

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Publication of French patent applications is governed by the French Patent statute (code de la Propriété Intellectuelle so-called « CPI »), in particular by articles L612-21 and L612-22 and by rules R612-39 and R612-40.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Under French patent law, patent applications are automatically published after 18 months from the filing date or from the earliest priority date (CPI L612-21.1° and R612-39). In practice, publication consists of a mention in the official French Patent Bulletin (BOPI) which is published every Friday as well as by the publication of patent application itself being made available by the French Patent Office, INPI.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

When a French patent application claims priority to an earlier application, the publication occurs 18 months from the earliest priority date (CPI L612-21.1°).

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

The applicant can withdraw its patent application at any time before grant (R612-38). If such withdrawal happens before the beginning of the technical preparation for publication of the application, the patent application will not be published unless such patent application already gave rise to a divisional patent application (R612-39, 4th paragraph) or is an application from which the benefit of the filing date has been requested unless the applicant expressly withdraws such request. Duration of the technical preparation for publication is decided by the INPI general director (R612-

40) and is currently of 6 weeks (decision 2011-714).

5. What parts of a pending patent application are published?

It is an A1- or A2-type publication, comprising the bibliographic data, the description, the claim/s and where applicable the figure/s.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

The protection starts from the filing date of the patent application (L613-1) but the patent is enforceable only after the publication of the patent application (to the extent the claim scope is not extended, in practice by way of an amendment) or after notification to the infringer (L615-4).

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

See above.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

The applicant can request early publication (L612-21.1°) in writing. No specific format is required. Such publication has 2 effects: allowing the patent application to enter prior art sooner and triggering provisional protection.

In addition, a request for expedite grant of a patent (made at the time of filing or within 10 months thereafter) shall include a request for early publication of the patent application. The publication of the patent application shall then occur within 10 months after the filing date (save earlier publication).

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Non publication is not possible in France. The only patent applications which are not published are (i) those which have been explicitly withdrawn before publication by the applicant, (ii) those pre-empted by the Defense Ministry for national security reasons, or (iii) those which have been rejected, including due to the failure of the

applicant to reply to an objection of the office requiring a reply within a deadline expiring before the end of the technical preparation for publication.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

Only an application explicitly withdrawn by its applicant can avoid publication if such withdrawal takes place before the start of the technical preparation for publication.

In addition, a withdrawn application will in any case be made available to the public is serves as a priority for a subsequent application.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

There is no continuation or continuation-in-part applications in France. Divisional patent applications are published within the same time line as its parent application (18 months for the filing date or from the earliest priority date). If filing of the divisional occurs after 18 months, then publication will occur as soon as possible but not before the time period to designate the inventor (R612-35. 6th paragraph).

Same rule applies for applications claiming internal priority.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes.

Automatic publication after a certain deadline is a rule common to most jurisdictions and is necessary to ensure a right balance of interests between applicants (who should enjoy a period of time to decide whether or not to continue prosecution, without being obliged to disclose the invention) and third-parties (who should be made aware of the contribution to the state of the art as a counterpart to the monopoly conferred by the patent).

Such automatic publication should occur by a particular deadline, which should be determined taking into account this balance of interests (long enough to allow the applicant to make an assessment and short enough to avoid that third-parties wait

too much before obtaining information on the invention). This deadline should be set and relatively simple to compute, in order to provide legal certainty.

The postponement of the automatic publication until a particular deadline is also required for national security screening procedures, common to most jurisdictions.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes.

The postponement of the publication is in the interest of the applicant, who should therefore be entitled to request early publication.

However, the option of early publication may be of interest for an Applicant who desires to disclose (early) the contents of the application, so that it forms part of the state of the art.

This is particularly true in systems such as before the EPO or in France, where unpublished patent applications are comprised in the state of the art when considering novelty but not when considering inventive step.

In addition, in jurisdictions where there can be no infringement of an unpublished application (save notification of an official copy to the infringer), such as in France, the applicant should have the possibility to request early publication, so as to have an early start of provisional protection.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

No.

