



INPI LAW

JOURNAL

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The **INPI LAW JOURNAL** is a newsletter published in English by the Institut national de la propriété industrielle (**INPI**) for a non-French-speaking readership. It covers changes in French law and court rulings on intellectual property in France, the INPI's new missions pursuant to the French PACTE Law, its work with regard to the examination of applications for intellectual property rights, its decisions further to the newly deployed procedures to invalidate and revoke trademarks and oppose patents, and technological upgrades made to its services (digitisation, open data, artificial intelligence, and more).

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Focus

Approval of France's 13th geographical indication: "Poteries d'Alsace Soufflenheim/Betschdorf"

In 1992, [Council Regulation No. 2081/92](#) introduced Community protection for geographical indications (GIs) and designations of origin for agricultural products and foodstuffs. In 2016, France's "Consumer Protection" law ¹ extended the scope of protection by geographical indication to industrial and artisanal products (such as granite from Brittany and porcelain from Limoges).

Geographical indications offer numerous benefits, for both producers and consumers. Managed by INPI, the official French label for GIs is used on industrial and artisanal products that have a specific geographical origin and possess qualities, characteristics or a reputation that are due to that origin². Only the presence of the official "*indication géographique*" label guarantees the product's authenticity.

Geographical indications have several objectives. They notably aim to:

- Protect know-how and the associated product's identity.
- Provide consumers with a guarantee of not only the origin and quality of a product purchased in a traditional sales outlet or via an online platform, but also the know-how behind it.
- Foster growth in regional areas by:
 - o Structuring the production chain locally.
 - o Protecting and promoting local producers, whose products have a reputation that is too often misappropriated by others.

- o Boosting employment by preserving local know-how.
- o Attracting the public's attention to products from a specific geographical area.

Essentially, a geographical indication is a type of industrial property right, and it can only be used by companies that comply with a set of specifications³.

Drafted by the group of local stakeholders applying to have the GI approved (the "ODG", protection and management body), these specifications must describe, in 12 points⁴, the product's specific characteristics and how they relate to a given geographical area. As a result, an application to have a GI approved can only be made by a trade association that is representative of the producers concerned (manufacturers or artisans). Once the application has been filed, INPI opens a public inquiry, that lasts two months, on the specifications drafted by the ODG. At the end of this period, INPI first submits a summary of the inquiry results to the ODG, together with any recommendations, then makes its decision on whether to approve or reject the application.

Registered geographical indications protect against the use of any name evoking the approved GI. The rights conferred are enforced by various agencies, including France's fraud squad (DGCCRF).

¹ See [French Law No. 2014-344 of 17 March 2014 on Consumer Protection](#).

² See the definition of a geographical indication on the [World Intellectual Property Organization's website](#).

³ See "[Que doit comporter le cahier des charges?](#)".

⁴ List from [Article L. 721-7 of the French Intellectual Property Code](#): name of the geographical indication, product in question, limits of the geographical area, quality

of the product, description of the fabrication process, identity of the ODG, frequency and method of control, reporting obligations, method for serving notice in the event of non-compliance with the specifications, projected funding of the ODG, labelling requirements, social and environmental commitments.

EU-wide extension

While a legal framework for protecting local know-how already exists in France, thanks to its industrial and artisanal GIs, EU-wide recognition of non-agricultural indications is one of the key industrial property challenges for France's presidency of the Council of the European Union. Member States seem to be moving towards a system to protect non-agricultural GIs. This would enable registered artisanal and industrial GIs to be recognized throughout the European Union⁵. The European Union Intellectual Property Office (EUIPO) based in Alicante, Spain, will probably be tasked with the registration of national GIs at the Union level⁶.

A new addition

While the first French GI was approved on 2 December 2016 ("*Siège de Liffol*", for chairs made using unique know-how in a specific area of eastern France near the Vosges mountains), INPI is now up to its 13th!

In a [press release](#) dated 11 March 2022, INPI announced the publication in France's Official Bulletin of Industrial Property ([No. 22/10](#), 11 March 2022) of the INPI CEO's decision to approve a new geographical indication – "*Poteries d'Alsace Soufflenheim/Betschdorf*"⁷ [Alsatian pottery from Soufflenheim/Betschdorf].

