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PATENT OPPOSITION BEFORE THE INPI: VENI, VIDI, NOW BEING ABLE TO TELL HOW IT COULD BE

Patent Law | 02/03/22 | François Pochart Lionel Martin

The opposition proceedings before the INPI came into force on 1st April 2020 and is off to a good start, with around twenty oppositions having been filed, mainly by strawmen but also by foreign companies. The oral proceedings started on 25 January 2022, and we attended and participated in the first four. Here we share our first impressions before the oral proceedings resume in mid-March[1]. On the whole, the course of oral proceedings before the INPI is very similar to that of the European Patent Office (EPO) with, nevertheless, a notable singularity: the INPI seems to be more welcoming of late submissions.

After recalling that the purpose of the oral proceedings is to bring a new perspective on the arguments submitted in the written phase, and not to repeat their content, the arguments are presented in the order indicated in Article L.613-23-3 IPC. The Chairman of the Opposition Board ensures that the various parties are given the opportunity to speak as much as necessary to carefully guarantee the respect of the adversarial process. The Chairman hears the parties as often as necessary and does not hesitate to ask for clarifications about the interpretation of the claims or the prior art. The Opposition Board therefore comes highly prepared. Moreover, for the past two years, INPI examiners have been encouraged to attend oral proceedings in opposition proceedings at the EPO, as members of the public.

As these are the very first oral proceedings before the INPI, they are necessarily conducted with caution. We intend to continue our monitoring of the first oral proceedings in 2022 to paint a picture as complete as possible of this new practice of the INPI. We plan to be able to share our thoughts during the Patent Workshops, our annual training sessions held at the end of June at our premises.

It is already possible to formulate the following teaching: if these first four oral proceedings reveal an obvious parallelism with the conduct of the oral proceedings before the EPO (even the references made to the EPO case law or guidelines are valid before the INPI), one can note some differences:

- 1) an apparent greater benevolence of the INPI in the treatment of late pleas; and
- 2) specific interrogation on the admissibility of request during the oral proceedings.

Regarding the first point, despite the INPI notifies the closure of the written phase to the parties, many of them filed auxiliary requests or documents in the days preceding the oral proceedings, which provided an opportunity to test the admissibility of late pleas. At the EPO, and at the discretion of the Opposition Division, the rule on the admissibility of late pleas (prior art documents or amended set of claims) is based on:

- firstly, the prima facie relevance of these late pleas,
- secondly, the impact of lateness on the efficiency of the proceedings, a potential abuse of process, and the provision of sufficient time for other parties to consider the late material at stake[2].

Before the INPI, Article R.613-44-7 IPC[3] lays down the rule of admissibility of late pleas, at the discretion of the Opposition Board, referring only to the respect of the adversarial process. The INPI's Guidelines on post-grant procedures state that the INPI "shall assess, in particular, the relevance of the factual plea, the circumstances of this late filing and the possibility for the parties to discuss adversely"[4], the guidelines then adding to the law the criteria of relevance and the circumstances of lateness.

In practice, regarding the assessment of the admissibility of late pleas, we have noted that the Opposition Board:

- focuses on ensuring that the adversarial process is respected (as provided by the law), and
- does not really consider the criteria of circumstance of lateness or even relevance (added by the Guidelines).

To sum up, late pleas are admitted once the parties have had the necessary time to take note of the new elements. For instance, in an oral proceedings in which we were a party[5], three new auxiliary requests, incorporating features from the description, were filed only two working days before. Similarly, a prior art document filed two weeks before the oral proceedings was admitted after a short discussion on the circumstances of its late submission. Late submissions are treated by the INPI with a benevolence that contrasts with the increasingly drastic practice at the EPO.

Regarding the second point of filing auxiliary requests specifically during oral proceedings, it should be noted that, formally, the texts on opposition distinguish between the written phase and the oral phase (official name of the oral proceedings before the INPI). Pursuant to Article R613-44-6 IPC[6],

- the oral phase is described as providing for the parties' observations, without further specification,

- whereas the written phase provides for the filing of observations but also explicitly for the filing of "proposals to amend the patent".

We had already pointed out [7] this difference in wording, which seems to exclude the possibility of filing new requests during the oral proceedings. This same reasoning was presented by the opponent in the 2nd oral proceedings [8], but it was not followed by the Opposition Board, which decided to admit the amendments introduced by the patentee during the oral proceedings. The written motivation of the Board for this admission of the auxiliary request, which is not foreseen by the law, is not yet known. But the written decision to come within 4 months will probably be detailed to try to survive its review during possible appeal.

The question of appeal is perhaps precisely what would justify such a liberality in the admission of amendments during oral proceedings. Indeed, if it were to be confirmed that new requests are not admissible in principle before the Court of Appeal, not admitting new requests already from the stage of the oral proceedings before the INPI would be even more restrictive and unfair to the patentee.

The INPI, which will honour us with its presence during our Patent Workshops, will certainly be able to enlighten us on this decision to admit requests filed during oral proceedings.

[1] The schedule of oral proceedings is available on the INPI website <https://www.inpi.fr/sites/default/files/Calendrier%20des%20audiences%20publiques%20de%20la%20proc%C3%A9dure%20opposition%20brevet.pdf>

[2] See EPO Guidelines part E-III, 8.6 §6 (2021), recast E-VI, 2.2.3 §5 in version 2022.

[3] which provides: "*The General Director of the National Institute of Industrial Property shall rule on the opposition in the light of all the written and oral observations filed by the parties and the latest proposals for amendment of the patent filed by the patentee. The General Director of the Institute may base his decision on facts or documents filed after the expiry of the time limits referred to in Articles R. 613-44, R. 613-44-1 and R. 613-44-6, provided that the parties have been able to discuss them in adversarial proceedings.*

The parties shall be notified of the decision ruling on the opposition. It shall be entered in the National Patent Register.

[4] Guidelines on post-grant procedures, B.4.5 - Late pleas

[5] Opposition to patent FR3080526 filed on behalf of François Pochart, oral proceedings on Tuesday 15 February 2022, three new auxiliary requests based on the description filed on the previous Friday.

[6] See Article R613-44-6 CPI, 3° and 4°: "*[...] the opposition proceedings shall be conducted in four stages:*

[...] 3° A written phase.

*On expiry of the period referred to in 2°, if at least one of the parties has submitted observations or the patent holder has submitted proposals for amendment of the patent in response to the notice of inquiry, the parties shall be notified thereof. The parties shall be given a period of time **to submit their observations** in response or, in the case of the patent holder, **to propose further amendments to the patent**. If at least one of the parties has submitted a reply, the parties shall be notified of the reply on expiry of that period;*

4° An oral phase.

*When submitting its written observations, **each party may ask to present oral observations**. The General Director of the Institute may also invite the parties to present oral observations without prior request if he considers it necessary for the purposes of the inquiry. **The parties shall then be brought together at the end of the written phase of the investigation to present their oral observations**, in accordance with the procedures laid down by decision of the General Director of the Institute.*

[7] See our article of 1st April 2020 <https://www.august-debouzy.com/en/blog/1493-the-opposition-before-the-french-patent-office-starting-shot>

[8] Opposition to patent FR3047436