

## Claim Interpretation

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### 1. *Claims claim.*

Patent interpretation consists of claim interpretation. The scope of protection of a patent is determined by the claim, and not by the description or drawings. As an American decision states, “the description teaches, and the claim claims”<sup>1</sup>.

a) For national patents, article 8,3 of Strasbourg Convention<sup>2</sup>, ratified and implemented by most European States<sup>3</sup>, lays down that claims determine the scope of protection. They are to be interpreted in the light of description and drawings, but not supplemented or altered by them<sup>4</sup>. Claims are not a technical, but a legal text. They form the text establishing rights and obligations, a text to be interpreted according to legal criteria.

b) For European patents, according to the article 69 EPC<sup>5</sup> and the Protocol<sup>6</sup> on claim interpretation, the scope of protection is determined

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<sup>1</sup> *S.R.I. International v. Matsushita*, 775 F. 2d 1107 (CAFC 1985).

<sup>2</sup> Convention signed on November 27, 1963: on the Unification of Certain Points of Substantive Law on Patents for Invention.

<sup>4</sup> The rule of art. 8,3 of the Strasbourg convention is a part of national laws, either because it has been incorporated into the patent law, or because it is inserted into the national legal systems after the ratification and implementation of the Convention.

<sup>4</sup> The different opinion that the scope of protection corresponds to the general inventive idea (*Allgemeine Erfindungsgedanke*), and therefore is reflected in all the parts of a patent, and not only in the claims, was prevailing for a long time in most European countries. It was abandoned after the Strasbourg and the EP Conventions. For Germany, see BGH *Formstein* 1987 IIC 795. In Italy it was maintained for a long period even after said conventions. It cannot be upheld any more (and it is also harmful for the technological development: Riv. dir. ind. 2002, II, 334). There are still in Italy decisions applying the old theory: see two decisions by the Court of Appeal of Milan 2001, *MEP/Schnell* and *FIP/Plastica Bustese*, mentioned in Riv. Dir. Ind. 2002, II, 334.

<sup>5</sup> European Patent Convention, signed in Munich on October 5, 1973.

<sup>6</sup> *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. Neither it should 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. On the contrary, it is to be interpreted as defining a position between these*

by the claims, and claim interpretation has to be carried out in the light of description and drawings. A hierarchy of texts to be interpreted must be established. In particular the texts are relevant in the following order:

i) first of all, the claims in the language of the procedure before the European Patent Office (see Art. 69, 1 CBE and 70 CBE),

ii) then the claims in the other two official languages of the EPO (Art. 69, 1),

iii) then the description and drawings (Art. 69, 1)<sup>7</sup>.

The translation in the national language has a lower value. For instance, in Italy,

iv) the translation is relevant only if it confers a more restricted protection (Art.5 Law –DPR- of Jan 8, 1979, no. 32). By contrast, the Italian texts has no bearing if it confers a different or wider protection. (But if the Italian text leads to a not comprehensible or a not easily recognizable extent of the patent right, in my opinion it could result in the invalidity of the patent.)<sup>8</sup>

## 2. *Criteria of interpretation.*

Claims do not constitute a private declaration<sup>9</sup>, and it does not seem possible to apply unconditionally the rules on the interpretation of contracts<sup>10</sup>. The most pertinent analogy is with statutory interpretation, since claims create obligations for third parties with character of abstractness and generality<sup>11</sup>. (An Italian decision said that the closest analogy is with corporate charters<sup>12</sup>, but this comparison does not seem really enlightening). Qualifying the patent as an act of administrative power<sup>13</sup> does not say anything on the interpretation criteria<sup>14</sup>.

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*extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.”*

<sup>7</sup> The description takes hierarchy over the drawings. Court Paris Oct. 28. 1992, *Oscobal et Dimso v. Biomécanique*, PIBD 1993, III, 78.

<sup>8</sup> In France, Appeal Douai *Broyeurs Poittermill v. Alpine* March 15, 1993. PIBD 1993, III, 447 seems to give precedence in all instances to the French translation.

