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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

Historic conclusion of a WIPO (World Intellectual Property Organization) Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge

After over twenty years of negotiations, on 24 May 2024, WIPO's member states finally concluded the WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge¹. This is the first WIPO treaty on the interface between intellectual property, genetic resources and associated traditional knowledge. It is also the first WIPO treaty to contain specific provisions on Indigenous Peoples and local communities.

1. Some context:

The **Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore** (IGC-GRTKF) has existed within WIPO since the 2000s. It deals with two separate themes: on one hand, the committee for genetic resources and traditional knowledge associated with genetic resources, which resulted in the [WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge](#) and, on the other, a committee for [traditional cultural expressions/folklore](#) (next session to be held in November 2024).

In July 2022, the WIPO General Assembly decided to convoke a Diplomatic Conference to conclude an international legal instrument relating to intellectual property, genetic resources and traditional knowledge associated with genetic resources.

The [Diplomatic Conference](#), which was held in Geneva² from 13 to 24 May 2024 resulted in

the long awaited success: the approval by consensus of this historic treaty by WIPO member states.

Genetic resources and other biological resources constitute a specific subject matter and are subject to many discussions as regards to their intellectual property protection, since intellectual property systems started protecting innovation in modern life sciences from the mid-70s. Genetic resources are defined as “*genetic material of actual or potential value*”³ and include, for example, plants, seeds, microorganisms, animal varieties, genetic sequences, etc. Genetic resources, as such, are not patentable given that they are products of nature and therefore not inventions. However, inventions *based on* these resources can be protected by a patent.

For **traditional knowledge associated with genetic resources**, no international definition has been established, but the French Environmental Code defines it as “*the knowledge, innovations and practices relating to the genetic or biochemical properties of the said resource, its use or its characteristics, which have been held from ancient times and on an ongoing basis by one or several communities of inhabitants referred to above, as well as the evolutions to such knowledge and practices when they are of the fact of those communities of inhabitants*”⁴. There are many examples of associated traditional knowledge⁵. Among them, one example is the *Jeevani*, from India, developed using the Arogyapaacha plant and the medicinal knowledge of the Kani tribe, is known for its anti-stress and anti-fatigue

¹ See [PIBD 2024, 1227, IV-3](#).

² See [PIBD 2024, 1225, IV-4](#).

³ Article 2 of the Convention on Biological Diversity (CBD) and Article 2 of WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge (document GRATK/DC/7).

⁴ Article [L412-4 5°](#) of the French Environmental Code.

⁵For further reading:

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1047_19.pdf

properties. Another example is the Marjala, a plant well known by the Indigenous People of the Jarlmadangah Burru community (North-West Australia) for its healing and analgesic properties.

Meanwhile, traditional knowledge in the broad sense includes the knowledge itself as well as [traditional cultural expressions](#), namely any distinctive signs and symbols associated with traditional knowledge, from traditional medicine and ecological knowledge to art, symbols, music and more.

[The Convention on Biological Diversity](#) (CBD) is a legally binding international treaty that was signed in 1992, tackling the conservation and sustainable use of biological diversity, as well as the fair and equitable sharing of benefits arising from the utilization of genetic resources. This convention resulted in the [Nagoya Protocol](#), which only addresses matters relating to the access to genetic resources and sharing of benefits arising from their utilization. The Convention and the Protocol set out general rules for access to genetic resources and associated traditional knowledge.

2. Main provisions of the WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, approved during the Diplomatic Conference in Geneva:

Objectives (Article 1)

The objectives of the WIPO Treaty are, on one hand, to enhance the efficacy, transparency and quality of the patent system with regard to genetic resources and their associated traditional knowledge, on which patented inventions are *based* and, on the other, to prevent patents from being granted erroneously for inventions that are not novel or inventive with regard to genetic resources and their associated traditional knowledge.

¹ Article 2 of the Convention on Biological Diversity (CBD) and Article 2 of WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge (document GRATK/DC/7) define “*in situ* conditions” as “conditions where genetic resources exist within ecosystems and natural habitats and, in the case of domesticated or

Disclosure requirement (Article 3)

To meet the Treaty’s objectives, one of the central provisions is found in Article 3, which introduces a disclosure requirement for patent applicants as regards to the origin or source of the genetic resources and/or associated traditional knowledge upon filing a patent application, when the claimed invention is “*based on*” such genetic resources and/or associated traditional knowledge.

- **Disclosure trigger (Article 2 - List of Terms)**

This disclosure requirement, which is a transparency measure, will only apply to patent applications filed in states having ratified the Treaty when the claimed invention is “*based on*” genetic resources and/or associated traditional knowledge.

“*Based on*” means that the genetic resources and/or traditional knowledge associated with genetic resources must have been necessary for the claimed invention, and that the claimed invention must depend on the specific properties of the genetic resources and/or associated traditional knowledge.

- **Content of disclosure (Articles 3.1 and 3.2)**

When an invention claimed in a patent application is “*based on*” genetic resources, the applicant must disclose the **country of origin of the resources** (understood as the country in which the applicant obtained the resources, possessing the genetic resources in “*in situ conditions*”¹). If the applicant does not know the country of origin, i.e. if the applicant gained access to the genetic resources *via* an *ex situ*² source, or if this does not apply (for example, genetic resources from places not under national jurisdiction, such as high seas), the applicant must disclose **the source of the genetic resource** (such as, for instance, a

cultivated species, in the surroundings where they have developed their distinctive properties”.

² Article 2 of the Convention on Biological Diversity (CBD) defines *ex situ* conservation as “the conservation of components of biological diversity outside their natural habitats”.

research centre, gene bank or botanical garden).

When an invention claimed in a patent application is “*based on*” traditional knowledge associated with genetic resources, the applicant must disclose **the Indigenous People or local community** who provided such knowledge associated with genetic resources. If the applicant does not know the Indigenous People or local community, or if this does not apply, i.e. if the applicant did not gain access to the traditional knowledge associated with genetic resources *via* an Indigenous People or a local community, the applicant must disclose the **source of the associated traditional knowledge** (such as, for instance, scientific literature, databases or patent applications and publications).

- **Case in which the applicant has no information (Article 3.3)**

If the applicant does not know any of the information required under Articles 3.1 and/or 3.2, the applicant must make a declaration to that effect, affirming that the content of the declaration is true and correct to the applicant’s best knowledge.

