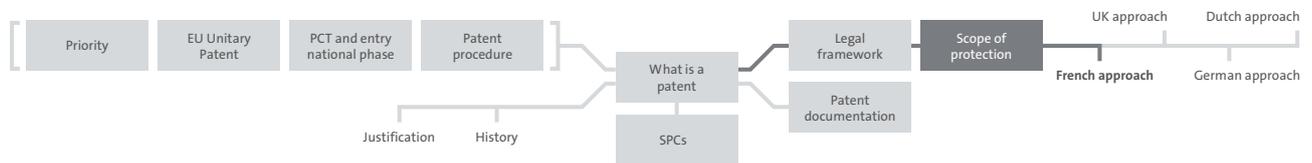

The French approach (Supplementary reading)



France has always been known for having a patent-friendly concept of infringement.

In a nutshell, the main step for the court is to determine whether the claimed means differ from the prior art by a novel form (or structure) (“particular means”) only, or by a novel function (“general means”).

This distinction is intended to prevent disguised infringement.

Claim construction

French patent construction is purposive, to give the claim its full meaning and to define the substance of the claimed invention.

Construction of the specification and claims is usually discussed in the first part of French judgments, under the heading “Scope of the patent”.

Claim construction is governed by Article 69 of the European Patent Convention for European patents for which France is a designated state and Article L. 613-2 of the French Intellectual Property Code for French national patents. These two articles, which are identical, state that “*the extent of the protection conferred by a patent shall be determined by the claims*” but that “*nevertheless, the description and the drawing shall be used to interpret the claims*”.

The French approach remains as defined by a decision issued by the Court of Appeal of Paris on 11 October 1990 in the first case involving a European patent (*Dolle v Emsens*):

“Article 69, as completed by its protocol, has chosen a middle way between a literal construction of the claim, in which the description and the drawings should be used only to dissipate ambiguities, and a broad construction, in which the claim would be used just as a guideline and in which the protection would extend to what, according to the skilled person, the patentee intended to protect.”

This compromise must ensure a fair protection for the patentee against the skill of the infringer to disguise infringement, and enable third parties to know with certainty what is protected.

In view of Article 69, the judge must construe the claims by reference to the description and drawings.

He must give the claim its full meaning, so that this condensed text is understood.

The construction leads to a definition of the substance of the claimed invention, without adding any element which the claim did not include and did not suggest.”

The reference to the full meaning of the claim and the substance of the invention shows that French judges seek a fair balance to ensure both reasonable protection for the patentee and a reasonable degree of legal certainty for third parties.

When construing claims, they seek to understand, with the eyes of the skilled person, the technical problem solved by the patent and the means taught to solve said problem, including their function.

However, the construction of a claim must not result in the addition of a feature which it does not include (*“interpreting is not adding”*) or, conversely, in the omission of a feature which it comprises.

When seeking to understand a patent, judges may take account of any definitions contained in dictionaries, handbooks or other documents submitted by the parties, but these definitions must never prevail over the meaning stemming from the patent itself.

Any such documents submitted are used mainly to help clarify, where necessary, the knowledge of the skilled person and the way they would read and understand the patent.

A written expert opinion may be provided if required in order to further clarify the documentary evidence and substantiate the knowledge of the skilled person, although this is not usual.

These tools will, where appropriate, also help judges to distinguish between:

- The features which should be considered “essential”, i.e. those without which the claim would not be considered novel and inventive or without which the claimed means would not perform the function of the invention, and

– The features which should be considered as minor (i.e. details), because they are not necessary for the claim to be novel and inventive and not indispensable for the claimed means to perform their function.

The key idea is to understand the extent to which the means taught by the patent differ from the prior art, in other words whether it is by some details of structure (or form) or because they perform a new function.

Claim construction is partly a question of fact and partly a question of law.

The *Cour de cassation* (France's highest civil court) checks the legal reasoning of the *cour d'appel*, but not its factual findings.

