

PATENTS: STRENGTHENING BY LIMITATION

VOLUNTARY LIMITATION OF GRANTED FRENCH NATIONAL PATENTS IS NOW POSSIBLE

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Since 1st January 2009, French law has allowed patentees to voluntarily limit their granted patent claims.

This possibility, which has existed for a long time in a number of European countries (Austria, Switzerland, Germany, Denmark, Italy, Norway, United Kingdom²), has recently been introduced into the European patent system through Articles 105 bis *et seq.* of the European Patent Convention (the so-called "EPC 2000" revision which entered into force on 13 December 2007)³.

The new regulation is good news for owners of national French patents who can now modify the wording of their claims to better delimit their inventions from the state of the art. It is also good news for courts as it should avoid them having to decide on unproductive disputes.

The new procedure will be particularly useful if, after the grant of the patent, the patentee becomes aware of additional prior art which affects the validity of the patent as granted but leaves a possibility to define a patentable invention by limiting the scope of protection.

Considering a limitation procedure will now be on the list of precautions to take and formalities to observe before starting infringement proceedings.

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² Concerning the extensive case law of the UK courts with regard to amendment proceedings, see *Terrell on the Law of Patents*, Sweet & Maxwell, 16th edition, 2006, pp. 345 to 382.

³ For a complete commentary on these provisions, see Ulrich Joos *Central limitation and revocation under Articles 105a to 105c of the revised European Patent Convention*, 14th European Patent Judges' Symposium OJ EPO Special edition 1/2009, page 43 *et seq.*

The Situation in France before the New Act

Until 1st January 2009, it was impossible for a patentee to voluntarily limit the claims of a national French patent once it had been granted.

The owner of such a patent could only:

- ▶ surrender the patent or some of its claims (Article L. 613-24 of the French Intellectual Property Code) for the future; however, surrendering one or more claims could never give an outcome equivalent to a limitation, *i.e.* narrowing the scope of protection conferred by a particular claim;
- ▶ request partial revocation of one or more claims of his patent from the court; in theory, the patentee could make such a request on his own initiative; in practice, such a request was generally made within the framework of infringement proceedings to which the defendant would reply by way of a counterclaim for the revocation of the patent, the patentee replying, in turn, that the potential invalidity was not total but only partial; although this was a possible way to obtain a limitation, the procedure was lengthy and inconvenient; a court pronouncing partial revocation could not draft the amended claims but had to send the patentee to the French Patent Office for the amendment; in addition, only certain types of amendments are acknowledged as allowable under French case law on partial revocation; this possibility was thus hardly ever used in France⁴.

These two options are still available to a patentee.

Now however, a patentee may also voluntarily limit the patented subject-matter after grant, independent of any revocation proceedings.

New French Act

The Act dated 4 August 2008⁵ amended Articles L. 613-24, L. 613-25 and L. 614-12 of the French Intellectual Property Code.

These provisions were supplemented by Article 3 of the decree of 30 December 2008⁶ (Article R. 613-45 of the French Intellectual Property Code).

They entered into force on 1st January 2009.

⁴ On patent revocation, in general, see Emmanuel Py's typed thesis "*L'annulation du brevet d'invention, les apports du droit judiciaire privé et de la théorie des nullités*" (Strasbourg, 2008); on partial revocation, see pages 374 *et seq.*, No. 1077, page 423 in particular: "*La nullité est une sanction qui vise à rétablir la légalité dans la limite de sa violation*".