The request for early publication should be made application by application, provided that the deadline for automatic publication start from the earliest priority.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes.

The applicant should be given the possibility of making a further assessment and decide not to disclose the application by way of automatic publication, for example the possibility to keep the invention as a trade secret, notably if it appears that there are risks that the application will be dismissed or limited (for example in view of the contents of the corresponding search report).

Withdrawal of a priority application may also come useful for preventing auto-collision (self-conflict) with a subsequent application claiming priority from same but comprising additional subject-matter.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

a. with respect to the patentee's own subsequent patent applications; and

There should be no specific consequences of such withdrawal on the patentee's own subsequent patent applications, which are legally distinct titles.

However, there should be consequences on priority issues:

(i) if the application withdrawn has not yet served as a basis for claiming priority at time of withdrawal, it should not be considered as a first application for priority purposes;

(ii) if the application withdrawn serves as priority for a subsequent application, such withdrawn application should be made available to the public, for example through file inspection, even though it has been withdrawn

b. with respect to third party patent applications?

The applications withdrawn before publication and which do not serve as a priority for a subsequent application (and therefore not published as such) should not be comprised in the state of the art when considering novelty and inventive step.

If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

Yes.

The patent office should be required to issue a preliminary search report and a written opinion on patentability before expiry of the deadline set for automatic publication.

The French Group of the AIPPI considers that, regarding priority applications, the mandatory deadline for the patent office to provide the results of its initial assessment should be no longer than 10 months.

This should allow applicants to assess whether they wish to pursue prosecution and seek patent protection or prefer to keep the invention secret.

17. In light of your answers to the previous policy questions, what would be appropriate time limits for:

a. the patent office to provide the results of its initial assessment?;

9-10 months as of filing for a priority application

b. the applicant to decide whether to withdraw the application?; and

17 months as of filing of the priority application

c. the application to be published?

18 months as of filing of the priority application.

10 months as of filing of the priority application in the event of a request for expedite grant (in jurisdictions where such expedite grant procedure is available).

18. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

a. on the initiative of the patentee;

No, except in case of express withdrawal.

b. on the initiative of the patent office; or

No, except if the application is finally refused by the patent office prior to publication.

c. on the initiative of third parties (such as other governmental agencies)?

No, except for national security purposes, and subject to compensation for the applicant.

19. If your answer to question 18 is yes, who should decide on whether such exception is applied?

N/A

20. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

No, i.e. the deadline for automatic publication should also be calculated starting from the priority date.

Therefore, if the continuation-in-part or divisional application is filed early enough before expiry of the automatic publication deadline, it should be published within said deadline (together with the original application serving as priority, even if withdrawn).

Otherwise, it should be published as soon as practicable.

21. What proposals would you make to improve your current system?

The positions of the French Group of AIPPI above mainly reflect the current French and EPO systems, ~~with the exception of the requirement for the patent office to provide its initial assessment of the validity of the patent before the applicant is required to decide whether to withdraw the application.~~

~~Even though, in France, the preliminary search report and written opinion is, in practice, generally available prior to the expiry of the deadline for automatic publication, this is usually not the case before the EPO.~~

~~Therefore, the French Group of the AIPPI proposes that such requirement is passed.~~

~~The position of the French Group of the AIPPI is that the deadline for the patent office to provide the results of its initial assessment should be no longer than 10 months.~~

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

22. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Yes (see question 17)

23. Should there be any exception to publication of applications, for example by the applicant's opt-out?

No (see question 18a)

24. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

National security should be defined by national law and such definition should be as restrictive as possible.

25. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

An appropriate period for publication is a period that ensures a balance of interests between applicants (who should enjoy a period of time to decide whether or not continue prosecution, without being obliged to disclose the invention) and third-parties (who should be made aware of the contribution to the state of the art as a counterpart to the monopoly conferred by the patent).

18 months should be an appropriate period.

26. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

Procedure

It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI (StandingCommittees@aippi.org) by 3 August 2016.

For inquiries, please contact either of the following members of the Standing Committee on Patents.

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