

# THE NEW TRADEMARK'S INVALIDITY AND REVOCACTION PROCEEDINGS IN FRANCE

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## Background

- EU directive 2015/2435 harmonizing the national trademark laws of the Member States
- In France, the provisions relating to trademark invalidity and revocation proceedings came into force on April 1, 2020

# New revocation and invalidity proceedings in Europe

- As a result, the national office has sole jurisdiction over :
  - Trademark revocation claims for lack of genuine use or degeneration;
  - Nullity claims based exclusively on :
    - One or more absolute grounds ; and/or
    - One or more relative grounds (domain name is included)
- By way of exception, the courts have retained exclusive jurisdiction over certain claims (10 courts)

# New revocation and invalidity proceedings in Europe

- The INPI's first decision in a nullity action was rendered on November 10, 2020 (INPI, November 10, 2020, Gang bang, NL20-0024)
- Then, one decision has followed another. Since the opening of these proceedings, INPI has received 1 200 applications for invalidity and revocation, and more than 870 decisions have been rendered as of December 31, 2022

## Basis of these new proceedings

- Contradictory procedure based on exchange of briefs and exhibits with possibility to ask at the end of the examination for an oral hearing
- Flat fee of €600 in the following cases
  - A request for revocation based on one or more grounds
  - A request for nullity based on one or more absolute grounds and/or a single prior right (additional flat fee : €150 per prior invoked right)

## Basis of these new proceedings

- No time limit for filing a claim for invalidity or revocation
- However, there are three exceptions for the invalidity cases, including “acquiescence” : the owner of an earlier trademark who has tolerated the use of a second trademark in good faith for 5 consecutive years can no longer request its invalidation

## Basis of these new proceedings

- Applications for revocation of trademarks are not subject to justification of an interest in bringing proceedings
- Contrary to a request for nullity based on relative grounds which must be presented by the holders of prior rights

Many invalidations are ruled inadmissible by the INPI in the absence of a legitimate interest to act

- Abuse of rights (rarely admitted by the Office) (INPI, April 9, 2021, request of forfeiture “JC/DC” / INPI, March 8, 2021, Revocation claim against “LE BOEUF SUR LE TOIT”)

# Two-stage procedures





# Two-stage procedures

## 1. Examination of admissibility

- If INPI considers that there are grounds for inadmissibility, it promptly sends the applicant a notification of inadmissibility (response time: one month)
- If the INPI confirms its position, it issues a decision of inadmissibility within approximately 4 months
- If the reason for inadmissibility is raised by the defendant, it is examined at the end of the procedure.

### Examples of grounds for inadmissibility :

- *Application against a trademark that has not been registered at the date of the application (INPI, March 8, 2021, invalidity claim of the trademark “Fête du livre de Talloires”)*
- *An application filed against a trademark that has been registered for less than 5 years at the date of the application is inadmissible (INPI, March 3, 2021, revocation claim of “BIGGY BURGER”)*

# Two-stage procedures

## 2. Examination of the merits

- The duration of the procedure varies according to the number of exchanges between the parties during the investigation phase, totaling between 6 months and 1 year

The procedure takes place within short, non-extensible deadlines. However, these deadlines may be suspended under certain conditions, in particular : at the request of the parties to negotiate a coexistence agreement (4-month suspension, renewable twice)

- In a revocation action for non-use, the trademark owner is asked by INPI to provide evidence of genuine use in relation to the period, territory, goods and services designated in the mark

the use demonstrated for a product or service makes it possible to validate a general category to which the product or service exploited belongs (*INPI, April 15, 2021, revocation claim of “L’ANE EN CULOTTE”*)

## Proof of use

- Defendants in a revocation action must ensure that their documents are submitted in a rigorously formal manner, otherwise they may be deemed inadmissible (CPI, Art. R. 716-5)

INPI Director General Decision no. 2020-35 sets out the procedures for presenting proof of use, in particular Article 5, which states that "1° The documents provided... are numbered and listed in a schedule. In the application and in the written submissions, the parties shall relate their arguments to the supporting documents". Failure to comply with these rules may result in the inadmissibility of exhibits that are not related to the practices invoked.

- Documents proving the genuine use of a French trademark, EU trademark or international trademark designating France may include the following : brochures, catalogs, prospectuses and all commercial or advertising documents; purchase orders or quotations ...

## Closing of the procedure

- Revocation and invalidity proceedings are closed, including :
  - When the contested trademark has ceased to have effect, in the absence of renewal, unless the applicant can demonstrate a legitimate, direct and present interest in obtaining a decision on the merits of the case with effect prior to the date of expiry of the contested trademark ([INPI, May 28, 2021, “JC de CASTEL BAJAC](#))
  - Where the plaintiff has lost his/her quality to act
  - When the effects of all the prior rights invoked have ceased
  - When, after suspension of the invalidity proceedings, the applicant has not responded, within the time limit set by the office, to the latter's request to be informed of the outcome of the proceedings

## Closing of the procedure

- The INPI's decision may be appealed before the competent Court of Appeal
- The Court of Appeal with territorial jurisdiction is that of the place of residence of the person lodging the appeal (10 competent courts)
- Appeals against decisions ruling on invalidity and actions in lapse for non-use will be appeals for reform and not simply for annulment



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**Thanks for your attention !**

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