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# The Legal 500 Country Comparative Guides

## France

# INTELLECTUAL PROPERTY

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in France.

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# FRANCE

## INTELLECTUAL PROPERTY



**1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

**(a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);**

A technical invention may be protected by a patent, subject to due filing and compliance with patentability requirements. Said requirements are novelty, inventive step and industrial application.

Patent applications can be filed at a French, European or international level. The *Institut National de la Propriété Industrielle* (INPI) is the competent Patent Office for the filing of French patents, while European patents may be filed at the European Patent Office (EPO). The patent grant procedure includes a search report of the patentability requirements. Since July 1<sup>st</sup>, 2020, it is possible to file a “provisional patent application” before INPI - this allows for a swift, low-cost filing for the purpose of recording a priority date which will be taken into account if, within the following 12 months, the applicant complies with the requirements for a standard patent application.

The unitary patent system, which is scheduled to start in

the second semester of 2022, will allow the protection of an invention across up to twenty-five EU Member States by filing a single application before the EPO.

Another source of legal protection for inventions is utility certificates, which are less expensive and do not require a search report in order to be granted.

Certain products requiring a marketing authorization (MA), such as human or veterinary medicines or plant protection products, may be protected by a supplementary protection certificate (SPC). Such protection extends the duration of protection of a patent having an effect in France, to compensate the long period than is often required to obtain a MA.

Specific provisions protect trade secrets since the implementation into French law in 2018 of the European Union Trade Secrets Directive of 8 June 2016. Confidential information and/or know-how may also be protected via contract law and tort law.

**(b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);**

Trademark and collective/certification mark applications can be filed at a French, European or international level. French trademarks may be filed at the INPI, while European Union (EU) trademarks may be filed at the European Union Intellectual Property Office (EUIPO).

Rights may be acquired on trade names and store signs by virtue of public use.

Rights may be acquired on company names also by virtue of public use following their registration at the Trade and Companies Register.

Geographical indications, including protected designations of origin (PDO), protected geographical indications (PGI) and traditional speciality guaranteed (TSG) can also be protected.

Tort law can also be a cause of action to protect brands. In particular, unfair competition prohibits misleading practices and behaviour generating confusion regarding the origin of goods and services. Parasitism, a particular form of unfair competition, is the action of taking advantage of a third party's economic value stemming from their investments and is also prohibited by tort law.

Contract law, in particular the provisions dealing with good faith, can be a tool to protect brands. Parties to a contract can also stipulate specific clauses regarding the protection of brands.

In addition, brands can be protected by consumer law provisions prohibiting consumer deception.

**(c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

Creations, technology and proprietary interests can be protected by:

- Copyright law, which protects creations that qualify as original works.
- Neighbouring rights (to copyright) which target specific holders such as performers, audio and video producers, database producers and press publishers.
- Design rights, which protect designs that are new and have an individual character. Design applications can be filed at a French, European (they are then named "Community designs") or international level.
- Plant variety rights, which protect new varieties and species.
- Semiconductor topography rights, which protect semiconductors that are the result of their creator's own intellectual effort and are not common.
- Tort law, and especially unfair competition and parasitism.
- Contract law (good faith provisions) as well as contractual terms.
- Consumer law provisions, which prohibit consumer deception.

**2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?**

Patents: A patent can be protected for a maximal period

of twenty years as of the filing date, provided annuities are paid. The mechanism of priority rights, as well as the combination of French and European patents, can result in an almost one-year extension of the patent term.

Utility certificates: A utility certificate creates a protection for a maximal period of ten years as of the filing date, provided annuities are paid. A utility certificate can be transformed into a patent (and thus acquire the duration of protection of a patent) within a period of eighteen months from the filing or from the priority date, and in any event before the publication of its application.

Supplementary protection certificates (SPC): SPCs serve as an extension to a patent right and can extend a patent right for the shortest period between either five years from the date of the patent's expiration or fifteen years from the first marketing authorisation.

Trade secrets: There is no legal term of protection for trade secrets, which remain protected so long as the information remains secret. In practice however, contractual provisions often provide for a five-year protection.

Trademarks, collective marks, and certification marks are protected in France (and in the EU) for a ten-year period as of their filing date. Registration can be indefinitely renewed. However, the trademark owner should bear in mind that following the "grace period" of five years after registration, he is subject to a use obligation. French and EU law provide that if a trademark is not used for a continuous period of five years, that trademark can be revoked.

Designations of origin, geographical indications and traditional speciality guaranteed are granted for an indefinite term so long as the product or service for which these protections are granted fulfil the conditions of protection.

Copyright protection distinguishes between economic rights and moral rights: the former are protected for seventy-years following the author's death or the first publication (depending on the classification of the work) while the latter are perpetual. Neighbouring rights generate different periods of protection ranging between two to fifty years.

Design rights create a five-year protection from the filing date, which can be extended up to a maximum of twenty-five-years. A protection also exists for unregistered Community designs which are protected for a three-year period from the date on which the design was made available to the public within the EU territory.

Plant varieties can be protected for a twenty-five-year term except forest, fruit or ornamental trees, wine grapes, grass and perennial legumes fodders, potatoes, and endogamous lines used for the production of hybrid varieties which can be protected for thirty years.

