

Clarification of the deadline for filing a second divisional patent application (Ruling n° 537- 20-15.480)

30/08/2023



Ruling No. 537

Quashing

FRENCH REPUBLIC

ON BEHALF OF THE FRENCH PEOPLE

RULING OF THE COMMERCIAL, FINANCIAL AND ECONOMIC CHAMBER OF THE *COUR DE CASSATION* (Court of Cassation) OF 30 AUGUST 2023

Kubota Corporation, a company incorporated under Japanese law, with registered office at [Address 3] (Japan), lodged appeal No. Q 20-15.480 against the ruling delivered on 22 November 2019 by the *cour d'appel* (Court of Appeal) of Paris (Division 5, Chamber 2) in the dispute between it and the Director General of the National Institute of Industrial Property (INPI), of address at [Address 2], the respondent in the quashing.

In the presence of:

- *Compagnie nationale des conseils en propriété industrielle* (National Company of Industrial Property Attorneys (French Patent & Trademark Attorneys Institute)), with registered office at [Address 1].

The plaintiff bases its appeal on one plea for quashing.

The case file has been sent to the Prosecutor-General.

On the report of Ms Champalaune, judge, the observations of SCP Thomas-Raquin, Le Guerier, Bouniol-Brochier, lawyers of Kubota Corporation, of SARL Cabinet Munier-Apaire, lawyers of *Compagnie nationale des conseils en propriété industrielle*, and the advisory opinion of Ms Texier, advocate-general, after debate in the public hearing of 6 June 2023 in the presence of Mr Soulard, First President, Mr Vigneau, President, Ms Champalaune, judge-rapporteur, Ms Darbois, elder judge, Ms Poillot-Peruzzetto, Ms Michel Amsellem, judges, Ms Comte, Ms Bessaud, Ms Bellino, Mr Regis, judge-referees, Ms Texier, advocate-general, and Ms Labat, Chamber Registrar,

the Commercial, Financial and Economic Chamber of the *Cour de cassation* (Court of Cassation), composed, pursuant to Articles R. 431-1 and R. 431-5 of the Judicial Code, of the above-mentioned First President, President and Judges, having deliberated in accordance with the law, has delivered the present ruling.

Intervention

1. According to articles 327 and 330 of the Code of Civil Procedure, voluntary interventions are only admissible before the *Cour de cassation* (Court of Cassation) if they are made as an ancillary measure in support of a party's claims and are only admissible if the author has an interest in supporting that party in order to preserve his rights. As *Compagnie nationale des conseils en propriété industrielle* does not justify such an interest in this dispute, which is not likely to affect the rights of all of its members, its voluntary intervention is inadmissible. The question raised relates to the conditions for filing a divisional patent such as to create rights solely on the part of the applicants and not on the part of their counsel.

Account of the dispute

Facts and procedure

2. According to the ruling under appeal (Paris, 22 November 2019), on 21 March 2008, the company Kubota Corporation (the company Kubota) filed an initial patent application under number 08 51869. On 22 April 2015, it filed an initial divisional application under No. 15 53600. Finally, on 1 March 2018, it filed a second divisional application under No. 18 51806.

3. According to the decision of 27 August 2018, against which Kubota filed an appeal, the Director General of the National Institute of Industrial Property (INPI) declared the second divisional application inadmissible.

Reviewing pleas

Review of the plea

Statement of plea

4. Kubota objects to the ruling dismissing its appeal, whereas "under the terms of Article R. 612-34 of the Intellectual Property Code, until the fee for the grant and printing of the patent specification has been paid, the applicant may, on his own initiative, file divisional applications for his initial patent application. Pursuant to this text, the applicant may not only file divisional applications for his original patent application (A), but also subsequently file one or more divisional applications (C) on the basis of an also divisional application (B); in the latter case, the deadline for filing a second divisional application (C) starting with an initial divisional application (B) corresponds to the date of payment of the fee for the grant and printing of the patent specification resulting from said initial divisional application (B), and not of the patent resulting from the original application (A); in considering, on the contrary, that "the term 'patent' which, in the text of the aforementioned Article R. 612-34, refers to the expression 'initial patent application' contained in the same sentence, designates the first divisional application patent application before any division, which thus sets a filing date applicable to all subsequent divisional applications", and by holding, therefore, that the Director General of the INPI was correct to consider that the second divisional application submitted by the applicant company was inadmissible on the grounds that it had been filed after payment of the fee for the grant and printing of the patent specification resulting from original application No. 08 51869, the *cour d'appel* (Court of Appeal) infringed Articles L. 612-4 and R. 612-34 of the Intellectual Property Code."

