

Interpretation of Patent Claims

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1 Introduction

The principles of interpretation of patent claims belong to one of the central themes in patent law.¹ These principles have been discussed and developed in a large number of rulings handed down by the highest national authorities in Europe as well as the board of appeals of the European Patent Office (EPO). In Sweden a few rulings of relevance in this context have been handed down by the Swedish Supreme Administrative Court, but the Swedish Supreme Court has not granted leave of appeal in any of the cases concerning patents since 1972, when the Court delivered a judgment concerning primarily inventive steps, containing also, however, argumentation regarding the patent's extent of protection (NJA 1972, p. 462, NIR 1972, p. 430; infusion apparatus).² It is to a high degree the Svea Court of Appeal and the Patent Court of Appeal which are responsible for lawmaking from the judicial and the administrative points of view respectively in the field of patent law, within the framework of the boundaries laid out by the European Patent Convention (EPC), based on the guiding principles established by the EPO's case law.³ It is therefore very gratifying that the Supreme Court has now tried a case concerning interpretation of patent claims (see, NJA 2000, p. 497).

¹ There has been a lively debate in Scandinavian literature concerning the so called patent claims doctrine, with major contributions by Godenhielm, Koktvedgaard, Bruun, Domeij, and others. In this connection refer to the latter's *Läkemedelspatent*, Stockholm, 1998, p. 481 ff., and Jacobsson-Tersmeden-Törnroth, *Patentlagstiftningen – en kommentar*, Stockholm 1980, p. 255 ff.

² See Bernitz-Karnell-Pehrson-Sandgren, *Immaterialrätt*, 7th ed., Stockholm 2001, p. 126 ff., and Koktvedgaard-Levin, *Lärobok i immaterialrätt*, 6th ed., Stockholm, 2000, p. 250.

³ Patent law is unusual in the sense that the Stockholm City Court, which is the first instance in many patent cases, contributes to a certain degree to the lawmaking in the absence of precedents and as a result of the boldness characterising sometimes the Court's decisions in patent cases.

2 Background

Section 39 of the Patents Act stipulates that “The extent of patent protection shall be determined by the patent claims” which define the invention (Section 8, subs.. 2 of the Patents Act; Article 84 of the EPC). Section 39 contains also an interpretation rule: “In construing the patent claims guidance may be taken from the description.”

Section 39 of the Patents Act is in the main similar to Article 96.1 of the EPC.⁴ This Article, whose object it is to promote similarity in determination of the patent’s extent of protection in Europe, is supplemented by a Protocol on the interpretation of the Article, which forms part of the Convention. The Protocol has been formulated in the following way:

“Article 69 should not be interpreted in the sense that the extent of protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that they only serve 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 extremes which combines fair protection for the patentee with a reasonable degree of certainty for third parties.”

The Protocol on the interpretation of Article 69 attempts to harmonise the different interpretation traditions existing in Europe – on the one hand the British tradition which attaches particular importance to the wording of the patent claims, showing great consideration for third-party interests, and on the other hand, the continental tradition which focuses on the inventive concept expressed in the patent document, showing great regard for the interests of the patentee. The Protocol has had a considerable effect at national level and has in this way contributed to the harmonisation of patent law in Europe.

For a patent infringement to apply it is required that the alleged offender’s products or conduct – the so called object of the infringement - satisfy all the statements used in the patent claims, in the way they should be construed according to the foregoing (see also Section 3 of the Patents Act). If the defendant has exploited the patentee’s invention, deviating at the same time in some respect from the statements, infringement can nevertheless be considered to apply if the object of the infringement produces the same result by the fact

⁴ It should be observed that Section 39 does not match one hundred percent any of the three versions of Article 69, and that these three versions differ also from one another. *Cf.* Godenhielm, *Patentskyddets omfattning i europeisk och nordisk rätt*, Helsingfors, 1994, p. 20 ff., 167 f., and 172 f. Törnroth has commented upon this relationship in his dissenting opinion in the Court of Appeal’s case mentioned below (Footnote 26, fastening device). The above-mentioned differences are not negligible, and there is reason to review Article 69 in connection with the on-going revision of the EPC; *see* Basic Proposal for the Revision of the European Patent Convention, CA/100/00 e, p. 55 ff.; *see also* Stenvik, *Patentrett*, Oslo 1999. The latter claims that the difference between the wording of Section 39 and Article 69 of the EPC does not mean that the two do not show good correspondence. (p. 298).

that the offender exploits the invention by means which are equivalent or closely related to the formulation of the patent claims (so called equivalence).⁵

3 The Case

3.1 *The Dispute*

The case concerned a dispute between Comviq GSM AB (hereinafter Comviq) and Europolitan AB (hereinafter Europolitan). Comviq – the owner of a procedural patent (concerning “procedures for telephone systems... in which component subscriber units (MS) are controlled by a subscriber identity module (SIM...)” – claimed that by using so called Tvilling cards Europolitan became guilty of infringement of their patent. The dispute activated several questions concerning the interpretation of the patent claims in question, and especially the question of whether it was possible to read into patent claims a statement taken from the patent description, which had no equivalent in the wording of the patent claims.

