

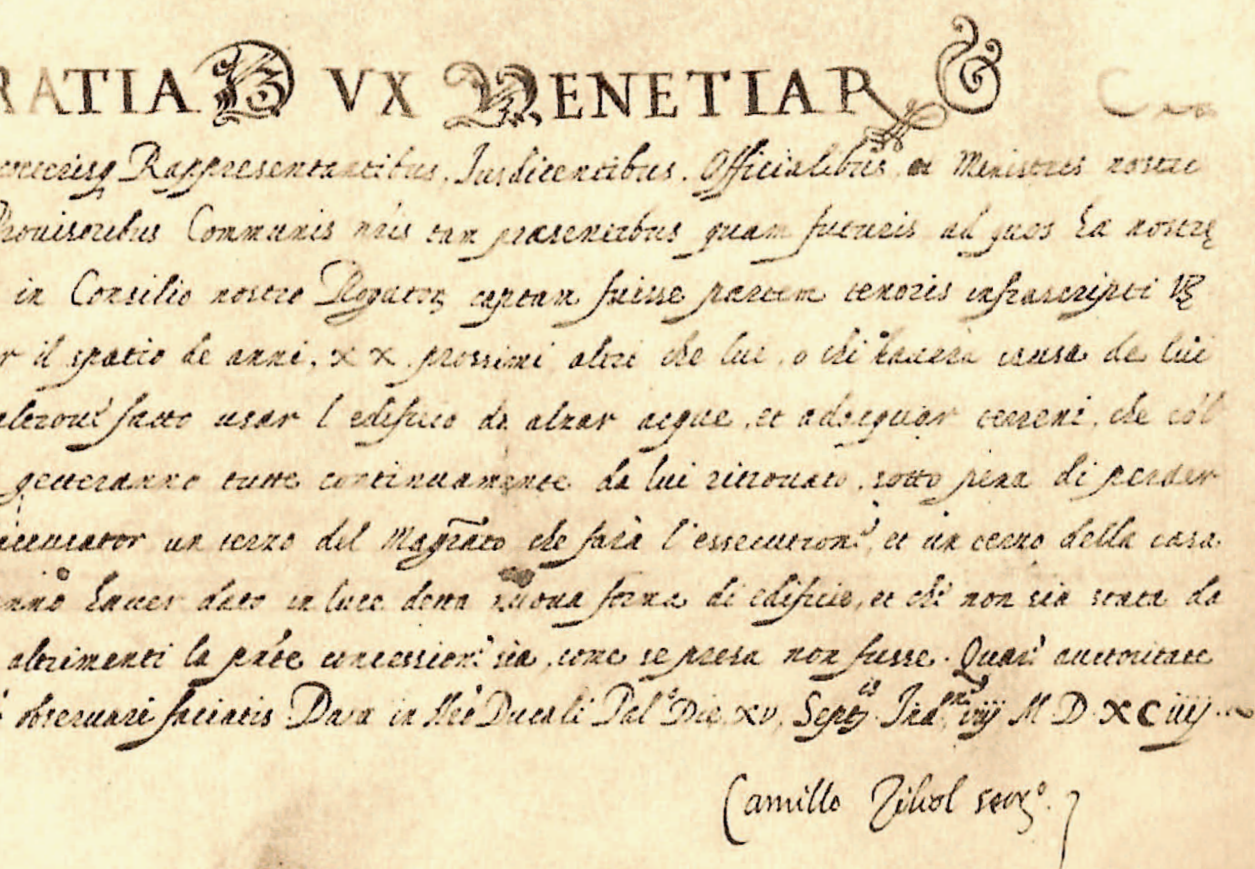
Claims Limitation in Patent Litigation

European Patent: A Variable Geometry Right?

Limitations and Amendments of Claims during Litigation

Contributions from Germany, UK, France, the Netherlands, Italy

Coordinated by Marina Tavassi and Robin Jacob



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Coordinated by Marina Tavassi and Robin Jacob

Editors: Thorsten Bausch, Mario Franzosi

to John Allen

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Cover: Patent granted to Galileo Galilei on September 15, 1594 for an irrigation apparatus.
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Dedication

Marina Tavassi, Presiding Judge,
Tribunale di Milano (Court of Milan)

I think that we can all remember the smiling face of John Allen and his brilliant presentation on the Dutch patent system in the meeting of 27-28 June 2014 in Milan.

We were all very shocked and consternated when reached by the news of his passing away together with his family in a tragic aeroplane disaster. He was killed along with his wife and three sons in the Malaysia Airlines Flight 17 crash. John, his wife, Sandra, and their sons, Christopher, Julian and Ian, were all aboard the flight that crashed in the Ukraine the 17 July 2014, a few days after our meeting.

Allen worked for the Law Firm Nauta Dutilh. In his professional life, he played a key role at the law firm in building the intellectual property practice group, where his expertise and skills in patent litigation and technology-related disputes were highly praised by his clients and peers, as reported by his colleagues.

During the Conference John offered us an example of his ability in the speech regarding the Dutch system on patents and amendments thereto.

Unfortunately these days we are all under threat because the terrorist attacks and international conflicts seem to be getting closer to us.

Moreover, when one of these tragedies occurs to a person with whom we have shared a social or cultural experience our sorrow is undoubtedly deeper.

In order to honour his memory, we would like to dedicate to John this book. It consists of the collection of reports about the limitations and amendments of claims during litigations, regarding very technical matters which allow us to compare our different ideas and national solutions.

This is a valid demonstration of the union of our countries, which is in my opinion the best way to commemorate our friend John.

Marina Anna Tavassi

Preface of the Editors

This book constitutes the proceedings of the conference “European Patent: A Variable Geometry Right? - Limitations and Amendments of Claims during Litigation” held in Milano on 27 and 28 June 2014. The style of the various contributions as lectures or oral presentations, has been maintained, even where the lectures had to be translated from Italian into English.

The title of the conference “European Patent: A Variable Geometry Right?” or perhaps better “A Right of Variable Geometry” is itself not completely unambiguous, thus reflecting the nature of the legal problems that were discussed. On the one hand, a European Patent post grant (and after conclusion of EPO opposition and appeal proceedings, if any) is no longer a uniform right. It can be individually amended and limited in each designated state and thus indeed receive a ‘variable geometry’ in the sense of a different subject-matter and scope that may vary from country to country. On the other hand, the ‘geometry’ of a European patent may also vary over time, i.e. the patent may at least be narrowed at (almost) any time after grant and in some cases even after its expiry, since such limitations will have retroactive effect *ex tunc*, cf. Art. 68 EPC: “The European patent application and the resulting European patent shall be deemed not to have had, from the outset, the effects specified in Articles 64 and Article 67, to the extent that the patent has been revoked or limited in opposition, limitation or revocation proceedings.”

The two key questions arising in nearly every jurisdiction where amendments of patents are possible, are “when” and “how”. The first question is mainly one of procedural law and relates to the point in time when amendments are still possible from a procedural point of view. The second question goes to the substantive requirements of amendments or limitations to be allowed. This conference compared in Part I the solutions found at the European Patent Office (Articles 105a, 123 and 138 EPC) with the laws and procedures of five countries (Germany, France, Italy, the Netherlands and the UK). It turned out that the various systems, despite being fundamentally based on the same EPC provisions and the same overall concept, present various non-irrelevant elements of divergence, so that a unitary title of protection may indeed assume a different geometry when litigated in various countries.

Part II of the Conference was a mock trial on amendments to a fantastic patent directed at “cani e lupi” which was essentially developed by ***Michele Baccelli***, European Patent Attorney at Hoffmann Eitle Munich, in cooperation with and

based on the ideas of Prof. Mario Franzosi and Avv. Anna Maria Stein from Franzosi Dal Negro Setti, Milano.

Part III has a conclusory speech by **Judge Marina Tavassi**, Presidente Sezione Imprese Div. A di Tribunale di Milano, comparing the various legal systems and what can be learnt from them in regard to the specific procedure in Italy.

The editors are very much obliged and thankful to **Judge Marina Tavassi** and **Lord Justice Robin Jacob** for coordinating the conference and for allowing it to take place in the premises of the court of Milan. We wish to thank all the speakers and authors who contributed to the conference and this book. And two persons deserve being mentioned here with particular appreciation, as they were the true enablers of this successful conference: **Anna Maria Stein** and **Ing. Michele Baccelli**. Without their indefatigable efforts in the preparation and the smooth conducting of the conference, this success would not have been possible.

Munich and Milano, May 2016

Thorsten Bausch

Mario Franzosi

Part I

European Patent: A Right of Variable Geometry?

Limitation and Amendment of Claims during Litigation in Italy

Introduction by **Prof. Mario Franzosi**,
Avvocati Associati Franzosi Del Negro Setti

I am asked to introduce the argument. Let me do it on a general tone.

1. Just to start with, the Italian Supreme Court says that the scope of protection is determined by what is contextually described and claimed. This sentence does not bring us too far, or too ahead. What kind of contextual description is required? A literal or a logical correspondence? If the description says that Charles and David have two legs each, should claims mention Charles and David or all men and women? And can claims cover Charles and David or may they be extended to all mankind? I do not believe we should investigate too much: the sentence does not give sufficient light. If it postulate a substantial correspondence between description and claim, the sentence may be wrong. In fact, claims in a sense are broader than the description and in another sense are narrower.

Claims are broader because they are normally the generalization of a technical law, which is expressed in the description only exemplarily. If the description says that $2+1$ makes 3, $3+1$ makes 4, $4+1$ makes 5, claims normally make a generalization of what can be derived by the description, and say that the *addition of one unit to a number results in the number which is immediately successive*. As such, a claim covers also a number of 3223445 digits plus one.

However, claims can also be, and usually are, narrower than the description. If the description teaches the rule of addition and subtraction, but what is claimed is only addition, subtraction (even though described) is not claimed and not covered.

Let me make another example, which is pertinent for the mock trial to follow.

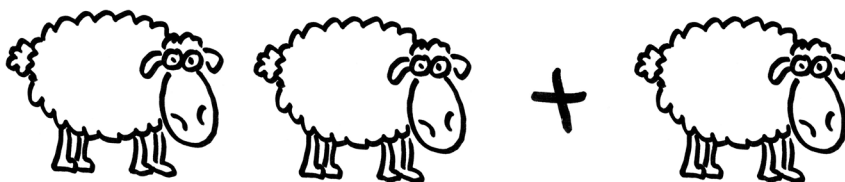
Suppose the description says:

one unit (e.g., one sheep) plus one unit (e.g., another sheep) makes two units,

and the claim says:

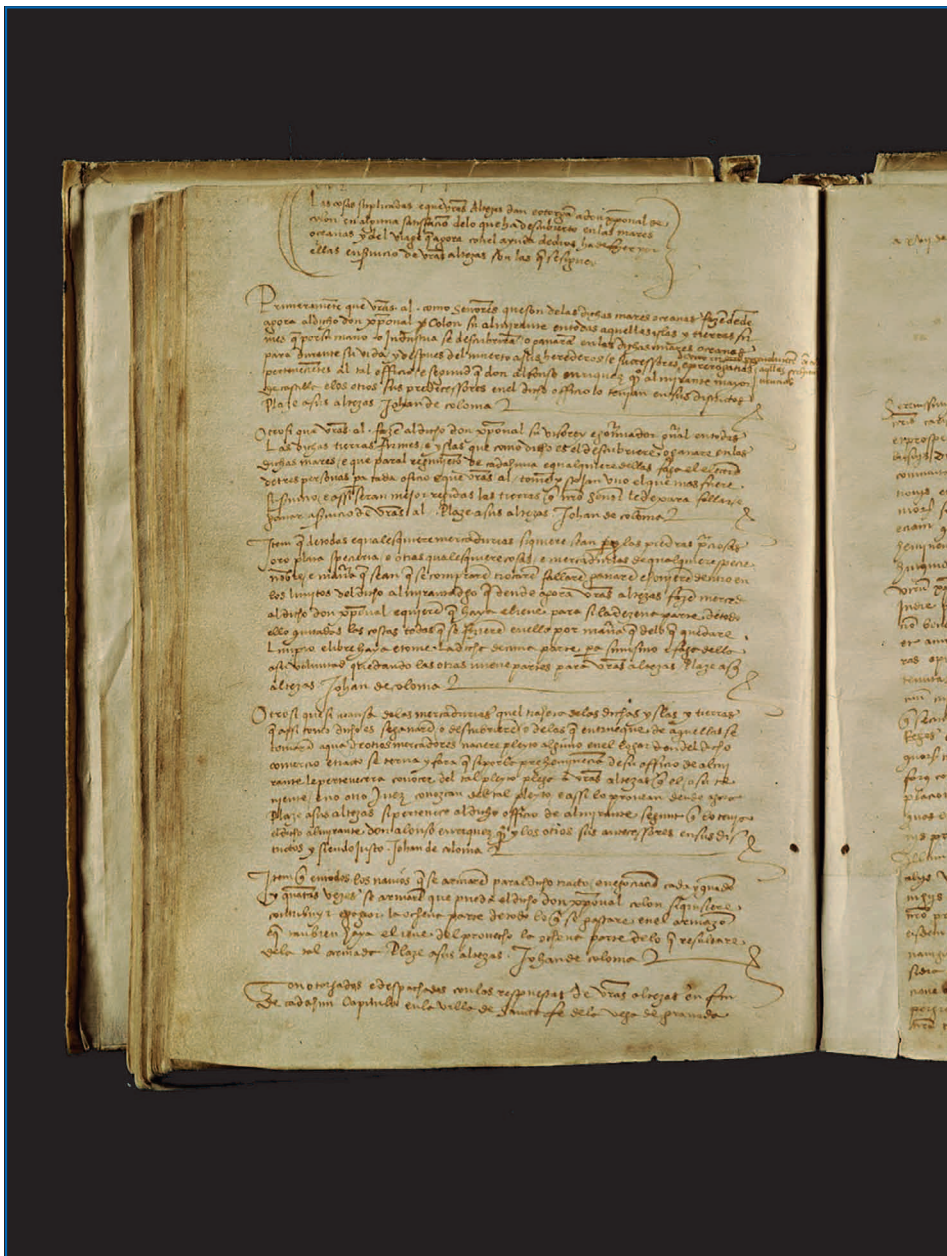
the addition of one sheep to a number of sheep results in the immediately successive number of sheep,

then a claim is narrower than the description in a sense and broader in another sense.



The task of the patent attorney consists in formulating claims. It is a most difficult task; nay, impossible. In fact claims remain fixed (carved in the stone) for 20 years, while technology evolves. Also languages evolve. What the patentee called *sheep*, may become *sheepgoat* after a while, and *goatsheep* after times. Genetic engineering has always surprises.

2. I want to mention here two significant cases in the past, where claim modification would have changed the course of events. One was the case created by the language of the **Capitulaciones de Santa Fé**, of April 17 1492. Christopher Columbus wanted to obtain from the Kings of Spain some concessions, as a compensation for his intended and expected achievements. The achievement consisted in ***buscar el levante por el poniente***, namely going West to reach East. The compensation (the monopoly granted, plus other benefits) was significant. Here are the Capitulaciones.



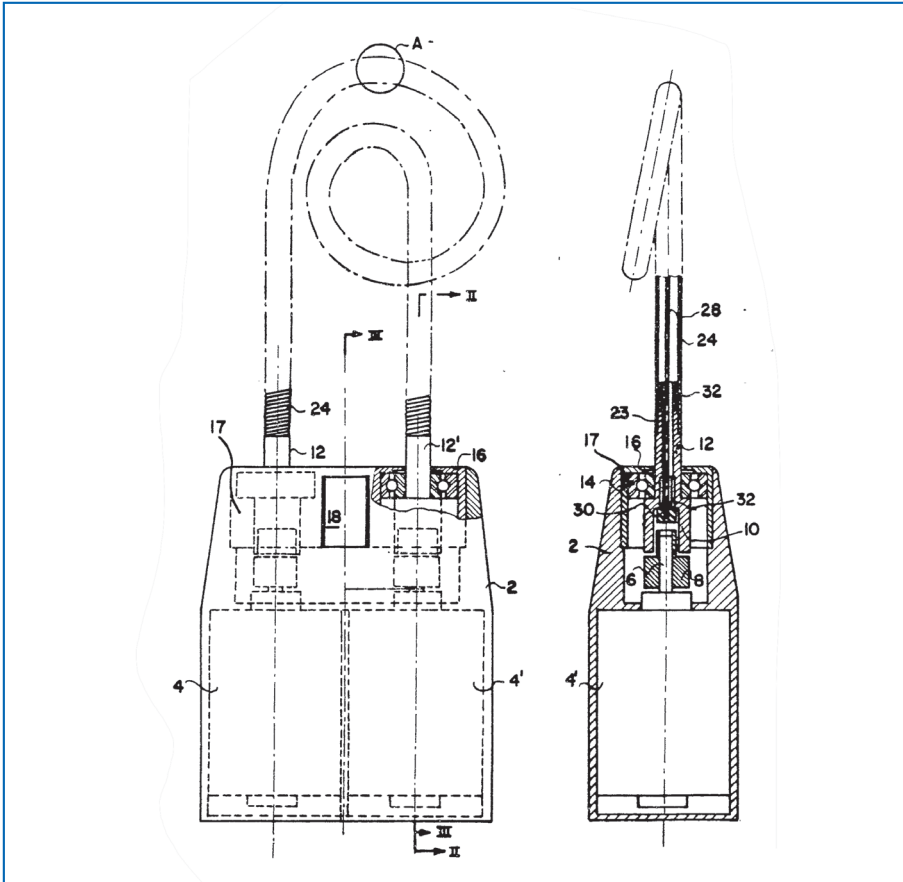
© Extract from the Capitulaciones de Santa Fé

You will see the various claims (*Plaze a Sus Altezas*) mentioning what Christopher wanted and what the Kings promised. The Altezas were too busy in the consolidation of their victories against Boabdil, and exhausted after the conquest of Granada, so they did not pay much attention to the rights granted.

The achievement, as you may know, was quite different from what was envisaged. The result would have justified a product claim (a *Nuevo mundo*, as Christopher had to acknowledge several years after the event), and not a process claim (*buscar el Levante por el Poniente*). So the specification did not correspond to what happened in reality, nor had Christopher a sufficient command of patent law, so as to be able to encompass everything that he discovered in the specification, and perhaps more. Therefore the Capitulaciones were a good example of how things should not be done. It was not possible to modify the Capitulaciones, and re-write the claims.¹ The Spanish law, before the advent of the EPC 2000, did not allow claim modification after grant. As a consequence, the kings could say that what was described was not identical to what achieved in reality, so that they could disregard the promise, and also could advance (almost successfully) the argument that, in view of the poor wording, the Capitulaciones did not constitute a contractual right but a royal privilege (that could be revoked by the same formal process as it was granted). And Christopher was put in jail when he insisted for having his rights recognized. Excessive consequence, perhaps, of a poor wording of claims, but a good lesson for those who write claims. The matter was settled after decades of litigation: consequence of poor claim drafting. And the son of Columbus, Diego or Diogo, received, when the case was closed with a settlement, the hand of a niece of the King (not the daughter, as he wanted) and a couple of islands, including Jamaica: nothing special. A solution that could by no means be considered encompassed by the claims, nor equivalent to the literal wording. Poor claim drafting changes history, and the possibility of an amendment of claims would have rectified history. In fact, had claim amendments been admissible, America would have become a colony of Genoa.

1 My interpretation here diverges from Thorsten Bausch's opinion. Thorsten believes that the claim was properly written: no modification was necessary. The claim, Thorsten remarks in Spanish, covers "*el título vitalicio y hereditario de Almirante de todas las islas y tierras firmas que Colón descubriese o conquistase por su mano o industria en las Mares Océanas*". I refuse Thorsten's interpretation, that is an indirect accusation to the Reyes Católicos or (even worse) to their legal counselors.

The second case was the well known Epilady mess². Here the claims covered an helical spring: did this exclude a structure where the rings of the spring were substituted by thicker rubber bars? Perhaps a modification of the claims would have prevented the legal battle, conducted in scores of countries all around the world. The legal literature would have suffered, not to talk of legal bills..



EP O 101 656 B1

² Patent was found to be infringed in Belgium, Germany, Italy, the Netherlands and not infringed in England, Austria and France.

3. Coming to the item examined here, I do not want to add my considerations to those of others. Especially because I have more doubts than suggestions. The doubts derive from the remark that in the past the claims were fixed, and the patentee and the accused infringer knew what the issue was. But now the landscape is different; the weather is not clear. The object of the litigation changes during litigation. Let me make some remarks.
- a) What is the reason to write new claim during litigation? If the old claim was valid, why there is a need to introduce a new claim? Just for sake of aesthetics? If the old claim was invalid, how can the patent be revalidated? Why?
 - b) Art. 68 EPC, after the revision of Nov. 29, 2000, allows a modification of the patent with effect, as the article says “from the outset”. Quite disturbing, because in my view this results (in the great majority of cases, if not all) in giving validity *ex tunc* to a patent that was not valid when it was granted. What happens of investments (of money or, even more, of time – e.g., investment for researches -) made after publication of the patent, and before the claim modification, on the assumption that the claim was not valid or not pertinent? In practice, a right of exclusion arises at a certain time after the date of publication. It is another case of submarine patents.
 - c) A decision holding the patent invalid becomes almost impossible, when the patentee adopts a smart strategy. The patentee can always change the claim, even after grant, even after the expiration of the patent: apparently there is no time limit. A smart (perhaps, excessively smart) patentee can always avoid having his or her patent held invalid, by modifying claims one minute before a declaration of invalidity. Procedural rules may limit, but not prevent, possible abuses. When my case is discussed before the Supreme Court, and I realize that the judge rapporteur believes that my claim is invalid, I will say: *“Sorry, your honors: Let me write new claims. Let’s start again. If you believe we should go back to the first instance court, let’s go.”*

And if national procedural rules prevent this behaviour, I will say that these rules violate the EPC.³

³ Most countries have tried to exclude the possibility to change claims after a certain deadline. For instance, Prof. Sena believes that claims can only be modified at any time but not after the hearing for the final fixation of the questions of facts and law (*udienza di precisazione conclusioni*). First or second instance? Then, if the second appeal (Supreme Court) decision sends the case back to another judge for re-consideration, can the claim be amended?
In general, and more pertinently: can a national procedural rule reduce the possibility of the patentee to modify the claims?

Amendments of pending patent applications and granted patents in prosecution before the European Patent Office

Heli Pihlajamaa, Director Patent Law, European Patent Office

1. Introduction

The European Patent Office's practice in examining allowability of amendments under Article 123(2) European Patent Convention has often been discussed by the users of the system. On the other hand, when compared with decisions of the highest national courts in many of the contracting states of the European Patent Convention, a lot of similarities in the application of the main principles can be seen, as also discussed by the other speakers of the conference.

This article discusses the main aspects of the allowability of amendments at a general level. An overview is given on specific sub-issues like disclaimers, however intermediate generalisations and selection from lists are left outside this context. The principles derive from the explicit legal provisions in the European Patent Convention as well as from the jurisprudence of the boards of appeals of the European Patent Office, which are translated in a more concrete form to the practice of the search, examination and opposition divisions. The practice is described in a non-binding manner in the Guidelines for Examination in the European Patent Office⁴.

The European Patent Convention (EPC) provides for the possibility to amend the patent application (or granted patent) within certain limitations. Those limitations apply to the time of amendments and to the scope of the amendments.

⁴ Both the Guidelines for Examination and the decisions of the Boards of Appeal cited below can be found via the website of the European Patent Office www.epo.org

2. Scope of amendments during the application stage under the European Patent Convention

Regarding the scope or content of the amendments the framework is established in the fundamental principles of the European patent system. Since the patent system in Europe is based on the first-to-file approach, the content and teaching of the application at the time of filing sets the outer limits for the obtainable scope of protection. The teaching of the patent application is what is understood from it by third parties (more concretely by a person skilled in the art) and not what the drafter or the inventor meant when writing it. The case law teaches that it must be possible to reproduce a claimed step using the original application documents without any inventive effort over and above the ordinary skills of a practitioner⁵. These principles are transcribed inter alia in Articles 83 and 123 EPC. The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The amendments to it may not lead to subject-matter which extends to subject-matter beyond the content of the application as filed.

The restrictions for the scope of amendments serve two purposes. Firstly, they protect the interests of the third parties and public relying on the content of the application as filed⁶. Second, an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed because that would mean unwarranted advantage for the applicant and could be damaging to the legal security of third parties relying on the content of the original application⁷. In fact, for example, the public could otherwise be faced at a later stage with claims which extend beyond what was disclosed in the application as filed and published for the information of the public⁸.

According to the established jurisprudence of the Boards of Appeal of the EPO the so-called gold standard is applied for the assessment of the allowability of amendments. It is essential, when deciding on issues of added subject-matter, to identify the technical information that the skilled person, on the date of filing, would have objectively derived from reading the entire original disclosure, including description, claims and drawings⁹. For identifying the subject-matter the recent

5 Decision T10/86 of the Boards of Appeal of the EPO

6 Decision T187/91 of the Boards of Appeal of the EPO

7 Decision T392/89 of the Boards of Appeal of the EPO

8 see Decisions G 1/93, OJ 1994, 541, point 9 of the reasons and T 740/91, point 2.5 of the reasons and T 1927/10 of 19.10.2012, Point 1.1.2 of the Reasons

9 see Decisions G 3/89, points 1.4 and 2 of the reasons; G 2/10, OJ 2012, 376, point 4.3, first full paragraph of the reasons

case law has clarified that the disclosure is relevant¹⁰. This principle correlates with the original intention of the legislator. According to one of the founding fathers of the European Patent Convention, Mr van Empel “the application taken as a whole is a reservoir from which the applicant is free to scoop out contents at will in view of amended claims, description and drawings”. During the drafting stage this was partially seen as a very liberal stand. However, it was concluded that the alternative would be almost inevitably for applicants to keep their options open by filing claims drawn up as widely as possible. This was seen as harmful for the third parties (and the granting authority) since there would be less certainty about the actual scope of the claimed subject-matter (and thus less certainty about what is to be searched).¹¹

An amendment is not allowable if the overall change in content of the application results in the skilled person being presented with technical information that is not directly and unambiguously derivable from the whole content of the application as filed. Generally, the “disclosure test” can be said to mean that when the comparison is not only limited to the claims but also to other parts of the application as filed there is the same invention. The consideration and assessment is similar as to when the novelty of subject-matter is compared to already existing state of the art¹². In practice one can ask if the amendment renders the claimed subject-matter presented in the application new over what was disclosed in the originally filed application documents.¹³

Thus far the principles concerning allowability of amendments are mostly uncontroversial in the practice. However, discussion arises often with regard to the phrases directly and unambiguously derivable. This is certainly an assessment to be taken in the context of each subject-matter and disclosure separately. For the gold standard, which has been established during decades and confirmed in several decisions of the Enlarged Board of Appeal of the European Patent Office¹⁴, the issue that matters is what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed. Under the gold standard the directly and unambiguously derivable has to

10 Decision of the Enlarged Board of Appeal G 2/10

11 M. van Empel: The Granting of European patents, Introduction to the Convention of the Grant of European Patents, Munich, October 5, 1973

12 see Decisions G 2/98 of the Enlarged Board of Appeal of the European Patent Office

13 The so-called modified novelty test and essentiality test are today more in the background for use if the gold standard proves insufficient. Thus, it is more the general principles of the gold standard that are applied, instead of argumentation on the basis of diversified variety of tests.

14 See Decisions of the Enlarged Board of Appeal G3/89, G11/91, G 2/10

be seen as subject-matter without providing a technical contribution¹⁵ and not contributing to the invention¹⁶. As the decisions of the Enlarged Board of Appeal cited here show, the same criterion is not only used for amendments but also novelty and priority assessment rests on the criteria of the directly and unambiguously derivable.

The jurisprudence teaches us that the whole content disclosure test under the gold standard might lead to the identification of subject-matter which has not been explicitly revealed as such in the application as filed but nevertheless derives directly and unambiguously from its content. Technical information which is clearly and unambiguously derivable from the original application can be explicit or implicit. Implicit disclosure means that subject-matter may be rendered obvious on the basis of the content of the disclosure. The term implicit disclosure relates solely to matter that is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned¹⁷. Thus, literal support is not required by the wording of Article 123(2) EPC¹⁸. This has been clarified also in the Guidelines for Examination in the EPO¹⁹. Instead of looking at the explicit wording there may be a need for technical assessment of the case under consideration, or more specifically an assessment of the overall technical circumstances of the individual case at hand. Here again, like in many other aspects of patent law and patent prosecution, the virtue of a person skilled in the art and his capacities or abilities to interpret the disclosure and teaching of an application comes to play a role.

