

PACTE LAW: CHANGES RELATING TO UTILITY CERTIFICATES AND ESTABLISHMENT OF A PROVISIONAL PATENT APPLICATION

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Paris, February 10, 2020 - The PACTE Law of 2019 will result in substantial changes to several fundamental aspects of French patent law. This law extends the term of protection conferred by utility certificates and establishes a provisional patent application. When developing your industrial property strategy, these provisions should be considered as a package deal along with the examination of inventive step of patent applications and new opposition proceedings.



As already reported in a previous [article](#), law no. 2019-486 of May 22, 2019, i.e. the [PACTE Law](#), results in significant changes to several fundamental aspects of French patent law. The PACTE Law introduces opposition proceedings, modifies the statute of limitations period and adds lack of inventive step as a ground for rejection of patent applications (cf. [our article](#)). It also extends the term of protection conferred by utility certificates, allows them to be converted into patent applications, and establishes a provisional patent application.

1. Extension of the term of protection conferred by utility certificates (January 10, 2020)

[Article L.611-2 of the French Intellectual Property Code \(IPC\)](#) has been amended such that the term of protection conferred by utility certificates has been extended from 6 to 10 years.

This provision entered into force on January 10, 2020, not only for utility certificates filed on or after this date, but also for utility certificates still in force.

Applicants are therefore advised to review their FTO (Freedom to Operate) analyses with regard to this new term of protection.

In addition, the transitional provisions of [Decree No. 2020-15 of January 8, 2020](#) specify that the seventh annual fee for maintaining a utility certificate in force may be paid after the expiry date, but within four months from the date of publication of this decree with no surcharge (= May 10, 2020) and also in the following 6 months with a surcharge (= November 11, 2020).

Applicants are therefore advised to evaluate their utility certificates which are still in force to consider the possibility of extending them beyond 6 years, in particular those in their 6th year.

2. Conversion of a utility certificate into a patent application (January 11, 2020)

[Article L.612-15 IPC](#) has been amended to offer applicants the possibility of converting a utility certificate application into a patent application. This provision concerns utility certificate applications filed on or after January 11, 2020.

The request for conversion of a utility certificate application into a patent application must be provided in writing at any time within the period of eighteen months from the filing date or the priority date if priority has been claimed and, in any case, before the beginning of technical preparations, provided for in Article R. 612-39, for publication of the utility certificate application (Article R612-53 IPC).

When a patent application results from the conversion of a utility certificate application under the provisions of the second paragraph of Article L. 612-15, the search report fee must be paid within one month of the request for conversion (Article R612-54 IPC).

As a reminder, a patent application could already be converted into a utility certificate application.

3. Provisional patent application (July 1st, 2020)

From July 1st, 2020, a patent application may be filed in the form of a provisional application, thereby allowing the filing of the claims, the abstract, and the copy of the previous filing when priority is claimed, to be deferred.

While this provision allows for extremely urgent filings, we strongly recommend that this possibility be used only sparingly, both because the “compliance” of this provisional application, i.e. its eventual confirmation into a patent application, will require claims which must be supported by the description, and because the description must be substantiated sufficiently enough to be used as a valid priority claim.

An applicant may request, in writing, that a provisional application be brought into **compliance** or that it be converted into an application for a utility certificate within the period of twelve months from the filing date of the provisional application or the earliest date of which it benefits.

Otherwise, the provisional patent application will be **deemed to be withdrawn**.

When the patent application has been filed in the form of a provisional application, the search report fee must be paid within one month of the request for compliance.

This procedure includes, after a much simpler initial filing, complex mechanisms which will not be discussed here, given that this procedure introduces the aforementioned risks with little advantage when compared to the filing of a patent application without the payment of fees and without claims, which is possible!



The substantial extension of the term of protection conferred by utility certificates certainly increases the appeal of this title, which is almost never used by applicants. It now forms part of a strategic package along with French patent applications whose inventive step will be examined (cf. our article) and opposition proceedings.

Industrial property strategy is precisely our job!

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