

EIP

Unchallenged claims of patent cannot be amended

Carrier Corporation v. BITZER Electronics A/S UPC_CFI_263/2023

Order of 30 April 2024 (ORD_24607/2024)[1]

BITZER Electronics filed a revocation action on 29 June 2023 against EP 3414708 at the Paris central division. The statement for revocation requested “revocation of the patent at issue to the extent of claim 1”. The patentee Carrier Corporation filed a defence on 20 November 2023 including an application to amend the patent, consisting of a main request and twelve auxiliary requests which relate not only to claim 1, but also to other non-attacked claims of the patent. The claimant requested in their defence to the application to amend the patent filed on 19 January 2024 that the amendments should not be admitted to the extent that they did not relate to claim 1. The judge rapporteur issued an order on 5 April 2024 stating that the issue concerning the admissibility of the amendments would be addressed by the panel during the course of the oral hearing.

On 18 April 2024 the applicant requested the Court to set aside that decision. The full panel therefore considered the issue of whether the patentee was only entitled to amend claim scope that had been challenged.

The Court observed that no provision of the UPC Rules of Procedure or the European Patent Convention explicitly addresses the issue of amending a claim that has not been challenged. It therefore considered the matter from general principles.

The Court considered that the right to amend functions as a defence to the challenge and therefore concluded that the patent may be amended only to the extent that it is necessary to react to the invalidity challenge. From this it followed that the request to amend the patent may not introduce new subject matter that broadens the scope of the proceedings set by the invalidity claim. Accordingly, any request to amend the patent with

regard to claims not challenged by the revocation action should be declared inadmissible to that extent.

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Therefore, the Court ruled that proposed amendments relating to claims other than claim 1 (the sole target of the revocation action) shall be excluded from consideration in the revocation proceedings.

While the Court is correct that no provision of the EPC addresses the issue of amending a claim that has not been challenged, it is notable that they did not consider Rule 80 EPC which would have applied in analogous opposition proceedings. This sets a rather different test that the amendments must be occasioned by a ground of invalidity, even if it is one that has not been raised by the challenging party. However, the judgment does note that judicial proceedings before the UPC should not be compared with EPO practice, as the EPO is an administrative body whose duty is to assess if an invention is worthy of patent protection and not to resolve disputes between parties in an adversarial system.

[1] <https://www.unified-patent-court.org/en/node/716>