Still, it needs to be taken into account that for determining the subject-matter directly and unambiguously derivable from the application as filed the standard of proof is set in the jurisprudence beyond reasonable doubt. There is a coherent practice in applying the said standard of proof. The standard of proof comes into play when, despite taking account of all available pieces of evidence, there is no conviction whether a decisive factor is true or false. The issues concerning interpretation of “directly and unambiguously derivable” have been discussed between the experts of the European Patent Office and the users. In those discussions the reasoning and advance clarification have been stressed. Clear explanations concerning the amendments²⁰ by the applicants allow the deciding bodies to easier determine the allowability of the amendment. Reasoning given to the applicant by the EPO is also a valuable asset to improve the quality of amendments.

15 see Decision G1/93 of the Enlarged Board of Appeal

16 see Decision G1/o3 of the Enlarged Board of Appeal

17 see Decision T583/o9

18 see Decision T667/o8, T2o96/o9.

19 See Guidelines for Examination in the European Patent Office 2o14, H-III, 2.1, H-IV, 2.3.

2o Rule 137(4) EPC gives a procedure for this purpose

Some specific attention is required when disclaimers are introduced in an application to exclude certain subject-matter from the application. Actually, in most cases a specific technical feature is excluded by means of a disclaimer. The disclaimer may be one which has been disclosed in the application as filed but it might also be that during the prosecution of the application a need arises to exclude a technical feature which was not part of the original disclosure of the application. However, irrespective of the category of the disclaimers, they have to be seen as amendments to the application. Thus, the general principles of Article 123(2) EPC universally apply.²¹ The criteria of Article 123(2) EPC is to be examined in addition to the restrictions for introduction of the non-disclosed disclaimers, which are allowable only in situations restoring novelty in specific situations or removing subject-matter which is excluded from patentability for non-technical reasons²². Especially in the last mentioned cases the Boards of Appeals have recently confirmed in several cases that the criterion of the general allowability of amendments applies. The specific circumstances justifying a non-disclosed disclaimer do not allow to revert from the general principle that the amendment needs to be directly and unambiguously derivable from the application as filed and should not take the third parties by accident.²³

3. Time of amendments

Moving more to the time of amendments it is established that no amendments are possible before the search report has been received²⁴. Thus, should the applicant wish to make some clarifying amendments to the claims as a reply to an invitation to reduce the number of independent claims in the same category²⁵ or to establish subject-matter for a meaningful search²⁶, the amendments to claims are to be confirmed or re-filed after the receipt of the search report. Any subject-matter excluded from search on the basis of the above-mentioned stipulations or otherwise cannot be added later into the claims²⁷.

For international applications entering the regional European phase several possibilities to amend the application documents serving as basis for the procedure in the European phase exist. The application may be amended before expiry of the

²¹ see Decision of the Enlarged Board of Appeal G 2/10

²² see Decisions G1/o3 and G 2/o3 of the Enlarged Board of Appeal

²³ see T 1441/13

²⁴ R 137(1) EPC

²⁵ R 62a EPC

²⁶ R 63 EPC

²⁷ R 137(5) EPC

31-month time limit for entry into the European phase and (further) amendments may be filed until expiry of the time limit set in the corresponding invitation²⁸ submitted by the European Patent Office after a valid entry into the European phase. The applicant has, however, also the possibility to waive such a further invitation in case there is interest of speedy proceedings with the application. As from 1st November 2014 more flexibility to amend the application documents exists in the sense that in case of a non-unitary application the applicant will be invited to pay further search fees for the inventions not searched during the international phase. Similarly, when a supplementary European search is to be conducted, the applicant will be invited to pay further search fees for the further inventions found. Therefore, when filing amendments, applicant must no longer take into account that only the first invention is searched in a supplementary European search, since this limitation is abolished. Moreover, if the EPO acted as ISA, applicants have no longer to take into account that only a searched invention can be pursued in examination, since also any invention searched upon payment of a search fee under amended Rule 164(2) may be pursued in examination, of course, respecting the requirement of unity of invention. The amendment of Rule 164 EPC enables more flexibility in amending the application and establishes equal treatment of all applicants in non-unity situations, irrespective whether they follow the international or the direct European route, and irrespective of their choice of ISA.

At the other end of the procedure the applicant should be wary to make the necessary amendments before the issuance of the intention to grant²⁹, since thereafter the admittance of amendments is limited by balancing the interest of obtaining a valid patent protection and the conduct of efficient procedure³⁰. At that stage it is recommended for the applicant to check the draft text with great care. After his approval of the text of the patent and the following grant, alterations are no longer possible³¹. Thus, the earlier practice for correction of errors in decisions is limited when it comes to the text of the patent³². The Enlarged Board of Appeal stated in its decision G 1/10 that if an applicant does not request reasoned amendments or corrections to the communicated text, where necessary, before it has been approved, then the responsibility for any errors remaining in that text after grant should be his alone³³. If a decision to grant contains an error made after the patent specification

²⁸ Rule 161 EPC which gives a time limit of one month

²⁹ R 71(3) EPC

³⁰ See Decision G 7/93 of the Enlarged Board of Appeal in which the argumentation was based on the multitude of earlier possibilities given to the applicant to make the necessary amendments or corrections. Therefore, after he had been informed about the Examining Division's intention to grant, the procedure shouldn't be unnecessarily prolonged but on the other hand the applicant should be given the possibility to react on new objections or issues which couldn't have been noticed before.

³¹ Decision G 1/10 of the Enlarged Board of Appeal

³² Rule 140 EPC

³³ G 1/10, point 11 of the reasons

has been approved by the patent proprietor, so that the granted text is not approved by the proprietor, then the patent proprietor is adversely affected by that decision and is entitled to appeal³⁴.

4. Amendments after grant

After the grant of the patent the possibilities to amend the patent are further limited in time and scope. In furtherance to the requirement that the scope of the claimed subject-matter may not extend beyond the content of the application as filed, a European patent may not be amended in such a way as to extend the protection it confers³⁵. This occasionally leads to situations, especially in cases of opposed patents, where the granted patent may not be amended so that its protection would again fall within the scope of the content of the application as filed, since such an amendment would, despite being within what is described in the application, go beyond the teaching of the claims as granted. In such situations the patentee finds himself trapped between the extension which has taken place during the prosecution and is leading to the revocation of the patent and the impossibility to amend the claims since any meaningful amendment of the claims would extend the protection they confer. This trap might be inescapable³⁶. During the opposition proceedings the patent proprietor may only introduce amendments occasioned by the ground of opposition, irrespective whether the relevant ground was raised by the opponent³⁷. Furthermore, amendments sustaining the patent over national prior rights are seen allowable. But, the patent proprietor may not use the opposition proceedings for tidying or improving the patent on aspects which are not grounds of opposition, like clarifying the description or claims.

Since the revision of the European Patent Convention which entered into force in 2007 the patent proprietors have the possibility to centrally limit the scope of the granted European patent in limitation proceedings³⁸. Any amendment, however, needs to be of limiting nature and fulfil the requirements of both Article 123(2) and Article 123(3) EPC, as their scope is explained above.³⁹ The compliance with the set requirements is examined⁴⁰. In positive cases the limitation of the scope of the patent applies to all contracting states of the European Patent Convention in respect of

34 G 1/10, point 12 of the reasons

35 Article 123(3) EPC

36 see Decision G 2/88 of the Enlarged Board of Appeal

37 Rule 80 EPC

38 Articles 105a-c EPC

39 A further requirement is the compliance with Article 84 EPC

40 Rule 80 EPC

which the patent has been granted. The limitation takes place only from the date on which the mention of the limitation decision was published in the European Patent Bulletin⁴¹. During the preparation work of the introduction of the central limitation possibility in the revised European Patent Convention it was much discussed if the effect of the limitation should apply *ex nunc* or *ex tunc*. However, out of reasons of rationality and legal certainty the effect was decided to take effect *ex nunc*⁴² but to have effect *ex tunc*⁴³.

Taken the possibility of amendments in opposition proceedings and the option for the patent proprietor to himself trigger the limitation proceedings, it can be seen that two possible arts of initiations of central proceedings after the grant of the patent exist. Firstly, the start of the pendency of proceedings during which the granted patent can be centrally amended may take place by opposition filed by a third party, namely somebody else than the patentee. Secondly, the patent proprietor can himself request limitation of his patent, thus starting the amendment process. During either the one or the other pending procedures an amendment is possible within the restrictions to the scope in compliance with Article 123(2) and Article 123(3) EPC. According to the most recent annual statistics⁴⁴, oppositions are filed against less than five percent of granted European patents. About one third of those oppositions leads to amendment of the patent and thus to maintenance of the patent in amended form. The option of central limitation proceedings is still rarely used, the number of requests for limitation stays at around hundred requests per year.

5. Conclusion

For the allowability of amendments standardised criteria leads in the large scale of examinations conducted by the European Patent Office to generally applicable expectations. Deviations exist mainly in the context of specific cases that introduce special technical features. It is to be concluded that whether an amendment of the application is directly and unambiguously derivable from the application as filed needs always a case-by-case assessment, taken through the eyes of the skilled person in the art.

41 Article 105b EPC

42 The travaux préparatoires for the revision of the European Patent Convention are available through the EPO website www.epo.org

43 Article 68 EPC

44 The last complete year for which statistics are available is 2013

Limitations and Amendments of Claims during Litigation

Italy

Prof. Giuseppe Sena, Studio Legale Sena e Tarchini

In our legal system, the activity of the technical experts is of the utmost importance and constitutes indeed an independent procedure, as part of the ordinary proceeding that takes place before the Judge.

This is a technical procedure governed by specific rules according to the civil procedure code (Articles 191 et seq.) and the industrial property code (Art. 121.5).

Therefore, in dealing with the issue of the amendment of the patent and in particular of the claims, one refers firstly to this technical procedure.

An amendment and limitation of the claims is in fact the result of the work of technicians, in particular the results which progressively mature in relation to the development of the debate between the various experts: the Court expert, of prime importance because he ends up being the third arbitrator in this procedure, but also the experts of the parties, whose contribution is often decisive.

I add incidentally that the trial system (Art. 121.5 Intellectual Property Code) permits the submission of novel documents during the technical procedure, after the preclusive terms of the pre-trial activity, and this fact explains why during the technical procedure, and therefore before technical experts of the parties and the Court expert, the content of the patent and the claims are rediscussed.

Nevertheless, despite the importance and the understandable centrality of this technical phase, in my opinion the principle remains steadfast that there is no limitation of the patent until the judgment is awarded. More specifically, only the judgment may amend and limit the claims.

Such judgment is ruled, amongst the others, by Article 77 of the IP Code which states that “*a declaration of nullity shall have retroactive effect*” and by Art. 123 of the

IP Code, which confers *erga omnes* effectiveness to the judgment which has been declared final.

Consequently many of the problems discussed here are overcome if one accepts the idea, which is in my opinion the only possible one as the correct interpretation of the rules, that the effective limitation of the patent claims only occurs when the judgment is awarded. Prior to this there is no limitation, but only the technical investigation, which consists in discussions, clarifications, additions and contributions which are not to be underestimated but which do not affect the content of the patent, which remains wholly unchanged until a final decision has been issued. In conclusion the limitation resulting from the amendment of the patent will occur only with the judgment: the declarations and the conclusions reached by the Court technical expertise have no legal significance until they have been accepted and implemented by the judgment.

This is a conclusion that I believe to be grounded on the interpretation of the combined dispositions of Art. 79.3 and Art. 76.2 of the IP Code. In fact Art. 79.3 gives patent holders the right to submit to the Court, in the course of a validity proceeding, amendments to the claims within the limits of the patent application as originally filed and not extending the scope of protection conferred by the patent as granted; therefore the patent holder may proceed to a limitation of the patent by subjecting it to the Judge. There is no provision in Article 79.3 as to what occurs after the patent holder asks the Judge for a limitation, but in such regard Article 76.2 expressly provides that in the case foreseen by Art. 79.3 the judgment is a partial nullity judgment, which limits and redraws the extent of the patent and establishes the novel claims resulting from such limitation. Therefore the definition of the novel claims resulting from the request for limitation by the patent holder is accomplished with the decision.

Considering the above to be correct, it results that the decision will have *retroactive effect and erga omnes* effect because it is a decision of partial nullity, according to Art. 123 of the IP Code.

These are the rules relating to the judgment on the limitation of the claims in a litigation for patent nullity which terminates with a decision of partial nullity.

This construction indirectly solves many of the problems that we have raised: for example if this proposed amendment of the claims by the patent holder may have alternative solutions. In my opinion this is not possible, because the patent holder has to propose a definitive amendment of the claims that constitute a change of the

claim. In my opinion it would seem difficult to request the Judge, according to Art. 79.3, alternative subordinated requests which could have been raised during the technical expertise, discussing with the Court technical expert, changing them and adapting them to the technical responses of the counterparts and so on, but not at the time when they are submitted to the Judge the limitations or amendments of the claims which, if granted, will then part of the definitive judgment.

This is one of the possible conclusions of the proceedings to revoke, amend or limit the patent, but we must also consider the hypothesis that the amendments as proposed by the patent holder are not deemed adequate, namely that the Judge maintains that the request for amendment of the claims is incorrect because, for example, it introduces material which is different to that which was present in the initial claim, because it extends the protection of the patent, or because anyway the Judge maintains that, notwithstanding this limitation, the patent is radically null or is partially null but for reasons other than those envisaged by the patent owner that amended it.

In these cases there will not be a decision which, according to Art. 79.3, establishes the novel claims as a result of the limitation, but it is the decision per se which, being a decision of partial nullity, fixes the limits of the patent, regardless of the indications of the owner.

Either in the event of a decision which grants the amendment proposed by the patent holder, either instead it concerns an autonomous decision made by the Judge about the validity of the patent, one arrives at a much easier solution that it might otherwise appear.

Before concluding, I would like to add one more consideration.

The third paragraph of Art. 79 IPC provides the possibility for the patent owner to submit to the Judge the proposal “*at any time and in each stage of the proceeding*” and this often a source of debate.

The time up to which the patent holder may advance its proposal for limitation is easily deduced from the term “*each stage of the proceeding*”. The interpretation of the different wording “*at any time of the proceeding*” is rather more sensitive, but it seems to me that the rule is so broad as to enable the patent holder to submit its limitation request until the hearing for the “*precisazione delle conclusioni*” (final claims statement), because, since this is the time in which the request is fixed, it is also set proposals for the amendment of the patent. Until then I believe that, given

the broad extent of the formula, the patent owner may again propose amendments and therefore I wonder if it is possible for the Judge to set narrower limits.

In conclusion, in my opinion it is necessary to clearly distinguish: on the one side the technical procedure which takes place through the activities of the technical experts and which develops from the formulation of the questions until the filing of the technical expertise. This procedure, as already mentioned, is carefully disciplined by various rules (Article 191 et seq. civil procedure code and 121.5 IP code); on the other side, the proceeding before the Judge, during which the rule allows the amendment of the claim by the patent holder (Art. 79 IP code), a proceeding which, in any case, terminates with a decision of partial nullity according to Art. 76.2 IP Code. A decision therefore with *retroactive* and *erga omnes* effect.

Amendments of Patents in Litigation

England and Wales

Lord Justice Robin Jacob, University of London

The subject matter is amendment of patents in litigation.

Before the European Patent Convention 1977, each country had its own patent laws, patent office and patent litigation procedure. Some countries allowed amendment of a patent in the course of litigation. Others did not. If they did, they did by different rules in different countries.

When the EPC came into force, we all aligned our patent laws⁴⁵. The unamended EPC contains some basic rules. There is a difference between amendment before grant and amendment after grant; amendment during prosecution was more liberal than amendment after grant.

Before grant, you could amend your claim as long as you did not go beyond the content of the application as filed:

A European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Art. 123(2) EPC).

After grant, another rule comes in. You may not have a claim that is wider than what was claimed in the patent as granted. In other words, you cannot make something that was not an infringement into an infringement.

⁴⁵ Very stupidly, every European government enacted its own system of novelty, obviousness and amendment etc. by giving it different section numbers in its own patent act. In reality, we all have the same law with different numbers. Personally, in court, I refer directly to the European Patent Convention. I ask counsel "is there any difference between the English statute and the European Patent Convention?" They say "no my lord" and I say "well then we can use those number can't we" and that makes it possible for our judges to be intelligible in other countries.

The UK position was that an amendment was in principle allowable provided it complied with certain conditions. It could be made by an application to the Patent Office and the patentee would have to disclose why he wanted to amend. However, if court proceedings were pending, the application could only be made to the court in the course of the proceedings (which were not bifurcated).

I turn to procedure. In my country, the rule is still quite strict: you must formulate your amendment as soon as you can and advertise the proposal. This is so that third parties that might be affected by the amendment can intervene in the proceedings to object. In the past, where a patentee tried to amend their patent too late, they were barred from amending it. In particular if he knew about a piece of prior art which affected validity and stood by, leaving his over wide claim on the register for a long time, he would not be allowed to narrow it later. The rationale behind this was that they had lost their chance because they had kept an invalid patent over the public. The invalid patent could not be saved by amendment.

However, as a result of European influence, our court has retracted from this approach which I think is unfortunate. The courts should encourage patent holders to amend when they know there is something wrong, instead of instead of leaving the public uncertain.

Then came the European Patent Convention 2000. This development has largely been a force for good. It allows the patent holder to amend the patent centrally at the EPO. If allowed, the amendment will apply in all countries for which the patent has been granted (and for the future unitary patent too), see Arts. 105a and 105b EPC.

But the system does have problems. Here is one. Samsung recently lost a case at first instance where the whole case had been fought on the existing claims. Before the main appeal reached the Court of Appeal, counsel for Samsung said to the Court of Appeal “we have applied to amend the patent in Munich, so delay the appeal”. The problem this makes for the European patent system is twofold: one, this enables a party to delay litigation and; two, the problem faced by the potential defendant who thinks the patent holder’s claims can be knocked out. In regard to the second of these two points, if the patent holder can amend at any time, the potential defendant now has to imagine more claims: he has to ask not only “are the existing claims invalid?”, but also “what possible valid claim could the patentee get by a narrowing amendment?”

Another problem is the tardy nature of EPO work. One would have thought that an application for central amendment could be done very quickly: all the examiner

needs is the patent as granted and the proposed amendment. He/she then checks (a) is protection extended and (b) is subject-matter added. There is no need to read any prior art, no need to hear other parties. Yet I fear the Office could allow this to be long and drawn out - probably because inadequate resources are applied to this serious subject. That will be a pity for I do not suppose there will be all that many applications for central amendment.

The importance of the golden rules - that the patent holder cannot widen the claim (i.e. you can't turn something in to an infringement that was not before) and that he cannot add matter⁴⁶ - must not be forgotten and remains in place for central amendment. Narrowing to dependent claims⁴⁷ causes no trouble at all. They are already in the patent for the public to see. It is when patentee amends to a new claim constructed from bits of the patent disclosure that there may be a problem. Of course there are limits to this: a combination claimed for the first time may well add matter and patent offices are reasonably alert to the objection. For instance they will not allow an "intermediate generalization." You should not underestimate the power of patent attorneys! They are paid to be clever and a lot of them are: for example, if they make the amendment in proceedings, there is no question about adding subject matter in contravention of Article 123 because you will be deciding Article 123 in proceedings.

Mario takes the view that this power of amendment at any time puts us to a sea of complete uncertainty. I do not go as far as that. It implies that we were in calm waters before which was not so. For example, lengthy opposition proceedings often mean that competitors do not know what the ultimate claims may be for many years anyway. They already have to try to predict the validity not only of the existing claims but of potential so-called "fall-back" claims. And in some countries, mine included, defendants already have to anticipate possible amended claims.

Nevertheless, the new European court will need to take action. It is going to have to discover for itself a lot of inherent powers because the hastily and clumsy way it has been enacted failed to put them in expressly. One of these may be a power to require patentees to identify its fall-back positions early and not to allow tardily created amendments e.g. between first instance and appeal. It seems to be to be legitimate to say that it is an abuse of process for a patentee to litigate all the way to a decision

⁴⁶ As I put it in a judgment, "cannot tell you anything more about his invention." It is because the rule is strict that I do not agree with Mario when he suggests the famous Epilady claim to a helical spring could be amended post-grant to a "hair-removing means" That would be telling you more about the invention - i.e. that you could use any means not just a helical spring.

⁴⁷ E.g. combining the features of claim 1 with the additional features of a claim 2 which reads " a device according to claim 1 having the following further feature ..."

at first instance and only then to propose amendments. A “put up” or “shut up” rule could be created by the court.

One word I would add as a little useful reminder is to commend the European Patent Office Board of Appeal White Book, seventh edition now, available on the internet for free. If you have a question whether you have got added matter, read through that and it will show you how it’s handled in European patent office.

The European patent office had an extra rule. It is a clever and good one. If you are not sure whether or not there is added matter, that’s not good enough; the patentee is not given the benefit of the doubt.

Limitations and Amendments of Claims during Litigation

England and Wales

Dr Penny Gilbert, Powell Gilbert LLP

Background

The law in the UK permits a patent, whether a GB national patent or a European Patent designating the UK, to be amended during the course of infringement or revocation proceedings (section 75, Patents Act 1977). The statute provides that such an application to amend “may” be allowed and therefore it is entirely within the discretion of the trial judge as to whether the proposed amendments are permitted.

In order to be allowed, however, the amendments proposed by the patentee must lead to valid claims. In particular they must be examined to ensure that they do not disclose additional matter that was not present in the application as filed (section 76(3)(a) Patents Act 1977); nor must they extend the scope of protection conferred by the patent (section 76(3)(b) Patents Act 1977). Furthermore, the proposed amendments to the claims must be supported by the disclosure in the specification and must not lack clarity. Nevertheless, the Court will only permit amendments to be made that are responsive, and appropriate, to the issues in the litigation and which do not result in procedural unfairness to the opposing party.

When amendments are allowed by the Court then they take effect *ab initio*, which may lead to questions regarding relief for infringement of such claims as will be discussed below.

Section 75 Patents Act 1977, which implements European Patent Convention (“EPC”) 2000, confirms that the court shall have regard to the relevant principles under the EPC. Accordingly, in *Zipher v Markem*⁴⁸ it was held by Floyd J that the same approach should be taken to amendment of patents in the UK as to

⁴⁸ *Zipher Ltd v Markem Systems Ltd* [2008] EWHC 1379 (Pat)

amendment in the EPO. Accordingly the UK court now has limited discretion to refuse amendments provided that they comply with the requirements for validity. Prior to this, an application to amend a patent in the course of UK litigation was seen as a request for equitable relief and therefore entirely within the discretion of the Judge. In particular, amendment could be refused if the patentee's past exercise of the Court's indulgence. For example, amendment could be refused where it could be shown that the patentee had delayed in seeking to amend claims that it knew to be invalid over prior art that it was aware of or where it had deliberately sought to enforce overly broad claims. These factors are no longer relevant considerations. Nevertheless the Judge still has discretion to impose conditions on the amendment being made. For example, the patentee may be prohibited from suing on acts of infringement committed prior to the amendment being made. Furthermore, it would be possible for the court to refuse amendment of the UK claims unless the patentee agreed to seek the same amendments in other jurisdictions designated by a European patent to ensure harmonisation. This would be a particularly relevant consideration in the context of parallel litigation on the same patent across multiple European jurisdictions.

The procedure for seeking amendment

In order to apply for amendment, the patentee must issue a formal Application Notice in the on-going litigation detailing the precise amendments that are sought and also the grounds upon which those amendments are considered appropriate. The application must be accompanied by a statement as to whether the patentee still maintains that the claims as granted are valid. Consequently, amendments may be proposed on a conditional basis (i.e. only taking effect if the patent as granted is held to be invalid) or on an unconditional basis (i.e. the validity of the patent will be determined entirely on the basis of the proposed amended claims). The application must also include a statement of reasons that sets out the patentee's explanation of the reasons for the amendments being sought.

Therefore, in addition to maintaining the granted claims the patentee may file multiple sets of proposed claim amendments, rather like the filing of multiple auxiliary requests in the course of EPO opposition proceedings. However the court tends to discourage the filing of too many new claim sets on the basis of unfairness to the alleged infringer and oppressive behaviour that would not be consistent with the Court's overriding objective of proportionality and fairness. However in *Inpro Licensing Sarl's Patent*⁴⁹ the court permitted three sets of claim amendments to be

49 Research in Motron Ltd v Inpro Licencing SARL [2006] EWHC 70 (Pat)

considered. It has yet to be determined where the limit of the UK Court's tolerance lies in the consideration of multiple auxiliary requests.

After filing, the Application for amendment must be served within 7 days on the UK intellectual property office (UK IPO) as well as on the other parties to the litigation. The amendment application must also be advertised in the Official Journal (Patents) so that any interested third parties also have an opportunity to respond to, and challenge, the proposed amendments to the patent in question. The requirement for advertisement may be dispensed with by the Court where all of the likely opponents to any amendment application are already parties to the litigation and, therefore, aware of the amendment proceedings. Otherwise, following advertisement, a Notice of Opposition must be filed within 14 days by any person seeking to challenge the amendments, including any third party that wishes to intervene in the proceedings. The Notice of Opposition must include details of the grounds relied upon to challenge the proposed amendments and must be served on all the parties to the litigation and the UK IPO.

The Comptroller of Patents (i.e. UK IPO) has the opportunity to comment on the proposed patent amendments and also to participate in the hearing at which the court decides whether they are allowable. Although the UK IPO tends not to participate in the amendment proceedings it has become increasingly common for the Comptroller to provide written observations as to the allowability of the proposed claim amendments but otherwise to leave it to the parties to fight out the issues before the Court.

Within 28 days of the advertisement of the proposed amendments, the patentee must apply to the Court for directions on the future conduct of its application. The usual procedure is for the amendments to be dealt with at the same time as the trial of the action. The case will therefore go to trial with validity and infringement being considered in the context of all the proposed claim amendments. This avoids the need for a separate hearing and the potential wastage of costs in duplicating evidence, arguments and educating the court in the relevant state of the art in parallel proceedings. A timetable is set down for any disclosure (i.e. documentary discovery) or evidence specific to the issue of amendment. This usually coincides with the timing of evidence and disclosure in the main proceedings.

With limited discretion to refuse amendment, the Court will focus upon the relevant principles of the EPC when considering the proposed amendment application. Nevertheless it may also apply its discretion in considering whether, for example, the proposed amendments are appropriate, necessary and procedurally fair. In

addition, the Court must decide whether the patentee has complied with the procedural requirements and whether the amended claims would be valid. In particular, the Court must assess whether the amendments add matter or extend the scope of protection.

Added matter / Extension of Protection

In considering the question of added matter (section 76(3)(a) Patents Act 1977), the UK court has a well-established test perhaps best summarised by Jacob J in *Richardson Vick's Patent*:⁵⁰

“I think the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.”

This was recently cited with approval by Floyd LJ in *AP Racing v Alcon Components*⁵¹ and was also applied by Jacob LJ in the Court of Appeal in *Napp v Ratiopharm*⁵².

According to section 76(3)(b) Patents Act 1977 the proposed amendment must not “extend the protection conferred by the patent”. Therefore the claims as amended must not be broader in scope than the claims as originally granted. The extension of the scope of an individual claim is not objectionable *per se* provided that the protection of the patent overall is not extended (*Siegfried Demel v Jefferson*)⁵³. However, amendments to the body of the specification, without any change to the wording of the claims, may themselves widen the scope of the claims if they expand upon the nature of the invention originally disclosed.

