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PROTECTING YOUR INTELLECTUAL PROPERTY IN FRANCE ?

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IP / ICT – CORPORATE- EMPLOYMENT – REAL ESTATE – PPP – ENVIRONMENT – INSURANCE – COMPETITION – BANKING

France

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1. Legal framework

National

French trademark law is governed by statutes as France is a civil law country.

The main law governing French trademarks is Law 91-7 of January 4 1991, implementing the EU First Trademark Directive (89/104/EEC) and codified in Book VII of the IP Code. The code was amended by Law 2007-1544 of October 29 2007, implementing the EU IP Rights Enforcement Directive (2004/48/EC), and amended again by Law 2008-776 of August 4 2008 and Order 2008-1301 of December 11 2008.

EU

Community trademarks in force in France are governed by the EU Community Trademark Regulation (40/94).

To take account of these changes, Chapter VII – Community Trademark was added to Book VII of the IP Code.

International

France is signatory to the following conventions:

- 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: International Classification of Goods and Services (June 15 1957);
- the Vienna Agreement establishing an International Classification of the Figurative Elements of Marks (June 12 1973);
- the Trademark Law Treaty (October 27 1994);
- the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (April 15 1994); and
- the Singapore Treaty on the Law of Trademarks (March 27 2006, not yet in force).

2. Unregistered marks

A mark owner has no rights in an unregistered mark. However, under Article 6*bis* of the Paris Convention, a well-known mark (according to the definition included in the article) may be protected in France even if it has not been filed with the French Trademark Office (INPI).

Any person who uses a well-known mark for goods or services that are not similar to those designated in the registration shall be liable under civil law if such use is likely to cause prejudice to the mark owner or if such use constitutes an unjustified exploitation of the mark. Further, invalidity proceedings against the owner of a well-known mark cannot be brought more than five years after the date of registration, unless that registration was applied for in bad faith.

Well-known marks must be recognized by a substantial proportion of the public in relation to the goods and/or services designated in the application.

3. Registered marks

Ownership

Any natural or legal person, including a public authority, can apply for a French mark. The filing may be carried out by the applicant or its representative. In some cases, a representative is mandatory – for example, if:

- the mark is owned by several persons; or
- the applicant is not resident in France, an EU member state or the European Economic Area.

If the representative is not a lawyer or a patent attorney, the representative established in the European Union must have a power of attorney. The said power of attorney has not to be notarized or legalized.

Scope of protection

A mark can be registered if it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A French trademark may consist of any signs capable of being represented graphically. The IP Code lists some examples of such signs capable of being represented graphically, including:

- denominations in all forms – words, surnames and geographical names, pseudonyms, letters, numerals and abbreviations;
- audible signs – sounds and musical phrases (eg, represented on a stave); and

- figurative signs – devices, holograms, logos, shapes (particularly those of a products or its packaging) and shades of colour. According to a new *arrêté* (equivalent to a regulation) dated September 2 2008, when the trademark application has a colour or a combination of colours, the description of those colours must specify an international identification code for each colour.

Excluded signs

A sign which has no distinctive character and/or which is descriptive or generic may not be adopted as a trademark.

The distinctive nature of the sign shall be assessed at the time of the application in relation to the designated goods or services. The following signs have no distinctive character:

- signs which constitute the necessary usual designation of the goods or services;
- signs which may serve to designate a characteristic of the product or service; and
- signs which are exclusively constituted by the shape imposed by the nature or function of the product or which give the products substantial value.

Distinctive character may be acquired by use, except in cases of signs exclusively made up of the shape imposed by the nature or function of the product or which give the product substantial value.

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

- signs excluded by Article 6ter of the Paris Convention (eg, state emblems, official hallmarks, flags);
- the new Red Cross emblem, the Red Crystal, according to Order 2008-1301 of December 11 2008;
- signs contrary to public policy or morality or whose use is prohibited by law; and
- signs liable to mislead the public, by suggesting a nature, quality or geographical origin that the goods or services do not have.

