

# **EPLAW**

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European Patent Lawyers Association

## **YEARBOOK**

### **2009 – 2010**

**(Editor : F. de Visscher (*Simont Braun*), Past Secretary to the Association)**

Association européenne d'avocats spécialisés dans le contentieux des brevets d'invention  
Europäische Vereinigung der Patentrechtsanwälte

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Siège : Avenue Louise, 149 (boîte 20) 1050 BRUXELLES - BELGIQUE  
Association sans but lucratif (Loi du 27 juin 1921)

Dear Colleagues,

This year marks the 10th anniversary of EPLAW; therefore the EPLAW Board at its meeting in March decided that a celebration was to be held with the members during the Congress in Brussels as we did it with the 5<sup>th</sup> anniversary. We thought that the judges at the Forum in Venice should be reminded how EPLAW's history was connected with the judges' meetings which now have regularly been held since 2005 and were glad that Lord Hoffman accepted our invitation for an anniversary speech there.

The major events of the year started with the *Young EPLAW conference* which was held on May 17 with interesting program features and good teams which you find on our website. I went directly from Brussels to Luxembourg where one day later the hearing before the ECJ on the request of an opinion concerning the Draft Agreement on the EEUPC was scheduled. The setting of 27 judges, 8 advocates general, more than 20 delegations of member states and the representatives of the Council, the Commission and the European Parliament made the impression of a big orchestra playing without rehearsal in view of the controversial views which were expressed<sup>1</sup>.

Since then at a number of conferences speculations on the eventual outcome were exchanged, few of them were as negative as my report on the hearing. It was therefore an unpleasant surprise for many that the Advocates General in an unofficially distributed opinion which was first published on the EPLAW website came to the conclusion that the Draft Agreement was incompatible with the EU Treaties for a number of points. Since then the discussion heated up, and I can only name a few conferences to which I had been invited to speak<sup>2</sup>. At all those conferences Margot Fröhlinger gave the contrast program: more optimistic and determined to get all 27 member states onboard. At the last conference in Brussels where I suggested to take advantage of the favorable view of the Advocates General on EPLA and start with a smaller group of countries I got the full support of Lord Justice Jacob, but a clear No from the Commission which may now change after it has been announced that one will initiate the instrument of enhanced cooperation after the language question did not find unanimity in the Council for the EU patent.

I will skip the other conferences mentioned and will rather give a report on the Venice Forum which took place on October 29 and 30. After a short introduction of EPLAW's founding president Pierre Véron into EPLAW's history Lord Hoffman presented the anniversary speech. It was a witty, but at the same time a powerful and critical evaluation of the policy of the EU Commission with respect to the EU project for a Community patent and the court system in the last ten years. He criticized in particular the hostile attitude of the Commission towards EPLA in spite of the overwhelming result of ca. 95% of the users as a result of the survey which the EC Commission itself had conducted in

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<sup>1</sup> See for a detailed report Pagenberg 41 IIC (2010) No.6

<sup>2</sup> GRUR Annual Meeting in Hamburg September 16, AIPPI World Congress in Paris October 4, Venice Judges Forum 29.10. and the conference of the Belgium Presidency in Brussels on November 3, 2010

2006. He finally made it clear how important the regular meetings between judges and attorneys in Venice have become over the years. The discussions between judges have contributed decisively to the frequent citations in court decisions of the case law of neighboring jurisdictions and the adjustment of legal principles in harmonized areas of law.

We felt also honored that Chief Judge Rader, the newly appointed Chief Judge for the Court of Appeal of the Federal Circuit in Washington (CAFC) had accepted my invitation to speak. He is also known as a very entertaining speaker and gave an insight into how the CAFC tries to harmonize the sometimes diverging trends of trial courts in different parts of the US. His announcement that he is working on a project which has the aim to cut back the cost of discovery for smaller companies by determining a litigation value at the beginning of a case and then eventually limit the extent of discovery was a very interesting information.

