

# AMENDMENT OF PATENT CLAIMS IN REVOCATION PROCEEDINGS

## THE NETHERLANDS

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### Introduction

It is an excellent idea to bring together practitioners from different EPC Contracting States to discuss patent issues. In Europe patent law is to a far extent harmonised and even unified.

I mention:

- 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)
- EEC Regulation 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products EC Regulation 1610/96 of 23rd July 1996 concerning the creation of a supplementary protection certificate for plant protection products
- Proposal for a Council Regulation on the Community patent (2003)

The aim of these legal instruments is the harmonisation and unification of the applicable national laws. As we all know the harmonisation and unification of the laws does not automatically result in the harmonised and unified application of the laws. It is the task of the judiciary with the support of the practitioners to create the result desired by the legislators. Ideally, in the desired situation, it should not make any difference whether a dispute on a certain infringement or the validity of a patent will be decided in Sweden, Germany or the UK.

Despite all these legal instrument there still exist not inconsiderable differences in practice. In the end these differences are neither in the interest of the patentee, nor in the interest of the alleged infringers. A European Court that could put an end to these differences is missing. It is not likely that such a court will be created soon.

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The topic of this seminar is interesting. I am afraid it will make clear that there is, or at least was, a discrepancy between ideal and reality, in any case with regard to the Netherlands.

I will picture the situation in my country before the entering into force of EPC 2000 on 13 December 2007 and after that date.

### **Situation before 13 December 2007**

It seems sensible to deal with the situation as of 1977 until 2007. In 1977 the EPC entered into force and in relation to that crucial event in patent law in Europe the Dutch Patent Act was amended. The EPC was implemented in the Act.

#### *The Patent Act*

Before 1 December 1987 it was possible to amend or supplement applications.<sup>2</sup> The law did not contain any rules on the boundaries for these amendments. The *Hoge Raad* (Supreme Court) decided in 1946 that it followed from the system of the law that eventually no patent may be granted for a substantially broader or different invention than is embodied in the application.<sup>3</sup> According to consistent case law of the *Afdeling van Beroep* (Board of Appeal) of the Dutch Patent Office the application as filed was decisive for the scope of the exclusive right to be granted: amendments of the application therefore had to be covered by the content of the original application.<sup>4</sup> Extension of the invention was not allowed.<sup>5</sup>

At that moment the Dutch Patent Act did not yet contain a provision on amending of the patent after grant. However, partial revocation was possible. Article 51 of the Dutch Patent Act reads: '*A patent shall be nullified insofar as ...*'. Partial revocation implies the amendment of the patent.

On 1 December 1987 the Dutch Patent Act was amended. In Article 51 Dutch Patent Act 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.

<sup>2</sup> Article 23(2) Dutch Patent Act 1910.

<sup>3</sup> 17 October 1946, *Nederlandse Jurisprudentie* 1947, 33.

<sup>4</sup> 16 December 1983, *Bijblad bij de Industriële Eigendom* 1984, p. 244; 19 July 1985, *Bijblad bij de Industriële Eigendom* 1987, p. 76.

<sup>5</sup> In 1974 this was still allowed: *Afdeling van Beroep* 28 October 1974, *Bijblad bij de Industriële Eigendom* 1975, p. 26. Critical about this practice was W. Neervoort, *IIC* 1989, p. 320.

These grounds for revocation correspond to those that are mentioned in Article 138(1)(c) and (d) EPC. Amendments to the claims should comply with these conditions. Otherwise the patent could be partially revoked. In the Dutch Patent Act there is no difference between patents granted by the Dutch Patent Office and patents granted by the European Patent Office in this respect.

#### *Case Law*

There is not much case law with regard to partial revocation. In the case that would lead to the controversial *Spiro v. Flamco* decision of the Supreme Court,<sup>6</sup> the District Court was of the opinion that an amendment after grant of the Dutch patent was only acceptable if the scope of protection was limited and the subject-matter was not changed.

