

France: the new cancellation actions before the French trade mark office

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Since 1 April 2020 most cancellation actions in France have become administrative proceedings and must be filed with the French trade mark office ("*Institut National de la Propriété Industrielle*"). Only invalidity actions based on earlier copyrights, designs, surnames, pseudonyms etc. remain judicial proceedings. These new administrative proceedings are the result of the implementation of Directive EU 2015/2426 of 16 December 2015 into the French Intellectual Property Code ("*Code de la propriété intellectuelle*").

Type of cancellation actions

Most cancellation actions have now become administrative proceedings and are handled by the French trade mark office (Article L.716-5 French Intellectual Property Code). These actions are:

• Invalidity actions based on the following grounds

- Absolute grounds
- Relative grounds: earlier trade marks, earlier trade marks with a reputation, earlier marks with a reputation within the meaning of Article 6 bis of the Paris convention, company or trade name, domain names, geographical indications, names of public entities,

unauthorised filings by an agent

- Additional grounds for certification and collective marks

▪ **Revocation actions based on the following grounds**

- Lack of genuine use
- Trade mark which consists exclusively of signs or indications which have become customary
- Trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service
- Additional grounds for certification and collective marks

Invalidity actions based on absolute grounds or revocation actions can be filed by any party without the need to prove legitimate interest. This point has created fear amongst trade mark owners.

An applicant cannot file an invalidity action and a revocation action within one same application. They have to be filed in two separate applications. Having said that, each of these actions can be based on several grounds. Invalidation actions can be based on several earlier rights (see below additional fee per additional earlier mark). In fact, the French trade mark office has declared its willingness to assess each of the earlier rights invoked in an invalidity action.

The official filing fees per cancellation action are 600€. If more than one earlier right is used as a basis of an invalidity action, 150€ will have to be paid per additional right.

The losing party will have to bear the costs of the winning party although the calculation method of these fees still has to be disclosed. Practitioners are awaiting the relevant decree outlining these costs.

Timeline

Applications for cancellation are filed online and must include a statement of grounds. The only exception are revocation actions based on lack of use for which no statement of grounds must be submitted.

Once the application has been filed online, the proceedings start and are split into three phases:

- **Instruction phase (1 month)**

The French trade mark office notifies applications to the owner or the representative on record per normal post. It is therefore essential that trade mark owners keep these records updated. This implies a change of practice as records could not easily be updated in the past. Records can now be updated for a small fee.

French trade mark records will be updated to include information on any cancellation actions (pending or closed), including the list of contested goods and/or services.

- **Adversarial part of the proceedings (up to 6 months)**

- **Written part of the proceedings: up to three rounds**

Trade mark owners should note that the turnaround to submit observations in reply are very short in cancellation proceedings (1 or 2 months). That is even more of a challenge when evidence (e.g. evidence of use) has to be gathered and submitted. Joint suspensions are available but, so far, unilateral extensions of time are not.

- **Hearing: on a party's or the French trade mark office's request**

- **Decision taking (up to 3 months)**

The French trade mark office's goal is to issue a decision within 10 months from the filing of the cancellation action.

Overall, practitioners have been waiting for these administrative proceedings and the reform should result in an increase of cancellation actions in France, especially non-use revocation actions.