



Patents

in 38 jurisdictions worldwide

2012

Contributing editor: Stuart J Sinder



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Patents 2012

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Patents 2012
Published by
Law Business Research Ltd
87 Lancaster Road
London, W11 1QQ, UK
Tel: +44 20 7908 1188
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ISSN 1742-9862

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Printed and distributed by
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Tel: 0844 2480 112

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Patent enforcement proceedings

1 Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

According to the French Intellectual Property Code, the patentee may enforce its rights by instituting civil or criminal proceedings, though criminal proceedings are very seldom used.

The District Court of Paris has exclusive jurisdiction for any litigation relating to patents and related unfair competition questions. An IP hub comprising four chambers for the first instance and two chambers for the Court of Appeal specialising in IP matters has been created in recent years.

The Court of Cassation is the highest jurisdiction that has jurisdiction to decide on matters of law to ensure a uniform body of case law

2 Trial format and timing

What is the format of a patent infringement trial?

The trial is rather short, as most of the cases take half a day and, exceptionally, one full day. The counsel (attorney at law) argues the case orally, based on the arguments developed in the written briefs exchanged between the parties and the documents: evidence and expert reports provided during the written proceedings. No live testimony or cross examination takes place.

The issue is decided by a panel of three judges.

3 Proof requirements

What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The patentee has the burden of proof of the infringement. The proof of the infringement may be provided by any means of civil law. The French IP Code has provided, since almost the first Patent Law, the infringement seizure (*saisie contrefaçon*). The seizure is the most common way in France to afford the proof of infringement and is used in more than 90 per cent of the cases.

4 Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

The patentee or the exclusive licensee may sue for infringement. The exclusive licensee may bring the action for infringement, under the condition that it can provide evidence that the patent holder did not wish to sue himself or herself.

The non-exclusive licensee can join the infringement proceedings to obtain compensation of its own damages.

An accused infringer may start a declaratory action for non-infringement under the following conditions:

- he or she affords the evidence that he or she works the patent in one member state of the EU or makes effective and serious preparatory work to that effect,
- he or she invites the patentee to take a position opposing his or her title against the exploitation described by him or her;
- if the alleged infringer does not agree with the answer or if the patentee does not answer within a time limit of three months.

5 Inducement, and contributory and multiple party infringement

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

The French IP code prohibits contributory infringement. Any person delivering or offering to deliver to a third party not entitled to work the patented invention, without the consent of the patentee, or the means for implementing, on French territory, the patented invention with respect to an essential element may be sued for contributory infringement.

The patentee will have to provide evidence that the third party knows, or it is obvious from the circumstances, that the means supplied are suited and intended for carrying out the patented invention.

French Law does not provide for joint liability in the case of each third party practising only some of the elements, all the parties together must practise all the elements.

The key element is that the third party should supply means to carry out an essential element. Several third parties may, however, be jointly condemned if they take part in the same delivery or offer of means (for example, the manufacturer, the retailer and the seller).

In the case of staple commercial articles, the patentee will have to provide the proof that the person delivering those means induced the third party to commit infringing acts.

6 Joinder of multiple defendants

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing the same patents?

Multiple parties can be joined as defendants in the same lawsuit. The requirement is that they are involved in the same infringement. For example, French courts have condemned the manufacturer for infringement, the printer of the notice announcing the infringement, the retailer and the supermarket selling an infringing product.

The court may compel the different parties to commonly pay the damages, meaning that if one party does not pay, the other parties will have to pay the total sum.

7 Infringement by foreign activities

To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

A foreign manufacturer who provides the infringing devices to the French market or to an importer of the French market may be sued for infringement. This will depend on the circumstances. In a recent decision the Court of Appeal decided that a US company manufacturing devices in the US and providing the devices to a European subsidiary in the Netherlands for importation into France was an infringer.

8 Infringement by equivalents

To what extent are 'equivalents' of the claimed subject matter liable for infringement?

To determine an infringement, the French courts use the term of 'means', which encompasses any technical feature and thus either the process or product features.

'Means' are characterised by their form or structure, the function they fulfil, and this is also categorised as the first or immediate result and the technical result that is enabled to be achieved, namely, the final result.

According to French case law, two means are considered to be equivalent if, despite their different form or structure, they fulfil the same function in order to provide a result of the same nature or to the same degree.

