

## **AMENDMENT OF PATENT CLAIMS IN REVOCATION PROCEEDINGS**

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### 1. Introduction

“Amendment”

- a) partial invalidity: main claim(s) declared invalid, dependent claim(s) found to be valid
- b) formulation of new claims, going beyond rearranging features of main and dependent claims

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## 1. Introduction (2)

Fundamental requirements applying to any change of the patent:

- Sec. 13 Patents Act: *A patent application must not be amended in such a way that protection is claimed for subject matter which was not disclosed in the application at the time it was filed.*  
Applies not just to patent applications, but also to granted patents that are the subject of opposition, limitation or revocation proceedings. Scope: claims and specification
- Sec. 19 (2) Patents Act: *Subsequent to the applicant having been notified that a patent may be granted, the patent claims may not be amended so as to extend the scope of the patent protection.*  
Scope: claims and arguably also specification

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## 2. Accession to the EPC

- Effective 1st January 2008.
- Obstacles and compromises. Opposition to “patents on life”. Implementation of Patent directive in 2003/2004: Norway reserved the right to apply the most restrictive approach in that area. Accession to EPC: problem of leaving it to the EPO to grant patents that would become effective in Norway. Increase opportunity for review of European (and Norwegian) patents: extended opposition period of 3 years to oppose “immoral” patents and administrative reexamination throughout the life of the patent (alternative to invalidity actions in the courts).
- Implementation of art. 138 EPC 2000.

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### 3. Situation before 1 January 2008

- 3.1 Norwegian Patents Act 1967
- Patents Act resulted from joint Nordic efforts to reform patent legislation in the 50'ies and 60'ies. NU 1963:6. Largely identical patent acts from 1967-1969
- Patents Act sec. 27: judicial review of refusals to grant patent
- Patents Act sec. 52 (1): Invalidity (revocation) action
- Courts have full competence in both types of actions – “Swingball” judgment, Supreme Court of Norway Rt. 1975 p. 603

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### 3. Situation before 1 January 2008 (2)

- Patents Act 1967: no express mention of partial invalidity.
- Preparatory works: no intention to depart from the previous situation - sec. 16 of the Patents Act 1910 expressly stated that courts could declare a patent to be entirely **or partly** invalid.
- Exact scope of the courts' competence in this area remained unclear throughout the following four decades, until the present amendment.

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### Situation before 1 January 2008 (3)

- Preparatory works in the 1960ies: Principle of separation between the functions of the administrative powers (the Patent Office) and of the Courts. However courts were to have the power to declare a patent partially invalid if that could be done without re-formulating the claims. Thus, only invalidation of one or more claims, no re-drafting of claims.
- The Supreme Court relied on this interpretation in a judgement of 15 June 1971 (Wiborg v. Lemm, Rt. 1971 p. 714) – but patent was upheld as granted.

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### Situation before 1 January 2008 (4)

- This position was advocated by Supreme Court Justice Mr J.C. Mellbye in an article in NIR 1971 (he did not decide in the mentioned case).
- Oslo City Court 1992: Patent declared invalid in so far as patent claims 1 and 2 are concerned (patent claims 3 and 4 held to be valid).
- Borgarting Court of Appeal 2007: One main claim declared invalid, while dependent claims and another independent claim were not.

Conclusion:

Only option available: declare main claim + some of the dependent claims invalid. Very limited scope of application for this, since entirely dependent on whether patentee had formulated relevant dependent claims.