<sup>9</sup> Thus Appeal Milan June 25, 2002 *Fedegari*, in Riv. dir. Ind., quoted above.

<sup>10</sup> Thus in Italy Giurì on the intellectual property (a private consultation body), *Monitor* case, in **Reid**, *European Patent Litigation Handbook*, London 1999, 249.

<sup>11</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 38 USPQ 2d 1461 (1996).

<sup>12</sup> High Court Monza 2001, *Breda /Hormann*, unreported.

<sup>13</sup> **Ascarelli**, *Teoria della concorrenza e dei beni immateriali*, Milan 1955, **Franzosi**, *L' invenzione*, Milan 1970.

<sup>14</sup> In Canada the qualification of a patent as Regulation (we would say “administrative act”) is used to derive criteria for interpretation.

The fact is that patents must be interpreted according to their own criteria<sup>15</sup>. For the European patent, the criteria are laid down in the Protocol of the article 69, and not on the basis of criteria of domestic law (among other things, it would be improper to call for hermeneutical criteria of a national system for a European patent). So, according to the direction of the Protocol, the interpreter has to search for a middle course between the inventor's protection and third parties' protection, and he (or she) does not have to limit himself to a literal interpretation, or to use a claim as a general guide, useful for the reconstruction of the inventor will. As I say herein below, the search for the pure inventor will is not pertinent.

### 3. *Objective interpretation*

A claim is an order, addressed to competitors, to refrain from economic activities in a specific area, which is the area of protection. Claim interpretation is directed to the understanding of the order, in its objective sense. What the inventor aimed at protecting in the patent is not relevant on a subjective level, but on an objective level, or better on two levels.

First of all, what is relevant of the inventor will is only what had been translated in an order comprehensible to third parties: so it is not admissible to search for an intention of the inventor leading to an order to refrain from doing something which is not clearly detectable from the patent. What is important is not what is wanted, or declared, but what is perceived: not what the inventor wants, but what third parties understand. In the same way, the reason why Captain Ahab wanted to kill the whale represents a good literature but, in the opinion of the simple sailors of the Pequod, Ahab just hunted the whale. This is the only important element in patent law.

Secondly, it is not important what the inventor wanted, but what he would have wanted if he had known the whole status of the art<sup>16</sup>:

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<sup>15</sup> *Rodi & Weinenberger v. Henry Showell*, 1968 FSR 100.

<sup>16</sup> In the EPO praxis is necessary to identify the solution of the objective technical problem, and not the subjective one. The solution of the objective problem is the one that “*results from an objective analysis of the differences or of the surplus of the results of the invention with respect to the most relevant prior art*”. **Knesch**, *Assessing Inventive Step in Examination and Opposition Proceedings in the EPO*, EPL. Information, 1994, 95; T 1/80, OJ. 1981, 206 ; T 39/93, OJ 1997, 134.

therefore the inventor is not protected on what he wants to reach, but on what he can reach.

Claims interpretation does not consist in identifying the technical problems solved by the inventor<sup>17</sup>. The identification of the technical problem may have a role in writing claims, but when claims are written, words, and not problems, are carved into the stone. There is no protection for a problem that has been solved but not claimed. Third parties' rights do not tolerate the expropriation of the general freedom with the excuse of rewarding the individual's cleverness. On the contrary, claims interpretation consists in identifying the *non-facere* obligation determined by the inventor's statement<sup>18</sup> (as long as this statement does not go beyond the scope of the application<sup>19</sup>). So, the identification of the technical problem solved is only useful to identify what third parties have understood about the inventor's statements.

In the claim, words have a meaning of their own, or better the meaning of the whole text (since no word has a univocal meaning). The aim of interpretation is to identify said meaning. The meaning of the words derives by the connection of the words. Not by A and B, but by A+B.

It should be assumed that the same words are used with the same meaning in the different patent claims of the same patent and in all the text of the patent. But, obviously, it must be considered that (for the European patent, where editing the claims is the main object of the granting procedure) the different claims have different meanings, defining different obligations to abstain<sup>20</sup>. There would be no reason to express different claims, if not in order to claim different things.

