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# Trademark Cancellations

## International Practice and Procedures

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### FRANCE

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This material is only intended to provide an introduction to and simplified profile of this jurisdiction's local practice and procedure relevant to trademark cancellation. This material does not take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of this jurisdiction such as might be provided by a local trademark attorney.

For more information about particular areas of practice, please see INTA's companion online publications: [International Opposition Guide](#).

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#### I. AVAILABILITY

- Cancellation of a trademark is available for:
  - national marks;
  - international marks;
  - European Union Trade Marks.
- "Cancellation" is not defined by legislation. French law uses the words "nullité" or "déchéance," the translation of which would be "invalidity" and "revocation." The only indication concerning "cancellation" is that an invalidity decision shall be absolute.
- Cancellation actions cannot be filed online.

#### II. GROUNDS

##### A. Absolute Grounds

- The following absolute grounds may be raised in cancellation proceedings:
  - the mark is descriptive;
  - the mark is misleading and/or deceptive;
  - the mark lacks distinctiveness;
  - the mark is generic;
  - the mark is functional;
  - the mark is against public policy or principles of morality;
  - the mark has not been authorized by competent authorities pursuant to Article 6ter of the Paris Convention;
  - the mark is prohibited in this jurisdiction;
  - the application for or registration of the mark was made in bad faith.

##### B. Relative Grounds

- The following relative grounds may be raised in cancellation proceedings:
  - there is an earlier application or registered mark;

- there are earlier use-based rights in an unregistered mark (in the event that the sign at stake is well known under Article 6bis of the Paris Convention);
- the mark is covered by a copyright;
- the mark is a company name (if there is a risk of confusion in the public's mind);
- the mark is notorious or well known (Article 6bis of the Paris Convention);
- the mark is a trade or business name (if there is a risk of confusion in the public's mind);
- the mark is a domain name;
- other relative grounds, i.e., grounds that are based on another party's proprietary rights:

when there are prior rights resulting from a protected appellation ("appellation d'origine protégée");

when there are prior rights in a registered drawing;

when there are prior rights resulting from personality rights, in particular, rights of someone in his/her first name or image;

when the name, image or the well-known character of a French territorial area ("collectivité territoriale") is altered.

### C. Grounds Other than Absolute, Relative or Non-Use

- Other than the absolute or relative grounds listed above and/or the non-use grounds listed below, there are no other grounds that may be raised in cancellation proceedings.

### D. Non-Use Grounds

- Non-use may be raised as a ground in cancellation proceedings.
- In relation to cancellation for non-use, "use" is defined as: Use of the mark has to be serious and genuine. Use is considered as being serious when the mark is used in conformity with its purpose, i.e., to certify the identity of the origin of the products or services for which the mark has been registered.
- The definition of "use" provided above is derived from both statute, regulation or administrative rule and case law: French Intellectual Property Code, Section L. 714-5; ECJ, Ansul, March 11, 2003; Cour de Cassation, Commercial Chamber, November 30, 2004.
- Use by a licensee or with the consent of the proprietor constitutes use by the proprietor. Such consent can be implied, for instance for an affiliated company. It is always necessary to prove the intention of the owner of the mark; prima facie tolerance is not sufficient.
- The time frame within which a mark must be used in order to avoid cancellation runs from:
  - the date of publication of the registration.
- Counting from the above date, to avoid cancellation for non-use, the mark must be used within: According to Section L. 714-5 of the French Intellectual Property Code, an owner who has not put his mark to genuine use in connection with the goods or services referred to in the registration during an uninterrupted period of five years, without good reason, shall be liable for revocation of his rights.
- The consequences of use being interrupted are: If use is interrupted for more than five years, the owner shall be liable for revocation of his rights (Section L. 714-5 of the French Intellectual Property Code).

### E. Multiple Grounds

- An application for cancellation may be based on multiple grounds (i.e., on a combination of absolute, relative and non-use grounds).
- The advantages of filing an action based on multiple grounds are as follows: If for any reason the judge rejects one of the grounds, the other grounds will be considered. Multiple grounds provide greater security to the applicant
- If an action is based on multiple grounds and the action could be disposed of on one ground, the other grounds will nevertheless be considered.