The Correction of Obvious Mistakes

It is possible for a patentee to seek amendment of the patent during the course of litigation, or otherwise, on the basis that there are obvious mistakes that need to be corrected. This does not require the formality of the procedure outlined above. Instead, the patentee can apply to make correcting amendments at any time. Nevertheless, the corrections will only be permissible if they do not add matter or

⁵⁰ *Richardson-Vick's Patent* [1995] RPC 568

⁵¹ *AP Racing Ltd v Alcon Components Ltd* [2014] EWCA Civ 40

⁵² *Napp Pharmaceutical Holdings Ltd v Ratiopharm GmbH* [2009] EWCA Civ 252

⁵³ *Demel (trading as Demotec Siegfried Demel) v C & H Jefferson & Anor* [1998] EWHC 324 (Pat)

extend the scope of protection. The question of whether the correction of a particular mistake is obvious will depend upon how it would have been viewed by the skilled person. Would the patent, on a proper construction, always have had the meaning that is proposed by the correction? In considering whether the patent contains a mistake, and to assess the intended meaning, the skilled person is deemed to be able to consult the prosecution file in order to evaluate any ambiguity (*Mölynlycke v Wake Forest*).⁵⁴

The Question of Timing

There is no fixed time by which an application to amend should be made during litigation. In infringement proceedings it would be usual, or advisable, for the patentee to wait until the defendant has given details of any prior art that they wish to cite against the validity of the patent and also until information has been provided on the allegedly infringing product and/or process.

Whilst there is no obligation upon the patentee to bring an application for amendment forward as soon as possible, nevertheless doing so late in the schedule for preparation of the case for hearing is potentially an abuse of process and may be procedurally unfair to an alleged infringer. Accordingly, the correct balance of fairness to the parties has to be determined. Whether an amendment should be allowed to proceed if it is only proposed close to the trial date will be a matter for careful consideration by the Judge on the facts of each individual case.

Amendment of claims after judgment

Section 63 (1) Patents Act 1977 provides that relief can be granted on the basis of a partially invalid patent. The patentee may therefore seek to amend the patent to delete those claims found invalid and to conform the specification accordingly. Where the application to delete invalid claims takes place after the Court of Appeal judgment it may be that disputes over conforming the specification, for example, are referred back to the High Court for consideration.

Although invalid claims may be deleted after judgment, a question arises as to whether the court will allow the re- writing of claims to validate them. Should the patentee be permitted a second chance to reformulate the claim language after

54 *Mölynlycke Health Care AB v Wakeforest University & Anor* [2009] EWHC 2204 (Pat)

judgment so as to obtain a valid form when it could have been put before the court at an earlier stage? Such a situation arose in the case of *Nikken v Pioneer*⁵⁵. There a claim including the feature “annular groove of predetermined depth” was found invalid. The patentee applied to replace the terminology with “annular groove of approximately 3 to 5 mm depth”. Jacob J held that it would be oppressive to put the defendant in the position of having to go through a new infringement trial, incurring additional cost and uncertainty, so rejected the amendment. The *Nikken* case was cited with approval in *Nokia v IP Com*⁵⁶ where it was held that re-writing the claim language after judgment would lead to a new trial that would be a waste of cost and unfair to the defendant. It is therefore not usually possible to re-write claims to a validating form unless the revisions are such that they would not create any new questions in respect of infringement so would not lead to a new trial and therefore not amount to an abuse of process.

Interaction of UK Claim Amendment with EPO Proceedings

When EPO oppositions are running in parallel with UK litigation it is very unusual for the UK action to be stayed, particularly where the parties assert that they require commercial certainty in a shorter timeframe than is likely with the EPO proceedings.

If a patentee has proposed various amended claim sets in the form of auxiliary requests in the EPO proceedings, or if there has been a decision from the opposition division revoking or limiting the granted claims, then it is very usual for parallel amendments to be proposed in the course of UK litigation. In fact, it has become the norm since this situation arises frequently.

If a decision is given by the Technical Boards of Appeal of the EPO then, obviously, the European patent claims are amended *ab initio* and so it is these amended claims that will fall to be considered in the ongoing UK proceedings. In circumstances where the TBA decision is given after the UK High Court’s judgment then the UK Court of Appeal will proceed with the case on the basis of the amended claims that were allowed by the TBA. This situation occurred, for example in the case of *HGS v Eli Lilly*⁵⁷. If the claims allowed by the TBA result in the need to reassess infringement then the Appeal Court may refer the case back to the High Court for reconsideration of infringement. This has potential cost implications for the parties,

⁵⁵ *Nikken Kosakusho Works v Pioneer Trading Co* [2006] FSR 4

⁵⁶ *Nokia GmbH v IPCOM* [2011] FSR 15

⁵⁷ *Human Genome Sciences, Inc v Eli Lilly and Co* [2011] UKSC 51

particularly where the patentee did not put forward those claims in the course of the UK litigation.

Impact of Central Limitation Proceedings at the EPO

Since December 2007 Article 105 (a) EPC has permitted central limitation of claims to be sought at the EPO any time after grant (unless an opposition is pending). How does that impact upon on-going UK litigation?

The situation first arose in *Samsung v Apple*⁵⁸, where the Court of Appeal had to consider how to deal with concurrent litigation and EPO central limitation proceedings. At first instance Samsung's patent had been held invalid. Before the appeal was due to be heard Samsung applied to the Court to have the appeal stayed pending the outcome of an application that it had made for central amendment at the EPO. Samsung confirmed that it had written to the EPO asking for expedition of the central limitation proceedings and gave assurances to the Court of Appeal that the amendment application would be pursued promptly. The application for central limitation was understandable in the context of parallel litigation being fought between the parties on the same patent across a number of European jurisdictions. The Court of Appeal considered that it would make no sense to proceed with hearing the appeal whilst the central limitation proceedings were pending. As the outcome of the EPO's review could lead to amendment of the claims *ab initio* then it that could result in a complete waste of costs for the parties in proceeding with the UK hearing. Accordingly, the Court of Appeal adopted a "wait and see" approach since there was no evidence that there would be any prejudice to Apple, the defendant, in any delay to final judgment. However, the Court noted that in such circumstances a defendant might be able to seek its wasted costs at a later date, particularly if amendment to the claims by the EPO made it necessary for a new first instance trial to be conducted to assess infringement. The Court of Appeal distinguished the facts in this case to the situation where an application for amendment was made under section 75 of the Patents Act rather than under the EPO limitation procedure. There is no reason why the patentee can be prevented, at any time, from making an application for central amendment to the EPO.

Subsequently, in *Starsight v Virgin Media*⁵⁹, Starsight applied to the EPO for central amendment of its patent claims shortly before the date set for the first instance trial.

58 *Samsung Electronics Co Ltd v Apple Retail UK Ltd Apple Sales International* [2014] EWCA Civ 376

59 *Starsight Telecast, Inc & Ors v Virgin Media Ltd & Ors* [2014] EWHC 1793 (Pat)

The Judge was asked to defer the trial date and agreed on the basis that there was no point in proceeding until the EPO had concluded its review of the claims. However, in that case there was no prejudice to the defendant since there was no pending question of infringement, only validity of the patent being an issue. Starsight agreed to seek expedition of the EPO amendment proceedings and to act promptly. However, the Judge noted that in coming to its decision on such circumstances the Court will resist any application for adjournment, pending central amendment, where it gains the impression that the amendment is being used as “*a device*” to gain procedural advantage and to avoid the trial being heard promptly.

In a more recent case, *Kennametal v Pramet*,⁶⁰ the first instance judgment had found the patent invalid. No appeal was filed but an application was made by the patentee to stay the order for revocation of the patent whilst it sought to amend the claims in a central limitation proceedings at the EPO. The Court refused to stay the revocation of the patent and noted that there were no concurrent proceedings in the UK and other European jurisdictions (unlike the situation in *Samsung v Apple*) and a final UK judgement had already been given. Furthermore the patentee had made no attempt to seek the same amendments in the course of the UK litigation. The patentee subsequently appealed this decision but shortly before that appeal was heard it settled with the opposing party. However, the Court of Appeal held that the points of principle raised were sufficiently important that the appeal should continue and ordered that the case should proceed with the Comptroller of Patents being given sufficient time to prepare a position on the issue. The outcome of that appeal is still awaited at the time of writing.

Recovery of Damages Following Claim Amendment

As explained above, where patents have been held partially valid then damages may still be recovered for the infringement of a valid claim according to section 62 (3) Patents Act 1977, including for the period prior to amendment. However, the Court must take into account whether, at the date of the infringement, the defendant knew, or had reasonable grounds to know, that he was infringing; whether the specification of the patent was drafted in good faith and with reasonable skill and knowledge; and whether the proceedings were brought in good faith.

60 *Kennametal Inc. v Pramet Tools SRO and Associated Production Tools Ltd* [2014] EWHC 1438 (Pat)

The Costs of Amendment Proceedings

In UK litigation the winner of a case is entitled to recover a large proportion of their legal costs. Formerly, where a patentee sought to amend its claims then the Court would automatically order the patentee to pay the defendant's costs of opposing the amendment, regardless of whether the amendment was allowed or refused. However, the current practice of the UK court is not so restricted. Costs are entirely within the discretion of the Judge: he may decide, on the basis of the facts and the way in which the case proceeded, as well as the ultimate outcome, whether to order the payment of some, all or none of the defendant's costs of opposing the amendment.

Conclusions

It is increasingly common for patents being litigated in UK proceedings to be the subject of parallel litigation in other jurisdictions across Europe and to be in EPO opposition proceedings. Consequently, it has become a matter of routine for patentees to apply to amend their patent claims in the course of UK litigation. Whilst this is nothing new, the advent of the possibility for central limitation proceedings at the EPO, which can be made at any time provided the patent is not still in opposition, has brought new challenges to the Courts in ensuring procedural fairness for both parties to the litigation. As the situation arises more often we can expect further guidance from the Courts as to when they will be prepared to stay proceedings, or indeed whether they will stay the effect of judgments, pending such central limitation requests.

Amendments of Claims during Litigation – Procedural Law

Germany

Dr. Klaus Bacher, Judge at the Bundesgerichtshof
(Federal Court of Justice), Karlsruhe, Germany

Compared to Italy, we have a completely different situation in Germany because we are quite familiar with patent amendments during litigation. In this lecture I will be focusing on procedural and formal matters, after which Mr. Bausch will talk on the substantive law on amendments.

To begin with, most of you will know that we in Germany have a special system, commonly called the ‘bifurcation system’. Bifurcation means that we have separate proceedings for validity and for infringement cases. Thus, validity is decided in the first instance by a special and unique court, the Federal Patent Court, whereas infringement is decided by certain designated civil courts spread all over Germany. There are twelve such first instance courts with special knowledge in patent matters. Amendments are normally dealt with in validity proceedings, but they can have an indirect effect on the infringement proceedings, and I will discuss this aspect towards the end of my talk.

As I said, amendments during nullity proceedings are nothing new in Germany. Until 2010 there were no special rules for amendments, or more precisely there was only one rule: It’s never too late to amend a patent. This could be done up until the final decision in the nullity case. This caused many problems, however, because nullity cases tended to last many, many years, and when in the last second the patentee amended his patent again, the case could perhaps be prolonged into another year. Therefore a new law governing nullity proceedings was introduced in October 2010, which included rules that are applicable to all amendments and generally deal with late-filing. As a result, there are now limitations to the right to restrict the patent and these limitations are quite strict.

The limitations apply as early as in the first instance of nullity proceedings. Since 2010 the Federal Patent Court is namely obliged (Sec. 83 German Patent Act) to

provide a written notification prior to the hearing; specifically the Court has to send the parties a statement setting out its preliminary opinion of the case so that the parties will be aware before the hearing of what the Court is thinking with regard to the case. So far so good for the parties, but there is a catch here: The Court may and always does set a time limit for a response to this notification. Within this time limit the patentee is free to amend the patent; he may amend it by way of his main request, or he may formulate one or two or plural auxiliary requests. But after this time limit has expired, the patentee will have difficulties amending his patent. It can even be said that this time limit is, in normal cases, binding and if the patentee has not amended the patent within this time limit, he will not be able to amend it afterwards. Of course there are exceptions to this rule, which are governed by the law. The first exception is if the opposing party is able to react immediately, without postponement of the hearing being necessary. In this case, an amendment will be possible even in the hearing, but this is very rare because most of the time the opposing party will rightfully say: I cannot react right now, I need additional time to deal with this amendment. If this objection is rightful, the amendment will not be permissible. Another exception is if the patentee has a reasonable, sufficient excuse for having filed the amendment late, but the excuse has to be very inventive. The third exception is if the patentee has not been instructed about the consequences of failure to observe this time limit. However, such instructions are normally attached to or included in each notification and therefore the parties should always have been properly informed, and this exception in practice does not apply.

As I have mentioned, we have had these new rules for about four years now, which is why we already have quite a few cases which deal with the allowability of amendments. Some of the first-instance decisions by the Bundespatentgericht (Federal Patent Court) and appeal decisions by the Bundesgerichtshof (Federal Court of Justice) are summarized here:

- Bundespatentgericht, 13 December 2012 – 10 Ni 6/11
 - Amendments during the hearing: rejected

- Bundespatentgericht, 12 April 2011 – 1 Ni 21/09
 - Amendments during the hearing: not rejectable if
 - there was no reason for amendments based on the notification according to Sec. 83
 - the Court had subsequently changed its opinion

- Bundespatentgericht, 28 February 2012 – 3 Ni 16/10
 - Amendments during the hearing: not rejectable if
 - the other party is given the opportunity to file a written answer after the hearing
 - and if no further hearing is necessary
- Bundespatentgericht, 12 February 2014 – 5 Ni 59/10
 - Amendments during the hearing, based on dependent claims: rejectable, but not rejected because the patent was declared null and void owing to obviousness anyway
- Bundesgerichtshof, 8 August 2013 – X ZR 36/12, GRUR 2013, 1174 – *Mischerbefestigung*
 - If the party's reaction to a notification under Sec. 83 is not sufficient, the Court is not obliged to issue a second notification.

I do not want to go into too much detail here, but I think the second decision on this list is quite important. As I said before, if there was a notification and the time limit to respond thereto has expired, the patentee may not normally amend his patent after this. However, if the Court later changed its opinion, i.e. if it expressed the opinion A in the notification, but later changed its mind to B, the patentee may, of course, still react once he has been informed about this change of opinion. This is because the patentee had no reason beforehand to amend the patent. If he suddenly learns of such a reason by this change of opinion, he may make an amendment even in the final hearing because in this case it was the “fault of the court”, so to speak, to issue a notification which later no longer applied.

The Federal Court of Justice has already issued a decision in this regard, and this stipulates quite strict rules that can be expressed in one sentence: There's no second chance! Thus, if there is a notification and the patentee had a fair chance to react to it, the Court is not obliged to issue a second notification if it finds the patentee's reaction insufficient. Therefore the patentee has to carefully read the notification of the Court and take it into account and he has to amend his patent if he thinks he can improve his position by such an amendment. However, he can only do this once, not twice nor thrice.

There are even stricter rules in appeal proceedings. Much depends on the first-instance proceedings. If the Federal Patent Court does not reject an amendment in the first instance, it will also be accepted for consideration in the second instance. On the other hand, if the amendment was rightfully rejected in the first instance,

it will not be admitted in the second instance either. However, if the rejection was erroneous, the amendment must be taken into account in the appeal proceedings.

The most difficult amendments are those filed for the first time in the appeal proceedings. In this regard, the general rule is that new amendments during appeal proceedings are not possible, except in three situations (see Patent Act, Sec. 117; Code of Civil Procedure, Secs. 529-531):

- the court of first instance has recognizably failed to consider an essential point which gave reason to make the amendment or has wrongly held this point to be insignificant,
- there was a defect in the first-instance proceedings, or
- the late-filing was not due to any negligence by the party.

The third exception is often cited when the adversary attacking the patent submits something along the lines of “well, I did another prior art search and found very interesting new patent applications of which I was not aware before”. However, such reasoning will not be considered to be sufficient. The party must submit not only that it became aware of something only late, but it must also explain why it was not able to get this information earlier. Therefore, it is very difficult to successfully achieve acceptance of one of these exceptions and to have new amendments accepted in the second instance.

As of yet, three major decisions have been issued by the Bundesgerichtshof in this regard:

- Bundesgerichtshof, 28 August 2012 – X ZR 99/11, GRUR 2012, 1236 – *Fahrzeugwechselstromgenerator*
 - New means of attack or defence in appeal proceedings may not be rejected if the party had no reason to file them in the first instance in view of the notification according to Sec. 83.
- Bundesgerichtshof, 28 May 2013 – X ZR 21/12, GRUR 2013, 912 – *Walzstraße*
 - If the contested decision is wrongly based on a too narrow interpretation of the patent, the subject matter of the patent may be limited to this scope during appeal proceedings.

- Bundesgerichtshof, 27 May 2014 – X ZR 2/13, GRUR 2014 – *Analog-Digital-Wandler*
 - An amendment may not be rejected if it is a proper reaction to a notification given by the court during the appeal hearing.

With regard to Sec. 83 of the Patent Code, quite the same applies as in the first instance: If the patentee had no reason to make an amendment in view of the first-instance notification on the grounds that the Federal Patent Court had committed an error in law or some such, the amendment can then be made in the second instance because it was again the first-instance court's fault that this amendment was not filed earlier. In such a case, the patentee must have the right to file for an amendment in the second instance.

Quite similar to this, if the first-instance court construed or interpreted the patent too narrowly and the Federal Court of Justice is of the opinion that the scope of the patent as granted is much broader than the first-instance court had assumed, the patentee may narrow its claims to accord with the interpretation of the first-instance court in order to adjust the scope of the patent to the decision of the first-instance court.

It might also happen that the first-instance court overlooked an essential point and the patentee only became aware of this in the second instance. Under this circumstance, the patentee may amend the patent even in the final hearing, just before the final decision. However, as I have said, these cases are exceptions and the rule is there may be no amendments in nullity appeal proceedings in the second instance.

Now let's turn to infringement proceedings in Germany. The general rule is this: The infringement court has to consider the patent to be valid as long as there is no final decision on revocation. Thus, the infringement judge may not decide whether the patent is valid. However, the judge does have the possibility to order a stay of the infringement proceedings until the nullity case has been decided. This is at the discretion of the infringement court and normally the court decides this question on the basis of the possibility or the chances of revocation of the patent in the nullity proceedings. Therefore, the infringement court will check whether the patent will likely survive the nullity proceedings or not. If the infringement court thinks the chances that the patent will be declared null and void are more than 50%, it will put the infringement proceedings on stay until the first-instance decision in the nullity case has been issued. If the patent is then declared null and void and this decision is appealed, the infringement proceedings will, of course, remain stayed until the

final decision by the Federal Court of Justice. If the Federal Patent Court dismisses the nullity case, infringement proceedings will normally be continued even if the decision on nullity is appealed.

How do amendments fit into this? As I said, the infringement judge must from the outset presume the patent is valid. This means, in theory, that even if the patent as granted is not defended in the nullity proceedings, the patentee may still base an infringement case on the granted version of the patent. However, in this situation, infringement proceedings will surely be stayed. To avoid this consequence, the patentee can limit his infringement action and base it on the amended version of the patent, even if the nullity case has not yet been finally decided. The infringement judge will then assess whether it is likely that the amended version will survive the nullity suit. If the judge finds it unlikely that even the amended patent will survive, he will stay the infringement proceedings. But if the judge is of the opinion that the amended version will probably survive, he will usually proceed with the infringement proceedings on the basis of the amended requests.

Quite the same rules are applicable to preliminary injunctions, however with one notable difference. Preliminary injunctions are normally granted only if the probability that the patent will be revoked in opposition or declared null and void in nullity proceedings is very, very small, i.e. not just less than 50%. I do not want to give a definite number here – but the likelihood of revocation or nullification must be much lower than 50%.

There has been one great exception to this, i.e. the famous “*Olanzapin*” decision (OLG Düsseldorf, 29 May 2008, 2 W 47/07, published in GRUR-RR 2008, at 329) that may be well known in other countries too. Here the patent had already been declared null and void by the Federal Patent Court, however the Higher Regional Court Düsseldorf still granted several preliminary injunctions. In the end the Düsseldorf court was found to have been right because in the second instance the patent survived. I am mentioning this decision for one specific reason: This is a very exceptional case. Normally, if a patent has been revoked in the first instance, it is very, very difficult to obtain a preliminary injunction based on this patent. The same applies if a patent is no longer defended in its granted form, but an injunction is sought based on the patent as granted. Thus, the only way to obtain a preliminary injunction is to introduce the amendments also during the infringement case and to build the infringement case on this amended version of the patent.

One word also about damages: Negligence is a pre-requisite for damages. However, quite strict requirements must be met for the defendant to show non-negligence.

German courts expect you to search public registers in advance for published rights of third parties. If you do not do this or even if you do and then decide to ignore a patent, you will be deemed to have been negligent and will have to pay damages. German case law is quite patentee-friendly in this respect. And even without negligence, the infringer is obliged to pay compensation based on license analogy. I have not found any decisions dealing with damages after amendments or establishing special rules for this situation.

If the patent has been amended and the additional features are not present in the contested device, no damages will, of course, have to be paid because there is no longer an infringement, neither for the past nor for the future. But if the additional features are present in the contested device, the infringer will normally have to pay damages according to the general rule that I have already mentioned. Even if the infringer can rightfully expect that the granted will be declared null and void he normally has to be aware that it might be upheld with a narrower scope. Therefore, it will be considered negligent to produce a product which has all of the features of the valid, but narrower scope.

What are the practical effects of our new law on nullity procedures? I think the most important effect is that the duration of appeal proceedings in nullity cases has been reduced from about four years to about 18 months. Thus, the second instance is now very, very quick. On the other hand, the first instance can last a little longer because a patentee who knows that he will no longer be able to amend his patent in the second instance may file more amendments in the first instance. In addition, the Federal Patent Court has a lot of work to do as it must now provide a preliminary opinion according to the new regulations. But, in general, the overall time of nullity proceedings has become shorter than before, and therefore the new law governing nullity proceedings seems to be a good regulation. In reaction to the increased case load, there has also been a change at the Federal Patent Court. They have established a further panel for nullity cases. There used to be five, now there are six panels (called “*Senate*” in German). The Court therefore now has 20% more staff to deal with nullity cases and they are trying by this also to reduce the time for first-instance proceedings. This improvement is still quite recent, only about 6 months old at the time of writing, which is why I cannot give you any exact numbers, but I expect that first-instance nullity proceedings will be shorter than they were before, and therefore that the overall duration of nullity proceedings will be much shorter than it used to be.

Limitations and Amendments of Claims during Litigation – Substantive Law

Germany

Dr. Thorsten Bausch, Hoffmann Eitle, München

Added matter issues are heard by various courts in Germany; hence, there is quite an abundance of case law in Germany on allowability of amendments, which is constantly evolving. The most important Supreme Court decisions issued so far⁶¹ are summarized in the following table:

- | | |
|--|---|
| • X ZR 51/72 – Alkylendiamine | • X ZR 135/04 – Multiplexsystem |
| • X ZB 10/88 – Crackkatalysator | • Xa ZR 158/04 – Crimpwerkzeug II |
| • X ZR 101/89 – Frachtcontainer | • Xa ZR 148/05 – Heizer |
| • X ZB 9/89 – Spleißkammer | • X ZR 27/06 – Hubgliedertor I |
| • X ZB 11/90 – Chrom-Nickel-Legierung | • X ZR 28/06 – Hubgliedertor II |
| • X ZR 109/90 – Linsenschleifmaschine | • X ZR 89/07 – Olanzapin |
| • X ZR 50/91 – Spielfahrbahn O3 | • Xa ZR 124/07 – Fälschungssicheres Dokument |
| • X ZR 76/93 – Bogensegment | • Xa ZR 149/07 – Fentanyl-TTS |
| • X ZR 49/94 – Rauchgasklappe | • Xa ZR 52/08 – Formteil |
| • X ZR 40/95 – Inkustierungsinhibitoren | • Xa ZR 70/08 – Maschinensatz |
| • X ZR 113/96 – Ventilbetätigungsverrichtung | • X ZR 75/08 – Reifenabdichtmittel |
| • X ZB 6/97 – Polymermasse | • Xa ZB 14/09 – Winkelmesseinrichtung |
| • X ZR 168/98 – Luftverteiler | • X ZR 43/09 – Integrationselement |
| • X ZR 184/98 – Zeitletogramm | • X ZR 88/09 – Elektronenstrahltherapiesystem |
| • X ZB 18/00 – Drehmomentenübertragungseinrichtung | • X ZR 3/10 – UV unempfindliche Druckplatte |
| • X ZR 226/00 – Momentanpol | • X ZR 31/11 – Reifendemontiermaschine |
| • X ZR 30/02 – Einkaufswagen II | • X ZR 117/11 – Polymerschäum |
| • X ZR 156/02 – Rückspülbare Filterkerze | • X ZR 130/11 – Verschlüsselungsverfahren |
| • X ZR 160/02 – Schlauchbeutelentleerungsvorrichtung | • X ZB 2/12 – Tintenstrahl drucker |
| • X ZR 226/02 – Sammelhefter II | • X ZR 107/12 – Kommunikationskanal |

61 Status of July 2014. In the meantime, several further important decisions dealing with the allowability of amendments have been issued by the Federal Court of Justice, e.g. X ZR 112/13 – [Teilreflektierende Folie](#); X ZR 171/13 – [Polymerschäum II](#) and X ZR 119/09 – [Schleifprodukt](#). A brief English summary and discussion of these cases can be found on www.kluwerpatentblog.com

Most of the above-cited decisions are available online in German via the webserver of the Bundesgerichtshof (Federal Court of Justice)⁶². If you are interested in an English summary of a specific case, please contact me.

Thus, there is a lot I should be covering, but I have the small problem that my original 20 minutes have just been shortened by 5. Therefore, all I can try to do in this lecture is to cover the tip of the iceberg of added-matter case law in Germany. To do that I would like to briefly introduce the general principles that we apply in Germany and then present some practical examples because examples often teach more than many words, as Seneca once, approximately, remarked (*verba docent, exempla trahunt*).

The general principle on added matter, i.e. the gold standard, has already been presented to you by Heli Pihlajaama from the EPO. Indeed and fortunately, the gold standard in Germany is pretty much the same as it is at the European Patent Office. Which is what one could expect, given that the statute is also the same. Indeed, Article 123(2) EPC together with Article 138 b EPC have the same wording as Section 21(4) together with Section 22 of the German Patent Act. They state that a patent must be revoked if its claimed subject matter extends beyond the content of the application as originally filed. In nullity proceedings dealing with a European patent, German courts must apply European law directly, which has also helped to harmonize the jurisprudence on the added-matter provisions between Germany and Europe. Therefore, I think it can be fairly said that the gold standard is the same, at least on paper, i.e. only that which can be “clearly and unambiguously derived” from the application as being part of the invention will be considered as not extending the content of the application as filed. Conversely, if a skilled person arrives at a further insight on the basis of his general knowledge or by varying the disclosed teaching, this will not be deemed to have been disclosed in the original application. This principle has been expressly recited, for example, in the FCJ decisions *Fälschungssicheres Dokument*, *Luftverteiler*, *Olanzapin*, *UV-unempfindliche Druckplatte*, *Polymerschaum* and *Kommunikationskanal*.

In other decisions (*Drehmomentenübertragungseinrichtung*, *Spleißkammer*, *Spielfahrbahn 02*, *Formteil*, *Polymerschaum*), the principle has been expressed more concisely as “The content of the application as filed is that which the skilled person can derive from the original application as belonging to the invention as filed”.

62 <http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/list.py?Gericht=bgh&Art=en>

Whether the gold standard is “directly and unambiguously derivable” or just “derivable” makes no difference in practice. In either case it is assumed that the skilled person is equipped with his common expert knowledge and he/she can use this common expert knowledge to identify what is “clearly and unambiguously derivable”, whereas he/she may not add something to the application on the basis of this general knowledge. This shows where the difficulty of added-matter cases usually lies: How much general knowledge can you really impute to the skilled person and to what extent may he use this knowledge to “derive” something rather than to “add” something. Defining the borderline between the two can be quite tricky at times.

The words “clearly and unambiguously derivable” were deliberately chosen by our Federal Court of Justice to emphasize that the same principles are to be applied as before the EPO and everywhere else in Europe. In addition, the German version of the gold standard requires that the skilled person must be able to derive the amendment from the original application as belonging to the invention as filed. These underlined words are not to be found in the European formulation of the gold standard. What they mean is that the added feature should have been expressed as being a part of the original invention, rather than, for example, just as part of the description of the prior art or as a side remark. However, the EPO practice does not seem to greatly differ on this point.

Therefore the jurisprudence of the European Patent Office on the allowability of amendments is a good compass to use when assessing the direction German jurisprudence is taking, at least as a first approximation.