Role of Patent Offices (Articles 3.4 and 3.5)

Patent offices must provide guidance to applicants to enable them to meet the disclosure requirement. However, they will not be required to verify the authenticity of the disclosure.

Sanctions (Article 5)

Non-compliance with the disclosure requirement may be subject to appropriate, effective and proportionate measures. However, sanctions affecting the rights conferred by the patent (notably revocation, invalidity) are excluded in the case of a failure to disclose the required information (Article 5.3). Where there has been fraudulent intent, this principle may be derogated from, and sanctions may be provided for at the discretion of each Contracting Party, in accordance with its national law (Article 5.4).

However, patent applicants are granted the opportunity to rectify any failure to include the information required during the pre-grant

phase (Article 3.4), and after grant of the patent, before any sanction or remedy is imposed on them (Article 5.2). The opportunity to rectify after the grant of the patent may be excluded by Contracting Parties who choose to, where there has been fraudulent conduct or intent, as prescribed by national law (Article 5.2 *bis*).

Information Systems (Article 6)

The Treaty includes provisions on **an information system (database)** that could be established to enable intellectual property offices to access information on genetic resources and associated traditional knowledge, notably for search and examination purposes.

Non-retroactivity of the Treaty (Article 4) and entry into force (Article 17)

The obligations of the Treaty will only apply in countries having ratified the Treaty and for patent applications filed as from the date on which the Treaty enters into force in the country in question.

The Treaty will enter into force three months after ratification of the Treaty by fifteen states.

Relationship with other international agreements (Article 7)

The Treaty must be implemented in a mutually supportive manner with other international agreements relevant to it, without derogating from or modifying the provisions of other international agreements.

The implementation of a disclosure requirement in patent applications should enable states having ratified the Nagoya Protocol to more easily check compliance with the obligations contained in the protocol as regards the access to genetic resources and associated traditional knowledge and sharing of benefits arising from their utilization.

Although s disclosure requirements already currently exist pursuant to a number of national laws, the entry into force of this Treaty will increase the number of states enforcing such disclosure requirements. ■

By Célia Benabou, INPI Legal and International Department

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*

Trademark

Aix-en-Provence Court of Appeal, 21 December 2023: The application for invalidity of the **TIZZANO** trademark is successful. The mark is [descriptive in relation to the designated wines of the "Vin de Corse Sartène"](#) Protected Designation of Origin (PDO). Tizzano is the name of a fishing village in Corsica, located in the geographical area covered by the PDO, which was susceptible to becoming known for its wine when the trademark application was filed. The Court of Appeal applied the Windsurfing Chiemsee¹ judgment handed down by the Court of Justice of the European Communities

Court of Cassation, 31 January 2024: The Court of Appeal dismissed the appeal lodged by the owner of the **BEATLES** trademark against the INPI's decision to reject the [opposition to the registration of the THE BEATLES trademark](#), which designates vehicles, architectural services, childcare services, etc. on the grounds that there was no damage to the reputation of the earlier mark. The Court of Cassation rejected its assessment of the link between the signs. It should have taken into account the **strength of the reputation of the BEATLES trademark for sound records**, its highly distinctive character and the high



Court of Appeal dismissed the appeal lodged by the owner of the **BEATLES** trademark against the

degree of similarity between the **BEATLES** and **THE BEATLES** signs.

Colmar Court of Appeal, 6 March 2024: The **CITY STADE** trademark, which designates a "structure [...] for playing various sports (tennis, basketball, football)", has been **revoked**. It has been shown that it has become the **common name** for a multi-sports playing area all over the country. However, prior to the appeal lodged by the appellant, the owner had sent only three formal notices to competitors to protect their trademark and had not brought any court proceedings. With their lack of action, they have contributed to the [degeneration of the mark](#). The use of the Anglo-Saxon "@" symbol does not compensate for this lack of action.



Paris Court of First Instance, 20 December 2023: In 1986, the Mars Group replaced its **TREETS** mark with the **M&M's mark** for marketing chocolate-covered peanuts. **TREETS marks** were then **filed thirty years later** by another company for the marketing of identical products, among others. The application for invalidity of these trademarks is rejected. In particular, the Court does not find the [trademark applications were made in bad faith](#), as the Mars companies cannot prove that unfair advantage was taken of the reputation of the earlier **TREETS** mark.

¹ EUCJ, Full Court, 4 May 1999, [C-108/97 and C-109/97 \(PIBD 1999, 683, III-381\)](#)

Furthermore, they were aware of the defendant company's intention to use the sign at issue for its products. In addition, the strategy they refer to (asking the owner of the earlier mark to surrender it, seeking to have a trademark revoked on the grounds of non-use) represents nothing more than usual steps taken in business when a competitor seeks to ensure, not in an unfair way, the availability of a sign it wishes to use as a trademark.

Court of Cassation, 28 February 2024: The company PMJC acquired the **JEAN-CHARLES DE CASTELBAJAC** and **JC de CASTELBAJAC** trademarks, comprising the name of a renowned French designer, in the insolvency proceedings of a company created and managed for many years by the designer himself. PMJC complained that the designer was pursuing his professional and artistic activities through the company Castelbajac Créative, and brought an action against them for infringement of its trademarks. The [counterclaim for revocation on the grounds of deception](#) is admissible. On this point, the Court of Cassation sets a limit to its case law. The Court ruled that the assignor is not liable for the **warranty against dispossession** when the application for revocation is based on fraudulent acts subsequent to the assignment and attributable to the assignee, i.e. the fact that the assignee company uses its trademarks in a way that leads the public to believe that the assignor is the author of the designs to which said trademarks are affixed. On the merits, the Court of Cassation **refers a question** to the Court of Justice of the European Union **for a preliminary ruling** on whether Articles 12(2)(b) of Directive 2008/95/EC and 20(b) of Directive (EU) 2015/2436 are to be interpreted as precluding the revocation of a trademark consisting of a designer's surname on the grounds that it is used after the assignment in such a way as to make the public actually believe that the designer is still involved in the design of the goods bearing the trademark, when that is no longer the case. With this

ruling, the *PIBD* (INPI's law review) examines applications for revocation of trademarks consisting of the surname of a designer, such as the **INES DE LA FRESSANGE, ELIZABETH EMANUEL or CHRISTIAN LACROIX** marks, which could become misleading as a result of changes in the conditions under which they are used. These are applications by well-known fashion designers and stylists filed against companies to which trademarks were assigned after the parties' collaboration had ended.

