Amendment of patent claims after grant (in court and administrative proceedings, including re-examination proceedings requested by third parties)

Questions

1) **Does your national law permit post-grant amendment of patent claims?** Are utility models – if available – treated the same way as patents or differently? If so, what are the differences?

Patent claims can be amended in opposition proceedings, limitation proceedings and court proceedings initiated by nullity actions.

There are no limitation proceedings for utility models. The owner of a utility model cannot, of their own accord, limit a utility model with legal effect. Any third party may, however, file a request for cancellation with the German Patent and Trademark Office. The utility model will be entirely or partly cancelled to the extent to which the substantive requirements for protection are not fulfilled. The owner of a utility model has the right to defend only a limited version of their utility model in utility model cancellation proceedings. Insofar these proceedings are comparable to opposition or nullity proceedings.

2) **Who is entitled to request post-grant amendment of patent claims under your national law?**

The patentee and any third party is entitled to request an amendment of patent claims. According to Art. 64 Patent Act, the patentee can request limitation of their patent by amending the patent claims. Any third party (excluding the patentee themselves) is entitled to file an opposition within a 3-month term (for German patents granted by the German PTO) or a 9-month term (for European patents). After the end of this time limit or after opposition proceedings are finalized, any third party can, furthermore, request an amendment of the patent claims by filing a nullity action with the Federal Patent Court. Any third party, but not the owner of a utility model themselves, may file a request for cancellation of a utility model.

3) **What is the procedural framework for requesting post-grant amendment of patent claims under your national law, in particular:**

- What procedures (judicial, administrative or other) are available for dealing with requests for post-grant amendment of patent claims under your national law?

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1 Cf. German Patent Office in Bl. f. PMZ, 1955, p. 209. However, they can file limited claims and declare that they waive any protection on the basis of this utility model beyond the scope of the limited claims, which will lead to cost advantages in the case of later cancellation proceedings.

2 The term "request an amendment" includes all procedural actions that are directed to an amendment of the claims. In a stricter sense, only the patentee is entitled to request a specific amendment; a third party can only request revocation or nullification to a certain extent.
Are all of these procedures freely available under your national law to those wishing to request post–grant amendment of patent claims, or does the law give priority to certain procedural measures in certain situations?

Is it possible under your national law for patentees to make multiple subsequent amendments of patent claims directed towards individual alleged infringers?

Who is entitled to amend claims? Is this limited to courts or do also the patent offices have the competence to amend claims?

Please limit the answer to a general description of the proceedings avoiding discussion of procedural details and peculiarities.

A patentee may request limitation of their patent by amendments to the patent claims with the German Patent and Trademark Office. The German Patent and Trademark Office does not check if the requested limitation is objectively necessary or is sufficient with regard to the prior art. If the limitation is admissible, i.e. covered by the disclosure of the original application, the request is granted.

Any third party can file an opposition with the German PTO or the European Patent Office within the opposition term of 3 months (for patents granted by the German PTO) or 9 months (for European patents). It is not necessary to prove an interest in order to file an opposition, as there is a public interest in the revocation of wrongly granted patents. In opposition proceedings, the German Patent and Trademark Office and the European Patent Office, respectively, investigate within the scope of the requests filed. In particular, the German PTO and the European Patent Office are not entitled to deviate from a request of the patentee and a version of the patent approved by them, without their consent; if the version of the patent accepted by the patentee does not comply with the requirements of the Patent Act and the requirements of the European Patent Convention, respectively, the patent must be revoked as a whole. An appeal against the decision of the Opposition Division is treated, in the case of patents granted by the German PTO, by the Federal Patent Court, and in the case of European patents, by a technical Board of Appeals in the European Patent Office. The same principles as in the first instance proceedings apply to the appeal proceedings.

If the opposition term has expired or an opposition procedure has been finalized, any third party can request the amendment of patent claims by filing a nullity action with the Federal Patent Court. The Federal Patent Court is also bound by the requests of the parties in the nullity proceedings. However, and in contrast to the opposition proceedings, the Federal Patent Court can reach any decision on the validity of the patent from the requested nullity on one hand to the rejection of the request on the other. In contrast to the opposition proceedings, a formal request of the defendant which is directed to the version of the patent considered to be acceptable by the Federal Patent Court is not necessary, as a court can always grant “less”. An appeal against the decisions of the nullity boards of the Federal Patent Court may be filed with the Federal Court of Justice. The same principles apply to the appeal proceedings before the Federal Court of Justice as in the first instance proceedings before the Federal Patent Court.

If a third party misses the term for filing an opposition and an opposition procedure is still pending, they may file neither an opposition nor a nullity action, Art. 81(2) Patent Act. Only a third party who proves that proceedings for infringement have been instituted against them may, after expiry of the opposition period, intervene in the opposition proceedings as an opponent, Art. 59(2) Patent Act and Art. 105 EPC, respectively. Parties having failed to timely file an opposition (and against whom no proceedings for infringement have been instituted...
and who have not filed a declaratory action against the patentee that they are not infringing
the patent in response to a request of the patentee to cease an alleged infringement of the
patent) are barred from the possibility of requesting amendments to the patent until the
conclusion of the opposition proceedings.  