So far so good. However, as always when different courts deal with the same subject, the results are not always exactly the same and the words “clearly and unambiguously derivable” may not have exactly the same meaning in Germany as they do at the EPO. While similarities do prevail, there are some differences in detail; and as such differences are perhaps more interesting for a lecture than the similarities, I would like to talk about some of the most notable differences.

Example 1 – Intermediate Generalization

What happens if you amend your application by adding to the claim just one feature from an example, rather than the entire example? Can you really do that? In Germany the answer is generally “yes”.

As has been stated in a number of decisions (*Spleißkammer*, *Crackkatalysator*, *Bodenwalze*, *Inkrustierungsinhibitoren*, *Sammelhefter II*, *Elektronenstrahltherapiesystem*, *Polymerschaum*, *Kommunikationskanal*), the Federal Court of Justice of Germany is of the view that the applicant or the patentee, if he desires protection only for a particular embodiment of the claimed invention, is not obliged to introduce all of the features of an embodiment example into the claim. The introduction of an additional feature from the description into the patent claim is allowable if the originally broader teaching is restricted to a more limited teaching and if the additional feature in the description was identifiable as belonging to the claimed invention.

However, it has been established that if only individual features of an example of the invention are included in the patent claim, the resulting feature combination will extend beyond the content of the application when the combination in its entirety circumscribes a technical teaching which the skilled person could not have derived as a possible embodiment of the invention from the original application. (FCJ *Drehmomentenübertragungseinrichtung*).

Therefore, the result will depend a little on the individual circumstances of each case. There can be examples where you just take an extraordinary feature from one example and put it into a general teaching where it does not really belong. In such a case the combination may result in a new teaching and a skilled person may really be surprised to suddenly find such a teaching in the claim. In such a case, this amendment will not be allowed. The same also applies if the combination consists of features taken from various dependent claims, if said combination had not been disclosed as a possible embodiment of the invention.

Therefore, even though adding combinations of features from the description and the examples to several claims is normally allowable, there can be exceptions where the gold standard is not met. One example of such a situation was outlined in the FCJ decision *Heizer*.

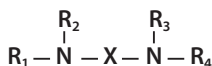
Example 2 – Amendment by Generalization of a Specific Working Example

Can you amend a claim by generalizing a specific working example? This would be close to impossible at the EPO, but in Germany, the answer is “in principle yes”. One can indeed generally take a feature from an example, generalize it and put it into a general claim. The FCJ in *Polymerschaum* put it as follows:

“According to the established jurisprudence of the Panel, it is necessary in order to affirm the original disclosure of the subject matter of a patent claim that the skilled person was able to ‘directly and unambiguously’ derive the technical teaching of the claim from the documents as filed, i.e. as a possible embodiment of the invention (cit. omitted). In this case law, the Panel also admitted generalizations of originally disclosed embodiment examples to avoid an unfair restriction of the applicant when using the disclosed content. The Panel in any event deemed a ‘broad’ claim to be unobjectionable from the point of view of added matter when an embodiment example of the invention described in the application presents itself to the skilled person as a configuration of the more general teaching as circumscribed in the claim and if this teaching in its claimed generality could be taken from the application as filed as belonging to the invention as filed (cit. omitted), be it in the form of a claim formulated in the application as filed or be it from the whole context of the application as filed. Mainly such generalizations have been admitted when only one or only a few of the plural features of an embodiment example, which taken together but also alone promote the success of the invention, have been included in the claim (cit. omitted).“

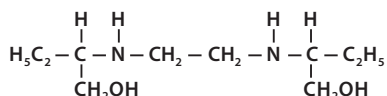
By applying the general golden rule that I just explained, even the generalization of a chemical compound was approved in one particular case (*Alkylendiamine D*). The following slide will give you a little bit of background.

Claim 1 as filed: A process for preparing **alkylene diamines** of the following general formula



by one of the following **nine methods a) – g)**, **method d)** involving a reaction with a compound **halogen-X-halogen ...**

Example 2 as filed: A process for preparing **ethambutol** of the following formula



according to **method d)** by reacting aminobutanol with **ethylene dichloride**

Claim 1 as amended (and maintained):

A process for preparing **ethambutol** by one of the following **nine methods a) – g)**, wherein in method d) the reaction is with the compound **halogen-X-halogen** (X = ethylene).

Thus, the claim 1 as originally filed had a general formula that is shown at the top of the slide. Such compounds could be produced using one of nine methods (A to G) and method D involved a reaction with a compound “halogen-X-halogen”. There was then an example 2 in the application as filed that used just this method to make one specific compound (ethambutol) starting from a specific chemical compound, i.e. ethylene dichloride. The patentee tried to amend the claim to a method for making specifically that compound from example 2 but using any one of the nine methods (A to G) and a general method D, not just the specific method D as described in example 2. The Federal Court of Justice said yes that’s OK because you had a general teaching for the production of all these compounds in the original claim 1 and that general teaching also applies to example 2.

Example 3 – Taking Claim Features From a Drawing

Can you take a claim feature just from a drawing, i.e. without any *expressis verbis* support in the description? The answer is generally yes, that is possible in Germany. It has been decided repeatedly (FCJ decisions *Crackkatalysator*, *Rückspülbare Filterkerze*, *Formteil*) that claims, description and drawings are equivalent means of disclosure (in German “*gleichwertige Offenbarungsmittel*”).

But, of course, amending a claim on the basis of the drawings only is generally more difficult when you have just schematic drawings and you want to derive a certain detailed feature therefrom. In such a case, there can be ambiguities and then an amendment will not be allowed (FCJ *Tintenstrahldrucker*). Such cases will in the end be decided on a case-by-case basis, but in principle it is possible to amend the application just on the basis of the drawing if the feature can be clearly and unambiguously derived therefrom.

Example 4 – Can you Amend Comprising into Consisting of?

Can you amend a claim stating “comprising” into “consisting of”? As you know, “comprising” is open language and may include more components than the recited e.g. three or four components, whereas “consisting of” is limited just to the recited three or four components, no more. Can you do that? The EPO practice is a bit divided on this (yes: T 997/06, T 425/98; no: T 1063/07) and so is the German practice.

In its decision *Reifenabdichtmittel* the FCJ stated this:

If it can be taken from the original documents of the patent application that a product is to “contain” certain components, this does not automatically disclose as part of the invention that no further components may be added to it. For the disclosure that it is part of the invention that the product solely “consists“ of the constituents mentioned, additional indications rather are generally required in the original application, such as a statement that the constitution of the product merely from the constituents mentioned has particular advantages or is otherwise desired.

Thus, the German answer to this question – as is the EPO’s – is “at least not always”.

Example 5 – The Inescapable Trap

What happens if a limiting amendment is shown to be violating Article 123(2) EPC in nullity proceedings? In other words, what happens if you limit your claim in the examination proceedings by adding a further feature, after which everything seems fine and you get your patent, at which point the patent comes into national revocation proceedings and a judge finds that this amendment is not allowable? In such a case, your patent contains subject matter that extends beyond the content of the application as filed. However, if you want to remove this feature, you would broaden the scope of the patent and thus violate Art. 123(3) EPC. Therefore you will find yourself in a trap which may well be inescapable. In Europe there is a famous decision of the Enlarged Board of Appeal (G 1/93) that deals with this situation and basically says (I am exaggerating here, just to make the point) that unless the unallowable feature provides a technical contribution, you cannot really do much about it. In Germany, fortunately as I must say, the Federal Court of Justice follows a more generous approach in such circumstances. In three cases (*Tintenstrahldrucker*, *Winkelmesseinrichtung*, *Integrationselement*) the FCJ decided that if the insertion of a feature that has not been disclosed as belonging to the invention in the application as filed results in a mere restriction of the protected subject-matter, this can be handled in such a way that the feature in question remains in the claim, but is to be disregarded when considering patentability as it may not be relied upon as support thereof.

The patent must be revoked, however, or declared null and void if the insertion of the feature has resulted in the patent protecting an “*aliud*”, i.e. something different, compared to that which was disclosed to the skilled person by the application as originally filed; i.e. if the inserted feature deals with an aspect which has not been disclosed in the application as being part of the invention.

In other words, when infringement is being considered, the amendment must be taken into account and has a limiting effect, but when validity is being considered, the situation is as if this feature were not present. Personally, I think that dealing with these situations in such a way is quite satisfactory in most cases. On the other hand, I also agree that if the limiting feature totally changes the content of the claim and makes an elephant out of a mouse, the claim would indeed cover an *aliud* which cannot be removed again.

Example 6 – Amending Numerical Ranges

My last example starts with a relatively old decision where an applicant wanted to limit 50ppm to 10ppm, with no basis for this to be found in the application as filed. However, in Germany it was possible. The FCJ held in two decisions (*Crackkatalysator I* (1990), *Chrom-Nickel-Legierung* (1992), later followed by *Inkrustierungsinhibitoren* in 1999) that you can pretty freely set new limits within originally disclosed numerical ranges. The FCJ stated:

“Because according to the rules of arithmetic, the mention of a range constitutes a simplified expression of the numerous possible intermediate values lying between the lower and the upper limits. Given that all intermediate values in the range of ‘up to 50 ppm’ as claimed in the original application are therefore to be considered as disclosed as belonging to the claimed invention, the limitation of this range to the narrower, numerically defined range of ‘less than 10 ppm’ is not objectionable.”

This may be a pretty dogmatic reasoning, and is completely at odds with the consistent case law of the EPO since the early eighties (e.g. T 198/84). Given that the FCJ has recently strengthened its efforts to bring its case law more into harmony with the EPO (for example, in *Olanzapin* the FCJ gave up the existing German case law on chemical formulae in favour of a more European approach), it is tempting to speculate whether the FCJ might one day also reverse its case law on numerical ranges. However, in a recent decision *Fettsäuren* (X ZR 40/12), the FCJ did not avail itself of this opportunity and instead held that it was OK to amend a range from 25-100 to 80-100, even though the figure 80 did not turn up anywhere in the application as filed. The FCJ argued such:

“Just as in the description of the patent in suit, a range of 30 to 100% by weight is also specified in the application as being preferred, and a range of 85% by weight is specified as being particularly preferred. It is apparent therefrom that the upper part of the first-mentioned range is preferred, but that, however, a value slightly

below the value of 85% by weight that is deemed to be particularly suitable is also still deemed to be advantageous. The fact that this value does not constitute a strict limit is furthermore apparent from the already mentioned first formulation example that is also provided in the application, in which the proportion of EPA and DHA together is 84% by weight.”

With this reasoning, the FCJ found that going a bit lower, i.e. to 80%, is not objectionable under Art. 123(2) EPC. While this may sound generous to the patent proprietor, the overall result of the decision was not – the patent was declared null and void in full for lack of inventive step. But that is another story.

Limitations and Amendments of Claims during Litigation – Introduction

France

Prof. Jean-Christophe Galloux

My presentation will be split in two parts. With my colleague, Dariusz Szleper, I will give a quick presentation of the French limitation system. Dariusz will present some French case law, and I will take the floor to finish with the unsolved questions about limitations.

The possibility to limit a patent was introduced into French patent law only quite recently. It is just by a law of 2008 and before it was ignored in the French patent law.

In the beginning of patent history, in France, we had a different system, with the law of 1944, when the scope of the patent was defined by the description.

So the system of the claims did not exist until 1968, and when we adopted it, after the Strasbourg Convention of 1963, we couldn't imagine that we should limit, or modify, these claims. That is the reason why the case law that we have and the experience, i.e. the French experience in this matter, goes back only 5 years, or 6 years, at the most.

So the French law applies for limitations to French patents, to the French part of the European patents, and also to supplementary patent certificates, i.e. a *sui generis* right for pharmaceuticals and agrochemicals. You may notice that nothing is said about a limitation of a paediatric extension of a patent, so this detail is ignored by most specialists in patent law,.

The French legislator aimed at reducing the number of litigations on validity. I must say that this goal has been not reached at all, because the legislation raises more problems than it solves.

For their legal framework, most of the legislation is included in 3 articles of the French Intellectual Property Code. I have noticed that they are quite similar to the one of the European patent convention, especially Article 105.

You can see that number of requests for limitations in France is quite narrow, between around 20-25 per year, and we have also a distribution of these limitations between mechanical, electronic and chemical cases.

We cannot say that one industrial sector is more impacted by the question of limitations than others.

That's about the requests for limitation of the French part of European patents, or national patents, and the number of requests approved and rejected by the French patent office.

You can see that sometimes there are demands that are rejected, but most of them are accepted by the French Patent Office.

We must say that the control, which is done at the level of the French patent office, it is quite a light control. It is not a deep one, which may cause a lot of legal problems, afterwards.

Just also some practical information for the duration of the proceedings: Before the French patent office, it takes 3-4 months, compared to nearly 1 year before the EPO. The cost is quite limited. It is around 250 Euros.

So that's for the very beginning of the presentation and I leave the floor to Dariusz, to see how the jurisdiction deals with this kind of legal framework.

Limitations and Amendments of Claims during Litigation – Current Case Law

France

Avv. Dariusz Szleper

The experience that we had this morning was very instructive, because it made me realize that with our French experience we do in effect not have too many things to say today.

In comparison with what is the science of our English, German and Dutch colleagues, we are a little bit left behind. This is due to the very recent introduction of this new institution of French patent law, ie the limitation of patent claims. Since the limitation of patent claims in France is only done by a procedure at the French patent office, it essentially raises the issue of coexistence between this proceeding and the pending litigation. So, in my presentation, I will try to express the questions that were already resolved by French case law. For example is it the French proceedings only adapted to French patents, or can it also be applied to the French parts of a European patent, knowing that there is central limitation at the EPO? What is the impact of ongoing infringement or nullity proceedings? What is the impact of the limitations on previous acts like infringement, if claims are based on a different patent than that debated at the end of the litigation? How to limit? What is the control that the judge exercises on the limitation? And what is the situation of third parties? There is a lot of issues that we have heard this morning, that were not resolved, fought, tackled yet by the French practitioners and French specialists, and French case law, and we will leave this part for the end of our contribution. This speculation will be done by Professor Galloux, who will mention the things that are unsolved.

I will simply try to present you the status of current case law, which we may call the positive one. The first question, i.e. is the French proceeding only applicable to French patents or also to the French portion of a European patent, was resolved 4 years ago, in July 2011, in litigation between TEVA v. INPI before the French Court

of Appeal of Paris. This court stated that the French code of intellectual property does not make any distinction of provisions between those two titles and, despite the fact that there is a central limitation proceeding at the EPO, it is also possible, for the owner of the French part of a European patent, to apply the French proceedings to this litigation. It has, however, some consequences because the way the litigation proceedings are organized, at the French patent office, is different from the way they are organized at the EPO.

For example the French patent office does not accept observations of the third parties, so it creates additional issues, e.g. how third parties shall or may react to a decision accepting, eventually, the limitation. The second point that was debated on the limitation was the question of who has the competence to decide if the limitation is valid or not. The dialectics was the following one. The patentee considers that since the limitation was accepted, the conditions for the limitations shall not be disputed, or regarded, anymore by the judges on the merit; contrary to this position the court of appeal in Paris argued that the judge who has the jurisdiction on the validity of the basic patent, also has the jurisdiction of the material substantial conditions of the limitation, if the patentee is opposed to the third party or if the nullity of the limited patent is sought. Additional point, which is quite important in the way of the French proceedings are handled, is the moment of the litigation. We have learned this morning that traditionally in Germany it was possible to make the limitation until the very last day of the proceedings, if I understood correctly, and we also in France have this particularity of the procedure of appeal, on the merit, since the procedure of the appeal has this, what we call it in France, devolutive effect. The judge of the appeal takes the case from the beginning. New means of the defence, new proofs, even sometimes new claims can be formulated, and therefore, at least in theory, it seems possible to present the limitation at the level of the court of appeal. But then the question arises what may happen if in the meantime the patent was nullified in the first instance, because this creates also some new legal situations. Specifically, if some provisions of the French code of civil proceedings provided that the first instance judges create the situation of *res iudicata* between the parties. But on this question the court on appeal in Paris answered, in October 2013, saying that is perfectly possible to request a limitation, even at the stage of the appeal, in case the patent was nullified in the first instance, and it ordered a stay of the appeal proceedings until the decision on the limitation. Of course, there is plenty in this case, which is not terminated yet because the substantive matters were not yet debated at the court of appeal level, which may eventually give rise to some criticism, but at least, at this stage and according to my understanding of the position of the court of appeal, it seems that a limitation can be proposed even if the

patent was nullified in the first instance and before there is a decision of the court of appeal.

An additional question, which has some link with the points that were debated this morning, was the analysis of the method that should be adopted to make the limitation, and this gave rise to some dispute in French jurisdiction because essentially the French patent office considered that a limitation can only be made by a mere combination of patent claims and nothing can be added, during the process of limitation, from the description of patent. This position was sanctioned by the Court of Cassation in a decision of march 2013, who set aside the decision of the court of appeal, and remanded the case to a new examination, considering that a limitation can be made by introduction of features from the description and is not limited solely to characteristics of the claims as it was initially the position of the French patent office. The French case law went even further because in a relatively recent decision of the Court of Appeal of Paris, the Court of Appeal seemed to consider that even features that are only found in the drawings can be used to limit the claims, which of course gives rise to all the vocabulary problems that were already mentioned this morning by the German speakers, but they can also be used in order to perform a limitation.

Another problem that I have mentioned already when I talked about the stay in the proceedings in a nullity case is the question: Shall the action on the merit being suspended? Shall the main action be stayed until the decision on the limitation, or shall the two proceedings go on in parallel, knowing as it was mentioned very briefly by Professor Galloux, that French law, specifically, states that a limitation has a retroactive effect to the date of the application of the patent? Here French judges have adopted two kinds of orientation. In most of the cases a stay of the proceedings on the merit was ordered, considering that it is only the patent under limitation that should be the object of the decision and dispute between the parties. But in two decisions the judges took different positions.

In the first case, which you have on the slide here, Boehringer v. INPI, which is the French patent office, the situation was relatively complex. The patent owner, Boehringer, wanted to obtain a supplementary protection certificate and this application was dismissed by the French patent office. So he made an appeal against this refusal to get an SPC to the French court of appeal and, in the meantime, presented an application to limit his original patent, in order to get a new SPC or to get SPC application, reanalysed after the limitation. And here the court of appeal considered that when it comes to the application for the SPC it is necessary to look at the situation of the title date, when the application for SPC was done, and refused

to stay on the proceedings, despite the claim for the limitation, and this position was upheld by the Court of Cassation who considered there was no need to stay in this situation. Another position similar to that one was expressed very recently by the district court of Paris in a litigation, which consisted of an infringement action, with a counter claim for patent revocation, where patentee presented a request for limitation to the French patent office, and asked for the stay of the proceedings on the merit. Here the district court of Paris decided there is no need to stay, because in fact the French patent office decides on a limitation very quickly, in something like two months, and in addition the patent was to expire in August of this year so it would do prejudice to the patentee and to the accused infringer not to have a quick decision on this matter. I also shall remind that the question of this correlation between limitation and procedures on the merit is not organized in French code of intellectual property, and therefore there is the rule of good administration of the justice that applies and therefore is maybe not at the total discretion of the judges but nevertheless these principles shall be applied to decide if the stay should take place or not. Another aspect which has meanwhile been resolved by the French courts is the relation between the limitation and acts that happened prior to the limitation. I have already mentioned the question of the validity of the results of a *saisie* which is a means of proof frequently used by French patent IP right owners, specifically in patent matters, and the court of appeal in Lyon decided that the fact that the patent was limited later, did not affect in any way the validity of the initial procedure that was conducted prior to validation, and this seems to be a relatively certain resolution.

Finally, a point for which we maybe don't still have clarity, but which is useful to remind, is the situation of third parties. The problem that we have here is the contrary to what we have learned this morning, about Germany, UK and Netherlands, where the limitations, or patent claim amendments, can be done within the litigation on the merit between the parties who will discuss them.

The limitation in France is done independently in the front of the French patent office, and it may be, if the patentee does not ask for the stay, that the defendant will even not be informed about the limitation, so his only way to oppose to this administrative decision would be to file an appeal against the French patent office decision, to the court of Paris.

However, this raises issues. At first, it raises the problem of a possible delay to the appeal because it's very short and starts from the publication of the decision of the French patent office, and it was considered the publication and the decision that makes the starting point, and secondly also raises the question of the demonstration

of the legal interest. Of course, if there is a situation where the appellant to the Court against the decision on limitation is already the party to the litigation because he should, or he/she should, for patent infringement, then his legal interest will exist. But in the case rendered by the Court by on September 2013 *Boehringer v. Actavis*, the court of Paris considered that the court of Actavis, who wanted to make an appeal against decision on limitation, which was favourable to *Boehringer* was without any legal interest, because *Actavis* did not demonstrate at the eyes of the court that is planning to launch a manufacturing of the product that would eventually fall within the scope of the limited patent by *Boehringer*. So this is a second difficulty that the third parties may face in this kind of proceedings, but, as I said, there are plenty of questions here to be tackled. Essentially, the question that will be presented by Jean-Christophe Galloux again is the question of the nature of the limitation by itself, because what I mentioned to you is just a technical decision on practical points that are necessary to be resolved, but almost all of them, with the small exception of the *Syngenta* case, where the Court of Cassation considered that the description can also serve as a basis for limitation, did not raise the question what is a limitation. And there is plenty of other questions, like the relation between limitation to species, limitation and, for example, contractual acts that existed previously, the limitation and this observation comes back a little bit to the comments made by Mario Franzosi in the morning when he mentioned the situation of the alleged infringer in another situation, i.e. somebody who in good faith exploits technology he has developed without disclosing it to the public but prior to the patent. We have this exception of prior person possession and with the limitation it may be complicated to use it as a defence against patent infringement claims.

Thank you very much for your attention.

Limitations and Amendments of Claims during Litigation – Unsolved Questions

France

Prof. Jean-Christophe Galloux

Thank you very much. Just some comments about unsolved questions. You understood, from the presentation of Dariusz, that the French case law focused, during the last year, on procedural problems, because they had to be solved first, e.g. when can you make a limitation, what kind of limitations and so on, but the substantive problems raised by limitations have not yet been solved.

- For example, the question of a disclaimer. It has never been raised before the French court up to now.
- The question of the introduction of limitation to rule out an exclusion, for example, in pharmaceutical patents. Swiss-type claims, for example, were not accepted by French court, so if you replace this kind of claim by a limitation to a dosage claim, is this acceptable or not? It is a complicated question because the rights of third parties are directly impacted by this kind of decision and, as we said already, because of the retroactive effect of the limitation you can see that the patent was always the same since the beginning, even if the limitation happened 20 years after the patent has been delivered. So these problems are still unsolved.
- Also, what is really a limitation? The problem is unsolved in the French law. If you just change the category of claim, is this a limitation or not? A product claim changed to a process claim, is it a limitation? When you ask for a limitation to allow afterwards a species, for example we have the Syngenta case where the original claim was directed to one compound, and not a combination of compounds, and, according to the case law of the European court of Justice, you need to have a claim to a combination of the compounds to obtain an SPC for it. So what happened in Syngenta? They asked for a limitation saying: “Oh, we will replace one of the claims to introduce a combination of two compounds in order to be able to have a second

SPC”. Is it a limitation or not? At the first stage, the Supreme Court of Cassation said: “It is a limitation, because you can’t find in the description the qualification of the second compound and the possibility to combine all these compounds, so you can apply for the limitation”. But there is a new appeal, before the Supreme Court, saying: “In that case, when you are allowed, because of the limitation, to obtain a second SPC, is it an extension of the scope as such or not?” So we will have the answer within one or two years.

- Limitation when? That is a procedural problem but more than a procedural problem. Is it possible to ask for limitation after the expiration of the patent? Recently, the delay for infringement is five years in France. Before it was 3 years. Now you can solve an infringement during 5 years after the expiration of the patent, so can you ask for limitation during this period? No answer. After cancellation proceedings, if a restoration is in progress, can you ask for a limitation? No answer.
- More recently, after the nullification of a patent, in the first instance, if you get provisional execution of the nullity judgment, are you allowed, is the patentee allowed, to ask for limitation? I think there is a tendency, a trend, from the French judges, to accept provisionally execution for nullity case, just to avoid a limitation during the first instance and the appeal. But if it is ok for the French law, what will be the impact of a European limitation on provisional execution? That is also an unsolved question.
- Also the question of the frequency. How many limitations are you allowed to do? In the French law there is provisions saying that, if you ask for several, what is several, limitations it can be seen as abuse, but when does an abuse start? After, 1, 2, 3, 4, 5 limitations? One limitation? Nobody knows exactly what is an abuse of limitation in that case.
- And, to finish, the question of limitation and third parties, that is, I think, the main problem, because the question of limitation can occur just during the life of the patent, first, and because of the retroactive system the French law accepted, there is a lot of uncertainty for the third parties, which is really the main problem for legal people. We are trying to set up a system, but it has not yet been adopted in France, to allow observations by third parties, at the level of the patent office, against limitations. However, the pre requisite for that is that the request, and the filing of the request, of the limitation has to be published, otherwise third parties would not know that there is one. There are some draft texts about that.

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- And, I think is the last one and I will finish with that, there is also another question about the appeal against a patent office decision for limitation. It has been refused by the Court of Cassation. I am not sure that this solution is really wise, because it's important for third parties, to stop this kind of proceedings shortly after it has been granted. So stopping any possibility for third parties to act, I think, is not really wise in the system adopted.

To conclude, the general trend, in France, is that this possibility of limitation is seen as something quite complicated, not complicated to get, but by adding more complexity in the litigation afterwards. Thank you very much.

European Patent: A Variable Geometry Right? Limitations and Amendments of Claims during Litigation

The Netherlands

Prof. Jan Brinkhof

1. Introductory remarks

Is a European patent a variable geometry right? That is the puzzling theme of this course. To help us there is an addition: Limitation and Amendments of claims during litigation.

Before trying to give an answer to the question I would like to tell something about the nature of a European patent.

It is often said that a European patent is a bundle of national patents. This is a somewhat misleading description. As if after grant of a European patent each national patent out of the bundle is only subject to national law.

In the very short preamble of the European Patent Convention it is said that this Convention also contains ‘certain standard rules governing patents so granted’. This means that after grant there are standard rules in the European Patent Convention, which govern the national patents out of the bundle.

The same is expressed in Article 2(2) European Patent Convention:

‘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.*’

The last five words ‘unless this Convention provides otherwise’ are often overlooked. Even by the European Court of Justice. Stauder wrote: ‘The appended subordinate clause is actually the main rule, as the Convention results in a highly autonomous European system of law governing European patents’.⁶³

So, the effect of the European Patent Convention stretches past the grant. For example:

- according to Article 69 EPC and the Protocol on its interpretation the scope of protection should be determined on an exclusive European basis
- a European patent can in national proceedings be revoked only on the grounds mentioned in Article 138 EPC

National judges deal with infringement and revocation proceedings. It goes without saying that the interpretation and the application of the European provisions by the courts should be uniform in all the Contracting States. It also goes without saying that as to the requirements for patentability the boards of appeal and the courts should have identical views.

Since 1980 conferences of European patent judges have been organised every two years. The aim of these conferences is to make the judges aware of the common task to interpret the European Patent Convention and to apply the provisions in an identical way. The national patent judges and the judges of the Boards of Appeal of the European Patent Office have to realise that they belong to a virtual European judiciary. In this light it is clear that for the national judges the national tradition cannot be the only point of orientation. The perspective of the national judges should change. It is no longer sufficient to look back to the national tradition. Instead, the national judges have to look to ‘the left and the right side’, that is to say: to read and to study the decisions made by judges abroad and judges of the boards of appeal of the European Patent Office. I can assure you that this could be very inspiring. Speaking for myself, I have learned a lot from studying decisions of the Bundesgerichtshof (German Federal Court of Justice) and the House of Lords/ Supreme Court of the UK. I was pleasantly surprised by the open attitude of the judges and the discussions in the decisions. In their decisions the judges refer to decisions made by judges abroad. In contrast, the judges of the Supreme Courts in for instance France and in the Netherlands used to reason in a rather abstract way.

⁶³ Singer/Stauder, European Patent Convention, A Commentary, Third edition (2003), Article 2, Note 7 ex.

There is hardly any discussion. No attention is given to decisions of foreign courts. That reduces the persuasiveness of their opinions.

