



**INPI LAW**  

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The **INPI LAW JOURNAL** is a newsletter published in English by the Institut national de la propriété industrielle (**INPI**) for a non-French-speaking readership. It covers changes in French law and court rulings on intellectual property in France, the INPI's new missions pursuant to the French PACTE Law, its work with regard to the examination of applications for intellectual property rights, its decisions further to the newly deployed procedures to invalidate and revoke trademarks and oppose patents, and technological upgrades made to its services (digitisation, open data, artificial intelligence, and more).

**INPI**, 15 rue des Minimes, CS 50001 – 92677 Courbevoie Cedex – **France**

Publication Director: **Pascal FAURE**, CEO of the INPI

Chief Editor: **Maxime BESSAC**

To subscribe to the **INPI LAW JOURNAL** or for further information: [pibd@inpi.fr](mailto:pibd@inpi.fr)

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# Focus

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## INPI extends Patent Prosecution Highway (PPH) programme to North America

After the historical signature of its first Patent Prosecution Highway (PPH) agreement<sup>1</sup> with the Japan Patent Office (JPO) on 26 November 2020<sup>2</sup>, INPI decided to extend its PPH programme to North America in 2021, giving fresh impetus to its cooperation with the United States Patent and Trademark Office (USPTO) and the Canadian Intellectual Property Office (CIPO).

To clarify, a bilateral PPH agreement is a cooperation agreement between two patent offices that aims to accelerate processing by the second patent office of patent applications claiming priority from an earlier national application filed with the first.

On 8 November 2021, INPI signed a PPH agreement with the USPTO, which is a member of the prestigious IP5 that brings together the world's largest intellectual property offices. As a result, since **1 December 2021**, the date on which the agreement between the French and US offices came into effect, applicants can request accelerated examination of a patent application filed with the USPTO – whether a national application or a US national phase application under the Patent Cooperation Treaty (PCT) – provided that the claims contained in the application are sufficiently similar to those used in a corresponding application found patentable by INPI. The reciprocal agreement also allows applicants to request accelerated examination in France of patent applications claiming priority from a USPTO national application or a PCT

application for which the USPTO is the International Searching Authority (ISA) and the International Preliminary Examining Authority (IPEA).

Continuing to implement its strategy, INPI signed another PPH agreement on 3 December 2021, with the Canadian Intellectual Property Office (CIPO). When this agreement comes into effect on **1 February 2022**, it will enable applicants to benefit from the CIPO's extremely efficient PPH system, which reduces the timeline for receiving a first office action to 13 months and the timeline for receiving a final decision to 23 months.

Thanks to these two agreements, which are both based on the IP5/Global PPH guidelines, the number of patent applications eligible for PPH will increase, thereby encouraging more applicants to make use of them.

More than ever, these new PPH agreements provide tangible testimony that foreign patent offices have confidence in INPI and in the quality of its procedures. In particular, the inclusion of the inventive step criterion in France's patent examination process – as introduced by the [PACTE](#) law – has put INPI firmly on an equal footing with the major intellectual property offices by bringing the quality of the French patent into line with the patents they grant. ■

*By Céline Boisseau, Special advisor for international relations, INPI*

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<sup>1</sup> Since the system was set up in 2006, 55 patent offices have signed at least one PPH agreement with another office. There are also multilateral agreements like the Global PPH, with 27 participating offices, and the IP5 PPH, with five participating offices: EPO, JPO (Japan), KIPO (South Korea), CNIPA (China), USPTO (USA). See: [INPI article](#) in French on requesting accelerated examination under PPH, and EPO

page, [Patent Prosecution Highway \(PPH\) programme - Outline and FAQs](#).

<sup>2</sup> See: [PIBD 2020, 1149, I-3](#) and pages 16-17 of [French Treasury Department publication No. 52](#) on intellectual property and anti-counterfeiting, dated May 2021.

# French Case Law

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*Below and in the French version of PIBD, the INPI's law review, you can read about various decisions handed down by the French courts and commented on by the INPI's legal experts.*

## Trademarks

**Court of Cassation, 13 October 2021:** [The Court of Cassation held](#) that the interpretation whereby the filing of an infringing sign as a trademark constitutes an act of infringement in itself, irrespective of its use, must be reconsidered in the light of the case law of the Court of Justice of the European Union.

