had to be done. Dutch practice was considered to be exactly in line with article 69 EPC and the Protocol.

In 1988, Pieroen, in his well-known thesis on the scope of protection of patents in The Netherlands, Germany and England, was probably the first one openly criticising the Supreme Court for being not in line with article 69 EPC with the continued ‘core of the invention approach’. But the Supreme Court was not impressed.

In its 1989 Meyn / Stork decision the Supreme Court still held on to that approach. It said: “when interpreting a patent claim, it does not come down to the literal wording of the patent, but to ‘what in essence is the core of the invention’.” It stated that this approach could still be adopted after coming into force of article 30 par. 2 Dutch Patent Act (implementing 69(1) EPC in similar wording).

The Supreme Court made clear that in a situation where the patent claim and the specification only specifically describe one variant, other variants are not necessarily outside the scope of protection. This would only be the
case when a third party expert, taking into account the core of the invention, as that emerges from the claim read in the context of the specification and the drawings, may assume that the patentee by using this (limited) wording in the patent specification really intended to waive part of the patent protection he would on the basis of the core of the invention be entitled to. And this assumption may only be made if there is good reason (compelling argument) to do so, in view of the content of the patent specification and other known facts, such as information publicly available from the prosecution file.

With time however, matters began to change. In the Ciba Geigy / Oté Optics case decided in 1995, the Supreme Court downgraded the role of the core of the invention in claim construction by rephrasing it slightly into ‘the inventive concept behind the invention’. Also, and more importantly, it no longer regarded that concept as the starting point, but as a ‘viewpoint’ in the claim construction exercise. The Supreme Court reiterated that it is necessary to take into account the inventive concept in order to prevent a too literal interpretation of the claims, which could do injustice to fair protection for the patentee (or lead to an unnecessary broad interpretation). However, the Supreme Court also acknowledged that this would not automatically lead to the balance required by the Protocol – the save route avoiding both Scylla and Charybdis. Thus the court, when interpreting a claim, should verify whether the result of his exercise sufficiently takes into account the legal certainty for third parties, and this (other) viewpoint may justify a more restrictive interpretation, closer to the wording of the claims.

In 2007, in the Lely / Delaval case, the Supreme Court seemingly merely confirmed its earlier Ciba Geigy ruling, but in reality further downgraded ‘the inventive concept to being one of the extremes, opposed to the literal meaning of the claims, that according to the Protocol both have to be avoided.

This approach is still the leading one and has been confirmed in several subsequent cases, most notably the Aga / Occlutech case decided in 2012 – concerning the occluder – and the 2014 Medinol / Abbott case about stents.

Although the Supreme Court is by some, notably the Pieroen followers, criticised for being not in sync with the rest of Europe and not applying article 69 EPC in the right way – allegedly still paying too much attention to the ‘core of the invention’ – I do not think this criticism is justified. Indeed, it may have taken some time to get there (and the lower courts probably
took a more claim-based approach earlier), the present Supreme Court approach to claim interpretation in my opinion is entirely in accordance with article 69.

In determining scope of protection, the claims are the starting point, but will always (not only in case of ambiguity) be interpreted in light of the description and drawings. In doing so, the court may take into account several viewpoints, one of which – certainly not the only or overriding one – is the inventive concept behind the invention. This requires establishing what the invention aims at and what it has added to the state of the art, as appreciated by the skilled person at the priority date, taking into account his common general knowledge, as well as the description and drawings.

Other than suggested by the criticism, this exercise does not necessarily lead to a broader scope of protection than the literal wording of the claims gives rise to. It may lead to a broader scope, but by the same token it may as well lead to a more limited scope of protection. This was seen in the Medinol / Abbott (stents) case, where the attacked stent, although maybe covered by the literal wording of the claim, was considered not to infringe as it did not fall within, and did not benefit from, the inventive concept behind the claims.

In addition, as is clearly set out by the Supreme Court, the claim construction exercise always also needs to take into account the reasonable legal certainty of third parties and a court is required to explicitly consider this. This is exactly what article 69, as further elaborated in the Protocol, requires us to do.