However, the Supreme Court formulated extra requirements in this case. It was of the opinion that a limitation of a patent by amending the claims, description or the drawings was only admissible

*“if it is sufficiently clear to the average person skilled in the art examining both the patent specification and the prior art on the priority date what protective boundaries are offered by the patent, to the extent the patent is valid. This does not only require that an addition to the patent specification can afterwards be formulated in order to draw sufficiently clear boundaries, but also that this is an addition that was sufficiently obvious to the average person skilled in the art prior to that addition to independently arrive at the conclusion, based on the content of the patent specification in correlation with the prior art on the priority date, that the patent should only have been granted with the limitation contained in that addition and that it was therefore valid within the stricter boundaries that can be deduced from that addition. It must also be sufficiently clear to the average person skilled in the art that the addition only limits the existing patent and does not lead to a different patent than the one whose revocation is being sought.”*

The Supreme Court based these requirements on its interpretation of the provision on the scope of protection in the Dutch Patent Act.<sup>7</sup> This provision was introduced in the Dutch Patent Act in 1977 because of the entering into force of the EPC. The provision is the equivalent of Article 69 EPC. The Protocol on the interpretation of Article 69 EPC is restated in the Offi-

<sup>6</sup> Hoge Raad 9 February 1996, *Nederlandse Jurisprudentie* 1998, nr. 2; *Bijblad bij de Industriële Eigendom* 1996, 334.

<sup>7</sup> Hoge Raad 13 January 1995, *Nederlandse Jurisprudentie* 1995, 391; *Bijblad bij de Industriële Eigendom* 1995, p. 333 (*Ciba Geigy v. Oté*).

cial Memorandum. In the Dutch Patent Act no distinction is made between the determination of the scope of protection of a Dutch and a European patent.

Unfortunately, the Dutch Supreme Court generally is sparing with its reasoning. The decisions are often rather categorical. The Court seldom explains why its view is preferable to - for instance - the opinions of foreign courts. There is no debate with legal literature. In that respect there is a big difference with the decisions of English and German courts.

In *Van Egmond v. Wiva*<sup>8</sup> the Supreme Court was of the opinion that the *Spiro v. Flamco* requirements also applied to European patents. No word was said about Article 123(2) and (3) and about Article 138(1)(c) and (d) EPC. The Court mentioned Article 138(2) EPC but it is unclear why it did so.

Especially the requirement that for an amendment to be acceptable it is necessary that the amendment was sufficiently obvious to the average person skilled in the art prior to that amendment to independently arrive at the conclusion, based on the content of the patent specification in correlation with the prior art on the priority date, that the patent should only have been granted with the limitation contained in the amendment and that it was therefore valid within the stricter boundaries that can be deduced from that amendment, caused uncertainty. The formulation of the requirement is rather complicated. Let me try to simplify it somewhat by splitting up the sentence in two:

- (i) 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;
- (ii) 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.

A commentator (Prof. Verkade) assumed that this requirement would seldom be met. It turned out that he was right.

The *Spiro v. Flamco* decision in 1996 has led to a lot of confusion and uncertainty. Patents were revoked while they might have been maintained in an amended form. In *Boogaard v. Installerende Partners*<sup>9</sup> the Supreme Court did not quash the decision of the Court of Appeal that the mere fact that four alternative limiting claims were proposed to substitute the overbroad claim demonstrated that the amendments were not sufficiently clear to

<sup>8</sup> Hoge Raad 16 February 2001, *Nederlandse Jurisprudentie* 2001, 393; *Bijblad bij de Industriële Eigendom* 2002, p. 156.

<sup>9</sup> Hoge Raad 21 February 2003, *Bijblad bij de Industriële Eigendom* 2004, 183.

the average person skilled in the art prior to that amendment to independently arrive at the conclusion, based on the content of the patent specification in correlation with the prior art on the priority date, that the patent should only have been granted with the limitation contained in the amendments and that it was therefore valid within the stricter boundaries that can be deduced from these amendments. In the case *Parteurosa v. Fokker*<sup>10</sup> the Court of Appeal was of the opinion that some claims of the European patent were invalid. Nevertheless it revoked the patent in its entirety because the (amended) subclaims related to different subject-matters and the person skilled in the art could not have foreseen at the priority date how eventually the claims would have been drafted.

