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INPI LAW --- JOURNAL

September 2023 | No. 7

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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).

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Focus

Customs : 2022 report on France and ongoing French and EU legislative project

Presented on 24 May 2023 by Bruno Le Maire, Minister of the Economy, and Gabriel Attal, then Minister Delegate for Public Accounts, the *Annual Review on Customs 2022* reports on the **results achieved by French Customs** in their various missions last year: “Combating Fraud and Trafficking” (Part I), “Guarding Borders” (Part II) and “Acting by Innovating” (Part III).

The first part focuses on the **fight against counterfeiting**, with a further increase in seizures in 2022: 11.53 million items (excluding tobacco) were seized versus 9.1 million in 2021 (+27%), a number which more than doubled in two years (5.64 million in 2020).

NUMBER OF COUNTERFEIT ITEMS SEIZED, 2018-2022 (IN MILLIONS OF ITEMS)



A classification of seized counterfeit goods by category shows **toys, games and sporting goods** (over 5.8 million) at the top of the list. This sector is the most affected by counterfeiting. It accounts for nearly half of all seized items, with an increase in excess of 250% in the number of counterfeit products seized compared to 2021.

It is followed by the sector of **body care products** (more than 778,000) which represent 6.7% of seized items, a decrease of more than half of items seized in this sector compared to 2021 (1.7 million products).

Approximately 479,000 **clothes and accessories** were seized. **Beverages and foodstuffs** accounted for over 374,000.

Other increases were recorded in the sectors of **medicines** and **electrical, electronic & IT equipment**, each accounting for less than 3 per cent of total seizures.

MAIN CATEGORIES OF COUNTERFEIT GOODS SEIZED IN 2022 (IN NUMBER OF ITEMS)



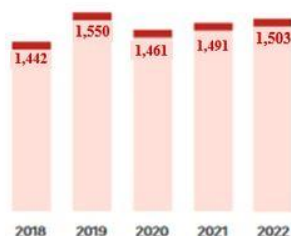
The Review states that “with regard to tobacco, seizures of counterfeit **cigarettes** have exploded, from just over 340,000 packs in 2021 to more than 4 million packs (equivalent to 85.5 tons of cigarettes) in 2022.”

Articles seized from **express and postal freight** account for 23.20% of counterfeits intercepted by customs, excluding tobacco. All goods combined, seizures of counterfeit goods represent an estimated value of **more than €405 million**.

The third part of the report provides information on the **legal procedures** for combating counterfeiting and the **new technical means** employed:

- **Applications for intervention** submitted in 2022 by companies holding IP rights reached 1,503 of which 504 governed by France (1,491 and 499 respectively in 2021).
- Actions are conducted mainly in collaboration with the National Anti-Fraud Operational Group (GONAP), the Cyber-Customs Unit of the National Administration of Intelligence & Customs Investigations (DNRED), the main e-commerce sites, and with INPI in order to encourage IP rights-holding companies to file intervention requests with customs authorities.
- New models of mobile scanners, as well as artificial intelligence and data analytics complement the system in operation.

NUMBER OF APPLICATIONS FOR CUSTOMS INTERVENTION SUBMITTED BY COMPANIES, 2018-2022



This report is published at a time when the legislative **bill to provide Customs with the**

¹ Ref. [Bill No. 1301](#) of 31 May 2023 adopted at first reading by the Senate, referred to the Committee on Finance, General Economy & Budget Control of the National Assembly

ways and means to address new threats, presented to the Government cabinet on 13 April 2023, was **passed by the Senate**¹ at first reading on 30 May 2023, following a fast-track procedure and amendment. The bill is intended to modernise the policy framework for customs administration, in particular by adapting it to developments in digital technology, cyber-customs crime, fraud ring strategies, EU regulations, as well as to bolster complementarity between the work of customs services and criminal investigations, and clarify the conditions for inspecting goods and transport facilities by customs officers.

At European level, on 17 May 2023 the European Commission presented proposals to **reform the EU Customs Union**². According to the Commission, by building on the opportunities offered by digital transformation, this reform will help simplify customs procedures for businesses, and provide customs authorities “with the tools and resources to properly assess and stop imports that pose real risks to the EU, its citizens and its economy”.

The draft proposal provides for the creation of a new authority, the **EU Customs Authority**, to oversee the **EU Customs Data Hub** which will become the engine of the new system by enabling companies to interact with a single portal to submit their customs information. Customs authorities will have an overview of the supply chains and production processes of goods entering the EU.

In addition, this reform provides for **online platforms** to play a central role in ensuring that goods sold online in the EU comply with all customs requirements. As official importers (“deemed importers”), the platforms will have to ensure that customs duties and VAT are paid at the time of purchase. Lastly, the reform puts an end to the duty relief threshold exempting goods with a value under €150 from customs duties, as 65% of these packages entering the EU are currently under-evaluated to evade importing customs duties.

² See also: National Administration of Customs and Indirect Duties, [news release](#), 17 May 2023

Anti-counterfeiting summer campaign 2023

In collaboration with the French Patent and Trademark Office (INPI), the French Anti-Counterfeiting Committee (CNAC), Customs and the Gendarmerie, the anti-counterfeiting association Union des fabricants (Unifab) launched its summer campaign to raise consumer awareness of counterfeiting in Cannes on 3 July 2023.

Using the slogan “Avoid a nasty surprise, these products are dangerous: counterfeiting is bogus!”, Unifab warned consumers that fake products always result in disappointment, danger or problems.

