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Protection by French Trademark Law

by

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The function of the trademark is to distinguish the origin of the goods or services of one party from those of others. The owner of the trademark has a right exclusive to use the mark to commercialize the goods or services designated in the registration of the mark.

A. What may be protected as a trademark?

To be protected the mark has to fulfill a number of requirements.

➤ Graphic representation:

Any sign subject to graphic representation may be registered as a mark. Are included:

- Nominative marks including first name, last name, character's names, pseudonyms, geographic names, slogans, letters, numbers...
- Figurative marks including drawings, signatures, pictures, labels, shapes of products, combination of colors...
- Semi-figurative marks encompass nominative and figurative elements

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- Aural signs including sounds (which can be represented on a sheet music) ...
- Distinguishable in respect of the goods and services designated in the registration:

The consumers with a normal attention should be able to distinguish the goods and services of the owner of the mark from the goods and services of the competitors. For this purpose, the mark has to be distinctive.

Pursuant to the French law, the following marks are not distinctive:

- Trademarks which consist exclusively of essential, generic, or usual denomination of the goods or services
- Trademarks which designate the feature of the goods or services, including the type, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or services
- Trademarks which consist exclusively of the shape which results from the nature or the function of the goods

This requirement tends to protect fair competition preventing a trader from getting the exclusive right to use words essential to trade.

For example, the word "car" cannot be registered to mark a "car". However the same word can be registered to designate a computer. In this case, the word is not use for it common meaning.

However the sign doesn't need to be original and can be merely evocative of the goods and services concerned. Thus marks weakly distinctive may be registered.

- Available:

The mark shall not infringe prior rights. The French law provides an unlimited list of prior rights:

- Prior registered mark or well-known mark;

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- b) Name of a company, when there is a likelihood of confusion on the part of the public;
- c) Trade names or sign of a store, known on the territory, when there is a likelihood of confusion on the part of the public;
- d) A protected appellation of origin;
- e) A copyright;
- f) A registered design;
- g) Personality rights as lastnames, pseudonyms;
- h) Name, reputation of a regional authority.

➤ Lawful:

Deceptive marks, official emblems or marks which are contrary to public policy or to morality.

B. How to establish trademark right?

- 1) Registration in the French intellectual property office, the "Institut National de la Propriété Industrielle » (INPI)

To be protected, the mark has to be registered in the French intellectual property office, the "Institut National de la Propriété Industrielle » (INPI).

Registration of a French mark takes minimum 5 months.

- 2) Registration process

The "Institut National de la Propriété Industrielle » (INPI) does not conduct a search for conflicting marks. However, the owner of a prior right can file an opposition with the "Institut National de la Propriété Industrielle" (INPI) to prevent the registration of the mark within 2 months from the publication of the trademark application. Furthermore, a registered mark can be invalidated by a judge.

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For this reason it is well recommended to conduct a search for conflicting marks prior to apply with the "Institut National de la Propriété Industrielle » (INPI).

3) Fees*

Application fees are 225 € for a paper filing, 200 € for an e-filing, to designate goods and/or services included in 1, 2 or 3 defined classes of goods or services. Up to 3 classes of goods or services, an additional fee of 40 € is due for each class of goods or services.

The applicant has to fill up the trademark application with the products and/or services that the applicant wants to identify with the trademark. The goods and services are listed in several classes according to an international classification called "Classification of Nice".

C. What are trademark rights?

- 1) The owner of the trademark has an exclusive right to use the trademark to identify the goods and services designated in the registration.
- 2) The protection can last indefinitely. The term of the trademark is 10 years with 10 years renewal terms.

However the protection can be withdrawn to an owner who doesn't make a serious use of his mark for a continuous period of 5 years.

Furthermore if, due to the acts or the inactivity of the owner, a trademark has become the common name in the trade for a good or a service in respect of which the mark is registered and thus the mark can no more distinguish the goods or services, the owner of the mark may lost the exclusive right to use the mark.

For this reason, the owner is advised to keep any evidence of his trademark's uses. At the same time it is recommended to conduct competitive intelligence to be aware of illegal uses of a trademark in order to stop them.

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- 3) The owner of a trademark can assign the rights in the trademark. The owner can also grant a license concerning the trademark.

D. Infringement

A person who infringes the rights of the owner in the trademark may be sued before a civil or a criminal court for infringement.

The civil liability of a counterfeit may be pursued for the following infringement:

- 1) Reproduction and use of the mark for goods or services identical to goods or services covered by the trademark, or for goods or services similar if there is a likelihood of confusion on the part of the public;
- 2) Imitation and use of the imitation for goods or services identical or similar, if there is a likelihood of confusion on the part of the public.

The infringement is also a crime and can be punished by a criminal court.

Protection of a trademark in a foreign country (Example of American trademark)

A. Why to extend the protection abroad?

1) Territorial protection

The trademark is protected only on the territory in which it has been registered. The owner of a French trademark, protected in France, cannot prevent a person from registering the trademark or using the trademark in other country to identify the same goods or services. Furthermore, if a person registers the same trademark in a foreign country, the first owner can't commercialize his goods or services in this foreign country without infringing the rights of the owner of the trademark in the foreign country.

For these reasons, the owner of a trademark has to protect his mark in all countries in which he wants to commercialize the goods or services identified by his mark.