2. Some observations and findings

Patent law has been Europeanised by treaties. Conventions do not always have a direct effect. Often the effects depend on the implementation in national legislation. And more in particular the effects depend on the willingness of national judges to interpret and apply the national provisions in which the provisions of the Conventions are implemented, according to the spirit of these Conventions. In this respect it is crucial that the judges are aware of their task – as organs of the Contracting States – to implement the purposes of the conventions. Finally, it is crucial that the supreme court judges watch this and set an example themselves to the lower judges. The German Federal Court and the UK Supreme Court show how this should be done. I am afraid that judges in other Contracting States do not take much notice of the case law in other Contracting States.

The European Patent Convention is a success. The judges of the Boards of Appeal and the Enlarged Board of Appeal of the European Patent Office show that they are able to develop consistent case law despite the different national backgrounds of the judges.

The weak links in the European Patent Convention system are the national judges. Undoubtedly, the conferences of European patent judges have improved the level of consciousness. But the speed is not impressive. The lack of a court in Europe, which speaks the last word in patent cases, is not compensated sufficiently. In the Netherlands, especially the lower judges do their best to be in step with the German and UK judges. So far, the role of the Dutch Supreme Court has been too modest.

In the light of what I have said you will understand that I praise the organisers of this course for inviting speakers from various European countries to discuss European patent law issues.

3. Back to the theme

And now back to the theme of this course.

In proceedings before the competent national court or authority relating to the validity of a European patent, the proprietor of the patent has the right to limit the patent by amending the claims. This is said in Article 138(3) EPC.

If the thus limited patent survives the revocation proceedings, we have a European patent with a variable geometry: a limited patent in the Contracting State where the patent was limited and an unlimited patent in the other designated states.

By the way: this is not a unique situation. There are other situations where the text of a European patent is not uniform for all designated Contracting States. See Singer/Stauder, EPC, 3rd edition, Article 118. [(a) Where prior European patent applications are identified as so-called prior European rights pursuant to Art. 54(3) and (4) during the examination proceedings, R 87 permits the filing of different claims; (b) National rights of earlier date (Art. 139(2)) have the same effect if the Office is notified of them (R 87) (c) If the person actually entitled to the grant prosecutes the European patent application as his own application for particular countries pursuant to Art. 61(1)(a), he may submit claims, descriptions and drawings for these countries which deviate from those submitted for the remaining countries.]

It seems questionable whether the patentee whose patent is limited in Contracting State A, could enforce his unlimited patent in Contracting State B. I am inclined to answer that this is not possible.

Personally, as a judge I never dealt with limitations of patents (if my memory is correct). I can imagine that it will not always be simple to deal with requests for limitation. Maybe the judge could in complicated matters request the European Patent Office to give a technical opinion on the basis of Article 25 EPC. [Fee € 3860]

Maybe there is an alternative. The court could stay the proceedings and order the patentee to file a request for limitation with the European Patent Office pursuant Articles 105a-c EPC. An advantage of this alternative is that the patent will be limited for all the designated countries.

Answer to the question

A European patent can be 'a variable geometry right' as a result of a limitation. Normally, a European patent will be uniform in all the designated States.

In other words: Malevich' Black Square is the normal geometry and Mondriaan's Victory Boogie Woogie the exceptional geometry.

Limitations and Amendments of Claims during Litigation

The Netherlands

John Allen

● **NautaDutilh** | Challenge the obvious



**Experience with post grant claim amendments in
The Netherlands**

John J. Allen
Palace of Justice Milan, 27 June 2014

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Post grant claim amendments in NL

Three routes:

- I. Article 105a – 105c EPC
- II. 138(2) and (3) EPC/Article 75 ROW – partial validity
- III. Article 63 ROW 1995 – Deed of (partial) abandonment
 - * Enter deed into patent register
 - * Deed is not entered without consent of certain third parties:
 - Party with registered entitlement (co-owners; security interest)
 - Party to proceedings regarding the patent
 - Licensees

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Route I - The impact of central limitation in national proceedings in the Netherlands

- A. ROW 1995: certain basic formalities
- B. Case law: impact on pending proceedings

3

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Route I - The impact of central limitation in national proceedings

Basic formalities ROW 1995

- Article 51 ROW: PO will include in the register a notification of:
 - * Institution of opposition or central limitation proceedings;
 - * The date thereof; as well as
 - * Any decision of the EPO in that respect
- Article 52 ROW:
 - * If EP is amended pursuant to opposition or central limitation, the patentee should file, within three months (Article 23 Implementing Regulations) after limitation:
 - A translation of the patent (unless official language is English)
 - A translation of the claims (all cases) language
 - * If the translation has a more limited scope than the authentic text, the translation shall be deemed the authentic text

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Route I - The impact of central limitation in national proceedings

Leading case law: Supreme Court 6 March 2009 (Boston Scientific/Medinol)

- Impact of central limitation after Court of Appeal judgment?
- Can a patent limited in central limitation proceedings be invalidated on grounds other than those mentioned in EPC?

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Route I - The impact of central limitation in national proceedings

Supreme Court 6 March 2009 (Boston Scientific/Medinol)

Facts:

- Boston Scientific (BS) patent, stent with features A and B
- Original claims invalidated in first instance Court and Court of Appeal
- During appeal proceedings BS argues partial validity for amended claims with features A, B and C
- Court of Appeal held:
 - Added matter (no)
 - Lack of unity (yes)
 - Divisional for feature C, therefore *“reclaiming subject matter abandoned during prosecution”*;
 - Adding feature C was *not foreseeable* for the skilled person
 - violation of legal certainty for third parties (yes)
- After appeal proceedings: central limitation

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Route I - The impact of central limitation in national proceedings

Background:

Additional national requirement for allowable claim amendments as per **Supreme Court 9 February 1996 (Spiro/Flamco)**, i.e. only allowable if:

- an amendment of the claims can be formulated which clearly demarcates the scope of protection;

AND

- this amendment would, a priori, be sufficiently obvious for the skilled person so as to enable him to independently conclude on the basis of the patent and the prior art that the patent should have only been granted with this amendment (*“one way street”*)

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Route I - The impact of central limitation in national proceedings

Findings in Boston Scientific/Medinol:

- I. central limitation is “*novum*”: (case remanded to Court of Appeal);
- II. Revised Article 138 EPC applies to any EP in force as per 13 December 2007
- III. The interplay between national proceedings and central limitation:
 - a. No precedence of central limitation procedure over national proceedings;
 - b. If concurrently pending, the national court may suspend or continue as per the national laws;
 - c. If national proceedings have been concluded, limitation can be implemented in other countries via central limitation;
 - d. Central limitation does not preclude further limitation by national courts.

- Decision of the Administrative Council of June 28 2001 on the transitional provisions under Article 7 of the Act Revising the EPC of 29 November 2000, Special Edition no 1 OJ EPO 2007, p. 197-198.
- Explanatory Remarks on the basic proposal for the revision of EPC d.d. 13 October 2000, MR/2/00, p. 125 sub 4.

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Route I - The impact of central limitation in national proceedings

Findings in Boston Scientific/Medinol:

- IV. National Court can and must invalidate an EP if the subject matter remaining after central limitation is not patentable (52-57 EPC) or in case of violation of Article 123 (2) and (3) EPC
- V. In this case it is unclear why the Court of Appeal considered unity of invention and the divisional, since these are not grounds for invalidity.
- VI. As per EPC 2000, the limitation of a European Patent takes place only in the form of a limitation proposed by the patentee which, if deemed insufficient, does not preclude a court from further limiting the patent.

HOWEVER, only the provisions of EPC and implementing regulations determine whether amendment is allowable and no further national requirements shall apply.

Note: in Court of Appeal 30 March 2010 (Bebecar. Maxi Millaan), it was held that Spiro/Flamco should also no longer apply to Dutch national patents

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Route II - Partial validity

Article 75 (1) ROW 1995: *a patent shall be invalidated to the extent that certain validity grounds apply:*

- non patentable subject matter (2 -7 ROW or 52-57 EPC);
- insufficiency;
- added matter;
- extension of scope
- lack of entitlement

How is Art 138(3) EPC implemented in the ROW 1995?
What are the legal requirements?

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Route II - Partial validity

Claim amendments during legal proceedings in the Netherlands:

- No specific legislation for national claim limitation
- In practice: main/auxiliary requests by the patentee:
 - flexible approach by Courts ; but
 - in addition to certain basic formal requirements
 - “due process” requirements apply

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Route II - Partial validity

Relevant case law:

- **District Court The Hague 21 May 2014 (Sanofi-Aventis/Amylin):**
 - * Multiple auxiliary requests possible, BUT
 - * Second auxiliary request raised clarity issue, which violates Article 84 EPC: not allowable;
 - * Late stage filing of additional auxiliary requests not permissible;
 - * Consequence: invalidation entire patent
- **District Court The Hague 5 June 2013 (Enpros/Smart Seal)**
 - * Amendments (disclaimer) of claims should comply with all EPC requirements, including clarity (Art. 84 EPC);
 - * If not, auxiliary request will be disregarded
- **District Court The Hague 2 July 2008 (Van Diepen/Pronk)**
 - * Auxiliary request 10 days before hearing is too late, also in view of lack of separate infringement analysis

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Route II - Partial validity

Relevant case law:

- **District Court The Hague 23 November 2011 (Impliva/Senz):**
 - * Advancing auxiliary requests at the hearing will generally be considered too late and in violation of due process rules
- **District Court The Hague 15 January 2013 (Rovi/Ziggo)**
 - * An “implicit” auxiliary request (in a footnote): interim judgment enabling Rovi to file a specific auxiliary request;
- Dutch translation of the auxiliary request not required

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Route II - Partial validity

Basic formalities

Article 52 ROW 1995:

- Patentee may at any time file an improved translation
- NOTE: if the scope of protection of the translation is more limited than the authentic text, the translations shall be deemed authentic

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Route II - Partial validity

Conclusions so far:

- No real problems implementing limitation right
- Courts willing to become “examiners”, but will observe due process
- Still unclear/developing:
 - * Clarity (Art. 84 EPC/R.43)
 - * Unity (Art. 82 EPC, 27 ROW 1995)

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Limitations and Amendments of Claims during Litigation

Italy

Claudio Marangoni, Judge, Tribunale di Milano (Court of Milan)

I will summarize an experience that, as correctly pointed out this morning by President Tavassi, is just at its beginning. An experience that, with the exception of few cases, is still limited to the conduction of the procedural phase. It is true, anyway, that some judgments have started to address some general issues of the problem; then, we should start the analysis from one of the most recent of these judgments, dated April 2014. The case was quite simple but the decision established some important principles.

It was a cause of alleged infringement of two patents - on electronic locks - started before the regulation, i.e. before the 2010; during the process the patents holder demanded two limitations, one for each patent.

The first interesting fact is that the Court solved a critical doubt, which had already caused some conflicting judgments: whether Article 79 of the Industrial Property Code could be applied to cases that were pending at the time of its entry into force. The Court opted for the applicability of the Article: it stated that considering that at the time the party already had power over his rights, and that Article 79 of the Industrial Property Code was just defining how to exercise this power, the rule had to be intended as a procedural rule, as such applicable to all the pending cases. This was a first point.

On the merits, the two patents had this peculiarity: their limitations did not raise big problems. The limitation of the first patent was even suggested by the technical expert appointed by the judge, who noticed that some elements of the description and the drawings were not included in the claims, i.e. some peculiar elements, very important for the patent scope, were not explicitly mentioned in the claims. Therefore, thanks to the technical expert's advice, a limitation on the claim n. 1 was demanded and easily accepted, because the particular feature added was already presented in both the description and the drawings. It was indeed almost just a

problem of writing; a clarification rather than a limitation, but a clarification that required a reformulation of claim 1. The other patent had a curious story. In that case the patent holder proposed a limitation but the Court considered valid the original patent. However, given the willingness of the owner, the Court granted the amendment; therefore the Court decided to give priority to the will of the owner to limit his own right. Thus, also this episode shows us that the claim limitation is an exercise of power by its holder, with all the consequences that may arise and that we may now assume.

From now on, I will move on a “grey area”: since I cannot refer to any other case law, I will refer to the orientation of our Section in the Court of Milan.

In particular, there is no doubt that the rule as formulated creates some relevant problems in our procedural system. This is because the rule undermines all our principles; especially the procedural rules that, with peremptory deadlines, give precise cadence to the procedural phase and define the parties’ claims. This rule completely disrespects these principles when it establishes that the patent holder can request the limitation in every moment and status of the litigation (not only in the first instance but also, as the French colleagues say, in the appeal).

At the moment, the more pressing problem is how to manage these procedures. We can establish some points even if they are certainly vulnerable. Meanwhile, back to the topic of the disposal nature of the limitation, i.e. the fact that limiting a patent is a power of its holder, we believe that at first it is necessary to present a specific demand to the judge where the amendment requested is specified. It may be added that the request must directly come from the party itself, because this waiver requires substantial power over the patent; so, probably, the lawyer himself could not be enough, unless he has a proxy providing him with the substantial power to do so. I believe the demand has to be presented to the Judge, because he is the one who formulates the instructions to the technical expert. So, even if the works of the technical expert have already started, the Judge must add a new question for the technical expert, in order to have the new claim examined.

What is the reason behind this formalism? We think it is better to avoid any negotiation between the patent holder and the technical expert appointed by the judge on how to make the limitation. At the time of the patent granting, when we see the original claims corrected by the examiner, the negotiation is totally legitimate. It is even a duty. During the administrative phase of issuance, collaboration between the two parties is totally normal, but not here. This is a totally different stage; here

we also have the alleged infringer, who needs a specific request, and the opinion of the technical expert on that specific request.

What is the deadline for the claim limitation request? The rule does not prescribe any limit, so I guess it could be proposed even at the final hearing, but this obviously means to open the investigation again. We hope some good practices will strengthen; on one side, practices of good management of the process, and, on the other side, practices between the parties and the lawyers. In this prospective, the best moment to propose the request would be either during the works of the technical expert or, even more, right after their end: this is the natural moment in which the party may, being informed on the final opinion of the technical expert, propose an amendment.

We may also wonder how many limitations can be demanded. The rule does not prescribe any limit even on this point. After all, even at the EPO there is no limit on the number of limitations an applicant can propose. Here too, highlighting a practice of good management of the process, the judge should – and this has been done in some cases – invite the parties to concentrate these requests. In a pending case, with the cooperation of the parties, this result has been achieved: the patent holder committed to produce his requests of limitation as alternatives, in this way the technical expert had to examine them in the indicated order. It is true, on the other hand, that in other cases this cooperation failed. In one of them after the demand of limitation and the consequent examination by the technical expert – who gave a negative opinion on the validity of the claims – the same party proposed other limitations. The highest number we recorded was of seven consecutive requests. Maybe we can improve our practice, but for sure this situation is in conflict with any principle of promptness of the decision that in some way concerns also the constitutional value of the duration of the trial and the due process.

Another very interesting problem raised this morning is about the infringer facing a limitation of the patent. This is a case that could – because, I repeat, we are still in a phase of investigations – affect those other cases where the limitation specifically implies the addition of a feature from the description that had not been included from the beginning in the claims; thus a claim made by taking matter from the description. A limitation that, in theory, is legitimate in itself, because restricts the patent instead of expanding it; we are still within the scope of the original protection.

In a system such ours, until now, the liability of the infringer was based on the fact that there was a title with a mandatory public disclosure, and therefore the misconduct was ascribed through a reversal of presumption. In fact, there was a presumption of guilt because there was a title and a disclosure and the counterfeiter

should have known it and avoided any conduct in violation of the patent. In this framework of reform, this value of the mandatory public disclosure is weak, it can be challenged at any time. That is why it is necessary to verify which position has the infringer in relation to the disclosure. Here the question is whether we can consider existing in our legal system an innocent infringement. Even within our Section there are different positions on this point, and some are quite extreme. Some say that once the legal value of the original title is taken away, the infringer is not responsible anymore, or, at least, there is not a presumption of guilt, therefore this has to be proven by the patent holder. Another idea suggests that when the limitation has been done in a proper way – with the so-called “funnel” – if the infringer is still within the scope of all the amendment alternatives, he will have to take responsibility for his actions without the necessity of the patentee proving the guilt.

We think that there is a case of “grey zone” where the infringer could not reasonably think that the invalid patent – because here at the beginning we have an invalid patent - could be saved by the proposed limitations. The problem is to decide which level of diligence can be expected from all third parties (not only the infringer) with regard to a patent application filed and granted, when the nullity of one or more claims is obvious. The technical expert himself could solve the problem during his works: he could evaluate the chance that the third parties had knowledge of that possible limitation. Obviously cases with alternative limitations are the clearest; in those cases, indeed, if a limitation is declared void and its alternative remains valid, the infringer cannot claim that he was now aware of it. On the other hand, in the cases in which secondary features were taken away – assuming a hierarchy between the claim’s features – there are two possibilities. The first one, that may need a specific request of the Judge, is that the technical expert may give an evaluation about the possibility for a person with average skills in the art to be aware, just by reading the claims and the description, that it was part of the acceptable solution. Otherwise the alternative to this solution could be to recover this part through the “guilt perspective”, as we said, and therefore to consider that, in that particular situation, the infringer could not have knowledge of the validity of a certain part of the patent, before the amendment proposal.

I conclude saying that these thoughts are outcomes of uncertainties raised in some judicial investigations. Giving a possible example, we may have a case where the technical expert considers valid the fourth or the fifth claim. So, imagine we make a technical cross-examination after which we reject four limitations and we find the fifth valid, and we say that the third parties should have known it before, while the patent holder himself was not able to reach it quickly. There obviously are some issues on the real possibility to get the required knowledge in some kind of cases.

Amendments of Claims during Litigation

Italy

Umberto Scotti, Presiding Judge, Tribunale di Torino
(Court of Turin)

Good afternoon everyone, I will try to stay within my 12½ minutes by deleting the references in the exposure of cases that I had selected, which are still a fairly modest. I will try to mention them in taking a position on the various issues that my colleague has already anticipated and that have come up in the debate in the morning, go to the hot spots and focus on key issues.

I will also leave the more substantive aspects of the technique of reformulations out, in which consultants of course are more experienced, and will focus on procedural aspects that are perhaps those in which the judge has something more to say.

On the nature of the amendment of the claims pursuant to art. 79 CPI, I agree with my colleague Marangoni who has already given us his assessment of the procedural nature of the standard. I am convinced, however, that this rule has a dual nature: it is a procedural act that must be translated into an act of the process – we shall see how and when - but it is also an act of relevance in substance. In fact, it is an act of negotiations according to the general theory of legal transactions which is suitable to produce effects according to the expression of the will, but that requires a judicial decision to achieve these effects. To verify the nature of the amendment one may wonder what happens if the process in which that declaration was made expires. Probably nothing would happen and the declaration does not produce any effect, unless it can be valued in another proceeding as a symptomatic element of a more or less strong awareness of the patent owner about the invalidity of his title.

Having said that, we must understand what the rationale of that provision is in order to understand which purpose the legislator wanted to pursue with this provision. Probably there is more than one: on the one hand the rule seeks to preserve patents as much as possible, a principle which was also already aimed at by art. 76 CPI with its various forms; I also believe that it aims at the cooperation of the parties with the

judge: The judge certainly could and can always declare the partial invalidity of the patent, in which case the law says he has to establish the new demands arising from the limitation. The technical consultant may assist in this procedure, but this can be a difficult task, and the limitation is an act of cooperation of the party in a procedural dialectic in which, by limiting its claim, it cooperates so that the judge can better formulate the claim, wherein he only must rely on this act. Finally, perhaps, such an act can allow you to distil a claim out of the process and the judgment, which may have its blessing and which does not have obscure and opaque aspects that can generate further disputes. This could be the three-fold rationale of the statute.

What could be the consequences of this technique? Of course there is a risk that the process gets entangled with itself, an recurring expression which visitors of a courtroom after the reform of 1990 are used to hear: those who knew the process before 1990 knew it was a process in which they could throw in everything at the hearing in which the closing arguments were made. Today this is no longer so; there is a process governed by the need for publication to be held under a system of preclusions and forfeitures that avoids a self-entanglement. However, some limits are provided and this possibility of a limitation is a limit. There are others in the order, there are cases where for reasons of substantial interest, the legislator wanted to enable the party to break through the regime of preclusions, for example in the process the party can always rescind the contract even when it initially requested fulfilment. This is an exception, as such recognized by the system to the interests of superior character. Moreover, the specific discipline of Italian industrial property knows the exceptions that are inspired by the same criterion as that of Article. 121 CPI relating to document production. In the provision under analysis the legislature has used a formula much more targeted and more technical from a procedural point of view than the general formula of 121 CPI, which reads: “the consultant may receive documents pertaining to the questions put by the courts even if they have not yet been produced in the case”, a wording a little difficult to square, while art. 79 CPI indicates expressly “in every state and stage of the process” with a very specific formulation.

How can one interpret this term? Surely “in every stage of the process” means in the first instance and on appeal; it also means in cassation, although this may lead to a need for back-referral to the second instance. Surely it also means in proceedings remanded, in which there is still a renewed appeal proceedings. At this point, by the way, the rule that does not allow the proposition of new requests and a change of the *thema decidendum* in the stage of remanded proceedings, must bow to that rule of higher priority.

But there are also other values that have to be balanced against that. There are the values of a contradictory process respecting the rights of defence of the parties, which must also have the goal of a fair trial, as Art. 111 of the Constitution and other key principles of our legal system teach us. This means that this rule, which is still always a special rule, must bow to the adversarial principle, therefore, I would say that a limitation can definitely be made until the hearing for closing arguments, as other speakers have argued before, and it is inevitable that this provision allows in the first stage and also in the second stage the introduction of this specific modification that must be contained in a procedural act. Obviously the formulation of limitations is permitted even earlier, for example during or at the end of inspection operations. I have doubts about the right to make limitations in the final written submission and I would definitely rule out that one can make them in the closing statement in reply, as was recently decided by our section, because there is no procedural act that allows to contradict such a limitation. This does not mean that the restriction, as proposed in the reply memorandum, cannot be an incentive to the judge, or so to speak a provocation, to rely on Article 76 paragraph 2 of the CPI in terms as suggested by the same side; but with a statement that has no value for amending the application but only the value of a suggestion that, therefore, may be even in the closing statement. The position of the party that has made a similar kind of provocation is different because, while it has made the application under Article. 79 CPI and it is accepted, one cannot speak of an unfavourable outcome and it cannot appeal it, whereas in the other case the pronouncement of a decision on the basis of Art. 76 CPI may allow an appeal. So the expression “in every state” must still be coordinated with the adversarial principle, otherwise we would come to the paradox that even by knocking on the door of a panel of the infringement court during deliberation one could request a limitation, because also the resolution is still a moment of the process. The rules of fair play, common sense and constitutional coordination in my view lead to the position that time limit is the hearing of the closing arguments. Obviously that would mean a remission in terms, according to general principles allowed by our legal system, Art. 153 clause 2 or the old 184a Code of Civil Procedure as well as the general principle that permeates our code.

I heard from the words of Prof. Sena and Prof. Franzosi two different evaluations of profiles that coexist in the law. On the one hand Prof. Franzosi highlighted the possible pathological use of requests for limitations as a tool for indefinitely delaying the decision on the request for revocation; on the other hand, Prof. Sena highlighted the physiological aspect, namely the right to an adaptation of parts to the outcome of the CTU in order to develop that solution that corresponds to how the technical part of the adversarial process has developed. I hope that the rule will be the physiological use, and our experience at the moment is in the second sense.

Undoubtedly the pathology exists and might well be used; I believe, however, that our system has antibodies, perhaps not the ones we had in the 70s and 80s, but the case law of the Supreme Court is now very strict in penalizing abuses with the procedural nullity of the act performed while abusing the right beyond the specific function for which the procedural law was assigned. Therefore equipped with a clear use of the option as an instrument, the judge of the years 2010-2020 has possibilities to react that perhaps were not allowed in the previous jurisprudence.

With regard to the responsibility for compensation by the infringer, I basically agree with Mr Marangoni: between the two perspectives proposed, I would rule out that it may be considered that the alleged infringer can be called innocent merely because limitations were accepted. This is a thesis that should be excluded; the prevailing automatism would seem to be the solution, that the infringer should be held responsible for the damage he has caused by violating the exclusive right awarded by that patent, as amended during the limitation and accepted by the court, every time when his conduct infringed the original patent scope that coincides with the scope of the patent as limited. This based on a presumption: that the pronouncement on the basis of art. 79 CPI is nothing but a limiting ruling that remains and must remain, otherwise it could be and would be wrong, a part of the original patent and therefore is essentially a decision pursuant to Art. 76 clause 2 CPI better formulated on the basis of a contribution and a manifestation of the negotiating will of the party. If so, the alleged infringer is guilty, as he would be presumed guilty if he had violated the original patent, because the original patent also contained the patent as limited. Undoubtedly there could be profiles of innocent error somehow engendered by the wording, which should be evaluated case by case. But always starting from the premise, which I believe is correct, that the pronouncement of a judgment on the basis of art. 79 CPI should not be issued if it adds subject-matter and therefore if the infringer has reasons to adduce that it was fundamentally wrong.

Limitations and Amendments of Claims during Litigation

Italy

Gabriella Muscolo, Commissioner at the Italian Competition Authority, former judge at the Court of Rome – IP Division

Surprisingly, so far, no cases of judicial limitation of patents have been filed before the Court of Rome. Therefore I will not refer to the case law, but I wish to raise some issues about the interpretation and the application of the Article 79 § 3 and 3 *bis* of the Industrial Property Code⁶⁴. At a later stage, I will briefly analyse some effects of the application of these rules both to the intellectual property trial and, referring to the cases involving patent law and antitrust regulation, to the proceedings of public and private enforcement, before the Italian Competition Authority and the national Courts.

The first issue is about the purpose of these rules. The question is whether their *raison d'être* is in favour of the patent, its conservation through the elimination of causes of nullity concerning that part of the claims previously expunged (by the judicial restraint) – thus resulting in a stronger protection for the IP right holder - or whether it represents a reduction in the protection of the invention and then a re-expansion of the free competition – broadening the freedom to compete.

I would say that both these reasons belong to the regulation, which is “multi-directional”. I would also add that, when these reasons enter in conflict, I would choose a pro-competitive interpretation, according a stronger protection to competitors and less to the invention.

The second issue, which I just mention, is about the nature of this regulation: are they procedural or substantial rules? The answer to this question will give two different effects: the first concerns the time in which these rules enter into force, since there isn't any expressed transitional rule; the second effect concerns which policy has to be adopted to resolve the apparent conflict with Article 183 of the Civil

64 Legislative Decree 10 February, 2005, n.30 - Industrial Property Code.

Procedural Code in the ordinary Court hearing⁶⁵. As far as the Italian ordinary trial proceeding is characterized by many foreclosures and deadlines within which the [judicial] issues must be specified by the parties, otherwise the questions forfeit. It is obvious that, if the rule of the Article 79 of the Industrial Property Code is just a procedural rule, the criteria of speciality cannot be used to solve the conflict, because it only operates within homogeneous judicial systems. There still remains the temporal criterion: Article 79's modification come after the reform of the Article 183 of the Civil Procedural Code, therefore the final result should be the permission to introduce. But until when? Until the statement of the conclusions of the parties, before or after the judicial modifications of the patent?

A good interpretation, for uniformity purpose, could use the model described by Article 30 of the Rules of Procedure, allowing modification just at the first replication of the parties and admitting it at a later just at the Court's discretion. This is due to the fact that the ultimate principle to keep in mind when we decide to admit or not these changes is the respect of the right of defence, of the adversarial principle and of course of the due process.

The fourth issue is about the interpretation of the word "limitation". Must the limitation be restricted to the claims or can it be extended also to the description and to the drawings? Or instead may *only* the parts of the patent file relating to its description and drawings be amended? The answer affects the interpretation of the patent, the reconstruction of the invention and ultimately the subject of the patent application.

The fifth question is whether the limitations should be confined to modifications that reduce the scope of the invention, in order to eliminate profiles of nullity, or instead if they could be extended to those changes that are clarifications of the claims when they are generic enlarging as a consequence the scope of protection of the patent, thus extended, but still with effects. Obviously the choice towards one or the other perspective will depend on the *ratio* that we will give to the regulation.

The last issue concerns the effects from a temporal point of view: if they are *ex nunc* or *ex tunc*. This is an important matter since it falls within the theme of the protection of the third parties in the proceedings of infringement or the proceedings for damages.

