

Amending patent claims: effects on infringement proceedings

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The Supreme Court Judgment of 3 July 2019 analyses the effects of an amendment of European patent claims made within a grant or opposition procedure.

1. Amending patent claims

- 1.1. The claims of a European patent may be amended by its proprietor both before and after the patent is granted. Indeed, the claims as they appear in the original application may be amended by the applicant (Art. 123(1) of the European Patent Convention [EPC]). It is also possible to amend the claims once the patent has been granted, in the context of an opposition procedure. It should be recalled in this regard that, within nine months of publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office (EPO) of opposition to that patent. Opposition may only be filed on the grounds set out in Art. 100 EPC, and may result in limitation or revocation, which will affect the patent in all the Contracting States in respect of which it has been granted. Opposition is therefore a way of obtaining the revocation of the patent by the EPO, on a centralised basis, and of avoiding having to resort to national court proceedings to challenge the validity of a European patent.

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However, if an opposition to the European patent has been filed, the proprietor may request, in addition to revocation, the limitation of the patent by an amendment of the claims (Art. 105a et seq. EPC). The decision concerning the limitation shall take effect on the date on which the mention of the decision is published in the European Patent Bulletin and shall apply to the European patent in all the Contracting States in respect of which it has been granted.

In any event, an amendment of the claims may not involve an extension of the patent's subject matter beyond the content of the application as filed, since the European patent may not be amended in such a way as to extend the protection it confers (Art. 123 EPC).

Moreover, the limitation of the European patent may also take place in the context of a national invalidity procedure, as provided for in Art. 138(3) EPC, according to which: "In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings".

- 1.2. The above regulation by the EPC has largely determined the regulation by the current Spanish Patents Act of 2015 ('LP'). Thus, it should be recalled that Art. 48 LP provides for amendments to claims in certain procedural steps, also providing that a patent application or patent may not be amended in such a way that it contains subject matter which extends beyond the content of the application as initially filed and that, in the opposition procedure, or where applicable in the limitation procedure, the patent may not be amended in such a way as to extend the protection it confers.

Based on the foregoing, Art. 105 LP provides that "at the request of its proprietor, a patent whose grant is final may be revoked or limited by amendment of the claims at any time during its legal life, including the period of validity of supplementary certificates, if any". And according to Art. 107 LP, the amended claims will retroactively determine the scope of protection conferred by the patent. In turn, Art. 120 LP regulates the limitation of a patent, amending its claims in proceedings in which validity of patent may be put in issue.

2. Judgment no. 389/2019 of the Supreme Court (Civil Division, First Chamber) of 3 July 2009

The Spanish Supreme Court, in its recent Judgment no. 389/2019 (ECLI:ES:TS:2019:2244) has analysed the effects on infringement proceedings of the amendment of claims of a European patent made within the grant procedure, as well as that made within the opposition procedure.

- 2.1. The device of prosecution history estoppel has been delimited in U.S. patent law to refer to those cases in which a person files a patent application, subsequently amends the application, and once the patent is granted intends to assert the initial terms of the

application that were subsequently amended. The most relevant U.S. case is *Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.* 535 U.S. 722 (2002) decided by the U.S. Supreme Court.

The Spanish Supreme Court follows the same legal doctrine and in the judgment of the Provincial Court appealed on the grounds of a breach of the rules governing the determination of disputes (cassation) it is understood that there is patent infringement on the part of the claimant despite the fact that the defendant did not reproduce the elements of the claim in a completely identical manner. According to the Provincial Court it is not required “that the elements, in addition, appear in the same exact proportion, with absolute identicalness, since the contrary would mean patent infringement as soon as a product presents minor differences without inventive activity or novelty to solve the same problem. And this is outside the theory of equivalence, since one element is not being replaced by another with the same purpose, but is slightly altering the percentage described in the patent. Because of this, although the claim refers to the presence of 99.3% of inactive yeast, infringement is deemed on the part of the defendant with a composition of 98% inactive yeast.

However, the Supreme Court holds that “we cannot agree with such considerations, if we look at the history of the application and grant of the patent, as we will explain below, since all the waivers and limitations made at the patent offices, as well as any other act of the applicant, can be alleged and taken into account to determine the scope of patent protection”. On this basis, the Supreme Court takes into account that the initial patent application included a claim that expressly referred to a percentage of 98% and that such claim was amended in the course of the procedure, limiting the percentage mention to “approximately 99.3%”. And this, according to the Supreme Court, is decisive from the point of view of the scope of patent protection. Because, although “it is true that in the description this reference to 98% is maintained [...] what determines the scope of protection of the patent is not the description, but the claims”. For this reason, the judgment of the Provincial Court is set aside.

In this way, the Supreme Court welcomes in our country the device of the prosecution history estoppel, to which it had already alluded, without analysing it because it understood that the limitation did not apply, in its Judgment no. 309/2011 of 10 May 2011 (ECLI: ES:TS:2011:4270), and that it was already a device applied by the lower courts; for instance, Judgment no. 292/08 of the Madrid Provincial Court of 1 December 2008, in which it is not considered acceptable to modify the application to restrict the subject matter of the patent and subsequently invoke the doctrine of equivalents to include in the protected area technical characteristics which, although they could be considered included in the scope determined by the patent application, were subsequently left outside the protected area by the amendments made during the processing, reducing the scope of the claims. In the words of the Madrid Provincial Court, “[t]he Court deems the patent applicant estopped by having waived a wider scope of protection

during the patent proceedings, introducing technical characteristics that reduce the scope protected by the claims, from subsequently, after registration, extending the scope of protection to include in the same embodiments that were left outside by virtue of the restrictions included by the applicant himself”.

- 2.2. In the case referred to in the judgment of the Supreme Court now commented on, following the claim for European patent infringement, the proprietor amended some of the claims in opposition proceedings before the EPO. This led the patent infringement defendant to lodge an appeal on the grounds of a breach of the procedures governing the determination of disputes against the appeal judgement, arguing that the continuation of the proceedings on the basis of claims that were different from those existing when the claim was filed would constitute a *mutatio libelli* prohibited by Art. 412 of the Civil Procedure Act, according to which claims or facts subsequent to the claim cannot be taken into account in the judgment. According to the appellant, the EPO’s decision to limit the patent should have led to the dismissal of the case because of loss of cause of action.

However, the Supreme Court dismisses the appeal, arguing that the EPO’s decision did not void the title on which the claim was based, and that the limitation of the patent does not imply its voidness, but only its amendment. In addition, “the amendment does not give rise to any detriment to the defendant, since the examination of the patent and any infringement thereof will be carried out from the point of view of the amended patent, the scope of protection of which must necessarily be narrower than that existing before the amendment, thereby reducing the possibility of the infringement having occurred”. Finally, the court of last resort also refers to the fact that the Patents Act 1986 did not contain a provision similar to the current Art. 120(4) of the Patents Act 2015, which allows a patent amended during the course of a proceeding to continue to serve as the basis for those proceedings. According to the Supreme Court, that “does not mean that it was prohibited or that nonsuiting was required”.