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**CANCELLATION AND NULLITY ACTIONS AT  
ADMINISTRATIVE AND JUDICIAL LEVEL**

**France**

***July 7th, 2022***

# PARTS

- I. IMPLEMENTATION OF THE ADMINISTRATIVE CANCELLATION ACTION
- II. FIRST DECISIONS
- III. CONSEQUENCES OF THE REFORM AND MISCELLANEOUS

# I. IMPLEMENTATION OF THE ADMINISTRATIVE CANCELLATION ACTION

## PREVIOUS SITUATION

**Exclusive competence** of the courts for the cancellation actions (invalidity and revocation)

Obligation to appoint a lawyer (today 90% of cancellation action filed with a professional representative )

👉 High costs :

- 3000/5000 € to file the revocation **request**
- Up to 15 000€ for cancellation action

👉 Long procedure

Consequences : Usually disregarded/not seen as a primary strategy

# DIRECTIVE (UE) 2015/2436 OF DECEMBER 16, 2015

Directive (UE) 2015/2436 of December 16, 2015

**Article 45** - Two objectives for the cancellation action

*Member States shall provide for an **efficient** and **expeditious** administrative procedure before their offices for the revocation or declaration of invalidity of a trademark*

# DIRECTIVE (UE) 2015/2436 OF DECEMBER 16 2015

## *Article 54 – Two different deadlines*

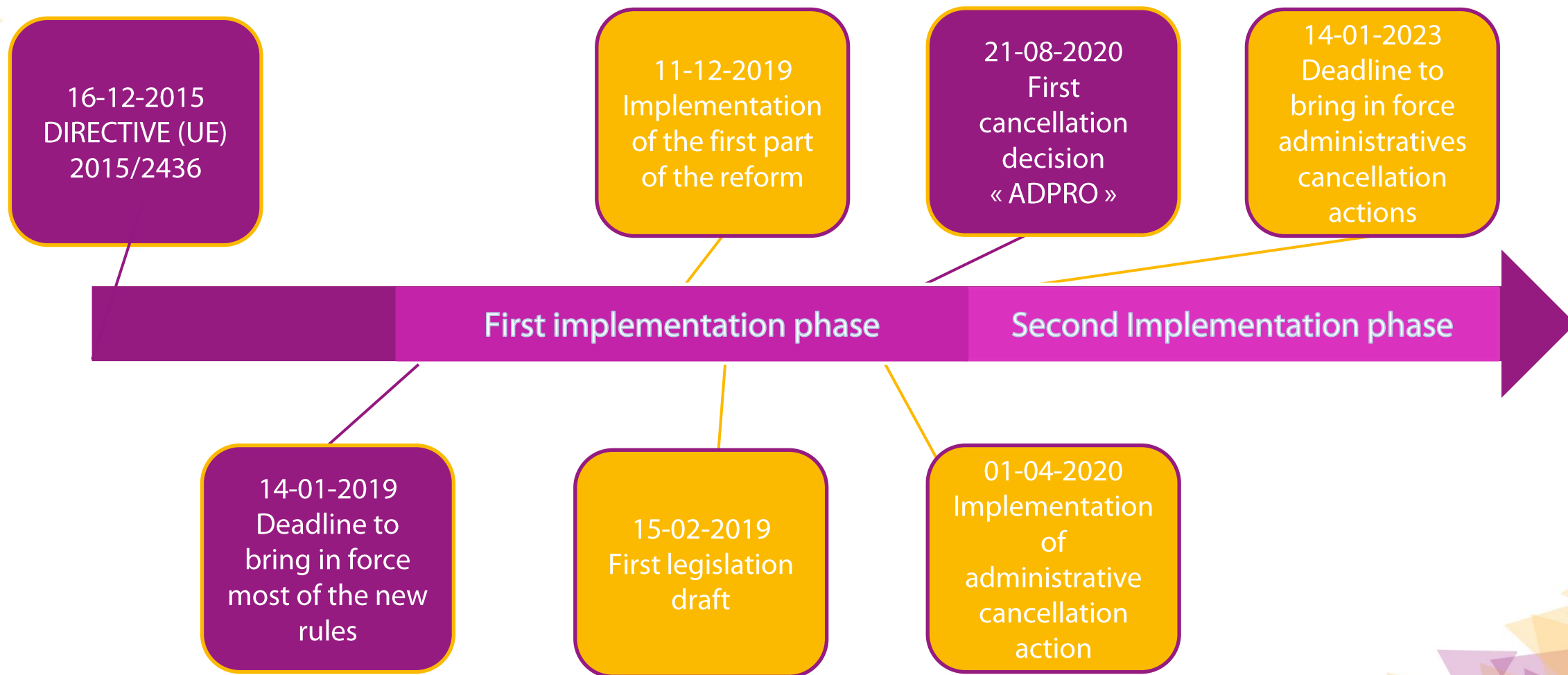
Deadline to bring into force the laws, regulations and administrative provisions to comply with the directive for most of the elements