As part of this campaign which ran until 20 August 2023, seasonal Unifab ambassadors and a wide-scale poster campaign on the beaches and markets in the south of France informed holidaymakers of the many harmful consequences of counterfeiting on the economy, the environment, health and safety.

During the launch of this campaign, Pascal Faure, CEO of the INPI, highlighted the INPI’s commitment to the fight against counterfeiting, and the work to strengthen the legal certainty of industrial property rights over the past three years: “This not only enables rights owners to better defend themselves against counterfeiters, but also to have access to simpler and less costly opposition, revocation and invalidity procedures, directly with the INPI”.



Key figures:

- In France, **37% of consumers** have already been tricked into buying a product they thought was genuine (**43% of 15–24 year-olds**), according to an IFOP survey (French and international opinion and marketing research institute).
- **32% of consumers** have questioned the authenticity of a product when purchasing it, and **11% say they have intentionally purchased fake goods**, according to a study by the European Union Intellectual Property Office (EUIPO).

The INPI: a key player in the fight against counterfeiting

The INPI plays an active role in the fight against counterfeiting by collaborating with the main private and public partners to defend intellectual property rights. In particular:

- The INPI is leading the “France against counterfeiting” initiative, launched in close collaboration with the Center for International Intellectual Property Studies (CEIPI), the French Confederation of Small and Medium-sized Enterprises (CPME), the Directorate General of Customs and Indirect Taxes (DGDDI), the French Federation of Mechanical Engineering Industries (FIM) and Unifab, with the main objectives of:
 - Uniting: holding discussions and giving a voice to all those involved in the fight against counterfeiting, to get the most comprehensive view possible of the situation;
 - Using data: gathering useful information to determine the nature and impact of counterfeiting in France ;
 - Proposing the creation of new tools to facilitate the work of players in the fight against counterfeiting.
- The INPI serves as the general secretariat for the French Anti-Counterfeiting Committee (CNAC), chaired by MP Christophe Blanchet, a forum for discussions, consultation and coordination between public and private partners involved in the fight against counterfeiting, aimed at improving the sharing of best practices, coordinating specific actions and formulating new recommendations.
- As a long-standing partner of Unifab, the INPI is involved in many of the initiatives driven by the association (World Anti-Counterfeiting Day, European IP Forum, etc.).

Internationally, the network of INPI regional counsellors – which covers almost 100 countries – helps French companies with issues related to counterfeiting.

French Case Law

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

Trademarks

Court of Cassation, 13 April 2023: The Court of Cassation has overturned a ruling that had classified [the operator of an online platform as a data host](#). The Paris Court of Appeal had noted that the operator offered, among other things, a logistical service for the manufacture and delivery of products, from which it could be inferred that it had an **active role** of such a kind as to give it knowledge or control of the data relating to the offers available on its platform. By wrongly classifying it as a hosting provider, it infringed Article 6-I-2 of the French Law on confidence in the digital economy of 21 June 2004.

Paris Court of Appeal, 12 April 2023: A company offering [online data storage services](#) incurs liability under Article 6-I-2 of the French Law on confidence in the digital economy of 21 June 2004 by **failing to act promptly to remove links** appearing on its website. These links directed users to unauthorised copies of "Pokemon" video games, in which the plaintiff companies hold copyright. One of them is also the owner of several European Union trademarks, including NINTENDO, SUPER MARIO and POKEMON SUN.

Paris Court of Appeal, 8 March 2023: The sale, on a [stand at the Saint-Ouen flea market](#), of goods bearing the trademarks invoked

constituted an infringement. The **owner of the stand**, who leased the stand to the trader who offered the infringing goods for sale, is an **intermediary** within the meaning of Articles 9(1)(a) and 11 of Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights. In view of the landlord's conduct, which is not limited to the mere legitimate defence of his interests, it should be considered that the injunction ordering him to terminate the lease with the tenant must be accompanied by a deterrent measure to ensure that it is effective. Nevertheless, in the present case, the landlord cannot be treated in the same way as the infringer and be held jointly and severally liable for payment of the penalties imposed on the infringer.

Paris Court of Appeal, 15 March 2023: The **opposition** against registration of the word mark FRANCOIS VILLON for goods in classes 18 and 25, based on **damage to an unregistered trademark that is well-known** within the meaning of [Article 6bis of the Paris Convention](#), is declared inadmissible. Although some of the documents produced show that the trademark was well-known in the 1970s and 1980s, there is no evidence to show that at the date the opposition was filed, the trademark, which was no longer being used, was still known to a large proportion of the French public.

Bordeaux Court of Appeal, 6 June 2023:

The decision of the INPI rejecting the application for [a declaration of invalidity of the trademark CENTAURE INVESTISSEMENTS](#), which designates financial, banking and insurance services, is confirmed. The trademark was not **filed in bad faith**. Indeed, although its owner was aware, on the date of filing, of the use by the plaintiff company, which is one of the world's leading sellers of cognac, of the term Centaure and the representation of a centaur, proof of fraudulent intent has not been adduced. Furthermore, the trademark at issue does not cause **damage to the reputation** of the word mark CENTAURE and the figurative mark depicting a centaur. Given the great difference between the goods and services concerned (production and sale of cognac/advice in finance, real estate and insurance), the similarities between the signs and the strength of the reputation of the earlier trademarks for spirits do not allow the existence of a link between the trademarks at issue in the mind of the consumer to be accepted.