Prior rights

Signs may not be adopted as marks where they infringe prior rights, particularly:

- an earlier mark that has been registered or is well known within the meaning of Article 6bis of the Paris Convention;

- a company name, where there is a risk of confusion in the public mind;
- a trade name or business name known throughout the national territory, where there is a risk of confusion in the public mind;
- a protected designation of origin;
- a copyright;
- a right deriving from a protected industrial design;
- the personality rights of another person, particularly his or her surname, pseudonym or likeness; and
- the name, image or privacy rights of a local authority.

In addition, as an application for an already registered trademark is considered to be an act of infringement in France, a search should be carried out prior to filing the application.

Search for prior rights

A search for identical trademarks is possible, either at the INPI or using the INPI's online database covering the following marks if they are in force:

- French trademarks since 1976;
- French trademarks with logos since 1982;
- Community trademarks with images since 1996; and
- international trademarks in force since 2004.

The INPI can also search:

- prior rights;
- trademarks; and
- company names, taking into consideration their activities.

Details of the searches are available on the INPI website (www.inpi.fr/). Since April 3 2009 the INPI database for French trademarks and company name is free of charge.

4. Procedures

Filing

Registration applications should be filed with the INPI and include:

- the applicant's details;
- a sample of the mark; and

- a list of the goods and services applied for in one or more classes of the Nice Classification with proof of payment of filing fees.

Only one mark can be applied for per filing. Furthermore, if priority is claimed through a foreign application, the applicant must submit to the INPI an official copy of the prior deposit and proof of the right to claim the priority within three months of the application in France.

If the INPI accepts the application, it shall be published in the *Trademark Gazette (BOPI)* within six weeks of receipt of the filing.

Examination

Each filing is checked by the INPI to ascertain that the application for registration and documents annexed thereto comply with legal requirements in force and that the sign is capable of constituting a mark – that is, it:

- is an authorized sign;
- has a character that is lawful and consistent with morality; and
- is a mark which has distinctive character or descriptiveness.

However, no search of prior rights is carried out during the INPI examination procedure. In the event of any irregularity in the application, a notification will be sent to the applicant with a time limit (usually one month) in which to respond. If the applicant does not respond or the INPI does not accept its response, the application will be rejected either totally or partially, depending of the scope of the irregularity or the objection raised by the INPI.

Opposition

Who can act? An opposition can be brought by:

- the owner of a senior mark (based on either use or application date), a well-known mark or a mark that has an earlier priority date; or
- the holder of an exclusive licence, unless otherwise stipulated in the agreement.

The opposition may be filed by the applicant or its representative (R712-2). In

some cases, a representative is mandatory, including if:

- the mark is owned by several persons; or
- the applicant is not resident in France or in a member state of the European Economic Area.

Duration of opposition period: An opposition may be filed within two months of publication of the application in *BOPI*. No extension of the opposition period is possible. For international registrations, the opposition delay starts from publication in the *Gazette* by the World Intellectual Property Organization.

The INPI is required to resolve all oppositions within six months of the date of the opposition. An opposition shall be deemed rejected if no decision is taken within that period.

The time limit can be suspended if:

- the prior mark has not yet been registered; or
- there is a pending claim, such as a claim based upon a non-use action, cancellation action or ownership dispute; or

The time limit can be suspended for three months, renewable once by common request of the parties.

Grounds for opposition: The following relative grounds may be asserted in an opposition:

- a mark that has an earlier application date, registration date or priority date; or
- an existing well-known mark.

To prove ownership of the mark on which opposition is based, the opponent must submit:

- a copy of the registration certificate (or the application, including proof of the basis for claiming priority, if any); or
- proof of the well-known trademark on which opposition is based.

If the opposing trademark was filed more than five years ago, the opponent may be called upon by the applicant in its first answer to submit evidence of use of its trademark.

If the opposing trademark was filed more than five years ago, the applicant must request that the opponent submits evidence of use

of its trademark. Responsive evidence may be submitted, with the exception of new evidence of use, which cannot be submitted at this stage.

The INPI usually renders its decision two weeks after final submission or oral hearings. This decision can be appealed before the competent court of appeal.

Withdrawal

An application or part of an application may be withdrawn up to the point when the technical preparation for registration begins. Withdrawal must be submitted to the INPI in writing by the applicant or its representative.