A domain name is protected for a one-year term which can be extended indefinitely.

Trade names, store signs and company names are not subject to a legal term of protection.

Owners of the above-mentioned rights are generally subject to a five-year statute of limitation to raise claims on these grounds. The same five-year statute of limitation applies in French law to contractual and unfair competition claims.

### **3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?**

Patents, utility certificates: The principle is that the inventor of the invention protected by a patent right is the first owner. However, an exception is made in favour of the employer when the invention is created during the inventor's employment if the inventor was commissioned by his/her employer or was paid a fair price.

SPCs: The principle is that the first applicant is the first owner.

Trade secrets: The holder of the secret information may claim trade secret protection.

Trademarks, collective marks, certification marks, designations of origin, geographical indications, traditional speciality guaranteed, designer rights, semiconductor topography rights, and domain names: The applicant is the first owner.

Copyright and related rights: The principle is that the author of the work is the first owner. By derogation from this principle, a company may be vested *ab initio* in the copyright over a work qualifying as a "collective work". A special regime applies to software, under which the copyright can be held by the author's employer provided the software was created in the course of his/her employment.

Plant varieties: The first owner is the plant's breeder. Here again, a special rule applies to plant varieties created in the course of employment under commission, according to which the employer is the owner.

Unfair competition / parasitism: Anyone who justifies of an interest is entitled to act on these grounds.

### **4. Which of the intellectual property rights described above are registered rights?**

Patents, utility certificates, SPCs, trademarks, collective marks, certification marks, registered design rights, semiconductor topography rights, plant varieties, geographical indications, designations of origin, traditional speciality guaranteed, domain names and corporate names are registered rights.

### **5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?**

Patents: A patent application may be filed either by the inventor, the employer who owns the rights to an invention, or his/her agent. Either way, the application shall be filed: (i) before the INPI for French patents, (ii) before the EPO for European patents and (iii) before the World Intellectual Property Organisation (WIPO) for international patents (designating France). It is worth noting that by filing one international patent application before WIPO, applicants can simultaneously seek protection in multiple countries, including France.

An invention created in France and which may be of interest to national defence must be filed in France first, so that the DGA (France's defence procurement agency) can assess where the invention needs to be kept secret.

The competent filing office publishes the patent application and examines it in order to assess patentability and initiate a search report on prior disclosures. The search report is public and third parties can file observations against the patentability or oppose the granting of the patent. International patents can be opposed at the national level of a State designated in the application. Once granted, the patent is published.

Utility certificates: The procedure for registration of utility certificates is different from the one pertaining to patents in that (i) no search report is initiated and (ii) no one is entitled to oppose the granting of a utility certificate. However, the phases of both procedures are similar in that the procedure for registration of utility certificates involves the following four steps: a verification of the request's regularity, an examination by the DGA, a publication of the request (18 months after the request) and the publication of the granting of a utility certificate.

It should be noted it is possible to convert a utility

certificate application into a patent application, and vice versa.

SPCs: The following requirements must be met in order to obtain an SPC under French law: (i) the product subject of the SPC request must be patent-protected and must have obtained a marketing authorisation (MA) which should necessarily be the first MA obtained for this product; and (ii) the product subject of the SPC request must not already have been the subject of an SPC.

Provided these requirements are met, the patent owner has six months starting from the date of delivery of the MA or the date of the grant of the patent (if the MA is granted before the grant of a patent) to submit an SPC request.

This request should include *inter alia* a copy of the first MA. Duly filed applications are published in the Official Bulletin of Industrial Property (BOPI). Regular requests from an administrative and technical standpoint are then examined and, unless withdrawn, the SPC is delivered and published.

Trademarks, collective marks and certification marks: A trademark can be filed by any legal or natural person or by an agent before the appropriate office, i.e. INPI for French trademarks, EUIPO for European trademarks and WIPO for international trademarks (designating France). Regardless of the trademark office, the wording of the specification designating the applied-for goods and/or services must be based on the International Classification of Goods and Services known as the "Nice Classification".

The office assesses absolute grounds for refusal such as distinctiveness, deceptiveness, and compliance with public order and, accordingly, can issue a notification refusing the registration or requesting amendments to the application. The French and European trademarks are then published so as to allow third parties to file observations or oppose the registration. International applications can be opposed at the national level of a Member State designated in the application. At the end of this process, the successfully registered trademarks are published in the BOPI.

Design rights: A design right can be filed by any natural or legal person who owns the design, or by an agent before the appropriate office, i.e. INPI for French designs EUIPO for Community designs and WIPO for international designs (designating France). Regardless of the trademark office, the wording used when designating the product in a design application must be determined by the international classification system for industrial designs known as the "Locarno Classification".

The application must also contain reproductions allowing the public to properly perceive the design (drawing or photography), and more specifically the features for which protection is sought.

The application is published in the BOPI and examined by the relevant office. Once granted, the design right is published by the office which examined the application.

Semiconductor topography rights: The owner or an agent can apply for registration and must do so within two years of the first commercial exploitation or not exceeding fifteen years after its fixation or coding if the topography has never been exploited. In the two months preceding the expiration of the ten-year term of protection, the applicant may request either the return of the parts or their conservation for an additional period of ten years renewable. The request for semiconductor topography rights must be filed at the INPI headquarters nearby Paris, which will examine the request and, if appropriate, grant a title of protection.

