PARIS, January 29, 2020 - The PACTE law of 2019 will result in substantial changes to several fundamental aspects of French patent law. Concerning the examination of French patent applications, in addition to the key measure that is examination of inventive step, several existing grounds of rejection are being reinforced and a new ground of rejection for extension beyond the content of the application as-filed is being introduced. Provisions concerning national security are also modified.

A previous article has detailed why the PACTE law is a crucial reform dealing with fundamental aspects of French patent law. The law introduces, among others, opposition proceedings, modifies the statute of limitations period, extends the term of utility certificates and allows for the transformation of utility certificates into patent applications. Concerning the examination of French patent applications, while the key measure is indeed the introduction of the lack of inventive step as a ground of rejection, other changes are worth also noting.

1. **Lack of inventive step and non-patentable inventions**

Article 122 of the PACTE law amends article L612-12 of the French Intellectual Property Code (IPC), which deals with the grounds of rejection of a patent application:

> A patent application will be refused, in whole or in part, if: [...]  
> 4° its subject-matter is an invention which is manifestly non-patentable under Articles L611-16 to L611-19;
5° its subject-matter is manifestly not to be regarded as an invention within the meaning of the second paragraph of Article L611-10 second paragraph, or as an invention susceptible to industrial application within the meaning of Article L611-16; […]

7° that has not been amended following notice to do so although an absence of novelty manifestly results from the search report its subject-matter is not patentable within the meaning of the first paragraph of Article L611-10; […]

Deleting the word “manifestly” from the fourth and fifth paragraphs confirms that the corresponding grounds of rejection, that is to say when subject-matter is a non-patentable invention or is not to be regarded as an invention, may be more easily and frequently raised by the French Industrial National Property Institute (INPI).

The new drafting of the seventh paragraph provides that lack of novelty will no longer have to “manifestly result from the search report,” and above all that lack of inventive step will be a ground of rejection.

Examination of applications filed from May 22nd, 2020 will thus be reinforced. An application filed by May 21st, 2020 will still benefit from the current system which allows for an easier grant. Applicants are thus advised to identify and prepare the filing of such applications sufficiently in advance and well before this deadline.

Regarding the applications for which inventive step will be examined, it will be possible to transform them into utility certificate applications, as provided by article L612-15 IPC if the applicant wishes to avoid at this stage such an in-depth examination while still benefiting from a 10-year term of protection (as compared to 6 years before the PACTE law).

Nonetheless, when opposition proceedings in-line with article 121 of the PACTE law become available, perhaps as early as April 2020, they may potentially be applied to patents which have been granted under the current examination procedure (without the ground of rejection for lack of inventive step). To strengthen their position with respect to a possible opposition, applicants are therefore advised to prepare fallback positions within the claims and to identify them as such when responding to the preliminary search report during examination of the corresponding application.
2. **Rejection for lack of support**

*Decree n° 2020-15 of January 8th, 2020* relates, in-line with its title, to the creation of a provisional application and to the transformation of a utility certificate application into a patent application. In addition, one cannot but help notice that other provisions are also provided, such as the addition, or specification, of a new ground of rejection for applications. Under new article R612-37-1 IPC:

> Amendments of the patent application should not extend its subject-matter beyond the content of the application as filed.

However, this article, which will come into force on July 1st, 2020, should not result in any fundamental changes to current practice. As a matter of fact, extension beyond the content of the application as-filed was already a ground for nullity of a patent; reviewing this aspect during application examination was therefore already essential.

3. **National security**

*The same decree* includes several provisions relating to national security.

Article R612-21 IPC, which allows for the description and claims to be filed in a foreign language, has been amended such that the 5-month time period of L612-9 IPC for automatic acquisition of the authorization of disclosure will now be suspended as long as the translation into French has not been filed.

Articles R612-26 CPI and R612-28 CPI are amended to confirm that the examination conducted by national security services will cover provisional applications and any supplementary document filed as long as there is no authorization of disclosure.

These amendments will also come into force on July 1st, 2020.
Patent examination proceedings before the INPI thus more closely resemble those before the European Patent Office (EPO). Nonetheless, taxes should remain much lower and granted patents should remain easier to obtain in France. Furthermore, the possibility of transformation to a utility certification application remains a strategic option unavailable at the EPO.

French patent application examination will evolve considerably due to the PACTE law as it enters into force; it is crucial for applicants to prepare for these upcoming changes sufficiently early.

Henri BOURGEOIS (bourgeois@regimbeau.eu)

French and European Patent Attorney,
REGIMBEAU

• About REGIMBEAU:

REGIMBEAU, a French IP law firm, has been assisting companies and private and public project developers to protect, enhance and defend their innovations (patents, trademarks, designs) for more than 85 years. Fourteen partners head a team of more than 200 people whose skills are put into practice in every strategic aspect of Intellectual Property - business intelligence and information search, license agreements, IP portfolio audits, partnership negotiations, acquisition of industrial property rights, litigation. Thanks to its wide-ranging expertise, REGIMBEAU (present in Paris, Munich, Lyon, Rennes, Grenoble, Montpellier, Toulouse and Caen) can meet its clients’ needs for international strategic consulting while preserving personalized relations of the highest quality.