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How Is The French INPI Coping With Its New Attributions Since 1st April 2020?

Casey Joly (ipSO) · Tuesday, December 22nd, 2020

Fairly well, one should say.

The three decisions issued to date should dispel some of the fears that many had, as to the capability of the administration of properly substituting the Courts in rectification/cancellation actions for non-use and cancellation/nullity proceedings.

[Trademark Ordinance of 13th November 2019 that came into effect on 1st April 2020.]

1. On competence divided between the Courts and the Administration:

Decision [DC20-008/3319571/SGU of 10/07/2020] clarifies how the exclusivity, attributed to both the Administration and the Courts, but in different situations, is to be understood.

Indeed, INPI has exclusive jurisdiction for rectification/cancellation actions for non-use, as a principal action, save where the rectification/cancellation for non-use is in fact related to a infringement or unfair competition claim, previously filed before the Civil Courts, in which case, the Civil Courts retain exclusive competence.

The Respondent for rectification had sued the Applicant before the Marseille IP Court for infringement of its FADA COLA mark in classes 32 & 33 of the international classification.

The Applicant then filed for total *rectification/cancellation for non-use* of the FADA COLA mark in classes 32, 33 & 43, as a principal claim before INPI.

Notwithstanding the fact that the claims were only partially identical, INPI's decision specifies that Article L 716-5 of the Intellectual Property Code does not provide for the competence to be divided out so that the Marseille Court is exclusively competent to hear the cancellation for non-use in its entirety. The decision also relied on the traditional principle of the proper administration of justice but also a fairly unheard-of principle of "litigation unity" [«unité des litiges»].

The message is clear: one may not misuse the facility offered by these new

cancellation proceedings (inexpensive and easy to file) as a retaliatory measure, by attempting to separate what is a related issue.

So, this seems to suggest that once there is a relation, i.e. an infringement and/or unfair competition complaint served that is related to the rectification/cancellation, competence lies with the Courts.

But what if the Applicant for rectification only filed for rectification/cancellation in class 43 which was not invoked in the infringement proceedings brought before Marseille ? Would the rectification/cancellation still be considered as « related »? The principle of “litigation unity” may suggest that it could.

2. Nullity on absolute grounds:

In its Decision [NL-20-0024/FDU of 10/11/2020] : INPI agreed with the Applicant for nullity that the trademark GANG BANG A PARIS, for goods and services in classes 25, 35 & 41, is contrary to public order as the underlying message is pornographic and degrading for any person of average sensitivity and tolerance (such reliance to be made more largely than simply the relevant public of the goods and services claimed). Was the Applicant morally interested in not upsetting public order? Probably not. Clearly though any subsequent use of GANG BANG by Applicant or Respondent could be criminally prosecuted under L 227-24 of the Penal Code. Note that a trademark BANG GANG for entertainment services is registered in France since 2007 !

3. Nullity on relative grounds:

Finally, in its Decision [NL 20-0016 of 17/11/2020], INPI upheld the likelihood of confusion between CICIOBELLO, the prior mark and CHICOBELLO, both in classes 25, 28 & 35. One interesting point made: when considering intrinsically, the distinctive character of the prior mark, the fact that there is no semantic link between the sign and the products/services does not automatically mean that the mark intrinsically has a strong distinctive character so that CICIOBELLO, is just normally distinctive. So, there is no automatic deduction possible here and one needs to explicitly argue why the mark’s distinctive character should be considered as above « normal ».

More to come on the new Trademark Law, especially on some of the sticky issues still unresolved...

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