Designs

Court of Cassation, 25 May 2023:



« Chaîne d'ancre enchaînée » ring by Hermès Sellier
- large model - <https://www.hermes.com>

The Court of Cassation approved the Paris Court of Appeal's decision to uphold the originality of a Hermès ring composed of the

assembly of three curved chains made up of ["Chaîne d'Ancre" links](#), on the basis that the specific combination invoked reflected aesthetic preferences that gave it an originality marked by modernity. The Paris Court of Appeal also correctly found acts of **unfair and parasitic competition**, distinct from infringement, because of the marketing by the defendant company of an entire range of necklaces, bracelets, cufflinks and earrings copying the "Chaîne d'Ancre" jewellery in question.

Patents

Paris Court of Appeal, 26 May 2023: Dana-Farber Cancer Institute Inc, holder of a European patent, filed an [application for a supplementary protection certificate \(SPC\)](#) for the drug Tecentriq intended for the treatment of certain cancers. The INPI rejected this application. Relying on the case law of the Court of Justice of the European Union (CJEU), in particular the **Royalty Pharma judgment** (C-650/17), the Second Chamber of the Paris Court of Appeal approved this decision. It held that the antibody atezolizumab, the subject of the SPC, although meeting the functional definition of the active ingredient covered by the basic European patent, was not protected by the latter within the meaning of Article 3(a) of Regulation (EC) No 469/2009. This product was expressly the subject of a subsequent patent after many years of research. In a ruling dated 25 May 2022, the First Chamber of the Paris Court of Appeal had overturned a decision by the INPI to reject an SPC application for another antibody, avelumab, filed on the basis of the same patent for the anti-cancer drug Bavencio. An appeal in cassation against this ruling is pending.

Paris Court of Appeal, 1st March 2023: A patent relating to a **kit for the consumption of drugs** is not contrary to **public order or morality**. Although it relates to an operative part enabling the consumption of narcotic products, which is prohibited, it can only be exploited through the distribution of the kit to drug users by associations that operate legally, with a public health objective, and not to promote or incite illegal drug use. On the other hand, the patent was partially revoked for lack of novelty, due to the [disclosure of the invention](#) by the company that filed the patent and that had previously sold the kit to associations fighting against the health risks to which crack smokers are exposed.

Paris Court of Appeal, 29 March 2023: [Inventions made by an employee](#) in the performance of an employment contract involving an inventive mission confer an entitlement to **additional remuneration** provided that **the invention is patentable**. In this case, the evidence provided by the former employee testifies to maintenance work, troubleshooting and technical improvements to the systems for which he was responsible as part of his duties. However, they are not sufficient to establish that the inventions concerned are new, involve an inventive step and are susceptible of industrial application.

Geographical Indications

Paris Court of Appeal, 26 May 2023: The word and semi-figurative marks NewRhône are cancelled on the grounds of infringement of [the protected designations of origin \(PDO\) Côtes du Rhône and Côtes du Rhône Villages](#). Pursuant to Article 103(2)(b) of Regulation (EU) No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products, **the imitation or evocation** of a PDO is prohibited, including for a wine covered by that designation. In the present case, the trademarks at issue incorporate the word "Rhône", which is the dominant element of the PDOs in question. This term will be identified by the average European consumer as referring to wines with a protected designation of origin, meeting criteria defined by a specification.



Sablet vineyard

By Marianne Casamance, Personal work, Public domain
<https://commons.wikimedia.org/w/index.php?curid=8029448>

INPI Decisions

Invalidity of the trademark Aylia&Co by Özge on the grounds of likelihood of confusion with the earlier trademark ALAÏA and damage to the reputation of that trademark

ALAÏA

Aylia&Co by Özge

The contested trademark AYLIA&Co by Özge, registered to designate numerous goods, in particular in classes 14 and 25, is invalidated on the grounds of **likelihood of confusion** with the European Union trademark ALAÏA, and on the grounds of **damage to the reputation** of that same trademark, for all the goods designated.

The goods of the contested trademark are identical to certain goods of the earlier trademark.

The signs at issue have weak visual and phonetic similarities and conceptual differences. However, these are offset by their **distinctive and dominant elements**. The terms 'Aylia' and 'Alaïa' do not have a direct and specific link with the claimed goods, nor do they indicate or evoke any specific characteristic of them. In addition, the word 'Aylia', which is highlighted in the contested sign by its initial position, appears to be the essential element of the contested mark, the sequence '&CO', which is universally used in a commercial context to designate the company, group or business producing the goods, being perceived as an incidental indication. Furthermore, although the word combination "By Özge" appears distinctive in relation to the goods at issue, it is nevertheless located at the end of a long sign. In addition, together with the word 'By', it immediately evokes an umbrella trademark or the signature of a designer, so that the word 'Aylia', situated in an initial position, has an autonomous distinctiveness and essential character within this trademark.

The earlier mark is **known to a significant part of the relevant public in the territory of the European Union** and principally in France to designate some of the goods deemed identical, namely articles of clothing. It will therefore be considered to have enhanced distinctive character for some of the claimed goods deemed to be identical.

There is therefore a likelihood of confusion on the part of the relevant public. Consequently, the contested trademark must be declared invalid for all the claimed goods.

