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COUR D'APPEL DE PARIS

Division 5 – Chamber 2



DECISION OF 26 JUNE 2015

(Nº 108, 8 pages)

Docket number: **14/23888**

Decision referred to the court: decision of 1 October 2014 - *Institut National de la Propriété Industrielle* - Nº BOPI 14/44

APPELLANT

S.A. ARKEMA FRANCE, represented by its general director domiciled in that capacity at the registered office located at

420, rue d'Estienne d'Orves

92700 COLOMBES

Registered in the Trade and Companies Register under Nº 319 632 790

Having elected domicile at

C/O association COUSIN & ASSOCIES

Ms Sandrine BOUVIER-RAVON

Attorney-at-law

8, rue de l'Odéon

75006 PARIS

Represented by Ms Sandrine BOUVIER-RAVON of the Association COUSIN & ASSOCIES, attorney-at-law, member of the PARIS bar, courthouse box R 159

IN THE PRESENCE OF

THE DIRECTEUR GENERAL OF THE INSTITUT NATIONAL DE LA PROPRIÉTÉ INDUSTRIELLE (INPI)

15, rue des Minimes

CS 50001

92677 COURBEVOIE CEDEX

Represented by Ms Isabelle HEGEDUS, Officer in charge

RESPONDENT

HONEYWELL INTERNATIONAL INC, a company incorporated under the laws of the United States of America, represented by its legal directors domiciled in that capacity at the registered office located at

101 Columbia Road
PO Box 2245
Morristown
NJ 07962-2245
New Jersey
UNITED STATES OF AMERICA

Represented by Mr Alain FISSELIER of the SCP AFG, attorney-at-law, member of the PARIS bar, courthouse box L 0044

Assisted by Ms Isabelle ROMET pleading on behalf of the SCPA VERON & ASSOCIES, attorney-at-law, member of the PARIS bar, courthouse box P 024

COMPOSITION OF THE COURT:

After an oral report, the case was discussed on 28 May 2015 in open court, before the court composed of:

Ms Marie-Christine AIMAR, Presiding Judge
Ms Sylvie NEROT, Judge
Ms Véronique RENARD, Judge

who deliberated.

Court Clerk during the discussion: Ms Carole TREJAUT

The file was previously transmitted to the Public Prosecutor represented during the discussion by Mr Hugues WOIRHAYE, Advocate General, who expressed his opinion.

DECISION:

After hearing all the parties

Made available at the Court Clerk's office, the parties having been previously informed as provided for in the second subparagraph of Article 450 of the French Civil Procedure Code

Signed by Ms Marie-Christine AIMAR, the Presiding Judge, and Ms Carole TREJAUT, the Court Clerk, to whom the original copy of this decision was given by the signatory judge.

Honeywell International Inc, which introduces itself as the world leader in high-performance materials (fluorocarbons, films, fibres, and reactants), remote control and monitoring solutions, components for aeronautics and components for automotive industry, is the holder of European patent N^o EP 1 716 216 entitled “*compositions containing fluorine substituted olefins*”. It relates to the use of fluorinated compounds for automobile air conditioning systems.

That patent designating France was filed on 29 April 2005 under number 05744161 and granted on 18 November 2009.

That patent stems from patent application PCT/US2005/014873 - WO2005/105947 in the name of Honeywell and claims priority from patent application US 10/837,525 of 29 April 2004.

By a letter dated 1 February 2013, Honeywell International Inc submitted to the *Institut National de la Propriété Industrielle* (hereinafter “INPI”) a request for limitation of the French designation of European patent EP 1 716 216.

The request mentioned in particular the fact that the patent was the subject of an action for invalidity pending before the *tribunal de grande instance de Paris* and an appeal in an opposition pending before the European Patent Office (EPO).

By a communication of 19 February 2013, the INPI raised an objection of inadmissibility against the request for limitation on the grounds that the patent at issue was the subject of an opposition pending before the EPO.

By a letter of 5 March 2013, Honeywell International Inc submitted its observations in reply to that objection and by a communication dated 21 June 2013 the INPI withdrew the objection of inadmissibility of the limitation request and informed the requesting party of the continuation of the examination proceedings.

