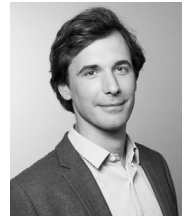




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## Everything you've always wanted to know on the new « Trademark Package » in French Law

**The EU Trademarks Directive, in force since December 11, 2019, contains important new features: the opposition procedure is now open to all owners of prior rights (and not only trademark owners); certain signs (animations, audio, multimedia) can now be registered as trademarks; and finally, the action for revocation is in principle now devolved to the French Trademark Office (INPI), unless it is raised before a Court as a defense to an infringement action. This last point will certainly raise complex procedural issues.**

Empowered by Article 201 of the Law of May 22, 2019, the French Government adopted Ordinance No. 2019-1169 of November 13, 2019 on trademarks and service marks. This Ordinance transposes Directive (EU) n°2015/2436 of December 16, 2015 of the "Paquet Marques", the stated objective of which is to harmonize the trademark laws of the Member States and to ensure the compatibility of the French Intellectual Property Code (IPC) with EU Regulation 2017/1001 of June 14, 2017 applicable to trademarks in the European Union. The Transposition Ordinance came into force on December 11, 2019, at the same time as its Implementing Decree No. 2019-1316 of December 9, 2019.

The new provisions will be applicable to trademark applications, proceedings and oppositions filed as of **December 11, 2019**, apart from the INPI's new powers to rule on applications for invalidity and revocation of trademarks, which will be applicable only to proceedings filed after **April 1, 2020**.

### Amendment of the opposition procedure

**Prior rights** – Trademark owners are no longer the only ones who can file an opposition before the INPI. The list of prior rights that can be invoked in support to an opposition ([L. 712-4 IPC](#)) now includes:

- Well-known trademarks,
- Corporate names,
- Trade names or domain names whose scope is not only local, and
- Geographical indications.

Thus, the owners of these prior rights, who previously could only act for invalidity once the trademark was registered, can now file opposition against a trademark application if they demonstrate a likelihood of confusion in the public mind. The stated objective is to strengthen the protection of other distinctive signs - not registered as trademarks - but likely to be imitated by third parties.

**Time Limit** - The time limit for filing an opposition remains two months following the publication of the trademark application ([L. 712-4 IPC](#)) but the opponent now has one additional month to file its grounds of opposition ([R. 712-14 IPC](#)).

### Introduction of administrative proceedings for revocation and invalidity of a trademark

**New distribution of jurisdiction** - As of April 1, 2020, the INPI will have exclusive jurisdiction to rule on the actions for trademark invalidity and revocation filed on a principal basis ([L. 716-5 I IPC](#)), which were previously ruled by specialized First Instance Courts

(*Tribunaux de Grande Instance*). Appeals against INPI decisions will however remain within the exclusive jurisdiction of the Paris Court of Appeal.

The extension of INPI's jurisdiction (L. 411-1 IPC) is intended to make these procedures faster and less expensive. It should also help to clear the National Register of Trademarks of unused or invalid trademarks.

However, the specialized First Instance Courts (*Tribunaux de grande instance*) will keep their exclusive jurisdiction for (L. 716-5 II IPC):

- Counterclaims for trademark invalidity or revocation filed as a defense to a trademark infringement action;
- Trademark invalidity claims filed as a principal action but on specific grounds of deceptive nature or contrary to public order;
- Trademark invalidity or revocation claims filed as a principal action but:
  - o Associated with any other requests falling within the jurisdiction of the specialized First Instance Courts (*Tribunaux de Grande Instance*) (e.g. infringement actions), or
  - o Consecutive to the issuance of provisional (e.g. provisional injunction) or probatory (e.g. seizure of proof of infringement) measures.

In addition, an action for invalidity filed by the owner of a prior trademark may be deemed inadmissible if, at the request of the owner of the contested trademark, the owner of a prior trademark cannot prove a genuine use of the earlier trademark during the five years preceding its action (L.716-2-3).

**Prescription** – Finally, trademark invalidity actions, whether they fall within the jurisdiction of the INPI or the specialized First Instance Courts (*Tribunaux de Grande Instance*), are now imprescriptible (L.716-2-6 IPC), except in two cases where they are subject to a limitation period of 5 years :

- When the invalidity action is filed by the owner of a well-known trademark, and
- When the owner of the prior right tolerated the use of the contested trademark for five consecutive years, unless the applicant acted in bad faith.

## New trademark registration requirements

**Suppression of the graphic representation requirement** - The graphic representation requirement is no longer formally required (L. 711-1 IPC). The sign must now be represented "*in an appropriate form, using commonly available technology*" (R. 711-1 IPC). This offers the possibility of submitting audio or multimedia files (MP3, MP4, JPEG) for sound, motion (animated) or multimedia trademark registration. However, olfactory or gustatory marks are a priori still refused. The trademark must be able to be "*represented in this register in a clear, precise, distinct, easily accessible, intelligible, durable and objective way*"» (R.711-1 IPC).

**Application fees** – The flat-rate application fee of 210 euros for a trademark for 1 to 3 classes of goods and services is replaced by a fee of 190 euros for the 1<sup>st</sup> class. Each additional class will cost to the applicant 40 Euros.