

The applicant for a patent who, within two months of notification of the dismissal of their patent application has not requested further processing may, within a one-year period, file a request for re-establishment of rights


01/12/2021



*It follows from Articles L. 612-16 (in its wording prior to Order No. 2020-116 of 12 February 2020) and R. 612-52 of the Intellectual Property Code that the applicant for a patent who, within two months of notification of the dismissal of their patent application on the grounds of an omitted act, has not requested further processing may, within a one-year period from the expiry of said two-month period, file a request for re-establishments of rights.*

Ruling No. 836 of the Court of cassation of 1 december 2021 (F-B), Appeal No. 20-10.875

**Quashing without referring back the case**



Public hearing of 1 December 2021- Quashing without referring back the case

**Ms DARBOIS, elder judge acting as president**

**Ruling No. 836 F-B**

**Appeal No. J 20-10.875**

FRENCH REPUBLIC

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ON BEHALF OF THE FRENCH PEOPLE

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**RULING OF THE COMMERCIAL, FINANCIAL AND ECONOMIC CHAMBER OF THE COURT OF CASSATION OF 1  
DECEMBER 2021**

The company B. Braun Medical, a simplified joint-stock company with registered office at [Address 3], lodged appeal No. J 2010.875 against the ruling delivered on 5 November 2019 by the *Cour d'appel de Paris* (Paris Court of Appeal) (Division 5, Chamber 1) in the dispute between said company and the Director General of the National Institute of Industrial Property, domiciled at [Address 2], the respondent in the quashing process.

**Intervener:**

- the *Compagnie nationale des conseils en propriété industrielle* (National Society of Industrial Property Attorneys), whose registered office is [Address 1].

The applicant bases his appeal on the single ground for quashing attached to this ruling.

The case file has been sent to the Prosecutor General.

On the report of Mr Mollard, Judge, the observations of the SARL Cabinet Munier-Apaire, lawyer representing the company B. Braun Medical and the *Compagnie nationale des conseils en propriété industrielle* (National Society of Industrial Property Attorneys), and the advisory opinion of Mr Debacq, Advocate General, following the public hearing of 12 October 2021, attended by Ms Darbois, Elder Judge acting as President, Mr Mollard, Reporting Judge, Ms Champalaune, Judge, and Ms Fornarelli, Chamber Registrar, the Commercial, Financial and Economic Chamber of the Court of

Cassation, comprising the President and the aforementioned judges, having deliberated in accordance with the law, has delivered the present ruling.

## Facts and procedure

1. According to the ruling under appeal (Paris, 5 November 2019), on 6 November 2015, the company B. Braun Medical (the company B. Braun) filed a patent application with the National Institute of Industrial Property (INPI).
2. By decision of 9 August 2016, notified on 16 August 2016, the INPI informed the company B. Braun that its application was incomplete because it failed to include certain documents, and gave it a period in which to provide said documents, expiring on 17 October 2016. With no response from the company B. Braun, the Director General of the INPI rejected the patent application by decision of 4 November 2016, notified on 10 November 2016.
3. On 8 January 2018, the company B. Braun filed an appeal with the Director General of the INPI based on Article L. 612-16 of the Intellectual Property Code, seeking re-establishment of its right to file a request for further processing under Article R. 612-52 of the said code.
4. By decision of 17 July 2018, the Director General of the INPI declared that the action for re-establishment was inadmissible on the grounds that the petition had been filed late, as it had not been filed before the expiry, on 17 October 2017, of the one-year period from expiry of the period given to the company B. Braun to produce the missing documents and complete its patent application.
5. The company B. Braun has filed an appeal against said decision.

## Reviewing plea

### On the first part of the plea

#### Statement of plea

6. The company B. Braun objects to the ruling dismissing its appeal of 12 September 2018 against the decision handed down by the Director General of the INPI on 17 July 2018 declaring inadmissible the request for re-establishment of the rights attached to patent application No. 15 02348, filed on 6 November 2015, whereas "the one-year period within which a request for re-establishment of rights must be filed on the basis of failure to observe the deadline for requesting further processing after dismissal of the patent application for failure to fulfil a formality initially omitted within the period granted for said purpose, runs from the date on which said period for requesting further processing expired; in this case, by declaring the request for re-establishment of rights brought by the company B. Braun on 8 January 2018 inadmissible on the grounds that the period for requesting further processing had not been observed, in view of the fact that more than one year had elapsed since the two-month period given to complete the formality initially omitted within the period granted for said purpose, namely the provision of the missing copy of the receipt for filing the aforementioned French patent application No. 15 00656, the *cour d'appel* (Court of Appeal) violated Article L.

612-16 of the Intellectual Property Code in its then applicable wording."