☞ **January 14, 2019**

Deadline to bring into force the laws, regulations and administrative provisions to comply with Article 45

☞ **14 January 2023**

# TIMELINE



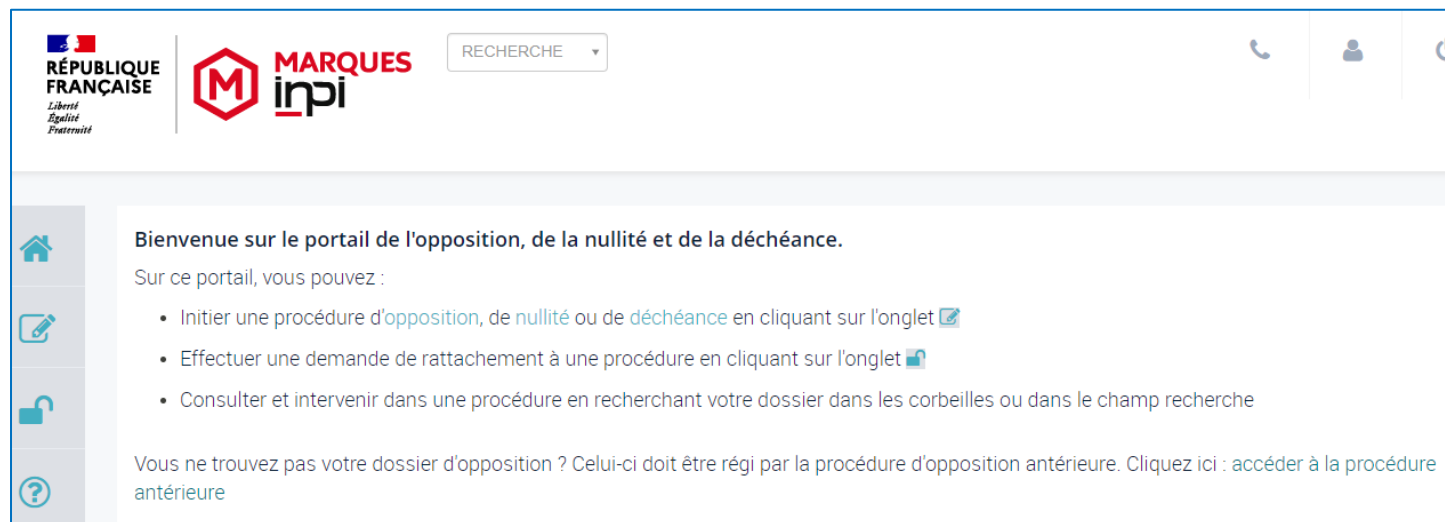


# TEXT – A NEW ADMINISTRATIVE PROCEEDINGS

## L 716-1 of the French Intellectual Property Code

*Requests for invalidity or revocation of trademarks filed before the National Institute of Industrial Property [...]*

*[...] nullity or revocation at the end of a **contradictory procedure** including an investigation phase,*





# REVOCATION ACTION

## L 714-5 & L 714-6

- Absence of genuine use as ground for revocation
- Trade mark having become generic or misleading indication as grounds for revocation
- First decisions
  - November 5, 2020 : révocation of **ensemble.bio**
  - November 11, 2020 : partial révocation of **PREMIERE** for photographic apparatus



# CANCELLATION ACTION

## Article L716-2

- Absolute grounds
- Relative grounds for refusal or invalidity (Prior Trademarks, domain names, Company name / trade name, Appellation of origin ...)

