



Special Committee Q228 Patents

National Group: French Group

Title: **Rights of prior users**

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I. Analysis of the legislation and the case law

1. In your patent law system, does any rule provide for an exception to the patentee's right of exclusivity when third parties have made use of the invention prior to the filing date / priority date of the patent?

French patent law makes provision for an exception to the patentee's rights of exclusivity in the event of prior possession of the invention by a third party.

Article L. 613-7 of the French Intellectual Property Code (CPI) provides:

"Any person who, within the territory in which this Book applies, at the filing date or priority date of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent shall enjoy a personal right to work that invention despite the existence of the patent."

The right afforded by this Article may only be transferred together with the business, the enterprise or the part of the enterprise to which it belongs”.

This exception was created in French case law at the beginning of the 19th century, under the regime created by the laws of 1791 and 1844, which did not provide for such an exception; it was then enshrined in law in 1968¹.

This exception can be analysed as a right to work the invention from which the possessor benefits on account of his prior possession.

The European Patent Convention does not contain any provisions relating to this point because it does not deal with the question of infringement, which is governed by national legislation.

The Agreement on a Unified Patent Court of 19 February 2013 contains an Article 18 relating to this question, which provides:

“Any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention.”

The Agreement on a Unified Patent Court thus also refers the matter to national legislation that is applicable on the territory of each State, and has not carried out any harmonisation.

2. Is personal possession relied on frequently in your country? Are any statistics available with regard to reliance on defences of personal possession during negotiations or court proceedings?

We have identified 128 court judgments since 1856 in which personal possession has been relied upon.

The databases consulted provide the following information, which is not always consistent:

- ▶ an initial survey suggests that, since 2000, out of 1396 judgments issued in patent infringement cases², prior personal possession has been relied upon 40 times, i.e. in 2 to 3 cases per year, or in approximately 3% of cases;
- ▶ a search relating to this point of law on the Darts-IP database indicates that reliance on this defence before the French courts has been successful in 50% of cases since 1996 (26 judgments identified).

We do not have any statistics relating to reliance on prior personal possession during negotiations, but it would seem that it is relied upon quite frequently.

1 G. Gaultier, *Naissance et fondement de l'exception de possession personnelle antérieure en matière de brevets*, *Droits de propriété intellectuelle, Liber Amicorum Georges Bonet*, Litec, 2010, p 233

2 Base des décisions du tribunal de grande instance de Paris, de la cour d'appel de Paris, ainsi que de la Cour de cassation

3. To what extent must a person relying on prior personal possession realise the invention? Is it sufficient to have envisaged the embodiment of the invention, or is it necessary to have put into practice or marketed it?

According to Article L. 613-7 paragraph 1 of the CPI, a person pleading this exception must prove that he was in "**possession** of the invention" prior to the filing date or priority date of the patent.

This exception simply requires intellectual knowledge of the invention; although this knowledge must be sufficiently comprehensive and complete to allow the invention to be implemented, there is however no requirement for the invention to be actually worked.

This position is set out by a number of authors:

- ▶ Pouillet (1909) considered that it was "*obvious that possession can be certain and unequivocal even where there has been no manufacture or use*"³;
- ▶ Professor Mathély (1991), while conceding that it "*would not be sufficient for the person relying on prior possession merely to have the idea of the invention or to be still at the stage of the studies or tests relating to it*"⁴, considered that possession would be satisfied where the pleading party has a "**completed conception of the invention** [...] relating to all of its constituting elements"⁵;
- ▶ for Geoffroy Gaultier (2010), expanding on Professor Mathély's thesis: "*as it is sufficient, for the validity of a patent, that the means enabling the person skilled in the art to implement the invention are set out with sufficient clarity, without there being a need for prior working, it would seem appropriate, in parallel, to admit that the conditions to which the exception to the right to a patent is subject are no different*"⁶;

3 E. Pouillet, *Traité théorique et pratique des brevets d'invention et de la contrefaçon*, 5^e édition, Paris, 1909, n° 431 ; Pouillet estime que la possession « peut résulter d'une description claire et précise qui permet l'exécution sans difficulté, sans tâtonnement, s'il s'agit d'un procédé chimique, ou de dessins, s'il s'agit de machines. Comment pourrait-on contester la possession de celui qui, ayant inventé une machine, en a arrêté toutes les dispositions jusque dans ses moindres détails et en a différé la fabrication ou qui, ayant découvert un nouveau procédé chimique en a décrit la formule, remettant à plus tard la mise en œuvre de sa découverte ? N'est-il pas certain que ce dessin, cette formule, s'ils avaient reçu de la publicité, auraient pu être opposés au brevet pris postérieurement, encore qu'il n'y aurait eu aucune mise en œuvre effective, aucune exécution ? Dès lors, comment refuser à celui qui possède ces dessins, cette formule, le droit de s'en servir, d'en tirer profit après qu'un brevet a été pris par un tiers, de la même façon qu'il aurait pu le faire avant ? »

Pouillet invoque au soutien de sa thèse une décision ayant retenu l'existence d'une possession personnelle antérieure « dans une affaire où l'État, actionné en contrefaçon [...], invoquait sa possession antérieure résultant de dessins de ses ingénieurs, lesquels n'avaient jamais été exécutés et étaient déposés dans ses archives » ; Paris, 5 mars 1896, *Rondepierre c. Préfet de la Seine*, *Annales* 1896, p 73

Pouillet reconnaît néanmoins que « c'est avec raison qu'une Cour d'appel refuse d'attribuer le caractère d'une pareille possession au seul fait que le poursuivi en contrefaçon se serait occupé à une époque plus ou moins éloignée, de l'application de principes et de moyens analogues à ceux du brevet » ; Paris, 7 mars 1857, *Fauconnier c. Jannot*, confirmé par Cour de cassation, 11 juillet 1857, *Fauconnier c. Jannot*, *Annales* 1857, p 321

Il approuve de même les décisions estimant que « le prévenu doit être en mesure d'établir d'une façon péremptoire qu'il avait réellement atteint le but proposé et n'en était pas seulement à la période des essais incertains quant à leur résultat » ; Pau, 14 janvier 1899, *Comet c. Bérot frères*, *Annales* 1899, p 259

Ou encore celles rejetant la possession « dès lors qu'il est établi que celui qui en excipe n'est pas sorti de la période des tâtonnements et n'a entrevu que de loin la découverte que le brevet a fait entrer plus tard dans le domaine de la pratique » ; Nancy, 22 juillet 1899, *Boudreaux c. Henrion*, *Annales* 1901, p 197

