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Implementation of opposition proceedings against a French patent: Get ready now!

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The PACTE law of May 22nd [1] introduced new opposition proceedings against French patents before the French PTO. A draft amendment to the Intellectual Property Code (hereinafter referred to as “IPC”) is currently under consideration in order to specify the modalities of proceedings (deadlines, costs, remedies, etc.). This draft is submitted for consultation to representatives of companies, industrial property professionals and courts from Friday, November 22 to Friday, December 13, 2019 [2].

As a reminder, the opposition proceedings against French patents aim to “*allow third parties to request by administrative means the revocation or amendment of a patent, while ensuring that abusive opposition proceedings are prevented*” (Article 121 of the PACTE law).

The order must be issued by the Government before 22 February 2020 (i.e. no later than nine months after the promulgation of the PACTE law). The proposed timetable seems to favor the entry into force of the opposition proceedings on 1st April 2020. It should therefore be possible to file oppositions against any French patent granted as from 1st April 2020 (or even against any French patent for which the nine-month opposition period has not yet expired on 1st April 2020).

The draft amendment to the IPC submitted for consultation includes amendments made necessary by the Trademark Package [3] and also other amendments concerning the opposition proceedings against French patents.

1. The opposition proceedings, at the crossroads of several existing proceedings

At first instance, the proposed opposition proceedings are inspired by several existing proceedings:

- the proceedings for examining patent applications before the French PTO (including representation);
- the trademark opposition proceedings before the French PTO (in particular the three phases of the opposition);
- the opposition proceedings to European patents before the European Patent Office (hereinafter referred to as “EPO”) (in particular the opposition period, no requirement of standing, the grounds for opposition and the suspensive effect of the appeal); and
- civil proceedings before the courts of first instance (in particular the res judicata, the principle of

adversarial proceedings, the enforceability of the decision rendered and for, the losing party, the award to pay the costs incurred by the other party).

The proceedings for appealing against an opposition decision are based on:

- civil proceedings before the courts of appeal (in particular representation, appeal for review, successive three-month time limits for exchanging initial submissions, without applying Article 700 of the Code of Civil Proceeding); and
- the proceeding for appealing against the decisions of the Director General of the French PTO (in particular the one-month appeal period, the exclusive jurisdiction of the Paris Court of Appeal, the administrative nature of the appeal, without being an appeal for annulment of the decisions of the Director General of the French PTO).

It is likely that the part of the draft amendment of the IPC relating to appeals will not change much after the consultation, as it is based on the new texts of the Trademarks Package. On the other hand, it can be expected that the part relating to opposition proceedings against French patents will still be amended.

2. Many pitfalls to avoid

As it stands, those opposition proceedings, at the crossroads between the EPO opposition proceeding (reserved for EPO professional representatives), civil proceedings before the courts of first instance and courts of appeal (reserved for lawyers) and the appeal proceeding against the decisions of the Director General of the French PTO (reserved for lawyers, but following a very specific proceeding), are highly complex and contains many “pitfalls” [4].

For example, with regard to the first instance, it is provided that “*the opposition shall be deemed to have been rejected if it is not decided within three months of the date on which the investigation phase ends*” (Article R. 613-44-6), which seems dangerous for the opponent: the slightest delay by the French PTO (in particular because of an overload of work due to numerous opposition cases) would be to the detriment of the opponent, who would then have to file an appeal without having a reasoned decision. By way of comparison, a request for limitation (although simpler than opposition proceedings) is only deemed to have been rejected after the French PTO has been silent for twelve months.

With regard to the appeal phase, it is surprising to note the position of the Director General of French PTO: he would not be a “*party to the proceedings*” (Article R. 411-23), even though the parties should send him their submissions by registered letter with acknowledgment of receipt, under penalty of inadmissibility of the notice of appeal (Articles R. 411-29 to 32) and that he could submit written observations (Article R. 411-35) and file an appeal against the decision of the Court of Appeal (Article L. 411-4).

