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PROTECTION OF AN INVENTION MADE IN FRANCE : Is an initial protection in France necessary?

As a general rule, the first patent application covering any invention made in France must be initially filed in France, whatever the nationality of the inventor and of the applicant may be.

1. This rule is a consequence of Articles L.612-8 to L.612-10 of the French Intellectual Property Code regarding prohibition of disclosure for National Defense reasons.

In particular Article L.612-9 sets forth:

"Inventions which are the subject of patent applications may not be disclosed or freely worked until an authorization to that effect has been granted.

Until such time, patent applications shall not be made available to the public, no true copy of the patent application shall be issued, except where authorized, and the procedures under Articles L.612-14, L.612-15 and item 1 of Article L.612-21 may not be instituted.

Subject to Article L.612-10, the authorization referred to in the first paragraph of this Article may be granted at any time. Authorization shall be automatic on expiry of a period of five months from the filing date of the patent application.

The authorizations referred to in the first and second paragraphs of this Article shall be granted by the Minister responsible for industrial property after having obtained the opinion of the Minister responsible for defense."

2. Similar stipulations are provided for by Articles L.614-3 to L.614-5 of said Code regarding the filing of a European patent application; the authorization is deemed to be granted on expiry of a period of four months from the filing date of the European patent application.

In addition Article L.614-2 sets forth, in its second alinea,

"An application must be filed with the National Institute of Industrial Property if the applicant has his place of residence or business in France and is not claiming the priority of an earlier filing in France."

And a similar stipulation is provided for regarding the filing of an International (PCT) application (Article L.614-18 of the Code); the authorization is deemed to be granted on expiry of a period of five months from the filing date of the PCT application.

3. The penalties provided for in the case of violation of these stipulations are criminal ones.

In particular, Article L.615-13 of the Code sets forth:

"Notwithstanding the heavier penalties provided for with regard to violation of State security, any person who knowingly violates any of the prohibitions laid down in Articles L.612-9 and L.612-10 shall be liable to a fine of 30,000 francs. Where the violation has prejudiced national defense, imprisonment of five years may also be ordered."

Similar penalties are provided for with respect to European patent applications (Article L.615-16 of the Code).

4. According to the stipulations above mentioned, particularly those of Article L.615-13 of the Code, it clearly appears that an initial filing at the French Patent Office is compulsory not only with respect to inventions likely to concern National Defense but also with respect to any and all other inventions.

5. The following French regulations are also to be taken into account:

- the Law N° 80.538 of July 16, 1980 prohibits the communication of documents and information of economic, commercial, industrial, financial or technical nature from a French citizen or person having its normal place of business in France to foreign authorities, individuals or corporate bodies when such communication can injure French economic interests or French public order.

- the French New Penal Code rules, in its Title I "Injuries to fundamental interests of the Nation", a very extensive definition of which is given by Article 410.1:

" The fundamental interests of the Nation consist in (...) essential elements of its scientific and economic potentialities...".

This Article 410.1 indicates several fields of application of this stipulation and amongst them refers to the above-mentioned Law of July 16, 1980 and to the penalties provided for by said Law.

Articles 411.1 to 413.12 of the New Penal Code deal with various forms of injuries to the fundamental interests of the Nation, in particular injuries to National Defense secret (Articles 413.9 to 413.12) and communication of information to a foreign country (Article 411.6).

- Finally Article L.621-1 of the Intellectual Property Code sets forth criminal penalties in the case of violation of manufacturing secrets.

6. As a consequence of all the stipulations above-mentioned, the filing outside France of an initial patent application covering an invention made in France, whether said invention is likely to concern National Defense or not, is strongly inadvisable; in particular the notion of "essential elements of the scientific and economic potentialities of the Nation" mentioned in the French New Penal Code should be interpreted in the broad sense: even if it is difficult to consider that any invention for which a patent application is foreseen corresponds to this definition, it is to be noted that the economic value of an invention often appears later on, for example when the working is undertaken.

7. We wish to point out that it is possible to ask the Ministry in charge of National Defense for an exceptional authorization for the filing, outside France, of the initial patent application covering an invention made in France.

It appears that such authorization can presently be obtained rather quickly provided that a full description of the concerned invention be enclosed to the request.

However, it is to be noted that the authorization given by the Ministry of Defense expressly refers only to the prohibition of disclosure and free exploitation, that is to say to the stipulations of Articles L.612-8 to L.612-10 of the Intellectual Property Code.

As a result our opinion is that such authorization does not allow to consider that the other French regulations mentioned in paragraph 5 above do not apply to the concerned invention.

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