The two other highlights were the panel on the litigation system and the mock trial. As to the first we will have a "replay" at our Congress in Brussels so that it suffices to say that none of the judges spoke in favor of an involvement of the ECJ as a third instance in future patent litigation proceedings. The discussion will have to be resumed after the decision of the ECJ has come out which is not expected before the end of the year.

The mock trial was based on a rather old German Supreme Court case which I had chosen as a technically less demanding case because a number of judges had complained in the past about difficult factual situations of former mock trials. Since I feared that the question of infringement might not give rise to a long discussion I had invented additional legal questions to which Kevin Mooney added the procedural background and great teams of judges and attorneys which led to lively presentations and partly surprising results in the different language groups and the Court. I do not want to disclose more since perhaps it would be an idea to conduct this case if not at the EPLAW yearly congress, but perhaps at the next Young EPLAW conference.

This report has become a bit long, but the year was full of events (for my taste too many), and I finish with my thanks to all the members of the Board, particularly also those who have had their first year on the Board, for their enthusiasm and support and wish you all an interesting Anniversary Congress in Brussels.

Dr. Jochen Pagenberg  
President

## **2000-2010: TEN YEARS OF EPLAW**

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### **Pierre VÉRON speech at the Venice Judges Forum (29 October 2010)**

It is probably because self-celebration is the sincerest form of flattery that I have been asked to summarise the first 10 years of EPLAW, the European Patent Lawyers Association!

#### **Conception**

You may remember that the Community Patent Convention was signed in 1975, and that in the late nineties we were about to celebrate its 25<sup>th</sup> birthday without ever having seen any sign of its possible coming into effect because of two controversial issues: the language regime and the litigation system.

In an attempt to solve these problems, the French government decided to convene in Paris a so-called Intergovernmental Conference in June 1999, a diplomatic conference of the States party to the European Patent Convention.

This gave rise, among other results, to the creation of a Working Party on Litigation aiming at building a so-called European Patent Litigation Protocol (EPLP) whereby the States would confer upon a central court the power of decision over the disputes arising about European patents.

Some patent litigation practitioners felt that they should offer their assistance for such an ambitious project.

On 10 March 2000 (ten years ago!) 20 lawyers<sup>1</sup> from Belgium, France, Germany, Italy, Spain, The Netherlands and the UK convened in my Paris office, at that time at Square de l'Opéra.

Shortly thereafter they decided to create an association so that their voices could be better heard.

After some debate<sup>2</sup>, they decided to take the name European Patent Lawyers Association (EPLA); the articles of incorporation were executed on 23 July 2001.

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<sup>1</sup> Fernand de Visscher (Braun Bigwood, Belgium), Olivier Lemaire (Nauta Dutilh, Belgium), Jacques Armengaud (Armengaud, Guerlain, France), Pierre Lenoir (Jeantet, France), Damien Régnier (Combeau, France), Dariusz Szeleper (Gaultier, Lakits-Josse, Szeleper, France), Pierre Véron (Véron & Associés, France), Isabelle Romet (Véron & Associés, France), Peter Chrocziel (Bruckhaus, Westrick, Heller, Lober, Germany), Bernhard Geissler (Bardehle, Pagenberg & Partners, Germany), Thomas Reimann (Clifford Chance Pünder, Germany), Peter Von Rospatt (Von Rospatt, von der Osten, Germany), Winfried Tillmann (Lovells, Boesebeck, Droste, Germany), Mario Franzosi (Franzosi, Dal Negro & Associati, Italy), Luca Trevisan (Trevisan & Cuonzo, Italy), Willem Hoyng (De Brauw Blackstone Westbroek, Linklaters & Alliance, Netherlands), David Pellise (Spain), Robert Anderson (Lovells, U.K.), Miles Gaythwaite (Bird & Bird, U.K.), Nigel Jones (Linklaters, U.K.), Edward J. Nodder (Bristows, U.K.)

