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Opposition procedure before the European Patent Office and nullity claim of a national designation

Pierre Véron (Véron & Associés) · Wednesday, July 14th, 2010

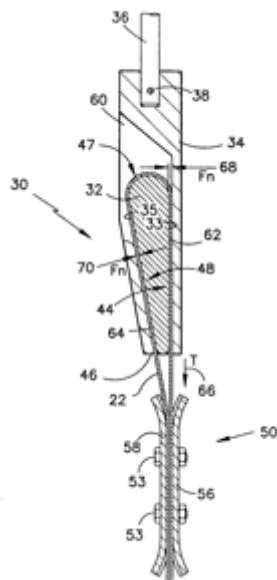
Otis Elevator Company (hereinafter referred to as “Otis”) is the owner of different European patents covering elevators systems.

Considering that some Schindler elevator models reproduced certain characteristics protected by its patents, on 24 November 2006, Otis brought proceedings against Schindler before the *Tribunal de Grande Instance* of Paris for the infringement of four patents (EP 1 066 213, EP 1 060 305, EP 1 153 167, EP 1 140 689).

In a first judgment dated 16 April 2008, the *Tribunal de Grande Instance* of Paris ordered the disjoinder of proceedings.

The court noted that oppositions had been filed before the European Patent Office against the first three patents and that “*admittedly, as regards European patents, the stay of proceedings ordered for the needs of a good administration of justice is subordinated to the examination by the court of the serious character and of the chances of success of the opposition filed before the European Patent Office and of the consecutive probability of amendments of the claims opposed in the litigation*”. Yet taking into consideration the prior art documents adduced by Schindler, the lack of inventive step could be pertinently alleged against these three patents so that the opposition filed had great chances to be approved by the European Patent Office. Therefore the court ordered the disjoinder of proceedings relating to these three patents and stayed the proceedings pending the final decision of the EPO on the oppositions filed against them.

However, as for the fourth patent in litigation (EP 1 140 689), the court noted that the opposition had been rejected by the European Patent Office on 4 December 2007 and although an appeal had already been filed before the Technical Board of Appeal against the Opposition Division’s decision of 4 December 2007, it ordered the disjoinder of the proceedings relating to this patent and requested the continuation of the case preparation to rule on the merits.



This ruling on the merits can be found in the second [decision](#) of the *Tribunal de Grande Instance* of Paris of 1 July 2009. The court held the French designation of European patent No. 1 140 689 invalid for insufficient disclosure. This patent was covering an elevator rope termination device of the “wedge clamp” type and its claim 1 indicated that it was necessary to calculate the angle of this suspension rope attachment device so that the traction force exerted on the rope during the use of the elevator does not generate on the elastomer coating of the suspension rope a stress higher than its maximum compressive stress capability and eventually a non-recoverable deformation. But neither the patent nor the knowledge accessible at the time of the invention provided the skilled person with the means to calculate this angle. In the patent’s specification or claims maximum compressive stress capability values were mentioned without any reference to precisely defined materials or time parameters. The notion of non-recoverable deformation could not be guaranteed because there was a large difference between point P from which there is a residual permanent deformation and the rupture point. Of course the Opposition Division likened the maximum compressive stress of claim 1 to a permanent elongation value of the belt of 0.1% but without stating which reasoning and which previous knowledge would lead the skilled person to consider this value as the value of the maximum compressive stress capability, it being noted that this value corresponded neither to point P nor to the rupture point of the material.

On 18 February 2010, the EPO Technical Board of Appeal issued its decision on the appeal against the Opposition Division’s decision of 4 December 2007 rejecting the opposition, in line with the *Tribunal de Grande Instance* of Paris, and revoked the European patent for insufficient disclosure (points 3.1 et seq.).

The 1 July 2009 decision of the *Tribunal de Grande Instance* of Paris is interesting as it illustrates the evolution of French courts as regards the stay of proceeding when the invalidity of the French designation of a European patent is requested in the main claim or in the counterclaim as a defence in the context of an infringement action, while an opposition relating to the same European patent is pending before the European Patent Office. Such a stay of proceeding is not mandatory since it is not legally required. Therefore, the stay of proceeding is optional: at first French courts ordered the stay of proceeding in a systematic way, with a view to ensuring good administration of justice and to avoid any risk of conflict between their decisions and those of the European Patent Office (e.g. *Tribunal de Grande Instance* of Paris, 3rd ch., 1st sect., 24 March 1999, *Sociétés Boston Scientific SA et Boston Scientific International B.V. v. Cordis Corporation*, RDPI 1999, No. 100,

p. 33). However, since the early 2000s (*Cour d'Appel* of Paris, 4th ch., sect. B, 14 January 2000, Docket No. 99/19633, PIBD 2000, No. 699, III, 273), French courts have considered that a stay of proceeding may contradict the philosophy of the European patent system which allows to file an opposition procedure after the patent grant, in the course of which the patent is deemed to be valid. The stay of proceeding may also seem unjustified because in practice most patents are maintained after an opposition, as they were or in a slightly amended version. It was also to be feared that the infringers could be encouraged to file oppositions for merely dilatory purposes. Therefore the courts changed their practice, ordering the stay of proceeding only if the procedure before the European Patent Office seems to be serious and to have real chances of success. It is that sort of assessment of the seriousness and chances of success of the opposition filed before the EPO that the *Tribunal de Grande Instance* of Paris made on 16 April 2008 concerning the first three patents claimed by Otis. In so doing the French courts' practice comes close to that of the UK courts. However, the question is not likely to arise in Germany, since Article 81 §2 of the German patent law provides that “*an action for a declaration of nullity of a patent shall not be brought as long as opposition may still be filed or opposition proceedings are pending*” and the patent litigation is split in two, the validity on the one hand (*Bundespatentgericht*) and the infringement of the patent on the other hand (*Landgericht*).

French case law on the stay of proceeding may seem sound. However it creates a serious risk of tricky conflicts of decisions between the French courts and the European Patent Office. Even if the French courts take the precaution of assessing the seriousness and chances of success of the opposition before the European Patent Office, a discrepancy and therefore an irreconcilability of decisions is always possible. It can lead to a complete contradiction where the French court holds the French designation of the European patent invalid whereas the European Patent Office rejects the opposition, or to a lower opposition but equally problematic if the French court holds the French designation of the European patent as granted invalid whereas the European Patent Office decides to maintain the patent as amended. In that last case, can the French decision invalidating the French designation of the European patent as granted prevent the patentee from using his rights over the European patent as amended?

[Original French decision.](#)

[English translation.](#)

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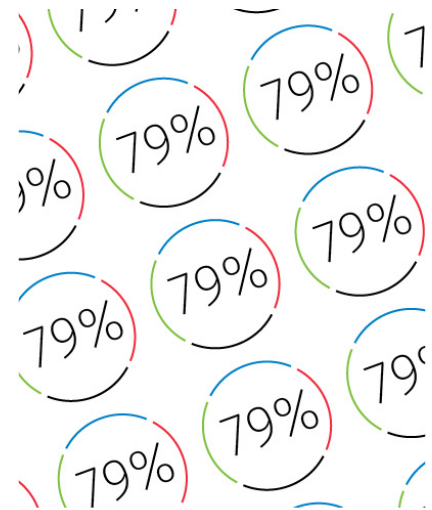
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