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Utility Models in French Law

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In France, *certificats d'utilité* were introduced by the Law n°68-1 of January 2, 1968. According to article L. 611-2 of the French Intellectual Property Code, French *certificats d'utilité* are regulated by the same rules as French patents, with the main exceptions being a shorter duration, the absence of a requirement for a research report, and the lack of opposition proceedings.

5.1 HISTORICAL BACKGROUND

Certificats d'utilité (hereinafter utility certificates) were created in 1968 as a way for inventors to obtain protection for their invention, but with fewer requirements than full patents.[1] Notably, utility certificates can be granted by the French Intellectual Property Office, called INPI (*Institut National de la Propriété Industrielle*) without providing any research report on the elements of the state of the art that can be taken into consideration to assess the patentability of the invention. An influential author has suggested that utility certificates were introduced as "petit (small) patents" in order to increase the prestige of regular patents.[2]

However, it should be noted that in the past, regular patents, introduced just after the French Revolution by the law of 5 Vendémiaire An IX, did not require any examination of priority, merit or success of the inventions, and patents were therefore always designated as "SGDG" (*sans garantie du gouvernement – without guarantee of the government*). Their validity could only be assessed by the courts.

The French Patent Law of 1844 maintained the absence of prior examination, and it was only in 1968 that the examination of patents was introduced through a

[1] *Certificats d'utilité* should not be confused with provisory patent applications, which have been created by Law no. 2019-486 of 22 May 2019 and Decree no. 2020-15 of 8 January 2020, nowadays codified in Articles R. 612-3-1 and R. 612-3-2 of the French Intellectual Property Code.

[2] Mathely 1974, 196.

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research report. However, even then, for more than fifty years, the effectiveness of that provision has been very limited: indeed, the INPI could only refuse to grant a patent if the research report showed that the invention was manifestly lacking in novelty.[3] In other words, there was still no substantial examination by the INPI of the novelty or nonobviousness of the invention.

It follows that, until very recently, these former French full patents were, in practice, as regards their examination, not very different from utility certificates of the time, even though a research report was formally required for patents as part of their application.

The examination of novelty and inventive step for French Patents only became greater with the enactment of the *loi n° 2019-486 du 22 mai 2019 relative à la croissance et la transformation des entreprises*, also known as the *loi PACTE*, which allows the INPI the right to refuse to grant a patent for an invention that does not comply with the requirements of novelty or inventive step.[4] Thus, the research report is now of practical use during application proceedings before the INPI, since its content can lead to the refusal of the patent, and it is not a mere formal requirement anymore. However, and rather strangely, that legislative reform also applies to utility certificates and therefore allows the INPI the right to refuse to grant a utility certificate for lack of novelty or inventive step, although a research report is not required, and will in practice not be provided to the office at that stage, which practically prevents an effective examination of these requirements.

Therefore, since 2020, utility certificates have become somewhat different from patents in practice, since the absence of a requirement of a research report as part of the application proceedings can be of practical use for inventions that are nonnovel or that lack an inventive step. Indeed, the research report that is requested for patent applications can now be used by the INPI to refuse to grant a patent, whereas a utility certificate might still be granted, although the INPI is also supposed to examine the requirements of novelty or of the inventive step for utility certificates, because of the references which are needed in order to examine these requirements are not required for a utility certificate.

5.2 APPLICATION PROCEDURE

The application procedure for a utility certificate follows the rules of a patent application, except for the requirement of research report, and that no opposition proceedings are possible. Indeed, article L. 611-2 of the French Intellectual Property Code states that "the provisions of this chapter relating to patents shall apply to utility certificates with the exception of those laid down in Article L. 612-14, the first paragraph of Articles L. 612-15 and L. 612-17 and Articles L. 613-23 to L. 613-23-6".

[3] French Intellectual Property Code, former Article L. 612-12, 7°.

[4] French Intellectual Property Code, Article L. 612-12, 7°, which points to Article L. 611-10, 1° referring to the novelty, inventive step, and industrial application requirements.

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The application for a utility certificate is therefore regulated by Articles L. 612-1 et seq. of the French Intellectual Property Code. According to Article L. 612-2 of the French Intellectual Property Code, the filing date of the [utility certificate] application is the date on which the applicant has filed documents that contain: (a) an indication that a [utility certificate] is sought; (b) information identifying or communicating with the applicant; and (c) a description [. . .] or a reference to a previously filed application under conditions prescribed by regulation.