Plant varieties: An application for a plant variety may be filed either by the plant breeder, the employer who owns the rights to the variety, or his/her agent. To obtain a valid plant variety certificate in France, the applicant must file a request before the secretariat of the National Plant Breeder's Authority (INOV). The period of examination takes up to six months, during the course of which the variety undergoes a technical examination of distinctness, uniformity and stability. At the outcome of the examination procedure, INOV may grant a title of protection.

To obtain a valid plant variety certificate in the EU, the applicant must follow a similar procedure before the Community Plant Variety Office (CPVO) located in Angers, France.

Geographical indications: An application for a geographical indication may be filed only by a non-profit organization of defense and management (ODG) that groups the operators (craftsmen or companies), or by a designated representative for said organization. The applicant files an online application before the INPI which carries out a first examination and then publishes the application on the BOPI. Consumers, associations, the INAO and others all have the right to submit observations to INPI. If necessary, the applicant must amend its specifications following the observations received. A second examination phase then takes place, at the end of which the INPI notifies its decision, that is later published.

Domain names: To register a domain name, the applicant must file an online application with a domain name registrar or one of its resellers and must specify

the extension that he/she seeks to obtain. The applicant must fulfil the terms of use established by the registrar (paying registrations fees, providing timely and accurate information). For all domain names ending with the “.fr” extension, the appropriate registrar is the AFNIC. If the domain name does not already belong to a third party, it will be granted to the applicant.

## 6. How long does the registration procedure usually take?

Patents: The registration procedure lasts an average of two years before both INPI and EPO.

Utility certificates: The application is published around eighteen months after its filing.

Trademarks, collective marks and certification marks: French trademark applications are published in the BOPI approximately six weeks after the filing date. Then begins a two-month period during which the holders of prior rights (such as other trademarks owners) may oppose the registration. If no opposition is formed within the two-month delay, the trademark can be registered, provided the INPI finds it valid. The trademark registration procedure lasts around six months before the INPI, if no opposition is raised. In the event an opposition is raised, the opposition proceedings last between six and months before a decision is issued. European trademarks follow a similar calendar, however the procedure for International registrations can be a little longer.

Designs: The average timeframe is four months between the filing of the design application and the grant of the protection by INPI. Community designs are subject to a similar timeframe, while International registrations can be a little longer.

Semiconductor topography rights: The registration procedure for such right lasts a few months.

Plant varieties: The registration procedure requires at least six months, given that the period of examination takes up to six months.

Geographical indications: The INPI’s decision on whether to grant protection to the applied-for geographical indication generally occurs between ten and twenty months after filing. Indeed, after the filing the INPI has two months to request additional information, to which the applicant has one month to respond. The publication in the BOPI marks the start of a two-month public inquiry during which consumers, companies, associations, and other parties can communicate their opinions on the draft specifications. In parallel, the INPI consults the

INAO (which is in charge of regulating French agricultural products with designations of origins), local authorities, consumer associations, and groups of interested professionals. They also have a period of two months to present to the INPI their observations on any point of the specifications. The INPI then sends the applicant, within two months, a summary of the comments received, as well as its recommendations and conclusions. The applicant then has two additional months to review said recommendations and possibly amend his/her project. A new phase of public inquiry and consultations is then conducted, only on the modifications made to the project.

Domain names: This procedure can take between a few hours to a few days, depending on the domain name registrar.

## 7. Do third parties have the right to take part in or comment on the registration process?

As mentioned at Point 5 herein above, third parties can file observations and/or form opposition against the registration of patents and trademarks.

As mentioned at Point 6 herein above, a public inquiry occurs before the granting of a geographical indication in order to allow third parties to communicate their opinion on the draft specifications.

## 8. What (if any) steps can the applicant take if registration is refused?

If registration of a trademark or design is refused by the INPI, the applicant can appeal the INPI’s decision before the competent court of appeal. Ten appeal courts in France are competent to hear appeals against decisions of the INPI regarding the granting of French trademarks and designs, namely the Courts of Aix-en-Provence, Bordeaux, Colmar, Douai, Fort-de-France, Lyon, Nancy, Paris, Rennes and Versailles.

Following the refusal of the registration of EU designs and trademarks by the EUIPO, the EUIPO Board of Appeals has jurisdiction to hear appeals.

The Paris Court of Appeal is the only French court that has jurisdiction to hear appeals against INPI decisions regarding the granting of French patents, utility certificates or SPCs.

Following the refusal of the registration of a patent application before the EPO, the EPO Board of Appeals has jurisdiction to hear appeals.

## 9. What are the current application and renewal fees for each of these intellectual property rights?

**Patents:** The filing fee before INPI is 26 euros, with an additional cost of 42 euros for each supplementary claim after the 11<sup>th</sup> claim. An INPI search report costs 520 euros and the granting of a patent 90 euros. The annuities owed increase with time and range between 38 euros (1<sup>st</sup> year) and 800 euros (20<sup>th</sup> year). A 50% discount is possible for SMEs, individuals, and non-profit research and education organisations.

