

IP Alert – 22 May 2019: Amendments of some IP law provisions in France

A new law has been passed in France aiming to strengthen the innovation capabilities of French industry.

Some sections of the law are devoted to industrial property and significantly modify the administrative procedures for patents and utility certificates as well as the provisions relating to the status of limitation of legal proceedings relating to IP rights.



A. Enhanced examination of novelty and inventive step for patent applications (in force on May 22, 2020)

The new provisions lead to a fundamental change in the procedure for issuing French patents.

Until now indeed, the French Patent Office (INPI) did not have the possibility of rejecting a patent application for lack of inventive step or novelty of the invention (except for very rare cases of "manifest" lack of novelty).

French patents were therefore issued without real patentability examination, only the courts being responsible for this examination in the event of a judicial action for nullity or for infringement.

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, for convincing 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.

IP Alert – 22 May 2019: Amendments of some IP law provisions in France

B. Opposition proceedings against a granted patent (in force after the promulgation of a further law, to be enacted in the future)

The new law provides for the future introduction of a post grant opposition procedure for French patents.

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.

Of course, this opposition procedure will not modify the existing court revocation procedure which will still be opened before the Tribunal de grande instance of Paris with a possible appeal before the Paris Court of Appeal.

This court revocation action is not subject to any limitation period. In other words, the revocation action can be initiated during the entire duration of the patent (and even after if a question of responsibility arises), while the opposition will have to be formed in a short time after issuance of the patent.

C. Amendments to the utility certificate (effective 2020)

The maximum duration of the French utility certificate will be extended to 10 years from the filing date, instead of 6 years.

A possibility of transforming a utility certificate application into a patent application will be further organized by a future regulation.

These amendments will come into force at the latest one year after the publication of the new law, i.e. by 22 May 2020.

D. Modification of status of limitation for court actions (effective immediately)

The law specifies that all revocation actions for patents, trademarks, designs and plant variety certificates are imprescriptible.

In other words, third parties may apply for revocation of these rights before a court at any time and for the duration of their validity.

This clarification became necessary after a 2008 reform shortening the duration of the prescription in civil actions for nullity in general.

In addition, the new law modifies the starting point of the five-year period during which infringement actions may be lodged against patents, trademarks, designs or plant variety certificates as well as actions relating to breach of trade secrets.

This starting point is henceforth the day when the rightholder knew or ought to have known the last fact enabling him to exercise the action.

IP Alert – 22 May 2019: Amendments of some IP law provisions in France

Such a starting point for the limitation period, set at an uncertain date, may be difficult to establish for both the owner of the industrial property right and the alleged infringer. It will now be necessary to provide convincing evidence to justify the fact that the action is not prescribed.



Contact us:

For any information, do not hesitate to contact our team. We will not fail to inform you again as soon as the details necessary for the entry into force of some of these new provisions become known.



Caroline Casalonga
Paris Office
Partner
Attorney at Law



Olivier Delprat
Paris Office
Partner
French & European Patent
Attorney



Gwennaëlle Le Roy
Paris Office
Partner
French & European Patent
Attorney



Julien Thon
Grenoble Office
Partner
French & European Patent
Attorney



Jean-Baptiste Lecoeur
Paris Office
Partner
French & European Patent Attorney



Virginie Martin-Charbonneau
Paris Office
Partner
French & European Patent Attorney



Francis Zapalowicz
Paris Office
Partner
French & European Patent Attorney

PARIS: 5/7 & 8 avenue Percier, 75008 Paris, France

Tel: +33 (0)1 45 61 94 64 - Fax: +33 (0)1 45 63 94 21 - [E-Mail: paris@casalonga.com](mailto:paris@casalonga.com)

GRENOBLE: 7 Chemin des Prés ZIRST 7703, 38944 Meylan cedex, France

Tel: +33 (0)4 76 90 22 25- Fax: +33 (0)4 76 90 19 96 - [E-Mail: genoble@casalonga.com](mailto:genoble@casalonga.com)