**Aix-en-Provence Court of Appeal, 23 September 2021:** In connection with an appeal against a decision of the INPI which recognised as justified the opposition to the registration of the GABRIELLE trademark, applied for in respect of **clothing**, on the basis of the existence of an earlier GABRIELLE trademark for **perfumes** and **cosmetics**, [this paper takes stock of the similarity between these products](#), in light of case law on appeals against INPI's decisions and infringement. Although they are inherently different, the courts have in some cases recognised their similarity, particularly in view of the **diversification of companies** in the ready-to-wear and haute couture sectors into the field of perfumes and cosmetics.

**Paris Court of Justice (Tribunal judiciaire), 16 April 2021:** In light of a decision on the detriment to the reputation of the TOUR DE FRANCE trademark, the *PIBD* offers [an overview of French decisions relating to trademarks consisting of the name of major sporting events](#).

**Paris Court of Appeal, 12 February 2021:** The reputation of an EU trademark, which is not known in France, may exacerbate the likelihood of confusion in the context of

opposition to the registration of a French trademark. [Read our analysis](#) of the decision of the [Paris Court of Appeal](#) which applied the *Pago* and *Iron & Smith* decisions of the European Court of Justice.

## Patents

**Paris Court of Appeal, 15 October 2021:** (Application of the *Royalty Pharma* decision in terms of SPCs): [The rejection of the SPC application for the product "sitagliptin" is justified](#), since this **active ingredient** is **not protected by the basic patent** within the meaning of Article 3(a) of Regulation (EC) No. 469/2009 concerning the supplementary protection certificate for medicinal products, as interpreted by the case law of the Court of Justice of the European Union. Furthermore, any **product developed** after the filing or priority date of the basic patent, **as a result of an independent inventive step**, shall not be considered to be protected by said patent.

## Designs

**Court of Cassation, 12 May 2021:** [The Court of Cassation ruled](#) that a company owning **EU designs** can bring an **infringement action** against a company that owns subsequently registered EU designs, by applying a decision of the Court of Justice of the European Union which held that the owner of an EU design can bring an infringement action against **any third party**, including the owner of a subsequently registered design.

# French IP Law updates

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## Patent/Software - Order No. 2021-1658 of 15 December 2021 relating to the transfer of intellectual property rights to assets obtained by software authors or inventors who are not employees or public officials and are hosted by a legal person carrying out research

Published in the *Official Journal* of the French Republic (*JORF*) on 16 December 2021, this text creates a legal framework to allow for the automatic transfer of economic intellectual property rights to software and industrial property rights to inventions created “*by natural persons who do not have an employment contract or the status of public official*” and “*who carry out missions within and using the means of a public or private legal person carrying out research*”.

The aim is to harmonise the framework for transfer with that applicable to employees and public officials.

Within this particular category of natural persons, the text targets in particular “*trainees, foreign doctoral students and professors or directors emeriti*”. However, whether it concerns software or patentable inventions, such natural persons **must be hosted by private or public legal persons “carrying out research”** without further clarification.

To this end, the Order introduces a new Article [L. 113-9-1](#) into the French Intellectual Property Code (hereinafter the “CPI”) concerning economic rights to software, and a new Article [L. 611-7-1](#) on patentable inventions.

In both cases, in order to fall within the scope of these texts, several criteria are provided for, i.e., that the staff be hosted within the framework of an agreement, that they be placed under the authority of a manager within the hosting

structure, and lastly, that they receive financial and/or material compensation.

With regard more specifically to patentable inventions, this new Article L. 611-7-1 provides that the inventor must inform the hosting legal person of the creation of the invention and transposes the three categories of inventions (“job-related inventions”, “independent inventions assignable to the employer” and “independent inventions non-assignable to the employer”) of Article [L. 611-7](#) of the CPI.

