

**Patent validity
Comparative study
The French perspective**

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**Preliminary remark about
the evidence sources**



- No witnesses
- Written evidence only
- Most limited weight of affidavits issued by people involved in the matter

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Context of validity disputes

- Most usually, validity is discussed within the framework of a counterclaim for revocation lodged by the alleged infringer
- Main actions for revocation are not usual

Grounds for revocation

FR patent : Art. L 613-25
of the French Intellectual Property Code

EP patent : L 614-12
Referring to 138(1) EPC

Lack of novelty, inventive step or industrial application, contradiction with public order or morality, insufficiency of disclosure, extension of the subject-matter of the patent beyond the content of the application as filed, or beyond the content of the earlier application in case of divisional application

-138(1)d : extension of the protection

-138(1)e : unentitled owner
(not applied by Paris First Instance Court,
September 15, 2000, Apotex v. Wellcome)

Limitation of claims

- Voluntary limitation impossible
- Only one possibility : partial revocation of the claim when the grounds for revocation affect it in part only (Article L 613-25 for French patents, L 614-12 for European patents)

Partial revocation of claims

- Exceptional (only 12 published French decisions)
- Admitted mainly in case of extension beyond the content of the description
- For French patents, Article L 613-27 provides that the patentee is referred by the Court to the French patent office for the filing of a modified claim

Impact of EPO or foreign Courts decisions

- EPO decisions dismissing an opposition do not have *res judicata* (Paris Court of Appeal, July 4, 2001 and Paris First Instance Court, May 28, 2002, Technogenia cases)
- Despite the principle of titles independence, French Courts can be influenced by foreign decisions

Novelty : basic principles



The invention is new if it is not part of the state of the art, which comprises all matter made available to the public, without any limitation regarding time, space and form



written



oral

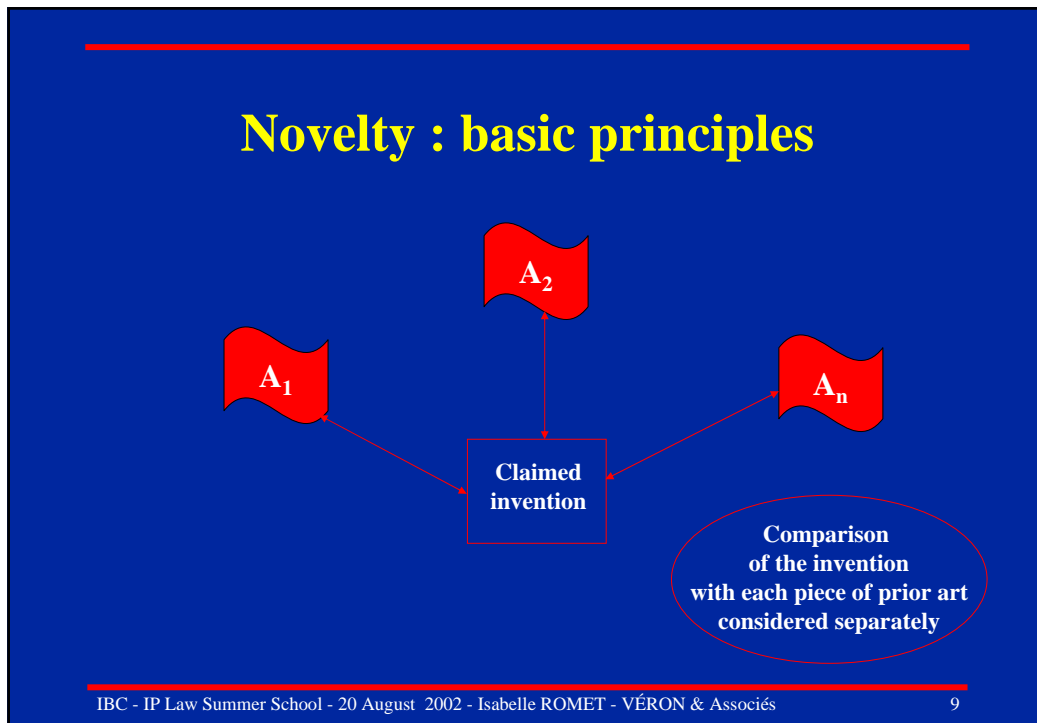


use



or any other
way

Patent filing or
its priority, if any



Novelty : availability requirement

The piece of prior art is available to the public if :

- At least one person,
- Not bound to secret either expressly or implicitly,
- Could, at least theoretically, have access to the piece of prior art,
- And if it revealed the claimed means sufficiently clearly so that the skilled person could reproduce them

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Interesting case law about availability

- Implicit confidentiality was admitted for employees, subcontractors, the manufacturer of a prototype but not for visitors,
- A recent and particularly liberal decision (Paris First Instance Court, September 1, 1999, Allen & Hanburys v. 3M Santé) admitted implicit confidentiality not only for physicians but also for patients taking part in extensive clinical trials,

Interesting case law about availability

- French case law (Paris First Instance Court, March 14, 2000) is in line with EPO case law about non availability of inherent hidden effects (G2/88, G6/88)
- French Courts take into account what the prior art document describes sufficiently and not embodiments which it implies as possible but which remain unspecified (Paris Court of Appeal, May 30, 1997, Genentech v. Lilly France)

Novelty : requirement regarding the content

- The piece of prior art is novelty destroying if it discloses all the means of the invention, as claimed, and recent case law is very demanding :

« To be anticipated, the invention must be entirely comprised in a single piece of prior art, with the same constituting elements in the same structure, the same arrangement and the same functioning, for the same technical result » (Cour de Cassation, Commercial Chamber, June 6, 2001)