The contested trademark also damages the reputation of the European Union trademark ALAÏA. Such a damage presupposes **the existence of a reputation** for the earlier trademark invoked in France or, in the case of a European Union trademark, in the European Union, which is only established when the earlier trademark is known to a significant part of the public concerned by the goods or services it designates, **the existence of a link between the signs** in the mind of the public and evidence showing the damage to the reputation. These three conditions are cumulative, so that the absence of any one of them is sufficient to rule out the damage.

On the basis of the documents provided, the earlier trademark ALAÏA must be regarded as having acquired a reputation mainly in France for articles of clothing, handbags and perfumes.

In order to assess whether there is a link between the signs in the mind of the public, account must be taken in particular of the degree of similarity between the signs, the nature of the goods and services (including the degree of similarity or dissimilarity between those goods and services) and the relevant public, the strength of the reputation of the earlier mark (in order to determine whether this extends beyond the public targeted by this trademark), the degree of distinctive character of the earlier mark, whether inherent or acquired through use, and the

existence of a likelihood of confusion on the part of the public.

The signs have significant similarities in view of their distinctive and dominant elements. The reputation of the earlier trademark is established mainly on French territory. In this respect, it should be noted that consumers of the products of the contested French trademark will necessarily be aware of the earlier trademark, so that they will be more likely to establish a link between the trademarks at issue because of the coincidence of the territories.

As regards the nature of the goods in question, the clothing goods covered by the contested mark are identical to some of the goods covered by the earlier mark and a likelihood of confusion as to the origin of the two marks has been established in relation to those goods. Although the jewellery goods in the contested mark do not have the same nature, purpose or method of use as the goods in the earlier mark in respect of which reputation has been demonstrated, and although the points of sale for those goods are usually different, certain chains which produce fashion clothing, handbags or perfumes also sell jewellery under their trademarks. There is therefore an **overlap between consumers** of the products of the earlier trademark considered to have a reputation and those of the contested trademark.

As the earlier trademark has no specific meaning in the French language, it is arbitrary and has **inherent distinctive character** in addition to that acquired through the intensity and duration of its use. Consequently, consumers of the goods of the contested mark who are necessarily familiar with the earlier mark are likely to make a link with it when they encounter the contested mark.

Damage to the reputation of the earlier trademark is constituted by **use without due cause** of the contested trademark which either takes or would take unfair advantage of the distinctive character or the reputation of the earlier trademark, or is or would be detrimental to its distinctive character, or is or would be detrimental to its reputation. Only one of these three types of damage is sufficient for reputed trademark protection to apply.

The harm caused by the **dilution** of the distinctive character of the earlier trademark has not been demonstrated. On the other hand, the earlier trademark enjoys a **positive image**, strongly anchored in the mind of the consumer given the length and intensity of use of the trademark and the quality and sophistication of its creations, some of which are described as 'iconic'. There is therefore a risk that consumers, who establish a link between the marks at issue, will project the characteristics of the earlier mark onto the contested mark.

Consequently, this transfer of the positive image of the earlier trademark could make it easier to market the products of the contested trademark, thereby reducing the need to invest in advertising, and would enable the owner of the contested trademark to benefit, free of charge, from the commercial efforts made by the invalidity applicant to create and maintain that image. It therefore appears that the contested trademark is likely to **take unfair advantage of the reputation** of the earlier trademark in respect of all the registered goods.

Finally, the owner has not put forward any due cause for the use of the contested trademark.

INPI decision, 28 April 2023, [NL22-0170](#) (NL20220170)

By Marie Jaouen, Head of the Publishing and Translation Unit, INPI

Opposition to a patent before the INPI - Extension of the subject matter beyond the content of the initial application by intermediate generalisation

The opposition filed against the patent entitled "Apparatus and method for filling water balloons with water" is recognised as justified.

The contested patent describes a device that enables a large quantity of water bombs to be filled quickly. Balloons are attached to tubes fixed to a housing which is then attached to a garden hose.

The opponent requested **total revocation** of the contested patent on the following grounds: insufficiency of disclosure, lack of novelty, lack of inventive step and extension of the subject matter of the patent beyond the content of the application as filed for claims Nos. 1 to 14.

The INPI found that the patent could not be maintained as granted because main claim No. 1 and dependent claims Nos. 2 to 13 extended beyond the content of the application as filed. On the other hand, independent claim No. 14 does not extend beyond the content of the filed application, but its subject matter is not new and does not involve any inventive step.

Claim No. 1 cannot be maintained as granted, due to two amendments during the grant proceedings which constitute extensions of the subject matter of the patent beyond the content of the application as filed.

The first is the addition of the feature whereby a plurality of hollow tubes extend in the same direction without specifying that they should flare outwards when the balloons are filled. Claim No. 1, reworded in this way, therefore teaches the technical possibility of dissociating the characteristic of the parallelism of the tubes from that of their outward flaring during filling. However, the description, as filed, explicitly and consistently states that "the tubes extend substantially parallel to each other and are designed and configured, when filled, to flare progressively outwards" without any mention of the possibility of their dissociation. A person skilled in the art, which in this case means a mechanic with basic knowledge of general mechanics, in particular piping and sealing, will understand from reading the patent application that because of the parallel positioning and flexibility of the tubes, filling the balloons necessarily means that they will come into contact with each other, naturally forcing the tubes to flare outwards. By this insert, the owner has therefore added a technical feature from the description by dissociating it from another which was inextricably linked to it according to the teaching of the description, which constitutes an extension of the subject matter of the patent beyond the content of the application as filed.