The invention must be set forth in the [utility certificate] application in a manner sufficiently clear and complete to enable a person skilled in the art to carry it out.[5] The claims define the subject matter of the protection sought. They must be clear and concise and based on the description.[6]

Additional details concerning the content of the application are provided by Article R. 612-3 of the French Intellectual Property Code, which states that the [utility certificate] application shall comprise a request for the grant of a [utility certificate], the model for which shall be laid down by decision of the Director General of the National Institute of Industrial Property, and to which shall be annexed: (1) a description of the invention, accompanied, where appropriate, by drawings; (2) one or more claims; (3) an abstract of the technical content of the invention; and (4) where appropriate, a copy of the earlier filings.

After filing, the conformity of the utility certificate application with the legislative and regulatory provisions referred to in Article L. 612-12 is formally examined by the Director of the Institut National de la Propriété Industrielle, according to Article L. 612-11 of the French Intellectual Property Code.

Notably, Article L. 612-12 of the French Intellectual Property Code states that any application for a [utility certificate] shall be rejected, in whole or in part: [. . .] (4) the subject matter of which is an invention that is not patentable under Articles L. 611-16 to L. 611-19; (5) whose subject matter cannot be considered as an invention within the meaning of Article L. 611-10, paragraph 2; (6) whose description or claims do not allow the application of the provisions of Article L. 612-14; (7) whose subject matter is not patentable within the meaning of Article L. 611-10, paragraph 1; (8) whose claims are not based on the description [. . .]. If the grounds for rejection affect the [utility certificate] application only in part, only the corresponding claims will be rejected. In the event of partial noncompliance of the application with the provisions of Articles L. 611-17, L. 611-18, L. 611-19 (4° of I) or L. 612-1, the corresponding parts of the description and drawings will be deleted ex officio. Therefore, although in theory, an application for a utility certificate where the invention is not novel or lacks an inventive step should be rejected, the INPI might, however, encounter serious difficulties for seriously examining these requirements without any research report, which the law does not require for utility certificates.

[5] Ibid., Article L. 612-5.
[6] Ibid., Article L. 612-6.

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The next step is the examination of the invention by National Defense. The Minister in charge of Defense is authorized to take cognizance of patent [and utility certificate] applications at the National Institute of Industrial Property, on a confidential basis. Inventions that are the subject of patent [and utility certificate] applications may not be disclosed and freely worked until authorization has been granted to that effect.[7] During this period, patent [and utility certificate] applications may not be made public, no true copy of the patent [or utility certificate] application may be issued without authorization, and no transformation of a patent into a utility certificate or vice versa may be initiated, and no publication of the invention may be initiated. These authorizations, which shall be granted by the Director of the National Institute of Industrial Property on the advice of the Minister responsible for defense, may be granted at any time, and the first authorization shall be acquired as of right at the end of a period of five months from the date of filing of the patent [or utility certificate] application.[8]

Afterwards, the application for a utility certificate is published, according to Article L. 612-21 of the French Intellectual Property Code.

Only then can the utility certificate be granted. The title (certificate) shall include the description, if applicable, the drawings, and the claims.[9]

Utility certificates are now issued for a period of ten years from the date of filing of the application.[10] Before the law of May 22, 2019, and its implementation decree n°2020-15 of January 8, 2020, the duration of a utility certificate was only six years from the date of filing of the application. Utility certificates that have been issued for less than six years before January 10, 2020, the date of publication of the implementation decree, have their duration extended to ten years.[11]

As of 2024, the filing fee for a utility certificate are 26€ for an online application. The delivery fee is 90€, and the annual tax varies from 38€ for the second year to 220 € for the tenth year.[12] In case the utility certificate is used in court proceedings for infringement, and only in that case, a research report will be required, which will add 520€ to the cost.

5.3 PRACTICAL USE OF UTILITY CERTIFICATES

In 2022, there were 673 applications for utility certificates made to the *Institut National de la Propriété Industrielle*, which corresponds to only 4.5 percent of all French patent applications. In addition, on that year, only 5 of these utility

[7] Ibid., Article L. 612-9.
[8] Ibid., Article L. 612-8.
[9] Ibid., Article L. 612-17.
[10] Ibid., Article L. 611-2.
[11] According to the INPI, in 2020, 70 percent of eligible utility certificates have been extended.
[12] In case the tax has not paid by the owner, the utility certificate will lapse: see, e.g., French Cour de Cassation, Commercial Chamber, 23 February 1993, n°91-15.376.

