

Patent opposition procedure in France

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Patent opposition procedure: a new procedure

Since April 1, 2020 (PACTE law of May 22, 2019):

- possible to file an opposition against a French patent

The goal: to obtain the revocation, in whole or in part, of a French patent

About 50 oppositions filed with the French Patent Office

- more than satisfactory start

36% filed oppositions come from French companies and 41% from straw men

The first decisions were issued in 2022.

AGENDA

- I. The patent opposition procedure in France**
- II. The timeline of the opposition procedure**
- III. The main differences between French and EPO opposition procedures**
- IV. Initial feedback on the first patent oppositions**

I. The patent opposition procedure in France

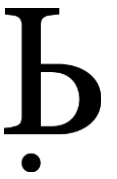
The patent opposition



- **Against which title** can an opposition be filed?
 - Any French patent issued (L.613-23 CPI)
- **Who** can file an opposition?
 - Any person, natural or legal, may file an opposition, with the exception of the owner of the contested patent (L.613-23 CPI)
- **What is the deadline?**
 - 9 months from the publication of the mention of grant of the patent (L.613-23, R.613-44 CPI)
- **How?**
 - By filing an opposition notice, providing the documents in support of the opposition notice, paying the opposition fee
 - Formal requirements have to be fulfilled

I. The patent opposition procedure in France

Notice of opposition (R. 613-44-1 CPI)



Must comprise:

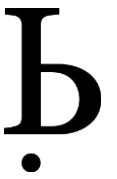
- Identity of the opponent
- References of the patent
- Statement of the extent to which the patent is opposed
- Statement of at least one ground on which the opposition is based
- Facts and evidence in support on these grounds
- Proof of payment of the opposition fee

The opposition must be substantiated:

- indicate the facts and evidence which show a possible ground against patentability

I. The patent opposition procedure in France

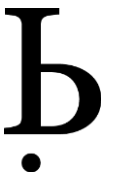
Possible attacks / Grounds for opposition (L. 613-23-1 CPI)



- Lacks of patentability
 - Novelty L. 613-23-1 1° CPI
 - Inventive step L. 611-10, 1. and L. 611-11 CPI
 - Industrial application L. 611-10, 1. and L. 611-14 CPI
 - Technical character L. 611-10, 1. and L. 611-15 CPI
 - Exceptions to patentability L. 611-10, 1. to 3. CPI
 - L. 611-16 to L. 611-19 CPI
- Insufficient disclosure L. 613-23-1 2° CPI
- Added subject-matter L. 613-23-1 3° CPI

I. The patent opposition procedure in France

Formal requirements (R. 613-44 and seq. CPI)



- Period: 9 months => No extension, No appeal
- Fee: € 600
- Filing the opposition: opposition notice and the documents must be filed in electronic form
- Signature: by the opponent acting personally or through an agent
- Formal information about:
 - Opponent
 - Patent
 - Scope of the opposition
 - Representative
 - Proof of the payment of the opposition fee
- Language: French
 - All documents must be translated into French

Representation



The opponent has to appoint a representative if:

- the opponent is not domiciled or based in France, in a Member State of the European Union or in a State party to the Agreement on the European Economic Area;
- there are several co-opponents jointly filing a single opposition; a common representative must be appointed.

The representative must be appointed within the 9-month time limit for filing the opposition.

II. The timeline of the patent opposition procedure

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The main stages of the patent opposition procedure

