

Managing Intellectual Property™

15TH EDITION

HANDBOOK

2008

FRANCE: MARKET OVERVIEW

PATENT PROSECUTION

Tier 1

Bureau D A Casalonga-Josse
 Cabinet Beau De Loménie
 Cabinet Lavoix
 Cabinet Plasseraud
 Cabinet Regimbeau
 Santarelli

Tier 2

Ernest Gutmann - Yves Plasseraud
 Hirsch-Pochart & Associés

Tier 3

Bredema
 Brevalex
 Cabinet Degret
 Germain & Maureau

PATENT CONTENTIOUS

Tier 1

Véron & Associés Avocats

Tier 2

Cousin & Moatty
 Duclos Thorne Mollet- Vieville & Associés
 Gaultier Lakits Szleper
 Phillipe Combeau

Tier 3

Allen & Overy
 Armengaud Guerlain
 Hirsch Lamoureux Desrousseaux
 Howrey
 Lovells

Tier 4

Bird & Bird
 Casalonga Avocats
 Freshfields Bruckhaus Deringer
 Gide Loyrette & Nouel
 Linklaters
 Yves Marcellin

French IP policy has been dominated by three issues over the past year: the introduction of tougher rules against counterfeiters, government proposals to break down the barriers between professions by merging the trade mark and patent attorney profession and the legal profession to give attorneys greater rights of audience before the courts, and the government's long-awaited decision to ratify the London Agreement on patent translations.

On January 29, the French IP office confirmed that France had deposited its instrument of ratification for the London Agreement in Germany. The move means that the Agreement will come into force on May 1 for the 12 countries that have signed it.

As a result, applicants who want a patent in Croatia, Denmark, France, Germany, Iceland, Latvia, Liechtenstein, Monaco, the Netherlands, Slovenia, Switzerland or the UK will no longer be required to translate the patent into each country's national language. Instead, these countries have agreed to accept patent applications in one of the EPO's official languages: English, French or German. Although many French IP owners gave their backing to the London Agreement, which should cut the cost of patenting in Europe by up to 40%, according to studies by the EPO, many patent attorneys across Europe, including in France, opposed the deal. This was partly for reasons of linguistic

TRADE MARK PROSECUTION

Tier 1

Cabinet Beau De Loménie

Cabinet Lavoix

Germain & Maureau

Tier 2

Bureau D A Casalonga-Josse

Cabinet Plasseraud

Ernest Gutmann-Yves Plasseraud

Santarelli

Tier 3

Adsigna

Cabinet Regimbeau

Gilbey Delorey

Hirsch-Pochart & Associés

Inlex IP Expertise

Novagraaf Intellectual Property

ProMark

Sodema Conseils

TRADE MARK CONTENTIOUS

Tier 1

Armengaud & Guerlain

Lovells

Tier 2

Cousin & Moatty

Duclos Thorne Mollet-Viéville & Associes

Gaultier Lakits Szeleper

Philippe Combeau

Tier 3

Allen & Overy

Escande

Gide Loyrette Nouel

Gilbey Delorey

Hirsch Lamoureux Desrousseaux

Linklaters

Tier 4

Bird & Bird

Casalonga Advocats

De Gaulle Fleurance & Associés

Freshfields Bruckhaus Deringer

Herbert Smith

Howrey

Latham & Watkins

Nataf & Flajenbaum

Simmons & Simmons

pride and a fear that the implementation of the Agreement would make it far harder for people who do not speak one of the EPO's three official languages to access the technological information contained in patent applications. But some attorneys also opposed it because they feared losing lucrative translation work. Of course the full impact of the implementation of the Agreement has yet to be felt.

Leading prosecution boutique Bureau D A Casalonga-Josse retains its top-tier position

for patent prosecution and second tier ranking for trade mark prosecution work this year. Axel Casalonga leads a team of 10 partners and 28 associates at the firm. He is highly praised by peers for his "wide experience in IP matters" and is described as "one of the more knowledgeable IP practitioners in France". His team has experience prosecuting patents across a wide range of industries, from mechanical and electronic applications to chemistry, pharmaceutical and biotech. The departure of

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Granrut Avocats

Nicolas Boespflug

Tier 3

Cl ry & De la Myre Mory

Darteville Benazeraf Merlet Dubest

Denton Wilde Sapte

Duclos Thorne Mollet Vieville et Associ s

Zylberstein & Associ s

partner Gabriel de Kernier in September 2007 will undoubtedly hit the IP practice, but the firm has already taken steps to boost the team adding two impressive new associates, Marie-Emmanuelle Haas and Emmanuelle Limouzy, from rival firms. Bureau D A Casalonga-Josse advises a blue-chip list of leading French companies including L'Oreal, Renault, BNP Paribas, and France T l vision, as well as international companies such as STMicroelectronics, SKF and Hasbro. It has offices in Paris and Grenoble, as well as in the European IP registration centres of Munich and Alicante. Over the past year the firm has represented chair maker Himolla in a trade mark and copyright dispute with Ekorness over the design of a reclining chair that is sold across Europe.

