

Limitation of the claims of a granted patent

A granted patent may be limited on request by the owner basing on art. 105*bis, ter, quater* of the EPC 2000 for a European patent and on articles 56.1 and 79.3*bis* of the Italian IP code for the Italian portion, and on the corresponding dispositions of articles 79.1 and 2 of the Italian IP Code for a national patent.

A thorough study on this relevant subject is in course by prof. Giuseppe Sena. We point out two recent statements dealing with the most controversial aspects.

With decision n. 21402 of 14 August 2019 the Supreme Court has faced the issue of the retroactivity of such limitation in the case of a European patent.

The Supreme Court has affirmed that, based on the provisions in the EPC 2000 (otherwise referred to as CBE in the decision), which correspond to those of the IP Code, it can be maintained that the effects of the limitation start on the date of publication of the patent “*as if it was granted with that limitation*”.

To overcome the recurring doubts in previous case law, the Supreme Court has provided useful indications consisting in keeping separate “*the term from which the decision by the EPO (on the limitation) shall take effect – which, as per art. 105*ter*, paragraph 3 CBE, is on the publication date of the its mention in the European Patent Bulletin – and the material content of such effect, which is given by the limitation ex tunc of the patent*”.

With a very interesting decision issued on 17 May 2019, the Milan Court of Appeal has instead dealt with the different issue of the admissibility of the limitation of the claims of the granted patent.

Such decision affirms specifically that the so-called “double limit” within which the limitation of the claims of the granted patent is admissible, or rather a so limited patent is valid.

The Court states that “*as one can see from reading the rule (in that case since it dealt with a national patent, art. 79.3 of the IP Code) there is a double limit to respect: the first one regards the source of the information to integrate the claims and is identified in the content of the initial application, in this way precluding the possibility to add a completely new matter, the second one regards instead the subject matter of the patent with consists in the extent of protection conferred by the original claim*”.

Furthermore, with a clarification, apparently in conflict with the prior case law of the Milanese Tribunal on the subject, the Court adds that the “*description, together with the drawings, may serve to interpret the claims, without however the possibility to make additions or integrations*”, recognizing giving only to the interpreter but not to the owner during the limitation of the claims of the patent granted, the faculty to avail of such elements.

Both of these decisions are particular interesting in that they deal with issues on which the trend in jurisprudence is anything but univocal.