The third and fourth paragraphs of this new article provide that the inventor must receive financial compensation (job-related inventions) or a fair price (independent inventions), but the precise terms and conditions of application are to be set by decree of the Council of State.

Lastly, Order No. 2021-1658 amends Article [L. 615-21](#) of the CPI so that any possible dispute concerning the financial compensation to be received by a “trainee” inventor may be submitted to the French National Commission for Employee Inventions (“CNIS”).

*By François Montador, Legal expert, Legal and International Department, INPI*

## Designs – Act No. 2021-1104 of 22 August 2021 (the “Climate Act”): spare car parts

In 2019 and 2020, the French **Constitutional Council** rejected, on two separate occasions, legislative provisions partially introducing a **repair clause into French law**<sup>3</sup>. These provisions aimed to liberalise the spare car parts market in a gradual and controlled manner, in order to reduce the cost of repair, to promote the competitiveness of the French car parts manufacturers industry, and to avoid the illegal

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<sup>3</sup> See Decision No. [2019-794 DC](#) of the Constitutional Council of 20 Dec. 2019, the Mobility Reform Act (*Loi d'orientation des mobilités*) [No. 2019-1428](#) of 24 Dec. 2019, [PIBD 2020, 1129, 1-2](#); Decision [No. 2020-807 DC](#) of the Constitutional Council of 3 Dec. 2020, Act [No.](#)

[2020-1525](#) of 7 Dec. 2020 for the Acceleration and Streamlining of Government Action (*Loi d'accélération et de simplification de l'action publique*), [PIBD 2020, 1150, 1-2](#).

use of counterfeit products that could present a risk of serious failure.

This time, however, through its Decision [No. 2021-825 DC](#) of 13 August 2021 on Act [No. 2021-1104](#) of 22 August 2021<sup>4</sup>, the Constitutional Council did not invalidate the provisions relating to **copyright** and **design** protection for spare parts.

With regard to **copyright**, Article [32, II, para. 1](#) adds an exception to the existing exceptions to the monopoly conferred by copyright, by means of a new paragraph (12) under Article [L.122-5](#) of the French Intellectual Property Code (*Code de la propriété intellectuelle*, hereinafter the "CPI").

Thus, once a repair part has been disclosed, its author can no longer prohibit "*The reproduction, use or marketing of parts intended to restore the original appearance of a motor vehicle or trailer, within the meaning of Article L. 110-1 of the Highway Code*".

In the area of **designs**, the text completes Article [L. 513-6](#) of the CPI. This article lists acts against which the holder cannot invoke the rights he/she holds over his/her design. Article [32, II, para. 3](#) of the Act added a new category of acts, namely: "*acts aimed at restoring the initial appearance of a motor vehicle or trailer within the meaning of Article L.110-1 of the Highway Code and which:*

- a) *relate to glazing;*
- b) *or are carried out by the equipment manufacturer who produced the original part*".

Lastly Article [32, II, para. 2](#) completes Article [L. 513-1](#) of the CPI regarding the duration of protection of a design by specifying that "*The maximum term of twenty-five years provided for in the first paragraph is reduced to ten years for the parts referred to in Article L.513-6, paragraph 4 for which this provision does not provide an exception to the exercise of the rights conferred by the registration of a design*".

In a [press release](#) dated 25 August 2021, the *Autorité de la concurrence*, France's competition regulator, welcomed this partial opening to

competition of the sale of visible spare parts, which will come into force on 1 January 2023.

*By François Montador, Legal expert, Legal and International Department, INPI*

### **UPC – Publication in the Official Journal of Decree No. 2021-1515 of 22 November 2021, publishing the Protocol on Privileges and Immunities of the Unified Patent Court**

Following its signature by France in Brussels on 29 June 2016<sup>5</sup>, the Protocol on Privileges and Immunities of the Unified Patent Court was published by French [Decree No. 2021-1515 of 22 November 2021](#), which was subsequently published in the *Official Journal* of 24 November 2021.

This Protocol establishes the special status that the future Unified Patent Court, as an international institution, will enjoy on French territory. The principle of immunity from jurisdiction is commonly found in other texts establishing international organisations, insofar as such texts enable them to carry out their missions of international remit in complete independence of the States in which they are located.