The application for this GI was filed by the Northern Alsace potters association and covers all stages in the production of the pottery in question (fabrication and decoration of the products). The new GI covers 97 municipalities in France's Bas-Rhin department and protects 12 entities, i.e. all the pottery businesses in the geographical area concerned. This is the second GI registered for France's Grand-Est region and France's second GI relating to tableware⁸.

A little history

Pottery has a very long history in Alsace; the high-quality clay from the Rhine plain has been moulded since the polished stone age. Over time, the region's potters – known as *Schüsseldreher* or "bowl turners" – have created a variety of colourful, robust pieces in glazed earthenware, used primarily for cooking and conserving food or as decorative items.



© Association des potiers d'Alsace du nord

The villages of Betschdorf and Soufflenheim are now home to all the region's potters, making them key destinations for tourists visiting Alsace.

While potters in Betschdorf and Soufflenheim use the same shaping process, each village has developed its own traditional finishing techniques.

As a result, pottery protected by this new geographical indication must carry the name of one of the two villages in question depending on the technique used, i.e. "*Poteries d'Alsace – Soufflenheim*" or "*Poteries d'Alsace – Betschdorf*". ■

By Baptiste Deschamps, Legal expert, Legal and International Department, INPI

⁵ See the [proposal for a regulation on geographical indication protection for craft and industrial products](#) : Proposal ; [PIBD 2022,1180,1-2](#).

⁶ See the interview with Antoine Ginestet on the use of artisanal and industrial geographical indications as a means of promoting know-how, available (in French only) on [INPI's website](#).

⁷ See the [notice of approval of the geographical indication "Poteries d'Alsace Soufflenheim/Betschdorf"](#) published in Official Journal No. 59 of 11 March 2022.

⁸ The others are "*Siège de Liffol*" [Liffol chair], approved on 2 December 2016 and "*Porcelaine de Limoges*" [Limoges porcelain], approved on 1 December 2017. Click [here](#) to see the complete list of French geographical indications.

French Case Law

Below and in the PIBD, INPI's law review (in French), you can read about various decisions handed down by the French courts and commented on by INPI's legal experts.

Trademarks

Court of Cassation, 17 March 2021: Does fraud equal bad faith? Following this ruling on an action for a declaration of invalidity of a French trademark on the ground of fraud in filing the application, this question was addressed in an [analysis published in the PIBD](#). Sections of the analysis are devoted to the impact of the EU trademark reform package (following which **bad faith filing was introduced as a new absolute ground for invalidity** in French law), as well as to French judicial practice and to the influence of Court of Justice of the European Union (CJEU) case law.

Paris Court of Appeal, 1 July 2021: [Rejection of an application seeking a ban on the marketing](#) of perfumes and cosmetics via an online sales platform in disregard of a selective distribution network. As a hosting provider, the platform operator is eligible for the exemption from liability provided for in Article 6 I. 2 of the "French law for confidence in the digital economy" (LCEN). According to the facts of the case, the platform operator cannot be considered a publisher because an active role giving the operator knowledge or control over the information relating to these offers for sale was not clearly established, as required in the interlocutory proceedings. The operator's role is one of simple intermediation and does not involve its direct intervention in the products sold.

Paris Court of Appeal, 14 December 2021: [Confirmation of detriment to the reputation](#) of Citroën's figurative "double chevron" trademark by the use of fellow car manufacturer Polestar's logo, which features two chevrons positioned to form a star.

Paris Court of Appeal, 17 December 2021: [Confirmation](#) of INPI's rejection of an application to register NORMINDIA as a word mark for alcoholic drinks because it **infringes on the rights conferred on earlier protected geographical indications**: "Cidre de Normandie", "Cidre Normand", "Eau-de-vie de Normandie", "Eau-de-vie de poiré de Normandie" and "Pommeau de Normandie". Given that it could be used on products of a completely different geographical origin than Normandy, it is also of such a nature as to **deceive the public about the geographical origin** of the associated products.

Patents

Court of Cassation, 1 December 2021: Starting point of the time limit for filing an application for the re-establishment of the right to file a request for further processing: [a reversal in case law](#). The Court has established a new principle of law that the starting point for this one-year period is the date of expiration of the two-month time limit for filing a request for further processing. The decision reflects the Court's desire to harmonize INPI's re-establishment of rights procedure with that of the EPO.

