RÉPUBLIQUE FRANÇAISE
Liberté
Égalité
Fraternité

INPI FRANCE

GRANT OF PATENTS AND UTILITY CERTIFICATES

Guidelines for patent and utility certificate applications

Contents

- INTRODUCTORY NOTE 3
- INTRODUCTION 4
- MAIN STAGES OF THE PROCEDURE 5
- SECTION A - PROCEDURE FOR FILING AN APPLICATION 6
- SECTION B – FORMAL EXAMINATION 12

CHAPTER I - EXAMINATION OF ADMISSIBILITY - ACCORDING A FILING DATE 13
CHAPTER II - THE COMPLIANCE EXAMINATION 16
CHAPTER III - DIVISION OF AN APPLICATION 30
CHAPTER IV – CONVERSION OF AN APPLICATION 33
CHAPTER V - CONVERSION OF A EUROPEAN PATENT APPLICATION INTO A FRENCH PATENT APPLICATION 34
CHAPTER VI - CORRECTION OF ERRORS 35

- SECTION C – TECHNICAL EXAMINATION 37

CHAPTER I - TITLE OF THE INVENTION 38
CHAPTER II - THE DESCRIPTION 40
CHAPTER III - DRAWINGS 49
CHAPTER IV - CLAIMS 54
CHAPTER V - THE ABSTRACT 63
CHAPTER VI - UNITY OF INVENTION - DIVISION OF A PATENT APPLICATION 66
CHAPTER VII - PATENTABILITY 72
CHAPTER VIII – SEARCH REPORT 116
CHAPTER IX – THIRD-PARTY OBSERVATIONS 125
CHAPTER X - CORRECTION OF ERRORS 127
CHAPTER XI – PROPOSAL TO CORRECT FORMAL DEFICIENCIES 131

- SECTION D – PUBLICATION OF A PATENT APPLICATION 132
- SECTION E – REJECTION OF A PATENT APPLICATION 134
- SECTION F – WITHDRAWAL OF THE APPLICATION 143
- SECTION G – GRANT 145
- SECTION H – MISCELLANEOUS 147

CHAPTER I – FEES RELATING TO THE GRANT PROCEDURE 147
CHAPTER II – NOTICES SENT BY THE INPI 149
CHAPTER III – TIME LIMITS RELATING TO THE GRANT PROCEDURE 150

This document is a publication of the French Patent & Trademark Office (*Institut National de la Propriété Industrielle,* hereinafter the "INPI") and is protected by copyright under French law. It may be used and reproduced for non-commercial purposes on condition that the source be quoted as follows:
INPI – Grant – Guidelines for patent and utility certificate applications – August 2026

INTRODUCTORY NOTE

Throughout the document, the references provided in the margin on the left shall refer to:

- Official acts governing French patents:

Art. L = article included in the legislative section of the French Intellectual Property Code (*Code de la Propriété Intellectuelle*)
Art. R = article included in the regulatory section of the French Intellectual Property Code
EECR = Council Regulation (EEC) No. 1768/92 concerning the creation of a supplementary protection certificate for medicinal products.
TEC = Treaty establishing the European Communities
Decision: Decision taken by the CEO of the INPI.

- Rulings handed down by the French courts:

TGI (*Tribunal de Grande Instance*) = French High Court
TJ (Tribunal judiciaire) = Judicial Court
CA (*Cour d'Appel*) = French Court of Appeal
CE (*Conseil d'Etat*) = French Council of State
C.Cass (*Cour de Cassation*) = French Court of Cassation

- Standards issued by the Word Intellectual Property Organization (WIPO)

- the Guidelines for Examination in the European Patent Office (EPO) and decisions taken by the EPO's Boards of Appeal and Enlarged Board of Appeal.

Passages taken directly from legislative or regulatory texts are denoted by the use of quotation marks.

INTRODUCTION

INDUSTRIAL PROPERTY RIGHTS ALLOWING FOR THE PROTECTION OF INVENTIONS

The following industrial property rights allow for the protection of inventions:
- patents,
- utility certificates,
- supplementary protection certificates.

	Patents	Utility certificates	Supplementary protection certificates
Purpose	Protects any patentable invention	Protects any patentable invention	Active ingredient or combination of active ingredients protected by a patent having effect in France; the ingredient(s) in question must be incorporated into at least one medicinal product covered by a marketing authorisation.
Duration	20 years from the day on which the application is filed	10 years from the day on which the application is filed	Maximum duration of 5 years from the expiry of the basic patent and variable according to the period between the filing of the application for the aforementioned patent and the granting of the first authorisation to place the product on the market in the Community.
Search report	Granted with a search report citing prior art that may affect its patentability	Granted without a search report	N/A: the patent on which it is based was already subject to a search report
Possibility of conversion	A patent application may be converted into an application for a utility certificate.	An application for a utility certificate may be converted into a patent application	N/A

Unless otherwise indicated, the terms "patent" and "patent application" used in these Guidelines shall also apply to utility certificates and applications for utility certificates.

MAIN STAGES OF THE PROCEDURE

The proceedings for the granting of a patent or utility certificate can be broken down into a number of stages:

1. The application is filed online with the French Patent & Trademark Office (*Institut National de la Propriété Industrielle,* hereinafter the "INPI").

2. The INPI verifies whether a filing date can be attributed to the application.

3. The application is submitted for examination to the Ministry of Defence.

4. An administrative review is carried out to verify the procedural compliance of the application and the payment of the filing fee and, in the case of patent applications, the search report fee.

5. A technical review is carried out to ensure that the application complies with certain formal and substantive conditions and to assign it a classification symbol in accordance with the rules of the International Patent Classification (IPC).

6. With the exception of applications for utility certificates, the application will give rise to the preparation of a preliminary search report, together with a written opinion on the patentability of the invention, which will be sent by the INPI to the applicant. The applicant will then have a period of three months, which may be renewed once at his/her request, to respond to the INPI by submitting observations and/or amending his/her claims depending on the relevance of the documents listed.

7. The application will be published 18 months after its filing/priority date. The file will then be made available to the public. Third parties may then submit their observations.

8. The preliminary search report will be published at the same time as the application or as soon as it has been drawn up, if it is drawn up after publication of the application. The period for third-party observations will lapse three months after publication of the preliminary search report.

9. The search report is drawn up.

10. The patent or utility certificate is granted.

SECTION A - PROCEDURE FOR FILING AN APPLICATION

1. FRENCH PATENTS

1.1. Online applications

Art. R.612-2

The filing of a French patent application as well as the related supporting documents shall be carried out online, by any personal or legal person meeting the conditions laid down in Article R.612-2 of the French Intellectual Property Code.

Online applications can be filed 24/7 via the INPI's Patent Portal.

In order to file an application online, the applicant must have Internet access and a valid email address. Their hardware must allow for the transfer of "cookies".

The applicant must choose a user name and password. This data is specific to the applicant, who is responsible for ensuring it remains confidential.

A link will then be sent to the applicant's email address, allowing him/her to activate his/her account. The applicant may request the deactivation of his/her account at any time.

The applicant has the possibility of creating draft applications, which will be saved for 30 days. He/she may suspend or cancel such draft applications at any time.

The application shall only be considered final once the INPI has assigned a national registration number, subject to the submission of the minimum documentation, and once the selected method of payment (deferred or immediate) has been validated.

1.2. Non-sensitive applications

Since 19 November 2018, French patent applications are filed online via the INPI's Patent Portal: https://procedures.inpi.fr.

The description and claims, the title of the invention, the abstract, where applicable, the drawings and the figure accompanying the abstract must be provided in Open XML (.docx) format (see 1.5 Documents for filing an application below).

1.3. Applications for inventions likely to be of interest to the Ministry of Defence

Art. R.612-10 and Art. R.612-11

Art. R.612-3

For "sensitive" or "potentially sensitive" patent applications, as defined by the Directorate General of Armament (*Direction Générale de l'Armement*), only the request for grant, as provided for under Articles R.612-10 and R.612-11 of the French Intellectual Property Code and excluding any mention of the title of the invention, shall be filed online via the INPI's Patent Portal.

Pursuant to Article R.612-3, the title of the invention and the documents accompanying the request must be sent by post or delivered in person by appointment to the INPI's headquarters, in accordance with the provisions of General Inter-Ministerial Instruction No. 1300, located at:

15, rue des Minimes,
CS 50001

92677 Courbevoie Cedex

Sensitive applications or presumably sensitive applications may not be submitted via the drop box.

These documents must be accompanied by the Ministry of Defence notification form, which is automatically generated during the filing procedure.

The description and claims, the title of the invention, the abstract, where applicable, the drawings and the figure accompanying the abstract must be submitted online via the INPI's Patent Portal in Open XML (.docx) format as soon as the authorisation to disclose or use the invention, provided for in Article L.612-9, has been granted by the Minister for Defence.

1.4. Problems converting files into Open XML (.docx) format

In the event that the Portal detects an error or alert preventing the conversion of a document into Open XML (.docx) format, and if the application is urgent, the applicant may transmit his/her document in PDF format in order to obtain a filing date.

Under Article R.612-46 of the French Intellectual Property Code, the application must be corrected by transmitting the exact same document in Open XML (.docx) format within two months.

1.5. Documents for filing an application

Art. L.612-2

An application consists of a file containing:

Art. R.612-3

(a) a request for grant,
(b) a description of the invention,
(c) one or more claims,
(d) an abstract,
(e) proof of payment of the related fees,

Art. R. 612-5

(f) the designation of the inventor,

Art. R. 612-10

and, where applicable:

(g) one or more drawings,
(h) a figure accompanying the abstract, chosen among the drawings,
(i) an authorisation,

Art. R. 612-24

(j) the priority document(s) (copies of earlier applications and, where applicable, authorisations to claim priority).

Art. R. 612-3

The description (b), the claims (c), the title of the invention, the abstract (d) and, where applicable, the drawings (g), the figure accompanying the abstract (h), and any amendments thereto, shall be filed **in a single document** in Open XML (.docx) format.
The names of the parties and the specific information provided for in the Open XML (.docx) notice, available in French at https://procedures.inpi.fr, are required for the conversion of the file.

> **N.B.**: However, for applications filed before 19 November 2018, applicants were authorised to provide **only the amended document(s)** in its(their) entirety **in a single PDF document**. (This point is dealt with in SECTIONS B and C, which are currently being updated).

It must be possible to reproduce an unlimited number of copies of these documents. They must not contain any corrections, overwritten text or interlineations that could hinder their reproduction or cast doubt on their authenticity.

1.6. Date of receipt of the documents

The date of receipt of the documents shall be deemed to be the date on which they are received on the INPI's server.

A receipt will be sent automatically to the applicant by email and via the Patent Portal, once the INPI has verified the viability of the files.
If the files are not considered to be viable, the applicant will be informed where possible.

> **N.B.**: In the case of applications for patents likely to be of interest to the Ministry of Defence, the filing date shall be assigned on the basis of the information supplied online and in paper form.
> (This point is dealt with in "SECTION B – Formal Examination", which is currently being updated).

1.7. National registration number of the application

Art. R.612-7

"Within 15 days of the delivery or submission of the documents to the French Patent & Trademark Office, the latter shall assign a national registration number to the patent application and shall immediately notify the applicant of said number. Any subsequent correspondence or submission of documents that does not refer to this number or that does not bear the signature of the applicant or his/her representative shall be declared inadmissible."

The national registration number can be found on the receipt issued by the INPI. It shall be granted to the applicant after payment or, in the case of deferred payment, after transmission of the application.

This number must be mentioned on all documents submitted in the course of the procedure.

2 EUROPEAN PATENTS AND PCT APPLICATIONS

2.1 Place of filing

Art. R. 612-1

'Patent applications shall be filed at the headquarters of the French Patent and Trademark Office (INPI) or sent there by post or by any means of electronic transmission in accordance with the conditions laid down by decision of its CEO-. The filing date shall be the date on which the application was received at the INPI's headquarters. The CEO of the INPI may demand that applications be filed online where this would facilitate the examination and publication of the application. The INPI provides assistance to applicants by any appropriate means, as specified by decision of its CEO.'

2.1.1 Electronic filing

Decision of the CEO 2026-35

A European or international patent application may be filed with the INPI electronically via the INPI's website, using the dedicated online portal. Any correspondence following the filing of applications, up to the point of their transmission to the World Intellectual Property Organization or the European Patent Office, is also conducted electronically.

Please note that for the PCT procedure, applications must be filed via the portal **https://procedures.inpi.fr** but subsequent correspondence (including requests for withdrawal) is carried out via WIPO's ePCT portal once WIPO has issued Form RO 301.

Please note: Payment procedures for international patent applications
For international patent applications, the payment of fees due is made electronically via the **'Other Procedures'** (*Autres démarches*) application, either by direct debit from a client account or by credit card.
The user must first open a client account with the Chief Accountant of the INPI.
Electronic payment is made in accordance with the procedures set out by the INPI.
The date of payment is the date on which the payment is received by the INPI, as recorded in a payment receipt sent to the applicant electronically.

Electronic filing requires:

- *Unconditional acceptance of the general terms and conditions of use relating to the E-PROCEDURES service of the INPI and the specific terms and conditions of use for the 'Other Procedures' service, available at https://procedures.inpi.fr;*

- *Use of the INPI's online service, accessible at this same address or via the website http://www.inpi.fr using a secure communication protocol (https);*

Applications can be filed online every day on the INPI Patents Portal, 24 hours a day, via the dedicated interface at https://procedures.inpi.fr.

In order to file an application online, the applicant must have internet access and a valid email address. Their equipment must allow the transfer of 'cookies'.

The applicant must choose a username and a password. These data are specific to the filer, who is responsible for ensuring their confidentiality.

The applicant then receives a link via email, which they use to activate their account. They may request that it be deactivated at any time.

The applicant is able to create draft filings. The applicant may suspend or withdraw their draft filing at any time.

Please note that the use of the online portal is not permitted for sensitive or presumably sensitive applications.

2.2.2 Filing by fax

Decision No 2014-67 on filings by fax, consolidated version as at 11 December 2019

Patent applications and all accompanying documents may be submitted by fax to the INPI in Courbevoie using **the following fax number only: +33 (0)1 56 65 86 00**, particularly in the event of a failure of the electronic filing service.

The filing by fax of European patent applications or international (PCT) applications is governed, in the case of the former, by the decision of the President of the European Patent Office dated 12 July 2007 and, in the case of the latter, by Rule 92-4 of the Regulations under the Patent Cooperation Treaty (PCT). A receipt is issued to the applicant.

The original documents relating to the application must be transmitted to the INPI (within 14 days for PCT applications), stating that they constitute confirmation of a filing made by fax and quoting the registration number shown on the receipt.

2.1.3 Filing by post

Applications may be sent to the INPI headquarters:
15 Rue des Minimes
CS 50001
92677 Courbevoie Cedex
from a post office in France or abroad.

For patent applications classified as sensitive, or potentially sensitive, as defined by the Directorate-General for Armament, the documents must be accompanied by the notification form for the attention of the Ministry of Defence.

2.1.4 Direct filing

Applications may be filed directly at the INPI headquarters, 15 rue des Minimes, 92400 Courbevoie:

- in a timer-operated drop-box, open from 10.00 am until midnight on working days, situated at the rear entrance to the headquarters at 30 Rue du Moulin des Bruyères, Courbevoie,

Please note that the use of the drop-box is not permitted for sensitive or presumably sensitive applications;

or

- by appointment, in accordance with the provisions of Interministerial General Instructions 1300,

For patent applications classified as sensitive, or potentially sensitive, as defined by the Directorate-General for Armament, the documents must be accompanied by the notification form for the attention of the Ministry of Defence.

2.2. Date of submission of documents

Art. R. 612-6

'A receipt confirming the date on which the documents were submitted shall be issued to the applicant by the INPI.'

a) Electronic filing

Decision of the CEO 2026-35

The date of submission of the documents for electronic filing is the date on which they are received on the INPI server in conditions that allow them to be opened and processed; this date is recorded in a receipt issued automatically to the applicant in electronic form.

Where an electronic receipt could not be issued or mentions an error, the date of submission of the documents shall be that recorded in a receipt subsequently sent to the applicant.

b) Filing by fax

Decision No 2014-67 on filings by fax

The filing by fax of European patent applications or international (PCT) applications is governed, in the case of the former, by the decision of the President of the European Patent Office dated 12 July 2007 and, in the case of the latter, by Rule 92-4 of the Regulations under the Patent Cooperation Treaty (PCT). A receipt is issued to the applicant.

c) Filing by post

Art. R. 612-1

In the case of filing by post, the date of submission of the documents is the date on which the post is received by the INPI. A receipt is sent to the applicant by post.

SECTION B – FORMAL EXAMINATION

The examiner reviews the documents filed to determine whether the application meets the conditions necessary to obtain a filing date (Art. L.612-2, Art. R.612-8) (Ch. I)

He/she also verifies that:

1. the application satisfies certain formal requirements of an administrative nature provided for by the French Intellectual Property Code (Articles L.612-1 and L.612-12 para. 1) (Ch. II);

2. the filing of a divisional application meets certain formal requirements (Articles L.612-4, L.612-12 para. 3, R.612-33 to R.612-35) (Ch. III);

3. the (voluntary or ex officio) conversion of a patent application into a utility certificate application is carried out in accordance with regulatory conditions (Articles L.612-15, R.612-55) (Ch. IV);

4. the conversion of a European patent application into a French patent application is carried out under the conditions and within the time limits laid down by the European Patent Convention and the French Intellectual Property Code (Articles L.614-6, R.614-5, R.614-6 and R.614-17) (Ch. V).

He/she accepts or refuses requests submitted by applicants for the correction of errors (Art. R.612-36) (Ch. VI).

If the application contains deficiencies that have not been corrected by the applicant, the examiner shall initiate the refusal procedure (Article L. 612-12, Article R. 612-45 *et seq.*) (see Section E).

Throughout this section and unless otherwise specified, the terms "application" or "patent application" shall be understood to include utility certificate applications. In application of Article L.611-2 of the French Intellectual Property Code, the provisions relating to patent applications also apply to utility certificate applications, with the exception of those concerning the preparation of the search report.

CHAPTER I - EXAMINATION OF ADMISSIBILITY - ACCORDING A FILING DATE

Art. R.612-8

The purpose of this examination is to determine whether the application complies with the requirements to be accorded a filing date.

Art. R.612-9

Failure to include part of the description or drawings in the application may result in a change of the filing date.

1. REQUIREMENTS TO BE ACCORDED A FILING DATE

Art. L.612-2
Art. R.612-8 para.1

The examiner inspects each application and shall accord a filing date to the latter if it contains at least one copy of the following items:

- a statement indicating that a patent is being sought;
- information enabling the applicant to be identified or contacted;
- a description, even if it does not comply with the formal requirements laid down by law, or a reference to a previously filed application ("earlier application").

1.1. Statement indicating that a patent is being sought

This consists of a statement indicating that an industrial property right is being applied for (patent or utility certificate).

Art. R. 612-3

This can be drawn up using the printed request form provided free of charge by the INPI.

1.2. Information enabling the applicant to be identified or contacted

A patent may be applied for:

- by any natural person; or
- by any legal person: company, trade union, registered association, State, department, municipality, public establishment;
- on behalf of several natural or legal persons;
- by any natural person acting on behalf of and in the name of a legal person pending incorporation (see below, Chapter II, point 3);

The information concerning the applicant is considered sufficient provided the following are indicated:

- the first name and surname of the natural person, accompanied, where applicable, by the name of the legal person pending incorporation on behalf of which he/she is acting;
- the official name of the legal person (company name, etc.), its legal form, the address of its registered office, or any information enabling it to be identified with certainty (e.g. SIREN /business identification number);
- an address for correspondence.

1.3. Description

Art. R. 612-8, paras. 4 & 5

The description must relate to an invention, detailing at least some of its technical features and explaining them with possible reference to drawings (see Section C, Chapter II).

The description may be replaced by providing a reference to an earlier application. In this case, the filing date, the number of the earlier application and the patent office with which it was filed must be indicated. Where any such reference is provided, the applicant must indicate that it replaces the description and, where applicable, the drawings. A copy of the earlier application, together with its translation into French, where applicable, must be produced within two months of filing.

Art. R.612-8 para.1
Art. R.612-21

1.4. Language of filing

The patent application must be written in French. However, the description and claims may be written in a foreign language.

Art. R.612-45

In this instance, the INPI requests that the applicant produce a French translation of the application documents within two months of filing. If the translation is not produced within the specified time limit, the application shall be rejected.

2. ACCORDING A FILING DATE

Art. R.612-8 para.1

- The inclusion of a statement that a patent is being sought, information enabling the applicant to be identified or contacted, and a description in French or a foreign language is sufficient for a filing date to be accorded to the application.

The filing date shall therefore coincide with the date of submission of the documents containing all of these items. The filing date shall be communicated to the applicant.

- Special circumstances: applications filed by fax

The filing date shall be the date on which the fax containing all of the abovementioned items is received by the INPI, on condition that:
- the application is sent to the dedicated fax number; in the event that the application is sent to another INPI fax machine, the date cannot be guaranteed;
- the fax is legible; if it is only partially legible, the filing date shall be accorded only for the legible items, provided that they include the three items mentioned above;
- the fax is followed by a digital confirmation that must be received within two working days (see Section A, point 1.2 above).

In the event of the applicant's failure to comply with the two-day period for confirming his/her application, the INPI shall inform him/her that the filing date on which the application was sent by fax will not be accorded. It will then request that the applicant submit his/her comments and indicate if and when he/she intends to confirm the application, where applicable.

If, based on the documents in the file and on the comments submitted by the applicant, it transpires that the application submitted by fax has not been confirmed or was confirmed after the period of five working days, the INPI shall send the applicant a decision in which it shall define the filing date as being the date of receipt of the original documents containing all of the abovementioned information.

3. INABILITY TO ACCORD A FILING DATE

The filing date shall not be accorded on the date of submission of the documents if one or more of the three aforementioned items – statement indicating that a patent is being sought, information enabling the applicant to be identified or contacted, description or reference to an earlier application – has not been submitted at the time of filing.

Art. R.612-8 para. 2

The applicant shall be notified of the absence of any of these documents and shall have two months from receipt of the notification to complete his/her application.

Art. R.612-8 para. 3

This notification shall inform the applicant that the filing date of his/her application shall be the date on which the application has been completed. If the application is completed within the specified time limit, it shall be declared admissible and the applicant shall be notified of its filing date.
If the application has not been completed within the two-month period, it shall be declared **inadmissible**. The search report fee shall be refunded to the applicant upon expiry of the appeal period.

4. CHANGE OF THE FILING DATE

Art. R.612-9

The filing date is subject to change in only one instance: if part of the description, or drawings referred to in the description or claims, are submitted after said date.

Two scenarios are provided for by law:

- the applicant spontaneously provides an additional description or additional drawings within the two-month period following the filing of his/her application.

In this instance, the applicant is accorded a new filing date, which is deferred to the date of submission of the additional items.
Proviso: the applicant has one month from the date of submission to withdraw these additional documents. By doing so, the original filing date is retained, but references to the missing part of the description or missing drawings must be deleted from the text of the application.

- the INPI notifies the applicant of the omission of a part of the description or of drawings to which the description or claims refer; in this instance, the INPI shall inform the applicant that he/she have a period of two months from the date of receipt of such notification to submit the missing documents.

During this period, the applicant must choose one of the following options:
- to submit the missing items, in which case the filing date will be deferred to the date of submission of the additional items;
- to refrain from submitting the missing items and therefore retain the original filing date; in which case, any references to the missing items in the text of the application must be deleted.

In both cases, if the applicant chooses to maintain/file the additional items, he/she will receive notification of a new filing date.

Art. R. 612-36

The omission of passages from the description or drawings may, however, under certain conditions, be considered a material error eligible for rectification without affecting the original filing date (see below, Section C, Ch. X).

CHAPTER II - THE COMPLIANCE EXAMINATION

The purpose of the compliance examination is to verify:

- payment of the fees due upon the filing of the application or, at the latest, within one month of the submission of the documents (1),

- the terms and conditions of representation when the application is filed by a representative (2),

- the content of the request and, depending on the information contained therein, the presence of supporting documents such as the representative's authorisation, the designation of the inventor, the copy of the priority document or the copy of an earlier application whose filing date is claimed. (3 to 6),

- the presentation of the documents of the application to be published (description, claims, abstract, drawings) (7).

1. FEES TO BE PAID WITHIN ONE MONTH OF THE FILING OF THE DOCUMENTS

Art. R.612-5

"The patent application must be followed, within one month of the filing of the documents, by the payment of:
1. the filing fee;
2. the search report fee".

1.1. Filing fee

Art. L.612-20
Art. R.613-63

This fee is due for all types of filings; it includes the first renewal fee for maintaining the patent application in force. The fee for applications filed online is lower.

If the applicant benefits from a reduction in the rate of fees (see Book II, Section B), he/she may pay the reduced-rate filing fee.

1.2. Search report fee

Art. L.612-20
Art. R.613-63

Order of 24 April 2008 on the procedural fees collected by the INPI

Decisions 92-286 and 92-287 of the CEO of the INPI, Industrial Property Information Bulletin (PIBD) no. 526

Decision 96-408 of the CEO of the INPI PIBD no. 616

This fee is not due for utility certificate applications.

If the applicant benefits from a reduction in the fee rates (see Book II, Section B), he/she may pay the reduced-rate search report fee.

The rate of the search report fee shall also be reduced (see Section C, VIII, 4), for applications that claim the priority of earlier Swiss, Dutch or Belgian applications, and which include the Swiss, Dutch or Belgian search report, on condition that:

- the content of the French and priority applications is identical; the applicant must attest to this in a declaration;

- that a copy of the search report and of the documents cited therein is supplied at the time the fee is paid.

1.3. Surcharge for late payment

Art. R.612-45 para. 2

If the applicant has not paid, of his/her own accord, the filing fee and/or search report fee in full and at the appropriate rate within one month of the filing of the documents, a rejection decision shall be sent to the applicant, who shall have a period of two months from the date of receipt of the notification to pay the corresponding fee plus a surcharge. The rejection decision shall be final if the applicant fails to contest the default of payment or pay the fee due plus the corresponding surcharge within the specified time limit.

2. REPRESENTATION

Art. R.612-2 para. 1

"The filing may be made by the applicant personally or by a representative having his/her domicile, registered office or place of business" in France or in another Member State of the European Union or of the European Economic Area.

Under certain circumstances, the applicant is nevertheless obliged to appoint a representative. In addition, certain procedural acts are reserved for a particular category of representative.

2.1. Cases in which the appointment of a representative is mandatory

Art. R.612-2 para. 2

- The applicant does not have his/her domicile, registered office or place of business in France or in another Member State of the European Union or of the European Economic Area.

- If an application is submitted by several applicants, they must appoint a common representative, who may be either a representative authorised to represent third parties before the INPI (industrial property attorney, lawyer, etc. – see 2.2 below) or one of the joint applicants.

2.2. Cases in which the appointed representative must have a special status

Art. L.422-4
Art. R.612-2 para.1

Certain stages of the filing and grant procedure are considered to be particularly technical and as such must be handled by specific representatives, where the applicant chooses or is obliged to appoint a representative.

Consequently, in order to carry out the filing of the patent application and any subsequent act relating to the patent grant procedure, with the exception of the payment of fees, only the following categories of natural persons/entities shall be authorised to act on behalf of the applicant:

Art. L.422-4 para.1
- professionals registered on the list of industrial property (IP) attorneys drawn up by the CEO of the INPI and specialising in "patents";
- lawyers;

Art. L.422-4 para. 2
- companies or government-controlled entities with which the applicant is affiliated;

Art. L.422-4 para. 2
- specialised trade associations,

Art. L.422-4 para. 2
- professionals appearing on a special list drawn up by the CEO of the INPI of intellectual property specialists other than industrial property attorneys,

Art. L.422-5
- professionals based in a Member State of the European Union or of the European Economic Area, entitled to represent third parties before the intellectual property office of their country and acting on a casual basis.

Art. L.422-4, para. 2

2.3. Supporting documents to be provided by the representative

a) Documents to be provided

- IP attorneys and lawyers
  IP attorneys and lawyers are not required to prove their status or to provide the authorisation attesting to the responsibilities conferred on them by their clients. They shall only be required to specify their status when performing an act on behalf of the applicant. In order to facilitate verification by the INPI, it is recommended that IP attorneys indicate the number assigned to them on the lists maintained by the INPI.

- Natural persons registered on the special list as referred to in Article L.422-5
  These natural persons are not required to prove their status and shall only be required to specify it when performing an act on behalf of the applicant, preferably in addition to the number assigned to them on the list maintained by the INPI.
  However, such natural persons must provide the INPI with the authorisation attesting to the responsibilities conferred on them by their client.

Art. R.612-2 para. 3

- Affiliated companies
  Natural persons acting in the name of and on behalf of a company or establishment with which the applicant is affiliated must specify the existence of this affiliation. They must provide the authorisation attesting to the responsibilities conferred on their company/establishment by the applicant. The affiliation may be mentioned in this authorisation.

- Specialised trade organisations
  Specialised professional organisations must prove that the applicant is a member of their organisation and provide the authorisation attesting to the responsibilities conferred on them by said applicant.

- Professionals based in a Member State of the European Union
  Professionals based in a Member State of the European Union or of the European Economic Area must produce a certificate issued by the Industrial Property Office before which they are entitled to represent third parties. This certificate can be produced once and for all to the INPI department in charge of managing the list of industrial property attorneys.

- Joint applicants

The applicant chosen to act as representative in the case of a joint application must provide an authorisation issued by all of the applicants concerned.

b) Scope of the authorisation provided for filing

- - Acts covered by the scope of the authorisation
  Unless otherwise indicated, the authorisation provided for filing shall cover, in particular, the following acts and notifications:
  - the priority claim (Art. R612-24),
  - the claim to retain the filing date of the earlier application (Art. R612-25),
  - the division of the patent application (Arts. R.612-33 to 35),
  - the designation of the inventor (Arts. R.611-16 to R.611-17),
  - the payment of fees (Arts. R.613-46 to R.613-50),
  - the application for restoration of rights (Art. R.613-52),
  - the establishment of the documentary report (Arts. R.613-60 to R.613-62),
  - the entries in the French Patent Register (Arts. R.613-53 to R.613-59),
  - the correction of material errors (Art. R.612-36),
  - the conversion of the patent application into a utility certificate application (Art. R.612-55),
  - the procedure for the preparation of the search report (Arts. R.612-56-1 to R.612-69)
  - the grant and publication of the patent (Arts. R.612-70 to R.612-73)

Art. R.612-2 para. 3

- Acts not covered by the scope of the authorisation
  Certain acts, on the other hand, can only be carried out by virtue of a special authorisation, namely:
  - the withdrawal of the application,
  - the surrender of the right granted,
  - the waiver of the right of priority,
  - the waiver of the right to retain the filing date of an earlier application (domestic priority),

Art. R.612-2 para. 3

Art. R.612-38
Art. R.613-45

Art. R.612-39 para. 6

- the limitation of the application or patent.

Industrial property attorneys and lawyers are not subject to this obligation; they are generally exempt from providing an authorisation to the INPI.

- "Registered" general authorisations
  Representatives acting on behalf of certain clients on a regular basis are authorised to file a permanent authorisation with the INPI, which is drafted in general terms. This authorisation is registered and kept on record by the administrative department.

The representative need only recall the registration number of this general authorisation when filing each application.

Important notice: this general authorisation is not sufficient to carry out the acts of withdrawal or waiver/surrender referred to in the previous point. Where the law requires a special authorisation, the representative must provide a specific authorisation relating to the right and the act to be performed.

2. REQUEST FOR GRANT

Art. R.612-3

"The patent application shall include a request for the grant of a patent, the model of which shall be laid down by decision of the Chief Executive Officer of the French Patent & Trademark Office".

Order on the procedure for filing applications
Decision 2005-469 of the CEO of the INPI
Art. R.612-10

The request form is available on the INPI's website. Only one copy of the request form shall be filed.

"The request for grant shall be signed by the applicant or his/her representative. It shall contain the following:
(i) The nature of the industrial property right being applied for;
(ii) The title of the invention showing clearly and concisely the technical designation of the invention and not including any fancy names;
(iii) The designation of the inventor: however, if the applicant is not the inventor or the sole inventor, the designation shall be filed in a separate document containing the first name, surname and domicile of the inventor and the signature of the applicant or his/her representative;
(iv) The first name and surname of the applicant, his/her nationality, place of domicile or of registered office;
(v) The name and address of the representative, if a representative has been appointed."

Art. R.612-11

"The request for grant shall be supplemented, where appropriate, by particulars relating to:

(i) A reduction in the rate of fees accorded to the applicant or requested by him/her;
(ii) Earlier filings, some elements of which may have been included in the current application;
(iii) Claimed priorities;
(iv) Presentation of the invention as part of an official or officially-recognised exhibition."

This information is divided into different sections:

SECTION 1 "NAME AND ADDRESS OF APPLICANT OR REPRESENTATIVE TO WHOM MAIL SHOULD BE ADDRESSED"

This section is reserved for the information necessary for correspondence between the INPI and the applicant (or his/her representative).

An email address must be provided so that the applicant can be notified when the INPI's notifications are made available on the patent portal.

SECTION 2 "NATURE OF THE APPLICATION"

Art. R.612-10 para. 1

The nature of the industrial property right being sought (patent, utility certificate, divisional application or conversion of a European patent) shall be indicated by ticking the relevant box.

In the case of a divisional application or a conversion of a European patent application, the number and date of the original application must be indicated.

SECTION 3 "TITLE OF THE INVENTION"

Art. R.612-10 para. 2

The applicant must choose a title that indicates, accurately and succinctly, the subject matter of the invention (see Section C, Chapter I below).

SECTION 4 "DECLARATION OF PRIORITY OR REQUEST TO RETAIN THE FILING DATE OF AN EARLIER APPLICATION FILED IN FRANCE"

Art. R. 612-24

a) Declaration of priority (See point 5 "Priority claim" below)
At the time of filing or within 16 months from the earliest priority date available to the application, the applicant may claim the priority of an earlier foreign application. The applicant must check the relevant box and indicate the date and number of the earlier application and the country concerned.

He/she must attach a copy of the earlier application, or provide it within a period of 16 months from the filing date of said earlier application.

Order on the procedure for filing applications

If the earlier application belongs to a third party, the applicant shall prove that he/she has obtained the authorisation of its owner with a view to claiming priority. Such authorisation must be provided in writing and must be attached to the application, together with a translation where necessary, or supplied within a period of 16 months from the filing date of the earlier application.

Art. L.612-3

Art. R. 612-11
Art. R. 612-25

b) Request to retain the filing date of an earlier application filed in France ("domestic priority") – (see point 6 below)
At the time of filing, the applicant may, under certain conditions, request to retain the filing date of a previous French patent application. The applicant must check the relevant box and indicate the date and number of the earlier application concerned.

SECTION 5 "APPLICANT(S)"

Art. R.612-10 para. 4

- If the applicant is a natural person, he/she must indicate his/her first name and surname, to the exclusion of any other information (pseudonym, shop name, etc.)

- If the applicant is a legal person, it must indicate the name of the company and its legal form. It must also provide its SIREN (business ID) number and the applicable APE code, to the exclusion of any other information such as shop name or trade name. The name indicated must be accurate; for French companies, the name indicated must be the name that appears in the French Companies Register (RNCS).

  The applicant must also indicate his/her nationality as well as the address of his/her domicile or registered office (including the postal code and, in the case of foreign applicants, the country). Only one domicile or registered office address is allowed per applicant. If this address is not located within a Member State of

the European Union or of the European Economic Area, a representative must be appointed (see point 2 above – Representation), unless the applicant can prove that they have an establishment within the EU or EEA.

- Companies pending incorporation shall be represented by a founding partner.

  In this case, the founder must indicate his/her first and last name, followed by the name of the company being formed, in a statement similar to the following: "Mr/Ms X, acting in the name of and on behalf of Company Y pending incorporation".
  These details must be followed by the natural person's address and not the proposed location of the company's registered office.
  Important notice: when the company is incorporated, it must take over the application filed by the founder and request the entry of this change in the National Patent Register, by providing a copy of the certificate of incorporation (Kbis) and a copy of the corresponding deed.

If there is more than one applicant, each applicant must provide this information. In this case, a common representative must be appointed, who may be a representative authorised to represent third parties before the INPI or one of the group of applicants (see point 2 above).

SECTION 6 "REPRESENTATIVE"

If the applicant has appointed a representative, the latter must indicate his/her first name and surname if they are a natural person, the name of the Law Firm or Company if they are a legal person, their address and, where applicable, the number of the permanent authorisation and/or contractual relationship filed with the INPI.

Unless he/she is an industrial property attorney or lawyer, the qualified representative shall produce an authorisation. The same applies to the co-applicant appointed to act as common representative in the case of multiple applicants (see point 2 above: "Representation").

SECTION 7 "INVENTOR(S)"

Art. R.612-10 para. 3

The identity of the inventor(s), natural person(s), must be indicated in the request at the time of filing (see point 4 "Designation of the inventor" below).

If the applicant is the inventor, he/she needs only check the appropriate box.

If the applicant is not the inventor, he/she must check the corresponding box and file the designation of inventor in a separate document containing the first name, surname and domicile of the inventor; the applicant must sign the document designating the inventor.