The Protocol provides, in particular, for the inviolability of the Court's premises, archives and documents, the immunity from jurisdiction and freedom of movement of representatives of the Contracting States in the exercise of their official duties, the exemption of the Court from taxation under certain circumstances, and the privileges and immunities accorded to the Court's judges and staff members. The Protocol also sets out the terms and conditions under which these arrangements shall cease to exist.

*By Leonard Munsch, Legal expert, Legal and International Department, INPI*

<sup>4</sup> Act No. 2021-1104 of 22 August 2021 on Combating Climate Change and Strengthening Resilience to its Effects (*Loi portant lutte contre le dérèglement climatique et*

*renforcement de la résilience face à ses effets*), known as the "Climate Act" (*Official Journal*, 24 August 2021).

<sup>5</sup> See [PIBD 2016, 1054, 1-75](#).

# About INPI

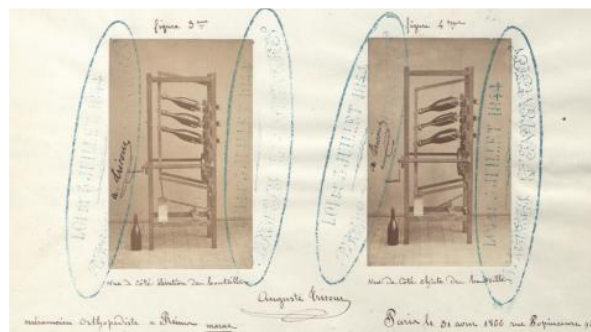
## Champagne all round!

A dip into INPI's archives

To celebrate the new year in style, we definitely won't be rehashing the same old story about Champagne and how it was – supposedly – invented by Dom Pérignon. Instead, we're going to look at some previously unpublished documents from INPI's heritage archives that shed new light on this iconic symbol of French excellence. Now that's a good reason to break out the Champagne!

The process of getting Champagne from field to flute has given rise to numerous industrial property rights since 1791. Below are some patents and trademarks that illustrate a centuries-old story that continues to unfold.

Let's start with the **patents** that provide technical solutions to issues relating not only to Champagne's production but also to its storage and transportation. Because making Champagne involves numerous actions that require a great deal of care and precision and have very specific names, like *pointage*, *remuage* (riddling) and *démasquage*. The latter was a process used to eliminate the yeast that collects at the bottom of the bottle to form a rather unattractive sediment. It involved delivering little hammer blows to the bottle – also known as *électrisage* – or tapping the bottle vigorously against a wooden bar or the edge of a rack or table – also known as *tapotage*. Today, machines are generally used to carry out these taxing and tedious tasks. The first machines started to appear back in the middle of the 19<sup>th</sup> century, thanks to advances in mechanisation. One example is the device patented by Auguste-Henri Tricout, an orthopaedic technician based in Reims, which was designed to dislodge the sediment in Champagne wines, deliver blows to, turn and shake the bottles.



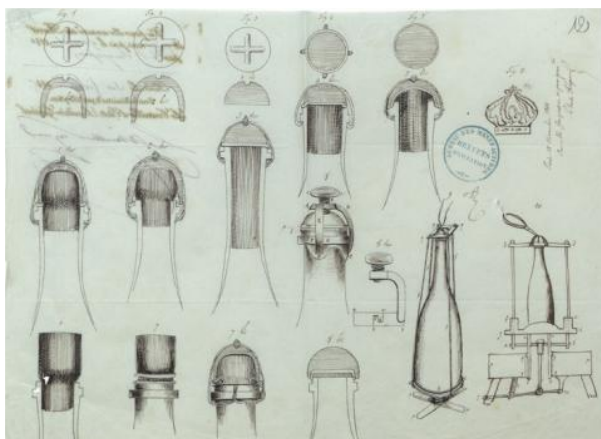
Patent No. 72786 filed on 1 September 1866 by Auguste-Henri Tricout for a device, known as the Tricout machine, designed to dislodge the sediment in Champagne wines, deliver blows to, turn and shake the bottles (1BB72786, INPI archives).

