

Amendment of patent claims in revocation proceedings before civil courts in Finland

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Framework and background in Finland

- ▼ Nordic co-operation
 - ▼ Substantive patent law harmonised
 - ▼ Procedural rules not harmonised
- ▼ Finland joined the EPC in 1996
- ▼ Specialty: pharmaceuticals in Finland
 - ▼ Product patents first in 1995
 - ▼ There are still process patents in force (until 2019)

Amendment of claims in Finland before EPC 2000

- ✓ No specific provision on amendments in the Patents Act
- ✓ However, possible to revoke the claims in whole or in part
 - ✓ In connection with revocation proceedings in court
 - ✓ Post-grant opposition proceedings available
 - but no separate administrative limitation procedure

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Implementation of EPC 2000 in Finland

- ✓ Government proposal (92/2005)
- ✓ Amendment of the Patents Act (1967, as amended)
 - ✓ Entry into force on 6 March 2006 / 13 December 2007
- ✓ Limitation of claims in connection with revocation proceedings before civil courts
 - ✓ Amendment of claims
 - ✓ At the request of the patentee
 - ✓ National patents and EP patents validated in Finland

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Amendment in a nutshell

- ✓ Request presented by the patentee in connection with revocation proceedings before civil courts
- ✓ Request presented before the main hearing
 - ✓ Typically in the first written statement, i.e. the response to the claim?
- ✓ Limitation (Requirements: Patents Act, Section 53 b)
- ✓ Effect retroactive and in relation to everyone

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Patents Act: Section 52, subsection 2*

"In connection with the invalidation process of a patent, the patent holder may request the Court to limit the patent in accordance with the amended patent claims. The request for limitation shall be presented before the case is transferred to the main hearing. If the request for limitation is presented, the issue concerning it must be solved separately before continuing the invalidation process. The limitation must meet the requirements under Section 53b. If the Court approves the request for limitation, the patent limited in this manner shall make the basis for continuation of the process. A decision regarding the request for limitation may only be appealed against in connection with the Court decision concerning the action."

* Source: Translations on the website of the Finnish patent office (www.prh.fi)

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Patents Act: Section 53 b*

"The condition for acceptance of a request to limit a patent before a Patent Authority or a Court is that the patent to be limited in accordance with the request meets the following conditions:

(1) the patent refers to an invention which is presented with sufficient clarity for a person skilled in the art to use the invention;

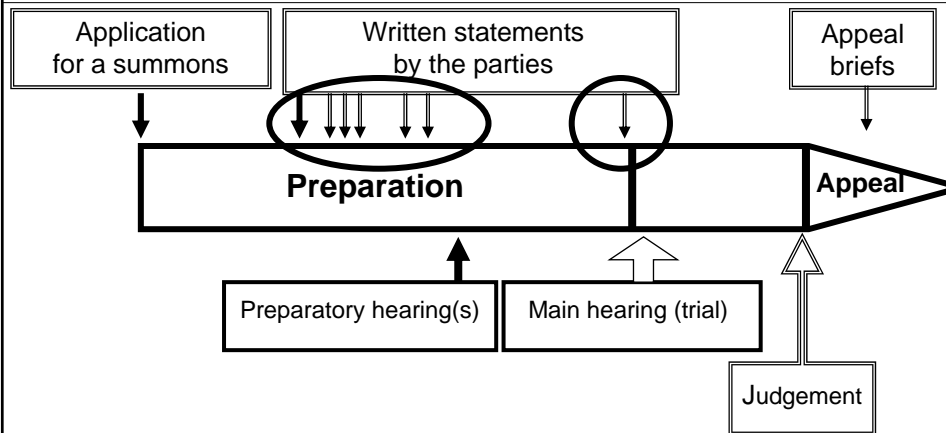
(2) the patent does not involve anything that does not appear from the application when it was filed; and

(3) the scope of protection of the patent has not been extended from the scope of protection of the patent granted or from the previously taken decision of the scope of protection."

* Source: Translations on the website of the Finnish patent office (www.prh.fi)

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Civil procedure in Finland



Patent litigation centralised: Helsinki District Court → Helsinki Appeal Court (→ Supreme Court)

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Preparatory works: government proposal (1)

- ✓ Limitation by amending the claims
- ✓ Request decided separately and prior to the handling of the revocation request
 - ✓ Code of Judicial Procedure (Chapter 5) applies:
a separate part of a case can be separately prepared
- ✓ A separate decision issued as soon as possible
 - ✓ Revocation case not unnecessarily delayed
 - ✓ Appealable first in connection with the revocation action
- ✓ No obligation to obtain a statement from the patent office
 - ✓ Discretion of the court
 - ✓ Mandatory in connection with revocation proceedings

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Preparatory works: government proposal (2)

- ✓ Aim: request presented only once during one litigation
 - ✓ Exception: if the patentee can invoke new grounds
 - ✓ Own comment: Several auxiliary requests used
- ✓ Delay in presenting the request may affect compensation for the legal costs
- ✓ States explicitly: not to be introduced first on appeal
 - ✓ Own comment: Possible in some exceptional cases?
- ✓ Broadening the scope of protection is a ground for revocation

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Additional remarks

- ✓ Administrative procedure available, too (Section 53 a)
 - ✓ Not when opposition pending or initiated later
 - ✓ Not when revocation action in court pending or initiated later
- ✓ Issues in dispute: clarity + included in the application?
 - ✓ Novelty and non-obviousness typically discussed, too?
- ✓ Abuse of rights, including inequitable conduct?
 - ✓ For example, the Finnish AIPPI Q189 Report refers to the US patent system

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