

## PATENTS

# The French Patent System

### **How to obtain a French National Patent**

Patent protection in France can be obtained by filing either an application for a French National Patent, or by designating France, be it in a European Patent application or in a PCT application.

However, if France is designated in a PCT application, the only means of obtaining protection in France by virtue of that PCT designation is via the European phase of the PCT; i.e. it is not possible to convert a PCT designation of France into a *national* patent application, such as for Germany or the UK. This is because, when ratifying the PCT, France used the possibility offered by Article 45(a) PCT.

(Other states having the same compulsory Euro-PCT route when designated in a PCT application are Italy, Belgium, Cyprus, Greece, Ireland, Monaco and The Netherlands.)

This paper deals only with the French National Patent System. The following covers the recent modifications of the French Intellectual Property Code resulting from the Law on Modernization of the Economy of August 4, 2008 (Law N°2008-776), which has in particular introduced provisions similar to those of the European Patent Convention (EPC) 2000 and of the Patent Law Treaty (PLT).

### **Application**

The application may be filed in any language. If a foreign language is used, a French translation must be filed within two months.

It is now possible to obtain a filing date even if no claims are filed or by mere reference to a previously filed patent application. However, within two months, the applicant must then file claims or the previously filed patent application (or its translation in French if needed).

The inventors must be designated. A certified copy of the priority document must be filed but no translation is required except for the cover page. No power of attorney is needed if the application is filed through a registered patent attorney.

### **Formal Examination**

A formal examination is carried out by the French Patent Office before the application proceeds to search.

Apart from checking whether formal drafting requirements are met, the main objects of the formal examination are to determine whether the claimed invention is of patentable nature and whether the claims cover one invention only.

The definition of patentable inventions given in the French IP Code is the same as the one given in the EPC. In particular, programs for computers as such and business models are not patentable.

The provision regarding unity of invention is also the same as in the EPC. Unity of invention requires all claims to be linked by a common inventive concept.

It is possible to include in a same application independent claims directed for example to a product, a process to obtain such a product and a use of that product. The common inventive concept may lie in the original features of the product.

It is also to some extent possible to include several independent claims of the same category, such as several product claims. A common inventive concept will then be recognised when the claims show a same set of features which, when taken in combination, distinguish over the prior art.

However, by Decree No 2007-280 of March 1st, 2007, France has introduced the same provisions as former EPC Rule 29(2) (EPC2000 Rule 43(2)). Examination may now become more severe regarding patent applications having several independent claims in the same category. In particular, the applicant may be required to change those independent claims into a set of claims including a main claim, covering the features which define the common inventive concept, and dependent claims linked to that main claim.

Facing a grounded objection of lack of unity of invention, the applicant may select only one set of claims relative to a same invention, or divide the application. In the first case, the possibility is offered to file divisional applications at a later stage, the time limit for this case expiring upon payment of the final grant and printing fees for the parent case. The lack of unity objection can be raised by the French Patent Office before search, or upon issuance of the (Extended) Preliminary Search Report. In the latter case, the search would be completed for the invention covered by the first group of claims only.

For this reason, it is advisable that this first group of claims be dedicated to the "most important" invention for the applicant.

### **Search Procedure**

The search fee must be paid upon filing or within a time limit of 1 month. Belated payment (with a 50% surcharge fee) is possible within two months following receipt of a relevant official communication.

A patent application can be converted to an application for a Utility Certificate within a time limit of 18 months starting from the priority date (or filing date when no priority is claimed). Utility Certificates are short-term patents. Their maximum duration is 6 years. They are subject to same patentability conditions as patents, but are granted without substantive examination.

The search results are in the form of a "Preliminary Search Report" having the same structure as a European or PCT Search Report. An Extended Preliminary Search Report is issued for applications filed after 1st July 2005. It consists of a Preliminary Search Report and a written opinion. The written opinion is not published with the application but is accessible to third parties with the other documents of the file after publication. When the application is a first application (no priority claimed), the Preliminary Search Report, drawn up by the EPO as subcontractor, is usually sent to the applicant within 9 months from the filing date. The applicant receives the result of the search within the priority year, before the end of the time limit for filing parallel patent applications abroad.

When the application is a second application (priority claimed), the Preliminary Search Report is often established later (one or even several years after filing). Publication of the Preliminary Search Report is then made separately from the earlier publication of the application as filed.

It should be noted that a Provision was introduced in the French IP Code by the Decree N°2007-280 of March 1<sup>st</sup>, 2007, allowing the French Patent Office to request, before the drawing up of the Preliminary Search Report, that the applicant discloses the prior art cited in parallel proceedings in other countries, when the application is filed under priority. With respect to such applications claiming priority rights, the Preliminary Search Report is now drawn up by the French Patent Office itself, not by the EPO.

### **Publication of the Application**

All French national patent applications are published 18 months after the filing date or the (earlier) priority date, if any.