9 Discovery of evidence

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

French IP Code or Case Law does not foresee a discovery procedure. The way to gather evidence of the infringement is the seizure for infringement where the patentee can obtain proof of the infringement.

In case of a pending action, the court may order, under penalty, the production of any document or information detained from the defendant or by any person who was found to be in possession of infringing products, carrying out the infringing process, providing services in infringing acts or was cited as an intervening party in the production, the manufacture or the distribution of those products, process or service provider, in order to determine the origin and the distribution network of the infringing products or processes.

10 Litigation timetable

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

The duration of litigation is approximately 18 – 24 months in the first instance and slightly less in the appeal. It may also be faster; we recently succeeded in obtaining a final decision by the Court of Appeal approximately 18 months after instituting the proceedings in the first instance.

11 Litigation costs

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal?

The range of costs in first instances varies between €50,000 and €150,000, the same applies for appeals.

12 Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit?

The proceedings before the Court of Appeal is a *de novo* case, meaning that the Court of Appeal is not bound by the arguments, documents or evidence provided in the first instance.

13 Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition or a business-related tort?

The patent owner may be sued for unfair competition at different levels:

- before the suit: the patentee should take care by drafting the warning letter and avoid stating that there is an infringement before any court decision or by contacting the clients of the alleged infringer;
- by launching a frivolous suit based on a patent clearly invalid; and
- by taking, during the seizure, documents or information not related to the patent.

14 Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Alternative dispute resolution is available under French law. Different organisations providing alternative dispute resolutions exist in France such as the International Chamber of Commerce, the Paris Arbitration Chamber in addition to WIPO or other foreign organisations; the Court of Appeal has judged that an arbitration chamber could rule on the validity of a patent by declaring the patent non-enforceable. The effect of the ruling has, however, only an *inter partes* effect and is not binding to third parties.

Scope and ownership of patents**15 Types of protectable inventions**

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

The French IP Code foresees the possibility of protecting an invention by a patent having a duration of 20 years, a Certificate of Utility having a duration of six years and a Supplementary Protection Certificate for Medicament and Phytosanitary products, for a maximum period of five years after the expiry of the basic patent and 15 years from the marketing authorisation of the Medicament or the Phytosanitary product.

The conditions are that the subject matter is an invention, having an industrial character, being new and inventive.

The following are excluded as not being inventions:

- discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts and playing games;
- business methods; and
- software per se.

The following are excluded as being unpatentable:

- therapeutic or surgical treatments of the human or animal body;
- diagnostic methods applied to the human or animal body;
- an invention, if the commercial use of it would be contrary to human dignity, public order or morality;
- plant or animal varieties;
- the human body at different stages of its constitution and development;

- the discovery of the total or partial sequence of a gene;
- cloning of humans;
- modification of the genetic identity of humans;
- use of human embryos for an industrial or commercial use; and
- total or partial sequences of genes per se.

16 Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor or multiple inventors? How is patent ownership officially recorded and transferred?

The invention belongs to the inventor or his or her successor in title.

The French IP code distinguishes two types of employees' inventions: the inventions corresponding to an inventive 'mission' of the employee and other inventions, as following:

- for the 'inventions of mission', they belong to the employer. The inventor has the right to get an additional remuneration determined by collective labour agreements, company agreements and individual employment contracts; and
- for the other inventions, they belong in principle to the employee with one restriction, when the invention was made by the inventor during the execution of his or her functions, or in the field of activity of the employer by using its knowledge of the technical fields or the technique or specific means of the employer. In such a case the employer has the right to have those inventions assigned to him or her. The employee is entitled to a fair price.

Defences

17 Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

Actions of invalidity are the exclusive jurisdiction of the Paris Court. A nullity action may be filed as a main claim before any infringement action or as a counterclaim in the course of an infringement action.

A patent may be declared void:

- for lack of patentability, that is, not being an invention, no industrial application, lack of novelty or lack of inventive step;
- for insufficiency of disclosure;
- for extension beyond that of the application as initially filed or beyond the scope of the patent as granted; and
- for non-entitlement of the patent owner; the Court of Cassation (Supreme Court) recently decided that this last ground could only be raised by the original owner and that the effect of the decision had an inter partes effect.

18 Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

There is an absolute novelty requirement with two exceptions:

- an evident abuse in relation to the applicant or his or her legal predecessor; and
- an international exhibition recognised by an international convention.

