



beau de Loménie

THE FRENCH PATENT SYSTEM

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How to obtain a French National Patent or Certificate of utility

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

However, based on a PCT application, the only way to seek patent protection in France is via the European phase of the PCT.

This paper deals only with the French National Patent System, addressing both patents and certificates of utility.

French National Patent

Filing

The patent application can be filed in any language but a French translation is required within two months following receipt of a Communication issued by the French Patent Office (INPI) shortly after the filing date.

The patent application is to be filed in docx format, using the dedicated web interface of the French Patent Office (e-procedure).

It is possible to obtain a filing date even if no claims are filed. However, the applicant is then invited to file claims within 2 months from receipt of a communication.

A filing date can be obtained by mere reference to an earlier-filed application in a Paris Convention country, provided that the country, number and filing date of the earlier application are provided to the French Patent Office. However, within four months the applicant must submit a certified copy of the earlier patent application and its translation into French.

The inventors must be designated no later than 16 months after the application date or the (earliest) priority date.

No power of attorney is needed to authorize the attorney filing the application.

Priority

If the priority of an application filed abroad is claimed under the Paris Convention, the FR application should be filed within 12 months of the earliest priority date and the date and country of the priority application(s) should be submitted at the time of filing the FR application.

A certified copy of the priority application must be filed within 16 months of the earliest priority date, together with an English (or French) translation of the front page, but no additional translation is required. The French Patent Office has entered into the DAS system on December 1, 2020. Hence, automatic retrieval of the priority document with offices also belonging to the DAS system will be possible.

In case of errors, it is sometimes possible to claim priority even if the FR application was filed up to 14 months after the earliest priority date ("restoration of the priority right"), and it is sometimes possible to add a missing priority claim if addition is requested within 16 months of the earliest priority date.

Formalities Examination

A formal examination is carried out by the French Patent Office before a prior art search.

In this process, compliance with formal requirements is checked (e.g. adequate support for the claims in the specification). Also, it is determined whether the claims are clear and cover only one invention, and whether the claimed invention is patentable subject matter.

The definition of patentable inventions given in the French Intellectual Property Code is the same as in the European Patent Convention. In particular, programs for computers as such and business methods are not patentable.

Unity of invention

The provisions regarding unity of invention are 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.

French patent law has a provision similar to Rule 43(2) EPC, prohibiting the presence of several independent claims of the same category, except in specific situations (interrelated products; different solutions to the same particular problem; difference uses of a product or a device).

Search Procedure

The search fee must be paid upon filing or within a time limit of 1 month from the filing date. Late payment (with surcharge) is possible within two months following receipt of an official communication in this respect.

The search results are in the form of a "preliminary search report" with written opinion, having the same structure as a European or PCT search report.

When the application is a first filing (no priority claimed), the search is carried out by the European Patent Office acting as a subcontractor for the French Patent Office, and the extended preliminary search report is usually sent to the Applicant within 9 months from the filing date.

When priority is claimed, the search procedure has two steps¹:

I. Information on prior art

About two years after the priority date, the French patent office invites the applicant to provide information on documents cited in relation to the application(s) claiming the same priority. The response must be filed within a time limit of 2 months, extendable once by 2 months.

Although replying is mandatory, this is not the same as an IDS in the US, as there is no risk of sanctions should the Applicant fail to communicate a prior art document. This procedure was implemented to provide guidance to the French patent office for their search.

Together with the response to this invitation, the applicant can file amended claims, if he so wishes.

II. Preliminary search report

Taking account of information provided by the applicant at stage i), the search is carried out by the French patent office, and the preliminary search report with written opinion is issued.

Conversion

A French Patent application may be converted into a Utility Certificate application at any time within 18 months from its filing date or, if a priority is claimed, from the earliest priority date.

¹ In exceptional cases, where the French patent office lacks the resources for conducting the search of the invention, the search is conducted by the EPO as if the application were a first filing.

[Publication of the application](#)

All French national patent applications are published 18 months after the filing date or the (earlier) priority date. Early publication can be requested. In case the preliminary search report is issued after publication of the application, said search report is published separately.

[Observations by third parties](#)

Third parties may file observations within 3 months from publication of the preliminary search report. Anonymous observations are not accepted.

[Response to the Preliminary Search Report](#)

It is compulsory to file a response to the preliminary search report within a (renewable) time limit of 3 months when documents are cited in a relevant category (mainly: noted "X" or "Y").