The purpose of the second amendment to claim No. 1 during the grant proceedings is to specify

that the filled balloons can be detached by gravity combined with an acceleration applied to the tubes, without the latter having to be upward. However, it is clear from all the references in the filed description that the acceleration applied to the tubes to detach the balloons is upwards. From reading the patent application, the skilled person will understand that in order to have a force capable of detaching all the balloons from the tubes, the most appropriate movement is an upward movement and not a downward or lateral movement. As a result, the rewording of claim No. 1 to the effect that acceleration is not required to be bottom-up extends the subject matter of the patent, as this feature cannot be deduced directly and unambiguously from the application as filed.

Thus, by adding two technical features to claim No. 1 and dissociating them from those with which they were inextricably linked, the owner **extended the subject matter of their patent beyond the application as filed by intermediate generalisation.**

The same is true of claims Nos. 2 to 13, which are directly or indirectly related to claim No. 1 in that they incorporate all of its features and none of these dependent claims corrects the intermediate generalisations set out above, so that they contain the same two intermediate generalisations as claim No. 1 and consequently the subject matter of each of them extends beyond the content of the application as filed.

The ground of opposition that the subject matter of the patent as granted extends beyond the contents of the application is therefore well founded.

The subject matter of independent claim No. 14 as granted is not new.

The contested patent claims **priority** to three US patent applications, two of which are being contested by the opponent.

However, the owner of the French patent is the same as the owner of the two US applications, and it cannot be argued that the patent owner wrongly benefited from a restoration of their priority right, since restoration decisions cannot be challenged in opposition proceedings. On the other hand, the opponent rightly contests the identity of the inventions, considering that the

invention presented in the French patent is not identical to those in the earlier US applications. Claim No. 14 contains technical details which cannot be directly and unambiguously deduced from the patents whose priority is claimed, so that this claim cannot benefit from their priority date.

The prior art documents submitted in support of the lack of novelty, namely promotional videos explaining how to use the product, distributed after the filing of the two contested US patent applications but before the filing of the French application, anticipate two of the three alternatives in claim No. 14. Consequently, two of the three alternatives in claim No. 14 are not new.

The protection conferred by a claim can only relate to patentable subject matter within the meaning of Articles L. 611-10, L. 611-11 and L. 611-13 to L. 611-19 of the French Intellectual Property Code (CPI). Thus, all the ways to carry out the invention falling within the scope of the claim must satisfy this requirement. If only one alternative in the claim defines subject matter that is not new, the claim relates to subject matter that is not new.

In the light of the evidence presented, the ground of opposition that the **subject matter of claim No. 14 is not new** is therefore well founded.

Moreover, claim No. 14 **lacks any inventive step**.

One of the videos does not disclose how to detach the balloons by moving them away from the hollow tubes, but by shaking the housing or letting the filled balloons slide under their own

weight. The technical effect of this difference is to define an alternative way of disconnecting the balloons from the device to stop them filling. The objective technical problem is therefore to find a method for disconnecting the balloons from the device that is an alternative to those presented in this video. A person skilled in the art wishing to solve this technical problem would obviously have found the subject matter of alternative b of claim No. 14.

The ground of opposition that claim No. 14 does not involve an inventive step is therefore well founded.

During the opposition proceedings, the owner may amend the claims of the patent provided, in particular, that the amendments made meet one of the grounds for opposition (Art L. 613-23-3 I 1° of the CPI). In the present case, none of the requests to amend the claims submitted by the owner is capable of resolving the objections presented.

The patent owner submitted 14 auxiliary requests during the opposition proceedings. The first 13 requests do not respond to a ground for opposition and therefore do not comply with Article L.613-23-3 I 1° CPI. Auxiliary requests Nos. 14 and 15 are inadmissible as they were submitted too late (Articles R.613-44-6 and R.613-44-7 CPI).

Consequently, the contested patent is revoked in full.

INPI decision, 21 April 2023, [OPP21-0018](#) (OB20210018)

By Astrid Coulourmy, Legal expert, INPI

About INPI



Annual report 2022

Posted online on 27 March 2023, the [INPI annual report](#) presents the **Institute's activity in the course of 2022**, "an intense year marked by success, the backdrop of political, economic and pandemic-induced instability in Europe and the world notwithstanding", according to the **editorial by the CEO of the INPI**, Pascal Faure.

After presenting the "Highlights of 2022" in the form of a chronological table, as well as "Key data"³, the report devotes particular attention to "Industrial property, **a matter for the French presidency of the Council of the European Union**" (1st January - 30 June 2022). The emphasis is on the INPI's contribution to this presidency by the organisation of an **international conference** on intellectual property⁴, and by its involvement in the European work aimed at developing the legislation on **geographical indications** for craft and industrial products, as well as to review the legal framework for **designs** at EU level.

