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APPEAL AGAINST FRENCH PATENT OFFICE'S OPPOSITION DECISION: NEW PRIOR ART AND NEW REQUESTS BEFORE THE COURT OF APPEAL

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In a previous article (available here), the question of whether the patent proprietor could file new auxiliary requests in response to new prior art produced at the stage of appeal against a decision of the French Patent Office (INPI) ruling on opposition against a French patent was left open. The ruling of 26 September 2025[1], handed down in the fourth appeal decided by the Paris Court of Appeal, provides an answer.

The decision first examines the nature of appeals against decisions ruling on opposition against a French patent. The appellant requested the annulment of the opposition decision. In response, the respondent raised the inadmissibility of this request. The court dismissed the request for inadmissibility, pointing out that this kind of appeal was an appeal for reversal[2] and that appeals for reversal give the court jurisdiction over the entire dispute. Thus, the request for annulment of the decision could only seek its reversal. The court confirmed its position adopted in a previous decision[3], in which it had ruled that it had jurisdiction to hear a request for annulment due to the devolutive effect attached to the appeal for reversal.

On the merits, the appellant-opponent produced three new prior art documents in the appeal[4], which the court deemed insufficient to destroy the novelty of the patent upheld as amended by the INPI, but sufficient to deprive claim 1 of inventive step. For the first time, the Court of Appeal therefore reversed an opposition decision, but on the basis of new prior art documents.

This brings us to the second and most important lesson to be learned from this ruling, concerning the admissibility of a new auxiliary request submitted at the appeal stage. The issue is not new, as it has already arisen in two previous cases. The Court of Appeal had declared new auxiliary requests inadmissible, considering in the first case that no new prior art document had been produced[5] and in the second case that the new requests were intended to respond to the ground of added-matter already raised before the INPI[6] .

The question therefore remained open as to whether the patent proprietor could file new auxiliary requests in response to new prior art documents. The court's previous clarification that no new prior art had been produced to justify the inadmissibility of new auxiliary requests suggested that the presence of new prior art could legitimize the admissibility of a new request. However, this is not the reasoning followed by the court in the present case, which declared the new auxiliary requests inadmissible for the third time.

The Court of Appeal first held, in line with its previous decisions on this subject, that auxiliary requests made for the first time on appeal are not new grounds but new claims. These claims are new because they do not seek the same ends as those submitted before the INPI, but aim to obtain different scope of protection.

Under the terms of Article R.411-38(2) of the French Intellectual Property Code, these new claims are automatically inadmissible unless they relate to issues arising from the intervention of a third party or the occurrence or disclosure of a new fact.

The court considers that the production of new prior art documents in appeal is not a sufficient reason to admit a new auxiliary requests. It holds that the new prior art cited is not new fact since it forms part of the state of the art, therefore pre-existed at the time of filing and could have been taken into account when drafting the patent.

The solution adopted differs from the practice before the Boards of Appeal of the European Patent Office.

Before the Boards of Appeal, Article 12(4) of the Rules of Procedure requires justification for the production of new prior art[7] and Article 12(6) prohibits the intentional withholding of prior art pending appeal[8]. On the contrary, before the Court of Appeal, the patent proprietor cannot oppose the production of new prior art. Article R.411-38 of the Intellectual Property Code expressly authorizes the parties to invoke new arguments before the court, to produce new documents or to propose new evidence.

Furthermore, in the presence of new admissible prior art, the EPO Boards of Appeal allow the patent proprietor to respond with new arguments and/or new requests, in accordance with the right to be heard guaranteed by Article 113(1) of the European Patent Convention[9]. On the contrary, according to the ruling in this case, only new arguments are admissible before the Court of Appeal in response to new prior art.

The patent proprietor finds himself in a particularly unfavorable position before the Court of Appeal: he cannot oppose the production of new prior art, while at the same time being prohibited from filing new auxiliary requests in response to it.

It remains to be seen whether the court's reasoning will stand up to the convergent interpretation between the EPO and the INPI sought by the Court of Cassation[10] .

If confirmed, such a practice could lead to procedural abuse by encouraging opponents to retain certain prior art specifically for the appeal phase, as the INPI rightly pointed out in his observations. It would also encourage the patent proprietor to file multiple auxiliary requests before the Opposition Commission in order to anticipate as many back-up solutions as possible, including in the event of prior art of which he is not even yet aware.

Finally, for the first time, the Court of Appeal decided that neither party should bear non-recoverable costs, ordering the appellant, the “losing party”, to pay only the legal costs. Although the appellant-opponent failed to obtain revocation of the patent, which was upheld in accordance with auxiliary request No. 2 (an admissible request as it had already been filed before the INPI), it did obtain a reversal of the decision. The court therefore considered it fair that each party should bear its own costs.

It is also questionable whether the court would have reached the same conclusion on the admissibility of auxiliary request No. 1, had auxiliary request No. 2 been found insufficient in light of the newly cited prior art documents to permit maintenance of the patent in an amended form.

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[1] Paris Court of Appeal, Pôle 5 – Chambre 1, 26 September 2025, Case No. 23/06726

[2] Article R.411-19 of the French Intellectual Property Code:

> *Appeals lodged against the decisions referred to in the first paragraph of Article L. 411-4 are appeals for annulment.*
>
> *Appeals lodged against the decisions referred to in the second paragraph of the same Article L. 411-4 are appeals for reversal. They refer the entire dispute to the court. The court rules on the facts and the law.*

[3] CA Paris, Pôle 5 – Chambre 2, 4 July 2025, RG No. 23/16553

[4] None of these three prior art references were cited in the Preliminary Search Report.

[5] CA Paris, Pôle 5 – Chambre 1, 9 April 2025, RG No. 23/14096:

> *[…] it should also be noted that it is not disputed that Koopman is invoking the same grounds for opposition and the same prior art documents before the Court of Appeal as those invoked before the INPI during the opposition proceedings*

[6] CA Paris, Pôle 5 – Chambre 2, 4 July 2025, RG No. 23/16553:

> *Furthermore, 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 a prohibited intermediate generalisation, which was at issue, responded to it.*

[7] Article 12(4) §2 of the Rules of Procedure:

> *The party shall clearly identify each amendment and provide reasons for submitting it in the appeal proceedings.*

[8] Article 12(6) §2 of the Rules of Procedure:

> *The Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.*

[9] See the Guidelines for Examination in the European Patent Office, April 2025, E-VI, 2.2.4, in the case of new prior art, the proprietor may file a new request:

> *Similarly, where the opponent files pertinent new material, the patent proprietor must be given a chance to present comments and submit amendments.*

[10] Cass. Com., 30 August 2023, appeal no. 20-15.480