The filing fee before the EPO is 270 euros for a paper filing and 130 euros for filing online. An EPO search report for applications made after July 1<sup>st</sup> 2005 costs 1,390 euros and the designation taxes for applications filed after 1 April 2009 cost 630 euros.

The fee for an international application is 1,235 euros and a search report costs 1,775 euros.

**Utility certificates:** The filing fee before INPI is 26 euros and issuance is 90 euros. The annuities owed increase with time and range between 38 euros (1<sup>st</sup> year) to 220 euros (10<sup>th</sup> year). Like for patents, a 50% discount is possible for SMEs, individuals, and non-profit research and education organisations.

**Trademarks and collective marks:** The filing fee before INPI is 190 euros per class of goods/services, plus 40 euros per each additional class, and a flat fee of 350 euros for collective marks. The renewal fee is 290 euros for regular trademarks and 450 euros for collective marks.

The filing fee before EUIPO is 1,000 euros for paper filings and 850 euros for electronic filings per class of goods/services, plus 50 euros for the second class, plus 150 euros for each supplementary class. The fee for paper renewals is 1,000 euros and 850 euros for electronic renewals.

**Designs:** The filing fee before INPI is 39 euros, plus 52 euros if protection is directly sought for a period of 10 years. Each reproduction costs 23 euros for black and white reproductions and 47 euros for colour reproductions.

The filing fee before EUIPO is 230 euros, plus 115 euros per additional design for designs number 2 to 10, and plus 50 euros for each additional design number 11 and above. The publication is 120 euros, plus 60 euros per additional design for designs number 2 to 10, and plus 30 euros for each additional design number 11 and above. Deferment of publication is 40 euros, plus 20

euros per additional design for designs number 2 to 10, and plus 10 euros for each additional design number 11 and above

**Semiconductor topography rights:** The filing fee before INPI is 79 euros.

**Geographical indications:** The filing fee before INPI is 350 euros.

**Domain names:** A domain names costs approximately 10 to 15 euros per year. The amount can vary depending on the chosen extension.

**Plant varieties:** The filing fee before INOV is 100 euros and issuance is 40 euros. Annuities range between 40 euros (1<sup>st</sup> year) to 150 euros (25<sup>th</sup> or 30<sup>th</sup> year).

## 10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

If the owner of registered rights fails to pay renewal fees or annuities, his/her title can be revoked.

However, grace periods are available for the payment renewal fees and annuities, subject to the payment of a surcharge, and appeals against revocation may be filed when there is good cause.

## 11. What are the requirements to assign ownership of each of the intellectual property rights described above?

According to contract law, any assignment of ownership of an intellectual property right must respect several conditions:

- The assignor must be the legitimate owner of the right subject to the assignment;
- The assignment must have a valid object, such that an expired or cancelled title cannot be the object of an assignment;
- The price and the duration of the assignment must be determined or determinable.

Trademark, patent and copyright assignments must be in writing.

In France, copyright assignments on future works are void and moral rights are perpetual, inalienable and imprescriptible, such that they are not transferable and may not be waived or overridden by a contractual agreement.

A copyright assignment must include specific terms as to the rights assigned and their scope, effect, territory and duration.

Assignments granted by authors and performers must comply with the fair remuneration requirement, i.e. provide for appropriate remuneration proportional to the actual or potential economic value of the rights transferred.

### **12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

The assignment of registered rights must be recorded with the relevant office (INPI, EUIPO, EPO). If a change in ownership is not properly recorded, it cannot be opposable to third parties.

### **13. What are the requirements to licence a third party to use each of the intellectual property rights described above?**

License agreements may contain various provisions regarding payment, exclusivity, term, territorial scope, jurisdiction, applicable law, preference rights so long as they comply with public policy rules.

According to contract law:

- The licensor must be the legitimate owner of the right subject to the licence;
- The license agreement must have a valid object, such that an expired or cancelled title cannot be the object of a licence;
- The price and the duration of the license agreement must be determined or determinable.

A patent license agreement must be in writing.

Under French copyright law, moral rights cannot be the object of a license agreement. The fair remuneration requirement mentioned at Point 12 herein above also applies for copyright license agreements.

License agreements can be exclusive in that the licensee will grant rights only to one person or non-exclusive: if the license is non-exclusive, then the rights owner is free to grant rights to several people.

### **14. Is there a requirement to register a**

### **licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

In the case of patents, failure to register a patent license agreement results in the agreement not being opposable to third parties. The same conclusion applies to trademark and design license agreements, even if there is no obligation that a trademark license agreement be in writing.

As a consequence, the absence of registration of a licence agreement can prevent the licensee from initiating infringement actions and obtaining infringement damages. However, damages based on general tort law may still be obtained if the licensee joins an infringement action initiated by the owner.

Copyright is not a registered right, such that there is no need to register a copyright license agreement.

### **15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?**

Parties are free to agree on exclusive or non-exclusive licences. The French Intellectual Property Code allows exclusives licensees of the following rights to initiate infringement actions directly:

- neighbouring rights related to music and video (exclusive licensee of audio and video producers);
- designs;
- trademarks;

The French Commercial Code states that the trademark licensee must receive precontractual information prior to signing trademark license agreements that contain exclusivity provisions.

