



EXCO MEETING, CAPE TOWN 13 & 18 APRIL 2015

COUNTRY REPORT	
TITLE:	Country report for <i>FRANCE</i>
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TABLED TO:	FICPI delegates
PURPOSE:	For information and consideration
SNIPPET:	News from and activities of the FICPI national group in <i>France</i> since the Barcelona ExCo in November 2014.

SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

B1. LEGISLATION

- Please provide details of any changes to IP legislation (patent, trade mark, design and other) in your country implemented or due to be implemented since you reported last in October 2014. On November 12, 2014, two Decrees were published:

- Decree "SVR" : Silence Vaut Refus (No response = request rejection)
- Decree "SVA" : Silence Vaut Acceptation (No response = request granted)

These two Decrees are much broader than IP: they globally cover relationships with French administrative authorities and aim at facilitating such relationship and ensuring that administrative authorities work faster.

Quite surprisingly, patents and trademarks were included in their scope. As the Decree SVR stands, it could be interpreted to mean that:

- In the absence of specific communication (such as request of completion of the files) by the INPI within 4 months from its filing date, a patent application would be deemed rejected
- In the absence of specific communication (such as request of completion of the files) by the INPI within 6 months from its filing date, a trademark application would be deemed rejected.

Of course, specifically for patents, such provisions are clearly not applicable. They contradict provisions of the IP law (e.g. a patent application is published at 18 months from its filing date and subject to observations by third parties within 3 months from publication of the Search report).

The INPI is willing to have these provisions changed or clarified and, in that respect, is working closely with the IP profession. On the other hand, the INPI cannot systematically issue communications which would "restart" the 4-month/6-month term as the government strongly advises "reluctant administrative authorities" (the INPI is not the only one) against such policy.



Most probably, corrective Decrees will be adopted by the “Conseil d’Etat” with retroactive effect.

The INPI has already issued a communiqué officially informing the IP community that provisions of the IP law should prevail.

B2. MAJOR CASES

2. Please provide brief details of any new case law in the field of patents, trademarks, design or other IP of general interest.

Preliminary proceedings - (Cour de Cassation) Supreme Court 21 Oct 2014

In this case, co-owners (Orange, Philips...) of an essential patent for broadcasting specific TV DTT signals had launched **preliminary proceedings** against Electrodepôt **after the patent had expired** (but still within the term provided in the statutes of limitation); in doing so, they did not request preliminary injunction, but the award of provisional damages.

They succeeded.

Electrodepôt filed an appeal before the Supreme Court, claiming that preliminary proceedings are intended for preventing infringement or continuation of infringement. The Supreme Court however confirmed that preliminary proceedings also enable the patent owner, as long as the action is not time-barred, to claim the allocation of provisional damages and implement the “right to information”.

Also, in this decision, the Supreme Court provides guidance on issues at stake in any preliminary proceedings:

- The licensee can join the preliminary action
- A positive decision shall be taken if infringement is likely, that is: it is likely that the patent is valid and infringed: the previous judges had validly refused to consider the file wrapper of the patent as the grounds for invalidation raised by the defendant did not seem *prima facie* serious.

Claims relating to dosage range: currently, the INPI [French Patent Office] relies on a decision of the Paris First Instance Patent Court (28 September 2010, Actavis/MSD,) to reject claims directed to a medicament posology, on the grounds that such posology constitutes a therapeutic treatment method. The Guidelines, Title 1, Section C, Chapter VII, 2.1.1.b, indicate: “thus may be rejected [...] a claim relating to the posology of a medicament”, and refer to the decision of 28 September 2010. However, the Paris Court of Appeal, in its ruling of January 30, 2015, contrary to the opinion of the French Patent Office, recognizes the patentability of claims relating to dosage schedule, in case a different technical effect is demonstrated. Therefore, the French Patent Office might change its position in the future.

Second medical use: Another decision of the Paris Court of Appeal on the same patent (Merck/Teva also of January 30, 2015), has however considered that the second medical use claims of this patent were not valid for insufficiency of disclosure; indeed, the Court interpreted the requirement of sufficiency of disclosure in the pharmaceutical field differently than in the other technical fields by requiring in particular that the description mentions the existence of research studies and of results, in relation with the disease concerned.