It is furthermore very similar to what European courts, notably the UK and German courts do. As Lord Hoffmann expressed it in Kirin-Amgen:

“Purposive construction” does not mean that one is extending or going beyond the definition of the technical matter for which the patentee seeks protection in the claims. The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean.”

I do not see much difference between that and establishing as a viewpoint the inventive concept behind the invention. In the recent pemetrexed case, which largely was about the construction of the claim, the Düsseldorf Court of Appeal in its introductory comments also refers to ‘the core of the invention’ before embarking on its scope determination.
Indeed, it is hard to envisage a claim construction exercise, requiring the court to find the right balance between fair protection to the patentee and reasonable certainty to third parties, that does not take into account, as one of the viewpoints, the inventive concept behind the invention. How to evaluate fair protection to the patentee if one does not consider what the invention is really about? Not taking the inventive concept into account on the one hand but still taking into account legal certainty on the other hand would lead to tilting to the literal approach and an unbalanced outcome contrary to article 69 EPC.

Incidentally, both cases – AGA / Occlutech and Medinol / Abbott, were the subject of parallel proceedings in the Netherlands, UK and Germany and the same outcome was reached in all three countries.

There are of course also cases where different national court do come to different results in parallel proceedings. However, this is not caused by a fundamental different approach towards claim construction, but inherent to the difficult, if not impossible, task to reconcile both fair protection and legal certainty. This inevitably sometimes leads to a different outcome, but not more or other than the differences between the various courts within one jurisdiction.

So much for claim construction. How about equivalents?

Equivalence is a quite difficult subject, with questions such as: what is the relevant point in time to consider it? Is it the priority date or the date of the infringement? And how does foreseeability play a role?

Our Supreme Court in the Medinol / Abbott case decided that scope of protection is determined as at the priority date. When considering infringement, the common general knowledge as at the date of the infringement may also be taken into account, especially when deciding on equivalents.

My analysis of Dutch law as it presently stands in relation to equivalents is as follows.

It is possible for variants that are foreseeable at the priority date to be brought within the scope of protection. This may be the result of the exercise of determining the scope of a claim. Taking into account as a relevant viewpoint the inventive concept behind the claims as the skilled
person perceives it, may lead to foreseeable variants already to be considered within the scope. Alternatively – if the claim language does not provide a proper basis for such broad construction that the relevant variant can be read into it – this is accomplished through the concept of equivalence.

There are two important limiting factors. First, the inventive concept must allow for the variant to be brought within the scope of protection. This requires that the inventive concept is sufficiently broad to also cover such equivalent variant and that the variant makes use of – and thus benefits from – the inventive concept. The second limiting factor is that reasonable legal certainty must not be unduly compromised.

Variants that are not foreseeable at the priority date may well, due to later developments, become an obvious variant at a later date. This may happen in case of a pioneer invention, where at the priority date the full breadth of the possible applications could or has not been fully recognised and therefore was not sufficiently taken into account when drafting a claim. Another possibility is that a new technique becomes available after the patent was granted, which makes available an obvious variant. It would be harsh and contrary to fair protection for the patentee to deny him the right to attack those, again provided such variant falls within the inventive concept and reasonable legal certainty is taken into account. So infringement by equivalence is not limited to foreseeable variants only.

In the AGA / Occlutech and recent Bayer / Sandoz case, the Supreme Court has set some limits to equivalence. It ruled that legal certainty requires a strict interpretation when variants are mentioned in the description, but are nevertheless not claimed. Then the rule ‘disclosed but not claimed is disclaimed’ applies and there is no room for equivalence, whatever the inventive concept may be.

The last – but not least – topic I want to address today is the use of the prosecution file in construing a claim. Taking into account the public and freely available parts of the prosecution file, dates back to the earliest days of patent protection in The Netherlands.

The Dutch approach to the possibility to derive arguments from the prosecution file in claim construction, is that a third party may always refer to the prosecution file and derive arguments from it, even if there is no lack of clarity. Although in Ciba Geigy the Supreme Court did not rule out that the prosecution file may be used in favour of the patentee, albeit only if it
remains uncertain how to construe the claim, taking into account the requirement that due account is taken of reasonable legal certainty of third parties, it is in my opinion highly unlikely that the prosecution file will be used in favour of the patentee.