<sup>2</sup> Because of its acronym PLEA, the name Patent Litigators European Association was also contemplated.

A few months later, the members of the Working Party on Litigation considered that the name *Protocol* was no longer suitable and called their future baby European Patent Litigation *Agreement* (EPLA).

We were left with no other option than to sue them or to change our name.

As professional litigators, we know that litigation is not always the best way to start building a strong and friendly relationship; we therefore decided to change our acronym to EPLAW.

### **Relationship with European organisations**

It was somewhat difficult to have our voice heard at the beginning.

The Working Party on Litigation did not deem it necessary to involve any representatives from the Bar as participants or observers, which was somewhat bizarre for a committee working on building a future court.

The EU Commission proved to be no more amenable in the early 2000s: its work took place behind closed doors and it considered rather unrealistic options, such as having a central court in first instance to decide all patent disputes in Europe.

Many things changed when Dr Margot Fröhlinger (I should say "*Tireless Margot*") took the controls as she agreed to take the necessary time to listen to experienced judges and practitioners.

We are now engaged together in the formidable challenge of creating the first European court having the power to resolve disputes between private parties.

If I may say so before Chief Justice Randall Rader, who is with us today, the challenge is more impressive still than the one the founders of the Federal Circuit had to face in the 1980s: they were creating one more federal court while we are contemplating the creation of the first such court of its kind.

Only the future will tell us whether we are legal pioneers or poor legal fiction writers...

### **Achievements**

After ten years, our association groups all the experienced patent litigators in Europe; no major patent case is decided without an EPLAW member being on one or the other side of the bar (most often, on both sides).

Our 150 members come from Austria, Belgium, Denmark, Finland, France, Germany, Italy, The Netherlands, Norway, Spain, Sweden, Switzerland and United Kingdom.

Most of them attend our annual meeting in Brussels.

Willem Hoyng, the third EPLAW President, created Young EPLAW, a yearly seminar designed for the younger members of our firms.

He also created a blog, [www.eplawpatentblog.com](http://www.eplawpatentblog.com), already an amazing success in its first year of existence: most of the important patent decisions in Europe are made publicly available there within a week or so of being handed down, often with an English translation.

Kevin Mooney, the second EPLAW President opened a transatlantic channel of communication with our US colleagues of the Federal Circuit Bar Association, in addition to other successes.

Mario Franzosi, one of the first Vice-Presidents of our association, worked arduously towards the creation, in 2005, of the Venice Forum which brings us together today on the occasion of its sixth edition: I cannot praise enough the imagination and the energy he applied to this project, reuniting patent litigators and judges on this island (I also praise his sense of humour for holding our reunion in a former lunatic hospital: Mario, what are you trying to say exactly?)

### **Friendship**

Patent cases are so intricate (some might say boring) that only the most tenacious litigators survive; patent law is so complex that only the best judges like it: no awkward people there!

I could therefore not conclude this summary of the first ten years of our association without saying that it has also been a place of friendship.

The Presidents who came after me, Kevin Mooney, Willem Hoyng and Jochen Pagenberg, the Vice-Presidents, Winfried Tilmann, the brain of our association (not surprisingly German), Mario Franzosi, its imagination (not surprisingly Italian), deserve a special tribute.

Fernand de Visscher, and now his partner Éric de Gryse, who kept the minutes of our meetings, Peter Heinrich and now Christian Gassauer who kept our books, have been less visible, but equally indispensable.

A final word in memory of Sir Nicholas Pumfrey who attended most of the past editions of this Forum: in addition to being an outstanding patent specialist, he was an excellent friend whom we miss every day.

I wish a long and successful life to the European Patent Lawyers Association!