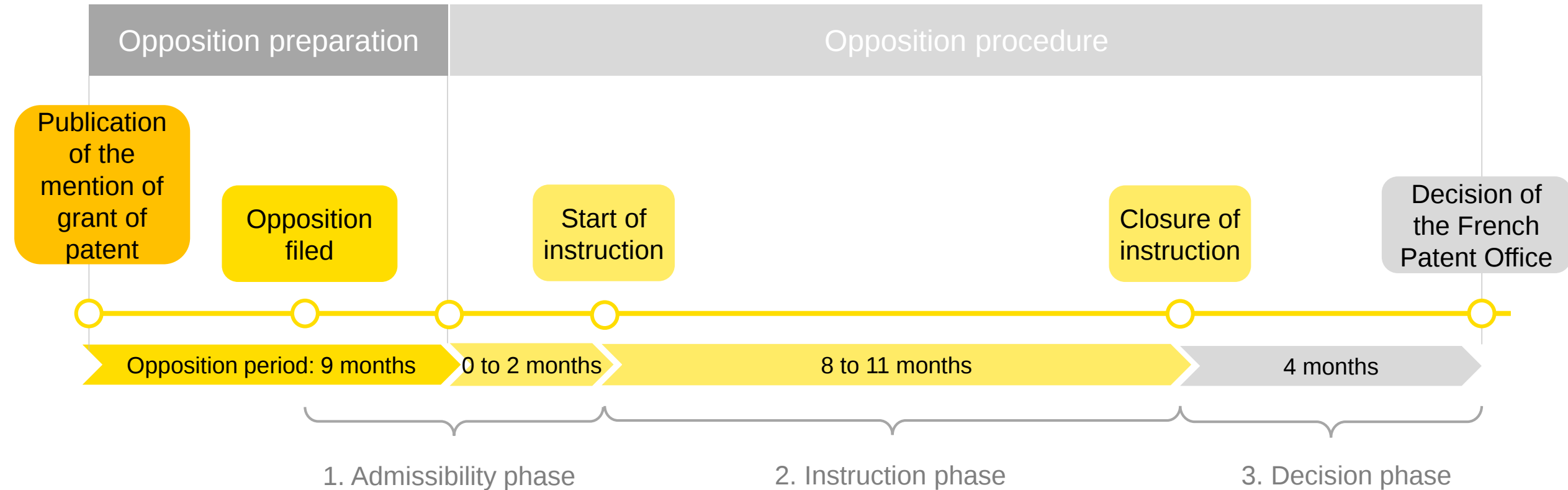
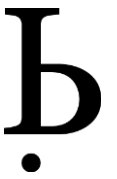


Figure translated from the guidelines of the French Patent Office

II. The timeline of the patent opposition procedure

Admissibility phase



Notification of the patent owner as soon as the opposition is filed.

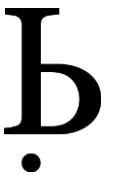
Examination of admissibility:

- consists of verifying compliance with the formal requirements for filing an opposition, without examining the merits.

After the 9-month period for filing an objection, only an irregularity concerning the representative's power of attorney can be rectified.

II. The timeline of the patent opposition procedure

Instruction phase



Includes **4 phases** (R. 613-44-6 CPI):

1. Phase of information and gathering of the opinion of the owner

- Notification without delay of all admissible oppositions to the patent owner in order to obtain his opinion on the grounds of opposition invoked by the opponent.
- As from the receipt of the notification, the owner has a non-renewable period of 3 months to respond.

The response may take the form of

- observations and/or
- a proposal to amend the patent.

During the opposition proceedings, the proprietor may submit a main request, together with one or more subsidiary requests in order of preference.

II. The timeline of the patent opposition procedure

Instruction phase



2. Preparation of the investigation opinion by the French Patent Office

Within 3 months following the expiration of the first deadline:

- notification of an investigation opinion

This opinion shall be accompanied by the observations or proposals for amendment of the patent submitted by the owner.

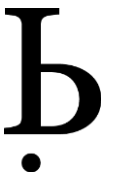
Investigation opinion:

- expresses the provisional position on the opposition of the French Patent Office
- is drafted on the basis of the elements provided in the opposition and taking into account the response of the owner.

The parties have a non-renewable 2-month "second deadline" to respond to the investigation opinion.

II. The timeline of the patent opposition procedure

Instruction phase



3. Written phase

If the opponent or the owner submits observations or if the latter proposes amendments to its patent, a written phase begins.

The observations or proposed amendments to a party are notified to the other parties.

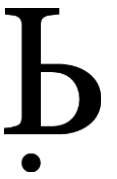
A new non-renewable "third time limit" of 2 months is granted to the parties to submit new observations.

➤ the owner also has the possibility to propose modifications to his patent.

If one of the parties has replied, notification to the other parties, for information, without an expected reply.

II. The timeline of the patent opposition procedure

Instruction phase



4. Oral phase

Preparation for the oral phase:

- If at least one of the parties requests it or
- If French Patent Office considers it necessary for the examination

The oral phase is not mandatory.

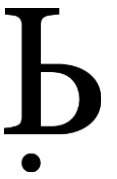
Summons to the oral phase:

- the parties are notified and invited to attend in person or to be represented by their appointed representative.

The hearing is public.

II. The timeline of the patent opposition procedure

Instruction phase



Oral hearing:

- a president and two technical assessors (and a legal expert in some circumstances)

Conduct of the oral hearing:

- the president announces the agenda and invites the parties to specify their requests
- the Opposition Committee deals with the items one by one according to the agenda.
- All claims presented by parties for the first time during the oral hearing shall be considered late and their admissibility shall be subject to the approval of the Opposition Committee after hearing the other parties.