Registration

A trademark is registered unless the application is rejected or withdrawn. Registration lasts for 10 years from the filing date (L712-1).

The registration date is the date on which it is published in *BOPI* (R712-23).

An unopposed registration takes around six months from filing to registration, while an opposed registration takes around one year.

Renewal

The trademark is renewable for further 10-year periods without limit. Renewal declarations should be filed with the INPI and must not modify the mark or extend it to cover further goods and services. However, it may state that the renewal applies only for part of the goods and services stated in the previous registration. Proof of use is not required.

Renewal must be filed in the six months before the expiry of the 10-year registration period. Later renewal may be filed within an additional six-month period, but will incur additional fees. Renewal shall take effect on the day following the expiry date of the registration. INPI sends out the registration documents about six to 12 months after renewal.

Removal from register

Cancellation: The validity of a registered trademark can be challenged through a cancellation action or in infringement litigation. Valid grounds for such actions are:

- earlier registered rights;
- earlier use-based rights;

- descriptiveness, distinctive character or genericness; and
- geographical meaning or deceptiveness;

A cancellation action can be initiated by the public prosecutor or the owner of a prior right. The action should be filed with the competent first instance court. A party may not act without a representative, who must be an attorney at law.

The first instance court usually renders a decision within nine to 18 months. That decision may be appealed to the competent court of appeal.

Revocation for non-use: A rights holder which has not used its trademark in connection with the goods or services for which it is registered for an uninterrupted period of five years without good reason shall be liable to have its rights revoked.

Use consists of:

- using the mark with consent of its owner;
- using the mark in a modified form which does not alter its distinctive character; and
- affixing the mark to goods or packaging exclusively for export.

Revocation may be requested in legal proceedings by any concerned person. If the request refers only to a part of the goods or services specified in the registration, the revocation shall be limited to the extent of the request.

Genuine use of the mark begun or resumed in the three months prior to the request for revocation, where the owner knows that such a request may be made, will not be considered.

The burden of proving exploitation rests with the owner of the mark for which revocation is requested. Evidence can be provided by any means.

Revocation shall take effect as of the date of expiry of the five-year period laid down in the first paragraph of this section and has absolute effect. There is no limitation period for filing such actions.

Revocation of a trademark that has become common: The owner of a mark shall be liable to revocation of its rights if the mark has become the common name in trade for a product or service.

Revocation of a trademark that has become misleading: The owner of a mark shall be liable to revocation of its rights if the mark has become misleading, particularly as regards its nature, quality or geographical origin of the product or service.

Surrender: The owner of a registered mark may surrender it at any time, with respect to all or part of the goods or services registered. The surrender notice must be filed by the rights holder or its representative.

5. Enforcement

Infringement of a mark is an offence incurring the civil and criminal liability of the infringer. Major acts constituting infringements are:

- the reproduction of a mark for similar goods or services; or
- the imitation of a mark for identical or similar goods or services.

In order to determine the acts of infringement, the marks and the goods or services must be compared. According to settled case law, the visual, phonetic and intellectual aspects of the trademarks must be studied. Evidence may be provided by all means, particularly by seizure.

A new decree dated June 27 2008 on the application of the Law of October 29 2007 enacted provisions detailing the new seizures proceedings and the time limits for such proceedings.

Who can act?

Civil infringement proceedings shall be initiated by the owner of the mark or the exclusive licensee if, after formal notice to the owner, the owner does not exercise such right (unless otherwise laid down in the agreement).

Since the Law of August 4 2008, the licensee, even if the licence contract has not been registered with the trademark registrar, is entitled to intervene in a counterfeiting proceeding initiated by the rights holder in order to obtain compensation for its own damage (ie, the damage created by the infringement, not damage that it may have suffered due to unfair competition).

Any party to a licence agreement shall be entitled to join infringement proceedings initiated by another party in order to obtain remedy for its own prejudice.

Infringement proceedings must be initiated within three years of the infringement.

Interim relief

There are two interim proceedings available for trademark owners:

- Expeditious summary proceeding (*référé d'heure à heure*) against the infringer to seek:

- withdrawal of the infringing content; and
- provisional compensation for such infringement.

