

Denmark

Re-examination: a convenient tool for testing patent validity

Many have experienced the feeling that strikes when a competitor's patent pops up in a database or arrives by mail: this patent may mean trouble. If the patent is critical and the period for opposing it has expired, in most EU member states the only way to invalidate the patent – or at least to have it limited to a tolerable extent – is to instigate invalidation proceedings in court.

In Europe, the term for filing an opposition with the European Patent Office (EPO), and thereby having the validity of a competitor's patent right examined, is nine months from the date of issuance of the patent. If no opposition is filed, an EU invalidation procedure cannot be requested at a later stage. However, in many cases it is not possible or relevant to file an opposition within the specific time limit. If no opposition is filed, the only way to invalidate the patent is to challenge its validity in court. Since a European patent court has not yet been established, in principle, invalidation proceedings must be carried out in each member state, making this a costly option. Furthermore, it may be years before a final decision is issued, as the case may proceed through several instances. In addition, although some member states have judges who specialise in patent law and are technically qualified to understand inventions, this is far from always the case.

In 1993 re-examination proceedings were introduced into the Danish Patent Law as a tool for both patentees and third parties. Re-examination offers them the opportunity to challenge the validity of a patent in Denmark. Re-examination proceedings are carried out at the Danish Patent Office by examiners specialised in evaluating the patentability of an invention during the normal, pre-issuance examination of a patent application. The examiners are qualified to understand the technical background of the invention, which allows for technical discussions during invalidation proceedings without having to appoint experts.

Re-examination proceedings are available for both Danish national patents and the Danish part of European

patents. In this regard, it must be emphasised that in Denmark there is no file history estoppel, and consequently the prior art and arguments used during re-examination proceedings may be used in court at a later stage, if relevant.

Denmark is the only EU member state to provide a legal basis for re-examination proceedings of issued patents. Although Denmark is a small market, the re-examination proceedings offer a unique opportunity for assessment of the validity of a European patent by a patent authority. As re-examination is performed by patent examiners, the results of the re-examination may have a bearing on subsequent court proceedings in other EU member states. Therefore, Denmark may be the testing ground for patent validity.

Anybody may request re-examination, including the patentee; however, the requirements for the patentee and for third parties are different. A third party requesting re-examination need not provide evidence of its interest in the patent. Re-examination may be requested at any time after issuance, except during the term for opposition or opposition proceedings. In addition, if a case is pending before a Danish court regarding the invalidity of the same patent, the Danish Patent Office will refuse the request for re-examination. Re-examination may be requested even after a patent has expired.

Re-examination requested by the patentee

The patentee may use re-examination to limit the patent claims after issuance and thereby strengthen the patent's position – for example, before instituting an infringement case. In particular, this may be relevant if new prior art came to the knowledge of the patentee after issuance of the patent.

When the patentee requests re-examination, it need not provide any information regarding the reasons for limiting the patent claims or file any proof of relevant prior art. However, the request must be followed by a claim set that is limited, as compared to the issued patent claims. The limited claims must fulfil the

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requirement for having a basis in the text as originally filed. This part of the Danish re-examination procedure corresponds to the recently introduced central limitation proceedings for European patents in general.

A recent decision confirmed that if a patentee requests limitation of its patent, the limitation must be a true limitation of the scope of the patent claims (ie, a limitation of independent claims, not merely dependent patent claims). In this case a patentee tried to improve the patent by introducing two new dependent claims through the re-examination procedure. The request was refused and the patent upheld as issued, since the introduction of dependent claims did not limit the main claim as such. Another patentee tried to remove a feature from the main patent claim. This was refused, since removal of the feature would broaden rather than limit the scope of the patent.

Although there is no need to file arguments and prior art in order to limit a patent, the patentee may also use the re-examination proceedings to have the limited claims evaluated in view of certain prior art. When the patentee provides prior art and arguments, the Danish Patent Office will examine whether the limited claims fulfil the patentability criteria in view of the filed prior art. This may be useful before initiating infringement proceedings, in particular if the prior art has been cited by the assumed infringer in other proceedings.

Unlike Danish re-examination proceedings, European limitation proceedings offer the patentee only the possibility to limit the claims; it is not possible to re-open a discussion of patentability in view of old or new prior art.

If the patent to be limited is a European patent and there is no need for a discussion of prior art, by far the most advantageous route is to request limitation at the

EPO. In contrast, if examination of the prior art at the Danish Patent Office would be advantageous, Danish re-examination proceedings may be useful. In addition, it may be useful to request re-examination of the Danish part first, optionally with argumentation and prior art, and, once the outcome is known, to request central limitation proceedings before the European Patent Office.