Paris Court of Appeal, 15 March 2024: The French semi-figurative mark **GEOGRAPHICAL NORWAY EXPEDITION**, appearing in a rectangle together with a Norwegian flag, is not susceptible to invalidity on the grounds of it having been [filed in bad faith](#). The respondent was accused of having taken essential elements from the NAPAPIJRI mark, which has a consolidated position in the quality outdoor clothing market. However, the mere **use of the Norwegian flag** combined with dissimilar expressions and logos is irrelevant, especially as the products concerned are different. Furthermore, the use of the GEOGRAPHICAL NORWAY EXPEDITION mark is not an infringement of the **semi-figurative European Union mark NAPAPIJRI GEOGRAPHIC**, which also includes a rectangle, nor is it **damaging for the latter's reputation**. On the other hand, the use of emblematic elements from the NAPAPIJRI mark is an act of unfair competition.



Paris Court of Appeal, 21 February 2024: The **use** of a photograph of earphones bearing the trademark DEUS **in an advertisement** is not an infringement, as it is a [necessary reference](#) to show that they are compatible with the helmet sold by the defendant company.

Paris Court of Appeal, 1 March 2024: The defendant company has forfeited its rights to the international trademark SO designating France and to the French trademark SO? on the grounds that [no genuine use in France has been demonstrated](#) since the date of registration of the trademarks. The **trademark infringement counterclaim filed** by the defendant company, owner of the European Union trademark SO...?, was also declared inadmissible on the grounds that it had **acquiesced in the use of the later French trademark SO' BIO ETIC** for five years. The opposition to the registration of the European Union trademark for the same sign, which was successful before the EUIPO, did not interrupt the period of limitation. Indeed, the defendant company did not unequivocally express its wish to oppose the use of the French trademark in France, which has a different scope.

Designs

Lyon Court of Appeal, 22 February 2024:



The **dismountable stool known by the name of "Tam Tam"**, for which design registrations were obtained in 1968 and 1983, is [protected by copyright](#). The originality of the work lies in the combination

of three elements: the diabolo shape and the use of plastic; the twin dismountable and interlocking parts that join together at a relatively slender point that makes it possible to support the weight of a body; the options offered by the dismountable and interlocking nature of these elements. There is no evidence of any prior art that uses this specific combination, which is random, fun to use and aesthetically pleasing. The fact that the designer came up with the stool in very little time is irrelevant.

Paris Court of Appeal, 12 January 2024:

Contrary to the court of first instance, the Paris Court of Appeal recognises the [originality of the gold and diamond ring and bracelet](#), which form



part of an iconic **Cartier** collection. Founded in 1847, this jewellery company has a long track record of selling luxury jewellery based on the theme of the panther, which has become its icon. It owns the copyright to the jewellery, which was designed by an employee under the supervision of the design studio and is therefore a **collective work**. Although the company is entitled to file an action for infringement, said infringement affects only the ring. For its part, the distributor company, which generated sales of 37 million euros from the iconic jewellery collection, is the victim of parasitic competition resulting from the marketing of the infringing ring.

Patents

Paris Court of First Instance, 28 March 2024:

The French part of a European patent for an invention relating to the **posology of Rivaroxaban**, a drug for treating thromboembolic disorders, is invalidated for [lack of inventive step](#). The uncertainty as to the lifespan of Rivaroxaban, and the reference in the patent to a half-life of 10 hours or less, is not enough on its own to demonstrate the inventive character claimed by the owner company.■

INPI Decisions

Partial invalidity of the trademark L'OIGNON DE TREBONS - Risk of misleading the consumer on the nature or composition of certain food products, taking into account the reputation of the onion from Trébons



The contested trademark, designating food products and agricultural, horticultural, forestry and seed products (classes 29, 30 and 31), is the subject of an application for invalidity based on three absolute grounds and two relative grounds for invalidity.

Only the ground based on the **misleading nature** of the trademark is upheld (Article [L.711-2-8](#)^o of French IP Code).

This ground is assessed on the day of trademark filing, with respect to the goods designated in the registration, being specified that *'a trademark is invalid where it is in itself liable to mislead the public as to one of the characteristics of the goods designated in its registration, without any need to take into account the conditions of its use, which concern only the subsequent revocation of the rights attached to it'*¹. Thus, the fact that the owner of the contested trademark sources Hourcadère onion (Trébons type) seed from the maintainer of the Hourcadère variety and

the fact that its producers are located in the historical region of production of the Trébons onions **are of no import for assessing the deceptive nature** of the trademark on the day of its filing.

The contested trademark contains in particular the verbal phrase *"L'oignon de Trébons"* [the Trébons onion]. The documents submitted demonstrate that, on the day of its filing, a certain **reputation of the type of onion originating from this town** existed. Consequently, the contested sign may, in the eyes of the relevant public, designate the nature or the composition of goods likely to consist of onion of this variety originating from Trébons or be composed of onion of that variety originating from Trébons. The trademark is thus **liable to mislead the public as to the composition** of *"jellies; jams; compotes; preserved meat; preserved fish; preserved pasta; preserved seafood; food croquettes; soups; pre-cooked soups; cooked meat dishes, cooked vegetable dishes, cooked fish dishes; prepared salads; prepared pasta dishes, prepared rice dishes; sauces (condiments); sandwiches; pizzas; pancakes (food)"* not specifying the mention *"composed of Trébons onions"*, and **liable to mislead the public as to the nature** of *"preserved vegetables; frozen vegetables; dried vegetables; cooked vegetables; agricultural and horticultural products; seeds; plant seeds; plants; fresh vegetables"* not specifying the mention *"Trébons onions"*.

Conversely, the applicant for the declaration of invalidity (hereafter referred to as "the applicant") does not establish that the consumer would expect any particular characteristic from the other above-mentioned products, unrelated to the Trébons onions. The application for invalidity is dismissed with regard to these products.

