



ARTICLE

PUBLICATION OF DECREE NO. 2020-225 OF MARCH 6, 2020 ON THE OPPOSITION PROCEDURE FOR FRENCH PATENTS AND SETTING OF THE OPPOSITION FEE

Patent Law | 03/03/20 | François Pochart Lionel Martin Océane Millon de La Verteville



The decree n°2020-225[1], taken for the application of the ordinance n°2020-116 which creates a right of opposition to French patents[2], was published in the Official Journal on March 6, 2020.

On the same day, an order was issued by the French gouvernement setting the fee to be paid to the National Institute of Industrial Property (« INPI ») for opposition to a French patent at 600 euros[3].

In particular, the decree lays down : the procedures for filing an opposition (in particular the conditions for filing an application with the INPI, the conditions for representing persons who may file an opposition, as well as the conditions for the admissibility of an opposition), the procedures for handling the opposition (in particular the stages of the examination phase by the INPI and the conditions for suspending the proceedings) and the conditions for the amendment of a patent by its owner in response to an opposition.

This "French opposition", in preparation for many months, has already been the subject of several flashes to which we refer[4].

The main changes to the text submitted for public consultation[5] are as follows:

1. Concerning the INPI's opinion on instruction[6]:

- The time limit granted to the INPI to draw up this opinion has been extended: it is no longer 2 months but 3 months (following the expiry of the time limit granted by the INPI to the holder to present its observations on the opposition).

- The draft decree submitted for consultation provided that this opinion "*details the institute's analysis*". This reference to a detailed analysis has disappeared from the published text. The opinion is now simply "*drafted on the basis of the information provided by the parties*". In practice, this will give the INPI the possibility of issuing very summary opinions, simply stating the reasons of the parties without beginning an analysis, similar to what could be done in the past by the EPO Boards of Appeal (a practice which now appears to have been clearly abandoned with the new rules of procedure of the Boards of Appeal of 2020[7]).

2. With regard to the admissibility of late submissions, the Decree still provides that "*the basis and scope of the opposition may not be extended after the expiry of the [9month] time limit for lodging an opposition*" [8]. However, a provision has been added according to which the Director General of the INPI may base his decision on facts or documents produced after the expiry of the time limits for opposition and investigation, i.e. up to the day of the oral debate[9]. Nevertheless, such late elements will only be admissible "*provided that the parties have been able to debate them adversely*", which should in practice limit the admission of late elements, especially those presented only just before or during the oral debate.

3. The possibility for the Director General of the INPI to reject the opposition implicitly, unanimously criticized by the practitioners during the public consultation[10], was maintained in the ordinance[11] but the decree extends the time limit at the end of which "silence is tantamount to rejection" known as the "SVR time limit" - from 3 to 4 months[12]. It is to be hoped that the extension of this period will allow the INPI to grant its own wish never to let this period expire without a reasoned decision...

4. The conditions for suspending the examination phase or the SVR time limit in the event of the launch of an action claiming ownership of the opposing patent have been relaxed: this suspension may be requested by "any person", i.e. in particular by the straw man opponent, if any, and no longer only by the person who filed the action at stake[13];

5. On the other hand, only the opponent who "has a legitimate interest in obtaining an opposition decision" can obtain continuation of the opposition proceedings when the effects of the patent have ceased. In practice, this condition will therefore prevent straw man opponents from obtaining continuation of the proceedings[14];

6. If the opposition proceedings have been suspended due to the existence of parallel claim for ownership or invalidity proceedings, they could be resumed at the request of a party when the decision on the claim for ownership or invalidity has "become final" (« *passée en force de chose jugée* » in French). This new wording[15] designates, pursuant to Article 500 of the Code of Civil Procedure, "the judgment which is not subject to any appeal suspending enforcement". The opposition proceedings may therefore resume when an appeal in cassation against the judgment ruling on the claim for ownership or the nullity is pending.