As a result, it will quash decisions showing that the construction exercise led to a distortion of the claim (by either the addition or omission of a feature) or to the creation of a contradiction between the specification and the claim.

But it will not review the technical findings of the *cour d'appel* about the knowledge of the skilled person.

The claims and specification are construed at the date of filing or priority date (where applicable) of the application.

The scope given to the claims is the same for both validity and infringement, so the so-called **Angora cat paradox** (see right) cannot apply.

The **Angora cat paradox** refers to the opposite approaches adopted by some patentees during prosecution and litigation. During prosecution, the claims are presented as being as narrow as a wet Angora cat to better distinguish them from the prior art. Once granted, however, and for the purpose of an infringement case, the same claims become far broader, like an Angora cat with thick, dry fur.

The person skilled in the art and his general knowledge

The person skilled in the art has no place in the assessment of infringement under French law, in particular because the question of whether the contested product was an obvious alternative is not relevant.

However, the person skilled in the art and his knowledge *are* taken into account for the construction of the claims and specification.

In any case, the skilled person is the same for all purposes relating to the same patent.

This person is a pure legal fiction. Professor Jean-Marc Mousseron defines him as *“a notional average person skilled in the art with access to a vast amount of documentation but with reasoning abilities limited to those of an average skilled person with no inventive capacity and no ability to go beyond the obvious area surrounding his knowledge”*.

“Technicien moyen étrange, il accède à une documentation considérable, mais ses facultés de raisonnement sont limitées à celles d’un agent moyen sans la moindre capacité inventive, sans la moindre aptitude à dépasser la zone d’évidence qui entoure les connaissances qu’il maîtrise.”

Professor Jean-Marc Mousseron, *Traité des brevets, Librairies techniques*, 1984, page 398

Since around 2009, French judges rarely omit to define the field and skills of the skilled person. He is usually the manufacturer, and not the user, of the claimed product.

In cases where the technical problem solved by the patent involves several technical fields, the skilled person may also be a team. For example, the decision of the *Tribunal de Grande Instance de Paris*, 3rd chamber, 3rd section, of 25 March 2009 (*Novartis v Johnson & Johnson*) held that:

“The person skilled in the art is a team made up of a polymer chemist whose objective is to develop suitable materials, a physicist in charge of determining the physical properties of the lenses and a clinician ophthalmologist specialising in contact lenses.”

The skilled person is defined as a specialist of average qualification or capacity in the field concerned. This can lead to considering an average technician for a relatively simple technical field and a highly qualified specialist in more complex cases.

The knowledge of the skilled person includes all the knowledge of his technical field, the knowledge of neighbouring fields raising identical or similar problems, general knowledge which is not specific to the relevant field (for example general mechanical knowledge), and common sense. It does not include research data which has not yet been validated. It may be supported by documents, and occasionally by a party’s expert opinion on documents submitted by the parties.

The skilled person has the ability to make logical deductions and perform routine operations and implementation work.

The French tests for infringement

The philosophy behind the purposive construction leads French judges to a relatively broad concept of infringement by equivalence, as set out in Pierre Véron's article "*France v The rest of the world*".

"Doctrine of Equivalents, France v The rest of the world" by Pierre Véron, Patent World, November 2001

Paul Mathély defines infringing means as those means which reproduce the essential means of the claimed invention, i.e. the novel and inventive means brought by the patent to the art which are necessary and sufficient to perform the function of the claimed invention.

"Les éléments constitutifs de l'invention sont les moyens, nouveaux et inventifs, que le brevet apporte à la technique antérieure, et qui exercent la fonction qu'il a prévue."

Ces moyens sont essentiels, lorsqu'ils sont nécessaires et suffisants pour assurer l'exécution de cette fonction ; les moyens essentiels sont ceux qui forment la substance de l'invention, et qui sont la condition même de la fonction qu'elle exerce."