SECTION 8 "REDUCTION IN THE RATE OF FEES"

Art. L.612-20
Art. R.613-63

Natural persons benefit from a reduction in the rate of procedural fees charged by the INPI. The same applies, under certain conditions, to small or medium-sized enterprises, as well as non-profit organisations in the teaching or research sector (see Book II, Section B below).

SECTION 9 "NUCLEOTIDE SEQUENCE LISTINGS"

Art. R 612-13 para. 2

The description of the invention may be accompanied by a list of nucleotide or amino acid sequences contained in the appendix.

In this case, the list must be established in accordance with standard ST.25 of the World Intellectual Property Organization (WIPO).

The list must also be submitted in computer readable format on a data storage medium such as floppy disk or CD-ROM and the relevant box must be checked.

WIPO Standard ST.25

The applicant must attach to his/her patent application a signed declaration stating that the information provided in paper form is identical to that provided in electronic form and the corresponding box must be checked.

WIPO Standard ST.25

Without these documents, the preparation of the search report cannot be initiated.

SECTION 10 "SIGNATURE OF THE APPLICANT OR HIS/HER REPRESENTATIVE"

This section must bear the signature of the applicant or his/her representative and the name of the signatory in capital letters.

If the application is made on behalf of a legal person, the status of the signatory (manager, managing director, etc.) must be indicated.

If the application is filed by a representative, the status of the signatory (industrial property attorney, lawyer, etc.) must be indicated.

If there are several applicants, the application will be signed by their representative or by the applicant who has been appointed to act as representative for the group of applicants concerned (see point 2. "Representation" above).

4. DESIGNATION OF THE INVENTOR

Art. L.611-9

"The inventor, whether they are an employee or not, shall be named as such in the patent; he/she may also object to such identification."

Art. R.612-10 para. 3
Art. R.611-16

The applicant is therefore obliged to designate the inventor, who can only be a natural person. In the event that the inventor objects to being named, the applicant shall transmit a waiver signed by the inventor.

Art. R. 611-15

The INPI does not verify the accuracy of the details provided concerning the designation of the inventor, which is the sole responsibility of the applicant. It does, however, ensure that the inventor has been designated.

4.1. Ways in which the inventor can be designated

Art. R.612-10 para. 3

Where the applicant is the inventor, he/she simply has to check the corresponding box in section 7 of the request.

The INPI verifies that the applicant (section 5) is not a legal person. If the applicant is a legal person, he/she is requested to provide a separate designation of the inventor.

Art. R.612-10 para. 3

Where the applicant is not the inventor or the sole inventor, he/she must check the corresponding box in section 7 and fill out a separate form to designate the inventor. The INPI checks that the designation form has been submitted; failing which, it shall send a notification accompanied by a printout of the "designation of the inventor(s)" form to the applicant.

4.2. The time limit for designating the inventor

Art. R.612-11 para. 2

- The inventor must be designated at the time of filing the application. Failing this, the INPI shall send the applicant a notification requesting that he/she designate the inventor within a period of 16 months from:
  - the date of filing,

- or the earliest date available that may be retained for the application (priority date or domestic priority date).

Art. R.612-45

- If an inventor has not been designated within the 16-month time limit, a rejection decision shall be sent to the applicant, who shall have a period of two months from the date of receipt of the notification to submit his/her observations.
  This two-month period does not constitute an additional period for remedying the deficiency; it is the period during which the applicant may contest the deficiency if he/she designated the inventor within the 16-month time limit provided.

As a result, the rejection decision shall be final, without any further notification being required, if the applicant has not contested the deficiency within the two-month period. If within that period the applicant has submitted observations but has not proven that he/she designated the inventor within the 16-month period provided, the INPI shall notify the applicant of its decision confirming the rejection of the patent application.

- If the designation of the inventor has been omitted from a divisional application, the applicant also has a period of two months from the date of notification by the INPI of this omission to complete his or her application (see Chapter 3 below).

Art. R.611-16

4.3. Rectification of the designation of the inventor

a) Omission of an inventor's identity

The designation of the inventor may be supplemented at any time, even after grant:

Art. R.611-16 para. 1

- either at the request of the applicant or the right holder or with their consent;

Art. R.611-16 para. 2

- or when a third party presents the INPI with a court decision having res judicata effect and acknowledging their right to be designated.

The applicant will then be required to provide a new inventor designation form showing the names of all the inventors.
Mention of the inventor shall be included in the copies of the application publications and/or of the specifications of the granted right that have not yet been disseminated. After grant, the applicant is advised to request the entry of the updated inventor designation in the French Patent Register.

b) Deletion of an inventor

A wrongly designated inventor may be removed at any time, even after grant:

Art. R.611-17

- either at the request of the applicant or the right holder or with their consent, the request must also be accompanied by the consent of the wrongly designated person;
- or in the event of a court ruling rendering the inventor designation invalid; in this case, a res judicata decision must be filed with the INPI.

The applicant or right holder will have to provide a new inventor designation form.

The details concerning the inventor shall be corrected in the copies of the application publications and/or of the specifications of the granted right that have not yet been disseminated. If the incorrect designation has been entered in the French Patent Register or published, the entry or publication will be rectified.

The deletion of the name of a wrongly designated inventor does not fall within the scope of application of Article R. 612-36 relating to the correction of material errors.

Art. L.611-9
Art. R.611-16 para. 3

4.4. Waiver of the right to be mentioned as an inventor

The designated inventor may at any time waive his/her right to be mentioned as such. He/she must do so in a written statement, which must be addressed to the INPI by the applicant.

If the inventor waives the right to be mentioned before the start of the technical preparations necessary for publication of the application, the name of the inventor shall not appear in the specification of the application.

If the inventor waives their right to be mentioned after the start of the technical preparations for publication of the application, his/her name shall not appear in the specification of the granted right.

5. PRIORITY CLAIM

The applicant may avail of one or more earlier filings and claim priority where:

The Paris Convention, Art. 4
The Marrakesh Agreement appendix I (TRIPS)

Art. L.611-12

- the earlier application was filed:
  - in a country that is a member of the Paris Union or of the World Trade Organization;
  - in a country that is not a member of the Paris Union or the World Trade Organization, but which grants, on the basis of a French patent application or an international or European patent application designating France, a right of priority having similar consequences to those provided for by the Paris Convention.

The Paris Convention, Art. 4

The earlier application must contain enough information to be assigned a filing date in the country concerned, whatever may be the subsequent fate of the application.
This is the case for provisional patent applications filed in the United States.

- The application is filed in France within 12 months of the filing date of the earlier application.

- The applicant in France is the holder of the earlier application or his/her successor in title, i.e. the assignee of the right of priority relating to that earlier application. Important notice: the assignment of the earlier application does not necessarily imply the assignment of the priority right relating to it.

Art. L.612-7 2

The applicant may claim several priorities on the basis of earlier applications filed in the same State or in different States provided that each of these States is a member of the Paris Union or the World Trade Organization or has agreed to reciprocity.

Art. L.612-7 1
Art. R.612-24

Any applicant who wishes to avail of the priority of an earlier application shall be required to file a declaration of priority and must prove the existence of the earlier application by producing a copy thereof.

5.1. Declaration of priority

Art. R.612-24 para.1

The declaration of priority shall be submitted upon the filing of the request for grant (section 4) and shall bear:
- the date of the earlier filing,
- the country in or for which it has been made,
- the number that has been allocated to it.

Art. R.612-24 paras 2 and 3

It must be made or can be corrected within 16 months from the date of the earliest priority date claimed (see 5.3 below).

(a) The filing date of the earlier application

Art. R.612-24 para. 7

The date of first filing indicated on the request shall be no more than one year prior to the filing date of the application in France. Where it is earlier than one year, the applicant shall be informed that there is no right of priority.

This principle is subject to two mitigating factors:

- if the date of first filing indicated is incorrect, the applicant may correct it in order to claim a priority with a correct filing date, within four months of the filing of the French application, provided that he/she has not requested early publication of said application;
- if the applicant failed to comply with the one-year time limit between the two filings and if he/she can provide a legitimate excuse for his/her failure to do so, he/she may file an application for restoration of the right of priority (see 5.3 below).

(b) The number of the earlier application and the country concerned

Art. R.612-24 para. 6

If the filing number of the earlier application and the country concerned are not indicated within 16 months of the earliest priority date, the declaration of priority shall be declared inadmissible.

However, if the copy of the earlier application is received within this time limit, the number and country shall be entered ex officio in the file.

5.2. Priority documents

(a) The copy of the earlier application

Art. R.612-24 para. 5

The copy of the earlier application must be filed within 16 months from the date of the priority concerned. Failing this, the priority shall be declared inadmissible.

Order on the procedure for filing applications

Where the copy is written in a foreign language, the INPI may demand a translation of the part of the document that contains the filing date and number of the foreign application, together with the particulars of the country in or for which it was filed.

(b) The authorisation to claim priority

Art. R.612-24 para. 5

Where the applicant is not the holder of the earlier application or of the priority right relating thereto, the latter must provide the applicant with a written authorisation in order to claim priority. Such authorisation must be filed with the INPI within a period of 16 months from the date of the priority concerned. Failing this, the priority claim shall be declared inadmissible.

Order on the procedure for filing applications

If it is written in a foreign language, the INPI may demand a translation in French.

This authorisation shall not require authentication.

5.3. Time limits for admissibility of the priority claim

Art. R.612-24, para. 2
Art.13-1 & Rule 14-3 of the Patent Law Treaty (PLT)
(Art. 2 & Rule 17.1 of the PCT)

In addition to the one-year time limit between filings, which determines the substantive validity of priority claims, the manner in which such claims are made is subject to several time limits.

- Time limit for declaring all priorities
  The priority or priorities must be claimed at the time of filing or within 16 months from the date of the earliest priority claimed.

Art. R.618-3

However, the declaration of priority or priorities shall no longer be admissible after the applicant has filed a request for early publication of the patent application.

Art. R.612-24 para. 4
Art. R.612-24, para. 5
Art. 6 and Rule 4 of the PLT

- Time limit for providing the priority documents
  The copy of each earlier application and, where applicable, the authorisation to claim the priority granted by the holder of said earlier application or of the priority right relating thereto, must be filed within 16 months from the filing date of the earlier application concerned (= of the priority date concerned).

Art. R.612-24 para. 3
Art. R.612-24 para. 4

- Time limit for correcting declarations of priority
  The applicant also has a time limit for correcting declarations of priority, which may include the addition of priority claim(s) that were originally omitted.

  He/she can make these corrections:
  - as long as he/she has not requested the early publication of his/her patent application;

  and within the following time limits:
  - within a period of 16 months from the earliest priority claimed; however, if the correction he/she wishes to make changes the date of said earliest priority, the date retained to be taken into account for the calculation of the 16-month period shall be the least-favourable of the two dates, i.e., the date initially indicated and the date as changed;
  - in any event, the applicant may make the corrections within a period of four months after the filing of his/her application.

  Failure to comply with these time limits shall render the declaration or priority or the correction thereof inadmissible.

Art. L.612-16-1

5.4. Application for restoration of the right of priority

Any applicant that is capable of providing a legitimate excuse for their failure to comply with the one-year priority period may have his/her right of priority restored.

The time limit for filing such a request is strictly limited. Within two months of the expiry of the priority period, the applicant must:
file the French application,
file his/her request for restoration of the right of priority.

Moreover, in the event that the applicant has requested the early publication of the application, his/her request for restoration of the right of priority shall be admissible only if it is submitted before the completion of the technical preparations for publication.

5.5. Publication of the patent application

Art. L.612-21

Unless a request for early publication has been made, the patent application shall be published within a period of 18 months from the earliest priority date to which it is entitled.

5.6. Waiver of the priority claim

Art. L.613-24
Arts. R. 612-38 and R.613-45

Since legislation specifies that a patent may be withdrawn or surrendered, in whole or in part, at any time, similarly a priority claim may be withdrawn before grant or waived after grant.

Art. R.612-38
Art. R.613-45

Unless he/she is an industrial property attorney or lawyer, the representative must be able to prove that he/she holds a special authorisation to proceed with the declaration of withdrawal or waiver of the priority claim. If the application has been filed on behalf of several applicants, they must all agree to the withdrawal or waiver. Similarly, if the application has given rise to rights in rem (pledge, license), the holders of those rights must give their written consent to the withdrawal or waiver.

Art. R. 612-45
Arts. R.612-11 and R.612-10

Such withdrawal or waiver shall not affect earlier decisions made on the basis of the existence of the priority claim (for example, the decision to refuse the application for failure to comply with the time limit of 16 months from the priority date for designating the inventor).

Depending on the moment at which such withdrawal/waiver takes place, it will or will not have an impact on the publication of the application and on the time limits calculated from the priority date:

(a) Publication

- If the withdrawal of the priority claim is made before the start of the technical preparations for publication, it will have the effect of delaying the date of publication if it is the earliest priority or the only priority claimed. Publication will then take place 18 months from the filing date of the application or from the date of the earliest remaining priority.

Art. R. 612-38

- If the withdrawal takes place after the start of the technical preparations for publication and before payment of the fee for the grant and printing of the specification, the reference to the priority claimed shall be deleted only from the specification for the granted right.
  In this case the withdrawal will be entered ex officio in the French Patent Register.

(b) Time limits calculated from the priority date

If these time limits have not elapsed prior to the withdrawal or waiver of the priority claim, or if the decision on the consequences of the applicant's failure to comply with such time limits has not been taken, waiver of the priority claim shall have the effect of deferring the starting date of those time limits to the filing date or the date of the earliest remaining priority.

6. REQUEST TO BENEFIT FROM THE FILING DATE OF AN EARLIER APPLICATION ("DOMESTIC PRIORITY")

Art. L.612-3
Art. R.612-25

"Where two patent applications are filed successively by the same inventor or his/her successor in title within a period of 12 months at most, the applicant may request that the second application be accorded the same filing date as the first application for those elements that are common to both applications".

This procedure cannot be combined with the priority claim from a foreign application (see 6.2 below).

The request must be made at the time of filing by indicating the following in section 4 of the request for grant:

- the date of the earlier application,
- the number allocated to said application,
- the nature of the application (patent or utility certificate).

6.1. Deficiencies in the request resulting in its inadmissibility

The request shall be deemed inadmissible where:

Art. L.612-3 para. 2
- the benefit of the right of priority attached to a previous foreign application has already been requested for one of the two applications;

Art. L.612-3 para. 2
- the first application already benefits from several filing dates, one of which is more than 12 months old;

Art. R.612-25 para. 1
- it is not made at the time of filing of the patent application claiming domestic priority;

Art. R.612-25 para. 2
- the filing date of the first application is more than 12 months old;

Art. R.612-25 para. 3
- the filing of the earlier application has been made under conditions that do not permit publication.

6.2. Deficiencies in the request that may be remedied

Art. R.612-46

A notification of deficiency in the request shall be sent to the applicant where the applicant is not the holder of the earlier application or his/her successor in title.

The applicant will be granted a period of time within which he/she must provide the authorisation of the holder of the earlier application.

Failure to comply with such time limit shall result in the rejection of the patent application.

6.3. Publication

(a) Of the application under examination

Art. R.612-39 para. 4

The patent application shall be made public eighteen months after the earliest filing date from which it benefits.

(b) Of the earlier application

Art. R.612-39 para. 6

The earlier application shall be made public eighteen months after filing, even if it is withdrawn or rejected, unless the entitlement to claim "domestic priority" was waived before the technical preparations for publication began.

7. NUMBER AND FORMAT OF COPIES OF THE DESCRIPTION, CLAIMS, ABSTRACT AND DRAWINGS

7.1. Number of copies

Order on the procedure for filing applications

Only one copy of the description, claims, abstract and drawings shall be included in the application.

7.2. Presentation of the application documents

(a) General requirements

Order on the procedure for filing applications

The application documents must be presented in such a way as to allow for their electronic or direct reproduction, in an unlimited number of copies.

They must not be folded or torn and must not contain any corrections, overwritten text or interlineations.

The paper used must be white, durable and A4-sized (21cm x 29.7cm).

Only the one side of each sheet must be printed on.

The margins to be respected are as follows:
- top margin: 2cm to 4cm;
- left margin: 2.5cm to 4 cm;
- right margin: 2cm to 3 cm;
- bottom margin: 2cm to 3 cm.

Each section (description, claims, drawings and abstract) must start on a new sheet of paper.

The sheets shall be numbered in consecutive Arabic numerals, independently of the sheets of drawings. The numbers shall be written at the top of the sheets, in the centre. The numbering of the claim sheets shall continue on from the numbering of the description sheets.

Order on the procedure for filing applications

(b) Conditions specific to text sections (see Section C, Chapter II, 3.10 to 3.13 below)
The description, the claims and the abstract must be typed or printed in black type.

Only graphic symbols and characters, chemical or mathematical formulae may be handwritten or drawn if necessary.

The description and the claims shall not include drawings.

Every 5th line of each sheet of the description and claims shall be numbered, the numbers being on the left side, to the right of the margin. The numbering shall begin at 5 opposite the fifth line of each page, whether the line is typewritten or not.

Art. R.411-17

The claims must be numbered consecutively in Arabic numerals. Where there are more than 10 claims, whether at the time of filing or as a result of amendments, a fee shall be paid for each claim from the eleventh claim onwards.

Order on the procedure for filing applications

(c) Conditions specific to drawings (see Section C, Chapter III, 3.2 below)

Where reference is made to drawings in the description, such drawings must be included in the application.

All technical drawings are considered to be drawings, including flow sheets and diagrams.

- Usable surface

  The minimum margins to be respected are as follows:
  - top margin: 2cm to 4cm;
  - left margin: 2.5cm to 4 cm;
  - right margin: 2cm to 3 cm;
  - bottom margin: 2cm to 3 cm.

- Drawing specifications
  Drawings shall be executed in durable, black lines and strokes, so as to allow for their reproduction, without colourings. In principle, the lines shall be drawn with the aid of technical drawing instruments.

  Cross-sections shall be indicated by hatching which must not interfere with the ability to clearly read the reference signs and leading lines.

- Scale
  The scale of the drawings and the clarity of their graphic execution shall be such that a reproduction with a linear reduction in size to two-thirds would still enable all details to be distinguished without difficulty.

- References
  The numerals, letters and reference signs shown in the drawings must be simple and clear.

- Captions
  The drawings must not contain any text, with the exception of short keywords that are essential for understanding the drawings.

- Layout of figures
  A single sheet of drawings may contain several figures.

The various figures shall be arranged on one or more sheets and shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.
Where figures drawn on two or more sheets are intended to form one whole figure, they shall be arranged in such a way that the whole figure can be assembled without concealing any part of the figures on the different sheets.

- Numbering of drawing pages or sheets
Each sheet shall be numbered consecutively in Arabic numerals, at the top and in the centre, within the usable surface, indicating in Arabic numerals the number of each sheet, followed by the total number of sheets, the two numbers being separated by a slash.
For example: 1/6, 2/6, 3/6, 4/6, 5/6, 6/6 if the file has 6 sheets.

- Figure accompanying the abstract
If the patent application includes drawings, the applicant shall provide the figure of the drawings to be published with the abstract. The presentation of the drawing accompanying the abstract shall comply with the abovementioned standards.

7.3. Deficiencies in the presentation

Art. R.612-46

If the application documents contain deficiencies with regard to the abovementioned presentation requirements, the INPI shall grant the applicant a period of time in which to make the necessary corrections. If the applicant fails to make the necessary corrections within the time allotted, the patent application shall be rejected.

CHAPTER III - DIVISION OF AN APPLICATION

Art. R.612-34

"**Up to the date of payment of the fee for the grant of the patent,** the applicant may, at his/her own initiative, file divisional applications relating to his/her initial patent application."

Art. L.612-4
Art. R.612-33

He/she may also be invited to divide his/her application if it does not meet the requirement of "unity of invention".

An application that has already been divided may still give rise to further divisions. Each of the divisional applications, including the initial application, may be further divided and shall retain the filing date of the initial application.

Art. R.612-35

Art. R.612-3

The file of the first divisional application shall consist of the file of the initial application. Each of the other divisional applications shall contain: a request; a description accompanied, where applicable, by drawings; one or more claims; an abstract and, where applicable, its accompanying drawing.

The examination of the admissibility and administrative compliance of divisional applications shall be carried out in the same way as for patent applications (see Chapters I and II). However, both examination procedures are subject to specific terms and conditions:

1. REQUEST FOR GRANT

The request for grant must include (section 2):

- indication that it concerns a "divisional application",
- the national registration number and the filing date of the initial application.

Otherwise, the divisional application will be treated as an independent patent application.

2. STATUS OF THE INITIAL APPLICATION

Art. R.612-34

The division of an application may only be requested up until the date of payment of the fee for the grant of the initial application. If the abovementioned fee has already been paid or if the grant procedure has been terminated due to the rejection, withdrawal or lapse of the initial application, the request for the division of the application shall be refused.

The same shall apply where the initial application has been declared inadmissible.

Where the division concerns a divisional application (B) following on from an initial application (A), verification shall relate to the initial application (A) and not to the divisional application (B).

An application for a utility certificate may only be divided into applications for utility certificates.

3. DATE OF EFFECT OF DIVISIONAL APPLICATIONS

Art. L.612-4 para. 2

Divisional applications, including those based on earlier divisions, shall be entitled to retain the filing date and, where applicable, the priority date or the earliest date available to the initial application. This date will serve as the reference date for calculating the time limits for the payment of the renewal fees (see Book II, Section A).

4. NAME OF THE APPLICANT

Art. R.612-34

The right to file a divisional application belongs to the holder of the initial application. The name of the applicant mentioned in the divisional application file is therefore generally the same as the name appearing in the initial application file or the name of the assignee of said application, entered in the French Patent Register following the publication of the latter.

If this is not the case, a notification of deficiencies will be sent to the party requesting the division, inviting him/her to justify this discrepancy, if necessary, by producing a copy of a deed of assignment that was not entered in the Register.

5. PRIORITIES CLAIMED

With respect to divisional applications, the applicant may claim all, some or none of the priorities claimed in the initial application.

Art. L.612-4

Art. R.612-24 paras. 2 and 3

In principle, he/she may not claim any additional priorities, the divisional application being entitled only to retain the filing date and, where applicable, the priority date of the initial application.

However, the divisional application may indicate an additional priority claim if it is filed:

- either within 4 months of the filing date of the initial application;
- or within 16 months of the earliest priority date, whether existing or added.

Aside from these two situations, if a priority other than the one mentioned in the initial application is claimed, the applicant shall be informed that this declaration of priority cannot be taken into consideration.

6. DESIGNATION OF THE INVENTOR

Art. R.612-35 para. 6

Art. R.612-45

Where the inventor is not designated in the divisional application file and the applicant is not the inventor or the sole inventor, a notification of deficiencies shall be sent to the applicant requesting that he/she designate the inventor:

- either within a period of 16 months from the filing date of the initial application or from the earliest priority date claimed for the initial application;
- or within a period of two months from the issue of the notification of deficiencies; the date of expiry of this period will be indicated in the notification.

Failing compliance with the above, the divisional application will be rejected.

7. PAYMENT OF THE FILING AND SEARCH REPORT FEES

Art. R.612-35
Art. R.612-5

Art. R.612-45

The filing fee and the search report fee shall be paid within one month of the submission of the documents of the divisional application.

Failing compliance with the above, the divisional application will be rejected.

CHAPTER IV - CONVERSION OF AN APPLICATION

1. VOLUNTARY CONVERSION OF A PATENT APPLICATION INTO A UTILITY CERTIFICATE APPLICATION OR OF A UTILITY CERTIFICATE APPLICATION INTO A PATENT APPLICATION

1.1. How to request the conversion of an application

Art. L.612-15 as modified by Art. 118 of Act no.2019-486 of 22 May 2019 (PACTE Act)

A request for the conversion of a patent application into a utility certificate application or of a utility certificate application into a patent application may be filed within a period of 18 months from the filing or priority date. Such request must be made in writing.

Arts. R.612-53, R.612-54, R.612-55 as modified by Decree no. 2020-15 of 8 January 2020

A utility certificate application may be converted into a patent application up to the start of the preparations for publication of the application.

Similarly, a patent application may be converted into a utility certificate application up to the start of the preparations for publication of the application.

An applicant may not file a request for the conversion of an application after the start of the technical preparations necessary for publication of the application.

1.2. Impact of the conversion on the procedure for preparing the search report

Art. R.612-66

When the conversion of a patent application into a utility certificate application is requested, the procedure for preparing the search report shall be terminated.

Art. R.612-54 as modified by Decree no. 2020-15 of 8 January 2020

If the conversion of a utility certificate application into a patent application is requested, the search report fee must then be paid (see Section B, Chapter II, point 1.2).

2. SPECIFIC CASE OF APPLICATIONS SUSPENDED BY THE MINISTRY OF DEFENCE

Art. R.612-31

If the restrictions preventing the disclosure and free use of the invention are lifted more than one year after the filing date of the application, the applicant shall have a period of six months following the expiry of said restrictions within which to request the preparation of the search report or the conversion of his/her patent application into an application for a utility certificate.

Art. R.612-46

If the applicant does not request the preparation of the search report or the conversion of his/her application into a utility certificate application within this period, the INPI shall send the applicant a notification inviting him/her to do so. If the applicant fails to take the necessary steps within the set time limit, his/her application will be rejected.

CHAPTER V - CONVERSION OF A EUROPEAN PATENT APPLICATION INTO A FRENCH PATENT APPLICATION

Art. L.614-6 para.1
Art. 135-1a
& Art. 77-3 (EPC)
Rule 37-2 of the Implementing Regulations

A request for conversion of a European patent application into a French patent application may only be made if the European patent application is deemed to be withdrawn because it was not been transmitted to the EPO within the 14-month period from the date of filing or priority.

1. CONDITIONS FOR ENTRY INTO EFFECT

Art. R.614-5 para. 1

- The conversion shall take effect upon receipt by the INPI of the conversion request and a national registration number will be allocated.

Art. R.614-5 para. 2

- The details required to identify the application subject to the conversion request shall be mentioned in the published patent application and the published patent specification.

Art. R.614-5 para. 3
Art. R.614-5 para. 17

- Filing fees and, where applicable, search report fees relating to such requests must be paid within two months from the date of publication of the conversion (or from the date of receipt of the request in the case of NATO applications).

Art. R.614-5 para. 3

- Where applicable, the translation into French of the original text of the European patent application must be provided within the same two-month period.

Art. R.614-5 para. 5

- The applicant must communicate within the same two-month period the name and address of his/her representative if his/her domicile or registered office is not located in France or in a Member State of the European Union/European Economic Area.

Art. R.612-46

Failure to complete these formalities within the allocated time limit shall result in the rejection of the request concerned.

2. PROCEDURE FOR FILING A REQUEST FOR CONVERSION

Art. 135-2 (EPC)

Art. 66 (EPC)
Art. 135-4
Rule 155 of the Implementing Regulations

- The request for conversion shall be filed within three months after notification has been provided that the application is deemed to have been withdrawn. The effect referred to in Article 66 (Equivalence of European filing with national filing) shall lapse if the request is not filed in due time (with three months).

- The request for conversion must be filed with the central industrial property office of the Contracting State in which the aforementioned European patent application was filed.

Art. 135-2 (EPC)

Art. 66 (EPC)
Rule 155(3) of the Implementing Regulations

This office will forward the request, together with a copy of the European application, directly to the central industrial property offices of the Contracting States mentioned by the applicant in his/her request (i.e. the Contracting States designated in the European patent application).
The effect referred to in Article 66 ("Equivalence of European filing with national filing") shall lapse if the request is not forwarded within 20 months of the date of filing or priority.

CHAPTER VI - CORRECTION OF ERRORS

1. ERRORS MADE BY THE APPLICANT

Art. R.612-36 para.1

"**Up to the date of payment of the fee for the grant of the patent**, the applicant may submit a request to correct errors of wording or of copying, in addition to any errors discovered in the documents submitted. The French Patent & Trademark Office may demand proof of the existence of the material error to be corrected and, where appropriate, an explanation regarding the meaning of the correction requested.
If the request concerns the description, the claims or the designs, correction shall only be authorised if it is clearly necessary and if it is obvious that the applicant could not possibly have intended any other wording or layout." (See Section C, Chapter X on the correction of material errors of a technical nature).
The request shall be submitted in writing and shall contain the proposed changes to the text; it shall only be admissible if it is accompanied by proof of payment of the related fee."

1.1. Presentation of requests to correct errors

Art. R.612-36 para. 3

The request must be made in writing and shall include the proposed changes to the text.

It shall only be admissible if it is accompanied by proof of payment of the related fee. This fee will not be reimbursed if permission to make the correction is refused.

1.2. Formal errors

- Conditions governing the acceptance of requests to correct such errors:

The applicant must prove the existence of the error and justify the meaning of the correction requested.

The error must be a material error and not concern a change in decision on the applicant's behalf (e.g., regarding the type of IP right being sought).

The existence of the error can be easily proven if there is an inconsistency in the documents submitted at the time of filing. However, in certain cases, proof of the error may be accepted by submitting documents that were not part of the application file.

The meaning of the correction must be explained. An explanation may be provided by way of documents such as the original of the letter provided to the representative or a copy of an entry in the Companies Register.

- Errors relating to the identity of the applicant

Where the applicant's name or company name has been misspelled, the applicant shall, by means of any document proving his/her identity (e.g., ID card, copy of an entry in the Companies Register), prove that the filing was supposed to be made in his/her name.

1.3. Technical errors

See Chapter X, Section C.

2. ERRORS MADE BY THE OFFICE

Errors in the specification document for the IP right granted, detected by the holder of said right and reported to the INPI, shall be included in the errata list published in the BOPI.

The sole purpose of errata lists is to correct errors of a documentary nature occurring in the published of the patent specification document.

CE,
Ternon Ruling
26 October 2001

Only errors that are reported within a short period of time after the decision to grant the right (see Section G, point 3) will be taken into consideration. The INPI can only revoke or correct an erroneous grant decision within four months of its announcement?

SECTION C – TECHNICAL EXAMINATION

The examiner verifies the compliance of the following elements with certain technical formal requirements provided for in the French Intellectual Property Code (IPC):

1. the title of the invention appearing in the request for grant (Chapter I),
2. the description (Chapter II),
3. the drawings (Chapter III),
4. the claims (Chapter IV),
5. the abstract (Chapter V).

He/she also verifies that:

6. the application satisfies the requirement of unity of invention (Chapter VI);
7. the subject matter of the application constitutes a patentable invention within the meaning of Articles L.611-10 2, L.611-10 4 and L.611-15 to L611-19, and that the application should not be rejected on the basis of Article L.612-12, para. 7 of the IPC (Chapter VII).

He/she establishes:

8. where appropriate, the preliminary search report together with a written opinion on the patentability of the invention (Chapter VIII);
9. the search report, possibly taking into account third-party observations (Chapter IX).

He/she accepts or refuses requests submitted by the applicant for the correction of technical errors (Chapter X).

If the application contains deficiencies, the examiner may:

10. suggest a correction of any formal deficiencies (Chapter XI),
11. initiate the rejection procedure (see Section E).

CHAPTER I - TITLE OF THE INVENTION

The title of the invention should indicate specifically and concisely the subject matter of the invention.

(WIPO Standard ST-15)

Considering the importance of the title in the documentary search process, the examiner should ensure that the title provides sufficiently precise information on the subject matter of the invention so as to be of practical value to the user of the databases. In order to allow coding for storage and retrieval purposes, the title should contain only characters and signs that can be read by computer.

1. CLARITY AND CONCISENESS

Art. R.612-10

The title of the invention must "clearly and concisely indicate the technical designation of the invention".

- A title that only indicates the technical field of the invention does not constitute a clear designation of the invention, for example: "electronic detector".
- For technical reasons, titles should not contain more than 200 characters and spaces.
- Due to its imprecise nature, the abbreviation "etc." should not be used and should be replaced by an indication of what it is supposed to refer to. Expressions such as "and the like", "or similar", "such as", "and others" should also be avoided, as should imprecise terms such as "enhancement" or "improvement".
- Titles which consist exclusively of words such as "Method", "Device", "Chemical compounds" and other equally vague titles shall not be accepted due to their insufficiently precise nature. The same may also apply to long titles, for example: "New, enhanced process for the production of particles featuring special properties and new device for carrying out this process".

2. RELEVANCE TO CLAIMS

Art. R.612-10 para. 2

The title must provide information that is contained in the claims–including, where applicable, in the characterising portion–if such information is necessary for the effective designation of the invention, as the claims define the matter for which protection is sought; this shall not be detrimental to the applicant since the title is never published before the application itself.

If amendments are made to the claims, the question of whether the title needs to be adapted shall be examined.

3. FANCY NAMES, PERSONAL NAMES AND TRADEMARKS, FOREIGN-LANGUAGE TERMS

Art. R.612-10 para. 2

The title of the invention must not include any fancy names, for example: personal names, trademarks or neologisms.

Foreign-language terms must be replaced by their French equivalent (see Section C, Chapter II, points 3.2 and 3.3).

4. UNITS OF MEASUREMENT

The title must not contain units of measurement. If, exceptionally, units of measurement are included, the requirements applicable shall be the same as those listed in Chapter II concerning the description (see Section C, Chapter II, point 3.7).

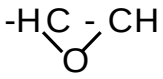
5. CHEMICAL OR MATHEMATICAL FORMULAE

Chemical or mathematical formulae shall only be accepted if they do not present any difficulty regarding their input and reproduction.

For example:

The formula SO_2 may be accepted.

The symbol $\sqrt{}$ shall not be accepted.

The formula  shall not be accepted.

To ensure they are processed, the specific semantic tags, details of which are provided in the table in the appendix, must be included in the application documents.

6. AMENDMENT TO THE TITLE

If changes are made to the title of the invention over the course of the procedure, the amended title, together with the description, the claims, the abstract and, where applicable, the drawings and the figure accompanying the abstract, shall be filed in a single document in Open XML (.docx) format.
To ensure these changes are processed, the specific semantic tags, details of which are provided in the user guide, available at https://procedures.inpi.fr and in the appendix to this Section, must be included in the application documents.

CHAPTER II - THE DESCRIPTION

Art. L.612-5

"The patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art."

Art. L.612-6

The claims must be supported by the description.

The content of the description must meet a number of requirements, which are verified by the examiner. It should be noted that some of these requirements also apply to the drawings and the claims (see Section C, Chapters III and IV).

1. CONTENT OF THE DESCRIPTION

Art. R.612-12

"The description shall contain:

1. Mention of the technical field to which the invention relates;
2. Mention of the prior art known to the applicant and which may be regarded as useful for understanding the invention and drawing up the search report; the documents reflecting the prior art must be cited wherever possible;
3. Disclosure of the invention, as claimed, in such terms that the technical problem and the solution proposed can be understood; where appropriate, any advantageous effects of the invention with reference to the prior art shall be stated;
4. A brief description of the drawings, if any;
5. A detailed description of at least one way of carrying out the invention; the description should be accompanied by examples and references to the drawings, if any;
6. Mention of the manner in which the invention is industrially applicable, when it is not obvious from the description or the nature of the invention."

Art. R.612-13

"The description shall be presented in the manner and order referred to in Article R.612-12 [above], unless the nature of the invention means that a different manner of presentation would be more concise and grant a better understanding.

In addition, the following may be appended to the description:

1. Short extracts of computer programmes presented in the form of lists written in current programming languages, where necessary for the understanding of the invention;
2. Lists of nucleotide and/or amino acid sequences;
3. Chemical or mathematical formulae."

1.1. Issues preventing the search report from being drawn up

Art. L.612-12 para. 6

The description must allow for the search report to be drawn up based on the elements which are relevant in order to assess the novelty and inventive step of the invention. To this end, the description must make it possible to understand the technical problem concerned and the solution proposed by the invention.

If the description does not make it possible to draw up the search report, the patent application shall be rejected (see Section E).

The description shall prevent a search report from being drawn up if it is written:

- in an unclear manner, for example if the explanations provided do not make it possible to understand how the invention works;

- in a vague and insufficiently precise manner with respect to the nature of the invention (for example: stainless steel composition in which the sum of the percentages of the indicated components does not equal 100).

The same shall also apply to applications concerning:

- an alleged solution to a technical problem that is inherently impossible to solve. For example, a "perpetual motion mechanism" or any device whose functioning is known to be contrary to well-established laws of physics.

- the invention of a device that clearly does not constitute a solution to the technical problem concerned, even if the problem could, in principle, be solved by another device. For example, a mechanism that would be impossible to operate due to a major technical flaw or whose operation would produce the opposite of the desired results. Thus, a patent application for a device presented as a solution to increasing the range of battery-operated electric vehicles would be rejected if it is obvious from the description of the device that its implementation would actually reduce the range of such vehicles, instead of increasing it. Similarly, a patent application for a device presented as being a direct-current generator would be rejected if it is in fact only capable of producing alternating current.

Art. L.611-2 (last para.)
Art. L.615-6

In the case of patent applications, the INPI shall send a notification to the applicant to inform him/her that it is not possible to draw up the search report.

In the case of applications for a utility certificate, the INPI will not send such a notification to the applicant as it does not draw up search reports for this type of application; it only examines the compliance of the claims.
However, these principles do apply to utility certificates, since the holder must produce a search report if he/she wishes to bring an action for infringement.