⁵ Act No. 2008-776, published in the Official Journal of 5 August 2008: see Ch. Caron, *La propriété intellectuelle dans la loi de modernisation de l'économie*, JCP E 2008, act. 397; idem, *La propriété intellectuelle dans la loi de modernisation de l'économie*, JCP G 2008, act. 600; idem, *Pot-pourri de propriété intellectuelle : textes nouveaux et attendus*, Com. com. électr. Oct. 2008, comm. 109; J.-P. Gasnier, *Loi de modernisation de l'économie et propriété intellectuelle*, Propr. ind. Nov. 2008, Focus 163; J. Azéma, *L'incidence de deux importantes lois récentes sur la propriété industrielle*, RLDA, Dec. 2008, p. 17 *et seq.*; J.-C. Galloux, *Les dispositions de la loi n° 2008-776 du 4 août 2008 de modernisation de l'économie relatives à la propriété intellectuelle*, RTD com. 2008, p. 720 *et seq.*; J. Raynard, *Droit des brevets et du savoir-faire industriel*, D. 2009, pan. p. 453 s., especially p. 454

⁶ Decree No. 2008-1471, published in the Official Journal of 31 December 2008

Article L. 613-24 of the new French Intellectual Property Code governs voluntary limitation procedures independently of any litigation:

*“ The owner of a patent may at any time surrender either the entire patent or one or more claims, **or limit the scope of the patent by amending one or more claims**”.*

The request for surrender or limitation shall be submitted to the National Institute of Industrial Property in accordance with the conditions laid down by regulation.

The Director of the National Institute of Industrial Property shall examine the request for its compliance with the regulations referred to in the foregoing paragraph.

The effect of the surrender or limitation shall be retroactive from the filing date of the patent application. (...)”

Amended Article R. 613-45 of the French Intellectual Property Code specifies the requirements to be fulfilled.

Articles L. 613-25⁷ and L. 614-12⁸ of the French Intellectual Property Code dealing respectively with French national patents and European patents in France, have been amended to specify the sanctions in respect of a limitation which does not narrow the scope of the patent and the possibility of limiting the patent within the framework of revocation proceedings.

Before examining the limitation procedure, it is necessary to define the concept of limitation and consider whether this legal technique is applicable to industrial property rights other than French national patents, namely European patents and supplementary protection certificates.

What is a Limitation?

The Act does not define the term limitation: it only indicates that the limitation is carried out by amending one or more claims.

However, logically, a limitation is the reduction of the scope of protection conferred.

Of course, everyone understands that a limitation is an intellectual process which is not simply the deletion of unwanted terms from the claims.

⁷ Article L. 613-25, concerning French patents, now provides for the following:
“A patent shall be revoked by court decision:

...

d) If, after the limitation, the scope of the protection conferred by the patent has been extended.

...

Within the framework of proceedings for the revocation of a patent, the patent proprietor is entitled to limit the patent by amending the claims; the patent thus limited is the subject of the instituted revocation action.

A party who, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed”.

⁸ And Article L. 614-12, concerning European patents:

“A European patent may be revoked with effect for France on any one of the grounds set out in Article 138(1) of the Munich Convention..

...

Within the framework of proceedings for the revocation of a European patent, the patent proprietor is entitled to limit the patent by amending the claims pursuant to Article 105 bis of the Munich Convention; the patent thus limited is the subject of the instituted revocation action.

A party who, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed”.

Nevertheless, this should not lead us to think that any type of claim narrowing constitutes an admissible limitation.

The courts will obviously be able to check, in case of dispute, that the claim as limited remains based on the description.

But they will also be able to check, when requested to do so, that the effect of the alleged limitation was not, in fact, to extend the protection (which is prohibited by Articles L. 614-12 and L. 613-25 of the French Intellectual Property Code, which provide for a sanction of revocation, expressed by the paradox: "*If, after the limitation, the scope of the protection conferred by the patent has been extended*").

Does the French Limitation Procedure Apply to European Patents?

Although this is not expressly stated in the new Act, the French limitation procedure also applies to European patents.

This follows from Article 2 of the European Patent Convention : "*(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise*".

In addition, nothing seems to prohibit the combination of the French national procedure and the central limitation procedure of Articles 105 bis *et seq.* of the European Patent Convention: it is therefore quite conceivable that a European patent could be, firstly, subject to a central limitation at the European Patent Office, and then to a limitation specific to France at the National Institute of Industrial Property (a "*French limitation of the European limitation*").

Does the French Limitation Procedure Apply to Supplementary Protection Certificates?

