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APPEAL AGAINST FRENCH PATENT OFFICE'S OPPOSITION DECISIONS: CONFIRMATION OF THE INADMISSIBILITY OF NEW CLAIMS IN THE ABSENCE OF NEW ELEMENTS

Patent Law | 16/07/25 | Grégoire Desrousseaux Anaïs Pallut Océane Millon de La Verteville

On 4 July, the Paris Court of Appeal handed down a new ruling on an appeal against a decision of the Director General of the French Patent Office (the "INPI").

In this ruling, handed down in a Linxens (patentee) v. Thalès (opponent)[1] case, the court confirmed the INPI decision revoking Linxens' patent FR3063555.

The judgment contains two points of interest for patent litigation practitioners:

- the applicant may, in the context of this appeal for reversal, request the annulment of the INPI decision;
- the patentee may not submit new requests for amendment of the patent in the absence of new elements brought by the opposing party at the appeal stage.

Jurisdiction of the court to hear an action for annulment of the INPI decision

Linxens claimed that the INPI had failed to comply with the adversarial principle for various reasons:

- firstly, because it had not been given the opportunity to respond to the written observations and prior art document submitted by Thalès to the INPI on the last day of the written phase of the proceedings,
- secondly, because its second subsidiary request for amendment of the patent submitted during the oral proceedings was rejected by the INPI as late, and
- finally, because the INPI had raised of its own motion a ground based on intermediate generalisation in order to rule on the opposition without inviting the parties to submit their observations.

The court ruled that the action for annulment was admissible, stating that "*due to the devolutive effect attached to the appeal lodged against the decision of the INPI General Director revoking the patent, the court has jurisdiction to hear a main action for annulment of that decision on the grounds of breach of the adversarial principle*". The first lesson to be learned from this ruling is therefore that, although an appeal against a French patent is an appeal for reversal [2], the court has the power to examine if the adversarial principle was respected and to annul the decision in the event of a violation.

However, on the merits, the court followed the INPI's observations and Thalès' arguments in concluding that, in this case, no evidence of a violation of the adversarial principle had been provided.

The court first noted that Linxens did not justify why it was unable to respond effectively to Thalès' observations and discuss the new document during the oral phase. In doing so, the judgment provides a second lesson regarding the separation between the written and oral phases of the proceedings before the INPI[3] . The court implicitly confirms that the end of the written phase does not prevent the patentee from replying (and submitting new requests) even during the oral phase. In other words, the end of the written phase is not equivalent to a closure in civil proceedings.

The third lesson to be drawn from this decision concerns the admissibility criteria for requests during the oral phase. On this point, the court confirms the position already expressed in its judgment of 29 May 2024 in the BMW (opponent) v Michelin (patentee) case[4] : the criterion for admitting requests during the oral phase is that the adversarial principle, referred to several times in the IP code[5], can be respected.

In the present case, the court approved the INPI's rejection of the second subsidiary request submitted by Linxens during the oral phase. This was a complex request (it contained four independent claims, whereas the patent as granted contained only two) and had been submitted at the meeting[6] , i.e. at the very end of the oral phase. The Court therefore considers this request to be "*manifestly late, as no adequate adversarial debate could take place at that stage, so that the INPI cannot be criticised for rejecting it*". It would undoubtedly have been more prudent for the proprietor to file this new request before the meeting[7] .

However, the court ruled that the use of the term "*intermediate generalisation*" in the INPI decision was not grounds for annulment of the decision, as intermediate generalisation is merely a form of extension of the subject matter, which could be debated by the parties in adversarial proceedings. The court focused on the arguments that had been made, rather than on the terms of the INPI's decision.

Confirmation of the impossibility for the proprietor to submit new requests for amendments of the patent at the appeal stage if these new requests do not respond to new elements

At the appeal stage, Linxens had submitted two new requests for amendment of the patent claims. These requests were new in that they did not correspond to any of the requests submitted to the INPI.

Thalès objected to the admissibility of these new requests on the grounds that they constituted new claims in the proceedings.

Relying on Article R.411-38 of the French Intellectual Property Code, the court ruled that *"requests made for the first time at the appeal stage in order for the patent to be maintained in a modified form cannot be considered as new grounds, since they seek to amend the claims of the patent before the Court of Appeal. They are considered to be claims that cannot have the same purpose as those submitted to the Director General of the INPI, since they do not seek to obtain the same protection as the claims arising from the requests filed with the INPI Opposition division".* It specifies that *"Linxens cannot validly argue that these new requests are intended to have the court rule on issues arising from the occurrence or disclosure of a fact, since the argument based on the extension of the subject matter beyond the patent application as filed had been raised during the administrative proceedings and the Director General of the INPI, in finding that there was prohibited intermediate generalisation, which was at issue, had responded to it".*

In doing so, the Court confirms the decision taken on 9 April in the Tinnus v. Koopman case, which has already been commented on[8] .

The Court's position is therefore clear: in the absence of new element before the court – prior art or new grounds for invalidity – the patentee is not entitled to submit new requests for amendment of the patent at the appeal stage. In other words, if the opponent sticks to the grounds or prior art it presented before the INPI (even though Article R. 411-38 of the French Intellectual Property Code allows him to invoke new documents before the court), the patent holder is not entitled to submit new requests for amendment of its patent.

It remains to be seen what the Court's position will be in the event that these new requests do not, as in this case, respond to a ground already discussed before the INPI, but to a new ground or a new document raised by the opponent at the appeal stage. According to our sources, this question was raised before the court in a case in which the judgment was expected on 11 July. Let's bet that, in this case, the new requests will be admissible : the patent holder must be able to respond to new prior art with arguments and/or new requests for amendment of its patent[9] .

[1] RG 23/16553, August Debouzy represented the opponent (Thalès) in this case

[2] Article L. 411-19 para. 2 of the French Intellectual Property Code

[3] These different phases are described in Article R. 613-44-6 of the French Intellectual Property Code

[4] in which August Debouzy represented Michelin. In this decision, the Court of Appeal ruled, pursuant to Article R. 613-44-7 of the French Intellectual Property Code, that "*the director of the INPI shall rule on the basis of all the written and oral observations submitted by the parties and the latest proposals for amendment of the patent, and that his decision may be based on "facts invoked or documents produced" after the time limits initially set, the only reservation made by this article being that the parties must have been able to debate them in adversarial proceedings* "

[5] This principle is reiterated in Articles L. 613-23-2, R. 613-44-4 and, above all, R. 613-44-7 of the French Intellectual Property Code.

[6] meeting referred to in Article R. 613-44-6 of the French Intellectual Property Code

[7] See, by analogy, the opposition proceedings before the EPO, where observations and requests submitted after the date set in Rule 116(1) but before the oral proceedings are common.

[8] Judgment delivered in case RG 23/14096 and commented on in our flash available at https://www.august-debouzy.com/fr/blog/2197-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

[9] The procedure before the Court of Appeal would differ here from that before the EPO's Boards of Appeal, as Article 12 of the Rules of Procedure of the Boards of Appeal prohibits, in principle, new arguments and new evidence in appeal proceedings.