



# ARTICLE

## APPEAL AGAINST AN INPI DECISION ON PATENT OPPOSITION: INSIGHTS FROM THE PARIS COURT OF APPEAL ON THE ASSESSMENT OF NOVELTY AND THE ADMISSIBILITY OF NEW SUBSIDIARY REQUESTS FOR AMENDMENT OF THE PATENT

Patent Law | 02/05/25 | Anais Pallut Geoffroy Thill



### PROPRIÉTÉ INTELLECTUELLE

The Paris Court of Appeal has just handed down its second ruling on an appeal against an INPI decision ruling on opposition to a French patent<sup>[1]</sup>. This judgment of 9 April 2025 was handed down in the case of Tinnus (patentee) v Koopman (opponent)<sup>[2]</sup>. It provides two lessons of interest to patent litigation practitioners.

The first - which goes beyond the scope of French patent opposition appeals - concerns the assessment of the novelty of a claim in which one of the features covers an alternative.

In this case, the alternative was three branches: A or B or C. The question was as follows: in the absence of novelty of branches A and C, can the claim be novel if branch B is not expressly disclosed? The answer was no. The Court observed that since branch B was merely an alternative to branches A and C, which are not new, it "*is not sufficient [...] to destroy the lack of novelty of all the features of claim 14*". In other words, the novelty of an alternative feature does not render a claim novel if at least one of the other claimed alternative features is disclosed.

The second issue concerns the possibility for the proprietor to submit new subsidiary requests for amendment of the patent at the appeal stage.

Relying on Articles R.411-19, paragraph 2 and R.411-38 of the Intellectual Property Code, the Court replied that the proprietor cannot submit new requests for amendment at the appeal stage because they do not have the same purpose as the patent as granted or the proposed amendments submitted to the INPI.

For the Court, the aim pursued by the proprietor is to obtain protection. According to the Court, each request to amend a patent corresponds to a different set of claims, with a distinct scope of protection.

The Court also observed that in the present case, the proprietor did not dispute that the opponent was invoking the same grounds for opposition and the same prior art documents before the court as before the INPI. This observation echoes Article R.411-38, paragraphs 1 and 2 of the French Intellectual Property Code, according to which the parties may put forward new arguments, produce new documents or propose new evidence (paragraph 1), but may not submit new claims, except "*to have questions arising from the intervention of a third party or from the occurrence or revelation of a fact judged*" (paragraph 2). This interpretation is in line with EPO practice (Article 12(6) of the Rules of Procedure of the Boards of Appeal).

Owners and opponents are thus invited to concentrate their requests for the former, and their attacks for the latter, before the INPI. It remains to be seen if the opponent, at the appeal stage, will raise a new argument or invoke a new prior art document, to know if the proprietor will be able, in these circumstances, to submit new subsidiary requests.

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[1] The first judgment ruling on an appeal against an INPI decision ruling on opposition to a French patent was handed down on 29 May 2024, in BMW (opponent) v Michelin (patentee), in which August Debouzy represented Michelin

[2] RG 23/14096, August Debouzy represented Koopman in this case.

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