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PATENT REVOCATION ACTIONS IN FRANCE: WHICH SLOT?

Isabelle Romet (Véron & Associés) · Tuesday, August 11th, 2015

Our previous post of June 2014 "*Patent revocation actions in France: mind the slot!* " presented and criticized the decision of 25 April 2013 of the *tribunal de grande instance de Paris*, 3rd chamber, 1st section, *Evinerude v. Giraudeau and Aair Lichens*, applying to patent revocation actions the new time limitation period of five years adopted by the statute ? 2008-561 of 17 June 2008 for actions qualified, under French law classification, as personal actions or real actions based on movable assets: according to this decision, the five-year limitation period running from the date on which the plaintiff "*becomes aware or should have been aware of the facts entitling him to start*" was triggered by the publication of the patent application (being recalled that the defendant to an infringement action is always entitled to raise a defence based on the invalidity of the asserted patent).

This criticized solution seems to be given up in the light of three other decisions issued since then by various panels of judges from the same court. The purpose of this post is to summarize the conclusions which may be drawn from them.

In a nutshell, none of these three additional decisions shows a discussion about the applicability of the time limitation period to patent revocation actions; regarding the determination of the event triggering the five-year period, the prevailing approach consists in an assessment "*in concreto*", which enables the judges to take into account all the circumstances of a matter: in one case, it was found to be a warning letter and, in another one, the mention of the grant of the patent by the European Patent Office.

These three decisions are summarized hereafter, in their chronological order.

On 6 November 2014, the panel which had issued the criticized decision of 25 April 2013 took a different position, in *Raccords et plastiques Nicoll v. Matériaux équipements*: this decision held that "*only an in concreto assessment of the moment when the one who brings the revocation action has had an effective knowledge of the right which is opposed to it, has to be done to determine the starting point of the time limitation*"; in that case, the event triggering the five year limitation period was found to be a warning letter sent by the patentee to the defendant.

On 6 February 2015, another panel of the *tribunal de grande instance de Paris* (2nd section of the 3rd chamber) seemed to go back to the decision of 25 April 2013, with the decision *Biogaran v. Merz*, founding that the starting point of the time limitation was the publication date of the patent application. However, this decision did not seem significant as the oral hearing before the

2nd section had taken place on 30 October 2014, *i.e.* before the decision of 6 November 2014 of the 1st section adopting an *in concreto* determination of the starting point of the limitation period.

The latest decision was issued on 13 March 2015 by the *tribunal de grande instance de Paris*, 3rd chamber, 3rd section, in *Bolton Manitoba v. Reckitt Benckiser*: it decided that the starting point should be determined *in concreto* and adopted the date of the mention of the grant of the patent, which was proposed by Bolton, seeking the patent revocation, while Reckitt, the patentee, defendant, was arguing in favour of the publication of the patent application, as decided in the criticized decision of 25 April 2013.Like in the decision of 6 November 2014, the court considered that the starting point of the limitation period has to be determined *in concreto*, which enables judges to take into account all the circumstances of a case:

"*Under the terms of Article 2224 [of the French Civil Code] above mentioned, the starting point of the time limit starts* "from the day when the right holder has known or should have known the facts allowing him to exercise his right" *and it falls on the court to assess in concreto the moment when the one who brings the revocation action has or is supposed to have effective knowledge of the facts allowing him to exercise the action, to determine the starting point of the time limitation*".

Then, the court followed the plaintiff, Bolton, and clearly rejected the publication of the patent application as the starting point of the time limitation:

"*it cannot be admitted that the starting point is the publication of the patent application, […] because at this stage the right may still evolve and the question is not that of the determination of the rights of the European patent holder, but that of the assertion of the rights to third parties.* "

The court then concluded that, in this particular case, "*the starting point of the 5 years' time limitation is the publication of the grant of the patent*" without any need, in this context, to assess more precisely *in concreto* when Bolton has known or should have known the facts allowing it to exercise its right.

As the patent revocation action had been initiated on 24 June 2013, less than 5 years after the publication of the grant of the patent (27 august 2008), the action initiated by Bolton was found admissible (but it was dismissed since the patent was held novel and inventive).

Additional decisions are expected and should shed further light on this hot topic, including about the applicability of the five-year limitation period to patent revocation actions.

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2013-04-25_TGI_Paris_3_ch_1_s_Evinerude_c_Giraudeau_et_AAir_lichens

2015-03-13_TGI_Paris_3_ch_3_s_Bolton_c_Reckitt_Benckiser

2015-02-06_TGI_Paris_3_ch_2_s_Biogaran_c_Merz

2014-11-06_TGI_Paris_3_ch_1_s_Raccords_et_Plastiques_Nicoll_c_Materiaux_Equipements

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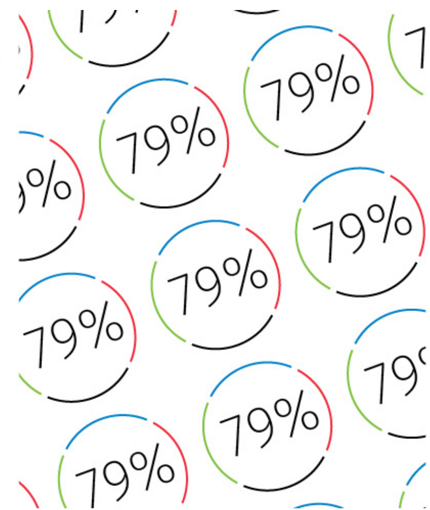

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