## F. International Registrations and European Union Trade Marks

- Grounds for cancellation are the same in respect of international marks as they are for national marks. The French part of an International Registration designating France shall follow the same rules as those that apply to national marks.
- Grounds for cancellation are the same in respect of European Union Trade Marks as they are for national marks. France being a member of the European Union, grounds for cancellation of national marks are very similar to grounds for cancellation of European Union Trade Marks.

## G. Introduced Late Grounds Proceedings

- Additional grounds for cancellation may not be introduced at a later stage in the proceedings

## III. FORUM

- The forum for cancellation proceedings is the same regardless of the grounds on which the proceedings are brought
  - Cancellation proceedings on all grounds may be brought before the following court or other judicial tribunal: Tribunal de Grande Instance (First Degree Tribunal). A limited number of First Degree Tribunals have jurisdiction to handle this matter.

Directive 2015/2436 of the European Parliament and of the Council of December 16, 2015, to approximate the laws of the Member States relating to trademarks provides that, "without prejudice to the right of the parties to appeal to the courts, Member States shall provide for an efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark" (Article 45).

Article 54 of the Directive provides that Member States shall bring into force the laws, regulations and administrative provisions to comply with Article 45 by 14 January 2023.

France thus will have to implement such an administrative procedure before the French Trademark Office (Institut National de la Propriété Industrielle, or INPI), insofar as, to date, this administrative procedure does not exist.

## IV. STANDING

### A. On Basis of Grounds

- Parties that have legal standing to apply for cancellation vary, depending on the grounds for the action.
- For cancellations based on absolute grounds, the following parties have standing:
  - any interested person. Legal interest is required.
- For cancellations based on relative grounds, the following parties have standing:
  - The owner of a previous right (e.g., copyright, trademark).
- For cancellations based on non-use grounds, the following parties have standing:

- any interested person. Legal interest is required.

## B. "Person"/"Interested Person" Defined

- For purposes of standing, a "person" is defined as:
  - both natural and juridical persons.
- For purposes of standing, an "interested person" is defined as:
  - someone who believes he is being damaged by the registration;
  - someone who has filed an earlier pending application to register a conflicting trademark;
  - someone who owns an earlier conflicting trademark registration;
  - someone who owns earlier rights in a copyright or design that conflicts with the mark that is the subject of the trademark application;
  - someone who is a licensee of any conflicting trademark or other intellectual property right (in the event that (i) the licensee has sent a cease and desist letter to the trademark owner to force his bringing a legal action and (ii) such letter remains without effect (no legal action brought by the trademark owner). This applies for actions based on trademark infringement.);
  - someone who owns a company name that conflicts with the subject of the trademark application;
  - someone who is of the opinion that the mark was not registrable (on absolute grounds).

## C. Domestic/Foreign Applicant

- The legal standing criteria for domestic and foreign applicants are the same regardless of the grounds for cancellation.

## D. Multiple Applicants

- More than one applicant may apply jointly for a cancellation based on:
  - absolute grounds.
  - relative grounds.
  - non-use grounds.

## E. Infringement Defendant as Applicant

- In a court action for trademark infringement, cancellation may be sought by a defendant.

## V. REPRESENTATION

### A. Qualifications

- The applicant is always required to appoint a representative in cancellation proceedings.
- The representative (attorney, agent or other legal representative) must be domestic, e.g., with an office in the jurisdiction.
- There are no additional professional qualifications that are required of a representative in cancellation proceedings.

### B. Power of Attorney/Notarization/Legalization

- A signed power of attorney need not be provided to a representative by an applicant to cancellation proceedings.

- There are no notarization/legalization requirements for a power of attorney form in cancellation proceedings.

## VI. COMMENCEMENT

### A. Timing

- Cancellation proceedings that are independent of opposition proceedings may never be commenced before a mark is registered.