This broad approach is supported by the traditional view that infringement is assessed by similarities and not by differences.

"Le nouveau droit français des brevets d'invention" by Paul Mathély, chapter II, section 1, page 413

The French infringement test can be considered as three-fold:

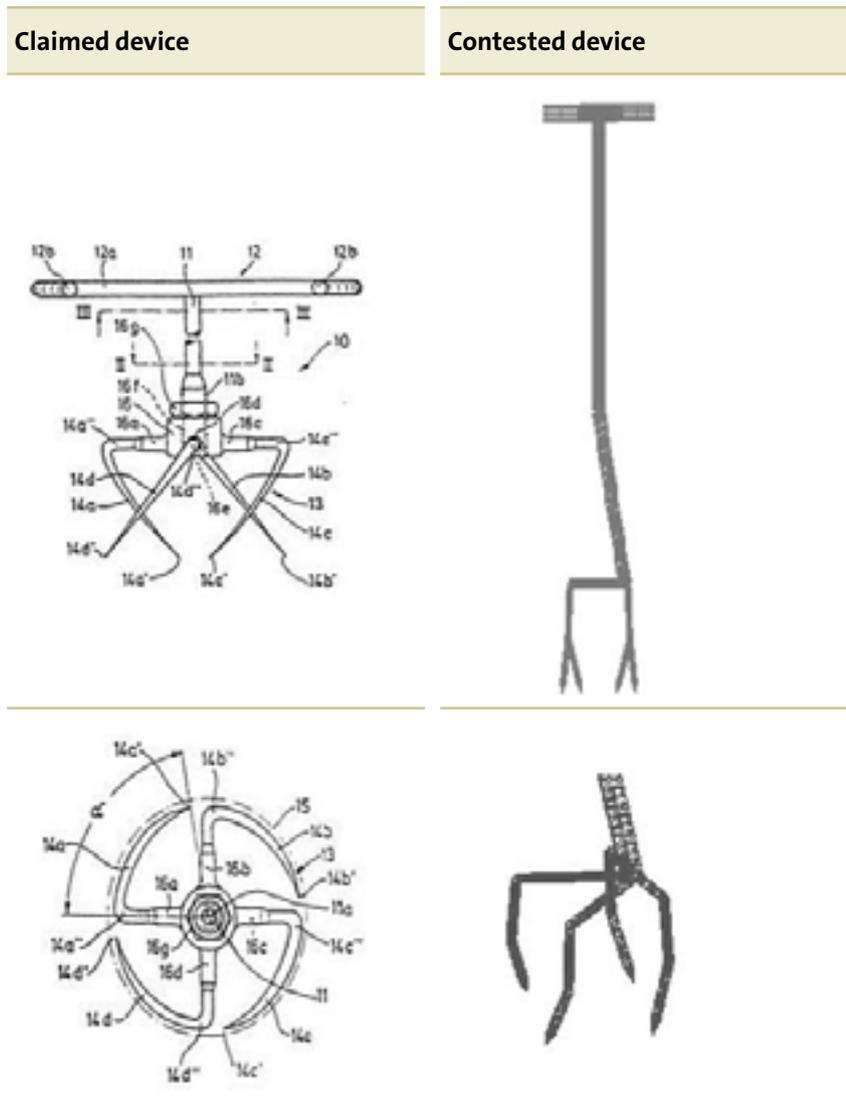
- (i) The first question is whether there is **literal infringement**, i.e. whether the contested means reproduce the claimed means in both their form (or structure) and function.
- (ii) If not, the second question is whether there is **infringement by reproduction of the essential means of the claim**, which is answered in the affirmative if the differences between the claimed and the contested means relate only to details and not to essential means of the claim.
- (iii) If not, the third question is whether there is **infringement by equivalence**, which is the case if the claimed means perform a new function and if the contested means perform said function for the same results as the claimed means.

