

# Kluwer Patent Blog

## The Danish High Court sets aside a patent as "presumably invalid" for the first time

Anders Valentin (Bugge Valentin) · Tuesday, August 28th, 2012

The pan-European litigation between Danish companies Danisco A/S (today a part of DuPont) and Novozymes A/S has been extensively reported in posts on this blog ([12/08/2011](#); [21/09/2011](#); [10/01/2012](#); [09/07/2012](#); [03/08/2012](#)). The litigation has involved Novozymes' European Patent EP 1 804 592 B1 on the manufacture of certain enzyme-containing animal food pellets. In a decision announced on 31 July 2012, the European Patent was finally revoked by the Board of Appeal of the EPO thus bringing to an end most (if not all) of this litigation (divisional utility models are still in force in Germany and in Finland).

Even though this brought the EPO opposition proceedings to an end at what appears to be record speed, this was still too late in order for the case not to provide the Danish courts with the opportunity to establish beyond doubt that patent rights can be held unenforceable in Danish PI proceedings because of the presumed invalidity of the patent-in-suit.

### Invalidity in PI proceedings

The Danish Patent Act provides that a patent can be revoked as invalid by judgment of the courts. It has for long been a subject of debate in Denmark whether this precluded, as matter of law, the Danish Enforcement Courts from considering the validity of the patent-in-suit in the context of PI proceedings, which do not result in any final judgment, and whether, in any event, it was appropriate for Enforcement Courts to consider the issue of validity in PI proceedings because of the characteristics of that type of litigation.

The only reported precedent of a Danish Enforcement Court actually refusing to grant a PI on the basis of the presumed invalidity of the patent-in-suit had been a ruling from 1976. In that case, the patent-in-suit was held unenforceable because of evidence that a third party had been selling the patented product prior to submission of the patent application under circumstances and in numbers, which had quite obviously been prejudicial to the novelty of the invention. Until the High Court's ruling in *Danisco v. Novozymes*, there had been no further examples of Danish Enforcement Courts refusing to enforce patent rights on account of the presumed invalidity of the patent-in-suit, although this has frequently been pleaded as a defense and in spite of numerous statements from Danish Enforcement Courts that it could potentially happen.

### *Danisco v. Novozymes*

In *Danisco v. Novozymes*, Novozymes had been successful in obtaining a PI against Danisco at the Copenhagen Enforcement Court in the first instance in March 2011. Danisco appealed against this

ruling to the Danish High Court (Eastern Division).

In a decision announced on 5 August 2011, the Opposition Division of the EPO decided to revoke the European Patent for want of novelty over an earlier patent application filed by Novozymes (WO 92/12645) and on account of a number of Auxiliary Requests being held lacking in inventive step. Novozymes appealed against this decision to the Board of Appeal of the EPO. This appeal had suspensive effect under Article 106 EPC, and the litigation between the parties in Denmark and other European countries could therefore continue.

In a ruling handed down on 25 May 2012, the Danish High Court had to consider whether Novozymes could enforce the Danish part of the European Patent against Danisco. The High Court noted that the European Patent had been granted by the EPO after an examination, which had included the earlier patent application filed by Novozymes. According to the High Court, this created a clear presumption in favor of the validity of the European Patent.

Noting that the examiner who had considered Novozymes' patent application prior to grant had also taken part in the Opposition Division's examination, the High Court further held, however, that the decision of the Opposition Division had weakened the presumption in favor of the validity of the European Patent. The High Court also held that it was of no significance in this respect that the Opposition Division's decision had been appealed and that this appeal had suspensive effect.

Against this background, the High Court proceeded to consider whether it could agree with the Opposition Division in finding that the invention of the patent-in-suit was in want of novelty. And, on the basis of the evidence before it, the High Court held that there likely was no novelty.

The High Court also considered whether two sets of amended patent claims contained in the Auxiliary Requests put forward by Novozymes during the proceedings before the Opposition Division and maintained on appeal to the Board of Appeal of the EPO were likely capable of allowing the European Patent to be maintained in an amended form and thus allowing the European Patent to be enforced in the Danish PI proceedings regardless of the finding of lack of novelty. In this regard, the High Court pointed out that there was no equivalent presumption in favor of the validity of the amended patent claims since they had not been considered and granted by the EPO. Quite the opposite, they had been rejected by the Opposition Division.

The High Court further noted that both parties to the proceedings had produced statements from expert witnesses, which were conflicting in their assessment of inventive step in the amended patent claims. The High Court held that, accordingly, it did not have sufficient basis for establishing that those amended patent claims were possessive of inventive step.

The High Court therefore ruled in favor of Danisco and vacated the PI, which had been granted by the Enforcement Court.

#### Comment

As noted above, this ruling from the Danish High Court is remarkable because it establish beyond doubt that the Danish Enforcement Courts can indeed refuse to enforce patent rights on account of the presumed invalidity of the patent-in-suit. It is furthermore not specified in the ruling that this can only happen where the invalidity has already been established, albeit intermittently, by the office having granted the patent-in-suit. Further cases will surely test the degree to which the presumption in favor of the validity of the patent-in-suit must have been weakened and what other factors than a ruling from the relevant patent office can be taken into consideration in that regard.

The ruling in this case is, furthermore, of interest on the point in question because the High Court appears to have attached significance to the fact that the prior art relied upon by the respondent in support of the defense of invalidity had been considered in the initial examination before grant. It is therefore an open question whether there is an equally clear presumption in favor of the validity of a patent-in-suit, when that patent is undermined by prior art that has not been taken into consideration in any administrative examination thereof.

Finally, the High Court's ruling in this case is noteworthy as it is a further example of the difficulty that Danish courts have, in particular in the context of PI proceedings, in determining points of fact when the parties rely on conflicting expert testimony. In those circumstances, the default position is quite often to let the rules determining the placing of the burden of proof decide the outcome.

Reported by Søren Christian Søborg Andersen

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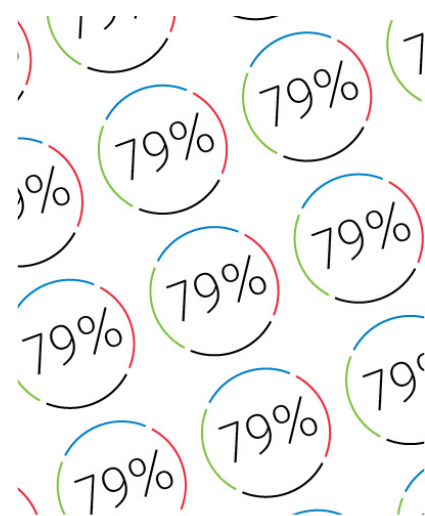
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