



ARTICLE



EMPLOYEE INVENTION: PRACTICAL IMPLICATIONS OF THE NEW INFORMATION OBLIGATION FOR EMPLOYERS

Intellectual Property, Media, and Art Law Patent Law | 22/10/15 | Grégoire Desrousseaux François Pochart

Article 175 of Law no. 2015-990 dated August 6, 2015 – also called the "Macron Law" – amends Article L. 611-7 of the French Intellectual Property Code by introducing an obligation for the employer to provide information. Now, Article L. 611-7 provides that:

The employer informs the salaried author of such invention in the event that such invention is subject to the filing of an application of an industrial property right and that such right, if any, is granted.

This article applies to inventions under mission ("*inventions de mission*"), i.e. inventions performed by a salaried employee in the course of his/her employment contract while carrying out an inventive mission, or during studies or research entrusted to him/her (as a reminder, the invention under mission vests in the employer and implies the payment by the employer of an additional remuneration to the salaried employee).

This obligation applies to all applications filed **as from August 8, 2015**, which corresponds to the entry into force of this provision. The article does not refer to pending applications on that date. Therefore, it may be prudent to promptly inform salaried employees of the grant of rights even if such applications were filed prior to the entry in force of the Law.

All industrial property rights should be covered. These rights include, of course, patents, divisional applications, utility certificates, probably supplementary protection certificates, but also maybe each foreign right. It may be prudent not to be limited to only national rights but to cover all rights, including the European patent – especially if it is effective in France. Indeed, the grant of a patent abroad is one of the elements identified by the CNIS (French National Commission for Employees' Inventions) and the courts for the assessment of the additional remuneration.

The employer shall inform all salaried employees who are the authors of an invention under mission. Where the text is silent, in addition to French salaried employees who are the authors of an invention under mission in France, there is no reason to exclude, including:

- French salaried employees on secondment who are the authors of an invention under mission outside France, employed by a French company,
- Foreign employees who are the authors of an invention under mission in France, or
- Former employees.

In the absence of specific provisions, **the employer remains free to inform the salaried employee according to processes he determines.** For example, that information can be provided with a transmission of:

- A copy of the patent application and of the grant, if applicable,
- Filing forms, or
- A simple statement by the employer.

There is no time limit imposed for giving that information. We consider it is cautious to comply with a reasonable time limit (not exceeding several months).

The Law does not provide any sanction against the employer who failed to comply with its information obligation. However, we can easily imagine that **any breach will necessarily harm the employer at the level of additional remuneration litigation.** Indeed, the salaried employee will certainly be able to raise the breach of the employer to challenge the limitation period (often invoked by the employer) of its payment application on the grounds that he was not informed of the filing, if applicable, of the grant, information that the inventor could consider as essential to be able to assess the amount of the claimed remuneration.

Considering the major financial challenges involved, the implementation of ad hoc internal processes is highly recommended. Contrary to the wishes expressed by the Lawmaker, we are concerned that this new obligation does not "*prevent any dispute that may arise concerning additional remuneration*".

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