

Kluwer Patent Blog

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What happens when the same invention is covered by a French national patent and a European patent claiming the priority of the French application and when the European patent lapses after having replaced the French national patent?

The patentee has no patent at all!

That is the bitter lesson of the [2 July 2010 decision](#) of the *Cour d'Appel* of Paris.

Technically, it rules on the date on which a French patent lapses in case of non payment of an annual fee:

- * the deadline for the payment of the annual fee, or
- * the expiry of the 6 month time limit to pay the surcharged annual fee?

It holds that the patent lapses on the expiry date of the 6-month time limit set by Article L. 612-19 and R. 614-16 of the French Intellectual Property Code(1) to pay the surcharged annual fee.

As a surprise, this decision, which seems favourable to the patentee, is, in the present case, a setback to him.

Because at the end of the day, the *Cour d'Appel* decides that he has lost all his patent rights (not only in the European patent – which was undisputed –, but also in the French patent, under which priority the European patent had been applied for – which was at stake).

The issue was raised in an infringement action that the claimant (Trèves) had initiated against Renault and its suppliers on the basis of a French patent, whereas a European patent designating France and claiming priority from the French patent had been applied for and granted which covered exactly the same invention as the French patent.

In such a situation French law (Article L. 614-13 Intellectual Property Code(2)) provides that the French patent “ceases to have effect” if no opposition is filed against the European patent or when the patent is maintained after opposition.

The difficulty arose because the patent holder had ceased to pay the annual fees maintaining the European patent in force in France, so that this patent had lapsed in France.

The chronology was the following:

- 10 April 1995 : filing of the French patent application
- 5 April 1996 : filing of the European patent application claiming priority from the French patent application
- 20 June 1997 : grant of the French patent
- 29 December 1999 : grant of the European patent
- 30 April 2000 : due date of the 5th annual fee for the European patent
- 29 September 2000 : expiry of the time limit to oppose the European patent
- 30 October 2000 : expiry of the 6-month time limit to pay the surcharged annual fee, which was due on 30 April 2000
- 31 December 2001 : decision of the Director of the French IP office recording the lapse of European patent No. 0 820 390 for failure to pay the 5th annual fee

Timeline *Trèves v. Renault, Silac & Simoldes*

The defendants argued that the European patent had only lapsed on 30 October 2000; that, accordingly, it was in force on 29 September 2000, the expiry date of the time limit to oppose the European patent; and, consequently, that the French patent had ceased to be effective on that date (in other words, the French patent had ceased to be effective on 29 September 2000 and the European patent on 30 October 2000).

On the contrary, the patentee argued that the European patent had ceased to be effective as soon as 30 April 2000, the due date of the unpaid annual fee, so that, on 29 September 2000, the expiry date of the time limit to oppose the European patent, there was no European patent that can replace the French patent, which was still in force.

The *Cour d'appel* decided in the defendants' favour considering that the European patent had been effective until the expiry of the 6-month time limit to pay the surcharged annual fee, *i.e.* until 30 October 2000; that, accordingly, it was in force on 29 September 2000, the expiry date of the opposition time limit; and that, on that date, it replaced the French patent, which, as a result, had ceased to be effective.

The end result is that the plaintiff had no longer any patent in force in France, neither the European patent, for which he failed to pay the 5th annual fee for France, nor the French national patent, which "*ceased to have effect*" before the lapse of the European patent which it did not therefore replace.

Original French decision.

(1)

Article L. 612-19 French Intellectual Property Code

Annual fees shall be paid in respect of every patent application and every patent, with payment to be effected not later than the date laid down by a Conseil d'État decree.

Where payment of an annual fee has not been made at the date referred to in the foregoing paragraph, such fee may be validly paid within an additional period of six months subject to payment of a surcharge within that same period.

Article R. 614-16 French Intellectual Property Code

The annual fees referred to in Article L. 612-19 that are due for the European patent application shall be paid as prescribed by Article 141 of the European Patent Convention; these fees shall be calculated as from the filing date of the European Patent application.

Where payment of an annual fee has not been made on expiry of the time limit referred to in Article 141(2) of the European Patent Convention, that fee may be validly paid within an additional six-month period on payment of a late fee within the same time limit

(2)

Article L. 614-13 French Intellectual Property Code

Where a French patent covers an invention for which a European patent has been granted to the same inventor or to his successor in title with the same filing date or the same priority, the French patent shall cease to have effect at either the date on which the period during which opposition may be filed against the European patent expires without opposition having been filed or the date on which the opposition proceedings are closed and the European patent maintained.

However, where a French patent has been granted at a date later than either of the dates, as appropriate, laid down in the foregoing paragraph, such patent shall not take effect.

The subsequent lapse or annulment of the European patent shall have no effect on the provisions of this Article

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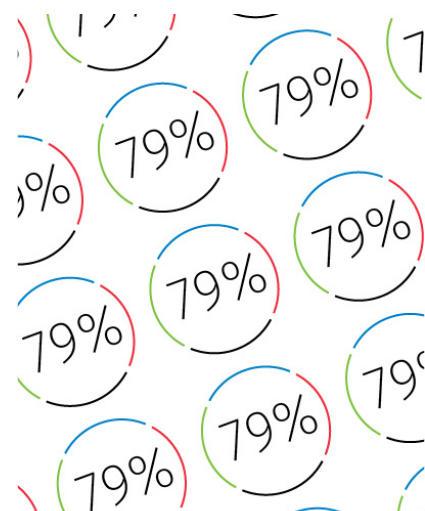
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