

# French perspective

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# General principles of French intellectual property law

- Strict interpretation of the territoriality principle: French law requires an infringing act located in France
  - Criminal law: French Supreme Court, 19 June 2017, *Blaise FIGUERO*, No. 06-86.165: the victim of the infringement is French: “Whereas, in order to uphold the judgment, the Court held that the facts constituted for the accused, in Sweden, to participate in the marketing of products obtained directly from a process subject to a European patent designating Sweden, and thus producing its effects in Sweden and not in France; Whereas it adds that patent law is territorial and that protection is acquired only within the borders of the State concerned by that protection; (...) that they indicate that infringement of a patent consists in the infringement of a legal title granted by a State for its territory and conferring on its proprietor a right of ownership in that territory and that the limited territorial scope of the patent in French law, resulting from its definition given by the code of the intellectual property, is confirmed by the international conventions; that they deduce that the French criminal law is inapplicable and that the French courts are incompetent; Whereas the Court of Appeal justified its decision” ;
  - Civil law: French Supreme Court, 5 July 2017, *Bell Helicopter v. Airbus*: “Whereas, in order to characterize the offer in France of this aircraft, the model Bell was presented on 15 September 2005 at Toussus-le-Noble (...) and that this presentation in France was preceded by presentations in the United States and Canada for which the Court of Appeal, which did not say that those facts constituted acts of infringement committed in France, did not infringe the principle of the territoriality of the patent right”.

# Direct infringement and infringement “by equivalent”

- Article L.613-3 of the French intellectual property code (IPC)
  - *“The following are prohibited, in the absence of consent of the owner of the patent: (...) the manufacture, offer, placing on the market, use, importation, exportation, transshipment, or possession for the aforementioned purposes of the product subject to the patent (...)”*
  
- Manufacture
  
- Offer
  - Distinct from “placing on the market”
  - French Supreme Court, 5 July 2017, *Bell Helicopter v. Airbus*: *“constitutes an offer (...) any material act intending to prepare the potential clientele for the forthcoming marketing of the product, even if it is still at the not approved prototype stage, insofar as the presentation of the product in the form of a prototype is likely to divert a part of the customer of the patented product”*
  
- Importation
  - Absence of definition
  - Non-opposability of contractual clause to the patentee

# Direct infringement and infringement “by equivalent”

- Infringement “by equivalent”
  - Same function for the same result
  - The function must be new
- Infringement of a method claim :
  - Article L.613-3 IPC: *“The following are prohibited, in the absence of consent of the owner of the patent: (...) (b) The use of a process subject to the patent or, where the third party knows or where circumstances make it clear that the use of the process is prohibited without the consent of the owner of the patent, the offer of its use on French territory ; (c) The offer, placing on the market, use, importation, exportation, transshipment or possession for the aforementioned purposes of the product obtained directly by the process subject of the patent”.*

# Contributory infringement

- Article L. 613-4 IPC
  - *“the following is also prohibited, save consent by the owner of the patent, to supply or offer to supply, on French territory, to a person other than a person entitled to work the patented invention, the means of implementing, on that territory, the invention with respect to an essential element thereof where the third party knows, or it is obvious from the circumstances, that such means are suited and intended for putting the invention into effect”*
- French Supreme Court, 8 June 2017, *SCA Tissue France*
  - *“contributory infringement of a patent covering an invention consisting of a combination of means may result from the provision of a means relating to an essential element thereof where the third party knows or it is evident that this means is suitable and intended for the implementation of this invention, even though it is a constituent element thereof”*

# Life technologies v. Promega

- Would the French judge be competent to declare that a patent having effect in France would be counterfeited by the manufacture of a component exported to the United Kingdom for assembly of the finished product subject to the patent in France?
- Absence of legal provision in France
- Territoriality principle: the French judge does not take into account acts of infringement committed outside France. Therefore he will only judge the manufacture of the component in France.



# Life technologies v. Promega

- Direct infringement: qualitative approach: does the sole manufacturing of the compound involve the essential features of the patent?
  - If yes: infringement
  - If no: no infringement
  
- Contributory infringement:
  - Appeal Court, 19 January 2000 *Aktiebolat Hassle and Laboratoires Astra France v. Torrent Pharmaceuticals*:
    - Promotion on a billboard exposed in a commercial conference of a patented product “*not available for sale in countries with valid product patent*”
    - Answer from the Court: a compound essential to the invention (qualitative approach) may not constitute an infringement act if it is not available in France:
      - » “*but considering that the TORRENT company rightly asserts that Article L 613-4 of the Intellectual Property Code prohibits the supply of the means of implementation of the patented invention on the French territory, that is to say in a place where the patent produces its effects and not outside France*”
  - Conclusion transposed to the *Life technologies* case:
    - The product seemed to be not available in the US
    - Therefore, the 4 others compounds would not have been judged as infringing because of the sole manufacturing (and eventually communication in France regarding this manufacturing) in France
  
- Conclusion: infringement difficult to prove in France in such case

# NTP, INC. v. RESEARCH IN MOTION, LTD.

- Would the French judge be competent to declare that a method object of a patent having effect in France would be counterfeited by the use of a process where one of the steps subject to the patent in France is carried out abroad ?
- Article L.613-3 IPC: “*The following are prohibited, in the absence of consent of the owner of the patent: (...) (b) The use of a process subject to the patent*”.
- Territoriality principle: the French judge does not take into account acts of infringement committed outside France. Therefore he will only judge the steps carried out in France.



# NTP, INC. v. RESEARCH IN MOTION, LTD.

## ■ Direct infringement:

- Qualitative approach: does the method located in France involve the essential features of the patent?
  - If yes: infringement
  - If no: no infringement
- Are the characteristics of the product obtained directly by the process subject of the patent reproduced?  
French law does not consider differently tangible and intangible product.
  - If yes: infringement: French judge could have issued a similar holding in the *NTP* case
  - If no: no infringement

# NTP, INC. v. RESEARCH IN MOTION, LTD.

## ■ Infringement by equivalent:

- French Supreme Court, *M. X / Broyeurs Becker*: infringement of a method claim (4 steps) by equivalent: qualitative approach in two times:
  - Firstly, do all four steps involve essential features of the patent?
    - » “But first of all, having regard to its own and adopted grounds, that claim 1 of the patent relates to a process which necessarily comprises four successive steps, including an essential step of drying and purification beforehand in a rotating drum, a cascade or a vibrating screen to bring the metal content of the metal waste to at least 70%, the Court of Appeal could reasonably conclude that the counterfeit could only be constituted if these four steps were reproduced”
  - Secondly, if all steps are essential and one is missing, do the litigious acts involve an infringement by equivalent of the missing step?
    - » “since it has not been established that treatment measures equivalent to those described in the patent have been implemented by Roland (...) the Court of Appeal (...) did not err in deciding this way”
- Conclusion transposed to the *NTP* case: step essential but no equivalent

## ■ System claim: approach similar to the *Life Technologies v. Promega* case

# Conclusion

- Doubts regarding the enforceability in France of foreign decisions condemning for patent infringement of a US patent because of acts located in France
- Conclusion
  - qualitative approach of the infringement by the French jurisdiction
  - be cautious in the writing of the claims

■ Thank you !

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