

22 May 2019: Amendment 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 modify the provisions relating to the status of limitation of legal proceedings relating to IP rights as well as the administrative procedures for patents and utility certificates.



A. 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.

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.

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

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

22 May 2019: Amendment of some IP law provisions in France

C. 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.

D. 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.



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



Arnaud Casalonga
Paris Office
Partner
Attorney at Law



Marianne Gabriel
Paris Office
Partner
Attorney at Law



Floriane Codevelle
Paris Office
Partner
Attorney at Law

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)