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And while, of course, not all of the above shortcomings of the current patent system can be discussed or addressed *in toto*, an interpretation of patent claims corresponding and limited to the technical contribution made to the state of the art would be an important step in re-aligning patent law to the original equation that the monopoly granted should be commensurate with the benefit the inventor has bestowed on society.

## Reports

*Pierre Véron and Isabelle Romet\**

### Patents: Strengthening by Limitation – Voluntary Limitation of Granted French National Patents Is Now Possible\*\*

Since 1 January 2009, French law has allowed patentees to voluntarily limit their granted patent claims. This possibility, which has existed for a long time in a number of European countries, (e.g. Austria, Switzerland, Germany, Denmark, Italy, Norway and the United Kingdom<sup>1</sup>) has recently been introduced into the European patent system through Art. 105<sup>bis</sup> et seq. of the European Patent Convention (the so-called “EPC 2000” revision which entered into force on 13 December 2007).<sup>2</sup>

The new regulation is good news for owners of national French patents who are now able to modify the wording of their claims to better delimit their inventions from the state of the art. It is also good news for courts as this should allow them to avoid having to decide on unproductive disputes. The new procedure will be particularly useful if, after the grant of the patent, prior art is discovered which was unknown to the patentee, and affects the validity of the patent as granted but, in respect of which it is possible to define a patentable invention by limiting the scope of protection. Considering a limitation procedure will now be on the list of precautions to take and formalities to observe before starting infringement proceedings.

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1 Concerning the extensive case law of the UK courts with regard to amendment proceedings, see “Terrell on the Law of Patents” 345–382 (16th ed., Sweet & Maxwell 2006).

2 For a complete commentary on these provisions, see ULRICH JOOS, “Central limitation and revocation under Articles 105a to 105c of the revised European Patent Convention”, 46 *et seq.*, 14th European Patent Judges’ Symposium, OJ EPO Special edition 1/2009.

### *The Situation in France Before the New Act*

Until 1 January 2009, it was impossible for a patentee to voluntarily limit the claims of a national French patent once it had been granted. The owner of such a patent could only:

- surrender the patent or some of its claims (Art. L. 613-24 of the French Intellectual Property Code (IPC)) for the future; however, surrendering one or more claims could never give an outcome equivalent to a limitation, i.e. narrowing the scope of protection conferred by a particular claim; or,
- request partial revocation of one or more claims of his patent from the court. In theory, the patentee could make such a request on his own initiative. In practice, such a request was generally made within the framework of infringement proceedings to which the defendant would reply by way of a counterclaim for the revocation of the patent, the patentee replying, in turn, that the potential invalidity was not total but only partial. Although this was a possible way to obtain a limitation, the procedure was lengthy and inconvenient. A court pronouncing partial revocation could not draft the amended claims but had to send the patentee to the French Patent Office for the amendment. In addition, only certain types of amendments are acknowledged as allowable under French case law on partial revocation. This possibility was thus hardly ever used in France.<sup>3</sup>

These two options are still available to a patentee. Now, however, a patentee may also voluntarily limit the patented subject-matter after grant, independent of any revocation proceedings.

### *The New French Act*

The Act dated 4 August 2008<sup>4</sup> amended Arts. L. 613-24, L. 613-25 and L. 614-12 of the French IPC. These provisions were supplemented by Art. 3 of the decree of 30 December 2008<sup>5</sup> (Art. R. 613-45 of the IPC). They entered into force on 1 January 2009.

3 On patent revocation, in general, see EMMANUEL PY's typed thesis "L'annulation du brevet d'invention, les apports du droit judiciaire privé et de la théorie des nullités" (Strasbourg, 2008); on partial revocation, see pages 374 *et seq.*, No. 1077 and page 423 in particular: "La nullité est une sanction qui vise à rétablir la légalité dans la limite de sa violation".