### B. Deadline

- The deadline for bringing cancellation proceedings varies, depending on the grounds.
  - For proceedings based on absolute grounds, the deadline is: end of validity of the mark.
  - For proceedings based on relative grounds, the deadline is: five years from the registration. In the case of bad faith, the deadline is five years for both civil and commercial matters (Law dated June 17, 2008).
  - For proceedings based on non-use grounds, the deadline is: five years from the publication of the registration or five years from the last use of the mark.
  - For proceedings based on grounds other than absolute, relative and non-use grounds, the deadline: depends upon the ground.

### C. Statute of Limitations

- The statute of limitations or acquiescence provisions that will prevent cancellation vary, depending on the grounds.
  - For proceedings brought on absolute grounds, the statute of limitations or acquiescence provision is: end of validity of the mark.
  - For proceedings brought on relative grounds, the statute of limitations or acquiescence provision is: five years from the registration of the mark. In the case of bad faith, the deadline is five years for both civil and commercial matters (Law dated June 17, 2008).
  - For proceedings brought on non-use grounds, the statute of limitations or acquiescence provision is: five years from the publication of the registration or five years from the last use of the mark.
  - For proceedings based on grounds other than absolute, relative and non-use grounds, the statute of limitations or acquiescence provision: depends upon the ground.

## VII. PARTIAL CANCELLATION

- Partial cancellation of a registration is possible, regardless of the grounds.
- For single-class registrations and for multiclass registrations, it is possible to apply for cancellation of some of the goods either within the single class or within a given class, as appropriate, without applying for cancellation of all of the goods within the class.

## VIII. LENGTH OF PROCEEDINGS

- The average duration of cancellation proceedings is: It depends on the complexity of the case, and on the appeal that the parties may or may not file.
- After final arguments have been made and/or oral hearings have taken place, a decision will be rendered within the following time frame: The time frame is determined by the judge and may vary from a few days to several weeks.

## IX. COSTS AND FEES TO INITIATE

- The following costs and fees are associated with initiating cancellation proceedings:
  - attorney fees;
  - statutory or regulatory fees.
- No official fees are refundable if an application for cancellation is withdrawn, regardless of the grounds for cancellation.
- If an application for cancellation is based on multiple grounds, no additional official fees are due.

## X. DOCUMENTATION / NOTARIZATION / LEGALIZATION REQUIREMENTS

- No documents need be notarized or legalized in cancellation proceedings.
- The documentation that must be submitted and the procedures necessary to initiate cancellation proceedings are the same regardless of the grounds for cancellation and are as follows: A writ of summons must be filed before the Tribunal de Grande Instance in order to commence the cancellation proceedings.

## XI. DISCOVERY

### A. Interrogatories

- No party may request that any other party answer written questions, under oath ("Interrogatories"). French law does not provide for Interrogatories in trademark cancellation proceedings.

### B. Document Requests

- Any party may request that any other party produce documents in response to written document requests ("Document Requests").
- The general rules concerning the timing, number and scope of Document Requests are: Document Requests can be submitted at any time during the course of the proceedings, before the closure.
- If the requested party fails to provide documents in response to Document Requests, in whole or in part, the procedure by which the requesting party can compel compliance is as follows: The requesting party can ask the judge to order the requested party to provide some documents.
- If the requested party fails to provide documents in response to Document Requests, in whole or in part, the consequences are as follows: The judge can make a restriction order to have the document provided, and can take the failure into account when he has to enter his judgment.
- The grounds upon which a party may justify its refusal to respond to Document Requests, in whole or in part, and the circumstances in which these grounds are applicable are as follows: The two major grounds are "force majeure" and professional secrecy.
- Documents obtained in response to Document Requests may be used as evidence in the action.

### C. Depositions

- No party may request that one or more witnesses for any other party appear in person to be cross-examined under oath ("Depositions").

## XII. BURDEN OF PROOF

- The burden of proof can shift to the other party during the course of cancellation proceedings under the following circumstances: French civil law states that the party

that is claiming the execution of an obligation has the burden of proof. In the case of cancellation for non-use, the burden of proof lies on the defendant, who has to prove that he has made serious use of his mark.

