

## Protection of IP

### France

#### **I. TRADE MARKS**

##### **I.1 INTRODUCTION**

In France, trade marks are protected by Book VII of the French Intellectual Property Code (the Code), the provisions of which were modified by the Act n°91-7 of January 4 1991, which implemented the Trade Marks Directive, and by the French Act no. 2007-1544 of 29 October 2007, which modified several provisions of the Code.

##### **I.2 REGISTERED TRADE MARKS**

According to Book VII of the Code, a person may register as a trade mark any sign which is capable of graphic representation and which serves to distinguish the goods or services of a natural or legal person. The registration will be refused if the sign is devoid of distinctive character, is descriptive of the goods or services for which it is to be registered, or is exclusively constituted by the shape resulting from the nature or function of the product or which gives the product its substantial value.

The registration of a mark may also be refused if:

- it is liable to mislead the public, particularly regarding the nature, quality or geographical origin of the goods or services;
- it is identical to an earlier trade mark which has been registered or which is well known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property;
- it is identical or similar to an earlier name or style of a company, where there is a risk of confusion in the public mind;
- it is identical or similar to a trade name or mark known throughout France where there exists a risk of confusion in the public mind;
- it infringes previously existing rights: in particular, protected appellations of origin, authors' rights, rights deriving from a protected industrial design, the personality rights of another person (particularly his surname, pseudonym or likeness) or the name, image or repute of a local authority.

The owner of a registered trade mark has the exclusive right to use the mark in relation to the goods or services for which it is registered and the right to bring an action for trade mark infringement against third parties who:

- use an identical mark for similar products or services, if there is a likelihood of confusion in the mind of the public;
- use similar mark for goods or services which are identical or similar to those designated in the registration, if there is a likelihood of confusion in the mind of the public.

Trade mark registrations last for an initial period of 10 years and can be renewed for periods of 10 years thereafter.

## **2. PATENTS**

### **2.1 INTRODUCTION**

In France, patents are governed by Book VI of the French Intellectual Property Code, the provisions of which were modified by the French Act no. 2007-1544 of 29 October 2007.

Book VI of the French Intellectual Property Code does not define which inventions might receive protection, but it provides that the invention:

- must be new (an invention shall be considered as new if it does not form part of the state of the art, ie information which is available to the public prior to the filing date of the application. The inventor must therefore keep the invention strictly confidential until the patent application is filed);
- must involve an inventive step (an invention shall be considered as involving an inventive step if, for a skilled person, it does not obviously result from the state of the art);
- must be capable of industrial application (an invention shall be considered capable of industrial application if it can be made or used in any kind of industry, including agriculture).

There are certain inventions which cannot be protected by a patent, for example:

- scientific and mathematical discoveries;
- aesthetic creations;
- computer games and programs;
- inventions which are held to be immoral or contrary to public order;
- parts of the human body and their products.

France uses the first to file system. A patent confers on the owner an exclusive right and allows the inventor to prevent third parties from using the invention without prior consent.

A patent lasts for a period of 20 years from the date of filing the application.

### **2.2 DISTANCE SELLING AND E-COMMERCE**

The E-Commerce Directive 2000/31/EC was implemented in France by the Act no.2004-575 of June 21 2004, relating to secure e-commerce.

The E-Privacy Directive was implemented in France in two stages, first by the Act no. 2004-575 of June 21 2004 relating to secure e-commerce, then by the Act no. 2004-801 of August 6 2004 relating to the protection of data subjects and the processing of personal data.

The “Trusting the Digital Economy” Act no. 2004-575 of 21 June 2004, enacted for the purpose of securing e-commerce, as supplemented by the French Decree no. 2005-674 of 16 June 2005, enables “certain contractual formalities to be carried out by electronic means”, and modified several provisions of the French Civil Code. It was further modified by the French “Crime Prevention” Act no. 2007-297 of 5 March 2007 which reinforced incriminations for cybercrime and communications law.

The French Decree no. 2001-741 of 23 August 2001 was also adopted to implement the provisions of the EC distance Selling Directive 97/7/EC in France.

The French “Chatel” Act no. 2008-3 of 3 January 2008 also introduced new provisions relating to e-commerce.

### **2.3 DATA PROTECTION**

France implemented the Data Protection Directive through the French Data Protection Act of January 6 1978, as amended by the French Act of 6 August 2004. The French Data Protection Act concerns automatic and non-automatic processing of personal data which is or may be contained in a personal data filing system. The Act imposes duties on data controllers regarding:

- the collection of data;
- the purpose of such collection;
- the duration for which the collected data may be stored;
- the security and confidentiality of the collected data; and
- the notification of such data collection to the CNIL (“*Commission Nationale de l’Informatique et des Libertés*”).

The penalties for failing to comply with these duties include financial penalties, injunctions, interruptions to the collection process, and notification to the prime minister. A sentence of 5 years imprisonment and a fine of up to EUR 300,000 can also be ordered under the French Criminal Code.

### **2.4 REGISTERED DESIGNS**

Registered designs are governed by the Industrial Designs Law of July 14 1909, the provisions of which are incorporated in Book V of the Code as amended by the French Act no. 2007-1544 of 29 October 2007. The French Decree no. 2001/270 of 25 July 2001 implemented the EC Designs Directive.

