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POST-GRANT AMENDMENT
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The Problem

- There is a real life problem in that when filing a patent application one will carry out a search, but it will be a relatively cheap one. When the patent is granted and becomes important, those who are or who feel threatened by the patent carry out a much more expensive search. This may result in prior art that knocks out part but not all of a claim. How is this to be resolved?

Issues in the PTAB

- It has so far proved difficult to amend in the PTAB:
- 1. Holdings that applications to amend must distinguish over all art known to patentee
- 2. Limitations on number of pages in which to explain amendment and how it accomplishes 1. (This will change shortly as rules are proposed to increase the page limit)
- 3. Fears of PTAB that amendments allowed in IPR etc are not examined by the Examining Corps
- 4 Fears that because (unlike old *inter partes* re-examination) parties can settle IPR this opens the door to collusion to maintain invalid claims

How does Amendment in PTAB affect litigation

- In *Fresenius USA Inc. v. Baxter International*, the Federal Circuit held that because the case was still pending on other issues, the court still had jurisdiction over it and that in view of the cancellation of the claims in re-examination, the case should be dismissed and a damages award made previously quashed.
- Presumably a similar situation would arise if the claims had been amended in an IPR

How do Other Countries Cope?

- We will look at: Australia, Canada, the European Patent Convention's provisions, France, Germany, Japan, and the United Kingdom.

Australia

- Under Section 101 of the Patents Act, any post-grant amendment must not result in the specification claiming or disclosing matter that extends beyond that disclosed in the complete specification as filed or result in a claim that “would not in substance fall within the scope of the claims of the specification before amendment” or fall afoul of the normal sufficiency and clarity requirement of Section 40.

Possibilities to Amend

- Section 97(2), either a third party of the patent owner may request that a patent be re-examined.
- Section 97(3), where the validity of a patent is disputed in any proceedings before a prescribed court the court may direct the Commissioner to re-examine the complete specification

- Section 104, the patent owner may request the Commissioner to amend the patent by:
- (a) removing a lawful ground of objection to the request or specification, whether that objection is raised in the course of an examination or re examination or otherwise; or
- (b) correcting a clerical error or an obvious mistake

- Section 104(4) provides for opposition to the allowance of any such amendment by “any person”. In order to facilitate this, Patent Regulation 10.5(2) requires publication of any amendment considered permissible in the Official Journal

- Section 105 provides that in any relevant proceedings in relation to a patent, typically an infringement action in which there is a counterclaim of invalidity under Section 121 or a stand-alone revocation action under Section 138 the court **may**, on the application of the patentee, by order direct the amendment of the patent request or the complete specification in the manner specified in the order.
- Discretion has been used to refuse amendment when a request to amend has been delayed too

- Section 112 provides that the patent office may not allow an amendment while court proceedings are pending unless ordered by the court

Canada

- Post-grant amendment may be made by disclaimer under Section 48 or in proceedings for re-examination under Section 48.1 or reissue under Section 47. Under Section 60, “any interested person” may institute proceedings in Federal Court for impeachment of a patent or any of its claims. Such challenges are also possible as counterclaims in infringement proceedings.

Disclaimer

- Where a claim is too broad or claims subject matter which was not invented by the named inventor as a result of “mistake, accident or inadvertence without any willful intent to defraud or mislead the public” patent owners are permitted to disclaim subject matter originally claimed.
- There is no substantive examination of any such disclaimer. There is no need to disclaim a whole claim, parts of a claim may be excised as long as this does not result in broadening of the claim.
- Section 48(4) provides that a disclaimer generally has no effect on any court proceeding that has already been commenced at the time it is made.

Re-examination

- Re-examination may be requested by any person, including the patent owner, on the basis that there is a substantial new question affecting patentability of a claim with respect to novelty or obviousness over a prior art patent, application for patent open to public inspection or printed publication.
- Section 48.3(2) provides that the patentee may propose any amendment to the patent or any new claims in relation thereto but no proposed amendment or new claim enlarging the scope of a claim.

Reissue

- Possible whenever any patent is deemed defective or inoperative by reason of insufficient description and specification, or by reason of the patentee's claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.
- Claim amendments are possible, including during the first four years after the grant of the patent, broadening amendments. The patentee must explain the nature of the error and how it came to be realized that one had occurred.
- There must be a showing that there was an intent to protect in the original patent that which is claimed in the reissue.

European Patent Convention

- Originally, post grant amendment was only possible in opposition proceedings instituted within 9 months of grant.
- The 2000 amendments to the European Patent Convention added Articles 105a, 105b and 105c which permit central post grant limitation to all patents in the bundle at any time unless opposition proceedings are pending.

- Any post-grant amendment, whether it takes place during an opposition or under the central limitation procedure, is subject to the requirements of Article 123 EPC.
- These provisions have been interpreted to impose a strict standard for support in the original application for any amendment pre or post grant and to restrict post-grant amendments to narrowing amendments.

- Under Article 115, third parties may present observations on the amendments proposed in such a procedure but do not have any right to oppose them.
- Examination is for clarity and compliance with Article 123 only – not for novelty or inventive step.