3.2 *The Lower Courts*

In their interpretation the judges of the (first instance) City Court, who made a detailed technical review of the patent document and the Tvilling card, paid attention to the description and the examples proposed in it. The Court argued that the particular inventive concept claimed by Comviq did not transpire from the patent document, and found that the use of the card entailed that both the problem and the solution varied from the invention protected by the patent, which is why Europolitan’s use of the card did not constitute an infringement of the patent. The Court of Appeal came to the same conclusion, and stressed the fact that, *inter alia*, the technological state of the art on the day of the application prevented the interpretation of the patent claims as maintained by Comviq. The claims would therefore have to be restricted in a way which did not transpire from the claims, but which nevertheless could be understood from the description. The Court of Appeal added the following: “... but a description and drawings should be used in order to determine the extent of patent protection only in order to attain the necessary qualification of the terms used in the patent claims. On the other hand it can never be the question of bringing in from the description a restrictive statement which has no equivalent in the wording of the claims.” Taking into consideration the state of the art of technology, bestowing on the patent the extent of protection desired by Comviq by means of equivalence could not apply either. The decisions of both instances were thus unanimous.

⁵ Törnroth in Karnov, Part 1, 2000/2001, p. 1030. For a more detailed analysis, see Domeij, *loc. cit.*, p. 484 ff.

3.3 *The Supreme Court*

To start with the Supreme Court considered certain fundamental issues, stating that: “one of the consequences of Sweden’s accession to the EPC is that earlier declarations appearing in the preparatory materials (*trauvux préparatoires*) concerning Swedish legislation in the field of patent law can no longer be considered as relevant in so far as they conflict with the Protocol on the interpretation of Article 69 of the Convention.” The Court also noted that the objective of Article 69 was to attain analogous assessment, but that there were no requirements concerning adaptation of national patent laws. The Court continued in the following vein: “Neither are there any requirements stipulating that national adjudications shall follow the adjudications of the European Patent Office. This is not to say, however, that it is not desirable for national courts to adjust their judicial practice as far as possible to the one applied by the EPO. Sweden belongs to those countries that have not only become signatories to the Convention, but that have also adapted their legislation to it. It appears therefore not particularly practical to try to determine a patent’s extent of protection in different ways, depending on whether the patent has been granted on the basis of a national patent application submitted to the Swedish Patent Office or on the basis of a European patent application submitted to the EPO and covering Sweden, in which case the patent will have the same legal effect in Sweden as a national patent.”

The Supreme Court invoked thereafter a judgement of the Swedish Supreme Administrative Court: “The Swedish Supreme Administrative Court has also ruled in a plenary decision RÅ 1990, ref. no. 84, that Sweden’s accession to the European Patent Convention has made it necessary for our internal application of the law to take account of the judicial practice of the European Patent Office, as far as this is consistent with Swedish legislation.”⁶

As regards the questions of interpretation relevant to the dispute, the Supreme Court discussed first the question of whether it was possible to read into the patent claims a statement taken from the description, which had no equivalent in the wording of the patent claims. The Court declared that both the EPO’s judicial practice and the European literature in the field answered this question in the affirmative, and came to the conclusion on the basis of the material that: “out of consideration for third parties it should ... be assumed that the statement must clearly follow from the description, that it shall be absolutely fundamental, and that a person skilled in the art who studies the patent document must be able to understand clearly the way in which the patent claims must be construed”. The Supreme Court came therefore to the conclusion that the limitation requested by Comviq could not be regarded as so necessary for the invention that the definition in question could be integrated into the patent claims.

Thereafter, the Supreme Court proceeded to interpret one of the key concepts stipulated in the claims, the so called “Subscriber’s Identity Module” (SIM) in

⁶ RÅ 1990, ref. no. 84, NIR 1990, p. 486 *talsignals tonhöjd*. The case has been commented on by Bernitz in JT 1990-91, p. 476 ff., and Godenhielm, *loc. cit.*, p. 41 ff., and 54 f. See also Levin, NIR 1991, p. 197 ff., and Törnroth, NIR 1999, p. 92 ff.

order to decide whether Europolitan's Tvilling card would fall within the patent's extent of protection. This interpretation has also been contested by Comviq. The Court has found that the concept had to be interpreted in accordance with the GSM standards, and that the result of such an interpretation was consistent with the invention.

