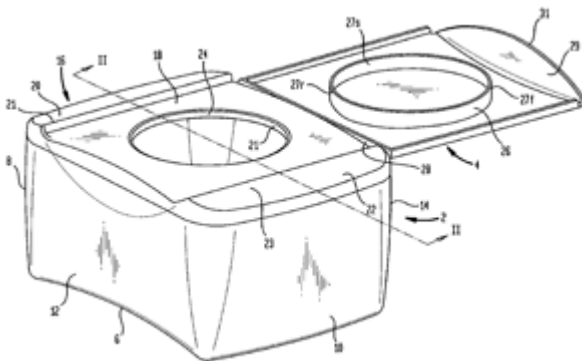


Kluwer Patent Blog

Temporal Scope of Application of the London Agreement in France

Pierre Véron (Véron & Associés) · Thursday, September 2nd, 2010



Unilever NV (hereinafter referred to as “Unilever”) is the holder of a European patent filed in English on 19 March 2001 and the grant of which was published in the European Patent Bulletin dated 25 May 2005. A first French translation was then filed with the *INPI* (French patent office) on 30 June 2005 pursuant to former Article L. 614-7 of the French Intellectual Property Code which provided that when the text of a European patent granted or maintained in amended form was not written in French, the patentee should provide a translation to the *INPI*, failing which the patent was void.

Act No. 2007-1544 of 29 October 2007 authorised the ratification of the London Agreement of 17 October 2000 signed by France on 29 June 2001 and amended the wording of Article L. 614-7, adopting two paragraphs in accordance with the principles of Articles 1 and 2 of the London Agreement : “*The text of a European patent application or a European patent written in the language of the proceedings before the European Patent Office set up by the Munich Convention shall be the authentic text. In the case of a dispute relating to a European patent which is not in French, the holder of the patent shall supply, at the request of an alleged infringer, or at the request of the competent court, a full translation of the patent into French at its own cost*”. France deposited its instrument of ratification on 29 January 2008. The agreement was published in France by decree No. 2008-469 of 20 May 2008, its Article 6 §1 providing that it shall enter into force on the first day of the fourth month following the deposit of this last instrument of ratification, that is, on 1 May 2008.

But, if new Article L. 614-7 became applicable as of 1 May 2008, what was exactly its scope over time? In the present case, following an opposition, the text of the patent had been amended and the amended text was published in the European Patent Bulletin dated 6 August 2008.

Unilever, convinced that the fate of its European patent filed in 2001 depended in France on former Article L. 614-7, sent on 5 September 2008 the translation of the amended text in order to avoid that its patent loses its effect.

The Director General of the *INPI* refused to consider this translation on the ground that “*since 1 May 2008, France has dispensed with the translation requirements provided for in Article 65, paragraph 1, of the European Patent Convention*”.

Unilever, considering on the contrary that the translation requirement still applies in the case of the publication of an amended version of a European patent granted before 1 May 2008 and that it might run a serious risk of being deprived of its intellectual property title due to the refusal of the Director General of the *INPI* to accept the new translation, lodged an appeal on 9 June 2009 against the latter’s decision before the *Cour d’Appel* of Paris.

In its [14 April 2010 decision](#) (and also in 23 similar decisions made on the same date), the *Cour d’Appel* of Paris dismissed the appeal on two grounds.

Under Article 9 of the London Agreement, the new scheme applied in France to European patents in respect of which the mention of their grant had been published after 1 May 2008 (the date of entry into force for France). This hypothesis did not concern the present case since the European patent was filed before 1 May 2008 and the mention of its grant published even before that date.

However, the court held that it could ignore Article 9 of the London Agreement, which “*did not result in preventing from an optional dispensation whose effects extend to the European patents in respect of which the mention of grant was published in the European Patent Bulletin after before this same date of entry into force of the agreement*” (that is, 1 May 2008). The court considered that Article 65(1) EPC, if it offered the option of requiring the applicant or patent owner to provide a translation, included implicitly but necessarily, the right of any Member State to waive this requirement. Hypothesis that the London Agreement itself would not have omitted by providing in Article 1 paragraph 4 that : “*Nothing in this Agreement shall be construed as restricting the right of the States parties to this Agreement to dispense with any translation requirement*”.

In the light of these provisions, the court then held that the new paragraph 1 of Article L. 614-7 of the Intellectual Property Code was construed as an immediately applicable waiver of any translation requirement, including to European patents in respect of which the mention of grant was published in the European Patent Bulletin at a date prior to that of the entry into force of the new Act.

Finally, the court also considered that it could rely on one of the general French rules on intertemporal conflicts of laws, which normally applies only in the absence of special legal provisions regulating the intertemporal issues and distinguishes between laws of procedure and substantive laws, stating that : “*the new provisions, which show a return to the original principle, within the spirit of the European Patent Convention, of the validity and protection of the patent in the language of filing independently of all translation, do not pertain to the substance of the right of protection by a patent but are of a procedural nature and, as such, immediately applicable since they relate to completing a formality, in this case the filing of a translation, so that, as rightly held by the Director General of the INPI and by the Ministère Public, the translation requirement for certain categories of patents would now be deprived of all legal basis*”.

There is no doubt that this solution is essentially grounded on the concern of the court to simplify

in practice the task of patent holders, by offering them all the benefits of the simplification introduced by the London Agreement, whatever the date of publication of the grant of their European patent may be.

Original French decision.

English translation.

Author: Nicolas Bouche, Head Legal Research and Literature, Véron & Associés, Paris, France

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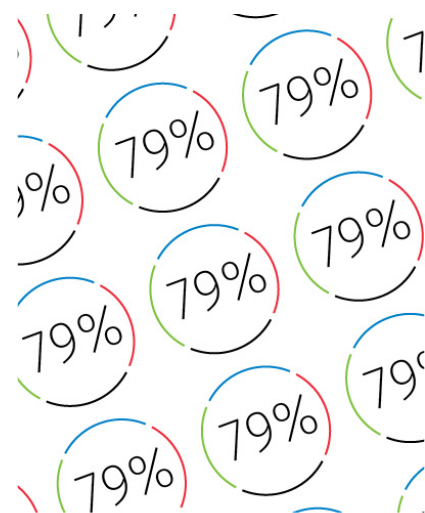
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This entry was posted on Thursday, September 2nd, 2010 at 8:00 am and is filed under [G 1/93](#), [OJ 1994](#), [541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and*

unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).“>Amendments, [EPC](#), [France](#), [Procedure](#)

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