

ARTICLE



E-FILING OF FRENCH PATENT APPLICATIONS: FRENCH PTO (INPI) SHUFFLE ITS FEET AFTER MESSING WITH PLT

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August & Debouzy wins its proceedings for exceeding its power (ultra vires) before the Conseil d'Etat against the decision of the Director of the INPI to force the dematerialization of patent applications in France

In the fall of 2018, the director of INPI (French Patent and Trademark Office) made the decision to switch the electronic filing of French patent applications from the EPOLINE system (offered by the EPO for its own European filings) to an in-house platform system: e-procedure, launched beforehand.

This decision[1] has just been partially overturned by the Conseil d'Etat[2] (French Supreme Court for Administrative law) on *proceedings for exceeding its power (ultra vires)* filed in the name of François Pochart, partner at August Debouzy, with the support and expertise of the patent and public law teams with Emmanuelle Mignon, Guillaume Potin and Pauline Roman.

Indeed, by this contested decision, the INPI took also the opportunity in particular to :

- remove all references to the possibility of filing a French patent application by paper
- force a new electronic document filing format in .docx but with mandatory XML tags which then generates a pdf when filed, while the applicant was then invited to check if the generated pdf reflected the submitted .docx;

which was not without causing some practical difficulties, not to mention the violations of France's international undertakings.

A decision resulting in long pre-filing processing

The removal of the possibility of a paper filing was done without any real shock: most of the professionals of patent filing, patent attorneys or lawyers, were already using filing software, including the common filing software with the EPO and which also integrated the filing of international applications before the WIPO. The profession was therefore mostly used to and routinely used to filing in pdf format.

For the record, the majority of French granting proceedings involve the appointment of a professional agent, should it be a patent attorney or a lawyer.

But the requirement of the new electronic filing format had required a strong preparation of the profession. This preliminary preparation had not however guaranteed a seamless entry into force of the requirement of filling by using the new platform and had moreover always left open the question of which is the document filed which is authentic. Indeed, in the event of a later dispute, the question of whether it is the .docx with XML tags or the pdf that is the authentic document. The .docx is the document actually submitted by the applicant whereas the pdf is generated during the filling process and could introduce some incorrectness that could hardly be foreseen.

The specific constraint of a filing format with a relatively sophisticated system of XML tags led to longer processing times for filing, compared to filings before the EPO or WIPO. This longer timing are sometimes particularly troublesome for urgent filing requests. On the contrary, the use of this pdf format generated from a docx including XML tags should facilitate the administrative processing by the INPI, in particular regarding the subsequent publication activity of the patent application.

The applicants were therefore preparing the publication work of the INPI.

... taken a little too quickly by the INPI

However, the contested decision appeared to be contrary to France's international undertakings.

In fact, in the set of texts governing the filing of patent applications, France is notably a party to the Patent Law Treaty of June 1, 2000er [3] known as PLT.

However, this text provides :

- on the one hand, in its article 5[4] , the possibility of a paper filing for national patent applications, probably with the aim of securing access to a facilitated filing for small applicants,
- on the other hand, in its article 6[5] , that the conditions for filing national patent applications in a country may not differ from those that the country reserves for filing PCT applications, i.e. for filing international applications.

Thus, by requiring that a patent application be filed in a more advanced form for a French application than for an international application, the INPI complicated, by segmenting them, the internal filing procedures of applicants, which was not permitted by the international commitments made.

...and without any real consultation of the professionals

Moreover, it can be noted that one of the means of illegality raised, under the heading of formal legality (called external legality) was based on the absence of consultation of the Industrial Property Attorneys Company. This Company (hereinafter CNCPI) is instituted at the INPI[6] to play a role of professional order for the patent attorneys, the "CPIs". The latter are the only professionals, alongside with lawyers, to be entitled to represent applicants in proceedings before the INPI. Thus, because of the institutional and professional proximity, one could have imagined that a reform impacting the daily functioning of the patent attorneys should have implied the prior consultation of their representation

But the Conseil d'Etat rejected this ground for illegality.

In fact, in the French Intellectual Property Code, and more generally in the law, nothing obliges the INPI to consult IP professionals beforehand. However, one cannot help but think that a prior consultation of these professionals could have avoided such practical, and now legal, difficulties for the implementation of a new platform for filing French patent applications.

[1] Decision No. 2018-156 of November 8, 2018 on the terms and conditions for filing patent applications and subsequent procedures and exchanges (In French : <https://www.inpi.fr/sites/default/files/decision-2018-156.pdf>)

[2] https://august-debouzy.s3-eu-west-1.amazonaws.com/pdfs/Le_conseil_d%C3%A9tat_statuant_au_contentieux.pdf (In French)

[3] Maintained by WIPO and in particular accessible on its website: <https://wipolex.wipo.int/en/text/288998>

[4] Article 5, 1) of the PLT

[5] Article 6, 1) i) of the PLT

[6] Article L422-9 of the French Intellectual Property Code