4 Un arrêt de la cour d'appel de Lyon estime pourtant que même si « les fabrications de S.C.D.R. sont restées jusqu'au milieu de l'année 1950 à l'état d'essais et de prototypes et n'ont pas été livrées au public [elles] peuvent constituer un droit de possession antérieure au profit personnel de la S.C.D.R. », Lyon, 25 mai 1960, *Altweg c. Société concessionnaire du Dr Razurel*

5 P. Mathély, *Le nouveau droit français des brevets d'invention*, JNA, 1991, p 299

6 G. Gaultier, *Droits de propriété intellectuelle, Liber amicorum Georges Bonet*, 2010, page 231

- ▶ other authors, agreeing with this principle, write that it would be sufficient to prove “one’s knowledge” (1991 and 2013)⁷, “one’s full knowledge”⁸ (2012), “one’s precise knowledge”⁹ (2011), without it being necessary to establish the existence of acts of working or even of preparatory steps for the purposes of working the invention.

French case law has often been in agreement with this position and does not require acts of working to have been carried out, or even serious preparatory steps:

- ▶ “whereas, for it to be possible to rely on **intellectual possession of the invention**, this must be **complete**, that is to say it must relate to all of the constituting elements of the patent as they are claimed”¹⁰ (2004);
- ▶ “whereas under these circumstances it is established that the company Concept K was, in France on 16 June 2000, **in the course of experimenting** with a calculator for converting Euros comprising a function of giving change in one single operation, and whereas **the research that had been carried out** for its account for several months by the company Genius Link International **for the purposes of the development of this particular function had been completed** as at that date, i.e. four days before the filing of the patent application by Mr Mo [...], whereas the exception of prior personal possession shall therefore be allowed”¹¹;
- ▶ “whereas it is settled case law that prior intellectual possession must be precise and complete, **without however proof of preparatory steps for the purposes of working being required**”¹²;
- ▶ “whereas the right of personal possession is accorded to the person who, prior to the date of filing of the patent, had **intellectual ownership** of the patented invention”¹³;
- ▶ “(...) the fact that the company Vinmer offered its product unsuccessfully cannot be rebutted by the two declarations introduced into the proceedings by the applicant, **as proof of marketing of the products is not necessary**. Proof is provided that the company Vinmer had [products according to the invention] modified then manufactured from 1996, and in any event before 1999, whereby the products, which were serious preparatory steps to working, had been offered to clients”; the second sentence of the reasoning cannot be interpreted as meaning that the court requires serious preparatory steps, but rather is explained by the fact that the defendant had provided evidence of preparatory steps, and so the court did not have to rule on whether intellectual possession was sufficient¹⁴.

7 J. Passa, *Droit de la propriété industrielle*, Tome 2, LGDJ, 2013, n° 512 et J. Foyer, M. Vivant, *Le droit des brevets*, Thémis 1991, p 319

8 J. Azéma, J.C. Galloux, *Droit de la propriété industrielle*, 7^e édition, Dalloz, 2012, n° 509

9 F. Pollaud-Dulian, *La propriété industrielle*, Economica, 2011, n° 607

10 Paris, 14 janvier 2004, *Paris Fors France c. MW Trading APS*

11 TGI Paris, 19 décembre 2003, *Concept K c. Moulin*, PIBD 2004, n°785-III-256

12 TGI Paris, 1^{er} juillet 2003, *SEL c. Hygiène Distribution*, PIBD 2003, n°776-III-587

13 TGI Paris, 9 mars 2001, *Laboratoires Innothera c. Société des Laboratoires Doms-Adrian*, PIBD 2001, n°728-III-495

14 TGI Paris, 6 juin 2013, *Balipro c. Vinmer*, PIBD 2013, n°992-III-1456

However, a minority of the scholarship (often from a long time ago) considers that possession, for the purposes of the legislation, implies working of the invention or, at the very least, effective and serious preparatory steps for the purposes of working:

- ▶ Dean Roubier (1954) stated that: *“prior possession must be recognised when matters are at a point such that it is no longer possible to doubt the inventor’s settled intention to bring about immediate and genuine working of his discovery. In summary, there needs to be, if not working, then at the very least a clear attempt at working”*¹⁵;
- ▶ Professor Le Stanc (1977) endorses this thesis for being *“more realistic and no doubt more in conformity with the spirit of our law, which requires of the possessor a little more than mere knowledge of the inventive result, that is to say, if not genuine working then at least a clear attempt at implementation or industrial mastery of the invention”*¹⁶.

This idea reflected the oldest of the judgments:

- ▶ The first judgment in which such an exception was recognised based it on the disturbance (“action en trouble”) to which the prior working of the invention by the third party was subjected by the subsequently filed patent¹⁷;
- ▶ *“whereas the exception of prior possession of the patented process is specific to the person who used this process prior to the patent”*¹⁸;
- ▶ *“whereas the simple test that Henrion carried out in 1887, of constructing a brush that had some analogy with the Boudreaux brush, cannot confer upon him any right with regard to the latter, since this test was not followed by industrial operation”*¹⁹;
- ▶ *“personal possession is established for legal purposes only when the person who pleads it is able to establish not that he is at the stage of studies and tests but that, if he has not actually worked it, then at least that he was in a position to do so without delay”*²⁰.

15 P. Roubier, *Le droit de la propriété industrielle*, Tome 2, Sirey, 1954, n° 162 ; Roubier justifie notamment cette position au regard du caractère dangereux de « l'admission de simples documents, d'une date plus ou moins sûre, ou a fortiori de témoignages toujours quelque peu suspects, qui viendraient établir que telle personne avait à telle date une connaissance exacte de l'invention. [...] il y a une matérialisation dans les faits, qui ne prête pas le flanc à des discussions et à des contestations, et qui d'ailleurs mérite le respect, par suite des dépenses entreprises et de l'exploitation engagée ». Roubier rappelle ensuite que si « beaucoup ont vu dans l'exception de possession personnelle une sorte de revanche de l'inventeur véritable, ce qui serait une transposition du système américain, c'est là une vue inexacte. Le droit dont on parle en cette matière, c'est non pas le droit de l'inventeur “véritable et premier”, mais seulement le droit de celui qui, en état de concurrence inventive avec le breveté, a voulu exploiter l'invention, mais avant d'avoir pris lui-même un brevet. Cette exploitation a paru mériter d'être prise en considération, parce qu'elle est une “possession”, qui sans doute n'est pas égale au titre, mais doit donner encore quelques droits à celui qui peut l'invoquer ». Roubier reconnaissait néanmoins qu'il est possible de se trouver « en face d'un inventeur qui a été paralysé dans la mise en œuvre de son invention, alors qu'il n'a pas pu trouver aussitôt les capitaux dont il avait besoin ».

