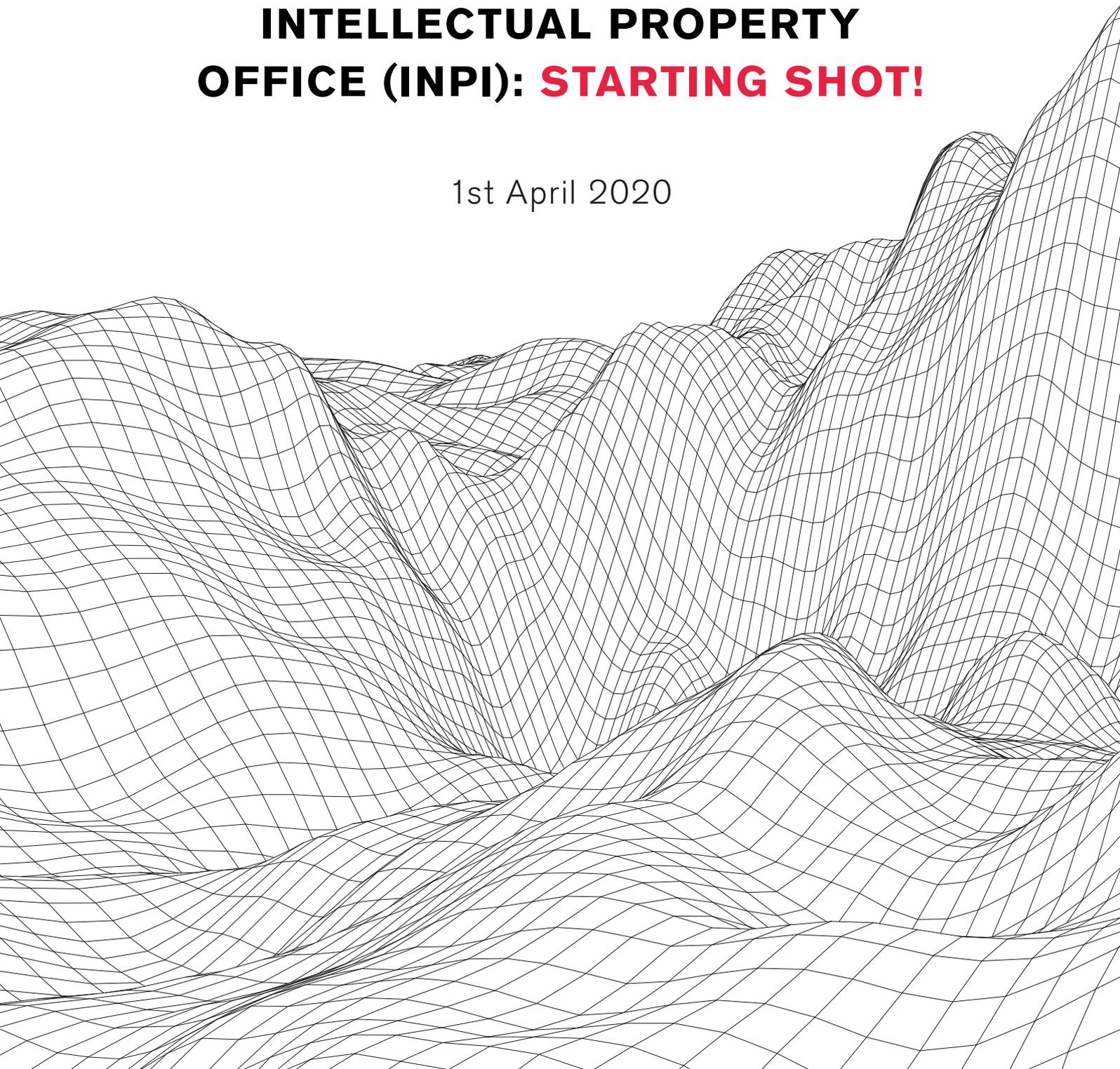




**AUGUST DEBOUZY**

**THE OPPOSITION PROCEDURE  
BEFORE THE FRENCH  
INTELLECTUAL PROPERTY  
OFFICE (INPI): **STARTING SHOT!****

1st April 2020



Today is the “launch” day of the opposition procedure before the French Intellectual Property Office (“Institut National de la Propriété Intellectuelle” or “INPI”).

This procedure is a new way to challenge the validity of a French patent, alongside the invalidity action.

Opposition may be filed against any French patent whose mention of grant has been published in the Industrial Property Official Bulletin as from 1st April 2020.

