

ARTICLE

REVOCATION, PROVISIONAL ENFORCEMENT AND LIMITATION: HEADS I WIN, TAILS YOU LOSE...

Patent Law | 27/10/25 | Grégoire Desrousseaux Geoffroy Thill



The Paris Court of Appeal has ruled a second time on the possibilities of limitation by the patentee, following a decision by the court of first instance to revoke a patent subject to provisional enforcement (No. RG 23/01389 dated 24/10/2025).

The Court of Appeal considers that the limitations of the patent before the French patent office (INPI), subsequent to the judgment, are *irregular and therefore unenforceable against the respondent*.

This decision goes even further than that of 16 May 2025^[1], which had held that, by failing to inform the INPI of the judgment, the limitation obtained was deemed fraudulent and therefore unenforceable.

Likewise, in the present case the INPI was not informed of the judgment; but the Court of Appeal does not appear to link this lack of information to the unenforceability of the limitation; it appears sufficient that the limitation concerns claims revoked under provisional enforcement.

The Court of Appeal also rejects the limitation request filed before it, which sought to restrict the scope of the patent to the claims as already limited by the INPI.

Therefore, the possibility for the patentee to limit the patent in light of the judgment appears to be seriously compromised.

Limitation before the INPI seems to have become impossible: the limitation is unenforceable due to provisional enforcement, or even fraudulent if the INPI was not aware of the judgment. The INPI also seems to have adopted the practice of refusing limitations once it is informed of the judgment.

A judicial limitation appears uncertain: in 1994, the Supreme Court (*Cour de cassation*) confirmed the possibility for judicial courts to limit a patent under what are now Articles L.613-25 and L.614-12 of the French Intellectual Property Code: *if the grounds for revocation affect only part of the patent, revocation is pronounced in the form of a corresponding limitation of the claims*^[2]. The patentee was referred to the Director of the INPI in accordance with the provisions now contained in paragraph 3 of Article L.613-27 of the French Intellectual Property Code.

Since this ruling, only two first instance judgments have recognized the possibility for the judicial court to limit the patent – without referring the matter back to the INPI^[3]. Meanwhile, the Court of Appeal does not appear to have confirmed the possibility of such a limitation before it since 1992...

And yet the right of the patent holder to limit is well established:

- Article 138(3) of the EPC confirms the right of the patent holder to request limitation of the European patent *in proceedings before the competent court or authority* – without any limitation,
- Article L.613-24 of the French Intellectual Property Code provides that *the owner of the patent may at any time (...) limit the scope of the patent by amending one or more claims*.

The question remains as to what effect provisional enforcement has on revocation: unlike payment, revocation does not entail enforcement... except for the registration of the decision in the National Patent Register^[4] which was expressly excluded from provisional enforcement by the court. This raises the question of actual effects of provisional enforcement when the judgment contains no enforceable provision.

Pending clarification by the Court of Cassation:

- the effects of provisional enforcement on revocation,
- the ability to limit claims before a court (and whether or not referral to the INPI is necessary),

it would undoubtedly be simpler for the court of first instance to refrain from systematically accompanying decisions declaring revocation with provisional enforcement...



[1] Paris Court of Appeal, 16 May 2025, No. RG 23/11407. In this case, the limitation concerned the combination of claims 1 and 11, both of which were revoked. In the case of 24 October, the limitation concerned the introduction of features from the description into independent claims 1 and 8.

[2] Cass. Com., 15 November 1994, No. 93-12.917

[3] Paris Court of Appeal, 24 March 2023, No. RG 20/03907 and Paris Court of Appeal, 14 September 2023, No. RG 22/08669

[4] This registration does not fall within the scope of provisional enforcement (Article L.613-27, paragraph 2 of the French Intellectual Property Code). This was expressly stated in the operative part of the judgment.