16 C. Le Stanc, *L'acte de contrefaçon de brevet d'invention*, Librairies Techniques, 1977, n° 224 ; Le Stanc propose notamment d'interpréter le terme « possession » à l'aune de l'impératif de territorialité prévue par l'article L. 613-7 : « si la possession d'une invention consiste à n'en avoir que la connaissance, que peut bien vouloir dire l'expression “avoir eu connaissance de la découverte sur le territoire où la loi est applicable” ? [...] Si l'on admet, par conséquent, que la mention que fait le texte du “territoire” a pour finalité de privilégier une possession ayant un lien avec la production nationale, il faut, à peine d'abus ou de contradiction, donner à la “possession” le sens minimal de tentative sérieuse d'exploitation ou de maîtrise industrielle de l'invention ». À l'attention de ceux qui n'auraient pas été convaincus de la pertinence de sa conception de la notion de possession, Le Stanc adresse la remarque suivante : « Ne serait-il pas quelque peu injuste, voire inopportun, de favoriser le simple détenteur de l'invention, qui ne se manifeste précisément qu'au moment où le breveté semble en tirer du profit ? Ce personnage n'a pas eu confiance dans l'invention, il n'a en rien été utile à la collectivité. On comprendrait mal à son égard l'indulgence du législateur ».

¹⁷ Cass. Civ. 28 juin 1803 (9 messidor an XI) cité par G. Gaultier, *Naissance et fondement de l'exception de possession personnelle antérieure en matière de brevets*, *Droits de propriété intellectuelle*, Liber Amicorum Georges Bonet, Litec, 2010, p 233

18 Douai, 19 juillet 1859

19 Nancy, 22 juillet 1899, *Boudreaux c. Henrion*, *Annales* 1901, p 197

20 Paris, 7 novembre 1966, *Potez c. Airflam*

As it constitutes a fact which automatically produces legal effects (*'fait juridique'*), prior personal possession may be proved by any evidential means²¹; these means must "*obviously be sufficiently certain and true in nature, though it is not possible to draw a parallel with the conditions imposed for proof of a prior document leading to the nullity of a patent since, as the latter is drawn from the public domain, objective proof of its existence is able to be provided*"²².

4. Is there any difference in your country depending on whether the possession is prior to the priority date or is subsequent to the priority date but prior to the filing date?

Article L. 613-7 paragraph 1 of the CPI provides:

*"Any person who, within the territory in which this Book applies, **at the filing date or priority date** of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent shall enjoy a personal right to work that invention despite the existence of the patent".*

If a priority is claimed, it is therefore necessary for the possession to have come about prior to the date of that priority.

Possession that came about subsequent to the priority date but prior to the filing date will not be considered.

5. In your country, is there a territorial limitation relating to the scope of the prior personal possession? In other words, can a person who has used a patented invention in another country before its priority date / filing date claim a right of prior personal possession in your country?

Article L. 613-7 paragraph 1 of the CPI provides:

*"Any person who, **within the territory in which this Book applies**, at the filing date or priority date of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent shall enjoy a personal right to work that invention despite the existence of the patent".*

A person who seeks to rely on this exception to the patentee's right of exclusivity must therefore have been in possession of the invention on French territory²³, as the Court of Appeal of Paris had occasion to note in a judgment of 19 February 1986:

*"There is no reason to verify the accuracy of the facts set out by the company Polypak since they do not establish that the personal possession that is relied upon resulted from facts which occurred in France, as is expressly required by Article 31 of the Law of 2 January 1968."*²⁴

The condition of territoriality poses the problem of how to determine the geographical location of an intangible element which consists of knowledge of the invention.

21 TGI Lille, 23 juin 1971, *S.I.C.A. c. Leusière*, PIBD 1972, n° 81-III-119

22 TGI Paris, 4 septembre 2001, *Eurexim c. Yasto*, PIBD 2001, n° 739-III-156

23 P. Mathély, *op. cit.*, p 300 ; J. Azéma et J.C. Galloux, *op. cit.*, n° 509

24 Paris, 18 février 1986, *Polypak c. Parrochia*, *Annales* 1987, p 113

Intellectual knowledge of the invention is indisputably acquired on French territory when the invention was made in France (for example research works, tests, trials, etc. were carried out in France).

Intellectual knowledge can also be deemed to be located in France on the basis of possession of the invention acquired in another country having then been transposed to French territory:

- ▶ by the manufacture or sale of the patented product in France (in a form that does not disclose the invention); the judgment of the Court of Appeal of Paris of 19 February 1986 suggests that manufacture, or even just marketing, on French territory would have permitted the acquisition of prior personal possession in France;

"The documents produced merely seek to establish that the company Polypak had made the invention before the filing date of the patent; this would confer a parallel right that could be relied on against that of the patentee, but in Italy on the basis of the manufacture and in countries other than France on the basis of the marketing (...). There is no reason to verify the accuracy of the facts set out by the company Polypak since they do not establish that the personal possession that is relied upon resulted from facts which occurred in France, as is expressly required by Article 31 of the Law of 2 January 1968"²⁵;

- ▶ by the carrying out of tests or demonstrations on the patented product; the *Tribunal de grande instance* (First-Instance Civil Court) of Paris allowed a company based in Hong Kong to have the benefit of the exception of prior personal possession even though the product in question had been developed outside of French territory, since *"the possessor established the existence, prior to the filing, of a distribution network for its products on French territory and that it had tested the product in question there before that same date"*²⁶ (in that particular case, the company pleading prior personal possession had sent prototypes to its distributors in France and one of its representatives had carried out a demonstration of a prototype);
- ▶ by the granting of a licence over knowhow between a licensor and a licensee before the filing date or priority date of a patent relating to the same technology that was filed by another company (other than the licensor);
- ▶ in general, Professor Passa explains that it is necessary *"undoubtedly to consider that possession on national territory is possession by a person who, on the filing date or priority date, was carrying out his activities or at the very least part of his activities in connection with the invention in question on that territory, with the location at which knowledge of the invention was acquired being immaterial"*²⁷;
- ▶ on the other hand, the *Tribunal de grande instance* of Paris refused the benefit of the exception to a company which, on the filing date, *"was carrying out its activities in Italy, with it being immaterial that it subsequently carried out its activities in France"*²⁸; it should also be noted that the judgment does not indicate whether, as at the priority date of the patent, the company which sought to rely on prior personal possession had offered or sold in France the products which implemented the invention, nor does it specify what should be understood by the terms *"was carrying out its activities"* (these terms could be understood restrictively as requiring the existence of an establishment on French territory, or more widely to include the marketing of products on French territory).