### **16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?**

The French Intellectual Property Code provides for the following criminal sanctions in the event of the infringement of intellectual property rights:

- Patents: Knowingly infringing a patent can lead to three years of imprisonment and a fine of 300,000 euros. When the offense is



committed by an organised criminal group or on an online public communication network, or when the facts relate to goods dangerous to the health or safety of humans or animals, the penalties are increased to seven years of imprisonment and a fine of 750,000 euros (Article L615-14 of the French Intellectual Property Code).

- **Trademarks/collective marks:** Trademark infringement can lead to a fine of 300,000 euros and three years of imprisonment, or 400,000 euros and four years of imprisonment (L.716-9 and L.716-10 of the French Intellectual Property Code).
- **Copyright:** Copyright infringement can lead to a fine of 300,000 euros and three years of imprisonment (Article L.335-4 of the French Intellectual Property Code).
- **Designs:** Design infringement can lead to a fine of 300,000 euros and three years of imprisonment (Article L.521-10 of the French Intellectual Property Code).

These sanctions can be pronounced in the context of criminal proceedings, which can be initiated by the rights owner, the public prosecutor, or customs officials. In practice, criminal proceedings are seldom in intellectual property disputes – however, they take place on a regular basis as a follow-up to customs seizures in trademark or design infringement cases, and at the initiative of the Public Prosecutor in certain copyright infringement cases.

### **17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.**

Civil infringement actions are the main enforcement option available in France and constitute the overwhelming majority of court actions in the intellectual property field. They are usually complemented by claims/actions for unfair competition and parasitism.

Customs actions are another cost-effective enforcement option available in France for right owners, particularly those experiencing large-scale infringement.

Invalidation actions before the competent court or office are also available and quite common. With regard to trademarks, it is now possible to bring actions for cancellation on grounds of invalidity and revocation on

grounds of non-use of trademarks before the INPI.

Alternative dispute resolution is also becoming increasingly common and is now compulsory in certain cases where it is provided that an amicable solution must be attempted before legal action is taken. In addition, in the framework of civil procedures case management judges tend to invite the parties to attempt mediation.

### **18. What is the length and cost of such procedures?**

Court fees are insignificant in France, where the judiciary system is to a large extent funded by the State. The same goes of administrative proceedings before the INPI.

The costs of such procedures are thus essentially made up of lawyer/attorney fees, bailiff (“*huissier*”) costs for the taking of evidence, and in certain instances expert fees.

Whilst there is growing consensus amongst practitioners and judges that the high technicality of intellectual property disputes generates fairly elevated costs, these costs are highly variable as they depend on many factors such as the nature and solidity of the intellectual property rights involved, the complexity of the case, the legal and technical issues at stake, etc.

They vary from a few thousand to hundreds of thousands of euros, sometimes more in the most sophisticated, sensitive patent disputes.

Proceedings on the merits before a Judiciary Court (first instance) approximately last between one to two years, sometimes three years in the most complex cases where multiple parties are involved.

Preliminary urgent proceedings can last from a few days to a few months. In certain cases a preliminary injunction may be obtained *ex parte* within a day.

### **19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

The Paris Judiciary Court has exclusive jurisdiction for patent, European Union trademark and Community design litigation. Ten courts across France have

jurisdiction over other civil intellectual property litigation: Bordeaux, Fort-de-France, Lille, Lyon, Marseille, Metz, Nanterre, Nancy, Paris and Rennes.

In criminal matters, non-specialized correctional courts have jurisdiction over intellectual property offences.

Civil proceedings begin with a summons which must be served on the defendant and then filed with the court. In most cases where there is no urgency, the plaintiff is required to briefly report in its summons the attempts he has made in order to resolve the matter amicably before commencing legal proceedings. Legal proceedings are prescribed by five years from the day when the right owner knew or should have known the last fact enabling him to exercise it.

Criminal proceedings may begin either with the service of a direct complaint or by filing a complaint with the public prosecutor, followed by the reiteration of the complaint with the investigating judge. The statute of limitations for criminal proceedings is six years from the day the offence was committed.

The procedure involves the exchange of briefs – generally two briefs per party (including the summons as regards the plaintiff), however the number of briefs can go up to four or more, depending on the nature and complexity of the case as well as the circumstances and motions that may arise in the course of the proceedings. In principle procedural motions are heard first independently of the merits. The case is heard in final hearings by one to three professional judges. A basic rule is that the court cannot take into consideration any argument or factual element not raised in the last brief of each party.

Time wise, final hearings for oral pleadings can last from less than an hour in the most straightforward cases, to one or two hours in most cases, to a couple days, exceptionally, in the most sophisticated patent disputes. Except in criminal cases, it is very rare to hear oral evidence from experts, witnesses or parties during the final trial. The judgment is usually delivered a couple months after the final hearing.

The plaintiff in an infringement proceeding may obtain damages calculated by taking into consideration *inter alia* the extent of the economic loss and moral prejudice suffered as a result of the infringement, as well as the infringer's profits.

The deadline to appeal is one month for civil judgments, which benefit from provisional enforcement unless ruled otherwise by the court, and ten days in criminal cases.