There remained only the question of whether the patent claims used in Comviq's patent might be given by means of equivalence interpretation such a meaning that Europolitan's Tvilling card would fall within the extent of patent protection. Similarly to the City Court, the Supreme Court has come here to the following conclusion: "Since both the problem that the Tvilling card intends to solve and the solution of the problem differ from Comviq's inventive concept, the Tvilling card cannot be fitted into the patent's extent of protection by means of equivalence interpretation."

Comviq's claim that Europolitan had been guilty of patent infringement did not meet with success in the Supreme Court either, which upheld the Court of Appeal's verdict. The decision of the Supreme Court was unanimous.

4 Commentary

4.1 Interpretation Consistent with the Convention

The judgment of the Supreme Court is short and concise. It means that Section 39 should be interpreted in accordance with the provisions of the Protocol on the Interpretation of Article 69 of the EPC and the EPO's case law. There is very little room here for any doctrine of patent claims differing from the above. The same must be taken to apply to the interpretation of other provisions of the Patents Act, whose formulation closely corresponds to the equivalent articles of the Convention. This view may now appear as self-evident, but it is equally valuable that the Court has taken such a clear position regarding the interpretation of the Patents Act, which is consistent with the provisions of the Convention.⁷ In this way the Supreme Court has made a contribution to the harmonisation of European patent law, even though it is only the highest European court for patent disputes that can formulate a uniform interpretation of concrete cases.⁸

⁷ Accession to the EPC does not require that a given country adjusts its national laws to the Convention. By means of the EEA Agreement Sweden has, similarly to other member states of EFTA, undertaken to follow the substantive provisions of the EPC (Article 3, p. 4 p 28); see also Norberg et al, *EG-rätten i EES*, Stockholm 1994, p. 587 and 599 ff. Cf. also Godenhielm, *loc. cit.*, p. 23 and Stenvik, *loc. cit.*, p. 33. This duty of the EFTA countries has not been imposed on the member states, which is why it has been dropped as a result of Sweden's membership of the EU. Paradoxically enough, Norway, which is not a signatory of the EPC or a member of the EU, is obliged to follow the substantive provisions of the EPC, whereas Sweden and the other member states who have acceded to the EPC do not have such an obligation.

⁸ Cf. Nyberg, *Patenträttsliga bedömningsgrunder – särskilt om fackmannen*, Stockholm 2000, p. 239 and 232, and Koktvedgaard/Levin, *loc. cit.* p. 248 f. It can be mentioned that work is

4.2 *Relationship to the Swedish Supreme Administrative Court's Case law*

The Supreme Court quotes here the Supreme Administrative Court's below-mentioned statement in the plenary decision from 1990 concerning EPO's judicial practice (3.3). This statement is quoted in a moderate form, however. The Administrative Court states nothing more than that "Sweden's accession to the Convention *encourages* us to take into consideration in our internal judicial application adjudications of the EPO." (italics added)⁹ Strictly speaking, this is a truism. Another formulation in the judgement of the same court is, however, somewhat more clear: "With regard to the closely matching formulation of Section 1, subsection 2 of the Swedish Patents Act, and the corresponding provisions of the Convention, there is reason, as has been stated in the preparatory materials for the Patents Act (see, Bill 1977/78:1, Par A, p. 323) to regard the development of the case law of the European Patent Office to be of great importance." This pronouncement of the Supreme Administrative Court is rather interesting, since the current case also deals with the application of the law which has been formulated in conformance with the corresponding article of the EPC.

One can ask whether there is any discrepancy between the Supreme Administrative Court's judgment and the judgment of the Supreme Court. No such discrepancy was certainly intended. On the basis of the wording, the Supreme Court's judgement may be said to go one step further than that of the Supreme Administrative Court in as much as the Supreme Court applies directly the legal rules transpiring from the European case law and literature. The Supreme Court does not even suggest that Swedish law has any room for another interpretation. One should remember, however, that the decision of the Supreme Administrative Court is ten years old. It was then natural to express oneself with a certain dose of caution. The generally formulated statements found in the reasons for the plenary decision shall be no longer taken literally, and perhaps they would not have been interpreted so even at the time of the decision.¹⁰ It should also be noted that in a couple of reported decisions from 1998 the Supreme Administrative Court emphasised more clearly the importance of the EPO's case law. In one case concerning assessment of the degree of inventiveness the Court stated that "great importance should be attached to the development of the case law by the European Patent Office, and methods of

in progress to set up such a top instance at European level (within the framework of the EU negotiations concerning a European patent, as well as those concerning a protocol for the EPC, the European Patent Litigation Protocol).

