



ICLG

The International Comparative Legal Guide to:

Trade Marks 2013

2nd Edition

A practical cross-border insight into trade mark work

Published by Global Legal Group, with contributions from:

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URL: www.glgroup.co.uk

GLG Cover Design

F&F Studio Design

GLG Cover Image Source

Global Legal Group

Printed by

Ashford Colour Press Ltd
May 2013

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ISBN 978-1-908070-59-3

ISSN 2049-3118

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General Chapters:

1	The Race for “Modernity” in Shaping Trade Mark Policy Around the World – 2012 Developments - John Olsen, Edwards Wildman	1
2	Admissibility of Trade Mark Revocation Actions: Discrepancies Between the European and the French Approaches - Frank Valentin, De Gaulle Fleurance & Associés	4

Country Question and Answer Chapters:

3	Albania	Boga & Associates: Renata Leka & Ened Topi	9
4	Australia	Gilbert + Tobin: Lisa Lennon & Lauren Eade	17
5	Austria	Hausmaninger Kletter Attorneys-at-Law: Dr. Leonhard Reis	26
6	Belgium	Baker & McKenzie: Pierre Sculier & Elisabeth Dehareng	34
7	Brazil	Kasznar Leonardos Intellectual Property: Filipe da Cunha Leonardos & Claudio Roberto Barbosa	44
8	Canada	Bereskin & Parr LLP: Daniel R. Bereskin, Q.C. & Cynthia Rowden	54
9	Chile	Beuchat, Barros & Pfenninger: Andrés Melossi	61
10	China	CCPIT Patent and Trademark Law Office: Chumeng (Jessica) Xu	68
11	Cyprus	Papacharalambous & Angelides L.L.C: Eleni Papacharalambous & Coralia Papacharalambous	76
12	Czech Republic	Johnson Šťastný Kramář, advokátní kancelář, s.r.o.: Roman Šťastný & Eva Haisová	84
13	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	93
14	European Union	Bristows: Paul Walsh & David Kemp	99
15	France	Armengaud & Guerlain: Catherine Mateu	107
16	Germany	Hengeler Mueller: Dr. Wolfgang Kellenter & Dr. Andrea Schlaffge	115
17	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	123
18	Hong Kong	Ella Cheong (Hong Kong & Beijing) Limited: Coral Toh & Vincent Oey	131
19	Hungary	Danubia Patent & Law Office: Michael Lantos	139
20	India	Subramaniam, Nataraj & Associates, Patent & Trademark Attorneys: Hari Subramaniam	145
21	Italy	Avvocati Associati Franzosi Dal Negro Setti: Vincenzo Jandoli & Dario Palmas	153
22	Japan	Anderson Mori & Tomotsune: Yasufumi Shiroyama & Ai Nagaoka	161
23	Kosovo	Boga & Associates: Renata Leka & Ened Topi	168
24	Luxembourg	Loyens & Loeff, avocats à la Cour: Véronique Hoffeld	175
25	Macedonia	Pepeljugoski Law Office: Professor Dr. Valentin Pepeljugoski & Ana Pepeljugoska	183
26	Malaysia	Tay & Partners: Su Siew Ling & Joanne Kong	193
27	Mexico	Olivares & Cia.: Alonso Camargo & Daniel Sanchez	202
28	Nigeria	Banwo & Ighodalo: Femi Olubanwo & Chinasa Uwanna	210
29	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	218
30	Portugal	Abreu Advogados: João Veiga Gomes & João Gonçalves Assunção	226
31	South Africa	DM Kisch Inc.: Andrew Papadopoulos & Derek Momberg	236
32	Spain	ELZABURU: Fernando Ilardia & Luis Baz	243
33	Switzerland	ThomannFischer: Daniel Plüss	253
34	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	260
35	Ukraine	Vasil Kisil & Partners: Oleksandr Mamunya & Yulia Chyzhova	270
36	UAE	Abu Ghazaleh Intellectual Property (AGIP): Amjad El Husseini & Karim El Gebaily	278
37	United Kingdom	Bristows: Paul Walsh & David Kemp	285
38	USA	Edwards Wildman: David I. Greenbaum & H. Straat Tenney	294
39	Vietnam	Pham & Associates: Pham Vu Khanh Toan	301

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France

Armengaud & Guerlain

Catherine Mateu



1 Relevant Authorities and Legislation

1.1 What is the relevant French trade mark authority?

The National Industrial Property Institute, *Institut National de la Propriété Industrielle* (INPI) for French trademarks and the Office of Harmonization for the Internal Market (OHIM) for European Community trade marks (hereafter CTMs), are the relevant trade mark authorities.

