

Symposium on IP trial

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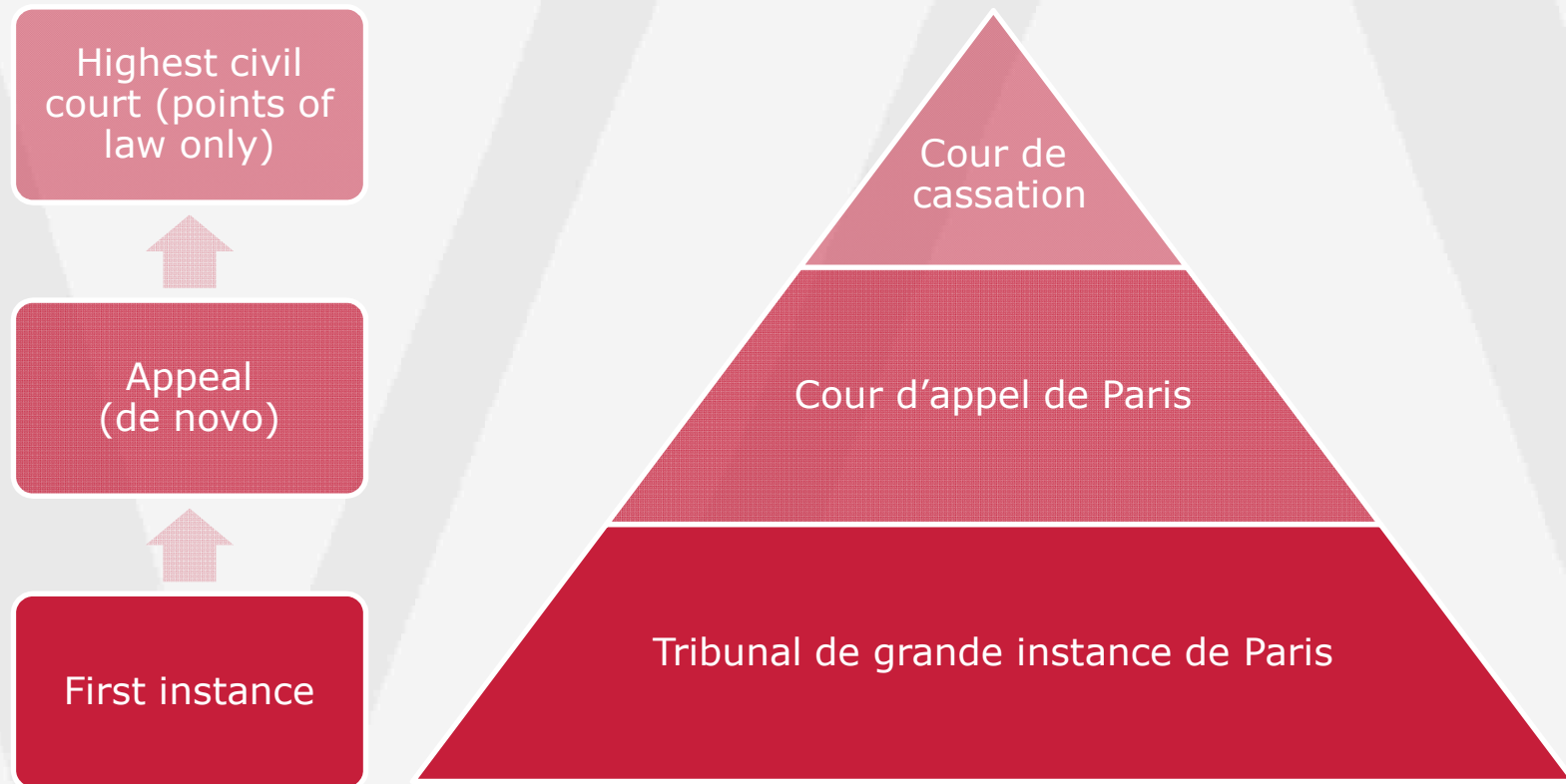
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1. Overview of the French legal system

- France is a country where proceedings are consolidated, i.e. both validity and infringement are heard by the same court
- Patent litigation is within the exclusive jurisdiction of the *tribunal de grande instance* of Paris (first instance court)

Courts having jurisdiction in patent litigation (both infringement and validity)



Typical timeline of French proceedings



Post-grant amendment of the claims

- Limitation of the claims (i.e. post-grant amendments) can be done:
 - Centrally through the EPO (at least 6 months)
 - Nationally before the French patent office (around 3 months if the limitation raises no formal issue)
- If national limitation, no stay of proceedings ordered by French courts but a mere delay in the proceedings

Judgement

- Scope and validity of the asserted claims addressed first (even if the action is originally a patent infringement action)
- Infringement is only considered if at least one claim is held valid

