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Patent revocation actions in France: mind the slot!

Isabelle Romet (Véron & Associés) · Wednesday, June 11th, 2014

Until recently, third parties had not to worry about the date at which they would initiate a patent revocation action in France. However, nowadays, this issue is a hot topic in France.

The origin of the current controversy is not recent as it lies in statute ? 2008-561 of 17 June 2008 which shortened to 5 years the time limit to initiate actions qualified, under French law classification, as personal actions or real actions based on movable assets. This 5-year time period runs from the date at which the owner of a right becomes aware or should have been aware of the facts entitling him to do so.

For the time being, only one decision had the opportunity to decide upon the determination of the starting point of the limitation period, namely the decision issued on 25 April 2013 by the *tribunal de grande instance de Paris*, 3rd chamber, 1st section, in a case *Evinerude v. Giraudeau and Aair Lichens*. But the issue is currently discussed in several pending proceedings.

In this decided case, the claimant had alleged that the limitation period was triggered by the filing of the patent application: this submission was rejected by the court on the grounds that the filing date of the patent is relevant only to determine the date at which the right exists, if granted later, but not the date from which the right is assertable against third parties.

The court followed the approach proposed by the patentee, according to which the limitation period would be triggered by the publication of the patent application, presented as the date at which third parties become aware of the existence and of the content of the patent.

To see the consequences of this reasoning, should it be maintained in future decisions, let’s take the example of a patent application filed on 1 July 2008, published on 1 January 2010 and granted on 1 January 2012: the right to start a revocation action would expire on 1 January 2015, so that the parties interested in starting such an action should hurry up. More generally, if this solution was maintained in future decisions, it would already be too late, on 1 June 2014, to start a revocation action in France against any patent whose application was published before 1 June 2009.

However, the debate opened by this decision is far from being closed.

Assuming that the 5-year time limitation does apply to patent revocation actions in France, the question is to determine the date at which the third party starting a revocation action becomes aware of the facts entitling it to do so.

For sure, the decision of 25 April 2013 was right to consider that the limitation period cannot be triggered by the filing of the patent application, which is not even known by third parties.

However, the starting point adopted by this decision, namely the publication of the patent application, seems incorrect.

As a first general remark, one should keep in mind that a patent revocation action leads to a judicial review of the decision of the patent office granting the patent; it would be illogical to consider that the limitation period for a revocation action could start before such grant.

As a second general remark, the publication of the patent application does not make it possible to know whether the patent will be granted, or with which scope of claims, contrary to the publication of the grant.

Still more, French legal writers consider that it is not possible to start a revocation action against the French designation of a European patent application.

It is also interesting to wonder what will happen if the patent is amended during opposition or limited either centrally before the EPO or nationally before the French patent office, which remains possible until the patent expiry. Such a modification should at least trigger a new 5-year time limitation period for the amended claims.

French judges should also take into account their recent case law applying more broadly the French general rule "*No interest, no action*" ("*Pas d'intérêt, pas d'action*"): several recent decisions found a revocation action not admissible because the claimant had not sufficiently established its intention and capability to exploit the disputed patent and, thus, its interest in obtaining the revocation of the patent. It would be logical to consider that the 5-year limitation period cannot run before the interest requirement is fulfilled, which opens another *Pandora*'s box for the determination of the date at which the claimant satisfied this requirement.

It might also be argued, at least in some circumstances, that the 5-year period starts only when the claimant becomes aware of the nullity grounds.

A post is too short to exhaust the subject and the possible points of view.

To reassure those who may have lost the right to initiate a revocation action, the right to lodge a counterclaim for revocation in reply to an infringement claim is not threatened.

However, there are cases in which it is strategically better to start a revocation action so that it is crucial that French case law is clarified in the future. Meanwhile, the best, to avoid controversy, is to hurry up.

It should be noted that the rules about the Unified patent court (UPC) do not provide any limitation period for revocation actions.

Author: Isabelle Romet, Partner, Véron & Associés, Paris, France

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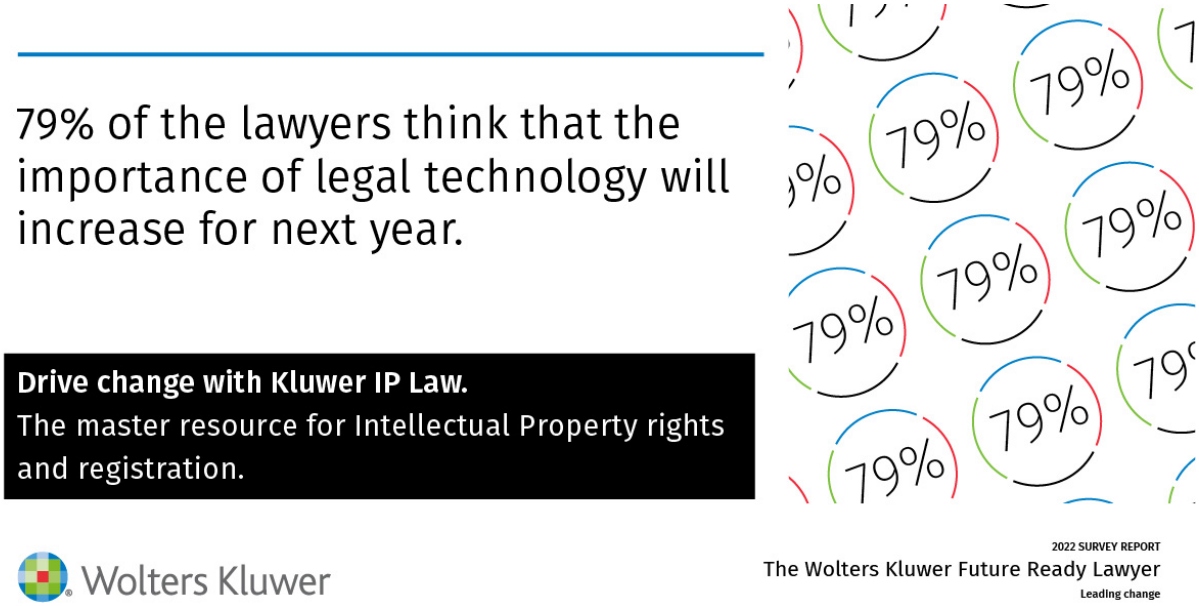

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