For a design to be registered in France, it must be new and have individual character. The artistic merit of the design is not taken into consideration.

Registration takes effect, as from the filing date of the application, for a period of five years, which may be extended by further periods of five years to a maximum of twenty-five years.

Registration confers a monopoly right on the owner to use the registered design and to bring an action for design infringement against third parties who use an identical design or reproduce the

essential characteristics of the registered design. It is not necessary to prove the likelihood of confusion between the registered design and the infringing design.

Registered designs may also be protected by Books I and III of the French Intellectual Property Code giving protection to “*droits d’auteur*” (see Copyright/Author’s Rights).

## 2.5 CONFIDENTIALITY AND KNOW HOW

In France, there is no formal protection of confidential information, trade secrets or know how. Confidential information, trade secrets and know how may therefore only be protected under confidentiality agreements.

## 2.6 COPYRIGHT (“DROITS D’AUTEUR”)

“*Droits d’auteur*” is governed by the Act of March 11 1957 regarding literature and artistic property, the provisions of which are incorporated within Books I and III of the Code, as amended by the French Act no. 2007-1544 of 29 October 2007.

“*Droits d’auteur*” protects any intellectual creation, provided that it is original. A work is original if it bears the stamp of the author's personality. Ideas per se are not protected and there must be some element of creative effort.

Book I of the Code provides a (non-exhaustive) list of “*oeuvres de l’esprit*” or ‘products of the intellect’, including:

- literary works, journalistic or scientific articles, brochures;
- conferences, court submissions (but not statute or case law), sermons, etc;
- dramatic or musical works;
- musical compositions, with or without works;
- drawings, maps, paintings, architecture, sculpture, photographic works, engraving and lithography;
- graphical and typographical works;
- works of applied art; and
- software.

The right lasts for the life of the author plus 70 years from the end of the calendar year of his death.

The right of the author is infringed by complete or partial performance, reproduction or translation, adaptation or transformation, arrangement or reproduction by any technique or process whatsoever, made without the consent of the author or his successors in title or assignees.

### **3. PROTECTION OF IP RIGHTS**

#### **3.1 REGISTRARS**

The National Institute of Industrial Property has jurisdiction to rule on requests to oppose, invalidate or revoke applications.

##### **3.1.1 Patents**

The procedure for applying for a patent is set out in Book VI of the Regulations section of the Code. Application for registration may be filed either with the National Institute of Industrial Property or with any Prefecture except Paris. The use of a patent agent is not necessary but is highly recommended for the purpose of describing the invention and its specifications and claims. The name of the applicant and of the inventor must be stated in the application. The applicant may not necessarily be the inventor. For example, inventions created by an employee will be automatically transferred to the employer if the conditions of Article L.611-7 of the Code are fulfilled.

Only the applicant has a monopoly right in respect of the invention.

Applications are reviewed by the Ministry of National Defence and by the National Institute of Industrial Property who then inform the applicant or his intellectual property agent whether the invention may be disclosed to the public. A search of prior art is carried out by an examiner and 18 months after the application, there is a publication in the *Bulletin Officiel de la Propriété Industrielle* (BOPI).

##### **3.1.2 Trade Marks**

The procedure for applying for a trade mark is outlined in Book VII of the Regulations section of the Code. Applications are filed either with the National Institute of Industrial Property or with the Clerk of the Commercial Courts or High Courts which have jurisdiction in the applicant's place of residence. In practice, applications are always filed with National Institute of Industrial Property.

Once it has been filed, the application is examined by the Director of the National Institute of Industrial Property. If no objections are raised, the application will be published in BOPI.

For a period of two months following the publication of the application in BOPI:

- any interested person may submit observations to the Director of the National Institute of Industrial Property; and,
- the owner of an earlier mark can file an opposition to registration before the Director of the National Institute of Industrial Property. The Director of the National Institute of Industrial Property may refuse or accept the registration of the trade mark. It is possible to appeal against such a decision before the Appeal Court of Paris.

### 3.1.3 Designs

The procedure for registering a design is developed in Book V of the Regulations section of the Code. Applications are filed either with the National Institute of Industrial Property, or with the Clerk of the Commercial Courts or High Courts which have jurisdiction in the applicant's place of residence. Intellectual property agents are often used although it is not necessary to do so. The application will be published within 30 months of the application.

### 3.2 COURTS

The jurisdiction rules pertaining to intellectual property rights were modified by the French Act no. 2007-1544 of 29 October 2007, whose provisions were supplemented by the French "Modernisation of the Economy" Act no. 2008-476 of 4 August 2008.

IP litigation is now a matter for specialist courts in France. The French High Courts (Tribunal de Grande Instance) which are specified by Decree now have exclusive jurisdiction over patent, trade mark, copyright, and registered design matters.

With regard to infringements which also constitute an offence in France, an action may be brought before the Criminal Court "*Tribunal Correctionnel*".

Proceedings may be brought to obtain the seizure of counterfeit goods and information, including details of the quantities sold and the name of the manufacturer(s). Such claims are usually initiated in France prior to seeking damages and measures to prevent publication. A request in that respect has to be filed before the Judge. Infringers are not notified at this stage and are therefore not aware of the imminent seizure. Summary proceedings can also be brought to have the infringement stopped immediately.

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