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## 3.2 Administrative limitations

- From 1997: administrative limitation at the request of the patentee
- Ex parte procedure, i.e. no “opponent” with party rights
- No requirement that the patent as granted is invalid or liable to be declared invalid
- Scope of limited patent must be narrower than patent as granted
- NPO should assess patentability of patent (after requested limitation)
- No auxiliary requests, but patentee/NPO communication will enable patentee to adjust his request
- If NPO rejects the request, patent stands as granted
- Appeal to the Second Division of the Patent Office and further recourse to the courts (judicial review of the decision)

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## 3.2 Administrative limitations (2)

- Courts would likely stay invalidity (and infringement) actions pending a decision of the Patent Office.
- From publication of limitation: effect *ex nunc* (from 1 January 2008: *ex tunc*) and *erga omnes*
- Only about 10-12 limitations were filed during the first 8-9 years, numbers have increased significantly in the last 3 or 4 years.
- Average time for processing a limitation was 7 months, but is now longer.
- Limitation may be requested at all times.

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## 4. 2008 Amendments of Patents Act

### 4.1 Administrative reexamination at the request of a third party (or the patentee)

- Only the basic patentability criteria can be relied on to request revocation (lack of novelty / inventive step, industrial applicability and invention pertaining to excluded technical field)
- Auxiliary request admissible
- No interlocutory decisions on main and auxiliary requests  
Everything is discussed before the Patent Office decides
- Procedure is in writing, although a meeting/hearing can be requested
- Appeal to the Second Division, and judicial review

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## 4. 2008 Amendments of Patents Act (2)

### 4.2 Amendment of patent claims in revocation proceedings

- This is the subject of today's seminar, and there are many questions that can be asked, but not so many answers can be given– yet.

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## 4. 2008 Amendments of Patents Act (3)

### 4.2.1 Wording of new provisions

A new sentence in section 52 second paragraph of the Norwegian Patents Act:

#### **Section 52 first paragraph**

A patent may be *fully or partially* invalidated by a court decision if:

1. it has been granted in spite of the fact that the requirements under sections 1-2 are not complied with;
2. it relates to an invention the description of which is not sufficiently clear to enable a person skilled in the art to carry out the invention on the basis thereof;
3. it contains subject matter which was not disclosed in the application as filed;
4. the scope of the protection of the patent has been extended after grant of the patent; or
5. after a request for patent limitation, the patent has been amended in such a way that the scope of protection has been extended.

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## 4. 2008 Amendments of Patents Act (4)

Section 52 first paragraph, last sentence

*If the patent is partly invalid and it can be maintained in limited form by amending the patent claims in accordance with a request from the patent holder, the patent shall be maintained in accordance with the request filed.*

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## 4. 2008 Amendments of Patents Act (5)

Section 52 Fifth paragraph

*A court decision made in pursuance of the first paragraph shall take effect from the date on which the patent application was filed.*

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## 4. 2008 Amendments of Patents Act (6)

- Scope: the provisions apply to Norwegian and European patent alike
- Partial invalidity: no change in the substantive law. As before, the Courts may strike out some claims, whilst others are upheld. Unclear if submission of a specific request is required on the part of the patentee defendant for this to occur. Possibly sufficient to enter a plea for the court to reject the plaintiff's request (=patent entirely valid) and to argue that even if the main claim is found to be invalid, dependant claims x, z and y are valid.
- Amendment of claims: request from patentee is required, if patentee fails to request a specific amendment, the court can not do it for him.

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## 4. 2008 Amendments of Patents Act (7)

Patents Act is silent with regard to practical and procedural issues concerning requests for claims amendments.

Provisions of the Civil Disputes Act (civil procedure act) will apply, and guidance can be sought for in the preparatory works to the EPC accession amendments.

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## 4. 2008 Amendments of Patents Act (8)

The preparatory works

The Bill (Odelstingsproposisjon nr. 33 (2006-2007) comments on the proposed amendment:

*The second sentence of the first paragraph is new, and gives the patentee the opportunity to limit the patent by amending the patent claims in a patent cancellation action. The background for this is a requirement in art. 138 no. 3 of the European Patent Convention that the patentee should have this opportunity, and that in the event of such a limitation the proceedings are to be based on the limited patent. The purpose of the provision is to allow a patent that is only partly invalid, to be upheld [to the extent it is not invalid]. If the patent is invalid in its original form, by means of the amendment the patentee will have the possibility of limiting the patent during the court proceedings, so that it may be upheld in amended form. It is presently not possible to amend patent claims during court proceedings concerning the validity of a patent.*