By a communication of 10 July 2014 the INPI raised, with respect to the requesting party, an objection of irregularities based on the provisions of Article R. 613-45 of the French Intellectual Property Code, drawn from the lack of clarity, concision and support of the amended claims 4 and 5. Following that objection, Honeywell International Inc submitted, on 10 and 26 September 2014, a new set of amended claims.

By a decision of 1 October 2014, the INPI acceded to the request for limitation on the basis of the last filed set of claims.

The limitation of the French designation of European patent N^o EP 1 716 216 was registered in the French Patent Register on 2 October 2014 under N^o 202710 and was published in the *Bulletin officiel de la propriété industrielle* N^o 2014/14/44 of 31 October 2014.

Arkema France, which is a chemical producer in the fields of vinyl products, industrial chemistry and performance products, which introduces itself as one of the world leaders in fluorochemicals, lodged, on 27 November 2014, an appeal against that decision pursuant to Article R. 411-19 of the French Intellectual Property Code.

Arkema France filed memoranda on 24 December 2014 and 15 May 2015 and requests that the decision of the *Directeur Général* of the INPI of 1 October 2014 published in the BOPI N^o 14/44 of 31 October 2014 be cancelled, Honeywell International's request lodged pursuant to Article 700 of the French Civil Procedure Code be dismissed, and Honeywell International be ordered to pay to Arkema France a sum of 30,000 euros pursuant to the French Civil Procedure Code.

For that purpose, it sets out that nine oppositions were lodged against European patent EP 1 716 216, which led to its revocation on 27 March 2012 pursuant to Article 123 (2) of the Munich Convention, and that Honeywell International lodged an appeal against that decision before the Board of Appeal and that the appeal is still pending.

It continues and indicates that it brought, on 19 November 2009, an action for invalidity of the French designation of that patent before the *tribunal de grande instance de Paris*, which, by a judgment of 5 October 2012, dismissed the request for a stay of proceedings lodged by Honeywell International pending the outcome of that appeal before the EPO, and specifies that it brought five other invalidity proceedings with regard to the Polish, Turkish, Spanish, Portuguese, and Italian designations of that patent.

Honeywell International, therefore, submitted, on 1 February 2013, a request for limitation of the French designation of that patent and requested before the Judge in charge of the case preparation a new stay of proceedings pending the outcome of those proceedings; the Judge, by an order of 19 April 2013, rejected it and set the hearing of the case on 28 September 2015.

Arkema France argues that it has an interest in lodging that appeal because it disputes the lawfulness of the decision of the *Directeur Général* of the INPI and that it can only do it by way of this appeal and that this decision, which complicates its pending invalidity action, adversely affects its interests.

It adds that, if it is not disputable that the holder of a European patent can limit, before the INPI, the only French designation of its European patent which is the subject-matter of an invalidity action without being obliged to use a centralised limitation before the EPO, the rules applicable to that limitation should, however, take into account the European nature of the patent.

It sets out that the analysis of the texts leads to the application of Article 105 bis (2) EPC for the limitation of the French designation because of the reference to Article 614-12 of the French Intellectual Property Code, that the request cannot, accordingly, be submitted as long as opposition proceedings relating to the European patent are pending, and that this interpretation is in accordance with the provisions of Article 2 § 2 EPC, which gives primacy to the opposition proceedings over the limitation proceedings.

It specifies that the EPC is of direct application in France, in particular the rules laid down in Articles 105bis *et seq.*, like the rules applicable to the invalidity of the French designation of a European patent laid down in Article 138, to which Article L. 614-12 of the French Intellectual Property Code refers.

It concludes that the *Directeur Général* of the INPI should declare the request inadmissible as the lists of Article R. 613-45 of the French Intellectual Property Code, according to Arkema France, are not restrictive and cannot, as it is a decree, prevail over a legislative provision (L. 614-12) and an international provision (Article 105 bis EPC). The contrary would have the effect of causing unacceptable practical difficulties and legal uncertainties as a set of claims emerging from the opposition proceedings would co-exist and/or be conflicting with a (different) set of claims emerging from the limitation proceedings. It is the case here as, within the framework of its appeal before the EPO, Honeywell International submitted a main request and, lastly, nine auxiliary requests, which constitute as much alternating claims, while none of these requests includes the same claims as those filed in the limitation proceedings, which is harmful to third party security.