25 Paris, 18 février 1986, *Polypak c. Parrochia*, Annales 1987, p 113

26 TGI Paris, 19 décembre 2003, *Paris Concept K c. Moulin*, PIBD 2003, n° 776-III-587

27 J. Passa, *op. cit.*, n°514

28 TGI Paris, 21 janvier 1982, *Akoram c. Cercomat*, PIBD 1982, n° 303-III-123.

In order that the possession can be transposed to France in an effective manner, it is also necessary that the acts that are intended to relocate possession in France:

- ▶ were carried out by the person who is claiming the benefit of prior personal possession, as in the above mentioned judgments:
 - either by the marketing (in a form which does not disclose the invention) or the presentation of the product by the person claiming the exception;
 - or by the filing of a 'Soleau envelope' (preliminary registration for proof of anteriority) or the production of bailiff's reports which describe the invention and are drawn up on the request of the person relying on personal possession;
- ▶ relate to the invention that is the subject-matter of the patent.

In this regard, for a patent protecting a process, the French group doubts that the exception of prior personal possession, such as it exists in French law, is able to benefit a company which implements, outside of France, the process for manufacturing a product and which imports this product into France before the priority date of a patent in force in France, because the possession of the process is not transposed to France by the importing of the product; however, the French group recognises that this position may offend and conflict with the principles upon which the exception of prior personal possession is based (see response to question 14).

It is necessary to bear in mind the comments of Frédéric Pollaud-Dulian²⁹, who questions whether the territorial limitation is compliant with Article 18 of the Treaty on the Functioning of the European Union, which prohibits any discrimination on grounds of nationality; as interpreted by the Court of Justice of the European Union, that Article prohibits not only discrimination based on nationality but also all covert forms of discrimination which, by the application of other distinguishing criteria, in fact lead to the same result and which are not justified by objective circumstances³⁰.

Neither the French courts nor the Court of Justice of the European Union have yet given any rulings on this question.

6. Is there any provision which excludes the benefit of prior personal possession for those who derive their knowledge of the invention from the proprietor of the patent and/or its inventor?

French law does not have any provision which excludes the benefit of prior personal possession for those who derive their knowledge of the invention from the proprietor of the patent or its inventor.

The benefit of prior personal possession can thus be claimed by persons who derive their knowledge of the invention from the patentee or the inventor, as long as they have come into that possession in good faith, that is to say without breaching any statutory or contractual obligation.

²⁹ F. Pollaud-Dulian, *La propriété industrielle*, Economica, 2011, n° 343

³⁰ CJUE, 30 juin 2005, *Tod's c. Heyraud*

As will be indicated in the following question, according to the case law "*the only condition required is that the prior possessor acts in good faith; the possessor acts in good faith when he has himself made the invention or when, as in the present case, he has received it legitimately from its originator*"³¹.

The case law provides that the benefit of prior personal possession shall be excluded when "*the person claiming the benefit of the exception has come to be aware of the invention in an illicit manner, by way of espionage or poaching of staff*"³², or if he became aware of it legitimately but under circumstances which do not imply that he has any right to use the invention:

- ▶ third parties "*cannot plead the necessary requirement of good faith where the knowledge that they have of the elements of knowhow results from a **licensing agreement with the subsequent patentee** that imposes a confidentiality obligation upon them*"³³;
- ▶ the third party cannot rely on the "*provisions of Article L. 613-7 of the Intellectual Property Code, which cannot be pleaded by a person who only had possession of the invention by reason of his **contractual relations with the patentee***"³⁴.

7. Must the prior possessor necessarily act in good faith in order to rely on prior personal possession?

A person relying on the exception of prior personal possession must establish that he was in possession of the invention in good faith.

Specifically, Article L. 613-7 paragraph 1 of the CPI provides:

*"Any person who, within the territory in which this Book applies, at the filing date or priority date of a patent was, **in good faith**, in possession of the invention which is the subject-matter of the patent shall enjoy a personal right to work that invention despite the existence of the patent".*

This statutory requirement echoes very old case law dating from the 19th century, which precluded the benefit of prior personal possession in the event of fraud, on the basis of the general principle of *fraus omnia corrumpit*.

However, the legislation is not limited to fraud, but refers to the wider notion of possessing in good faith.

Bad faith means that the person in possession of the invention does not enjoy any right to work the invention³⁵. The possessor will be acting in good faith if he made the invention personally or if he received it legitimately from its originator and has not been prohibited from using it.

A person who only possesses the invention on account of his contractual relations with the patentee cannot rely on a right of prior personal possession if the contractual relations involved a prohibition on working the information provided.

31 TGI Paris, 9 mars 2001, *Laboratoires Innothera c. Société des Laboratoires Doms-Adrian*, PIBD 2001, n° 728-III-495

32 J. Passa, *op. cit.*, n° 511

33 Paris, 11 janvier 2006, *Octapharma c. AETS*

34 TGI Paris, 31 mai 2000, *Eidmann c. Strulik*

35 J. Passa, *op. cit.*, n° 511

It is generally accepted in the scholarship and the case law that contracts of employment, research agreements and improvement clauses in agreements for the licensing of patents or knowhow impose on the obligors a positive obligation to communicate information and a negative obligation not to make disclosure to third parties and not to file a patent in their own name; this prevents those subject to such obligations from relying on prior personal possession:

- ▶ by way of example, it has been held that if the knowledge of the elements of knowhow results from a licensing agreement which imposes a confidentiality obligation on the licensee, the latter cannot rely on prior personal possession;
- ▶ it has also been held that the former manager of a company taken over by another could not rely on prior personal possession on the grounds of not being able to prove good faith³⁶;
- ▶ the case law has also held that a former employee exploiting the trade secrets of his former employer could not rely on prior personal possession on the grounds that he was acting in bad faith³⁷.

Likewise, a salaried inventor, by virtue of his duty of loyalty to his employer or of his confidentiality obligation, cannot claim to be in possession of good faith.