Whether a third party prefers an opposition or a nullity action, may not be freely chosen, but
depends on the moment in time when an amendment to the patent claims is requested.

It is conceivable for a patentee to defend their patent in opposition, limitation or nullity
proceedings consecutively in differently limited form. However, after legally effective
termination of a first procedure limiting the patent claims, the patentee cannot fall back on a
broader scope nor on different subject matter – any further amendment can only be directed
to a further limitation.

4) What are the substantive conditions for allowing post–grant amendment of patent claims
under your national law, in particular:

– Is there a distinction in your national law between the remedies available to
patentees/third parties and/or the substantive conditions applicable to patentees/third
parties for allowing post–grant amendment?

– In what ways may patent claims be amended post grant under your national law?

– Is it a requirement (or a possibility) under your national law that the description/
specification be amended to correspond with amendments of the claims?

– Is it possible to make amendments for the purposes of clarification and/or correction of
errors?

The only difference between an opposition and a nullity action is that the extension of the
scope of protection of the patent (in the opposition proceedings) can be raised additionally in
the nullity action. After grant, patent claims can only be amended by means of limitations. An
extension of the scope of protection after grant is not possible. The description of the patent
can also be amended within opposition proceedings if the patent is maintained in a restricted
version or declared partially null. In nullity actions, the description of the patent is generally
not amended; the reasons for the decision usually replace the amended description.
Amendments not directed to a limitation of the patent, but, for example, only to a clarification
are not admissible.

5) What are the consequences for third parties of post–grant amendments of patent claims
under your national law, in particular:

– What are the consequences for third parties’ liability for patent infringement where
patent claims are amended post grant?

– Are amendments effective only inter partes or, conversely, erga omnes, including
in relation to previously decided cases?

3 Although the Federal Patent Court has decided that Art. 81 (2) Patent Act does not exclude a nullity action against the
German part of a European patent subject to an opposition, insofar as the action is based on a prior national
application under Art. 139 (2) EPC (cf. Federal Patent Court in GRUR 2002, 1045 – “Schlauchbeutel”), the Federal
Patent Court has explicitly limited its decision to a special case in which the patent in question is indisputably identical
with a prior national application. In all other cases, the third party is restricted to submitting documents that could have
prejudiced the grant of the patent with the competent patent office (Art. 59 (3) Patent Act in conjunction with Art. 43 (3)
“Strahlungssteuerung”.

Giesspfannen”
Are amendments effective only ex nunc or also ex tunc? Does that depend on the context in which the amendment is made?

Amendments to patent claims in limitation, opposition or nullity proceedings are always effective retroactively. The patent is deemed to be granted in the limited extent as from the beginning and has to be judged in this form as from the time the decision becomes effective. The amendments are always effective erga omnes, even with respect to cases previously decided. If, for instance, infringement proceedings have been effectively terminated before a decision becomes legally effective which limits the patent so that the patent is deemed to be valid in a limited extent as from the beginning, an alleged patent infringer already found liable can request an amendment to a legally effective judgment by means of a restitution action. Independently of the context in which the amendments to patent claims were effected, the amendments are always effective ex tunc.

II) Proposals for substantive harmonisation

The Groups are invited to put forward their proposals for adoption of uniform rules, and in particular to consider the following questions:

6) Should post–grant amendment of patent claims be permitted?

Yes, it should. The public has an interest in the revocation of wrongly granted patents. On the other hand, the patentee should have the right to limit their patent, by amendments to patent claims, to a scope which would make it appear legally valid.

7) Who should be entitled to request post–grant amendment of patent claims and who should have the competence to amend?

Both the patentee and any third party should have the possibility of requesting limitation of patents with respect to the granted version.

Both granting authorities and the courts in adversarial proceedings should generally have the possibility of amending patent claims. This corresponds to the system of controlling administrative acts in other areas. The possibility of claims being amended by the granting authorities allows for efficient control prior to court proceedings and without the costs arising therefrom.

The subsequent possibility of amendments being effected by the competent courts is necessary in order to guarantee constitutional control of administrative decisions. However, the decisions of the Examination and Opposition Divisions of the European Patent Office are currently only internally reviewed by technical Boards of Appeal. In contrast to patents granted by the German Patent and Trademark Office, the decisions of the European Patent Office are not subject to a court review. From the point of view of the German National Group of AIPPI, it would be desirable to provide for the possibility of a court review of decisions of the Technical Boards of Appeal. A court instance designed for reviewing decisions should be available to all parties in order to enable them to have the decision reviewed at least with respect to legal errors.

