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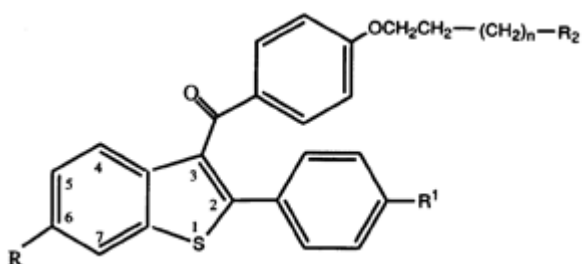
Limitation of the French designation of a European patent: before which office?

Pierre Véron (Véron & Associés) · Monday, August 1st, 2011

Since 2009, French law has allowed patentees to voluntarily limit their granted patent claims. This possibility, which has existed for a long time in a number of European countries, (*e.g.* Austria, Switzerland, Germany, Denmark, Italy, Norway and the United Kingdom) has recently been introduced into the European patent system through Art. 105bis *et seq.* of the European Patent Convention (the so-called “EPC 2000” revision which entered into force on 13 December 2007). Following this example, the French Act No. 2008-776 dated 4 August 2008 amended Arts. L. 613-24 (voluntary limitation procedure independently of any litigation), L. 613-25 (voluntary limitation within the framework of a French patent revocation proceedings) and L. 614-12 (voluntary limitation within the framework of a European patent revocation proceedings) of the French Intellectual Property Code (IPC). These provisions were supplemented by Art. 3 of the decree of 30 December 2008 (Art. R. 613-45 IPC). They entered into force on 1 January 2009.

This reform is very important in practice since the owner of patents are now able also in France to modify the wording of their claims to better delimit their inventions from the state of the art and then to strengthen their patents by limitations (on this reform, see P. Véron and I. Romet, *Patents: Strengthening by Limitation Voluntary Limitation of Granted French National Patents Is Now Possible*, *IIC* 8/2009, vol. 40, p. 957 *et seq.*; also in French, P. Véron et I. Romet, *Brevets : limiter pour consolider ? La limitation volontaire des brevets nationaux désormais possible en France*, *Propriété industrielle*, December 2009, étude 23, p. 11 *et seq.*).

This new regulation is at stake in the present decision, dated 1 July 2011, by which the *Cour d'Appel* of Paris interprets the amended Articles L. 613-24, L. 613-25 and L. 614-12 IPC and clarifies one major ambiguity of the reform.



The American company Eli Lilly is the holder of European patent EP 0 584 952 entitled “Improvements in or relating to benzothiophenes”.

By way of an act dated 30 July 2009, the Teva companies (Teva Pharmaceutical Industries and its French subsidiary Teva Santé) served a summons upon Eli Lilly before the *Tribunal de Grande Instance* of Paris for the invalidity of the French designation of this European patent.

During this proceedings (on 20 April 2010), according to the reform recently introduced in French law, Eli Lilly filed with the INPI (French Industrial Property Office) a request for limitations of the claims of the French designation of its European patent.

On 6 May 2010, the Director General of the INPI decided to limit the French designation of the European patent and this decision was published on the *Registre National des Brevets* (National Patent Register) on 11 June 2010.

Pursuant to Article L. 411-4 IPC, the Teva companies then lodged an appeal against this administrative decision before the *Cour d'Appel* of Paris.

One of their main claims was that it was not possible, within the framework of a revocation proceedings relating to a French designation of a European patent, to file with the INPI such a request for limitation. Only the EPO, pursuant to Article 105bis of the EPC, should be the convenient place where to file such a request.

It is true that there was some ambiguity on that question. Does the French limitation procedure apply especially to the French designation of a European patent?

Very clearly, Article L. 613-25 IPC deals with the voluntary limitation within the framework of a French patent revocation proceedings and Article L. 613-24 IPC provides that the request for limitation shall be submitted to the INPI and the Director of the INPI shall examine that request.

