

collection and processing of the data, meet the requirements set out in the Convention, notably its **Article 5** and following Articles. An important factor in the consideration of the legality of the EPO's data protection policy is that the inventor may waive his/her right to be designated as inventor. The EPO has therefore concluded that it is not only entitled, but *obliged* to make the patent data including address details available to the general public.

The availability of the inventor's contact address on the internet is therefore the **responsibility of the representative** preparing the patent application documents. The

representative must therefore ensure that the inventor is aware that the contact address will be available to the public and should check which address the inventor wishes to be used. Inventors should also be informed that they may waive their right to be mentioned as inventor.

There has been a practice for many years in the pharmaceutical and biotechnology fields for the inventor's place of work or the applicant's head office to be used as the contact address for the inventor; this practice would appear to be the safest option in most cases, not just for EPO applications but also for national and international applications.

Strengthening patents in France by post-grant limitation



A revision of French law², which came in to force on 1 January 2009, now allows a patentee voluntarily to limit the scope of the claims of a granted patent in France. This will allow patentees to strengthen their patents in France before or during litigation.



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Previously, post-grant limitation in France was restricted to:

- the surrendering of one or more of the patent claims³; and
- partial revocation of one or more claims during court proceedings (which has generally be restricted to consideration of patentability of exiting dependent claims).

These two options are still available in addition to the new voluntary post-grant limitation procedure.

The new law does not define the term 'limitation': it only indicates that the limitation is carried out by amending one or more claims. Logically, a limitation probably requires a reduction in the scope of protection conferred by the patent. Extension of the scope of protection of the granted patent is explicitly prohibited and carries the sanction of possible revocation⁴.

The new French limitation procedure applies not only to national French patents but also to European patents in France⁵ and, probably, to supplementary protection certificates⁶.

Limitation may be requested by the registered proprietor(s) 'at any time' after a patent has been granted, including during a revocation action⁷ or, it seems, during an appeal. A limitation of a European patent in France may be requested during a pending opposition at the European Patent Office, for example rapidly to limit the claims in France to

those being defended in the European opposition.

The procedure is relatively simple. A written request for limitation filed at the National Institute of Industrial Property with the required fee (currently €250) is examined for compliance with the requirements:

- (i) not to extend the scope of protection; and
- (ii) for the claims to be clear and concise and supported by the description.

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'. A time limit is set for the applicant to rectify or comment on any objections raised.

Once accepted, the limitation is entered on the National Patent Register (there is no publication of a new specification) and has retroactive effect from the filing date of the patent application.

The law does not specify whether a court should stay an infringement or revocation action pending the outcome of a request for limitation. However, given the relative speed of a limitation procedure and the explicit reference in the law to the possibility of requesting a limitation 'within the framework' of revocation proceedings, it is reasonable to think that stays will generally be granted.

There is no provision specifying that a limitation may be requested only once; thus a 'limitation of a limitation' is possible.

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However, if a patentee 'makes a plurality of limitations of his patent, in a dilatory or abusive manner' within the framework of revocation proceedings he may be liable to damages and a civil fine of up to €3,000⁸.

This new post-grant voluntary limitation procedure should thus allow patentee in France to strengthen their position before or during litigation and streamline French infringement proceedings.

References

1. The authors wish to thank **Anaïs Artus**, attorney-at-law, Véron & Associés, for her help in the preparation of this article.
2. The Act dated 4 August 2008 amended **Articles L. 613-24, L. 613-25 and L. 614-12** of the French Intellectual Property Code.

These provisions were supplemented by Article 3 of the decree of 30 December 2008 (Article R. 613-45 of the French Intellectual Property Code).

These provisions entered into force on 1 January 2009.

Article L. 613-24 of the new French Intellectual Property Code governs voluntary limitation procedure 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 **Article R. 613-45** of the French Intellectual Property Code specifies the requirements to be fulfilled.

Articles L. 613-25 and L. 614-12 of the French Intellectual Property Code dealing respectively with French national patents and European patent 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.

3. **Article L. 613-24** of the French Intellectual Property Code.
4. **Articles L. 614-12 and L. 613-25** of the French Intellectual Property Code
5. This follows from **Article 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*"
6. Since **Article L. 613-24** on limitation is not included in the articles whose application to supplementary protection certificates is explicitly excluded by **Article L. 611-2**, it seems that the limitation procedure may be applied to supplementary protection certificates
7. **Articles L. 614-12**, concerning European patents, and L. 613-25, paragraph 3, concerning national French patents
8. **Article L. 613-25**, for a French patent, and **Article L. 614-12**, for a European patent

Divisional applications: yet more on the new law



By **Alex Rees** and **Liz Dawson** (Fellows)

The new rules relating to divisional applications and other procedural rules as well as the articles in which they are discussed have prompted a lot of discussion and debate. Following **Jim Boff's** article in last month's *CIPA Journal* (Ed.: p.540; and see his response and addendum/corrigendum following this article) we could not resist adding our thoughts to the melting pot.

We have seen little or no discussion of the interplay between the rules relating to divisional applications and the rules relating to the handling of applications at the search stage. This could see the **death of non-unity objections as we know them** so that some of the scenarios suggested by Jim may just not happen. Read on...

Firstly, a couple of minor points:

1) We note Jim's point that the wording 'the earliest application for which a communication has been issued' is unclear. The EPO published a notice on 20 August (which Jim would not have seen when writing his article) indicating that they presently intend to interpret this to mean the 'earliest application in the sequence'. However, the wording is ambiguous and it would be possible for them to change this interpretation at a later date.

2) **Rule 36(1)(b)** does not come into play unless the Examining Division objects that the

earlier application does not meet the requirements of **Article 82 EPC**. It applies only to a communication raising a specific objection to lack of unity 'for the first time'. This clearly means the first time ever, otherwise it would be possible for applicants to file cascading divisional applications containing the same claims as their parent in order to extend the time limit indefinitely.

More importantly, considering the effect of new **Rule 62a** an objection to lack of unity will be very rare.

Suppose that an application contains separate independent claims relating to different inventions. The first action by the EPO will be to invite the applicant under new **Rule 62a (1)** to indicate the claims *complying with Rule 43(2)* on the basis of which the search is to be carried out.

Since the elected claims have to comply with **Rule 43(2) EPC**, the indicated claims can only include independent claims to one invention. We think the other claims to the