

EIP



Post-grant amendment, Court discretion and narrowing scope for wider rights

A recent High Court decision demonstrates that a post-grant amendment may still be rejected in the UK at the discretion of the court. The amendment was rejected as even though the scope of the proposed amendment was narrower than the originally granted claims, it would nevertheless have extended the scope of rights conferred regarding contributory infringement.

This case was between Datacard Corporation and Eagle Technologies Limited, and concerned two patents owned by Datacard relating to printers. The proposed amendment was the addition of a new dependent claim to one of the patents, the new claim reciting “the supply item of any preceding claim further comprising a carrier to which the cylinders can be mounted”. The carrier was an item that might be supplied by a third party.

If the amendment was allowed, third parties supplying the carrier could become contributory infringers retrospectively, as they would not have been contributory infringers of the claims as originally granted. However, the amendment could not be refused on the basis that the scope of the patent would be extended post-grant, because, as was acknowledged by the court, the extent of protection relates to the amount of subject matter protected by the claims of the patent, rather than the extent of rights conferred in relation to that subject matter. By introducing an additional limitation (the further need for a carrier), the scope of the claims was narrowed, regardless of whether the amended patent would confer additional rights with respect to contributory infringement.

Nevertheless, the judge refused the amendment. Arnold J stated that the policy that underlies Art 123(3) EPC and the corresponding section 76(3)(b) of the 1977 Act is that third parties should not be exposed to a new risk of infringement by an amendment of a patent after grant. Accordingly, he declined to permit the amendment in the exercise of his discretion.

The fact that the refusal was based on the judge's discretion is noteworthy, as there has been a view that a change made to the Patents Act 1977 had removed the possibility of a judge rejecting a post-grant amendment solely at their discretion. This is because the change in law now requires the court to have regard to any relevant principles applicable under the EPC when considering whether or not to allow an amendment (section 75(5) of the 1977 Act, introduced by the Patents Act 2004). Because post-grant amendment is allowed under the EPC on a non-discretionary basis, it was felt that this might have removed the UK judges' discretion in refusing amendments. However, Arnold J stated that although the change in law has curtailed the extent of the court's discretion, it has not removed it altogether.

Despite the fact the UK refused this amendment, it is possible that had a similar amendment been sought via central limitation at the EPO it would have been allowed, as the extent of rights conferred would not have been considered in post-grant proceedings before the EPO.

This case shows that it cannot be assumed that, due to the introduction of section 75(5) of the 1977 Act, the UK courts will take the same approach to the allowance of post-grant amendments as the EPO; they may take into account rights conferred, which the EPO will not. It also demonstrates the value in assessing whether there are any advantageous amendments which might be made to a patent via central limitation at the EPO prior to initiating litigation proceedings. Finally, this highlights one way in which an understanding of the market in which a technology operates is important when drafting a

patent, including its dependant claims.