1.2 What is the relevant French trade mark legislation?

The Intellectual Property Code (hereafter IPC) and more particularly book VII about trade mark law legislation and book IV which refers to the National Industrial Property Institute are the most used statutes regarding trade mark law. There are also some relevant provisions in the Civil Code as well as in the Commercial Code. European Union legislation is applicable to both French and EU trade marks.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Article L.711-1 of the Intellectual Property Code, which implements Article 2 of the European Union Directive No. 2008/95/EC, specifies, “A trademark or service mark is a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person. The following, in particular, may constitute such a sign: a) Denominations in all forms, such as: words, combinations of words, surnames and geographical names, pseudonyms, letters, numerals, abbreviations; b) Audible signs such as: sounds, musical phrases; c) Figurative signs such as: devices, labels, seals, selvedges, reliefs, holograms, logos, synthesized images; shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of color”. Similar provisions regarding Community trade marks are found in article 4 of Council Regulation n°207/2009/EC. In practice, it may be more difficult to register laudatory words, as well as product shape and/or its packaging.

2.2 What cannot be registered as a trade mark?

Anything that does not comply with the conditions set here above.

In practice, it is more difficult to register certain three dimensional signs such as the product shape (the Paris Appeal Court ruling invalidating a trade mark consisting of a red shoe sole has been held legitimate by the French Supreme Court), its packaging or a mere flavour (a trade mark application consisting of artificial strawberry flavour has been rejected by both the National Industrial Property Institute and the Paris Appeal Court). Also, there is abundant case law about trade marks that include geographical names where issues of distinctiveness and deceptiveness are discussed.

2.3 What information is needed to register a trade mark?

French trade mark applications must include the information listed in Article R.712-3 of the IPC, in particular, the name of the applicant, the graphical representation of the trade mark, the relevant goods and services, as well as the corresponding classes, if applicable, a priority claim, payment of application fees, a power of attorney for representatives that are neither lawyers nor industrial property counsel, if applicable, any evidence showing acquired distinctiveness, also in case of a collective mark of certification, the regulation defining the conditions of its use, if the applicant is a foreigner, depending on the applicable international conventions, documents showing that he has properly filed the trade mark in the country of his residence or his establishment and that this country grants a reciprocal protection to French marks. For CTMs, the information listed in Rules 1 to 3 of the Regulation n°2368/95, which include most of the information listed for French trade marks, as well as information regarding the applicant’s nationality and contact information, is needed.

2.4 What is the general procedure for trade mark registration?

For both French trade marks and CTMs, an application must be filed according to the regulations which are respectively found in the IPC and in Regulations n°207/2009 and n°2368/95. Following the filing of the trade mark application, is an overall assessment of it by the trade mark authority and the publication of the trade mark application, which allows third parties to present observations or an opposition to the registration, which may lead to the rejection of the application. Trade mark registration proceedings are finalised once the publication of the registration is made.

2.5 How can a trade mark be adequately graphically represented?

The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. More particularly

regarding French trade marks, sounds must be graphically represented, holograms must be represented by any graphic representation or photography of the elements of the hologram excluding the hologram itself, a three dimensional sign must be represented by its flat reproduction and colour or colour combination trade marks must refer to an international colour code. CTMs must be represented according to Rule 3 of Regulation n°2368/95 which contain provisions similar to those applicable to French trade marks. While the odor of “fresh cut grass” had been registered as a CTM, in practice, it is extremely difficult to register smells or flavours as trade marks as it is very difficult to meet the conditions of representation set hereinabove.

