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## A SHED OF LIGHT IN THE DARK: First Spanish decision admitting post-grant claim limitations under article 138.3 of CPE 2000

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The Commercial Court of Granada has just handed down a Decision dated 6 July 2011 which, as far as the author is aware, has admitted for the first time a post-grant claim limitation under article 138.3 of the European Patent Convention (EPC 2000) in Spain. The Decision has been made in the context of an infringement action filed by Sanofi-Aventis against Hospira Productos Farmacéuticos y Hospitalarios S.A. (“Hospira”). In their statement of defence, Hospira filed a revocation action against two of the patents on which the infringement action was based (EP 667,771 and EP 827,745).

The first question addressed by the Judge is whether article 138.3 of EPC 2000 is self-executing or, on the contrary, it requires implementing regulations so that it may be applied by the EU’s national courts. Relying on the judgment from the Court of Appeal of Barcelona (Section 15) of 17 January 2008 (Cinfa, Kern & Alter v. Eli Lilly), confirmed by the Supreme Court in its en banc judgment of 10 May 2011, which found articles 27.1 and 70.2 of TRIPS to be self-executing, the Judge concluded that the language of article 138.3 of the EPC is sufficiently clear and unconditional as to lend itself to be applied by a national court. Also, the Judge relied on the travaux préparatoires of EPC 2000, which show that the phrase “if national law so permits” was deleted from the draft. All in all, the Judge concluded that, since the purpose of introducing article 138.3 was to harmonise post-grant claim limitations throughout the EU, and its language is sufficiently precise, it can be directly applied by a national court.

The Judge then analysed the impact of article 138.3 on the case at hand. After considering Document MR/2/00 from the travaux préparatoires of EPC 2000, the Judge noted that article 138.3 confers a legal right to owners of European patents, that is, the right to limit the claims of a European patent after grant. The Judge then highlighted that an amendment of the claims down the road may amount to changing the subject matter of the case. Thus, assuming that the limited claims are valid, in principle, the judgment to be handed down in the case will not declare the “partial” nullity of the original claims. Rather, it will declare the “total” validity of the limited claims. And the legal effects of this judgment will have retrospective effect according to article 68 of the EPC. The Judge also highlighted that once accepted, the Judge may send an order to the Patent Office so that the limited claims are registered and published in the Official Intellectual Property Gazette.

The last point considered by the Judge was how the right enshrined in article 138.3 can be reconciled with Spain’s civil process which, in principle, prevents the parties from altering the subject matter of the case while the process is under way (the so-called *perpetuatio iurisdictionis* principle). In particular, the Judge asked himself whether a limitation may be accepted even after

the initial complainant has filed its statement of defence in response to the revocation counterclaim and, as in the case at hand, when even the so-called “preliminary hearing” has taken place. For the readers’ benefit, it should be clarified that the “preliminary hearing” is a short hearing that takes place after the parties have filed all their written submissions, for the purpose of trying to narrow down the facts under dispute, admit any new evidence and prepare the main trial. In this regard, the Judge noted that international treaties trump domestic law. Therefore, if article 138.3 of an international treaty (i.e. the EPC) confers a right to individuals, the national Judge must find ways to accommodate the exercise of that right within the national procedural milieu. In this context, the Judge concluded that since article 138.3 does not establish any time limitations for the modification of the claims, the patentee is entitled to propose the limitation of the claims even after the preliminary hearing has taken place.

This decision has shed a light in the dark, since to date, the possibility of limiting claims under article 138.3 of EPC 2000 had been hotly debated among academics and in judicial circles, but no court had dared to take the first step forward. Hopefully, other courts will follow suit in future cases, which would place our practice on the same page as other countries with a long-standing post-grant amendment tradition, such as the United Kingdom, Germany or The Netherlands.

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