Due to a change in the law implemented in 2020, two situations apply, depending on the filing date of the patent applications.

1- Patent applications filed before May 22, 2020

For such applications, the grounds for rejection by the French Patent Office do not include a lack of inventive step. Of course, even for such patent applications, inventive step is a criterion for patentability in France and will be discussed in litigation if the granted French patent is challenged in Court.

2- Patent applications filed on May 22, 2020 and later

Lack of inventive step is a further ground for rejection for such applications. Importantly, this applies also to Divisional applications of which the filing date (which is the one of the parent application) is earlier than May 22, 2020, but which were actually filed on that date or later. The Guidelines for examination invite the Examiners to use the "problem-solution" approach for assessing inventive step. As such, their approach is similar to the one prevailing at the European Patent Office, although one may expect that the French examiners might be less severe than their colleagues of the EPO.

In addition, in both situations 1 and 2, the French Patent Office is allowed to reject a patent application for new matter, lack of enablement or lack of unity.

If the Examiner considers that there are grounds to reject the claims as filed in response to the Preliminary Search Report, a Communication of non-compliance is issued. The (renewable) time limit is set by the Office and is normally two months.

Although no new matter can be introduced in any claim amendments, there is a little more flexibility for the amendments than at the European patent office.

[Substantive Examination and drawing up of the final search report](#)

Substantive examination is carried out based on the prior art cited in the preliminary search report, possible third party observations and response(s) made thereto by the Applicant. A final search report is then drawn up by the Examiner, to be appended to the granted patent.

[Acceleration of Examination/PPH](#)

Since December 2015, it is possible to request acceleration of examination.

The acceleration request shall be made within 10 months from filing and shall include a request for early publication (except if publication has occurred already).

No official fee is due.

In order to be accepted for accelerated prosecution, the application must be in condition for rapid examination. In particular, the claims must be clear enough for a complete preliminary search report to be issued.

A request for extension of a time limit for responding to an office action risks cancellation of the accelerated proceedings.

The French patent office endeavours to complete examination within 20 months. In case objections are raised in the preliminary search report, this time frame may not apply, but the French patent office would avoid any undue delay if the applicant plays along. The 20-month time frame would not apply either if third parties observations are filed.

PPH (Patent Prosecution Highway) is available for a French patent application claiming the priority of a Japanese patent application or a PCT application having matured into a Japanese national phase. This PPH program is implemented in the framework of a Pilot Program conducted until December 31, 2022. At that point, the pilot program may be extended or the PPH program may be confirmed. So far, no PPH agreements have been signed between the French patent office and any other patent office.

The PPH request is available as long as substantial examination of the French patent application has not started. No official fee is due. The French patent office recommends filing the PPH request within 12 months from filing the French patent application.

Together with the PPH request, the following elements are requested:

1. a claim correspondence table or a statement that the claims filed in France are identical to the Japanese claims deemed allowable (mandatory),
2. copies of Japanese office actions relevant to substantial examination for patentability,
3. translation (into English or French) of such office actions,
4. copies of all claims determined to be patentable by the JPO,
5. translation of such claims;
6. copies of the references cited by the JPO (if other than patent literature).

If elements 2 to 5 are available via the JPO electronic file (<https://www.j-platpat.inpit.go.jp/>), it is possible to merely invite the French patent office to retrieve these elements.

If the PPH request is found admissible, examination of the French patent application would be expedited.

Rejection

If the Patent application is rejected, the Applicant may initiate an Appeal against the decision before the Paris Court of Appeal.

Grant

When the final search report is drawn up, 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 whether some documents are believed by the Examiner to possibly affect the validity of some claims.

Post-grant opposition

The opposition procedure was implemented in 2020 and is available for any French Patent granted on April 1, 2020 or later.

Within 9 months from publication of the grant of the patent, any third party can file an opposition at the French Patent Office. The grounds for oppositions include lack of patentability, lack of enablement (insufficient disclosure of the invention) and extension of the scope of the granted patent.

The opposition procedure comprises a written phase and oral proceedings. During the written phase, the patentee is invited to file a response to the Opposition, based on which the Office issues a Preliminary Opinion, and the parties are invited to file briefs taking account of the Preliminary Opinion.