### **XIII. WRITTEN ARGUMENTS**

#### **A. Requirement/Deadline**

- Written arguments are mandatory. As the proceedings take place before the Tribunal de Grande Instance, written arguments are mandatory.
- The deadline for submitting written arguments is determined by scheduling order or ruling of the court, other judicial tribunal or administrative body and is: as a general rule, compulsory.

#### **B. Extensions to File**

- Extensions of time are available to the applicant to file written arguments.
  - The duration of the extension is: decided by the judge, depending upon the reasons why he granted the extension.
  - The following number of extensions are available: Usually, only one extension is available.
- Extensions of time are available to the respondent to file written arguments.
  - The duration of the extension is: determined by the judge.
  - The following number of extensions are available: Usually, only one extension is available.
- Extensions do not require the consent of the adverse party.
- Extensions require the approval of the court, other judicial tribunal or administrative body.
- No official fees are required to obtain extensions.

### **XIV. ORAL HEARINGS**

- Oral hearings are permitted in cancellation proceedings.
- The determination of whether oral hearings will take place is made by: Usually, whenever a party has to file a brief, a short oral hearing is scheduled. The schedule of such hearings is determined by the judge. A final oral pleading on the merits always takes place before the Tribunal de Grande Instance.

### **XV. EVIDENCE**

#### **A. To Establish Absolute Grounds**

- The following types of evidence may be submitted to establish absolute grounds: All types of evidence can be submitted to the judge to establish absolute grounds.
- Evidence must be submitted to: the other party, during the course of the proceedings; and the judge, before the pleading.
- Evidence must be submitted by the following deadline: A schedule is determined by the judge. Evidence must always be submitted to the other party before the closing of the proceedings.

#### **B. To Establish Relative Grounds**

- The following types of evidence may be submitted to establish relative grounds: All types of evidence can be submitted to the judge to establish absolute grounds.
- Evidence must be submitted to: the other party, during the course of the proceedings; and the judge, before the pleading.

- Evidence must be submitted by the following deadline: A schedule is determined by the judge. Evidence must always be submitted to the other party before the closing of the proceedings.

### C. To Establish Non-Use Grounds

- The following types of evidence may be submitted to establish non-use grounds: Every type of evidence can be submitted to the judge to establish non-use grounds.
- Evidence must be submitted to: the other party, during the course of the proceedings; and the judge, before the pleading.
- Evidence must be submitted by the following deadline: A schedule is determined by the judge. Evidence must always be submitted to the other party before the closing of the proceedings.

### D. To Establish Other Grounds

- Not Applicable

### E. Applicant's Proof of Use

- The applicant is not required to submit proof of use of the mark on which the cancellation is based. The cancellation request can be made, either at a first-level claim (the applicant brings an action to request the cancellation of the trademark at stake), or at a defending level (the applicant has been sued by the trademark owner for copyright infringement and, as a counterclaim, requests the cancellation of the trademark at stake). The trademark owner is the one who is required to submit proof of use of the trademark at stake.

### F. Applicant's Extensions of Time

- Extensions of time available for the applicant's submission of evidence are the same regardless of the grounds on which the cancellation proceedings are based. Extension is possible for: There is no statutory basis for an extension. An extension may be allowed depending on the facts. For example, an applicant that is a foreign entity/natural person may require more time to translate written arguments or pieces of evidence.
- No official fees are payable to obtain an extension for submitting evidence.

### G. Additional Evidence

- Additional evidence may not be submitted at a later stage in the cancellation proceedings.

### H. Evidence in Reply/Deadline and Extensions

- Evidence in reply is optional.
- Evidence in reply must be submitted by the following deadline: as scheduled by the judge.
- The following extensions of time for the respondent's submissions are available: as decided by the judge.
- No official fees are payable to obtain extensions.
- Petitioner can demand that respondent provide additional particulars relating to respondent's proffered evidence, using the following procedure: petitioner can file a formal notice in the course of the proceedings.