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certificates were transformed into regular patents, whereas there were 188 transformations of utility certificates into regular patents in 2021 and 137 in 2020, which were the first two years following the legislative reform allowing that possibility.

The number of applications seems to be slightly increasing, since, in 2005, only 390 applications for utility certificates were made, whereas in 2010 this number had increased to 484, and reached its peak to 1019 in 2020.

In practice, according to the INPI, in 2010, 44 percent of the applicants for utility certificates were French, whereas 30 percent of applicants were from China, Taiwan and Hong-Kong.

5.4 PUBLICATION OF UTILITY CERTIFICATES

Like patents, utility certificates are published in the *Bulletin officiel de la propriété industrielle* (BOPI).

Article L. 612-21 of the French Intellectual Property Code provides that the Institut National de la Propriété Industrielle shall ensure publication, under the conditions defined by decree in Council of State, by mention in the BOPI, by making the full text available to the public or by dissemination by means of a data bank or distribution via computer storage medium the file of any application for a patent or utility certificate at the end of a period of eighteen months from its filing date or from the priority date if priority has been claimed, or, at the request of the applicant, before the expiry of that period.

French utility certificates are also available in public databases, notably in the Espacenet database of the European Patent Office.

5.5 EFFECTIVENESS OF UTILITY CERTIFICATES

Although utility certificates are granted by the INPI without any research report, and therefore without any serious possibility for the office of examining of the requirements of novelty and inventive step, it should be noted that these "paper tigers" can only produce actual legal effects if they are valid, which notably means that they concern an invention which is new, which involves an inventive step and which is susceptible of industrial application.

For this reason, infringement proceedings before courts require the owner of the utility certificate to provide the research report that is mandatory for the granting of a Patent.

Article L. 615-6 of the French Intellectual Property Code provides that in infringement proceedings brought pursuant to an application for a utility certificate, the applicant shall file a research report drawn up under the same conditions as the report provided for in Article L. 612-14 (i.e., for a patent application).

That research report and the challenging of the validity of the utility certificate by the presumed infringer will allow the court to check whether that utility certificate is valid, and therefore whether or not to allow it to be asserted.

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Although license agreements of utility certificates[13] technically do not require a research report, the validity of such license agreements can be challenged in court proceedings, on the basis of the nonvalidity of the utility certificate, for example, for lack of novelty or inventive step. Indeed, a judgment of the Paris Court of First Instance stated that a license agreement and an assignment of a utility certificate were void for lack of purpose ("*absence d'objet*": former article 1126 of the French Civil Code) since the owners of this utility certificate had not proven the novelty and the inventive step of the invention protected by the licensed utility certificate.[14]

Unlike the French patents, opposition proceedings are expressly excluded for French utility certificates by Article L. 611-12 *in fine* of the French Intellectual Property Code.

Therefore, the validity of a utility certificate can only be challenged in court proceedings. According to Article L. 611-12 *in fine* of the French Intellectual Property Code, Article L. 613-25 relative to challenging the validity of a French patent in court is also applicable to French utility certificates. This means that the [utility certificate] shall be declared invalid by a court decision: (a) if its subject matter is not patentable under Articles L. 611-10,[15] L. 611-11[16] and L. 611-13 to L. 611-19;[17] or (b) if it does not set forth the invention in a manner sufficiently clear and complete for a person skilled in the art to carry it out; or (c) if its subject matter extends beyond the contents of the application as filed or, where the [utility certificate] has been granted on the basis of a divisional application, if its subject matter extends beyond the contents of the original application as filed; or (d) if, after limitation [. . .], the scope of protection conferred by the [utility certificate] has been increased.

5.6 ENFORCEMENT OF UTILITY CERTIFICATES AGAINST INFRINGERS

Utility certificates may be enforced against an infringer before the Paris Court of First Instance.[18] As already mentioned, this requires the owner to request a research report for that utility certificate. Indeed, Article L. 615-6 of the French Intellectual Property Code provides that in infringement proceedings brought pursuant to an application for a utility certificate,[19] the applicant shall file a search report drawn up under the same conditions as the report provided for patent applications.