Statement of reasons

Court's response

In view of Articles L. 612-4 and R. 612-34 of the Intellectual Property Code:

5. According to the first of these texts, the patent application may concern only one invention or several inventions linked to each other in such a way that they form one single general inventive concept. Any application which does not comply with the preceding subparagraph will be divided in the prescribed deadline; divisional applications will be given the filing date and, where applicable, the priority date of the original application.

6. Under the terms of the second text, until the fee for the grant and printing of the patent specification is paid, the applicant may, on his own initiative, file divisional applications for his original patent application.

7. It follows from the European Patents Office's practise relating to the examination of divisional applications, as set out in the guidelines for examination carried out by that office, in the version thereof that came into effect on 1 November 2018 (Part A, Chapter IV, 1.1.1), that, for the application of Articles 76 of the Munich Convention on the Grant of European Patents of 5 October 1973 and 36 of the implementing regulation of that agreement, the term "earlier application" refers to the closest application on which the divisional application is based, that expression being substituted for the "initial application" in the above-mentioned Article 76, before its revision by an act of 29 November 2000.

8. As the ruling points out, until 2011, the INPI accepted the filing of a new divisional application until the date on which the fee for the grant and printing of the patent specification resulting from an initial divisional application was paid.

9. The interest both of a convergent interpretation of European and national texts pursuing the same object of protecting innovations and of maintaining, for the safety of inventors, an INPI practise based on texts that have not been modified by the legislator requires that, since the applicant may proceed with the filing of divisional applications for his original

patent application, as well as with the filing of one or more divisional applications on the basis of an application that is itself divisional, the deadline for filing a second divisional application starting from a first divisional application corresponds to the payment date of the fee for the grant and printing of the patent specification resulting from said first divisional application.

10. In dismissing Kubota's appeal, the ruling notes that, in Article R. 612-34 of the Intellectual Property Code, the term patent refers to the expression "initial patent application" contained in the same sentence, designates the first patent application before any division and thus sets a filing date applicable to all subsequent divisional applications, without leaving room for any other interpretation of this text. It concludes that, since the second divisional application made by Kubota was filed on 1 March 2018 after the payment of the fee for the grant and printing of the specification of initial patent No. 08 51869, which occurred on 24 April 2015, the Director General of the INPI rightly declared this application inadmissible.

11. In so ruling, the *cour d'appel* (Court of Appeal) violated the above-mentioned texts.

Operative part of the ruling

ON THESE GROUNDS, the Court:

Declares inadmissible the voluntary intervention of *Compagnie nationale des conseils en propriété industrielle*,

QUASHES AND SETS ASIDE, in all its provisions, the ruling handed down on 22 November 2019 between the parties by the *cour d'appel* (Paris Court of Appeal) of Paris. Returns the case and the parties to the status existing prior to this ruling and refers them to the *cour d'appel* (Court of Appeal) of Paris otherwise composed;

Awards the costs to the Public Treasury;

Pursuant to Article 700 of the Code of Civil Procedure, dismisses the claims;

At the request of the Prosecutor-General of the *Cour de cassation* (Court of Cassation), orders that this ruling be transcribed in the margin or at the bottom of the quashed judgment.

Thus decided by the Commercial, financial and economic chamber of the *Cour de cassation* (Court of Cassation), and pronounced by the first President in his public hearing of the thirtieth day of the month of August of the year two thousand and twenty-three.

First President : Mr Soulard

President : Mr Vigneau

Advocate-general : Ms Texier

Judge : Ms Champalaune

Lawyer(s) : SCP Thomas-Raquin, Le Guerier, Bouniol-Brochier – SARL Cabinet Munier-Apaire

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Institution judiciaire

Translated rulings