In the scenario where an invention is developed by an employee within the scope of his duties, for the account of his employer, and is subsequently protected by a patent filed by the employer, the employee, after leaving the company, cannot rely on the exception of prior personal possession to work his invention after he has left his employer because, even though he personally developed the invention, he will be considered to be acting in bad faith on account of his duty of loyalty to his employer and because the law allocates ownership of service inventions to the employer.

Conversely, the case law has provided that, in the scenario where an invention is developed by an employee outside of the scope of his duties, and is subsequently protected by a patent filed by the employer, the employee, after leaving the company, can rely on prior personal possession in relation to this invention because he *"was not given any specific duties by his employer and did not occupy any role among the staff responsible for the manufacture [and therefore] only managed to arrive at the subject-matter of his invention by virtue of his own research, outside of his own role as a commercial representative for the company"*³⁸.

³⁶ Cour de cassation, 20 mai 2003, *Axis c. Jotul France*, PIBD 2003, n° 771-III-439

³⁷ Paris, *Établissements Muller c. Masut*, 13 août 1931, *Annales* 1933, p 134

³⁸ Lyon, 31 mars 1927, *Rigot c. Jacquet et Roy*

8. Is there any substantive limitation relating to prior personal possession in your country? In particular, can someone who had possession of an embodiment of a patented invention before the filing date / priority date of the patent rely on his prior personal possession with regard to any element whatsoever that is covered by the patent? In particular, does the proprietor of a right of prior personal possession have the right to alter / modify the embodiment of the patented invention that it used before the filing date / priority date of the patent, in such a way as to use other embodiments also covered by the patent, or is he strictly limited to the specific use realised or prepared before the filing date / priority date of the patent? If applicable, to what extent are such modifications / alterations permitted by your national law?

Article L. 613-7 paragraph 1 of the CPI provides:

*"Any person who, within the territory in which this Book applies, at the filing date or priority date of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent **shall enjoy a personal right to work that invention** despite the existence of the patent".*

This Article allows the person benefiting from prior possession of the invention "to work the invention" without any particular limitation.

A person who was in possession of an embodiment of the invention may work the invention, without being limited to the single embodiment of which he had possession; he may therefore make alterations or modifications to that embodiment so long as these other embodiments are equivalent to the embodiment that was subject to prior possession, which means, in French law, embodiments incorporating a different means but producing the same effects in order to achieve the same result.

The case law has established that prior personal possession existed in cases where the technology possessed prior to the filing (or to the priority date) of the patent was equivalent to the technology patented³⁹.

These judgments relate only to the determination of the existence of prior personal possession and not the existence of the acts which it allows to be carried out, but it would seem possible to infer from them that the beneficiary of personal possession may work the technology that he had possession of as well as the equivalents of that technology.

³⁹ Paris, 11 avril 1972, *Dumon c. Fauvet Girel*, PIBD 1972, n° 92-III-290 : « Un plan d'études antérieur de plusieurs années au brevet litigieux décrivant un dispositif de structure équivalente, **produisant un résultat identique** [...] fait bénéficier le défendeur d'une possession personnelle antérieure »

TGI Paris, 2 juillet 1976, *Pont à Mousson c. Ets Larrieu Bedin La Girondine*, PIBD 1977, n° 188-III-131 : « Attendu que cette machine est certes alimentée en capsules par l'intermédiaire d'une goulotte, les amenant une à une, alors que dans la machine décrite au brevet, elles arrivent par un dispositif les aspirant et les maintenant en place ; mais attendu qu'il y a là, contrairement aux dires de la Société Pont à Mousson, une **équivalence véritable**, ce système de préhension sous vide étant équivalent à celui visé au brevet du fait que si les moyens sont assurément de forme différente, ils **remplissent la même fonction pour procurer un résultat semblable** [...] qu'il ressort de ces considérations que l'agencement de la machine livrée en 1966 est en tous points comparables à celle décrite au brevet : **que la preuve de la possession personnelle doit être regardée comme judiciairement rapportée** »

TGI Lille, 16 mai 2002, *Limoges Brandt Cooking c. Société Constructions Électriques RV*, PIBD 2002, n° 749-III-397 : « Attendu que pour être **juridiquement caractérisée**, au sens de l'article L. 613-7 du Code de la propriété intellectuelle, il faut que la possession personnelle invoquée soit dépourvue de tout caractère équivoque, condition qui impose au prétendant au bénéfice de l'exception de possession de prouver qu'il avait une connaissance précise et complète de tous les éléments de l'invention brevetée, et ce **sans qu'il soit toutefois indispensable qu'il justifie d'une identité totale entre l'objet de la possession personnelle et de l'objet du brevet** »

On the other hand, he ought not to be able to work embodiments that are the subject of dependent claims, which would not be equivalents of his prior possession.

Professor Passa would appear to adopt a stricter position, namely that *“the possessor must undoubtedly restrict himself to working the invention of which he had possession, without, in our view, being able to work an invention that is closer to that disclosed and claimed by the patent”*⁴⁰.

9. Is it necessary in your country to provide proof of continued use (or of preparatory steps necessary for that use) of the invention claimed by the patent as at the time at which the exception of prior personal possession is claimed, or is it sufficient that the invention claimed by the patent was used before the priority date / filing date of the patent, even if it was later abandoned?

Article L. 613-7 paragraph 1 of the CPI provides:

*“Any person who, within the territory in which this Book applies, **at the filing date or priority date** of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent shall enjoy a personal right to work that invention despite the existence of the patent”.*

As indicated above, the law requires only intellectual knowledge of the invention; once this knowledge has been acquired, it cannot then disappear.

No continuity of working or use is thus required by French law.

A judgment of the *Chambre des requêtes* (Civil appeals chamber) of 28 April 1938 held that *“a person relying on a right of prior personal possession against a patentee, for example on account of the fact that he had possession of the subject-matter of the invention in good faith, is not obliged to continue to work the subject-matter of the patent in order to preserve the right that he has thus obtained”*⁴¹.

In a case decided in 2013, the claimant in the action argued that the defendant was not able to rely on the exception of prior personal possession because the possession was *“eight years prior to the filing of the patent”*, and that it related to a product *“which had not given rise to any act of working during that period and was marketed only after the patented device had itself begun to be sold”*. However, the court rejected the argument and upheld the exception, stating that *“proof of marketing of the products [is] not necessary.”*⁴²

10. Is prior personal possession transferrable and/or can it be the subject of a licence in your country? If so, under what circumstances?