Added Requirement to permit amendment in court

- Article 138 was amended to specify that in proceedings before a national court “or authority” where validity is in issue, the patentee shall have the right to limit the scope of protection by amending the claims. The patent as thus limited shall form the basis for the proceedings.

France

- . In France, invalidity of a claim being asserted in an infringement action is a defense to that action. Additionally, the defendant in an infringement action can bring a counterclaim for invalidity in such an action with a view to effecting revocation of the patent. (Intellectual Property Code L613-25) All such matters are dealt with by the Paris Tribunal de Grande Instance.

- Limitation of the claims is possible as a result of such a challenge to the claim's validity. (Intellectual Property Code L613-27) In this case, the patent owner must submit amended claims in conformity with the court's ruling to INPI. The Director of the INPI has the power to refuse to effect the amendment if it is not in conformity with the court's judgment. (Intellectual Property Code L613-27¶3)

Voluntary Amendment

- Since 2009, it has been possible to seek limitation of a French patent or the European part of a French patent by a request to INPI at any time during the life of the patent. (Intellectual Property Code L613-24) INPI can review the proposed amendment for compliance with the law, particularly on the questions of clarity and whether the proposed amendment complies with the requirement that it must not broaden the scope of the claim.

- Proposed amendments are not advertised, but if a third party is made aware of them and submits observations these shall be taken into consideration. The third party does not, however, have any right to participate in the consideration beyond making its observations.

Germany

- In Germany infringement is dealt with by the district court and validity by either the Patent Office in opposition proceedings (Article 59) or the Federal Patent Court in nullity proceedings. (Article 81)
- Amendment is possible in response to an opposition or a nullity suit.
- Infringement proceedings tend to be quicker than validity proceedings.

- Additionally Article 64 of the patent Law provides for the possibility of voluntary amendment of patent claims before the German Patent Office.

- In cases where a patent claim is limited as a result of an opposition or nullity period after it has been found to be infringed such that the acts in question no longer fall within the scope of the amended claim, it may be possible to seek restitution of any damages paid as long as this is sought within five years.

United Kingdom

- Section 76(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it - (a) results in the specification disclosing additional matter, or (b) extends the protection conferred by the patent
- Section 27 – voluntary amendment
- Section 73 – amendment initiated by the comptroller to limit the claims to exclude

- Section 27 – voluntary amendment
- Section 73 – amendment initiated by the comptroller to limit the claims to exclude the prior art
- Section 75 amendment during patent infringement or revocation proceedings - applies to proceedings before the court or the Patent Office

- The patent owner must give reasons for the amendment and if these involve distinguishing from defined prior art, the amendments will be examined to see whether they do.
- Before an amendment under any of these proceedings is finalized, the proposed amendment is advertised on the Official Journal as being open to opposition.

Discretion

- The remedy is discretionary and leave to amend may be refused . Traditionally, factors such as the patentees conduct (whether it had known of the need for amendment for a long period and continued to maintain a patent known to be invalid) were taken into account in exercising discretion.

However Section 75(5) provides:

- In considering whether or not to allow an amendment proposed under this section, the court or the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.
- It has been held (*Zipher Ltd v Markem Systems*) that this means that any delay in seeking amendment should no longer be taken into account in deciding whether to exercise discretion to permit the amendment

Relation to Court Proceedings

- Where proceedings involving possible amendment and infringement are separated, the relative speed becomes important. In **Virgin v. Zodiac** infringement had been found but an assessment of damages was on-going at the time when an opposition in the EPO resulted in claims being narrowed so that there was no longer any infringement, the UK Supreme Court held that the claim amendment had retroactive effect and so the proceedings terminated and no damages payable.

Japan

- Although it is now a defense to an infringement action that a patent is invalid (Article 104ter), a determination that a patent is invalid *contra omnes* is only possible as a result of an invalidity trial in the JPO. (Article 123)
- “Correction” is possible during such an invalidation trial. (Article 134 bis) Correction of a patent claim is also possible in a separate correction trial. (Article 126)

- The courts may, but rarely do stay infringement actions pending the outcome of an invalidity trial.
- Article 104*ter*(2) provides:
- Where the court considers that the materials used for an allegation or defense under the preceding paragraph are submitted for the purpose of unreasonable delaying the proceedings, the court may, upon motion or ex officio, render a ruling to the effect that the defense is to be dismissed.

Correction Trials

- Article 126(1) provides that the patentee may file a request for a trial for correction of the description, scope of claims or drawings attached to the application, provided, however, that such correction shall be limited to the following:
 - (i) restriction of the scope of claims;
 - (ii) correction of errors or incorrect translations; and
 - (iii) clarification of an ambiguous statement.

Issues

- Is there merit to allowing amendments during a law suit?
- If so should the amendments apply to those proceedings or only prospectively?
- If permissible, what should the role of the patent office be?
- Should there be total re-examination or just consideration of clarity and narrowing nature of the amendment?

- The list of permissible corrections in response to an invalidity trial is similar.
- Prior to April 1, 2012, it was possible to demand a correction trial after a finding of invalidity within 90 days of filing an appeal against the invalidity ruling. This has been changed so that prior to the final decision in the invalidity trial, a preliminary opinion will be issued, in response to which a request for correction may be filed during the invalidity proceedings.

- Should there be a role for public intervention in the amendment proceedings?



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THANK YOU