*August 21<sup>st</sup>, 2020 : First decision of inadmissibility of a cancellation action  
The trademark registration contested should be registered...*

幽必克  
UBIQUE

# COMPETENCE RULES

Exclusive competence of the **French Office** (INPI)

- Cancellation action grounded on an earlier trademark
- Cancellation action grounded on an earlier domain name, company name...
- Cancellation action on absolute grounds
- All the revocation actions (non use and TM having become generic or misleading indication )



# COMPETENCE RULES



**Courts** remain competent for

- Cancellation action grounded on copyright, personality rights or design
- Cancellation action as counterclaim
- Cancellation action directly linked to an action for which the courts are competent (counterfeiting, passing-off...)

# APPEAL

Competence of the Appeal Courts

Full reexamination of the case



Possibility to file **new** arguments /evidences (contrary to the opposition appeal)

*10 % of the decisions issued by INPI have been appealed*  
*Majority of confirmation of the INPI decision*

## OFFICIAL FEES

Action	Fees (€)
Révocation action	600
Cancellation action on absolute grounds	600
Cancellation action based on one right	600
for each additional right	150

## decision on the costs

*At the request of the winning party, the Director General of the National Institute of Industrial Property shall charge the losing party all or part of the costs incurred by the other party within the limit of a scale fixed by order of the Minister*



## Decision on the apportionment of costs

Max amount	(€)
Fees regarding the written phase	600
Fees regarding the oral phase	100
Representation fees	500

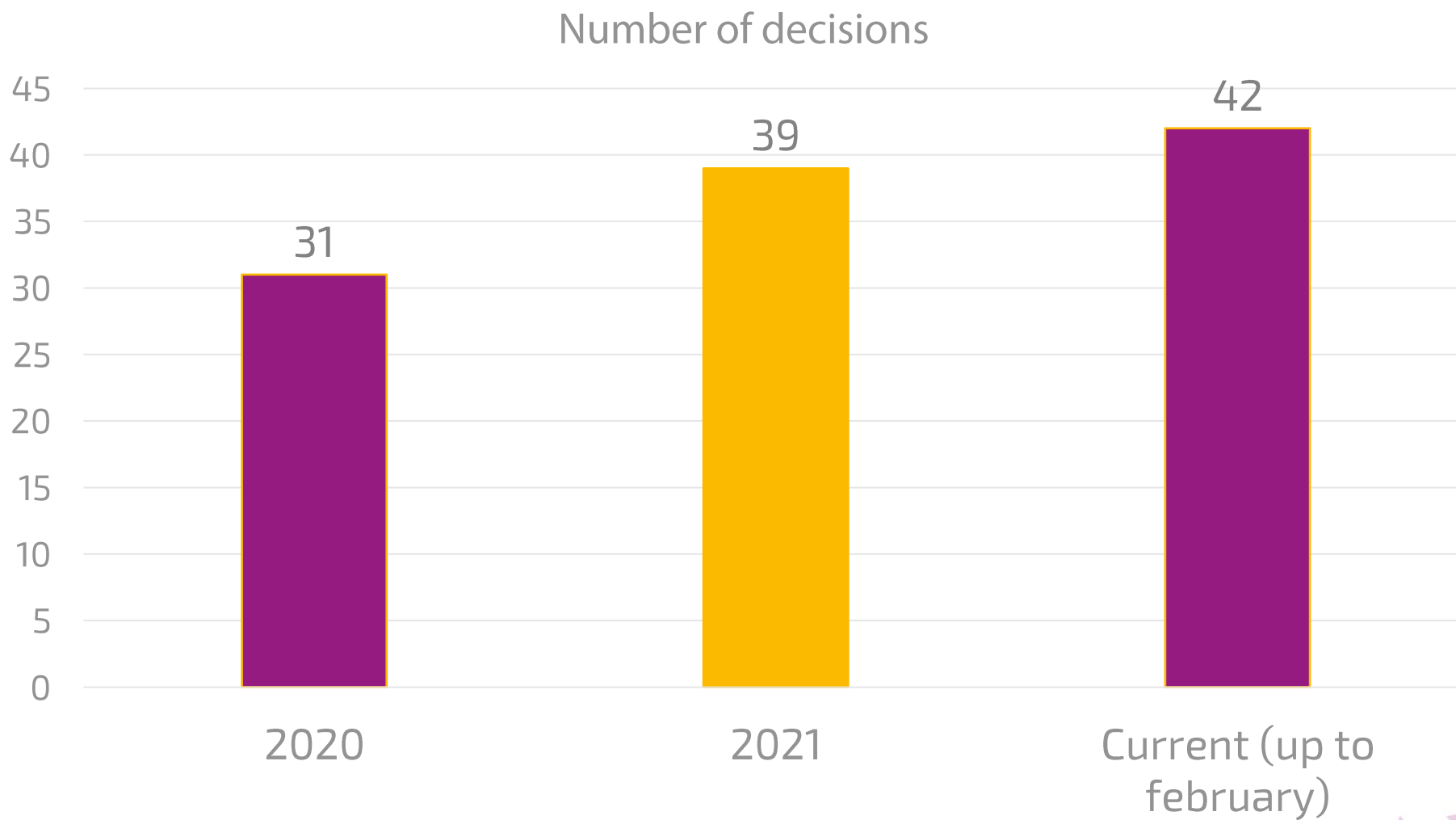
*33% of case where cost decisions have been requested*

