

PROCEEDINGS FOR INFRINGEMENT



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The possibility to oppose an European patent (EP) after expiry of the opposition period is governed by Article 105 of the European Patent Convention (EPC), as was discussed in our article in the May/June issue of *WIPR*.

In a brand new decision 1713/11 given by the European Patent Office's (EPO's) Board of Appeal on April 25, 2013 to revoke an EP, the board comments on some legal actions as the qualifying basis for filing an admissible intervention in pending EPO opposition proceedings.

In the present case the legal provision on which the intervention was based was the first scenario of Article 105 EPC: 'proceedings for infringement'. The actual legal proceeding was a *Privatanklage* raised on behalf of the patent proprietor/patentee by the exclusive licensee of an EP valid for Austria against the intervener before the Landesgericht für Strafsachen Wien (the regional court of Vienna). The *Privatanklage* alleged a wilful infringement of the EP but was dismissed as manifestly flawed.

During the opposition proceedings the patentee repeatedly contested the admissibility of such legal proceedings qualifying as a basis for an intervention, arguing that:

- Intervention under Article 105 EPC should be limited to civil proceedings, and that criminal proceedings under Austrian law did not provide for injunctive relief or damages;
- The *Privatanklage* was rejected and therefore deemed never to have existed or been instituted;
- The proceedings for infringement should be pending at the time the intervention was filed;
- Neither the *Privatanklage* nor its dismissal were officially communicated to the intervener, so there was no date to start the intervention opposition;
- There was abuse of process due to ownership interests of the intervener in the exclusive licensee (or vice versa); and
- Legal proceedings on which an intervention is based require a two-party procedure to avoid conflicting decisions.

In its decision to allow the intervention the Board of Appeal noted that "as EPC must accommodate for national proceedings in its member states, current and future, it can give no specific definition of what constitutes proceedings for infringement but can only refer to infringement in the broadest terms".

The Board of Appeal also commented that Article 105 EPC has to be applied to national infringement proceedings of all member states with often widely different national systems of ascertaining infringement of patents. So the board found it inappropriate to give Article 105 EPC a particular interpretation tailored to national infringement proceedings in some member states, but not in others.

The Board of Appeal took the view that "as long as a patentee or any other party entitled to do so initiates proceedings meant to establish whether a third party is commercially active in an area that falls within the patentee's right to exclude, such proceedings are 'proceedings for infringement' in the sense of Article 105 EPC".

This conclusion was found clearly supported by Section 159 of the Austrian Patent Act, the basis for criminal enforcement of patent infringement. Section 159 starts with the words: "*Wer ein Patent verletzt ...*" (whoever infringes a patent). So the *Privatanklage* did amount to being 'proceedings for infringement' according to Article 105 EPC.

The Board of Appeal also noted that neither the wording of Article 105(1) nor Rule 89(1) EPC mentioned or suggested that infringement proceedings should still be pending at the time of intervention. Therefore the board took the view that it was sufficient that the patentee had made its move in claiming that there is infringement and that such infringement would be sanctioned.

Regarding whether the infringement proceedings need to be officially communicated to the intervener, the Board of Appeal considered the three-month period for filing the intervention. The board acknowledged that proof that infringement proceedings have been instituted must be available to the intervener. In the absence of an official notification, the EPO cannot assume that the intervener has obtained knowledge of the proceedings, so an official notification that infringement proceedings have been instituted is no requirement for an admissible intervention.

So the Board of Appeal took the opinion that it suffices for Article 105 EPC that the party instituting the infringement proceedings has done everything for the proceedings to take their course.

The allegations of abuse of process were not discussed in the oral proceedings because it was insufficiently proven.

The complete decision can be read at <http://www.epo.org/law-practice/case-law-appeals/recent/t111713eu1.html>. ■

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