1.2. Omission of description pages from the patent application

The applicant shall be informed if any part of the description has been omitted. The applicant may then:

Art. R.612-9

- file the missing elements in an Open XML document (docx.) containing the other items required for the application (Section A - Procedure for Filing an Application - 1. 5 Documents for Filing an Application), within two months from the filing of the application, or from the date of the notification sent to him/her by the INPI indicating the missing elements. The filing date shall then be deferred to the date of submission of the missing elements, unless the applicant claims priority and indicates that the missing elements are contained in the earlier application. The conditions for filing such supplementary elements are specified in Title I, Section B, Chapter I, point 4;

Art. R.612-36

- submit a request to correct material errors (see Section C, Chapter X). The proposed text can only be accepted if it is clearly substantiated by:

  - either the documents contained in the earlier application, for example, if the proposed text corresponds exactly to the wording of structural features that are obvious from the drawings, or to the wording of features contained in the claims;

  - or documents with a definite date on the date of filing.

Art. L.612-3
Art. R.612-25

- If the application does not claim foreign priority, it is possible, within a period of 12 months from the earliest date available to the application, to file a second complete application, including the parts of the description omitted in the first application. The elements that are common to both applications shall retain the filing date of

the first application (under the "domestic priority" mechanism; see Section B, Chapter II, point 6).

- leave the description as is. The omission of part of the description may result in certain deficiencies that shall be made known to the applicant:

Art. L.612-6

- reference signs used for the drawings that do not appear in the description,

- drawing not provided for in the description (see Section C, Chapter III, point 1.2).

- claims not supported by the description (see Section C, Chapter IV, point 1.4).

2. PROHIBITED MATTER

In addition, the description must be free of prohibited matter.

2.1. Matter contrary to human dignity, public policy or morality

Art. L.611-17
Art. R.612-4 para. 1
Art. L.612-12 (last para.)

The examiner verifies that the description does not contain any elements or drawings whose "publication or implementation would be contrary to human dignity, public policy or morality", such as propaganda in favour of racial, religious or any other form of discrimination, any form of encouragement to riot or commit criminal acts, obvious obscenities, etc. (see Section C, Chapter VII, point 2.2).

2.2. Disparaging statements

Art. R.612-4 para. 2

The description must not contain any "disparaging statements regarding the products or processes of any particular person other than the applicant, or the merit or validity of applications or patents of any such person. However, mere comparisons with the prior art shall not be considered disparaging in themselves."

2.3. Elements clearly not relevant to the invention

Art. R.612-4 para. 3

"The patent application shall not contain elements that are clearly irrelevant to the description of the invention", such as defamatory statements, political, religious or philosophical opinions, etc.

2.4. Deletion of prohibited matter

Art. R.612-50

Art. L.612-12 (last para.)

Where the description contains prohibited matter, a notification shall be sent to the applicant specifying the proposed deletions. If the applicant fails to submit his/her observations within the time limit set or if his/her observations are not accepted, the parts concerned shall be deleted by the INPI before publication of the patent application.

3. FORMAL DEFICIENCIES

Art. L.612-12
Art. L.612-1
Art. R.612-46
Art. R.612-50

Where the description contains formal deficiencies, a notification shall be sent to the applicant, which may be accompanied by a proposal for amendment or indicate the proposed deletions. The letter shall specify the time limit within which the applicant may submit his/her observations or remedy the deficiencies.

3.1. References to claims

The description should not contain any references to the claims, such as for example:
"Other features appear in the claims".
"The device of claim no. 1 provides a solution to the technical problem...".

In order to correct the description, the applicant may:

- either delete the part of the description concerned;
- or replace this part with the exact wording of the text contained in the claim concerned. Since this is not a correction of a material error, no fee shall be due (see Section B, Chapter VI).

3.2. Foreign Language

a) Applications filed in a foreign language (see Section B, Chapter I, 1.4)
In the case of an application filed in a foreign language, in accordance with Article R.612-21 of the French Intellectual Property Code, the applicant is requested to provide a French translation of his/her application within a period of two months.

Art. R.612-8

b) Foreign-language terms

Art. R.612-21

French Decree No. 96-602 of 3 July 1996 on the enrichment of the French language provides for the publication in the Official Journal (OJ) of lists of certain foreign-language terms and their French equivalents. According to Article 11 of this Decree, "the [French] terms and expressions published in the OJ must be used instead of their foreign-language equivalents in all correspondence and documents, of any nature whatsoever, issued by State-run public services or establishments".

The examiner shall verify the existence of a French equivalent to the foreign-language term found in the patent application by consulting the list of recommended terms published in the OJ (available online: franceterme.culture.gouv.fr).

- **If the foreign-language term appears on the abovementioned lists**, a notification shall be sent to the applicant requesting that he/she replace it with the equivalent French term, failing which the application shall be rejected.
- **If the foreign-language term does not appear on the abovementioned lists, but can be found in a standard French dictionary**, the applicant will be requested to amend the text of his/her application provided that the dictionary indicates that the term is foreign and that there is a well-known French equivalent.
- **If the foreign term does not appear either on the abovementioned lists or in any standard dictionary**, and if no French translation exists, the examiner shall request that the word be put in quotation marks and followed by an explanation upon its first occurrence in the patent application.

3.3. Neologisms

Neologisms are generally refused. However, if no suitable French term exists, it is requested that the term be clarified when it is first cited in the patent application and then put in quotation marks.

3.4. Fancy names

The description shall not include fancy names, except where such names are necessary for the identification of an object, product or document; for example, the names given by applicants to their inventions and any names made up from scratch shall be prohibited.

3.5. Personal names

Art. R.612-10 para. 3

The description shall not include the names of persons unless such information forms part of a citation of a patent or other document.

The names of the inventors of the invention that is the subject matter of the application must appear either on the request if the inventors are the applicants (see Section B, Chapter II, point 3, items 5 and 7) or in a separate document (see Section B, Chapter II, point 4).

3.6. Trademarks

The description shall not include any trademarks, unless such information is necessary for the identification of an object, product or document.

If the examiner finds that a term used in the description is a registered trademark in France, he/she shall require the applicant to present the term as follows: "known as 'X' (registered trademark)". The name must be written with a capital letter and in quotation marks. The symbol ® may also be used.

3.7. Physical values and units of measurement

Where reference is made to the properties of a material, the relevant units need to be specified if quantitative considerations are involved.

Physical values must be expressed in units recognised in international practice, if possible, using SI units or SI derived units. Any values that do not meet this requirement must also be expressed in units recognised in international practice. In this case, it is preferable that the applicant leave the value in brackets after it has been expressed in legal units. This way of expressing values makes it easier to verify at a later stage whether the conversion into units of another system has been correctly carried out.

If an official standard is referenced and referred to by the use of abbreviations, the standard and the abbreviations must be adequately identified.

For mathematical and chemical formulae, the symbols in general use must be adopted. In particular, if official international standards exist and are applicable to the technique in question, they shall be used wherever possible. To ensure they are processed, the specific semantic tags, details of which are provided in the table in the appendix, must be included in the application documents.

3.8. Consistency in terminology and signs

Care is taken to ensure consistency of terminology, technical symbols and signs used throughout the application.

3.9. Reference to drawings

a) Reference signs

"Reference signs may only be used for drawings if they appear in the description and in the claims and vice versa. Reference signs for the same elements must be identical throughout the application."

Where reference signs are used for the drawings, the name of the element and its number must be mentioned; in other words, instead of being written as follows: "3 is connected to 5 by 4'", the reference should be written in the following manner "resistor 3 is connected to capacitor 5 by switch 4".

b) Incorporation of drawings in the description

Art. R.612-3

Drawings may accompany the description but may not form an integral part of it. Expressions such as "the drawings form an integral part of the description" are not permitted.

3.10. Typewritten elements (see Section B, Chapter II, points 7.2a and b)

The description and claims must be typed. They must not contain any handwritten passages.

The documents must be of sufficiently high quality to allow for their reproduction in an unlimited number of copies.

The documents must not contain any corrections or overwritten text.

3.11. Page numbering (see Section B, Chapter II, point 7.2b)

For applications filed before 19 November 2018, the pages of the description and claims must be numbered consecutively in Arabic numerals. Sub-numbering of pages (e.g., "1a", "1b", etc.) shall not be accepted.

The page numbers shall be written at the top and in the centre.

3.12. Line numbering (see Section B, Chapter II, point 7.2b)

For applications filed before 19 November 2018, each page of the description and of the claims must display line numbers at intervals of five (i.e. every fifth line shall be numbered). Line numbering will commence at 5 and will start over again on each new page.

3.13. Presence of drawings in the description

The description shall not include drawings. All drawings must be grouped together on the pages of drawings specially reserved for that purpose and may in no case be inserted in the description, even if the text of the description ends at the top of a page and leaves sufficient space, and even if there is only one figure.
However, the description may include chemical or mathematical formulae and tables. To ensure they are processed, the specific semantic tags, details of which are provided in the table in the appendix, must be included in the application documents.

3.14. Excerpts from computer programmes

Art. R.612-13 para. 2 (1)

"Short extracts of computer programmes presented in the form of lists written in current programming languages" may be included in the appendix at the end of the description, "where necessary for the understanding of the invention".

Art. R.612-13 para. 3

"Short extracts of computer programmes presented in the form of flow diagrams, necessary for the understanding of the invention, shall be considered to constitute drawings" and must not be included in the description.

3.15. Lists of sequences

Art. R.612-13 para. 2 (2)

If nucleotide and amino acid sequences within the meaning of WIPO Standard ST.25, paragraph 2(ii), are disclosed in the French patent application, they should be presented in a sequence listing that complies with WIPO Standard ST.25. This sequence and/or amino acid listing should be appended to the description. It shall be entitled "Sequence Listing" and shall be subject to separate page numbering (from 1 to n).

The sequence listing shall be presented as being part of the description.

The sequence listing must be provided in an electronic format (TXT format) compliant with WIPO Standard ST.25, paragraph 39 *et seq.*, separately from the Open XML file (docx.) containing the other parts of the application (see Section B, Chapter II, point 3, item 9).

Each sequence shall be assigned a separate sequence identifier. The sequence identifiers shall begin with 1 and increase sequentially by integers. In the description, claims or drawings of the application, the sequences represented in the sequence listing shall be referred to by the sequence identifier and preceded by "SEQ ID NO:".

Nucleotide and amino acid sequences should be represented by at least one of the following three options:
(i) a pure nucleotide sequence;
(ii) a pure amino acid sequence;
(iii) a nucleotide sequence together with its corresponding amino acid sequence.

The examiner may inform the applicant of any deficiencies found in the sequence listing itself and/or its electronic format and request that they be remedied.

Art. L.612-12 para. 6

Compliance with these formal requirements is necessary for the search report to be drawn up. Failure to provide the sequence listing or providing it in an unsuitable electronic format (a format other than TXT) may result in the rejection of the patent application as the Preliminary Search Report cannot be drawn up.

Art. R.612-52

In the event of such rejection, the applicant may request that the application be pursued. He/she must then provide the elements required.

3.16. References to documents in the description

Art. R.612-12 para. 2

References to other documents may be made in the part of the description concerning prior art. However, these documents may not be incorporated into the description. Indeed, Article R.612-12 para. 2 does not provide for the incorporation of documents into the description to illustrate the prior art, only their citation.

Art. L.612-5

"The patent application must describe the invention in a manner sufficiently clear and complete for a person skilled in the art to be able to carry it out." This means that the description of the invention in the patent application must be complete, i.e. the invention must be comprehensible without reference to any other document. This does not exclude the possibility of referring to other documents in order to carry out the invention.

Art. L.612-12 (last para.)
Art. L.612-1

Art. R.612-50

Expressions such as "document XXX, the contents of which are considered to be incorporated into this description" are therefore not allowed. A letter specifying the proposed deletions shall be sent to the applicant. If the applicant fails to submit his/her observations within the time limit set or if his/her observations are not accepted, the sections concerned shall be deleted by the INPI.

4. OBVIOUS ERRORS

If the examiner finds that there is an obvious error in the description, depending on the significance of the error, he/she may:

Art. R.612-36

(a) indicate to the applicant the discrepancy found by requesting that the applicant submit a request to rectify the mistake (see Section C, Chapter X). Such notification shall not entail any obligation to reply.

Art. L.612-12 para. 6
Art. R.612-49

(b) notify the applicant that the description does not allow for the search report to be drawn up (see Section C, Chapter II, point 1.1.); such notification may lead to the rejection of the application.

5. AMENDMENT OF THE DESCRIPTION

If amendments are made to the text of the description over the course of the procedure, the amended description, together with the claims, the title of the invention, the abstract and, where applicable, the drawings and figure accompanying the abstract, shall be filed in a single document in Open XML (.docx) format.
To ensure these amendments are processed, the specific semantic tags, details of which are provided in the user guide, which can be found at https://procedures.inpi.fr and in the appendix to this Section, must be included in the application documents.

For applications filed before 19 November 2018, however, it is possible to provide only the full description in a single document.

In order to ensure that the amendments made are properly understood, the INPI may request that the replacement pages be accompanied by a copy in which the amendments are clearly marked.

The only amendments to the description provided for by the IPC are the following:

5.1. Corrections made in response to a notification of deficiencies by the INPI

Art. R.612-37

Regarding the correction of the description, it may only be amended "to the extent necessary to remedy the deficiencies found". If passages not concerned by the notification of deficiencies are amended, the applicant must restore them to their original wording.

Similarly, if the title is amended or if the claims are amended before the start of the documentary search, the applicant shall not be authorised to make the corresponding amendments to the description, even if the aim is to eliminate unpatentable elements. In this case, the amended parts of the description shall not be taken into account.

Art. R.612-36

5.2. Corrections of material errors, subject to certain conditions (see Section B, Chapter VI and Section C, Chapter X).

Art. R.612-35

5.3. Amendments relating to divisional applications, in particular the limitation of the description to the subject matter of the divisional application alone (see Section B, Chapter III and Section C, Chapter VI, B).

Art. R.612-60

5.4. If the claims are amended in response to the preliminary search report, the deletion, upon request, of any elements of the description that no longer correspond to the new claims. This request shall be admissible up to the date of payment of the fee for the grant of the patent and only if the claims have been amended in response to the preliminary search report (see Title I, Section C, Chapter VIII, point 5.2.2).

Art. L.612-13
Art. R.612-37

Apart from the cases listed in points 5.1 to 5.4 above, the description may not be amended. Any amendments made to the description and provided by the applicant will therefore not be taken into account.

Art. L.613-25

Moreover, the patent shall be declared invalid if its subject matter, as amended, extends beyond the content of the original application.

6. INVENTIONS RELATING TO BIOLOGICAL MATERIAL

(With regard to the patentability of biotechnological inventions, see Section C, Chapter VII, point 3)

Art. L.612-5

Where an invention involving biological material to which the public does not have access cannot be described in such a way as to enable a person skilled in the art to carry out such an invention, its disclosure shall be considered sufficient only if the biological material has been deposited with a competent body: an international depositary authority (IDA) in accordance with the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

If the application contains sufficient details of the properties that identify the biological material, the disclosure shall be considered sufficient.

Art. R.612-14

Otherwise, the biological material must be deposited with the authorised body no later than the date of filing of the patent application. Information on this deposit must be included in the patent application:

- within 16 months of the filing of the patent application or of the earliest date available to the application;
- at the time of the request for early publication of the patent application, if such a request is made before the expiry of the aforementioned period.

Art. L.612-5
Art. L.613-25

Failure to comply with these provisions may result in the patent being declared invalid on the grounds of insufficient disclosure.

Art. L.612-12 para. 6

Furthermore, if the indications in the description relating to the biological material do not allow the search report to be drawn up, the patent application may be rejected.

CHAPTER III - DRAWINGS

Art. L.613-2

When drawings are attached to the file, their role is to illustrate the description in such a way as to facilitate the understanding and interpretation of the invention.

The description and drawings are used to interpret the claims.

1. DISCREPANCIES BETWEEN THE DESCRIPTION AND DRAWINGS

▶ 1.1. Drawings omitted upon filing the patent application (See Section B, Chapter I, point 4)

Where reference is made to drawings in the description of a patent application, such drawings must be included in the application. Where one or more drawings referred to in the description have been omitted, the applicant shall be informed accordingly. The applicant may then:

Art. R.612-9

- file the missing drawings in an Open XML document (docx.) containing the other items required for the application (Section A - Filing Requirements - 1. 5 Documents for Filing an Application), within two months from the filing of the application, or from the date of the notice sent to him/her by the INPI indicating the missing elements; the filing date shall then be deferred to the date of submission of the missing elements, unless the applicant claims priority and indicates that the missing elements are contained in the earlier application; the conditions for filing such supplementary elements are specified in Section B, Chapter I, point 4;

Art. R.612-9

- delete the references made to the drawings in question, in which case the filing date shall be maintained;

- submit a request to correct material errors (see Section C, Chapter X). The proposed drawing shall only be accepted if it can be clearly substantiated by:

  - elements included in an earlier application, if the proposed drawing corresponds exactly to the data contained in the description and it is clear that no other layout could have been envisaged by the applicant; or

  - documents with a definite date on the date of filing.

- If the application does not claim foreign priority, it is possible, within a period of 12 months from the earliest date available to the application, to file a second complete application, including the drawings omitted in the first application. The elements that are common to both applications shall retain the filing date of the first application (under the "domestic priority" mechanism; see Section B, Chapter II, point 6).

▶ 1.2. Drawings not provided for in the description

Art. R.612-36

Where the documents included in the application contain a drawing to which no reference is made in the description, the examiner may request that the applicant remedy the situation.

(a) If the additional drawing obviously represents a variant of the invention and it is obvious that a reference to the drawing has been omitted in the description, the examiner may accept, as correction of this material error (see Section C, Chapter X), a simple reference to this drawing in the description, such as: "Figure X represents a variant of the method used to carry out the invention".

If the additional drawing has a connection with the invention but the conditions for correcting the error are not fulfilled, the application shall be left as it stands.

Art. R.612-4 para. 3
Art. R.612-50
Art. L.612-12 (last para.)

(b) If the additional drawing is clearly not related to the description of the invention, the examiner may recommend that the applicant delete it. If no comments are received within the applicable time limit or if the applicant's comments are not accepted, the examiner shall automatically delete the drawing concerned (see Section C, Chapter II, points 2.3 and 2.4).

If the drawing unrelated to the invention has been wrongly submitted in the place of a drawing provided for in the description, the latter may be accepted by the examiner under the same conditions as those set out in point 1.1 (see Section C, Chapter II, point 1.1).

2. PROHIBITED MATTER

Art. R.612-4 para. 1

The drawings must not be detrimental to human dignity, public policy or morality (see Section C, Chapter VII, point .2.2.). Elements whose publication or implementation would be contrary to public policy or morality shall be made known to the applicant, who shall be invited to submit his/her comments. If the applicant fails to submit his/her observations within the time limit set or if his/her observations are not accepted, the drawings concerned shall be deleted by the INPI.

3. FORMAL DEFICIENCIES

3.1. Provisions common to those relating to the description

The provisions concerning the description and relating to:

- foreign-language terms (see Section C, Chapter II, points 3.2. and 3.3.)
- fancy names (see Section C, Chapter II, point 3.4.)
- personal names (see Section C, Chapter II, point 3.5.)
- trademarks (see Section C, Chapter II, point 3.6.)
- units of measurement (see Section C, Chapter II, point 3.7.)
- corrections, overwritten text (see Section C, Chapter II, point 3.10.)

shall also apply to drawings.

3.2. Provisions specific to drawings (see Section B, Chapter II, point 7.2c)

In general, drawings should be executed in accordance with the rules of industrial design. Where applicable, the figures shall be arranged vertically on several pages.

For applications filed before 19 November 2018, pages containing drawings shall be numbered in Arabic numerals, at the top and in the centre of each page starting from the number 1, with an indication of the serial number of each page, followed by the total number of pages, the two numbers being separated by a slash.
For example: 1/6, 2/6, 3/6, 4/6, 5/6, 6/6 if the file contains 6 pages.

Drawings shall consist of durable, black lines and strokes, so as to allow for their reproduction.

(a) Numbering of figures
The various figures making up the drawings must always be numbered consecutively, starting from 1, in Arabic numerals, in accordance with the user manual for Open XML

documents, which can be found at https://procedures.inpi.fr, even in the case of divisional applications.

(b) Scale of drawings

The graphic representation of the scale of drawings, in cases where its inclusion is considered useful, must be such that it remains usable even if the drawing is reproduced in a smaller format. This excludes indications of size such as "full size" or "half scale", both on the drawings and in the description. However, graphic representations of scale are acceptable.

The elements of a given figure must be in proportion to each other unless a difference in proportion is essential for the clear illustration of the figure.

(c) Cross-sections

- Sectional diagrams:

Where the figure represents a cross-section of another figure, it is recommended that the latter should indicate the position and viewing direction.

- Hatching:

A cross-section must be set out and drawn in the same manner as a normal view, the cross-section parts being hatched with evenly spaced strokes and the space between the strokes being selected on the basis of the total area to be hatched.

(d) Numbers, letters and reference signs

Numbers, letters and reference signs and any other data provided on the pages of drawings, such as the numbering of figures, the numbering of the drawing pages, text that may be included, graduations on scales, etc., must be clear and simple. Signs such as 6′ and 35" are permitted.

The numbers, letters and reference signs should preferably all be arranged in the direction in which the figure is to be viewed, i.e. vertically.

Reference signs may only be used for drawings if they appear in the description. By way of exception, if the description has been amended by deleting entire passages, the INPI shall not oblige the applicant to systematically delete all of the references that have been rendered superfluous on the drawings.

Conversely, all reference signs used in the description and claims must be found on the drawings. There shall be no exceptions to this rule.

"Reference signs for the same elements must be identical throughout the application."

(e) Text matter in the drawings

"The drawings must not contain any text matter. Where indispensable to understand the drawings, a few short keywords, such as "water", "steam", "open", "closed", or "section on AB" may be included." Aside from these brief indications, the terms appearing on the drawings shall be replaced by reference signs and the captions for the drawings may be incorporated into the description.

In the case of electric circuits and block schematic or flow sheet diagrams, a few short keywords identifying the functional integers of complex systems (such as "magnetic core memory" or "speed integrator") may be considered indispensable from a practical point of view if they are necessary to be able to interpret a diagram rapidly and clearly.

Art. R.612-13

(f) Excerpts from computer programmes

"Flow sheets, diagrams and short excerpts from computer programmes submitted in the form of flow diagrams necessary for the understanding of the invention shall

be deemed to constitute drawings." These flow diagrams must be presented in such a way as to occupy the least possible space while remaining legible.

Excerpts from computer programmes presented in the form of listings may not appear on the drawings and must be transferred to an appendix attached at the end of the description (see Section C, Chapter II, point 3.14).

(g) Reproduction of a computer screen

Art. L.112-2
Art. L.122-1
Art. L.122-3
Art. L.122-4

The application must not contain copies of a computer screen displaying the graphical user interface of software protected by third-party copyright. This reproduction may be replaced by a rectangle depicting the layout of the screen.

(h) Drawings consisting of photographs

Black and white photographs are accepted, provided that they can be reproduced and meet all of the abovementioned requirements for drawings.

4. OBVIOUS ERRORS

If the examiner finds that there is an obvious error in one of the drawings provided, depending on the significance of the error, he/she may:

Art. R.612-36

(a) indicate to the applicant the discrepancy found by requesting that the applicant submit a request to correct the mistake (see Section C, Chapter X). Such notification shall not entail any obligation to reply.

Art. L.612-12 para. 6

(b) notify the applicant that the description and the drawings provided do not allow for the search report to be drawn up (see Section C, Chapter II, point 1.1. and Section C, Chapter IV, point 1.3.); such notification may lead to the rejection of the application.

5. AMENDMENT OF THE DRAWINGS

If amendments are made to the drawings over the course of the procedure, the amended drawings, together with the description, the claims, the title of the invention, the abstract and, where applicable, the figure accompanying the abstract, shall be filed in a single document in Open XML (.docx) format.
To ensure these amendments are processed, the specific semantic tags, details of which are provided in the user guide, which can be found at https://procedures.inpi.fr and in the appendix to this Section, must be included in the application documents.

For applications filed before 19 November 2018, however, it is possible to provide only all of the drawings in a single document.
In order to ensure that the amendments made are properly understood, the INPI may request that the replacement pages be accompanied by a copy in which the amendments are clearly marked.

As for descriptions (see Section C, Chapter II, point 5), the only amendments that can be made to drawings are as follows:

Art. R.612-37

▶ 5.1. corrections made in response to a notification of deficiencies sent by the INPI

Regarding the correction of drawings, they may only be amended "to the extent necessary to remedy the deficiencies found". If parts of the drawings not concerned by the notification of deficiencies are amended, the applicant must restore them to their original state.

Art. R.612-36

▶ 5.2. corrections of material errors, subject to certain conditions (see Section B, Chapter VI and Section C, Chapter X).

Art. R.612-35

- 5.3. amendments relating to divisional applications, in particular the limitation of the description to the subject matter of the divisional application alone (see Section C, Chapter II, point 5.3 and Section C, Chapter VI, B, point 2), the deletion of figures corresponding to passages deleted from the description.

Art. R.612-60

- 5.4. amendments following the amendment of the claims in response to the preliminary search report, the deletion, upon request, of any elements of the description that no longer correspond to the new claims, the deletion of figures corresponding to passages deleted from the description (see Section C, Chapter II, point 5.4. and Section C, Chapter VIII, point 6.3).

Apart from the cases listed in points 5.1 to 5.4 above, any pages containing amended drawings provided by the applicant shall not be taken into account.

CHAPTER IV - CLAIMS

Art. L.612-6

The claims must:

I) define the matter for which protection is sought,
II) be clear and concise,
III) be supported by the description.

Since the terms of the claims shall determine the extent of the protection conferred, it is extremely important that they be clear. However, claims are not assessed in isolation and should not be taken strictly literally. The description and drawings shall be used to interpret the claims.

Art. L.613-2

1. CONTENT OF THE CLAIMS

1.1. Elements constituting a claim

"Claims shall comprise:

Art. R.612-17

1. A preamble indicating the designation of the subject matter of the invention", i.e., the general technical field of the apparatus, process, etc., to which the invention relates, and indicating "the technical features necessary for the definition of the elements claimed, but which when combined, form part of the prior art";

2. A characterising portion preceded by an expression such as "characterised by", stating the technical features which, in combination with the features stated in paragraph (1), are those for which protection is being sought".

Example:

"Device for breaking the tips of the ampoules containing a liquid, (*preamble*)

characterised in that it comprises a casing with an opening into which the tip of the ampoule is inserted" (*characterising portion*)

Art. R.612-17 (last para.)

The applicant is generally required to comply with the abovementioned rules regarding the two-part presentation of claims. However, if the nature of the invention justifies it, claims may be presented in a different manner.

Certain types of inventions may require a different form of presentation, for example:
- a combination of known elements that are of equal relative importance, the invention residing solely in that combination; or
- a new chemical compound or a group of compounds.

Art. R.612-16

Irrespective of the form of presentation chosen, the claims must disclose the "**technical features**" **of the invention**, i.e., what precisely defines the invention from a technical point of view (e.g., the physical composition of a product, a series of steps to be carried out as part of a specific process, etc.).
The technical features stated must make it possible to define the matter for which protection is being sought in a sufficiently precise manner.

Indications of a general nature shall therefore be refused:
"....characterised in that any kind of material is used".
"....characterised in that it can be fitted to any existing or future device."

Similarly, the listing of mere properties that are not sufficient to precisely define the product that is the subject matter of the invention shall not be accepted. For example, a claim relating to an alloy characterised by its elastic properties shall not be considered valid if the composition or manufacturing process of said alloy is not defined.

In general, the subject matter of an invention is defined by positive features. However, it is possible to limit the scope of a claim by expressly excluding from the claimed protection an element clearly defined by technical features. The drafting of a claim in this manner is reserved for cases where the remaining subject matter of the claim cannot be defined more clearly and concisely by positive features.

A claim belonging to one category may simply refer to a claim belonging to another category, if the latter contains all of the required technical features.

For example, a product claim may simply refer to a claim defining the manufacturing process (e.g., "Product obtained by the process set out in claim X").

Claims should not contain non-technical information, such as statements relating to possible commercial advantages of the invention; statements relating to the purpose of the invention shall only be accepted if they contribute to defining the invention and are provided in addition to a technical statement.

1.2. Different types of claims

(a) Categories

Art. R.612-18

The French Intellectual Property Code mentions different "categories" of claims (claims to a "product, process, device or use").

There are in fact only two basic types of claims, namely claims relating to a physical object (product, device) and claims relating to an activity (process, use).

Provided that the unity of invention requirements are met (see Chapter VI), an application may contain several independent claims belonging to different categories.

Art. R.612-19
Art. R.612-17, para. 1

However, an application may only contain several independent claims of the same category where this can be justified; for example, in the case of several interrelated products.

This is the case, in particular, where an invention consists of two separate but closely interrelated products (e.g., an electrical plug and socket), where the same product/device is used in several different ways or where there are several alternative solutions to the same problem.

(b) Independent and dependent claims

All patent applications contain one or more so-called independent claims, directed to "the essential features of the invention".

Art. R.612-18

Each of these claims "may be followed by one or more claims concerning particular ways of carrying out the invention". Needless to say, any claim concerning a particular way of carrying out the invention must contain the essential features of the invention and, therefore, all of the features of at least one independent claim.

"Any claim that contains all of the features of another claim" is considered to be a "dependent claim". Any such claim "shall make reference, where possible in the preamble, to the other claim" and "shall state the additional features for which protection is sought".

Example:

(1) Device for breaking the tips of ampoules containing a liquid, characterised in that it comprises a casing (1) with an opening into which the tip of the ampoule (3) is to be inserted, and a lever (4).

(2) Device for breaking the tips of ampoules containing a liquid according to claim no. 1, characterised in that the lever (4) forms part of the casing.

A dependent claim cannot refer to only part of another claim, it must include all of the features of the latter. References to another claim such as "Device according to the preamble of claim no. 1" shall not be accepted.

On pain of rejection, a dependent claim must always include additional technical features besides those listed in the claim on which it is dependent.

These additional technical features must contribute to effectively defining the subject matter of the dependent claim. For example, if the dependent claim relates to a **product**, the additional features cannot be limited to mentioning **uses** of the product, since the manner in which the product is used does not define the product itself.

A claim that refers to a claim belonging to a different category (e.g., "a device...for carrying out the process disclosed in the first claim, characterised by...") shall not be regarded as a dependent claim, but rather as a referring claim. Similarly, where an invention relates to several interrelated products, a claim relating to one product that refers to a claim relating to the other product with which it is related shall not be regarded as a dependent claim (for example: "Plug...associated with the socket of claim no. 1, characterised by...")

1.3. Claims preventing the search report from being drawn up

Art. L.612-12 para. 6

The provisions applicable to the description, relating to the impossibility for the INPI to draw up the search report (see Section C, Chapter II, point 1.3) shall also apply to the claims on the basis of which the preliminary search report and the search report are established.

1.4. Support in description

Art. L.612-6
Art. L.612-12, para. 8
Art. R.612-49

Each claim must be supported by the description, failing which it shall be rejected. "The claim must be supported by the description" shall be understood to mean that the subject matter of each claim must be found in the description. This condition shall be deemed to be met where the claim matches the description word for word, or where the wording of the claim is equivalent. However, in practice, if the technical features of a claim are clearly shown in the drawings but are not described, they shall only be accepted if they specify a technical means already provided for in the description, which is consistent with the overall content of the description.

TGI Paris, 6 April 2004, PIDB 2004, no. 790, III, 410

For example, a claim concerning the positioning of stops on the underside of handling crates shall be acceptable provided "the stated positioning is referred to in the description, at least implicitly, and is illustrated on the figure".

A claim may define a feature of the invention in terms of its function, provided that the description contains sufficient examples of means performing said function or that such means are well known.

Where the features set out in a claim are not supported by the description, the claim shall be rejected.

It is sometimes possible to rectify such claims. In this respect, there are two possible scenarios, depending on whether the claim in question existed at the time the patent application was filed or whether it was submitted at a later date.

Art. R.612-36

(a) Original claims

In the case of an original claim, it is considered beyond doubt that the applicant's intention was to obtain the protection of the subject matter of this claim. Thus, any omission from the description of the feature that is the subject matter of the disputed claim shall be clearly deemed to be the result of an error. There are two possible scenarios:

- If no elements of the patent application (description, drawings) contradict the wording of the disputed claim:

the applicant may delete the feature in question from the claim, he/she may also insert it in the description in the context of a request to correct a material error (see Section C, Chapter X); as a matter of fact, such a correction of the description is obvious.

- If an element of the patent application contradicts the wording of the disputed claim:

such correction is not obvious as it is not the only possible solution: the error may have been made in the claim or in the other element of the patent application.
In the absence of any other evidence (see Section C, Chapter X), the correction of the error shall not be granted and the claim must be amended.

(b) Claims submitted after the date of filing the patent application

Such claims must be supported by the original description supplemented, where appropriate, by drawings (see Section C, Chapter IV, point 1.4 above).

No new matter may be introduced either in the description or in the claims. Technical features described only in the priority documents and/or any document cited in the description may not support the claims.

Art. L.613-25

A patent whose subject matter extends beyond the content of the initial application may be declared invalid by the court.

In a patent concerning a decorative heating element, the Paris Court of Appeal considered that the replacement of the expression "heating fluid" by "heating source" in the final claims extended the subject matter of said claims beyond the content of the description supplemented by the drawings (see Section C, Chapter IV, point 1.4 above).

Similarly, the deletion from an independent claim of a technical feature that is consistently presented in the description as an essential feature of the invention shall not be permissible.

Such deletion shall constitute a generalisation of the invention and thus an extension of the subject matter of the claims, not supported by the description.

VAN DER LELY
Court of Cassation
18/10/1994
PIBD 579-III-2

In a patent for a machine designed to move plants lying on the ground, all of the examples mentioned in the description refer to rake members having a flexible shield. The Court of Cassation held that the deletion of the mention of this flexible shield in the claims constituted an extension beyond the content of the description.

Paris Court of Appeal
24/01/1995
PIBD
585-III-173

In a patent concerning a baling process and a hay baler, an independent claim that failed to specify the existence of a device for detecting the pressure in the feed line to the baling chamber was found not to be supported by the description, which did not provide for a machine without such a detection device.

2. PROHIBITED MATTER

Art. R.612-4

The claims shall not contain any elements considered to be detrimental to human dignity, public policy or morality, disparaging statements or elements that are clearly irrelevant to the invention, as defined in Chapter II on the description (see Section C, Chapter II, points 2.1 to 2.3).

Art. L.612-1
Art. L.612-12, para. 1
Art. R.612-46

Where a claim contains such prohibited matter, a notification shall be sent to the applicant inviting him/her to remove such elements on pain of rejection of the claim. In the case of disparaging statements or elements that are clearly irrelevant to the invention, this notification may contain proposed amendments incorporating the necessary deletions. In this instance, the proposed amendments shall be deemed to have been accepted if the applicant does not contest them within the time limit provided.

3. FORMAL DEFICIENCIES

3.1. Provisions common to those applicable to the description

The provisions applicable to the description and relating to:

- foreign-language terms (see Section C, Chapter II, point 3.2)
- neologisms and fancy names (see Section C, Chapter II, points 3.3 and 3.4)
- personal names (see Section C, Chapter II, point 3.5)
- trademarks (see Section C, Chapter II, point 3.6)
- physical values and units of measurement (see Section C, Chapter II, point 3.7)
- typewritten elements (see Section C, Chapter II, point 3.10)
- page and line numbering (see Section C, Chapter II, points 3.11 and 3.12)

shall also apply to claims.

3.2. Specific provisions applicable to claims

(a) References to the description or drawings

Art. R.612-16

As regards the technical features of the invention, the claims shall not consist merely of references to the description or drawings. In particular, they shall not include references such as "as described in part ... of the description" or "as shown in Figure 2 of the drawings".

By way of exception, where an invention contains an element that cannot be defined in words or by a simple mathematical formula, but which can be represented graphically, the claims relating to that element may refer to the drawings concerned. This applies in particular where an element has a particular shape that is difficult to describe or where it consists of a chemical substance, certain characteristics of which can only be defined by means of a graph or diagram.

No citations of patents or documents shall be accepted in the claims. Claims shall not include references such as: "as described in patent X".

(b) Clarity of claims

Art. L.612-6
Art. L.612-1
Art. L.612-12, para. 1
Art. R.612-16

"The claims shall define the matter for which protection is sought. They must be clear." Their wording must not be contradictory or imprecise, in particular as regards any reference to other claims, a choice between several features or the exact scope of one of the features indicated.

- Contradictions:

The same claim may not contain two mutually exclusive features.

A dependent claim may not contain an additional feature that is incompatible with a feature of the claim to which it refers.

- Imprecise features:

Claims may not contain "run on" expressions such as: "etc.", "or the like", "about", unless they do not affect the precision of the technical features claimed. The examiner shall decide, on a case-by-case basis and relying on his/her technical knowledge, whether the meaning of the expression is sufficiently clear in the context.

An expression such as "notably" may not precede the characterising portion of a claim (e.g., "subject matter characterised notably by ..."). However, expressions like "preferably", "such as", "for example", "in particular" and "notably" may be tolerated where they precede an entirely optional passage, introduced by way of example, and where they do not have a limiting effect on the claim. Nevertheless, the accumulation of such expressions shall not be acceptable if it makes it difficult to understand the claim.

- Choice between several features:

A claim may provide for a choice between several different features, provided that they constitute alternatives and that they do not render the claim obscure or difficult to interpret on account of their number and/or method of presentation.

For example, in the field of chemistry, a formula with variable substituents may be accepted, provided it consists of a defined group.