The quest for the ideal bottle also provided opportunities for innovation. The reason for the current shape remains unclear. Some say the punt – the conical cavity at the bottom of the bottle – was created by glassblowers so they could fit the blow-moulded bottle onto a cone to hold it still for the finishing process. One thing is certain: the most important quality for a Champagne bottle is strength, so that it can withstand the constant pressure it's under. Many patents have been filed to protect improvements in this regard. In 1847, for example, wine merchant Louis-Marie Canneaux patented a new type of bottle designed to prevent breakage.



Patent No. 5175 filed on 8 March 1847 by Louis-Marie Canneaux for a type of bottle, designated a "segmental bottle", for Champagne wines and other carbonated liquids (1BB5175, INPI archives).

Because of this need for solidity, Champagne bottles are heavy. Generally speaking, they're made from translucent, dark green glass and have a very specific shape and precise dimensions. The cylindrical body is 88.4 millimetres in diameter, the punt is 30 millimetres deep and the top of the neck is 30 millimetres wide, with a rim or "annulus". This serves as an anchor for the system that keeps the stopper in the bottle until it's time to drink the Champagne. Securing the cork stopper – so typical of sparkling wines – has always been an issue. Made from cork since day one, the stopper was initially held in place using only hemp strings or wire. But in 1844, a wine merchant from Châlons-en-Champagne named Adolphe Jacquesson filed a patent for an invention that consisted of inserting a metal cap between the strings or wire and the cork.



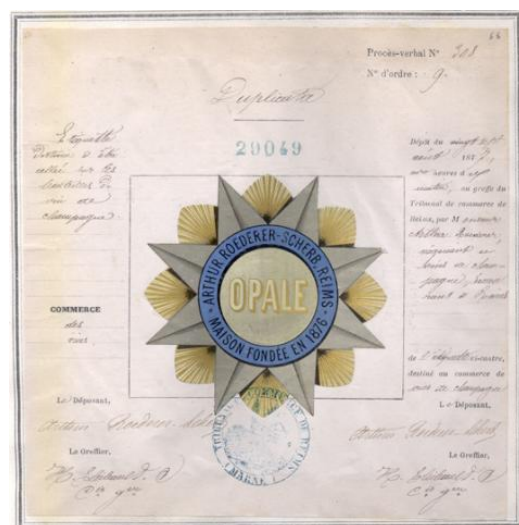
Patent No. 412 filed on 15 November 1844 by Adolphe Jacquesson for improvements to the devices and processes for sealing bottles containing sparkling and non-sparkling wines and other liquids (1BB412, INPI archives).

The metal cap balanced the forces acting on the cork and prevented the hemp string or wire from becoming embedded in the cork under pressure, causing gas or liquid leaks. Known as a *muselet*, this device is used to help seal the bottle and hold the cork in place. It is also designed to enable the consumer to uncork the bottle safely. Today, the *muselet* is made up of a wire belt; the wire body or cage itself, consisting of four legs and a head; and a varnished, printed or embossed metal cap, which usually carries the Champagne House's trademark.

Champagne Houses are the agricultural and/or industrial and commercial businesses that control the human and technical resources required to produce and distribute Champagne. Their talent lies in crafting *cuvées* that perpetuate the House's characteristic style by blending grape varieties, vineyards and even vintages. INPI carefully maintains records of all the **trademarks filed** by the Houses, which have contributed to the prominence and **prestige of Champagne worldwide**. Below are some examples of the beautiful trademarks filed in the late 19<sup>th</sup> century.



Trademark for a label designed to be affixed to bottles of Champagne wine, filed on 3 May 1877 by wine merchant James Le Forestier in Epernay (1MA28105, INPI archives).

