

**IN SUMMARY**

- A first attempt at harmonizing European Patent law was made in 1973 through the European Patent Convention
- The scope of the EPC is limited. It provides harmonised rules for the procedure of granting European patents but the post grant life of a European patent still remained a purely national affair
- A completely revised EPC will enter into force providing stronger harmonization on various levels. The revisions are referred to as “EPC2000”

**AUTHORS**

**Otto Swens** (left) is a partner at Vondst Advocaten. His practice focuses on patents and pharmaceuticals & life sciences. Otto advises and litigates in all fields of industry, but particularly in the field of mechanical engineering, medical devices, pharmaceuticals and chemicals.

**Hidde Koenraad** (right) is a senior associate at Vondst Advocaten. Hidde litigates and advises on all aspects of intellectual property, including patents, trademarks, copyrights and design rights. Hidde has a particular interest in national and community plant variety rights.



# You can make a change!



 *EPC2000 introduces centralised post grant amendment of European Patents*

**Otto Swens and Hidde Koenraad of Vondst Advocaten** explore the ‘EPC2000’ and its various procedural changes

**A** first attempt at harmonizing European Patent law was made in 1973 through the European Patent Convention (EPC). The EPC introduced the European patent creating the possibility to file an application for a European patent, whereby the applicant simply designates the European countries where he wants his invention to be protected. However, the scope of the EPC is limited. It provides harmonised rules for the procedure of granting European patents but the post grant life of a European patent still remained a purely national affair. This lack of substantive harmonization together with the difficulties in obtaining effective cross-border relief has hindered patent law in Europe. As per 13 December 2007, however, a completely revised EPC will enter into force providing stronger harmonization on

patents with different contents in designated countries.

The new limitation and revocation procedure is interesting in particular as it applies not only to European Patents granted on applications pending at, or filed on or after 13 December 2007, but also to European Patents that were already granted at the that date.

### Limitation and revocation procedure

The new rules for post grant amendment are laid down in Articles 105a-105c EPC2000 and provide for a central (European) limitation procedure. On the basis of this procedure the owner of a European patent can, subject to payment of a fee, limit the claims of its patent *ab initio* at any time after grant.

the scope of the patent is restricted accordingly in each of the designated countries (subject to the fulfilment of the validation requirements in each Contracting State). As the limitation procedure is an *ex parte* procedure and since a full (re-) examination is not made, the examining division is generally expected to issue its decisions quickly.

There will be no procedure for third parties to intervene in the amendment procedure. However, Article 115 EPC2000 provides that third parties can submit so-called 'third party observations' in any procedure pending before the EPO and, generally, it is thought that this will also be possible in limitation procedures.

After the EPO has communicated to the patent owner that the limitation is accepted, the patent owner is requested to file a translation of the amended claims and to pay the fee for printing. The patent owner thus has the opportunity to examine the version of the patent intended for publication. Any obvious mistakes or typing errors may be rectified on request. Obviously, the patent owner can then not make any substantive amendments to the claims anymore. Upon publication of the mention of the decision to limit the European patent, the EPO will also publish an amended European patent specification containing the new version of the claims, a translation of these claims in the official languages of the EPO and, where appropriate, the description and drawings as amended<sup>3</sup>.

In accordance with the revised Article 68 EPC2000 the European patent is deemed not to have had effect, as from the outset, to the extent that the patent is revoked or limited. This uniformly establishes the retroactive effect of limiting or revoking a European patent in opposition, limitation and (national) revocation proceedings. The revocation of European patents now has an *ex tunc* effect in all contracting states and it formalises the harmonisation in that respect. When the decision to accept the amendment of the European patent takes effect, the effects of the European patent are thus cancelled *ab initio* in full or in part in respect of all the contracting states in which it was valid<sup>4</sup>. If, however, prior European or national rights are invoked during the limitation procedure in respect of certain Contracting States, the patent may be limited for these states only by means of a separate set of claims.

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various levels. The revisions are referred to as “EPC2000”.

Besides various procedural changes, EPC2000 introduces simplification of the medical use claim format, a doctrine of equivalents, the possibility of claiming priority from applications filed in non-Paris Convention countries, the possibility for Board of Appeal decisions to be reviewed and last but not least a procedure for amending European patents post grant through the so-called “limitation and revocation procedure”. This possibility was missing until now. A patent owner who wanted to amend his granted European Patent had to pursue this through the national laws of the EPC Contracting States. This made it difficult for the patent owner, because, as so often, the national laws of the EPC Contracting States in this respect show great differences, meaning that an amendment that could be acceptable in one Contracting State may be unacceptable in another. This situation forced the patent owner to adopt a different amendment strategy for every EPC Contracting State, in a sense changing his European patent to national

Rule 92 of the Implementing Regulations sets out the criteria for admissibility. An important restriction is that a request for limitation may not be filed while opposition proceedings in respect of the European patent are pending<sup>1</sup>. The priority given to opposition proceedings prevents limitation procedures occurring where an opposition has already been filed. The procedure to be followed in situations where opposition proceedings are initiated *after* a request for limitation or revocation has been filed by the patent owner is also laid down in the Implementing Regulations: if revocation is requested, these proceedings continue and the patent may be revoked, but if limitation of the patent is requested, these proceedings are to be terminated.

