

**Managing
Intellectual
Property™**

IP **Handbook**



**World IP Contacts
Handbook** 14th edition

2007

FRANCE: MARKET OVERVIEW

PATENT PROSECUTION

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2006 was a busy year in France, with IP issues debated at the highest levels. In the final stages of Jacques Chirac's presidency, the country has been under pressure to sign the London Agreement on translations of European patents. Although industry in France and beyond supports the Agreement, they have yet to convince those in power of its benefits, despite a favourable ruling from the country's Constitutional Council. The Council was also called to rule on the implementation of an EU copyright directive, following controversy over interoperability between music devices. Meanwhile, there has been some discussion in the country about allowing lawyers to become partners in industrial property agencies.

The debates reflect the changing trends in IP work. Like other EU countries, France is

seeing more interest in Community trade marks combined with less domestic work. There is also increasing work in litigation and anti-counterfeiting.

Patent litigation boutique **Véron & Associés** retains its position as the top firm for patent contentious work in France. With a total of 30 staff working in more than 1000 square metres of office space located in both Paris and Lyon, the firm comprises 10 lawyers working in French and English. Veron specializes in pharmaceuticals, telecommunications, electronics, mechanics and plant breeders' rights. The firm recently acted for Bayer CropScience to recover its patent rights on an important invention relating to genetically modified corn, Air Liquide in a patent infringement case

concerning liquid gas bottles and 3M in a patent infringement case concerning a process for manufacturing an antiarrhythmic drug. Other high profile clients include L'Oréal, Honeywell, Novartis, Sandoz, Chiron and Novartis Animal Health. Clients refer to Véron & Associés as "an excellent firm who really pay attention to a client's needs and know how to integrate themselves into a company strategy". Partners Pierre Véron, Isabelle Romet and Sabine Agé are highly regarded by clients.

Cabinet Beau de Loménie is one of the largest IP firms in France and operates in all fields of IP covering all technical fields and industries. The firm maintains its position in first tier this year for patent and trade mark prosecution work. It was created in 1930 by two engineers and has offices in Paris, Lyon, Lille, Marseille and a German branch in Munich. The agency has five partners including Jean-Jaques Joly, Gérard Portal, Philippe Hubert and Didier Intes and clients include Sony, Motorola, Véolia, Accord, Hermés, Philip Morris and Coca-Cola. Cabinet Beau de Loménie also handles work for makers of spare parts in the automobile industry and compatible products in the field of printer devices. The firm works with prominent Japanese clients and companies in China, Korea, Italy and the United Kingdom.

Cabinet Regimbeau is one of the leading IP firms for biotechnology in France and has offices in Paris, Lyon and Rennes. The firm has 10 partners including Jaques Warcoin, Francis Ahner, Christian Texier, Eric Le Forestier and Evelyne Roux. Regimbeau covers all IP matters, with the emphasis on patent and trade mark prosecution and contentious work. The firm concentrates in all technical fields, with specialists in biotech, IT/telecoms, agri-food industries, automotive industries and financial and insurance services.

In June 2005, **Casalonga-Josse** separated into two firms. **Bureau Casalonga & Josse** is a

FRANCE AT A GLANCE

Patent office contact details

Institut National de la Propriété Industrielle
26 bis rue de Saint Pétersbourg
75800 Paris Cedex 08
Tel: +33 (0)825 838587
Website: www.inpi.fr/front/?ref=undefined

Most recent statistics on

Patent applications: 17,291 (2004)
Patents registered: 11,836 (2004)
Trade mark applications: 66,979 (2004)
Trade marks registered: 65,552 (2004)
Patent application fee: €1,025 (\$1,243) (minimum fee)
Trade mark application fee: €225 (\$273)

Main courts/ judges for IP cases

Majority of cases are in the Paris Court of First Instance. Other courts used include the Paris Court of Appeal, the Lyon Court of First Instance and the Bordeaux Court of First Instance. The Bordeaux court is particularly for appellations of origin matters.

Main IP laws

Patents and Industrial Designs

Law Number 92 -597, July 1992, on the Intellectual Property Code, as last amended by Decree Number 96103, February 1996.

Trade Marks

Decree on Trade Marks and Service Marks Number 92-100, January 1992.

Law Number 92 -597, July 1992, on the Intellectual Property Code, as last amended by Decree Number 96103, February 1996.

Copyright

Law number 92-597, July 1992, on the Intellectual Property Code, as last amended by Law number 95-04 of January 1995.

Law number 97-283, March 1997

Decree Number 97-1316, December 1997

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 Hirsch - Pochart & Associés
 Novagraaf Intellectual Property
 ProMark
 Sodema Conseils

Tier 4

Inlex IP Expertise
 Adsigna

firm of patent and trade mark attorneys and concentrates on patents, trade marks, copyright and design prosecution and on patent contentious work. **Casalonga Avocats** is a firm of attorneys-at-law dedicated to patents, trade marks, copyrights, designs, litigation and advice and trade mark and design prosecution work. Bureau Casalonga & Josse has two offices in France, one office in Alicante and one in Munich while Casalonga Avocats has one in Paris. In January 2006, the IP litigation team from Courtois Lebel joined Casalonga Avocats bringing its total to nine attorneys, who are all members of the Paris Bar. Both firms have clients across all industries, including pharmaceuticals, IT, sports, clothing, media, luxury goods and audiovisual. Over