⁹ It can be noted that the Supreme Court reports one part of the heading in RÅ when it says that the Swedish Supreme Administrative Court has decreed that Sweden's accession to the EPC "*has made it necessary*" for us to take into consideration EPO's case law. The heading used by the Swedish Supreme Administrative Court stretches clearly further than the formulation used in the reasons for the decision. The Supreme Court has chosen to quote the heading (which must be considered to have the same value as a legal source as the reasons for the decision). In a later, unreported decision delivered by the Supreme Administrative Court, the expression "makes it necessary" has been used in the reasons for the decision; RÅ, 1991, note 483.

¹⁰ The formulation of the heading (*cf.* the preceding footnote) supports this view.

determining, *inter alia*, the extent of invention.” After that the Court gave a detailed account of the aforementioned methods, without, however, using them to the full extent (RÅ 1998, ref. 55, NIR 1998, p. 745; *jordbruksvält*). In another judgment, also concerning the extent of invention, the Supreme Administrative Court argued that “the fact that the judicial practice manifested by the EPO shall be taken into consideration in the course of internal judicial application, provided it is consistent with Swedish legislation, has been demonstrated by RÅ 1990, ref. 84” (RÅ 1998, ref. 4, NIR 1998, p. 309; *vägmarkeringsremsa*).¹¹ In both these decisions the Court has gone further than in the plenary decision.¹² This course of development is a natural one in the light of the fact that national, individual solutions in the field of patent law are becoming increasingly more difficult to justify.

4.3 The Question of Interpretation in the Case

In its assessment of patent infringement the Supreme Court refers to a decision of the EPO and European literature regarding the possibility of reading into the patent claims a statement taken from the description, which does not have a counterpart in the formulation of the patent claims. The Supreme Court posits three types of criteria for such a possibility, with reference to the aforementioned decision.¹³ The Court does not discuss the judicial practice of the EPO in general or the practice of European national courts of the highest instance. Neither does it raise the question of whether Swedish law has or could have different connotation as regards this issue; The Supreme Court does not discuss the content of Swedish law regarding the central issue of this case at all.

It must be assumed that Swedish judicial practice has been more restrictive in this regard than the EPO’s practice, as perceived by the Supreme Court on the basis of the aforementioned decisions, which is why the Supreme Court’s decision has led to a certain extension of the scope of the interpretation of Swedish law. The seemingly categorical statement of the Court of Appeal

¹¹ Cf. Nöteberg in NIR 1999, p. 535 f.

¹² See also RÅ 1993, ref. 96, NIR 1994, p. 279 (Section 72 of the Patents Act), as well as RÅ 1995, footnote 389. Regarding the rulings handed down by the Patent Court of Appeal a plenary decision from 1986 concerning the so called second medical indication can be mentioned (NIR 1987, p. 248). The decision was appealed against to the Supreme Administrative Court which supported the Patent Office’s view (*see above* footnote 9, RÅ 1991, footnote 483). For further information on the Patent Court’s of Appeal views on harmonisation, refer to Törnroth, NIR 1994, p. 198 f.

¹³ The statement delivered by the Board of Appeal in opposition proceedings concerning revocation of the patent, accepted by the Supreme Court has the following wording in the original: “In the Board’s view, if the description on its proper interpretation specifies a feature to be an overriding requirement of the invention, following Article 69 (1) EPC and its Protocol, the claims may be interpreted as requiring this as an essential feature, even though the wording of the claims when read in isolation does not specifically require such feature. In the present case, the overriding requirement regarding the difference in styrene content between the two blocks is to be implied in Claim 1, and cannot therefore be ignored;” T 416/87, OJ EPO 10/1990, 415 (reasons for the decision point 5).

opposing the possibility of reading into the patent claims a statement, which has been accepted by the Supreme Court (see, 3.2 above), supports such a conclusion, which is also supported by other material, even though it may not be very clear-cut.¹⁴ The fact that Norwegian case law is more restrictive than the case law of the EPO points in the same direction.¹⁵ One of the consequences of the decision is that Swedish law has now acquired criteria determining whether interpretation of the kind in question can be allowed, at least in those cases in which the interpretation, as in this case, is supposed to restrict the extent of the patent protection.

On the other hand it remains to be seen whether the particular decision of the EPO, which the Supreme Court seems to be inclined to follow, is an expression of accepted judicial practice of the EPO. The decision is not only several years old, but it has not been confirmed by any later rulings. Neither is it self-evident that the three criteria stipulated by the Supreme Court follow from the decision.