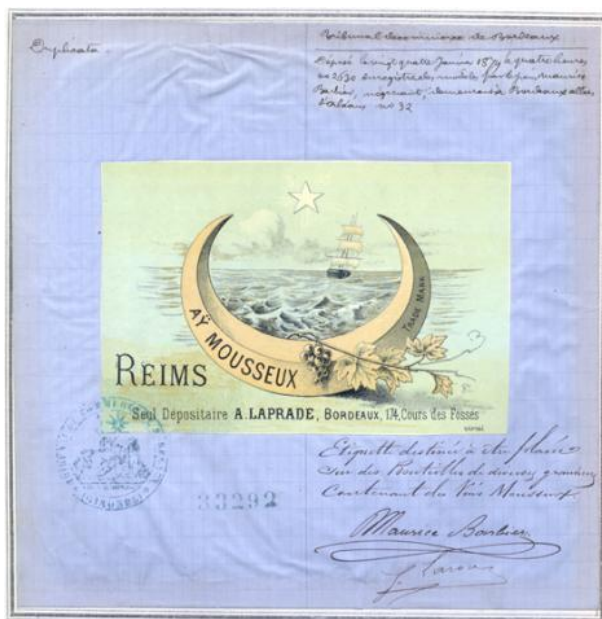


Trademark for a label designed to be affixed to bottles of Champagne wine, filed on 20 August 1877 by Champagne merchant Arthur Roederer in Reims (1MA29049, INPI archives).





Trademark for a label designed to be affixed to bottles of Champagne wine, filed on 2 February 1878 by Albert de Bary in Epervy (1MA30344, INPI archives).



Trademark for a label designed to be affixed to bottles of sparkling wine, filed on 24 January 1879 by wine merchant Maurice Barbier in Bordeaux (1MA33292, INPI archives).

With more than 500 patents granted in this sector since 1791 and records of all the trademarks registered since 1857, INPI is a key source of information about the history of Champagne and the Houses that have contributed to its reputation. The unique, original documents that make up INPI's heritage archives provide greater insight into the history of this exceptional wine from the Champagne region, part of which is inscribed on UNESCO's World Heritage List under the title "Champagne Hillsides, Houses and Cellars". ■

*By Steeve Gallizia, responsible for preserving and promoting INPI's heritage archives*

(This article also appeared in French in *Journal spécial des sociétés*, No. 82, p. 20, on 23 December 2020.)

## Designs portal: online procedures

INPI continues to modernise its design-related interfaces. As a result, since 12 July 2021, the online design portal is the single point of access for all procedures relating to designs.

Applicable since that date, [Decision No. 2021-89](#) issued by the Chief Executive Officer of INPI on 9 July 2021 states, in Article 1, that "**procedures relating to designs** and any subsequent exchanges, whether carried out by the right holder, their representative or a third party wishing to enter information into the register, shall be carried out in **electronic format** via the dedicated online portal on INPI's website."

This means that **renewals**, **surrenders** and **requests for reinstatement** must now be carried out exclusively online, just like all other procedures relating to designs.

INPI provides applicants with a general [presentation](#) of its online design [portal](#), as well as a practical and very detailed [user's guide](#).

# International IP Law news

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## UPC - the Protocol on the Provisional Application of the UPC Agreement has entered into force

On 15 October 2021, the Slovenian government deposited its instrument of ratification for the Protocol on the Provisional Application of the Unified Patent Court (UPC) Agreement and the UPC Agreement itself<sup>6</sup>. On 18 January 2022, while the only thing missing for the Agreement to enter the final phase of its implementation was the ratification of the Protocol by only one more Signatory State, **Austria** just closed the loop by the deposit of its instrument of ratification.

As a result, the **Protocol on the Provisional Application of the UPC Agreement** has entered into force. It marks the start of a new phase, which is the birth of the Unified Patent Court as an international organisation. This transitory phase will last approximately eight months and will make it possible, under the guidance of the UPC Preparatory Committee, to answer technical and infrastructural questions with a view to putting in place all of the elements necessary for the proper functioning of the future court. At the end of this period, Germany is expected to deposit its ratification instrument for the UPC Agreement, triggering a 3- to 4-month period, following which the Unified Patent Court will commence its activities.

## Strengthened cooperation between OMPIC and EPO

EPO President **António Campinos** and the new head of the Moroccan Office of Industrial and Commercial Property (OMPIC) **Abdelaziz Babqiqi**, appointed on 3 June 2021, met for the first time at an online meeting on 22 September, opening a new chapter of cooperation between their offices<sup>7</sup>.