The application based on the ground of a trademark **consisting of or reproducing an**

¹ Court of Cassation, commercial chamber, 15 March 2017, Société Fermière du Château

Léoville Poyferré et al vs. Olivier P. et al ([PIBD 2017, 1070, III-284](#))

earlier plant variety denomination is also dismissed. According to Article L. 711-2 10° of IP Code, a trademark may be declared invalid if it consists of the denomination of an earlier registered plant variety, or reproduces it in its essential elements, if it relates to plant varieties of the same or closely related species. In the present case, the applicant invokes the denomination 'Hourcadère', registered for a variety of yellow onion. However, this denomination is not reproduced in whole or in part nor reproduced in its essential elements in the contested trademark.

The **bad faith** of the owner of the contested trademark is not established. That ground for invalidity may be admissible when it is apparent "*from relevant and consistent indicia that the proprietor of a trademark has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trademark, in particular the essential function of indicating origin.*"¹. In that regard, the Court of Justice of the European Union has clarified that the fact that **the applicant knows or must know that a third party is using an identical or similar sign for identical or similar goods and/or services**, leading to confusion with the sign whose registration is disputed, could constitute, inter alia, a relevant factor of bad faith².

In this instance, the applicant, who invokes in particular the **earlier use of the denomination 'L'oignon de Trébons'** appearing in its company name 'Comité de l'oignon de Trébons', establishes that the owner of the contested trademark **necessarily had knowledge** of it on the day of filing of the contested trademark.

However, this circumstance alone is not sufficient to demonstrate the existence of bad faith on the part of the trademark applicant. The applicant does not prove **the**

intention of the trademark owner to harm their interests in a manner inconsistent with honest practices.

On one hand, the mere fact that the owner was able to market or contemplate marketing Trébons onions originating from its producers cannot be sufficient to demonstrate his intention to harm the interests of the applicant, since the latter does not provide any other evidence likely to substantiate his assertions.

Furthermore, if the trademarks previously used by the applicant were not renewed in 2019 and have therefore expired, the mere fact that the owner of the contested trademark filed to register the trademark in February 2022 is not sufficient to demonstrate his dishonest intention, in the absence of any other objective evidence demonstrating the truth of those claims.

Finally, it is not apparent from the evidence produced by the applicant that the owner of the contested trademark registered it in order to establish a blocking position liable to harm the interests of third parties, since the owner does not claim protection solely on the terms 'L'oignon de Trébons doux & sucré' but on the association of those terms with a particular coloured design, on several lines, accompanied by graphic elements. Thus, it is not shown by the applicant that the filing of the contested trademark forms part of a strategy aimed at diverting the purpose of trademark law and at preventing competitors from using it. The ground for invalidity based on bad faith is therefore dismissed.

The application for invalidity of the contested trademark is also based on the existence of a **likelihood of confusion with the earlier company name** *Comité de l'oignon de Trébons*.

Firstly, this likelihood of confusion must be assessed in the light of the **activities actually carried out** under the company name, both on the day of filing of the contested trademark and on the day the INPI issues its ruling. It is apparent from the applicant's

¹EUCJ, 4th ch., 29 Jan 2020, Sky PLC, C -371/18 ([PIBD 2020, 1139-III-3](#))

² EUCJ, 1st ch., 11 June 2009, Chocoladefabriken Lindt & Sprüngli AG, C-529/07([PIBD, 2009, 900, III-1225](#))

observations and from the documents submitted in this instance that the company name 'Comité de l'oignon de Trébons' was used prior to the filing of the contested trademark for activities of 'promotion of the Trébons onion'.

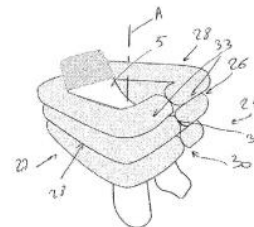
Secondly, the applicant **does not establish any link or provide any arguments** likely to substantiate the similarity of the contested goods and the invoked activities, a similarity that is not immediately obvious. Accordingly, it is not possible for the INPI to make any comparison, since INPI cannot substitute for the applicant in order to inter-correlate the goods and activities invoked, hence it follows that no likelihood of confusion between the signs invoked can be established for the contested goods.

Finally, the applicant alleges **damage to the name, image or reputation** of the town of Trébons. However, pursuant to Article L. [716-2, II 7°](#) of IP Code, the application for invalidity of trademarks on the grounds of Article L. [711-3-1 9°](#)) addressing damage to the name, image or reputation of **a local authority or a public establishment of intermunicipal cooperation**, may be introduced only by the holders of those earlier rights. In this instance, the application for invalidity is filed by the *Comité de l'oignon de Trébons*, which is a **trade association**, and not a local authority nor a public establishment of intermunicipal cooperation acting on the grounds of damage to its name, image or reputation. This ground for invalidity is therefore dismissed.■

INPI decision, 10 November 2023, NL 23-0020, Association Comite de l'oignon de Trebons vs. Cooperative du haricot Tarbais SCA

By Livie Cruzoe, Legal expert, INPI

Rejection of opposition to a patent for a child protection system on a bicycle baby seat: the invention, disclosed in a sufficiently clear manner, involves an inventive step



The opposition filed to the patent titled "Protective system, baby seat, bicycle and use implementing such a protection system" is not justified and the patent is upheld as granted.

The opponent requested total revocation of the contested patent, on two grounds: insufficiency of the disclosure and lack of an inventive step.

On the **insufficiency of the disclosure** of claim 10, the opponent argues that the definitions of the locked and unlocked states of the protection system lack clarity. In his opinion, the person skilled in the art would not know how to implement these two locking states on the basis of the teaching of the patent alone.

However, the requirement for a sufficiently clear and complete disclosure set out in article [L. 612-5](#) of the French Intellectual Property Code is satisfied so long as **at least one way of carrying out the invention** is indicated **that would enable the person skilled in the art to execute the invention**. In the case at hand, the description of the contested patent sets out, namely in paragraph [0059], a way of carrying out the invention that would enable the person skilled in the art, defined in this case as a specialist in protective systems for bicycle baby seats, to execute the invention: no particular inventive effort is required to understand the wording of claim 10, based on the information presented in the description, and to reproduce the features claimed in the contested patent. The requirement for a sufficiently clear and

complete disclosure of the invention is therefore met.

To assess the **inventive step**, one should select the **closest state of the art**. This is not necessarily unique so long as the documents cited are directed to a similar purpose or effect as the invention. Consequently, the closest state of the art to be considered in this case may be document P1 as well as document P4.

