
France: Administrative Invalidation and Revocation Actions Now Available

By Tommas Balducci

As discussed in our February 2020 [article](#), a new French trademark law was passed in November 2019 to meet the requirements of EU Directive 2015/2436 and streamline European trademark practice. While the majority of the changes were implemented on December 16, [More](#)

By Tommas Balducci

As discussed in our February 2020 [article](#), a new French trademark law was passed in November 2019 to meet the requirements of EU Directive 2015/2436 and streamline European trademark practice. While the majority of the changes were implemented on December 16, 2019, the procedural changes concerning invalidity and revocation actions, including the transfer of jurisdiction over such actions from the local courts to the French Trademark Office (the “INPI”), entered into force on April 1, 2020.

Jurisdiction

Shifting invalidity and revocations actions from court-based litigations to administrative proceedings was intended to make it easier, more affordable, and more time-efficient for interested parties to bring such actions. In the case of revocation actions, the shift was also intended to promote the clearing of deadwood from the French Trademark Register.

Under the new trademark law, the INPI now holds exclusive jurisdiction over petitions for trademark revocations and invalidations in the following instances, as long as no other legal issue or claim is also raised:

- Revocation petitions under any basis, namely where:
 - a registered mark has not been used within an uninterrupted period of five years after registration;

- due to the actions or inactions of its owner, a registered mark has become the common name for a good or service within its respective trade; or
- due to the actions or inactions of its owner, the mark has become liable to mislead the public in regard to the nature, quality, or geographic origin of the covered goods or services.
- Invalidity petitions based on:
 - any absolute ground; or
 - the relative grounds of a prior trademark right, corporate name, appellation of origin or geographical indication, or name of a local authority or public entity.

However, the French courts of first instance retain exclusive jurisdiction in the following instances:

- where a petition or counterclaim seeking invalidation or revocation (based on any grounds) is made as part of another action falling within the court's jurisdiction (e.g., infringement or unfair competition actions); or
- where a petition for invalidation is brought as a principal or sole claim based on one of the following relative grounds:
 - ownership of a prior copyright,
 - ownership of a prior design, or
 - ownership of personality rights.

In order to avoid the potential manipulation of these procedures, the new trademark law establishes that the principle of *res judicata*, also known as claim preclusion, will apply to invalidation and revocation decisions issued by either the INPI or a French court.

Standing

Another potential benefit to petitioners in these administrative invalidation and revocation actions is the relaxed standing requirements. Under the new law, a petition for invalidation or revocation before the INPI can be filed by any third party. Unlike a plaintiff before the French courts, the petitioner need not demonstrate a legal interest in or harm caused by the registration against which the action is filed.

Administrative Procedure

The administrative actions for invalidation and revocation before the INPI created by the new law are structured in the following way:

- Pre-Examination Phase (1 Month):
 - The petition for invalidation or revocation is filed with the INPI.
 - Within one month of filing, the owner of the contested trademark registration (“Registrant”) must be identified and notified of the filed action.
- Examination Phase (2-6 Months):
 - The Registrant then has two months from the date they are notified of the action to respond to the allegations in the petition and provide evidence in support of their position.
 - In turn, the Petitioner then has one month to file a response on the merits and/or to provide evidence in support of the petition.
 - The parties may engage in up to two more exchanges of written arguments and supporting evidence. In each instance, the parties have a period of one month each to do so.
 - After the final exchange between the parties, and where appropriate, either the Registrant, Petitioner, or the INPI may request an oral hearing.
- Decision Phase (3 Months):
 - The INPI has a maximum of three months from the conclusion of the Examination Phase to issue a decision.

During the proceedings, and no more than twice, the parties may submit a joint request for a four-month suspension. The proceedings can also be suspended at the discretion of the INPI in cases where a decision in a related administrative or court proceeding is pending.

As described above, administrative actions for invalidation and revocation generally should last nine months, or seventeen months at most if the parties jointly request the maximum of two four-month suspension periods. These new procedures are therefore considerably quicker than the average time-frame for such actions before the French courts, and introduce a welcome change for those seeking to register trademarks in France.