## 20. What customs procedures are available to stop the import and/or export of infringing goods?

The customs procedure available to stop the import and/or export of infringing goods is the procedure of customs detention or seizure.

It is a provisional measure consisting of the detention by customs services of suspected infringing goods that is automatically lifted if an action on the merits has not been brought within ten days of its notification.

The intellectual property rights protected under this procedure are trademarks, designs, copyright and related rights, patents, semiconductor topography rights, utility models, SPCs relating to medicines and plant protection product, plant varieties and designations of origin, geographical indications and geographical names.

The detention results from the provisions of Regulation (EU) 608/2013 of 12 June 2013 and the French Intellectual Property Code.

Indeed, for protection within the EU, the detention is provided for by Regulation (EU) No 608/2013 and is intended to protect the Community's borders against infringing goods from third countries.

Domestic law, on the other hand, provides for a detention procedure applying to goods circulating within the French territory, enabling French customs to search and detain goods in various places such as storage facilities, shops and trucks, and not just at entry points in the French territory.

## 21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

Article 750-1 of the French Civil Procedure Code provides, under a sanction of inadmissibility which may be ordered by the court *sua sponte*, that court proceedings must be preceded by an attempt at conciliation, at mediation or at a participatory procedure, for all claims not exceeding 5,000 euros, including in the field of intellectual property. Urgency is however amongst the circumstances which are regarded as a legitimate reason for not making such an attempt.

Alternative dispute resolution mechanisms can also be made mandatory by contractual provisions in intellectual

property disputes involving larger sums of money.

## 22. What options are available to settle intellectual property disputes?

Parties involved in intellectual property disputes in France can decide to settle at any stage of the proceedings (before, during and even after the proceedings and the rendering of a decision) and by any means (by a written contract or orally).

## 23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

To establish infringement of the intellectual property rights described above, it must be shown that an object protected by one of these rights has been reproduced / is being used without the authorization of the owner of the said right and that no exception applies.

First of all, this requires showing that the allegedly infringed-upon object is protected by an intellectual property right owned by the plaintiff:

- In the case of registered rights such as patents or trademarks, it will be necessary to produce certified copies of the register identifying the protected object and the owner of the rights.
- Protection is more difficult to prove in the case of unregistered rights, particularly copyright. But the plaintiff's rights in a claimed work can be proved if the author has used a *Soleau envelope* (a formality for filing with the INPI that does not confer intellectual property rights but makes it possible to obtain a definite date for the creation and thus to assert its anteriority in the event of a dispute), has had his/her creation reported by a ministerial officer (notary or bailiff) on a definite date, has called upon a society of authors or is in possession of working documents showing the various stages of creation of the claimed work.

Next, the plaintiff must show that the protected object has been infringed upon by the defendant:

- In copyright law, it must be proven that the original elements of the work have been copied, generally by an act of reproduction or representation by the defendant.
- In trademark law, the finding of trademark

infringement requires both use of the disputed sign as a trademark in the course of trade and violation of one of the trademark's functions.

- In patent and design law, it is generally sufficient to prove infringement of any of the rights of the owner of the rights to establish an act of infringement either by possession, use or placing an infringing product on the market.

Evidence often consists of elements obtained during an infringement seizure or established by a bailiff's report.

## 24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

### a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?

Judges sitting in the courts that have exclusive jurisdiction over civil intellectual property cases have experience of dealing with these matters. However, they are not required to have a scientific or technical background.

Whilst this is not the standard in the French practice of intellectual property disputes, a court has the possibility to appoint judicial experts who are responsible for drafting a report in which they provide answers to questions posed by the court after interviewing the parties. In their various sets of pleadings, the parties would then discuss the expert's report. The court would not be bound by such report, which would solely be one of the elements at this disposal for making his assessment.

Parties also sometimes produce reports from private experts that they have appointed. However the courts are not bound by such reports, which are most often criticized by the adverse parties.

### b) What mechanisms are available for compelling

### the obtaining and protecting of evidence? Is disclosure or discovery available?

The main mechanism available for compelling the obtaining and protecting of evidence is the infringement seizure, which is an evidentiary measure provided by French procedural law for collecting evidence of an alleged infringement through a power of investigation.

By filing an *ex parte* application before the competent Judge, the owner of an intellectual property right may seek a court order granting authorization to have a bailiff visit the premises of a third party (generally an alleged infringer) for the purpose of collecting evidence of (i) the existence, (ii) the origin and (iii) the extent of the purported infringement.

The bailiff's powers are listed in the court order. Most commonly s/he may (i) ask questions, (ii) request documentation, (iii) draw an official description of the allegedly infringing product/process, (iv) physically seize samples of the allegedly infringing product, and/or (v) collect technical, commercial as well as accounting documents.

The bailiff may be assisted by a patentee's patent attorney, a technical expert if needed, a photographer, etc. all of whom are appointed and chosen by the plaintiff. The bailiff is usually backed up by law enforcement officers.

Performing a seizure is a right for the intellectual property right owner. The Judge may not refuse to grant a seizure order, provided formal requirements are met. Whilst the owner is expected to provide reasons for which a seizure appears justified, no evidence of the claimed infringement has to be provided to the Judge. Furthermore, the Judge has no power to assess the credibility of the infringement claim.

