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PATENTS: PARIS COURT OF APPEAL'S ASSESSMENT OF THE PRACTICE OF INTERMEDIATE GENERALISATION



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Paris Court of Appeal, Division 5 Chamber 2, 13 June 2025, No. 23/02588

IMPACT: In this ruling, the Paris Court of Appeal addresses the practice of intermediate generalisation, which consists of extracting a specific feature by isolating it from an originally disclosed combination of features, subject to strict constraints.

The Court also penalises, on grounds of disparagement, the patent holder's publication of an announcement on its website mentioning the filing of an infringement action, even though it was not based on sufficient factual grounds.

➤ **The facts**

The US company Intellectual Ventures LLC (IV), which specialises in the creation, development, acquisition and exploitation of inventions, is the holder of a European patent entitled "Organisation of data encryption in a wireless communications system," designating France.

Considering that SFR's "Auto Connect WiFi" service—which allows subscribers to automatically switch from the mobile network to the SFR WiFi Mobile network using EAP-SIM technology—implemented several

claims of the patent, IV obtained, in October 2016, an order for an infringement seizure.

Following the execution of the seizure at SFR's premises, IV brought infringement proceedings against SFR before the Paris Judicial Court in November 2016.

On 3 February 2017, a bailiff's report recorded that IV had announced the filing of the infringement action in the "news" section of its website. SFR then filed a counterclaim for disparagement.

By a judgment dated 25 October 2022, the Court annulled the claims at issue on the grounds of added subject-matter, dismissed the infringement action and found IV liable for disparagement. The Court of Appeal upheld the judgment in its entirety.

➤ **Invalidity of the patent for "intermediate generalisation"**

The Court first recalled that, pursuant to Article L. 614-12 of the Intellectual Property Code, a European patent designating France may be revoked on one of the grounds set out in Article 138(1) EPC, in particular where the subject-matter of the granted patent extends beyond the content of the application as filed.

To determine whether the subject-matter of the claims extends beyond the content of the original application, the Court referred to the practice known as *“intermediate generalisation”*, which it defined as *“the extraction of a characteristic in isolation from its specific context”*, that is, detached from a specific embodiment and not closely linked to the other features of that embodiment.

Such a generalisation is justified only *“in the absence of any clearly recognisable functional or structural relationship between the features of the specific combination”* or *“if the extracted feature is not inextricably linked”* to those features.

More specifically, intermediate generalisation is admissible only *“if the skilled person can recognise without any doubt, from the application as filed, that the features taken from a detailed embodiment are not closely linked to the other features of that embodiment and that they apply directly and unambiguously to the more general context.”*

In this case, IV had isolated the feature according to which encryption was performed at the MAC layer of a wireless local area network, while deleting the original reference to the WEP protocol, even though, for the skilled person, these features are closely and functionally linked. The Court therefore found that dissociating them resulted in a claim extending beyond the content of the original application, and confirmed the invalidity of claims 1, 11 and 14 of the French part of the patent.

➤ ***Public disclosure of the infringement action constituting disparagement***

On the basis of Article 1240 of the Civil Code, the Court reiterated that disparagement may be found *“even in the absence of direct and effective competition,”* where *“information likely to cast discredit on a marketed product”* or on an operator is disseminated without sufficient factual basis.

In this case, IV had published on its own website, on the very day the writ of summons was served, a notice announcing the filing of an infringement action against SFR before the Paris District Court, using the following wording (here translated into French): *“Today, Intellectual Ventures has brought an infringement action against SFR before the court.”*¹

The Court emphasised that this publication:

- was accessible to the French public, including SFR’s customers;
- disclosed the existence of an infringement action;
- lacked a sufficient factual basis, as it was based solely on the writ of summons;
- did not relate to a matter of general interest.

Accordingly, the Court held that the publication in question constituted an act of disparagement harming SFR’s image and upheld the order requiring IV to pay €50,000 in damages, as awarded at first instance, without giving any further detail on how the damages were assessed.

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¹ In its original English version: *“Today Intellectual Ventures filed a patent infringement complaint against Société*

Française du Radiotéléphone – SFR before the District Court.
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