Insofar as the limited claims have a basis in the originally filed text and fulfil the requirements for patentability if prior art is filed, the limited claims are accepted and the patent is amended. On the other hand, if the limited claims cannot be accepted, for whatever reason, they will be refused and the patent will be maintained as issued. Even if the limited claims are deemed unpatentable in view of the filed prior art there is no automatic rejection of the patent as such – only a refusal of the limited claims, which leaves the patentee open to request a different limitation of the claims.

There is no upper limit on the number of times that re-examination may be requested for the same patent. Recent practice has shown that a patent for which re-examination was requested by a third party was upheld in amended form. A few years later, the patentee requested re-examination of that patent by introducing further limiting features into the main claim, which by then had been amended twice after issuance.

Re-examination requested by third party

Limitation proceedings at the EPO provide no possibility for a third party to file a request for limitation or invalidation of a European patent. In contrast, a third party may request re-examination of a patent in Denmark. The third party is party to the proceedings until a final decision is issued and may file responses and arguments to any comments from the patentee.

When requested by a third party, re-examination proceedings are almost identical to opposition proceedings. A request from a third party must be based on the conventional criteria for requesting invalidity of a patent – that is, the request may be based on a lack of:

- novelty, inventive step or industrial applicability of the invention;
- enabling description; or
- basis for amendments made during examination of the patent application or made during opposition proceedings.

All parties may provide as many written submissions as the Danish Patent Office deems to be required, and there is also a possibility for oral proceedings.

During re-examination proceedings requested by a third party, the patentee may file arguments as well as amended claims, if deemed relevant. The Danish Patent Office examines whether the optionally amended claims fulfil the patentability criteria in view of the prior art and arguments presented by the third party. If the claims on file are considered patentable, the patent is upheld, optionally in amended form; whereas if the claims are deemed unpatentable, the patent is rejected. This is contrary to the procedure requested by the patentee, wherein the patent cannot be rejected, even if the amended claims are deemed unpatentable.

Amended claims must still fulfil the formal criteria for amendments (ie, that there is basis in the originally filed text), as shown in a case recently decided by the Danish Appeal Board. During re-examination requested by a third party, the patentee amended the patent claims and subsequently the Danish Patent Office decided that the amended claims fulfilled the patentability criteria. The third party appealed the decision, claiming that the amended claims did not fulfil the requirements for amendments (ie, they related to subject matter not described in the original patent application). The board decided that the amendments were unallowable and consequently the case went back to the Danish Patent Office, which subsequently agreed and revoked the patent.

The costs involved in requesting and prosecuting Danish re-examination proceedings are lower than the costs involved in invalidity proceedings before the courts; therefore, Danish re-examination proceedings are often appropriate for third parties to test the relevance of arguments and prior art when attacking a patent.

Appeal

A decision of the Danish Patent Office may be appealed to the Appeal Board; if the re-examination was requested by a third party, the requester is party to the

appeal proceedings. At the final oral proceedings before the board, both parties may be present and argue their case. Board decisions may be appealed to the courts.

Re-examination of supplementary protection certificates

Supplementary protection certificates (SPCs) were introduced in the European Union in order to extend the patent term for patents covering medicinal products and plant protection products. SPCs are governed by an EU directive and are therefore incorporated into national laws. Although SPCs are governed by an EU directive, they must be applied for on a state-by-state basis. An application for an SPC in Denmark must be filed at the Danish Patent Office.

The rules for re-examination in Denmark also include the possibility of re-examination for issued SPCs. As for the re-examination of patents, both the certificate holder and third parties may request re-examination.

Several grounds for invalidation of an SPC are possible during re-examination. An SPC may be invalidated because:

- the basic patent does not cover the product;
- there is no valid marketing authorisation;
- the product has already been the subject of an SPC;
- or
- the basic patent has lapsed, is limited or is invalid.

If the invalidation of the SPC is based on invalidity of the basic patent, it is also necessary to request re-examination of the basic patent if no opposition against the basic patent is pending.

Since the requirements for obtaining an SPC are identical in all EU member states, invalidation or change of a certificate in Denmark may have an impact on corresponding SPCs in all other EU member states if challenged, for example during infringement proceedings.

Case law provides some examples of the use of SPC re-examination. In one case, the expiry term was adjusted. The SPC holder apparently became aware that the marketing authorisation in the SPC application, which was indicated as the first marketing authorisation and from which the term for expiry should have been calculated, was in fact not the first. The re-examination request stated that another marketing authorisation issued some months earlier was the first, and therefore the certificate should be amended. The amendment decreased the term until expiry; however, the risk of the SPC being invalidated during infringement proceedings was markedly decreased.

In another case the re-examination procedure related

to whether the scope of the basic patent in fact covered the marketing authorisation allowing the product into the market. The case was settled and the request for re-examination was withdrawn; however, this is nonetheless a good example of the possibilities of the re-examination process.

Comment

Since the introduction of the re-examination proceedings in Denmark in 1993, both patentees and third parties have availed of the possibility to evaluate the scope of patent claims, in particularly before infringement proceedings.

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