

IMPLEMENTATION OF THE E.U. “TRADEMARK REFORM PACKAGE” IN FRANCE: THE FRENCH TM OFFICE NOW COMPETENT TO INVALIDATE OR REVOKE TRADEMARK REGISTRATIONS

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Paris, April 21, 2020 - As of April 1, 2020, requests for invalidity or revocation of trademarks which had been brought before the judicial courts prior to this date, now fall within the purview of the INPI and become administrative and purely electronic procedures.



The French National Institute of Industrial Property (INPI) now has exclusive jurisdiction to deal with invalidity or revocation actions filed as a principal claim, whereas judicial courts remain competent in some particular cases, for example when a request is connected with a TM infringement action.

Thanks to simpler, faster and inexpensive procedures before the INPI, the goal is to make the cancellation of invalid trademarks (either for absolute grounds of refusal, or because of earlier conflicting rights), as well as the revocation of trademarks for grounds of non-use for 5 consecutive years, easier.

There is no need for the applicant to demonstrate a specific legal interest in bringing the proceedings, and the official fees amount to only a few hundred euros, making these procedures very easy to launch:

- 600 € for a revocation action or a request for invalidity based on only one earlier right;
- 150 € for each additional earlier right put forward.

The total duration of these procedures cannot exceed a maximum of nine months to ensure that the petitioner obtains a quick decision. After an investigative phase during which the parties exchange written arguments, the INPI then has a maximum period of three months to render its decision.

Another new aspect: the INPI may order the losing party to pay all or part of the costs incurred by the other party.

Decisions can be challenged before the competent Court of Appeal with suspensive and devolutive effects, which means that the Court will review the entire case and issue its own decision.

These new procedures should encourage economic players to act against trademarks barring their own projects or which infringe their rights. There is no limitation period in this respect; these procedures can be filed at any time.

They should progressively declutter the French Trademark Register, removing unexploited trademarks in order to let other economic players use identical or similar trademarks, depending on the circumstances.

Therefore, it is now even more important for trademark owners to organize their recordkeeping of proof of use of their trademarks in advance, such that they are in a position to validly defend them in case of such actions.

Finally, despite the implementation of simpler procedures, the subject nevertheless remains technical. You may fully rely on our experience and guidance to take advantage of these new procedures, to secure your projects or defend your rights.



We are at your disposal for any advice or additional information that you may need. Do not hesitate to reach out to your regular contact, who remains fully committed to answering to your questions.

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