

# Invalidation under the UPC

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„Always take the weather with you“ (CROWDED HOUSE)

- Grounds for nullity / revocation are not modified by the UPC
- Art. 24 para. 1 lit. c): it's still the EPC that sets the rules for patentability / nullity / revocation
- Radically changed procedure, however:
- Revocation may be counterclaimed
- Time frame of 1 year before the court of first instance
- Technically qualified judge may be assigned to the panel at any time

### „Look what I’ve found in my beer“ (BEAUTIFUL SOUTH)

- Lack of novelty appears to be the most promising ground of revocation
- It requires, however, the complete revelation of the art claimed by the patent in question
- Practically: One single objection needs to reveal every single characteristic of the patent
- Difficulties:
  - „Scope of revelation“ unclear
  - Revelation of the one single objection must not be combined with the „common knowledge“ of the person skilled in the art
  - Implicit revelations („implicitly read by the skilled person“) in but a few cases

### „Hangar 18“ (MEGADETH)

- Obviousness / lack of inventive step will continue to be a rather complex ground of revocation
- Two pieces of prior revelation cannot be combined without a cause; the person skilled in the art needs to be motivated to combine unless making an inventive step
- „could-would-approach“ needs to be followed also when testing the combination between written objection(s) and the skilled persons’ common knowledge
- Difficult (unpredictable?) assessment: What divides a thorough but routine research work from acting inventively?

## „Tornado of Souls“ (MEGADETH)

- Decisions by competent patent offices may give an indication on whether or not there is an inventive step in the technical art claimed
- This is most of all true for EPO's decisions but as this is the competent office for EPs, a precedent EPO decision will mostly be the object of the court's assessment
- Decisions by European national offices can be in place and should be closely examined as far as the national laws applied follow the EPC's principles
- Decisions by the USPTO on parallel US patents have to be examined while bearing in mind the differences between the EPC and substantive US patent law

## „Don't look back in anger“ (OASIS)

- Objections / prior revelations cannot be interpreted in the light of the patent's claims and revelation
- They need to be interpreted from an „ex-ante“ point of view instead
- A double fiction has to be made: Assessing the knowledge and capability (1) of the ideal, i.e. non existing person skilled in the art (2) at the date of priority of the patent
- Both fictions are normative, need to be construed normatively, i.e. following legal criteria

## „Trapped Under Ice“ (METALLICA)

- Will the panels be able to work through piles of objections and/or auxiliary requests?
- Claimants being confronted with a counterclaim will most often need to apply to amend the patent so to have a “safety net”
- Applications to amend the patent can (and will) be phased into one or multiple auxiliary requests, coming from the patent’s broad scope and focusing it to the embodiment in question
- The court must decide on each following auxiliary request unless granting the prior (auxiliary) request

## „Hero of the Day“ (METALLICA)

- In this situation, the panels will need to exercise an elaborate case management as required by both the UPC and the rules of procedure
- But: what chance remains for a party to change the mind of a well prepared panel in the course of the oral procedure?
- “Trick #1”: Keep one more smoking gun in the pocket – and present it not before the oral proceeding
- “Trick #2”: Highlight the technical / factual features of the case (distinguishing in fact)
- “Trick #3”: Prove the necessity to develop a completely new legal assessment, e.g. due to the procedural law ruling the UPC (distinguishing in law)

## „Welcome to the Jungle“ (GUNS N' ROSES)

- Time limits and rules for written pleadings during the written procedure have to be observed
- The ratio being that the proceeding's subject matter has to be reasonably limited
- What has not been delivered during the written procedure in first instance will not be taken into account – not in the first instance decision and very probably not before the Court of Appeal (see Rule 222)

## „One shot at Glory“ (JUDAS PRIEST)

- This will especially affect revocation actions, both isolated and as counterclaims
- Objections have to be presented as timely as possible – i. e. they need to be found almost at once
- “Amending strategies” have to be designed either quickly within the proceedings or prophylactically in advance
- Complex standoffs of objections and amendments will most probably not fit the 1-year time frame

## „Wouldn't it be good“ (NIK KERSHAW)

- Bearing in mind the significance of revocation actions: How technically qualified do the legally qualified judges have to be?
- Technically qualified judges are always in the minority, can always be overruled (art. 35 statute)
- However, they are part of the panel and can (and are obliged to) make their “technical” position clear in the panel’s consultation
- And they are not alone: Witnesses and parties’ and court’s expert are also there to highlight the technical aspects of a case

## „Ace of Spades“ (MOTÖRHEAD)

- Again: Grounds for nullity / revocation are rules to be interpreted and applied in a normative manner; i.e.: what is scientifically true is not necessarily legally true
- A court expert’s finding art the basis of the court’s decision, not its blueprint
- The technically qualified judge is a member of the panel; his arguments must neither be blindly overruled nor blindly followed
- Technicians and lawyers on the panel have to find a common ground of normative communication

## „Some Kind of Monster“ (METALLICA)

- Setting up the UPC is both chance and challenge with regard to Europe's legal cultures
- To put it ironically: It's the clerk-wise working German judges always keen to conclude a case vs. the British Lord Justice trying to discover every single aspect of the case before deciding on it
- It's a conflict of aims the UPC has to resolve: producing a good, well founded decision that respects the parties' interests – in a timely manner
- It is also in the hands of the parties to (1) support productive proceedings and to (2) put the stress rather on thoroughness or on timeliness

Thank you for your attention!

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