## Court's response

Having regard to Articles L. 612-16 (in its wording prior to Order No. 2020-116 of 12 February 2020) and R. 612-52 of the Intellectual Property Code:

7. It follows from these texts that an applicant for a patent who, within two months of notification of the dismissal of their patent application on the grounds of an omitted act, has not requested further processing, may bring a request for re-establishment of rights.
8. According to the former, the appeal is admissible only within one year of the expiry of the unobserved time limit.
9. The Court of Cassation (Com., 15 April 1986, Appeal No. 84-12.527, Bull. IV, No. 60) interpreted Article 20 bis of the Law of 2 January 1968 and Article 124 of Decree No. 79-822 of 19 September 1979, the provisions of which have been codified in Articles L. 612-16 and R. 612-52 of the Intellectual Property Code, respectively, in the sense that Article 124 of the aforementioned decree cannot have the effect of extending the period by one year as provided in paragraph two of Article 20 bis of the above-mentioned law and that, whatever the basis of the request for re-establishment, it is admissible only within a one-year period from the deadline by which the act initially omitted had to be completed.
10. However, that interpretation must be reconsidered.
11. First of all, it is apparent from the very wording of Article L. 612-16 of the Intellectual Property Code that the one-year period provided for therein starts from the expiry of the unobserved time limit. Where the applicant lodges a request for re-establishment of rights to request further processing despite the expiry of the two-month period for filing said request, as given in Article R. 612-52 of the Intellectual Property Code, the unobserved time limit is said two-month period.
12. Secondly, the legal certainty sought for third parties by the introduction of the one-year period would also be assured if the starting point for said period was not the expiry of the period for performing the act initially omitted, but rather the expiry of the two-month period for requesting further processing.
13. Finally, according to Article 122 of the European Patent Convention and Rule 136 of the implementing regulation of said convention, the applicant for a proprietor of a European patent who was unable to observe a time limit vis-à-vis the European Patent Office is granted the same possibility to have his rights re-established upon a request that shall be filed within one year of the expiry of the unobserved time limit. Therefore, it appears desirable, for the one-year period to be calculated in the same way, depending on whether the request for re-establishment of rights is filed with the INPI by an applicant for a French patent or with the EPO by an applicant for a European patent designating France. However, a Legal Board of Appeal of the EPO has interpreted the relevant provisions as meaning that, where the applicant seeks re-establishment of rights, the one-year period for filing the request of re-establishment of rights starts from the expiry of the period for filing the request for further processing (Decision of 30 April 1993, Case J 12/92). Taking this case-law into consideration, the guidelines for examination in the EPO state that, when the period for filing for continuation of procedure has expired, "the re-establishment of rights in respect of the time limit for requesting further processing is to be requested, and not in respect of the originally missed time limit. " (Part E, Chapter VIII, 3.1.1).
14. It appears therefore necessary to abandon the above-mentioned case-law and henceforth interpret Articles L. 612-16 and R. 612-52 of the Intellectual Property Code in such way that the one-year period provided in the former of said texts for bringing a request for re-establishment of rights starts at the end of the two-month period provided in the latter text, failing which it shall be inadmissible.
15. There is nothing to prevent the immediate application of this new interpretation in this case.

16. In order to dismiss the action brought by the company B. Braun against the decision of the Director General of the INPI declaring the request for re-establishment of rights inadmissible on the grounds that it was filed late, the ruling states that, regardless of basis, the request for re-establishment is admissible only within one year of the deadline by which the act initially omitted should have been completed.
17. In so ruling, the *cour d'appel* (Court of Appeal) violated the above-mentioned texts.

## Scope and consequences of the quashing order

18. After notice served to the parties in accordance with Article 1015 of the Civil Procedure Code, Articles L. 411-3, paragraph 2, of the Judicial Code and 627 of the Civil Procedure Code are applied.
19. The interest of the proper administration of justice justifies the *Cour de Cassation* (Court of Cassation) deciding on the merits.
20. Based on Article R. 612-52 of the Intellectual Property Code, the two-month period given for the company B. Braun to request further processing expired on 10 January 2017, the one-year period given in Article L. 612-16 of the same Code for bringing a request for re-establishment of rights started on said date, failing which it shall be inadmissible. The action brought by the company B. Braun on 8 January 2018 was therefore brought before the expiry of said period on 10 January 2018.
21. The decision of the Director General of the INPI of 17 July 2018 declaring said action inadmissible must therefore be set aside.

## ON THESE GROUNDS, and without the need to rule on the second complaint, the Court:

QUASHES AND SETS ASIDE all provisions, the ruling delivered for the parties by the *Cour d'appel de Paris* (Paris Court of Appeal) on 5 November;

DECLARES that there is no need to refer back the case

SETS ASIDE the decision of the Director General of the National Institute of Industrial Property of 17 July 2018 declaring inadmissible the action for restoration of the rights attached to patent application No. 15 02348;

Leaves the Public Treasury to bear the costs;

Pursuant to section 700 of the Civil Procedure Code, dismisses the claim made by the company B. Braun Medical;

At the request of the Prosecutor General of the Court of Cassation, this ruling is to be forwarded for transcription along with or further to the partially quashed ruling;

Thus decided by the Commercial, Financial and Economic Chamber of the Court of Cassation and pronounced by the President at the public hearing of the first day of December of the year two thousand and twenty-one.

**President : Mr Darbois, elder judge acting as president**

**Reporting Judge : Mr Mollard**

**Advocate-General : Mr Deback**

**Lawyer(s) : SARL Cabinet Munier-Apaire**

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