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PUBLICATION OF DECREE NO. 2020-15: A RISKY SIMPLIFICATION OF PATENT PROCEEDINGS.

Patent Law | 15/01/20 | François Pochart Lionel Martin

Following the adoption of the PACTE law of May 22, 2019[1], the decree No. 2020-15 dated from January 8, 2020 and "*relating to the creation of a provisional patent application and the transformation of a utility certificate application into a patent application*", was published in the Official Journal on January 10, 2020.

If the provisions concerning the transformation of utility certificates are enforceable for filings made as from January 11, 2020; those concerning the provisional patent application are enforceable as from July 1st, 20201.

I. The provisional patent application.

First of all, the possibility of obtaining a filing date by disclosing only a description of the invention already existed, and this, without paying an official fee[2]. The present decree therefore seems to institute a "new" alternative for patent applicants: to file a provisional patent application that can be regularized within twelve months.

Make no mistake about it, this provisional application can be very dangerous:

i. This provisional application allows a description of the invention to be filed without claims. Without the help of a professional such as an industrial property attorney or a lawyer in this drafting phase, the risk is real. Indeed, a poorly drafted provisional application will hinder the future drafter of the patent claims (the law imposing this drafting at a later stage called regularization), by preventing him from properly delimiting the invention.
ii. The second risk relates to the false sense of security caused by the provisional deposit. This sense of security may lead the applicant to disclose his invention. However, at the time of regularization, it is conceivable that the drafter may not be able to derive relevant claims from the provisional application. Thus, an applicant who has already disclosed his invention would be unable to make a new patent application, properly delimited, for lack of novelty in relation to his own early disclosure. The same problem will arise in the case of foreign extensions, where claims are not given priority.
iii. Finally, the applicant for a provisional application wishing to extend his patent internationally will conduct the filing procedure in France and in third countries in parallel. In doing so, he will not have been able to benefit from the research report provided by the INPI[3] and will have to do "blind" foreign extensions. This will also create difficulties in the payment of the fees for the research report, since French applicants can ask the EPO, at the time of their extension, for reimbursement of the research fee[4]. However, at the time of the foreign extension, the applicant will not be in possession of this research report, which is a condition of the application for reimbursement. The question then remains as to how the two fees (INPI and EPO), relating to the same research (both made by the EPO), will be dealt with.

It is clear that the provisional application "à la française" is more dangerous than anything else and is of very limited value. Avoid it!

II. The transformation of the utility certificate

The second article of the decree creates a reciprocal of Article L. 612-15 insofar as it allows the utility certificate to be transformed into a patent. If the new provisions leave a period of 18 months to require transformation, this period is necessarily limited by the start of the technical preparations for publication, which appear to be the real deadline. The actual period to be considered to carry out the transformation would then be closer to 16 months[5]. The underlying idea is to inform third parties about the regime and the length of protection of a title which, once published, can be opposed to them.

The criticism concerning foreign extensions of provisional applications can also be reiterated here. Nevertheless, this transformation procedure does not entail any risk for applicants regarding the drafting of claims.

Unlike the provisional patent application, which is deemed withdrawn when it is not brought into conformity, the utility certificate is published if the applicant has not been proactive in transforming or withdrawing the application.

If this provision allows one to feel remorse ("I should have filed a real patent application"), one may doubt its relevance. The only difference between a utility certificate and a patent is the research fee, which is €520 and even reduced to €260 for small applicants[6], which is *a priori* the preferred target of utility certificates.

Much Ado About Nothing.

[1] In particular, pursuant to Article 118 of Law No. 2019-486 of 22 May 2019 on the growth and transformation of companies, the following measures have been adopted

[2] The option of filing a provisional application in order to benefit from a filing date is not new insofar as it is provided for by the Patent Law Treaty (PLT) and codified in Article L.612-2 of the IPC.

[3] Research report commissioned by INPI from the EPO

[4] Article 9 of the Fees Regulations

https://www.epo.org/law-practice/legal-texts/html/epc/2016/f/EPC_rfees_20190101_fr_20181211.pdf

[5] INPI Directives - Issuing procedure - MAJ May 2016 - page 113, specifies that the technical preparations take 6 weeks.

https://www.inpi.fr/sites/default/files/inpi_dir_brevets_delivrance_20160601.pdf

Decision of the Director of the INPI n°2011-714 relating to the technical preparations for the publication of patent applications

https://www.inpi.fr/sites/default/files/decision2011714-bopi1206_0.pdf

[6] https://www.inpi.fr/sites/default/files/tarifs-procedures-au-11-12-19_1.pdf