If these conditions are not met, the claim shall be rejected due to lack of clarity. This may be the case in particular for:
- claims relating to both a combination of features, to those features taken individually and to sub-combinations of those features;
- claims accumulating the expressions "or" and "and/or"; this type of claim may also lack unity of invention (see Section C, Chapter VI).

- Incorrect references:

Claims must not contain incorrect references. For example:
- claims cannot contain references to themselves or to subsequent claims;
- dependent claims can only refer to previous claims of the same category;
- the technical features of the dependent claim must not be incompatible with the technical features of the claims to which it refers.

- Imprecise references:

Imprecise references, such as references covering a large number of possible combinations, shall not be accepted as they make it difficult to define the subject matter of the invention.

Furthermore, the use of expressions such as "notably", "preferably" and "in particular" to introduce a reference to a previous claim (e.g., "subject matter according to, notably, claim x") may also result in lack of unity of invention (see Section C, Chapter VI).

Art. L.612-6
Art. L.612-1
Art.L.612-12, para. 1

(c) Conciseness of claims
The conciseness requirement applies both to the claims as a whole and to each individual claim. The number of claims must be reasonable in view of the nature of the invention. An unnecessary number of independent claims should be avoided. Unnecessary repetition in two independent claims may be deleted by drafting a dependent claim.

(d) Drawings and tables
The claims and the description may contain chemical or mathematical formulae and tables, but not drawings.

In the case of tables, the subject matter of the claims must demonstrate their relevance: the tables must contribute to the understanding of the claims, on pain of rejection of the latter.

To ensure they are processed, the specific semantic tags, details of which are provided in the table in the appendix, must be included in the application documents.

(e) Numbering of claims
"Where there is more than one claim, they must be numbered consecutively in Arabic numerals."

(f) Reference signs to drawings
"If the patent application contains drawings, the technical features mentioned in the claims shall, in principle, be followed by the reference signs (placed in brackets) appearing in the corresponding parts of the drawings, where this would make it easier to understand the claim." Such references may appear both in the preamble and in the characterising portion of the claims.

Example:
Device for breaking the tips of ampoules containing a liquid, characterised in that it comprises a casing **(1)** with an opening into which the tip of the ampoule **(3)** is to be inserted, and a lever **(4)**.

These references do not limit the scope of the protection being sought; they merely serve as points of reference intended to facilitate the understanding of the subject matter of the application.

(g) Page numbering
For applications filed before 19 November 2018, "the pages of the description and claims must be numbered consecutively in Arabic numerals". Sub-numbering of pages (e.g., "1a", "1b", etc.) shall not be accepted. The numbering of the claim pages shall continue on from the numbering of the description pages.

4. OBVIOUS ERRORS

If the examiner finds an obvious error in the claims submitted, depending on the significance of the error, he/she may:

Art. R.612-36

(a) notify the applicant of the error found and request that he/she submit a request to correct it. Such notification shall not entail any obligation to reply (see Section C, Chapter X);

Art. L.612-6
Art. L.612-1
Art. L.612-12, para. 1

(b) order, on pain of rejection, correction of the error if it is detrimental to the clarity of the claims (e.g.: an obviously incorrect reference to another claim); or

Art. L.612-12, para. 6

(c) notify the applicant that the claims do not allow for the search report to be drawn up (see Section C, Chapter IV, point 1.3); such notification may lead to the rejection of the entire patent application.

5. AMENDMENT OF THE CLAIMS

If amendments are made to the claims over the course of the procedure, the amended claims, together with the description, the title of the invention, the abstract and, where applicable, the drawings and figure accompanying the abstract shall be filed in a single document in Open XML (.docx) format.
To ensure these changes are processed, the specific semantic tags, details of which are provided in the user guide, available at https://procedures.inpi.fr and in the appendix to this Section, must be included in the application documents.

For applications filed before 19 November 2018, however, it is possible to provide only all of the claims in a single document.

The INPI may request the amendment of claims by means of a notification of deficiencies. The amendment of the claims must then be made within the time limit specified by the INPI.

Amendments may also be made in the context of a request to correct a material error, if the necessary conditions are met (see Section C, Chapter X).

In addition to these cases, the applicant may also, at his/her own initiative, file new claims, subject to the following conditions:

5.1. Time frame for making amendments

Art. L.612-13, para. 2

The applicant may file new claims only at certain stages of the procedure, depending on whether the application is for a utility certificate or a patent.

(a) Applications for utility certificates
Claims may be amended up to the date of payment of the fee for the grant of the utility certificate.

(b) Patent applications
Claims may be amended:

Art. L.612-13, para. 1

- from the date on which the application is filed up to the date on which the documentary search commences;

Art. R.612-59
Art. R.612-65

- within a period of three months, which may be renewed once, from the date of receipt of the preliminary search report and, where applicable, the supplementary preliminary search report (see Section C, Chapter VIII);

Art. R.612-64

- where applicable, within a period of three months, which may be renewed once, from the date of receipt of the notification of third-party observations (see Chapter IX);

Art. R.612-34

- up to the date of payment of the fee for the grant of the initial application, in the case of a division of the application at the applicant's own initiative (see Section C, Chapter VI).

In all instances where the time limit for reply is renewable, such renewal must be requested **before** the expiry of the first time limit.

5.2. Fees

Art. R. 411-17

A claim fee must be paid for any claim from the eleventh claim onwards, either at the time of first filing or at the time of subsequent amendments resulting in an increase in the number of claims beyond ten. No refund shall be possible in the event of a reduction in the number of claims.

5.3. Examination of the compliance of new claims

Any new set of claims must be examined to ensure that it meets the general compliance requirements (form, support in description, unity of invention, patentability criteria examined by the INPI).

Art. R.612-37

Where a notification of deficiency is sent to the applicant outside the time limits within which he/she may, at his/her own initiative, amend the claims (see Section C, Chapter IV, point 5.1), the claims may be amended only to the extent necessary to remedy the deficiency found. If the claims have been amended beyond the necessary extent, a notification shall be sent to the applicant indicating that the amendments will not be accepted.

Apart from the correction of material errors, any new claims submitted by the applicant at his/her own initiative, with the exception of those submitted under the circumstances and within the time limits specified in point 5.1, shall not be taken into account.

CHAPTER V - THE ABSTRACT

Art. R.612-20

The abstract summarises the technical content of the invention. It plays a very important role in terms of documentation, but has no legal value, particularly in assessing the scope of the IP right being sought.

Art. R. 612-3
Art. R. 612-46

The abstract is one of the documents contained in the patent application file. If the applicant does not provide an abstract, he/she will be notified of this deficiency and asked to provide one.

1. TEXT OF THE ABSTRACT

1.1. Content

"The abstract shall be drafted in such a way as to constitute an effective basis for selection in the technical field in question, in particular by making it possible to assess whether the patent application itself needs to be consulted."

"The abstract shall include a concise summary" indicating:

(a) the technical field of the invention
This indication is not necessary if the title of the invention is sufficiently precise.

b) the technical problem and the nature of **the solution** proposed by the invention.
This part must accurately reflect the invention by describing its main technical feature(s) and referring, where appropriate, to the drawing accompanying the abstract.

(c) the main use(s) of the invention
This clarification must be made if the applicant has provided examples of uses in the description.

Order on the procedure for filing applications

(d) Where applicable, the **chemical formula** that, among those included in the patent application, best characterises the invention.

The abstract shall not contain any elements that are not included in the description, nor "any statements relating to the alleged merits of the invention".

1.2. Length of the abstract

Art. R.612-20

The abstract shall not exceed one hundred and fifty words (18 lines of 50 characters each, including spaces) if accompanied by a drawing or two hundred and fifty words (30 lines) where there is no drawing.

The purpose of this limitation in terms of length is to allow for the publication of the abstract in the Official Bulletin of Industrial Property (BOPI) on a half page, accompanied by its drawing under a heading comprising:

- the publication and filing numbers,
- the filing date,
- the IPC classification with all the relevant classes,
- the name(s) of the inventor(s),
- the name(s) of the applicant(s),
- where applicable, the name of the representative,
- where applicable, the priority statements,
- where applicable, the conversion and divisional application references.

The abstract shall also be printed with its drawing on the lower third of the front page of the patent specification document.

1.3. Reference signs

If the abstract is accompanied by one or more drawings, each of the main features mentioned in the text of the abstract and illustrated by the drawing(s) shall be followed by a reference sign written in brackets.

Reference signs in the text must match those on the drawing(s) and vice versa: reference signs not appearing on the drawing(s) must be removed from the text or added to the drawing(s).

2. DRAWINGS

If the patent includes drawings, the applicant shall designate the figure among the drawings that he/she wishes to be published alongside the abstract. Failing this, a notice of deficiency shall be sent to the applicant.

The drawing contained in the abstract must match the invention and not represent prior art.

The INPI may decide to publish a figure other than the one proposed by the applicant if it considers that it reflects the invention more accurately.

The figure accompanying the abstract may not consist of a computer program (lines of code).

3. AMENDMENT OF THE ABSTRACT

Art. R.612-20

The abstract must be amended if it is the subject of a notice of deficiencies. The final content of the abstract may, if necessary, be established by the INPI, in particular if no correction is made within the time limit specified by the notification.

Aside from corrections made in response to notices of deficiencies, the abstract may be amended at the initiative of the applicant up to the date of publication of the application (see Section D), on condition that such amendment constitutes an improvement and that the content thereof does not extend beyond the scope of the description.

If changes are made to the abstract over the course of the application procedure, the amended abstract, together with the description, the claims, the title of the invention and, where applicable, the drawings and figure accompanying the abstract, shall be filed in a single document in Open XML (.docx) format.
To ensure these changes are processed, the specific semantic tags, details of which are provided in the user guide, available at https://procedures.inpi.fr and in the appendix to this Section, must be included in the application documents.

For applications filed before 19 November 2018, however, it is possible to provide only the full abstract in a single document.

Table of tags and alternatives for documents filed in Open XML (.docx) format

Tags	Authorised alternatives
Description	Description of the invention
Title:	Title of the invention:
Claims	Claim
Abstract	Abstract
[Table 1]	[Table 1], [Tables 1]
[Chem. 1]	[Chem.1], [chem1], [chem.1]
[Math. 1]	[Math.1], [math1], [math.1]
[Fig. 1]	[Fig. 1], [Figure 1], [fig. 1], [fig 1] , [figure 1]
Technical field	Technical field of the invention Field of the invention
Prior art	Technical background Technological background Background art State of the art
Disclosure of the invention Technical problem Technical solution Advantages provided	Presentation of the invention Solution to the problem
Summary of the invention	
Short description of the drawings	Short description of the figures Presentation of the drawings Presentation of the figures Description of the drawings Description of the figures Figures
Detailed description	Description of embodiments Detailed description of the invention
Example	Examples
Best way of carrying out the invention	
List of reference signs	
Reference to deposited biological material	Reference to biological material
List of cited documents Patent literature Patent documents Non-patent literature	References
Sequence listing free text	Sequence listing

CHAPTER VI - UNITY OF INVENTION - DIVISION OF A PATENT APPLICATION

A. Unity of Invention

1. GENERAL CRITERIA

Art. L.612-4, para. 1

"The patent application shall relate to one invention only or to a group of inventions related to each other in such a way that they form a single general inventive concept."

This requirement of unity of invention shall be deemed to be fulfilled when there is a common inventive problem or a common inventive solution.

The unity requirement is met where there is a technical relationship between the claimed inventions.

The technical relationship between the claimed inventions involves one or more special technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

2. BASIS FOR ASSESSING UNITY OF INVENTION

Unity of invention shall be assessed on the basis of the claims made in the patent application. Therefore, objections of lack of unity may not be made on the basis of the description and drawings.

In determining whether several inventions are so linked as to form a single common inventive concept, it is immaterial whether the inventions are the subject of separate claims or are presented as alternatives within a single claim.

Any objection of lack of unity must identify the different groups of inventions, indicating the claim numbers for each group.

Lack of unity may be apparent a priori or may become apparent a posteriori:

- A priori lack of unity is assessed by the examiner before the establishment of the preliminary search report, on the basis of the claims in the original filings or of any new set of claims filed by the applicant in the course of the procedure, taking into account the common general knowledge of the person skilled in the art and the prior art at hand.
- A posteriori lack of unity is apparent between or within claims without a common inventive concept, where documents identified during the search have made it possible to conclude that all or part of those claims lack novelty and/or inventive step in view of the preliminary search report. This information is communicated to the applicant at the same time as the preliminary search report.

3. ASSESSING UNITY OF INVENTION

The assessment of unity of invention is intended to determine whether the subject-matter of the claims has features in common that form a single common inventive concept.

The examiner must give reasons for any finding of lack of unity of invention after identifying the different groups of inventions, by presenting the common subject-matter or, where appropriate, justifying the absence of common subject-matter between those different groups of inventions.

If common subject-matter has been identified, it must be compared with the prior art at hand in order to determine whether that common subject-matter makes a contribution over that prior art.

The prior art on which the assessment of lack of unity is based may vary depending on the stage of the procedure:

- If the assessment is carried out before the search, the only "prior art at hand" may consist of the common general knowledge of the person skilled in the art and/or the prior art mentioned in the description. It is also possible that no prior art is available at this stage of the procedure.
- If the assessment is carried out during or after the search, other prior art may be identified and may constitute the prior art at hand for assessing lack of unity.

The comparison with the prior art at hand must establish that the features identified as forming part of the common subject-matter do not make a contribution over the prior art at hand.

Where prior art has been taken into consideration, the examiner must identify that prior art in the objection.

The examiner must analyse the remaining technical features which do not form part of the identified common subject-matter and explain why there is no common technical relationship between the groups of inventions, where appropriate by highlighting the differences between the remaining technical features in view of the technical effects achieved or the technical problems solved by those remaining features.

Furthermore, unity of invention is assessed taking into account the different categories of claims and their dependency relationships.

3.1. Independent claims

Art. R.612-17, para. 1

"A patent application may only contain more than one independent claim of the same category (product, process, device or use) if the subject matter of the application relates to:

(a) several products that are interrelated;

(b) different uses of a product or device;

(c) alternative solutions to a particular problem to the extent that such alternatives cannot be adequately covered by a single claim."

Art. R.612-19

"In particular, the following may be included in the same patent application:

(1) An independent claim for a product, an independent claim for a process specifically designed for the manufacture of said product, and an independent claim for a use of the product;

(2) An independent claim for a process and an independent claim for a device or means specifically designed for carrying out said process;

(3) An independent claim for a product, an independent claim for a process specifically designed for the manufacture of said product, and an independent claim for a device or means specifically designed for carrying out said process."

A single patent application may, therefore, contain several independent claims of the same category and several independent claims of different categories.
The independent claims must be related to each other by way of a common inventive concept.
Therefore, in order to determine whether there is a lack of unity between independent claims, the examiner checks whether there is an actual technical relationship between them.
It should be noted that the existence of a common section, for example a common preamble among independent claims of the same category, is not sufficient in itself to establish unity of invention. The same applies to a common objective or outcome, which does not in itself prove unity of invention.
In points (1) and (3) of Article R.612-19, the relationship between the product and the process is determined on the basis of whether the process has been "specifically designed for the manufacture" of the product. Similarly, in points (2) and (3) of the same Article, the device or system for which protection is being claimed must be "specifically designed for carrying out" the process. An objection of lack of unity shall be raised in the case of a process claim and a device claim unrelated to the process claim if the device is suitable for carrying out processes different from the one claimed.

Examples

Some examples of possible situations are set out below, but these examples are by no means exhaustive:

- Multiple devices that may be operated together

An objection of lack of unity shall be raised if the devices in question are claimed as being also capable of operating independently of each other.

For example: an application relating to a seed drill and a distribution component, where it is stated that the seed drill can operate with any kind of distribution component and that the distribution component claimed is not specifically designed for the drill in question.

- Multiple improvements made to a device

An objection of lack of unity shall be raised in respect of independent claims for devices having almost identical preambles, but where the characterising portion of each claim relates to improvements made to different parts of the device, resulting in protection being sought for each of the individual improvements separately.
For example: an application relating to a tedder, in which the three improved elements operate simultaneously, but do not contribute to the same action, in which case the improvements would not involve any technical interaction.

There shall be no grounds for raising an objection of lack of unity if the claimed subject matters constitute variations of the same product and all of the independent claims contain the features considered essential to the invention, either in identical form or in an equivalent form.
For example: an application concerning two photographic lenses, the components of which have different numerical values, if there is a high degree of similarity between the two lenses and if, in both cases, an attempt has been made to solve the same problem.

- Multiple compounds

An objection of lack of unity shall be raised if the various compounds do not have a sufficiently similar structure.

There shall be no grounds for raising an objection if:
the various compounds have a common basic structure and are obtained via the same preparation process;
a functional relationship exists between the various compounds, for example, a radical responsible for the desired effect;
the main claim includes, in a single formula, all of the compounds having the same use;
the structure of the intermediate product and the final product is sufficiently similar to conclude that the intermediate product has been specifically designed for the sole purpose of carrying out the process for the manufacture of the final product.

- Multiple products, one use

There shall be no grounds for raising an objection of lack of unity where several products are claimed and the use concerns only some of them.

Similarly, it shall be permissible to claim use of a family of products or only some of the products of that family.

- Multiple processes

An objection of lack of unity shall be raised if:
the different processes are not technically related to each other bar the fact that they share a common purpose. For example: wastewater treatment processes where there are as many solutions claimed as there are types of wastewater treated.
the only link between the different manufacturing processes is the unclaimed manufactured product. The product cannot constitute proof of the unity of the processes since it is separate from the invention.

- Process for the preparation of a product and use of the product, where the product itself is not claimed

An objection of lack of unity shall be raised if, in the claim for use, the relationship between the product and its preparation process is not indicated: the product is not the only one obtained by way of the claimed preparation process.

3.2. Individual claims

The provisions concerning unity of invention shall also apply to individual claims. An objection of lack of unity shall therefore be raised if, within an individual claim, several ways of carrying out the invention do not correspond to a single general inventive concept.

3.3. Dependent claims

There shall be no grounds for raising an objection of lack of unity where several claims are dependent on the same main claim, but independent of each other.

3.4. Referring claims

Claims are said to be referring claims when they are of different categories and refer to each other.
An objection of lack of unity shall be made where the reference is purely formal and technically incorrect or imprecise.

B. DIVISION OF AN APPLICATION (see Section B, Chapter III and Section D)

Art. L.612-4, para. 2
Art. L.612-12 (2)
Art. R.612-33

Any application that does not satisfy the requirement of unity of invention must be divided or limited to a single inventive concept, on pain of rejection.

Art. R.612-34

The applicant may choose to divide the application of his/her own accord, up until the date of payment of the fee for the grant of the initial application.

Divisional applications shall be entitled to retain the filing date and, where applicable, the priority date of the **initial application** or the earliest date available to the **initial application**.

The initial application may be an application for a patent or utility certificate. An application of a given category may only give rise to divisional applications of the same category.

Each of the divisional applications, including the initial application, may be redivided up until the date of payment of the fee for the grant of the **initial application**, provided that the scope of its subject matter does not extend beyond the content of the **initial application**.

- Content of each divisional application

Art. R.612-35, para. 2

"The applicant may choose to:
reiterate, in each divisional application, the contents of the initial application, unless he/she chooses to restrict the claims to the subject matter of the divisional application alone; or

restrict the description, claims and drawings of each divisional application to its subject matter alone, in which case, they shall only contain–aside from the text, claims and figures extracted respectively from the description, claims and drawings of the initial application–the connecting and explanatory sentences necessary for the clarity of the explanation."

The file for each divisional application shall be compiled using the file for the initial application subject to the above provisions.
Hence, following its division, the initial application shall be referred to as the "first divisional application".

In practice, the following rules shall be applicable to:

- The description and drawings

Art. L.612-12 (3)
Art. R.612-47

If certain paragraphs of the description or elements of the drawings were not included in the initial application, the applicant shall be invited to delete them from the divisional application, on pain of rejection of the latter. In particular, the applicant shall not be permitted to add or amend paragraphs in order to incorporate the new claims directly in the text of the description.
In the event of limitation of the description of the first divisional application, the entire description of the initial application shall be published; the limited description shall only be published upon the grant of the first divisional application.

- The claims

The scope of the claims of each divisional application shall not extend beyond the scope of the description and drawings contained in the initial application.

In addition, the following rules shall apply to claims, depending on the time of division:

(a) Division of an application within the time limit provided for filing new claims under the initial application at the applicant's own initiative (see Chapter IV, point 5.1)

Art. L.612-12 (3)
Art. R.612-47

Under such circumstances, it is not necessary for the claims of each divisional application to be included among the claims of the initial application. They may be amended with respect to the claims of the initial application and may contain

elements that were not initially claimed provided that they do not extend beyond the scope of the initial application.

In the case of the voluntary division of an application, the claims of the first divisional application may be identical to those of the initial application and the claims of the other divisional applications may be based on elements that were not included in the initial application.

(b) Division of an application outside the time limit provided for filing new claims under the initial application at the applicant's own initiative (see Chapter IV, point 5.1)

Art. L.612-12, para. 1
Art. R.612-35, para. 2
Art. R. 612-46

In this case, the claims of the first divisional application (corresponding to the initial application after division) must all be based on the most recently filed claims of the initial application. Consequently, the applicant may only delete or limit some of the claims of the initial application, e.g., by linking them to earlier claims.
For subsequent divisional applications, the claims may contain elements not claimed in the first divisional application provided that they do not extend beyond the scope of the initial application.

Art. L.611-10

"(1) **New inventions** involving an **inventive step** and capable of **industrial application** shall be patentable in all fields of technology.

(2) The following in particular shall not be regarded as inventions within the meaning of the first paragraph of this Article:

(a) discoveries, scientific theories and mathematical methods;
(b) aesthetic creations;
(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
(d) presentations of information.

(3) The provisions of paragraph (2) of this Article shall only exclude the patentability of the elements listed in said provisions if the patent application or the patent in question only concerns one of those elements as such".

(4) Subject to the provisions of Articles L.611-16 to L.611-19, inventions relating to a product consisting, in whole or in part, of biological material, or to a process for producing, processing or using biological material, shall be patentable under the conditions laid down in paragraph (1).
Any material containing genetic information and capable of reproducing itself or being reproduced in a biological system shall be regarded as a biological material."

Art. L.611-16

"Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be patentable. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods."

Art. L.611-17

"Inventions shall not be patentable if their commercial exploitation would be contrary to human dignity, public policy or morality; however, the mere fact that such exploitation is prohibited by law or regulation shall not be deemed contrary in itself".

Art. L.611-18

"The human body, at the various stages of its formation and development, or the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

Only an invention constituting the technical application of a function of an element of the human body may be protected by a patent. Such protection shall cover the element of the human body only to the extent necessary for the realisation and exploitation of that particular application. The latter must be disclosed in a concrete and precise manner in the patent application.
In particular, the following shall not be patentable:

a) processes for cloning human beings;
b) processes for modifying the genetic identity of human beings;
c) uses of human embryos for industrial or commercial purposes;
d) sequences or partial sequences of a gene as such."

Art. L.611-19

"I. The following shall not be patentable:

1. Animal varieties;
2. Plant varieties as defined in Article 5 of Council Regulation (EC) No. 2100/94 on Community plant variety rights;

3. Essentially biological processes for the production of plants and animals; shall be considered to be processes based exclusively on natural phenomena such as crossing or selection;
3bis. Products exclusively obtained by means of essentially biological processes as defined in 3a above, including the elements of such products and the genetic information they contain;
4. Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

II. Notwithstanding the provisions of (I) above, inventions relating to plants or animals shall be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.
III. The provisions of (I) paragraph (3) shall not affect the patentability of inventions having as their subject matter a technical process, in particular a microbiological process, or a product obtained by means of such a process; any process involving or performed upon or resulting in biological material shall be regarded as a microbiological process."

For patent applications with a filing date prior to 22 May 2020,

Art. L.612-12 amended by Act no. 2008-776 of 4 August 2008 (Article 132)

Clear non-compliance with the patentability requirements may lead to the rejection of the patent application in the following circumstances:

"A patent application shall be rejected, in whole or in part, if:
4. it concerns an invention that is clearly not patentable pursuant to Articles L.611-16 to L.611-19;
5. its subject matter clearly cannot be considered an invention within the meaning of the second paragraph of Article L.611-10;
7. it has not been amended following a formal notice, even though the search report clearly indicated a lack of novelty."

For patent applications filed on or after 22 May 2020,

Art. L.612-12 amended by Act no. 2019-486 of 22 May 2019 (Article 122), i.e. the "Business Growth and Transformation Action Plan" (PACTE)

Non-compliance with the patentability requirements may lead to the rejection of the patent application in the following circumstances:

"A patent application shall be rejected, in whole or in part, if:
4. it concerns an invention that is not patentable pursuant to Articles L.611-16 to L.611-19;
5. its subject matter cannot be considered an invention within the meaning of the second paragraph of Article L.611-10;
7. its subject matter is not patentable pursuant to the first paragraph of Article L.611-10."

Non-compliance with the patentability requirements may lead to the patent being invalidated by the Courts.

1. INVENTIONS

Art. L.611-10, para. 2

The French Intellectual Property Code does not provide a definition of what constitutes an "invention", but Article L.611-10, paragraph 2, contains a non-exhaustive list of what shall not be deemed to constitute an invention.

The invention must have technical character; it must provide a solution showing technical features to a technical problem. It must therefore possess technical features, set out in the form of claims defining the subject matter for which protection

is sought (see Chapter IV). The condition relating to its "technical character" may be decisive in determining whether an invention should be excluded from patentability within the meaning of Article L.611-10, para. 2.

Art. L.611-10, para. 3

Exclusion from patentability shall apply only where the application relates solely to the element or the areas of activity that are excluded as such.

Art. L.612-12 (5) of the IPC, amended by Act no. 2008-776 of 4 August 2008 (Article 132)

For patent applications with a filing date prior to 22 May 2020,

the rejection of a patent application on such ground (exclusion from patentability) may be declared when the subject matter of the patent application clearly cannot be regarded as an invention.

Art. L.612-12 (5) of the IPC, amended by Act no. 2019-486 of 22 May 2019 (Article 122), i.e. the "Business Growth and Transformation Action Plan" (PACTE)

For patent applications filed on or after 22 May 2020,

the rejection of a patent application on such ground (exclusion from patentability) may be declared when the subject matter of the patent application cannot be regarded as an invention.

Art. R.612-16 to R.612-18

A dependent claim may not be rejected for lack of invention if it refers to a claim that complies with the invention requirement. However, this does not rule out the possibility of an objection for lack of additional technical features, which may result in partial rejection for failure to comply with the requirements of Articles R.612-16 to R.612-18 of the French Intellectual Property Code.

Art. L.613-25

In any event, exclusion from patentability may constitute a ground for bringing an action for invalidity of the patent before the Courts.

Art. L.613-23 (1) of IPC amended by Ordinance no. 2020-116 of 12 February 2020

Exclusion from patentability shall constitute a ground for an opposition to the patent with the INPI, once the patent has been granted (for patents granted from 1 April 2020 onwards).

1.1. Discoveries

Art. L.611-10 (2a)

The discovery of a new property of a known material or object shall not be patentable. However, if a person uses this property for practical purposes, he or she can create a potentially patentable invention. Thus, for example, the discovery of the mechanical shock resistance of a known material shall not be patentable, but a railway sleeper made of such material may be patentable. The finding of a substance in nature shall be regarded as a mere discovery and its subject matter shall therefore not be patentable. However, if a new substance is found in nature and a process is developed to obtain it, that process shall be patentable. In addition, if the substance can be adequately characterised by its structure, by the process used to obtain it, or by any other factor, and if it is "new" in the sense that its existence has not been previously recognised, it may also be considered patentable as such.

Art. L.611-10 (2a)

1.2. Scientific theories

A scientific theory cannot be patented. On the other hand, the practical application of a scientific theory in a new product or process can be patented.

For example, the physical theory of semi-conductivity is not patentable, but semiconductor devices and their manufacturing processes may be.

The product or process must be sufficiently technically characterised and its description must not be limited to a list of general properties or steps of a theoretical nature.

For example, a process for placing satellites and spacecraft in orbit was considered unpatentable, as no details were provided as to the specific features allowing for the process to be carried out.

Art. L.611-10 (2a)

1.3. Mathematical methods

A mathematical method claimed as such provides a unique illustration of the principle according to which a purely abstract or theoretical method cannot be considered an invention within the meaning of Article L.611-10, paras. 2 and 3.

A mathematical method shall be regarded as such where it does not serve a technical purpose or where the technical implementation claimed remains generic. Thus, the mere fact of automating the mathematical method by generic computer-based means shall not result in conferring a technical character to such a method. Similarly, specifying that data or parameters of a mathematical method are of a technical nature shall not necessarily be sufficient to confer a technical character to such a method.

For illustrative purposes, the following were not considered to be patentable:

- a process and apparatus for generating mathematical function values by using iterative interpolation processes, where the "means" mentioned for the apparatus consisted solely of statements that did not mention any specific material structure;
- a computer processing method comprising a step for calculating an indicator vector, where the latter consisted of a combination of variables for determining the attitude of a potential entrepreneur to risk associated with a loan from a financial institution.

A mathematical method shall not be regarded as such if it serves a technical purpose, i.e., if it presents a technical solution to a technical problem. To this end, the subject matter claimed must be limited to that technical purpose and a sufficiently strong link must be established between that technical purpose and the steps of the mathematical method.

For illustrative purposes, the following methods were considered to have a technical purpose:

- a method for encrypting, decrypting or signing electronic communications, such as a method for securing information exchanged in messages by means of elliptic curve points;
- a method for analysing audio signals or digital images/videos, such as a method for cancelling out noise or for detecting people in a digital image;
- a method for controlling a system, such as controlling the trajectory of an autonomous vehicle in a lane of traffic.

Furthermore, if the claim relates to a specific technical implementation of the mathematical method, designed on the basis of technical considerations relating to the internal functioning of a computer, it shall be regarded as technical (for example: a method for optimising memory by means of an algorithm).

1.3.1 Modelling, simulation or design

Modelling, simulation and design methods shall be considered to be mathematical methods as such if the subject matter claimed, taken as a whole, relates to a purely abstract or theoretical method. In such cases, the subject matter of the application cannot be regarded as an invention within the meaning of Article L.611-10, paras. 2 and 3. In this respect, point 1.3 on mathematical methods shall apply.

(a) Modelling

The modelling of an object such as a product, system or process consists in representing that object by way of another, which is easier to understand. It can be of a mathematical or physical nature. If the model claimed is of an abstract nature (e.g., a series of equations), the modelling is not considered to produce a technical effect even if the product, system or process being modelled is of a technical nature.

(b) Computer-aided simulation

Computer-aided simulation is used to predict the behaviour of a modelled object. It is considered to serve a technical purpose if it is limited to a specific technical field, processes technical data and simulates a technical object. This is the case, for example, of a digital simulation of the behaviour of an electronic circuit subjected to pink noise.

By contrast, the simulation of non-technical processes such as a marketing campaign or a business plan for deliveries of goods does not constitute a technical purpose.

Moreover, the limitation of the technical field must be more specific than a generic limitation such as "simulation of a technical system". For example, a process for simulating "a physical phenomenon in a given environment", using a linear model that reduces the calculation time, which lacks any concrete technical application or technical characteristics related to a specific technical system, shall be deemed to have no technical purpose. In effect, this process can be applied to a physical or non-physical phenomenon, such as stock market values. The optimisation of the calculation time alone is not sufficient in itself to produce a technical character.

(c) Computer-aided design

Computer-aided design is the act of determining a parameter of a manufactured product or tool in order to produce it, by means of a computer and digital simulation. It shall be deemed to have a technical purpose if it determines a technical parameter intrinsically linked to the characteristics of a specific technical object (product, system or process) on the basis of technical considerations. For example, a method for determining the stiffness coefficient of the means for securing the support of a pendular damping device to a component of a vehicle propulsion unit was considered to have a technical purpose.
By contrast, a computer-aided method for the design of an optimum transport plan for a rail transport line with regard to various cost parameters and passenger demand was considered to have no technical purpose.
If the computer-aided design is conditional upon predominantly human intervention or is based on non-technical considerations, it shall not produce any technical effect.

1.3.2 Artificial intelligence

Artificial intelligence is the set of theories and techniques used to create computer programs, calculation models and algorithms that allow machines to reproduce a form of intelligence.

In recent years, artificial intelligence has almost always been associated with learning capabilities such as machine learning, which uses statistical methods to enable computers to learn from data.

Artificial intelligence, to the extent that it is based on computational models, is considered by definition to be a computer-implemented mathematical method which, when claimed as such, does not constitute an invention under Article L.611-10, paragraphs 2 and 3. In this respect, point 1.3 of this Chapter shall apply.

The use of expressions such as: "support vector machine (SVM)", "genetic algorithm", "artificial neural network (ANN)" or "automatic/deep learning" is not sufficient in itself to confer a technical character to the claimed subject matter.

The contribution to the technical character may be made, in particular, by introducing a technical solution to a technical problem by non-generic technical means or by processing measured technical data.

For example, artificial intelligence can be applied in a number of different areas, including:

- Computer vision, for the recognition, processing and/or classification of images and/or videos. The following, for example, are considered to be of a technical nature:
  - the recognition of the environment of an autonomous vehicle based on data obtained via sensors;
  - the use of artificial intelligence to analyse digital images in order to recognise an incident such as a tumour in a series of images or to detect movement within a video sequence.
- Speech recognition and/or human-machine dialogue For example, the use of artificial intelligence is considered technical when it is used to enable a dedicated robot to analyse human speech, with speech data being acquired via audio sensors and converted into language data via speech recognition software in order to determine and vary the robot's behaviour in terms of gestural and vocal output.

- Robotics and/or monitoring/control processes. The following, for example, are considered to be of a technical nature:

  - the real-time control of a drilling tool, based on physical properties measured in the drilling environment by training an ANN;
  - the classification of Internet Protocol (IP) traffic between nodes using machine learning to improve traffic management on the IP network.

- Predictive analysis: For example, a process using artificial intelligence to predict stock market prices has been found to be non-technical. However, the use of an ANN in a heart monitoring device to detect an irregular heartbeat was considered to be a technical contribution.

- Word processing: For example, the use of a tool to extract business-related keywords from content in order to enable their identification and indexing by means of artificial intelligence was found to be non-technical.

1.4. Aesthetic creations

Art. L.611-10 (2b)

A purely aesthetic creation is an object (e.g., a painting or sculpture) whose purpose is neither practical nor functional; its appreciation is essentially subjective. The protection of such creations is ensured by literary and artistic property rights (Part I of the French Intellectual Property Code) and by designs (Book V of Part II of the French Intellectual Property Code).
The aesthetic nature of an object alone is not patentable, for example:

- a book characterised by the aesthetic or artistic nature of its content or layout,
- a painting characterised by the artistic nature of its subject matter, the arrangement of its colours or its genre (e.g. impressionist);
- a decorative panel made from modular elements, comprising rows of tiles, where the invention does not relate to the tiles, which are not described, but to the arrangement of these tiles according to their colour;
- a camouflage-print fabric, where the invention consists only in giving a particular shape (specific to a brand/label) to the pattern on the camouflage fabric;
- a dressing characterised by the fact its colour matches the patient's skin colour.

Art. L.511-8 (1)

However, if a single object has both aesthetic features and technical/functional features, and if the aesthetic effect is inextricably linked to the technical features, that object can only be protected by a patent. This would be the case, for example, of:

- the tread of a tyre;
- a fabric with a specific texture and number of layers lending it an attractive appearance;
- a book characterised by a particular type of binding or spine gluing technique;
- a painting characterised by the type of canvas, pigments or binders used.

A process for producing an aesthetic creation may include a technical invention and thus be patentable. For example, a diamond may have a particularly attractive shape (not patentable in itself) resulting from the use of a new technical process. In this case, the process may be patentable, as well as the product obtained, i.e. the diamond with that particular shape, provided that it results from the use of said process.

1.5. Schemes, rules and methods

Art. L.611-10 (2c)

(a) For performing mental acts

Schemes, rules and methods that are purely mental in their realisation are not patentable. This would apply, for example, to a method for studying languages or a method for solving crossword puzzles. In keeping with this, the following were rejected:

- a patent application for a teaching method whereby a direct link is created between the pupil and the teacher by means of a recording attached to the usual homework assignment;

- a patent application relating to a teaching method consisting in visually presenting a technical subject by means of separate images or tapes.

Art. L.611-10 (2c)

(b) For playing games

In view of their abstract nature and the fact that they are defined by rules, games are not deemed to be patentable.

Where a claim relates to a game featuring physical elements, several cases can be distinguished:

- if the physical elements are defined only by their role in the course of the game, the claim shall be rejected on the basis that it relates to the rules of the game;

Art. R.612-17

- if the physical elements of the game appear only in the preamble of the claim, the characterising portion of which relates exclusively to the rules of the game, a notice of non-compliance with Article R.612-17 (absence of technical features in the characterising portion) shall be sent to the applicant.

- if the physical elements of the game present technical features that are independent of the rules, the claim shall be admissible.

(c) for doing business

Art. L.611-10 (2c)

Schemes, principles and methods for doing business shall not be regarded as inventions in themselves. The mere fact that the method is implemented by computer means, in particular software, shall not be sufficient for it to be considered a patentable invention, irrespective of whether the claims of the application relate to a device or a process.

Solving an economic problem by implementing a solution that is not of a technical nature cannot be regarded as a patentable invention.