4 Act No. 2008-776, published in the Official Journal of 5 August 2008; see CH. CARON, "La propriété intellectuelle dans la loi de modernisation de l'économie", 2008 JCP E, act. 397; *idem*, "La propriété intellectuelle dans la loi de modernisation de l'économie", 2008 JCP G, act. 600; *idem*, "Pot-pourri de propriété intellectuelle : textes nouveaux et attendus", Oct. 2008 Com. com. électr., comm. 109; J.-P. GASNIER, "Loi de modernisation de l'économie et propriété intellectuelle", Nov. 2008 Prop. ind., Focus 163; J. AZÉMA, "L'incidence de deux importantes lois récentes sur la propriété industrielle", Dec. 2008 RLDA 17 *et seq.*; J.-C. GALLOUX, "Les dispositions de la loi n° 2008-776 du 4 août 2008 de modernisation de l'économie relatives à la propriété intellectuelle", 2008 RTD com. 720 *et seq.*; J. RAYNARD, "Droit des brevets et du savoir-faire industriel", 2009 D. pan. 453, especially, 454.

5 Decree No. 2008-1471, published in the Official Journal of 31 December 2008.

Article L. 613-24 of the new French IPC governs voluntary limitation procedures independently of any litigation:

The owner of a patent may at any time surrender either the entire patent or one or more claims, or limit the scope of the patent by amending one or more claims. The request for surrender or limitation shall be submitted to the National Institute of Industrial Property in accordance with the conditions laid down by regulation. The Director of the National Institute of Industrial Property shall examine the request for its compliance with the regulations referred to in the foregoing paragraph. The effect of the surrender or limitation shall be retroactive from the filing date of the patent application. (. . .)

Amended Art. R. 613-45 of the French IPC specifies the requirements to be fulfilled. Articles L. 613-25<sup>6</sup> and L. 614-12<sup>7</sup> of the IPC, dealing respectively with French national patents and European patents in France, have been amended to specify the sanctions in respect of a limitation which does not narrow the scope of the patent and the possibility of limiting the patent within the framework of revocation proceedings.

Before examining the limitation procedure it is necessary to define the concept of limitation and consider whether this legal technique is applicable to other forms of protection for inventions, namely European patents and supplementary protection certificates.

### *What Is a Limitation?*

The act does not define the term limitation: it only indicates that the limitation is carried out by amending one or more claims. However, logically a limitation is the reduction of the scope of protection conferred. Of course, everyone understands that a limitation is an intellectual process, which is not

<sup>6</sup> Article L. 613-25, concerning French patents, now provides for the following:

“A patent shall be revoked by court decision: . . .

d) If, after the limitation, the scope of the protection conferred by the patent has been extended. . . .

Within the framework of proceedings for the revocation of a patent, the patent proprietor is entitled to limit the patent by amending the claims; the patent thus limited is the subject of the instituted revocation action.

A party who, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed”.

<sup>7</sup> And Art. L. 614-12, concerning European patents:

“A European patent may be revoked with effect for France on any one of the grounds set out in Article 138(1) of the Munich Convention. . . .

Within the framework of proceedings for the revocation of a European patent, the patent proprietor is entitled to limit the patent by amending the claims pursuant to Article 105<sup>bis</sup> of the Munich Convention; the patent thus limited is the subject of the instituted revocation action.

A party who, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed”.

simply the deletion of unwanted terms from the claims. Nevertheless, this should not lead us to think that any type of narrowing of the protection conferred constitutes an admissible limitation. The courts will obviously be able to check, in case of dispute, that the claim as limited remains based on the description. They will also be able to check, when requested to do so, that the effect of the alleged limitation was not, in fact, to extend the protection (which is prohibited by Arts. L. 614-12 and L. 613-25 French IPC, which provide for a sanction of revocation, expressed by the paradox: “*If, after the limitation, the scope of the protection conferred by the patent has been extended*”).

### *Does the French Limitation Procedure Apply to European Patents?*

Although this is not expressly stated in the new act, the French limitation procedure also applies to European patents. This follows from Art. 2 of the European Patent Convention : “(2) 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”. In addition, nothing seems to prohibit the combination of the French national procedure and the central limitation procedure of Arts. 105<sup>bis</sup> et seq. of the European Patent Convention: it is therefore quite conceivable that a European patent could be, firstly, subject to a central limitation at the European Patent Office, and then to a limitation specific to France at the National Institute of Industrial Property (a “French limitation of the European limitation”).