To criticise Honeywell International's other arguments, it indicates that, in France, invalidity proceedings may take place in parallel with opposition proceedings, while, in limitation proceedings before the INPI, the accepted amendments are not decided by the *tribunal*, and adds that it is entitled to have a rapid decision on the invalidity of the French designation without waiting for the outcome of the proceedings brought before the EPO.

Regarding the merits of the decision, Arkema France argues that the limitation granted by the INPI does not limit the subject-matter of the patent as the terms of claim 1 of the patent, which defines the scope of the patent since all the other claims are only dependent on the first one, were not amended. The amendments made only consist of a complete change of the dependent claims, the number of which increased from 8 to 18, so that the scope of the patent remained as broad as that initially fixed by the main claim.

Honeywell International filed memoranda on 30 March and 28 May 2015.

It requests that the appeal lodged by Arkema be dismissed, that the decision of 1 October 2014 be affirmed and that Arkema be ordered to pay it the sum of 50,000 euros on the basis of Article 700 of the French Civil Procedure Code.

It sets out for that purpose that it lodged the request for limitation of the French designation of the patent to avoid the risk of seeing the *tribunal* revoke the French designation without it being able to make the amendments proposed in the auxiliary requests submitted to the Board of Appeal of the European Patent Office and could, consequently, make limitations consistent with those presented before the European Patent Office.

It argues that the legislator did not prohibit the French designation of a European patent, the subject-matter of opposition proceedings before the European Patent Office, from being limited as, according to Article L. 613-24, the patent holder may, at any time, request a limitation of one or more claims of a patent, without distinguishing whether it is a French or a European patent, no exception from that principle being provided.

It adds that Article L. 614-2 globally refers to Article 105 bis and does not suggest a dissociation between § 1 and § 2, nor does case law, and no Article of the EPC provides that this Article applies in France while Article R. 613-45 provides, on the contrary, that the *Directeur Général* of the INPI applies the rules of Article R. 613-45.

It continues and indicates that Article 105 bis § 2 only tends to avoid two distinct decisions, which both apply to all the territories covered by a European patent, from modifying a same European patent in different terms.

It specifies that it was obliged to lodge that request by reason of Arkema's procedural strategy.

It also argues that finding admissible the request for limitation of the French designation of a European patent while an opposition is pending before the EPO does not increase third party uncertainty as it is frequent that a same European patent comprises different claims according to the countries (Germany, United Kingdom), while there is no primacy between the proceedings of limitation and opposition and adds that the French legislator had no reason to prohibit limitation on the grounds that opposition proceedings are pending.

Regarding the merits of the decision, it sets out that the patentee has no further obligation to limit the scope of the patent in its entirety: it is required and sufficient that all the amendments made are intended to limit the claims, which does not require the amendment of claim 1.

The *Directeur Général* of the INPI expressed her observations on 28 May 2015 and emphasised that the causes of inadmissibility of Article R. 613-45 of the French Intellectual Property Code are restrictively listed and do not refer to the existence of pending opposition proceedings before the EPO and that Article L. 614-12 refers to Article 105 bis in its entirety, the first paragraph of which exclusively governs the requests submitted to the EPO. It specifies that Arkema France is inadmissible in disputing the grounds of that decision.

WHEREUPON, THE COURT,

On the admissibility of the request for limitation of the French designation of the European patent when it is being opposed before the EPO,

Article L. 613-24 of the French Intellectual Property Code provides:

"The owner of a patent may at any time surrender either the entire patent or one or more claims, or limit the scope of the patent by amending one or more claims.

The request for surrender or limitation shall be submitted to the *Institut national de la propriété industrielle* in accordance with the conditions laid down by regulation.

The *Directeur* of the *Institut national de la propriété industrielle* shall examine the request for its compliance with the regulations referred to in the foregoing paragraph.

