

## France

### Administrative procedure

#### Opposition

At the time of writing, no pre- or post-grant opposition procedure exists. However, France is working on setting up a post-grant opposition procedure for implementation in 2020.

Currently third parties may, within three months from the date of publication of the application, submit written observations that may affect the patentability of the invention (R. 612-63 IPC). Such observations are communicated to the applicant, who may submit his counter-observations or a new wording of the claims (within three months) (R. 612-64 IPC).

#### Appeal

Action for annulment of any decisions regarding the grant, refusal or maintenance of patents should be filed with the Paris Court of Appeal (L. 411-4, R. 411-19 IPC).

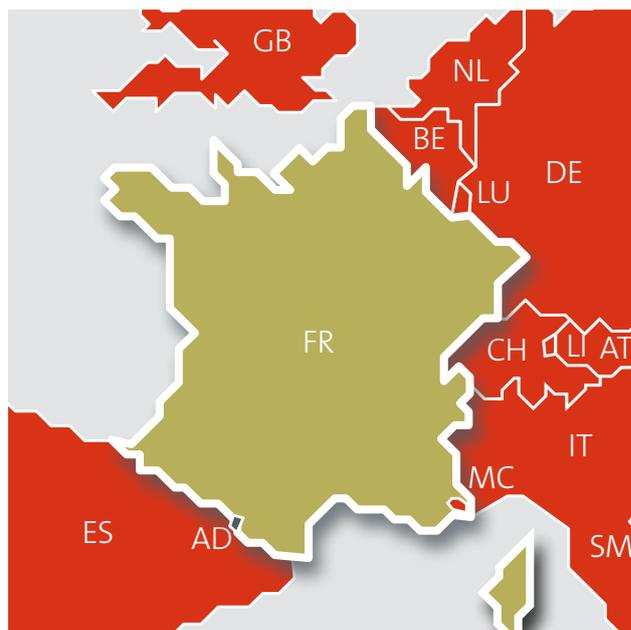
The action may be brought within one month by the applicant or patent proprietor or by a third party having an interest in the proceedings and residing in France, within two months if the party resides in overseas administrative departments of France, and within three months if the party resides in another country outside France (R. 411-20, R. 411-24 IPC). The action has no suspensive effect.

Further appeal may be made to the Supreme Court (L. 411-4(2) IPC).

### Civil procedure

#### Infringement

Patent infringement in France gives rise to both civil (L. 615-1 IPC) and criminal liability (L. 615-14 IPC provides for a maximum of three years' imprisonment and a fine of EUR 300 000 or, if the offence is committed by an organised criminal group or if the products are considered dangerous for the health and security of humans or animals, a maximum of five years' imprisonment and a fine of



EUR 500 000). These penalties are doubled if the offence is repeated or if the offender was contractually bound to the aggrieved party (L. 615-14-1). Deprivation of the right to elect and be elected to commercial courts, chambers of commerce and industry and professional chambers and to joint conciliation boards is also possible.

An action may be brought by the owner of the patent or a licensee (if the patentee fails to do so – L. 615-2 IPC).

All patent litigation matters fall under the special jurisdiction of the first instance court in Paris (*Tribunal de grande instance de Paris*) and the Paris Court of Appeal (L. 615-17 IPC; Art. D 211-6 Code of Judicial Organisation). Infringement cases are tried by three judges, who do not have formal technical or scientific training. Judges at the *Tribunal de grande instance* deal exclusively with IP cases and the court has the power to appoint experts.

Infringement actions may also be brought in respect of acts committed before grant but after the application became open to public inspection. The Court will then postpone its decision until the patent has been granted (L. 615-4 IPC).

Infringement actions may not be brought more than five years after the day on which the owner of the patent was aware, or ought to have been aware, of the last fact enabling him to bring it (L.6158 IPC).

Nullity of a patent may be raised as a counterclaim or defence.

FR

## Nullity/counterclaim for revocation

The validity of a patent can be disputed only by initiating a nullity action before a court of general jurisdiction (*Tribunal de grande instance de Paris*). An invalidity action can be brought only after the patent has been granted, this action is imprescriptible (L.61581 IPC) i.e. there is no time limit to introduce this action.