Designs

Paris Court of Appeal, 16 November 2021: Patterns characterized by a combination of eyelets and rhinestones arranged in horizontal lines, applied to luxury handbags, cannot be protected by copyright law. Creating a contrast between the "punk rock" look provided by the metal haberdashery elements and the refinement of a luxury accessory is not enough to establish originality. The earliest pattern is [protectable as an unregistered Community design](#) and is infringed by the pattern used on the disputed bag, which is an outright copy.

French IP Law updates

Decree No. 2022-196 of 17 February 2022 relating to the transfer to the CEO of the French Patent and Trademark Office (INPI) of the power to make decisions regarding disclosure and use of invention authorizations and prohibitions.

This decree is issued to implement [Article 28 of French Law No. 2020-1525](#) of 7 December 2020 on the acceleration and simplification of public action (known as the ASAP Law), which has amended [Article L.612-9](#) of France's Intellectual Property Code.

France's national defence authority has the right to examine, in confidence, all French patent applications filed with INPI ([Article L.612-8 of the French IP Code](#)), as well as European patent applications ([Article L.614-3](#)) and international applications ([L.614-19](#)). In practical terms, these applications must be presented within fifteen days of their reception by INPI to specially authorized representatives of the French minister in charge of national defence, who are required to review the applications on INPI's premises ([R.612-26](#)).

Article [L.612-9](#) of the French IP Code requires that authorization be granted before inventions for which patent applications have been filed can be disclosed or used. This requirement effectively serves as a temporary secrecy order, giving the country's national defence authority time to examine each patent application.

If the invention on which the patent application is based is not of interest to the national defence authority, or if no response has been received from said authority within five months of the application's filing date, the secrecy order is lifted and the applicant is allowed to use their invention ([Article L.612-9 paragraph 3](#)).

However, in certain cases, in accordance with paragraph 1 of Article [L.612-10](#) of the French IP Code, the national defence authority can request an extension of the temporary secrecy

order. In such cases, the order prohibiting the disclosure and use of the patent application can be extended for a renewable period of one year but may be lifted at any time.

Failure to comply with these restrictions is punishable by criminal law.

In Article 28 of the aforementioned ASAP Law, the legislator transferred to the CEO of INPI the power to make decisions authorizing the disclosure and use of inventions for which patent applications have been filed, as well as decisions extending or lifting the order prohibiting disclosure and use – a power previously held by the minister in charge of industrial property.

This decree therefore amends the relevant regulatory provisions, contained primarily in Articles [R.612-26](#) to [R.612-28](#) of the French IP Code, and specifies this new power by adding a paragraph 1 *bis* to Article [R.411-1](#) of said code defining INPI's remit.

It should nonetheless be noted that the amendment of Article [R.612-27](#) of the French IP Code by [Article 3](#) of Decree No. 2022-196 results in a sharing of powers between the CEO of INPI, for French patent applications, and the French minister in charge of industrial property, who retains the relevant decision-making powers for European patent applications and international applications for the protection of inventions.

Lastly, this decree also provides for the consequences of said transfer of power by amending Article [R.613-42](#) of the French IP Code to add these decisions by the CEO of INPI to the orders and decrees in secrecy matters, i.e. the administrative acts, in relation to which the judge hearing an appeal must keep the invention secret if its disclosure has not been authorized. ■

By François Montador, Legal expert, Legal and International Department, INPI

The arrival of the first roller coasters was swiftly followed by many others, with various models popping up all over Paris from 1810 onwards. Fierce competition among manufacturers and developers led to numerous patents being filed for new inventions. The French names used for these attractions varied greatly, from things like Swiss, Italian or Bordeaux “mountains” to salutary or aerial “promenades” or races.



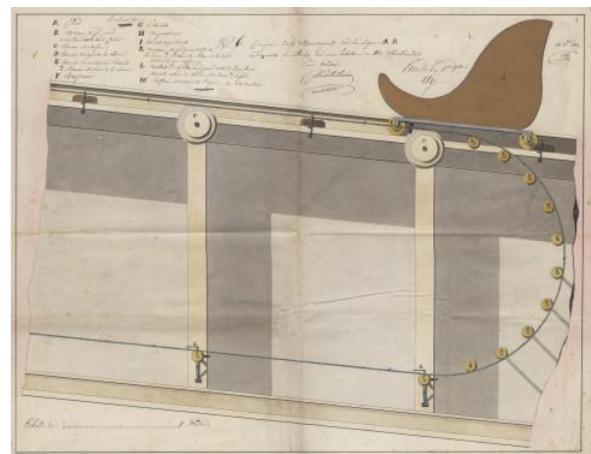
Patent filed on 22 March 1817 by Pillet de Beaumont for the creation of a structure designated by the name “aerial promenade” (Source: INPI archives)

In 1817, a new type of roller coaster was built in the Beaujon gardens near the Champs-Élysées, which at that time was just an alley between two rows of trees. A prelude of things to come, this new model replaced the single-slide structure of its predecessors with two semi-circular tracks sloping down from the same 25-meter-high starting point to reach speeds close to 60 kilometres per hour. After its initial success, the attraction eventually went out of business and closed down in 1824.

