

Amendment of patent claims in revocation proceedings in the UK – prior to and after implementation of EPC 2000

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Amendment of claims in UK proceedings both before and after EPC 2000

- ✓ Normal to amend claims during proceedings
- ✓ No limit to existing claims or even claim language subject to the added matter rule
- ✓ Need to do so in time for advertisement in the official journal so as to allow notice to third parties
- ✓ Third parties can also therefore respond to advertisement and join the proceedings for the purposes of the amendment only

Amendment of claims in UK proceedings both before and after EPC 2000 (cont'd...)

- ✓ Patentee needs to choose whether to continue to maintain the unamended claims as well
 - ✓ Conflict in reasons for amendment and maintaining old claims
 - ✓ Costs consequences normally flow from this
- ✓ Amendment on grounds of limitation, clarification or correction
- ✓ Objections on grounds of
 - ✓ Clarity (Art84 EPC)
 - ✓ Added matter (Arts 123(2) and (3) EPC)

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Amendment of claims in UK proceedings both before and after EPC 2000 (cont'd...)

- ✓ Procedure
 - ✓ Advertisement of amendments and grounds for amendment
 - ✓ Response pleadings from Defendant and any third party interveners
 - ✓ Oral hearing normally at beginning of main revocation (and infringement if relevant) trial

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Before implementation of EPC 2000

- ✓ Amendment subject to discretion
- ✓ Patentee had to prove that
 - ✓ They had only recently become aware of the need for amendment
 - ✓ Their behaviour as regards prosecution of the patent worldwide was proper and did not argue against amendment
 - ✓ Their behaviour as regards assertion of their rights under the patent does not argue against amendment
- ✓ The issue of discretion gave rise to extensive discovery on the part of the patentee e.g. all documents relating to prosecution of the patent worldwide including those that were otherwise privileged

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Central limitation

- ✓ New procedure in EPO which can occur while first instance proceedings on foot
- ✓ Art 105(a)
 - ✓ Request filed by patentee
 - ✓ Cannot be done whilst EPO Opposition proceedings pending
- ✓ Art 105(b)
 - ✓ Examined by EPO (Examining Division rule 91)
 - ✓ Decides if amendments accepted or rejected or if the patent is revoked
- ✓ Art 105(c)
 - ✓ Amendments to specification and claims published

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Central limitation (cont'd...)

- ✓ Amendments examined under Art 84 and Arts 123(2) and (3) only
- ✓ Only takes about 3-6 months and therefore occurs before first instance hearing in the UK if applied for following filing of Grounds of Invalidity by the Defendant
- ✓ No damages shall be awarded for infringement before the decision to allow the amendment unless the Court is satisfied that:
 - ✓ The specification of the patent as published was framed in good faith and with reasonable skill and knowledge; and
 - ✓ The proceedings were brought in good faith

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Actual example of central amendment during proceedings in the UK

Claim 1 – as granted

1. A stent valve, suitable for placement in a vessel (80), the vessel further having a diameter (84) and an inner luminal surface, comprising:
 - a) a radially expandable stent (20) having a proximal stent end (31), and a distal stent end (33), the stent having an expanded diameter (86) sized to permit contact with an inner luminal surface of the vessel;
 - b) a valve (41) having a proximal valve end (48) and a distal valve end (50), the valve being at least partially located within an inner portion of the stent, wherein the valve is formed with a collagen containing bio material (38), characterised in that said collagen containing bio material extends within said stent (20) substantially from said proximal stent end (31) to said distal stent end (33) and forms at least two valve leaflets (46) that extend substantially from said proximal stent end (31) to said distal stent end (33), with the proximal valve end (48) connected to the proximal stent end (31).

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Actual example of central amendment during proceedings in the UK

Claim 1 – amended

1. A stent valve, suitable for placement in a vessel (80), the vessel further having a diameter (84) and an inner luminal surface, comprising:
 - a) a radially expandable stent (20) having a proximal stent end (31), and a distal stent end (33), the stent having an expanded diameter (86) sized to permit contact with an inner luminal surface of the vessel;
 - b) a valve (41) having a proximal valve end (48) and a distal valve end (50), the valve being at least partially located within an inner portion of the stent, wherein the valve is formed with a collagen containing bio material (38), characterised in that said collagen containing bio material **comprises pericardium and** extends within said stent (20) substantially from said proximal stent end (31) to said distal stent end (33) and forms at least two valve leaflets (46) that extend substantially from said proximal stent end (31) to said distal stent end (33), with the proximal valve end (48) connected to the proximal stent end (31).

Questions.....?

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