Obviously, this question is meaningless for supplementary protection certificates granted on the grounds of European regulation n° 1768/92, as they do not have any claim.

The question only relates to the national French supplementary protection certificates formerly granted on the grounds of the French provisions.

The new Act does not specify that the limitation procedure applies to those supplementary protection certificates.

As confirmed by the *Tribunal de Grande Instance* of Paris in two recent decisions⁹, Article L. 613-25 of the French Intellectual Property Code, which provides for the partial revocation of claims, does not apply to supplementary protection certificates, since this Article is explicitly included amongst the Articles whose application to supplementary protection certificates is excluded by Article L. 611-2.

However, since Article L. 613-24 on limitation is not included in the Articles whose application to supplementary protection certificates is explicitly excluded by Article L. 611-2, it seems that the limitation procedure may be applied to French national supplementary protection certificates.

Who Can Request the Limitation?

Any request for limitation must be submitted by the owner registered on the French Patent Register or by his representative (where there are co-proprietors of the patent, any request must be filed by all co-proprietors).

Where property rights, a security or a licence have been recorded on the French Patent Register, the patentee must prove that he has consent from the owners of such rights.

When May Limitation be Requested?

A request for limitation may be submitted by the patentee *"at any time"*, pursuant to Article L. 613-24 of the French Intellectual Property Code: this means that it may be submitted as soon as the patent has been granted and even after its expiry date.

Articles L. 614-12, concerning European patents, and L. 613-25, paragraph 3, concerning national French patents, explicitly provide that a request for limitation may be submitted within the framework of an action for revocation.

These articles do not restrict the limitation to first instance proceedings: thus, sooner or later, courts will come up against limitations requested during appeals or even whilst the case is pending before the *Cour de cassation* (the French highest court for civil matters)¹⁰.

⁹ *Tribunal de Grande Instance* of Paris, 3rd Chamber, 2nd Section, 20 February 2009, docket No. 2004/18665 and docket No. 2005/12994, *PIBD* 2009, No. 896, III, 1039; *Jurimp* n° B20090051: *"that besides, Article L. 613-25 of the Intellectual Property Code according to which 'If the grounds for revocation affect the patent in part only, revocation shall be pronounced in the form of a corresponding limitation of the claims' did not apply to supplementary protection certificates pursuant to Article L. 611-2, nor did Article L. 613-27 relating to the implementation provisions for partial revocation provided for in Article L. 613-25; and considering finally that Article L. 613-28 last paragraph of the French Intellectual Property Code relating to the invalidity of a supplementary protection certificate does not provide for the partial revocation of a claim of a supplementary protection certificate but only for the revocation of some of its claims; thus, the claims of the supplementary protection certificate in issue cannot be amended through the mechanism of partial revocation of the patent on which it is based"*.

¹⁰ Faced with such a situation, the *Hoge Raad* (the Dutch highest court) decided that a limitation requested after the appeal decision should lead to a new examination of the case in appeal proceedings (*Boston Scientific v. Medinol*, 6 March 2009, [2009] E.I.P.R., N-61).

The question of whether a request for the limitation of a European patent pursuant to the national procedure may be introduced while an opposition procedure is pending before the European Patent Office is a delicate one¹¹.

How to Request Limitation?

The request for limitation of a patent is submitted in writing to the National Institute of Industrial Property¹²; it requires the payment of a fee which is currently €250.

Amendment of the Description and the Drawings when Requesting Limitation

The new provisions allow for a request for amendment not only of the claims but also of the description and the drawings.

Article L. 613-24 of the French Intellectual Property Code only deals with claim limitation, but Article R. 613-45 specifies that the request for limitation must be accompanied "*by the full text of the amended claims and, as the case may be, by the description and the drawings as amended*".

Examination of the Request for Limitation by the National Institute of Industrial Property

The Director of the National Institute of Industrial Property examines the request for its compliance with the provisions stipulated in Article R. 613-45 of the French Intellectual Property Code.

He first checks that the amended claims do not constitute an extension with respect to the previous claims of the patent.