#### 4. *Description and drawings*

The starting and arriving point of the interpretation of claims are claims. Nevertheless description and drawings help to interpret claims. Let's see how.

First of all, it should not be held that description and drawings are called for when the claim meaning is doubtful, and not called when it is clear<sup>21</sup>. The article 69 EPC (and the article 8,3 of the Strasbourg Convention for

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<sup>17</sup> **Franzosi**, *Three European Cases on Equivalence: Will Europe Adopt Catnic?*, 2001 IIC 113.

<sup>18</sup> In examination systems, from the claims resulting after the examination.

<sup>19</sup> Otherwise the patent would be invalid.

<sup>20</sup> *Claims differentiation: Chisum*, *On Patents*, 5A:18.03(6).

<sup>21</sup> But see the Austrian decision *Sliding Gate (Schiebgittertor)*, Nov. 27, 1985, in **Marks & Clerk**, *European Patent Infringement Cases*, London 1999, 53.

national patents) imposes to call for description and drawings in any event. But it is clear that description and drawings cannot alter the meaning of the claim, nor add or detract. Widening or limitations to claims cannot be derived from description and drawings. These latter

- i) clarify the obscure meaning of claims (thus allowing to choose which meaning is to be selected among many possibilities) or
- ii) confirm the clear meaning, but
- iii) they cannot alter a clear meaning, nor
- iv) give sense to a text that has no meaning.

Therefore, if a claim:

- is clear and is confirmed by the description, this is the end of the interpretation;
- if it is contradicted by the description, the patent is invalid (the claim is not supported by the description);
- if obscure (not provided with any clear meaning, or provided with more than one meaning) but made clear by the description, this is the end of the interpretation;
- if it remains obscure, the patent cannot be interpreted, and so it is invalid.

For patent interpretation, the importance of description and drawings can be compared to the importance of *travaux préparatoires* for law interpretation<sup>22</sup>. Both of them are useful to clarify the meaning, but not to alter it.

It is worth asking whether the patent title shall be considered for interpretation. Art. 69 EPC does not mention it. I do not think that the title is relevant: it is formulated in order to find the document, and not to assess the rights<sup>23</sup>.

## 5. Other documents

Beside the patent document, the acts on the granting procedure and other documents not concerning the procedure are important to interpret claims. Here, however, not everybody agrees.

In America the acts on the granting procedure (*file wrapper, file history, prosecution history*) have (almost) the same relevance of description and

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<sup>22</sup> We speak of *law interpretation* and not of *law and travaux préparatoires interpretation*. Therefore we should speak of *claim*, and not of *patent interpretation*.

<sup>23</sup> In the English case *American Home Products vs. Novartis* Court of Appeal 2001 EWCA Civ 165 it was held that the right was not extended to a product mentioned in the title, but not in the claim.

drawings<sup>24</sup>. They are considered an *intrinsic evidence*. It is not the same in Europe. In Germany the Bundesgerichtshof considered that the declaration of the patentee can be used against him only by the party taking part to the opposition, acting now as defendant in an infringement action<sup>25</sup>. In Great Britain the High Court showed reluctance to use the file history<sup>26</sup>, while the Court of Appeal thought that the file history could be of assistance to resolve some uncertain features of the specification<sup>27</sup>. In Holland, the Supreme Court of Justice (Hoge Raad) excluded that the information contained in the file history can never be used to interpret the patent, even if they are available to third parties, but it added that caution is necessary if arguments in favour of the patent owner could be found<sup>28</sup>. In France the Courts do not seem to be willing to use the file history, even if recent decisions allow to get from the procedure a confirmation of an interpretation which is already possible from the patent<sup>29</sup>. In Italy Case Law is unwilling to use that data<sup>30</sup>.

I think it should be held that public statements (available to third parties) are relevant if essential or useful to overcome objections on patentability (*patentability necessitated, or related*). But they do not allow a new formulation or a different understanding of the claim<sup>31</sup>.