While Bureau D A Casalonga-Josse takes care of prosecution issues, associated law firm **Casalonga Advocats** looks after legal concerns. The firm was created in 2006 as a result of the merger between the trade mark

At-a-glance

Institut National de la Propri t  Industrielle

26 bis rue de Saint-P tersbourg

75800 Paris Cedex 08

France

Tel: +33 (0) 820 210 211

Website: www.inpi.fr

team from Bureau Casalonga & Jose and the IP litigation team of Courtois-Lebel. It now has three partners and five other fee earners and advises clients in all areas of IP, but excels mainly in patent and trademark contentious work where it has a very respectable tier 4 ranking, sitting alongside much larger rivals.

Another leading prosecution firm **Cabinet Beau De Lom nie** retains its tier 1 ranking for both patent and trade mark work this year. The firm has offices in France and Munich and employs more than 200 people, including 60 associates and five partners working out of four offices in France. It counts among its clients companies in the electronics, perfumes, clothes and IT industries.

Another French firm with a strong regional presence is **Cabinet Lavoix**, which has offices in Paris, Lyon, Toulouse and Auvergne. The IP team retained its position as one of the top teams for patent and trade mark prosecution but in 2008 it sought to boost its already impressive capabilities when it merged with JP Colas, a small firm of 20 people that specializes in electronics. The move gave it seven new associates and three new partners – Thierry Geismar, Samuel Le Cacheux and In s Tripoz. The firm now numbers 17 partners and 43 associates.

Michel Moncheny and Gérard Myon receive particular praise from peers for their work in patent prosecution.

Cabinet Regimbeau specializes in patent prosecution and rivals in the market agreed that it merited its top-tier ranking in this area. Ten partners lead a team of 180 people, including more than fifty scientists and lawyers, based in offices in Paris, Rennes, Lyon and Grenoble.

Cabinet Plasseraud was founded in 1906, comprises 60 patent attorneys and is one of the leading firms for patent and trade mark prosecution work in France. The firm has been busy reinforcing its IP practice at all levels this year: it appointed Raphaël Fleurance and Albert Hassine as partners and recruited patent attorneys Magali Touroude, Béatrice Aveline, Guy Le Falher and technology specialists Abdelaziz Khatab, Aurélien Huisman, Jacqueline Vinatier-Gilchrist and Carolyn-Ann Caron.

Rounding off the top-tier patent prosecution firms is Santarelli, which comprises seven partners and 30 practitioners in offices in Paris, Marseille and Toulouse. The firm provides a full range of IP services but specializes in patent and trade mark prosecution, contracts and licensing. Nathalie Berna, a specialist in pharmaceutical and chemical patent work, joined the Marseille office in March 2007.

The legal affairs, trade marks and industrial designs department is managed by Laurence Julien-Raes. The patent department is managed by partners Luc Santarelli, Herbert Lewitter, Bruno Quantin, François Lepelletier-Beaufond and Thierry Caen.

Ernest Gutmann Yves Plasseraud has 20 years' experience providing IP prosecution services. The firm comprises 50 professionals including five partners and 14 associates operating from Paris, Lyon and Alicante. The firm's clients include research institutes, biotechnology start-up companies and some

of France's leading universities. Third tier patent prosecution firm Germain & Maureau was founded in 1849. It is headquartered in Lyon and has offices in Paris and Saint Etienne. The firm specialises in the protection of patents, trade marks, designs and copyright, and it is particularly strong in trade mark prosecution, where it ranks as one of France's top three practices, according to market feedback. The IP team comprises seven partners and around 30 fee earners.

Cabinet Degret is again placed in tier 3 for patent prosecution work, alongside Bredema, the new name for the merged practice of Breese Derambure Majerowicz and BDSA. Pierre Breese is a highly rated attorney and he leads the team of five partners and about 100 associates based in offices in Paris and London. Rounding off the third tier for patent prosecution is Brevaalex, the new name for the former Société de Protection des Inventions. The firm is jointly managed by Pascal Moutard and Gerard Poulin, and has 16 partners, eight French Industrial property attorneys and 69 other fee earners spread between offices in Paris, Grenoble and Toulouse. The IP practice assist clients in the drafting, acquisition, defence, exploitation, management and assessment of IP rights. The firm has a number of clients in the French energy sector.

