France

Contributing firm
Promark



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Legal framework

National

French trademarks are governed mainly by Law 1991-7, which implements the EU First Trademarks Directive (89/104/EEC) and is codified in the Intellectual Property Code. The code was amended several times, in particular by Law 2007-1544, which implements the EU IP Rights Enforcement Directive (2004/48/EC).

International

France has ratified the following international conventions and treaties:

- the Paris Convention for the Protection of Industrial Property (March 20 1883);
- the Madrid Agreement (April 14 1891);
- the Madrid Protocol (June 27 1989);
- the Nice Agreement (June 15 1957);
- the Vienna Agreement (June 12 1973);
- the Trademark Law Treaty (October 27 1994);
- the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights (April 15 1994); and
- the Singapore Treaty on Trademarks (March 27 2006).

Unregistered marks

French trademark law confers no exclusive right on the owner of an unregistered mark. However, a well-known mark within the meaning of Article 6*bis* of the Paris Convention may be protected under civil law, even if it has not been registered in France, if:

- an unauthorised use of the mark by a third party is likely to cause damage to the mark owner; or

“French courts assess the well-known character of the mark taking into consideration factors such as the seniority of the mark, the scope and the intensity of its use, and promotional and advertising investments”

- such use constitutes an unjustified exploitation of the mark.

In order to enjoy such protection, the well-known mark must be recognised by a substantial proportion of the public in relation to the goods/services concerned.

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Registered marks

Ownership

Any natural person or legal entity can apply for a French trademark before the French *Institut National de la Propriété Industrielle* (INPI). The application can be filed by the owner itself or its representative.

A representative is mandatory if the trademark has several applicants or if the applicant is not a resident in France, an EU member state or the European Economic Area. If the representative is neither a lawyer nor a patent attorney, it must at least be established in the European Union or the European Economic Area and must have a power of attorney (neither notarised nor legalised).

Scope of protection

A trademark can be registered if it is capable of distinguishing the goods/services of one undertaking from those of another.

A French trademark may consist of any sign capable of being represented graphically. The Intellectual Property Code gives examples of such signs, including:

- denominations in all forms – words, surnames and geographical names, letters and numerals;
- audible signs – sounds and musical phrases (represented on a stave); and
- figurative signs – devices, logos, shapes (particularly those of a product or its packaging) and shades of colour, provided that the description of those colours specifies an international identification code for each colour.

Excluded signs

A sign that has no distinctive character or that is descriptive or generic may not be protected as a trademark.

The distinctive nature of the sign shall be assessed at the time of the application in relation to the goods/services for which registration is sought.

The following signs, for instance, have no distinctive character:

- signs that constitute the necessary, generic and usual designation of the goods/services;
- signs that designate a feature of the goods/services (eg, quality, quantity, geographical origin); and
- signs that consist exclusively of the shape imposed by the nature or function of the product, or a shape that gives the product its substantial value.

Distinctive character may be acquired by use, except when the sign is of the kind described in the last bullet point above.

The following may not be adopted as a mark or an element of a mark:

- signs excluded by Article 6*ter* of the Paris Convention (eg, state emblems, official hallmarks, flags), as well as the Red Cross;

“A sign that has no distinctive character or that is descriptive or generic may not be protected as a trademark. The distinctive nature of the sign shall be assessed at the time of the application in relation to the goods/services for which registration is sought”

- geographical indications for wines/spirits that do not originate from that geographical area;
- signs that are contrary to public policy or morality, or whose use is prohibited by law; and
- signs that are liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods/services.

Prior rights

A sign may not be adopted as a trademark where it infringes prior rights, particularly:

- a registered earlier mark or a well-known prior mark within the meaning of Article 6*bis* of the Paris Convention;
- a company name or a trade name/signboard known throughout the national territory, where there is a risk of confusion in the minds of the public;
- a protected designation of origin;
- a copyright;
- rights deriving from a protected industrial design;
- personality rights of another person, particularly his or her surname or pseudonym; and
- the name, image or repute of a local authority.