[13] See, e.g., French Cour de Cassation, Commercial Chamber, 19 September 2006, n°04-17.932.
[14] Paris Court of First Instance of 13 June 2013, n°11/04424.
[15] Which deals with nonpatentable inventions.
[16] Novelty requirement.
[17] Mainly dealing with public policy.
[18] Article D. 631-2 of the French Intellectual Property Code, which refers to the Article D. 211-6 of the French Code of Judicial Organization.
[19] According to Article L. 613-1 of the French IP Code, exclusive rights [patents, utility certificates, SPCs] start from the application date. However, according to Article L. 615-4, infringements made prior the publication of the application or to the notification of the application to a third party cannot be actioned. Furthermore, the court cannot decide upon infringement until the patent [or utility certificate] has been granted (Paris Court of appeal, 25 April 2001).

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As regards the proof of infringement, the very efficient French proceeding called *Saisie-contrefaçon* can be used for establishing infringement of a utility certificate.[20] This specific form of action can be ordered by the president of one of the specialized courts in whose jurisdiction the action is brought.[21] The order need only include a simple request and recitation of the utility certificate to be enforced.[22]

The *saisie-contrefaçon* proceedings are detailed by Article L. 615-5 of the French Intellectual Property Code, which first states that infringement may be proven by any means. It then adds that, to this end, any person having standing to sue for infringement shall be entitled to have an infringing product, or document describing it, seized for evidentiary purposes. This seizure may be conducted in any place and by any bailiffs, and if necessary assisted by experts appointed by the plaintiff. The court may order, for the same evidentiary purposes, a seizure of a detailed description or materials and instruments used to manufacture or distribute the allegedly infringing products or to carry out the allegedly infringing processes.

The remedies that are available against an infringer of a utility certificate are the same as for the infringement of a patent.[23]

Therefore, the rules concerning the determination of damages are provided by Article L. 615-7 of the French Intellectual Property Code, which provides, in accordance with the European Directive 2004/48 of April 29, 2004, on the enforcement of intellectual property rights, that in determining damages, the court shall take into account separately (1) the negative economic consequences of the infringement, including the loss of profit and loss suffered by the injured party; (2) the intangible harm caused to the injured party; and (3) the profits made by the infringer, including the savings in intellectual, material and promotional investments that the infringer has derived from the infringement. Finally, the court may, as an alternative and at the request of the injured party, award a lumpsum as damages, and that this sum, which is not exclusive of the compensation for the intangible harm caused to the injured party, shall be greater than the amount of the royalties or fees that would have been due if the infringer had requested authorization to use the right infringed.

In addition, products recognized as infringing and the materials and instruments that were used primarily for their creation or manufacture may be recalled from commercial channels, permanently removed from those channels, destroyed or

[20] For an example, see French Cour de Cassation, Commercial Chamber, March, 29, 2011, n° 09-16.330 and 09-68.144.

[21] These judicial courts referred to in Article D. 631-2 of the French Intellectual Property Code. In practice, these can only be on first instance, the Tribunal Judiciaire de Paris (Paris Court of First Instance), and, on appeal, Paris Court of Appeal.

[22] Article R. 615-2 of the French Intellectual Property Code.

[23] In addition, customs enforcement is also possible for French utility certificates: see Article 2, 1, k) of the EU Regulation n°608/2013 of the European Parliament and of the Council of June 12, 2013, concerning customs enforcement of intellectual property rights.

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confiscated for the benefit of the injured party.[24] The court may also order any appropriate measure to publicize the judgment, in particular its posting or publication in full or in excerpts in the newspapers or on the online public communication services that it designates, in accordance with the terms that it specifies. Naturally, these measures are ordered at the expense of the infringer.

In addition, injunctions can be issued by the courts.[25]

However, it should be noted that utility certificate enforcement proceedings seem to be very rare in practice. In any case, since such proceedings would in practice imply discussion of the validity of the utility certificate, and hence raise the same issues of fact and law as a full patent litigation, the cost of litigating a utility certificate would probably be as high as the cost of a full patent litigation.

5.7 CONVERSION BETWEEN UTILITY CERTIFICATES AND FULL PATENTS

Under the recent *loi PACTE* and the decree n°2020-15 of January 8, 2020, effective as of January 11, 2020, it is possible to convert a utility certificate application into a French patent application. Before this, a patent application could be converted to a utility certificate but not the reverse.

Accordingly, Article L. 612-15 of the French Intellectual Property Code now provides that an applicant may convert its application for a patent into an application for a utility certificate under conditions laid down by regulation, but also that an applicant may convert its application for a utility certificate into an application for a patent, within a time limit and according to a procedure specified by regulation.