7. As it had been announced,[16] and in the face of abundant criticism during the consultation phase[17], draft article R. 6151 A was finally abandoned. In essence, this provision would have conferred the authority of res judicata on the decision (to reject or maintain the patent in a modified form) of the Director General of the INPI ruling on the opposition when it was no longer subject to appeal. In the absence of a dedicated provision, some may be tempted to invoke the general principle of res judicata of Article 1355 of the Code of Civil Procedure. Nevertheless, it should be recalled that the French courts refuse to confer the authority of res judicata to the decisions of the EPO ruling on oppositions[18]. Logically, this should also be the case for decisions of the INPI. However, one may wonder what will happen to the decisions of the Paris Court of Appeal ruling on opposition appeals: will they have the force of res judicata and/or will they impose an "estoppel" on the parties during a nullity action concerning the same patent?

8. Finally, a provision has crept into the decree concerning the request for renunciation or limitation: Article R. 61345 now provides that such a request may be made by the patentee at any time, even when the effects of the patent have ceased.

Like the Ordinance, this decree applies to patents whose mention of grant will be published in the Official Bulletin of Industrial Property as of April 1st, 2020[19]. However, the INPI has not yet published the form to be filled in to request opposition. The INPI is also in the process of drawing up opposition guidelines. At the end of January[20], the INPI indicated that a first version of these guidelines should be available at the beginning of April and will be then supplemented by updates to be announced on the INPI website.

[1] <https://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000041698006&categorieLien=id>

[2] See our previous flash on the subject: <https://www.august-debouzy.com/en/blog/1409-publication-of-ordinance-no-2020-116-of-12-february-2020-creating-a-right-of-opposition-to-french-patents>

[3] <https://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000041698223&categorieLien=id>

[4] <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> , <https://www.august-debouzy.com/en/blog/1409-publication-of-ordinance-no-2020-116-of-12-february-2020-creating-a-right-of-opposition-to-french-patents>

[5] 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/>

[6] Draft article R. 613-44-5 2° submitted for consultation v. Article R. 613-44-6 2° as it results from decree n°2020-225

[7] See our previous flash on the subject: <https://www.august-debouzy.com/en/blog/1385-the-new-rules-of-procedure-of-the-boards-of-appeal>

[8] Article R. 613-44-1 al. 8 of the French IP Code

[9] Article R. 613-44-7 of the French IP Code

[10] See in particular the response of the Institut de Boufflers <https://drive.google.com/file/d/1U1hXrmvM7UNK9ztYqjlud55n6RHb--Aq/view> and that of the AFPPI: https://www.afppi.fr/wp-content/uploads/AFPPI_commentaires_ord_decret_proc_opposition_2019-12-16_final.pdf

[11] Article L. 613-23-2 of the French IP Code, resulting from Order n°2020-116

[12] Article R. 613-44-8 of the French IP Code, this period runs from the end of the investigation phase.

[13] Article R. 613-44-10 of the French IP Code

[14] Article R. 613-44-12 of the French IP Code

[15] The text submitted for consultation provided that the procedure would resume at the request of one of the parties transmitting to the INPI the decision ruling on the claim for ownership or nullity "which is no longer subject to appeal".

[16] Notably at the conference organised by the APEB on 29 January 2020 on the impact(s) of the PACTE law.



[17] See in particular the response of the Institut de Boufflers <https://drive.google.com/file/d/1U1hXrmvM7UNK9ztYqjlu d55n6RHb--Aq/view> and that of the AFPPJ: https://www.afppi.fr/wp-content/uploads/AFPPJ_commentaires_ord_decret_proc_opposition_2019-12-16_final.pdf

[18] Paris Court of 1st instance, 3rd chamber, section 3, 28 May 2002; Cour de cassation, Commercial Chamber, 26 March 2008; Cour d'appel de Paris, 4th chamber, 7 December 2005, No. 2004/16096

[19] With the exception of certain provisions relating to Overseas France

[20] At the conference organised by the APEB on 29 January 2020 on the impact(s) of the PACTE law.