**CONGRESS of 20 November 2009 in Brussels**



**EPLAW Congress**

**Brussels 2009**

**Limits on Limitation**

**Central national limitations and  
their effect on national proceedings**

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BARDEHLE  
PAGENBERG  
DOST  
ALTENBURG  
GEISSLER

**DR. JOCHEN PAGENBERG**

**ATTORNEY-AT-LAW, MUNICH/PARIS**

**Features of  
National Limitation Practice  
What do we want in Europe?**

- I Legal Basis**
- II National Practice**
- III Future Rules**

**Art. 138 (3) EPC 2000**

**(3) 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. (When –any time?)**

**Draft Article 38a Agreement on ECPC**  
***Decision on the validity of a patent***

**(3) Without prejudice to Art. 138 (3) EPC, if the grounds for revocation affect the patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part.**

## Draft Rules Procedures

### Rule 29 – Request to amend the claims (1)

1. The Reply to the counterclaim for revocation may include a Request to amend the claims which shall contain

(a) the proposed amendments of the claims of the patent in dispute, including where appropriate one or more alternative sets of claims (auxiliary requests),

### Rule 29 – Request to amend the claims (2)

(b) the grounds upon which the amendments are sought and

(c) an indication whether the proposals are definite or conditional; the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case.

2. Any subsequent request to amend the claims may only be submitted with the leave of the judge-rapporteur.

## **Rule 30 – Lodging of the Rejoinder to the request to amend the claims**

**Within two months of service of a Request to amend the claims, the defendant may lodge a Rejoinder to the request to amend the claims stating why**

- (a) the proposed amendments are not allowable or**
- (b) the claims as amended remain invalid.**

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## **Two Models of Proceedings in EU**

### **(1) Bifurcation (infringement/revocation) (10)**

**Amendment discussion in revocation and  
in context of stay of proceedings**

### **(2) Combined Proceedings (17)**

**Amendment in counter claim**

## **DE Revocation and EPO Opposition**

- **patentee can agree to a limitation**
- **patentee can file auxiliary claims**
- **amendment still possible on appeal**
- **very similar to opposition proceedings before the EPO (several auxiliary petitions)**
- **no uniform practice about reasonable numbers**

## **Allowability of Amendments**

- **scope of protection must not be extended;**
- **claimed subject-matter must be disclosed in original application**
- **amendment must be clear and concise**
- **claim must still protect the same subject matter**

**Claim must still protect the same subject matter**

**DE NL: Change of category possible:  
from product to use claim**

**AT: change from product to Swiss type  
claim allowable**

**DE UK Not possible to include new  
“subject matter”, if not claimed before  
BGH GRUR 2004, 354 – Vertagung (Suspension)**

### **Limited Defense – No formalities**

- ❖ **AT: Infringer can be sued based on a limited claim without formal limitation**
- ❖ **Inter partes limitation possible**
- ❖ **DE: “Limited Defense” possible in opposition and revocation procedure (“I defend only claim 3”)**

## ***Competent Authority***

**UK: must be in the same forum as the revocation action (either in court or comptroller).**

**FR only in PO; NL involvement of PO**

**DE NL NO UK: Limitation only in revocation, not in “pure” infringement proceeding**

**DE DK AT Parallel procedure in PO possible**

## ***Source of new claim feature***

**AT DE NL: New feature in limited claim can come from sub-claims, from description only, if also combination disclosed in description** BGH XA ZR 148/05-Heizer

**DE NL: combination claim 1 with dependent claims generally possible**

**EPO Art. 105a.: Central limitation allows also feature from description if disclosed**

**Problem of disclosure: was combination predictable?**

## *Effect of Limitation*

**DE AT: For revocation and counterclaim  
limitation becomes effective *erga omnes***

**FR DE NL AT (+EPO): Effect of limitation  
from filing date, no damages for the past**

**UK from granting date**

## *Patentability examination*

**DE NL: yes in revocation court**

**AT: remaining claims must not be an  
extension, but no full examination for  
patentability conducted**



## ***Stay of infringement Case***

**DE AT “In general” no stay of infringement case during revocation**

**FR Yes, pending PO decision**

**UK NL in general no (validity and infringement usually heard together), although the revocation/infringement case may be stayed until after the hearing on the limitation (assuming the application for limitation is opposed, or opposition pending).**