Additional details are provided in the regulatory part of the French Intellectual Property Code. According to Article R. 612-53, and subject to the provisions of Article R. 612-31, the request for conversion of the utility certificate application into a patent application must be made in writing at any time during the period eighteen months from the filing of the utility certificate application or from the priority date if priority has been claimed and, in any event, before the start of the technical preparations, provided for in Article R. 612-39, undertaken with a view to publication of the utility certificate application. Where the patent application is the result of the conversion of a utility certificate application in accordance with the provisions of the second paragraph of Article L. 612-15, the search report fee shall be paid within one month of the date of receipt of the request for conversion.[26] Likewise, a request for conversion of a patent application referred to in Article R. 612-3 into an application for a utility certificate maybe made in writing at any time during the period of eighteen months from the filing date or from the priority date if priority has been

[24] Article L. 615-7-1 of the French Intellectual Property Code.
[25] See Gisclard and Py 2022.
[26] Article R. 612-54 of the French Intellectual Property Code.

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claimed and, in any event, before the start of the technical preparations provided for in Article R. 612-39, undertaken with a view to publication of the patent application.[27]

As a result, conversions between patents applications and utility certificates applications are now possible in both directions. This means that an invention which is novel and involves an inventive step can be protected at first with a utility certificate application, which can shortly after be converted to a full patent application, since it deserves it. Conversely, an invention which is either not very promising from an economical point of view, or which might not comply with the requirements of a patent (e.g., because it is obvious) can be "downgraded" and still be the subject of a utility certificate application, even though there is now a (rather theoretical, at least if the research report has not been made yet) risk of rejection of that utility certificate application because of the lack of novelty or inventive step, and, even if granted, that utility certificate will only be effective in a court proceeding if the invention is novel, nonobvious, and the research report has been made at that later stage.

Utility certificates are therefore not necessarily third-rate patents: indeed, they can also be a step towards a full patent.

5.8 PRACTICAL USE OF UTILITY CERTIFICATES

Utility certificates are designed and mostly used for inventions that have a shorter lifespan, in order to lower the costs and delays compared to regular patents.

However, the protection is shorter (ten years instead of twenty years), and the research report is still required a posteriori if the utility certificate is asserted in infringement proceedings, which means the cost of the research report is not avoided, but only delayed until the litigation stage (for those few utility certificates that are eventually litigated).

The new procedure to convert a utility certificate application into a patent application may allow utility certificates to constitute an intermediate step before an applicant incurs the expense of obtaining a regular patent.

A key use of utility certificates is to prevent, on the grounds of lack of novelty,[28] a third party from applying for a patent in France concerning the same invention. Utility certificates can also be used to obtain international priority for applications made by the owner of the utility certificate.[29]

[27] Article R. 612-55 of the French Intellectual Property Code.

[28] French Cour de Cassation, Commercial Chamber, 27 September 2017, n°15-23.246.

[29] For an example highlighted in a litigation, see Paris Court of First Instance May 7, 2015, n° 13/16172. Conversely, the owner of a foreign utility certificate can use it as a priority for the application of a French utility certificate: see, for a German utility model used as a priority, French Cour de Cassation, Commercial Chamber, March 29, 2011, n°09-16.330 and n°09-68144.

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In a more questionable way,[30] utility certificates can be used to obtain protection for inventions that would not meet the requirements for a regular patent, taking profit from the lack of research report at the application stage, which does not allow for an effective control of novelty and inventive step, and of the lack of opposition proceedings. For this reason, in such cases, a utility certificate might still be granted by the INPI, although that invention doesn't comply with the legal requirements (novelty, inventive step, etc.) for a utility certificate. However, such a utility certificate will be held invalid in court because the defendant will, at that stage, be able to prove that it did not satisfy the legal requirements. This strategy might be used by the inventor either ab initio, or through a conversion from a patent application, but before the research report for a patent application has been issued, since an already issued unfavorable research report can now be used by the INPI to reject the application for a utility certificate if the invention lacks novelty or inventive step. In such cases, utility certificates may be used (abusively) as leverage in negotiation against small entities or weak competitors.

[30] Compare with a decision which considered as an act of unfair competition the use of the words "patented" for an invention which was only protected by a utility certificate, French Cour de Cassation, Commercial Chamber, October 24, 2000, n°98-12.563, since it wrongly implied that the duration of the protection was longer.

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