During the meeting, the two leaders reviewed the [validation agreement](#) between the EPO and OMPIC, which entered into force on 1 March 2015 as the EPO's first ever validation agreement. In 2020, around 400 European patents granted by the EPO were validated in Morocco by virtue of this agreement, a number that is expected to increase in coming years.

The validation system offers European patent applicants a simple and cost-effective way of obtaining patent protection in countries that are not members of the EPO. At the applicant's request, and on payment of the prescribed fee to the EPO (€240 for Morocco), European patents and patent applications (direct or Euro-PCT) can be validated in Morocco, where they then have the same legal effects as national patents and patent applications. The validation procedure is governed solely by national law.

*By François Kaiser, INPI's Regional IP Counsellor for Morocco<sup>8</sup>*

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<sup>6</sup> See: [PIBD 2021, 1169, I-1](#).

<sup>7</sup> See: English-language EPO [News release](#) of 22 September 2021, EPO and Moroccan IP office sign Memorandum of Understanding, and French-language OMPIC [News release](#) of 22 September 2021 on the same topic.

<sup>8</sup> [francois.kaiser@dgtrésor.gouv.fr](mailto:francois.kaiser@dgtrésor.gouv.fr). The members of **INPI's international network** (ten IP Counsellors covering around 100 countries) implement international cooperation initiatives with its public and private partners worldwide. They also support companies in their export activities, in liaison with the French Treasury Department.

# Agenda

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3 February 2022

**INPI – INTERNATIONAL CONFERENCE  
ON INTELLECTUAL PROPERTY**

[Details](#)



24 March 2022

**INPI – Matinale INPI-CNCPI :  
« Mes marques et moi »**

[Details](#)

25 January 2022

**EUIPO – “Dynamic blocking injunctions.  
A webinar in collaboration with CEIPI”**

[Details](#) and [link to streaming](#)

1 February 2022

**EUIPO – “Power your business with the  
SME Fund”**

[Details](#)

10-11 February 2022

**Unifab - European Forum of Intellectual  
Property (Paris)**

[Details](#)

22 February 2022

**EUIPO – “EUIPO online platform - e-filing  
and what lies ahead”**

[Details](#)

10 March 2022

**Café ASPI – Secret d’affaire pour les TPE  
et PME**

[Details](#)

15 March 2022

**French Tech in the Alps – INPI – CNCPI :  
« Les contrats liés à la PI » (Grenoble)**

[Details](#)

15 March 2022

**FNDE – Synthèse « Droit des Marques »**

[Details](#)

17 March 2022

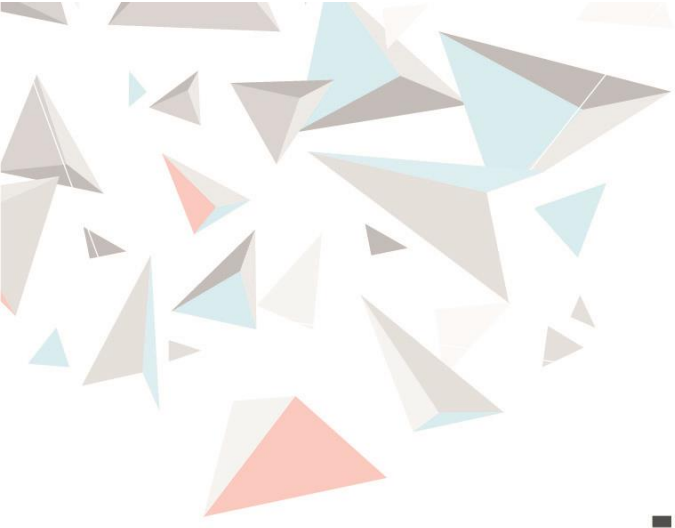
**FNDE – Synthèse « Contrats de  
propriété industrielle sur brevets et  
savoir-faire »**

[Details](#)

24 March 2022

**FNDE – Synthèse « Dessins et Modèles -  
Propriété littéraire et artistique »**

[Details](#)



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