It should also be noted that the complexity generated by the “annulment” action specifically provided for in the event of a decision rejecting an application to amend a set of claims following the partial revocation of a patent (Article R. 612-73-3), whereas the appeal against an opposition decision is an appeal with a devolutive effect (Article R. 419-1 paragraph 2) which therefore allows the Court of Appeal to be informed of the entire dispute.

The following three points can further be identified regarding appeals:

- Each new set of conclusions must recapitulate all previous means (Article R. 411-39 paragraph 4) – it is therefore important to increment the conclusions progressively (unlike appeals to the EPO).
- The parties must present in their submissions their new means in a “*formally separate manner*” (Article R. 411-39) – the practice of “line in the margin” therefore seems to be systematically required in those proceedings.
- It is not clear whether new grounds for opposition can be invoked at the appeal stage (Article R.411-38 is not clear on this point) – it is therefore recommended to systematically invoke all grounds (by “ticking” all grounds) when filing an opposition.

3. Many questions remain open

The proposed texts still have many grey areas.

As a result, several questions remain open, including:

- Will the opposition proceeding be oral (as are oppositions before the EPO), as suggested by the “*oral debate*” and the fact that the opposition will be decided “in the *light of all written and oral observations*” (Article R. 613-44-5), or will it be written (as it is customary in French civil proceedings, excluding summary proceedings)? In other words, will the parties be able to make oral submissions that were not previously included in their written submissions?
- If the patentee could “*submit proposals for amending the claims*” and “*propose new amendments to his claims*” during the opposition (Article R. 613-44-5, I., 2° and 3°), does this mean that he will be able to file several subsidiary requests during the proceedings (as the EPO allows)? The use of the plural (“*proposals*” and “*new amendments*”) suggests that the French PTO will accept the filing of several subsidiary requests and examine them.
- How many members will the Opposition Division include? It is only known that the examiner who assessed the patent application would not be a member (Article R. 613-44-11), whereas the EPO allows it.
- Will the French PTO require a complete translation of the prior art cited by the opponent (even though the French PTO does not provide translations of the prior art attached to its preliminary search report)? The Court of Appeal, for its part, usually requires complete translations.
- Will all documents in the opposition file be open for consultation by third parties, on the French PTO’s online database, as already allowed by the EPO’s European Patent Register?
- What will be the criteria for assessing novelty and inventive step in an opposition? Will these criteria be in line with those applied by the EPO (in particular the problem-solution approach) or with those already established by the case law of the Paris Court of Appeal, which will necessarily bind the French PTO (the same Court of Appeal having to hear appeals against the opposition decisions of the Director General French PTO)?
- If the Paris Court of Appeal overturns a decision of the Director of the French PTO which had ruled that an opposition was inadmissible, can it rule on the opposition in the same decision or must it refer the case back to the Director General of the French PTO?
- What will be the cost of the opposition proceedings? The amount of the opposition fee was not disclosed. In addition, if there is provision for the losing party to be ordered to pay the costs incurred by the other party, within the limits of a scale, this applies only to the first instance, on the one hand, and on the other hand there remains the question of the value of the scale point and the determination of the “losing party” in certain cases (for example if the patent is maintained in amended form).

The answers to all these questions may be provided by the French PTO Guidelines, once they have been implemented in order to set out the final details of the opposition proceedings.

4. First strategic considerations

From a strategic point of view, the opposition will be an additional tool for third parties. We will therefore be able to consider the best choice to make against a French patent: (i) file an opposition before the French PTO, (ii) bring an action for a declaration of invalidity before the Paris First Instance Court or (iii) wait to be summoned for infringement before the Paris First Instance Court to file a counterclaim for a declaration of invalidity. In this respect, it may be noted that, as it stands, the action for invalidity would take precedence over the opposition (the opposition being suspended if an action for invalidity is pending, Article R. 613-44-7, 2°) and that it is not yet clearly provided that the alleged infringer may intervene in a pending opposition (Article R. 411-32 only refers to a “*voluntary intervention*” at the appeal stage, but without regulating it). It may also be noted that the parties would have the opportunity to jointly request the suspension of the opposition proceedings for a period of one year (more precisely, “*for a period of four months renewable twice*“, Article R. 613-44-7 paragraph 2), which could be used to negotiate – this is the *cooling-off* period that is already known in trademark matters.