The patent owner who files a request for limitation is not under obligation to give reason for this request. The examining division simply examines whether the limitation meets the requirements of clarity, added matter and extension of protection beyond the application as filed<sup>2</sup>. The examining division does *not* examine whether the subject matter of the limited patent is still patentable under Articles 52 to 57 EPC2000. If the limitation is accepted,

The decisions of the examining division in limitation procedures are subject to appeal, which appeals are heard by the Technical Boards of Appeal<sup>5</sup>.

### Relationship to national (revocation) proceedings

The Explanatory Remarks provide that the limitation procedure does not take precedence over national proceedings (revocation proceedings in particular). Where parallel cases do occur, the national proceedings can be stayed or continued in accordance with the provisions of the relevant national laws or practices. Where national proceedings resulting in limitation have already been concluded, the limitation may be extended to further

provided in 138(2) second sentence, to pronounce partial revocation by also amending the description and/or the drawings in the patent, is no longer included in EPC2000. Furthermore, Article 138(3) EPC2000 gives the patent owner the right to limit the patent by amending the claims in proceedings before the competent Court or authority relating to the validity of the European patent.

### What is the expected effect on national laws?

An interesting question is to what extent the post grant amendment rules in the EPC2000 correspond to the national laws of the Contracting States on post grant amendment. To give a first impression, we hereby summarise the current national rules on post grant amendment of six important patent jurisdictions in Europe,

art on the priority date, the conclusion that the patent should only have been granted including the restriction comprised in such addition and that for this reason it was valid within the stricter limits to be concluded from this.

It is important to note that the Dutch Court will not only amend a patent at the request of a patentee, but it can also amend a patent *at its own account* if it believes that a patent is only partially valid and the patent owner has not proposed amended claims. This approach to post grand amendment seem to correspond to a large extent with the post grant amendment rules in EPC2000, although it appears the conditions in the Netherlands are slightly stricter. Substantial changes of the Dutch approach in view of the new rules in EPC2000 are, however, are generally not expected.

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namely the Netherlands, UK, Germany, France, Italy and Spain. We also discuss whether it is likely that these rules will change with the entry into force of the new EPC2000 post grant amendment rules on 13 December 2007<sup>6</sup>.

### The Netherlands

The Dutch Supreme Court in 1996 rendered its landmark decision *Spiro v Flamco* in which it sets out criteria relating to post grant amendment. Partial invalidation and amended upholding of a patent is, according to the Netherlands Supreme Court, only permissible if it is sufficiently clear to the average skilled person who reads both the patent specification and prior art on the priority date, where the limits of the protection run which the patent offers as far as it is valid. This does not only require that an addition to the patent specification may be phrased afterwards, thus drawing said limits with sufficient clarity, but also that it concerns an addition which was already sufficiently obvious to the average skilled person beforehand to independently reach, on the basis of the content of the patent specification in conjunction with the prior

### United Kingdom

In accordance with s63(1) Patents Act 1977, UK parts of European Patents can be held partially invalid. The patent holder can apply to amend the patent at any time during the invalidity proceedings, but there are a number of procedural steps that need to follow, such as advertising the wording of the proposed amendments. The UK judge cannot change the words of the proposed amendments – it is up to the patentee to amend the patent so that it is valid and the judge will only decide on the wording that is before him. The judge can, however, arrive at one of a number of competing constructions of the amended claims. Currently, the UK Court can take into account the behaviour of the patentee, such as, for example, delay. The EPC2000 will probably change this position so the Court can only consider the substantive aspects of the amendments the consideration of discretion will be removed. Matters the Court will be able to consider are whether the amendments overcome the pleaded invalidity case and are permissible under the EPC.

contracting states via the centralised limitation procedure. The Explanatory Remarks emphasise that limitation of a European patent in proceedings before the EPO does not preclude further limitation in national proceedings.