B3. OFFICIAL PRACTICE

3. Please provide details of any changes in official patent and trade mark office practice which would be of general interest to other members.



B4. PROPOSALS FOR CHANGES

4. Please provide details of any proposed changes in IP laws or practice and indicate if your National Association/Section is involved in providing comments to such changes.
Would it be of assistance to have input from the CET on any proposed changes?

SECTION C: OTHER INFORMATION

Please provide details of any other information pertaining to your country or region that would be of general interest to FICPI members and other IP practitioners browsing FICPI's website.

C1. QUALIFICATION AND THE RIGHT TO REPRESENT CLIENTS BEFORE A COURT

- 1.1 Please describe the qualification process for becoming a patent attorney in your country/region.
French patent and trademark attorneys do not represent their clients before the IP Court. Subject to specific qualifications (master's degree in Law...), French patent attorneys will probably be authorized to represent their clients before the UPC.
- 1.2 Has the patent attorney qualification process changed in any way in the past 5 years?
No.
- 1.3 Does qualification as a patent attorney permit you any right of representation before any Court in your country?
As any one, we can represent a party before a Court of Commerce
- 1.4 If so are there any special requirements or restrictions?
- 1.5 Are qualified lawyers in your country permitted to work in the patent field without any further qualification?
Attorneys at law are authorized to represent clients before the INPI
If so are there any restrictions on what they may do?
No
If so, please describe those restrictions.
- 1.6 Please describe what privilege attaches to patent attorney communications including any restrictions.
French patent attorneys basically enjoy "attorney-client" privilege, although a recent isolated Court decision denied such privilege in specific circumstances (letter sent by a patent attorney to an attorney-at-law, who communicated this letter in a Court action).
- 1.7 Please describe the qualification process for becoming a trade mark attorney in your country/region.
Have a Master's degree in IP law + at least 3 years of practice under the responsibility of a qualified Trademark attorney + pass an exam to become an authorized representative before the French patent office (1st round with 2 papers on trademarks + 2 papers on designs, and, if 1st round passed, 2 oral presentations before a Jury (1 on trademarks, 1 on designs)). In France, trademark attorneys do also designs.



- 1.8 Has the trade mark attorney qualification process changed in any way in the past 5 years?
No.
- 1.9 Does qualification as a trade mark attorney permit you any right of representation before any Court in your country?
Court of commerce.
If so are there any special requirements or restrictions?
- 1.10 Are qualified lawyers in your country permitted to work in the trade mark field without any further qualification?
Yes: qualified attorneys-at-law can represent clients before the French patent and trademark office and before courts.
If so are there any restrictions on what they may do?
No
If so, please describe those restrictions.
- 1.11 Please describe what privilege attaches to trade mark attorney client communications including any restrictions.
Same as for patent attorneys. In France, the common title for patent and trademark attorneys is "Industrial Property Counsel", plus an option in trademarks or patent. The French IP profession is thus a unified profession.
- C.2 CET AND PEC SPEAKERS
- 2.1 Would your National Section/Association be interested in obtaining assistance from FICPI, through either the CET Work and Study Group or the Professional Excellence Commission (PEC), in providing speakers for seminars organized by your national group in your county?
Although I have no specific occasion in mind, ACPI would basically be interested in involving the CET and /or the PEC. Note that a number of ACPI members are CET and/or PEC members.
- 2.2 If your group does, or in the future might, require such assistance, please identify topics that might be of interest to your members, with a view to raising FICPI's profile and providing added value from membership of FICPI in your country.
I currently have no specific topic in mind.
- C.3 TOPICS OF INTEREST
- 3.1 Please list three IP topics that are of particular interest to you and/or your national section members.
Evolution of the IP profession worldwide (reserved acts, work sharing between IP offices...)
"Unfair competition" by IP offices
Education, including continuous education

[End of document]

Annexes attached:

- ACPI IP excellence Charte (12 pages)
- ACPI communiqué de presse (3 pages)