Decision of the Paris Court of Appeal Sagem of 24 January 2003

For example, a patent application for a "method of ordering products online from a sales centre" was rejected on the grounds that the method was not intended to achieve a "technical effect", but only to enable a commercial transaction, which is not patentable in itself. The Court of Appeal stressed the fact that "the use of technical means for exclusively non-technical purposes and/or to process information that is inherently non-technical does not necessarily confer a technical character to each step of the method or to the method as a whole".

Thus, the use of non-specific technical means, which are not characterised by their technical nature, but simply by the fact that they are used to process non-technical data or are implemented for non-technical purposes, does not confer a technical character to the method.

Decision of the Paris Court of Appeal Cotranex of 15 March 2006

A patent application was rejected on the same grounds for a method allowing (i) insurance companies to verify the use made by insured parties of compensation paid out under claims and (ii) insured parties to acquire a replacement for their lost/damaged property.

Decision of the Rennes Court of Appeal Antionietti of 7 October 2003

Also rejected was a patent application for a "device for the long-term processing and management of data likely to be used on an online brokerage site" and a "computer system enabling an offer to be attributed to the highest bidder", on the grounds that the device/system involved was not described in technical terms, but only by referring to the means involved in the various stages of the business method.

Business transaction schemes, accounting methods and management methods are also not patentable. For example, a patent application for an accounting method used to calculate the maximum price for the construction of a house, taking into account the applicants' ability to pay, was rejected on the grounds that it did not mention any physical element.

Also rejected were two separate patent applications relating to a physical element consisting of a sheet of paper characterised by different entries or data for implementing a management or accounting method. For example:

- a form facilitating the management of inventories of goods, characterised by the positioning of the headings: date, price, number of items, etc.;
- a special printout for the payment of invoices and debts characterised by mention of the instructions necessary for the execution of payment orders;
- a security certificate for two share classes: it was considered that, by way of the various mentions and inscriptions chosen, the applicant was in fact seeking protection for the use of his/her certificate in relation to the management method of the securities in question, and that this method constituted the actual subject matter of the application;

- a method of personnel management requiring the use of accounting records defined by their method of use and by the information contained therein.

1.6. Computer Programs

(a) Definitions

Order of 22 December 1981 on the Expansion of Computer Science Vocabulary

Software is the set of programs, processes, and rules - and, where applicable, documentation - related to the operation of a data-processing system.

A computer program is a set of instructions that, once stored on a computer-readable medium, can cause a computer to perform a function, carry out a task, or produce a specific result when the program is executed by a computer.

Toulouse Court of Appeal, 9 October 2007, 05/02806

Preliminary design material is defined as preparatory design work that leads to the development of a program, provided that it is of a nature that enables the creation of a computer program at a later stage. This design material does not include the specifications.

A computer-implemented invention may be protected by claims that involve computers, computer networks, or other programmable devices in which at least one feature is implemented by means of a computer program.

An application relating to a computer-implemented invention may include various categories of claims, including:
- a computer-implemented process;
- a computer program used to implement a process.

A distinction is made between a claim relating to a computer-implemented process that is actually executed by a computer and a claim relating to a computer program that consists of a sequence of instructions that can be executed by a computer.

(b) Exclusion from patentability

Art. L. 112-2 (13)

Software, including preliminary design material, is considered an intellectual work and may be protected by copyright.

Computer programs as such are not considered patentable inventions.

Art. L. 611-10 (2) and (3)

However, this exclusion does not apply to computer programs with technical character - that is, capable of producing a *further technical effect* when implemented on a computer.

A "further technical effect" refers to a technical effect that goes beyond the *normal physical interactions* between the program (software) and the computer (hardware) on which it is executed. The claim must state all of the features necessary to achieve this *further technical effect*.

"Normal physical interactions" refer to the physical effects inherent in the execution of a program, such as the flow of electric current inside the computer. These effects alone cannot confer technical character to a computer program.

A computer program may therefore be eligible for patent protection provided that it produces a *further technical effect*.

The presence or absence of a *further technical effect* is assessed without taking the prior art into consideration.

(i) Absence of a *further technical effect*

The mere fact that a computer program enables a process to be executed automatically by a computer is not sufficient to confer a *further technical effect* on it.

Optimising computation time alone is also not enough to confer a *further technical effect*. Thus, the mere fact that a computer program enables the optimisation of computation time does not, in itself, establish the existence of a further technical effect in that computer program.

Furthermore, comparing how a computer program and a human being would perform the same task is not a valid criterion for determining whether the computer program provides a *further technical effect*.

Furthermore, programming—in the sense of writing lines of code - is an intellectual, non-technical activity. For example, defining and providing a programming language does not in itself solve a technical problem, even if its specific syntax and semantics make the programmer's job easier. Reducing the programmer's intellectual effort is not, in itself, a technical effect.

(ii) Presence of a *further technical effect*

A *further technical effect* may be achieved through the computer-implemented technical process or through the computer program's impact on the computer's internal functioning.

- Technical character resulting from the process implemented by the computer

The implementation of a technical process - that is, a process comprising technical steps or features - by a computer, may confer a technical character.

For example, a computer program that implements a process designed to do the following may, in particular, produce a further technical effect:
- control an anti-lock braking system,
- control an industrial process,
- detect emissions using an X-ray machine,
- compress videos,
- process a digital image,
- encrypt electronic communications, or
- measure a patient's eye convergence.

- Technical character stemming from the computer's internal functioning

A computer program that is designed based on specific technical considerations relating to the internal functioning of the computer on which it is to be executed - for example, when the program is tailored to the computer's architecture - may produce a further technical effect.

For example, a computer program that does the following may produce a *further technical effect*:
- optimises processor load balancing,
- improves memory allocation,
- increases the data transfer rate in a communication link,
- implements security measures designed to protect the integrity of the boot sequence, or
- implements IT security countermeasures to combat cyberattacks.

(c) Claims relating to a computer program

(i) Categories of claims relating to a computer program

In a computer-implemented invention, the set of claims generally begins with a computer-implemented process claim.

To further protect the invention, it is possible to add one or more claims relating to a computer program that implements the process.

Art. R. 612-18

A claim relating to a computer program falls under the *"product"* category, while the corresponding process claim falls under the *"process"* category (see Chapter IV, section 1.2 (a)).

(ii) Patentable inventions

Computer programs as such are excluded from patentability under Article L. 611-10 (2) and (3) of the IPC.

Nevertheless, claims relating to a computer program are not excluded from patentability if they meet two cumulative conditions:

- The claim relating to a computer program pertains to a claimed technical process, either by reference to the process claim or by listing the steps of said process,
- The claim relating to a computer program refers to a physical aspect associated with a computer element in order to exclude lines of code. Physicality may be provided by a storage medium containing the computer program or by a computer processing system capable of executing the computer program and, consequently, of carrying out the steps of the process.

Art. R. 612-13

It should be noted that short excerpts from computer programs written in common programming languages should not be included in the claims relating to a computer program, but may be attached as an appendix at the end of the description (see Chapter II, section 1).

(iii) Suggested wording

There are generally two types of claims relating to a computer program:

- Computer program [product] claim;
- Program storage medium claim.

- Computer program [product] claims

A computer program [product] claim must include evidence of physicality (see paragraph (ii) "Patentable inventions" above) and must therefore include at least one of the following:

- Execution on a computer;
- Loading into a computer's memory or from a telecommunications network;
- Storage on a computer-readable medium.

Otherwise, the claim will be considered a non-invention within the meaning of Article L.611-10 of the IPC.

Examples of how to draft computer program [product] claims are provided below:

"Computer program [product] comprising code instructions for implementing [the steps of] the process according to claim(s) X when said program is executed on a computer";

"computer program [product] comprising programming code segments/means/instructions stored on a computer-readable medium capable of implementing [the steps of] the process according to claim(s) X."

Note: The term in square brackets is optional.

- Program storage medium claims

A claim relating to a program storage medium must also include evidence of physicality - that is, the storage medium must be a physical, computer-readable medium on which a computer program is stored.

Examples of wording for claims relating to program storage media are provided below:

"A computer-readable storage medium on which is stored a computer program comprising code instructions for implementing [the steps] of the process according to claim(s) X";

"A [computer-readable] storage medium on which is stored a computer program according to claim(s) Y."

If a storage medium claim relies on a computer program claim drafted in accordance with the preceding section regarding computer program [product] claims, the phrase "computer-readable" is optional.

- Other wording

Art. L. 611-10
Art. L. 612-6

Claims relating to a computer program that are not drafted in accordance with the wording defined above are assessed on a case-by-case basis, based on the requirements for patentability and clarity.

1.7. Databases

(a) Definitions

Art. L. 112-3 (2)

A database is defined as a collection of works, data, or other independent elements, arranged in a systematic or methodical manner, which can be individually accessed by electronic or other means.

Order of 22 December 1981 on the Expansion of Computer Science Vocabulary

Data is a representation of information in a conventional form intended to facilitate its processing.

A **data structure** is a specific format designed to organise, process, extract, and store data.

A **database** can contain one or more data structures.

A **database management system** is a computer-implemented system designed to store and retrieve data using various data structures to ensure efficient data management.

(b) Database protection

For databases, there are three possible types of independent and cumulative protection:

Art. L. 112-3 (1)

(i) copyright protection

To be eligible for copyright protection, a database must be **original** in that it reflects the author's personality through the selection, arrangement, and organisation of the information it contains. Where applicable, the contents of a database may also be eligible for copyright protection, for example, in the case of a database of photographs, films, etc. For example, the Paris Court of Appeal has recognised copyright protection in the field of databases (*Paris Court of Appeal, 2 March 2005, RG 2003/20960*).

Art. L 341-1 et seq.

(ii) protection under database maker's right
This is a *sui generis* right that protects the contents of the database. The maker of a database - defined as the person who takes the initiative and assumes the risk of the corresponding investments - is entitled to protection of the database's contents when the creation, verification, or presentation of those contents demonstrates a substantial financial, material, or human investment. This protection is independent and applies without prejudice to the protections arising from copyright or any other right relating to the database or any of its constituent elements.

Art. L. 611-10

(iii) patent protection
The mere presence of a data structure, database, or computer-implemented database management system in a claim is generally not sufficient on its own to confer a technical character on the claimed subject matter. Nevertheless, such a claim is considered an invention within the meaning of Article L. 611-10 (2) and (3) if it is limited to a technical solution that solves a technical problem.

(c) Nature of data, data structure, and database design

The nature of the data or the data structure itself may provide a technical effect sufficient to confer patentability on a database-related invention.

This may be the case if the data in the database is functional - that is, if the database serves a technical function within a technical system, such as controlling the functioning of a device that processes the data. In this case, the functional data inherently includes the device's technical features or is associated with those features.

On the other hand, cognitive data - that is, data whose content and meaning are relevant only to human users - do not contribute to producing a technical effect.

For example, a storage medium intended for use in an image retrieval system that contains encoded images as well as a data structure defined in terms of line numbers and addresses that tell the system how to decode an image and access it from the medium is regarded as technical. This data structure is defined in terms that inherently imply the technical features of the image retrieval system in which the storage medium operates, with said system consisting of the storage medium and a reading device. The data structure therefore contributes to the technical character of the storage medium, whereas the cognitive content of the stored images—such as a photograph of a person or a landscape - does not.

Similarly, a database of a terrain area divided into grid cells within an onboard avionics system overflown by an aircraft is regarded as technical; for each terrain grid cell, the database includes an uncertainty value associated with a first terrain elevation value. If an uncertainty value is calculated based on a plurality of second terrain elevation values associated with said terrain grid cells and derived from a second database with a second resolution higher than the first resolution, then the reliability of the calculated uncertainty value is improved, and this therefore contributes to the technical character of the invention.

A method for building a training data database for an in-vehicle vision system is also considered technical, as the data is technical in nature and undergoes image processing before being entered into the database.

Conversely, a data structure used in a database management system of a system for planning or purchasing products and/or services generally does not produce any technical effect.

d) Database management

Features that define the internal functioning of a database management system are typically based on technical considerations. They therefore contribute to the technical character of the invention. Technical considerations come into play, for example, when a system's throughput or response time to requests is improved through automatic data management using various data stores with different technical properties, such as their levels of consistency or performance.

Database management systems execute structured queries that formally and precisely describe the data being searched for. Optimising the execution of such structured queries with regard to the required computing resources (processor, main memory, or hard drive) contributes to the technical character of the invention, as it involves technical considerations related to the efficient operation of the computer system.

For example, improving the performance of a computer system in terms of speed and resource usage can in itself be a technical effect if the improvement is based on technical considerations.

Similarly, the use of historical query data to predict the future workload of a multi-tier storage system—with the aim of improving access times to the storage system, which is a search engine index - is considered technical.

Furthermore, reducing the processing load associated with memory allocation by providing metadata that enables direct, structured access to field values in a serialised representation of an in-memory object is considered technical.

In database management systems, data structures - such as an index, a hash table, or a query tree - that facilitate data access or execute structured queries also contribute to the technical character of the invention. Such data structures are functional in nature because they specifically control the operation of the database management system to perform technical tasks.

In contrast, in database management systems, data structures defined by the cognitive data they contain - that is, data whose content and meaning are relevant only to human users - do not contribute to the technical character of the invention beyond the mere data storage.

- *Generating a query*

A query is a means provided by a database management system for interacting with the data in that database.

Defining a query in natural language is not in itself a technical task, but rather falls within a non-technical field. Furthermore, translating a natural-language query into a structured query is not a technical task.

A distinction is made between the execution of structured queries by a database management system and information retrieval. The latter includes searching for information within a document, actual document searches (text, images, audio), as well as searching for metadata that describes the data. The query can then be made by the user who needs information, usually in an informal manner, using natural language and without a specific format. For example, users can enter search terms as a query in internet search engines to find relevant documents, or upload a document as an example to find similar documents. If the method used to assess relevance or

similarity relies solely on non-technical considerations, such as the cognitive content of the searched-for items, purely linguistic rules, or other subjective criteria (for example, items deemed relevant by friends on social media), it does not make a technical contribution.

In the context of searches based on the semantic similarity of terms, the concept of "best search" is subjective rather than technical, as it is characterised by the cognitive content of the information being sought.

1.8. Presentations of information

Art. L. 611-10 (2) (d)

(a) Any presentation of information that is characterised solely by the information it contains is not patentable.
This applies to a claim regarding:

- **the presentation of the information itself**, for example:
  - acoustic signals
  - visualisations
  - conversion tables showing the relationship between certain foot measurements and the corresponding shoe-size references
  - pre-calculated tables of values that can be used for flying gliders
  - a musical notation system.

- **a medium characterised solely by the information contained or recorded on it, for example:**
  - books characterised by their content
  - records characterised by the piece of music recorded on them
  - traffic signs characterised by the warning thereon
  - magnetic tapes characterised by their recording
  - packaging for medications characterised by the information printed on one of its sides

- **processes and devices intended for the presentation of information,** such as indicators or recorders characterised solely by the information indicated or recorded.

(b) The manner in which information is presented, provided that it is distinct from the content of the information, may have technical features that are patentable.
Here are a few examples where such technical features can be identified:
- a telegraph or communication system characterised by the use of a particular code to represent the characters, if this method offers technical advantages (for example, pulse-code modulation)
- a phonograph record characterised by the unique shape of its groove, which allows for stereophonic recordings to be made
- a slide with an audio track around its edge
- the data medium on which a computer program is stored (assuming that the program in question is patentable)
- a colour television signal whose technical features depend on those of the system in which it occurs.

2. EXCEPTIONS TO PATENTABILITY

Art. L.611-16 to Art. L.611-19

The French Intellectual Property Code excludes certain categories of inventions from patent protection.

For patent applications with a filing date prior to 22 May 2020,
the rejection of a patent application on such a ground (exclusion from patentability) may be declared when the subject matter of the patent application is clearly unpatentable.

Art. L.612-12 amended by Act no. 2019-486 of 22 May 2019 (Article 122), i.e. the "Business Growth and Transformation Action Plan" (PACTE)

For patent applications filed on or after 22 May 2020,
the rejection of a patent application on such a ground (exclusion from patentability) may be declared when the subject matter of the patent application is unpatentable.

Art. L.613-25

In any event, non-patentability pursuant to Articles L.611-16 to L.611-19 may constitute a ground for bringing an action for invalidity of the patent before the Courts".

Art. L.613-23 (1) of the IPC amended by Ordinance no. 2020-116 of 12 February 2020

Non-patentability pursuant to Articles L.611-16 to L.611-19 shall constitute a ground for opposition to the patent with the INPI, once the patent has been granted (for patents granted from 1 April 2020 onwards).

Art. L.611-16

2.1. Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body (Art. L.611-16)

L. 611-16

The following are not patentable:
- methods for the treatment of the human or animal body by surgery or therapy,
- diagnostic methods practised on the human or animal body.

These exceptions are intended to allow physicians and veterinarians, in the best interests of their patients, to freely use what they believe - based on their expertise and knowledge - to be the best treatment methods available to them, without having to worry that a treatment method might be patented.

This provision does not apply to products - including substances or compositions - intended for use in any of these methods.
Consequently, the substances or compositions, as well as the surgical, therapeutic, or diagnostic instruments and apparatuses for use in these methods, may be patented. This applies, for example, to the active ingredients of medicinal products, prosthetic devices, apparatuses for disabled persons, and artificial organs.

In addition, it should be noted that the exceptions provided for in Article L. 611-16 are limited to methods for the treatment of the human or animal body by surgery or therapy and to diagnostic methods practised on the human or animal body.
As a result, other methods for the treatment of humans or animals - such as, for example, treating an animal to promote its growth, improve the quality of its meat, or increase its wool yield, or methods for measuring or recording features of the human or animal body, are patentable, provided they are of a **technical** nature and not essentially biological.

Furthermore, the treatment or diagnostic methods excluded by Article L. 611-16 are excluded only to the extent that they are actually practised on a **living** human or animal body. Methods for the treatment of, or diagnostic methods practised on, a dead human or animal body, or on a component extracted from a human or animal body, may be patented [See below 2.1.1. c) Specific cases and 2.1.3. c) Specific cases].

The exclusion from patentability under Article L. 611-16 does not depend on the person who implements it or the means used for such implementation. In particular, the mere fact that these methods are computer-assisted or computer-implemented does not allow them to be exempt from this exclusion.

For the specific case of the use of substances or compositions in the medical field within the meaning of Article L. 611-11 (4) and (5), see section 5.2. f. below.

2.1.1. Method for the surgical treatment of the human or animal body

a) Definition of surgical treatment

Surgery is defined as a branch of medicine dedicated to the treatment of the body, in particular its internal organs, using both manual and instrumental techniques.

The term "surgery" therefore covers:

- "bloodless" or "non-invasive" procedures involving an external intervention, such as, for example, in the field of orthopaedics, the reduction of a bone fracture or joint dislocation by external manipulation; and
- "invasive" surgery involving the use of instruments, such as, in particular, all of the acts usually referred to by the expression "surgical operation" (see below, b) for examples).

However, the concept of surgical treatment must not be limited to surgical treatment for therapeutic purposes.

Thus, the expression "surgical treatment" shall be understood to define the **nature** of the treatment, more so than its purpose. For example, methods of surgical treatment for cosmetic purposes or for embryo transfers are excluded from patentability in the same way as surgical treatment for therapeutic purposes (Paris Court of Appeal, 29 October 1997, Biolase Tech.Inc., PIBD 646-III-29).

b) Examples of methods of surgical treatment

The following are thus likely to be rejected:

- claims for methods allowing for the replacement of a balloon catheter in a patient's vascular system;
- claims for a method of cleaning and boring dental canals using vapour cavitation produced by means of a laser;
- claims for a method of using an osteosynthesis pin;
- claims for a method for treating urinary incontinence in a patient including steps for making various incisions and inserting a pubovaginal sling;

- claims for a method of treating a volume of biological tissue by localised hyperthermia.

(c) Specific cases

Multi-step method or procedure

A claim for a multi-step method, where one or more of the steps involved consist of an intervention of a surgical nature, is likely to be rejected on the basis that its subject matter encompasses a method for the surgical treatment of the human or animal body.
Indeed, unlike the items referred to in Article L. 611-10 (2) which are excluded from patentability only if they are claimed "as such" (see Art. L. 611-10 [3]), the presence of at least one surgical step in a multi-step method shall be sufficient to confer a surgical nature on said method.

However, if a multi-step procedure applied to an animal includes a step involving the slaughter of that animal, it cannot be regarded as a method of surgical treatment of the animal. Indeed, any method or procedure that intentionally causes the death of a laboratory animal shall not, by its very nature, constitute a method of surgical treatment, even if some of the steps involved are of a surgical nature.

Method or procedure for operating an apparatus

Procedures for operating an apparatus are not excluded from patentability, provided they do not include any steps of a surgical nature.

The following are thus likely to be rejected:

- A claim for a method of assisting the manipulation of an instrument by means of a device for assisting the manipulation of the instrument, involving the joint manipulation of a surgical instrument/tool by a robot and a surgeon in the course of a surgical procedure;

- A claim for a method of controlling a device for assisting the positioning of a medical instrument inserted into a natural or artificial passage of a patient's body with respect to an organ;

- A claim for a method of controlling the rotation of an endodontic file on an apparatus for dental treatment, including a step to repeatedly determine the distance of the file from a set-value position during a root canal procedure, defined with respect to the apex of the tooth by measuring the distance remaining between the file and the apex during drilling, and thereby making it possible to anticipate the stoppage of the apparatus and avoid drilling the apex of the tooth.

- A claim for a method of operating a device for inserting a needle into a patient's body, which allows the depth of needle insertion to be controlled based on the patient's body type and the type of injection being administered.

2.1.2. Methods for the therapeutic treatment of the human or animal body

a) Definition of therapeutic treatment

Therapy refers to ways of treating a general illness or malfunction of the body, as well as the relief of discomfort and painful symptoms.

Both the prophylactic and curative treatment of disease are covered by the term "therapeutic" as they both aim to maintain or restore the subject's health. Thus,

therapy may be considered as the transition from a state of illness to a normal state, or as the prevention of a state of illness.

While a method of therapeutic treatment may involve the use of substances or compositions for therapeutic purposes, a method involving the use or application of apparatuses or devices, in particular medical devices, to prevent or cure a disease, shall also constitute a method of therapeutic treatment of the human or animal body.

Thus a claim relating to the "use of a substance or composition or an X device in the treatment of the Y disease", shall be considered as a claim to a method of therapeutic treatment of the human or animal body in that it consists of applying the substance or composition to the human or animal body or using the device in question on the human or animal body.

b) Examples of therapeutic methods

The following are thus likely to be rejected:

- a claim concerning a method of remote therapeutic treatment (e.g., radiotherapy); its subject matter is considered to be a method of therapeutic treatment applied to the human body;
- a claim concerning a method for transferring an active ingredient into the nuclei of eukaryotic cells, whereby this transfer can take place both inside (*in vivo*) and outside (*in vitro*) the human body. This claim would be partially rejected if the transfer of the active ingredient was carried out *in vivo*;
- a claim concerning the treatment of blood by means of dialysis, whereby blood is reintroduced into the body;
- a claim concerning the dosage of a medicinal product.

However, the following shall be considered patentable:

- a method of treating blood with a view to its conservation (blood bank). This method does not involve any interaction with the human body and is not applied to the human body.

(c) Specific cases

Multi-step method or procedure

A claim for a multi-step procedure, where one or more steps involved consist of a therapeutic treatment, is likely to be rejected, in that its subject matter encompasses a method for the therapeutic treatment of the human or animal body.
Indeed, unlike the items referred to in Article L. 611-10 2, which are excluded from patentability only if they are claimed "as such" (see Art. L. 611-10 3), the presence of at least one therapeutic step in a multi-step method shall be sufficient to confer a therapeutic nature on said method.

Method or procedure for operating an apparatus

A claim relating to a procedure for the operation of an apparatus used for therapeutic purposes on the human or animal body shall be **excluded** from patentability if there is a therapeutic effect that is considered to be **indissociable** from the implementation of the procedure.

The following are thus likely to be rejected:

- claims for a method of checking the functioning of an anaesthetic device which uses patient-specific measured data during treatment to rectify the functioning of the device;

- claims for a method of operating a respiratory assistance device connected to the patient's body;

- claims for a method of controlling an apparatus for supplying breathing gas to improve the lung properties by increasing the volume of breathing gas supplied at least intermittently compared to the volume provided in assisted breathing.

Simultaneously therapeutic and non-therapeutic methods of treatment
If a claim relates to both a therapeutic and a non-therapeutic method of treatment, the applicant shall be notified of the need to limit the claim by excluding the therapeutic method of treatment, if it is **technically possible** to separate the therapeutic and non-therapeutic methods from each other. If it is not possible to separate the two, the claim cannot be accepted. The wording of the claim plays an important role in this respect.

The following were rejected:

- A claim relating to the cosmetic use of a chemical product having an inevitable therapeutic effect, whereby the claimed invention was required to include a method of therapeutic treatment of the human (or animal) body (TGI of Paris, 16 November 1994, L'OREAL v. ESTEE LAUDER, RG 1991/27126, PIBD 1995, 583-III-115);

- Claims relating to an abrasive teeth-cleaning method, having a cosmetic effect and a therapeutic effect that could not be dissociated. (Court of Cassation, Commercial Division, 17 June 2003, decision No. 1004, EMS France v. Dentsply).

2.1.3. Diagnostic methods practised the human or animal body

a) Definition of diagnosis
Diagnosis is defined as the time required, during the medical process, to identify the nature and cause of a patient's condition. It is established in several stages.

The diagnostic methods excluded from patentability in application of Article L. 611-16 do not include all of the methods related to diagnosis.

A purely intellectual approach consisting in establishing a diagnosis on the basis of various symptoms and/or biological and/or physical data is excluded from patentability under Article L. 611-10 2 (intellectual method).

In addition to a deductive decision phase, considered indicative of a purely intellectual approach, any diagnostic method excluded on the basis of Article L. 611-16 must include steps of a technical nature, the implementation of which shall contribute to making the diagnosis.

In order to determine whether a claim relates to a diagnostic method within the meaning of Article L. 611-16, first it is necessary to establish whether the claim includes **all** of the necessary steps, namely the following four phases:

(i) the **examination phase**, which involves the collection of data

(ii) the **comparison** of this data with standard values;

(iii) the **finding of a significant deviation** (e.g., a symptom) during this comparison;

(iv) the attribution of this deviation to a specific clinical picture, i.e. the deductive medical or veterinary **decision phase** (diagnosis for curative purposes *stricto sensu*).

It is important to take into account any steps that may be regarded as implicit, i.e., steps relating to the comparison of data with standard values (phase ii) may also imply the finding of a significant deviation (phase iii). The deductive medical or veterinary decision phase (iv), i.e. the "diagnosis for curative purposes *stricto sensu*" consists of determining the nature of a particular medical or veterinary condition with a view to identifying or uncovering a pathology; it is not necessary to identify the underlying disease.

It is also important to determine which of first three steps (i-iii) are of a **technical nature** and meet the criterion of being "**practised on the human or animal body**". For each technical step, it is therefore necessary to determine whether there is interaction with the human or animal body. The type and intensity of the interaction are not decisive: the criterion is fulfilled if the performance of the technical step in question requires the presence of the body. Direct physical contact with the body does not have to be established.

A medical or veterinary practitioner does not have to be involved in the procedure, either by being physically present or by bearing responsibility.

Conversely, methods that merely aim to obtain information (data, physical quantities) on the body of a living human being or animal (e.g. X-rays, MRIs or blood pressure readings) are not excluded from patentability under Article L. 611-16, if the information obtained simply provides **preliminary results** which do not, in themselves, make it possible to establish a diagnosis with curative purposes *stricto sensu*.

b) Examples

The following were deemed to be patentable:

- a process for acquiring information about the heart rate, on the basis of which a doctor can then make a diagnosis (Paris Court of Appeal, 26 May 1983, ELA Medical, RG 00870, PIBD 1983, 329-III-189).

(c) Specific cases

In vitro diagnosis

Diagnostic methods applied to substances (tissue, body fluids) extracted from the body of a human being or animal are not excluded from patentability per se. For example, a method for determining the level of glucose in a sample of body fluid, **which is not directly practised on the human or animal body**.

2.2. Inventions whose commercial use would be contrary to human dignity, public policy or morality (Article L. 611-17)

L. 611-17

Under this provision, any invention whose commercial use would be contrary to human dignity, public policy or morality shall be excluded from patent protection.

R. 612-4 (1)

Under the Intellectual Property Code a patent application must also not contain any elements or drawings whose publication or implementation would be contrary to public policy and morality.

TRIPS Agreement, Article 27 (2)

The concept of **public policy** encompasses, in particular, the maintenance of safety, security, public health, good order, and public tranquillity, including the protection of the health and lives of people and animals, the protection of plants, and the prevention of serious damage to the environment. An invention that infringes on one of these principles is therefore not patentable.

ECHR Article 10 (2)

The concept of **morality** can be defined as the idea that certain behaviours are morally acceptable, while others are not, taking into account the set of norms that are

CJEU, 27 February 2020, C-240/18

accepted and deeply rooted in a given culture - norms that are inherent to French and European society and civilisation. In its usual sense, this concept refers to the fundamental moral values and norms that a society adheres to at a given time. An invention whose use would be considered immoral by society would not be patentable.

QPC (priority question of constitutionality) No. 2013-674, paragraphs 5 and 14
Civil Code, Articles 16 to 16-9

The principle of **human dignity** is understood to mean respect for the integrity of the human race, the integrity and inviolability of the human body, and its status as non-property; no human being may be subjected to any form of enslavement or degrading treatment. An invention that violates this principle is not patentable.

However, Article L. 611-17 states that an invention shall not be deemed contrary to human dignity, public policy or morality merely because its use is prohibited or restricted by law. This means that inventions are patentable if they are not contrary to morality, do not infringe upon human dignity or a fundamental right, and do not jeopardise public safety or security, even if they may be subject to a state monopoly or if their use is, or may be, legally restricted. Thus, an invention relating to a device for detecting speed cameras would be patentable if the description of the invention does not mention any elements that would encourage a violation of traffic regulations, even though certain uses of such a device might be contrary to traffic regulations.

Pursuant to Article L. 611-17, any device designed to study the distribution of substances of interest in one or more cavities of the human body would be rejected if that device incorporates an anatomical specimen derived from a human cadaver. Indeed, such a provision is contrary to the respect due to the human body after death under Article 16-1-1 of the Civil Code, a provision that is elevated to the status of a principle of public policy by Article 16-9 of the same code, in the name of respect for human dignity.

Nevertheless, an invention may have various applications, only some of which are contrary to human dignity, public policy, or morality, for example, a method designed to break safes, the use of which would be considered shocking by a burglar, but perfectly acceptable by a locksmith.

Art. L. 612-12, *in fine*
R. 612-4 (1)

In such a case, if the application contains an explicit reference to a use that is contrary to human dignity, public policy, or morality, the removal of that reference is required under the provisions of Articles L. 612-12 (*in fine*) and R. 612-4 (1) (see Book 1, Section C, Chapter II, points 2.1 and 2.4).

Civil Code, Article 16-10
Article 226-25 of the Penal Code

For example, a genetic analysis method used to determine an individual's ethno-geographic origin would be partially rejected if the patent expressly provides for the use of the method for purposes other than medical or scientific research, in violation of Article 16-10 of the Civil Code and the fundamental principles of non-discrimination and respect for human dignity. The patent may be granted after the prohibited uses of the method have been deleted.

Public Health Code, Articles L. 3421-4, R. 5132-74, R. 5132-84, R. 5132-86, R. 5132-86-1

Decree of 22 February 1990, establishing the list of

An invention relating to a composition comprising a plant, part of a plant, or substance classified as **a narcotic or psychotropic substance** may not be deemed patentable because it is contrary to public policy or morality. In fact, the production, manufacture, transport, import, export, possession, offering, transfer, acquisition, or use of the aforementioned plant, part of a plant, or substances - except for the manufacture of medicines under certain conditions - are prohibited. It shall be assessed whether this invention constitutes an explicit or implicit provocation or incitement to the illicit use of narcotic drugs, since portraying the use of narcotic drugs in a favourable light is punishable under Article L. 3421-4 of the Public Health Code in the interest of protecting public health and public welfare, which are components of public policy.

substances classified as narcotics Decree of 22 February 1990, establishing the list psychotropic substances

Decree of 30 December 2021, implementing Article R. 5132-86 of the Public Health Code

Decision No. 444887 of 29 December 2022, of the Council of State

An invention relating to **cannabis**, the cannabis plant, or cannabis resin, products containing them, or those derived from cannabis, the cannabis plant, or its resin, unless the invention does not, either implicitly or explicitly, encourage the illicit use of narcotics, may not be deemed patentable. Particular attention is paid to varieties of *Cannabis sativa L.* (hemp), hemp extracts, and products containing them - particularly finished products - whose delta-9-tetrahydrocannabinol (delta-9-THC) content must not exceed the current legal limit.

It should be noted that an invention relating to a device that facilitates the use of prohibited narcotics and encourages such use is contrary to public policy or morality and will therefore not be deemed patentable.

In the analysis, the criterion of proportionality is decisive. An invention whose benefit to society outweighs its incompatibility with human dignity, public policy, or morality may be deemed patentable. That is why an invention relating to a transgenic mouse that develops cancerous tumours at an increased rate is likely to be patentable, following an analysis of the balance between the invention's benefit to humanity - in this case, a contribution to medical research on cancer - and the serious concerns raised by the suffering the animal may endure (see Title 1, Section C, Chapter VII, point 3.3.5).

Biotechnological inventions may raise issues specific to them relating to incompatibility with human dignity, public policy, or morality. These issues are addressed in the section devoted to this topic (see Title I, Section C, Chapter VII, point 3).

3. EXCLUSIONS AND EXCEPTIONS TO PATENTABILITY IN THE FIELD OF BIOTECHNOLOGICAL INVENTIONS

▶ 3.1 General remarks and definitions

European Community Directive 98/44/EC of 6 July 1998

Sections 3.1 to 3.3 address the patentability of biotechnological inventions, which is specifically governed by Articles L. 611-18 and L. 611-19 of the Intellectual Property Code. These provisions result from the transposition of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998, on the legal protection of biotechnological inventions. The recitals and articles of this Directive must be taken into account when interpreting these two articles.

In Articles 2 and 3, Directive 98/44/EC sets forth, among other things, a number of general principles and definitions:

L. 611-10 (1) and (4)

- "Biological material" means material that contains genetic information and is capable of reproducing itself or being reproduced in a biological system;

- Subject to the patentability requirements applicable to any invention, inventions relating to a product consisting of or containing biological material, or to a process by means of which biological material is produced, processed or used, are patentable;

L.611-19 III

- A "microbiological process" is any process involving or performed upon or resulting in microbiological material;

L. 611-19 I (3)

- An "essentially biological process" for obtaining plants or animals is a process that consists entirely of natural phenomena such as crossing or selection;

Article 3 of Directive 98/44/EC

- Biological material may be the subject of an invention, even if it previously occurred in nature, provided that such biological material is isolated from its natural environment or produced by means of a technical process.

3.2. Inventions relating to or involving the human body and its elements (L. 611-18)

L. 611-18

Article L. 611-18 concerns inventions relating to the human body and its elements (Articles 5 and 6 of Directive 98/44/EC),

Recital 16 of Directive 98/44/EC

It defines and distinguishes between inventions that are not patentable and those that are, based on the fundamental principles that safeguard human dignity and integrity:

3.2.1 The human body and its elements, and the total or partial sequences of a gene considered as such.

L. 611-18 (1) and (2)

"The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.
Only an invention constituting the technical application of a function of an element of the human body may be protected by a patent. Such protection shall cover the element of the human body only to the extent necessary for the realisation and exploitation of that particular application. The latter must be disclosed in a concrete and precise manner in the patent application."

L. 611-18 (3) (d)

"In particular, the following are not patentable [...]
(d) sequences or partial sequences of a gene as such."

Recital 16 of Directive 98/44/EC

The stages of the formation and development of the human body involve germ cells.

Inventions relating to elements (intrinsic elements, such as cells, proteins, DNA, various metabolites) or products (excreta, such as sweat and urine) of human origin are unpatentable when considered as such, that is to say

- when these elements or products are presented as they occur in nature, interacting with their natural environment - for example, a non-isolated DNA fragment integrated into the entire human genome. Patenting such non-isolated DNA would be tantamount to patenting the human genome itself.
- when these elements or products have been merely isolated and defined in chemical terms, but no function or industrial application has been identified. This is particularly the case for an isolated DNA fragment whose sequence has been determined, even though the product encoded by this DNA is unknown, as its function, making it difficult to envisage its practical application for industrial purposes (pharmaceutical, agrochemical, etc.). This exclusion from patentability is an application of the general principle that a mere discovery cannot be the subject of a patent.

Recitals 20 and 21 of Directive 98/44/EC

However, an invention relating to an element isolated from the human body or otherwise produced by a technical process, and which is capable of industrial application, is not excluded from patentability, even if the structure of that isolated element is identical to that of a natural element. Indeed, this isolated element is, for example, the result of technical processes used to identify, purify, classify, and reproduce it outside the human body, techniques that only humans are capable of carrying out and that nature is incapable of accomplishing on its own.

The patent application must therefore describe the function of the claimed isolated element, and **its industrial application must be specifically described** (in the case of gene sequences: see Title I, Section C, Chapter VII, point 4).

