

EIP

Put up or shut up: Nokia vs IPCom

This appeal decision demonstrates the importance of considering potential patent amendments early in litigious proceedings. The appeal was concerned with two patents which were part of a larger dispute between IPCom and Nokia. IPCom alleged infringement by Nokia of two patents, European Patent (UK) No. 0,540,808 (the "Synch Patent ") and European Patent (UK) No. 1,186,189 (the "Access Rights Patent"). Nokia countersued alleging invalidity.

At first instance Floyd J had found both patents to lack inventive step. In addition IPCom had made two applications to amend the "Access Rights Patent" either side of the main trial. Both applications to amend were rejected by Floyd J. IPCom did not challenge the invalidity decision regarding the "Access Rights Patent" and instead sought to appeal the rejections of their two applications to amend.

The Court of Appeal upheld Floyd J's original decisions in all three instances. In relation to the applications to amend, Jacob LJ stated that "IPCom had every opportunity of proposing the amendments in time so that there could be a trial about them, it did not do so (whether deliberately or not we do not know), it only proposed amendments too late for them to be dealt with fairly at the trial, it elected to go to trial on the patent as it stood, and only when it lost did it seek to prolong matters thereby to vex Nokia again with the same patent. The Judge was fully entitled to regard that as procedurally unfair and to refuse to allow that to happen".

Jacob LJ went on to explain that this was clearly set out in the Civil Procedure rules, and is consistent with the position taken by the EPO.

The procedural rules of the Court [CPR Part 63.10] as summarised in *Nikken v Pioneer Trading* [2005] EWCA Civ 906, allow a patentee to formulate one or more "fallback"

positions by way of amendment, and to make it clear that amendment is only sought if his patent as it stands is found invalid.

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This approach is similar to the “auxiliary requests” used before the European Patent Office. Jacob LJ referred to Article 13(3) of the amended Rules of Procedure before the Boards of Appeal of the European Patent Office which states that “amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings”. In reality, the EPO will often allow amendments which are proposed after oral proceedings are arranged, and even during the proceedings themselves. Nevertheless, Jacob LJ relied on Art. 13(3) as demonstrating that the position of the English courts was consistent with that of the EPO.

This case highlights the need for litigants to both consider and propose potential amendments to their patents at a relatively early stage in proceedings, as otherwise they risk a patent being invalidated which could otherwise have been saved. As summarised by the Court of Appeal: “put up in time, or shut up”.