Tribunal de Grande Instance de Paris, 3rd Chamber, 1st section, 26 April 2000 (Garden Claw v Leborgne)

For each of these steps, both the claimed and the contested means should be considered not only in terms of form (or structure), but also in terms of function (meaning the primary technical effect) and results (meaning the advantages provided by the invention).

The way infringement is tested in France is illustrated below using the example of a claim covering a gardening device.

The figures show the claimed device and the contested device.



The patent at issue relates to a manual gardening device, comprising a handle at one end and a tool at the other, for loosening soil, mixing soil layers and removing weeds without great effort thanks to a helical movement.

Claim 1 relates to the structure of the tool, and in particular the arrangement of its tines, in which the tines:

- envelop a virtual cylinder in the axis of the shaft, and
- form an angle of approximately 90°.

On the basis of the explanation provided by the description, the Court considered that the function of the device was to rotate so that it could be introduced into the soil in the manner of a screw and thereby loosen the soil and mix its different layers.

Claim 1

A manual agricultural implement, comprising a shaft (11), a handle (12) arranged on one end of said shaft and a tool on the other end of said shaft and including a plurality of helically curved tines (14) disposed around said shaft (11) in a radially spaced relationship therewith, characterized in that said tines (14a – 14d) extend parallel to each other along an imaginary cylinder (15) which is coaxial to said shaft (11), and that said tines (14a – 14d) are evenly distributed over the circumference of said imaginary cylinder (15) and curved such that the lines which connect the tine feet (14 a'' – d'') and tine tips (14 a' – 14 d') with the axis of said shaft (11) form an angle of approximately 90°.

Literal infringement

Literal infringement (“*contrefaçon à l’identique*”) occurs when the contested means reproduce the claimed means in their form and function for the same result.

However, in most cases, the contested means are not identical to the claimed ones.

In the gardening device example, the contested device did not reproduce the claimed means in their form and function for the same result, since there was a notable difference relating to the angle formed by the tines (90° in the patent, but far smaller in the contested device).

Far from excluding infringement, the existence of differences leads to the second step of the infringement test, which is to determine whether these differences relate to details or to essential means of the claim.

Infringement by reproduction of the essential means of the claim

According to some decisions and legal writers, infringement by reproduction of the essential means is included in literal infringement. Infringement by reproduction of the essential means of the claim is deemed to exist when the differences shown by the contested means relate only to details, in other words minor features.

There are two aspects to this:

- First, comparison of the claimed means and infringed means allows you to determine the features of the claim which are not reproduced, which is quite easy.
- Second, you have to determine whether the non-reproduced features constitute details only (in which case there is infringement), or whether they constitute essential means of the claim (in which case it will be necessary to apply the third part of the infringement test to decide whether there is infringement).

French decisions show the various questions which should be examined to determine whether a feature is a detail or an essential feature of the claim:

- Is the feature presented as essential in the patent or during the pre-grant prosecution phase? For example, does the patent mention alternatives?
- Is it one of those without which the claim would not have been found novel and inventive?
- Is it indispensable for fulfilling the function of the claimed means and solving the technical problem underlying the invention?

The question as to whether the patent mentions alternatives appears in a decision of the *Tribunal de Grande Instance de Paris*, 3rd chamber, 4th section, of 28 March 2013 (*somfy v Gaposa*). The fact that the patent gives a precise description of the form of the brake, without mentioning any alternative, is considered as showing that this feature is essential: “*L’invention n’envisage qu’un seul type de frein... sans autre alternative. Il ne peut donc être considéré que cet élément de la revendication du brevet n’est pas essentiel*” (“*The invention considers only one type of brake ... with no alternative. Therefore, it cannot be considered that this feature of the claim is not essential.*”)

If the claimed means which are not literally reproduced turn out to be a minor feature (i.e. a detail), there will be a final finding of infringement.

Otherwise, the analysis continues in order to determine whether there is infringement by equivalence.