3.2.2 Processes for cloning human beings

L. 611-18 (3a)

Recital 41 of Directive 98/44/EC

Processes for cloning human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being.
Such processes are not patentable.

3.2.3 Processes for modifying the genetic identity of human beings.

L. 611-18 (3) (b)

This term refers to the genetic modification of the germ line genetic identity of human beings, in accordance with Article 6.2(b) and Recital 40 of Directive 98/44/EC.
Such processes are not patentable.

3.2.4 The use of human embryos for industrial or commercial purposes.

L. 611-18 (3) (c)

Under Article L. 611-18 (3) (c), the use of human embryos for industrial or commercial purposes is not patentable.

Although the Intellectual Property Code does not directly define this concept, the Court of Justice of the European Union (CJEU) has issued, following preliminary rulings, two decisions clarifying the concept of "human embryos" and that of their "uses […] for industrial or commercial purposes" as referred to in Article 6 (2) (c) of Directive 98/44/EC, which is transposed by Article L. 611-18.

(1) Concept of "human embryo"

CJEU, C-34/10, Brüstle
C-364/13, International Stem Cell Corporation

It follows from the Brüstle decision of 18 October 2011, and the International Stem Cell Corporation decision of 18 December 2014, that the term "human embryo" must be understood in a wide sense. The Court of Justice notes in that decision that the European Union legislature intended to exclude any possibility of patentability where respect for human dignity could thereby be affected.

The following are therefore considered to be a "human embryo":
- any human ovum, as soon as fertilised,
- any unfertilised human ovum into which a cell nucleus from a mature human cell has been transplanted,
because these organisms are capable of commencing the process of development of a human being.

With regard to an unfertilised human ovum whose division and further development have been stimulated by parthenogenesis, resulting in the formation of a parthenote, the Court of Justice's position has evolved between the two aforementioned decisions.

In the Brüstle decision, the Court first defined a "human embryo" as any unfertilised human ovum whose division and further development have been stimulated by parthenogenesis, holding that this organism, due to the effect of the technique used to obtain it, is capable of commencing the process of development of a human being, just as an embryo created by fertilisation of an ovum can do so.

In the second International Stem Cell Corporation decision, the Court of Justice nuanced its position by holding that the parthenote could not be classified as a human embryo*" if, in light of current scientific knowledge, it does not, in itself, have the inherent capacity of developing into a human being, this being a matter for the national courts to determine."*

The mere onset of the developmental process is therefore insufficient to establish the existence of a "human embryo"; this classification applies only to an organism" *capable of commencing the process development of a human being, just as an embryo created by fertilisation of an ovum can do so,"* that is, one that possesses the **intrinsic capacity to develop into a human being**. A human totipotent embryonic stem cell is an example of such an organism.

With regard to stem cells obtained from a human embryo at the blastocyst stage, it is also necessary to examine, in light of scientific developments, whether these stem cells are capable of commencing the process of development of a human being and thus constitute a "human embryo" within the meaning of the Directive.

In light of these decisions and current technological knowledge, the INPI considers that an invention relating to or involving a group of cells or a cell capable of commencing the development of a human being is excluded from patentability, this capability being understood as the intrinsic ability to develop into a human being. This is particularly true of a human embryo or a human totipotent embryonic stem cell.

(2) Concept of "uses of human embryos"

CJEU, C-34/10, Brüstle

In the Brüstle decision, the Court of Justice confirmed that an invention is excluded from patentability where the technical teaching which is the subject matter of a patent application requires the **prior destruction of human embryos or their use as base material,**
- whatever the stage at which that takes place, and
- even if the description of the technical teaching claimed does not mention the use of human embryos.

Thus, an invention relating to a product—such as a cell or a group of cells—that is not capable of commencing the development of a human being may nevertheless be excluded from patentability if the implementation of the invention requires the prior destruction of a human embryo, even if the destruction takes place at an earlier stage or is not explicitly mentioned in the description of the invention.

Similarly, an invention relating to a product whose production or a process whose implementation requires the use of human embryos as base material is excluded from patentability.

A subject matter relating to human **pluripotent** embryonic cells—which may be derived from a human blastocyst—or human **multipotent** cells will be patentable if,
- firstly, based on the scientific knowledge at the time the patent application was filed, these cells cannot commence the process of development of a human being,
- secondly, the implementation of the invention did not require the destruction of a human embryo, regardless of when the destruction occurred, that is, even at a stage well before the invention was implemented, and even if the use of the embryo is not described.

These conditions also apply in the case of an invention that involves a pre-established human embryonic cell line.

The INPI therefore considers that an invention relating to or involving human embryonic cells or human embryonic cell lines is a patentable invention in accordance with Article L. 611-18 (3) (c) of the IPC if

1) **these cells and cell lines are incapable of commencing the process of development of a human being, and**
2) **it is further specified that, as of the filing date of the patent application, these cells and cell lines are obtained using a technique that does not destroy the human embryo.**

An invention relating to human iPS (induced pluripotent stem) cells obtained by the dedifferentiation of somatic cells is patentable if these human iPS cells, based on the scientific knowledge at the time the patent application was filed, cannot commence the process of development of a human being.

Similarly, an invention relating to human stem cells that are isolated from umbilical cord blood, adult human tissues (bone marrow, adipose tissue, etc.), is patentable, provided that these cells do not have the capacity to commence the process of development of a human being, based on the scientific knowledge at the time the patent application was filed.

(3) Concept of "uses [...] for industrial or commercial purposes"

Recital 42 of Directive 98/44/EC

Directive 98/44/EC interpreted this exception strictly, specifying that: *this exclusion from patentability "does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it."*

CJEU, C-34/10, Brüstle

In the Brüstle decision, the Court of Justice clarified that the concept of the use of human embryos for industrial or commercial purposes as a ground for excluding patentability also covers the use of human embryos for purposes of scientific research.

Human embryos are considered to be used for industrial and commercial purposes when the implementation of the invention requires the use of human embryos that results in their destruction, even if such destruction is not within the scope of the invention.

In conclusion, it should be noted that in the case of an invention relating to or involving a cell, a group of cells, or a cell line that is not patentable under Article L. 611-18 (3) (c), it is possible to include a ***disclaimer*.**

3.3. Inventions relating to plants and animals (Art. L. 611-19).

Art. L. 611-19

Article L. 611-19 concerns inventions relating to animals, plants, and their elements (Articles 2, 4, and 6 of Directive 98/44/EC),

The following are excluded from patentability:

3.3.1 Animal varieties

Art. L. 611-19 I (1)

Animal varieties are not patentable.

There is no scientific or legal definition of an animal variety.

With regard to a patent claiming a genetically modified non-human mammal, in particular a rodent, it is considered that "rodents" and even "mammals" rank higher than "varieties" in taxonomic terms. Therefore, if the subject matter of a claim is an animal designated in terms of its taxonomic class/order (mammal, rodent) or genus (mouse, rat), the subject matter of the claim cannot be excluded from patentability on the grounds that it relates to an animal "variety". Any exclusion from patentability must be interpreted restrictively.

Art. L.611-19 II

Under the provisions of paragraph II of Article L. 611-19, an invention relating to an animal shall be patentable if the technical feasibility of the invention is not limited to a specific animal variety.

Thus, a claim relating to an animal is not excluded from patentability if the claim does not relate to individual animal varieties, even if it may cover animal varieties. Furthermore, this animal must not be obtained exclusively through an essentially biological process (see section 3.3.4).

Art. L. 611-19 I (3 bis)

3.3.2 Plant varieties

Art. L. 611-19 I (2)

Exclusion from patentability applies to plant varieties, not to plants in general, with "varieties" being defined in Article 5 of EC Regulation No. 2100/94 on Community plant variety rights, and in Article L. 623-1 of the IPC, as amended by Act No. 2011-1843.

Council Regulation (EC) No. 2100/94 of 27 July 1994

Art. L. 623-1

Act No. 2011-1843 of 8 December 2011, on Plant Variety Certificates.

The term **"variety"** shall be taken to mean a plant grouping within a single botanical taxon of the lowest known rank, which may be:
(1) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
(2) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
(3) considered as a unit with regard to its suitability for being propagated unchanged.

Plant varieties are not patentable, but may be protected by a "Plant Variety Certificate" in accordance with the International Convention for the Protection of New Varieties of Plants (UPOV Convention) of 1961 (revised in 1991, ratified in 2012) and EC Regulation No. 2100/94. The granting of Community plant variety rights is governed by the Community Plant Variety Office (CPVO). The granting of French plant variety rights is governed by the French Office for Plant Breeders' Rights (INOV) in accordance with Articles L. 412-1 and L. 623-1 to 16 of the IPC.

Art. L. 611-19 II

Under the provisions of paragraph II of Article L. 611-19, an invention relating to a plant shall be patentable if the technical feasibility of the invention is not limited to a specific plant variety.

Thus, an invention relating to a plant, for which the claims do not relate to specific plant varieties, is patentable, even if it may cover plant varieties. Furthermore, this plant must not be obtained exclusively through an essentially biological process (see section 3.3.4).

Art. L. 611-19 I (3 bis)

For example, an invention relating to a transgenic rapeseed is patentable because it does not pertain to a specific plant variety. A claim relating to such genetically modified rapeseed will not be rejected.

However, plant varieties - whether obtained through genetic engineering techniques or through traditional breeding methods - are not patentable.

3.3.3 Essentially biological processes for the production of plants or animals

Art. L. 611-19 I (3)

An essentially biological process for the production of plants or animals is not patentable.

A process for the production of plants or animals is "essentially biological" if it relies exclusively on natural phenomena such as crossing or selection.

A process for the production of plants or animals with desired characteristics that involves or consists of steps of sexual crossing (recombination of whole genomes) and of subsequent selection of the plants or animals is therefore excluded from patentability as being essentially biological.

A process consisting solely of steps of crossing, backcrossing, and cultivating a plant, and in which human intervention consists solely of:

- selecting parent plants with desirable characteristics,
- crossing them
- and selecting the offspring, which comes down to a simple choice based on the observation of a natural phenomenon, as a result of which certain plants exhibit interesting morphological characteristics or advantageous agronomic properties,

must be rejected on the grounds that it constitutes an essentially biological process for the production of plants.

Furthermore, a process of this kind that includes a technical step **intended to enable or support the performance** of the steps of sexual crossing or selection of plants or animals is also excluded from patentability, even if that technical step is part of the crossing or selection steps**.**

Conversely, a process is patentable if it includes a technical step that, by itself, introduces or modifies a genetic trait of a plant or animal, as such introduction or modification does not result from the sexual mixing of genes.

The presence of a technical step in the process is necessary for it to be patentable, but it is not sufficient. The nature of the technical step is decisive. It must therefore introduce a genetic modification into the plant or animal that does not result from the mixing of genomes through crossing.

If a claim relates to a process for the production of a plant or an animal that also includes technical steps preceding the process in question (e.g. the preparation of the plant or animal) or following it (e.g. treatment of the plant or animal) that do not introduce or modify a genetic trait of the plant or animal, these preceding and subsequent technical steps are not taken into account when assessing whether that process for the production of a plant or an animal is essentially biological.

In particular, the following are not patentable:

- a process for the production of a plant or an animal, which includes steps of sexual crossing and genetic marker-assisted selection, because it is considered that this genetic marker-assisted selection, although technical, merely supports an essentially biological selection step. The technical step of selection using genetic markers is not responsible for the modification of genetic traits, and therefore for the technical effect.

- a process for the production of a plant intended to improve at least one phenotypic trait selected from grain yield, germination rate, and growth, which comprises overexpressing an enzyme E in the plant. Obtaining the overexpression of an enzyme in the plant may be the result of a natural phenomenon.

- a process for the production of a plant intended to improve at least one phenotypic trait selected from grain yield, germination rate, and growth, which comprises the introgression of a gene consisting of the introduction of the gene into the genome through crossing and selection steps. The step of introgression of a genetic element - which may result from a natural phenomenon - is essentially biological.

- a process for the production of a plant intended to improve at least one phenotypic trait selected from grain yield, germination rate, and growth, which comprises steps of sexual crossing and selection including an embryo rescue step. This embryo rescue step, which does not introduce or autonomously modify any genetic trait of the plant and which supports a naturally occurring process, is essentially biological.

In particular, the following are patentable:

- a process for the production of a transgenic plant or animal using genetic engineering techniques, such as transformation with a recombinant vector.

- a process for the production of a plant intended to improve at least one phenotypic trait selected from grain yield, germination rate, and growth, which comprises transforming a cell of said plant with a nucleic acid that encodes enzyme E, in order to achieve overexpression of enzyme E in the plant.
- a process for the production of a mutant plant or animal using a mutagenesis technique, in particular directed mutagenesis, such as a process for the production of a mutant plant or animal using genome editing techniques (e.g. CRISPR-Cas).

In the case of a claim relating to a process for the production of plants or animals that can be carried out autonomously by an essentially biological process, a ***disclaimer*** should be introduced to clearly exclude the essentially biological process for the production of plants or animals from the claimed subject-matter.

Article 2 of Directive 98/44/EC

The exclusion from patentability of essentially biological processes does not, however, apply to microbiological processes or to the products thereof. "Microbiological process" shall be understood to mean any process involving the use of microbiological material, as well as any process resulting in microbiological material, for example by genetic engineering, or performed upon such microbiological material.

Art. L. 611-19 III

3.3.4 Products exclusively obtained by means of essentially biological processes for the production of plants or animals, including the elements of such products and the genetic information they contain.

Art. L. 611-19 I (3 bis)

Act No. 2016-1087 of 8 August 2016 on the Restoration of Biodiversity, Nature, and Landscapes

(1) Plants and animals exclusively obtained by means of an essentially biological process are not patentable.

An essentially biological process is defined in section 3.3.3. A claim relating to a plant or animal organism that is defined as being obtained by a process such as that defined or exemplified as essentially biological in section 3.3.3 is therefore not admissible.

On the other hand, plants and animals obtained by a technical process - for example, through transgenesis - are patentable if they do not consist of a plant variety or an animal variety and if the technical feasibility of the invention is not limited to a specific plant variety or animal variety (sections 3.3.1 and 3.3.2).

In the case of a claim relating to a plant or animal obtained using a process for the production of plants or animals that can be carried out independently by an essentially biological process, a ***disclaimer*** should be introduced to clearly exclude the plant or animal obtained using the essentially biological process for the production of plants or animals from the claimed subject-matter.

(2) The elements of products exclusively obtained by means of essentially biological processes for the production of plants or animals, and the genetic information they contain, are not patentable.

Constituent elements and genetic information as such - that is, when they are presented in interaction with their natural environment, or when they are isolated or produced by a technical process but without any specific function or application being identified - are excluded from patentability. This is an application of the general principle that discoveries are not patentable.

Similarly, a part of a plant or animal organism obtained through an essentially biological process for the production of plants or animals that is capable of generating a whole plant or animal (propagation or reproductive material such as seeds, embryos, fertilised ova, and plant cells and tissues capable of regeneration) is not patentable if the technical effect in that part is exclusively produced by the essentially biological process.

Art. L. 611-10 (2) (a)

On the other hand, the constituent elements and genetic information contained in plant and animal organisms exclusively obtained by essentially biological processes are patentable, even if they previously existed in nature, provided that they are isolated from their natural environment or produced using technical processes, particularly microbiological ones (isolated genes, isolated proteins, extracts, etc.).

The exclusion from patentability of animals and plants exclusively obtained by essentially biological processes does not apply to biological material obtained by a microbiological process. "Microbiological process" shall be understood to mean any process involving the use of microbiological material, as well as any process resulting

Article 2 of Directive 98/44/EC

in microbiological material, for example by genetic engineering, or performed on such microbiological material.

Art. L. 611-19 III

3.3.5 Processes for modifying the genetic identity of animals, which are likety to cause them suffering without any substantial medical benefit to humans or animals, and animals resulting from such processes.

Art. L. 611-19 I (4)

Processes for modifying the genetic identity of animals, which are likely to cause them suffering without any substantial medical benefit to humans or animals, and animals resulting from such processes are not patentable.

Article 6 of Directive 98/44/EC

Furthermore, such an invention is not patentable because its commercial exploitation would be contrary to public policy or morality.

Art. L. 611-17

Substantial medical benefit must be considered in the fields of research, prevention, diagnosis and therapy.

Recital 45 of Directive 98/44/EC

An invention relating to a transgenic mouse serving as a model for cancer research, involving the introduction of an oncogene into the mouse's genetic make-up to increase its likelihood of developing cancerous tumours, is patentable. While the implementation of the method described in the invention may cause the mouse to suffer (by encouraging the development of tumours), there is also a distinct possibility that cancer research conducted on this transgenic mouse will contribute to medical research.

The aim, therefore, is to weigh the potential suffering endured by the animal against the potential benefit to humanity.

4. INDUSTRIAL APPLICATION

Art. L.611-15

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

4.1. Lack of industrial application

The term "industry" should be understood in a broad sense.

An invention, whether it relates to a device or a process, shall be deemed inapplicable or unusable if it is contrary to well-established physical laws.
For example, a perpetual motion machine, would not be patentable on the ground of lack of industrial application.

The case of gene sequences.

Article 5 and Recitals 22, 23 and 24 of Directive 98/44/EC

Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions sets out provisions relating to the industrial application of inventions relating to a sequence or partial sequence of a gene. Thus, the industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application. A mere DNA sequence without indication of a function does not contain any technical teaching and is therefore not a patentable invention. And where a sequence or a partial sequence of a gene is used to produce a protein or part of a protein, the applicant must specify which protein or part or a protein is produced, or what function it performs, in order to satisfy the criterion of industrial application.

For example, in the case of a nucleotide sequence that does not code for a protein but which may act as a transcription promoter, the industrial application may consist of

using this promoter in *in vitro* expression systems to produce molecules of interest. In the case of a gene sequence encoding a protein, where the function of that protein may be its activity as an enzyme, the industrial application may consist of its use in a process for producing compounds by fermentation.

4.2. Examination by the INPI

The examination carried out by the INPI depends on the filing date of the application.

Art. L.612-12 (7) of the IPC, amended by Act no. 2019-486 of 22 May 2019 (article 122), i.e. the "Business Growth and Transformation Action Plan" (PACTE)

For patent applications with a filing date prior to 22 May 2020:
applications filed before that date, which are not susceptible of industrial application, shall not be rejected by the INPI for that specific reason.

For patent applications filed on or after 22 May 2020,
rejection for lack of industrial application may apply to one or more claims within a given application. A rejection procedure may then be initiated (see Section E, point 2).

In any event, lack of industrial application may constitute a ground for bringing an action for invalidity of the patent before the Courts.

Art. L.613-25

Lack of industrial application shall constitute a ground for opposition to the patent with the INPI, once the patent has been granted (for patents granted from 1 April 2020 onwards).

Art. L.613-23-1 of the IPC amended by Ordinance 2020-116 of 12 February 2020

5. NOVELTY

Art. L.611-11, para. 2

"An invention is considered to be new if it does not form part of the prior art."

5.1. Prior art

Art. L.611-11, para. 2

"The prior art consists of everything made available to the public by a written or oral description, by use, or in any other way before the filing date or the priority date".

Art. L.611-11, para. 3

"The contents of French patent applications and European or international patent applications designating France, as filed, which have an earlier filing date or priority date than the date referred to in the second paragraph of this Article and which were only published on or after that date, shall also be considered to be comprised in the prior art." (Conflicting applications, see Section C, Chapter VIII, point 3.2).

Art. L.611-13

Specific case of the disclosure of the invention itself

"For the application of Article L.611-11, disclosure of the invention shall not be taken into consideration in the following two cases:
- if it occurs within the six months preceding the date of filing of the patent application;
- if it is the result of the publication, after this filing date, of an earlier patent application and if, in either case, it results directly or indirectly from:
(a) a clear case of abuse in relation to the applicant or his/her legal predecessor;
(b) the presentation by the applicant or his/her legal predecessor of the invention at an official or officially-recognised exhibition within the meaning of the revised Convention on International Exhibitions signed in Paris on 22 November 1928.

However, in case (b), the presentation of the invention must have been declared at the time of filing and a certificate of exhibition provided within the time limits and under the conditions laid down by law."

5.2. Novelty assessment

Novelty is established if there is no prior art document providing evidence to the contrary.
Conversely, an invention shall be considered to be lacking novelty if the subject matter of the invention, the features of which are defined in the claims, can be found in its entirety in a single document or disclosure.

Thus, for the invention to lack novelty, its subject matter must be found in a single prior art document with definite character, which presents the constituent elements of the invention in the same form, arrangement and functioning, and in order to achieve the same technical result(s).

Thus, the examiner shall not take into account any prior art document that would disclose, for example:
- equivalent means, since switching from a given form to an equivalent form is a matter for inventive step assessment;
- the same means, associated in the same way, but leading to a different industrial result. Thus, a new use of the DDT compound would not be anticipated by the document making it known as a product or an insecticide. Similarly, the use of a substance for the treatment of plants with a view to influencing their growth is not anticipated by the use of the same substance to control fungi in useful plants.

(a) Sufficient prior art document

In order to determine whether a prior art document discloses the technical features of a claimed invention, its content must be ascertained in the same manner as that which would have been adopted by a person skilled in the art on the date of publication of this document. In order to determine a lack of novelty, the mere fact that these features could have been inferred from this document shall not be sufficient; the technical features must be clearly disclosed in the document without any obvious error.

To assess novelty, the combination of various prior art elements shall not be permitted. In particular, the various embodiments described in a single prior art document cannot be combined in order to arbitrarily create new subject matter that would be citable against the claimed invention, unless the prior art document expressly mentions such a combination.

Example:
In order to assess the novelty of a claim relating to a shearing tool, all of the features of two shearing tools described in the same catalogue cannot be considered as a

whole. The two shearing tools described in the catalogue are two separate objects, which form two independent bases of comparison and must be considered separately in order to assess novelty.

(b) More complex prior art documents

The prior art document may be more complex, i.e. contain additional means in addition to the claimed invention.

Such a prior art document destroys the novelty of the claimed invention on the condition that no difference in the form, function or result appears in the solution proposed in the claimed invention.

However, the technical disclosure contained in the prior art document must be considered in its entirety; it is not acceptable to arbitrarily isolate parts of the document from their context in order to infer technical information that would differ from the overall teaching of the document. Should a difference in form (e.g. needed for a specific adaptation), in function or in the result itself (e.g. any simplification obtained) arise as a result of the separation of the means claimed from the entire content of the prior art document, the prior art document cannot be cited against the novelty of the invention.

(c) Implicit result

A prior art document destroys the novelty of the claimed invention where it discloses the same device or process having, even if only implicitly, the same result. Consequently, this result need not be explicitly disclosed in the prior art document if it is implicitly derivable from the device or process disclosed in the prior art-document.

Example:
Machine for working the soil: a protective part, featuring a specific shape, is arranged laterally in front of the implements. In addition to its protective function, this part serves as a means of support for the machine and evens out the terrain in front of the implements. A prior art document discloses a device, having the same shape and placed in an identical manner on the same machine; however, it only has a protective function and provides support. Given that its shape and position on the machine are identical, the part disclosed in the prior art document implicitly, but quite clearly, also performs the function of evening out the terrain: therefore, the prior art document destroys the novelty of the claimed invention.

(d) Implicit technical features

A prior art document destroys the novelty of the claimed invention if the latter is directly and unambiguously derivable from the prior art document – including any features not explicitly disclosed in the latter – provided that, at the date of publication of the prior art document, such features were common and ordinary in the field in question, well-known and necessary for carrying out the subject matter of the prior art document.

As a general rule, an invention relating to a product intended for a particular use ("product for …", "product intended for …", etc.) is not considered to be new with respect to a same product intended for a different use, unless this particular use requires implicit features that confer novelty on the claimed product.

In the case of a process, the precise indication of its intended use ("process for …") restricts the process to that use, which constitutes a functional characteristic of the process and must be taken into account in the same way as the other stages of the process.

For example:

A claim relates to a heat engine for a motor vehicle comprising:
- a crankcase,
- a cylinder head fixed above the crankcase,
- an air intake system,
- a fresh air cooling section, and
- a cooling chamber for recycled gases.

The crankcase and cylinder head are not explicitly mentioned in the prior art documents found. Nevertheless, they are common and indispensable components of any heat engine, and are widely known in combustion engines: thus, they constitute an implicit structural technical feature of an internal combustion engine. Moreover, these features are not useful to define the subject matter of the invention.

Conversely, the novelty of a claimed invention relating to a mould for molten steel and implicitly comprising specific features, in particular a material resistant to molten steel, shall not be destroyed by the disclosure of an ice cube mould comprising the same explicit features.

(e) General disclosure and specific disclosure

Disclosure of a specific technical element destroys the novelty of any claimed general technical means. On the contrary, disclosure of general technical means does not necessarily destroy the novelty of a claimed specific technical element.

For example:

- A prior art document disclosing the presence of a spring in a device destroys the novelty of a claimed invention relating to this "same device" and comprising an "elastic element", as the generic term "elastic element" encompasses the specific embodiments of the spring, the actuator, the shock absorber, etc.

- Conversely, a prior art document disclosing a general wording such as "substituted aliphatic alcohols having 10 to 22 carbon atoms" does not destroy the novelty of a claimed invention relating to compounds covered by a same wording with only 12 to 15 carbon atoms, except where at least one example of compounds with 12 to 14 carbon atoms has been explicitly disclosed in the prior art document.

(f) Claim categories: process, product and use

If the product claimed is new, then this fact shall confer novelty on the process by which it is obtained and on the use of the product.

However, a new process for manufacturing a product does not confer novelty on the product in itself.

Art. L.613-2, para. 1, Art. L.612-6

An ambiguous claim that relates to both a product and a process, or to a product and its use, is often an incorrectly worded claim which must be interpreted on the basis of the description and/or rectified for lack of clarity, if the invention is novel (see Section C, Chapter IV, points 1 and 3).

Example:
Claim X: insecticidal substance, characterised in that it consists of DDT.
Claim Y: insecticide, characterised by... (definition or formula of DDT)

If a prior art document reveals that DDT as a chemical substance is known and if the description shows that the invention relates to the use of the product as an insecticide, it shall be considered a use invention and novelty shall be recognised.

(g) More on therapeutic uses

Art. L.611-11, paras. 4 & 5

The French Intellectual Property Code does not exclude the patentability of a substance or composition, comprised in the prior art, for use in a method referred to in Article L.611-16, provided that its use for any of these methods is not comprised in the prior art.
Furthermore, the French Intellectual Property Code does not exclude the patentability of a substance or composition referred to above for any **specific** use in any method referred to in Article L.611-16, provided that such use is not comprised in the prior art.

Art. L.611-11, para. 4

- **First medical use**
  A claim relating to a known substance or composition that would be used for the first time in a method for treatment by surgery, for treatment by therapy and/or in a diagnostic method should be worded as follows: "Substance or composition X", followed by an indication of the intended use, e.g., "... for use as a medicament"; or "... for use as an antibacterial agent"; or "... for use in the treatment of disease Y"; or "... for use in a method for treatment by surgery/in a method for treatment by therapy/in an in vivo diagnostic method".

  These types of claims shall be interpreted as being limited to the substance or composition as presented in the view of the use in question. These are claims relating to a **first medical use** of the substance or composition.

Art. L.611-11, para. 5

- **Second (and subsequent) medical use**
  Where a substance or composition is already known for a medical use, a claim relating to a different use that is not disclosed in the prior art shall not be rejected for lack of novelty. It is a claim relating to a **second medical use** or subsequent medical use.

  The use not contained in the prior art shall be considered to be novel, regardless of the fact that **other uses** for surgical/therapeutic/in vivo diagnostic purposes were already known.

  An example of acceptable claim wording for the second medical use could be as follows: "Substance or composition X", followed by an indication of the specific use in a method of treatment by surgery/a method of treatment by therapy/or in an in vivo diagnostic method, e.g., "... for its use in the treatment of disease Y".

Comments

Paragraphs 4 and 5 of Article L.611-11 only apply to substances and compositions whose medical use is not included in the prior art, and not to products other than medical substances or compositions.

Thus, a claim relating to a **medical device** for use in a method referred to in Article L.611-16 (such as: "stent ... for use in the prevention of blood vessel restenosis" or "strip ... for use in the treatment of urinary incontinence") shall not be acceptable under Article L.611-11, paragraphs 4 and 5.

Indeed, such a claim would constitute a device (product) claim, lacking clarity and technical features of a device (see Section C, Chapter IV, points 1.1, 1.2 and 3.2.b).

(h) Independent claims and dependent claims

The novelty assessment starts with the assessment of the independent claims.

Since a dependent claim contains all the features of the main claim to which it refers (plus additional features), if the subject matter of the main claim is new, then all of the embodiments of the invention defined by the dependent claims shall also be considered to be new.

5.3. Assessment by the examiner

The following is not applicable to applications for utility certificates.

The examiner shall assess the novelty of the claimed invention in relation to the prior art, which consists of:

- the documents cited in the preliminary search report, possibly supplemented by one or more supplementary preliminary search reports, and the accompanying opinion on the patentability of the invention (see Section C, Chapter VIII);
- the documents cited by third parties in the case of third-party observations (see Section C, Chapter IX).

The examination carried out by the INPI depends on the filing date of the application.

For patent applications with a filing date prior to 22 May 2020,
only applications whose lack of novelty is clearly apparent from the search report are liable to be rejected (see Section E).

Art. L.612-12, para. 7 as modified by Act no. 2008-776 of 4 August 2008 (Art. 132)

To this end, the technical features set out in the claim and those set out in the prior art document must be identical : the subject matter of the claim must, in an obvious and irrefutable way, be fully anticipated by the prior art document revealing all the technical features of the claimed invention. "Identical" shall also be understood to mean the disclosure of a specific technical means that clearly destroys the novelty of the corresponding general means.

Nevertheless, novelty is taken into account by the INPI to draw up the preliminary search report and the accompanying opinion, the search report that accompanies the granted patent and the documentary report.

Rejection for clear lack of novelty may apply to one or more claims of an application

For patent applications filed on or after 22 May 2020,
lack of novelty shall constitute a ground for the rejection of the application, which shall no longer apply only to applications where the lack of novelty is clearly apparent from the search report (see Section E).

Art L.612-12, para. 7 as modified by the PACTE Act no. 2019-486 of 22 May 2019 (Art. 122)

Thus, the means set out in the claim and those set out in the prior art document must be identical. This means that the prior art document reveals all of the features of the invention, either explicitly (they are explicitly cited in the document) or implicitly.

Rejection for lack of novelty may apply to one or more claims of an application.

In any event, lack of novelty may constitute a ground for bringing an action for invalidity before the courts.

Art. L.613-25

Art. L.613-23-1 as modified by Ordinance no. 2020-116 of 12 February 2020

Lack of novelty shall constitute a ground for opposition with the INPI, once the patent has been granted (for patents granted from 1 April 2020 onwards).

6. INVENTIVE STEP

Art. L.611-14

"An invention shall be considered as involving an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art."

The question of inventive step only arises if the invention is not included in the prior art, i.e., if the requirement of novelty is met. Novelty and inventive step are, however, separate requirements: inventive step should not be confused with an enlarged novelty. On the contrary, it should be assessed using a different method to that used to assess novelty.

In order to determine whether a claimed invention involves an inventive step, it is therefore necessary to consider whether, at the filing (or priority) date and having regard to the prior art at that date, a result corresponding to the claimed invention would have been obvious to a person skilled in the art. If such is the case, the invention shall not be patentable on the grounds of lack of inventive step.

6.1. Prior art

Art. L.611-14

The inventive step examination differs from the novelty examination (see Section C, Chapter VII, point 5.1): conflicting applications do not form part of the prior art and are therefore not taken into account for the assessment of inventive step.

6.2. Person skilled in the art

The person skilled in the art plays a key role in the assessment of inventive step. This person is a reasonably skilled practitioner, deemed to be aware of what constituted common general knowledge in the art at the date of filing (or priority). He/she is presumed to have had access to all the elements making up the prior art.

One of the major difficulties lies in determining the "occupation" of this person. The person skilled in the art is defined having regard to the technical field to which the claim concerned, as a solution to the technical problem posed, relates.

More generally, the person skilled in the art is specialised in the technical field to which the preamble of this claim relates, the preamble containing the technical features that, when combined, form part of the prior art (see Section C, Chapter I, point 1.1).

For example, if a claim relates to a fibreglass fishing rod, the person skilled in the art is, in principle, specialised in fishing rods, not fibreglass.

TGI Paris, 3rd chamber, 14 January 2009, Abbott v. Evysio

However, the wording of the claim and the prior art may result in the person skilled in the art being defined as someone specialised in the subject matter of the characterising portion.
In some cases, the person skilled in the art may be a multidisciplinary team involving specialists in various fields.

Determining the field of practice of the person skilled in the art is of the utmost importance, as his/her level of knowledge will vary from one area of specialisation to another. The manner in which the person skilled in the art apprehends the prior art depends on whether it concerns his/her technical field (which he/she knows perfectly), a neighbouring field (which he/she is capable of understanding without being an

expert) or remote fields (which he/she has trouble having access to and in which he/she can only have access to the basics).

In any event, the person skilled in the art is considered to be someone who carries out tasks: he/she is capable of carrying out tasks perfectly, but is only capable of dealing with simple problems and is not skilled in the art of creation. To conclude, the person skilled in the art is biased by the technical prejudices in his/her discipline and belonging to his/her time.

6.3. Obviousness

Obviousness is the quality possessed by something that is immediately and clearly apparent, and which leaves no doubt in the mind. Therefore, an invention does not involve inventive step if, for a person skilled in the art, it obviously and logically follows from the prior art and does not surpass expectations in terms of ordinary technical progress, i.e. does not require a more advanced qualification or skill than may be reasonably expected of a person skilled in the art. In other words, an invention does not involve inventive step if, for a person skilled in the art, it is merely the result of the carrying out of simple operations.

6.4. Assessing inventive step

In order to ensure inventive step is assessed as objectively as possible, particular care must be taken to avoid the dangers of *ex post facto* analysis, by favouring the problem-solution approach and/or by using secondary indicators or criteria to determine inventive step.

(a) Dangers of *ex post facto* analysis

For practical reasons, inventive step is not assessed on the basis of the prior art as a whole, but on the basis of a selection of documents identified in the course of a prior art search. However, it is often easy to demonstrate, theoretically or academically, that it was possible to proceed from these documents to the invention by means of a series of apparently easy steps. In order to avoid the risk of such *ex post facto* analysis, the examiner must always bear in mind that these documents were searched for and found while having foreknowledge of the invention. In order to remain objective, the examiner must therefore try to visualise the overall prior art confronting the person skilled in the art at the filing (or priority) date, before the inventor's contribution. As such, any documents that lean away from the invention are just as important as those that come close to the invention.

(b) The problem-solution approach

The problem-solution approach is an objective assessment of inventive step. It involves three stages:
- determining the closest prior art;
- establishing the objective technical problem to be solved; and
- assessing obviousness.

Determination of the closest prior art

The closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for a development leading to the invention. In selecting the closest prior art, the first consideration is that it must be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention.

Formulation of the objective technical problem to be solved

In order to formulate the objective technical problem to be solved, it is necessary to:
1: Identify the difference(s) between the claimed subject matter and the closest prior art
2: Identify the technical effect resulting from this/these difference(s)
3: Formulate an objective technical problem, on the basis of the identified technical effect

Since an invention is a technical solution to a technical problem, the inventive step that may be involved in an invention must be assessed having regard to the problem that the invention is intended to solve, and the manner in which it solves that problem.

Art. R.612-12 (3)

Determining the technical problem that the claimed invention is intended to solve is therefore an essential part of inventive step assessment. In principle, this problem should be explicitly set out in the description, which must provide "disclosure of the invention, as claimed, in such terms that the technical problem and the solution proposed can be understood; where appropriate, any advantageous effects of the invention with reference to the background art should also be stated".

In any event, it is generally accepted that an invention that makes it possible to solve a technical problem for the first time, either because the problem was never raised in the prior art or because it was raised but could not be solved, involves an inventive step.
If the problem was never raised in the prior art, it shall be referred to as a "new problem" or a "problem invention", and it does not matter whether the solution to the problem appears retrospectively trivial or obvious.

Such inventions are, however, relatively rare and, in most cases, the examiner shall be required to pursue his/her research by studying the solution provided by the invention to the problem raised.

Obviousness assessment
The question that then arises is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would) prompt the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching so as to obtain something falling within the terms of the claim, and thus making it possible to achieve the same result as the invention.

Thus, a person skilled in the art who would be prompted to combine documents with each other or parts of the same document with each other to arrive at the claimed invention would render the claimed invention devoid of inventive step.

When analysing the various documents, the general knowledge of the person skilled in the art at the filing (or priority) date of the application must be taken into account.

In practice, it is generally agreed that solving a given technical problem by means of technical features already used in a neighbouring technical field to solve a similar problem does not involve inventive step.
For example: an invention consisting in the application of a pulse control process to the electric motor driving the auxiliary mechanisms of an industrial vehicle, such as a fork-lift truck, is not deemed to involve inventive step, since the process to control the propulsion motor of the truck was already known.

On the contrary, solving a problem by means of technical features already used in a remote technical field to solve a different problem shall be deemed to involve inventive step.

For example, a manufacturer who has developed a space-saving door for a cabinet containing data processing equipment would not be expected to have conducted research in the area of aircraft hangar doors.