This «French-style» opposition procedure is seemingly relatively similar to that of the EPO.

However, its specificities should not be underestimated, and more specifically:

- overall shorter time limits to respond before the INPI compared to those applicable before the opposition divisions of the EPO;
- an apparently more circumscribed oral phase, during which, for example, it should not be possible for the patent holder to submit new proposals for amendments in relation to those made during the written phase;
- the impossibility for the INPI to maintain the procedure in the event the opponent withdraws their claim;
- an appeal before a court (the Paris Court of Appeal), which implies, in particular, that the parties are familiar with the case law of this court regarding invalidity and that they anticipate, from the beginning of the procedure before the INPI, the rules of civil procedure that will be applicable at the appeal stage.

The practical details of this procedure were specified by INPI in the decision No.2020-34 of 1st April 2020. Further details are expected to be provided by the future INPI guidelines on the opposition procedure.

Due to its specific features, the new opposition procedure requires the assistance, as early as the proceedings before the INPI, of a counsel having both technical and scientific expertise, experience of the opposition procedure before the EPO and experience of patent litigation in France, in order to determine the best possible strategy with regard to other options (invalidity, limitation, infringement, etc.) in terms of time, cost and chances of success, and to best anticipate the procedural rules applicable before the Court of Appeal, including inadmissibility .

August Debouzy’s patent team, comprising lawyers, French patent attorneys (CPI) and European patent attorneys, has this three-fold expertise and is at your disposal to use this expertise in connection with the assessment of the appropriateness, the preparation and the management of opposition procedure in France.

## FOR ALL PARTIES

### DO

#### **From the beginning of the procedure before the INPI: anticipating the appeal phase before the Court of Appeal**

- Building one's arguments by taking into account the case law of the Paris Court of Appeal regarding invalidity
- Building arguments by anticipating the inadmissibility applicable at the appeal stage

#### **During the investigation phase before the INPI: asserting one's arguments and producing one's exhibits sufficiently in advance**

- Goal: complying with the adversarial principle and avoiding rejection

### DON'T

#### **Filing the opposition, without considering other legal options**

- For French-style opposition procedure, we recommend that you build your action or defence strategy with the assistance of a counsel experienced in other types of patent litigation and that you consider all possible actions (opposition, invalidity claim for ownership, infringement action, limitation action).

#### **Choosing a counsel specializing only in granting procedures before the offices**

- For French-style opposition procedure, we recommend that you seek legal assistance from a counsel with both technical expertise and experience in judicial litigation (including the adversarial principle and the rules of civil procedure).

## FOR THE OPPONENT

### DO

**Contesting all relevant claims as soon as the opposition is filed**

**Asserting all grounds for opposition as soon as the opposition is filed**

**Mentioning all available documents (and their translations in French) as soon as the opposition is filed** (unless there is a deliberate intent to keep some of them for other procedure, or a carefully considered staggered opposition).

**Leveraging the «window of opportunity» of approximately two years**, in which it will be possible to oppose patents that have not been subject to an in-depth examination by the INPI (this in-depth examination, including in particular the criterion of inventive step not previously examined, only takes place for applications filed as from May 22).

### DON'T

**Filing the opposition without /taking into account the opponent's identity**

- Filing an opposition on behalf of the «real» opponent presents a significant risk of res judicata.
- On the other hand, choosing a straw man makes it possible:
  - o to remain discreet in relation to the public (in particular if the opposition procedure is resolved by an amicable solution);
  - o to benefit from longer time limits (extra time allowed for distance) by choosing a straw man located abroad

## FOR THE PATENT HOLDER

### DO

**Considering the possibility of filing a divisional patent application in France**

### DON'T

**Awaiting the INPI's opinion to file proposals for amendments**

- Contrary to the practice at the EPO, since the possibilities for submitting amendments are very limited, it is even more risky to remain passive and wait for the Office to decide on the opposition before amending the claims.