When applied to the example of the gardening tool, this two-fold test leads to the following conclusion:

The contested device differs from the claim in particular in that it has tines forming angles of less than 90°. This angle of 90° was not a minor feature, in particular because it was important during prosecution to obtain the grant of the patent and because it is indispensable for the rotation of the tool in the soil like a screw. As a result, it is an essential feature, and the contested device does not constitute infringement by reproduction of the essential features of the claims.

This leads to the last part of the infringement test, which is to determine whether there is infringement by equivalence.

In a decision of the *Tribunal de Grande Instance de Paris* of 29 September 2004, 3rd chamber, 1st section (*L'Oréal/Al Khouri*), the judges examined the technical importance of the modified means. In this case, the use of the polymer selected by the defendant changed all of the chemical reactions involved in the formation of the capsules:

"... therefore, there cannot be an infringement, since the defendants' process is based on a polymer while the claimant's process involves no polymerisation chemical reaction.

[...] the CNRS patent, used by the defendants, uses a polymer that dissolves in organic phase leading to a solution polymer which, after injecting the solution, precipitates at the surface of the oil nanodroplets also leading to nanocapsules;"

Infringement by equivalence

There is infringement by equivalence when means which do not reproduce the claimed means in their form (or structure) perform the same function for the same results.

However, the doctrine of equivalence applies only if it has been already been ascertained that said function of the claimed means is novel.

The test for infringement by equivalence is therefore three-fold:

- Do the essential means of the patent whose form is not reproduced (“the means at issue”) **perform a novel function?**
- If so, do the contested means **perform the same function?**
- If so, do these contested means **provide the same results?**

Tests applied in some other countries, such as whether it is **obvious to the skilled person** that the contested means are equivalent or what the intention of the patentee was, are not relevant in France.

These explanations refer to cases in which only one of the claimed means is not literally reproduced. However, they also apply when the differences relate to several different means.

The claimed means at issue must perform a novel function

The function is claimed *per se*, because in such cases, any means which perform this function will be held to be infringing, whatever their structure may be. In this case, the infringement is literal.

As a result, the doctrine of equivalence is relevant only for claims which protect one or more means characterised at least partly by their form (or structure).

For these claims, the doctrine of equivalence applies only if the claimed means at issue perform a novel function.

In other words, infringement by equivalence can exist only if the claimed means at issue differ from the prior art not only by their form (or structure) but also by the function they perform.

In yet other words:

- If the function of the claimed means at issue is known in the prior art, then the scope of the claim is limited to the claimed structure (and its minor variants). In this case, the claim is said to cover specific means (“*moyens particuliers*”), and infringement by equivalence cannot apply.
- If the function of the claimed means at issue is novel, the scope of the claim extends to structures performing the same function for the same results. In this case, the claim is said to cover general means (“*moyens généraux*”), and the doctrine of equivalence can apply.

The above explanations show that, when assessing infringement by equivalence, the key question is the contribution of the invention to the art.

This rule has been applied by French judges for decades, and is still being applied, as illustrated by the following recent decisions.