In addition, since an application for a mark that is identical and/or similar to a prior registered mark is considered to be a trademark infringement in France, a prior rights search should be carried out before filing a trademark application.

Search for prior rights

Prior trademarks search usually concern either identical marks/company names or similar marks. In most cases, both are necessary in order to secure a trademark application.

A search for identical marks is possible using INPI’s online database. However, such search includes neither prior company names nor any analysis of the similarity between the goods/services of the earlier identical marks and the goods/services for which registration is sought. Consequently, it is recommended to call on French trademark professionals to conduct such a search and analysis.

The same is true of searches for prior similar marks, as the similarity between prior marks and the applied-for mark must be assessed with reference to French case law and practice.

Procedures

Filing

Applications for registration should be filed before INPI together with proof of payment of the filing fees. They should include:

- information on the applicant;
- a sample of the mark; and
- a list of the goods/services for which registration is sought, specifying the classes of the Nice Classification concerned.

Failure to provide the information above or proof of payment will result in the inadmissibility of the application.

If priority is claimed, the reference of such priority should be provided. In case of foreign priority, the applicant shall provide INPI with an official copy of the prior application (with a translation) and proof of the right to claim priority within three months of filing the application in France.

Only one mark may be applied for per filing.

If INPI considers an application admissible, it will be published in the *Trademark Gazette* within six weeks of the filing date.

Examination

INPI examines all applications to determine

whether:
- the application and the attached documents satisfy the conditions set by law; and
- the sign may be registered as a mark, based on the criteria listed above.

However, INPI does not conduct any search for prior rights during the examination process.

If an application is considered unfit for registration, INPI issues an objection, with a deadline for the applicant either to amend the application or to reply to INPI's objection (one month for formal shortcomings and two months for substantive shortcomings).

In the absence of a response by the deadline or if INPI rejects the applicant's changes, a final refusal of registration will be issued. Such refusal may concern all or a part of the application, depending on the scope of the irregularity or the objection raised by INPI.

Opposition

Within two months of publication of an application for a French trademark in the *Trademark Gazette* or, for an international registration, in the *World Intellectual Property Organisation Gazette*, an opposition may be filed, in person or through a representative, by:
- the owner of a prior registered mark or a prior application;
- the owner of a prior well-known mark; or
- the exclusive licensee of such marks, unless otherwise stated in the licensing agreement.

The two-month deadline is not extendable. A representative is mandatory in the same circumstances as for filing applications. The opponent must submit proof of ownership of the mark on which the opposition is based.

If the opposing mark was registered at least five years before the date of opposition, the applicant may request that the opponent provide evidence of use of its mark. The opponent shall then prove use for at least one (not necessarily all) of the goods/services covered by its prior mark or provide proper reasons for non-use.

INPI should decide on the opposition within six months of filing of the opposition. In the absence of a decision within such timeframe, the opposition shall be deemed rejected. However, in practice, INPI always makes a decision before the end of the six-month period. This period shall be suspended in the following cases:
- *ex officio* by INPI if the prior mark has not yet been registered;
- at the request of one of the parties if a claim is pending before the courts; or
- at the request of both parties, for three months, renewable once at the request of both parties.

INPI's opposition decisions are appealable before specialised courts of appeal, within one month of notification of the decision if the appellant is French, and within three months if the appellant is not from France. The territorial jurisdiction of these appellate courts is determined by the domicile of the appellant; the Paris Court of Appeal has exclusive jurisdiction where foreign appellants are concerned.

Withdrawal

The applicant may request, in writing, the complete or partial withdrawal of its application at any point in time until the technical preparation for registration begins.

Registration

Unless the application is rejected or withdrawn, the mark is registered in the National Trademarks Register for 10 years from the filing date. Registration of an unopposed application takes approximately four to five months from the application date, while registration of an opposed application takes about 10 to 11 months. INPI issues the registration documents about two to three weeks after the registration.