2. Validity of the patent at issue (defendant)

- Specification of the Main cited invention (Gazette 085):

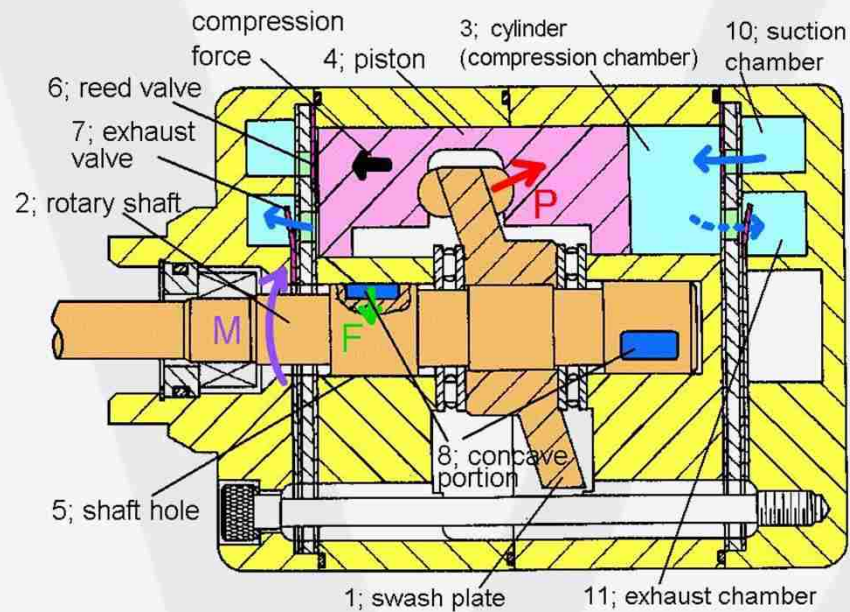
[0049] For example, as disclosed in Patent Gazette 63165 (Gazette 165), in a compressor in which rotary valves are provided on the parts corresponding to the rotary shaft, this invention can be applied to these rotary valves.

[0058] It is preferable that the width of the clearance is adjusted, for example, being less than 20µm, between the inner peripheral surface of the shaft hole(5) and the outer peripheral surfaces of the rotary shaft(2)

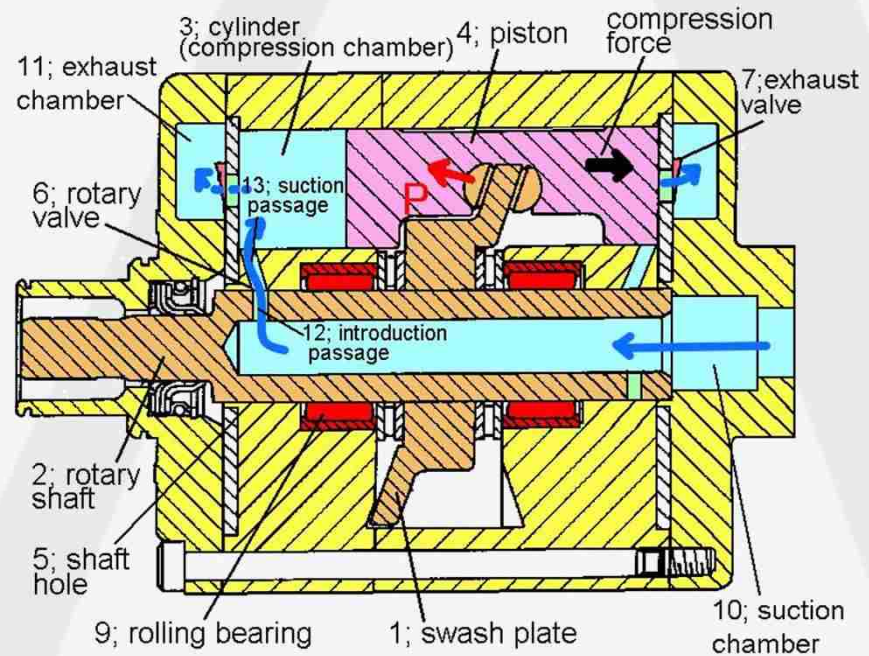
- The mere adaptation of the teachings of the Main Cited invention to rotary valves compressors is therefore not inventive;
- Limited claim 1 still lacks inventive step: the one skilled in the art knows well how to implement rotary valves having a cylindrical shape (apart for the outlets of the introduction passages) from the Sub-Cited Invention (Gazette 165)

Validity of the patent at issue (defendant)