**Limits of Art. 138 (3)? *Number of Auxiliary requests***

**System of successive auxiliary requests (EPO and DE opposition) allows patent owner to defend patent with maximum possible scope of protection when prior art is found after grant of patent.**

**In the hearing before Federal Patent Court, main request and all auxiliary requests are discussed before court deliberates; no interlocutory decisions (different from EPO opposition proceedings).**

**New Law in DE Art. 83 (4) Pat G (2009) -  
Revocation Proceedings**

**{Procedural Limits}**

**The [revocation chamber of the] Federal Patent Court can reject ... a defense ..  
in the form of an amended version of the patent which is only submitted  
after lapse of a prescribed deadline,  
and decide without further  
investigation, if...**

**New Law in DE Art. 83 (4) Pat G (2009) -  
... if**

- 1. the consideration of the new ground of defense would require the adjournment of the already fixed hearing date, and**
- 2. the respective party does not sufficiently excuse the late filing, and**
- 3. the respective party had been warned by the court about the consequences of a delay**

**The ground of excuse must be proven**

## **Limits of Art. 138 (3)? - Due Process?**

**[DE] NO AT NL**

**Situation: Can auxiliary limitation request(s) be filed at any time in the proceedings, even during the hearing?**

**If request is filed very late, plaintiff may in special cases not be in a position to timely react to the request. E.g., plaintiff may have to conduct additional prior art search.**

**In this case, does plaintiff's right to be heard demand that hearing be adjourned?**

## ***Limits of Art. 138 (3) - Time of Filing?***

**{NL} DE: new procedure in revocation with fixing of time limits,**

- rejection of belated submissions**
- no new matter on appeal**

**Compatibility with Art 138 (3) EPC 2000?**

**Can member states limit limitations?**

**Exclude limitations on appeal?**

## ***Suspension of hearing***

- Example (BGH GRUR 2004,354- *Vertagung*):

**Patent owner files in the hearing new limitation request in which claim is amended by a feature contained in the description but not in any of the claims. Revocation plaintiff could not foresee such limitation and has to conduct additional prior art search to be in position to reply to limitation request.**

**More Limits of 138 (3) : Number of auxiliary claims?**

**UK: None or one?**

**DE: Unlimited so far, but limitation by rule of reason and misuse (*and statute*)**

***Requirement: structured “tree construction” – not wild multitude of features***

***Add feature by feature to overcome lack of novelty against main references***

**Limits of Art. 138(3) - NoAmendment on appeal**

**DE Today: new limitation requests can be filed on appeal (BGH) still in the hearing.**

**DE (new law): Only under strict conditions**

- ❖ if plaintiff agrees
- ❖ if court regards limitation as reasonable and pertinent

**FR NL: [Further] amendment on appeal**

**AT: Yes (as long as unconditional limitation of claim)**

**Draft Rule 29 – Request to amend the claims**

1. (c) ....the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case.

**Proposed Venice Resolution**

Consider the following options

A. Number of citations

a) *I am in favour of a (significant) reduction of the number of citations of prior art – not more than three - (“show me your best piece of prior art”)*

*or*

b) *I prefer stricter rules on substantiation, but no limitation of the number of prior art citations.*

B. Number of Auxiliary Requests

a) *I am in favour of a (significantly) reduced number of auxiliary requests as a principle*

*or*

b) *I prefer a reduced number of auxiliary requests in proportion to the number of citations*

## **C. Fixing of time limits for submissions**

### **E. No filing of new matter on appeal**

exception: patentee may file one unconditional limitation?

- Patentee has no further chance
- Plaintiff can file a new case