2.6 How are goods and services described?

Goods and services must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought. CTMs and French trade marks are subject to the Nice Classification. However, the European Court of Justice has considered that some class headings do not meet the conditions of clarity and precision and has invited national authorities to decide on a case-by-case basis whether the description meets the required conditions. According to the INPI, a mere reference to class headings specifying that all the goods/services of the class are claimed does not satisfy the conditions of clarity and precision. Therefore, goods and services descriptions must be written carefully following INPI's practice.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a French trade mark?

The entire French Republic, which includes remote locations such as New Caledonia or French Southern and Antarctic Territories, as well as the Llivia exclave, surrounded by Spain, are covered by a French trade mark. However, French trade marks do not cover territories that belong to other countries very close to France both geographically and administratively, such as the Principalities of Monaco or Andorra.

2.8 Who can own a French trade mark?

Any natural or legal person may own a French trade mark or a CTM. Such trade marks may have multiple owners as described in the report of the French group of the AIPPI in Q194.

2.9 Can a trade mark acquire distinctive character through use?

Both French and European legislation provide that distinctiveness may be acquired through use. Acquired distinctiveness is assessed on a case-by-case basis. For instance, the Supreme Court (Cass. Com., April, 28, 2004, Appeal No. 02-14537) ruled that LOTO had not acquired distinctiveness for games. The CJEU (May 4, 1999, Case No. 108-109/97, Windsurfing v. Boots) has also ruled that to determine whether distinctiveness has been acquired, the relevant authority must globally appreciate the elements showing that the sign may identify the product/service of one undertaking from those of other undertakings. In this case, the CJEU ruled that distinctiveness is established when a significant fraction of the relevant class of persons identifies, with the trade mark, the product/service originating from one undertaking.

2.10 How long on average does registration take?

Currently, if there is no opposition to the registration and no notification from the INPI, a French trade mark application is usually registered within 5 to 6 months. A CTM's registration takes slightly longer.

2.11 What is the average cost of obtaining a French trade mark?

As of today, the INPI trade mark application fees are EUR 200 for up to three classes and EUR 40 for any additional class. Paper applications lead to the payment of an extra EUR 25. Professional fees, which may vary, may have to be added to the aforementioned fees.

2.12 Is there more than one route to obtaining a registration in France?

Trade mark protection is available in France through French national trade marks following a French trade mark application, or a CTM conversion into a French trade mark, through CTMs, or for international trade marks that designate France. All these trade mark applications may be operated electronically by fax or postal mail.

2.13 Is a Power of Attorney needed?

French trade mark law requires a power of attorney when the representative is neither an industrial property counsel nor a lawyer. For CTMs, a power of attorney is required more generally.

2.14 How is priority claimed?

According to Article R.712-4 of the IPC “*The claim to a priority right, when making a deposit in France, deriving from a preceding deposit abroad shall imply the obligation to submit to the National Institute of Industrial Property within three months of the deposit in France an official copy of the prior deposit and, if appropriate, proof of the right to claim the priority. Where this obligation is not complied with, the priority shall be deemed not to have been claimed*”. Rule 6 of Regulation n°2868/95 contains similar provisions regarding CMTs. Furthermore, regarding CTMs, priority rights may be claimed within two months of the CTM application.

2.15 Does France recognise Collective or Certification marks?

Both French and European trade mark law recognise collective trade marks which are subject to specific rules; for instance, it is compulsory for French collective trade marks to file regulation of use and collective CTMs may, contrary to ordinary trade marks, consist of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services. According to French law, collective trade marks refer to marks which may be used by any person who complies with regulations for use issued by the owner of the registration.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

French law has implemented the EU directive harmonising trade mark law, and therefore provides that, to be registered a trade mark,

the mark must be “a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person” and cannot be contrary to public order or to morality, nor can the use of which be prohibited by law or liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services. EU regulations contain similar provisions. For instance, the Paris Court of First Instance has cancelled a trade mark that contained a reference to a public entity considering that such reference was misleading (Paris Court of First Instance January 13, 2012, RG 10/11950).