In 1818, an Egyptian-themed roller coaster was built in the Delta gardens on Rue du Faubourg-Poissonnière. Antique-style carriages, with no guardrails, were lifted into the air at the starting point via a hoisting mechanism. They then glided along cables supported by a tall, Egyptian-inspired pylon reminiscent of the pillars used for suspension bridges. Poorly designed, this “Egyptian” roller coaster only operated for two years.

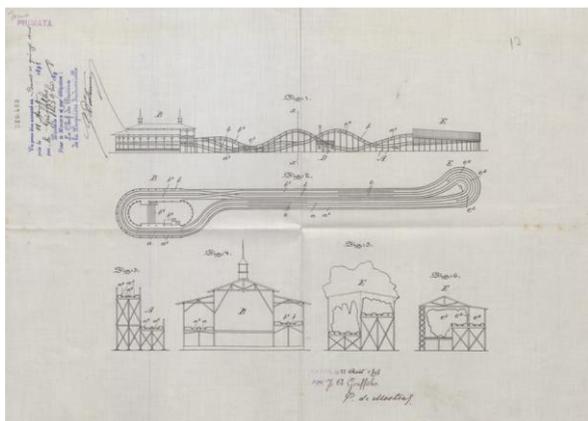
As for safety, a simple strap was the only thing preventing patrons from falling out! An advertisement from the period tried hard to reassure the public: “Although the journey is without danger, and the more timorous ladies may be reassured by the solidity of the

construction and the perfection of the mechanism (hidden from the eye), those who don’t dare ride on it themselves can still enjoy the wonderful view from the pavilion that sits at the top of mountain.” Despite these reassuring words, accidents were frequent and several people died from their injuries. And yet, these incidents also led to the invention and patenting of systems designed to improve safety. In 1817, rails were introduced, and the ingenious device still known today as an up-stop wheel was invented. Used in a three-wheel assembly, up-stop wheels hug the bottom of the rail as they slide along the track, preventing the carriage from coming off.



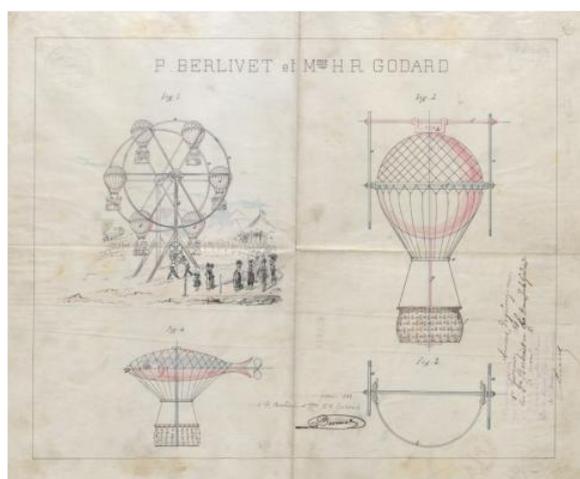
Patent filed on 1 October 1817 by Pierre-Magloire Chatelain for processes used to guide the upward and downward movement of carriages over “artificial mountains” (Source: INPI archives)

Based on designs that were more empiric than scientific, France’s first roller coasters only lasted about twenty years. Deemed to have become too dangerous, most closed down around 1825. The land they stood on, having increased in value, was sold to property developers. It wasn’t until some twenty years later that roller coasters returned to Paris. The world’s first looping roller coaster – called a “centrifugal railway” in press clippings from that period – was probably built in Paris in 1846. It involved a sled being propelled around a vertical loop that was approximately four metres in diameter. None of its tracks, however, formed a complete circuit. The first roller coaster of this type appeared many years later, in the United States in 1884, on the Coney Island site in Brooklyn, New York. Today, Coney Island is still home to famous attractions like the Wonder Wheel and Luna Park.