Once you have your patent, you need to enforce it. And when it comes to patent enforcement in France, Véron & Associés leads the way. The IP litigation boutique is specializes in cases in the pharmaceutical, mechanics, electronics, plant breeders' rights, and telecommunications industries. One rival said of the firm: "They are highly considered in France for their unique skills at explaining to judges even the most complex technical issues". Pierre Véron leads the firm of four partners and 11 associates, based in offices in Paris and Lyon. Véron is regarded as a "leading French authority on IP matters".

Over the past year the firm advised Chiron on the first case decided in a French court relating to infringement of a molecular biology patent, and is advising Nokia on its legal battle in France with Qualcomm. Other key clients include Novartis, L'Oreal, Air Liquide and bioMerieux.

Another strong patent litigation firm, which also has a strong showing in the trade mark contentious rankings, is Gaultier Lakits Szeleper. The firm's three partners, Geoffroy Gaultier, Anne Lakits-Josse, Dariusz Szeleper, are described by clients as "very capable litigators". The firm specializes in patent and trade mark law, and has particular experience defending clients in trade mark disputes.

Phillipe Combeau is another leading firm for contentious work in France and retains its strong tier 2 placing on both sides of the contentious rankings. Philippe Combeau is a highly regarded litigator and is described by one competitor as having "successfully dedicated his life exclusively to contentious work".

US IP and antitrust firm Howrey is continuing its assault on key European markets, and is already seeing good returns in France. Its office in Paris has a strong reputation in high-stakes litigation and this year moves up to the third tier in the patent contentious rankings and makes its first appearance in the trade mark contentious table. The IP practice covers all aspects of IP law, but specializes in litigation. In April 2007 it boosted its team with the hire of former Linklaters lawyer Denis Monegier Du Sorbier as a partner. The IP team now consists of three partners and four associates. It recently advised Mitsubishi in patent infringement cases involving mobile phones and advised P&G on a cutting edge case relating to registered Community designs. Other important clients include Pfizer, Essilor, GlaxoSmithkline and Coca-Cola.

Freshfields Bruckhaus Deringer provides a

full range of IP legal services from its office in Paris. The firm occupies a tier 4 position in the trade mark contentious ranking and this year has been included in tier 4 of the patent contentious table, as well as an excellent performance in the inaugural copyright rankings. Unsurprisingly for a magic circle corporate law firm, the IP team works closely with colleagues in other areas of the firm, providing corporate support work. The firm lost leading French lawyer Xavier Buffet Delmas, president of the French IP association, to Hogan & Hartson in June 2007, but appointed Sophie Havard Duclos as counsel four months later. The firm recently advised Colgate-Palmolive on the re-use of a jingle created by several authors in TV advert and represented Hauck and Toys'r'us in an infringement dispute.

Inlex IP specializes in the protection and valuation of trade marks, industrial designs, copyright and domain names, and also advises on unfair competition issues. The firm merged with Applima Conseil on October 2006 and over the past 12 months has hired nine attorneys, advised Nestlé on a Community trade mark, and represented Thomson Life Multimedia Sales in a lawsuit related to a registered trade mark.

De Gaulle Fleurance & Associés hired three associates in 2007 and now comprises four partners and 13 associates. Name partner Louis de Gaulle has been appointed to represent the French Pharmaceutical Industry Union to negotiate with the WHO on counterfeiting matters. The firm recently advised Microsoft on the protection of its trade mark for Windows Vista and the launch of the operating software in France. Other clients include Business Software Alliance, Dreamworks Animations and Fox.

Simmons & Simmons's Paris IP team comprises one partner and three associates and the firm advises a number of companies in the fashion, consumer goods, tobacco and

alcohol industries. Another UK firm, **Allen & Overy**, has a very good reputation for contentious work. Head of the IP team **Pierre Lenoir** is regarded by competitors as an “outstanding individual” who has broad experience in cross-border litigation and product liability cases, particularly within the pharmaceutical sector.

Gide Loyrette Nouel retains its tier 3 ranking for trade mark contentious work and its position as a tier 4 firm for patent contentious work this year. The IP team comprises four partners, 12 associates and three paralegals and partner **Grégoire Triet** is highly praised by clients as “one of the most

respected IP practitioners in France”. The firm has gained substantial experience in legal issues raised by communications technologies: media law, information technology, personal data management, network security and piracy prevention, on-line transactions, as well as telecommunications law. **Borowsky & De Baecque** features this year in tier 1 of the inaugural copyright rankings. Its IP practice is particularly focused on advising clients in the audiovisual, film and television, art, fashion, luxury goods, and design and music industries. It has also developed substantial expertise representing authors, actors and producers in disputes relating to copyright.