II. The timeline of the patent opposition procedure

Instruction phase



Indication of the opposition committee's interim opinion:

- The president may suspend the hearing to discuss certain points with the assessors in the absence of the parties.
- When the session is resumed, the president may announce an intermediate opinion for each point.

Closure of the debate and end of the oral phase:

- When the president considers the opposition committee to be sufficiently informed and after ensuring that the parties have had the opportunity to present all their arguments, he closes the session of the oral phase and thus the instruction phase.

Minutes

- drafted by one of the technical assessors, signed by the president and sent to the parties.

II. The timeline of the patent opposition procedure

Instruction phase



End of the instruction phase

- the date of the end of the instruction phase is notified to the parties by the French Patent Office.

II. The timeline of the patent opposition procedure

Decision phase



Decision: must be sent within 4 months after the end of the instruction phase (R.613-44-8 CPI)

1. Silence means rejection

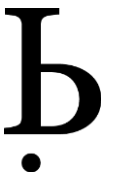
- opposition deemed to be rejected if the French Patent Office has not taken a decision within 4 months of the end of the instruction phase.

2. Decision on the opposition

- French Patent Office drafts a reasoned decision ruling on the opposition which will be notified to the parties.
- Sending the notification of the decision closes the decision phase and the opposition procedure.

II. The timeline of the patent opposition procedure

Decision phase



The decision on the opposition may be:

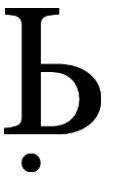
- the total or partial revocation of the patent;
- the maintenance of the patent in modified form; or
- the maintenance of the patent as granted.

Distribution of costs (L. 613-23-5 CPI)

- Each party shall bear the costs it has incurred.
- French Patent Office may decide to apportion the costs differently if equity so requires.

II. The timeline of the patent opposition procedure

After the decision on the opposition



Exclusive jurisdiction of the Paris Court of Appeal

Deadline: 1 month from the receipt of the notification of the decision
+ 2 months if the applicant lives abroad

III. The main differences between French and EPO opposition procedures

III. The main differences between French and EPO opposition procedures

Main differences



Observations of third parties:

- French Patent Office: not admissible
- EPO: possible (Art. 115 EPC)

Intervention of an alleged infringer:

- French Patent Office: not possible
- EPO: possible (Art. 105 EPC)

III. The main differences between French and EPO opposition procedures

Main differences



Suspension at the initiative of the parties:

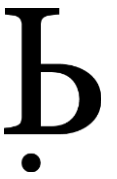
- French Patent Office: the opposition can be suspended for a period of 4 months renewable twice (R. 613-44-10 CPI)
- EPO: Not provided for

Withdrawal of all opponents:

- French Patent Office: Closure of the opposition procedure (R. 613-44-12 1° CPI)
- EPO: Ex officio continuation of the opposition procedure (R. 84 EPC)

III. The main differences between French and EPO opposition procedures

Main differences



Language:

➤ French Patent Office:

- Opposition notice and exchanges in French
- Any document in a foreign language must be accompanied by its translation into French
- Invitation from French Patent Office to provide a full or partial translation
- The document may be declared inadmissible

➤ EPO:

- Opposition notice and exchanges in one of the official languages
- Documents can be filed in any language - the EPO can request a translation
- If translation not submitted within the time limit, the document may not be taken into account

III. The main differences between French and EPO opposition procedures

Main differences



Partial revocation (only certain claims):

- EPO: not possible
- French Patent Office: possible (L. 613- 23-4 CPI)

IV. Initial feedback on the first patent oppositions

Observations



In the oral hearing, the opposition committee comes very prepared

The president:

- makes sure that the parties are given the opportunity to speak as much as necessary in order to guarantee the respect of the adversarial procedure
- hears the parties for as long as necessary
- asks for clarifications on the interpretation of the claims and the prior art

Observations



Requests (main and auxiliary) as well as prior art documents filed a few days before the oral hearing or during the oral hearing:

- The filing of new requests by the owner only a few days before or during the oral hearing (and after the date of closure of the written phase):
 - The French Patent Office decided to hold such belated requests admissible, insofar as they can be discussed during the oral phase pursuant to the adversarial principle.
- Same reasoning for new prior art filed by the opponent a few days before the oral hearing

The late filing of requests seems to be allowed solely based on the adversarial principle.

- the French Patent Office would have a more flexible practice than the EPO

Observations



Decision is similar to that of the EPO:

- successive analysis of each ground of opposition raised and each prior document opposed.
- details of the main arguments raised by the opponent and those of the owner before giving French Patent office's position.

For the examination of the inventive step: the reasoning is strictly similar to that of the EPO

- application of the problem-solution approach

Thank you!

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