Adopting pre-existing case law, the Intellectual Property Code accepts that during the life of the patent certain persons who did not initially meet the conditions for prior personal possession may nevertheless rely on it and become derivative beneficiaries of this right.

⁴⁰ J. Passa, *op. cit.*, n° 512 et 515

⁴¹ Cour de cassation, 28 avril 1938, *Annales de la propriété industrielle*, 1939, page 146

⁴² TGI Paris, 6 juin 2013, *Belipro c. Vinmer*, PIBD 2013, n° 992-III-1456

However, the legislator has strictly circumscribed the transfer of prior personal possession.

Accordingly, Article L. 613-7 paragraph 2 of the CPI provides:

"The right afforded by this Article may only be transferred together with the business, the enterprise or the part of the enterprise to which it belongs."

The previous law (dating from 1968) authorised the transfer of the right of prior personal possession but made it conditional upon the transfer of the enterprise.

The meaning of the term "*enterprise*" has given rise to diverging interpretations on account of its lack of legal certainty, in particular when the need has arisen for companies to restructure.

The current version of Article L. 613-7 paragraph 2 of the CPI provides that possession may be transferred as an accessory to a business, an enterprise or part of an enterprise, but it still cannot be transferred in isolation or be the subject of a licence to work.

The current version has allowed the ambiguities to be eliminated.

The benefit of the exception of prior personal possession can be transferred in limited cases resulting from the transfer of the business which was at the origin of the prior possession:

- ▶ for legal persons, personal possession may be transferred by the effect of a merger of companies, a partial contribution of assets or the sale of a business, with the personal possession following the part of the enterprise to which it initially belonged;
- ▶ in the event of a demerger, only the company operating the part of the enterprise of the demerged company to which the possession initially belonged becomes the beneficiary of this prior possession.

This rule must be transposed to natural persons, with the scholarship and case law being in agreement that the right can be transferred *mortis causa* or else assigned *inter vivos*, on condition that the transfer only takes place along with the business.

In other words, the benefit of personal possession is transferred only with the business to which it belongs; likewise, in the event of the death of the possessor, his heir, who carries on the work of its originator, may continue this working.

On the other hand, the right of prior personal possession cannot be transferred in isolation or be the subject of a licence⁴³.

⁴³ Précisons que l'existence d'une licence de savoir-faire, entre un donneur de licence et un licencié, entraîne un transfert de la connaissance qui peut permettre au licencié de bénéficier de l'exception de possession personnelle antérieure en cas de dépôt ultérieur d'un brevet par une société autre que le donneur de licence.

11. Does your national law provide for exceptions or particular rules with regard to prior personal possession by a company within a group of companies? In particular, can prior personal possession be transferred or given under licence to a company in the same group?

Article L. 613-7 paragraph 1 of the CPI provides:

*“Any person who, within the territory in which this Book applies, at the filing date or priority date of a patent was, in good faith, in possession of the invention which is the subject-matter of the patent shall enjoy a **personal** right to work that invention despite the existence of the patent”.*

The concept of a group of companies is not recognised in French law, and the companies of one and the same group are therefore considered to be distinct legal persons in the same way as companies not belonging to one and the same group.

There is therefore no exception in French law with regard to the transfer of prior personal possession within a group of companies.

12. Are there any exceptions which relate to the technological field concerned or the nature of the prior possessor in your country?

There are no exceptions which relate to the technological field concerned or the nature of the prior possessor.

13. The national groups are invited to provide any additional observations regarding the conditions of application of prior personal possession in their national law.

French legislation and French case law have not fixed a quantitative limit for the extent of the working that can be realised by the beneficiary of prior personal possession; thus, someone who only worked the technology in question on a marginal basis before the filing of the patent can increase its production subsequent to the filing, and can even do so to a significant extent.

Nor is the exception of prior personal possession limited in terms of the acts undertaken; the beneficiary of prior personal possession who was happy just to sell the products implementing the patent before the patent was filed can, after this filing, elect to manufacture them.

The benefit of prior personal possession extends to those who market or make use of the invention downstream of the beneficiary, such as retailers⁴⁴ or end customers⁴⁵.

It would also seem possible for the beneficiary of prior personal possession to use subcontractors.

44 Lyon, 25 mai 1960, *Altweg c. Société concessionnaire du Dr Razurel*

45 TGI Lille, 23 juin 1971, *SICA. c. Leusière*, PIBD 1972, n° 81-III-119 : « la preuve ayant été faite de la possession personnelle antérieure, celui qui l'invoque est en droit de poursuivre son exploitation et de vendre des emballages à ses clients qui ne sauraient être poursuivis en contrefaçon, les produits qu'ils utilisent ainsi n'ayant pas le caractère de produit contrefait »

However, the scholarship would seem to be divided on this point: certain individuals assert that the subcontractor who manufactures for the account of the beneficiary cannot be held to be infringing⁴⁶ while others consider that the subcontractor could be regarded as an infringer⁴⁷.

II. Reflections on the legislation and proposals for the improvement of your current system

14. Should the exception of prior personal possession exist in every legal system? If so, what is the main legal justification for this exception?

The French group is of the opinion that the exception of prior personal possession should exist in every legal system.

There are various arguments that can justify this exception to the rights of the patentee:

- ▶ the "rights" of the third parties who made or had possession of the invention before the first person to file must be preserved so as to retain the possibility of selecting a policy of patenting or secrecy policy, in order to avoid a situation where a person who has chosen to keep an invention secret finds himself deprived of the right to work it on account of a patent subsequently being filed; any other arrangement would have the indirect result of making the filing of a patent obligatory;
- ▶ the filing of a patent after an invention has been made by a third party who does not make a filing has not enriched the level of knowledge of this non-filing third party, and so there can be no justification for the exclusive rights of working that are conferred on the patentee being able to be relied upon against a person who does not derive anything in return from it;
- ▶ no one should be prevented from pursuing an economic activity in respect of which he has already incurred expense; this argument does not provide the basis for the exception in French law, since commercial working or even serious preparatory steps are not required under French law, but it is legitimate;
- ▶ a patent should not allow acts which were carried out legitimately before the filing or the priority date of the patent to be prohibited.

15. How is the value of prior personal possession perceived in your country?

Industrial companies in France consider that the exception of prior personal possession is indispensable.