### I. Proof of Respondent's Use

- The respondent may submit the following kind of evidence to prove use:



- invoices;
- catalogues;
- evidence of turnover;
- packaging;
- labels;
- price lists;
- advertisements;
- written statements;
- market surveys;
- use of the mark on the Internet;
- maintenance of a website (The use of the trademark on a website may be deemed an element of proof, irrespective of whether the website is interactive.);
- use of the mark on a social media site;
- any other use that may be deemed effective by a French judge, provided that it targets the market of the trademark at stake.
- In assessing whether "use has been made," sufficient use is demonstrated by: Use has to be serious and genuine in connection with the goods and services referred to in the registration. Sufficient use is demonstrated by a genuine use in connection with the goods and/or services referred to in the registration.
- The following factors are considered when determining whether a mark has been sufficiently used:
  - the nature of the goods or services at issue;
  - market characteristics;
  - the scale and frequency of use of the mark;
  - other:
- Respondent can demand that petitioner provide additional particulars relating to petitioner's proffered evidence, using the following procedure: Respondent can file a formal notice in the course of the proceedings.

## J. Consequences of Failure to Respond

- The consequences if a respondent fails to file a response in answer to a petition for cancellation are as follows:
  - The court, other judicial tribunal or administrative body must consider and decide the matter on the merits despite such failure, relying on the documents or other evidence filed by the petitioner.

## XVI. DEFENSES

### A. Acquired Distinctiveness

- Acquired distinctiveness can be a valid defense to cancellation proceedings based on absolute grounds. The following criteria are used to establish acquired distinctiveness: The sign must have been used as a mark to designate the products of the owner of the mark and must have presented a feature of distinctiveness, even if very slight.

### B. Excusable Non-use

- Non-use can be excused, thereby avoiding cancellation, if: there is an action before the European Commission in order to have a French administrative decision cancelled; while awaiting the official authorization for marketing a pharmaceutical product; while awaiting any administrative authorization.

## XVII. MONETARY AWARDS/ATTORNEY FEES

### A. Basis/Amount of Award

- A cancellation decision may include a formal monetary award against the losing party regardless of the grounds for cancellation. A judge can allow awards to a party.
- Monetary awards are based on:
  - actual losses; or any kind of prejudice demonstrated, such as non-pecuniary damages or damages to reputation. If the cancellation is the result of the infringement of a trademark, the profits gained by the infringing party may also be taken into account.
- The amount of a monetary award is likely to be influenced by the following circumstances: The judge can take many circumstances into account, such as bad faith and unjust enrichment, insofar as these circumstances are direct damages.

### B. Attorney Fees

- The successful party is entitled to recover attorney fees in cancellation proceedings, regardless of the grounds for cancellation. In France, unlike other jurisdictions, this does not ensure for the winning party the recovery of all attorney fees, but only an amount decided by the judge, usually a fraction of such fees.
- The award of attorney fees in cancellation proceedings is:
  - discretionary.

## XVIII. CONCLUSION OF PROCEEDINGS

### A. Effect of Decision

- A decision in cancellation proceedings is valid against all third parties, regardless of the grounds on which the proceeding was brought.
- A decision ordering cancellation of a mark takes effect: (a) between the parties, as soon as the judgment has been served to the other party and an appeal is no longer possible; (b) against third parties, when the judge has communicated the decision to the INPI and it has published the decision.

### B. Withdrawal or Termination of Proceeding/Costs

- Cancellation proceedings based on any grounds can be terminated by withdrawing the cancellation application regardless of the grounds for cancellation.
- Withdrawal of a cancellation application based on any grounds requires the approval of the court, other judicial tribunal or administrative body regardless of the grounds for cancellation. As a general rule, the judge renders a decision to confirm the withdrawal of the cancellation, but it is not necessary to have the withdrawal of the cancellation take effect; the judge's decision is an administrative way to enforce the withdrawal of the cancellation.
- Withdrawal of a cancellation application based on any grounds requires the approval of the other party to the proceedings regardless of the grounds for cancellation.
- When cancellation applications are withdrawn, the cost of the proceedings is borne by: the plaintiff, unless otherwise agreed.