65 Civil Procedure Code, Royal Decree 28 October, 1940, n. 1443, art. 183 "First Hearing and Examination of the Lawsuit"

Examining the effects of the patent limitation on IP litigation; we should consider it in trials for a declaration of nullity and infringement, but maybe even in proceedings where *petitum* and *causa petendi* have a contractual nature -as it would be for instance if the subject would be a contract of technology transfer-, because in these cases the patent, judicially limited, is subject matter of a contract and thus that limitation affects the functioning and even the birth of the agreement.

I conclude with a consideration about those cases involving IP law as well as antitrust law. The aggressive exercise of an IP right, when the patent has been already declared invalid, can lead to an abuse of dominant position according to the case law of the European and national Courts⁶⁶.

In particular to sue in order to defend a patent that has already been declared null and void represents “sham litigation”, a particular case of abuse, which becomes relevant under the antitrust law when the IP holder holds a dominant position.

The “inherent conflict” between patents and competition policy has been widely debated by scholars. On one hand, patents are aimed to provide their owners with market power, by giving them the right to exclude competitors and competition policy is *inter alia* aimed at forbidding and eventually sanctioning the abuse of market power.

On the other hand, despite under a dynamic efficiency perspective the existence of a conflict is highly discussed, patents contribute to innovation and, indirectly, to more effective competition.

The question is: as the judicial limitation is responsible for the ceasing of the risk of revocations and of declarations of nullity (for that part that has been limited), what kind of effect does it have on the configuration of the antitrust offense? And thus on the configuration of abusive behaviour? We have to keep in mind that a directive on private enforcement of antitrust law has been adopted by the European Union, and that Article 9 of the latter provides that the decisions of the Competition Authorities become binding in the “follow on” lawsuits in the Courts⁶⁷.

⁶⁶ See European Commission, *Perindopril*, 9 July 2014, where the Commission fined Servier as committing an abuse by pursuing an anti-competitive strategy to delay the entry of cheaper generic versions of its drug Perindopril, also by means of sham litigation.

⁶⁷ Directive 2014/104/EU of the European Parliament and of the Council of 26 November 2014 on “certain rules governing actions for damages under national law for infringements of the competition law provisions of the Member States and of the European Union”, art. 9, “Effect of National Decisions”.

The judge is now bound by the decision of the Authority ascertaining a breach of antitrust rules. It occurs also in the aforementioned event in which a Competition Authority adopts a decision that ascertains an abuse of dominant position perpetrated by the IP holder; it might happen even when the patent, repeatedly contested in national Courts, has not yet been declared invalid. Well, but what would happen if, after the Authority's assessment of an abusive behaviour, the third parties act for the damages with a "follow on" lawsuit in front of the national Courts, but then, in the time period between the two decisions of public and private enforcement, the patent, in another judicial or administrative proceedings, national or European, is subject to a limitation that provokes the loss of that nullity which has been considered the reason of the abuse by the Authority?

The latter question presents the IP regulators, the IP judges and competition authorities with a sophisticated issue to deal with and possibly solve.

Limitations and Amendments of Claims during Litigation

Italy

Dr. Luciano Bosotti, Buzzi, Notaro & Antonielli d'Oulx

As a first point I would like to address an issue just raised by Dr. Muscolo: can a patent, and therefore its scope of protection, be limited by a simple amendment in the description without any formal amendment to the claims?

I would say: yes, it can. I saw this happen in at least one European opposition case, where dispensing with a possible ambiguity by changing “should” into “shall” in the description did in fact affect, in a limitative sense, the construction of the *per se* un-amended claims. Whether the wording “a reformulation of the claims” in Article 79 Industrial Property Code may be held to apply to an amendment in the description leading to a possible different construction of the claims is a point that we technical people should leave to the jurist.

As far as I can see, the issue of patent limitation has been discussed this morning by referring primarily to the EPO’s point of view, with national laws considered only marginally. A point we technical counsel may bring to the debate is how to coordinate limitations possibly effected before different national courts. European patents may be involved in parallel litigations in various contracting States to the European Patent Convention (EPC) – that is proceedings involving the same patent, the same alleged infringement, the same parties – while an opposition may be possibly pending before the EPO in respect of that patent. This is not a new situation: we have become used to it since the Convention came into operation. Also, the fact that different systems may reach different, possibly diverging, judgments has always been referred to as clear evidence of the need of a Unified Court. On the other hand, this possible diversity is enshrined in Art. 139 EPC with the aim of safeguarding prior national rights, and Rule 138 EPC expressly envisages that is possible for an EP Patent to contain claims (and a description and drawings) which are different for different contracting states.

Litigation procedures concerning a same EP patent may be pending simultaneously before the courts of different EPC contracting states while an opposition against that patent is also pending before the EPO. Such an opposition may last several, if not many years.

The blame for this length also rests on us, European representatives: perhaps we have learned too well from lawyers. At the outset of the EPC, European oppositions were fairly simple and naive, focusing on novelty and the inventive step. They could be terminated in, say, 1 or 2 years (I refer to the early '80s). Today, especially when dealing with sophisticated technology, European oppositions may now start with a thorough discussion on the alleged addition of “new matter”. Even a minor amendment in examination, such as a switch from the “one-part” to the “two part” form to partition a claim in a preamble and characterizing portion, may fuel an endless debate on “new matter”. This may be e.g. because, once recast in the two-part form, the claim may imply a temporal sequence of steps that, allegedly, was not there in the application as originally filed. This leads to “new matter” and “insufficient description” being the topics first discussed extensively in opposition.

How does one raise an “insufficient description” challenge under Art 83 EPC? Simple: one has to seek a far-fetched, imaginative construction of the claim and then show that this construction is not supported by the description. An example: I note that the patent generally recites “a wheeled vehicle” but the description does not disclose any boat equipped with a crane. Someone may argue that a boat is not a wheeled vehicle. Wrong: a boat is a vehicle – no question – and, once equipped with a crane having an actuating wheel turned by a handle, it becomes a vehicle with at least one wheel, then a “wheeled vehicle”. This is covered by the claim language, but not described in the patent application: hence “insufficient description”. The patentee may try to fix the situation by specifying “a wheeled *land* vehicle”. No way: this is new matter, the opponent argues. The description refers to a vehicle – at large – and the drawings in the patent schematically show a motorcar. So there is no proper disclosure for a land vehicle at large, which may be e.g. a horse-drawn cart (not originally disclosed).

This may be a little exaggerated but may explain why oral proceedings at the EPO may be very long, and last days. Even in relatively simple cases, key technical issues such as novelty and inventive step may end up being considered e.g. only late in the afternoon because all the previous discussion has been absorbed by formal points. This has increasingly led us representatives to attend oral proceedings as teams, with the lead of the team subsequently taken by different members of the team as discussion progresses through the various topics debated e.g. new matter,

sufficiency of description, novelty and inventive step. We thus bear part of the blame for making oral proceedings so taxing and oppositions so long to be ruled upon.

This may lead to quite entangled situations. For instance – I deliberately refrain from providing too much detail, as the case is still pending in some jurisdictions – an EP patent, already found valid and infringed by a UK Court, is similarly held to be infringed in Germany. There “bifurcation” applies, and in deciding not to stay the infringement proceedings, the German court briefly considers the opposition which is pending at the EPO against the patent, taking the view that this is unfounded. The following day, the EPO revokes the patent in its entirety, and in the UK the first instance decision (patent valid/infringed) is subsequently confirmed in appeal. The EPO decision leading to revocation is in turn appealed. In appeal, the patent is held to be valid by the EPO on the basis of claims extensively amended, and the case is sent back to the Opposition Division to render a first instance decision on the points of novelty and inventive step – revocation in the first instance was on new matter issues. A new EPO decision and appeal follow.

In the meantime, a parallel action in Italy which was started after the actions in the UK and Germany moves through the technical expertise stage and reaches the decision stage. This is at a point where the EP patent as originally granted no longer exists (this was revoked by the EPO in the first instance and *de facto* surrendered by the patentee when submitting extensively narrowed claims in appeal) and a final text will become available only if and when the oppositions proceedings are terminated. Even if possibly different, decisions by the national courts will not conflict, insofar as they apply to their respective jurisdictions. Decisions by the EPO as the patent granting authority are however pre-emptive: e.g. if the EPO eventually revokes the patent, this will no longer exist *ab initio*, with any contrary earlier national judgment overruled and rendered void.

This contingency may affect the activity of court appointed experts, e.g. European representatives called to advise a court on technical points debated in litigation. Those experts may be requested to submit their reports within a certain date, possibly when oral proceedings dealing with the same patent are scheduled to be held at the EPO after that deadline. An evaluation provided in the report by the court expert in respect of e.g. validity may thus be overruled by a decision subsequently rendered by the EPO. Such a decision may be based on a further claim amendment submitted after the court appointed expert has submitted his or her report for the judge.

A question may then arise: how can the Unified Patent Court address this issue? The Unified Court will be in a position to dispense with possible discrepancies in judgments rendered by different jurisdictions, however the problem of coordinating operation of the Unified Court and the EPO will remain. The ruling of the Unified Patent Court (e.g. a decision as to nullity of a patent) will have effect in all the contracting States, exactly like a decision rendered by the EPO in opposition.

One may then suggest that the possibility of filing oppositions at the EPO should be simply eliminated *in toto*. This is perhaps an overly radical approach: the purpose of an opposition at the EPO may be different from the purpose of a nullity action before the Unified Court. Opposition at the EPO is oftentimes a precautionary step: a party may consider opposition at the EPO as a good step against a potentially obstructive patent. The related costs, such as the opposition and appeal fees, which are thoroughly reasonable, may still render opposition an attractive option. Also, eliminating opposition before the EPO may not be the best option in one considers the number of oppositions and related appeals currently handled by the EPO yearly: these would certainly represent quite a heavy burden for the Unified Court to deal with.

Another suggestion might be to turn EPO opposition into a purely administrative re-examination procedure, a sort of supplemental examination of an EP patent upon request by a third party. Again, this suggestion does not properly reflect the reasons which may underlie an opposition before the EPO.

Another option may be to provide a principle of precedence. When centralized limitation provisions were introduced in the European Patent Convention (EPC2000) as we discussed this morning, a principle of precedence was set out in Article 105a § 2 EPC and Rule 93 EPC: while opposition proceedings are pending at the EPO, a request of limitation may not be filed; if, at the time of filing an opposition, limitation proceedings are pending, the limitation proceedings are terminated. Opposition then takes precedence over a limitation request. Similarly, letting a nullity action before the Unified Court take precedence over opposition in the EPO may be an option deserving some thoughts.

Many issues remain of course outstanding and we technical counsel look forward to your directions.

European Patent: A Variable Geometry Right? Limitations and Amendments of Claims during Litigation

Italy

Giovanni Galimberti, Bird & Bird, Milano

During yesterday's session, I was rather surprised in listening to the intervention of some professors of Intellectual Property law, among which the one of Prof. Franzosi, who even hypothesized a possible violation of the Convention of the Human Rights where an amendment of the claim of a patent is allowed.

I deem it is necessary to read quite carefully Article 79 of the Italian Intellectual Property Code, subject matter of this conference, which reads as follows: *"In invalidity proceedings, the owner of the patent has the right to submit to the Court, at any stage or instance of the judgment, a reformulation of the claims"*.

The same article continues, clearly specifying that the mentioned reformulation of the claims shall remain "within the limits of the content of the patent application as initially filed and that does not extend the protection conferred by the granted patent".

In other words, the reformulation of the patent can be only a limitation.

So the issue that I will address here is if in the reality the above indicated Article 79 of the Italian Intellectual Property Code adds anything to the already well-established Italian practice and case law.

Even before the introduction of this provision, in fact, whoever enforced a patent, noticing that the patent was beginning to show *"signs of strain"*, or however believing that it could show *"signs of strain"*, was used to submit - normally to the

Court Technical Expert - a possible different interpretation of the patent, often combining two or more claims.

Moreover, even in cases where in invalidity proceedings the owner of the patent did not request or propose an amendment of the claims, the Judge was in any event bound to determine the scope of protection of the patent and, in case, to declare it partially invalid.

In all the above cases a limitation / amendment of the claims - which has always been considered lawful and admissible - occurred.

In my view Article 79 of the Italian Intellectual Property Code simply establishes the terms and the conditions according to which the amendment of the claims shall be proposed.

And indeed, the patentee has now the burden to provide its own interpretation of what he considers the valid scope of protection of his patent in a “more formal” way, directly addressing the Judge.

Nevertheless, the amendment of the claim cannot lead to any limitation of the patent owner’s right to the compensation for damages, as instead argued by someone in previous speeches.

After all, I am not aware of the fact that in the past, in cases where it was ascertained that the enforced patent was only partially valid – eventually through a reformulation of the claims – but in any case infringed, someone ever considered the issue of exonerating the infringer from the compensation for damages.

Nor this issue was considered in the any other cases where the claims were or are amended during infringement proceedings.

As a matter of example, let’s consider the case in which the patentee decides to start infringement proceedings and enforces a European patent that is granted, but is still under opposition or appeal proceedings before the EPO.

As known, it is a well-established practice of the Italian Courts – as well as of other European jurisdictions – to proceed in the assessment of the validity and the infringement of the Italian designation of a European patent without awaiting the outcome of the administrative procedure before the EPO. And it may well occur that

during the Italian proceedings a decision of the Opposition Division or even of the Board of Appeal is issued, by which the claims are amended.

In similar occasions it has never been considered that the right for compensation for damages had to be evaluated in a way different from the case in which the enforced patent had not been amended following the proceeding before the EPO.

Simply, the claim as amended by the EPO after opposition became and becomes the claim subject matter in the Italian proceedings. And, at that point, if the Judge determines that the claim is still valid and infringed, normally condemns the infringer to compensate the damages.

Even more, to use a more provocative example, as known the Italian system, unique in Europe, allows to start proceedings on the basis of a mere patent application without the necessity to wait for the grant. The only requirement to enforce an application for a European patent is to file the translation of the claims – and not of the whole patent - before the Italian Patent Office.

In these situations it is likely that a patent application filed before the EPO will be then granted with a different and amended scope of protection – and often claims – compared to the application initially filed. The patent application and the relevant claims are in fact discussed at length with the examiner before grant, sometimes also in light of possible observations by third parties. At the end of this administrative process the claims as granted may well be completely different in structure and scope of protection from those of the original application.

But also in this case, if the patent granted at the end of the administrative procedure is considered valid and infringed by the Italian judge, it follows the condemnation of the infringer to compensate damages, without discussions about the amendments intervened during the administrative phase at the EPO.

Someone also raised the issue of the possible issues on protection of third parties when a limitation of the patent occurs.

In my view the protection of third parties lays in the fact that the Court has to verify that the possible amendment of the claims remains within the limits of the patent application as originally filed, that the enforced patent does not extend beyond its original scope of protection and, in any case, that it is supported by the specification.

In any case, from the publication of the application, or from the filing of its translation in a country, the third party knows and should know the patent and cannot limit itself to a strictly literal, crystalized examination of the same, being bound to keep into consideration the fact that said patent could be amended, obviously within the limits provided by the Italian Intellectual Property Code and by the European Patent Convention.

In other words, it is burden of the third party to examine in depth the content of the patent as published, to take responsibility of the commercialization of a product that may interfere with its scope of protection and, eventually, to be liable for the compensation of the damages caused by any possible infringing activity.

In my opinion, if this was not the case, there would be issues not only in relation to the compensation for damages but also in respect to injunctions.

As a matter of fact, following a – non-shareable – theory, in order to the grant of an injunction it would be necessary also the evidence of the negligence of the infringer.

Therefore, following the mentioned theory, when there is a limitation of the patent, it would be necessary to evaluate if the infringer could have expected the patent as amended.

If, as result of this evaluation, the Court concludes that the limitation was not knowable or “foreseeable”, then we should probably say that the infringer is in some way “excused” and can continue his activity – even interfering with the patent – within the limits of the so called “pre-use”.

I deem that this situation is inadmissible and cannot be admitted.

Moreover, if we followed the above said theory the Judge would face an extremely unpleasant situation: which is the activity interfering with a patent that, at the same time, exonerates from the compensation from damages (and possibly even from an injunction) the infringer? Would a limitation consisting in the combination of two claims of the patent as originally (filed or) granted be sufficient? Or would a different kind of limitation be necessary? And, in this case, how should the Judge proceed? Shall importance be given to the fact that the limitation is quantitative? Shall it be sufficient that two or three words are taken from the specification and inserted into the claims to exonerate the infringer from the compensation for damages? And shall we differently conclude (and therefore condemn the infringer) if the words taken from the description and inserted into the claims are more than two or three?

This would be a situation of great uncertainty for the whole system and, in particular, for third parties.

Let me go further and make another - provocative - example.

During this conference we also discussed infringement by equivalence.

In my opinion, if we follow the strict approach indicate above, in case of infringement by equivalence the third party could somehow hide itself behind a strictly literal reading of the patent and be exempted from liability for infringement and from compensation of the damages. The third party would be somehow “excused”.

The easy reply to a similar interpretation, nevertheless, is that it is burden of the third party to carry out an effort of interpretation of the patent and to verify that it does not fall within its scope of protection either literally or by equivalence.

In my opinion this is exactly the same “effort” requested to the same third party when facing any patent that could be limited by its owner (within, obviously, the limits set forth by Article 79 of the Italian Intellectual Property Code).

The third party shall in fact examine and interpret the text and the content of the patent, without limiting itself to a literal interpretation, but carefully understanding what is its valid scope of protection, even in case of a possible limitation.

Part II

Mock Trial

Preface on the patent

Michele Baccelli, Hoffmann Eitle, Munich and Milano

One *panino* for a quick lunch before rushing to Franzosi's offices could not end without *caffè*, though this time it did not leave the usual feeling and taste. To reach the appointment, the walking route brought me in front of and around the opera house *Teatro alla Scala*: no opera on at this time of the day, only tourists looking at the play bill and workers on a side entrance busy with staging material.

The topic on the agenda with Prof. Franzosi and Ms. Stein was deciding on which subject matter to base the mock trial, with the main typical requirements being that it should not be technically complex and shall not favour attendants expert in one field over others. Certain mechanical cases can be considered to be relatively easy to grasp, even visually and also by those less involved in the technical details. But their intrinsic functioning and the specific terminology often hide technical pitfalls that can be more easily and quickly spot by those routinely handling such cases.

Ideally, one should draft a mock case that is not at all technical, though at first glance this is a contradiction: if patents are for protection of technical subject matter, how can a patent mock trial be non-technical?

Before one could be persuaded that this could not be a viable solution for a patent mock trial, Prof. Franzosi's wish came in, namely of possibly revolving the example around animals like dogs, sheep and wolves. The assignment of developing a case out of the general idea became clear to the only patent attorney present in the room, and the meeting could be closed. The brainstorming having cleared out many thoughts, the *caffè* and its aroma, at the same bar but after the meeting, tasted now as it should, and a popular *aria* seemed almost to come out of the nearby opera house.

Starting from the above premises, the mock-up text has then been elaborated by trying to maintain a parallel with some basic patent principles, like setting an object to reach, proposing a solution, explaining (or hinting to explanations of) the possible inter-relationships between the components making up the solution. At the same time, the claims and the (not always) supporting description have been

intentionally modelled to leave certain aspects of the disclosure implicit or even ambiguous, with the aim of testing how far the person skilled in the art of rearing animals could read into the disclosure.

Furthermore, the case has been shaped also with the intention of possibly identifying whether different jurisdictions could come up with different conclusions. By now, national legal provisions including those on amendments are, often literally, aligned with the EPC. It is also said that national case law on added matter is consistent with that of the EPO, namely that amendments are allowable as long as the skilled person would be able to derive the amendment unambiguously and directly from the originally filed application documents. Amongst practitioners (and not only) having faced multi-jurisdictional litigation, there is however a latent impression that still the general principle of jurisprudence may lead to different results in different countries. The writer is not aware of any clear examples to support such impression, which however seems justified by the fact that there can still be some margin in interpreting the capabilities of the skilled person: namely, whether and to what extent the skilled person would regard a feature as directly and unambiguously derived from the original disclosure. Simplifying with other words, while national patent offices and courts seem to agree that literal disclosure is not the requirement for allowing amendments, there seems to be still some unquantifiable differences in assessing how far the skilled person would depart from the literal disclosure.

The resulting mock trial comprises three patents A, B and C, all sharing the same description, but each distinguished by a different granted claim 1. For the purpose of the exercise, the granted claims have been deemed to be the same as originally filed, i.e. the claims were not amended during prosecution. For each patent, a number of questions have been formulated as to whether an amendment strongly wished by the Proprietor can be allowed or not. It was an aim of the exercise to have certain proposed amendments that could be more easily answered than others. Patent attorneys were then asked to make their case on behalf of hypothetical parties.

The actual debate showed that indeed there can be many reasons for arguing in favour and against the amendments being allowable, regardless of how borderline the case can be.

While this remains an illustrative mock up, it shows that indeed national approaches are apparently aligned, at least in that they reach the same conclusion in most of the cases, even if the reasoning could be possibly slightly different. Also, the alignment seems to be on the side of setting a high hurdle for allowing a claim amendment.

At the same time, as the German judge's dissenting opinion on question 3 shows, the results of the mock trial also apparently confirm the latent impression that different national courts may recognize slightly different capabilities to the skilled person's reading, thus potentially arriving at different conclusions. It is nevertheless important stating that such differences, if actually going beyond mere perceptions, would be overall an exception to the somewhat European uniformity in the substantial assessment of amendments.

Special thanks go not only to Prof. Franzosi for having ignited the spark, but also to Avv. Anna Maria Stein for several reviews of the text and valuable feedback, and of course to all the patent attorney colleagues involved in the preparations and presentation of the mock-up case for their contributions and fine tuning of the final version of the text.

Mock Patent “Cani e Lupi”

Description

The present invention concerns the rearing of animals inside dedicated facilities or in natural environments or a combination of the two.

One recurrent problem consists in protecting animals from external attacks, the well-known solution being the use of fencing. However, this prior art solution proves to be insufficient. Thus, more effective protection of animals needs to be achieved.

The present invention is the result of a series of observations that we have made in our animal husbandry facilities for rearing a diverse range of animals, among which sheep belonging to the family Bovidae, dogs, horses and also donkeys, which are known to have several characteristics in common with horses as both belong to the same family Equidae. We also raise wolves, which we keep separate from the other animals inside our facilities. However, observing accidental and occasional interactions between the animals of the various species, we have noted that the wolf has a propensity to attack the sheep, whereas the dog has a propensity to protect the sheep, especially against wolves that attempt to approach them. In subsequent experiments, we have also found that the dogs tend to protect the horses as well, should a wolf attempt to approach them. We have also observed the tendency of the dogs to protect dwellings against strangers. It would thus appear that the dogs have a predisposition to be protective of persons and animals. Moreover, they grow fond of the facility irrespective of the presence of people. From the various experiments conducted, it was also noted that the wolves often demonstrate protective behaviour similar to that of the dogs, especially if the areas are relatively unfrequented or at building facilities with restricted access such as those used for military purposes; the wolves intimidate people and keep them away, even the most daring and fearless.

Based on our observations, we have arrived at the solution specified in the claim.

Patent A

Description: as above.

Granted claim:

1. A system comprising at least one building facility and/or a group of animals and a dog to protect said building facility and/or said group of animals.

Q1 Is it allowable to amend the granted claim as follows?

1. A system comprising a group of animals belonging to the family Bovidae and a dog for protecting said group of animals belonging to the family Bovidae.

Q2 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one non-residential building facility and a dog for protecting said non-residential building facility.

Q3 Is it allowable to amend the granted claim as follows?

1. A system comprising a group of animals belonging to the family Equidae and a dog for protecting said group of animals belonging to the family Equidae.

Q4 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one building facility, which jointly accommodates persons and animals, and a dog for protecting said building facility, provided that said building facility is fenceless.

Patent B

Description: as above.

Granted claim:

1. A system comprising at least one group of horses and an animal for protecting said group of horses.

Q5 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one group of donkeys and an animal for protecting said group of donkeys.

Q6 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one group of horses and a wolf for protecting said group of horses.

Patent C

Description: as above.

Granted claim:

1. A system comprising at least one building facility and an animal for protecting it.

Q7 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one building facility used as a military installation and a wolf for protecting it.

Q8 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one military installation and a dog for protecting it.

Patent A – Q1

M. Modiano – V. Faraggiana

Granted Claim

1. A system comprising at least one building facility and/or a group of animals and a dog to protect said building facility and/or said group of animals.

Amended Claim

A system comprising a group of animals and a dog for protecting said group of animals belonging to the family Bovidae

Highlighted Requested Amendments

1. A system comprising ~~at least one building facility and/or~~ a group of animals belonging to the family Bovidae and a dog to protect ~~said building facility and/or~~ said group of animals belonging to the family Bovidae.

For the Patent Proprietor, Micaela Modiano:

As regards the deletion of the feature “*at least one building facility and/or*”, the deletion of this feature is supported in the application as originally filed. In fact, thanks to the conjunction “*and/or*” the granted already clearly contemplated three embodiments, namely (i) a system comprising a building facility with a group of animals, (ii) a system comprising a building facility *tout court* and (iii) a group of animals *tout court*. Thus, the deletion of that feature merely amounts to the deletion of one of the three embodiments.

The deletion of the above feature does not cause the scope of protection of the amended claim to extend beyond that of the granted claim, since the system of the amended claim does not comprise anything other than, or in addition to, what was already covered by the granted claim.

Rather, the deletion of the above feature actually represents a limitation since a system comprising solely a building facility is no longer protected by the amended claim.

For all these reasons, the deletion of the mentioned feature is allowable.

As regards the fact that the amended claim specifies that the animals belong to the family Bovidae, this specification is supported by the application as originally filed, in particular by lines 9-10 of the description which mentions “*a diverse range of animals, among which sheep belonging to the family Bovidae*”. In this respect, it is true that the passage mentions “*sheep belonging to the family Bovidae*” and not simply “*Bovidae*”; however, the skilled person would have no doubt regarding the suitability and useability of the system for protecting Bovidae altogether and from the explicit reference to the family Bovidae in the description he would draw the unambiguous teaching regarding the applicability of the system to all Bovidae as a whole.

The specification that the animals belong to the family Bovidae does not represent a broadening of the scope of the amended claim compared to that of the granted claim, as the system of the amended claim does not cover any animals which were not already covered by the granted claim.

Rather, such specification represents a limitation as a system comprising animals other than those belonging to the family Bovidae is no longer protected by the amended claim.

For all these reasons, the mentioned specification is allowable.

For the Plaintiff (Opponent), Vittorio Faraggiana:

I think that the requested limitation is not acceptable because not supported by the description of the patent as originally filed, nor can it be even considered a mere limitation.

The first amendment requested for the construction of the limited claim consists in deleting the words “a building facility” where the granted claim defines a system that has to include “a building facility and/or a group of animals” possibly combined (in my opinion this is what derives from the use of “and/or”).

Therefore, the amendment results in the mere elimination of the existence of the building facility, which is indicated as possible and alternative to the existence of a group of animals already mentioned in the granted claim.

I would be inclined to consider this first limitation resulting from this amendment legitimate, as it is explicitly already contained in the claim as granted. Furthermore, it can be noted that the limitation that excludes the presence of the building facility in a possible (“and/or”) combination with a group of animals is also supported by the description. In fact, the description indicates the building facility as just possibly existing, because the invention can refer to groups of animals in a natural environment where we may reasonably assume that building facilities do not exist.

Instead, I think that the second limitation concerning the definition of animals that constitute a “group of animals”, namely the replacement of the words “*group of animals*” with the words “group of animals belonging to the family *Bovidae*”, is added matter. I apologize, but I wish to point out that I put an emphasis on the letter “o” not to play hard to get, but because we are dealing with bovid that are quite different from cattle. Bovid are all artiodactyl animals, whose paws have an even number of fingers, namely a huge family including eight sub-families, such as cattle, goats (which sheep belong to), etc.; anyhow, it can be considered a very huge family, without getting lost in the study of the Linnaean classification. Now, the description deals with the application of the system as including the sheep. The sheep are known to belong to the huge family *Bovidae*, which includes hundreds and hundreds of sub-species. Not only. The description highlights that different effects of the invention can occur according to the combinations between the protective and the protected animals. It suffices noting that the description states that “*by observing the accidental and occasional interactions between the animals of the various species*”, the inventor observed different effects according to the combination of protective and protected animals.