**Giving oneself a chance to slightly adjusting the proposed patent amendments for the oral phase (e.g. small problems of clarity).**

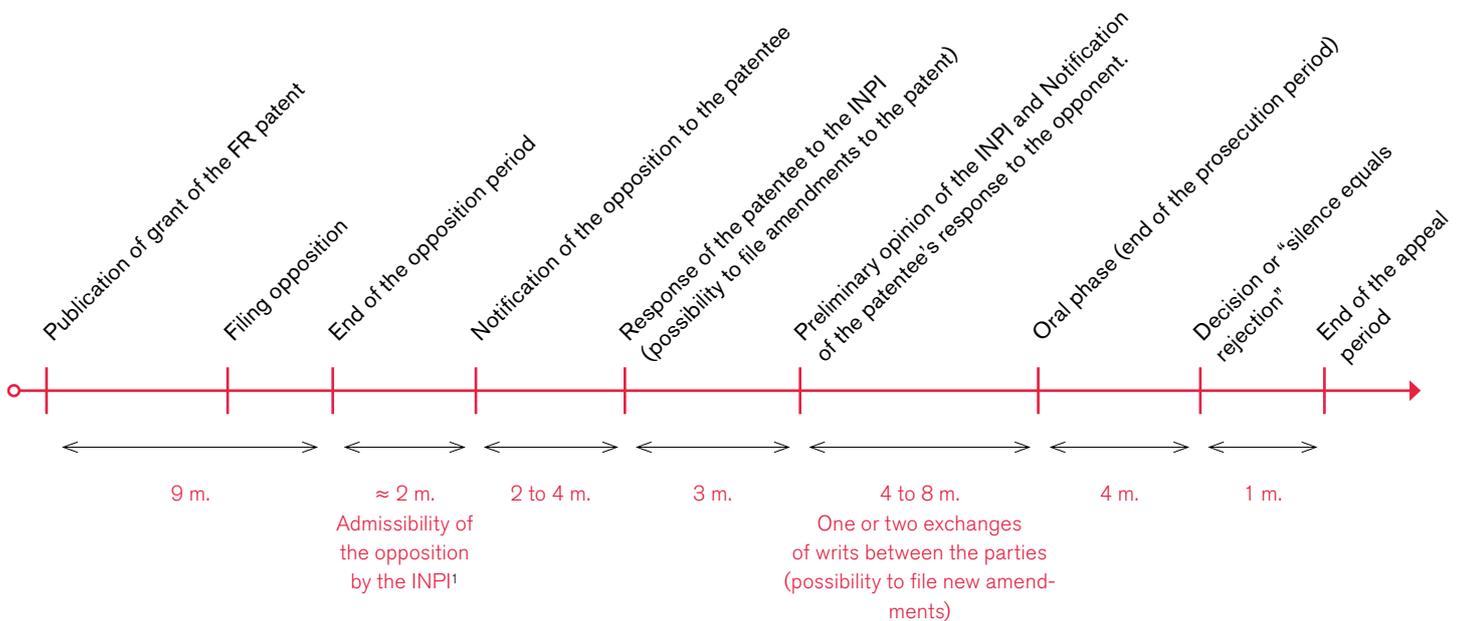
- The oral phase does not literally provide for the possibility of submitting amendments, so the slightest amendment to be made during this phase could therefore be rejected.

**Considering the opposition appeal as a new procedure with the possibility of further amending the patent.**

- Similar to the recent amendment of the Regulation before the Boards of Appeal at the EPO, the appeal procedure in France will not accept further amendments (prohibition of new claims).

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## 1. THE MAIN STAGES OF THE OPPOSITION PROCEDURE



1. Time limit not specified in the texts but assumed with respect to the declarations made during the preparatory meetings.

## 2. WHO CAN OPPOSE?

**Anyone, except for the patent holder.**

It will therefore be possible for a **"straw man"** to oppose. If the straw man resides abroad, **extra time allowed for distance**, as provided in particular at the stage of appeal before the Court of Appeal, will be granted. However, choosing a "straw man" has a disadvantage if the prosecution is very long (opposition filed at the end of the patent lifecycle) or if the patent holder chooses to no longer pay their annuities. Indeed, when the effects of the patent against which the opposition has been filed cease, only the opponent who can justify a legitimate interest in obtaining an opposition decision can obtain that the proceedings continue and not be terminated. It will therefore not be possible to obtain this for the straw man.

Where **several oppositions** relate to the same patent, these requests shall be joined in a single procedure.

Contrary to what is provided for before the EPO, French texts do not provide for **the possibility for the alleged infringer to take part in** the procedure once the nine-month period for filing an opposition has expired. The texts refer only to a possible intervention at the appeal stage, without giving any details, but the provisions of the French Code of Civil Procedure should apply, in particular those providing for the possibility for a third party to take part voluntarily in an ancillary manner if it is in their interest, for the preservation of their rights, to support a party. This could be the case for the alleged infringer (in support of the opponent) or the licensee (in support of the patent holder).