Gazette 085 : reed valve compressor

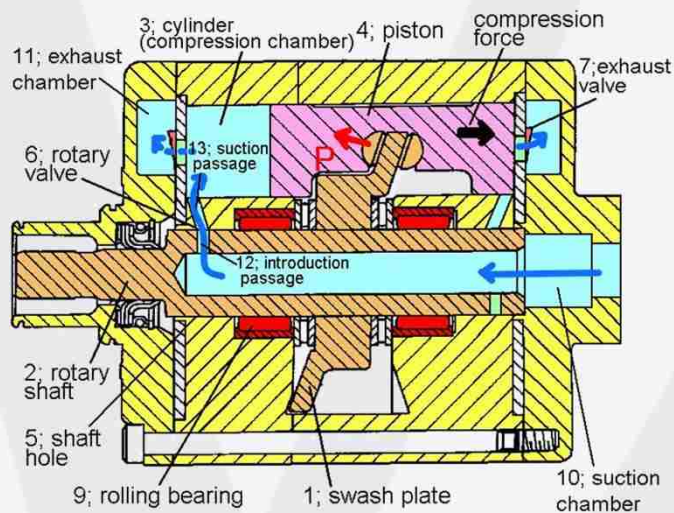


Gazette 165 : rotary valve compressor



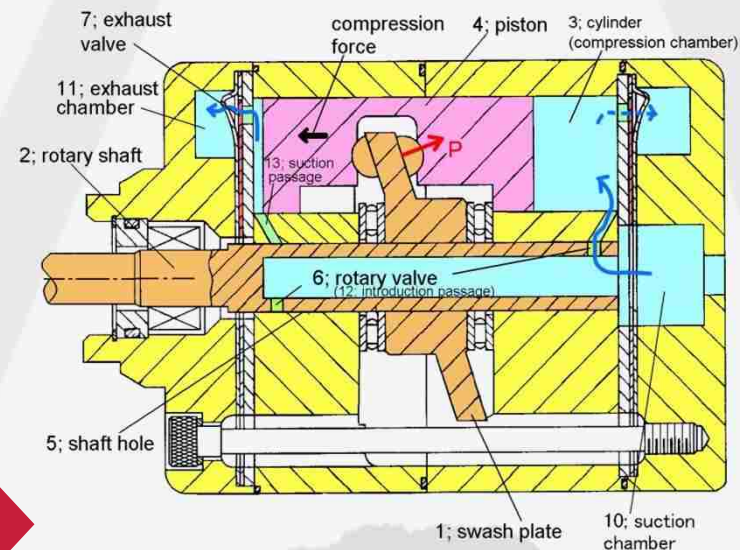
Validity of the patent at issue (plaintiff)

- Reed valves compressor \neq rotary valves compressor
- Inventive step to avoid using rolling bearings in rotary valves compressor



Gazette 165

Inventive step



Patent at issue

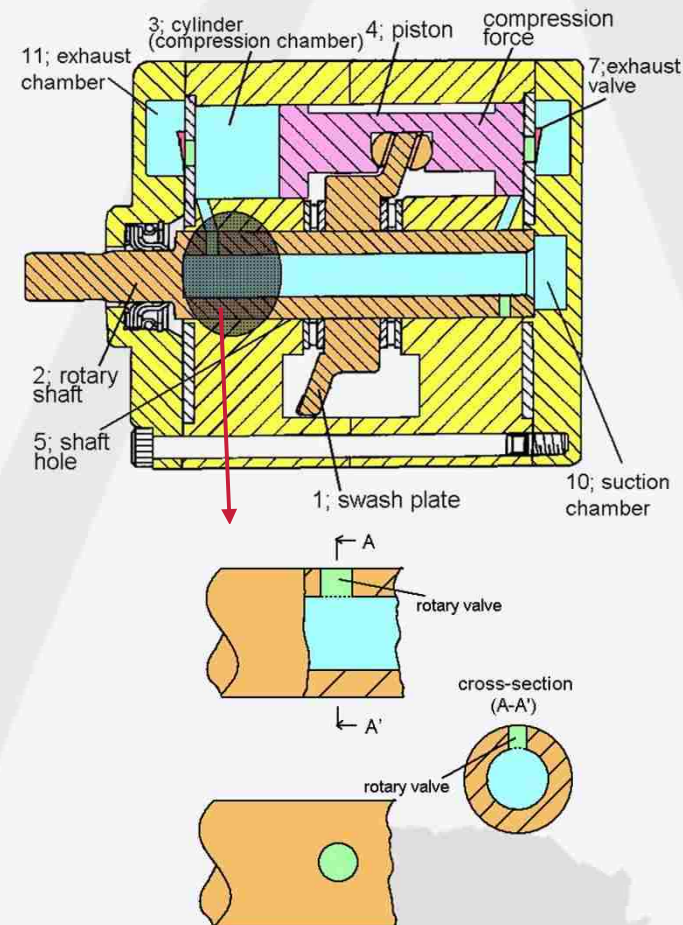
Validity of the patent at issue (plaintiff)

- Limited claim 1 helps departing from the Main cited invention
 - how to adapt the concave portions of the Main cited invention to the rotary valves which have to be cylindrically shaped?