The subject-matter of the invention relates to a removable fastening system for protecting a child on a bicycle baby seat, comprising in particular a hood and a device for tensioning this hood.

Document P1, a European patent relating to a child protection system on a bicycle baby seat, discloses features 1.1 to 1.6.3 of the contested patent. The technical effect of features 1.7 to 1.7.3 of the contested patent is to enable the protective system to be attached to the baby seat in such a way as to enable it to be adapted to different baby seats.

The **objective technical problem** is therefore to find an **alternative** way of attaching the safety device **which allows it to be adapted to different baby seats**. The person skilled in the art who is trying to find such an alternative **has no motivation to combine the teachings of documents P1 and P2**. Indeed, document P2, a US patent disclosing a child car seat cover that enables users to control the temperature of child car seats, does not concern the same technical field, nor the same objective technical problem. The person skilled in the art would have no motivation to modify the fastening system in document P1 in order to solve the technical problem addressed by the patent. It would therefore appear difficult for the person skilled in the art, without exercising inventive skill, to transform the case of document P1 into a removable fastening system comprising a hood and a device for tensioning said hood, as they appear in the contested patent.

Similarly, the person skilled in the art has no motivation to combine document P1 with document P3, a Chinese utility model disclosing a car seat cover holding device. It is

not from the same technical field, and does not aim to solve the objective technical problem, because it does not include a part that can be likened to a "hood" sensu stricto. Indeed, if the person skilled in the art were to combine them, the result would not be a fastening system with a hood, but rather a cover that would be fastened at the ends.

Document P4 is a Japanese patent disclosing a system for protecting a child on a bicycle baby seat and a protection device comprising an inflatable protection structure. Claim 1 of the contested patent differs from this system of protection in features 1.3 to 1.3.2 and features 1.7 to 1.7.3, the technical effect of which is to enable the safety device to be attached to the baby seat in a way that is easily removable and adaptable to different baby seats.

The **objective technical problem** is therefore to enable the safety device to be attached to the baby seat in a way that is **easily removable and adaptable to different baby seats**. The person skilled in the art who is trying to solve this objective technical problem **has no motivation to combine the teachings of documents P4 and P2**. Thus, it appears difficult for the person skilled in the art, without exercising inventive skill, to transform the device of document P4 (with two airbags integrated into the seat) into a removable attachment system for the protection system comprising a hood and a device for tensioning said hood. Modifying the device from document P4 would require very significant structural changes.

None of the documents submitted in the course of the proceedings, taken in combination with the closest prior art documents, motivate the person skilled in the art to attain the subject-matter of claim 1 of the contested patent. The subject-matter of the latter therefore involves an inventive step.

By virtue of their reference to claim 1, claims 2 to 17 also demonstrate an inventive step. ■

INPI decision, 3 November 2023, [OPP 22-0030](#) Brandon IP v. Helite

By Norma Point, Legal expert, INPI

About INPI

Delve into the INPI's heritage archives

DATA INPI has launched a new online service. You can now gain quick and easy access to nearly 900,000 scanned copies of original patent and trademark documents. Delve in to discover more about the INPI's heritage archive collections in just a couple of clicks!



Plate filed on 1st March 1869 by Jules-Jacques Rabinel to support a patent application for "an undersea tube bridge (international railway) between France and England".

Easy access to the INPI's heritage archive collections

The INPI has launched a new service: [online access to its heritage archives](#). This service is available on the [DATA INPI](#) platform via the "historical archives" tab. Designed for members of the public, researchers, and professionals, it provides unprecedented quick and easy access to two heritage collections*¹ displaying 410,000 patents filed between 1791 and 1901 in one, and 460,000 trademarks filed between 1857 and 1920 in the other.

Aside from opening up extraordinary avenues for research (or a leisurely perusal of the

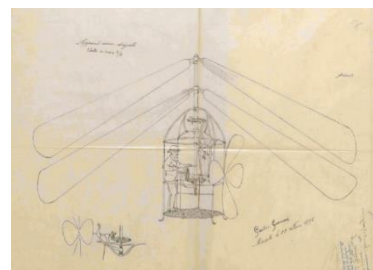
inventions of the 19th century), this new online space will also be the venue for regular virtual exhibitions to highlight the value of the INPI's heritage archives.

For students and researchers, it is also possible to view original documents by booking an appointment online and, for vintage image enthusiasts, to purchase copies of patent files and trademark forms.

The reuse of images acquired from the website (to document historical research or simply print on a mug or a tee-shirt!) is free of charge provided the INPI archives are mentioned as the source.

Find out more about the purpose behind the INPI's new heritage archive space

- First, it provides a vast audience with access to historical archives, which represent one of France's valuable heritage assets.
- Second, the digitisation and dissemination of such old and fragile documents serves as a means to preserve them.
- Lastly, it is consistent with the INPI's mission to make available and share information pertaining to industrial property.



Drawing filed on 26th February 1896 by Gaëtan Granieri to illustrate a patent application for "a steerable aircraft for industry, designed to replace" aerostats".

¹ The term "collection" refers to a collection of documents. The new online service dedicated to the INPI's heritage

archives therefore provides access to two separate collections, one for patents and the other for trademarks.

Unique archives in France

Founded in 1951, the INPI is the successor to different former institutions dating back to the end of the 18th century that protected innovations and their archives.

These archives resulted from the creativity of generations of inventors, engineers, creators, and artists. They form a unique treasure trove of historical documents comprised of each and every industrial property right granted or registered in France since legislation was first introduced.

A rare occurrence in France, the INPI preserves all its heritage archives pursuant to an agreement between the INPI and the French Ministry of Culture in 2008. Few public organisations can boast of such an honour!

Find out more about how the INPI preserves its archives

- The INPI keeps its archives in specifically allocated buildings that guarantee the right conditions for the preservation of old documents, particularly with regard to temperature and humidity.
- The INPI's heritage archives represent 20km of documents out of a total of 145km of archives.■

> [Click here](#) to access the INPI's heritage archive space.