### **Examination**

It is compulsory to file a response to the Extended Preliminary Search Report within a (renewable) time limit of 3 months when documents are cited other than in the “A” category. If no response is filed, despite it being compulsory, the French Patent Office issues an invitation to respond within a given time limit. Failure to file a response before the final deadline will lead the application to be rejected. The Extended Preliminary Search Report should then be considered as an Office Action which needs to be answered when documents deemed to be relevant (other than “A” documents) are cited.

The French Patent Office is entitled to reject patent applications for lack of novelty, but it is not entitled to reject patent applications for lack of inventive step.

When responding to the Extended Preliminary Search Report, applicants should nevertheless amend the claims:

- not only so that they can be held novel, whereby a patent can be obtained,
- but also so that at least one of the claims would not only be held novel but also probably not obvious to resist any request for invalidation of the patent during possible future Court proceedings.

Indeed, the response to the Extended Preliminary Search Report is normally the last opportunity given to the applicant to amend the claims.

When the written opinion that accompanies the Preliminary Search Report raises objections other than lack of novelty/inventive step, such as lack of clarity objections, it is advisable to also address such issues when responding to the Extended Preliminary Search Report.

Examination is continued on the basis of the prior art cited in the Preliminary Search Report, possible third party observations and response(s) made thereto by the applicant.

The first step of the substantive examination consists in checking that all claims are novel. Lack of novelty of one or several claims may lead to rejection of the application if no satisfactory further amendment is made to the objected claims.

If the examiner rejects the application, the applicant may appeal against the decision to reject before the Paris Appeal Court.

Based on the pending claims, the examiner will decide whether documents need to be retained in the final Search Report because, in his opinion, they may affect inventive step. Thus, the mention of documents in the (final) Search Report with respect to some claims is an indication of the opinion of the examiner that validity of those claims could possibly be challenged for lack of inventive step.

It is only the judge, when the validity of a granted French patent is challenged before the Court, who is entitled to invalidate a patent (partially or totally) for any legal ground, including lack of inventive step. The judge is in no way bound by the opinion of the examiner.

The French patent granting system is advantageous in that it leaves the applicant with the responsibility and freedom to draft the claims optimally in view of the prior art cited and otherwise known to him. There is no obligation to give any explanation or reasons for the amendments made to the claims. It is even recommended to avoid making statements that could be used in the future to force some limited interpretation of the claims.

In this respect, the fact that French examiners are not allowed to reject an application for lack of inventive step may make it possible for the applicant to overcome lack of unity objections by filing a broad main claim which would be novel but not inventive, and sub-claims more precisely directed to the various inventions. In a similar situation, at the EPO, such a broad main claim would not be accepted, thus making the filing of divisional applications unavoidable.

### **Amendments**

Amendments to the claims are possible until the search starts and within the time limit set for the reply to the Extended Preliminary Search Report.

The French Patent Office is generally more flexible than the EPO to allow claim amendments, provided of course that adequate support can be found in the original specification as filed. However, contrary to the EPO practice, the drawings cannot provide such support.

Of course no new matter may be introduced but correction of obvious errors is possible (up to grant).

### **Grant**

When the (final) Search Report has been established, the applicant is invited to pay the grant and printing fees.

The granted patent is published with the (final) Search Report, so that the public is informed as to whether some documents are believed by the examiner to possibly affect the validity of some claims.

No opposition procedure is provided for in the French Patent System. This is a further advantage, in addition to the above-stated relative freedom and flexibility to introduce claim amendments.

### **Post-Grant Limitation**

Limitation of a French patent (either a French national patent or the French part of a granted EP patent) may now be requested by the patent owner as appearing in the French Patents Register.

The request has to be filed with the French Patent Office together with the text of the amended claims and the possibly amended description.

The request is granted provided that the changes made appear to be properly supported and actually consist in a limitation.

### **Invalidation**

Invalidation of a patent is generally requested as a counter-claim in patent infringement suits. It may also be requested as a main claim, by initiating an invalidation action before the Court. This is however very seldom done because the legal proceedings may be long and complete invalidation of a patent is not easy to obtain. The position of a defendant in a patent infringement suit may be more comfortable than the position of a plaintiff in a patent invalidation suit because, in the former case, a possibility is given to avoid infringement by partial invalidation or limitation of the scope of the claims, without requiring complete invalidation.

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### **Conclusion**

France has adopted an intermediary step between a system of complete patentability examination and a mere registration system, which gives applicants a greater flexibility to amend the claims with respect to the prior art, without risking the rejection of the application for lack of inventive step.

The recent changes introduced to make the French IP Code consistent with the revised EPC and with the PLT have brought more flexibility: possibility to file in any language, simplification of the requirements to obtain a filing date, and possibility of post-grant limitation, but no opposition system has been introduced.

The above makes the French Patent system attractive. It is only regrettable that a French national patent cannot be obtained via the PCT route since designation of France in a PCT application is treated in the same way as an EP designation covering France.