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#### 4. 2008 Amendments of Patents Act (9)

*A limitation will only be possible if the patent is partly invalid, and if the requested limitation corrects this. Thus it is a requisite that the patent in amended form fulfils the conditions for patentability. During court proceedings there can be no other limitations than those correcting the invalidity. Further it is a condition that the limitation should occur by an amendment of the claims, and that the amendment entails a limitation of the scope of protection of the patent.*

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#### 4. 2008 Amendments of Patents Act (10)

*For example, the amendment may consist in combining a main claim with one or more dependent claims or parts of such claims. Further, the amendment may consist in transferring limitations from the specification into the patent claims. However, it is not possible to amend the specification itself. Only the patentee may file a request for a limitation. Even if the patent can be upheld if its claims are amended, the court can not base its decision on an amendment not requested by the patentee.*

*If the patentee has requested an amendment, that amendment is to be relied upon when testing the patentability, if the patent can not be upheld as originally granted. If the patent can be upheld with the amendment, in the judgment the court must set out the extent to which the patent is to be upheld, and that other than that, it is invalid.*

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## 4. 2008 Amendments of Patents Act (11)

### 4.2.3 Important and practical issues

- a) Form for requesting an amendment: statement of claim that includes requested wording of patent claim
- b) At what stages? Before end of preparatory phase of litigation, in special situations later. On appeal.
- c) Auxiliary requests? Yes
- d) More than one auxiliary request? Yes, but probably not successive auxiliary requests

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## 4. 2008 Amendments of Patents Act (12)

e) In infringement proceedings? Not unless they are joined with revocation proceedings

f) Effects for third parties:

- Amendment is effective *ex tunc* and *erga omnes*.
- Damages awarded and paid for infringement: case in which damages were awarded can be re-opened and judgment reversed so that damages can be reclaimed.
- License fees can probably not be reclaimed, subject to interpretation of license agreement.

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#### 4. 2008 Amendments of Patents Act (13)

g) Impact of availability of claims amendment in court proceedings on parties' interest in EPO administrative limitation procedure:

Advantages to patentee of EPO limitation procedure:

- i) procedure is *ex parte*
- ii) procedure is available regardless of pending Norwegian invalidity proceedings, which may be stayed

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#### 4. 2008 Amendments of Patents Act (14)

Advantages to patentee of Norwegian administrative limitation procedure:

- i) procedure is *ex parte*
- ii) procedure is available regardless of pending invalidity proceedings, which may be stayed
- iii) Claims and specification may be amended
- iii) procedure allows for "parallel" limitation (in Norway) of European patent and Norwegian patent (if relevant)

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#### 4. 2008 Amendments of Patents Act (15)

Advantage to patent owner of claims amendment in revocation proceedings:

Challenged patent can be defended by submitting a number of auxiliary requests very late, without unconditionally giving up granted claims (as in administrative limitation procedure)

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#### 4. 2008 Amendments of Patents Act (16)

Unresolved issues:

- Preparatory works appear to assume that court first decides on validity of patent as granted, then the patent owner may file for amendment. Not in accordance with procedural practice. File amendment as an auxiliary statement in the case.
- Preparatory works appear to mean that court should ensure no limitations that do not correct invalidity are introduced. Probably not intended in the strictest sense. Patent owner may limit claims "more than strictly needed".

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## 4. 2008 Amendments of Patents Act (16)

Unresolved issue:

Prior use by third party who has read patent as granted and relies on claims being invalid. Should he be entitled to continue using the invention after an amendment? Not discussed in preparatory works.

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## 5. Fundamental problem

- Increased uncertainty for third parties when permissible amendments include reformulations of claims and introduction of features from specification
- Departure from the principle that the scope of protection is defined by the claims - Art. 69 EPC and sec. 39 Patents Act ?

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Thank you