19 Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The invention shall not be obvious to a person skilled in the art with regard to the prior art.

20 Patent unenforceability

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

There is no specific provision under French law with regard to unenforceability. The only reasons are lack of patentability, namely, an invalid patent cannot be enforced or in the case of unlawful ownership of the claimant, as the patentee has no right to sue.

21 Prior user defence

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

The IP Code contains provisions with regard to prior personal use. Any person who was in good faith in possession of the invention or subject matter of the patent before the filing or priority date, has the right to work the invention notwithstanding the patent right. French case law requires only the knowledge proven by notebooks and documents and does not require the previous working.

Remedies

22 Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature?

Monetary remedies or damages are based on the Civil Code according to which any fact that causes damages, shall be repaired by the person who caused it by its fault.

According to the IP Code amended in 2007, in order to determine the amount of damages the court shall take into consideration the negative economic consequences including the lost profit of the patentee, the profits made by the infringer and the moral prejudice, if any.

Alternatively, the courts may allocate a lump sum to the patentee that cannot be lower than the royalties that would have been due in the case of the infringer requesting the authorisation to use the rights that have been infringed. Usually the licence rate applied by the court is slightly higher than the rate applied to an amicable licence.

The statute of limitation is three years back from the launch of the litigation. This means that the damages start to accrue three years before the start of the infringement suit.

Punitive damages are not provided by the law, even if the the use of a higher royalty rate may in some way be considered as punitive.

The court may also order the payment of publication costs in newspapers.

23 Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

The IP Code provides for interim and permanent injunctions.

Interim preliminary injunctions can be obtained in inter partes or in ex parte proceedings.

Any person having the authority to act on an infringement may obtain interim measures against an alleged infringer or intermediary persons (a supplier for example), which are used against the alleged infringer to prevent an imminent infringement or the continuation of infringing acts. The only condition is that the patentee affords the evidence that it is likely that there is an infringement or that the infringement is imminent. The courts, in determining the likelihood, tend also to take into account the apparent validity of the patent.

Ex parte interim injunction may be ordered in the case that the circumstances make it necessary that the measures are not taken in inter partes proceedings or if any delay would generate an irreparable prejudice.

The patentee will have to initiate proceedings on merit within a time period of 20 working days or 31 calendar days.

24 Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Custom seizures are based on the Council Regulation of the EU. This procedure is relatively seldom used in patent matters as compared to trademark or design matters.

The patentee may file a request of intervention with the customs authorities. In the case of withholding or suspension with the customs of the alleged infringing goods, the patent owner has 10 working days to inform the custom authorities that a suit has been filed to determine the infringement.

25 Attorneys' fees

Under what conditions can a successful litigant recover costs and attorneys' fees?

The court may order the payment of the attorney's fees, which some years ago were nominal but in recent years take into account the costs of the litigation. Sums in the range of €150,000 to €300,000 are now current. The patentee will have to provide the bills of their attorney at law and IP attorney.

26 Wilful infringement

Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate?

In civil proceedings there are no additional remedies available, except that the court may be influenced by the behaviour of the infringer in allocating a higher amount of damages.

Wilful infringement is required in criminal proceedings and may be sentenced by three years imprisonment and a €300,000 fine. The standard is in most cases based on the repetition of infringing acts after a first condemnation by a civil court.

27 Time limits for lawsuits

What is the time limit for seeking a remedy for patent infringement?

The statute of limitation is three years. This means that the patentee cannot sue an alleged infringer for acts committed more than three years before the launch of the suit. As mentioned under question 22, the damages will also be limited by this three-year limitation.

28 Patent marking

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

Patent marking is not required by French law. There are therefore no consequences on the determination of the infringement and the damages.

On the contrary, false marking may fall under the scope of unfair competition. A third party using false marking to compete with a patentee may be sued and condemned for unfair completion.

Licensing

29 Voluntary licensing

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

The patentee must take into consideration the Competition Rules either of France or of the EU.

In particular, the agreements between innovator pharmaceutical companies and generic companies are checked by the competition authorities.

30 Compulsory licences

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

The IP Code provides the possibility of compulsory licences, which are very seldom used.

The applicant for a compulsory licence has to provide the following evidence:

- it was unable to get an amicable licence from the patent owner; and
- it is in a position to work the invention in an effective and serious manner.