If, despite this examination, a request for amendment is accepted which does not constitute a real limitation, third parties may request revocation of the limited patent from the court, pursuant to the provisions for revocation introduced in Article L. 613-25 d)¹³ for French patents and Article L.614-12 for European patents.

The Director of the National Institute of Industrial Property also examines compliance with Article L. 612-6 of the French Intellectual Property Code which provides that the claims must be clear and concise and supported by the description.

¹¹ Indeed, (see above) the French limitation procedure not only applies to national French patents, but also to European patents designating France and the same regulation should apply to both type of patent; but Article 105 bis (2) of the European Patent Convention according to which "*the request may not be filed while opposition proceedings in respect of the European patent is pending*" can only apply to European limitation proceedings; this leads to the conclusion that a national request for limitation may be lodged even if opposition proceedings are pending.

¹² For this purpose, a form is available on the website of the National Institute of Industrial Property http://www.inpi.fr/fileadmin/mediatheque/pdf/FB_limitation_renonciation.pdf

¹³ Article L. 613-25 d):
"A patent shall be revoked by court decision: [...]
d) If, after the limitation, the scope of protection conferred by the patent has been extended."

If these requirements are not met, a reasoned notification is sent to the applicant for limitation. A time limit is then specified, within which the request may be corrected or observations may be submitted by the applicant.

If the applicant fails to correct his request or to make observations permitting any objections to be waived, the request for limitation is rejected.

Effect of the Limitation

If the request for limitation is deemed to be in compliance with the law, the limitation is entered on the National Patent Register (without publication of a new specification).

The effect of the limitation is retroactive from the filing date of the patent application.

Impact of a Limitation on Infringement and Revocation Proceedings

The Act does not specify whether a court ruling on infringement or revocation should stay the proceedings if the patent is undergoing a request for limitation.

However, since Articles L. 614-12 (European patent) and L. 613-25 (national patent) expressly provide that the limitation may be requested "*within the framework*" of proceedings for the revocation of a patent, and specify that "*the patent thus limited is the object of the instituted revocation action*", it is reasonable to think that the court should stay the proceedings when there is such a request.

If a limitation is requested outside a revocation action, *e.g.* within the framework of an infringement action, given that the limitation procedure is relatively quick, the court will, generally, wait for the outcome of the limitation before ruling on validity and infringement¹⁴.

Finally, it will be possible for the courts to be faced with a claim for infringement of a European patent which is still subject to a pending opposition and, simultaneously, to a national voluntary limitation (which seems possible, see note 11); generally, a patentee who requests a limitation in this context will be seeking to rapidly limit his patent claims in France to the claims defended in the opposition procedure. In this case, the courts will have to assess whether, after the restriction of the scope of the claims, the opposition still has a serious chance of success, as they currently do in comparable situations.

¹⁴ The first decision issued on the subject ruled in that sense; this case relates to a request for a central limitation made to the European Patent Office, but the question regarding the stay of proceedings is the same (*Tribunal de Grande Instance* of Paris, 3rd Chamber 1st Section, 7 April 2009, Georgia-Pacific France / Delipapier, docket No. 2008/02969, *Juripix* n° B20090073)

How many times?

There is no provision specifying that the limitation may be requested only once (there is no rule preventing "*a limitation of a limitation*").

However, with respect to limitation within the framework of revocation proceedings, Article L. 613-25, for a French patent, and Article L. 614-12, for a European patent, provide that if the owner "*makes a plurality of limitations of his patent, in a dilatory or abusive manner*", he may be liable to damages or even a civil fine of up to €3,000.

Strengthening a Patent before Initiating an Action for Infringement

The post-grant voluntary limitation of a patent allows streamlining the infringement proceedings.

Indeed, a feature may have been too broadly claimed when filing the patent or during prosecution because an element of the prior art was unknown.

The quick and simple modification of the wording of a claim to define the exact scope of the invention avoids unproductive discussions during the procedures (there is no point in long discussions on the validity of features which cannot be protected).

Patentees will thus be able to strengthen their patents before initiating an action for infringement.