Any party which considers that a patent is invalid and should not have been granted may initiate an invalidity action; the public prosecutor may act *ex officio* (L. 613-26 IPC).

Revocation decisions have retroactive and absolute effect (L. 613-27 IPC). Revocation may also be partial (L. 613-25, L. 613-27 IPC – claims limitation).

Patent claim amendment is allowable in the following cases:

- The owner may file for a limitation of his patent, for example in the course of a revocation action. The request for limitation must be filed before the National Institute of Industrial Property (hereinafter the “Patent Office”). The Patent Office’s decision to accept or reject the limitation request is subject to appeal before the Paris Court of Appeal (L. 613-25 IPC).
- In the course of a revocation action, if the grounds for revocation affect the patent in part only, revocation is pronounced by the court in the form of a corresponding limitation of the claims (L. 613-25).

Where a decision partially revokes a claim, the owner of the patent is referred to the Patent Office in order to submit a modified wording of the claim in accordance with the terms of the decision. The Patent Office is empowered to reject the modified claim for lack of conformity with the decision, subject to appeal to the Paris court of appeal (L. 613-27).

An average of 30 limitations per year are filed under Art. L. 613-25. Limitations under L. 613-27 are infrequent (less than 1 per year).

## Remedies

Civil and criminal penalties – damages, fines, interim injunction, confiscation, seizure, publication of the decision, recall of the infringing products from the channels of commerce or removal from the channels of commerce, destruction of the infringing products.

## Other actions

Anyone who proves they are working on an invention that may infringe an existing one has the right to request a judgment that such use does not infringe a certain patent (L. 615-9 IPC). The court’s declaration does not exclude a later suit for infringement or nullity.

“*Saisie-contrefaçon*”: if a claimant does not already have evidence in its possession, the President of a court of first instance may be asked for an order of *saisie-contrefaçon*, a means of obtaining evidence that heavily favours the patentee, e.g. inspection of the defendant’s premises (L. 615-5 IPC). This *saisie-contrefaçon* can be cancelled if the claimant does not bring a civil or criminal infringement action within twenty working days or thirty-one calendar days, whichever is the longer (L.6155).

## Appeal

The losing party has one month (two months for a foreign party) to file an appeal against the decision at first instance. In the Court of Appeal the parties will follow the same stages of procedure as at first instance (full rehearing).

Further appeal to the Supreme Court is available but restricted to points of law. If the Supreme Court disagrees with the Court of Appeal’s decision, that decision is quashed and the case remanded to the Court of Appeal for further consideration.

## Parallel proceedings

The Court’s decision whether to stay national proceedings depends on the circumstances of the case.

If the court considers that the pending proceedings before the EPO have a good chance of affecting the national litigation, it may postpone them (e.g. if the patent revocation claims are the same before the EPO and the Court and have a good chance of succeeding).

On the other hand, if the opposition before the EPO is considered not to be serious, or if the stay would result in over long national proceedings, the Court may proceed to decide the case regardless of the outcome of the EPO proceedings.

## Arbitration/mediation

Arbitration or mediation is not available in patent validity/ revocation litigation. Arbitration and mediation are available in litigation over patent ownership, use, agreements (e.g. licence) and infringement and, as an incidental issue only, patent validity.

The *Médiateur des entreprises*, the permanent court of arbitration (CAIP), the National commission for employees' inventions (CNIS) and the WIPO arbitration centre are competent to deal with arbitration and mediation.

## Enforcement

A bailiff is responsible for enforcing an order both during the procedure and after termination or final decision of the court.

## Compulsory licence

Compulsory licences may be granted by the Tribunal de grande instance, or in the case of public interest, by the Ministry in charge of industrial property.

## Relevant national law

Intellectual Property Code – as amended by Act. No. 2003-706 [cited as: L-IPC];

Regulations concerning the Intellectual Property Code (R-IPC), Decree No. 95-385 of April 10, 1995 [cited as: R-IPC].

## Competent authorities or courts