**The texts make no provision for the transferability or non-transferability of the status of opponent.** This is a complex issue. It is advisable to await the guidelines or initial decisions of the INPI in this regard.

**The licensee should be able to act in opposition**, subject to applicable provisions of contract law and competition law.

Finally, contrary to what happens at the EPO, French texts do not provide for the possibility for the INPI to pursue the opposition alone in case of withdrawal of the opposition.

### 3. BY WHOM CAN THE OPPONENT BE REPRESENTED?

Before the INPI: if the opponent's place of residence or registered office is located in a Member State of the European Union or in a State that is a party to the Agreement on the European Economic Area, the opponent may act directly or shall appoint a representative. Otherwise, representation by an agent is mandatory.

Finally, regardless of the opponent's place of residence, if the opposition is filed jointly by multiple persons, representation by a common representative is mandatory.

The representative's place of residence, registered office or place of business must be located in a Member State of the European Union or in a State that is a party to the Agreement on the European Economic Area.

This may be an employee of the opponent with a power of attorney, a French Patent Attorney or a lawyer. Lawyers and French Patent Attorneys are exempt from the power of attorney.

During the appeal procedure before the Court of Appeal, representation by a lawyer is mandatory.

We therefore recommend that the parties be assisted, as early as the proceedings before the INPI, by a counsel with both technical expertise, experience in opposition procedure before the EPO and experience in judicial patent litigation in France, in order to best anticipate the procedural rules applicable before the Court of Appeal, including inadmissibility.

August Debozy's patent team, comprising lawyers, French and European Patent Attorneys has this three-fold expertise and will make full use of it to assist you.

### 4. WHICH PATENTS CAN BE OPPOSED?

All French patents whose mention of grant has been published in the Industrial Property Official Bulletin as from 1st April 2020.

## 5. HOW ARE THE «OPPOSITION DIVISIONS» OF THE INPI ORGANIZED?

During preparatory meetings, the INPI announced that its Patent Department is composed as follows:

- 10 divisions according to technical fields;
- 1 opposition referent per division responsible for prosecuting the opposition with 2 other agents, preparing the preliminary opinion and conducting any oral proceedings
- This referent has received training on how to conduct an adversarial debate and training with the EPO on how to draft a preliminary opinion.

The INPI Examiner in charge of the examination of the patent application cannot prosecute the opposition but may be heard.

## 6. IS THE PUBLIC INFORMED OF THE OPPOSITION, THE PARTIES' SUBMISSIONS AND EXHIBITS, AS WELL AS THE DECISION?

Yes.

The opposition and the decisions of the Opposition Division are recorded in the National Patent Register.

The texts do not contain any further details as to the publicity of the other elements of the opposition procedure (such as the opinion of the INPI, the parties' submissions and exhibits). However, the INPI has indicated during preparatory meetings that all the elements of the file will be posted online rapidly as it is the case at the EPO.

## 7. WHAT IS THE AMOUNT OF THE OPPOSITION FEE TO BE PAID TO THE INPI?

600€

## 8. HAS THE INPI ISSUED/WILL THE INPI ISSUE OPPOSITION GUIDELINES?

Yes, the INPI is currently preparing opposition guidelines that will be completing the decision 2020-34 of 1st April 2020.

During the preparatory meetings, the INPI announced that the emphasis will be on what differs from the opposition procedure before the EPO but that the majority of these guidelines will be based on those of the EPO.

A first version should be available in April. It will be supplemented by updates that will be announced on the INPI website.

## 9. I AM THE OPPONENT : WHAT SHOULD I DO?

### 9.1. What grounds for opposition can I invoke?

The grounds for opposition before the INPI are the same as those before the EPO:

- The subject matter of the patent is not patentable for (i) lack of novelty, (ii) lack of inventive step, and/or (iii) lack of industrial application;
- The subject matter of the patent falls within the exceptions and exclusions to patentability (surgical, therapeutic and diagnostic methods, animal breeds and plant varieties, computer programs, etc.);
- Insufficient disclosure;
- The subject matter of the patent extends beyond the content of the application as filed, or, where the patent was granted on the basis of a divisional application, beyond the content of the parent application as filed.

In addition, it is possible to challenge the amendments made by the patent holder after the grant of the patent which would broaden its scope.

It should be recalled that the in-depth examination of patent applications by the INPI (also provided for in the "PACTE" law), including notably the criterion of inventive step, will only take place for applications filed as from 22 May 2020.

Given the usual time limits for examination and grant, it can be assumed that, for about two years, the patents to be granted will have been examined before May 22 and will therefore not have been examined, in particular, for inventive step.