The Judge may however: (i) limit the scope of the authorized operations and/or (ii) order that any item/document seized be kept by the bailiff under provisional escrow in order to protect trade secrets of the seized party.

The purpose of the seizure is only to gather evidence in view of an infringement action, which must be filed following the seizure, failing which the seizure will be deemed void and the defendant will be entitled to damages. The time-limit for filing the infringement action is thirty-one calendar days of the date of the seizure.

It should be noted that a seizure is not an equivalent to discovery-type proceedings. The main difference is that the court order for the seizure is issued without any prior notice to or consent by the defendant, so the

proceedings are fully inquisitorial in nature, as opposed to adversarial discovery-type proceedings.

There is no duty of disclosure or discovery before French courts.

However, a judge can order or facilitate submission of evidence. Indeed, parties may request at any stage of the proceedings (pre-trial proceedings, case management proceedings, proceedings on the merits) court orders to gather additional information or evidence related to the infringement such as information to determine the origin of the infringement, the distribution networks of the infringing products and their quantities and prices.

### 25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

The court makes its opinion on the basis of its free assessment of the information and evidence submitted by the parties. Indeed, the parties must provide evidence for each of their claims.

In intellectual property civil cases, most disputes are decided on the basis of written evidence submitted by the parties with their pleadings. There is no cross-examination of witnesses available in civil court proceedings in France.

### 26. What defences to infringement are available?

French procedural law classifies defences into three main categories:

- Procedural motions bear on the compliance with strictly procedural requirements (e.g. lack of jurisdiction of the court or formal irregularity of a procedural deed).
- Motions for inadmissibility aim at having the claim dismissed on procedural grounds that affect the plaintiff's standing to sue. For example, due to the expiry of the statute of limitations, the plaintiff's lack of legal interest, or *res judicata*.
- Defences on the merits include *inter alia*:
  - The lack of proof of the alleged infringement (e.g. as a result of the invalidity of an infringement seizure or a bailiff report),

- The lack of personal involvement of the defendant in the alleged infringement,
- The lack of infringing character of the incriminated device or behaviour,
- The benefit for the defendant of a derogation or authorization from the right owner,
- The lack of proof by the plaintiff of the alleged prejudice.

There is no settled case law and it remains discussed amongst scholars and practitioners whether a defence pertaining to the plaintiff's lack of right over the protected object should be classified as a motion for inadmissibility or a defence on the merits. In copyright cases the prevailing view is that the lack of originality of the claimed work is a defence on the merits; whereas a defence against the validity of the asserted patent, trademark or design could potentially receive different qualifications depending on how the argument is framed before the court.

### 27. Who can challenge each of the intellectual property rights described above?

Any person having a direct and personal legal interest may in principle challenge an intellectual property right described in Section A herein above.

The defendant in an action involving a purported infringement is considered to have such a legal interest with respect to the asserted intellectual property right.

Main actions for invalidity of a registered intellectual property right can be reserved to a limited circle of persons proving standing to sue, subject to the forum before which the action is filed (i.e. a court or the INPI), the contested right, and the ground on which invalidity is claimed. For example:

- An application for invalidity of a trademark, based on relative grounds (e.g. alleging that the trademark infringes prior rights having effect in France), may be filed only by the owner of said prior rights – regardless of whether it is filed before a court or before the INPI.
- By contrast, an application for invalidity of a trademark, based on absolute grounds or bad faith registration, may be filed before a court by any person having a legal interest, or before the INPI by any person regardless of

his/her legal interest.

### 28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

It is possible to challenge a French patent or a European patent by filing an opposition before the INPI or the EPO, respectively, within nine months of the publication of the grant of the patent.

Further to the grant of the patent, there is no time limit for filing a nullity action.

It is possible to challenge a trademark by filing an opposition before the INPI or the EUIPO, respectively. The timeframe for filing an opposition against a French trademark application is two months as of the publication of said application in the BOPI; with regard to an EU trademark, the opposition period is three months as of the publication of the EU trademark application in the EU Trademarks Bulletin.

There is no time limit for filing an application for a declaration of invalidity before the EUIPO, or a cancellation action before the INPI. However, the owner of an earlier right who has tolerated the use of the later trademark in good faith for five consecutive years can no longer request its cancellation.

It is also possible to challenge a trademark in revocation proceedings for non-use. Such an action may be filed within five years as of the publication of the registration.

As regard geographical indications, it is possible to challenge them by filing observations with the INPI during the public search procedure, which takes place within two months of the publication of the application for registration.

Thereafter, there is no time limit for filing an application for invalidity.

Other registered intellectual property rights (designs, collective trademarks, utility patents and supplementary protection certificates, plant varieties, semiconductor topography, etc.) can be challenged after registration or grant by filing invalidity actions, for which there is no time limit.

### 29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are

## the grounds for a finding of invalidity of each of these intellectual property rights?

**Patents and SPCs:** The Paris Judiciary Court has exclusive competence for patent ownership actions as well as invalidity actions against patents and SPCs. The main grounds for a finding of invalidity of a patent are lack of novelty, inventive step and/or industrial application, added subject-matter, lack of support in the description, insufficient disclosure.