In such proceedings, the president of the court must be satisfied that there is real need for the case to be judged so expeditiously. Provisional compensation is very difficult to obtain in such expedited proceedings.

- Summary proceeding against the infringer to seek:
 - withdrawal of the infringing content; and
 - provisional compensation for such infringement.

Such an action can be initiated if there is an emergency or if the demands are not or cannot be disputed legitimately.

Limitation resulting from acquiescence

Where the owner of a trademark has acquiesced for five successive years to the use of a later trademark while being aware of such use, it shall no longer be entitled to initiate infringement proceedings, unless the registration of the later trademark was applied for in bad faith. However, such limitation shall be restricted to those goods and services for which use was allowed.

6. Ownership changes and rights transfers

In order to be enforceable against third parties, the following must be registered in the National Trademarks Register:

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- acts affecting the existence or scope of the mark (eg, court order);
 - acts affecting the ownership or use of the mark (eg, assignment, coexistence agreement); and
 - changes of name, legal form or address of the rights holders.

The registration of a licence is no longer compulsory, but is useful for reasons of evidence.

An application for such changes shall contain a copy or an abstract of the deed stating the change in ownership or use of the rights. Only the French version of the documents (full or abstract) is enforceable against third parties.

Documents submitted to the INPI need not be legalized.

Article L143-17 of the Commercial Code provides that sale or assignment of business which includes trademarks must be registered with the INPI, on production of the certificate of registration of the *Tribunal de Commerce*, within two weeks of registration in order to be valid with respect to third parties.

All registrations are mentioned in the National Trademark Register and published in *BOPI*.

Use by a licensee is not attributed to the mark owner.

According to settled case law, unauthorized use includes internet use, such as domain names, websites, hyperlinks or metatags. Grounds for litigation on such issues could be infringement and/or unfair competition.

Case law is uncertain regarding French jurisdiction over a foreign website without any evidence of connection to French consumers in cases where the website is accessible in France and in a foreign language. However, French law is applicable and infringement may be admitted where a website is used by French consumers, although the availability of products and the language are considered.

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 the rights of third parties.

In addition to judicial actions, alternative dispute resolution is available for disputes over ‘.fr’ domains. Each issue is administered by different authorities and has separate regulations:

- alternative dispute resolution leading to online recommendation, administered by the Centre for Mediation and Arbitration of Paris;
- alternative dispute resolution leading to mediation, administered by the Internet Rights Forum; and
- alternative dispute resolution leading to a technical decision, administered by the Centre of Mediation and Arbitration of the World Intellectual Property Organization.

7. Related rights

There are certain areas of overlap between trademarks and other IP rights. For example, copyright may be used to protect trademarks in advertising slogans which have artistic merit. A logo may be protected as a trademark, copyright or design. Shapes of products or packaging may be protected as trademarks or designs.

8. Online issues

A mark entitles its owner to prohibit any unauthorized use for goods or services identical or similar to those designated in the registration if there is a likelihood of confusion in the public mind.

Unregistered rights Protection for unregistered rights?	
Specific/increased protection for well-known marks?	
Examination/registration Representative requires a power of attorney when filing? Legalized/notarized?	only when representative is not lawyer or patent attorney 
Examination for relative grounds for refusal based on earlier rights?	
Registrable unconventional marks	3-D, aspects of packaging, colours, olfactory, sounds 
Opposition Opposition procedure available? Term from publication?	
Removal from register Can a registration be removed for non-use? Term and start date?	5 years' non-use from date of publication 
Are proceedings available to remove a mark that has become generic?	
Are proceedings available to remove a mark that was incorrectly registered?	
Enforcement Specialist IP/trademark court?	
Punitive damages available?	but implementation of Directive 2004/48 creates punitive damages 
Interim injunctions available? Time limit?	the decision is valid until the decision on the merits 
Ownership changes Is registration mandatory for assignment/licensing documents?	 / 
Online issues National anti-cybersquatting provisions?	
National alternative dispute resolution policy (DRP) for local ccTLD available?	