These two examples are both at the opposite ends of the spectrum, and many inventions fall in between. The question of the obviousness of the solution shall therefore need to be answered on a case-by-case basis, with the help of secondary indicators or criteria for determining inventive step.

(c) Secondary indicators or criteria

The presence of indicators merely constitutes a presumption; it is not in itself necessary or sufficient to establish the existence or lack of inventive step.

For example, it is clear that technical progress is not a criterion for patentability. The table below groups together a number of indicators that are either favourable or unfavourable to the existence of inventive step.

	INDICATORS OF THE PRESENCE OF INVENTIVE STEP	
	Favourable indicators	**Unfavourable indicators**
Prior to the invention	Prior art is very old Prior art is dispersed Patchwork of at least three documents Invention meeting a long-standing unsatisfied need Problem addressed differently Prolonged period of time between discovery of the product and its use Novelty of the technical problem	Problem already raised in an identical manner
At the time of the invention	Technical prejudice overcome Invention moving in a direction contrary to that generally followed in the field in question Technical difficulties overcome Selection among a large number of possible solutions	Extrapolation in a straightforward way from a known technique Systematic and purely routine testing Choice between a small number of known, equally credible solutions Substitution of well-known equivalents New use of a well-known material, by making use of its known properties Predictable function Standard adaptation Implicit or predictable result
After the invention	Synergy effect Significant technical progress Unexpected result Big gap between the invention and the prior art Commercial success owing to technical qualities	

d) Substitution and grouping of means

The examples of inventions or standard categories of inventions ("Substitution of means" and "Grouping of means") set out below are not intended to be exhaustive; each invention must be studied on a case-by-case basis and no attempt should therefore be made to subject it to a pre-established framework.

These examples sometimes refer to the notion of "means". For the purposes of examining patentability, "means" shall be understood to refer to a technical element which, when applied in a given context, performs a function and produces a result.

- **Substitution of means**
  It is generally agreed that any invention consisting in the replacement of one means with another means, known to be equivalent, does not involve inventive step.
  Two means are said to be equivalent if, when subject to the same application, they perform the same function and produce the same result.

  For example:

  in a mechanical application where only an elastic force is sought, a coil spring must be considered equivalent to a leaf spring. This would not apply if a damping effect is also sought, as the leaf spring is capable of exerting this damping effect on its own thanks to inter-leaf friction, whereas a coil spring is not.

- **Grouping of means**
  It is generally agreed that the **juxtaposition of known means in a new manner** does not involve inventive step. The term "juxtaposition of means" refers to when the result obtained by the grouping of means is equal to the sum of the results obtained by each of the means within the group when considered individually.

  For example:

  a new sausage-making machine consisting of the association of a known meat grinder and a known stuffing device would be considered a juxtaposition of means that does not involve inventive step.

  The term "combination of means" refers to when the result obtained by the grouping of means is greater than the sum of the results obtained by each of the means within the group when considered individually; in other words, when there is a synergy effect due to the functional interaction of the different means within the group.

  For example:
  the association, on the same railway bogie, of a conventional motor driving the wheels and a linear motor using the running rails as a frame must be considered a combination of means. In this instance, the linear motor acquires, in addition to the thrust component, a component perpendicular to the running surface, which increases wheel grip and therefore improves the performance of the conventional motor.

  The existence of an enhanced result is usually an indication of inventive step. However, it should not be ruled out that a combination presenting an enhanced result may be obvious to a person skilled in the art and would therefore be considered lacking inventive step.

e) Selection

The term "selection" refers to when, within a family known to possess a specific property, a sub-family is selected. The novelty of this sub-family shall be established if none of its members has been previously exemplified in the prior art document (see Section C, Chapter VII, point 5.2.d). Inventive step shall be established if the choice of this sub-family makes it possible to solve a specific problem (for example, to exacerbate the known property, obtain a particular advantage or eliminate a known disadvantage) and if –provided that the inventive step is not established solely in view of the statement of the problem– the prior art does not prompt a person skilled in the art to make this choice.

Example

A family of products, with a general AxBy formula, is known to have hair-removing properties. However, all known members of the family present the drawback of being either unstable or toxic, or both unstable and toxic. A new selection would consist in selecting, within this family, a sub-family that does not include any of the known examples. This selection may be defined by applying a condition to x and a condition linking x and y, and be completed by a few more specific examples. Such a selection may involve inventive step where the members of the sub-family, while maintaining hair-removing properties, are neither unstable nor toxic, and where the choice of this sub-family would not be obvious to a person skilled in the art, for example because the known examples closest to the limits of this sub-family were among the worst hair-removing products and both unstable and toxic.

The principles of selection are often considered to apply to the field of chemicals alone, but they can in fact be applied to other technical fields: selection can concern, for example, dimensional ratios in a device, or temperature/pressure conditions in a process.

(f) Claims having technical and non-technical features

To assess the inventive step of claims having both technical and non-technical features, only features contributing to the technical character of the invention shall be taken into account.

(g) Independent claims and dependent claims

The inventive step assessment starts with the assessment of the independent claims.

Since a dependent claim contains all the features of the main claim to which it refers (plus additional features), if the subject matter of the main claim involves inventive step, then all of the embodiments of the invention defined by the dependent claims shall also be considered to involve inventive step.

6.5. Assessment by the examiner

The following is not applicable to utility certificate applications.

In assessing the inventive step of the claimed invention, the examiner shall take into account the date of filing the application.

The prior art consists of:

- the documents cited in the preliminary search report (excluding conflicting applications, see Section C, Chapter VIII, point 3.2), possibly supplemented by one or more supplementary preliminary search report(s), and the accompanying opinion on the patentability of the invention (see Section C, Chapter VIII);

- the documents cited by third parties in the case of third-party observations (see Section C, Chapter IX).

The examination carried out by the INPI depends on the date of filing the application

Art. L.612-7, para. 7 as modified by Act no. 2008-776 of 4 August 2008 (Art. 132)

For patent applications with a filing date prior to 22 May 2020:
The French Intellectual Property Code does not provide for the rejection of a patent application for lack of inventive step.
Consequently, the examiner cannot reject an application on this ground.

However, inventive step is taken into account by the INPI in drawing up the preliminary search report and the accompanying opinion, the search report that accompanies the granted patent (see Section C, Chapter VIII) and the documentary report.

Art. L.612-7, para. 7 as modified by the PACTE Act no. 2019-486 of 22May 2020 (Art. 122)

For patent applications filed on or after 22 May 2020:
The French Intellectual Property Code provides for the rejection of applications where the invention does not involve inventive step, on the basis that their subject matter is not patentable in accordance with the first paragraph of Article L.611-10 (see Section E).

Rejection for lack of inventive step may apply to one or more claims of an application.

Art. L.613-25

In any event, lack of inventive step may constitute a ground for bringing an action for invalidity before the courts.

Art. L.613-23, para. 1 as modified by Ordinance no. 2020-116 of 12 February 2020

In addition, lack of inventive step shall constitute a ground for opposition to the granted patent before the INPI (for patents granted on or after 1 April 2020).

CHAPTER VIII – SEARCH REPORT

1. DEADLINES

Art. L.612-14

Art. R.612-45

Any patent application that has received a filing date and whose contents allow for a search report to be drawn up (see Chapter II, 1.3 and Chapter IV, 1.3) shall be subject to a documentary search, the result of which shall be presented in the form of a preliminary search report together with a written opinion on the patentability of the invention. This search procedure shall only be initiated if the applicant has paid the search report fee within a period of one month from the date of filing of the patent application. If payment is not made within this period, the patent application shall be rejected (see Section B, Chapter II).

2. ROLE OF THE PRELIMINARY SEARCH REPORT

Art. R.612-57, para.1

"A preliminary search report shall be drawn up [...]. It shall cite the documents that may be taken into consideration to assess the patentability of the invention which is the subject of the patent application. It shall be accompanied by an opinion on the patentability of the invention in relation to the documents cited. This opinion shall be made available to third parties in the patent application file.

The preliminary search report and the opinion shall be drawn up on the basis of the claims filed, taking into account the description and, where appropriate, the drawings."

The preliminary search report shall therefore have an informative role:

- **with respect to the applicant**: the results of the documentary search and, where applicable, the third-party observations (see Chapter IX) must enable him/her to ascertain the scope of the exclusive rights to which he/she shall be entitled. The applicant will then generally make the necessary adjustments to his/her claims in order to take into account the prior art that has been brought to his/her knowledge.

- **with respect to third parties**: the purpose of publishing the preliminary search report is to provide third parties with information on the patentability of the invention and to enable them to inform the INPI and the applicant of the existence of any documents that may be more relevant and of which they are aware (see Chapter IX).

3. CONTENT OF THE PRELIMINARY SEARCH REPORT

Art. R.612-57

The preliminary search report shall cite the documents that may be taken into consideration to assess the novelty of the invention, i.e. the subject of the patent application, and to determine the existence of an inventive step.

"Each citation shall be made in relation to the claims to which it relates. If necessary, the relevant sections of the cited document shall be identified by indicating, in particular, the number of the page, column, line or figure concerned.

The preliminary search report shall distinguish between the cited documents that were published before the priority date, between the priority date and the filing date, on the filing date itself and on any subsequent date.

Any document referring to the use or disclosure of the patent application in any form (including orally), which took place before the filing date, shall be cited in the

preliminary search report with indication of the date on which the related document was published or the non-written disclosure was made.

3.1. Categories of documents

All documents cited in the preliminary search report are identified by a code (letters) in the left-hand column. These letters indicate the degree of relevance or a specific feature of the document:

X: A document marked with the letter 'X' shall prevent the claimed invention from being regarded as new or as involving an inventive step.

Y: A document marked with the letter 'Y' shall prevent the claimed invention from being considered to involve an inventive step, if combined with one or more other documents of the same category and if this combination would be obvious to a person skilled in the art.

A: A document marked with the letter 'A' illustrate the technological background.

E: The letter 'E' shall be used to indicate any patent document which is a conflicting application, i.e. a document bearing a filing date prior to that of the application under review, and published on or after that date (conflicting document).

O: Stands for 'non-written disclosure'.

D: Indicates a document cited in the description

P: Refers to intermediate documents, with a publication date between the priority date (the earliest date applicable, if there is more than one) and the filing date of the application.

L: Denotes a document cited for a particular reason (e.g., raising doubts as to the merits of a priority, confirming the date of publication of a document, etc.). Documents marked with an '**L**' may or may not form part of the prior art depending on their date of publication.

T: Denotes a document relating to the theory or principle underlying the invention and fulfilling the following two conditions:

- its publication date is **later** than the filing (or priority) date of the application;
- it does not represent a conflicting application.

Documents of this kind, which explain the theory or principle underlying the invention or show its inaccuracy, shall not be considered to form part of the prior art.

A single document may be assigned several letters, e.g., **DY =** a document cited in the application, which is particularly relevant when paired with a **Y** document.

The preliminary search report may be supplemented by an additional document indicating, for each patent document cited, all of the other patent documents belonging to the same family, i.e., all patent documents based on the same priority application.

Any dependent claim shall be mentioned alongside the document that discloses its additional feature; this document must be examined in combination with the documents cited in relation to the claim on which the secondary claim is dependent.

Any dependent claim having a "mundane" (commonly known) feature shall not be mentioned in the preliminary search report if no document found in the course of the search revealed the feature contained in said claim or demonstrated its lack of

inventive step. This does not mean that the feature in question involves an inventive step.

3.2. Specific case of intermediate documents and conflicting applications

(a) Documents marked with the letter "P"

Documents marked with the letter 'P' are "intermediate" documents, with a publication date between the priority date and the filing date of the application being examined. If more than one priority date is claimed, the earliest date shall be taken into account.

An INTERMEDIATE document can therefore only be cited in objection to an application claiming PRIORITY.

Any type of document may be cited as an INTERMEDIATE document and may be prejudicial, on the grounds of novelty or inventive step, to the patent application under examination if its claim to priority is not valid.

(b) Documents marked with the letter "E"

The letter 'E' shall be used to indicate any patent document bearing a filing date prior to that of the application being examined and published on or after that date. These documents include the following:

- **Any FR, EPO/FR or PCT/FR patent documents** that constitute conflicting applications.

Art. L.611-11, para. 3

A conflicting application is a patent application that matches the following criteria:
- it concerns a French, European or international application designating France (EPO/FR or PCT/FR);
- it has a filing (or priority) date prior to that of the application being examined (or the corresponding priority);
- it was not published until the filing (or priority) date of the application being examined or until a later date.

Conflicting applications can only be cited in objection to novelty.

Art. R.612-20 (EPC A85) (PCT A3)

It is the content of the earlier application (the E document) as filed that shall be taken into consideration for determining novelty; the abstract shall not be taken into consideration for such purposes.

If a patent application filed on the same date as the application being examined is cited in the preliminary search report and marked with the letter **'E'**, this document shall not be prejudicial, even if the applications are identical, if no priority right has been claimed for the **E** document. In any other case, the **E** document may constitute a conflicting application, depending on whether the claim to priority is valid.

It should be noted that, at this point in time, a search for conflicting applications is not carried out systematically after the preliminary search.

- **Documents relating to foreign patents**

  Since conflicting applications can only consist of an FR, an EPO/FR or a PCT/FR patent application, an **E** document in the form of a foreign patent or a foreign patent application shall not be prejudicial to the application being examined.

(c) Documents marked with the letters "PX"

If a document meets the requirements for **P** documents and for **X** documents, it shall be treated as a **PX** intermediate document.

These documents are particularly relevant intermediate documents and may be used to object to the novelty or inventive step if priority is not validly claimed.

3.3. Partial preliminary search report

In some cases involving "complex" applications, only a partial search is carried out, as an in-depth search is not possible for some of the claims or parts of the claims. This occurs, in particular, when:

- a broad or speculative claim is based on limited disclosure of the invention in the description, in which case the search is carried out on the basis of the invention subject to the limited disclosure;
- there are too many claims;
- a single claim covers too many possibilities (in particular, for chemical compounds);
- a claim defines the invention in unclear terms that are unknown in the prior art;
- a claim defines the invention on the basis of the result being aimed for
- the application consists of several different inventive concepts (lack of unity) (see Section C, Chapter VI).

The partial preliminary search report shall be accompanied by a supplementary sheet indicating which claims were partially searched or not searched at all, and the reasons why only a partial search was carried out.

3.4 Opinion

The preliminary search report shall be accompanied by an opinion on the patentability of the invention. This opinion is intended to help the applicant interpret the preliminary search report with respect to novelty and inventive step.

4. PRELIMINARY SEARCH REPORT DRAWN UP ON THE BASIS OF A FOREIGN SEARCH REPORT

4.1. Provision of prior art documents

Art. R.612-56-1

In the case of a patent application claiming the priority of at least one foreign application, which relates to the same invention as that which was the subject of the French patent application, the INPI may request that the applicant provide any information at its disposal, on the date of notification, relating to the prior art that was taken into consideration in the patent procedure before the foreign patent office(s). In addition to the published patents and patent applications, the INPI may request that the applicant provide any documents cited and that the relevant passages (translated into French) be clearly indicated.

The applicant shall have a period of two months, which may be renewed once, from the date of receipt of this request to communicate all of the above information to the INPI.

Should the applicant fail to respond within the time limit set in the abovementioned request, his/her application shall be rejected.

4.2. Amendment of claims after the search report for the priority application has been filed

The documentary search shall be deemed to commence on the day on which the applicant provides the information on the prior art that was taken into consideration in the examination of applications relating to the same invention, or justifies his/her inability to produce such documents. As a result, the applicant shall not be entitled to

amend the claims at his/her own initiative until he/she has been notified of the French preliminary search report.

Order on the procedural fees collected by the INPI

4.3. Specific case: preliminary search report based on a foreign search report recognised as being equivalent to the French search report

The search report fee shall be reduced for applications claiming foreign priority accompanied by a search report recognised as being equivalent to the French search report by decision of the Chief Executive Officer of the INPI.

4.3.1. Patent applications concerned

PIBD no. 526
PIBD no. 616

Decisions 92-286, 92-287 and 96-408 of the Chief Executive Officer of the INPI recognise such equivalence for Swiss, Dutch and Belgian search reports on the condition that:

- the content of the priority patent application and that of the French patent application are identical;
- the search report drawn up on the basis of the priority application is provided at the time of payment of the search report fee.

4.3.2. Verification of applications concerned

Where the applicant benefits from the reduced-rate search report fee, the following conditions must be verified:
(a) the priority application is Swiss, Dutch or Belgian;
(b) the applicant provided the search report drawn up on the basis of the priority application at the time of payment of the search report fee;
(c) the applicant has provided a copy of the documents cited in the search report;
(d) the applicant has provided a written statement confirming the identical nature of the contents of the French application and the priority application and the equivalence between the claims of the French application and those of the priority application, on the basis of which the search report was drawn up.

Claims shall be deemed to be equivalent if the only differences in the content of the French claims and that of the priority claims consist of cosmetic changes designed to remedy deficiencies reported by the examiner prior to the filing of the search report of the priority application.
If conditions (**a**) and/or (**b**) are not met, the applicant shall be requested to pay a full search report fee.

If conditions (**c**) and/or (**d**) are not met, the applicant shall be requested to provide a copy of the documents and/or the written statement set out in point (**d**) so as to enable the examiner to draw up the French preliminary search report.

5. PROCEDURE FOR DRAWING UP THE PRELIMINARY SEARCH REPORT

5.1. Notification of the preliminary search report

Art. R.612-58

"The preliminary search report shall be immediately sent to the applicant who, if prior art documents are cited, shall be required, subject to refusal of the patent application, to file new claims or submit observations to support the claims being upheld."

Art. R.612-59

"The applicant shall have a period of three months, which may be renewed once, as from notification of the preliminary search report, to file new claims or to submit observations for the purposes of debating the prejudicial nature of the prior art

documents cited." Requests for the renewal of this period must be made **before the expiry of the first three-month period.**

Art. R.612-62

"The preliminary search report shall be made public at the same time as the patent application, or, if it has not yet been drawn up, once the applicant has been notified. Its availability to the public shall be made known in the Official Bulletin of Industrial Property."

5.2. Applicant's response to the preliminary search report

5.2.1. Obligation to reply

Art. R.612-58
Art. L.612-12 (9)

Within the aforementioned period of three months, which may be renewed once, from the date of receipt of the preliminary search report and only within that period, the applicant:

Art. R.612-51

- **may** reply if he/she so wishes, in all cases, even where the preliminary search report does not cite relevant documents.

- **must** reply where the preliminary search report cites prior art documents, in particular **X**, **Y**, or **E** documents that may be **prejudicial**. In the absence of a reply, a formal notice shall be sent to the applicant, setting a new time limit for him/her to reply to the preliminary search report. Failure to reply to the formal notice shall result in the rejection of the application.

Any reply received after this time limit shall not be admissible.

5.2.2. Content of the reply

Art. R.612-58

The applicant's reply may consist of observations in support of the claims being upheld or a revised version of the claims, which may be accompanied by observations in support of the amended claims.

(a) Claims upheld

The purpose of the observations is to discuss the prejudicial nature of the prior art documents cited.

In light of this, an observation shall not constitute a reply within the meaning of the French Intellectual Property Code if it only consists of:

- a request for correction of material errors on the basis of Article R.612-36;
- a statement of the advantages of the invention;
- a statement of the features of the invention **without** any comparison being made with the prior art documents, provided that such comparison is not implied;
- an affirmation of the validity of the claim to priority, unless the obligation to reply relates only to **PX** or **E** documents.

(b) Amended claims

Art. R.612-60

The amendment of claims in response to the preliminary search report must consist of the actual filing of the new claims accompanied by a copy on which the amendments are highlighted and, where appropriate, the applicant has indicated, by way of comments, the passages of the original application on which the amendments are based.

Art. R.612-59

During the time limit for replying to the preliminary search report, the applicant may amend the claims several times. In such cases, only the last set of claims supplied shall be taken into consideration in establishing the search report.

In the absence of any significant observations, an amendment shall not be deemed to constitute a reply within the meaning of the French Intellectual Property Code if it only consists of:

- a correction of an error that does not affect the substance with respect to the prior art document cited;
- a cosmetic change.

The filing of new claims or observations that do not constitute a reply within the meaning of the French Intellectual Property Code shall result in the start of the procedure to reject the application.

5.2.3. Amendment of the description and drawings

Art. R.612-60

If the claims are amended in response to the preliminary search report, the applicant may request authorisation to "delete any elements of the description and drawings that no longer correspond to the new claims. This request shall be admissible up to the date of payment of the fee for the grant" and only if the claims have been amended in response to the preliminary search report.

The amendment of the description must consist in the deletion of elements contained therein. **No new matter may be introduced in the description.** Such deletion may only concern elements that are no longer in keeping with the new claims. This amendment may take the form of:

- the deletion of examples that are no longer claimed;
- the restrictive addition, to a paragraph of the disclosure of the invention, of specific details already contained in the original description, provided that the new claims containing such an addition were previously considered as being based on the original description.

6. SUPPLEMENTARY PRELIMINARY SEARCH REPORT

Art. R.612-65

"The preliminary search report may be supplemented at any time prior to the drawing up of the search report."

6.1. Cases in which a supplementary preliminary search report is required

(a) Need to carry out a supplementary search following the filing of new claims

Art. R.612-61

If the subject matter of the new claims is not covered by the original claims, the applicant shall receive notification to pay the fee for the preparation of a supplementary preliminary search report. "Original" claims are those upon which the preliminary search report was based; as a result, they are not always identical to the claims filed. "New" claims are those which were filed last; they may therefore include claims that were corrected in response to a notice of deficiencies issued by the INPI.

This provision, which is based on the assumption that the claims are supported by the description, requires the comparison of the amended claims with the claims upon which the preliminary search report was based. It is important to ensure that the amended claims relate to the same subject matter as the preliminary search; this helps to ensure that the preliminary search report was properly drawn up on the basis of a full documentary search.
In particular, a supplementary preliminary search report may be required for new claims which, despite being based on the description:

- constitute a generalisation or broaden the scope of the claims filed originally;
- modify the inventive concept (for example, a previously unclaimed alternative);
- include claims of a category (process, product) that was not previously claimed.

(b) For patent applications with a filing date prior to 22 May 2020,

the examiner attributes the letter 'X' (see 3.1 above) **to a document that was not marked as such** in the preliminary search report, if the document in question has clearly an impact on novelty (see Section C, Chapter VII, 5.3).

(b') For patent applications filed on or after 22 May 2020,

the examiner attributes:

the letter 'X' (see point 3.1 above) **to a document that was not marked as such** in the preliminary search report, if the document in question has an impact on novelty (see Section C, Chapter VII, 5.3).

the letters 'X' or 'Y' (see point 3.1 above) **to a document (where applicable, to two documents in case of a 'Y') that was not marked as such** in the preliminary search report, if the document in question has an impact on inventive step (see Section C, Chapter VII, 6.5).

(c) New documents that may constitute prior art documents are revealed after the preliminary search report has been drawn up. These documents may constitute:

- conflicting applications, once they have been published;
- documents of which the examiner is aware;
- documents indicated by the applicant;
- third-party observations (see Chapter IX).

In cases (b) and (c), no fee shall be due for the supplementary preliminary search report.

6.2. Format and procedure

The format of the supplementary preliminary search report shall be the same as that of the preliminary search report.

If the preliminary search report has not yet been published, and to avoid the simultaneous publication of two preliminary search reports, the supplementary preliminary search report shall take the form of a new preliminary search report that combines the contents of the original preliminary search report with any supplementary elements. This new preliminary search report shall cancel and replace the original preliminary search report.

The supplementary preliminary search report shall be notified to the applicant and the same procedure shall be followed as for the drawing up of the original preliminary search report (see point 5 above).

7. DRAWING UP OF THE SEARCH REPORT

Once all of the time limits have expired, the examiner shall determine the definitive content of the search report on the basis of:

- the preliminary search report, which may be supplemented;
- the latest claims provided by the applicant;
- any observations made by the applicant;
- any third-party observations (see Chapter IX).

All of the documents cited in the course of the procedure are classified into three groups, taking into account the replies received:

- the first group consists of documents that remain likely to be taken into consideration in assessing the patentability of the invention;
- the second group consists of documents that illustrate the general technological background alone;
- the third group consists of documents whose relevance depends on the validity of the claims to priority.

CHAPTER IX – THIRD-PARTY OBSERVATIONS

Art. L.612-13, para. 3

Any person may submit written observations to the INPI relating to the novelty or inventive step of the invention to which a patent or utility certificate application relates.

However, these observations must, on pain of inadmissibility, comply with certain time limits and requirements in terms of format.

1. TIME LIMIT

(a) Patent applications

Art. R.612-63, para.1

Third parties may submit written observations as soon as the patent application is published and up to three months after publication of the preliminary search report concerning the patent application.

Art. R.612-64

These observations shall then be communicated to the applicant, who is not obliged to reply. If the applicant wishes to reply, he/she must do so within a period of three months, which may be renewed once (the request for renewal must be made before the expiry of the first three-month period).

The applicant's reply may consist in observations and/or new claims.

Art. R.612-65

Third-party observations made after the abovementioned time limit will be considered inadmissible and will be communicated to the applicant for information purposes only.

(b) Applications for utility certificates

Art. R. 616-1

Third parties may submit observations relating to an application for a utility certificate until the expiry of a three-month period from the date of publication of the application. These observations shall be communicated to the applicant, who has a period of three months – which may be renewed once upon their request – to respond to them.

.

2. CONTENT AND PRESENTATION

Art. R.612-63, para. 2

Art. R.612-57

On pain of inadmissibility of third-party observations, their presentation must comply with the format of the preliminary search report, as defined in Article R.612-57 (see Section C, Chapter VIII, point 3), except for the assignment of a code.

The documents cited must be provided on pain of inadmissibility, except in the case of patents. However, the INPI may request a copy of foreign patents, which must be provided within two months of the date of receipt of such a request.

3. DOCUMENTS AFFECTING PATENTABILITY

Art. L.612-12, para 7 as modified by Act no. 2008-776 of 4 August 2008 (Art. 132)

For patent applications with a filing date prior to 22 May 2020,
if the third-party observations communicated to the applicant cite a document that clearly affects the novelty of the invention claimed (see Section C, Chapter VII, point 4.3), the examiner shall draw up a supplementary preliminary search report (see Section C, Chapter VIII, point 5.1c), as rejection for clear lack of novelty can only be made on the basis of a document from the search report.

Art. L.612-12, para 7 as

For patent applications filed on or after 22 May 2020,

modified by the PACTE Act n° 2019-486 of 22 May 2019 (Art. 122)

rejection for lack of novelty and/or inventive step can only be made on the basis of prior art documents cited during the course of the procedure: preliminary search report (where applicable, supplementary preliminary search report) and third-party observations communicated to the applicant.

CHAPTER X - CORRECTION OF ERRORS

Art. R.612-36, para.1

"Up to the date of payment of the fee for the grant of the patent, the applicant may submit a request to correct errors of wording or of copying, in addition to any material errors discovered in the documents submitted." (See Section B, Chapter VI on the correction of errors).

Such a request shall be made either at the initiative of the applicant or in response to a notification from the examiner informing him/her of the deficiency.

The request must comply with strict formal and substantive conditions as set out below.

1. PAYMENT OF THE FEE

Art. R.612-36, para. 3

Requests to correct errors shall only be admissible if the applicant can provide proof of payment of the related fee.
This fee is due for each request, regardless of the number of errors or pages concerned. Additional evidence provided after submission of a request shall not entail payment of an additional fee.

The fee shall not be refunded by the INPI regardless of the outcome of the procedure (acceptance or rejection).

The correction of errors in the abstract shall be free of charge. Such errors may only be corrected if the amended text can be found in the description (see Section C, Chapter V, point 3).

2. PRESENTATION OF REQUESTS

Art. R.612-36, para. 3

The request must be made in writing and shall include the proposed changes to the text. The request may pertain to any of the documents submitted during the procedure.

Any changes that are made either to the text of the description or claims or to drawings must be filed **in a single document** in Open XML (.docx) format.
The names of the parties must comply with the instruction notice relating to Open XML documents available at https://procedures.inpi.fr

However, for applications filed before 19 November 2018, it is possible to provide **only the amended document(s)** in its (their) entirety **in a single PDF document**. The INPI may request that the amended document(s) be accompanied by a copy in which the changes have been clearly marked.

3. CONDITIONS GOVERNING THE ACCEPTANCE OF REQUESTS TO CORRECT ERRORS

▶ 3.1. Errors that may be corrected

Art. R.612-36, para. 2

A correction may be accepted if the applicant can prove:
(a) that there is an error;
(b) that the error is material, not conceptual;
(c) if the request concerns the description, the claims or the drawings, that the correction is obvious and is the only possible solution, as it is obvious that the applicant could not possibly have intended any other wording or layout.

(a) The existence of the error must be beyond doubt

The existence of the error must be apparent from the application documents or from supporting documents with a date prior to the filing. For example:

- The text contains a glaring contradiction:
  - difference between the text and the chemical formula;
  - difference between the general wording and the examples provided.

- Content is clearly missing from the application:
  - incomplete, incomprehensible sentence(s);
  - blank table(s) with no values.

- The description includes sentences that are completely irrelevant or duplicate passages.

- The text contains an incorrect translation of a term found in the certified copy of the priority document.

- The description and drawings of two patent applications filed on the same day have been switched.

- The title indicated on the request does not correspond to the content of the description and claims and does not correspond to the drawings.

- A specific feature of an original claim does not appear in the description or in the drawings (see Chapter IV, point 1.4, a).

A passage in the description of a patent application that quotes an earlier application, which was withdrawn before publication and no longer legally exists, may also be regarded as an error.

However, if the text does not clearly contain an inconsistency and can be perfectly understood without any correction being made, the existence of an error shall not be established. A mere difference between the French application and the certified copy of the priority document shall not in itself constitute proof of an error (see point 3.2.c).

(b) The error must be material, not conceptual

A material error shall be understood to mean an error made at the time the various application documents were being prepared. For example:

- a typing or spelling error;

- a mistake made inadvertently on the drawings, such as a reference inserted in the wrong place or a cross sectional view in the wrong place;

- the incorrect translation of a term in the certified copy of the priority document.

However, the following cannot be corrected:

- an error in the design of the invention, whether it consists of a calculation error or an error in the very structure of the device of the invention, even if it is obvious that the device would not be able to function;

- an error made during the trial phase of the invention, such as an incorrect lab result due to a faulty apparatus;

- an error in the patent drafter's understanding of the invention.

(c) The correction must be obvious (only one possible solution)

Art. R.612-36, para. 2

"If the request concerns the description, the claims or the drawings, the correction shall only be authorised if it is obvious, as it is obvious that the applicant could not possibly have intended any other wording or layout."

Example:

- The equation "2 + 8 = 16" contains an obvious error; however, the correction is not obvious, as there is more than one possible solution: the error could concern any of the five values (numbers/signs). In the absence of any other evidence (see point 3.2.), permission shall not be granted to correct such an error.

- In spite of an inconsistency between two values appearing in two columns of a table, permission to correct the error shall not be granted if the error could relate to either of the two values.

- In the event of an inconsistency between an original claim and a passage in the description, permission to correct the error shall not be granted if the error could have been made in either the claim or in the description, and no obvious solution exists as there is more than one possible solution (see Chapter IV above). However, permission to correct the error will be granted if it is obvious from the patent application as a whole, or from a supporting document having a date prior to filing, that the error clearly relates to either of these elements.

3.2. Justification of the requested correction

Except in the case of an obvious error, such as a spelling mistake, justification must be provided. This may be based on:

(a) The text of the patent application itself

For example, permission to correct a general formula may be granted in order to harmonise it with the set of examples provided in the description.

(b) Scientific knowledge

The knowledge of a person skilled in the art, at the time of filing or on the priority date of the application, may be taken into account in general. Thus, permission to correct the melting point value of a known product may be granted on the basis of any scientific reference.

(c) The certified copy of the priority document

A discrepancy between the French application and the foreign priority document does not imply that it is automatically the result of an error, as the French application does not necessarily have exactly the same content as the certified copy of the priority document. Permission to correct such a discrepancy shall therefore not be granted systematically, even if the applicant provides a certified copy of another patent application belonging to the same family and containing the requested correction.

In order for the certified copy to be taken into consideration as proof of the requested correction, the existence of the error in the French application must be obvious; in addition, the passages concerned by the requested correction must, in every respect, be technically identical in the French application and in the certified copy and be placed in the same context (e.g., they relate to the same variant of the device or process disclosed). If these conditions are not met, the discrepancy between the French application and the certified copy may be presumed to be deliberate, in which case, correction of the error is not obvious.

CA Paris
22/02/1980
Kyowa Hakko
Kogyo

It was thus held that the failure to cite three chemical substances in the original text of an application did not constitute a correctable error, despite the fact that the same three substances were cited in the priority applications, on the basis that the omission may have been intentional, and, in the case in point, deliberately compensated for by the designation of five other chemical substances that did not appear in the corresponding sentence in the priority applications.

(d) Any other document with a date prior to filing

The following documents may be provided as supporting documents:

- earlier patent applications mentioned in the prior art;
- a letter of instruction from the principal to his/her representative with a date prior to the date of filing of the application.

However, the following shall not be taken into consideration:

- any document dated after the date of filing of the application;
- any text that does not have a definite date.

CHAPTER XI – PROPOSAL TO CORRECT FORMAL DEFICIENCIES

1. LEGISLATION

Art. R.612-46

If the patent application is affected by certain formal deficiencies, the INPI may attach a list of proposed amendments to the notice of deficiencies sent to the applicant. The proposed amendments shall be deemed to have been accepted if the applicant does not object to them within the time limit provided. This procedure aims to facilitate the correction of files and to shorten the related processing time.

2. SCOPE OF APPLICATION

Art. R.612-20

This procedure covers formal deficiencies, the correction of which does not alter the scope of the rights conferred, whether in the context of an initial notice or with respect to the processing of improper replies to notices or replies to the preliminary search report. It does not apply to the abstract, which may be drawn up ex officio.

2.1. Examples of its application to the title

- Deletion of superfluous items, such as fancy names.
- Correction of spelling mistakes or typing errors. This correction is necessary as words that are included in the title may be used to search the databases.
- Shortening of a title that is too long or clarification of an ambiguous title.

2.2. Examples of its application to the description

- Deletion of minor elements added to a description.
- Deletion of reference signs.
- Modification of the page numbering, excluding the omission of a page, where the claims have been duplicated at the end of the description.
- Deletion of references to claims.

2.3. Examples of its application to the drawings

- References found in the description alone shall be copied onto the drawings.
- Correction of the numbering of the drawings.
- Deletion of dimensions and legends if the corresponding elements are already included and explained in the description.
- Deletion of reference elements or signs no longer appearing on the final drawings.

2.4. Examples of its application to the claims

- Correction of the numbering of the claims where it does not result in the need to correct the references. This may be due to a lack of numbering, for example, or to separate numbering of the preamble and the characterising portion.
- Correction of a clear error in the references, such as "(2) Device as featured in claim 2...".
- Deletion of incorrect reference signs.

SECTION D – PUBLICATION OF A PATENT APPLICATION

Art. L.612-21, para. 1
Art. R.612-39, para.1

The patent application file shall be made public at the end of a period of 18 months from the filing date or the earliest date available to the application (the priority date where applicable), or at the request of the applicant, before the expiry of said period. A statement shall be published in the Official Bulletin of Industrial Property (BOPI) indicating that the patent application has been made public.

Article R.612-40
Decision no. 2011-714 of the CEO of the INPI of 12/12/2011

For technical reasons, the official publication process takes six weeks. During this period, the applicant shall be informed of the forthcoming publication of his/her application with an indication of the date and number of the corresponding Official Bulletin of Industrial Property.

1. SPECIFIC TIME LIMITS FOR PUBLICATION

Art. R.612-39

(a) Applications claiming priority
Where the claim to priority has been declared inadmissible or where the applicant has waived such a claim (see Section B, Chapter II, points 5 and 6) before the technical preparations necessary for publication of the application have begun, the application shall not be published until 18 months after the filing date or, if a claim to priority still exists, from the date of said priority.

(b) Divisional applications
The publication of a divisional application shall take place 18 months after the filing date of the initial application or the earliest date available to the initial application (where applicable, the priority date), except where the division is filed after the expiry of that period. In this instance, the publication shall take place after the expiry of the time limit prescribed for designating the inventor (see Section B, Chapter III, point 6).

(c) Applications that are of interest to the Ministry of Defence and have been subject to restrictions preventing their disclosure and free use.
Art. R.612-31, para.1
If such restrictions are lifted more than one year after the filing date, the application shall not be made public until six months after the date on which the restrictions ceased to have effect, unless the applicant has filed a request within that period for the publication of the application before the expiry of said period.

2. REQUESTS FOR EARLY PUBLICATION

Art. R.612-39
Art. R.612-31, para.1

Any applicant who wishes to have his/her application published before the end of the 18-month period (or 6 months for applications that have been subject to restrictions) must make such a request in writing.

Decision no. 2015-136 of the CEO of the INPI of 18/12/2015

Accelerated publication of the application shall be necessary if the applicant requires the accelerated grant of his/her patent.

In this case, the submission of the request for the accelerated grant must be accompanied by a request for early publication of the application. The publication period shall then be reduced to 10 months, unless the request for the accelerated grant has been declared inadmissible.

3. NON-PUBLICATION OF AN APPLICATION

Art. R.612-39, para. 5
Art. R. 612-39, para. 6

The patent application shall not be published where it has been rejected or withdrawn before the start of the technical preparations for publication, unless it concerns:

- an application that has been subject to a division;
- an application whose filing date has been claimed in a subsequent application, unless the applicant renounces this.