We therefore recommend taking advantage of this «window of opportunity» to initiate opposition procedure against competing patents, including those with inventive step weaknesses.

### 9.2. During the prosecution period before the INPI: can I extend the scope of my opposition to claims that are not included in the notice of opposition?

No, the texts provide that the scope of the opposition cannot be extended after the expiry of the 9-month period for filing an opposition. This means that after this period, it should no longer be possible to add claims which were not covered by the notice of opposition.

Since the text provides for this impossibility «at the expiry of the time limit», the following issue may arise: if I file an opposition before the expiry of the time limit, will I be able to add claims in the interval between my opposition and the end of the 9-month period? In case of doubt, and while waiting for the INPI's guidelines relating to opposition, it is recommended that you file the opposition on a maximum number of claims.

### 9.3. During the prosecution period before the INPI: can I add new grounds that were not included in my notice of opposition?

No, just like the scope, the basis of the opposition cannot be extended after the expiry of the 9-month period for filing an opposition. This means that it should no longer be possible to add new grounds for opposition against the claims referred to in the notice of opposition after this period.

Here again, since the text provides for this impossibility «at the expiry of the time limit», the following issue may arise: if I file an opposition before the expiry of the time limit, will I be able to add new grounds in the interval between my opposition and the end of the 9-month period? In case of doubt, and while waiting for the INPI's guidelines relating to opposition, it is recommended that you file your opposition on as many grounds as possible.

After the expiry of the 9-month period for filing an opposition, it should be possible to develop grounds raised in the notice of opposition. However, we recommend that you do not just mention the grounds but that you also provide arguments in support of such grounds. Indeed, in the absence of an explanation regarding a ground, the INPI may not take it into consideration in its preliminary opinion.

#### **9.4. During the prosecution period before the INPI: can I raise new facts or produce new documents and if so, until when?**

Yes, it is possible to raise new facts or to produce new documents in support of the grounds referred to in the notice of opposition, up to the oral phase, provided that these new elements can be discussed in accordance with the adversarial principle. Otherwise, the INPI will not take them into consideration.

#### **9.5. At the appeal stage: can I extend the scope of my opposition to claims that were not covered by my notice of opposition before the INPI?**

No: If I filed an opposition against claims 1 and 2 before the INPI,, it should not be possible, before the Court of Appeal, to extend the scope of the opposition to claim 3. Indeed, there is a strong likelihood that the request to oppose claim 3 will be considered as a new claim since it serves a different purpose (revocation of claim 3) from that of the claims raised before the INPI (which sought revocation of claims 1 and 2 only).

#### **9.6. At the appeal stage: can I add new grounds for opposition to those raised before the INPI?**

Maybe: if I filed an opposition against claim 1 before the INPI for lack of inventive step, it should be possible, at the appeal stage, to add new grounds for opposition against the same claim (e.g. insufficient disclosure) because, in this case, it would not be a new claim (since it serves the same purpose as the one submitted before the INPI: the revocation of claim 1), but a new plea in law.

#### **9.7. 9.7. At the appeal stage: can I produce new documents compared to those produced before the INPI?**

Yes, it is possible to produce new documents and new evidence before the Court of Appeal compared to those produced before the INPI to justify the claims that are the subject of the appeal.

#### **9.8. Conclusion: recommendations to the opponent**

– You should carefully prepare your notice of opposition so that you do not forget any claims,

as it should no longer be possible to assert new claims, either before the INPI after the opposition period or before the Court of Appeal.

- You should carefully prepare your notice of opposition so that you do not forget any grounds for opposition, as it should no longer be possible to raise new grounds for opposition before the INPI after the opposition period; you will have to wait for the appeal stage before the Court of Appeal.
- You should raise the facts and provide the documents early enough during the prosecution period to give the opposing party time to discuss them in an adversarial manner.
- Generally speaking, you should anticipate the appeal phase as early as the procedure before the INPI and therefore not rush it or conduct it with an economy of means.

## 10. I AM THE PATENT HOLDER: WHAT SHOULD I DO?

### 10.1. Before the INPI: can I submit proposals to amend the patent and if so, until when?

Yes, proposals to amend the patent (called “auxiliary requests” in the EPO opposition procedure) can be submitted up to the end of the written phase.

It does not seem possible to submit new ones during the oral phase.