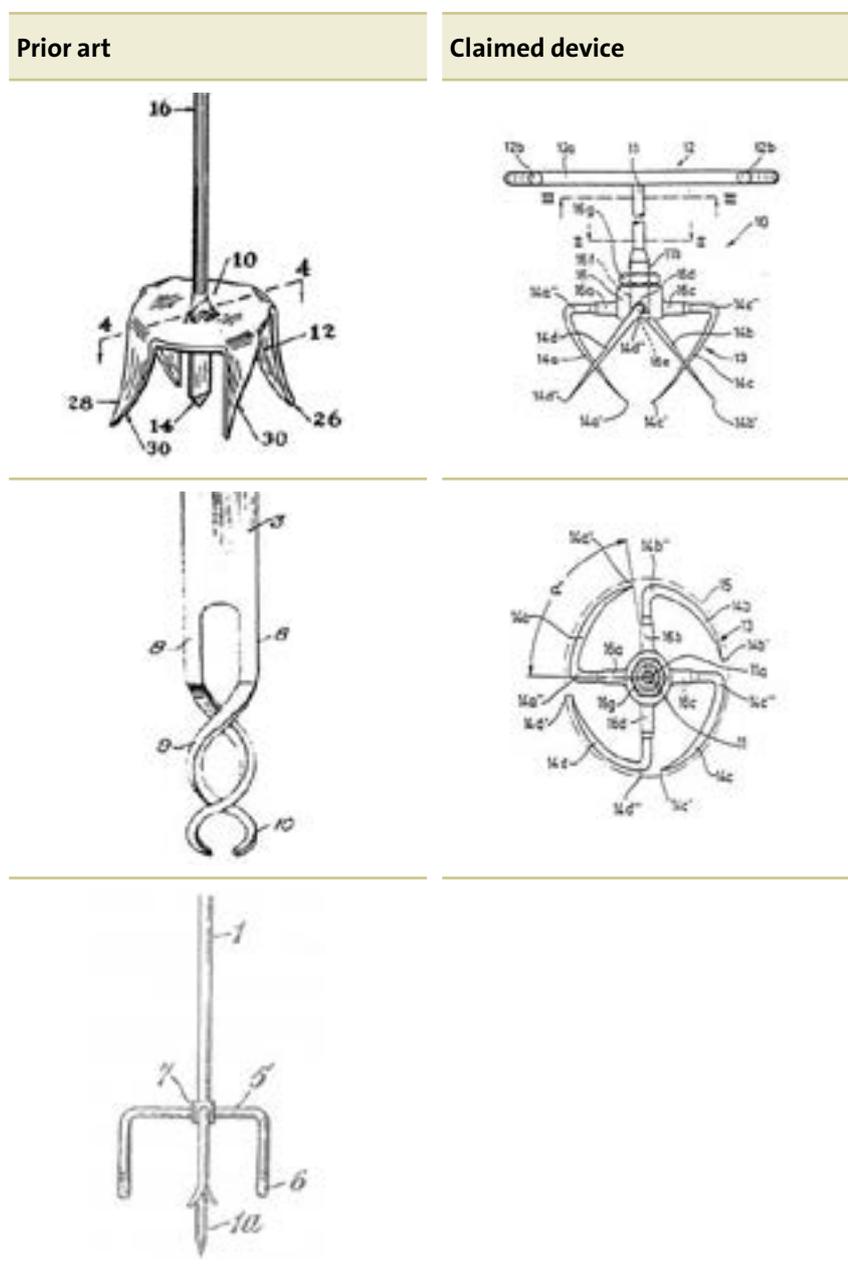
In a decision of 16 April 2013 (*Cycles Lapierre v Decathlon*), the *Cour de cassation*, commercial chamber, held that the appeal judges did not need to determine whether the contested means were equivalent to the claimed means, because they had found that the claimed combination of means differed from the prior art only by their form, and not by their function, which was not new.

Likewise, the *Cour d’appel de Paris*, Division 5, Chamber 1, in a decision of 26 September 2012 (*Beaba v Seb France*), held that there was no infringement by equivalence because the claimed cooking device was an innovation only in the combination of its structural features.

The same approach was followed by a decision of the *Cour d'appel de Paris*, Division 5, Chamber 2, of 17 June 2011 (*Salomon v Merrell and Wolverine*), which considered that the clamping organ of the claimed shoe device could be protected only in the form defined by the claim, because the function performed by this organ was not novel.

These recent decisions are consistent with established French case law. In the example of the gardening device, the question of whether the claimed means (and, in particular, the tines with an angle of 90°) implemented a novel function led the court to study the prior art cited by the alleged infringer and examine whether this specific angle of 90° created a structural difference only, or a functional one, over the prior art.

The drawings below show the claimed device and three gardening tools from the prior art:



The court considered that the function of the 90° angle in the claimed device, i.e. enabling it to rotate like a screw in the soil and loosening the soil, was not disclosed in the prior art.