In spite of the fact that it shall put an end to the grant procedure, the lapse of an application shall not prevent its publication.

Where the application is withdrawn after the start of the technical preparations, publication cannot be prevented.

Art. R.612-40

If the withdrawal of the application was carried out with the specific intention of preventing its publication, the applicant will be informed that such withdrawal will not be carried out. If the applicant still wishes to withdraw his/her application, he/she shall be required to submit a new request for withdrawal, which must not be conditional on the non-publication of the application.

4. IMPACT OF THE ASSIGNMENT OF A PATENT APPLICATION

Art. R.613-53

The specification document shall always indicate the name of the original applicant. In the case of assignment prior to the publication of an application, it may not be mentioned at the time of publication of the application; such assignment may only be entered in the French Patent Register once the patent application has been published. It shall therefore fall to the assignee to renew his/her request for entry in the Register after publication of the patent application.

SECTION E – REJECTION OF A PATENT APPLICATION

Pursuant to Article L.612-12 of the French Intellectual Property Code, the Chief Executive Officer of the INPI has the power to reject a patent application.

Art. L.612-12 as modified by Act no. 2008-776 of 4 August 2008 (Art. 132)

For patent applications filed before 22 May 2020:
"A patent application shall be rejected, in whole or in part, if:

1. it does not meet the requirements of Article L.612-1" (formal requirements: see Section B and Chapters I to V of Section C);

2. "it has not been divided in accordance with Article L.612-4" (see Section C, Chapter VI, part A);

3. "it relates to a divisional application whose subject matter extends beyond the contents of the description in the initial application" (see Section C, Chapter VI, part B);

4. "its subject matter is an invention that is clearly not patentable pursuant to Articles L.611-16 to L.611-19" (see Section C, Chapter VII, point 2);

5. "its subject matter clearly cannot be considered an invention, pursuant to the second paragraph of Article L.611-10" (see Section C, Chapter VII, points 1 and 3);

6. "its description or claims do not allow the application of the provisions of Article L.612-14" (see Section C, Chapter II, point 1.3 and Section C, Chapter IV, point 1.3);

7. "it has not been amended following a formal notice, even though the search report clearly showed a lack of novelty" (see Chapter VII, point 4);

8. "the claims are not supported by the description" (see Section C, Chapter IV, point 1.4);

9. "the applicant has not, where applicable, made any observations or filed new claims in the course of the procedure for drawing up the search report provided for in Article L.612-14" (see Section C, Chapter VIII, point 6).

"If the grounds for rejection only partially affect the patent application, only the corresponding claims shall be rejected.

In the event of the partial non-compliance of the application with the provisions of Articles L.611-17, L.611-18 and L.611-19 (paragraph I, point 4) or of Article L612-1" (formal requirements), "the corresponding portions of the description and the drawings shall be deleted ex officio".

Art. L. 612-12 as modified by the PACTE Act no. 2019-486 of 22 May 2019 (Art. 122)

For patent applications filed on or after 22 May 2020:
"A patent application shall be rejected, in whole or in part, if:

1. it does not meet the requirements of Article L.612-1" (formal requirements: see Section B and Chapters I to V of Section C);
2. "it has not been divided in accordance with Article L.612-4" (see Section C, Chapter VI, part A);
3. "it relates to a divisional application whose subject matter extends beyond the contents of the description in the initial application" (see Section C, Chapter VI, part B);

4. "its subject matter is an invention that is not patentable pursuant to Articles L.611-16 to L.611-19" (see Section C, Chapter VII, point 2);
5. "its subject matter cannot be considered an invention, pursuant to the second paragraph of Article L.611-10" (see Section C, Chapter VII, point 1);
6. "its description or claims do not allow the application of the provisions of Article L.612-14" (see Section C, Chapter II, point 1.3 and Section C, Chapter IV, point 1.3);
7. "its subject matter is not patentable pursuant to the first paragraph of Art. L. 611-10" (see Section C, Chapter VII, points 3, 4 and 5);
8. "the claims are not supported by the description" (see Section C, Chapter IV, point 1.4);
9. "the applicant has not, where applicable, made any observations or filed new claims in the course of the procedure for drawing up the search report provided for in Article L.612-14" (see Section C, Chapter VIII, point 6).
   "If the grounds for rejection only partially affect the patent application, only the corresponding claims shall be rejected.
   In the event of the partial non-compliance of the application with the provisions of Articles L.611-17, L.611-18 and L.611-19 (paragraph I, point 4) or of Article L612-1" (formal requirements), "the corresponding portions of the description and the drawings shall be deleted ex officio".

PROCEDURE

Art. R.612-45 to Art. R. 612-51

The procedure for rejection shall be different depending on the deficiency concerned:

- regarding certain formal deficiencies, set out in Article R.612-45, a rejection decision shall be sent to the applicant as soon as the INPI notes that the set time limits have not been respected (direct rejection procedure).

- In other cases, the procedure shall involve several steps:
  - formal notice or notification before a rejection decision is taken;
  - possibly, a draft rejection decision.

1. DIRECT REJECTION

Art. R.612-45

Art. R.612-8

Art. R.612-11, para. 6 - Art. R.612-10 (3) - Art. R.612-35, para. 6 - Art. R.612-21, para. 2

Art. R.612-5

A rejection decision shall be sent to the applicant if:

- the application contains, by way of description, a reference to an earlier filed application and a copy of this earlier application, accompanied, where applicable, by its translation, has not been produced within two months of filing;

- designation of the inventor has not been provided within 16 months of (i) the filing date, or (ii) the earliest date available to the patent application, or (iii) the earliest priority date or, in the case of a divisional application, (iv) within two months of the date of the request for such document;

- the translation of the documents of an application drawn up in a foreign language has not been provided within a period of two months from the date of the request for such translation;

- the filing and search report fees have not been paid within one month of the submission of the application documents.

The applicant shall then have a period of two months from the date of receipt of the rejection decision to contest the non-compliance of his/her application or to pay the fees due together with a surcharge (see below Section H, Chapter III "Time limits relating to the grant procedure").

If, within that period, the applicant provides proof that his/her application was compliant or pays the fee plus the surcharge, the examination of the application shall continue.

If, within that period, the applicant fails to pay the fee plus surcharge or to submit any observations, or if such observations are not accepted because they do not prove that the application was compliant, the decision to reject the application shall be final.

2. REJECTION INVOLVING SEVERAL STEPS

2.1. Rejection for non-payment of fees other than the filing and search report fees (see Section H, Chapter I)

Art. R.612-46 (fees)
Art. R.411-17

A notification is sent to the applicant setting a time limit for the payment of these fees. If payment is not made within the time limit, a rejection decision shall be sent to the applicant.

Art. R.612-52

The applicant may, however, submit a request for further processing within two months of receipt of the decision to reject the application, along with payment of the corresponding fee and of the outstanding fee on the basis of which the rejection decision was made (see below Section H, Chapter III "Time limits relating to the grant procedure"). The rejection decision shall thus have no effect.

2.2. Rejection on the grounds of formal or substantive deficiencies

2.2.1. Notification

Art. R.612-46 to Art. R.612-50

(a) With the exception of the cases referred to in paragraphs 1 and 2.1 above, if the examiner finds that there is a formal or substantive deficiency likely to result in the total or partial rejection of the application, he/she shall notify the applicant of any such deficiency. The notification shall specify the grounds on which it is based. The applicant shall be given a period of two months within which he/she may, as appropriate:

- rectify the application (Article R.612-46);
- submit any observations and/or rectify the application (Articles R.612-47 to R.612-49);
- submit any observations (Article R.612-50).

Art. R.612-51

(b) If, after having communicated a preliminary search report citing prior art documents, the examiner notes that the applicant:
- has failed to provide a reply; or
- has provided a reply which cannot be considered a satisfactory reply within the meaning of Article R.612-58 of the Intellectual Property Code,

he/she shall send formal notice to the applicant requesting that he/she provide, within a set time limit (two months), a reply enabling the application to be rectified:

- either by filing new claims; or
- by submitting observations to support the maintained claims

Art. R.612-51

(c) For patent applications with a filing date prior to 22 May 2020,
if the examiner notes that **the search report clearly shows a lack of novelty**, he/she shall send formal notice to the applicant requesting that he/she provide, within a set time limit (two months), a reply enabling the application to be rectified and the grant procedure to continue.

Art. R.612-51

(c') For patent applications filed on or after 22 May 2020,
If the examiner notes that **the subject matter of the application is not patentable pursuant to the first paragraph of Art. L.611-10**, he/she shall send formal notice

to the applicant requesting that he/she provide, within a set time limit (two months), a reply enabling the application to be rectified and the grant procedure to continue.

2.2.2 Consequences of notification

Art. R.612-46 to Art. R.612-51

(a) Lack of rectification or observations
A decision to reject the patent application in whole or in part shall be addressed to the applicant. The applicant shall have a period of two months from the date of receipt of notification of the rejection decision within which to submit a request for further processing, together with the required fee and the missing rectification or observations (see below Section H, Chapter III "Time limits relating to the grant procedure"). Subject to the compliance with the above conditions, the rejection decision shall have no effect.

Art. R.612-46 to Art. R.612-51

(b) Rectification or relevant observations made by the applicant
If a rectification or a satisfactory reply is submitted within the set time limit or (if it is submitted outside the set time limit) is submitted along with an admissible request for further processing, the examiner shall continue with the grant procedure.

Art. R.612-47 to Art. R.612-51

(c) Irrelevant observations submitted by the applicant
If the examiner considers that the observations submitted are not relevant and that the patent application is not compliant, he/she shall draw up a draft rejection decision, which shall be addressed to the applicant.

2.3. Draft rejection decision

Art. R.612-47 to Art. R.612-51

The draft rejection decision shall set out the reasons why the applicant's observations have not been accepted and shall specify the scope of application of the proposed rejection (full or partial). Partial rejection may consist in the rejection of certain claims (Article R.612-49 or R.612-51) or the deletion of certain parts of the description or drawings (Article R.612-46).
The draft rejection decision must be substantiated and refer to the legal and/or regulatory provisions on which it is based. It shall be communicated to the applicant, who shall be granted a period of two months to submit a reply.

There are three possible scenarios:

(a) If the applicant fails to reply, he/she shall receive a full or partial rejection decision. The applicant shall have an additional period of two months from the date of reception of the notification of the rejection decision within which to submit a request for further processing, together with the required fee and his/her reply (see below Section H, Chapter III "Time limits relating to the grant procedure"). Subject to the compliance with the above conditions, the rejection decision shall have no effect.

(b) If the applicant submits a relevant reply within the set time limit or (if he/she submits a reply outside the time limit) submits his/her reply along with an admissible request for further processing, the examiner shall rectify the patent application and continue with the grant procedure.

(c) If the applicant's reply does not allow for the rectification of the application, the examiner shall draw up a decision to fully or partially reject the application based on the latest observations submitted.

2.4. Rejection decision

The rejection decision taken by the Chief Executive Office of the INPI shall be communicated to the applicant.

The notification of the rejection decision shall be accompanied by an indication of the possibilities of appeal available to the applicant and, where appropriate, of his/her right to submit a request for further processing.

3. APPEALS

3.1. Application for reconsideration

Decisions taken by the INPI are of an administrative nature. Under French administrative law, such decisions may be subject to an application for reconsideration (*recours gracieux*), whereby the applicant submits a letter to the Chief Executive Officer of the INPI to apply for withdrawal of the decision.

Any decision taken in connection with the rejection, grant or maintenance of a patent may be the subject of such an application, in particular decisions declaring the lapse of a patent (Book II, Section A, point 2).

The application shall be admissible only if the decision is deemed to be unlawful (for example, regarding the lapse of a patent, where the renewal fee was paid on time and at the correct rate) and not for reasons of expediency.

EC, Ternon ruling 26/10/2001

The INPI can only withdraw its decision within the four months following the date on which the decision was made.

CA Paris, Sankyo 14/03/2007

However, applications for reconsideration with respect to lapse decisions shall not be confined to this period.

The application for reconsideration shall not have a suspensive effect on the time limit available to the applicant to lodge an appeal before the competent Court of Appeal.

Where the application for reconsideration has the effect of cancelling the rejection of a published application, mentions of the rejection and the cancellation shall be entered in the French Patent Register.

Art. R.411-19 to Art. R.411-26

3.2. Appeal to set the decision aside

(a) General remarks

Any decision taken by the Chief Executive Officer of the INPI in connection with the grant, rejection or maintenance of industrial property rights may be subject to an appeal to have the decision set aside by the Court of Appeal, in which the appellant contests the correctness of the decision in question. As these appeals are not brought against the Chief Executive Officer, but against the decisions themselves, the Chief Executive Officer cannot be considered as a party to the proceedings; consequently, he/she cannot be held liable in relation to costs under Article 700 nor under Article 696 of the French Code of Civil Procedure.

Art. L.411-4, para. 2

C.Cass 13/12/1994

In the context of a decision relating to a patent, utility certificate, supplementary protection certificate or semiconductor topography, the appeal must be brought before the Paris Court of Appeal.

Art. R.411-19

The appeal may be brought either by the owner of the patent application or patent or by a third party having standing to appeal. In the latter case, the owner of the application or patent shall be served a third-party notice by the Chief Registrar of the Court of Appeal by registered letter with acknowledgement of receipt.

Art. R.411-24

The decision handed down by the Court of Appeal may be appealed before the Court of Cassation. Both the INPI and the applicant may lodge an appeal before the Court of

Art. L.411-4, para. 2

Cassation. The time limit for filing an appeal shall be two months from the date of notification of the ruling to the applicant and the INPI.

(b) Time limit for lodging an appeal to set a decision aside

Art. R.411-21

The time limit for lodging an appeal before the Court of Appeal shall be equal to one month; however, if the applicant is resident outside of mainland France, this time limit may be increased by:

- one month, if he/she lives in a French overseas department or territory;
- two months if he/she lives abroad.

The submission of an application for reconsideration to the Chief Executive Officer of the INPI shall not have the effect of suspending these time limits.

(c) Presentation of appeals

Art. R.411-22
Art. R.411-24

The appellant is required to appoint a lawyer and the appeal shall be submitted to the competent court of appeal **by electronic means**, on pain of inadmissibility.

Art. R.411-25

The notice of appeal must contain the following information, on pain of being null and void:

1.a) If the appellant is a natural person: his/her first name, surname, profession, domicile, nationality, date and place of birth;

b) If the appellant is a legal person: its legal form, name, the address of its registered office and the body that legally represents it;

2. Where applicable, the first name, surname and domicile of the person against whom the action is being brought, or, in the case of a legal person, its name and the address of its registered office;

3. The unique identification number of the appellant company or any document equivalent to the copy of the certificate of incorporation in the Companies Register for companies located outside of France;

4. The subject matter of the appeal;

5. The name and address of the rights owner if the appellant is not the rights owner;

6. The notice of appointment of a lawyer by the appellant. A copy of the contested decision must be attached to the notice of appeal, except in the case of an implicit rejection decision.

Art. R.411-29

On pain of expiry of the notice of appeal, the appellant shall have three months from the date of that notice within which to present his/her submissions to the Court Registry. Subject to the same consequence and within the same time limit, he/she must send his/her submissions to the INPI (addressed to the Litigation Department) by registered letter with acknowledgement of receipt.

3.3. Application for restoration of rights

Art. L.612-16 and Art. R.613-52

3.3.1. General case

(a) Conditions

If an applicant has failed to comply with a time limit with respect to the INPI, he/she may submit an application to the Chief Executive Officer of the INPI requesting to have his/her rights restored.

Art. L.612-16

- **Cases where rights may be restored after failure to comply with a time limit:** Rights may be restored in some cases, i.e. when failure to comply with a time limit results directly in the rejection of the patent application or a request, the lapse of the application or patent, or the loss of any other right.

Art. L.612-16

This is particularly the case for the payment of renewal fees.

However, certain time limits are expressly excluded under Article L.612-16:

- the two-month time limit and the one-year time limit within which the application for restoration must be submitted to the Chief Executive Officer of the INPI;

- the time limit for submitting and correcting a declaration of priority.

The one-year priority period is subject to a specific application for restoration, under special conditions (see point 3.2.2 below). Failure to meet the time limits set under this specific application for restoration cannot be the subject of an application for restoration.

- **Legitimate excuse**
  The applicant must be able to provide a legitimate excuse. In general, the INPI recognises the following as being legitimate excuses: the failure to comply with a time limit is due to an impediment, an accident or, more generally, to a cause that cannot be attributed either to the owner's will or to his/her fault or negligence.

  When assessing the **impediment**, a distinction is made depending on whether the party concerned is a natural person or a legal person:

- A natural person may be prevented from carrying out a formality due to a personal (illness, etc.) or family-related event (illness, death of a close relative, etc.), his/her professional circumstances (unemployment, critical situation of the company he/she manages, etc.), an accident or any unforeseeable/exceptional event having a causal link with his/her failure to comply with the time limit. However, financial difficulties, unless they are linked to illness or unemployment, and any foreseeable events shall not be regarded as legitimate excuses.

- For legal persons, the disruption of the company, in particular due to significant difficulties or its being placed in judicial settlement or liquidation, an accident, or any unforeseeable/exceptional event having a causal link with its failure to comply with the time limit (a fire on the premises, the simultaneous departure of several employees, etc.) shall be deemed to constitute legitimate excuses.

- The term "**accident**" shall also include any material error committed in particular:
  by the rights owner, who did nevertheless demonstrate in due time his/her intention to maintain his/her rights;
  by any other person responsible for the file on account of his/her area of expertise (e.g., professional representative, specialised industrial property department). However, an error made by a mere employee or secretary within the company shall not constitute a ground for restoration. As such employees are not considered to be qualified in the area, the rights owner shall remain responsible for such formalities and must personally ensure that they are carried out.

(b) Time limits in respect of applications for restoration

Art. L.612-16, para. 2

The following two time limits shall apply:
- a time limit of one year from the expiry of the initial unobserved time limit; where the application for restoration relates to the failure to pay a renewal fee, the unobserved time limit shall be understood to mean the six-month grace period granted for the payment of the renewal fee;
- a time limit of two months from the end of the impediment.

During this two-month time limit, the application for restoration must be submitted and the formality that was not fulfilled (e.g., payment of the filing fee, presentation of the authorisation to claim priority) must be completed.

Art. R.613-47, para. 4

If the unfulfilled formality is the payment of a renewal fee, this fee must be paid within the set time limit, together with the related surcharge. If a partial payment was made before or on the due date, the balance must be paid within the set period and no surcharge will be due.

The impediment must have occurred during the unobserved time limit and must have lasted up to two months prior to the submission of the application for restoration. The

end removal of the impediment usually depends on factual circumstances that must be proven by the applicant.

These two time limits must be observed cumulatively: the application for restoration will not be admissible, even if it is lodged within two months of the end of the impediment, if it is submitted more than one year after the expiry of the unobserved time limit.

(c) Presentation of applications for restoration

Art. R.613-52

The application for restoration must be made in writing to the Chief Executive Officer of the INPI and must indicate the facts and explanations invoked. It must be made by the patent applicant, who must be entered as such in the French Patent Register if the patent application has been published, or by his/her representative.

The application for restoration must be accompanied by the corresponding fee, all documents proving the existence of the impediment, its duration and the date on which it ended, as well as proof that the omitted formalities have been completed. If the documents provided as proof are written in a foreign language, they must be accompanied by a translation into French.

(d) The non-suspensive nature of applications for restoration

Art. L.612-16 para. 3

Unlike an appeal to set a decision aside, an application for restoration does not have suspensive effect. It does not call into question the correctness of a decision, but tends, with respect to an applicant who can provide a legitimate excuse, to eliminate the consequences that would otherwise result from his/her failure to comply with a time limit.

Art. R.613-50, para. 3

Consequently, renewal fees must be paid within the set time limits. If the application for restoration relates to the non-payment of a renewal fee, restoration shall only have effect if the subsequent renewal fees due on the date of restoration have been paid within three months from the date of entry of the restoration decision in the French Patent Register.

3.3.2. Specific case: Restoration of the right of priority

Art. L.612-16, para. 1
Art. R.613-52

If the applicant did not respect the twelve-month priority period (see above, Section B, Chapter II, point 5), he/she may submit an application to restore his/her right of priority. He/she must provide a legitimate excuse (see point 3.3.1 a).
The application for restoration shall only be admissible if:

- the patent application is filed within a period of two months from the expiry of the priority period which was not respected;
- the application for restoration is filed within the same time limit, before completion of the technical preparations for publication of the patent application.

4. REQUESTS FOR FURTHER PROCESSING

If an applicant has failed to meet a time limit **set** by the INPI, and his/her application has been or is likely to be rejected, he/she may submit a request for further processing in order to prevent a rejection decision from being made or having effect.

▶ 4.1. Time limits set by the INPI

Art. R. 618-4

These are time limits whose duration is set by the INPI within a limit of two to four months; failure to comply with such time limits is likely to lead to the rejection of the application (see Section H, Chapter 3 below).

4.2. Presentation of requests

Art. R.612-52

(a) Form

Requests must be submitted in writing via the INPI's Patent Portal: https://procedures.inpi.fr.

Requests shall only be admissible if they are accompanied by payment of the corresponding fee.

(b) Time limits

Requests must be made before the expiry of a period of two months from the date of receipt of the rejection decision (see below Section H, Chapter III "Time limits relating to the grant procedure").

Any formalities that were not carried out within the set time limit must be completed within the same period (e.g., payment of the grant fee, filing of the power of attorney, etc.).

4.3. Consequences

- If the request for further processing is correctly submitted before the rejection decision has been made, the latter will not be pronounced.

- If the request is correctly submitted after the rejection decision has been made, the latter shall not have effect.

In either case, the procedure shall continue.

SECTION F – WITHDRAWAL OF THE APPLICATION

Art. R.612-38, paras. 1 and 2

The owner of a patent or patent applicant may surrender his/her patent or application at any time by submitting a written request.

If the surrender is requested before payment of the fee for the grant, it is called a "withdrawal" and is carried out free of charge. The conditions set out below are applicable.

The withdrawal request shall be made using a specific form entitled "Declaration of withdrawal of an application".

This declaration form may only be used for a single application.

- "This form must be submitted by the applicant or by a representative who, unless he/she is an industrial property attorney or a lawyer, shall enclose a special authorisation for withdrawal with the form".

This means that the representative must attach a special authorisation to the request for withdrawal, even if the general authorisation submitted at the time of filing entitles him/her to withdraw the application.

Art. R.612-38, para. 3

- "If the patent application was filed on behalf of more than one person, it may be withdrawn only if so requested by all of the persons concerned." In this case, if a special authorisation for withdrawal is required, it must be signed by all the joint applicants.

Art. R.612-38, para. 4

- "If rights in rem (pledge, license) have been entered in the French Patent Register, the declaration of withdrawal shall be admissible only if it is accompanied by the written consent of the holders of such rights."

- If the declaration has been made on a plain sheet of paper and does not clearly show the applicant's intention to withdraw his/her application, he/she shall be informed by letter that he/she has the possibility to withdraw the application and that should he/she fail to do so, the processing of the application shall proceed. A withdrawal request form shall be attached to this letter.

- The date of withdrawal will be the date on which all of the documents (special authorisation for withdrawal signed by all of the applicants, declaration of withdrawal) are submitted to the INPI. After this date, the decision to withdraw the application will be irreversible.

Art. R.612-38, para. 6

If the application is withdrawn, one copy of it shall be kept by the INPI.

- After the rejection or lapse of the application, resulting in the termination of the grant procedure, the application may no longer be withdrawn.

1. WITHDRAWAL AND PUBLICATION OF THE APPLICATION

▶ 1.1. Withdrawal before publication

Art. R.612-39, paras. 5 and 6

The patent application shall not be published if it is withdrawn before the start of the technical preparations (6 weeks) preceding the date on which the application is due to be published, unless the application is:

- a divisional application containing the documents of the initial application, if the other divisional applications are still in force;
- an application whose filing date has been claimed in a subsequent application, unless the applicant renounces this.

1.2. Withdrawal after publication

Art. R.612-38, para. 5

If the declaration of withdrawal is received by the INPI after the publication of the application, the withdrawal of the latter shall be entered ex officio in the French Patent Register.

2. WITHDRAWAL AND PROCEDURE FOR DRAWING UP THE SEARCH REPORT

Art. R.612-66

2.1. The procedure commenced before the withdrawal of the application.

If the preliminary search report has not yet been notified to the applicant, the procedure for drawing up the search report shall be terminated after the preliminary search report featuring the words "TERMINATION OF THE PROCEDURE" has been communicated to the applicant. However, as the search has been carried out, the search report fee shall not be refunded.

Art. R.411-17

2.2. The procedure had not commenced before the withdrawal of the application.

In this case, the search is not carried out. If the search report fee has already been paid, it will be reimbursed to the applicant.

3. WITHDRAWAL AND ACTION TO CLAIM OWNERSHIP

Art. R.611-20

From the date on which a person has provided proof that he/she has brought an action to claim ownership of a patent application, the holder of that application may no longer withdraw it, unless he/she has the written consent of the person who brought the action.

SECTION G – GRANT

1. PAYMENT OF THE FEE FOR THE GRANT

Art. R.612-70

On completion of the processing of the patent application, the applicant shall be requested to pay, within a time limit of two months, the fee for the grant.

Art. R.612-46

Art. R.612-52

If payment is not made within the time limit, a rejection decision shall be sent to the applicant. The applicant shall have a further period of two months, from the date of receipt of the rejection decision, within which to pay the grant fee by submitting a request for further processing, together with the corresponding fee (see below Section H, Chapter III "Time limits relating to the grant procedure"). The rejection decision shall then have no effect and the procedure for the grant of the patent will be resumed.

Once payment has been made, the applicant shall be informed of the grant of his/her patent, together with details of the date and number of the Official Bulletin of Industrial Property in which the grant will be published.

Art. R.612-70-1

A decision on the patent application shall be taken within four months of payment of the fee for the grant.

Art. R.612-70-2

In the absence of an express decision within the abovementioned four-month period, the application shall be deemed to have been accepted.

At the end of this period, and provided that he/she is in possession of a receipt for due payment of the grant fee, any applicant who has not received notification of publication of the grant may contact the INPI to request a statement of implicit decision of grant.

2. OWNER OF THE PATENT

Art. R.612-71, para.1

The patent shall be granted in the name of the applicant if the patent application has not been assigned.

Art. R.612-71, para. 2

"If the application has been assigned, the patent shall be granted in the name of the last assignee **entered** in the French Patent Register until payment of the fee for the grant. However, the name of the applicant shall be mentioned."

3. GRANT DECISION

Art. L.612-17
Art. L.612-21
Art. R.612-71, para.1

The decision to grant the patent shall be made by the Chief Executive Officer of the INPI. Mention of the grant shall be published in the Official Bulletin of Industrial Property.

Art. R.411-20

Court of Cass. (commercial chamber)

The grant decision may be appealed before the Paris Court of Appeal by any interested party within a period of one month (see Section E, point 3.2 above) from:

- the date of reception of the notification of the decision (appeal by the holder of the patent) - (see below Section H, Chapter III "Time limits relating to the grant procedure");
- the date of publication of the mention of the grant in the Official Bulletin of Industrial Property (appeal by a third party).

This time limit shall be extended to:

Art. 643 of the French Code of Civil Procedure

- two months for persons residing in Guadeloupe, French Guiana, Martinique, Réunion, Mayotte, Saint Barthélemy, Saint Martin, Saint-Pierre and Miquelon, French Polynesia, the Wallis and Futuna Islands, New Caledonia and the French Southern and Antarctic Territories; and
- three months for persons residing abroad.

Within four months from the date of the grant decision, any person may notify the INPI of any errors detected in the published specification document (see Section B, Chapter VI, point 2). After this period, it will not be possible to correct these errors.

SECTION H – MISCELLANEOUS

CHAPTER I – FEES RELATING TO THE GRANT PROCEDURE

This chapter does not concern renewal fees for maintaining patents/patent applications in force (Book II, Section A).

1. LIST OF FEES AND TIME LIMITS FOR PAYMENT

The list of fees is provided in Article R.411-17.

	FEES	TIME LIMITS FOR PAYMENT OF FEES
Art. R.612-5	Filing and search report	1 month from the submission of documents
Art. R.612-45	Surcharge for late payment of the filing fee or search report fee (in addition to the filing fee or search report fee)	2 months from the date of receipt of the rejection decision
Art. R.612-46	Additional claim (from the eleventh claim onwards)	Time limit provided in the letter of notice
Art. R.612-61	New claims resulting in a supplementary search report	Time limit set out in the letter of notice
Art. R.612-36	Request for the correction of errors	Upon presentation of the request for correction
Art. R.612-52	Request for further processing following failure to meet a time limit	Upon presentation of the request and, at the latest, 2 months after receipt of the rejection decision
Art. L.612-16 Art. R.613-52	Application for restoration of rights not related to the priority period (see Section B, Chapter 2, point 5.4 above)	Upon submission of the application, i.e. 2 months after the end of the impediment and at the latest 1 year after the expiry of the unobserved time limit
Art. L.612-16-1 Art. R.613-52	Application for restoration of the right of priority	Upon submission of the application, i.e., no later than two months after expiry of the priority period
Art. R.612-46	Grant	Time limit set out in the letter of notice

2. AMOUNT OF FEES

The amount of the fees is set by decree. Fees shall be paid at the rate in effect on the date of payment. However, the rates set by previous decrees shall remain applicable if advance warning or notice has already been provided, unless the new rates are lower.

3. METHODS OF PAYMENT AND DATE OF EFFECT

The payment of fees relating to the patent procedure can only be made online, directly via the applicant's personal account on the dedicated website (https://procedures.inpi.fr/.

Art.4 of the Order of 24 April 2008 on the procedural fees collected by the INPI

The only methods of payment accepted are by direct debit from a client account opened with the INPI or by credit card.

The effective date of payment shall be the date on which the direct debit order is submitted online or the date of payment by credit card.

4. REDUCTION IN FEES

Art. L.612-20
Art. R.613-63

The amount of fees payable to the INPI shall be reduced for:

- natural persons;
- small and medium-sized enterprises (SMEs), i.e., companies with fewer than 250 employees and in which no more than 25% of the capital is held by another entity that does not meet the same condition;
- non-profit organisations in the educational or research sector.

For the last two categories, the request for a reduction must be submitted at the time of filing of the patent application, on pain of inadmissibility.

The applicant must declare if he/she falls into one or other of these categories. Any false declarations shall be punishable by an administrative fine.

The fee reduction shall not apply to:
- renewal fees for the eighth claim and onwards;
- the search report fee for a foreign priority application accompanied by a search report recognised as equivalent to the French search report;
- the fee for an application for restoration of rights;
- the fee for correction of a material error;
- the fee for entry in the French Patent Register;
- the fee for publication of a translation or revised translation of a European patent or of the claims of a European patent application.

5. REIMBURSEMENT OF FEES

Art. R.411-17

Search report fees shall be reimbursed ex officio if the application is found to be inadmissible.

The search report fee shall also be reimbursed ex officio in the event of rejection or withdrawal of the application, termination of the grant procedure, or extension of the restrictions in relation to the disclosure and free use of the invention, where such an event occurred before the initiation of the procedure for the establishment of the search report.

CHAPTER II – NOTICES SENT BY THE INPI

1. SENDING OF NOTICES

Art. R.618-1

A notice shall be deemed to be valid if it was made:

- either to the last owner of the patent application declared to the INPI or, if it was sent after publication of the application, to the last owner of the application as registered in the French Register of Patents;

- or to the representative.

If the owner is not domiciled in France or in a Member State of the European Union/European Economic Area, the notice shall be deemed valid if it was sent to the last representative that was appointed before the INPI.

The notice shall include the name, capacity and contact details of the agent responsible for examining the application.

Art. R.618-2

Notices are made available exclusively in electronic form on the Patent Portal.
When the INPI issues a notice, an email is sent to the e-Procedure account linked to the application and to the correspondence addressee, provided an email address has been supplied.

If it is not possible to send the notice via a means of communication that provides proof of the date of receipt, the notification shall be made by publication of a notice in the Official Bulletin of Industrial Property (BOPI), which can be consulted on the INPI website. This is the case if no link has been established to the electronic file.

2. REPLYING TO A NOTICE

Art. R.612-7

Any response to a notice must be signed by the applicant or his/her representative. If this signature is missing, the applicant or his/her representative shall be informed of this omission and must provide a duly signed document within the time limit initially set by the INPI in order to rectify the application.

The response to the notice must include the national registration number of the application, on pain of inadmissibility.

CHAPTER III – TIME LIMITS RELATING TO THE GRANT PROCEDURE

1. CALCULATION OF TIME LIMITS

Art. R.618-3

The rules for calculating the time limits that apply during the patent grant procedure are determined by the French Intellectual Property Code:

"Where a time limit is expressed in days, the day of the deed, event, decision or notice triggering the start of the time limit shall not count.

Where a time limit is expressed in months or years, it will expire on the day of the last month or year bearing the same date as the day of the act, event, decision or notice triggering the start of the time limit. If the month in question does not have an identical number of days, the time limit shall expire on the last day of the month.

Where a time limit is expressed in months and days, the months shall be counted first and then the days.

All time limits shall expire at midnight on the last day.

If the last day of the time limit falls on a Saturday, a Sunday, a public holiday or a non-working day, the time limit shall be extended until the first working day thereafter."

N.B.: This method of calculation does not apply to the time limits for the payment of renewal fees for maintaining the patent application/patent in force, which are subject to special rules (see below Book II, Section A).

- **The starting point of the time limit** shall be the date of receipt of the notice delivered to the applicant. This date of receipt corresponds to the date on which the notification is first viewed, i.e. when it is downloaded or displayed.

  However, if the notification is not viewed within fifteen days of it being made available on the Patent Portal by the INPI, it shall be deemed to have been received on the date it was made available on the portal.

- **With regard to the end of the time limit**, the date on which the response to the notice is made available on the Patent Portal is deemed to be the date of response to the notice. Responses to notifications may be submitted on the last day of the time limit at the latest.

2. MAIN TIME LIMITS FOR PROCEDURES AND POSSIBLE MEANS OF RECOURSE IN THE EVENT OF NON-COMPLIANCE WITH THESE TIME LIMITS

	TIME LIMIT	Possible application for restoration of rights (Art.)	Possible request for further processing (Art.)
Art. R.612-8	Provision of a description, an indication that a patent is being applied for and information enabling the applicant to be identified or communicated with, on pain of inadmissibility *(2 months from date of receipt of the notice)*	YES	NO
Art. R.612-9	Provision of the omitted parts of the description or drawings *(2 months from date of receipt of the notice)*	YES	NO
Art. R.612-5	Payment of the filing fee and search report fee *(1 month from the date of submission of the documents)*	YES	NO
Art. R.612-45	Payment of the filing fee or search report fee plus a late payment surcharge *(2 months from date of receipt of the rejection decision)*	YES	NO
	Priority period *(12 months from the priority date)*	YES	NO
Art. R.612-24	Submission of the priority documents *(16 months from the related priority date)*	YES	NO
Art. R.612-24	Declaration and/or rectification of the priority date *(16 months from the earliest priority date available to the application)*	NO	NO
Art. R.612-11; Art. R.612-35	Designation of the inventor *(16 months from the filing date or the earliest priority date available or, for a divisional application, 2 months from the date of receipt of the notice)*	YES	NO
Art. R.612-21	Provision of the translation of the elements of an application filed in a foreign language *(2 months from the date of receipt of the notice)*	YES	NO
Art. R.612-8; Art. R.612-45	In the case of a description consisting of a reference to an earlier application, provision of a copy of the previously filed application and, where applicable, of its translation *(2 months from date of filing)*	YES	NO
Art. R.612-45	Time limit for contesting the failure to provide the designation of the inventor or the translation of the application documents *(2 months from date of receipt of the rejection decision)*	YES	NO
Art. R.612-59	Response to the preliminary search report (*3 months, renewable once, from the date of receipt of the preliminary search report)*	YES	NO
Art. R.612-64	Response to third-party observations for a patent application *(3-month period, renewable once, from the date of receipt of notification of third-party observations)*	YES	NO
Art. R.616-1	Response to third-party observations for an application for a utility certificate *(3 months, renewable once, from the date of receipt of notification of third-party observations)*	YES	NO
Art. R.612-46 to Art. R.612-50	Response to a notice indicating a time limit set by the INPI	YES	YES
Art. R.612-51	Response to a formal notice *(time limit set by the INPI)*	YES	YES
Art. R.612-52	Request for further processing *(2 months from the date of receipt of the rejection decision)*	YES	NO
Art. L.612-16	Application for restoration of rights *(2 months from the end of the impediment and at the latest 1 year after the expiry of the unobserved time limit or the end of the grace period for renewal fees)*	NO	NO
Art. L612-16-1	Application for restoration of a priority right *(2 months after the expiry of the priority period)*	NO	NO

Art. R.612-70	Payment of the fee for the grant *(time limit set by the INPI)*	YES	YES

RÉPUBLIQUE FRANÇAISE
Liberté
Égalité
Fraternité

INPI FRANCE

inpi.fr

contact@inpi.fr

INPI Direct
+33 (0)1 56 65 89 98

The INPI on your doorstep:
For a full list of our offices and addresses, visit
www.inpi.fr ou INPI Direct

afaq ISO 9001 Qualité AFNOR CERTIFICATION