¹⁴ Apart from the decision of the Court of Appeal no material seems to exist that would be able to elucidate the question of patent description as an aid to a more narrow interpretation of the patent claims than that following from their wording. In an interim decision handed down by the Court of Appeal on 17 January 1994 (T 513/96 case; blood bag) the Court did not reject the possibility of reading into the claims a limitation, despite the absence of any express restriction in the patent claims. To make use of this possibility it was necessary, however, according to the Court of Appeal "that in the general part of the patent description or in the patent claims as such there is a clear support for such an interpretation". When the city court tried the case anew, it clearly repudiated the position taken by the Court of Appeal in this matter. In its final trial of the case, the Court of Appeal did not consider it necessary to discuss the aforesaid question in detail. However, in the presently discussed case, the Court of Appeal has dissociated itself from the position taken by it in the interim decision in the blood bag case - in any case if the formulation of that position is to be perceived as generally applicable, and not relevant to just one case, such as the one discussed above. *Cf. also* the Svea Court's of Appeal judgement 1994-01-14 in T 7-487-9 case and T 7-301-91 case, reported in NIR 1994, p. 286 (lock construction); *also* Svea Court's of Appeal judgement 1998-04-15 in T 644-96 case, reported in NIR 1998, p. 312 (ice-breaker's stern). *See also* Westlander-Törnroth p. 276 f., p. 303 and 304 f, and p. 217 f. *Cf. Törnroth in Karnov, loc. cit.*, p. 1030. Nyberg claims that "a more careful assessment is (perhaps) necessary in the cases when the description is invoked in order to *increase* the extent of patent protection, whereas a more generous assessment may be more suitable in cases when the description is invoked in order to *restrict* the extent of patent protection" (*loc. cit.* p. 270 f.). Nyberg's point of view does not have to be generally applicable, however, for example, when the patent documents give the person skilled in the art straightforward information about how the definition of the inventive concept should be legally understood in the patent claims; *see* Westlander-Törnroth, *loc. cit.*, p. 276 and 307 and Törnroth in NIR 1994, p. 195. Grennberg presents a line of reasoning similar to Nyberg, to the extent in which reformulation of patent claims is concerned (NIR 1979, p. 51 ff.). *Cf. Godenhielm in NIR 1985, p. 15 f.* Nyberg argues that a restrictive interpretation may be suitable especially if the patent claims contain generic or functional distinctive features (*loc. cit.* 264 f., and 271 f.). The restrictive attitude towards reformulation presented in footnote 19 below can be said to support the view that interpretation of patent claims of the kind that the Supreme Court performed earlier on, has not been accepted in Swedish law.

¹⁵ "The Supreme court has however shown restraint in interpreting the patent claims in a restrictive manner, in conflict with the wording, in order to avoid such a conflict. Restraints which the patents claims does not give any basis for, appear at least to be excluded" (Stenvik *op. cit.* at 323).

In its attempt to apply the Patents Act in the way that would be consistent with the EPC (and the EPO's application of the Convention), the Supreme Court has come to the conclusion which does not necessarily conform with either the EPC or the EPO's case law. The three criteria posited by the Supreme Court cannot either be found in other adjudications of any European authority of the highest instance.¹⁶

4.4 Reformulation of Patent Claims

In numerous cases concerning inapplicability the patentee demands reformulation of the patent claims because he desires to limit the extent of protection. For a long time now this has been regarded as possible only in "quite simple cases".¹⁷ Swedish practice concerning legal reformulation is therefore more restrictive than European practice as regards this issue.¹⁸ Among other things, using statements taken from the descriptions, which do not appear in the claims, has been considered unacceptable.¹⁹ Restricting the extent of protection by way of interpretation in infringement cases or restricting it by way of reformulation in cases concerning invalidity is substantially the same. It can be argued that the effect of reformulation on third parties calls for particular watchfulness as regards their legal security. In return, a restriction made by means of interpretation does not become the object of the same publicity as do claims which have received a new wording.

From the factual point of view the difference between the two procedures is very small: on the one hand it appears to be difficult to convince the court to make a different interpretation of the same patent document in an infringement process against an alleged offender; on the other hand infringement proceedings and their outcome become always known among the affected parties of the business sector in question. Attention that ought to be paid to the legal security

¹⁶ See Domeij, "www.brandeye.se".

¹⁷ Bill 1966:40, p. 193.

¹⁸ Westlander-Törnroth, *loc. cit.*, p. 307. See also Dahlgren, *Festskrift till Bernitz*, NIR (2001), p. 15 ff. Swedish law lacks the possibility for a patentee to bring about administrative re-examination. See, however, note 21 below.