As to the other documents (considered as an *extrinsic evidence* in America<sup>32</sup>), like dictionaries, generally known handbooks, well-known technical articles, as well as patents or publications mentioned in the patent specification, they are useful to show both the contextual and not contextual meaning of the word. It must be assumed that the inventor used words and expressions according to the meaning that was acknowledged (in handbooks, articles or patents mentioned in the

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<sup>24</sup> *Markman I*, 52 F.3d 967 (CAFC 1995), aff'd 517 US 370 (1996).

<sup>25</sup> *Weichvorrichtung II*, 1993 GRUR 886, 25 IIC 420.

<sup>26</sup> *Kirin-Amgen v. Roche Diagnostics*, High Court April 11, 2001, 2001 EWHC Pat 433; *Kirin-Amgen v Hoechst Marion Roussel*, Court of Appeal July 31, 2002, 2002 EWCA Civ 1096.

<sup>27</sup> *Rohm & Haas v. Collag*, Court of Appeal, October 29, 2001, 2001 EWCA Civ. 1589.

<sup>28</sup> *Ciba Geigy v. Oté Optics*, January 13, 1995, 28 IIC 748,

<sup>29</sup> Appeal Paris, *Prod'hygia c. Molnlycke*, PIBD 1999, 671, III, 79.

<sup>30</sup> Court of Milan, December 13, 1999, *LEM c. Pietro Cucchi*, unreported.

<sup>31</sup> **Franzosi**, *Prosecution History Estoppel in Europe*, in IIP (Italian Intellectual Property) 2003, 123 ; **Id.**, *L'interdiction de se contredire au détriment d'autrui et la teneur du dossier de délivrance du brevet d'invention (prosecution history estoppel)*, RIPIA 2004. It is worth noticing how the English expression is translated into French. Even in the Italian language the translation should be similar to the French one. For this reason I have used the English expression.

<sup>32</sup> Discussion on whether dictionaries are extrinsic evidence or elements for understanding of the intrinsic evidence in *Philips v. AWH*, Fed. Cir. 03-1269 of Feb 8, 2005.

application) at the time of application. On the contrary, publications that are not well known, or patents that are not mentioned in the application, cannot be considered as expressive of the meaning used in the patent application.

The inventor may have used words or expression in a particular meaning (but the practice cannot be approved if it is done to make the interpretation more difficult). If the description, implicitly or explicitly, defines a particular term in a way differing from the usual, this definition must be adopted, since the description is used as a glossary to the understanding of the claim<sup>33</sup>.

The inventor's statements in lectures, books etc, before or after the patent, should not be so relevant, since they can show the meaning conferred to the terms by the inventor, but they cannot show the meaning perceived by third parties. For the same reason the inventor's deposition should not be used<sup>34</sup>.

#### 6. *The interpreter.*

A patent is to be understood according to the expert's understanding: in fact the claim is addressed to the expert, and not to an undifferentiated audience. The expert is the one who is gifted with the *common general knowledge*, i.e. the practical knowledge (experience) of the skilful technician having a practical interest in the technology considered by the patent<sup>35</sup>. He or she is a technician that wants to understand and work, and not simply to understand and know<sup>36</sup>. The *common general knowledge* is a different and more restricted thing than the state of the art; it includes the generally known treatises, the most reliable technical articles, as well as the well known patents that are part of the current qualification. Use of internet has greatly expanded the category.

In my opinion, he who interprets a patent in order to establish its scope is not the same person as the person who establishes its validity. The latter is a technician that wants to understand in order to know, while the

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<sup>33</sup> *Autogiro of America v. United States*, 384 F. 2d 391, 155 USPQ 687 (CCPA 1967); *Vitronics v. Conceptoronic*, 90 F. 3d 1576, 39 USPQ 2d 1573 (CAFD 1996); BGH *Spannschraube*

<sup>34</sup> In Great Britain it is not admitted, while it is common in America (which is somehow in contradiction with the principle that gives value only to the objective meaning).

<sup>35</sup> **Franzosi**, *Novelty and non-obviousness*, 3 JWIP 683 (2000); **Terrell**, *On the Law of Patents*, London 2000, p.124 ff.