The patent owner's right to limit a European patent in national validity proceedings is expressly laid down in Article 138 EPC2000. The new wording of Article 138(2) EPC2000 makes it clear that limitation and partial revocation of a European patent are always to take the form of a corresponding amendment of the patent claims. The possibility previously



## Germany

Currently, there are three possibilities in Germany for post-grant amendment, namely a voluntary limiting procedure, or in the course of an opposition or nullity proceedings. The prerequisites are that the claim:

- may not extend the scope of the protection of the granted patent;
- is not a replacement of the patented invention even though it might have been originally disclosed;
- was originally disclosed in the patent application as filed;
- would be understood to belong to the invention directly and unambiguously from the application by the skilled person in the art, and would not involve an unallowable change of category.

**“This procedure will improve *inter alia* the patent owner’s possibilities for eliminating (foreseeable) validity problems by amending the patent before (or while) enforcing it, without prejudicing the strength of its infringement claims”**

Germany has not yet ratified EPC2000, but it is expected to do so timely before 13 December 2007. The German approach to post grant amendment to a large extent corresponds with the new post grant amendment rules introduced in EPC2000. Substantial changes in view of the new rules in EPC2000 are not expected.

## France

French patent law also allows the possibility of limiting the claims of a patent in nullity proceedings. A distinction is made between national and European patents. If the French Court rules that a French patent is only partially invalid, it refers the case to the French Patent Office in order to redraft the claim(s) concerned in accordance with its ruling and stays the proceedings on infringement until the claim is amended. However, in several occasions the French Courts, before referring the case, immediately decided whether the patent was infringed or not. If partial invalidity relates to the claims of a European patent, it is not provided to refer the matter to the French Patent Office: the Court itself may amend the claim. In the last ten years only

occasionally the French Courts ruled that a claim was partially invalid and amended it accordingly. This concerned situations where the amendment was fairly straight forward. At the time of preparing this article, France is still in the process of ratifying EPC2000. One of the few changes to be expected in view of the new rules on post grant amendment in EPC2000 arises from the possibility for the patentee to bring limitation proceedings before the EPO if a claim for partial nullity of the French part of a European patent is brought in France. Case law will determine whether French Courts will accept to stay the nullity proceedings pending the limitation proceedings brought before the EPO. On the merits, the French approach to post grant amendment appears to

correspond with the new post grant amendment rules introduced in EPC2000.

## Spain

At the moment, the Spanish Patents Law expressly prohibits Spanish Courts to declare a claim partially invalid during the course of nullity proceedings. Even if only a part of the claim lacks novelty or inventive activity, that claim is invalid in its entirety, and it is not possible to overcome the invalidity cause by amending the claim. The possibility of amendment of claims will thus be new for Spain with EPC2000. At this moment it is difficult, if not impossible, to anticipate the way that the Spanish Courts will interpret EPC2000 and how the patent holder may amend a granted claim. However, although there is no case law on this issue, it is to be expected that the Spanish Courts will take into account the decisions of the Board of Appeals of the EPO on amending claims and also the examination Guidelines, especially Rule 80.

## Italy

In Italy, Article 79 of the IP Code provides that the patentee may file a motion with

the Italian Patent Office (IPO) to limit / amend the scope of protection of a granted patent. The amendment can concern the claims as well as the patent specification and drawings. In general, the amendment may not result in broadening the scope of the original claims and may not lead to a different invention. Combining the main claim with one of the sub-claims is allowed, just like a ‘retreat’ to sub-claims. Italy has not ratified the EPC2000 and it is, unfortunately, at this moment not clear whether Italy will ratify, let alone by 13 December 2007. Should Italy, however, ratify (in time) substantial changes to the Italian practice on post grant amendment are not to be expected as it corresponds already with the post grant amendment rules in EPC2000.

## Conclusion

The opportunity for central (European) post-grant amendment introduces an important change and creates a powerful strategic tool for European patent owners in (preparing) pan-European litigation. This procedure will improve *inter alia* the patent owner’s possibilities for eliminating (foreseeable) validity problems by amending the patent before (or while) enforcing it, without prejudicing the strength of its infringement claims. The change is important in particular as also current owners of European patents can benefit from this new procedure after 13 December 2007. We do note, however, that a limitation centrally at the EPO does not preclude the national Courts of the EPC2000 Contracting States to examine whether the limitation accepted by the EPO also meets the on occasion more stringent national criteria. It remains to be seen to what extent the post grant amendment rules and the related actual practice at the EPO will have a harmonizing effect on the various national post grant amendment rules of the EPC2000 Contracting States. 🌐

## Notes

1. Article 105a(2) EPC.
2. Articles 84, 123(2) and (3) EPC.
3. Article 105c EPC.
4. Article 105b(3) EPC and Rule 138 EPC2000.
5. Articles 21 and 106 ff EPC.
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