

# EIP



## If you claim 'a duck', does it have to quack? - Construction of technical terms

### Introduction

It is said that 'if it walks like a duck, and quacks like a duck, then it probably is a duck'. However, if a claim refers to 'a duck' feature, what does that imply about how the claimed feature walks or quacks?

In two cases involving the same parties relating to patents said to be essential to 3GPP standards, the claims defined features using terms that already had some technical connotations. The judge was required to determine the extent to which those technical connotations affected the scope of the claims.

### Claim construction

A claim term can be a 'term of art' if it has a special (and unambiguous) meaning, in the relevant field, at the priority date[1]. However, there is often disagreement about the meaning of a term (e.g. [2], [3]) in which case purposive ('normal') construction must be carried out to determine the scope of the claim.

In the first case [4], the claim referred to

"transferring....information....based on pilot symbols".

At issue were the limitations implied by the use of the term 'pilot symbols'. Pilot symbols were known to have certain properties which made them particularly useful for certain functions. One of these functions was to allow a receiver to determine a channel quality.

The defendants argued that 'pilot symbols'

"must be understood as referring to something which is used for not only [transferring information] but also for its conventional purpose of channel quality determination".

This reasoning was based on the manner in which the patent described the invention and contrasted it with known ways in which pilot symbols were used. For example, the patent noted that in the prior art, pilot symbols 'are transferred for the only purpose of channel conditions determination'. A benefit of the invention was said to be that "as the signals representative of pilot symbol patterns convey another information, the resources of the telecommunication network are used efficiently."

On this, the judge concluded that the skilled person would understand that while the pilot symbols must be capable of being used for channel quality determination, it was not necessary that they are in fact used for this purpose. If such a limitation were to exist, "the skilled person would expect the claims to have said so". On this construction, a prior art message which was not suitable for channel quality determination did not fall within the scope of the claim.

The judge found the patent essential to a communications standard in which pilot symbols were used, but not for channel quality determination.

In the second case [5], the claim referred to:

"a length indicator for indicating [purpose 1]"

'purpose 1' did not relate to indicating a length, and there was no explicit requirement in the claim that the 'length indicator' had to be able to indicate a length.

As in the first case, the invention centred on the use of a known feature (in this case, a 'length indicator') for a further or different purpose.

In the prior art (acknowledged in the patent) was an indicator which could be used for a purpose very similar to 'purpose 1', but could not indicate length.

The judge considered that the term 'length indicator' was used specifically to exclude this prior art, because the patentee could have omitted the word 'length' otherwise:

136. ...This helps to show that the term 'length indicator' was used in claim 1 as granted to exclude the [prior art indicator], there being no other words in the claim which could perform that role. ...

137. ...Accordingly, I find that to fall within the term 'length indicator' in the Patent, the field in question must be capable of [indicating length], even if certain values are capable of being used to [perform purpose 1]. If the field in question is not so capable, then in my

judgment, it is not a 'length indicator'.

p3

This construction meant that the alleged infringement (which did not perform the function of a length indicator) fell outside of the scope of the claim, on normal construction.

The judge also found no infringement under the doctrine of equivalents. Applying similar reasoning to the third Actavis question [6], he held that the patentee intended strict compliance with the claim scope in order to avoid the prior art: "Otherwise the claim would be invalid".

## **Analysis**

These cases give useful insight into how the scope of a claim may depend on how the invention is framed in the specification.

When claims are drafted using existing technical terms, it is important to consider characteristics that may be understood by the skilled person as implicit in such terms, and how these terms are used in the specification (see also [7]). Unless, of course, your invention always walks and quacks like a duck!

[1] *Qualcomm v Nokia* [2008] EWHC 329 (Pat) at 9

[Qualcomm Incorporated \(A Delaware Corporation\) v Nokia Corporation \(A Finnish Company\) \[2008\] EWHC 329 \(Pat\) \(03 March 2008\) \(bailii.org\)](#)

[2] *TQ Delta v ZyXEL* [2019] EWHC 562 (Ch) at 72-78

[TQ Delta, LLC v ZYXEL Communications Ltd & Anor \[2019\] EWHC 562 \(Ch\) \(11 March 2019\) \(bailii.org\)](#)

[3] at 96

[Moelnlycke Health Care AB v Brightwake Ltd \(t/a Advancis Medical\) \[2011\] EWHC 376 \(Pat\) \(25 February 2011\) \(bailii.org\)](#)

[4] *Mitsubishi Electric Corporation & Anor v Archos SA & Ors* [2021] EWHC 1639 (Pat)

<https://www.bailii.org/ew/cases/EWHC/Patents/2021/1639.html>

[5] [Mitsubishi Electric Corporation v Oneplus Technology \(Shenzhen\) Co, Ltd & Ors \[2021\] EWHC 1048 \(Pat\)](#)

[6] *Eli Lilly v Actavis UK Ltd & Ors* [2017] UKSC 48 at 88

Eli Lilly v Actavis UK Ltd & Ors [2017] UKSC 48 (12 July 2017) (bailii.org)

p4

[7] Bringing sufficiency within range: Birss J recasts the Regeneron principles for process claims, EIP | Patent Attorneys and Litigators