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2) Priority date

Within 6 months from the filing date of a trademark application in a contracting party of the Paris Convention for the Protection of Industrial property or a contracting party of the World Trade Organization, the applicant can extend the protection of his trademark in a contracting party, claiming the priority of the first filing date (the "priority date").

From the priority date, the trademark cannot be registered by an other person than the recipient of the priority date.

The extension under priority date can be a national trademark application, a community trademark application or an international trademark application.

B. How to extend the protection abroad?

1) National trademark: example of an American trademark

An applicant may apply for trademark registration in the countries in which the protection is sought and he has to conform to the trademark law of these countries.

For example, under the American trademark law, the registration of the mark is not required to establish right in a mark. Trademark right arises from either actual use of the mark or, the filing of an application to register the mark in the United States Patent and Trademark Office (USPTO) stating that the applicant has a bona fide intention to use the mark in commerce.

However the registration of the mark in the United States Patent and Trademark Office (USPTO) provides several advantages. Among these advantages, the applicant is presumed to be the owner of the mark for the goods and services specified in the registration and to be entitled to use the mark in the United States. Moreover the registration of the trademark is necessary before an infringement lawsuit may be filed in court.

As for the registration process, the United States Patent and Trademark Office (USPTO) does a search for conflicting marks and the United States Patent and Trademark Office (USPTO) will deny the applicant

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the registration of a mark if there is a conflict with a prior mark. The applicants can conduct a search for conflicting marks before applying with the United States Patent and Trademark Office (USPTO) to determine if a conflicting mark is registered and to avoid committing money for an application.

The registration fee* is 375\$ for each class of goods or services to file a paper form application and from 275\$ to 325\$ to file online. It takes minimum 1 year to have a registered mark.

The mark is registered for 10 years and can be renewed indefinitely every 10 years. However the owners have to proof periodically that they continue to use the mark on or in connection with the goods and services in the registration to keep their marks enforceable.

2) Community trademark

The Community trademark provides a protection in all the countries of the European Union based on a single application with the Office of the Harmonization for the Internal Market (OHMI), the trademark and designs registration office for the European Union in Alicante, Spain.

An agent is mandatory to file an application when the applicant is not established in a country party of the European Union.

The procedure for the registration of the Community trademark takes about 12-18 months if an opposition to the registration isn't filed by a third party.

The application fee* is 750 Euros to file online or 900 Euros to file a paper form. If the application covers more than three classes of goods and services there is a fee of 150 Euros for each additional class.

The registration fee* is 850 Euros. If the application covers more than three classes of goods and services there is a fee of 150 Euros for each additional class.

The Community trademark is valid 10 years from the filing date of the application and it can be indefinitely renewed for further periods of 10 years.

3) International trademark

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A trademark owner can have his trademark protected in any country members of the Madrid System by simply filing one application with his own national trademark or regional trademark office, members of the Madrid System. The Madrid System for the international registration of marks is administered by the International Bureau of the World Intellectual Property Organization (WIPO) located in Geneva, Switzerland.

➤ The applicant

The Madrid system of international registration can be used by a person or legal entity which has the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union.

For example, any trademark owner with a French trademark application or a registration and who is a national of, has a domicile in, or has a real and effective commercial or industrial establishment in France, can submit an international trademark application through the "Institut National de la Propriété Industrielle » (INPI), the French trademark office. The applicant can designate in the registration any country members of the Madrid System including the United-States.

Any trademark owner with an trademark application filed in or a registration issued by the United States Patent and Trademark Office (USPTO) and who is national of, has a domicile in, or has a real and effective commercial or industrial establishment in the Unites States can submit an international trademark application through the United States Patent and Trademark Office (USPTO). The applicant can designate in the registration any country members of the Madrid System including the France.

➤ The registration process

An applicant has to file an international trademark application with his national or regional trademark office (including the Office of the Harmonization for the Internal Market (OHMI) when the applicant has a Community trademark). The national or regional office examines the application and presents it to the International Bureau of the World Intellectual Property Organization (WIPO).

Then the mark is recorded and published. The International Bureau notifies to each contracting country in which protection has been requested. Each trademark office of the designated contracting party

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examines the international registration in exactly the same way as an application filed directly in the country concerned. An international trademark registration is therefore equivalent to a bundle of national registrations.

➤ Fees*

International application fees include :

- Basic fee : 653 Swiss francs ** for representation of the mark in black and white, 903 Swiss francs for a representation in color;
- Complementary fees for the designation of the countries: 100 Swiss francs for each designated contracting country (including France), except if the designated contracting party is a contracting party in respect of which an individual fee is payable, fixed by each country concerned (including the United-States or the European Community).
- Supplementary fee: 100 Swiss francs for each class of goods and services beyond three classes, except if only contracting parties in respect of which individual fees are payable , fixed by each country concerned, are designated (including the United-States or the European Community).

Then a fee is paid to the national office of each contracting party designated (fee due to the INPI is 60 Euros, fee due to the USPTO is 100 Dollars or 150 Dollars for each class).

** On May 2009: 150 Swiss francs are around 100 Euros

4) Advantages of the Community and International trademarks systems

- A single and simplified procedure
- A price-cut compared to fees that an applicant has to commit to file an application in each country in which he wants to protect his trademark.

**The fees as indicated are the fees in force on April 1, 2009. The fees may not include additional fees related to the registration of the trademark and the fees for the renewal of the trademark. The fees don't include the fees of a patent agent or patent attorney also.*

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