Renewal

Registered trademarks are renewable every 10 years, by declaration. At the renewal, the owner of the trademark shall not modify the sign or extend the list of goods/services. However, the renewal may apply only for part of the goods/services stated in the initial registration. Proof of use is not required for renewal.

A renewal declaration should be submitted to INPI in the six months preceding the expiry of the registration. An application for renewal may also be filed within an additional six-month period, upon payment of additional fees. Renewal shall take effect on the day following

“The ‘.fr’ naming rules provide expressly that it is the responsibility of the person registering or using the domain name to ensure that it does not breach third parties’ rights”

the expiry date of the registration. INPI issues the renewal documents about two to three months after renewal.

Removal from register

Cancellation: The validity of a registered mark may be challenged through a cancellation action or in infringement litigation before the courts:

- on absolute grounds (impossibility of graphic representation; absence of distinctive character and descriptiveness; unlawful signs); or
- on relative grounds – namely, earlier rights.

A cancellation action based on absolute grounds may be brought by any interested party or the public prosecutor, whereas relative grounds may be invoked only by the owner of an earlier right (or its licensee). Representation by an attorney at law is compulsory in these judicial actions. The first-instance courts usually issue a decision within nine to 18 months. Their decisions are appealable before courts of appeal.

Acquiescence: If the owner of a trademark has acquiesced to the use of a later identical or similar mark for five successive years while being aware of such use, and if the later mark was applied for in good faith, the owner of the earlier right shall no longer be entitled to act against the use of the later mark in respect of the goods/services for which the later mark has been used.

Revocation for non-use: If, within a successive period of five years starting from publication of registration, the mark has not been put to genuine use in connection with all or part of the goods/services for which it is registered, and there are no proper reasons for non-use, the rights of the mark owner shall be revoked. Such revocation can be invoked by any interested party or as a counterclaim in infringement proceedings.

In this respect, use of the mark in a modified form that does not alter its distinctive character is considered genuine use.

The owner of the mark for which revocation is requested bears the burden of proof of genuine use of its mark. Evidence of use shall be provided for all goods/services for which the trademark is registered. Failing that, the mark will be revoked for the goods/services for which genuine use was not proved.

If use of the mark started or resumed within three months of the request for revocation, after the owner of the mark became aware of a request for revocation against its mark, such use shall be disregarded.

Revocation shall take effect retroactively as of the date of expiry of the five-year period mentioned above.

Revocation for genericisation: If a mark has become the common name in trade for a product/service for which it is registered, the owner’s rights shall be revoked for such good/service.

Revocation of a misleading mark: The registration of a mark shall also be revoked if the mark has become misleading, particularly as regards the nature, quality or geographical origin of a product/service.

Surrender: A registered mark may be surrendered at any time in respect of all or part of the goods/services for which the mark is registered.

Enforcement

Anyone that uses a mark without the authorisation of its owner, by reproducing the mark or imitating it for identical or similar goods/services, shall be liable for trademark infringement.

In order to determine an infringing act, the court must assess:

- the identity or similarity of the conflicting signs on the basis of visual, phonetic and intellectual criteria; and
- the identity or similarity of the goods/services concerned.

Civil infringement proceedings can be brought before specialised courts by either the owner of a mark or the exclusive licensee, if the licence is recorded in the Trademark Register. A licensee whose licence agreement has not been recorded can intervene in infringement proceedings only to claim for remedy for damages that it suffered.

An infringement action must be brought within three years of the infringement.

Such infringement may be proved by any means. To secure evidence of the infringement and to obtain any information related to it, the rights holder may obtain from a competent court an order to carry out a seizure at the premises of the alleged infringer.

Such order authorises a bailiff to seize the suspected infringing products (effective seizure) or to visit the alleged infringer's premises to collect evidence of the infringement by taking pictures of the suspected infringing goods or taking samples (descriptive seizure).

The rights holder shall then summon the alleged infringer on the merits before a court within 20 working days or 31 calendar days of the seizure, whichever is the longer. Otherwise, the seizure shall be annulled at the request of the alleged infringer.