## XIX. APPEALS

### A. Availability/Deadline

- A cancellation decision may be appealed.
- Appeals of cancellation decisions must be brought before the following deadline: The time limit starts running when a party serves the judgment on the other party. The

time limit is one month after service of the decision.

## B. Forum

- Regardless of the grounds for cancellations, appeals are heard by
  - the following court or other judicial tribunal: Cour d'appel (Court of Appeal).

## C. New Evidence

- New evidence may be submitted on appeal.

## D. Representation/Cost/Awards

- The approximate cost range of official fees (in local currency) to file an appeal is: While court costs are nominal, the parties must be represented by a lawyer, whose fees depend on the extent of work to be performed (in particular, depending on the complexity of the file).
- Specialist counsel is required for an appeal of a cancellation decision.
- An appeal decision can include a monetary award against the losing party, even if the earlier decision did not include a monetary award. The approximate award, in local currency, would be an amount that depends on the circumstances and is determined by the judge.

## E. Scope

- An appeal consists of a complete rehearing of the matter.

## F. Further Appeals/Alternatives to Appeal

- Appeal decisions may be further appealed.
  - Appeal decisions may be further appealed to: Cour de cassation (Supreme Court).
  - Details regarding the deadlines and fees for further appeal are as follows: two months from the date on which the decision was served upon the losing party.
- There is no alternative procedure to an appeal.

## XX. CONSEQUENCES

### A. Revocation or Invalidation

- A mark that is revoked does not differ from a mark that is declared invalid following cancellation proceedings.

### B. Licenses, Assignments, Other Transactions

- Because a mark that is revoked does not differ from a mark that has been invalidated in cancellation proceedings, the consequences for licensing agreements are the same, and are: A license agreement based on a trademark that has been cancelled/revoked/invalidated is null and void.
- Because a mark that is revoked does not differ from a mark that has been invalidated in cancellation proceedings, the consequences for assignments are the same, and are: An assignment based on a trademark that has been cancelled/revoked/invalidated is null and void.
- Because a mark that is revoked does not differ from a mark that has been invalidated in cancellation proceedings, the consequences for past transactions are the same, and are: When a trademark is cancelled/revoked/invalidated, the rights to the trademark are deemed to have never existed and all past transactions involving the trademark, as a general rule, are deemed null and void.

## XXI. NOTIFICATION TO TM OFFICE

- Following a decision to cancel a mark, the Trademark Office must be formally notified of the cancellation, regardless of the grounds on which the proceedings were brought.
  - The following party has responsibility to notify the Office: Any party, as well as the court registrar or the judge, can ask the INPI to have the cancellation registered.
  - The deadline to make the notification is: There is no specific deadline, but the court decision must be definitive (i.e., there must be no appeal filed).
- The consequences of failing to meet the deadline to notify the Trademark Office are: If the notification of INPI is not done, the cancellation is of no effect against third parties.

## XXII. REILING OF IDENTICAL MARK

- There are limitations as to when an application to register the mark can be refiled depending on the grounds for the cancellation proceedings.
- There are no time limits for reiling following the cancellation of a mark.

## XXIII. COLLECTIVE MARKS

- Collective marks may be registered in this jurisdiction. Collective marks are defined as: A mark shall be known as a collective mark if it may be used by any person who complies with regulations for use issued by the owner of the registration.
- The provisions discussed throughout this jurisdictional profile all apply to the cancellation of collective marks.

## XXIV. CERTIFICATION MARKS

- Certification marks may be registered in this jurisdiction. Certification marks are defined as: A collective certification mark shall be annexed to goods or services that display, in particular, with regard to their nature, properties or qualities, the characteristics detailed in the respective regulations.
- There are certain unique provisions in the law of this jurisdiction in relation to the cancellation of certification marks on absolute, relative, non-use or other grounds as follows: Invalidity of the registration of a collective certification mark may be ordered on a petition by the public prosecutor or at the request of any concerned person if the mark does not meet any of the requirements that apply to collective marks.

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