¹⁹ In a joint Scandinavian report NU 1963:6 the following has been stated on the question of reformulation: "In the event of reformulation it should therefore be impossible to bring from the description issues which do not appear in the claims." (p. 318). In Bill 1977/78:1, Part A, a few examples have been given as to what could be regarded as "quite simple". The following typical cases have been mentioned: "If (on the other hand) it is the question of getting restricting statements from the description, such practice should be limited, in my opinion, considering third parties' security in legal relations, to cases when it is the question of making a necessary qualification of an expression which *appears in the patent claims*. I consider bringing statements from the descriptions in other cases to be incompatible with the provisions of section 39 of the Patents Act concerning the extent of patent protection" (p. 266 f., italics added). A similar point of view is presented by the Patent Court of Appeal in a comment to the Stockholm City Court (T 7-123-77 case). The comment has been reported in Westlander-Törnroth, *loc. cit.*, p. 303 f. For a critical commentary on the Committees' outlook, refer to Godenhielm, NIR 1981, p. 11.

of third parties is consequently and essentially the same, and so are the restrictions that should be applied to the proceedings. The aforementioned supports in any case the view that the prerequisites for reinterpretation and reformulation are determined along the same lines.²⁰ The fact that the patent claims are maintained in the infringement case, but are given a new formulation in the invalidity case does not lead to any new conclusion; being able to foresee the patent's extent of protection in the interest of third parties is equally worthy of protection in both cases.

A less restrictive approach towards the patentee's interests concerning reformulation in a case of invalidity would thus be a logical parallel to the possibility illustrated in the infringement case to read into the patent claims a statement, despite the fact that no equivalent statement is found in the wording of the patent claims. Greater possibilities of reformulation would be desirable, since Swedish patent law would then show better conformance with European case law also in this respect. To all appearances this course of legal development is on its way. A report was submitted in April 2001, proposing that it should be possible to restrict a patent by means of administrative procedure.²¹ The proposal is based on the amendments to the EPC to the same effect, decided upon in the autumn of 2000.²² This is compounded by the fact that also judicial practice goes in the direction of a more free view regarding the prerequisites necessary for reformulation.²³

4.5 *The Principles of Interpretation of Patent Claims*

In the preparatory materials for the amendments to the Patents Act, made in 1978 in order to make Swedish accession to the EPC possible and adapt Swedish patent law to the Convention, it was argued with regard to the extent of patent protection "that the point of view represented by Swedish law in relation to the

²⁰ Is it possible that a greater possibility of reformulation by legal procedure would make us look more critically at interpretations following a more restrictive trend, for example, because reformulation would create greater precision in the form of new, publicly known requirements that would apply to everyone? No. It would mean that the patentee would be compelled to start invalidity proceedings – something that might constitute an incitement to fictitious partnerships. In addition, trying infringement and invalidity cases at the same trial may lead to waste of time and extra costs. If a possibility to try the case by administrative procedure were introduced, which could be requested by the patentee himself, the situation would be easier (see, next footnote).

²¹ See Report on the Patent Proceedings Inquiry SOU 2001:33 (recommended sections 40 a-e of the Patents Act). Cf. the Patent Office's submission, 1998-01-09, in which the Office proposed that a possibility of restricting a patent by administrative procedure should be created.

²² See Basic Proposal (footnote 4), p. 195 ff., with proposals of amendments to Article 138, and EPO's home page "www.european-patent-office.org".

²³ Dahlgren discusses two rulings of the City Court, showing this tendency (*loc. cit.* p. 18 f., with references). The rulings have been appealed against, so that it remains to be seen whether the Court of Appeal will accept the legal trend propagated by the District Court. Cf. also SOU 2001:33, recommended provisions of section 52, subs. 2 the Patents Act.

issue of interpretation is in conformance with the wording of Article 69 of the European Patent Convention and does not conflict, in principle, with the provisions of the pertinent Protocol on the interpretation of Article 69 of the Convention regarding the interpretation of this Article” (Bill 1977/78: Part A, p. 303).²⁴ The above-mentioned approach was not self-evident, however. Among other things, a more restrictive view of the importance of the description was recommended in the preparatory materials for the Patents Act, and similar viewpoints were advanced in the literature.²⁵ Despite that, nobody seems to maintain nowadays that Swedish judicial practice is not in line with the Protocol.

Another issue is the question of the principles underlying the statement that Swedish patent law practice does not conflict with the Protocol. In other words, what is the actual subject matter of the “patent claims doctrine”? The Supreme Court does not make any explicit pronouncement on this issue, but The Svea Court of Appeal, which did not see any reason to make statements on matters of principle in the current case, has presented its views on the matter in a number of judgements in a very informative way.²⁶ Based on the aforementioned judgements and other material the applicable law can be described in the following way.