3.2 What are the ways to overcome an absolute grounds objection?

A response to the INPI or to the OHIM examiner may be presented trying to establish that the trade mark application complies with the trade mark legislation. In trade mark cancellation proceedings, any relevant arguments or evidence may be submitted by the defendant.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal against a decision from the INPI rejecting a trade mark application is available within one month, plus two months for residents abroad. The appeal may argue the wrong application of the law, as well as the wrong assessment of facts.

3.4 What is the route of appeal?

The Appeals Court, specialised in intellectual property, that has jurisdiction over the petitioner has exclusive jurisdiction. The Appeals Court decision may be appealed to the French Supreme Court, Cour de Cassation, based on the wrong application of the law.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Following European Union harmonisation, French law provides that a trade mark application shall be refused upon a third party’s opposition which claims prior trade mark rights. Also, third parties may seek the cancellation of a registered trade mark, based on prior trade mark rights as well as on other prior rights such as a company name, a trade name or sign board known in the entire French territory, a geographical indication, author’s rights, a natural person’s name, rights of the image and reputation of a territorial administration or to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organisations. CTMs are subject to similar conditions of validity.

4.2 Are there ways to overcome a relative grounds objection?

In opposition proceedings, the trade mark applicant may respond to an opposition from a third party, within the deadline set by the INPI, and file any relevant evidence. In proceedings before the Court, the defendant may also argue the relative grounds objection. In any case, parties may reach a settlement or sign a coexistence agreement.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Exactly the same as mentioned in question 3.3.

4.4 What is the route of appeal?

Exactly the same as mentioned in question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

An opposition may be filed only based on prior trade mark rights.

5.2 Who can oppose the registration of a French trade mark?

The owner of a prior trade mark or the beneficiary of an exclusive right of exploitation, unless otherwise stipulated in the contract, may oppose the registration of a trade mark within two months from the publication of the French trade mark application.

5.3 What is the procedure for opposition?

According to the IPC, opposition to the registration of a French trade mark shall be submitted in writing in the manner stipulated by regulations. Unless proceedings are suspended, an opposition is deemed to be rejected if no decision is taken within six months. The opposition shall specify: the identity of the opponent, together with the particulars suitable to establish the existence, nature, origin and scope of his rights; the references of the application for registration against which the opposition is entered, together with a statement of the goods or services concerned by the opposition; the statement of the grounds on which the opposition rests; proof of payment of the prescribed fee; and, where appropriate, the powers of the representative. The opposition shall be notified without delay to the holder of the application for registration. The latter shall be afforded a period of time that shall be no less than two months to submit counter observations and, where appropriate, appoint a representative. Failing counter observations or, where appropriate, the regular appointment of a representative within the prescribed time limit, a decision shall be taken on the opposition. If such is not the case, a draft decision shall be drawn up on the basis of the opposition and the counter observations. The draft shall be notified to the parties and they shall be given a period of time in which to contest, if necessary, the well-foundedness of the proposal. If not contested, such draft shall constitute a decision. If such is not the case, a decision shall be taken on the opposition based on the most recent observations and, if one of the parties so requests, after the parties have been permitted to submit oral observations. CTM applications can be opposed before the OHIM according to CTM regulations.

6 Registration

6.1 What happens when a trade mark is granted registration?

A certificate is automatically sent and there is a publication of the registration of the trade mark. Such publication ends registration proceedings.

6.2 From which date following application do an applicant's trade mark rights commence?

The effects of registration shall begin on the filing date of the application. However, acts preceding publication of the application for registration of a mark may not be held to infringe rights deriving from that mark. However, acts subsequent to notification to the alleged infringer of a copy of the application for registration may be ascertained and prosecuted.

6.3 What is the term of a trade mark?

The term is ten years from the application, which may be indefinitely renewed.