46 F. Pollaud-Dullian, *op. cit.*, n°613 : « le caractère personnel du droit d'exploiter l'invention n'empêche pas de confier les opérations d'exécution matérielle, pour le compte du possesseur à un sous-traitant, ce que l'on ne peut pas assimiler à une cession ou concession de droit »

A. Chavanne et J.J. Burst, *Droit de la propriété industrielle*, 5^e édition, Dalloz, 1998, n°445 : « Le sous-traitant qui ne travaille que pour le compte de son donneur d'ordre ne doit pas être considéré comme un tiers »

C. Le Stanc et J.M. Mousseron, *La possession personnelle antérieure*, *Dossiers Brevets* 1978, II, n°37 : si « à première observation [...], le sous-traitant ne peut pas se présenter comme le bénéficiaire au second degré de la possession personnelle constituée par son donneur d'ordres [puisqu'] la conclusion d'un contrat de sous-traitance n'implique à l'évidence aucune transmission d'entreprise [...] on ne voit pas comment la responsabilité du sous-traitant pourrait être engagée lorsque celle du donneur d'ordres serait exclue ».

47 J. Passa, *op. cit.*, n° 510

This is because these companies consider that it is sometimes preferable not to file a patent to cover their invention and instead to be protected by way of secrecy, in particular in cases where the technology implemented cannot be discovered by third parties (in the case of a manufacturing process that cannot be identified by examination of the manufactured product).

In this case, the exception of prior personal possession allows them to preserve their freedom to operate even in the case where a third party made the same invention and subsequently held a patent over this invention.

It is particularly important for companies, whatever their size, to be able to preserve their freedom to operate.

16. Should specific aspects be altered or modified in relation to the current application of prior personal possession in your country? In particular, could specific measures be taken in order to improve and/or strengthen your current system?

Under Part III, in the context of international harmonisation, the French group proposes a regime which would mean a significant modification of French legislation; this regime would require that, to benefit from the exception, it would be necessary to prove that the invention has been worked or that effective and serious preparatory steps for the purposes of working the invention have been taken.

However, if the exception of prior personal possession were to remain in conformity with the current legislation (requiring only intellectual possession), clarifications with regard to the following points are desirable:

- ▶ conditions under which it is possible to relocate (or transpose) to France the possession that was initially acquired in another country;
- ▶ clarification of the case where products manufactured in another country in accordance with a patented process are imported into France;
- ▶ clarification of the situation regarding the subcontractors of the beneficiary of prior personal possession.

The French group has thought about the possibility of extending personal possession within a group of companies but believes that such a provision would extend the benefit of the exception excessively and would be difficult to implement in practice, in particular because of the imprecision of the concept of a group (shareholding, control, etc.) and the changes that can occur within a group of companies.

The French group further considers that practical mechanisms already exist which allow groups to "*transpose*" knowledge from one company to another.

III. Harmonisation proposals

The national groups are invited to make proposals for the adoption of harmonised rules relating to prior personal possession. In particular, the national groups are invited to answer the following questions:

17. Is harmonisation with regard to prior personal possession desirable?

The French group of AIPPI considers that harmonisation with regard to prior personal possession is desirable.

18. How should “use / possession” be defined for the purposes of prior use / prior personal possession? Should the use / possession be of a commercial nature?

No one definition of “prior use” or of “prior personal possession” has asserted itself; the definition necessarily results from a political compromise to be determined between, on the one hand, the rights granted to the patentee and, on the other hand, the protection afforded to third parties who have decided not to patent the invention that has been made.

A good compromise would consist in it being a requirement, in order to benefit from the exception, to work the invention or at least to carry out effective and serious preparatory steps for the purposes of working the invention.

There are five reasons in support of this proposed definition:

- ▶ patent law, which is intended to encourage the dissemination of technical knowledge, must grant complete protection to the proprietor of the rights; a person who keeps a patent secret without patenting it and without working it publicly is not participating in this dissemination of knowledge. In so far as he does not teach anything, he should not therefore be awarded particular rights that restrict those of the patentee; the benefit of the exception of prior use should therefore be limited to cases in which the third party made investments before the priority date of the patent for the purposes of working the invention, in order to prevent those investments from being lost;
- ▶ prior use is an exception to the rights granted by a patent which, like any exception, must be interpreted strictly;
- ▶ the requirement for working or for effective and serious preparatory steps is closer to the legislation in a large number of countries, and so this proposal would promote harmonisation on a European and international level, which is desirable;
- ▶ historically, the exception of prior personal possession was created by French case law on the grounds that the prior working of the invention by the third party was interfered with by the rights acquired subsequently by the patentee⁴⁸; this proposal thus amounts to giving the exception of prior personal possession the meaning that it initially had in France;

⁴⁸ G. Gaultier, *Naissance et fondement de l'exception de possession personnelle antérieure en matière de brevets*, *Droits de propriété intellectuelle, Liber Amicorum Georges Bonet*, Litec, 2010, p 233

- ▶ if a grace period were to be instituted on an international level, as AIPPI proposed in its resolution Q233 of September 2013 in Helsinki, the criterion of working or of effective and serious preparatory steps for working would be more relevant than the simple intellectual possession of the invention; this is because a disclosure of the invention by the patentee during the grace period would have the consequence of putting all third parties in intellectual possession of the invention, and thus the patent would be devoid of any effect if the criterion of intellectual possession were retained.

19. What should be the “date” (or “critical date”) that is adopted in order to assess whether prior personal possession exists? (i.e. at what moment must someone have had possession of the invention in order to establish prior personal possession?)

The date that is adopted in order to assess whether the requirement of prior use is satisfied should be the filing date or the priority date, if one exists.

20. Does prior personal possession continue to exist when the use / possession and/or the preparation for the use of the invention has already been abandoned as at the filing date / priority date of the patent, or should it be extinguished upon the conclusion of the use / possession and/or of the preparation for the use of the invention?

The exception of prior use should not be granted when the working or the effective and serious preparatory steps for the purposes of the working had been abandoned as at the filing date or priority date of the patent.

This strict position is justified:

- ▶ for the same reasons as those set out for question 18;
- ▶ because the third party's abandonment of the working or of the preparatory steps means that it had given up on deriving the benefits from the investments made, and so it cannot use these investments as a basis for claiming a right of prior use;
- ▶ because, in the event that a grace period were recognised on an international level, it would be necessary to prevent the patent granted from being deprived of effect on the basis that competitors who became aware of the disclosure of an invention by the inventor or his successor in title simply performed tests on the disclosed invention so as to be able, subsequently, to claim the benefit of a prior use.

21. What should be the territorial scope of prior personal possession? In particular, can the prior possession of an invention in a different country before the filing date / priority date of the patent allow an exception of prior personal possession to be claimed in the country covered by the patent?