It is the way in which a person skilled in the art construes the patent documents which is decisive for the interpretation, and here the patent claims are of central importance. The patent claims shall not be interpreted literally - the interpretation must take into account the inventive concept which can be understood from the claims and the description. The inventive concept constitutes a framework and a context for the interpretation which must conform with that concept. The description may also indicate how to interpret the patent in a different way. For example, records of the application procedure may fulfil such a function. The state of the art of technology on the date of the application – whether the patent documents reveal it or not – provides also guidelines for the interpretation and imposes restrictions on the conceivable extent of protection. The final interpretation must not produce a result – whether more extensive or more restricted – than that which the person skilled in the art had reason to expect on the basis of the above-mentioned circumstances.²⁷

²⁴ See also p. 141 f. of the Bill. The minister supported the point of view of the Committee on patent policies; see *Internationellt patentsamarbete II, 1973 års europeiska patentkonventionen* 1973, SOU 1976:24, p. 191.

²⁵ Cf. references below in footnote 30.

²⁶ Of the more recent judgements, see T 644-96 case, Judgement 1998-04-15, in NIR 1998, p. 312 (ice-breaker’s stern), and T 198-98 case, p. 4 f., Judgement 1999-10-05 (fastening device).

²⁷ A few more extensive interpretation doctrines than the one presented here have also been forwarded. Godenhielm proposes such a doctrine in his publication from 1994, and Törnroth seems to support this point of view in his perception of applicable law. Törnroth, who has analysed the problem area in his dissenting opinion concerning one of the aforementioned judgements (fastening device; see previous footnote) argues that Godenhielm’s view of the extent of patent protection is in keeping with Swedish law: “It should be mentioned that Swedish practice, as discussed in Westlander, 1995, is essentially consistent with the interpretation principles advocated by Godenhielm” (Karnov, *loc. cit.* p. 1030). Cf. Berndt Godenhielm, *Patentskyddets omfattning i europeisk och nordisk rätt*, Helsingfors 1994. See

The judgment of the Supreme Court has not undermined the principles of the interpretation of patent claims presented here. Even though the Supreme Court allots the description a primary place, it should be noted that it is only under limited conditions that a statement may be taken from the description if it lacks the equivalent in the wording of the patent claims.²⁸ It is a mistake to recognise patent claims which are so unclear that their interpretation has to be based on a statement taken from the description, which has not equivalent in the claims.²⁹ It is only natural that the scope for rectification of such mistakes by means of interpretation with the help of judicial procedure is restricted.

The Court does not make any general statements concerning the relationship between claims and description, and does not change the balance between the two. Nevertheless, it paves the way for a somewhat less constrained view of this relationship, making it possible for the description to acquire slightly greater importance than before, as long as it is in line with the provisions of the Protocol and the EPO's practice. In each individual case a separate assessment must be made so that third-party interests are not infringed upon.

It is also possible that the judgment of the Supreme Court does not really entail any significant deviation, since the courts' interpretation practice regarding the use of description has not probably been as restrictive as has often been maintained.³⁰ It is probable that also in patent cases the judges are influenced in reality by the non-formalistic view of interpretation, which is so characteristic of the Swedish legal method, due to the fact that an overall assessment is used as a basis of interpretation which is performed in a pragmatic way in order to obtain a well-balanced result.³¹

also Westlander-Törnroth who explain the importance of the inventive conception (*loc. cit.*, p. 281. Koktvedgaard, a supporter of an extensive doctrine, points out the importance of an overall assessment, on the other hand; *See* Koktvedgaard-Østerborg, *Patentloven*, Köpenhamn 1979, p. 217 f., and Koktvedgaard, *Lærebog in Immaterialret*, Köpenhamn 1999, p. 234 ff. It must be pointed out, however, that despite the extensively diverse formulations, the differences between the viewpoints mentioned above are relatively small from the factual point of view, which is why it is difficult to evaluate them.

²⁸ It can be mentioned here that in a decision of the EPO, the Board of Appeal argued that it had to be possible to make out the claims without having recourse to the description (T 2/80, PJ 1981, 431). As can be seen, this statement was made a long time ago, and it is not clear whether it would hold now in view of the decision of the EPO quoted by the Supreme Court, but it reminds us, nevertheless, of the importance of not drawing too far-reaching conclusions from the decision and the Supreme Court's judgment.

²⁹ *See* Domeij, "www.brandeye.se".