6.4 How is a trade mark renewed?

French trade mark registrations may be renewed for additional periods of ten years by the declaration of the owner of the mark to the INPI filed six months before the expiry date. Currently, the renewal fee is EUR 240 for up to three classes and EUR 40 for each additional class. A renewal is still possible within six months after the expiry date. In such case, an extra EUR 120 fee is due. In any case, professional fees, which may vary, may be added to the above mentioned fees.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes. Furthermore, any transfer of a registered mark shall only have effect against others if entered in the National Register of Marks. However, an unregistered transfer may have effect against third parties who knew of the transfer. An excerpt from the assignment or a confirmation of it may be accepted by the INPI.

7.2 Are there different types of assignment?

The rights under a French trade mark may be transferred in whole or in part, independently of the company that exploits them or has them exploited. Assignment, even where in part, may not comprise territorial limitation.

7.3 Can an individual register the licensing of a trade mark?

Yes. Furthermore any licence of a registered French trade mark shall only have effect against others if entered in the National Register of Marks. However, an unregistered licence may have effect against third parties who knew of the transfer. An excerpt from the assignment or a confirmation of it may be accepted by the INPI.

7.4 Are there different types of licence?

All types of licence (exclusive, non-exclusive, cross-licences, franchises, etc.) are possible following the civil law principle of freedom to contract.

7.5 Can a trade mark licensee sue for infringement?

The exclusive licensee may institute infringement proceedings, unless otherwise laid down in the contract, if, after formal notice, the owner does not exercise such right. In any case, a licensee may intervene in trade mark infringement proceedings initiated by the owner of the trade mark.

7.6 Are quality control clauses necessary in a licence?

Under French law, trade mark licence contracts without quality control clauses may be valid. The existence of licence contracts without quality control clauses has no incidence regarding the validity of French trade marks.

7.7 Can an individual register a security interest under a trade mark?

A security interest under a trade mark may be registered at the INPI by filing a form and recording the security (contract or legal order).

7.8 Are there different types of security interest?

French law provides, regarding French trade marks, the possibility of contractual securities between willing parties or legal securities available to creditors under general civil law proceedings.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

Trade marks that have become the common name in trade for a product or service or that are liable to mislead, particularly as regards the nature, quality or geographical origin of the product or service, may be revoked. Also, a trade mark may be cancelled following continuous non-use for five years.

8.2 What is the procedure for revocation of a trade mark?

For French and international trade marks which designate France, the procedure is initiated throughout a complaint delivered to the trade mark owner and filed at the competent civil court specialised in trade marks. Both the plaintiff and the defendant are able to file arguments before the Court who decides after the final oral pleadings, which follow written proceedings. CTMs may be subject to revocation counterclaims in proceedings pending before the Paris Court of First Instance.

8.3 Who can commence revocation proceedings?

Any interested party (i.e. a competitor) may file revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

It depends on the cause of action. A defence against a revocation action based on the fact that the trade mark has become a common name or misleading may lead to a defence arguing against the evidence or arguments filed by the plaintiff, or arguing the wrong understanding of the law. A defence against a cancellation action

for non-use may lead to arguing against the documents filed by the plaintiff, arguing the wrong understanding of the law, or claiming that the trade mark has been used and/or that there have been legitimate reasons for the non-use.

8.5 What is the route of appeal from a decision of revocation?

An appeal to the competent Appeals Court specialised in trade mark law may be filed. The Appeals Court ruling may be appealed to the Supreme Court for the incorrect application of the law.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The registration of a mark that does not comply with the relative and absolute grounds for refusal mentioned hereinabove may be declared null and void.

9.2 What is the procedure for invalidation of a trade mark?

The procedure is initiated through a complaint delivered to the trade mark owner and, for French trade marks, filed at the competent civil court specialised in trade marks. Both the plaintiff and the defendant are able to file arguments before the Court who decides after the final oral pleadings, which follow written proceedings.

9.3 Who can commence invalidation proceedings?

Any interested party (i.e. a competitor) and the public prosecutor may file a cancellation action based on absolute grounds for refusal. Only owners of prior rights may initiate invalidity proceedings based on relative grounds.

