EIP

UPC Court of Appeal Confirms no Provisional Injunction for VusionGroup

VusionGroup SA (formerly SES-imagotag SA) v Hanshow UPC_CoA_1/2024

Order of 13 May 2024 (ORD_17447/2024)[1]

SES-imagotag SA, which in the meantime has changed its name to VusionGroup SA, was refused a provisional injunction by the Munich local division in relation to certain electronic labels sold by various companies in the Hanshow group.[2] The Munich panel was not convinced that the patent EP 3883277 (which was separately subject to a revocation action at the Paris central division filed by Hanshow Germany) was actually infringed by the accused products.

The point of dispute was whether the Hanshow products had the circuit board and the antenna arranged in the case of the electronic label as required by Claim 1 of the patent, which specifies (underlining added for emphasis):

- a printed circuit board (35) housed in the case (30) on the side of the back of the case;
- the electronic chip (37) of the radio frequency device being disposed on the printed circuit board (35);
- the antenna (38) of the radio frequency device being disposed on or in the housing on the side of the front of said electronic label

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The first instance decision had notably considered an amendment to the claim made during prosecution of the application at the EPO, where claim language (considered unclear by the EPO examiner) stating that the chip was placed "at a distance" from the antenna had been replaced by a limitation on the antenna, as set out above.

The Court of Appeal reiterated the fundamental principles of claim construction that it had set out in the 10x Genomics v Nanostring case[3], emphasising that "The patent claim is not only the starting point, but the decisive basis for determining the protective scope of the European patent", but also that "the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim". Here, no mention is made of the use of prosecution history.

Interpreting the above listed features in the context of the totality of the claim and the description, the Court of Appeal concluded that the claim excludes that the circuit board and the antenna are positioned in the same plane – it requires that the antenna is positioned more towards the front of the electronic label than the circuit board. The Court of Appeal considered that the claim also requires that that the antenna is not placed behind the display screen.

Reviewing the Hanshow products, the Court of Appeal observed that the antenna is positioned behind the display screen, and that the antenna is not positioned more to the front of the electronic label than the printed circuit board. Therefore, like the first instance tribunal, the Court of Appeal concluded that the claim was not infringed. Therefore, the refusal of the provisional injunction was affirmed.

The judgment states that the interpretation of the claims was reached without having regard to the prosecution history of the patent. It then however immediately goes on to say that "The parts of the European Patent Office examination file cited by the parties do not shed any new light on this interpretation. Therefore, the Court of Appeal in this case does not need to address the question whether the prosecution history can be taken into account when determining the scope of protection of a European patent." Accordingly, while not employed in this case, and not listed in the principles for claim construction to be adopted by the UPC, the Court of Appeal has not excluded that in a future case it might decide to take prosecution history into account.

[1] https://www.unified-patent-court.org/en/node/717

[2] Reported here https://eip.com//knowledge_hub/article/upc_declines_to_grant_provisional_injunction/

and in more detail here

https://eipamar.com/en/knowledge_hub/article/claim_construction_at_the_upc/

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[3] Reported here

https://eipamar.com/en/knowledge_hub/article/why_did_the_court_of_appeal_reverse_the_local_division