

Pursuant to a recent reform in French trademark law, as of April 1, 2020, it became possible to file cancellation and revocation for non-use actions directly before the French Trademark Office (the “INPI”). Prior to this reform, such actions could only be brought before the French courts.

Pursuant to Article L.716-1-1 of the French Intellectual Property Code (hereinafter “IPC”), during such cancellation/revocation proceedings, the winning party may request that the INPI order the losing party to bear its costs.

The legislative order fixing the maximum amount of costs that the losing party in such procedures may be ordered to reimburse, which are set forth below, was published on December 4, 2020 and came into force on December 7:

Type of fees	Maximum amount to be borne by the parties (in Euros)
Fees incurred for the written phase	600
Fees incurred for the oral phase	100
Representation fees	500

According to this same legislative order, the request for the reimbursement of the costs incurred must be filed at the latest before the end of the contradictory phase of the proceedings, i.e. before closure of the written and/or oral exchanges between the parties.

In addition, the legislative order provides that the winning party is:

- the owner of a contested registration that raises a successful inadmissibility defense;
- the owner of a contested registration that is not modified at all as a result of the decision in the invalidity or revocation action;
- the party seeking revocation or cancellation if such claim is successful against **all** of the goods or services initially referred to in the application for invalidity or revocation.

Consequently, in cases where French registrations are partially revoked or cancelled, neither party will be ordered to bear the other’s costs.

It is not yet clear if this order will apply to invalidity and revocation actions filed prior to December 4, 2020 for which the contradictory phase of the procedure has not yet been concluded.

This legislative order, issued more than one year after the reform allowing these types of actions to be brought directly before the INPI came into force, was eagerly awaited and finally clarifies the question of the reimbursement of the costs associated with such procedures.

For any questions about cancellation and revocation actions before the INPI, or other Intellectual Property matters in France or the European Union, please do not hesitate to contact us.



Contact us:

For any question you may have, please do not hesitate to contact our team.



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