Therefore, the function of the claimed device, in particular of its angle of 90°, was novel.

When a claimed feature which is not literally reproduced performs a new function, the judges have to proceed to the next part of the test, to determine whether the disputed means perform said function.

The contested means must perform the same function

Two means perform the same function if they produce the same primary technical effect.

The “primary technical effect” can be defined as the effect directly and immediately produced by implementation of the means.

It must not be confused with the result, which is the advantage provided by the means.

Dossiers Brevets 1993, I, 2

This distinction between function and result is particularly well explained in a decision of the *Cour de cassation*, Commercial chamber, of 26 January 1993, involving a patent for a process for obtaining doxycycline through hydrogenation of methacycline, with a modified catalyst.

The alleged infringer argued that the function of the process was to reduce, through hydrogenation, methacycline into doxycycline, which was not novel. The patentee argued that the function of the process was rather to obtain selectivity and stereospecificity at almost 100% of the required epimer (a), which was novel.

The *Cour de cassation* confirmed the judgment of the *Cour d'appel de Paris*, which had decided that obtaining a very high yield of epimer (a) was a novel function, not a result.

As the process carried out by the defendant involved not only the known result of reduction through hydrogenation of methacycline into doxycycline, but also the novel function of selectivity and stereospecificity of epimer (a), the defendant was found to be infringing the patent.

In the example of the gardening device, the question whether the contested device performs the same function for the same result led the court to a finding of non-infringement. It considered that the tines of the contested device did not perform the same function as those of the claim

because they did not have the screw effect. The contested device had to be introduced into the soil through vertical pressure applied by the foot. On the other hand, when the contested means perform the same function as the claimed means at issue, it remains to be assessed whether they achieve the same result.

The contested means must provide the same result

Until recently, French case law considered that the result obtained by the means at issue had to be similar, without necessarily being identical. As a consequence, the result could be of a different quality (less perfect, or better or poorer) or of a different degree than the result obtained by the patented means.

However, some recent decisions have indicated that the result must be “of the same nature and of identical quality and efficacy”.

Tribunal de Grande Instance de Paris, 3rd chamber, 1st section, 3 April 2014, Équipement pour l’environnement v Rabaud, and Tribunal de Grande Instance de Paris, 3rd chamber, 3rd section, 22 November 2013, Manitou v Haulotte

Irrelevant factors (obviousness and the intention of the patentee)

Under French law, obviousness is not a criterion for infringement, but only a ground for invalidity. It is taken into account in the assessment of inventive step only.

Therefore, when assessing whether they constitute infringement by equivalence, the question of whether the contested means are obvious for the skilled person is not relevant in France.

The lack of relevance of obviousness is confirmed by the French approach that improving the claimed means may be an infringement.

This solution used to be referred to as “*improving is infringing*”. However, this does not mean that any improvement of a claim would be an infringement. It only means that an improvement will not automatically avoid infringement and that the infringement test must be applied as usual. Lastly, equivalence is assessed in a purely objective manner, so that there is no reason to speculate about the possible intentions of the patentee.

For example, the decision of the *Tribunal de Grande Instance de Paris* of 29 September 2004 (*L’Oréal v Al Khouri*) recalled that obviousness is not taken into account: “*That it does not matter much, concerning the discussion on the infringement, that the skilled person can replace – based on Mr Al Khouri’s patent – the alkyl monomers by polymers, since this criterion is only relevant, as pointed out by the defendants, for assessing the inventive step of a patent and therefore its validity and not for deciding whether there is an infringement or not*”.

A recent example of infringing improvement is provided by the decision of the *Tribunal de Grande Instance de Paris*, 3rd chamber, 3rd section, of 22 November 2013 (*Manitou v Haulotte*).

However, when the patent explicitly and unambiguously excludes a variant from its scope, this variant, if exploited by a third party, will not be held to be equivalent to the patented invention.