It could be modification of:

- the claims, in order to meet any of the grounds for opposition;
- the description and drawings but only in response to the ground for opposition of insufficiency of disclosure attack (the French texts therefore differ on this point from Rule 80 EPC which provides that an amendment to the description and drawings is possible in response to any of the grounds for opposition referred to in Article 100 EPC).

As before the EPO, the patent holder will have to ensure that such amendments do not extend the subject-matter of the patent beyond the content of the application as filed, or the parent application as filed, and that they do not extend the protection conferred by the granted patent.

In the case of amendments to claims, the patent holder should also ensure that they are clear and concise and that they are based on the description.

### 10.2. Before the INPI: can I invoke facts, produce documents and file observations, during the written phase and the oral phase, subject to the adversarial process?

Yes, I can invoke facts and produce documents up to the oral stage, but with the risk, for elements presented too late, that they will not be taken into consideration if the other party is not able to debate them contradictorily.

### 10.3. At the appeal stage: can I submit proposals for amendments to the patent that had not been submitted before the INPI?

No.

If, before the INPI, I made two proposals to modify the patent: PM1 and PM2, I can still submit PM1 and PM2 in appeal.

However, if I submit a new proposal to amend the patent (PM3) in appeal, it may be considered as a new claim and therefore declared inadmissible.

#### **10.4. At the appeal stage: can I submit proposals for amendments to the patent which had already been submitted to the INPI but which were not examined by the INPI?**

The issue is not yet decided.

Example 1: If, before the INPI, I made two proposals for amendments to the patent (PM1 and PM2) and the INPI maintained the patent in the form required in PM1, can the Court of Appeal examine PM2 if it considers that PM1 is invalid?

The issue is complex but it can be assumed that, since PM2 was submitted to the INPI, it is not a new claim before the Court of Appeal and it could therefore be examined by the latter.

#### **10.5. At the appeal stage: can I produce new documents compared to those produced before the INPI?**

Yes, it is possible to produce new documents and new evidence before the Court of Appeal compared to those produced before the INPI to justify the claims made before the Court of Appeal.

#### **10.6. What can I do if the opposition decision partially revokes my patent?**

If the opposition decision (whether by the INPI or the Court of Appeal) partially revokes the patent, the patent holder returns to the INPI to submit amendments to the patent in accordance with this decision.

This amendment can only be made if the opposition decision is no longer subject to appeal.

This is a procedure in which the opponent does not participate.

In practice, the claims should be blocked by the decision of partial revocation and the amendment procedure should be limited to bringing the description and drawings into compliance.

If the amendment of the patent complies with the decision of partial revocation, the INPI publishes a new specification of the patent.

If the amendment does not comply with the decision of partial revocation, the INPI shall inform the patent holder, specifying the changes to be made and the time limit for him to make them.

The amendment application shall be refused in the following two cases:

(1) If the patent holder fails to comply with the INPI's notification within the time limit or fails to file observations to contest the merit of such notification within the same time limit;

(2) If the observations submitted are not accepted and the patent holder does not comply with the new INPI's notification within the new time limit set by the INPI.

This INPI's decision should be subject to an appeal in "annulment" before the Court of Appeal.

#### 10.7. Conclusion: recommendations to the patent holder

- Prepare thoroughly the proposals for amendments to the patent during the proceedings before the INPI, in order to avoid having to submit new ones at the appeal stage which might be declared inadmissible as constituting new claims.
- Submit observations, proposals to amend the patent, and exhibits sufficiently early in the written phase before the INPI so that they are not refused on the grounds that the opposing party has not had time to debate them adversely.
- In some cases, it could be strategic to file a divisional application in order to maintain a patent application in France, and thus, the ability (i) to amend its claims in the examination procedure to which, by definition, the opponent is not a party, and (ii) to adapt its claims to the products of the opponent (alleged infringer) without this adaptation being limited to the scope of the granted patent. Care should be taken to file this divisional application before the date of payment of the grant fee and the date of printing of the original application specification.

#### 11. WHAT IS THE POWER OF THE COURT OF APPEAL AT THE APPEAL STAGE? HOW IS THE DECISION OF THE COURT OF APPEAL ENFORCED?

The appeal against the opposition decisions of the INPI is an appeal "in reformation", this means that the Court of Appeal judges the entire dispute and substitutes its own decision for that of the INPI (in contrast to the appeal in «annulment» in which the court could only annul the decision of the INPI, leaving it to the INPI to take a new decision).

The decisions of the Court of Appeal shall be notified to the parties and to the INPI, who shall be responsible for recording the decision in the national patent register.