The sections that follow, entitled "Offering you more services", "Promoting your innovations" and "Upgrading systems for management", develop the following points, in particular :

- the deployment of the **online one-stop shop** for business formalities;
- **appeal** and **administrative procedures** before the INPI made more accessible: patent opposition hearings, applications for trademark cancellation;
- the **approval of the geographical indications** "potteries of Alsace Soufflenheim/Betschdorf" on 11 March 2022, and "Laguiole knife" on 23 September 2022⁵;
- the **fight against counterfeiting**, chiefly with the launch of the project managed by the INPI, "France anti-contrefaçon" [France against counterfeiting], at the General Assembly of the National Anti-Counterfeiting Committee (CNAC)⁶;
- **cooperation, at international level, with the foreign offices** and, in particular, the signing of two **PPH agreements** (*Patent Prosecution Highway*) with Brazil on 15 March 2022, and with the Korean Intellectual Property Office on 14 July 2022⁷, as well as Pascal Faure's chairing of the assembly of the **Lisbon Union** for the Protection of **Appellations of Origin** and their International Registration at the sixty-third session of WIPO General Assemblies (14-24 July 2022, Geneva)⁸.

³ Statistics on the number of applications for industrial property rights, new types of trademarks, utility certificates, post-registration/grant procedures, inventive step, provisional patent applications, offices across France and strategic regions across the world, the international network, customer support, *open data* (pages 10-15).

⁴ See [PIBD 2022, 1174, I-1](#)

⁵ See [PIBD 2022, 1189, I-1](#).

⁶ See [PIBD 2022, 1194, IV-1](#)

⁷ See [PIBD 2022, 1179, I-3](#); [PIBD 2022, 1186, I-5](#).

⁸ See [PIBD 2022, 1187, IV-1](#).

Viva Technology 2023: a landmark moment for innovation

The French Patent and Trademark Office (INPI) attended Viva Technology, the world's biggest tech, start-up and digital event, from 14 to 17 June in Paris. At the heart of the show's hustle and bustle, our stand held themed workshops, inspiring pitches, captivating demos and fruitful discussions with our business experts. Here's a look back at the highlights of the 7th edition.

From **14 to 17 June**, the INPI was at Viva Technology, the world's leading event for innovation and new technologies. This year, over 150,000 visitors attended.

Over 4 days, the INPI welcomed innovators, entrepreneurs, start-ups and students to its stand. Our industrial property (IP) experts on the stand answered their questions on IP matters and presented our various help and [support services](#).

The INPI also organised **fifteen workshops** on its stand with internal and external speakers.

Topics ranged from financing IP strategy to patent taxation, from protecting new types of trademark to raising funds, from counterfeiting on e-commerce platforms to international development.

We **co-hosted** several of the workshops with [Business France](#), with whom we shared the stand. All workshops were shared live on the INPI's X (formerly Twitter) and LinkedIn accounts, where they are available for you to watch back.

Fourteen start-ups supported in their daily operations by INPI showcased their innovations on our stand: Tshoko, I-Virtual, Foxar, Tiny, Maison M, Veragrow, Rebelle Snacks, Zufo, AI-Bright, TwinswHeel, Convergence, Ugla, Gravipack, Hexadrone. The

start-ups presented their activities and innovations through pitches and demos.

The [INPI pitch contest](#) was also a big success. It was held for the first time at Viva Technology in partnership with the French Tech Tremplin programme, which promotes diversity and inclusiveness in the entrepreneurial ecosystem.

The discussions, meetings, sharing, discoveries, inspirations and innovations were all highlights of this 2023 edition of VivaTech.

Discover the history of Conté pencils

It's back to school time! Young and old are back at school. When it comes to school supplies, the traditional pencil is always at the top of the list. An opportunity to take a look back at the famous Conté pencil, for which the INPI still holds the original patent.

In 1794, France was at war. British ships blockaded the country's ports, preventing the supply of many products. Among them, the **pencil**, an essential tool for many trades: artisans, craftsmen, artists... Made from graphite, a natural mineral derived from carbon and extracted from mines in the county of Cumberland on the Northern border of England, the pencil was nowhere to be found on the other side of the Channel.

Despite these difficult and uncertain times, France enjoyed a flourishing artistic and scientific scene. **Nicolas-Jacques Conté** was a draughtsman, painter and renowned scientist, a true *jack-of-all-trades* who was also a mechanic, physicist and chemist. In 1794, at the age of 40, he helped found the Conservatoire National des Arts et Métiers [National Conservatory of Arts and Crafts] and

became a distinguished member. The same year also saw the creation of the Agence des mines [Agency of Mining], which would go on to become the Corps des ingénieurs des mines. The Agency asked Conté to invent a pencil lead that no longer required English raw materials.



In a very short time, Conté found a solution using a mixture of ordinary graphite and clay fired at high temperature. On 7 January 1795, he filed a **patent** for "artificial pencils". This was the **77th application filed** since the first **patent law was passed in 1791**.

This new-generation pencil had several advantages: ordinary graphite was available almost everywhere and the manufacturing

process could be industrialised. Two factors that make production cheaper. The lead, protected by two half-cylinders of cedar or juniper, would become more or less greasy according to the firing temperature and the graphite-clay ratio.

The quality of the Conté pencil quickly established its reputation: it was acclaimed at the 1798 Exhibition of the Products of French Industry and, two years later, was awarded the médaille d'or des Arts et Métiers [gold medal of Arts and Crafts].

After Conté's death in 1805, his son and son-in-law took over and created *Conté-Humblot et compagnie*. The democratisation of writing, followed by Jules Ferry's compulsory education system, enabled sales to soar and the company to expand. Bought by Bic in 1979, the brand has endured and become the reference brand for drawing and dry techniques.

The artificial pencil? A seemingly simple idea, but above all an idea of genius, whose patent is still the pride of Conté: 150 years after it was filed, the original document was used as an advertisement in an issue of the weekly magazine *L'Illustration*. And the Conté pencil is still present in our schoolchildren's pencil cases.

