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Limitation of the claims of the French designation of a European patent: an option even during opposition proceedings?

Isabelle Romet (Véron & Associés) · Friday, September 18th, 2015

Since 2011, it has been clear in France that the possibility for patent owners to request before the French patent office a limitation of the claims of a granted patent, offered by article L. 613 24 of the French Intellectual Property Code (“IPC”) since 1 January 2009, applies not only to the claims of French patents but also to the claims of the French designation of a European patent: this point was clarified by a decision of the cour d’appel de Paris, Pole 5, chamber 2, 1 July 2011, *Teva v. Eli Lilly*.

In its decision of 26 June 2015, between Honeywell and Arkema, the *cour d’appel de Paris*, Pole 5, Chamber 2, states that the limitation of the claims of the French designation of a European patent remains possible even if the European patent is the subject matter of an opposition pending before the European Patent Office (“EPO”).

This decision can be seen [here](#) as well as its English [translation](#).

Context

The decision explains the context in which the patent owner, Honeywell, filed a claim limitation request with the French patent office:

- on the one hand, Honeywell was the defendant in the nullity proceedings commenced by Arkema against the French designation of Honeywell’s European patent ? 1 716 216: the discussion pending before the *tribunal de grande instance de Paris* related to the claims as granted;
- on the other hand, opposition proceedings were pending before the EPO: the discussion, in Munich, related not only to the granted claims but also to the amended claims of auxiliary requests;
- the French court refused to stay the French nullity proceedings;
- in this context, a limitation of the granted claims of the French designation of the European patent at issue was a way to discuss more similar claims before the French court and the EPO.

The Director of the French patent office accepted Honeywell’s claim limitation request and Arkema lodged a recourse against this decision before the *cour d’appel de Paris*.

Legal arguments raised by Arkema

Arkema mainly argued that the Director of the French patent office, in the first place, and the *cour*

d'appel de Paris, on appeal, should apply Article 105 bis § 2, of the European Patent Convention (“EPC”), according to which a claim limitation cannot be filed before the EPO while opposition proceedings are pending in respect of the European patent at issue.

In support of this submission, Arkema notably argued that:

- Article 105 bis EPC is mentioned in Article L. 614 12 of the French IPC;
- the EPC is directly applicable in France, in particular its Article 105 bis about limitation and its Article 138 about the nullity grounds to which Article L. 614 12 IPC refers;
- Article R. 613 45 IPC, which lists the requirements applicable by the French patent office to claim limitation requests without referring to opposition proceedings pending before the EPO, is not exhaustive and its regulatory provisions cannot prevail over the statutory provisions of Article L. 614 12 IPC and the international provisions of Article 105 bis EPC.

Arkema also argued that the limitation of the claims of the French designation of a European patent during an opposition pending before the EPO would create unacceptable practical difficulties and legal uncertainties harmful to third parties’ security in case of differences between the claims limited for France and those resulting from the opposition.

Decision of the *cour d’appel de Paris*

The *cour d’appel de Paris* rejected Arkema’s recourse and followed the arguments put forward by Honeywell.

First of all, the *cour d’appel de Paris* found that Article 105 bis § 2 EPC, which excludes centralised limitation proceedings in case of opposition pending before the EPO, is not applicable by the French patent office to the claim limitation requests relating to the French designation of European patents; in this respect, the *cour d’appel de Paris* followed Honeywell and noted that Article L. 614 12 IPC refers to the whole Article 105 bis, including its § 1 which states that the claim limitation request is filed with the EPO.

The court also adopted Honeywell’s argument that there is no provision, whether in European or national rules, providing for the application of Article 105 bis EPC by the French patent office or the French courts (the situation is different for Article 138 § 1 EPC, also quoted by Arkema, since its application in France is provided for by Article L. 614 12 IPC).

Following Honeywell again, the *cour d’appel de Paris* held that the requirements for a claim limitation are exhaustively listed by Article R. 613 45 IPC, which means that the Director of the French patent office cannot create any other grounds for refusal than those provided in this article: as this article does not refer to pending opposition proceedings, the existence of an opposition cannot be a ground for refusing a claim limitation request.

The *cour d’appel de Paris* also recalled that claim limitation in France is possible both for French and European patents without any distinction: in this respect, Article L. 613 24 IPC allows the patent owner to request a limitation at any time, without distinguishing between French and European patents and without any exception.

More broadly, the *cour d’appel de Paris* noted that there is no text excluding a claim limitation of the French designation of a European patent in case of an opposition pending before the EPO.

Regarding the security of third parties and risks of inconsistencies, the court considered that such

risks already exist in various procedural scenarios, such as an invalidity action coexisting with a claim limitation request or a centralised limitation with different sets of claims according to the designated states; it stated that “*the national judge has jurisdiction to settle those difficulties and draw the consequences thereof*”; therefore the risk alleged by Arkema was not found as excluding the right for the owner of a European patent to request a limitation of the claims for France pursuant to Article L. 613 24 IPC in case of opposition proceedings pending before the EPO.

Arkema finally argued that the claim limitation requested by Honeywell should have been refused on the grounds that claim 1 was not modified and that only dependent claims were modified so that there was no limitation of the subject matter of the patent at issue.

In this respect, Honeywell replied that the only legal requirement is a limitation of amended claims but that this requirement does not oblige to modify claim 1.

The Director of the French patent office held that Arkema had no standing to dispute the validity of the limited claims in the proceedings before the *cour d’appel de Paris*.

The court followed this argument and considered that this discussion should be held in the nullity proceedings pending before the *tribunal de grande instance de Paris*:

“As an action for invalidity against the patent the subject-matter of the limitation request is referred to the tribunal de grande instance de Paris, the other party to the proceedings on the merits is not admissible as party in an appeal lodged against the INPI’s limitation decision to dispute the amendments made to the claims, which emerge from the causes of invalidity referred to the judge ruling on the merits of the case.

It follows that Arkema France is inadmissible in disputing the grounds of that decision.” (page 7 of the decision, § 8 and 9)

Arkema has lodged a recourse against the decision of 26 June 2015 before the *Cour de cassation*, the French highest court for civil matters.

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