If the decision maintains the patent in an amended form and is no longer subject to appeal, the INPI shall publish a new patent specification. We assume that this procedure should be ex officio, without intervention by the parties.

If the decision partially revokes the patent, then the patent holder is referred back to the INPI to make the amendments in accordance with the decision, as soon as the decision is no longer subject to appeal (cf. 10.6 above).

#### 12. HOW DOES THE OPPOSITION PROCEDURE FIT IN WITH POSSIBLE PARALLEL INVALIDITY ACTION, CLAIM FOR OWNERSHIP, LIMITATION AND INFRINGEMENT ACTION?

The invalidity action and the action to claim for ownership take precedence over the opposition: the latter is suspended if an invalidity action is pending or if an action to claim for ownership has

been filed.

The opposition procedure takes precedence over the limitation procedure (similarly to Rule 93 EPC) except where the limitation is required following a claim for a declaration of invalidity of the patent. Furthermore, the admissibility of the request for limitation is conditional on the fact that the decision ruling on the opposition is no longer subject to appeal.

If an infringement action is pending, it will be possible to ask the court seized of this action for a stay of proceedings pending the opposition decision. This stay remains at the court's discretion, and the courts are used to allow it only if it is necessary for the proper administration of justice, by checking in particular that the opposition is grounded and serious and that the claim for a stay is not dilatory.

### **13. WILL THE DECISION TAKEN BY THE INPI OR THE COURT OF APPEAL TO MAINTAIN THE PATENT FOLLOWING AN OPPOSITION HAVE ANY INFLUENCE ON A FUTURE INVALIDITY ACTION FOR THE SAME PATENT BEFORE THE FRENCH COURTS?**

As regards the decision of the INPI: the French texts do not provide that the decision be invested with *res judicata* making inadmissible a subsequent claim for invalidity of the patent between the same parties. The legislator had provided for such a possibility, but it was finally abandoned. This is consistent with established case law which refuses to confer *res judicata* to decisions of the EPO Boards of Appeal ruling on oppositions.

With regard to decisions of the Court of Appeal ruling on oppositions: the question of whether or not it will be vested with *res judicata* rendering inadmissible a subsequent claim for invalidity between the same parties is less easy to decide since, unlike the INPI, the Court of Appeal is a court of the judicial order which issues judicial decisions having, in principle, such *res judicata*.

Given the above, the opponent will be advised to file opposition through a straw man so that he can, if necessary, launch an invalidity action against the same patent in his own name in order not to have *res judicata* claimed by the adverse party.

In any event, it is to be expected that the opposition decision will have an influence in the invalidity action. In particular, if the Paris Court of Appeal upheld the patent in the opposition proceedings, and even if *res judicata* does not apply, the same Court of Appeal hearing a claim for invalidity against the same patent should be reluctant to invalidate it, unless new grounds and new documents, not examined during the opposition proceedings, lead it to reconsider its position on the validity of the patent.

### **14. WHAT HAPPENS IF I MISS A DEADLINE?**

Concerning the opposition period: if the time limit for opposition is exceeded, no appeal for restoration is possible, which is in line with the practice before the EPO. The sanction for filing an opposition after the deadline will be inadmissibility.

Concerning the time limits set within the prosecution period before the INPI (i.e. the time limits set by the INPI for the parties to exchange their observations and, in the case of the patent holder, his possible proposals for modification of the patent): no appeal for restoration is possible either. Nevertheless, the sanction for non-compliance of such time limits remains uncertain: will it still be possible, as before the EPO, to take the step in question late under certain conditions? Or will any delay lead to more drastic sanctions, such as refusal or lapse? The yardstick will undoubtedly be for the compliance with the principle of adversarial proceedings.

## 15. HOW IS THE ORAL PHASE BEFORE THE INPI?

There is an oral phase if requested by either party in its written submissions or if it is decided ex officio by the INPI.

From the texts, it appears that during the oral phase, the parties will only be able to make submissions.

The texts do not refer to the possibility of hearing natural person witnesses during the oral phase.

It is stated that the INPI may base his decision on facts or documents submitted after the time limits set within the prosecution period, including those submitted during the oral phase. Nevertheless, it is recommended not to wait until the oral phase to present new facts or documents, as these elements might not be taken into consideration if the INPI considers that the parties have not been able to discuss them in a contradictory manner.

Furthermore, it is not indicated that the patent holder may submit new proposals for amendment of the patent during the oral phase. It is therefore recommended to submit all of them during the written phase.

Other modalities of the oral phase should be specified in the INPI guidelines.

