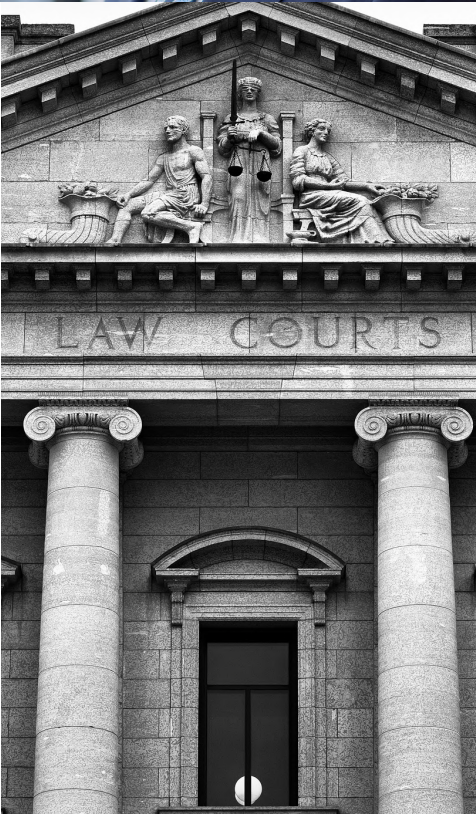


CASE COMMENT

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UPC PROCEEDINGS: MUNICH LOCAL DIVISION SHARPENED PRINCIPLES OF PATENT CLAIM CONSTRUCTION

On 20 December 2023, the Munich Local Division issued its decision in *SES-Imagotag v. Hanshow* ([UPC CFI 292/2023](#))*, which for the first time addressed fundamental issues of claim construction before the UPC.

In particular, the court addressed the question of whether the wording of the patent claim as originally filed could be used as an aid to construe a patent claim in the event of subsequent amendments during the prosecution proceedings. The Munich Local Division held that “the wording of the patent claim as filed can be used as an aid to construe the granted patent claim in conjunction with amendments made during the prosecution proceedings.”

SES-Imagotag (the patentee) had applied for preliminary measures against several Hanshow group members, claiming that the electronic labels for product and price labelling offered by the defendants infringed its European patent EP 3 883 277. The Munich Local Division, however, rejected the application for preliminary measures as it was not convinced that the contested embodiments implemented the patented teaching.

The key issue in the case was how to construe certain features of the patent claim regarding the location of a printed circuit board (PCB) and an antenna. The patent claim required the circuit board to be located “on the rear surface of the housing” and the antenna to be located “on or in the housing on the side of the front of said electronic label”.

The patentee argued that the claim did not require the PCB to be in contact with or mounted on the housing. With respect to the antenna, the patentee further argued that it is not required that the antenna be located in front of all other features of the electronic label, such as the display screen.

The defendants, in contrast, took the position that the wording of the patent claim clearly required the PCB to be technically and functionally aligned with the back of the housing. Regarding the antenna, the defendants argued that it was a core aspect of the invention to avoid additional elements between the antenna and the front surface in order to achieve an optimal wireless connection.

The Munich Local Division did not follow the patentee’s claim construction. Firstly, the Court found that the features in question should be interpreted together as the technical purpose was to regulate the technical interaction of the PCB and the antenna by the spatial arrangement of both components.

In addition, the Court referred to the wording of the patent claim as originally filed, according to which the chip on the printed circuit board and the antenna are to be placed at a distance from each other. This wording was no longer included in the granted patent claim but specified during the prosecution proceedings by including the features in question.

In view of the wording of the claim as filed, the Court concluded that the patent claim had to be interpreted as requiring that the PCB and the antenna be placed “diametrically” opposite each other. Furthermore, the skilled person understands that the whole of the PCB must be located at the rear side of the housing and the whole of the antenna must be located on or in the housing on the front side. Since it had not been shown that the features so understood were implemented by the contested embodiments the court dismissed the application for preliminary measures.

The relevance of the prosecution file in claim construction is a matter of debate in various UPC member states.

According to the German case law, it is not permissible to refer to events in the prosecution proceedings for the interpretation of a patent if they are not reflected in the granted patent. However, the German Federal Court of Justice has left open whether these principles also prohibit recourse to patent publications such as the officially published patent application or earlier versions of the patent which have been subsequently amended, if the content of the patent as granted is only apparent from a comparison with these. In other UPC member states as France, Belgium and the Netherlands, courts have taken a different approach and relied on the prosecution file for questions of claim construction.

The Munich Local Division has now taken a clear position in this regard stating that the original version of the claim can generally be used as an aid in construing a patent claim in view of amendments during the prosecution proceedings.

An appeal against the decision has been lodged on 4 January 2024. It will be interesting to see how the Court of Appeal deals with the general issues of patent interpretation raised by the Munich Local Division.

*Find [here](#) an English translation of the decision by the court.