Annual report 2023: a year full of events

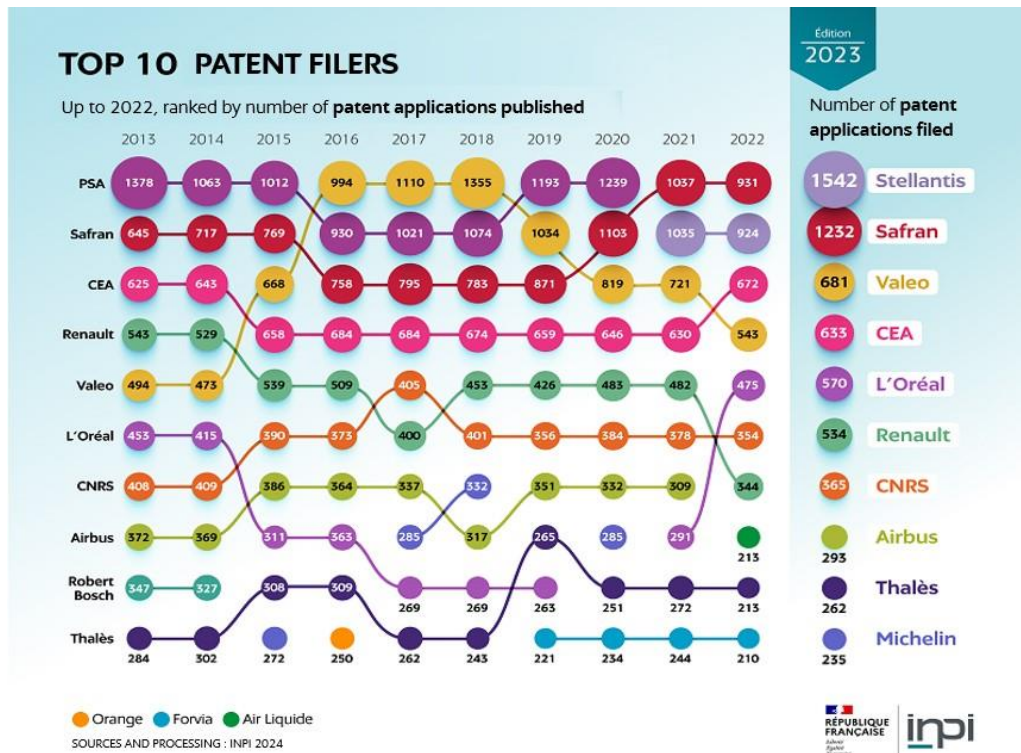


As it does every year, the INPI has published its annual report: discover the many events that marked 2023!

The guichet unique (one-stop shop) for business formalities, meetings at international level, new partnership agreements, the fight against counterfeiting, etc.: discover 2023 at the INPI, a year marked by intense activity linked in particular to the integration of new missions and to the ambition of the Performance Agreement (COP 2021-2024).

"More than ever, INPI teams are working alongside entrepreneurs and innovators both in France and abroad to provide them with increasingly high-quality services to help our country become more competitive." **Pascal Faure, CEO of the INPI.**■

Top patent filers in 2023



The INPI 2023 List of Top patent filers and holders¹ ranks the number of patent applications filed by legal persons with the INPI between 1 January 2023 and 31 December 2023, including utility certificate applications and provisional patent applications. This year, for the first time, INPI is publishing its rankings of patent applications filed in order to provide a more accurate representation of French economic activity.

"In 2023, patent applications increased by an historic 5.6%.² This is good news. The 2023 edition of the top patent filers in France shows that we have a high concentration of filers, demonstrating our national champions' incredible capacity for innovation", says Pascal Faure, CEO of the INPI.

The top organisations that invest the most in innovation: Stellantis, Safran and Valeo come out on top.

Businesses

- The top three are Stellantis (1,542 patent applications filed), Safran (1,232) and Valeo (681);
- Thirty-eight major companies feature in the ranking;
- more than one in ten applicants is a foreign industrialist;
- There are two mid-sized businesses in the Top 50: Soitec Group, which specialises in semiconductor materials (twenty-fifth place, 62 patents) and Gaztransport et Technigaz (GTT), a marine engineering company that designs liquefied gas storage and transport systems (twenty-sixth place, 61 patents).

Public research

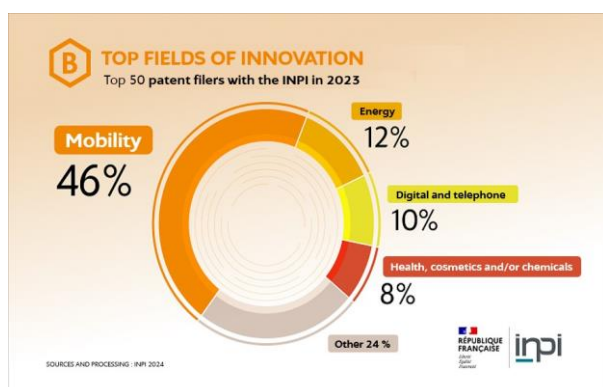
- Ten public research organisations are ranked in the Top 50. The Commissariat à l'énergie atomique et aux énergies alternatives (CEA) ranks fourth (633 patents) and the Centre national de la recherche scientifique (CNRS) ranks seventh (365 patents).

¹See [PIBD 2023.1201, IV-5](#) (ranking 2022).

² See [PIBD 2024. 1220, IV-2](#) (Industrial property key figures 2023)

Technology fields

- **Mobility tops the list of fields of innovation** with 24 businesses, manufacturers and/or equipment suppliers in the aeronautical and/or land or sea transport sectors, among the top 50 filers (46%).
- It is followed by energy (12%), digital and telecommunications (10%), and health, cosmetics and chemicals (8%).



Patent holders

- For the first time, the rankings show the twenty-five biggest patent holders in 2023, ranked by the number of patents in force in France. Twelve foreign companies are also included, demonstrating how attractive the French market is. ■

Patent Opposition proceedings before the INPI Statistical Review of the First Three Years

Since 1 April 2020, the patent opposition procedure allows a third party to challenge a French patent for which the mention of grant was published in the INPI's *Official Bulletin of Industrial Property* (BOPI) within 9 months of publication.

This procedure was introduced by the [Pacte Law](#) in order to provide an alternative to a lawsuit by allowing a third party to challenge, more quickly and at a lower cost, a patent that could hinder the operation of their business, without having to demonstrate legitimate interest. This procedure also strengthens the quality of French patents by allowing any third party to submit documents that were not identified during the grant procedure.

