

Kluwer Patent Blog

Kit Crack Commandments

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After having us recently hummed the Beatles' Ob-La-Di Ob-La-Da song with the TRUVADA case (see [here](#)), French case law is now flirting with New York gangs with a decision about a "Kit Crack" (not to be confused with the "Kit Kat"), reminding us the Notorious Big's *Ten Crack Commandments* rap (listen [here](#)). In short: a new opportunity for the commentator to combine business with pleasure!

The judgment, rendered by the Paris High Court ("Tribunal Judiciaire") on February 6, 2020, involved the company TERPAN, which was the holder of a French patent filed under priority on March 4, 2013, and granted on January 22, 2016, entitled "Kit for consumption by inhalation" (FR3002724 hereinafter the "FR 724 Patent"). The invention relates to a kit for crack smokers to prevent the transmission of blood-borne infections - such as HIV and Hepatitis C - consisting of a tube and a filtering element.

Having learned that the SAFE association and the company ASD were distributing a kit called "Kit Crack", that seemed to reproduce the characteristics of FR 724 Patent, TERPAN brought an action before the Paris High Court against the company both for patent infringement and unfair competition. The defendants brought a nullity counterclaim, in particular for contrariety to the public order and lack of novelty.

"Rule Number Uno": you will do prevention

The first ground of nullity raised by the defendants appears as interesting as it is rarely raised. It was argued that the patent at issue concerned an invention whose exploitation was contrary to public order because it was aimed at drug use. In this regard, the Court noted that if drug use is prohibited, the distribution via prevention associations was not a danger for the public order.

The judges' reasoning reveals the fundamental ambiguity of this provision concerning public order. On the one hand, Article 53 EPC - taken up by L. 611-17 of French IP Code - which places the question on the ground of patentability while evoking exploitation, even though the latter does not exist at the time of filing.

In my opinion, it is here where the motivation of the judgment appears the most controversial: the assessment of patentability must be made at the time of filing and in relation to the content of the patent. Here, nothing in the patent itself allows to assert who will distribute the product or not. On the opposite, what matters is not precisely

the future exploitation by the patentee, on which we can have no certainty at the time of filing, but the potential exploitation that could be made of it. From this perspective, there can be little doubt that the concerned invention was contrary to public order, since it is not aimed at prevention, but at drug use.

That said, it is not so much the Court that is to blame for its motivation as Article 53, because only the use made of an invention may be contrary to public order and not the invention *per se*. In other words, at the time of the filing we can only make assumptions about the future exploitation, unless we focus on a potential use, which would be far too large. A revolver is not a danger for the public order if it is used by law enforcement officers to protect the United States Capitol, whereas it is if it is used by a gang. Actually, the violation of public order should not be included in patentability requirements, but in the rules concerning the prerogatives attached to the patent right once the patent is granted.

“Rule Number Two”: you will use the balance of probabilities

A defendant also raised a lack of novelty by arguing that the Kit Base was marketed as early as 2012, i.e. before the priority date (March 4, 2013). However, TERPAN replied that the Kit had been modified over time and that the version marketed in 2012 did not correspond to the invention that was the object of the application filed.

The Court was not convinced by TERPAN argumentation, putting forward several evidences: the references on TERPAN’s website that the Base Kit *“in its final version”* had been available on the market since April 2012; TERPAN provided a combination in 2010-2011 with wire filters having exactly the dimensions and wire diameter specifications indicated in dependent claims 2, 3, 6 and 7 ; in April 2012, TERPAN provided the Kit Base to various drug harm reduction centers under a single common reference; a bailiff’s report from 2017 described a sample of the Base Kit provided to an association in 2012 as corresponding to the claimed invention, although the latter is questionable since the kit described in the report was not taken from an intact original package.

Thus, the Paris Court seems to have implemented what looks like the balance of probabilities applied by EPO Boards of Appeal. The latter distinguishes between, on the one hand, cases where it is sufficient to examine the probability of the alleged facts (which is more likely to have occurred than not)[1] and, on the other hand, cases where absolute conviction is required (to prove by *“beyond all reasonable doubt”*)[2]. In the second case, *“their decisions [for EPO bodies] need not, and in most cases cannot, be based on absolute conviction, but instead are to be arrived at on the basis of the overall balance of probabilities, in other words on the footing that one set of facts is more likely to be true than the other”*[3].

This balance of probabilities is undoubtedly more liberal than the traditional French case law, according to which anteriority must be of a certain date. Nonetheless, with a sufficiently convincing body of evidence, the method adopted here seems reasonable. In this instance, the evidences adduced by the defendants and the mere indication of a change over time without any details on the elements that had actually changed did not seem likely to prevail.

At the end of the day, the Kit Crack enabled the Paris High Court to deliver significant commandments on public order violation and the assessment of novelty. All that is lacking is the conclusion is the conclusion that I gladly allow myself to leave to Biggie Smalls: *“I’ve been in this game for years, I wrote me a manual, a step-by-step booklet for you to get your game on track”*.

[1] EPO, TBA 3.3.01, November 10, 1988, [aff. T 381/87](#).

[2] EPO, TBA 3.3.03, November 20, 1996, [aff. T 472/92](#).

[3] EPO Guidelines, III-G, 4.3.1.

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