## 16. WILL IT BE POSSIBLE TO BRING IN EXPERTS?

It should be possible to produce a written expert statement in the written phase. It will always be possible to indicate that the expert is available to answer any oral questions. However, since texts do not indicate that an expert or witnesses may be heard during the oral phase, such interventions by persons who are not parties to the proceedings may not be permitted.

## 17. SHOULD I BE AFRAID OF THE RULE THAT «SILENCE EQUALS REFUSAL»?

On the one hand, the texts provide that the opposition is deemed to have been refused if the INPI fails to take a decision within a period (known as the «SVR period») of 4 months from the end of the examination period.

On the other hand, the law also provides that reasons must be given for the decision ruling on an opposition against a patent.

The INPI has indicated at preparatory meetings that there is no reason to fear this SVR rule, as there will always be minutes at the end of the oral phase (which is the end of the prosecution period) and the final decision should globally equals to the content of these minutes. In the absence of an express decision, it will therefore be possible to refer to these minutes in the notice of appeal. It is therefore recommended that an oral phase should always be requested in order to have such minutes.

## 18. HOW ARE THE COSTS DIVIDED BETWEEN THE PARTIES?

The principle is that each of the parties bears the costs it has incurred.

Nevertheless, the INPI may decide on a different apportionment of these costs, in so far as equity requires, and within the limit of a scale fixed by order of the Minister responsible for industrial property.

For the time being it is not foreseen that the fixing of costs will be the subject of a separate decision as is the case at the EPO (Rule 88).

## 19. EXAMPLES / CASE STUDIES

### 19.1. Example 1: the opposing patent is a FR patent without an EP equivalent

The possible options for those who wish to counter this patent are:

- The opposition, possibly via a straw man;
- An invalidity action, but the straw man is not possible in this case;
- Waiting to be sued for infringement and making a request for a declaration of invalidity by way of counterclaim or by way of exception.

It is also conceivable to start with an opposition via a straw man using a limited number of prior art documents in order to keep others for an invalidity application or to build a «Gillette defense» in a subsequent infringement action.

The choice between these different options will, of course, depend on the elements of the file and, in particular, on the grounds of invalidity that may be invoked.

For example, if the strongest ground for opposition is insufficient description, the chances of success could in some cases be better in an invalidity action, as the courts are used to dealing with this ground of invalidity, unlike the INPI.

It will also be necessary to estimate the chances of success of a patent amendment at the opposition stage compared to those of a subsequent limitation. In particular at the opposition stage, the patent holder has a great deal of flexibility to circumvent particular grounds by making multiple proposals for amendment of the patent, which is not possible in the case of a limitation.

### 19.2. Second example: the opposing patent is an FR patent with an EP extension

The possible options for those who wish to counter these patents are:

- Opposition before the INPI, possibly via a straw man;

- Opposition before the EPO, possibly via a straw man;
- An invalidity action, but the straw man is not possible in this case;
- Waiting to be sued for infringement and making a request for a declaration of invalidity by way of counterclaim or by way of exception.

Even if an opposition before the EPO is envisaged - which has many advantages, such as the geographical scope of the decision and the relative predictability of the case law of the Boards of Appeal - it may still be advisable to file an opposition in France.

Indeed, closing this possibility by missing the French opposition deadline could be regretted if the FR patent were to survive following revocation of the EP extension by the EPO. In such a case, the chances of the French patent being maintained would be very low, even if the patent holder could try to make certain amendments to the remaining French part in order to avoid revocation. In this respect, it nevertheless seems that the opposition procedure in France offers less flexibility to the patent holder to amend his patent than before the EPO (possibility of amendments within shorter time limits than at the EPO, impossibility to present amendments at the oral phase, impossibility to present new amendments at the appeal stage).

If the FR patent is upheld after opposition, the risk of this decision influencing the opposition divisions or Board of Appeal of the EPO remains low, as the EPO regularly reiterates its independence from national courts.

An option may also be to start an opposition procedure in France using only part of the state of the art documents and trying to negotiate an amicable solution in parallel by threatening, in order to move the negotiations forward, to file an opposition before the EPO using the rest of its state of the art documents.

During the negotiations, it is possible to request the suspension of the French opposition procedure at the joint request of the parties for 4 months, renewable twice. If the negotiations are successful, the parties request the closure of the procedure without the INPI being able to continue it ex officio, contrary to what the EPO can do.

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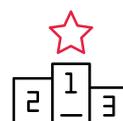
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