*Medium amount allowed : 700 €*

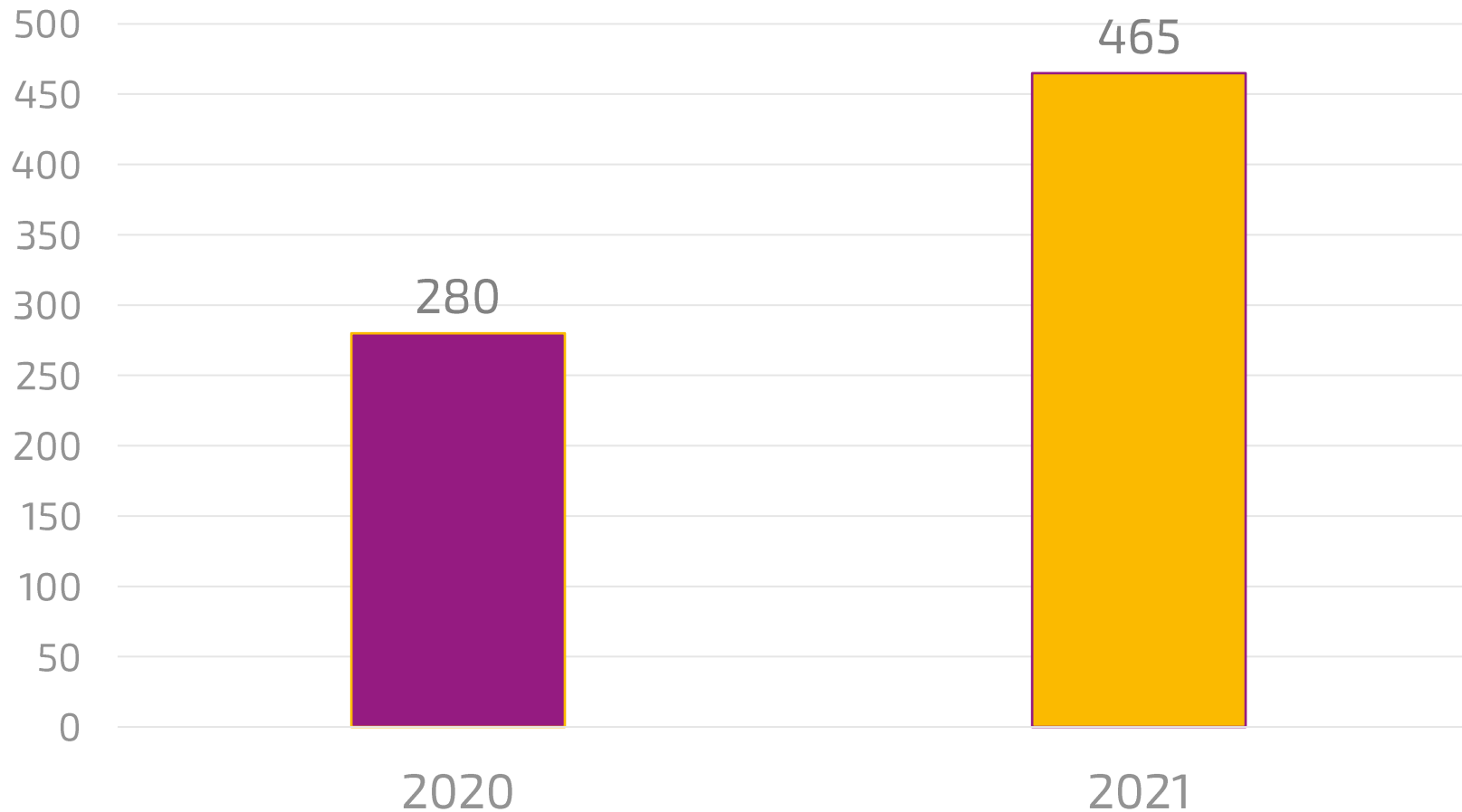
## II. FIRST DECISIONS



## CANCELLATION ACTION NUMBER / Month



## CANCELLATION ACTION NUMBER

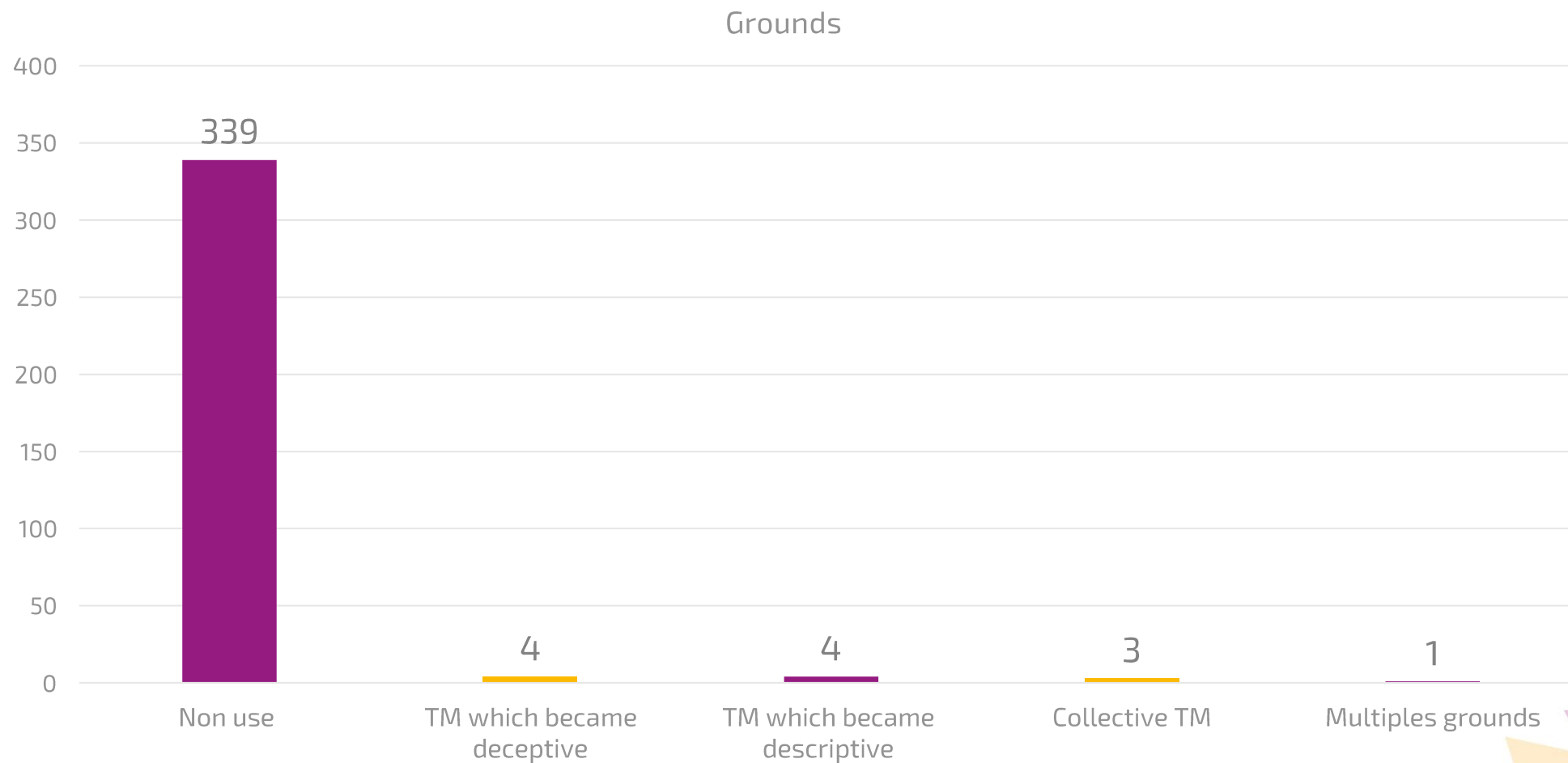


Total  
(February  
2022)  
**870**

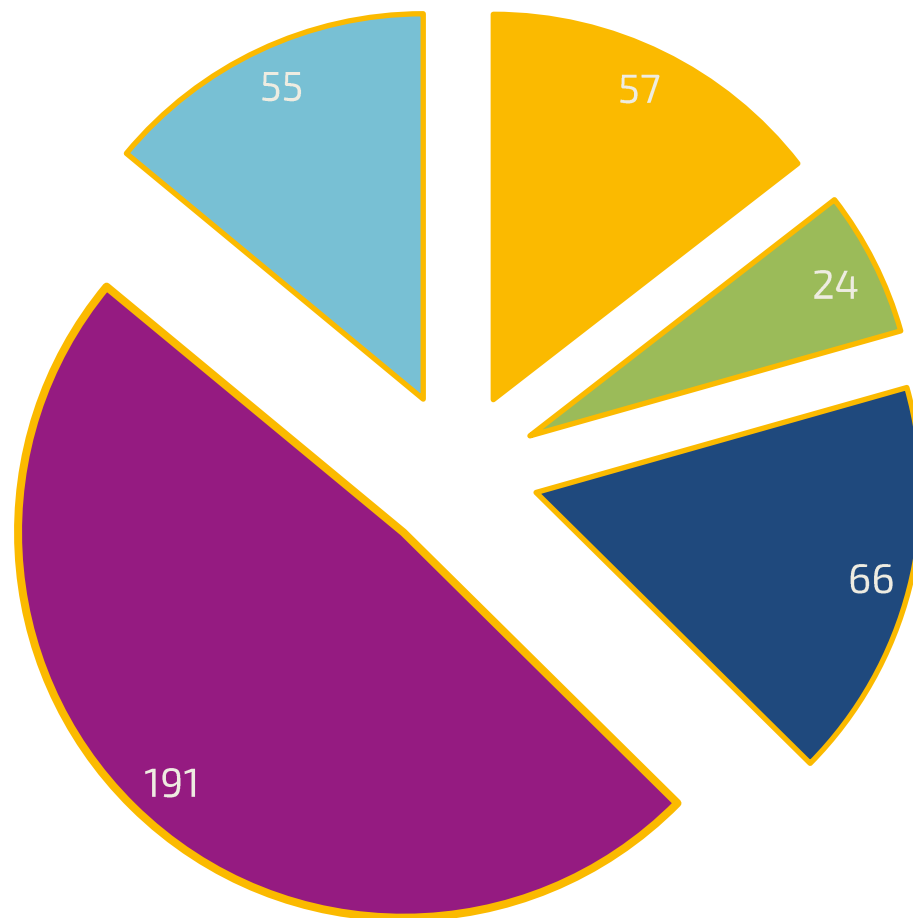
## CANCELLATION / REVOCATION (trend)



# Révocation



## Cancellation



- Multiple absolute grounds
- Single absolute grounds
- Multiple relative grounds
- Single relative grounds
- Absolute and relative grounds



# III. CONSEQUENCES AND CONCLUSIONS



# USE IMPORTANCE IS BACK

Before the reform:

- Costly and long proceeding to obtain the revocation of a trademark
- No genuine used to be demonstrated within opposition proceedings

Now : full analysis of the use of the prior trademark (similar proceedings with the EUIPO's one)

## EVOLUTION FOR THE CLIENTS

- Availability search
- Opposition defense
- Decision to file opposition / scope of the opposition
- Amicable settlement

# PRESCRIPTION

Article L716-2-6

*the action or request for invalidity of a trademark is not subject to any limitation period*

Important evolution

- A trademark registered despite its illicit character could not be cancelled if the prescription period had lapsed (8 June 2017 High Court)
- Better articulation between prescription and preclusion due to acquiescence

# THANK YOU

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