

Report Q189

in the name of the Hungarian Group
by Marcell KERESZTY, Judit KERÉNY, Attila MÁNDI, Imre MOLNÁR,
Tivadar PALÁGYI, István POLGÁR, Éva SOMFAI and Zsolt SZENTPÉTERI

Amendment of patent claims after grant (in court and administrative proceedings, including re-examination proceedings requested by third parties)

Questions

- 1) *Does your national law permit post-grant amendment of patent claims? Are utility models – if available – treated the same way as patents or differently? If so, what are the differences?*

Both Hungarian Act No. XXXIII of 1995 on the Protection of Inventions by Patents (in the following referred to as HPA) and Hungarian Act No. XXXVIII of 1991 on the Protection of Utility Models (in the following referred to as HUMA) permit post grant amendment of patent claims by means of revocation proceedings and by means of surrender. Patents and utility models are treated the same way in this respect. [HPA Art. 41, 42 and 80, HUMA Art. 21 and 36(1)]

- 2) *Who is entitled to request post-grant amendment of patent claims under your national law?*

A patent owner is not entitled to request post grant amendments in the framework of revocation proceedings against her/his own patent.

Apart from this,

- any person may institute proceedings for revocation of a patent based on unpatentability (lack of novelty, inventive step or industrial applicability, or non patentable subject matter), insufficient disclosure and new matter; and
- only the natural or legal person entitled to the patent but not being registered as owner may institute proceedings for revocation of a patent granted to another natural or legal person who is not entitled to be registered as owner. [HPA Art. 80(1), (2)]

A patent owner may surrender the entire patent protection or some of the claims by means of a written declaration filed with the Hungarian Patent Office. [HPA Art. 41]

- 3) *What is the procedural framework for requesting post-grant amendment of patent claims under your national law, in particular:*

- *What procedures (judicial, administrative or other) are available for dealing with requests for post-grant amendment of patent claims under your national law?*

As referred to in above points 1) and 2), post-grant amendment of patent claims by third parties is only possible in the framework of revocation proceedings. Revocation of a patent may be requested without time limit. In the revocation proceedings the Hungarian

Patent Office brings a decision on the revocation, limitation or refusal of the request. This decision is appealable, second and third instances are the Metropolitan Court and the Court of Appeal of Budapest, respectively.

The only way for a patent owner to effect post-grant amendment of patent claims is to surrender (i.e. delete) one or more claims. Surrender is acknowledged by the Hungarian Patent Office. No withdrawal of the surrender is possible.

- *Are all of these procedures freely available under your national law to those wishing to request post-grant amendment of patent claims, or does the law give priority to certain procedural measures in certain situations?*

With the limitation of point 2) above, all of the above procedures are freely available to those wishing to request post grant amendment of patent claims.

- *Is it possible under your national law for patentees to make multiple subsequent amendments of patent claims directed towards individual alleged infringers?*

Multiple subsequent procedures, accordingly subsequent amendments of the claims are possible. However, all amendments have an erga omnes effect.

- *Who is entitled to amend claims? Is this limited to courts or do also the patent offices have the competence to amend claims?*

Please limit the answer to a general description of the proceedings avoiding discussion of procedural details and peculiarities.

In the first instance of revocation proceedings the Hungarian Patent Office has the competence to amend claims. Upon an appeal, in the second instance the Metropolitan Court of Budapest and in the third instance the Court of Appeal of Budapest have the competence to effect such amendments.

In the case of a surrender the Hungarian Patent Office has exclusive competence.

- 4) *What are the substantive conditions for allowing post-grant amendment of patent claims under your national law, in particular:*

- *Is there a distinction in your national law between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?*

With regard to remedies, we refer to the next answer. With regard to substantive conditions, we refer to point 2) above.

- *In what ways may patent claims be amended post grant under your national law?*

In the case of a revocation any kind of amendments (e.g. deletion of claims, combination or addition of features, drafting new claim), are possible, but the scope of protection of the amended claims has to be within and narrower than the scope before amendment.

In the case of surrender claims can be deleted, only.

- *Is it a requirement (or a possibility) under your national law that the description/specification be amended to correspond with amendments of the claims?*

There is no such requirement under Hungarian law, however, it is not prohibited either. Practice shows that such harmonisation of the specification is generally not effected.