<sup>36</sup> **Franzosi**, *Come si legge un brevetto*, (*How a patent is to be read*), in *Notiziario Consulenti* 2004, 9.

former is an interpreter that wants to understand in order to make and sell.

### 7. *All elements rule.*

In order to assess infringement it is necessary to divide a claim into its constituent elements, and to assess whether the several elements are present in the accused device, literally or by equivalence. A synthetic and global evaluation is appropriate for trademarks, but not for patents. There is no such a thing as the infringement of the overall idea, essence or meaning of the invention (*Allgemeiner Erfindungsgedanke*). Claims are not ideas, and therefore are sets of elements.

Patent infringement exists if the accused infringement reproduces all the claim elements, literally or by equivalence (except for what will be dealt with below). But the claim is what is understood by the interpreter. If the interpreter understands that some elements expressed in the claims are not necessary, or are to be understood in a way different from the apparent literal meaning, he or she will establish the scope of protection without considering those unnecessary elements, or with elements different from the ones that the apparent literal meaning evidences.

### 8. *Independent and dependent claims*

A patent often contains one or more independent claims, and one or more dependent claims<sup>37</sup>. Independent claims do not refer to previous claims. The dependent ones refer to one or more independent claims, or to one or more dependent claims (multiple dependence), or to one or more independent and dependent claims..

There is a violation of an independent claim if the accused production possesses the elements of the claim. There is violation of a dependent if the accused production possesses the elements of the dependent claim, plus the elements of the claim(s) on which it depends.

It is not admissible to combine elements of different claims, and to assess infringement if elements belonging to different claims are present. This course of action is followed sometimes<sup>38</sup>, but it is a unnatural combination of elements, like the creation of a non-natural organism in *Frankenstein, the Modern Prometheus*. It is a *Frankenstein* procedure.

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<sup>37</sup> *Guidelines EPO, C III 3.*

<sup>38</sup> Court of Appeal Milan, *Fedegari*, quoted above.

A non-final decision that establishes infringement of the independent claim should continue and examine also whether dependent claims are violated<sup>39</sup>. Otherwise, if it is found out later (in the appeal or the invalidation procedure) that the independent claim is not valid, the evaluation of infringement has to start anew again.

### 9. *Pre-characterizing part*

In the European procedure, patents are usually written with a pre-characterizing part, a transition expression and a characterizing part<sup>40</sup> (*two parts claims*, if we neglect the transition).

The pre-characterizing part (*Oberbegriff*) establishes the general technical frame of the invention. In the procedure of the EPO, it is represented by the closest known art. It usually consists of a single document in the same technical field of the invention or in a similar field<sup>41</sup>. The selection of this piece of prior art is often arbitrary. In fact, if the invention consists of “A characterized by B”, it can often be equally well represented also as “B characterized by A”.

The problem is whether the expressions of the pre-characterizing part are to be interpreted with the same criteria applying to the characterizing part, i.e. if they equally limit the inventor’s right. Generally it is so: if we say “A characterized by B”, it follows that A and B have the same weight<sup>42</sup>.

Nevertheless sometimes the inventor expresses the pre-characterizing part as an indication of the technical field where the invention operates (namely, as classifier part), so that it is not understood as a restrictive expression, but as an indication of the area. In this case the inventor identifies the invention in two steps, first by indicating a generic target in the classifier part, and then a precise target in the characterizing part. His indications are perceived by third parties as a target achievement in two steps, whereas the first one gives an initial approximation, useful to aim at the final goal<sup>43</sup>. In particular this happens when the characterizing

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<sup>39</sup> Appeal Paris Dec. 1. 1993, *New Mat v. Scherrer*, PIBD 1994, III, 135,

<sup>40</sup> This format is not adopted when elements of equal status are combined, an element is omitted and there is a set of elements functionally linked. *Guidelines*, C III 2. The format is called *Jeppson claim*. *Ex parte Jeppson*, 1917 C.D. (Commissioner’s Decisions) 62.

<sup>41</sup> T 254/86, OJ 1989, 115.