9.4 What grounds of defence can be raised to an invalidation action?

It depends on the cause of action. A defence against prior rights may involve both arguing the existence of prior rights and the lack of likelihood of confusion or of damage. A defence against a claim based on absolute grounds for refusal may lead to arguing against the documents filed by the plaintiff or arguing the wrong understanding of the law. Regarding relative grounds, acquiescence to the challenged trade mark may be opposed to the plaintiff who knew for a period of over five years of the use of a registered junior trade mark.

9.5 What is the route of appeal from a decision of invalidity?

An appeal to the competent Appeals Court specialised in trade mark law may be filed. The Appeals Court ruling may be appealed to the Supreme Court for the incorrect application of the law.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Any actions based on French trade marks, as well as any actions involving both a matter of trade mark law and unfair competition,

are judged by one of the nine First Instance Courts specialised in intellectual property. CTM infringements actions are of the exclusive jurisdiction of the Paris First Instance Court.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Infringement actions are initiated following a complaint to the defendant that is filed before the competent Court. Prior to the complaint, the plaintiff may request a seizure order from the president of the court to collect evidence at private premises. Once the case is filed at the Court, case management proceedings start, during which parties may ask the judge to order the communication of relevant pieces of evidence as well as any provisional measures (injunction, provisional compensation, etc.). Both the plaintiff and the defendant are able to file written arguments before the Court that decides after the final oral pleadings, which follow the case management proceedings. In Paris, infringement proceedings may take from 9 to 18 months.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions may be granted prior to trials on the merits or during pre-trial proceedings, should plaintiffs establish that the infringement is plausible. An *ex parte* injunction may be delivered within a couple of hours after the petition. Successful plaintiffs on the merits are very commonly granted injunctive relief. Under French practice, injunctive relief is granted under penalties per day of delay or per infringement to the injunction with the benefit of immediate execution (there is no suspension of the injunction even if under appeal).

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Upon a court order during case management proceedings, a party may be compelled to provide the disclosure of relevant documents. During pre-trial proceedings, the judge in charge of the management of the case will assess whether it is legitimate to grant an order to disclose documents considering the nature of the case and whether the opposition to disclose documents is legitimate. An order to disclose information/documents may also be found in court rulings on the merits, should the Court consider that the communication of additional documents is needed to judge the case completely.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In regular civil proceedings, while each party's attorney will present the case orally showing relevant pieces of evidence, the Court is only bound by written submissions correctly presented during the pre-trial proceedings. Testimonies are usually written and witnesses are heard very rarely. Preliminary injunction proceedings, like criminal law proceedings, are, as a matter of principle, oral; nonetheless, written submissions will be carefully considered by judges. During pre-trial proceedings, the parties exchange at least two times their written submissions, replying each time to the opponent's former submissions. This exchange of

submissions in reply offers the opportunity to develop the argumentation further according to the opponent's arguments. It is possible to add new means of defence or to abandon arguments that have been mentioned previously. However, once the pre-trial proceedings are closed, no new arguments or exhibits can be exchanged. Indeed, the Judge is bound by the last submissions filed before the closing of the pre-trial proceedings. Oral pleadings should only back-up the written submissions.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Courts may stay on the proceedings for good administration of justice (i.e. other proceedings pending, a referral to the ECJ, etc.) and must stay on the proceedings when the trade mark is not registered yet. Usually, a request to stay on the proceedings is filed by one of the parties.

10.7 After what period is a claim for trade mark infringement time-barred?

A claim is time-barred after three years.

10.8 Are there criminal liabilities for trade mark infringement?

Trade mark infringement may constitute a criminal offence that may result in sanctions, such as prison, fines, destruction and publication orders.

10.9 If so, who can pursue a criminal prosecution?

Criminal law proceedings may be initiated by either the victim or by the prosecutor.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Illegitimate threats of trade mark infringement may lead to an action under tort law.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defendants in trade mark infringement proceedings may invoke various arguments such as lack of use as a trade mark (for instance, the use of a word in its common sense), lack of use in the course of trade, as well as lack of likelihood of confusion considering the signs, the goods and the relevant market.