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

International IP Law news

Bilateral side meetings on the occasion of the sixty-fourth series of meetings of the Assemblies of the Member States of WIPO

The sixty-fourth series of meetings of the Assemblies of the Member States of WIPO took place this year from 6 to 14 July, attended by hundreds of delegates from the 193 Member States of WIPO, who came to discuss the future of the global intellectual property ecosystem.

Alongside these General Assemblies, INPI [French Patent and Trademark Office] was able to organise several bilateral meetings with its foreign counterparts also attending this occasion in Geneva.

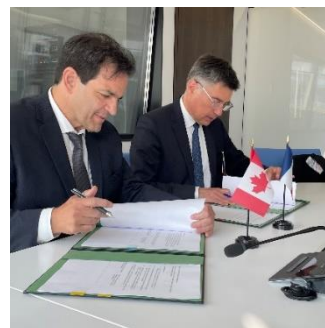
The CEO of INPI, Mr Pascal Faure, was able to meet with several heads of delegation from third countries, including three IP5 countries, namely China, South Korea and Japan. These meetings within this world event dedicated to intellectual property are considered to be time to exchange views on what has been done in the context of our collaboration with each other, to discuss prospects for the future and even forge new links with international partners.

In a few days, around ten meetings were held with the following intellectual property offices:

- The Korean Intellectual Property Office (KIPO), with which relations are very dynamic, particularly with regard to the implementation of the agreement for accelerated processing of patent applications, known as PPH (patent prosecution highway), signed in July 2022;
- The Australian intellectual property office (IP Australia); this very first meeting with Australia made it possible to determine

the common areas of interest on which to build our work with each other;

- The Saudi Authority for Intellectual Property (SAIP), for a meeting in which it transpired that both our countries have a keen interest in cooperation directed towards the promotion of geographical indications;
- The Canadian Intellectual Property Office (CIPO), for a meeting marked by the signing of a new agreement and a work plan for the years 2023-2025, including, in particular, a main approach to IP awareness raising for start-ups and SMEs, or for younger people;



Konstantinos Georgaras, CEO of the Canadian Intellectual Property Office (CIPO) and Pascal Faure, CEO of the INPI

- The Qatar industrial property office, to touch on future cooperation between our two countries;
- The Japan Patent Office (JPO), for a meeting allowing us to bring up, in particular, strengthening of our cooperation with regard to supporting economic players and to raising public awareness of the importance of IP;

- The China National Intellectual Property Administration (CNIPA); this meeting allowed us to record the priority areas of cooperation between our two offices; the discussions with the CNIPA were, moreover, continued in Paris on 12 July on the occasion of the 34th Joint Commission organised with the key players in the fight against counterfeiting at the premises of the French anti-counterfeiting association Unifab;
- Finally, INPI also met in Geneva with European partners, including the United Kingdom Intellectual Property Office (UKIPO) and the Swiss Federal Institute of Intellectual Property (IPI).

By Céline Boisseau, Coordinator of INPI International Network

Intellectual Property Benchbook Series



WIPO has just released the first volumes of a series entitled "[Intellectual Property Benchbook Series](#)" on its website. The series contains a set of practical manuals on IP law and procedure intended, inter alia, to support judges in adjudicating IP cases.

The first volume of the Benchbook series introduces the international legal framework for IP (trademarks, patents, copyright, and remedies), and the multilateral treaties.

The following volumes are national guides on the judicial adjudication of IP disputes. They are authored by experienced judges, with a special focus on procedural aspects. The first two are devoted to the Philippines and to Viet Nam.

On 5 September 2023, INPI and the Moroccan Office of Industrial and Commercial Property (OMPIC) signed an agreement to fast-track the patent granting process, known as the Patent Prosecution Highway (PPH) agreement.

During their 26th Joint Committee, held in Casablanca this year, INPI and OMPIC signed an agreement to enable accelerated processing of patent applications (Patent Prosecution Highway (PPH)). This is the seventh such agreement at international level for INPI since it signed the first one on 26 November 2020 with the Japanese Patent Office (JPO).

Not only that, but it is also the first agreement of this type to be signed with an African nation.

INPI has already entered into PPH agreements with the United States Patent and Trademark Office (USPTO) and the Canadian Intellectual Property Office (CIPO), signed at the end of 2021, the Brazilian office (INPI Brazil) and the Korean Intellectual Property Office (KIPO), signed in 2022, and, most recently, the China National Intellectual Property Administration (CNIPA), signed on 6 April 2023.

The agreement signed with OMPIC will enter into force on **1 November 2023**. This means that, from that date onwards, applicants will be able to request a fast-tracked granting procedure for a second patent filing with OMPIC, whether this concerns a national filing or a Moroccan national stage filing under the PCT, as long as the second filing contains claims that are sufficiently similar to those mentioned in the first application examined and deemed patentable by INPI. On a reciprocal basis, this PPH agreement will apply to applicants wishing to benefit from the expedited processing of patent applications in France, whether these claim the priority of a

Moroccan national application or a PCT application.

Regarding patent filings with the Moroccan office, it is interesting to note that, among foreign applicants as a whole, French applicants are ranked second behind the United States, which shows that there is keen interest in seeking protection for their innovations in Morocco.

Under this agreement, applicants will therefore benefit from a new route for obtaining a Moroccan patent, which is guaranteed to save them time.

