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Amendments of Patent Claims in Revocation Proceedings *- GERMANY and EPC 2000 -*

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**GERMAN practice with three possibilities
of amendment after grant**

**-Limitation before the Patent Office
*ex parte***

**Amendment during an opposition
proceeding before the GPO (or the
Federal Patent Court)**

**- Amendment during a revocation
proceeding before the Federal
Patent Court**

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§ 64, 21 (2) German Patent Act – Limitation Procedure (*ex parte*)

- (1) A patent may be limited with retroactive effect, at the request of the patentee, by amending the patent claims.**
- (2) The request shall be filed in writing and the grounds on which it is based shall be stated. A fee shall be paid**
- (3) The Patent Division (of the Patent Office) shall decide on the request...
The amendment is to be published.**

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Characteristics:

- purely *ex parte* proceeding like Art. 105 et seq EPC 2000**
- not a re-examination procedure like in DK**
- unconditional - no auxiliary requests**
- there will be an examination about the admissibility of the limitation**
- publication - effect *erga omnes***

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Revocation proceedings before the Federal Patent Court for German or EP patents

- **was possible in Germany even before EPC 2000 => no need for implementation of A. 138(3) EPC**
- **patentee can agree to a limitation**
- **patentee can file auxiliary claims**
- **amendment still possible on appeal**
- **very similar to opposition proceedings before the EPO or the GPTO (several auxiliary petitions).**

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Revocation Similar to Opposition (I)

- **Germany has bifurcated patent litigation system with separate infringement and revocation proceedings.**
- **Infringement proceedings are heard by the district courts which do not deal with validity/amendment of claims directly, but examine whether to stay infringement proceedings while revocation proceedings are pending.**

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Revocation Similar to Opposition (II)

- **Revocation proceedings: 3 out of 5 judges of the panel are technical judges, usually former patent examiners.**
- **Federal Patent Court decides by itself whether requested claim amendments are allowable. No need to consult PTO like in France.**
- **Revocation proceedings are like opposition, but can be filed at any time.**

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Allowability of Claim Amendments

Rules for allowability of post-grant claim amendments practically identical to EPC Art. 105a et seq.

E.g.,

- **scope of protection may not be extended;**
 - **claimed subject-matter must be disclosed in original application;**
 - **amendment must be clear and concise**
 - **Limitation becomes effective *erga omnes* and also for the past**
- **Claim must still protect the same subject matter – not an *aliud***

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Allowability of Claim Amendments

- **Difference to GPO: In GPO limitation there will be no examination as to the patentability of the „new“ claim – in revocation action patentability is a must**
- **Difference to EPO: no “inescapable trap” in Germany. If claim as granted goes beyond content of originally filed application, claim may be amended by footnote saying that non-disclosed feature may not be used to distinguish claim over prior art.** (cf. Teschemacher Pagenberg, MPI Studies vol. 6 p.481)

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Patent Strategy Points - *Auxiliary requests I*

- **System of successive auxiliary requests (like in EPO opposition) allows patent owner to defend patent with maximum possible scope of protection when prior art is found after grant of patent.**
- **In the hearing before Federal Patent Court, main request and all auxiliary requests are discussed before court deliberates; no interlocutory decisions (different from EPO opposition proceedings).**

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Patent Strategy Points - *Auxiliary requests II*

- **In contrast, limitations before EPO and GPO are unconditional, questions of novelty and inventive step are not discussed.**
- **=> Patent owner in general better off with limitation during revocation proceeding.**
- **But he may use limitations before patent offices prior to litigation for avoiding costs of revocation proceedings.**

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Patent Strategy Points - When to File (I)

- **Situation today: (auxiliary) limitation request(s) may be filed at any time in the proceedings, even during the hearing.**
- **If request is filed very late, plaintiff may in special cases not be in a position to timely react to the request. E.g., plaintiff may have to conduct additional prior art search.**
- **In this case, plaintiff's right to be heard demands that hearing be adjourned.**

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Patent Strategy Points - When to File (II)

- ***New Patent Act* introduces new rules for actions filed on or after 1 October 2009. Goal: accelerate invalidity proceedings.**
- **Federal Patent Court required to issue preliminary opinion prior to the hearing.**
- **Preliminary opinion may be combined with a deadline for filing new prior art and new requests, including (auxiliary) limitation requests.**
- **No new requests on appeal !**

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Art. 83 (4) Pat G (2009) - Revocation Proceedings

The [revocation chamber of the] Federal Patent Court can reject ... a defense .. in the form of an amended version of the patent which is only submitted after lapse of a prescribed deadline, and decide without further investigation, if

- 1. the consideration of the new ground of defense would require the adjournment of the already fixed hearing date, and***
- 2. the respective party does not sufficiently excuse the late filing, and***
- 3. the respective party had been warned by the court about the consequences of a delay***

The ground of excuse must be proven

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Patent Strategy Points - When to File (III)

- **When would consideration of new limitation request require *adjournment* of already fixed hearing date?**
Only in rare cases!
- **Example (BGH GRUR 2004,354- *Vertagung*):** Patent owner files in the hearing new limitation request in which claim is amended by a feature contained in the description but not in any of the claims. Revocation plaintiff could not foresee such limitation and has to conduct additional prior art search to be in position to reply to limitation request.

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Patent Strategy Points - When to File (IV)

- **When would late filing of limitation request be *sufficiently excused*?**

Example: new prior art is filed by invalidity plaintiff in the last minute and is admitted into the proceedings by the court.
- **Even if limitation request would require adjournment of hearing date and late filing is not sufficiently excused: no obligation for court to reject limitation request.**

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Patent Strategy Points - When to File (V)

New German rules still more liberal than R. 116 EPC, under which Opposition Division may always reject late filed limitation requests:

Rule 116 Preparation of oral proceedings

(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. ... New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

(2) If the applicant or patent proprietor has been notified of the grounds prejudicing the grant or maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis.

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Patent Strategy Points - When to File (VI) - Appeal

- **Today: new limitation requests can be filed on appeal (BGH) still in the hearing.**
- **New law: Actions filed after 1 October 2009: further auxiliary requests in revocation proceedings admissible only**
 - **if other party agrees or court regards request sensible**
 - **if first instance decision is based on erroneous application of the law.**
- **New limitation requests will be difficult on appeal, particularly multiple auxiliary claims.**

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The Future - ECPC Draft Agreement

Art. 38a Decision on the validity of a patent

(3) Without prejudice to Article 138 (3) EPC, if the grounds for revocation affect the patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part.

Article 138 EPC - Revocation of European patents

In proceedings before the competent court ... (the ECPC) relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceeding.

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What can we expect from the future Court?

Compare with Germany:

- **Transfer of limitation to patent office? - No**
- **Strict disclosure requirements? – Yes**
- **Patentability examination? – Yes**
- ***Erga omnes* effect? – For counterclaim Yes**
- **Unescapable trap? – Hopefully not**
- **Bifurcated proceeding? - Better not here**
- **Stay of proceedings? - Hopefully not**
- **Discussion of right to be heard? – Certainly Yes**
- **Suspension of hearing date? – May depend**

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What can we expect? Compare with Germany:

- **Auxiliary requests allowed? - A must**
- **Interlocutory decision on auxiliaries? - Would be helpful**
- **Effect of Limitation from filing date? – Yes**
- **When to file? – Any time, until last minute**
- **Preliminary indication by the court before hearing with deadline? – Helps to accelerate and prevents abuse.**
- **Excuse for late filing possible? – Yes under strict conditions**
- **Cost on whom? – *Pro rata* for win and lose as part of counterclaim cost sharing**

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Thank you

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