

STRATEGIC USE OF LIMITATION PROCEDURES



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The European limitation procedures were enacted by the European Patent Convention (EPC) 2000 and came into effect in 2007. Requests for limitation allow a European patent proprietor to amend a European patent using a centralised *ex parte* procedure at the European Patent Office (EPO). This avoids the need to file separate requests in each contracting state where the granted patent is in force.

Limitation proceedings are designed to avoid costly national disputes over the validity of a European patent and to enhance legal certainty. While only the proprietor can file a request for limitation, the request can be filed at any time during the term of a European patent. However, the request cannot be filed if the patent is subject to pending opposition proceedings.

A request for limitation must include amended claims that constitute a limitation of the scope of protection with respect to previous claims. Claim amendments that merely clarify or encompass different subject matter are not considered a 'limitation'. Likewise, amendments to the description that only improve the patent or constitute cosmetic changes not necessitated by the limited claim are not allowed. It is permitted to amend a dependent claim, by introducing a new limitation, but it is not permitted to add new depending claims if such depending claims have not been caused directly by the introduced claim limitation.

Since the claims as granted were found to be new and inventive, the EPO will become involved only if the claims filed during the limitation proceedings meet the requirements of clarity and allowable amendments. Thus, novelty and inventiveness are not evaluated.

Limitation proceedings are strategically useful in a number of situations, for example if a particular limitation seems to be necessary due to a new prior art document, ie, a document which was not considered during the grant proceedings. This might be beneficial for a later judicial enforcement of the patent and could avoid a suspension of infringement proceedings due to prior art that clearly anticipates the features of the main claims.

National prior rights, ie, national patent applications filed before a European patent but published after the filing date, are prior art documents, which are not considered in the grant proceedings of a European patent. When the Unitary Patent enters into force under the EPC, national prior rights are likely to be able to invalidate the entire European patent with unitary effect—the Unitary Patent—and since there are no provisions for converting the Unitary Patent into national patents, the limitation procedure will be relevant for preventing the Unitary Patent from being revoked based on a national prior right.

The proprietor can also use the limitation procedure to tailor patent claims to products an infringer has placed on the market, thereby avoiding lengthy and costly infringement proceedings. This is because a patent with a relatively limited scope of protection can be very difficult for the infringer to invalidate. The potential infringer is therefore left with the options of

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terminating the infringing action, obtaining a licence agreement to the patent or purchasing the relevant rights.

The limitation procedure can also be useful if the claims have been found to have problems with clarity, are missing essential features, or comprise added subject matter that can be addressed by limiting their scope.

Thus, the limitation procedure can be a powerful tool for defending a claim or counterclaim for invalidity. As an example, the UK Court of Appeal agreed recently to adjourn an appeal in an ongoing dispute between Apple and Samsung, in order to await the outcome of Samsung's applications to the EPO to limit the claims of two of its European patents which were revoked during the trial at the High Court.

Accordingly, the proprietor may seek to initiate limitation proceedings as soon as possible, for example after receiving a ruling rendered by a national court invalidating or maintaining the patent with a limited scope in view of a prior art, instead of having to argue the matter during a national appeal or before different jurisdictions.

In light of this, third parties concerned about infringement may have even greater cause to file European oppositions as a defensive measure, since doing so will prevent the use of the *ex parte* central limitation procedure by proprietors until the (often lengthy) opposition proceedings have been brought to a close. ■

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