3. Infringement (plaintiff)

■ Product X:

- Implements all the features of claim 1 as limited
- Not disputed by defendant

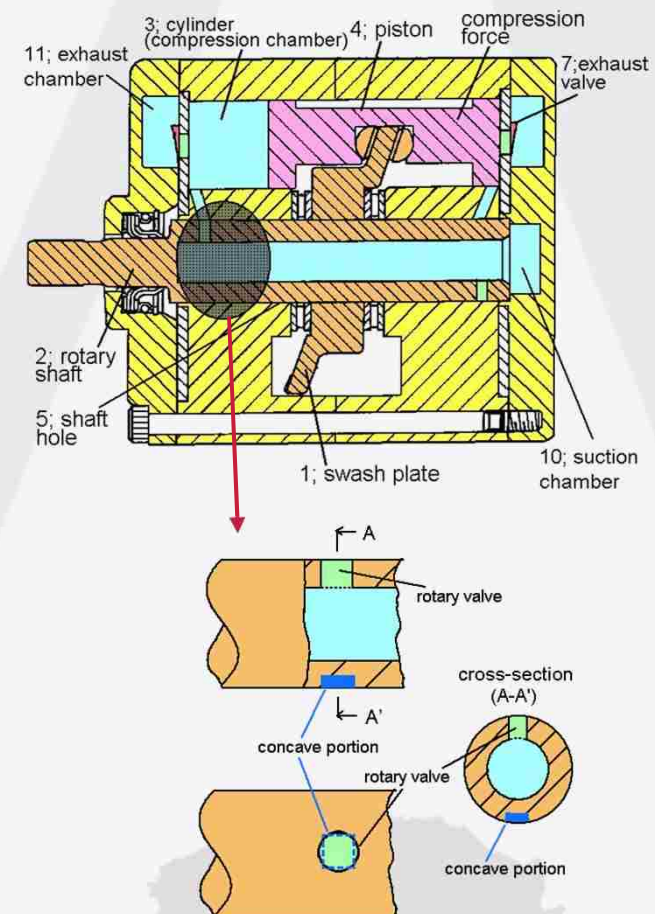


Infringement (plaintiff)

■ Product Y:

Examination procedure (addition of feature F): *"the inner peripheral surface of said shaft hole (5) directly supports the outer peripheral surfaces of said rotary valves (6) and the clearance between them is set at less than $20\mu\text{m}$ "*

- no requirement for the clearance being set at less than $20\mu\text{m}$ on the entire surface
- the presence of the concave portions in Product Y does not alter the fact that the clearance is set at less than $20\mu\text{m}$ for the almost entire surface and has the same technical effect (i.e. avoiding the tilt of the rotary shaft)



Infringement (defendant)

- Impact of the statements and amendments made by the patentee during examination:

"Reason for refusal indicated by the examiner should have been resolved because of the amendment in which the element "the clearance between them is set as less than 20µm" was added. The tilt of a rotary shaft(2) could be prevented if all clearance was being set as less than 20µm, between the inner peripheral surface of the shaft hole(5) and the outer peripheral surfaces of the rotary valves(6).

- "all" the clearance should be implemented
 - Product Y having concave portions, which increase the clearance above 20µm on some parts of the outer surface of the rotary valves, does not implement this feature
- the limitation of the claim according which the outer peripheral surfaces of the rotary valves are cylindrically shaped except for the outlets of the introduction passages is not reproduced in Product Y, where concave portions are present: the rotary valves are therefore not cylindrically shaped.

4. Judgement

■ **Validity:**

Claim 1 as limited is valid because the one skilled in the art would not have considered the Main cited Invention (Gazette 085) as the closest prior art and, starting from Gazette 165, it was not obvious to adapt the technical solution suggested in Gazette 085 to a rotary valves compressor.

Judgement

■ Infringement:

Product X infringes claim 1 as limited

Product Y does not infringe claim 1 as limited because:

- feature F of claim 1 shall be construed with regard to the patentee's statement during examination. According to such statement, the clearance of less than 20µm should be for all the surface between rotary shaft and rotary valves, which is not the case in Product Y due to the concave portions;
- the limitation of the claim according which the outer peripheral surfaces of the rotary valves are cylindrically shaped except for the outlets of the introduction passages is neither reproduced by Product Y due to its concave portions.

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Thank you

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