In the case of limitation or opposition proceedings, the authority for effecting the amendment should lie with the patent office. In the case of appeal proceedings against decisions of the patent office, the competent appellate court should have the authority to effect amendments. In nullity proceedings initiated by a third party and, if applicable, in subsequent appeal proceedings, the respective competent courts should be authorized to execute amendments. This is the most efficient way of examining whether the requested amendments are admissible and sufficient for defending the patent.
8) **What should be the substantial conditions for allowing post–grant amendment of patent claims?**

Amendments to the patent after grant should neither go beyond the content of the application originally filed nor extend the protection conferred by the granted patent (Art. 123(2) and (3) EPC). Both requirements serve the purpose of legal certainty for third parties. Third parties should be able to rely on the fact that the scope of such a monopoly right cannot be extended after grant. On the other hand, it seems fair to permit the patentee to amend claims by adding features from the description, provided that these features are part of the subject matter of the invention as originally filed. It should not be decisive whether this feature is still mentioned in the patent document – it should only be ascertained that the limited claim was disclosed by the original application at the time of filing. Juridical security is sufficiently respected in that only amendments limiting the protection are permitted.

9) **Should there be a distinction between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post–grant amendment?**

This question seems aimed at the issue of whether the patentee and third parties should be treated differently with respect to the applicable means of effecting amendments and/or with respect to the substantive requirements for amendments.

With respect to the substantive requirements, we can see no reason to differentiate between the patentee and third parties.

With respect to procedural possibilities ("remedies") resulting in an amendment to the patent, it seems reasonable to differentiate.

– The patentee should have the possibility of limiting the patent unilaterally for example in light of prior art which has become known after grant and thus waiving part of the protection conferred by the granted patent. This enables the avoidance of the costs of opposition or nullity proceedings in advance. As this is a waiver on the part of the owner of the protective right which does not disadvantage any third party, the admission of third parties to the proceedings of voluntary limitation does not seem necessary. However, the possibility of requesting substantial examination in the limitation proceedings – comparable to the grant proceedings – would be desirable.

– Third parties should only be able to obtain amendments to a patent in adversarial proceedings (opposition or nullity proceedings), since the patentee is disadvantaged by the amendment and must therefore have the opportunity of defending their granted patent against the amendment.

– The interests of third parties are sufficiently respected in that the granted claims can be questioned in opposition or nullity proceedings initiated by third parties. The request directed to the specific amendments to be introduced into the claim language must exclusively be reserved to the patentee, as also nullity and opposition proceedings should enable the patentee to maintain the protectable remainder of their patent by means of a sufficiently broad "waiver".

Both third parties and the patentee should have the opportunity of amending the patent claims throughout the lifetime of a patent.

10) **What should be the consequences for third parties' liability for patent infringement where patent claims are amended post grant?**

It seems fair that all amendments to patent claims for a patent should be effective **ex tunc**, i.e. as from the beginning. Third parties should therefore not be liable for patent infringement if the patentee (e.g. because of prior art prejudicial to novelty or the like) subsequently limits their patent in such a way that the third party does not infringe the limited patent.
11) Does your Group have any other views or proposals for harmonisation in this area?

The German National Group of AIPPI is of the opinion that the possibilities of amending patent claims after grant provided for in the German Patent Act and the EPC 2000 generally confer a fair and transparent balance of interests of the patentee and any third parties involved. The defence of a patent in a limited version is an important means for the patentee of defining the [dynamic] limits to a fair monopoly right in return for their valuable, patentable invention.

However, it would be desirable for legal systems to provide for a substantive examination of the amended claims similar to the grant procedure at the patentee’s request. This would lead to an improved legal certainty for the public, and the patentee could – e.g. in the event of finding new relevant prior art after grant – rely upon an examined protective right. This can be important for the patentee especially in patent infringement proceedings in order to avoid suspension of proceedings, possible under German law according to Art. 148 Code of Civil Procedure (ZPO), on the basis of pending nullity proceedings.

For the German National Group of AIPPI it would be desirable if administrative decisions on the limitation of a patent were generally subject to a review by a court so as to assure that substantive law and procedural law are applied in a uniform and correct manner.

Summary

In Germany, the patent owner and any third person is entitled to request an amendment of patent claims at any time after grant. To the extent that an administrative agency handles the amendment of patent claims after grant, the decision of this administrative agency should be subject to a review by a court. It would further be desirable if the legal systems offer, upon request of the patent owner, a substantive examination of the amended claims similar to the prosecution proceedings.

Résumé

En Allemagne, le propriétaire d’un brevet et les tiers ont le droit de demander une modification des revendications du brevet à tout moment après délivrance. Dans la mesure où la modification des revendications est confiée à une autorité administrative, il devrait être possible de soumettre la décision de cette autorité administrative à une révision par un tribunal. De plus, il serait souhaitable que la législation offre – à la demande du propriétaire – un examen quant au fond des revendications modifiées, semblable à l’examen de brevetabilité.

Zusammenfassung