### *Does the French Limitation Procedure Apply to Supplementary Protection Certificates?*

Similarly, the new Act does not specify that the limitation procedure applies to supplementary protection certificates. As confirmed by the Paris District Court in two recent decisions,<sup>8</sup> Art. L. 613-25 of the French IPC, which provides for the partial revocation of claims, does not apply to supplementary protection certificates, since this article is explicitly included amongst

<sup>8</sup> Paris District Court, 3rd Chamber, 2nd Section, 20 February 2009, docket No. 2004/18665 and docket No. 2005/12994, PIBD 2009, No. 896, III, 1039; *Jurinpi* n° B20090051: “that besides, according to Article L. 613-25 of the Intellectual Property Code ‘If the grounds for revocation affect the patent in part only, revocation shall be pronounced in the form of a corresponding limitation of the claims’ did not apply to supplementary protection certificates pursuant to Article L. 611-2, nor did Article L. 613-27 relating to the implementation provisions for partial revocation provided for in Article L. 613-25; and considering finally that Article L. 613-28 last paragraph of the French Intellectual Property Code relating to the invalidity of a supplementary protection certificate does not provide for the partial revocation of a claim of a supplementary protection certificate but only for the revocation of some of its claims; thus, the claims of the supplementary protection certificate in issue cannot be amended through the mechanism of partial revocation of the patent on which it is based”.

the articles whose application to supplementary protection certificates is excluded by Art. L. 611-2. However, since Art. L. 613-24 on limitation is not included in the articles whose application to supplementary protection certificates is explicitly excluded by Art. L. 611-2, it seems that the limitation procedure may be applied to supplementary protection certificates.

### *Who May Request the Limitation?*

Any request for limitation must be submitted by the owner registered in the French Patent Register or by his representative (where there are co-proprietors of the patent any request must be filed by all co-proprietors). Where property rights, a security or a licence have been recorded on the French Patent Register, the patentee must prove that he has consent from the owners of such rights.

### *When May Limitation be Requested?*

A request for limitation may be submitted by the patentee “*at any time*”, pursuant to Art. L. 613-24 of the French IPC. This means that a request may be submitted as soon as the patent has been granted and even after its expiry date. Articles L. 614-12, concerning European patents, and L. 613-25, para. 3, concerning national French patents, explicitly provide that a request for limitation may be submitted within the framework of an action for revocation. These articles do not restrict the limitation to first-instance proceedings; thus, sooner or later, courts will come up against limitations requested during appeals or even whilst the case is pending before the French Supreme Court.<sup>9</sup> The question of whether a request for the limitation of a European patent pursuant to the national procedure may be introduced while an opposition procedure is pending before the European Patent Office is a delicate one.<sup>10</sup>

### *How to Request Limitation?*

The request for limitation of a patent is submitted in writing to the National Institute of Industrial Property;<sup>11</sup> it requires the payment of a fee which is currently €250.

9 Faced with such a situation, the Dutch Supreme Court decided that a limitation requested after the appeal decision should lead to a new examination of the case in appeal proceedings (*Boston Scientific v. Medinol*, 6 March 2009, [2009] E.I.P.R., N-61).

10 Indeed, (*see above*) the French limitation procedure not only applies to national French patents, but also to European patents designating France and the same regulation should apply to both type of patent; but Art. 105<sup>bis</sup>(2) of the European Patent Convention according to which “the request may not be filed while opposition proceedings in respect of the European patent is pending” can only apply to European limitation proceedings, this leads to the conclusion that a national request for limitation may be lodged even if opposition proceedings are pending.

11 For this purpose, a form is available on the website of the National Institute of Industrial Property [http://www.inpi.fr/fileadmin/mediatheque/pdf/FB\\_limitation\\_renonciation.pdf](http://www.inpi.fr/fileadmin/mediatheque/pdf/FB_limitation_renonciation.pdf).

