

**AMENDMENT OF PATENT CLAIMS
IN REVOCATION PROCEEDINGS**

The Netherlands

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Introductory remarks (1)

- Usefulness of comparative approach:
 - Inspiration
- Usefulness of comparative approach in Europe:
 - Harmonisation of laws
 - Unification of laws
 - Level playing field

Introductory remarks (2)

Legal instruments:

- Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention (1963)
- European Patent Convention (Munich 1973)
- Community Patent Convention (Luxembourg 1975/1989)
- Proposal for a Council Regulation on the Community patent (2003)

Introductory remarks (3)

From an economic perspective the ideal situation of patent law in Europe is:

no differences as to:

- Substantive law
- Procedural law
- Quality of courts

Netherlands before EPC 2000 (1)

- Partial revocation was possible under the Dutch Patent Act (1910)
- Partial revocation necessarily implies the amendment of the claims
- There were no special provisions as to how one should proceed and what conditions should be met

Netherlands before EPC 2000 (2)

In 1987 the Patent Act was amended. The following grounds for revocation were introduced:

- *if the subject-matter of the patent extends beyond the content of the application as filed (...)*
- *if the protection conferred by the patent has been extended.*

Netherlands before EPC 2000 (3)

These new grounds for revocation correspond to those that are mentioned in Article 138(1)(c) and (d) EPC.

These grounds contain conditions for amending the claims.

Supreme Court *Spiro v. Flamco (1996) (1)*

The Supreme Court formulated very strong conditions for amending the claims.

Supreme Court
Spiro v. Flamco (1996) (2)

The most difficult conditions to meet were:

- The amendment should have been obvious to the average person skilled in the art on the basis of the patent as granted and the prior art at the priority date;
- On the same basis the average person skilled in the art should also have realised, that only the amended patent should have been granted and that this amended patent was valid.

Supreme Court
Spiro v. Flamco (1996) (3)

The Supreme Court did not take into account:

- the new grounds for revocation in the Patent Act derived from the EPC
- the European practice

Effects of *Spiro v. Flamco*

- This decision has led to a lot of confusion and uncertainty.
- Patents were revoked while they might have been maintained in an amended form.

EPC 2000

Situation as of 13 December 2007 (1)

District Court 2008 (*Boston Scientific v. Expandable Grafts*):

The *Spiro v. Flamco* doctrine is 'no longer' applicable to European patents as of 13 December 2007

EPC 2000

Situation as of 13 December 2007 (2)

Supreme Court 2009 (*Boston Scientific v. Medinol*):

“Whether the Dutch part of a European patent should be revoked (in whole or in part) in accordance with the provisions of Article 138 (EPC) should be assessed by the court with due observance of the provisions of this revised Convention and the corresponding Implementing Regulations.”

Discussion (1)

The *Spiro v. Flamco* doctrine has always been wrong. As to European patents:

- the doctrine was not in line with the EPC. The interests of patentee and third parties is warranted by Article 123(2) and (3) EPC.
- There is no room for extra requirements at the national level.

Discussion (2)

As to Dutch patents:

Since it has always been the clear intention of the legislator to harmonise and unify patent law in Europe, it is wrong to make a distinction between national and European patents in this respect.