In the same way, when the variant directly and unambiguously goes against the teachings of the patent, it will not be held to be equivalent. Some French decisions do not explicitly describe each of the above steps, and may use a slightly different wording.

Is there a doctrine of file wrapper estoppel?

Estoppel does not exist as such under French law, and judges are under no obligation to refer to the “file story” of the patent, as underlined, for example, in a decision of 23 November 2010 of the *Cour de cassation*, commercial chamber (*Institut Pasteur v Chiron*).

However, it is not uncommon to find decisions which take account of explanations or amendments made by the patentee during prosecution or opposition proceedings.

Some of these decisions refer to the general procedural rule, based on the parties’ duty of loyalty, that a party cannot contradict itself within the framework of the same proceedings to the detriment of another party. However, the application of this general rule is quite limited:

- It applies mainly in cases of a contradiction within the framework of the same proceedings, so that a contradiction with an argument raised in parallel proceedings has less impact (see, for example, *Tribunal de Grande Instance de Paris*, 3rd chamber, 3rd section, 29 June 2012, *LPG Systems v Gianffranco Tudo*).
- It applies only in cases of a real contradiction with regard to the goal pursued (e.g. invalidity claim vs. clear recognition of the validity), whereas a change in the line of argument does not suffice to characterise a contradiction (*Cour d’appel de Paris*, division 5, chamber 1, 19 April 2013, *Recycl’air v Faurecia*).

Independently of the above rule, the content of the “file story” may be taken into account like any other fact of the case. It is up to the judges to assess the possible relevance and impact of the statements and amendments made by the patentee, either during prosecution of the patent application or during opposition.

This is illustrated by the decision of the *Tribunal de Grande Instance de Paris*, 3rd chamber, 2nd section, of 28 May 2010 (*Institut Pasteur v Siemens Healthcare Diagnostics*) (relating to the same patent as the above-cited decision of the *Cour de cassation* of 23 November 2010):

“Institut Pasteur rightly argues that only these provisions [Article 69 and its Protocol] govern the interpretation of the claims’ wording and that the “file wrapper estoppel” theory, which consists in also taking into account, to interpret a patent, the statements made by the applicant during the grant or opposition proceedings, cannot be applied [...]

“Secondly, although pursuant to Article 69 of the Munich Convention in its version applicable to this case and L. 613-2 of the French Intellectual Property Code, the scope of the protection conferred by a patent is determined by the claims as amended following the opposition procedure, and the drawings and the description shall be used to interpret the claims, the cour d’appel, by pointing out that the patent application had been initially filed with 24 claims but that, following the opposition procedure, it had been granted with 11 claims of a limited scope, simply appraised the scope of the claims in their final drafting; the cour d’appel, which did not have to proceed via the allegedly omitted research targeted by the fourth branch of the argument, legally justified its decision.”

Decision of 23 November 2010 of the *Cour de cassation*, commercial chamber (*Institut Pasteur v Chiron*)

However, they in no way exclude the possibility for the court, which has to rule on the extent of the protection conferred by the patent, of referring to the wording of the claims as initially filed and of appraising the scope thereof, in particular in light of the amendments made during the grant or opposition proceedings before the European Patent Office.”

The discretion of the judges is also illustrated by a case decided by the *Tribunal de Grande Instance de Paris*, 3rd chamber, 2nd section, 1 June 2012, *Le Roy v Saertex*. The defendant, claiming invalidity of the French priority patent on the grounds that it extended beyond the content of the application as filed, relied on the observations of the European Patent Office concerning the equivalent European patent application and was followed by the court. The Tribunal recalled that observations made during the opposition proceedings were not binding, but that reference to these proceedings in the specific scenario of the case was relevant, and admitted the invalidity argument raised by the defendant.

As a result, French case law comprises a significant number of decisions using the file story of the patent to clarify issues arising in constructing the patent.