

Amendment of patent claims in France

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Amendments of claims

Content

- 1. Partial revocation of a claim by Court
(only possibility until January 1, 2009)
- 2. *Ex-parte* limitation by the patentee
before the French patent office
(additional possibility since January 1, 2009)

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Amendments of claims

1. Partial revocation of a claim by Court (only possibility until January 1, 2009)

- Articles L. 613-25 and L. 613-27 of the French Intellectual Property Code for national French patents
- Article L. 614-12 of the same Code for European patents

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Amendments of claims

Classical scenario

- A party requests the Court to revoke a claim
- The patentee replies that the claim is only partially invalid and requests a limitation

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Other theoretical scenario

- Theoretically, a patentee is allowed to take the initiative to request the Court to hold a claim partially invalid
- However, in practice, this strategy is not satisfactory

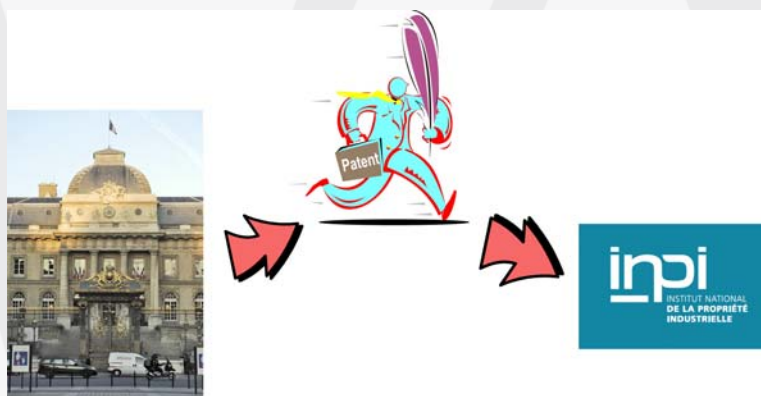
Partial nullity grounds

- Most often, partial nullity of a claim is pronounced for one or – some – of the various options covered by said claim
- Case law shows all the nullity grounds:
 - ▶ Extension beyond the content of the description as filed
 - ▶ insufficiency of disclosure
 - ▶ lack of industrial applicability
 - ▶ lack of novelty
 - ▶ lack of inventive step

Power of the French Court for French patents (1/2)

- For French patents (Article L. 613-27 of the French Intellectual Property Code) :
 - ▶ the patent owner is referred to the French patent office in order to submit an amended claim drafted in accordance with the judgment
 - ▶ the Director of the French patent office has the power to reject the amended claim for lack of compliance with the judgment
- For European patents, Article L. 614-12 does not mention any referral to the French patent office

Power of the French Court for French patents (2/2)




Comparison of the rules applying to French and European patents

French patents	European patents
Only the claim can be limited	Amendments can be brought to the claim, the description and the drawings
Scope broadening not prohibited but not retroactive	Scope broadening prohibited
Retroactive except in case of claim scope extension	Retroactive
<i>Erga omnes</i>	<i>Erga omnes</i>


Comments about partial claim revocation by Courts in France


- ▶ Rarely requested
- ▶ Judges seem suspicious
- ▶ Ambiguous case law
- ▶ Not comparable to the amendments possible during opposition before the EPO
- ▶ Not appropriate for voluntary limitations


Amendments of claims

2. Ex-parte limitation by patentee before the French patent office (additional possibility since January 1, 2009)

- French provisions, applicable since January 1, 2009:
 - ▶ Act n° 2008-776 of August 4, 2008
 - ▶ Decree n° 2008-1471 of December 30, 2008
- Articles of the French Intellectual Property Code integrating the above provisions:
 - ▶ amended Article L. 613-24 (general)
 - ▶ amended Article L. 613-25 for national French patents
 - ▶ amended Article L. 614-12 for European patents
 - ▶ amended Article R. 613-45


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Amendments of claims


Article L. 613-24 of the French Intellectual Property Code

“ *The owner of a patent may at any time relinquish either the entire patent or one or several claims of the patent, or limit the scope of the patent by amending one or several claims.*

The petition for relinquishment or limitation shall be filed before the National Institute of Industrial Property, as specified in detail by Decree

(...) ”




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IP rights subject to limitations

- National French patents
- French designation of European patents (this seems to derive from Article L. 613-24 although not specifically provided)
- National French supplementary protection certificates

Who can request the limitation ?

- The owner registered on the French patent register
- In case of co-ownership, all the co-owners together
- The owner(s) representative
- In case of rights granted to third parties (e.g. licence), the patentee must prove the consent of all the IP rights owners

When may limitation be requested ?

- French law provides:
 - ▶ « at any time »
 - ▶ even while a revocation action is pending
- To be confirmed by case law:
 - ▶ even while the case is pending before the *Cour de Cassation* (French highest Court for civil matters)
 - ▶ even while an opposition is pending before the EPO

How ?

- Filing a form before the French patent office
- Filing the amended set of claims, and if any, the description and figures as amended
- Paying a fee of € 250

Requirements ?

- No extension of the scope of protection (Article L. 613-25 d))
- The claim must be clear, concise and supported by the description (Article L. 612-6)

Effects of the limitation ?


- Limitation entered on the National patent register
- Retroacts to the filing date of the patent application (Article L. 613-24, § 2)
- *Erga omnes* effect

Amendments of claims

Impact on infringement or nullity proceedings, if any ?

- Most probably, a stay of the proceedings

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Amendments of claims

How many times ?

- If the owner « *makes a plurality of limitations of his patent, in a dilatory or abusive manner* », he may be liable to damages or even a civil fine of up to € 3,000 (Articles L. 613-25 and L. 614-2 respectively for French and European patents)

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Comments about limitation procedure

- A long felt need in France
- Allows to strengthen the patent before starting a litigation
- Risk of abuse ?

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Thank you
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