#### *Literature*

The *Spiro v. Flamco* doctrine was criticised by several authors.<sup>11</sup> The main objection was that this doctrine was not in line with the EPC.

#### **Situation after 13 December 2007**

##### *Case Law*

Before the entering into force of EPC 2000 the District Court of The Hague had already demonstrated it did not agree with some of the opinions of the Court of Appeal. In its decision of 8 October 2008 in the case *Boston Scientific v. Expandable Grafts* the District Court clearly expressed its reasoned view that the *Spiro v. Flamco* doctrine was ‘no longer’ applicable on European patents as of 13 December 2007.

In the case *Boston Scientific v. Medinol* the Supreme Court<sup>12</sup> realised that the *Spiro v. Flamco* doctrine could not be maintained with regard to European patents after EPC 2000 had entered into force:

*“5.4.1. As also explained in 2.2-2.3 and 2.6-2.7 of the advisory opinion of the Advocate-General, the provisions in Article 138 of the EPC were substantially amended as per 13 December 2007.*

*It follows from the travaux préparatoires that the purpose of that amendment is to explicitly lay down in the Convention that a patent*

<sup>10</sup> Hof Den Haag 24 March 2005, *Bijblad bij de Industriële Eigendom* 2006, nr. 8.

<sup>11</sup> Jan Brinkhof in his annotation to the Supreme Court’s decision in *Bijblad bij de Industriële Eigendom* 1996, p. 347; J. den Hartog, *Partiële nietigheid van een octrooi: kanttekeningen bij Spiro Research / Flamco*, *Bijblad bij de Industriële Eigendom* 1997, 27; F.N. Ferro, *Spiro-Flamco strijdig met EOv?*, *Bijblad bij de Industriële Eigendom* 2004, p. 51; E.H. Visscher, *Wijziging en gedeeltelijke nietigheid van octrooien: van Spiro/Flamco naar de ontwikkeling van Europese maatstaven*, *Bijblad bij de Industriële Eigendom* 2008, p. 4. Verkade had another view.

<sup>12</sup> Hoge Raad 6 March 2009.

holder is entitled to limit a European patent in national proceedings regarding that patent's validity (Article 138(3) of the EPC 2000). Pursuant to the new Convention provision, the revocation of a European patent is no longer subject to further conditions derived from national law. Contrary to the provision of Article 138(2), second sentence, of the EPC – which sentence was removed when the Convention was revised – a European patent may only be limited in the form of an amendment of claims proposed by the patent holder, after which the patent thus amended forms the basis for the further proceedings. If the court considers that limitation insufficient to protect the patent from revocation, it is entitled to further limit the patent (see the Explanatory remarks on the Basic proposal for the revision of the EPC dated 13 October 2000, MR/2/00, pp. 199-202).

Against the background of this amendment to harmonise the regulations for the revocation of European patents by national courts on the basis of Article 138 of the EPC 2000, which Convention provision has immediate effect pursuant to Article 8 of the EPC Revision Act and has been declared applicable with retroactive effect to the European patents granted before 13 December 2007 in Article 1.2 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000, the Supreme Court holds that the application of the standard from its judgment dated 16 February 2001<sup>13</sup> – referred to above in 5.3.2 – for the assessment of the (partial) revocation of the Dutch part of a European patent cannot be reconciled with Convention law applicable as per 13 December 2007. Whether the Dutch part of a European patent should be revoked (in whole or in part) in accordance with the provisions of Article 138 should be assessed by the court with due observance of the provisions of this revised Convention and the corresponding Implementing Regulations.

#### Literature

Several authors have already applauded the decisions of the District Court and the Supreme Court. Some wonder whether the same approach should also be followed as to Dutch patents.

#### Discussion

In my view the *Spiro v. Flamco* doctrine has always been wrong. As to European patents it 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

<sup>13</sup> In the case *Van Egmond v. Wiva*, mentioned above.

room for extra requirements at the national level. The Supreme Court ignored this.

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.