The decision should be rendered within 4 months from the oral proceedings. The total duration of the opposition, from filing to the communication of the decision, is expected to be about 16 months.

The Parties can appeal the decision before the Paris Court of Appeal.

Post-grant limitation

The owner of a French national patent, or of the French part of a European patent, can request limitation thereof at the French Patent Office. If validity of the patent is challenged in Court, a limitation procedure can be initiated, in which case, the Court proceedings will be stayed until the French Patent Office issues its decision on the requested limitation.

The limitation shall consist in amending at least one claim so as to limit its scope. The amendment may find basis in the claims or in the description. The criteria for the French Patent Office to accept a limitation are whether the claims are indeed limited and whether the amendment(s) find clear basis in the patent. The patentee is not required to provide any reasons for the 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. In that case, the person filing the invalidation action is requested to show an interest to act.

Territory covered

A French patent provides effect in France, as well as in the French overseas departments and territories, except for French Polynesia. Since February 2014, for a French patent to also cover French Polynesia, an extension fee has to be paid at the time of filing the French patent application.

Provisional Patent Application

Concept

A French Provisional patent application is a patent application that may be filed without claims and without paying any fees except the filing fee. The Provisional patent application is not published. It is automatically deemed withdrawn at the end of a one-year term from its filing, except if converted into a "regular" French Patent application within such term. A Provisional patent application may serve as the priority application for a subsequent patent application.

Filing

The Provisional patent application may be filed without claims or abstract. There is no requirement to designate inventors. Only the filing fee is due.

The application is filed using the dedicated web interface of the French Patent Office (e-procedure).

No examination

The Provisional patent application is not examined whatsoever.

Conversion

If the Provisional patent application claims the priority of a previous filing, it cannot be handled as a Provisional patent application. Hence, it is automatically converted into a "regular" Patent application. In such case, the Applicant is invited to pay the search fee or to request that the conversion be into a Certificate of utility rather than into a Patent application.

Within one year from filing the Provisional patent application, the Applicant may request its conversion into either a "regular" Patent application or into a Certificate of Utility application.

Certificate of Utility

Filing

The requirements for filing a Certificate of Utility are the same as those for filing a patent application, except that no search fee is due.

Duration

Certificates of utility have a maximum duration of 10 years.

Subject matter

They can cover either a product, a method, or a device.

Filing

Filing requirements are the same as for a French national patent application. No search fee is due.

Formal examination

Formal examination is the same as for a French national patent application.

[Conversion](#)

A French Utility Certificate application may be converted into a Patent application at any time within 18 months from its filing date or, if a priority is claimed, from the earliest priority date.

In such case, the Search fee has to be paid within one month from the conversion request.

[Publication of the application](#)

All French certificates of utility are published 18 months after the filing date or the (earlier) priority date. Early publication can be requested.

[Observations by third parties](#)

Third parties may file observations within 3 months from publication of the certificate of utility application. Anonymous observations are not accepted.

[Acceleration of Examination](#)

Certificates of utility are also eligible to acceleration of examination. The same conditions as for patent applications apply.

[Grant](#)

The Applicant is invited to pay the grant and printing fees after checking the existence of possible observations filed by third parties.

[No post-grant opposition](#)

The opposition procedure is not open to Utility Certificates.

[Post-grant limitation](#)

The owner of a French certificate of utility can request limitation thereof at the French patent office.

[Invalidation - Enforceability](#)

For enforcing a certificate of utility, the owner has to request a prior art search at the French patent office. Invalidation can be requested as a counter-claim in patent infringement suits or as a main claim in an invalidation suit.

[Territory covered](#)

Same as for a French patent.

Coexistence with a patent

There is no clear legal basis excluding the coexistence of a French Certificate of utility and a French patent covering the same invention (same owner, same filing or priority date and similar scope). However, Art. L.611-1 of the Patent Law mentions that "Any invention can be protected by an IP title" and goes on indicating that such titles are Patents, Certificates of Utility and Supplementary Protection Certificates. The French Patent Office may consider that this means that an invention can be protected by one of such titles only. Accordingly, if a Certificate of Utility application and a Patent application are filed for the same invention, the French Patent Office is likely to issue a "double patenting objection", asking the Applicant to abandon one of such titles. If the Certificate of Utility application and the Patent application do not have the same effective date (priority date or filing date), then the one having the earliest effective date would anticipate the one having the latest effective date.



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