

PATENT: A VARIABLE GEOMETRY RIGHT?
Limitation and Amendments of claims during litigation.

The French case law

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The French case law

- Questions raised until now:
 - French or EP
 - Stay on the infringement proceedings
 - Infringement seizure
 - How to limit: claims or description?
 - Situation of the third parties
 - etc...

The French case law

- Limitation by the French Patent Office
 - French patent only or also the European patent designating France?

Decision:

Cour d'Appel de Paris, July 1st, 2011,

TEVA vs /Eli Lilly

Limitation can be made both on French and European patents by the French patent office.

The French case law

- Jurisdiction on the validity of the limitation:
the extension of the protection being a cause
of the nullity of the patent

Decision:

Cour d'Appel de Paris, March 30th, 2011;

Teisseire vs/ INPI and Routin

- The same judge who has jurisdiction on the
validity of the patent

And not the judge who controls the decision
of the French patent office

The French case law

- The moment of the limitation application:
 - First instance or also during an appeal?
 - Prior to an eventual nullity or also after a nullification?

Decision:

Cour d'Appel de Paris October 30th, 2013

Astellas vs/ Mylan

Admission of the limitation during the appeal proceedings despite the nullification by the first instance judgment

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- Method of limitation:
 - combination of claims only?
 - introduction of the new characteristics from the description?
 - disclaimer?

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Decisions:

1) Cour de Cassation, March 19th, 2013
and Cour d'Appel de Paris, October 25th,
2013

Syngenta vs/ INPI

The limitation can be made by
introduction of the characteristics from the
description

The French case law

Decisions

2) Cour d'Appel de Paris, February 12th,
2014

Duquesnoy vs/ Hermes

The limitation can be made by
introduction of the characteristics from the
description, even completed by the
drawings.

The French case law

- Relation with a pending litigation
(infringement and/or nullity)

Reminder: nothing in the law on the stay

Two types of solutions :

Stay on the proceedings

Decision:

- Cour d'Appel de Paris June 10th, 2011
TTI INC vs Adixen Vacuum
- Cour d'Appel de Paris October 30th, 2013
Astellas vs Mylan

The French case law

- **Dismissal of the application to stay:**

Decisions:

- Boehringer vs/INPI

Cour d'Appel de Paris: June 8th, 2012
and Cour de Cassation November 26th,
2013

- Cloplay vs Aplix

Tribunal de Grande Instance de Paris:
March 21st, 2014

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- No influence on the prior acts (infringement seizure ...)

Decision:

- Cour d'Appel de Lyon: July 13th , 2011
Cycles Lapierre vs / Decathlon

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- **Situation of the third parties:**

Reminder:

no possibility to make the observation during the limitation proceedings to the French Patent Office INPI

Solution:

make an appeal against the INPI decision accepting the limitation

The French case law

- **Situation of the third parties:**

Thresholds:

a) Delay to make an appeal

Decisions:

Cour d'Appel de Paris October 25th, 2013

Galet Vert vs/ INPI

The French case law

- **Situation of the third parties:**

Thresholds:

2) Legal grounds to make an appeal:

Decision:

Necessity to demonstrate the legal interest

Dismissal of the intervention:

Cour de Paris September 11th, 2013

Boehringer vs INPI and ACTAVIS

The French case law

- Many questions still to resolve:
 - Limitations and the SPCs
 - Limitation and license contract
 - Limitation and the exception of the prior personal possession
 - Etc...