

## **New trademark law reform in France**

We wish to inform you of a modification of the French intellectual property code with a significant impact on French trademark prosecution and litigation.

This modification results from the transposition into French Law of the European Directive (EU) No. 2015/2436 of 16 December 2015 relating to trademarks. It is made by the French order (“ordonnance”) no. 2012-1169 of 13 November 2019 and the decree implementing it (Decree no 2019- 1316 of 9 December 2019).

This order came into force on 11 December 2019, except for the provisions relating to the administrative procedure for revocation and invalidity that will enter into force on 1 April 2020.

This order aims at modernizing, simplifying and improving the effectiveness of trademark protection systems.

You will find below a summary of its main provisions:

### **1. MODIFICATION OF THE REGISTRATION PROCESS**

- **Amendment of the graphic representation requirement**

The order allows new types of signs that are neither verbal nor figurative, such as sound, multimedia or so-called movement marks, to be registered as trademarks provided that their representation is clear, easily accessible and durable.

- **Extension of prior rights in support of an opposition and amendment to the opposition proceedings**

The list of prior rights that can be invoked in support of an opposition to a trademark has been extended.

In addition, there are two significant amendments to the opposition proceedings:

- It will be possible to file an opposition based on several prior rights, which can be of different nature (such as trademark, domain names, company names) as long as these different rights are held by the same person.

- The filing of the notice and the grounds of the opposition may now be filed separately. The grounds on the merits of the opposition can be filed one month after the filing of the notice of opposition.

- **Expansion of the grounds for refusal of a trademark application**

The reform extends the grounds for refusing a trademark application. From now on, geographical indications, designations of origin and trademarks consisting of the denomination of an earlier plant variety could also be considered as prior rights that could be opposed to the registration of a later trademark application.

- **Amendment of the filing costs of a trademark**

New taxes have been implemented:

	<i>Previous tax</i>		<i>New tax</i>	
<b>Application</b>	1 class	<b>210 €</b>	1 class	<b>190 €</b>
	2 classes	<b>210 €</b>	2 classes	<b>230 €</b>
	3 classes	<b>210 €</b>	3 classes	<b>270 €</b>
	extra class	<b>42 €</b>	extra class	<b>40 €</b>
<b>Renewal</b>	1 class	<b>250 €</b>	1 class	<b>290 €</b>
	2 classes	<b>250 €</b>	2 classes	<b>330 €</b>
	3 classes	<b>250 €</b>	3 classes	<b>370 €</b>
	extra class	<b>42 €</b>	extra class	<b>40 €</b>
<b>Opposition</b>		<b>325 €</b>	1 prior right	<b>400 €</b>
			Per extra right	<b>150 €</b>

## 2. NEW JURISDICTION OF THE FRENCH PTO FOR REVOCATION AND INVALIDITY CLAIMS

As of 1 April 2020, the French PTO (INPI) will share jurisdiction with the French courts for revocation and invalidity claims against trademark rights:

- The French PTO will have exclusive jurisdiction to rule on cancellation and revocation claims. Regarding cancellation claims, the French PTO will have exclusive jurisdiction for all claims based on (i) absolute grounds and (ii) relative grounds based on the following prior rights: prior trademark, company name, name of a public entity, appellations of origin, indications of origin.
- The French courts will have exclusive jurisdiction for (i) cancellation actions based on copyright, designs and personality rights, (ii) counterclaims based on revocation actions for non-use or cancellation whatever the prior right invoked, (iii) revocation or cancellation claims raised in addition to any other action for which the courts have jurisdiction such as infringement, unfair competition or contractual liability proceedings, or (iv) where interim measures have been ordered to stop an infringement or to collect evidence prior to a trial.

We remain available if you need any further information or legal advice regarding these new provisions.

***For any questions related to the content of this document, you can contact:***



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