Prior to an infringement action, the rights holder can also request an injunction in order to prevent an imminent infringement or any further infringement, by means of summary proceedings. Such proceedings may be *ex parte* if the circumstances require that such measures be issued without the defendant being heard.

Ownership changes and rights transfers

In order to be enforceable against third parties, the following information should be recorded in the Trademark Register:

- information relating to the owner and the mark, as well as acts affecting the existence or scope of the mark;
- acts affecting the ownership/enjoyment of the rights on the mark (eg, assignment agreement); and
- changes of name, legal form or address of the owner.

The recordation of a licence is not compulsory, but is useful for evidentiary and opposability purposes and for the licensee to be able to act in infringement litigation.

The applicant of such recordation shall provide INPI with a copy or an abstract of the deed stating the change in ownership or use of the rights (not legalised, but translated into French).

Related rights

Trademarks and other IP rights can overlap. Thus, a subject matter may be protected as a trademark, by copyright or as a design if it satisfies the requirements for such protection.

Online issues

Under French law, unauthorised use of a trademark on the Internet also constitutes trademark infringement. The rights holder may sue those that unlawfully use its mark on the grounds of trademark infringement or unfair competition.

According to case law, the French courts have jurisdiction over infringements on websites that are intended for French consumers (depending on the language, the currency or the measurement units used on the website).

Law 2004-575, which implements the EU E-commerce Directive (2000/31), establishes liability regimes applicable to internet access providers (IAP), hosting service providers (HSP) and website editors in case of an illegal act on the Internet, including trademark infringements.

Article 6.I.2 of Law 2004-575 defines 'HSP' as a natural or legal person who, for the provision to the public through online public communication services, stores signals, writings, images, sounds or messages of any kind.

By virtue of Article 6, IAPs and HSPs have no general obligation to monitor the information

that they transmit or store, or actively to seek illegal activities. They are liable only if they knew of the illegal act or if they did not act promptly in order to delete the illegal content or make the content inaccessible when they knew of it.

As to domain names, the '.fr' naming rules provide expressly that it is the responsibility of the person registering or using the domain name to ensure that it does not breach third parties' rights.

A dispute resolution procedure called Syreli is available for disputes over '.fr' domains, in addition to judicial actions. This system is managed by AFNIC, the registry of the '.fr' top-level domain; decisions are issued within two months of receipt of a complaint. WTR

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	**Examination for relative grounds for refusal based on earlier rights?**	**Non-traditional marks registrable?**
Yes (when representative is neither a lawyer nor a patent attorney)/No	No	3D; aspects of packaging; colours; olfactory; sounds.

Unregistered rights	
Protection for unregistered rights?	**Specific/increased protection for well-known marks?**
No	Yes

Opposition
Can a registration be removed for non-use? Term and start date?
No: two months.

Removal from register		
Can a registration be removed for non-use? Term and start date?	**Are proceedings available to remove a mark that has become generic?**	**Are proceedings available to remove a mark that was incorrectly registered?**
Yes: five years' non-use from the date of publication.	Yes	Yes

Enforcement		
Specialist IP/trademark court?	**Punitive damages available?**	**Interim injunctions available? Time limit?**
Yes	No	Yes

Ownership changes
Mandatory registration for assignment/licensing documents?
Yes: to be enforceable against third parties.

Online issues	
National anti-cybersquatting provisions?	**National alternative dispute resolution policy (DRP) for local ccTLD available?**
Yes	Yes

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Alain Berthet is the founding partner of PROMARK, which he established in 1991. He holds a postgraduate degree in IP law from the University of Paris-Pantheon, where he has taught trademark law for 12 years. He has extensive experience with trademarks, designs, copyright and domain names, and advises national and international clients in France and before the Office for the Harmonisation in the Internal Market and the European Court of Justice. His varied experience and deep understanding of the use of trademarks in trade enable him to provide clients with business-oriented, cost-effective solutions.

Mr Berthet has published a book on trademark protection in France and Europe, and several articles on trademarks.



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