<sup>42</sup> The statement generally followed is that all the parts of the patent have the same importance in interpreting the patent: this seems to be equivalent to the principle according to which they must be subject to the same interpretation rules.

<sup>43</sup> *Catalina Marketing v Coolsavings*, 229 F 3d 801 (CAFC 2002).

part shows the purpose that the inventor wants to achieve<sup>44</sup>. This purpose is not binding; as said before, what the inventor aims at obtaining is not important to establish the scope of protection. So, if Christopher Columbus states that he wants to find a new way to the Indies, *buscando el levante para el poniente*, the indication of purpose cannot deny the discovery of America. But when the pre-characterizing part contributes to define the invention, and gives to the creative idea its precise meaning, it is a limit to the protection<sup>45</sup>.

To hold that there is infringement when only the elements of the characterizing part are present, is a utterly wrong conclusion. Even if it seems strange, there are many decisions in this sense; with all due respect, it seems to me that the *Labinal* decision by the French Supreme Court<sup>46</sup> belongs to this category. It is the argument of the blue horse: he who obtains a patent for “a horse, characterized by the fact that it is blue”, cannot say that everything that is blue is a infringement, without considering the horse, for the reason that it was already known and was not characterizing.

## 10. Transition

Transition between the pre-characterizing and characterizing part is made up of the expression “characterized by the fact that”, or a similar expression<sup>47</sup>. This expression is particularly suitable to assess the inventive level, since for the simplicity of the examination it can be assumed<sup>48</sup> that the creative contribution lies in the second part of the claim.

The expression “characterized by the fact that” is not the same as the most accurate terms used in America, such as *comprising* or *consisting*. Nevertheless that expression is often supplemented by these other terms, and becomes “characterized by the fact that it comprises” or “characterized by the fact that it consists of”. The former is *open-ended*,

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<sup>44</sup> Indication of purpose in the pre-characterizing part generally do not limit the scope. **Benkard**, *Patentgesetz*, Munchen 1993, Anm. 14.

<sup>45</sup> In America it is said that the preamble has a limitative effects when it provides claim with “life, meaning and vitality”. *Pitney Bowes v. Hewlett-Packard*, 182 F.3d 1298 (CAFC 1999).  
<sup>46</sup> Court de Cassation Nov. 4, 1987, PIBD 1988, III, 97. See also **Mathély**, *Ann* 1988, 1, 3 ; **Martin**, *JCP* 1988, 15327, 742; **Le Tallec**, 1989 IIC 359. See also Appeal Paris, *Salomon v. Nordika* Jan. 18, 1995, PIBD 1996. III, 327.

<sup>47</sup> In the procedure of other countries we find “the invention consists of”, or “consisting” or “comprising”.

<sup>48</sup> But not in a conclusive way.

and it does not exclude from the scope of protection further structures or activities. The latter is *closed-ended*, so that the scope of protection is limited to those mentioned components or passages: the addition of components or passages avoids infringement (unless is insignificant at all). Another transition expression is “characterized by the fact that it consists essentially of”. This sentence excludes from the scope of protection those elements that alter considerably the property of the invention.

The expression “characterized by the fact that”, without the further terms “comprising” or “consisting”, results in a strong assumption of being closed-ended, so that the addition of other elements normally excludes infringement. The description shows whether the expression is closed-ended or opened-ended.

### 11. *Characterizing part*

The characterizing part is made up of structures or activities defined as essential to identify the invention. A realization that uses these structures or activities, beside those belonging to the pre-characterizing part, represents a literal infringement; another one that does not use them is not an infringement, unless it is an equivalent.

Generally, the elements of the characterizing part are all essential to define the invention: infringement requires adoption of all the elements (*Merkmalsgliederung*). So the various elements are properly understood as limits to protection<sup>49</sup>.

Nevertheless there can be cases in which some elements can be neglected, and a product or process is an infringement even if it neglects them<sup>50</sup>. What is decisive is the interpreter’s understanding of the scope of protection, and not the expert’s understanding of the technical sense (*Sinngehalt*) of the invention. If the interpreter understands that the omission of some elements not only does not change the meaning of the invention, but rather does not lead to a different outline of the right, then the useless element can be omitted. Care should be used in this connection. The fact that the useless element is present carries an heavy presumption that the inventor did not believe that the invention could have been patentable without that element. Even if the opinion of the

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<sup>49</sup> The Italian translation of art. 69 says “Limiti della protezione”.

