

Applying statutes of limitations to patent revocations in France:  
“Running solves nothing: you have to start moving at the right moment... but when?”

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Equity aids the vigilant, not the ones who sleep over their rights (*iura vigilantibus, non dormientibus prosunt*). This is also true for claimants in a patent revocation action.

The nullity of a patent can be raised either as a main claim, in a patent revocation action, or, more often, as a counterclaim to a patent infringement action.

Even if some authors still consider that time limitation should not apply at all, the Paris Courts have now clearly admitted that a patent revocation action is subject to the **main time limitation period of five years**, provided for in Article 2224 of French Civil Code. The starting point of this five-year period is **the day on which the holder of a right knew or should have known the facts enabling him/her to exercise his/her right**.

The question has arisen then how to determine this starting point. The Paris Courts have put forward three alternatives:

- 1) the date on which the patent application is published<sup>1</sup>;
- 2) the date on which the grant of the patent is published<sup>2</sup>; and
- 3) the date on which the party claiming for nullity knew or should have known that the patent could have been an obstacle to the development of its business (*in concreto* approach).<sup>3</sup>

The **date of publication of the patent application** was quite hard to sustain, as a revocation action cannot be initiated in France before the patent is even granted. This criterion was eventually dismissed on 20 October 2017 by the Paris Court of appeal, which ruled that before the publication date of the grant of a European patent, the revocation action is not available.<sup>4</sup>

The **date of publication of the grant of the patent** has been chosen (or seems to have been chosen) as a starting point in several recent decisions. Among others, the Paris Court of appeal ruled, on 22 September 2017, that the party “*could not claim for the nullity of the patent beyond the time limitation period which must be calculated as from the publication*”, understand, of the grant.

On 20 October 2017, the Paris Court of appeal seemed to have coloured this principle, ruling that, in the case at stake, “*the limitation period can only start to run, in the present case, at*

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<sup>1</sup> Paris Court of First Instance, 25 April 2013, 10/14406 (*Evinerude/Air Lichens et al*), confirmed by Paris Court of Appeal, 8 November 2016, 14/15008; Paris Court of First Instance, 6 February 2015, 13/04291 (*Biogaran/Mertz & Co*)

<sup>2</sup> Paris Court of First Instance, 13 March 2015, 13/09605 (*Bolton/Reckitt Benckiser*), confirmed by Paris Court of appeal, 20 October 2017, 15/09777; Paris Court of Appeal, 22 September 2017, 14/25130 (*Halgand and al/Nicoll*).

<sup>3</sup> Paris Court of First Instance, 16 March 2017, 16/07920 (*Actelion/Icos*); Paris Court of First Instance, 28 April 2017, 15/09770 (*B/E Aerospace/Zodiac Aerotechnics*)

<sup>4</sup> Paris Court of appeal, 20 October 2017, 15/09777 (*Bolton / Reckitt*)

*the earliest as from the publication of the grant of the patent*". As a consequence, the starting date of the limitation period cannot predate the publication date of the grant, but could postdate it.

Under which circumstances then?

The answer may be found in cases which have applied an *in concreto approach*<sup>5</sup>, determining, on a case by case basis, the date on which the claimant for nullity knew or should have known the facts giving rise to the said action.

This was deemed initially, for example, to be the date on which the defendant received an infringement notice from the patent owner<sup>6</sup>, or the date on which an opposition was filed against a corresponding patent at the EPO.

The Paris Court of first instance ruled, on 5 October 2017, that it should be the date at which the claimant knew or should have known that the patent for which he seeks invalidity was likely to hinder its activities, i.e. the date the claimant had a standing to start a nullity action against said patent.<sup>7</sup>

The same judgment stated that the publication date of the grant of the patent could not be chosen as a fixed starting point, since it would impose an impossible burden to monitor the patent register. Moreover, the knowledge of the grounds for nullity cannot be a relevant starting point either.

Nevertheless, the Paris Court of Appeal has recalled that *"if the publication of the application does not provide rights to the patentee, the publication of the grant constitutes an acknowledgement of its rights"*, noting the importance of this step *vis-a-vis* third parties.<sup>8</sup>

The recent decisions show that the choice of the starting point of the statutes of limitations to a patent nullity action is still not clearly settled.

This legal uncertainty should encourage companies to consider carefully patent revocation actions in France, to avoid being time barred.

**To be on the safe side, it is recommended to act within five years as from the publication of the grant of the patent.**

At last, it is recalled that even if time barred, a defendant to an infringement action can always raise the nullity of the patent as a defence. The Court will not revoke the patent *erga omnes*, but will only rule that the patent cannot be infringed because it is not valid.

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<sup>5</sup> Paris Court of First Instance, 16 March 2017, 16/07920 (*Actelion/Icos*); Paris Court of First Instance, 28 April 2017, 19/09770 (*B/E Aerospace/Zodiac Aerotechnics*).

<sup>6</sup> Paris Court of First Instance, 6 November 2014, 13/14239 (*Raccords et Plastiques Nicoll/MEP*)

<sup>7</sup> Paris Court of First Instance, 5 October 2017, 17/01156 (*LUK/Valeo Embrayages*)

<sup>8</sup> Paris Court of Appeal, 22 September 2017, 14/25130 (*Halgand and al/Nicoll*)