

PATENT PROTECTION STRATEGY IN FRANCE

THE REVISION OF THE FRENCH PATENT LAW

Duration of the utility certificate (into force since January 10, 2020)

The duration of French utility certificates has been increased to 10 years from the filing date (it was only 6 years before) and this applies to existing utility certificates not yet expired.

Possible conversion of a utility certificate application into a patent application (into force since January 10, 2020)

A utility certificate application may be converted into a patent application by simply filing a request therefore at the French patent office within 18 months from the filing or priority date. The official fee for search report, which is compulsory for patent applications, must be paid within one month from the conversion date.

Enhanced examination of patent applications (into force as from 22 May 2020)

French examiners will have the possibility to issue a rejection decision:

- not only when the patent application is not relating to a technical invention (which was already the case before the new law)
- but also if the invention does not involve an inventive step or is not new
- or if the invention is not susceptible of industrial application

The applicant will have the possibility to challenge the rejection and file amended claims, to convince the examiner of the patentability of the invention.

However, if the examiner maintains his position, the patent application will be definitively rejected by an administrative decision of the French Patent Office.

This administrative decision can only be challenged by appealing to the Paris Court of Appeal. As a last resort, a further appeal before the Court of cassation will still be possible after the decision of the Court of appeal.

Possible post grant opposition (into force before July 2020)

When this procedure is introduced, third parties will have the possibility, within a specified time, to request from the French Patent Office, the revocation of a granted patent. It will be possible to challenge the administrative decision of the Office before an appeal body, created within the Office.

HOW CAN A FOREIGN APPLICANT BENEFIT FROM THE NEW FRENCH PATENT LAW?

Cumulative filing of a French certificate of utility and a European patent application

A French certificate of utility can be granted in about one year without substantive examination; the French patent office only checks whether the invention is of technical nature and not a pure business method or software.

Since the maximum duration of a French utility certificate is now ten years, the invention may be protected in France during the entire pendency of a parallel European application, and even during the entire duration of a potential opposition procedure before the EPO (including appeal)

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It could therefore be advisable to file simultaneously an application for a French utility certificate and a European patent application.

The cost of filing such a French utility certificate is low (26 euros official fee). The only substantive costs are for the translation into French.

In case of an infringement in France, the infringer may be sued before the Paris first instance Court on the basis of the French utility certificate. A search report has to be requested at the French patent office and handed to the first instance Court. The Court, after receipt of the search report, may take a decision within one year, including a possible preliminary injunction.

A court decision could therefore be obtained in France without waiting for the grant of the parallel European patent.

When the parallel European patent has been granted (or after completion of an opposition procedure), the French utility certificate may be maintained, if for example the scope of the claims is broader. This allows to sue an infringer on the basis of the French certificate of utility (if still in force), together with the French part of the European patent and increases the chances of a favourable decision.



Contact us:

For any question you may have, please do not hesitate to contact our team.



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