³⁰ *See* explanatory statements in the next section (4.6), Borggård in SvJT 1972, p. 474 ff., and Ugglå in NIR 1982, p. 53 ff. *Cf.*, however, Jacobsson-Tersmeden-Törnroth, *loc. cit.*, p. 264, Sandgren in SvJT 1982, p. 314 f., and Godenhjelm, *loc. cit.* (footnote 4) p. 229 f.

³¹ *See* Sandgren JT 1999-2000 p. 873.

4.6 Relevance of Explanatory Statements

The Supreme Court maintains that earlier statements in the preparatory materials (travaux préparatoires) for the Swedish Patents Act can no longer be considered as relevant in so far as they conflict with the provisions of the Protocol. The Supreme Court does not refer to any particular statements of this kind, but a few can be noted below.

A statement appeared in Bill 1966:40 (section 39 was not amended in the legislative provisions from 1978), stipulating that: “To the extent in which a description and drawings are made use of for the sake of interpretation, this should be done only in order to provide the necessary clarification of the terms used in the patent claims” (p. 151 f.). It is questionable whether the courts accepted this pronouncement even at the time it was made, i.e. before the promulgation of the Protocol. In any case, the statement is no longer valid.³²

A couple of other questionable statements were made by the minister in connection with Sweden’s accession to the EPC. The minister delivered the following statement: “For my part I would like to emphasise the importance that the patentee may not exploit any ambiguities in the patent claims in order to extend the patent protection” (1977/78:1 Bill, part A, p. 303). This statement cannot either be easily reconciled with the Protocol³³, or with the Supreme Court’s judgment. The same applies to the strict view of the patent claims: “There (in Section 39) the patent claims have been (namely) given the major importance as regards determination of the extent of patent protection. The description may be used only as a guideline in order to understand the patent claims.”³⁴

It is uncertain whether there are prerequisites for any analogy with the statements concerning reformulation. Such analogy would mean that the judgment has been passed for the benefit of re-examination of the palpably restrictive attitude presented above.³⁵ The Supreme Court had no reason to examine this question. Taking into consideration the close correspondence between the two proceedings – concerning the objective and the interests worthy of protection – some sort of analogy of this kind would be justified, however.³⁶ This is reinforced by the fact that Swedish judicial practice would become more consistent this way with European practice.

³² Even though the above-mentioned judgments of the Court of Appeal from 1998 and 1999 (see footnote 26) seem to illustrate it, one should note that the judgment of the Court of Appeal in the case at hand somewhat surprisingly upheld the aforementioned formulation used in the 1966 Bill; see section 3.2 above (“... but a description and drawings ... the patent claims”) Cf. Godenhielm, *loc. cit.*, p. 228 ff, and Nyberg *loc. cit.*, p. 230 and 232.

³³ Jacobsson-Tersmeden-Törnroth *loc. cit.*, p. 258 and Domeij *loc. cit.*, p. 482 f. Cf. Westlander-Törnroth, *loc. cit.*, p. 281 whose views have been questioned by Nyberg, p. 270.

³⁴ Bill 1977/78:1, Part A, p. 267.

³⁵ See the Minister’s statement (preparatory materials for 1977-78 legislation) reported in Footnote 19 above.

³⁶ Cf. the arguments propounded in Section 4.4. above.

4.7 *Ambiguous Argumentation*

Having stated, *inter alia*, that Sweden is one of “those countries which have not only become signatories to the Convention, but have also adapted their patent law to it”, the Supreme Court draws the following conclusion: “It seems to be hardly meaningful to determine a patent’s extent of protection in different ways, depending on whether the patent has been granted on the basis of a national application to the Swedish Patent and Registration Office or on the basis of a European patent application to the EPO, embracing Sweden, in which case the patent has the same legal effect in Sweden as any national patent.”³⁷

This pronouncement is not easy to understand, since the patent’s extent of protection shall not be determined in different ways, depending on the procedure – Swedish or European – which has led to the granting of the patent. Such a difference would be incompatible with the structure of the European patents system (Article 2 and 64) and Section 81 of the Patents Act which stipulates that a European patent shall have the same legal effect in Sweden as a patent granted in this country, and that it shall otherwise be subject to the same conditions as such patent. An alternative interpretation would be to perceive the pronouncement as a wish to stress that interpretation of patent claims by Swedish courts does not differ from EPO’s interpretation. Understood in such a way, this line of reasoning would be justifiable.

³⁷ The Supreme Court has taken its statement almost word by word from Godenhielm, *loc. cit.*, (Footnote 4), having formulated it in the following way: “For the countries which have both adapted their patent laws to the European Patent Convention and become signatories to the Convention – such as Sweden – it cannot be meaningful to determine the patent’s extent of protection in different ways, depending on whether the patent has been granted by the national patent office or by way of a European patent application.” (p. 171).