In practice, the prosecution file is referred to by the alleged infringer and it happens very often, if not always. There are very good reasons why reference to the prosecution file should be allowed.

Firstly, the information in the file may be more relevant than other materials commonly used in claim interpretation. A reference to textbooks to substantiate that the skilled person would give a particular meaning to a claim is generally allowed. However, the problem with textbooks is that the purpose of claim construction is not to establish the meaning of the claims in the abstract, but in the context of the description and drawings. The general meaning of certain words does not necessarily correspond to the specific meaning given to these words in the context of a specific patent. In that regard the examination file is a more reliable and accurate source than textbooks.

Secondly, the examination file is not only relevant for claim construction but also for validity and it will therefore always be consulted by the attorneys preparing a court case. No sensible patent attorney will advise his client without consulting the prosecution file. It does not make sense to subsequently neglect that information in court.

Thirdly, allowing the use of the prosecution file will prevent the patentee from claiming broad scope of protection when suing for infringement, after he has accepted more limited claims in view of validity or obviousness objections by the examiner and / or the Board of Appeal. This is a risk that more readily materialises in bifurcated systems, such as the German one, as is clear from the Occluder case: only in the lower court in Germany the attacked occluder was found to be an infringement.

The regularly heard objections to using the prosecution file in my opinion hold no ground.

It is often noted that the examination file is not mentioned in article 69 EPC, as that article only provides that the description and drawings must be used in the interpretation of the claims. Indeed, article 69 EPC does not say that the file must be used to interpret the claims. But neither does it say that the file cannot be used for that purpose. It just does not say anything about use
of the file. Article 69 EPC does not mention other information and materials either, such as common general knowledge and cited prior art. Still, all jurisdictions allow that to be used in establishing the scope of protection. So, the mere fact that the examination file is not mentioned in article 69 EPC does not imply that it is not allowed to use it.

Another argument against use of the examination file is that it is not public, or at least hard to access. This may have been a valid point in the past, but it is certainly no longer the case with the files of the EPO today, that are freely available online.

A further argument against use of the prosecution file is legal certainty. The argument being that the whole purpose of having claims is that third parties can easily find out what the patentee claims and that third parties can rely on the information disclosed in the patent document and need not study the examination files. Indeed. There is and should be no need for a third party to study the examination file. This is exactly why use of the file in favour of the patentee is hard to imagine. However, if a third party takes the effort of studying a publicly accessible file in order to clarify any question about the scope of a claim, I cannot see any reason to preclude use of that information in Court against the patentee. Quite to the contrary. After all, the Protocol provides that a reasonable degree of legal certainty must be offered to third parties. Denying a third party to rely on any statements made by the patentee himself during examination proceedings in my view is clearly against legal certainty.

The ‘life is too short’ argument, advanced by Lord Hoffmann, is unconvincing for the same reason. One does not have to read it, nobody forces anybody to do so. But practise shows it is usually done and it is very unsatisfactory if someone who has made the effort to go through the file, subsequently has to ignore it is there.

Finally, the UK Court of Appeal in the pemtrexed case very recently noted: ‘I do not regard it as useful to go to the prosecution history in order to discover that the patentee accepted a restriction to his claim against an objection [of the examiner]. (…) It is still open to the patentee to say that he need not have done so, and the apparent concession he made in prosecution was wrongly made.’

That of course is true. But it is no reason to ignore or even prohibit reference to the prosecution file. Under Dutch law there certainly is no estoppel – the mere fact that the patentee limited his claim during
prosecution does not mean he is prohibited from arguing he need not have done so. As mentioned earlier, a more limited scope of protection than the claim would otherwise have given rise to, may only be accepted if there is good (valid) reason to assume that the patentee waived protection. If it is apparent to the skilled person that the examiner when requiring that the claims be more limited had no good (valid) ground to do so, the skilled person will not (validly) assume the patentee really intended to waive protection. As a result, under such circumstances, reference to the prosecution file will not, at least not for that reason, lead to a more limited scope of protection. The patentee is always allowed to advance that argument.