11.2 What grounds of defence can be raised in addition to non-infringement?

Following the five-year known use of a junior trade mark, acquiescence may be invoked. Also, a defendant in a trade mark infringement action may file a cancellation/revocation counterclaim in the same proceedings.

12 Relief

12.1 What remedies are available for trade mark infringement?

Most of the time, a ruling that finds there has been a trade mark infringement contains an immediate injunction not to continue the counterfeiting, even though an appeal is lodged. In some cases, the benefit of immediate execution is also available regarding damages. It is more rarely allocated for the publication of the order. A lump sum is generally awarded as a monetary compensation to cover both moral and economic loss. Sometimes, the court appoints an expert to assess the damages due to the victim. An order to recall infringing goods, with the benefit of immediate execution, may also be granted. The cancellation of junior rights and an injunction to change the name at the companies registry may also be granted.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Most of the time, the losing party must pay a lump sum corresponding to attorney fees. The losing party will also have to pay legal costs that correspond to court stamps to file the claims, bailiff fees and to fees billed by experts appointed by the court. According to the current practice, the Paris Court increasingly grants orders to pay the costs that are very close to the actual expense.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal may be filed within the shortest of the following deadlines (i) one month from the notification of the decision, or (ii) two years from the date of the decision. A two-month extension to the one-month deadline is granted to parties located outside France. After a formal appeal, the appellant must present its motives within three months. In practice, most appeals cover the right to contest all aspects of the judgment. Once the appeal is filed, the non-appealing party may also contest the first instance ruling within the appeal proceedings. The appeals court decision may also be appealed to the Supreme Court, which may only judge on the wrong application of the law.

13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be added at the appeal stage, as well as claims that are directed towards the same purposes as those submitted before the lower judge, even where the legal ground is different.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

EU Regulations n°1383/2003 and n°1891/2004 have harmonised and set the conditions for seizures by customs authorities of infringing goods entering in the EU. Customs agents may act upon the trade mark owner's request or during a customs control (in

which case, the trade mark owner has 3 business days from the notification to present a request). Once goods are seized, the trade mark owner must introduce proceedings to seek whether intellectual property rights are infringed within 10 business days. Then, regular proceedings will follow. French trade mark law and French customs law also contains provisions to prevent trade mark infringement. In any case, these measures apply to similar and identical signs and to similar and identical goods.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in France?

Trade mark rights are acquired in France through registration. However, unfair competition law may protect the owners of trade names and sign boards within the scope of the territory where they are known. Also, famous and good repute trade marks may be protected beyond a trade mark registration.

15.2 To what extent does a company name offer protection from use by a third party?

Company names are also protected by unfair competition law.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Authors' rights may protect titles of any work such as books or films. Design law may protect sign boards, the shape of goods or their packaging.

16 Domain Names

16.1 Who can own a domain name?

Any person can own a domain name.

16.2 How is a domain name registered?

Domain names are registered at accredited registrars.

16.3 What protection does a domain name afford *per se*?

Under French law and practice, domain names may be protected under unfair competition law that provides that any act which causes damage to another person obliges the one by whose fault it occurred to compensate it.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

There has been an important referral from the ECJ regarding the use of the headings of the Nice classification in descriptions of goods and services.

17.2 Are there any significant developments expected in the next year?

There are a couple of referrals pending before the ECJ regarding the type of trade mark use required to counter a trade mark cancellation action for non-use.

17.3 Are there any general practice or enforcement trends that have become apparent in France over the last year or so?

The defence of lack of use of a trade mark is becoming quite frequent. Many infringement actions based on the use of key words by competitors have been dismissed.



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Cabinet Armengaud & Guerlain, founded in 1993, is fully specialised in intellectual property (patents, trademarks, designs and models, and copyright) and the related issues of unfair competition, consumer law, advertising rights (particularly comparative advertising) and the Internet. Reflecting its well-recognised expertise, the firm has worked with a wide variety of French and international clients, from artists and inventors to blue-chip companies, governments and state-owned enterprises.

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