It can already be noted that the proposed proceedings provide a strong incentive to oppose French patents through a straw man, preferably located abroad. Indeed, an opposition via a straw man, made possible by the absence of interest to act (Articles L. 613-23 and R. 613-44), allows the real opponent to avoid an authority of *res judicata* in the event of subsequent action for invalidity (Article R. 615-1 A). In addition, the fact that the straw man resides abroad also allows the real opponent to artificially extend several delays in the opposition proceeding by two months (Article R. 411-43).

With regard to the transitional provisions, while the entry into force of the provisions relating to the opposition proceedings is scheduled for 1st April 2020, the taking into account of inventive step during the examination proceedings should only take place on 22 May 2020 (i.e. one year after the promulgation of the PACTE law). This means that only patent applications filed on or after May 22, 2020 will benefit from an inventive step examination. Given the usual time limits for examination before the French PTO, the first French patents granted after an inventive step examination will therefore probably be granted from 2023 onwards. Consequently, French patents granted before 2023 – without examination of inventive step before the French PTO – could be the subject of an opposition including inventive step as a ground for opposition. For a patent whose written opinion attached to the preliminary search report (delegated by the French PTO to the EPO) mentions a lack of inventive step, it would then be “easy” to file an opposition on the basis of the preliminary search report alone. To avoid such a case, applicants ought to “regularize” the scope of their securities, either by amending the claims or filing a divisional application just before grant [5], or by filing a request for limitation shortly after grant (being specified that opposition proceedings would then prevail over limitation).

In other words, both potential opponents of French patents and patent holders – and especially the latter – must prepare now for the implementation of those opposition proceedings.

[1] Law n° 2019-486 of 22 May 2019 known as the “PACTE Law”:

<https://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000038496102&ateTexte=ategieLien=id>

[2] Press release of the DGE of November 22, 2019 on the draft order and decree relating to the creation of a right of opposition to patents (and draft amendment of the associated Intellectual Property Code).

[3] Order No. 2019-1169 of 13 November 2019 on trademarks or service marks known as “Trademark Package”:
<https://www.legifrance.gouv.fr/eli/ordonnance/2019/11/13/2019-1169/jo/texte> To see our article on this order by Véronique Dahan and Laure Arnon-Duquesnoy:
<https://www.august-debouzy.com/fr/blog/1375-transposition-finale-de-la-directive-paquet-marques-etat-des-lieux-des-modifications-apportees-par-lordonnance2019-1169-du-13-novembre-2019>

[4] In the following, the references to the articles of the Intellectual Property Code are those indicated in the draft amendment to the same Code dated 22 November 2019. These articles are still subject to change. In the following, the conditional is used to remind the provisional nature of the proposed provisions.

[5] Article R. 612-34 of the IPC: “*Until the fee for the grant and printing of the patent specification has been paid, the applicant may, on his own initiative, file divisional applications for his initial patent application.*”

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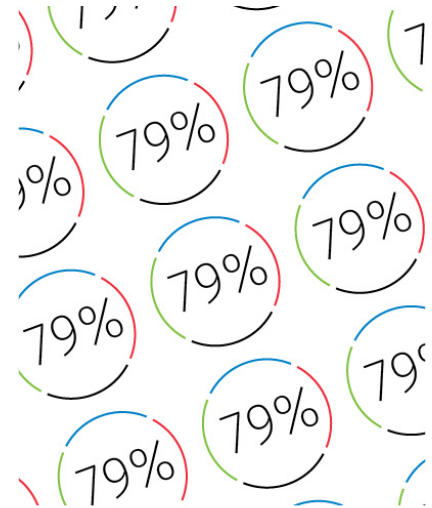
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