TRADE MARK/ COPYRIGHT CONTENTIOUS**Tier 1**

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 Escande
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Bureau D A Casalonga-Josse
 De Gaulle Fleurance & Associés
 Freshfields
 Latham & Watkins
 Nataf & Flajenbaum
 Simmons & Simmons

the past 12 months, Casalonga Avocats has represented France Television in numerous trade mark and copyright matters and VF Corporation in various proceedings with the French Customs authorities. Both Casalonga Avocats and Bureau Casalonga & Josse represented Air Liquide Sante in a patent infringement action against AGA Medical and Mönlycke against Urgo in an important patent matter. Bureau Casalonga & Josse also represented BNP Paribas in an important patent infringement matter against an individual who was claiming prior rights on a computer-related invention for consulting bank accounts by phone or through a computer terminal. Other clients of the firm include CBS, Nike, Seiko, Polaroid, France

Televisions, Hasbro, L'Oreal, ST Microelectronics, Schering Plough and Renault.

Lovells retains its position in tier 1 for trade marks. Sadly for the firm, 2006 was marked by the sudden death of partner Milan Chromecek in a motor accident at the beginning of April. After 11 years with the firm, David Taylor became a partner. The Paris IP practice office has 13 lawyers and five paralegals devoted to IP. The firm concentrates on the full breadth of IP: trade marks, design rights, copyright and domain names including both prosecution and contentious work. The firm's work for patents is contentious in nature including arbitration, mediation and ADR. Clients include Spirits International, Estée Lauder, TOTAL Petrochemicals, Wright Medical Group and eBay. Marie-Aimée de Dampierre and Antoine Briand represented Crocodile International, a key player in the clothing industry in Asia, in proceedings in France against La Chemise Lacoste. Dominique Ménard, Andreas von Falck, Martin Faehendrich, Luigi Mansani, Alexander Klicznik, Esther Van Weert and Olivier Banchereau acted for Association pour l'Essor de la Transfusion Sanguine (AETS) and Centre Régional de Transfusion Sanguine de Lille (CRTS) in a trans-border patent infringement litigation which started in 1991. Lovells' global online brand management and protection service, named Anchovy, is based in Paris and David Taylor, Jane Seager, Lionel de Souza, Daniel Madden and Tony Vitali advised 44 clients, including Amazon.com, Horn Abbott, Prudential, Levi Strauss and Deutsche Telekom on their strategies to protect their IP rights under the new .eu domain extension.

Simmons & Simmons in France concentrates on trade marks, copyright, design rights prosecution and contentious work and is involved in the textiles/fashion, consumer goods and tobacco and alcohol

industries. Senior associate Sarah Bailey and partner Antoine Juaristi have recently defended simultaneous trade mark infringement proceedings in relation to new product packaging. Bailey and Frédérique Potin have also advised the Indian Pharma Company in multiple opposition proceedings at French and OHIM level to protect its group name and advised on the IP rights in the context of an acquisition of an ambient music business.

Freshfields' IP practice is run by Xavier Buffet Delmas, who is president of the well known French association of intellectual property, Association des Praticiens du Droit des Marques et des Modèles. This year, the firm advised Colgate Palmolive in relation to an acquisition with significant IP aspects in Europe, France Telecom in relation to licence and patent issues and Informatique CDC in relation to the management of its licences on free software. In other cases, Freshfields acted for L'Oréal in a wide range of IP cases, Sara Lee on the sale of its European meats business to Smithfield Foods and Solvay in relation to a key patent infringement litigation and in several IP disputes. Other clients include Abbott Laboratories, Ipsen, LVMH, Nintendo, Reed Elsevier, Renault, Sony and Synthon.

Parisian IP firm **Gilbey de Haas** has a team of three partners and five associates and advises both French and international clients and associates, including multinational corporations in the pharmaceutical, cosmetics, electronics, food and beverage, consumer products, apparel and luxury goods fields, in all phases on management of their IP assets. The firm is strong in trade marks and handles non-contentious and contentious work but does not file or prosecute patent applications.

German & Maureau has offices in Lyon and Paris and has a good reputation in France for patent matters and trade mark prosecution. **Ernest Gutmann – Yves**

Plasseraud is devoted to patent prosecution and has an excellent reputation for biotechnology work. The firm moves up to the second tier from tier 3 in patent prosecution. Ernest Gutmann-Yves Plasseraud is led by three female partners, Anne Desaix, Julia Andral-Ziurys and Carol Almond-Martin. Almond-Martin is particularly well recommended by peers for the quality of her work.

The forerunner of **Cabinet Plasseraud** was founded in 1906 by Charles Weismann and Armand Marx. In the past 10 years the firm has grown considerably and has doubled in size. Cabinet Plasseraud is now well known as

one of the top French firms in the field of intellectual property and has departments for electricity, electronics, mechanics and physics. This is reflected in its first tier and second tier status in patent prosecution and trade mark prosecution respectively.

Boutiques featuring for the first time in the French rankings include **Howrey Cousté** and **Yves Marcellin** in the patent contentious area, **Inlex IP Expertise** and **adsigna** for trade mark prosecution and **Nataf & Flajenbaum** for trade mark contentious. **Howrey Cousté** is considered to be a good firm, which is performing well in the litigation field and attracting a lot of clients.