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AMENDMENT OF PATENT CLAIMS IN REVOCATION PROCEEDINGS
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AVAILABILITY OF AMENDMENT IN REVOCATION ACTIONS

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The implementation of EPC 2000 in Denmark did not change our approach to amendment of patent claims.

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Danish approach prior to EPC 2000 implementation

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The Danish rules were based on the same Nordic preparatory works (1963) as the rules in Sweden (and Finland and Norway).

Nevertheless, we took different approaches.



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Traditional Danish approach is that:

- courts have authority to limit protection scope by way of partial revocation
- amendment is probably limited to uncomplicated cases
- probably the only way of limiting claims is
 - (a) by *striking out* existing claims or parts of existing claims, or
 - (b) by *combining* 2 or more claims
- features from specification probably cannot be introduced into the claims in order to limit scope



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No request for amendment/partial revocation has been decided by Danish courts in decades.



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Generally, requests for revocation can be made

- in a separate revocation action
- within an infringement action
- within a confirmatory action following a PI, but not in PI proceedings as such.

The same applies to requests for *partial* revocation, but probably the patentee cannot request partial revocation by the courts by his own motion, i.e. in the absence of a third party claim for revocation.



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A request for partially upholding a patent can be made as an auxiliary request where patentee's primary claim is for the patent to be upheld as granted.



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Conditions:

- patentee must show that all formal requirements (clarity, no "new matter" etc.) are satisfied, as well as the requirements for novelty and inventive step
- amendment must be a limitation compared with claims as granted
- in practice, patentee must have support from court-appointed experts at least in respect of novelty and inventive step
- no general condition that patentee could not have requested partial revocation at an earlier stage
- no condition of absence of "bad faith"



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Effects on past licensing or infringement falling outside amended claims:

- in principle, amendment clearly has effect *erga omnes* and *ab initio*
- no case law on practical effects
- probably, licence fees cannot be reclaimed
- conceivable but not clear that finally decided cases on damages for infringement could be reopened



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Number of requests for amendment in *administrative* re-examination proceedings (available since 1993):

Total (1993 – 2008): 110 requests

2002: 0

2003: 1

2004: 2

2005: 5

2006: 9

2007: 6

2008: 5



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In recent years, more than half of the requests have concerned EPs.

More than half are third party requests for re-examination.

In the same period, no requests for amendment have been decided by Danish courts.

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Present state of the law (after EPC 2000 implementation)

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Implementation of EPC 2000 did not change the Danish approach to claim amendment by the courts.

Scope of Art. 138 (3) not discussed in legislative process.

This must mean that:

- amendment is still limited to
 - (a) *striking out* existing claims or parts of existing claims, or
 - (b) *combining 2* or more claims, and
- features from specification probably cannot be introduced into the claims in order to limit scope



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Some procedural aspects:

- a request for amendment may be filed or changed at any stage of proceedings (provided that it is not so late that other party cannot defend its interests)
- a request may be filed in the first instance or on appeal
- a request can be made as an auxiliary request
- there could be successive auxiliary requests
- amendment could be requested within infringement proceedings



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Effects of amendment for third parties:

- in principle, amendment clearly has effect *erga omnes* and *ab initio*
- no case law on practical effects
- probably, licence fees cannot be reclaimed
- clarified in legislative process that finally decided cases on damages for infringement could not be reopened

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National amendments vs. EPO restriction procedure:

- major attraction that patentee can use EPO procedure
 - (a) *ex parte* and
 - (b) during a national revocation action (national administrative amendment could not be thus used)

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(National amendments vs. EPO restriction procedure)

- patentee can "sabotage" a national revocation action at a very late stage by unilaterally restricting the claims in a way that does not take away infringement (no "trade-off")
- there is certainly scope for using EPO restriction as a supplement to partial revocation in Danish courts



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Two illustrative examples from the Danish courts



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(Two illustrative examples from the Danish Courts)

Danish Supreme Court : *Korsgaard* (straw bale wrapping apparatus) - 2007

- invalidity raised during appeal to Supreme Court of infringement case
- court-appointed experts agreed patent as granted lacked inventive step
- patentee requested amendment by combining claims 1 and 2
- experts held combined claim to be inventive
- invalidity issue withdrawn in Supreme Court
- patentee undertook to seek limitation in pending parallel High Court cases, and defendant undertook to accept such limitation
- High Court gave judgement limiting claim 1, based on parties' pre-orchestrated requests

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(Two illustrative examples from the Danish Courts)

Danish Supreme Court: *Meyn vs. Linco* (poultry dressing apparatus) – pending

- case pending since 2000 (PI case, PI appeal, confirmatory action, Supreme Court appeal)
- defendant gradually dug out more and more prior art
- long line of declarations by court-appointed experts declaring patent novel and inventive
- finally, experts declared lack of novelty based on newly discovered prior art document

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(Two illustrative examples from the Danish Courts)

(Danish Supreme Court: *Meyn vs. Linco*) (cont.)

- patentee requested restriction at EPO without notifying defendant
- patentee informed defendant of restriction shortly before final expert hearing at Supreme Court
- basis for long-scheduled oral hearing vanished
- Supreme Court upheld scheduling of final oral hearing
- new expert appraisal immediately before final oral hearing in Supreme Court
- preparation and costs incurred through 9 years of litigation wasted



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Some thoughts for discussion

- Is it fair if patentee can derail carefully prepared revocation proceedings by nominally restricting the claim scope shortly before the conclusion of such proceedings, when the going gets tough? This might, in extreme cases, amount to "procedural sabotage".
- If a limitation is requested, say, every 18 months, it would be impossible in most countries to ever obtain a final judgment revoking the patent. Ideal for the patentee, but is it fair and balanced?
- Because EPO restriction does not require an assessment of novelty or inventive step, a sequence of such limitations could effectively bar the revocation of a patent that truly merits revocation. Is this fair, particularly in cases where limitation can be made without sacrificing any valuable protective scope because nominal restrictions are sufficient (so there is no "trade-off")?
- Should patentee be obliged to notify defendant immediately of restriction requests made during revocation actions?



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THE END

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