

Amendment of patent claims in revocation proceedings before civil courts in Sweden– prior to and after implementation of EPC 2000

- *Örjan Grundén, senior counsel Bird & Bird,
Stockholm*

THE SITUATION PRIOR TO 2007

No difference between EP and national patent

No administrative limitation procedure

Revocation actions before civil courts

Limiting amendment possible in partial revocation

-dependent claims

-rewording (omformulering) of granted claims

only in quite simple cases

e.g. defining more accurately a feature in a claim

reintroducing a disappeared feature

deleting an alternative

THE SITUATION FROM 1 July 2007

Implementation of Article 138(3) EPC 2000 by an explicit corresponding provision

- in revocation actions, patentee may claim a limitation by amendment of granted claim(s)
- rewording by limiting features from the description (or a dependent claim) admissible
- applies to both European and national patents

A national administrative limitation procedure

- applies to both European and national patents
- not available after revocation having been initiated
- unconditional request for limitation by patentee

CONDITIONS FOR AMENDMENT

On the whole the same in administrative and judicial limitation procedures

- examination whether amendment represents a limitation and is consistent with the conditions referred to in Article 138 (1) b-d EPC
- in administrative procedure no substantive examination of the patentability of an amended claim
- the courts judge also the patentability when disputed in the revocation action

PROCEDURAL RULES RELATING TO PARTIAL REVOCATION

Invalidity defence requires revocation action

Amendment a defence in a revocation action

If the amendment is admissible, the patent is declared restricted to the amended claim(s) with effect *ex tunc* and *erga omnes*

An amendment may be an auxiliary request while the patentee defends the validity of the patent as granted

These rules applied prior to 2007 and still do

TIMING

An amendment should be requested in the patentee's Statement of defence

General procedural rules limit but do not exclude belated filing of amendments in the first instance court

At the appeal stage, an amendment not requested before may only be requested provided that the patentee could not have raised it earlier or otherwise has a valid excuse for doing it at this stage

BALANCE OF INTERESTS

It is in the interest of patentees to be able to maintain and defend granted claims while relying on auxiliary amendment(s), if needed in revocation proceedings

It is in the interest of third parties that scope of protection can be determined by known claims, including dependent claims - Article 69 EPC

In general, patentees will not use administrative limitation procedures unless the advantage of the judicial procedure is offset by other consequences

Such consequences might be that injunctive relief or compensation for infringement or litigation costs are affected

BALANCE OF INTERESTS (continued)

Considered but rejected to introduce a right to continue a prior use falling under an amended claim while not covered by a valid granted claim

However, a transitory provision was introduced allowing continued use by someone who in good faith had commenced it prior to 1 July 2007

Also no exception from general provisions on compensation for patent infringement for a prior use falling under an amended claim while not covered by a valid granted claim but compensation may be restricted to a reasonable royalty under the general rule on infringement in good faith