- *Is it possible to make amendments for the purposes of clarification and/or correction of errors?*

Making amendments for the purposes of clarification or correction of errors is not possible, however, correction of clerical errors in the letters patent document in relation to the text as granted is possible by Errata. This latter correction can be initiated by anyone without time limit. The Hungarian Patent Office has the competence to effect such amendments.

5) *What are the consequences for third parties of post-grant amendments of patent claims under your national law, in particular:*

- *What are the consequences for third parties' liability for patent infringement where patent claims are amended post grant?*

Amendments resulting from revocation make the scope of protection narrower. Such amendments are effective *ex tunc*, i.e. third parties are liable for patent infringement only if being within the narrowed scope.

In the case of a surrender, the day following the receipt of the surrender or an earlier date specified by the patent owner will be the date of amendment. Third parties are liable for infringing activities according to the scope of protection applicable on the date of the given activity.

- *Are amendments effective only **inter partes** or, conversely, **erga omnes**, including in relation to previously decided cases?*

Amendments are effective *erga omnes*. There is no case law concerning the effects of amendments in relation to previously decided cases.

- *Are amendments effective only **ex nunc** or also **ex tunc**? Does that depend on the context in which the amendment is made?*

Amendments resulting from revocation are effective *ex tunc* independently of the context in which the amendment is made. Amendments resulting from surrender are effective *ex nunc* (see above).

II) Proposals for substantive harmonisation

The Groups are invited to put forward their proposals for adoption of uniform rules, and in particular to consider the following questions:

6) *Should post-grant amendment of patent claims be permitted?*

Yes.

7) *Who should be entitled to request post-grant amendment of patent claims and who should have the competence to amend?*

Patent owners and third parties should be entitled to request post-grant amendment of patent claims. Generally, in the first instance authorities responsible for grant, i.e. the Industrial Property Offices, should have the competence to amend. If amendment is requested in the framework of an infringement proceeding, also the court should have the competence to amend.

8) *What should be the substantial conditions for allowing post-grant amendment of patent claims?*

Unpatentability (lack of novelty, inventive step or industrial applicability, or non patentable subject matter), insufficient disclosure, new matter and granting to one not entitled should be substantial conditions.

- 9) *Should there be a distinction between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?*

No distinction should be between the remedies available to and substantive conditions applicable to patentees and third parties. However, the last substantive condition in point 8) above should be available to relevant third parties, only (see point 2) above).

- 10) *What should be the consequences for third parties' liability for patent infringement where patent claims are amended post grant?*

See point 5), answer to the first question.

- 11) *Does your Group have any other views or proposals for harmonisation in this area?*

N/A

Summary

Post-grant amendment of patent claims should be permitted for both patent owners and third parties. The scope of protection of the amended claims has to be within and narrower than the scope before amendments. Amendments based on substantive conditions should be effective *ex tunc*, and *erga omnes*. In the case of a surrender, the patent owner should have the possibility to specify an earlier date from which the amendment is effective.

Résumé

L'amendement des revendications après l'accord du brevet devrait être permis aussi bien aux titulaires du brevet qu'à des tiers. L'étendue des revendications amendées doit se situer à l'intérieur de l'étendue préalable à l'amendement, et elle doit être plus restreinte que celle-ci. Des amendements basés sur des conditions substantielles devraient prendre effet *ex tunc* et *erga omnes*. En cas de renonciation, le titulaire du brevet devrait avoir la possibilité de spécifier la date à partir de laquelle l'amendement prend son effet.

Zusammenfassung

Änderungen der Patentansprüche nach dem Inkrafttreten sollten sowohl für den Patentinhaber wie auch für Dritte zulässig sein. Der Schutzzumfang des geänderten Anspruchs soll innerhalb des vor der Änderung gültigen Schutzzumfanges liegen und enger sein als dieser. Auf meritorische Bedingungen gegründete Änderungen sollen *ex tunc* und *erga omnes* gültig sein. Im Fall des Verzichtes auf einen oder mehrere Ansprüche soll der Patentinhaber die Möglichkeit haben, ein früheres Datum des Inkrafttretens der Änderung zu bestimmen.