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FINGOLIMOD or the Hesitation Blues: can preliminary injunctions be based on a patent application under French law?

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Yes and no, it seems. Well, yes and then no, if recent French decisions are anything to go by. In short, [Hesitations Blues](#) reign. This attitude is all the more interesting given that the question, which arose more especially in the FINGOLIMOD case, has been raised before several European courts, all of which are opposed to the position taken by the Paris High Court (“Tribunal Judiciaire de Paris”) (in [Germany](#), [Denmark](#) and [Spain](#)).

The discussion sparked off in France therefore remains singular.

On the one hand, the Paris High Court has twice accepted this kind of actions (in the FINGOLIMOD case, in two decisions rendered on June 3, 2022, No. 22/52718, and August 4, 2022, No. 22/54655). Since then, the Paris Court of Appeal (1st Chamber) has adopted a strictly opposite stance on two occasions (in the FINGOLIMOD case, which opposed NOVARTIS against BIOGARAN, in a reversal ruling of March 22, 2023, No. 22/11165, then in a confirmation ruling in the case of SHARK ROBOTICS vs. ANGATEC *et al.*, rendered on November 22, 2023, no. 22/19275). Will the Court of Appeal’s judgments be the final word?

A positive conclusion would be too hasty.

Admittedly, the First Chamber of the Paris Court of Appeal has twice rejected the admissibility of provisional measures based on patent applications. In the first case, however, the Court stated that the grant of a patent during proceedings was sufficient to regularize the situation (which was the case here). This case law also seems somewhat fragile if we consider the entire jurisprudential context.

Firstly, the position of the Paris High Court remains unchanged for the time being, and this cannot be overlooked without having a distorted view of French case law, particularly due of the authority of this jurisdiction and its significant activity in patent law (in view of the number of cases handled each year). It should also be noted that in the SHARK ROBOTICS case, the President of the Court did not rule on the question that concerns us today (decision rendered on November 7, 2022). In fact, the measures were rejected because the plaintiff, who based its action on three patent applications, had requested, as its principal claim, a stay of proceedings until the patents were granted, which the President considered did not fall within his jurisdiction, but within that of the Judge on the merits. Moreover, the alternative measures requested by the plaintiff appeared

disproportionate.

Secondly, neither the 2nd Chamber of the Court of Appeal, nor, above all, the Civil Supreme Court (“*Cour de Cassation*”) has given a ruling. It should be noted that Judge Sabotier, author of two of the Court’s orders (NOVARTIS vs MYLAN of August 4, 2022, and SHARK ROBOTICS of November 7, 2022), now sits on the *Cour de Cassation* bench. Of course, this prevents her from judging cases in which she previously intervened. Sill, having said that, it is hard to believe, particularly in view of Judge Sabotier’s authority in patent law, that she would be contradicted and/or, at the very least, that she would not be consulted informally by her colleagues if the question arose before the French Supreme Court.

So, the question remains: can preliminary injunctions (“PI”) be based on a patent application under French law?

According to the *Tribunal Judiciaire de Paris*, article L. 615-3 of the French IP Code (“FIPC”), which relates to PI, provides that “*any person having standing to bring an action for infringement*” may request “*any measure intended to prevent imminent infringement of the rights conferred by the title*”. This applies to the holder of a patent application, insofar as articles L. 613-1 and L. 615-4 provide that holder may bring an action for infringement. In this High Court’s interpretation, the end is undoubtedly the most important, and therefore the most interesting: the expression “*the rights conferred by the title*” cannot deprive of the right to act, since the term “*title*” must be understood as the basis of the infringement action (i.e., patent application or patent).

The Court of Appeal took an identical approach *ab initio*: the owner of a patent application can bring an action for infringement under articles L. 615-3, L. 613-1, and L. 615-4 of FIPC. On the other hand, the notion of “*industrial property title*” must, according to the Court, be interpreted in accordance with article L. 611-2, which lists said titles and does not mention the patent application.

At first glance, we might be inclined to think that the Court of Appeal’s reading of the text was nothing more than a literal application of the texts, particularly regarding article L. 611-2, which omits patent applications from its list of “*industrial property titles*”. In short, the Court of Appeal would apply article L. 611-2, while the Paris High Court would adopt a questionable interpretation. However, such a view of French case law does not resist to analysis. Indeed, when article L. 615-3 states that “*any person having standing to bring an action for infringement*”, it necessarily refers to the owner of the application, since article L. 615-4 precisely provides that it may bring an action for infringement. To refer, as the Court does, to article L. 611-2 in fact contradicts articles L. 615-3 and L. 615-4. On the contrary, the Paris High Court prefers to give precedence to these first two texts, specifying that by designating the “*industrial property title*”, article L. 611-2 refers to the basis of the action.