The French group considers that the exception could have a wider territorial scope than the current national scope.

The harmonisation of the conditions required in order to benefit from the exception such that a stricter criterion than mere intellectual knowledge of the invention is required, specifically its working or the taking of effective and serious preparatory steps for the purposes of working, could mean that the territorial scope of the exception could be extended. On a European Union level, this extension would be particularly justified in view of the principle of free movement of goods and the prohibition of any discrimination on grounds of nationality. The entry into force of the Unitary European Patent will provide further justification for extending the territorial scope of the exception.

A number of approaches have been envisaged:

- ▶ the exception associated with a prior use could have a territorial scope that is analogous to that of the patent in opposition to which it has been relied upon; effective and serious preparatory steps for the purposes of working a product or a process in a State in which a Unitary European Patent produces its effects should allow this product or process to be worked in all States in which this patent produces its effects; if the patent is a national patent or is a national part of a European patent, the exception will retain a national scope, but if the patent is a regional patent, in particular a Unitary European Patent, the exception will have to cover all of the territories covered by the patent.
- ▶ another approach would be to agree that the prior use acquired in a country of the European Union could produce its effects on the territory of all of the States of the European Union.

The French group considers that an extension to a wider scale (i.e. to an international level) is not desirable:

- ▶ firstly, in order that the benefit of the exception, which must retain its strict application, is not extended too widely;
- ▶ secondly, because at the moment the economic and regulatory differences which exist between the markets and the jurisdictions on a worldwide level are too great.

22. Should there be a provision excluding the benefit of prior personal possession for those who derive their knowledge of the invention from the proprietor of the patent and/or its inventor? If so, should the prior possessor need to be acting in good faith in order to rely on prior personal possession?

The benefit of the right of prior use should not be excluded on the grounds that the person relying on it derived his knowledge of the invention from the proprietor of the invention and/or from the inventor.

The only condition should be that the effective and serious preparatory steps for the purposes of the working must have been carried out in good faith, that is to say that the person relying on the exception must, as at the filing date or priority date, have had a right to possess and work the invention without breaching any statutory or contractual obligation, with the burden of proof in this regard being placed upon the person relying on the exception.

Additionally, in the event that a grace period is in force, a third party who, in good faith, would have been aware of an invention disclosed by its inventor or his successor in title and who would have initiated effective and serious preparatory steps for the purposes of working this invention before the filing of the patent, should be able to benefit from the exception.

23. Should there be any substantive limitation to prior personal possession? In particular, should someone who had possession of an embodiment of a patented invention before the filing date / priority date of the patent be able to rely on his prior personal possession with regard to any element whatsoever that is covered by the patent?

A person who benefits from the exception on the basis of a prior use of an embodiment of a patented invention should be able to work any embodiment of the invention that is equivalent to the embodiment that was subject to prior use. On the other hand, this exception should not benefit developments covered by the patent which would be considered as patentable improvements in comparison with the embodiment that was subject to the prior use.

However, these rules should not stand in the way of modifications relating to points that are foreign to the invention that is the subject of the patent.

24. Should prior personal possession be transferrable and/or should it be able to be the subject of a licence?

Prior personal possession should be transferrable *"together with the business, the enterprise or the part of the enterprise to which it belongs"*.

25. Should there be exceptions which relate to the technological field concerned or the nature of the prior possessor?

No exceptions relating to the technological field or the nature of the prior possessor should exist.

26. The national groups are also invited to provide any other suggestion relating to a possible harmonisation of prior personal possession.

The harmonised rule should not fix a quantitative limit for the extent of the working that can be realised by the beneficiary of prior personal possession; thus, someone who only worked the technology in question on a marginal basis before the filing of the patent can increase its production subsequent to the filing, and can even do so to a significant extent.

Nor should the harmonised exception of prior personal possession be limited in terms of the acts undertaken.

The harmonised exception should also extend to those who market or make use of the invention downstream of the beneficiary, such as retailers or end customers, and also subcontractors, that is to say those parties involved at the request of and solely for the account of, the beneficiary of the exception.

Marketing products on a territory should allow a person to rely on the exception of prior use on that territory, even with regard to a patent relating to the process for manufacturing the product; in other words, any company which, in good faith, as at the filing date or priority date of a patent, is directly or indirectly marketing on a territory products that it manufactures, should be able to continue to market these products, directly or indirectly, on that territory.

Summary

French patent law provides for an exception to the rights conferred to the patent holder in case of a « prior personal possession » of the invention by a third party. In order to benefit from such a prior user right, a third party must demonstrate that it was personally in possession of the invention, on the French territory, at the priority date of the patent. The possession of the invention is considered to have been acquired if the third party masters the invention, at least intellectually, in a manner sufficiently complete and finished for it to be implemented, without requiring however that it be really exploited. The benefit of a prior user right can be transferred in limited cases, resulting from the transfer of the activity at the origin of the prior possession.

The French Group is in favour of a harmonization of prior user rights.

However, if the French rules would not change (an intellectual possession is sufficient), the French Group would like some clarifications in the French law, in particular regarding:

- the conditions permitting to locate in France a possession initially obtained in another country;
- the importation in France of products manufactured in another country according to a patented process;
- the situation of subcontractors of the beneficiary of the prior user rights.

A compromise solution for harmonization would be to require, to benefit from a prior user right exception, the use of the invention or at least to carry out effective and serious preparatory steps for the purposes of working the invention.

There are five reasons in support of this proposed definition:

- patent law, which is intended to encourage the dissemination of technical knowledge, must grant complete protection to the proprietor of the rights; a person who keeps a patent secret without patenting it and without working it publicly is not participating in this dissemination of knowledge;
- prior use is an exception to the rights granted by a patent which, like any exception, must be interpreted strictly;
- the requirement for working or for effective and serious preparatory steps is closer to the legislation in a large number of countries, and so this proposal would promote harmonisation on a European and international level, which is desirable;
- this proposal amounts to giving the exception of prior personal possession the meaning that it initially had in France;
- if a grace period were to be instituted on an international level, as AIPPI proposed in its resolution Q233 of September 2013 in Helsinki, the criterion of working or of effective and serious preparatory steps for working would be more relevant than the simple intellectual possession of the invention; this is because a disclosure of the invention by the patentee during the grace period would have the consequence of putting all third parties in intellectual possession of the invention, and thus the patent would be devoid of any effect if the criterion of intellectual possession were retained.