Now, it is true that the bovid belong to animals and therefore the limitation defines a sub-group, which is entirely contained in the group of animals cited in the granted claim. This is right. However, if we replaced the word “animals” with the word “bovid”, we would introduce a selection in a surreptitious manner. I say in a surreptitious and not in a justified manner because we would extrapolate the feature of belonging to a certain family of animals from the mention in the description of an animal precisely indicated, namely the sheep. From this indication, namely from a feature of a specific animal, we would extrapolate, and therefore inappropriately generalize, a feature. In this way, we would carry out a selection among all animals, which is in no way suggested by the invention. It is easy to get convinced of this: according to common experience and knowledge, the sheep generally have a woolly fleece; nevertheless, I absolutely cannot replace the word “animals” with the words “animals with woolly fleece” because I would conduct a precise selection among all animals, which was not at all intended by the description.

Thus, the use of a specific feature (the membership to the family *Bovidae*) of the described animal (the sheep), its extrapolation and generalization (all bovid), would identify a mental act not at all suggested by the description.

Thus, the selection of the bovid deriving from the amendment to the granted claim requested as “limitation” is absolutely illegitimate and not supported directly and without ambiguity by the description considered in its entirety, even if formally the word “bovid” identifies a sub-group of the group (animals) defined by the claim as granted.

The patentee’s statement that the description mentions the membership of the sheep to the family *Bovidae* is correct, but it does not indicate that in general this element allows achieving the invention’s effects.

The membership of the sheep to the family *Bovidae* is cited in the description exclusively as an accidental fact, and no correlation between the membership of the sheep to the family *Bovidae* and the achievement of the invention’s purposes is described. From this accidental feature of the sheep, the skilled person cannot deduce that the entire family *Bovidae* may have uniform features that can be generally considered in the application of the invention.

When the description deals with horses and donkeys, it states that they have features in common because they both belong to the same family *Equidae*. The description teaches nothing about the fact that the invention must have an application in particular to the sheep because belonging to the family *Bovidae*. The membership of the sheep to the family *Bovidae* is cited as a mere accidental fact and the skilled person cannot deduce from this that the bovid have specific features, which involves that the invention has particular effects for these animals.

In conclusion, the indication of the family *Bovidae* in the claim introduces a selection not conceptually contained in the description and therefore must not be admitted.

If any doubt persists, I think that in such a case the limitation should not be admitted because it would introduce a new teaching. This new teaching would not only unduly favour the proprietor, but also disfavour the researchers who successively may search inventions dependent on the one described in the patent: therefore, accepting the limitation would involve a double damage for the community.

The requested amendment introduces new matter and has to be rejected because it would extend the patent content beyond the content of initial application.

Patent A – Q2

S. Hassan – G. Dragotti

For the Patent Proprietor, Sandro Hassan:

Deletion of “and/or a group of animals and a dog”, “and/or said group of animals”.

By referring to “*one building facility and/or a group of animals*”, the granted claim expressly comprises three different embodiments, which include respectively:

- one building facility
- a group of animals
- one building facility and a group of animals.

By deleting the second and the third embodiment, a mere limitation of this claim is made. There is neither addition of subject matter nor extension of the protection.

Replacement of “building facility” by “non-residential building facility”

A first argument in favour of admissibility is based on the wording of the granted claim. The claim refers to a “*building facility*”. Building facilities can be either residential or non-residential, further categories of building facilities do not exist.

Accordingly the granted claim includes by definition both residential and non-residential building facilities. By limiting this claim to non-residential facilities, the patentee does not propose a selection lacking support, but simply renounces one of the two options that are both included in the claim. Renouncing one of two or more options constitutes a typical limitation.

This has nothing to do with the selection of a specific chemical compound out of a broad general formula. A general formula normally includes thousands or more of options, and picking up one or few specific ones evidently constitutes an inadmissible selection, in the absence of specific indications in the description. In

this, case, however, the options are only two, and both of them are very clear to any reader, at least implicitly.

A further argument in favour of admissibility is based on the description, which expressly refers both to residential and to non-residential building facilities and provides in particular the following information:

- “we have also observed the tendency of the dogs to protect dwellings” (lines 19-20)
- observations made in “*animal husbandry facilities*” have shown that dogs “*grow fond of the facility*” (lines 9, 21-22);
- wolves and dogs have a similar protective behaviour, “especially at building facilities with restricted access such as those used for military purposes” (lines 23-26).

Therefore the description is disclosing the dogs’ protective behaviour with respect to both types of facilities. Moreover it provides two specific examples of non-residential facilities, i.e. animal husbandry and military facilities.

This means that the description is clearly supporting both alternatives. Accordingly, removing one alternative constitutes a limitation, not an unsupported selection.

For the Plaintiff (Opponent), Gianfranco Dragotti:

The starting point is that of the differences between the granted claim and the modified one being proposed.

First of all the granted claim recites: “A system comprising at least one building facility and/or a group of animals and a dog to protect said building facility and/or said group of animals.”

The proposed limitation or the modification (because in my opinion it is a “modification”) reads “A system comprising at least a non-residential building facility and a dog to protect said non- residential building facility”.

Thus the differences are the deletion of the reference to a group of animals and the non-residential character of the building facilities.

When a modification proposal of a claim is taken into consideration, I would suggest that the starting point is that of checking what is said in the specification because that is the place where the possible bases are to be found.

What is said in the specification?

That the invention relates to the breeding of animals, which are bred either in devoted facilities or in natural environments with their combinations. The problem indicated as the general problem is the protection of animals from external attacks and also an indication of prior art is provided, consisting in the use of fencing, which however is considered as an insufficient protection.

Thus the specific problem aimed at by the invention is that of a more effective protection of the animals. I omit the list of the animals being bred, because more interesting - I would call it as the experimental evidences- are the evidences provided by the specification.

It is worth to shortly list these evidences:

- wolves attack sheep, although this is relatively interesting in the present case;
- dogs protect sheep, especially against wolves;
- dogs protect horses, again against wolves;
- dogs protect dwellings against strangers and tend to protect both persons and animals.

Dogs grow fond of the facility independently from the presence of people. Then the wolves are considered, but as an analogy with dogs, namely having a protective behaviour and thus in fact protect relatively unfrequented or qualified access facilities such those for military use.

In the specification facilities are mentioned in general terms, directed, as stated by the opposing counsel, to the breeding of animals. No fence is contemplated. Houses are contemplated, as confirmed by the statement relating to dogs as being inclined to protect against strangers. It is also stated that dogs become fond of the facility independently from the presence of people and lastly, still talking about facilities and referring to wolves, it is reported that they, like dogs, protect building facilities with qualified access such as those used for military purposes.

Thus the first difference to be noticed is that relating to the deletion of the group of animals. As confirmed by the analysis of the specification, the invention definitely

relates to the protection of animals from external attacks and the purpose stated as well is that of achieving a more effective protection than that provided by fencing still for the protection of animals.

Consequently since the reference to the group of animals disappears from the modified claim, the invention as proposed by the modified wording would be directed to the solution of a different technical problem it being the protection of a building facility, but this technical problem is not dealt with, is not contemplated per se by the invention. As a matter of fact, looking for a basis in the specification referred to the building facility alone, we should limit to the dwellings, as being those protected by dogs, or to the building facilities with qualified access, as being too protectable by dogs.

Thus in my opinion this is a first point which is an unjustified broadening.

As the second point reference is made to non residential building facilities: non residential is a synonym of non inhabiting facility: if we look at the statement of a simple dictionary such as that of Treccani, which is the main reference dictionary for Italian citizens, it states that residential buildings are those intended exclusively for residence and civil dwelling, being thus distinct from the facilities intended for fully different uses. Consequently non-residential building facility is a synonym of non inhabiting facility. In the specification (lines 19 to 20) it is stated that dogs tend to protect dwellings against strangers, but the word dwelling cannot be a base for the wording non-residential building facility, the latter being, as already stated, a synonym of non inhabiting facility.

The specification also states that “dogs have a predisposition to be protective of persons and animals”, but also this statement cannot be a reference for the wording ‘non-residential building facility’, since the presence of persons, which cannot be eliminated, involves an inhabited building facility, namely residential, which cannot be non-residential.

Lastly I would recall the attention to the fact that the wording non-residential not only is not contained in the specification as originally filed, but moreover (referring to EPO approach) is not directly and unambiguously derivable from the specification. The latter is referred only to facilities intended for breeding of animals, or to building facilities with qualified access such as those used for military purposes, whereas the term or wording non-residential is much more generic and encompasses the building facilities which for instance do not require particular conditions for the access.

For the above reasons in my opinion the proposed wording is not a limitation but it would amount to a protection extending beyond the scope of the patent as granted.

Patent A – Q3

F. Macchetta – P. Rambelli

Description: as above.

Granted claim:

1. A system comprising at least one building facility and/or a group of animals and a dog to protect said building facility and/or said group of animals.

Q3. Is it allowable to amend the granted claim as follows:

1. A system comprising a group of animals belonging to the family Equidae and a dog for protecting said group of animals belonging to the family Equidae.

For the Patent Proprietor, Francesco Macchetta:

Admissibility of the requested amendment

Conformity with Art 79(3) CPI (Italian Industrial Property Code) that in its paragraph (a) prescribes that any reformulation of the granted claims remain within the boundaries of the content of the original disclosure and in its paragraph (b) prescribes that it does not otherwise extend the protection conferred by the granted claim(s), in line with Art 123(2) and (3) EPC.

- a) The amended claim remains within the boundaries of the original disclosure since it is based on the original description, specifically, lines 8-13 where the family “**Equidae**” it is expressly mentioned among the examples of “animals” to which the claimed invention relates to, with reference in particular to two of its well known members, i.e. “horses and donkeys” (see the original description, cited paragraph where it is stated :”diverse range of **animals**, among which... horses and donkeys, which are known to have several characteristics in common with them as both belongs to the same family **Equidae**.” No doubt therefore that the person skilled in the art, reading the whole description at the relevant time, understands “Equidae” to be a “group of animals” to which the invention pertains. Since substituting “Equidae” to “animals” in the original claims, is a

genuine limitation of the scope of the granted claims and is based on the original disclosure, we submit that this amendment is allowable under Art 79(3) CPI.

- b) The amended claim represents also a limitation of the original claim in that it relates to only one of the alternatives contained in the granted claim. In fact while the original claim concerns “at least one building facility and/or a group of animals...” the amended claim now relates only to one of the possible alternatives i.e. “a group of animals...” (further specified as being “Equidae”, as already illustrated). No doubt therefore that the amended claim fulfills the requirements under Art 79(3)(b) CPI. Since it is also based on the original description (as it was indeed acknowledged with the granted claim) see for instance lines 1 and 2 (“The present invention concerns rearing of animals **inside** dedicated facilities **or** in natural environments...”) it also satisfies the requirements of Art 79(3)(a) CPI.

Conclusions:

In conclusion we submit that the proposed amended claim should be allowed.

For the Plaintiff (Opponent), Paolo Rambelli:

Although the term “system” in granted claim 1 is rather unclear, my interpretation is that this is a “device claim” corresponding to three independent claims which respectively recite the combination of the following integers:

- 1) building facility + group of animals + dog
- 2) building facility + dog
- 3) group of animals + dog.

The amended claim deletes the above-mentioned claims 1 and 2 and claims a subset of the above-mentioned claim 3, namely:

3' (amended) - Group of animals of the Equidae family + dog.

The amended claim does not broaden the extent of protection of the patent as granted and constitutes a limitation compliant with Art. 79(3) CPI, last requirement, whereby no ground of nullity of the amended patent can be raised under Art. 76(1) (c) CPI, last alternative.

However, the amended claim **does not remain within the limits of the content of the patent application as originally filed** and violates Art. 79(3) CPI, first requirement, thus generating a ground of nullity under Art. 76(1)(c) CPI, first alternative.

In support of the above-mentioned ground for nullity, the following argument is submitted:

- the description, as filed, states that “dogs tend to protect the horses as well, should a wolf attempt to approach them” (page 1, lines 18, 19);
- the description also suggests that the invention may be applied to “**horses and also** donkeys, which are known to have several characteristics in common with **horses as both belong to the same family Equidae**”(page 1, lines 10-11).

The above quoted first sentence of the description may support an amended claim referred to the combination of “a group of horses and dog”, but, by itself, does not disclose and support the more general concept of “group of animals of the *Equidae* family”. Such a generalization is not equally supported by the above-quoted second sentence, wherein the reference to the “*Equidae* family” has only the purpose of better characterizing “*horses and dogs*”, but cannot be construed by the person skilled in the art as a clear and unambiguous teaching that the invention may be applied to all the *Equidae* family.

As shown by the attached exhibit (cf. it.wikipedia.org/wiki/Equus) the *Equidae* family includes twelve species, among which the two domestic species, horse (*Equus caballus*) and donkey (*Equus asinus*), to which the original disclosure of the patent application refers, as well as their sterile hybrids (mule and hinny) and some wild species, such as zebras.

The proposed amendment, therefore, extends the original teaching of the description, which was limited to the above-mentioned domestic species to the ten species within the family, which were not described or mentioned.

The fact that original claim 1 (whose content is here considered as an integral part of the original description) disclosed the broader concept of “a group of animals” in combination with “a dog” is irrelevant, since indeed the teaching of a group of animals does not specifically disclose the *Equidae* family.

It follows that the proposed amendment provides for an undisclosed generalization which is intermediate between the originally disclosed species “horse and donkey”

and the originally disclosed concept of a “group of animals”, which intermediate generalization is therefore inadmissible since not supported by the original description.

The counterargument that the person skilled in the art, on the basis of the above-mentioned teachings in the original disclosure, would be in the position to extend such a teaching to other species of the *Equidae* family is, in my opinion, irrelevant and legally inadequate. In fact, the test for the admissibility of an amendment vis à vis the content of the original description may not be a subjective test carried out with reference to the person skilled in the art, but it must be an objective test based on what is explicitly and unambiguously disclosed (although taking into account what is implicit within the explicit disclosure).

The issue as to whether the skilled in the art would be able to extend the teaching may at most be considered in the context of the assessment of the extent of protection of a granted claim, possibly on the basis of the principle of equivalents, but if the applicability of such a test to evaluate the admissibility of an amendment is accepted, that would lead to the consequence that the claim construction of the thus amended claim could possibly further extend the scope of protection.

Patent A – Q4

M. Modiano – C. Germinario

Granted claim:

1. A system comprising at least one building facility and/or a group of animals and a dog to protect said building facility and/or said group of animals.

Amended claim:

1. A system comprising at least one building facility, which jointly accommodates persons and animals, and a dog for protecting said building facility, provided that said building facility is fenceless.

For the Patent Proprietor, Micaela Modiano:

As regards the deletion of the feature “*and/or a group of animals*”, the deletion of this feature is supported in the application as originally filed. In fact, thanks to the conjunction “*and/or*” the granted claim already clearly contemplated three embodiments, namely (i) a system comprising a building facility with a group of animals, (ii) a system comprising a building facility *tout court* and (iii) a group of animals *tout court*. Thus, the deletion of that feature merely amounts to the deletion of one of the three embodiments.

The deletion of the above feature does not cause the scope of protection of the amended claim to extend beyond that of the granted claim, since the system of the amended claim does not comprise anything other than, or in addition to, what was already covered by the granted claim.

Rather, the deletion of the above feature actually represents a limitation since a system comprising solely a group of animals is no longer protected by the amended claim.

For all these reasons, the deletion of the mentioned feature is allowable.

As regards the fact that the amended claim specifies that the building facility jointly accommodates persons and animals, this specification is supported by the

application as originally filed, in particular by lines 20-21 of the description according to which *“It would thus appear that the dogs have a predisposition to be protective of persons and animals”*. It is true that this passage does not explicitly state that the persons and animals are jointly accommodated in the building facilities; however, the skilled person would have no doubt about the suitability and useability of the system for protecting building facilities accommodating both persons and animals. From the explicit reference in the description to persons and animals as the entities to be protected, the skilled person would draw the unambiguous teaching regarding the applicability of the system to building facilities which are inhabited.

The specification that the building facility jointly accommodates persons and animals does not represent a broadening of the protection of the amended claim compared to that of the granted claim, since the system of the amended claim does not comprise building facilities which are not already covered by the granted claim.

Rather, this specification represents a limitation since a system comprising a building facility which does not jointly accommodate persons and animals is no longer protected by the amended claim.

For all these reasons, the mentioned specification is allowable.

Finally, as regards the introduction of the negative feature whereby the building facility is fenceless, this specification is supported by the application as originally filed since the application as originally filed never states that the building facility must be fenced.

Furthermore, the introduction of such feature does not represent a broadening of the scope of protection of the amended claim compared to that of the granted claim, since the system of the amended claim does not comprise building facilities which are not already covered by the claim as granted.

Rather, such feature represents a limitation, as a system comprising a fenced building facility is no longer covered by the amended claim.

For all these reasons, the introduction of the mentioned negative feature is allowable.

1. Extension of protection (Art. 76.1 (c) CPI & Art. 123 (3) EPC)

The amendment extends the scope of the protection. In fact, anyone who, before the amendment, had used a dog to protect a structure housing together people and animals, would not have infringed the granted claim that was limited to a system comprising a [...] structures and/or a group of animals.

The same action, after the amendment, becomes infringement, which unequivocally proves that the amendment extended the scope of the protection.

2. Extension of the technical content of the initial application (art. 76.1 (c) CPI & Art. 123 (2) EPC)

2.1. Claim I, the first part:

The first part of claim 1 cites the features: „A system comprising at least one building structure, which accommodates together people and animals, and a dog to protect the building structure ...“.

This feature is not described explicitly or implicitly in the text.

The patent specification refers, in line 1 and 2, to “*structures dedicated to breeding of animals*”.

Although it is undeniable that these facilities can accommodate both animals and people who look after livestock, the patent specification does not describe the condition or does not justify the conclusion, that one could use a dog to **simultaneously** protect people and animals in the same structure.

The text does not, in fact, allow the conclusion that the protective instinct of the dog will be manifested also in the presence of man. In reality, it would be reasonable to expect the contrary: if a man is there, the dog would understand to be redundant!

In details, the text explicitly describes, in separated and non-overlapping paragraphs, that a dog protects animals (sheep or horses) against the threat of a wolf (lines 15-17) or dwellings or structures against strangers (lines 18-19 and 20 -21).

In other words, the patent text describes the protective attitude of dogs, but separates the protection of animals from the protection of housing and building structures and therefore people.

Also the paragraph at lines 19 and 20, which states that the dog has a predisposition to be protective for people and animals, can only be read as the concluding paragraph of the preceding paragraphs, where the two activities of protection of animals and humans are maintained voluntarily separate. So this paragraph cannot be considered a good support for a claim that brings together “animals and people” in the same structure as the object of protection by the dog.

2.2. The disclaimer: “... provided that the building structure is without a fence.”

2.2.1. The disclaimer is not supported (*undisclosed disclaimer*) for different reasons, i.e. it is not described in the text of the original filed application. Moreover, under the present circumstances, the conditions of admissibility of an *undisclosed disclaimer* are also not met.

Although the very words “*fence*” is indeed present in the text (line 4), this word only appears in the section of the description dedicated to the “*state of the art*”, where it is affirmed:

“One of the recurring problems is the protection of animals versus external attacks, a problem normally solved with the use of fences.”

This section is not part of the description of the invention and accordingly cannot be properly used to limit the scope of the protection conferred.

On the contrary, the text section actually describing the invention does not report the presence of any “fence”, either in relation to facilities for animal breeding or in relation to building structures.

In fact, the passage of the patent text (lines 11 and 12), which affirms that in livestock holdings the wolves are kept separate from all other animals in the structure, does neither mean nor justify the conclusion that the separation is achieved through a

fence. The separation may be obtained e.g. by a deep ditch filled with water or the animals could be confined in separated spaces adjacent to each other (like horses in a stable).

From the foregoing, it is evident that the added disclaimer is indeed an “*undisclosed disclaimer*”, attempting to exclude from the scope of protection subject-matter that was not present in the original text.

It is well known that an “*undisclosed disclaimer*” is admissible (i) only if its purposed is to exclude from protection an **accidental anticipation** that would be relevant exclusively against the novelty of the claimed subject-matter. For “*accidental anticipation*” is meant a prior art document that, (ii) although being placed in a technical field deeply remote from the one of the invention and (iii) though solving a technical problem completely different from the one solved to the invention, falls, accidentally, within the scope of protection conferred by the patent before limitation.

In the present case, the “*fences*” cited in the prior art are immaterial to the requirement of novelty of claim 1, because the protection offered by a fence is something different from the protection offered by a dog. Therefore the first condition for admissibility of an undisclosed disclaimer is not met. Moreover, the fences cited in the prior art are in the same technical context as the present invention and are intended to solve the same technical problem as that solved by the present invention. Therefore also condition (ii) and (iii) are not met.

In conclusion, the prior art “*fences*” can neither be considered an accidental anticipation of the presently claimed subject-matter, nor a valid support for the undisclosed disclaimer. The disclaimer in claim 1 is therefore inadmissible because it extends the technical content of the originally filed patent application.

2.2.2. Also assuming that the concept of “*fence*” were implicitly described in the patent, the disclaimer would nevertheless represent an inadmissible extension of the original technical content, because the patent does not contain any hint or information teaching that the “*dog*” should, or could, be intended as an alternative measure to the “*fence*”, rather than an additional measures to the same, as it would be logical.

Patent B – Q5

C. Germinario – P. Rambelli

Claim 1 (granted):

A system comprising at least one group of horses and an animal to protect the said group of horses.

Claim 1 (amended):

A system comprising at least one group of donkeys and an animal to protect the said group of donkeys.

For the Patent Proprietor, Claudio Germinario:

1. Extension of protection (Art. 76.1 (c) CPI & Art. 123 (3) EPC)

The amendment does not extend the protection conferred by the granted patent.

In fact, the patent text contains, lines 9-11, the sentence:

[we breed] “... also donkeys which are known to share several features with horses, as they belong to the same equine family.”

This statement cannot be interpreted as a mere motivation of the fact that donkeys are also bred in the farm, because in this case the text would contain equivalent explanations justifying the fact that dogs, wolves and sheep are bred too. So the original purpose of this statement can only be to highlight an equivalence between horses and donkeys on aspects relevant to the breeder. For this reason, the original text implicitly, but clearly, includes among the “*several common characteristics*” shared by horses and donkeys also the features concerning their protection.

The amendment to the claim does not extend the conferred protection, because, in view of the donkey-horse equivalence, a third person making the action of “*protecting donkeys with a dog*” would have infringed the patent, also in the original form, under the doctrine of “infringement by equivalents”.

Thus, the amendment in the claim simply modifies the type of infringement, without making infringer any person who, before amendment, was not considered infringer. Therefore there is no extension of the protection.

2. Extension of the technical content of the initial application (Art. 76.1 (c) CPI & Art. 123 (3) EPC)

The patent text explicitly describes (lines 16, 17) that “dogs tend to protect also horses, when a wolf is trying to approach them.”

Yet it is implicit that in a farm where horses and wolves and other animals are bred, although separately, the wolves will always try to approach all the other animals, horses, donkeys sheep, or whatever. Therefore the condition that stimulates a dog to be protective towards horses is normally achieved in the explained situation.

In view of the equivalence (lines 9-11) between protection of horse and protection of donkey, the teaching that “*dogs tend to protect also horses*” (lines 16, 17) represents an implicit disclosure of the fact that dogs also protect donkeys.

For this reason, the amendment does not result in an extension of the technical content of the original application.

For the Plaintiff (Opponent), Paolo Rambelli:

Although the term “system” in granted claim 1 is rather unclear, my interpretation is that this is a “device claim” based on the combination (or aggregation) of two integers: a group of horses and a generic animal. The quotation in the claim of the function of the animal (“to protect said group of horses”) does not appear to impose any real limitation as to the nature of the protecting animal to be selected, since the claim does not recite “*animal suitable to or adapted to protect ...*”.

The proposed amended claim replaces the integer “group of horses” with “group of donkeys”, again in a combination with a generic animal.

The proposed amendment violates articles 79(3) CPI, first requirement and generates a ground of nullity of the patent under Art. 76(1)(c), first alternative, since it introduces subject matter which was not originally disclosed, whereby the

subject matter of the patent would be extended beyond the content of the original application.

Even though the granted claim is to be construed as an integral part of the original description (group of horses + generic animal), in the original description there is no explicit and non-ambiguous reference to the combination “group of donkeys and a generic animal”.

The only reference to donkeys in the original description is in the sentence at page 1, lines 8 to 12, wherein reference is made to a series of observations, carried out within the frame of the invention relating to the rearing of a diverse range of animals, among which horses and also donkeys are cited. Although the quoted sentence states that “*donkeys are known to have several characteristics in common with horses as both belong to the same family Equidae*”, such a statement cannot be construed as an explicit and unambiguous disclosure that the group of horses in granted claim 1 can be replaced by a group of donkeys within the context of the claimed system which provides for the use of a generic protecting animal.

Moreover, should the function “*for protecting said group of donkeys*” be construed as a real functional limitation to the protecting animal to be selected (contrary to the above-mentioned construction), then also the amendment “*an animal for protecting said group of donkeys*” would extend beyond the content of the application as filed, since it would define a subset of protecting animals which is undisclosed in the original application.

Moreover, the proposed amendment violates Art. 79(3) CPI, second requirement, and generates a ground of nullity under Art. 76(1)(c) CPI, second alternative.

In fact, the amendment extends the protection conferred by the granted patent in that it does not define a subset within the original scope of protection, rather it shifts the protection by aiming at protecting subject matter which was not originally covered by the wording of the granted claim.

Patent B – Q6

S. Hassan – M. Baccelli

Granted claim:

1. A system comprising at least one group of horses and an animal for protecting said group of horses.

Q6 Is it allowable to amend the granted claim as follows?

1. A system comprising at least one group of horses and a wolf for protecting said group of horses.

For the Patent Proprietor, Sandro Hassan:

The description provides the following information:

- “the dogs tend to protect the horses as well” (line 18)
- “the wolves often demonstrate protective behaviour similar to that of the dogs” (lines 23-24).

This directly and unequivocally discloses that wolves also tend to protect horses.

The statement that similarity has been noted “*especially if the areas are relatively unfrequented*” (lines 24-25) constitutes no limitation (“*especially*”).

Moreover, while the granted claim generally refers to “*an animal for protecting*”, the description specifically mentions dogs and wolves (the admissibility of such a general claim needs not be discussed here). Accordingly, replacing “*an animal*” by “*a wolf*” is an admissible limitation in the form of a supported selection, and has nothing to do with intermediate generalization.

For the Plaintiff (Opponent), Michele Baccelli:

Proprietor intends substituting in the granted claim the feature of „an animal“ for protecting a group of horses with that of „a wolf“ for performing the same function.

The patent describes that “the dog tends to protect the horses as well, should a wolf attempt to approach them”, but is however silent on the fact that wolves can protect horses. Therefore, there is no support in the patent for the proposed amendment.

It is further noted that, also in case proprietor would argue that the substitution of the generic term *animal* with the specific term *horse* could be derived from the patent, this would not be allowable in the present case. In fact, if the patent explains that “the wolves often demonstrate protective behaviour similar to that of the dogs”, the same immediately clarifies that the similarity is to be intended as limited to the case of “areas... relatively unfrequented or at building facilities with restricted access such as those used for military purposes”. Thus, the proposed feature extends beyond the original description, in that it would go beyond the limitation originally disclosed.

But there is even more. The patent explicitly explains that the wolf has an aggressive tendency towards animals like sheep. Moreover, in explaining the protective behaviour of dogs towards horses approached by wolves, the same patent at least implies that there is a concrete risk that a wolf could attack horses. Thus, the skilled person in the art would derive from an objective reading of the patent that the wolf has an inclination to attack certain animals like sheep, and most likely also horses. From the reading of the patent, it therefore follows that the proposed amendment is not only non-derivable from its teaching, but it is even in contrast with the same, or at least there are serious doubts that this modification would be directly contemplated by the original disclosure.

Being the amendment neither described nor directly derivable, it is not admissible.

