



ARTICLE

PUBLICATION OF ORDINANCE NO. 2020-116 OF 12 FEBRUARY 2020 CREATING A RIGHT OF OPPOSITION TO FRENCH PATENTS

Patent Law | 19/02/20 | François Pochart Lionel Martin Océane Millon de La Verteville



On 13 February 2020, Order No. 2020-116 was published in the Official Journal. It creates a right of opposition to the French patents before the INPI[1]. The content of this ordinance is summarized in the report to the President of the Republic published the same day[2].

With the exception of certain provisions relating to French overseas departments, this Ordinance will enter into force on April 1, 2020, and will apply to patents whose mention of grant has been published in the Official Bulletin of Industrial Property as from that date.

This "French opposition", in preparation for many months, has already been the subject of several flashes to which we refer[3].

By way of introduction, it should be recalled that, since it is an ordinance, this text by definition relates only to amendments to the legislative part of the Intellectual Property Code. The corresponding implementing decree should be issued shortly.

The main changes to the text submitted for public consultation[4] are as follows:

- Since the legislator's intention was probably never to subject utility certificates to the opposition procedure, the text is brought into line (Article L. 611-2).

- The Ordinance excludes the possibility of an appeal for restoration of the right to oppose in the event of exceeding the time limit for filing the opposition, which is in line with practice before the EPO, but also in the event of failure to comply with the time limits set during the opposition examination phase (Article L.612-16). The question of the sanction in the latter case remains open: will it still be possible, as before the EPO, to take the step in question late under certain conditions? Or will any delay lead to more drastic sanctions, similar to those provided for in the appeal procedure before the Court of Appeal, such as inadmissibility or lapse?

- Article L.613-23-3 now includes a second part allowing the proprietor to amend the description and drawings of his patent but only in response to the ground of opposition of insufficient description, clearly distinguishing in this respect from Rule 80 EPC which provides that an amendment of the description and drawings is possible in order to meet any of the grounds of opposition referred to in Article 100 EPC.

- Still in line with the rules practised before the EPO (Article 104 EPC), the wording of the new Article L.613-23-5 has been modified: in the text submitted for consultation, it was provided that, at the request of the winning party, all or part of the costs could be borne by the losing party; the Article now provides that each party shall bear its own costs unless the Director General of INPI provides otherwise to the extent that equity so requires. This distribution will be based on a scale set by ministerial order.

- Article L.613-23-6 submitted for consultation provided that the possibility for the proprietor to request the amendment of his patent in order to comply with a decision of partial revocation was open in the event of a decision of partial revocation "which has become final". Article L.613-23-6 as published provides that this request for amendment is admissible "only if the decision ruling on the opposition is no longer subject to appeal", i.e. it is an irrevocable decision. This clarification is to be welcomed. Indeed, as a "final decision" can always be challenged by an appeal[5], the previous wording could have led to situations in which the patentee would have formulated a request for modification of his patent before the INPI while an appeal against the decision of partial revocation of the same patent was pending or still possible.

- The Ordinance introduces the principle of primacy of the opposition procedure over the limitation procedure (in a similar way to Rule 93 EPC) in the legislative part of the Intellectual Property Code (Art. L. 613-24) whereas the draft submitted for consultation reserved it for the regulatory part (Art. R. 613-45 of the text submitted for public consultation). The exception to this principle of primacy has been clarified: it does not apply where the limitation is required as a result of a request for invalidation of the patent, whether that request is "made as a principal claim or counterclaim before a court". Finally, as with the request for modification mentioned above, the admissibility of the request for limitation is conditional on the fact that the decision ruling on the opposition is no longer "subject to appeal". The implementing decree will lay down the conditions for implementing this new right of opposition, such as the authority of res judicata.

Opposition guidelines will also have to be drawn up by the INPI - but on this point the deadlines are likely to be much longer.

[1] <https://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000041566923&dateTexte=&categorieLien=id>



[2] <https://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000041566915&dateTexte=&categorieLien=id>

[3] https://www.august-debouzy.com/en/blog/1240-pacte-law-and-industrial-property-how-to-make-the-french-patent-more-attractive_; https://www.august-debouzy.com/en/blog/1382-implementation-of-opposition-proceedings-against-a-french-patent-get-ready-now_; https://www.august-debouzy.com/en/blog/1390-publication-of-decree-n2019-1316-relating-to-trademarks-or-service-marks-its-impact-on-all-appeals-against-the-decisions-of-the-director-general-of-the-french-pto_; <https://www.august-debouzy.com/en/blog/1329-adoption-of-the-pacte-bill-by-the-national-assembly-what-impact-on-industrial-property>

[4] See the draft "Consolidated provisions resulting from draft ordinances and decree n°2019-XXX of XX/XX/XXXX relating to the creation of a right of opposition to patents" available on the AFPPI website: <https://www.afppi.fr/commissions/loi-pacte/loi-pacte/>

[5] Civ. 2, 8 July 2004, pourvoi 02-15893; R. Perrot, "Jugement : la notion de jugement définitif", RTD civ. 2004. -775