- Exception : in case of collocation of means, i.e. means which do not cooperate for a common result different from the addition of their own results, each means can be anticipated separately (Lyon Court of Appeal, September 10, 1998)

Second therapeutical use : hopes in 1991

Paris Court of Appeal, June 11, 1991, Synthelabo v. Najer :

- refers to EPO case law to admit the novelty and the inventive step of a claim protecting a drug comprising alfuzosine and excipients for the treatment of urinary diseases,
- although this compound was used in the past for the treatment of cardiovascular diseases,

Second therapeutical use : step back and uncertainty

- Decision quashed by the *Cour de Cassation*, October 26, 1993, on the grounds that it is contrary to Article L 611-11 of the French Intellectual Property Code (= Article 54(5) of the EPC)
- According to its own report, the *Cour de Cassation* did not want to take position about the novelty of second therapeutical uses and preferred to consider that they could not show inventive step
- No other relevant decision since that time !

Second therapeutical use : a missed opportunity with AZT

Paris Court of Appeal, September 15, 2000, Apotex v. Wellcome, relating to a patent covering the use of AZT for the treatment of AIDS :

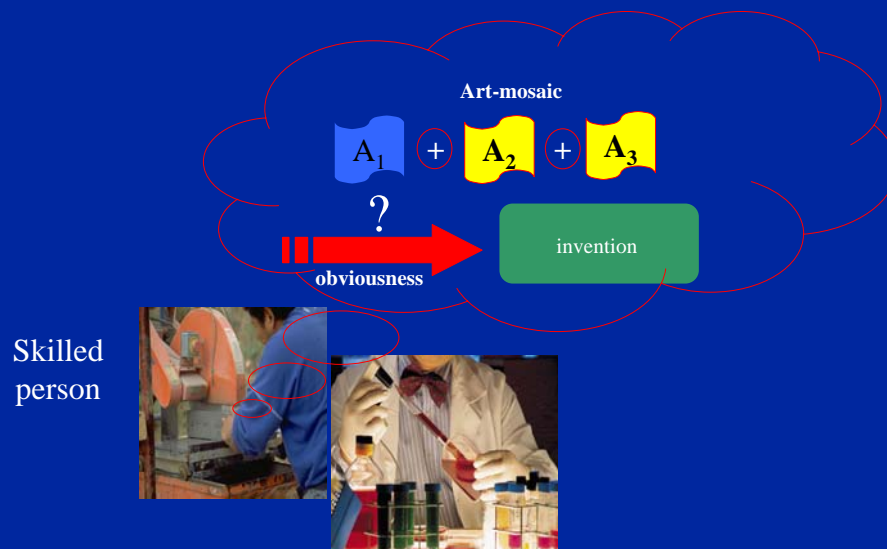
- held that the prior art had only issued an assumption about a possible medical use of AZT, without describing any,
- so that the invention is novel regardless the novelty of a second medical use.

Novelty : proof requirement

- The one who challenges the validity of a patent has the burden to prove the date and the content of prior art with certainty.
- Doubt benefits to the patentee.



Inventive step : basic principles



Inventive step : the profile of the skilled person

- An ordinary person, who is able to implement but without imagination
- In the field of the problem solved by the invention
- In contrast to EPO, French Courts tend to refuse to consider a group of experts (*Cour de Cassation*, Commercial Chamber, October 17, 1995, quashing a decision which had held that the skilled person in the field of hand drills could refer to the specialist of tools of all types of drilling machines)

Inventive step : admissible prior art

- Knowledge corresponding to the professional profile of the skilled person
- Basic general knowledge, whatever the field
- Knowledge corresponding to close fields
- French case law tends to reject non definitely established scientific data, especially in the medical field (Paris First Instance Court, November 16, 1994, which put aside recent research reports which were not yet established scientific data)

Obviousness appraisal

- French approach is in line with EPO :
 - Problem-solution approach
 - Unexpected effect
 - Overcome prejudice
 - Long felt need
- Nevertheless, French reasoning is less systematic as compared to EPO one

Sufficiency of disclosure

- French Courts tend to be quite liberal
- Insufficiency of disclosure is rarely admitted

Sufficiency of disclosure : recent case law

- « *Description is sufficient when the information it provides about prior art enable the skilled person, with his basic general knowledge, to reproduce the invention* » (Paris Court of Appeal, September 28, 2001)
- Mistakes should not lead to the revocation of the patent « *if the skilled person can correct them with his basic general knowledge and the prior art quoted in the patent* » (Paris Court of Appeal, September 28, 2001)
- « *The ability to reach more or less perfectly the announced result does not have to be considered* » (Paris Court of Appeal, September 12, 2001)

Sufficiency of disclosure : breadth of claims

- Validity of claims defining the means of the invention by their function,
- Especially if there is no other way to define the invention without limiting its teaching,
- Provided that the claim does not cover a result

(see, in particular, Paris Court of Appeal, May 30, 1997, Genentech v. Lilly France, affirmed by the *Cour de Cassation*, Commercial Chamber, December 19, 2000)

Sufficiency of disclosure : breadth of claim

- The sufficiency of disclosure requirement does not imply to describe all the embodiments of a claim
- A claim can validly generalize one or several examples

(see, in particular, Paris Court of Appeal, May 30, 1997, Genentech v. Lilly France, affirmed by the *Cour de Cassation*, Commercial Chamber, December 19, 2000)

Conclusion

- No major differences regarding the applicable rules in European countries
- Quite patent friendly application of these common rules by French Courts

Thank you for your attention