[Note: the remaining questions were not discussed due to time restrictions]

Decision of the Panel

Panel composed of **Robin Jacob, Marina Tavassi, Jean-Christophe Galloux, Klaus Bacher, Mario Franzosi**

For the panel, the Chairman Lord Justice Robin Jacob:

The Court has very anxiously considered this very important and serious patent. We have worried extensively but because we had to decide one way or the other, we have reached some conclusions. Starting with patent A, we observe first of all that the description is formed into two parts, which you have to distinguish more and better than the patentee did. The first part is all about the prior art solution being insufficient and the next part tells you that it is going to be based on a series of observations and it is clear that patent claims are based on these observations.

What they have been doing is rearing a diverse range of animals; they do not talk about all of them, but we are told about sheep and their family, dogs, horses and donkeys. It is mentioned that donkeys have several characteristics in common with horses. Then, they tell you what these animals can do. Then they also raise wolves. We know that wolves cannot protect some of the animals without a fence. We are told that it has been observed in the experiments that dogs protect horses as well as sheep, and then they say that horses protect dwellings, which we take it to mean places where people live, against strangers, which we read as human being strangers, and the dogs get fond of the facility irrespective of the presence of people. And that is all we are told about the dogs. Then there's a bit about the wolves. And there is disclosure that the wolves demonstrate protective behaviour similar to that of the dogs, but we do not read that passage as saying that wolves would do the same things as dogs, for that it would be inconsistent with the earlier passage, where it says that wolves will attack sheep whereas dogs protect them.

Question I

So, with that we come to the proposed amendments to the patent. We accept, as we go to question one, that there was no extension of protection; the real question is

whether there is added matter. The original disclosure was a group of animals in the claim – a very general disclosure – and specific disclosure about protection of horses and sheep. Is this intermediate limitation to the family Bovidae disclosed in the original description of the patent? We think the answer is clearly no. The only point where there is a mention of the family Bovidae is at the point where the patentee is describing the various kinds of animals that he breeds. He mentions that the sheep belong to the family, but there is no disclosure of the use of dogs to protect any member of the family – any kind of a family. He has made a much more general disclosure, he is not allowed to pick from that very large generality and in effect create a new invention. ***He therefore fails on question 1.***

Question 2

As with regard to question 2, again we think there is added matter. The description does not really go into different kinds of dwellings or buildings and there is no explicit disclosure of non-residential buildings at all. There is a description of dwellings for protection by dogs against strangers but that is not a disclosure of a non-residential building. It must be recorded that the test for added matter is strict. Counsellors for the patentee ingeniously argued that buildings are either residential or non-residential. The description disclosed buildings and therefore disclosed all the classes, and it follows that coming down to one of the two classes is not hiding anything. He is confusing restricting the claim – which he is doing – with disclosing new matter – and he got at it.

Question 3

Chairman:

Now here there was more ***division among the court***: the majority think this fails for added matter too, we take the view that it falls in the same case as question 1. It is true that in a list of animals which the patentee says he is rearing, he says a bit more about donkeys and horses having simple characteristics in common and as well as the fact that they both belong to the family “Equidae”. But this is no teaching about the invention and there is no specific disclosure of the system with the dog for the family as a class. At this point it may be convenient for the dissenting opinion to be given.

Dissenting opinion given by Dr. Klaus Bacher:

I respectfully disagree on just a single point: it is true that there is no single sentence in the description saying dogs protect donkeys or even dogs protect Equidae, but from the description as a whole it seems sufficiently clear to me that they want to say or that they say also: well we have horses and donkeys, they have similarities, because they belong to this family, and dogs protect horses. So it seems sufficiently clear to me that dogs also protect donkeys and that they do this because they belong to the same family – to the family Equidae. Of course it could have been stated in a clearer way, but I think it is disclosed clear enough so ***I would say this is allowable.***

Chairman:

Well that goes to a rather soft German tradition.

Question 4

Now to question 4, there is no specific disclosure of a building facility that jointly accommodates persons and animals. For that ground ***there is added matter.*** More interesting is the last point: is there a disclosure of a building facility that is fenceless? We think not.

The only bit about fencing is in the problem, which the patent is set to solve. It says the prior solution of fences is quite insufficient. It goes on to say “thus more effective protection needs to be achieved” and that can be potentially perhaps read as if we are going to add the fences, while there is no clear and unambiguous disclosure that you could do away with fences. We have this further observation that if you did do away with the fences and you had dogs or wolves, what might happen? The wolves would probably push off and the dogs couldn’t be relied upon that they hang around all day, so we think that there is added matter there too.

Question 5

As to patent B we can be very short: *Swapping donkeys for horses isn't just extending, it is completely changing the subject matter.* Nor is there any disclosure of donkeys protected by any form of animal, as there was in the granted claim, which we observe in passing was almost certainly granted by the patent office on a Friday afternoon.

Question 6

The logic of this, the arguments for this, would apply equally to using a wolf for protecting people: There is no disclosure of a group of horses and a wolf appropriately protecting them. We also remain completely puzzled as to why the patentee thinks having a patent claim for this subject-matter would ever make him any money.

All the amendments are therefore refused.

Part III

European Patent: A Right of Variable Geometry? Limitations and Amendments of Claims during Litigation

Conclusive Report

Marina Tavassi, Presiding Judge, Tribunale di Milano

The Conference held on 27 and 28 of June 2014 in Milan has explored the topic of post-grant claims modifications, with particular regard to limitations and amendments during litigation.

Given the importance of the topic, we invited leading experts from numerous European countries. Their presentations offered a comprehensive overview of the legal solutions and the experiences adopted in Europe, which sometimes are close and some others interestingly distant. I will first summarize the legal framework of the European countries covered during the Conference and subsequently I will outline the Italian system and some interesting Italian case law.

The conference involved the following countries: Germany, France, the United Kingdom, the Netherlands and Italy.

Germany

As discussed during the presentations of Judge Klaus Bacher and Dr. Thorsten Bausch, the patent system in Germany is characterised for the presence of the so-called bifurcation between proceedings on infringement and proceedings on validity. In the first instance, the Federal Patent Court has exclusive jurisdiction over validity cases, while infringement cases are decided by designated civil courts. This framework makes the German patent litigation system very different from the Italian one, and of course affects also the regulation of claim amendments. Claim

amendments are indeed usually dealt with in validity cases. However, they can have effects on infringement cases, such as leading to stay infringement proceedings.

In nullity proceedings there are not specific rules for amendments, but since October 2010 there is a new regulation on late filing that is applicable also to amendments and aims at limiting the right to make such a request. With regard to first instance decisions, normally the German Federal Patent Court now rejects amendments proposed during the hearing. However, there are two reported cases in which (1 Ni 21/09 of the 12 of April 2011 and 3 Ni 16/10 of the 28 of February 2012) the Court considered amendments proposed during the hearing not rejectable and that appear to be very interesting. In the first case, two conditions were required: there had to be no reason for amendments based on the notification according to Section 83 of the German Patent Act and the Court had to have changed its opinion afterwards. In the second one the amendments were considered not rejectable if the other party could give a written answer after the hearing and no further hearing was necessary.

In the light of the case law, the German Speakers concluded that usually late filings are rejected, except if: i) the other party is able to react in time without postponement of the hearing, ii) there are sufficient grounds for the delay, or iii) the party was not properly instructed as to the consequences of late – filing.

During appeal proceedings amendments accepted in the first instance are maintained, while for amendments rejected in the first instance the rejection is confirmed in appeal proceedings if it was rightful. On the other hand, amendments are taken into account if the rejection in the first instance was not rightful. New amendments proposed in appeal proceedings are rejected unless: i) the Court of first instance has recognisably failed to see them or wrongly held them to be insignificant, ii) there was a defect in the first instance proceeding or iii) the late-filing is not due to the negligence of the party.

Turning to infringement proceedings, it is interesting that if the patent is amended in nullity proceedings, the claimant is not obliged to make the same amendments in infringement proceedings. Another peculiarity of the German system is that the judge of the infringement action may decide to continue the infringement proceedings even in presence of a nullity action. The decision is based on whether the Court estimates the chances for nullification of the claims at no more than 50%. For preliminary injunctions the evaluation is even stricter. However, it is interesting to mention one exceptional case mentioned during the presentations (OLG Dusseldorf, 29 of May 2008 – 2 W 47/07, GRUR-RR 2008, 329 [Olanzapin]) in which a preliminary injunction was granted even though the patent had been

declared void in first instance, because the infringement Court believed that the decision on the validity of the patent was clearly wrong.

It is the opinion of Judge Klaus Bacher that the new regulation will reduce the average duration of appeal proceedings on nullity from four years to eighteen months, but first instance proceedings will be longer and there will be a larger number of auxiliary requests, especially in first instance. The same is happening in many patent validity proceedings in Italy.

The German system for claim amendments, as described by Judge Klaus Bacher and Dr. Thorsten Bausch and briefly summarised in this paragraph, is very interesting in comparison with the Italian one. The bifurcation is certainly a main peculiarity and the limits on claim amendments requests established with the 2010 reform seem to have found a good balance between the right to make amendments and the necessity to avoid abuses of such right. The estimation made by infringement judges in order to decide on whether to stay infringement proceedings, pending a validity action, is another interesting characteristic of the German system.

France

Prof. Jean-Christophe Galloux and Maitre Dariusz Szleper presented how the claim amendment issue is dealt with in France. This paragraph will summarise their presentation and express few comments in a comparative perspective with the Italian system.

Proceedings for claim limitation were introduced in French patent law by Law n° 2008-776 of 4 August 2008 (art. 132 VI). Before this legislation, post-granting limitation in France was restricted to the surrendering and the partial revocation of one or more of the patent claims during court proceedings.

The new law applies to i) French patents, ii) French parts of European patents and iii) Supplementary Patent certificates (SPCs). The main goal is reducing the number of validity litigations. The following articles set out the legal framework of the new law.

Article L613-24 IPC states that the owner of a patent may at any time relinquish either the entire patent or one or more claims under the patent. Relinquishment shall be performed in writing with the National Institute of Industrial Property and shall take effect on the day of its publication and be retroactive from the filing

day of the patent application. The solution given to the problem of a license on a patent subsequently amended is particularly interesting: where real property rights, under a pledge or license, have been entered in the National Patent Register, relinquishment shall only be admissible if the beneficiaries of such rights give their consent.

Article L 614-12 IPC refers to European patent, providing that the French part of a European patent may be revoked by a court for any of the grounds referred to in Article 138, paragraph 1, of the Munich Convention.

Article L. 613-25 IPC provides that a patent is invalid, among the other cases, also if after the limitation the scope of protection conferred by the patent has been extended.

Articles L. 614-12 and 613-25 IPC also state that in the context of a nullity action the patent holder is entitled to limit the patent by amending the claims and that the patent so limited will be the subject of the nullity action engaged. They also provide a civil fine of up to € 3.000 in case the party, in the same instance, carries out several limitations of the patent for dilatory or abusive purposes.

Article R 613-45 IPC sets out the formalities that the request for limitation must meet. Such requests have to be in writing and in order to be admissible must:

- i) come from the patent holder registered the day of the request at the National Patent Register, or his representative, who, unless he has the quality of industrial property attorney must have a special power of waiver or limitation. If the patent belongs to several persons, waiver or limitation can only be performed if it is required by all of them. The Court of Milan has adopted a similar solution, requiring that the waiver or limitation must be requested directly by the patent owner (or patent owners) or by an attorney with a special proxy (Court of Milan, 21 May 2015, docket no. 74438/2011, *Actial Farmaceutica / Kraft - Mondelez*; Court of Milan, 1 December 2014, docket no. 20896/2011 *Unical / Riello and Corima*);
- ii) be accompanied by proof of payment of the prescribed fee;
- iii) must concern a single patent;
- iv) be accompanied, if real rights, encumbrances or licenses are registered at the National Patent Register, the consent of the holders of such rights;

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- v) be accompanied, when the limitation is required, by the full text of the amended claims and, where appropriate, by the description and drawings as amended.

If, when the limitation is requested, the amended claims do not constitute a limitation from previous patent claims, or if they do not comply with the provisions of Article L. 612-6, reasons shall be notified to the applicant. In this case the applicants have a deadline to regularize his request or comment. Failing regularization or observations to resolve the objection, the request is rejected by decision of the Director General of the INPI (*Institute National de la Propriété Industrielle*).

The disclaimers and limitations are listed in the National Register of Patents. A registration notice is given to the author of the waiver or limitation.

The proceeding before the INPI takes about 3-4 month, while the duration of the one before the EPO is roughly 1 year. The cost of the French procedure for claim amendment is 250 €.

Some statistics from the INPI were showed during the presentation:

Year	Total	Approved
2009	18	15
2010	21	20
2011	25	24
2012	9	6
2013 (until 15/10/2013)	21	11

(slide 12 of Prof. Jean-Christophe Galloux and Me Dariusz Szeleper's presentation)

In conclusion, there are some unsolved questions that must be mentioned:

I. What is the definition of a “limitation”?

The problems are related to the lack of analysis of patentability of the claim limited by the INPI:

- The addition of a feature extracted from the description?
- Drawings?
- A disclaimer which involves an analysis of admissibility?
- Limitation restricted to one type of independent claims
- The introduction of a limitation to rule out exclusion from patentability? (e.g. limitation to a dosage claim)

The question about the definition of “limitation” also concerns whether it can include a change of category of the claim, a limitation that allow a SPC and if it can cover an equivalent (precision of the result to be achieved).

II. When is it possible to make a claim limitation?

Is it possible after the expiration of the patent? (INPI admits 3 years). What about after the validity proceedings if restoration is in progress or after nullification of the patent in the first instance subject to the provisional execution?

It is also debated if it can be proposed between a seizure (*saisie-contrefaçon*) and serving the summons on the merits and how often it can be requested. The last question, in particular, regards the topic of frequency and abuse that can lead also to the € 3.000 sanction.

III. What is the relationship between limitation and third parties?

Third parties can make observations during the limitation’s proceedings. Information to third parties can be done with a publication of the amendment request.

The United Kingdom

The approach adopted in the United Kingdom with respect to claim amendments was brilliantly described by Sir Robin Jacob and Dr Penny Gilbert.

Before the European Patent Convention the UK position was that claim amendment was in principle allowable provided it complied with certain conditions, set out in the Statute 1949 Act (s.31(1)). It could be made by an application to the Patent Office unless court proceedings were pending; in that case the application had to be made to the Court in the course of the proceedings. The amendment had to be proposed and advertised as soon as possible in order to allow third parties to know about the amendment and to propose an opposition. At that time where a patent owner delayed without justification to seek amendments he would be barred from doing so in the Court's discretion.

The entry into force of the European Patent Convention 2000 changed the legal framework. The limits on the kind of allowable amendments remain unchanged: added matter and extension of claim are still prohibited. However, there is not anymore a requirement of timing and claim amendments can be proposed at any time and will have a retrospective effect. In Sir Robin's view, the new rules are mainly positive, primarily with regard to the possibility to make central amendments at any time under Article 105a EPC. However, he identified some problems, in particular three: i) the possibility for a party to delay litigation, ii) the problem for defendants, that now have to imagine amended claims that could restore validity in an invalid patent, and iii) the slowness of the EPO procedure for central amendments, probably due to the inadequate resource invested in it.

During his presentation, Dr. Gilbert discussed also the above-mentioned problems of possible abuses of the system and of the defendant's liability in case of multiple amendments. With regard to the first one, there is not a fixed time frame to propose the application and therefore patentees do not have an obligation to apply for it as soon as possible. However, applying for amendments late can constitute an abuse of process and may therefore be procedurally unfair to an alleged infringer. As it happens in other systems, also in UK the correct balance of fairness to the parties has to be determined by the Courts taking in consideration the circumstances of each individual case. This issue concerns also cases in which claims amendments or limitations are proposed after the Court of Appeal judgment and disputes over conforming the specification are referred back to the High Court for consideration. In such a situation English Courts decided (*Nikken Kosakusho Works v Pioneer*

Trading Co [2006] FSR 4; *Nokia GmbH v IPCOM* [2011] FSR 15) to reject the amendments arguing that a new infringement trial would have been unfair to the defendant. It is possible to note that the concept fair trial has played a major role in contrasting abuses of the system.

On the liability of defendants, and in particular on the recovery of damages following claim amendments, Section 62 (3) of the Patent Act 1977 establish that damages may be recovered also for the period before the amendment. The reason for this rule is the retrospective effect of claim amendments. However, English Courts take into account also whether at the moment of the infringement the defendant knew or had reasons to know the illegality of his actions. In this respect, many elements are considered, such as whether the specification of the patent was drafted in good faith and the amendments were proposed during the proceedings in good faith. As I will explain in the paragraph about Italy, the Court of Milan faced the same issue and in the specific case decided that the defendant could not have the burden to know the scope of validity eventually granted after the amendments and therefore was not liable for the infringement prior to the limitation (Court of Milan, *Imar / Viessman*, 24 April 2014, no. 5425/2014, and 29 April 2015, no. 5377/2015).

Another important element discussed by the Speakers from the UK is the relationship between central amendments at the EPO and litigation in UK. It is indeed becoming increasingly common that patents litigated in UK are subjected to a central amendment at the EPO and also that at the same time are under parallel litigation. English Judges in deciding whether to stay the proceedings usually take into consideration potential prejudices for the defendant (for example there will be no prejudice if only the validity of the patent is at stake), principles of fairness and also the presence of parallel litigation in other European jurisdictions. In Italy there are few cases with such circumstances, but we are also experiencing an increase on that respect.

In conclusion, the necessity for English Courts to find their own solutions to the problems of each specific case involving the issue of claim amendments is shared also by Italian Courts. Legislations are not totally comprehensive on this topic and Judges have to take into consideration fundamental principles such as fair trial and fairness between the parties.

The Netherlands

This paragraph will describe the Dutch experience regarding post grant claim amendments as discussed by John Allen in his presentation. In the Netherlands there are three routes for claim amendment:

- I. Article 105a – 105c EPC;
- II. 138(2) and (3) EPC/Article 75 ROW (Dutch Patent Law) – partial validity;
- III. Article 63 ROW 1995 – Deed of (partial) abandonment.

The last route requires consent of certain third parties: party with registered entitlement (co-owners; security interest), party to proceedings regarding the patent and licensees.

Route I - The impact of central limitation in national proceedings

ROW 1995 prescribes certain formalities: the patent office will include in the register a notification of the institution of opposition or central limitation proceedings, the date thereof and of any decision of the EPO in that respect. Article 52 ROW 1995 prescribes that if a European patent is amended pursuant to opposition or central limitation, the patentee should file, within three months (Article 23 Implementing Regulations) after the limitation is granted, a translation of the patent (unless official language is English) and in all cases a translation of the claims. If the translation has a more limited scope than the authentic text, the translation shall prevail.

The leading case law for this first route is the decision *Boston Scientific / Medinol* decided by the Dutch Supreme Court on the 6 March 2009.

The object of the case was the patent held by Boston Scientific (BS), which had two main features (A and B). The original claims were invalidated by the first instance Court and by the Court of Appeal. During the appeal proceeding, BS argued that there was partial validity for amended claims with features A, B and C.

The Court of Appeal stated that there was not added matter but lack of unity and it was divisional for the presence of feature C, therefore “*reclaiming subject matter abandoned during prosecution*”. It also held that adding feature C was *not foreseeable* for the skilled person and there was a violation of legal certainty for third parties.

Before assessing the conclusion of the Dutch Supreme Court, it is necessary to explain the background of the decision. The Dutch Supreme Court had already established additional national requirements that claim amendments had to fulfill to be allowable (case *Spiro / Flamco*, decided on the 9 February 1996). In particular it held that an amendment was allowable if it could be formulated with a clear demarcation of the scope of protection and if, *a priori*, it could be sufficiently obvious for the skilled person so as to enable him to independently conclude on the basis of the patent and the prior art that the patent should have only been granted with this amendment (“*one way street*”).

The findings of the Dutch Supreme Court in *Boston Scientific / Medinol* were the followings:

- i) central limitation is “*novum*” (case remanded to Court of Appeal);
- ii) revised article 138 EPC applies to any EP in force as per 13 December 2007;
- iii) about the interplay between national proceedings and central limitation, it affirmed that there was no precedence of central limitation procedure over national proceedings and that in case of a national proceedings concurrently pending, the national Court had the possibility to suspend or continue as per the national laws. It continued stating that if national proceedings have been concluded, limitation can be implemented in other counties via central limitation and that a central limitation does not preclude further limitations by national Courts;
- iv) national Courts can and must invalidate an EP if the subject matter remaining after central limitation is not patentable (52-57 EPC) or in case of violation of Article 123 (2) and (3) EPC;
- v) in this case it is unclear why the Court of Appeal considered unity of invention and the divisional, since they are not grounds for invalidity;
- vi) as per EPC 2000, the limitation of a European Patent takes place only in the form of a limitation proposed by the patentee which, if deemed insufficient, does not preclude a Court from further limiting the patent.

However, only the provisions of the EPC and implementing regulations determine whether an amendment is allowable and no further national requirements shall apply. It should be noted that the Court of Appeal on the 30th of March 2010 (case

Bebecar / Maxi Miliaan) held that *Spiro / Flamco* should also no longer apply to Dutch national patents.

Route II - Partial validity

The second route concerns the cases of partial validity of a patent. Article 75 (1) ROW 1995 establishes that “*a patent shall be invalidated to the extent that*” certain validity grounds apply: i) non patentable subject matter (2-7 ROW or 52-57 EPC), ii) insufficiency, iii) added matter, iv) extension of the scope and v) lack of entitlement.

In the Netherlands there is no specific legislation for national claim limitation. In practice there can be a main or auxiliary request by the patentee. Courts have a flexible approach but in addition to certain basic formal requirements due process requirements apply. The relevant case law is:

- District Court The Hague 21 May 2014 (*Sanofi-Aventis / Amylin*): the Court held that requesting multiple auxiliary requests is possible, but the second auxiliary request raised clarity issue, which violated Article 84 EPC and was then considered not allowable. The Court stated that late stage filing of additional auxiliary requests is not permissible. The consequence was that the entire patent was declared invalid.
- District Court The Hague 5 June 2013 (*Enpros / Smart Seal*): the Court affirmed that amendments (disclaimer) of claims should comply with all EPC requirements, including clarity (Art. 84 EPC). In case they don't, auxiliary request must be disregarded.
- District Court The Hague 2 July 2008 (*Van Diepen / Pronk*): the Court considered that an auxiliary request filed 10 days before hearing was too late, also in view of lack of separate infringement analysis.
- District Court The Hague 23 November 2011 (*Impliva / Senz*): the Court stated that advancing auxiliary requests at the hearing is too late and in violation of due process rules.
- District Court The Hague 15 January 2013 (*Rovi / Ziggo*): the Court enabled Rovi to file a specific auxiliary request with an interim judgment. It specified that a Dutch translation of the auxiliary request was not required.

On the subject of translation, it is interesting to note that article 52 ROW 1995 established that a patentee might at any time file an improved translation. It is important to remember that if the scope of protection of the translation is more limited than the authentic text, the translations will be deemed authentic.

The conclusion of John Allen is that the Dutch situation does not have real problems in implementing the right to make limitations and that Courts are willing to become “examiners”, but also that they are strict in observing due process principles. On the other hands, the issues of clarity (art. 84 EPC/R.43) and unity (Art. 82 EPC, 27 ROW 1995) are still unclear.

In the light of the description above, it can be observed again that balancing the right to make amendments with the principle of due process is an issue that Courts are facing in many EPC countries. Italian Courts dealt with this problem in many occasions, as it will be described in the next paragraph.

Italy

Also in Italy the topic of claim amendment is certainly in the spotlight, and the solutions to the numerous problems related to it are at the centre of an intense debate.

In Italy the rules governing claim amendments are included in the Italian Industrial Property Code (Legislative Decree No. 30, 10 February 2005). Paragraph 4 of Article 79 IPC, as modified by Article 40 of the Legislative Decree No. 131 of 13 August 2010, establishes the rules to propose claim amendments during a nullity proceeding: *“In a proceeding concerning nullity, the owner of the patent has the right to submit to the Court, at any stage or instance of the judgment, modified claims that remains within the limits of the content of the patent application as initially filed and that does not extend the protection conferred by the patent granted.”*

Article 76.2 IPC concerns the judicial limitation of the claims subsequent to a judgment of partial nullity and the following paragraph (Art. 76.3 IPC) considers the case of the conversion of a void patent into a different one (that the patent owner would have wanted had he known the patent was null), which meets the validity requirements. In case of extension of the original duration of the patent, licensee and investors have the right to obtain a mandatory, free and non-exclusive license for the extended period.

Under the Munich Convention, it is also possible to convert a void European patent. During the proceedings before the EPO, the applicant can modify the description, the claims and the drawings at least one time (Art. 123.1 EPC). The limit of this modification is the scope of the patent, which cannot be extended beyond what was contained in the original application as filed (Art. 123.2 EPC; Art. 138.1 EPC for invalidation proceedings). A European patent application can be transformed in a national patent under Articles 135-137 EPC and Article 58.1 Italian Industrial Property Code. In addition, a European patent application can be converted also in a national patent for utility model under article 58.2 and 58.3 IPC.

After the granting of the patent and during the opposition procedure, the patent owner can propose some modifications. If the patent and the invention meet the conditions of the EPC, the Opposition Division of the EPO maintains the patent as modified (Article 102.3 EPC). Again, this right of modification cannot extend the scope of the protection beyond the one of the original application as filed (Art. 123 EPC).

The topic of claim amendment has raised many questions, of both substantive and procedural nature. With regard to the first, the problems are the following: i) the content of the concept of limitation, ii) the admissibility of multiple, alternative and/or subordinate limitations, iii) the possibility to refer to the description, the examples therein provided, and the drawings (that could lead to the question of whether the modification is an extension or a limitation of the scope of the patent), iv) the effect of the patent limitation on the responsibility of the alleged infringer and v) the effect of the patent limitation on the evaluation of the *fumus boni iuris* in interim proceedings. On the other hand, we are also facing many procedural problems, in particular: i) the time limit for the patent limitation request (within the same instance / in any status of the case), ii) the possibility to request multiple, alternative, conditioned and or subordinate limitation in a so-called “funnel”, iii) the increasing difficulty or the necessity of renovation of the activities of the technical expert appointed by the judge and the increase of the relative costs and iv) the possibility to request a patent limitation in an interim proceedings.

There are also some problems related with the deposit of the modifications at the EPO or at the Italian Patent and Trademark Office and with regard to the rules for the deposit of the translation.

Italian Courts have been dealing with these problems for the last several years, finding some interesting solutions. It has been established the principle that the limitation / amendment of the claims must be proposed before the judge and not

before the technical expert appointed by the judge (as it sometimes was happening). In addition, the Court of Milan affirmed in several occasions that the amendment must be proposed in writing, with a clear and precise text signed by the patent owner or by an attorney with a special proxy (Court of Milan, 21 May 2015, docket no. 74438/2011, *Actial Farmaceutica / Kraft - Mondelez*; Court of Milan, 1 December 2014, docket no. 20896/2011 *Unical / Riello and Corima*).

In another important decision (Court of Milan, *Imar / Viessman*, 24 April 2014, no. 5425/2014, and 29 April 2015, no. 5377/2015) it was assessed the problem of admissibility of multiple or subordinates amendments, stating that such strategy, although considered abused in the specific case, was admissible under the new Art. 79.3 IPC. However, the same case dealt with the responsibility of the alleged infringer in case of a patent whose scope of protection was completely twisted after the technical examinations and the numerous amendments proposed. The Court stated that the alleged infringer could not have the burden to know the scope of validity eventually granted after the amendments. Therefore the abuse perpetrated by the patent holder was sanctioned with a decrease of the damages relief.

Conclusion

The Conference “European Patent: A Variable Geometry Right? Limitations and Amendments of Claims during Litigation” has been a very interesting occasion to share our opinions and to learn that issues related to claim amendments are similar in different countries, pushing us all to further examine the topic to find satisfying solutions.

In some countries Legislators have intervened to solve the problems related to claim amendments with specific norms. In others (including Italy) the legislation regarding this specific issue is very limited and solutions have to be searched in the case law.

I want to thank each participant to the Conference and in particular those more active in its organization. The comparison that has been made and the exchange of opinions and experiences we have made represent an important enrichment for each of us that will certainly facilitate and improve the quality of our daily work.

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 aduocato, et eorum excusatio speciosa, sua speciosa potestate significamus,
 Che per autorità di questo Consiglio sia concesso a D. Galileo Galilei, et
 per persona in questa Città, o luogo del stato nostro far, o far far, o
 mero di un solo Canale uero bocche de acqua che si ricionano in
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