**Trademarks:** Following the implementation into French law of European Directive 2015/2436, commonly known as the “Trademark Package”, INPI and the judicial courts share jurisdiction over trademark invalidity actions. From 1 April 2020:

- INPI is exclusively competent for trademark invalidity actions based on :
  - All grounds for forfeiture
  - All absolute grounds for invalidity
  - Relative grounds for invalidity based on certain distinctive signs (prior trademark, corporate name, trade name, sign, domain name, name of public entity) and territorial signs (names of territorial authorities and EPCIs, appellations of origin and geographical indications).
- The judiciary courts remain exclusively competent for trademark invalidity actions based on:
  - invalidity claims based on an infringement of a copyright, a design or a personality right;
  - in the context of legal proceedings, counterclaims for invalidity or forfeiture filed in the absence of any preliminary referral to the INPI, whatever the grounds;
  - any claim for invalidity or revocation, whatever the grounds, when such claim is related to an action falling within the court’s jurisdiction of the (e.g., an action for infringement, unfair competition or contractual liability) or when probatory, provisional or protective measures have been ordered to stop an infringement of a trademark right and are being implemented before the commencement of an action on the merits.

Invalidity actions of EU trademarks must be filed before the EUIPO, whereas invalidity counterclaims regarding EU trademarks may be filed with the Paris Judicial Court.

**Geographical indications:** the Council of State (*Conseil d’Etat*) is competent to rule on invalidity proceedings relating to geographical indications.

**Designs:** invalidation of a French design can be ordered by a limited number of courts on a main claim or by way of a counterclaim. Challenges to Community design rights must be filed with the EUIPO except for counterclaims which can be filed with the Paris Judiciary Court.

## 30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

The effect of intellectual property rights may be limited as a result of various other legal concepts or procedures, such as:

- Declaratory non-infringement actions which are declaratory actions, whereby a party requests that its product be deemed not to infringe the object protected by a third party’s intellectual property right. The latter will therefore be unable to enforce the effects of the intellectual property rights relating to that object against the first party or only to a limited extent.
- Withdrawal and renunciation actions in the field of trademarks, designs and patents allow the rights owner to give up his rights on all or part of the protected object.
- Exhaustion of rights, according to which the owner of industrial property rights on a product has exhausted its exclusive right when it is first put into circulation within the EU and cannot oppose the free circulation of the product.
- Licensing, as discussed in Section D hereinabove, is another way of limiting one’s intellectual property rights.

## 31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

The main remedies available for infringement are the

following:

- damages to compensate the loss resulting from the infringing acts;
- the prohibition of further infringement, under penalty;
- the destruction of the infringing products, under penalty;
- an order to recall the infringing products, under penalty;
- the communication of information on the extent and origin of the infringement;
- the publication of the judgment or a summary or section thereof in periodicals and/or on the defendant's website.

### 32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

See Point 18 hereinabove regarding costs of enforcement proceedings.

With regard to costs recovery, the courts compensate the costs incurred by the prevailing party in an amount that they discretionarily assess in light of the nature and complexity of the case.

In order to maximize chances to obtain full costs compensation, parties may produce justifications of the attorney fees invoiced.

There is no procedural mechanism enabling or requiring security for costs.

### 33. Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.

The COVID-19 pandemic caused a number of changes to

the protection or enforcement of intellectual property rights.

With regard to deadlines, Ordinance No. 2020-306 of March 25<sup>th</sup> 2020 provided that all deadlines falling between March 12<sup>th</sup> and June 23<sup>rd</sup> 2020 were extended either to (i) July 23<sup>rd</sup> 2020 for one-month deadlines, or to (ii) August 23<sup>rd</sup> 2020 for two-month or more deadlines. This Ordinance applied to all deadlines set out in the French Intellectual Property Code, but not to those resulting from international agreements or European texts.

Following an EUIPO decision, all deadlines falling between March 9<sup>th</sup> 2020 and April 30<sup>th</sup> 2020 were automatically extended to May 1<sup>st</sup> 2020.

Similarly, the EPO also indicated that all deadlines expiring on or after March 15<sup>th</sup> 2020 were extended to April 17<sup>th</sup> 2020.

With regard to filing requirements, the procedures for filing patents, trademarks and designs are electronic and therefore were not affected. Nonetheless, INPI extended the deadlines for responding to its notifications in patent, trademark and design procedures to four months as of March 18<sup>th</sup> 2020, with the exception of the time limits for trademark oppositions. The set deadlines having not yet expired on 16 March 2020 were also extended to four months.

With regard to court processes, most of them (with the exception of essential litigation) were postponed until further notice. This was notably the case for intellectual property proceedings, including hearings before the specialised chambers of the Paris Judicial Court (i.e. the 3<sup>rd</sup> Chamber) and the Paris Court of Appeal (i.e. Section 5).

In addition, Ordinance No. 2020-304 of March 25<sup>th</sup> 2020 provided that in most civil cases, the courts could decide that the proceedings would take place without a hearing, unless the parties objected.

Moreover, since May 11<sup>th</sup> 2020, it has been possible to file applications for infringement seizures without hearings.

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