This 26th annual Joint Committee demonstrates the enduring trusting relationship that has been upheld between our two offices which, furthermore, took stock of their cooperation and discussed their new road map for 2023/2024 around the key objectives of training, dissemination of intellectual property information and talks about our respective procedures.

By Céline Boisseau, Coordinator of INPI International Network

SAUDI ARABIA

Seminar on the protection of intellectual property and the fight against counterfeiting co-organised with the Naif Arab University for Security Sciences (NAUSS)

For the second year running, the INPI and the Naif Arab University for Security Sciences (NAUSS), the academic body of the Arab Interior Ministers Council, co-organised a seminar entirely dedicated to the protection of industrial property and the fight against counterfeiting from 13 to 15 June in Paris.

The seminar was part of the collaborative relationship forged in recent years with the NAUSS and duly set out in a **cooperative agreement signed on 12 November 2022**.

Prominent specialists in IP law and institutional stakeholders in anti-counterfeiting brought their expertise to the event, enabling participants to benefit from a comparative analysis of the French and Arab legal frameworks pertaining to these matters.

The seminar enjoyed a particular standing this year. Participants convened from eight countries across the Arab League and for the most part, from ministries engaged in the fight against counterfeiting, namely those of the interior, justice, business, and the economy.

The first day focused on the legal and regulatory framework for the protection of intellectual property and the legal requirements for the registration of trademarks.

The latter part of the day concentrated on collective anti-counterfeiting measures and the role of customs in the fight against counterfeiting.

The second day provided participants with an opportunity to gain insight into individual actions designed to prevent infringement of IP rights. Judicial procedures also came under discussion.

The aim of the last topic on the day's agenda was to share other experiences in the area of IP protection and enforcement, namely those of Qatar (within the specific context of the FIFA World Cup) and Spain.

The last day of the programme focused on visits on the ground. One group visited the Court of Appeal and the Manufacturers Union (UNIFAB) hosted a second group.

The wealth of information and sharing of experience over the three-day seminar gave rise to constructive discussions between participants and speakers, and participants from different countries.

By Jinane Kabbara, INPI Regional Counsellor for the Middle-East⁹

INPI/AfriPI cooperation: regional seminar in Tunis dedicated to the fight against counterfeiting and the enforcement of intellectual property rights

From **12 to 14 September 2023**, in connection with the project “Intellectual Property Rights and Innovation in Africa” (AfriPI) funded by the European Union and implemented by EUIPO, INPI organized in Tunis a **regional seminar dedicated to the fight against counterfeiting and the enforcement of intellectual property rights**, in a context of increasing proliferation of counterfeit products in North Africa.

This seminar, intended for decision-makers, regulatory authorities, rights holders and players involved in the enforcement of intellectual property rights (IPRs) of North African countries, notably Algeria, Egypt, Morocco and Tunisia, aimed to raise awareness among the authorities about the importance of intellectual property, as well as the major role of each of the stakeholders involved in combating counterfeiting. It also aimed to encourage a dialogue between key stakeholders in order to foster experience sharing, identify factors conducive to counterfeiting, and exchange about effective techniques and strategies for detecting,

monitoring and investigating IPR infringements.

The opening ceremony took place on 12 September, including a video address by the CEO of INPI. Mr Pascal Faure congratulated the authorities of the countries in attendance for their involvement and their efforts to combat counterfeiting, pointing out that it is by acting together through close cooperation that it will be possible to strengthen consumer confidence, ensure the defence of business interests, and enable growth to be stimulated.

François Kaiser¹⁰, INPI regional counsellor based in Rabat, helped organize this event. During the first day, he also moderated a session dedicated to the role of IP Offices in the protection and enforcement of IP rights, involving representatives from the Moroccan, Algerian, Tunisian and American offices.

This event in Tunis followed a previous regional seminar entitled “Anti-counterfeiting and intellectual property and their impact on the economy and the environment”, which took place on 28 and 29 November 2022 in Algiers, with the same objective of strengthening the capacities of stakeholders and raising their awareness on issues related to the enforcement of IPRs, thus demonstrating a determination to confirm this type of event in the long term in order to rally the largest number of players in the fight against counterfeiting.

By Céline Boisseau, Coordinator of INPI International Network

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The members of INPI’s “international network” (ten 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

4 October 2023

IRPI – 7th edition: Young IP Researchers' Day

[Details](#)

10-11 October 2023

EPO – Examination Matters 2023

[Details](#)

11-12 October 2023

CEIPI – Conference: "How harmonized is patent law in Europe?"



[Details](#)

17 October 2023

EPO Observatory on Patents and Technology – Inaugural event on innovation, Intellectual Property rights (IP rights) and startups

[Details](#)

17 October / 23 November 2023

FNDE – Patent Law Round Up

Obtaining patents - supplementary protection certificates – bio-medical: Patentability requirements, French and European filing procedures

[Details](#)

26 October 2023

WIPO – Seminar on Traditional Knowledge and Genetic Resources

[Details](#)

16 November / 24 November 2023

FNDE – Patent Law Round Up

Patent exploitation: Infringing acts and infringement actions, contracts, ownership and employee inventions

[Details](#)

2-3 November 2023

WIPO – Seminar on the Practical Aspects of the Madrid System for the International Registration of Marks for Advanced Users

[Details](#)

7-8 November 2023

WIPO – Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice

[Details](#)



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