In other words, there is no such thing as a “*literal application*” of the texts, as none of these readings necessarily follow from them. A choice between one interpretation or the other must be made, and only a more detailed examination of our subject, including a search for the legislator’s intention, will help us.

First, we should remember that patent rights arise from the filing of the patent application, not from the granting of the patent. This is why the applicant can sue for infringement: because he is the owner of the invention. In this context, it is difficult to understand how this owner could not request PI, like any other owner of an invention.

It's important to emphasize this point: a patent is, above all, a title issued by a public authority, whose essential function is to provide proof of the patent right over the invention. In other words, issuance merely confirms a pre-existing property right on the invention, which becomes a patent right through application. In fact, despite constant confusion, patent differs from patent right in that the patentee is both the owner of the title (i.e., ownership of the patent) and the owner of the invention (i.e., patent right is confused with ownership of the invention at the time of filing).

Thus, the very purpose of patent law lies above all in its finality (i.e. to encourage the development of innovation and its disclosure) through the granting of a temporary exclusive right over the invention. In other words, ownership of the invention precedes and takes precedence over ownership of the patent itself, which explains why the inventor is the first holder of the right (an assignment to the applicant is presumed, according to Articles 60 and 81 of the EPC) and why the inventor can claim ownership of the invention that has been stolen from him.

As a result, patent, patent right and invention are frequently confused, particularly by the legislator (e.g., infringement or assignment of the “patent”, whereas only the *patented invention* is infringed or can be assigned). Similarly, there is frequent confusion between patent and patent application, which renders article L. 611-2 of the FIPC, on which the Paris Court of Appeal relies, somewhat irrelevant.

This mechanism helps explain why the right to sue for infringement is recognized at the time of the application: it is because it recognizes the pre-existing property right on the invention, so that the applicant, like any owner, can sue for infringement and, a fortiori, should also be able to apply for PI, which only requires plausible infringement and not established infringement (as is the case for action on the merits).

Moreover, the distinction between infringement actions, for which the Court hearing the case on the merits must stay the proceedings (L. 615-4), and PI proceedings, for which the President cannot stay the proceedings, was carefully recalled by Judge Sabotier in the SHARK ROBOTICS case. A stay of proceedings has nothing to do with measures which, by definition, are provisional, and which must be referred to the Court on the merits within a month of the measures being pronounced (art L. 615-3 and R. 615-3 of FIPC), and which may also be appealed to the Court of Appeal. In addition, this stay of proceedings seems designed to avoid contradictory decisions between the Court seized on the merits, which is competent to revoke a patent, and the Office examining the original application. If the President of the High Court grants PI, it will not be able to revoke the patent; at most, it will be able to consider that the contestations concerning the validity of the title are serious. Only the Judge on the merits can be seized of claims that could lead to the invalidation of the title. Moreover, the order, if pronounced, may be subject to the provision of a guarantee to compensate the defendant if these measures ultimately are proven to be unjustified and cause prejudice to the defendant.

Similarly, it has been accepted that the owner of the patent application can request preservation measures, in particular to preserve evidence (“*saisie-contrefaçon*”) (Court of Cassation, Commercial Chamber, February 10, 2015, n° 10-23.668). Here too, it would be illogical to accept that the claimant could request preservation measures and not provisional measures. These two types of measures are generally considered together, particularly regarding urgency, as evidenced by article 62 of the UPC Agreement, which refers to both types of measures together.

In conclusion, the issue is not as simple as it first appears. For my part, at the end of my above

analysis, I can only endorse the decisions of the Paris Tribunal Judiciaire, while awaiting the *Cour de Cassation* to put an end to this debate in France, and I would be very curious to also know opinion of UPC on this question, which could put an end to the debate in Europe.

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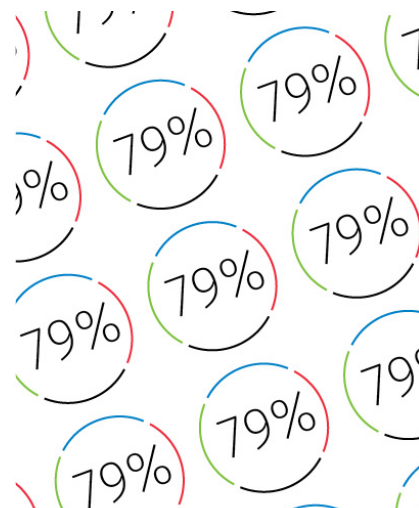
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