The effect of the surrender or limitation shall be retroactive from the filing date of the patent application.

The second and third subparagraphs of this Article shall apply to the limitations made under Articles L. 613-25 and L. 614-12."

Article R. 613-45 of that Code sets the requirements that the limitation request must fulfil: by a written declaration, coming from the holder or all the holders of the patent with the consent of the holders of the real rights, and justification of the payment of the annual fees, accompanied with the full text of the amended claims.

If, when the limitation is requested, the amended claims do not constitute a limitation in relation to the previous claims of the patent or if they do not comply with the provisions laid down in Article L. 612-6, the request is rejected by the *Directeur Général* of the *Institut national de la propriété intellectuelle*.

Article L. 614-12 of the French Intellectual Property Code, which relates to the invalidity of the French designation of a European patent, sets forth in subparagraph 3 that "*within the framework of proceedings for the revocation of the European patent, the holder is entitled to limit the patent by amending the claims pursuant to Article 105 bis of the Munich Convention. The patent thus limited is the object of the revocation action instituted*".

Article 105 bis EPC provides in paragraph 1 that the limitation request is submitted to the EPO and in paragraph 2 that the request cannot be submitted as long as opposition proceedings relating to the European patent are pending.

Article L. 612-6 of the same Code sets forth that "the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description".

On 31 January 2010 before the European Patent Office, Arkema lodged an opposition against Honeywell's European patent N^o 1 716 216; eight further oppositions were lodged afterwards by other companies. On 27 March 2012, the Opposition Division of the European Patent Office revoked that patent for extension beyond the content of the application on the basis of Article 123 (2) of the European Patent Convention.

On 29 March 2012, Honeywell International lodged an appeal against that decision, which is still pending.

This being set out, Article L. 614-12 of the French Intellectual Property Code refers to Article 105 bis of the European Patent Convention in its entirety, the first paragraph of which exclusively governs the requests submitted to the EPO, and that Article only refers to the proceedings before the EPO while no text, at both European and national levels, provides its application before the INPI.

No text excludes the possibility of requesting, before the INPI, a limitation of the only French designation of a European patent when opposition proceedings are pending before the EPO.

That limitation before the INPI governed by Articles L. 613-24 and R. 631-24 relates without distinction to national (L. 613-25) or European (L. 614-12) patents, the invalidity of which is requested, and the causes of inadmissibility of Article R. 613-45 of the French Intellectual Property Code, which are restrictively listed, do not refer to the existence of pending opposition proceedings before the EPO.

Accordingly, nothing in all those provisions limits the right recognised to the holder of a European patent to limit, before the INPI, the scope of the French designation of its patent, which is, furthermore, the subject-matter of oppositions before the EPO, while there is an interest in opposing the invalidity action brought before the French judge as the different purpose of Article 105 bis, which is to avoid that two distinct decisions emerging from the EPO equally apply to all the territories covered by the European patent, is not such as to remove that first faculty.

Third party certainty and the risks of consistency problem, which, incidentally, already exist as an invalidity action may co-exist with a limitation request, and, within the framework of a centralised limitation, different sets of claims according to the designated States may be filed, do not hinder the exercise of that national right of limitation, while the national judge has jurisdiction to settle those difficulties and draw the consequences thereof, in particular on the possible absence of infringement resulting therefrom.

It follows that the *Directeur Général* of the INPI rightly held that request admissible and the appeal lodged against that decision should, consequently, be dismissed.

On the merits

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.

Article 700 of the French Civil Procedure Code should not be applied.

ON THESE GROUNDS

Dismisses the appeal lodged by Arkema France against the decision of the *Directeur Général* of the *Institut national de la propriété industrielle* dated 1 October 2014 published in the BOPI on 31 October 2014 under N^o 2014/44,

Holds that Article 700 of the French Civil Procedure Code should not be applied,

Holds that this decision will be notified by the Court Clerk by a registered letter with acknowledgment of receipt to the parties and the *Directeur Général* of the *Institut national de la propriété industrielle*,

The Court Clerk

The Presiding Judge