The **first opposition** was filed on 3 April 2020 following the publication of the first *BOPI* after the Pacte Law came into force. Since then, the number of oppositions continued to rise, reaching a total of 93 by the end of 2023.

Challenged patents

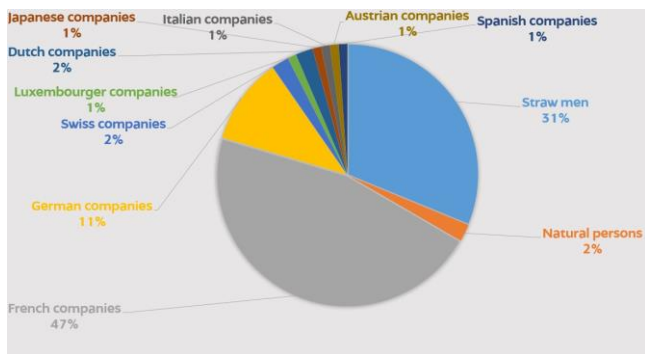
70% of challenged patents have been extended abroad. The challenged patents are mainly in the field of Mechanical Engineering (43%). Followed by Electric/Digital (39%) and Chemistry (18%).

International Patent Classification (IPC)	Number of oppositions	% of patents granted by IPC section	% of patents challenged by IPC section
Section A: HUMAN NECESSITIES	26	13.87%	31%
Section B: PERFORMING OPERATIONS; TRANSPORTING	15	26.78%	17.9%
Section C: CHEMISTRY; METALLURGY	9	6.91%	10.7%
Section D: TEXTILES; PAPER	1	0.64%	1.2%
Section E: FIXED CONSTRUCTIONS	12	5.5%	14.3%
Section F: MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING	6	16.92%	7.1%
Section G: PHYSICS	11	16.29%	13.1%
Section H: ELECTRICITY	4	13.08%	4.8%

Opponents

The majority of opponents are French companies (47%), closely followed by straw men (31%).

As far as the owners of the challenged patents are concerned, while the majority are French companies, 16% are foreign.

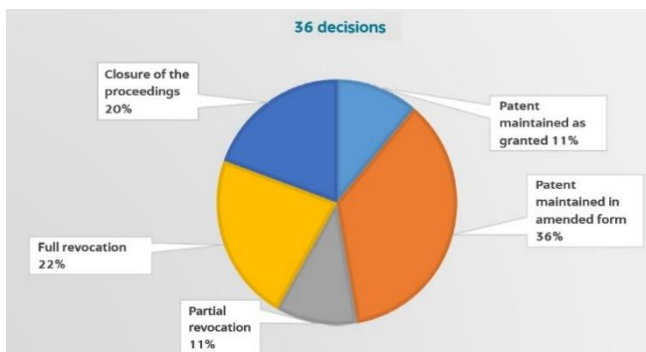


Grounds for opposition

The main grounds for opposition were lack of inventive step (99%), lack of novelty (87%) and insufficient disclosure (65%).

Hearings and decisions

Hearings are open to the public, and the schedule of hearings is available on the [INPI website](#): 35 hearings were held during the period under review, and 36 oppositions were ruled upon, including 7 decisions to close the proceedings. In the majority of cases, the patent was maintained in amended form.



Processing time

The **total time taken to process** oppositions from the end of the 9-month opposition period to the notification of the decision is 16.66 months, which is less than the 17 months announced by INPI for the complete processing of oppositions. This timeframe has been accelerated for the latest decisions notified.

Appeal

The opposition decisions of the CEO of the INPI can be appealed before the Paris Court of Appeal. The appeal process makes it possible to reverse the decision of the CEO and has suspensive effect. 8 appeals were filed during the period under review out of 29 decisions handed down. The first ruling was handed down on 29 May 2024 by the Paris Court of Appeal, upholding the INPI's decision.

By Vicky Rouss Douchy, Head of the Opposition Unit, Patents Department, INPI

International IP Law News

72nd meeting of the Association of Southeast Asian Nations (ASEAN) Working Group on Intellectual Property Cooperation (AWGIPC).

This year, the French Patent and Trademark Office (INPI) took part in the 72nd meeting of the Association of Southeast Asian Nations (ASEAN) Working Group on Intellectual Property Cooperation (AWGIPC), which was held in Da Nang, Vietnam, from 22 to 25 April, and brought together the heads of IP Offices of the ten ASEAN member states!

AWGIPC works notably to promote intellectual property and facilitate dialogue both within ASEAN and with the region's external partners.

The presence of the INPI in this context offered the opportunity to collaborate with the AWGIPC, particularly on a topic of regional interest such as geographical indications for industrial and craft products¹.

On the sidelines of this major event, Mr. Pascal Faure, CEO of the INPI, was able to take part in three bilateral meetings organised with certain key partners in Southeast Asia, each marked by the signing of a work plan outlining the operational framework for these respective bilateral cooperations.

Firstly, a meeting with IP Vietnam and its Director General, Mr. Luu Hoang Long, in the context of commemorating thirty years of cooperation with this country, led to the signing of the joint roadmap for 2023/2024. The main areas of interest in this roadmap are training, support for businesses, and geographical indications.

A meeting also took place with the Singaporean Office (IPOS), represented by Mrs. Rena Lee, its Chief Executive, with whom the exchanges were particularly smooth and constructive. Both Offices took advantage of their presence in Vietnam to sign the work plan for 2024/2025, which aims to better support businesses and the intellectual property ecosystem through various activities and to maintain the sharing of

experiences on various subjects, such as supporting businesses in intellectual property evaluation, an area where the experience of the IPOS is enriching.

Finally, a last meeting was held with the Intellectual Property Office of the Philippines (IPOP), and its Director General, Mr. Rowel S. Barba. It is worth noting that cooperation between the INPI and the IPOP was framed by a memorandum of understanding in May 2023, signed on the sidelines of the annual INTA meeting in Singapore. This new meeting in Vietnam was an opportunity to sign a first work plan, particularly aiming to strengthen exchanges between our two Offices in terms of protection, utilization, and enforcement of intellectual property. This plan organises cooperation activities with our counterpart until 2025 around themes such as sharing information and experiences in promoting an intellectual property culture, strengthening capacities in areas of interest such as geographical indications, and training professionals. ■

By Céline Boisseau, Coordinator of INPI International Network.