Having said all this, the question arises whether the prosecution file is really not used in court in Germany and England? Well, not explicitly, but there are signs it happens implicitly. In the pemetrexed cases, which ran in parallel in England and Germany, the prosecution file was referred to in great length in both proceedings.

Arnold J. in his pemetrexed decision accepted that at the stage of ascertaining scope of protection the prosecution file may be considered.

The UK Court of Appeal did not agree for the reasons I just mentioned. After having set out the reasons for not considering it useful to look at the prosecution file, the UK Court of Appeal, when construing the claim, stated that ‘the skilled team would understand that the patent was clearly limited to the disodium salt, and did not extend to the dipotassium salts’ and he gave several reasons, among which the following: ‘The only data contained in the specification are for pemetrexed disodium, and broader claims therefore lack support and might have been unacceptable to the EPO’.

With all due respect, it seems slightly artificial if the prosecution history, which shows that the claims were limited to the disodium salt following disclosure issues raised by the examiner, is first extensively discussed in the judgement, then reference to it is not considered useful, and subsequently it is decided that the claim should be construed narrowly, because the skilled person would see that broader claims lack support and might have been objected to during prosecution. This is something that strongly reminds of ‘keeping up appearances’.

Similarly, the German court of appeal in Düsseldorf rejects the use of the prosecution file, but nevertheless uses it.
It stated: ‘Here, which has to be noted by way of precaution, taking into account the content of the prosecution file does not serve to interpret the claim or to determine the scope of protection of the patent in suit; rather, the opinion of the examiner is cited as an indication of the fact that the person skilled in the art would not understand the term “pemetrexed disodium” in the sense desired by the Plaintiff. (...) However, this does not mean that the contents of the prosecution file cannot be taken into account by the infringement court. Rather, the contents of the prosecution file – comparable to a specialized technical lexicon – can provide evidence as to what a certain term in the patent signifies. In this regard, statements by the patent proprietor during prosecution can be an indication of how the person skilled in the art understands the feature in question. The same applies to the opinions of the examiner, particularly when the Applicant does not dispute them. Such a taking into account is unobjectionable because the granting file in this case has only the significance of a reference book or the like, which may of course be consulted in order to create certainty regarding the possible technical meaning of a feature of a claim.’

I am puzzled by this. The court mentions it is not allowed to take the file into account, for various reasons, and then goes on to explain it does take it into account and that this is allowed, because it is only treated as a reference book? To me, determining how the person skilled in the art understands the feature of the claim is determining scope of protection.

From this, there is only one possible conclusion: in theory the UK and German courts reject the use of the prosecution file, but in practise they do. And rightly so, for all the reasons I gave.

So, where does all this bring us in relation to the question whether patent claim construction boils down to determinism or crystal gazing?

Proceeding from the Dutch approach to claim construction it certainly is not determinism. The claims are the starting point for that exercise. But these cannot be taken on the face value but have to be interpreted, always, whether clear on the face of it or not. The inventive concept behind the claims as the skilled person understands that to be, using his common general knowledge, in light of the description and drawings, is one, but very important, viewpoint to be taken into account, as it is an indication for the fair protection to the patentee. At the opposite end the legal certainty of third parties has to be taken into account. And these interest must be balanced, leading to a fair result.
Does this exercise then amount to glazing in a crystal ball with an uncertain outcome? I think not. It is generally known that what is seen in a crystal ball entirely depends on the state of mind of the person looking into it. If the various courts among Europe really had a different approach towards patent claim construction, the decisions of the various European courts would be different most of the time. But they are not.

Cases such as AGA / Occlutech and Medinol / Abbott clearly show that European courts have come a long way from their own traditions. They may to a certain extent still struggle with their old habits, but that has not prevented the courts from coming to a largely harmonised approach that tends to lead to the same end result.

By avoiding both Scylla and Charybdis, they strike the right balance between fair protection to the patentee and reasonable legal certainty to third parties. And that is what claim construction is really about.