The terms of the licence will be determined by the court and based on a reasonable royalty in the technical field concerned, with an obligation to work the invention.

Patent office proceedings

31 Patenting timetable and costs

How long does it typically take, and how much does it typically cost, to obtain a patent?

The duration of the proceedings before the French patent office is around three to four years from the filing date. There is no full examination on the merits. A prior art search is carried out by the EPO on behalf of the French patent office.

The examiner investigates whether there is support in the description of the claim, that the subject matter does not relate to non-patentable matter (software, therapeutic or surgical treatment, aesthetic objects, etc) and whether the invention as claimed is novel over the prior art cited.

The costs are around €1,500 to €5,000 depending on the technical field and difficulty and scope.

32 Expedited patent prosecution

Are there any procedures to expedite patent prosecution?

There is no expedited procedure, an applicant may request an accelerated procedure by basing it on possible infringing acts.

33 Patent application contents

What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

There are no specific conditions under French law for drafting a patent application. The invention shall be disclosed in a manner sufficiently clear and complete so as to enable the person skilled in the art to reproduce the invention.

In the pharmaceutical field it is advisable to disclose the therapeutic use in a precise way, it is not sufficient to mention the therapeutic use. It is necessary to specify the disease, the way of administration and the dosage.

For gene sequences, the scope is limited to the specific function disclosed in the patent.

34 Prior art disclosure obligations

Must an inventor disclose prior art to the patent office examiner?

According to the IP Code, the examiner may request the applicant to cite prior art cited in foreign corresponding proceedings.

35 Pursuit of additional claims

May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

Additional claims disclosed in an earlier application may be protected by filing divisional applications. There is no limit, except that the parent application shall be pending at the time of filing the divisional. It is possible to file a divisional from a divisional.

The only condition is that the application should not extend beyond the scope of the parent case.

Additional claims may be prosecuted in a new application under the condition that their subject matter is novel, if the later application is filed before publication of the earlier application. For example, if an earlier application discloses a generic formula, a later application may be filed on a specific compound falling under the generic formula but not specifically disclosed.

36 Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

It is possible to file an appeal before the Court of Appeal of Paris against any adverse decision of the Patent Office. The Paris Court of Appeal has exclusive jurisdiction in those matters.

37 Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

French Law does not provide any mechanism for opposing the grant of a patent. Nevertheless, a third party may file observations citing documents against the patentability of the invention. Those observations may lead to the rejection or the limitation of the patent if they are novelty destroying.

38 Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

There is no specific regulation with regard to priority disputes. The Paris Convention applies for determining the priority. The priority is based on the first application of the applicant. If two applicants claim the same invention with the same priority, the patent office will grant two patents for the same invention, as none is prior art.

Update and trends

The most important development in recent years is the passage from 10 jurisdictions to one jurisdiction having competence in patent matters, namely the Paris courts (District Court and Court of Appeal) and the creation of a specialised IP hub.

The trend of the courts is to grant easier preliminary injunctions and even ex parte injunctions.

The amount of damages granted to the patentee in the case of infringement has increased as they may be based on the profit of the infringer, and the grant of reimbursement of the costs is now closer to the reality.

The Paris court also recently granted damages to be paid by the patentee in the case of a preliminary injunction and was overturned on the merits due to the invalidity of the patent. If preliminary injunctions are now more easily granted, care has to be taken for the enforcement as, by enforcing those injunctions, the patentee may be condemned to pay the lost profits to the alleged infringer.

Limitation proceedings in the case of infringement actions or before launching infringement actions is more and more used by the patentees.

39 Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

There is no procedure for modifying, re-examining or revoking a patent before the Patent Office.

The patentee has, however, the possibility to abandon a patent partially or totally or request a limitation. The Patent Office in the case of a limitation request will not examine the merit of the new claim but check whether the limited claim constitutes a limitation and not a mere rewording and whether it does not go beyond the application as filed and beyond the patent as granted.

40 Patent duration

How is the duration of patent protection determined?

The duration of 20 years of a patent is determined from the filing date. There is a possibility of extension in the case of pharmaceutical or phytosanitary products by filing SPCs (Supplementary Protection Certificates).

An SPC should be limited to the scope of the product, subject matter of an authorisation to market the medicament or to a homologation for phytosanitary products. The duration cannot exceed five years from the expiration of the basic patent and 15 years from the grant of the first marketing authorisation or homologation in the EU.



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