Initiating a partnership between the INPI and the ASEAN Working Group on Intellectual Property Cooperation (AWGIPC)

The 72nd meeting of the AWGIPC in late April 2024 in Da Nang, Vietnam, provided an opportunity for the INPI to propose initiating a partnership with ASEAN countries on the theme of Geographical Indications (GIs). GIs are indeed a subject of interest and importance for many countries in the region, although the practice varies widely from country to country: some have few registered GIs, while others have many, and there are differences in the age of sui generis systems (e.g., 21 years in Thailand and 2 years in the Philippines). To date, only two ASEAN countries have acceded to the Geneva Act of the Lisbon Agreement: Laos and Cambodia.

We need not reiterate here the numerous studies that have demonstrated the positive effects of Geographical Indications, whether on the economy, territorial development, employment, tourism, preservation of traditional

¹ See the following article by Fabrice Perrono.

knowledge, the environment, not to mention the consumer, as GIs guarantee the origin and quality of products. France has a long history of promoting GIs, with protection granted to approximately 700 GIs in the 20th century for wines, spirits, agricultural products, and foodstuffs. Furthermore, France was the first European country to establish a system for industrial and craft GIs in 2014. Through sharing experiences, the partnership between the INPI and the AWGIPC, to be implemented through concrete actions, could, depending on the interest of the countries in the region, involve various aspects: strengthening the skills of producer associations, defining specifications for craft products, improving the legal system and application processing, and enhancing third-party control mechanisms. ■

By Fabrice Perrono, INPI Regional Counsellor for Southeast Asia¹

Signature and entry into force of an agreement to accelerate patent grant procedures, known as Patent Prosecution Highway (PPH) agreement, with the Mexican Institute of Industrial Property (IMPI)



A new Patent Prosecution Highway (PPH) agreement for accelerating patent examination procedures came into effect for INPI on June 3, 2024.

This agreement, concluded with the Mexican Institute of Industrial Property (IMPI), represents the ninth PPH agreement signed by the INPI since the signing of its first PPH agreement with

the Japan Patent Office (JPO) on November 26, 2020, and more specifically the third with a North American country. The INPI is already bound by PPH agreements with the United States Patent and Trademark Office (USPTO) and the Canadian Intellectual Property Office (CIPO), concluded at the end of 2021.

Such agreements were also signed in 2022 with the Brazilian IP Office (INPI Brazil) and the Korean Intellectual Property Office (KIPO), followed by agreements in 2023 with the China National Intellectual Property Administration (CNIPA), the Moroccan Industrial and Commercial Property Office (OMPIC), and the Saudi Authority for Intellectual Property (SAIP), the latter entering into force on April 30, 2024.

As a result of the PPH with the IMPI coming into force on June 3, 2024, applicants can now request the acceleration of the grant procedure for a second patent application filed with the IMPI, whether it is a national application or a Mexican national phase of a PCT application, provided it contains claims sufficiently similar to those mentioned in the application examined by the INPI and deemed patentable. Reciprocally, this PPH agreement applies to applicants wishing to benefit from accelerated processing of patent applications in France, whether they claim priority from a Mexican national application or a PCT application.

It should be noted that French applicants rank seventh in terms of patent filings with the Mexican Office, indicating a strong interest in securing protection for their innovations in Mexico.

This agreement shall also provide applicants with a new route to obtain a Mexican patent through a French filing, significantly reducing the time needed to achieve quicker commercialization of their innovations in Mexico. ■

By Céline Boisseau, Coordinator of INPI International Network.

¹ fabrice.perrono@dgtresor.gouv.fr

The members of INPI's "international network" (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.

First anniversary of the Unitary Patent system

The European patent with unitary effect and the Unified Patent Court (UPC) entered into force on 1 June 2023. One year on from the system's launch, the **Unitary Patent system** has seen a successful start¹, completing Europe's single market for technology².

Over 28,000 requests for unitary effect have been filed and the EPO has registered more than 27,500 Unitary Patents. This means that almost one in four granted European patents have been converted into Unitary Patents. This rate is also steadily increasing. The uptake rate reaches almost 50% among applicants established in Denmark and Poland, and about 40% in Spain. Most patents are awarded for medical technology (31%), civil engineering (6%) and transport (5%).

As the new system celebrates its first anniversary, the European Patent Office has published a collection of over 250 preparatory documents relating to the Unitary Patent system. This online collection of *travaux préparatoires* to the UP Regulations and the UPC Agreement will enhance transparency and provide valuable insights into legislators' discussions over the years, helping to inform legal interpretation today.

Another event marks this first anniversary, as a new Member State will join the unitary system. Romania has deposited its instrument of ratification of the Agreement on a Unified Patent Court on 31 May 2024 and its participation will take effect on 1 September 2024.

Since the start of operations, more than 370 cases³ have been initiated before the **Unified Patent Court (UPC)**. This new court now enables centralised litigation not only for unitary patents, for which UPC has exclusive competence, but also for non-unitary European patents, under certain conditions.

Actions brought before the UPC are listed in the UPC registry, which can be accessed online⁴:

The EPO has also published new material celebrating the first anniversary of the Unitary Patent system, and providing further information to users⁵.

By Elodie Durbize, Head of the International Unit, Legal and International Department, INPI

¹ <https://www.epo.org/en/news-events/news/successful-start-unitary-patent>

² See *PIBD 2024*, 1229, IV-8 (article to be published on 1 July 2024).

³ Including 35 revocation actions and 132 infringement actions

⁴ <https://www.unified-patent-court.org/en/registry/cases>

⁵ See for example [Happy first birthday, Unitary Patent system!](#)

Agenda

9 July 2024

OEB – European Inventor Award 2024

[Details](#)

9-17 July 2024

WIPO - Assemblies of the Member States of WIPO: Sixty-Fifth Series of Meetings

[Details](#)

9 August 2024

WIPO – IP financing policies: What are they about? – *Virtual*

[Details](#)

13 September 2024

NDDCAMP – Domain market, seo, marketing, technologies & law – *Paris*

[Details](#)

11 September 2024

WIPO - Efficiently Handling Your International Design Registrations: Simplifying Transactions – *Virtual*

[Details](#)

26-27 September 2024

FICPI - FICPI's 22nd Open Forum - *Madrid*

[Details](#)

27 September 2024

APRAM - Conference

[Details](#)



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