<sup>50</sup> What in Germany is called protection of the sub-combination. **Benkard**, Anm. 14; **Rogge**, Mitt 1998, 204; **Pagenberg**, GRUR 1993, 264.

patentee is not decisive, third parties usually have reasons to rely on what the inventor defined as essential for his right. However, if third parties easily understand that there is a useless element to be neglected, both when ascertaining how the invention works, and when defining what kind of impediment is created for competitors, then that element can be neglected and the claim is infringed even by a simplified implementation.

## 12. *Interpretation rules*

A few guidelines to interpret the patent can be laid down here.

Interpretation has to be carried out in order to find a meaning in the text, and not for the purpose of denying it. Therefore any “*kind of meticulous analysis in which lawyers are too often tempted by their training to indulge*” must be avoided<sup>51</sup>.

If possible, interpretation must detect the validity of the text, and not its invalidity; nevertheless this principle (currently applied in Italy) is denied by those believing interpretation should be neutral<sup>52</sup>. But if the most suitable interpretation leads to an invalidity assessment, the patent cannot be upheld. In other words, I would favour a positive interpretation when the odds are balanced, and not when the arguments for invalidity are stronger than for validity.

Although the Protocol of article 69 states that the interpreter must search for a fair protection of the inventor, without unreasonable uncertainties for third parties, I would think that third parties’ interest should prevail. Between the third parties that cannot suffer from excessive restraints and the inventor that defines the restraints for third parties, it is fair to assume that the applicant himself has a greater responsibility for clearly expressing his or her own rights<sup>53</sup>. Therefore the petitioner is responsible for any expression fault; his mistakes cannot result in unexpected obligations for third parties (obligations that carry serious civil and sometimes criminal consequences). For this reason, when more interpretations are possible, the one that causes less impediments to third parties shall prevail.<sup>54</sup>

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<sup>51</sup> Lord **Diplock**’s statement, in *CatnicComponents v. Hill & Smith*, 1981 FSR. 60; 1982 RPC 183.

<sup>52</sup> *Turrill v. Mich*, 68 US 491 (Supreme Court, 1863).

<sup>53</sup> *Warner-Jenkinson v. Hilton Davis*, 117 S.Ct. 1040, 41 USPQ 2d 1865 (1997).

<sup>54</sup> *Athletic Alternatives v. Prince*, 73 F 3d 1573 (CAFC 1996).

The interpretation given by the patentee in a litigation or elsewhere is not relevant to establish the scope of the text, unless it is a confession or an admission. What is really important is the objective interpretation.

Claims are a regulation destined to last twenty years. But it often happens that the words or expressions usually used change their meaning, due to the technical environment in which they are inserted. So the problem of establishing the time for interpretation arises.

As to the validity assessment, it is necessary to refer to the application or to the priority date. So a patent that cannot work at the time of the application is invalid, even if it can be accomplished later on. Verne cannot expect to have a monopoly on the missile to the moon, even if today this can be accomplished. And a patent that is inventive at the time of application is not considered invalid just because it becomes evident later on.

In order to determine infringement (scope of protection), I would refer (I hope not to be considered eccentric) to the date of the application to establish literal infringement, and to the date of infringement to establish infringement per equivalence. As to literal infringement, the words used in the patent should be taken in their literal and historical meaning, and an accused product (or process) is an infringement if it can be described with the same words, endowed with that meaning. Nevertheless claims are prescriptions addressed to third parties, and what they express, at the time in which they express, goes beyond their literal meaning. Claims have a meaning independent from the historical moment in which they are laid down; they take a meaning of their own. Therefore he who carries out an implementation that does not correspond to the historical value of the words adopted, but nevertheless corresponds to their meaning, performs an infringement by equivalence.

Prof. Avv. Mario Franzosi