### *Amendment of the Description and the Drawings when Requesting Limitation*

The new provisions allow for a request for amendment, not only of the claims, but also of the description and the drawings. Article L. 613-24 of the French IPC only deals with limiting the claims, but Art. R. 613-45 specifies that the request for limitation must be accompanied “*by the full text of the amended claims and, as the case may be, by the description and the drawings as amended*”.

### *Examination of the Request for Limitation by the National Institute of Industrial Property*

The Director of the National Institute of Industrial Property examines the request for its compliance with the provisions stipulated in Art. R. 613-45 of the French IPC. He first checks that the amended claims do not constitute an extension with respect to the previous claims of the patent. If, despite this examination, a request for amendment is accepted, which does not constitute a real limitation, third parties may request revocation of the limited patent from the court, pursuant to the provisions for revocation introduced in Art. L. 613-25 d)<sup>12</sup> for French patents and Art. L.614-12 for European patents.

The Director of the National Institute of Industrial Property also examines compliance with Art. L. 612-6 of the French IPC, which provides that the claims must be clear and concise and supported by the description. If these requirements are not met, a reasoned notification is sent to the applicant for limitation. A time limit is then specified, within which the request may be corrected, or observations may be submitted by the applicant. If the applicant fails to correct his request or to make observations permitting any objections to be waived, the request for limitation is rejected.

### *Effect of the Limitation*

If the request for limitation is deemed to be in compliance with the law, the limitation is entered on the National Patent Register (without publication of a new specification). The effect of the limitation is retroactive from the filing date of the patent application.

### *Organisation of a Limitation in Infringement and Revocation Proceedings*

The Act does not specify whether a court ruling on infringement or revocation should stay the proceedings if the patent is undergoing a request for limitation. However, since Arts. L. 614-12 (European patent) and L. 613-25 (national patent) expressly provide that the limitation may be requested

<sup>12</sup> Article L. 613-25 d): “A patent shall be revoked by court decision: [...] d) If, after the limitation, the scope of protection conferred by the patent has been extended”.

“*within the framework*” of proceedings for the revocation of a patent, and specify that “*the patent thus limited is the object of the instituted revocation action*”, it is reasonable to think that the court is obliged to stay the proceedings when there is such a request.

If a limitation is requested outside a revocation action, e.g. within the framework of an infringement action, given that the limitation procedure is relatively quick, the court will, generally, wait for the outcome of the limitation before ruling on validity and infringement.<sup>13</sup> Finally, it will be possible for the courts to be faced with a claim for infringement of a European patent which is still subject to a pending opposition and, simultaneously, to a national voluntary limitation (which seems possible, see note 11). Generally, a patentee who requests a limitation in this context will be seeking to rapidly limit his patent claims in France to the claims defended in the opposition procedure. In this case, the courts will have to assess whether, after the restriction of the scope of the claims, the opposition still has a serious chance of success, as they currently do in comparable situations.

### *How Many Times?*

There is no provision specifying that the limitation may be requested only once (there is no rule preventing “*a limitation of a limitation*”). However, with respect to limitation within the framework of revocation proceedings Art. L. 613-25, for a French patent, and Art. L. 614-12, for a European patent, provide that if the owner “*makes a plurality of limitations of his patent, in a dilatory or abusive manner*”, he may be liable for damages or even a civil fine of up to €3,000.

### *Strengthening a Patent before Initiating an Action for Infringement*

The post-grant, voluntary limitation of a patent allows streamlining the infringement proceedings. Indeed, a feature may have been too broadly claimed when filing the patent or during prosecution because an element of the prior art was unknown. The quick and simple modification of the wording of a claim to define the exact scope of the invention avoids unproductive discussions during the procedures (there is no point in long discussions on the validity of features which cannot be protected). Patentees will thus be able to strengthen their patents before initiating an action for infringement.

<sup>13</sup> In any case, the first decision issued on the subject ruled in that sense. In this case, it concerned a request for a central limitation made to the European Patent Office, but the question regarding the stay of proceedings is the same (Paris District Court, 3rd Chamber 1st Section, 7 April 2009, *Georgia-Pacific France v. Delipapier*, docket No. 2008/02969, Jurinpi n° B20090073).