Article L. 614-12 §3 IPC deals with the voluntary limitation within the framework of a European patent revocation proceedings and it expressly refers to Article 105bis of the EPC, *i.e.* the limitation proceedings before the EPO : “*Within the framework of proceedings for the revocation of a European patent, the patent proprietor is entitled to limit the patent by amending the claims pursuant to Article 105bis of the Munich Convention; the patent thus limited is the subject of the instituted revocation action*”.

Then, the question which is not clearly resolved is the office before which the request for limitation of the French designation of a European patent shall be filed. Does such a request give rise to the application of Article L. 613-25 IPC, the request having to be filed before the INPI ? Or does such a request give rise to the application of Article L. 614-12 IPC, the request having to be filed before the EPO ?

The *Cour d'Appel* of Paris rightly finds the answer in Article L. 613-24 IPC which is the other article amended by the 2009 reform, deals with the voluntary limitation procedure independently of any litigation and finally contains the more general provisions on patent limitations.

Especially, Article L. 613-24 IPC ends indicating that “*The second and third paragraphs of this Article shall apply to limitations made under articles L. 613-25 and L. 614-12*”. And these second and third paragraphs of Article L. 613-24 indicate that the request for limitation shall be submitted to the INPI and the Director of the INPI shall examine that request. It is easy to understand that the limitation of a French patent (L. 613-25) shall be submitted to and examined by the Director of the INPI. But this same precision with regard to Article L. 614-12 IPC (European patent) can only

mean that the limitation of the French designation of a European patent shall also be submitted to and examined by the Director of the INPI.

Therefore, Article L. 614-12 IPC deals with the voluntary limitation within the framework of revocation proceedings relating to a European patent or to a French designation of a European patent. In the second case, the request will be filed before the INPI ; in the first case, the request will be filed before the EPO, pursuant to Article 105bis of the EPC. The *Cour d'Appel* of Paris then concluded that “*the reference made by Article L. 614-12 to Article 105bis of the Munich Convention is illustrative and does not exclude the jurisdiction of the director of the INPI*”.

Nothing seems to prohibit the combination of the French national procedure and the central limitation procedure of Arts. 105bis *et seq.* of the EPC: it is therefore quite conceivable that a European patent could be, firstly, subject to a central limitation at the European Patent Office, and then to a limitation specific to France at the INPI (a “*French limitation of the European limitation*”, P. Véron and I. Romet, *ibidem*).

Original French decision.

English translation made by Hogan Lovells and published on the [EPLAW Patent Blog](#).

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French Intellectual Property Code

L. 613-24 IPC

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 National Institute of Industrial Property in accordance with the conditions laid down by regulation.

The Director of the National Institute of Industrial Property 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 paragraphs of this Article shall apply to the limitations made under Articles L. 613-25 and L. 614-12.

L. 613-25 IPC

A patent shall be revoked by court decision:

- a) If its subject matter is not patentable within the terms of Articles L. 611-10, L. 611-11 and L. 611-13 to L. 611-19;
- b) If it does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

c) If its subject matter extends beyond the content of the patent application as filed, or if it was granted on a divisional application, beyond the content of the earlier application as filed.

d) If, after the limitation, the extent of the protection conferred by the patent has been increased.

If the grounds for revocation affect the patent in part only, revocation shall be pronounced in the form of a corresponding limitation of the claims.

Within the framework of proceedings for the nullity of the patent, the holder is entitled to limit the patent by amending the claims; the patent thus limited is the object of the nullity action instituted.

The party which, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed.

L. 614-12 IPC

A European patent may be revoked with effect for France on any one of the grounds set out in Article 138(1) of the Munich Convention.

If the grounds for revocation affect the patent in part only, revocation shall be pronounced in the form of a corresponding limitation of the claims.

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.

The party which, in the course of the same proceedings, makes several limitations of its patent, in a dilatory or abusive manner, may be liable to a civil fine not exceeding €3,000, without prejudice to any damages which may be claimed.

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