Patent No. 280 489 filed on 11 August 1898 by Griffiths for improvements to recreational railways known as roller coasters (Source: INPI archives)

The product of numerous technical improvements and inventions patented since the early 19th century, roller coasters continue to evolve today to offer their many fans an ever more emotion-charged experience!



Patent No. 140 903 filed on 1 February 1881 by Pierre Berlivet and Honorine-Rosalie Godard for a type of rotating ride, roller coaster or similar recreational attraction using balloons (Source: INPI archives)

By Steeve Gallizia, responsible for preserving and promoting INPI's heritage archives

(This article also appeared in Journal Spécial des Sociétés, No. 22, page 16, on 21 March 2020).

Creating alerts for trademarks, patents, designs and companies via Data INPI

As part of INPI's policy of **disseminating public data**, it is now possible **to set up alerts** relating to trademarks, patents, designs and companies, **free of charge**, via the Data INPI portal⁹.

These **weekly alerts** enable users **to stay informed** about a particular company or industrial property right. Up to ten alerts can be created at the same time.

There are three types of alerts available:

- alerts relating to a trademark, patent, design or company, based on the registration or publication number of the industrial property right or the company identification number (SIREN);
- alerts relating to new publications in the trademark, patent, design and company databases, based on a key word;
- advanced alerts relating to a single database (trademarks, patents, designs or companies), based on several criteria.

In practical terms, these alerts might be used, for example, by a local authority wishing to be notified of any trademark applications containing its name¹⁰, by a company keen to monitor its competitors' patent filing activity, or by a designer who hopes to enter the handbag market and wants to be informed of all the handbag designs registered.

In addition to this free service, INPI also offers **paid searches** conducted by INPI experts, which provide companies with the assurance they need to carry out their projects. ■

⁹ See [INPI's website](#) for updates and instructions.

¹⁰ This new alert function replaces the alert service for public authorities that was previously linked to INPI's trademark database. A [page](#) dedicated specifically to local authorities

and public establishments of inter-municipal cooperation (EPCIs) provides instructions on how to recreate an alert in the new system.

International IP Law news

Update on the network of anti-counterfeiting committees set up by INPI

Today more than ever, the sale of counterfeit products is a major problem, accounting for 6.8% of all goods imported into the European Union. This illicit trade particularly impacts France, which continues to be the number one country in Europe, and the number two country in the world, affected by counterfeiting¹¹. Over the past two years, the situation has been exacerbated by the global pandemic and the resulting surge in online sales¹². The counterfeit trade now affects all sectors and product types and makes use of all the available channels, including express courier and postal services¹³.

It's impossible to combat counterfeiting at the national level alone. More than ever before, international cooperation is crucial. It is only by acting in concert that we'll be able to defend the interests of legitimate businesses, boost consumer confidence and, as a result, stimulate growth worldwide.

With this in mind, INPI¹⁴ set up a network of anti-counterfeiting committees in 2018¹⁵. Designed to enhance visibility, facilitate experience sharing and allow the committees to support each other's initiatives, the network enables the French office to communicate with numerous partners. Interaction with other anti-counterfeiting networks around the world is notably carried out through INPI's international network of counsellors¹⁶. Another key objective of this international network is to position INPI representatives in various countries around the

world in order to help French companies address any issues they encounter while doing business abroad.

Regular contact is maintained between France and the other countries that attended the meeting in Lyon in 2018 (Côte d'Ivoire, Morocco, Italy and the United Arab Emirates). In some cases, cooperation has even been strengthened. On 18 February 2020, during a visit to Côte d'Ivoire with French Senate President Gérard Larcher, the then President of CNAC, Senator Richard Yung¹⁷, signed a cooperation agreement between France's National Anti-Counterfeiting Committee (CNAC) and its local counterpart (CNLC) in the presence of Côte d'Ivoire's Minister of Commerce and Industry. The cooperation agreement is primarily aimed at facilitating the sharing of information and best practices, enabling the deployment of training and awareness campaigns, and supporting the creation of anti-counterfeiting committees in other countries, starting with countries in Sub-Saharan Africa.

The network has recently been enhanced by the addition of new partners. An initial discussion was held via video conference with Japan's anti-counterfeit office (ACO) in August 2021 and an initial meeting will take place in Paris between the French committee and its Portuguese counterpart in May 2022.

INPI fervently hopes that many other anti-counterfeiting committees will join the network in the future.

By Stéphanie Leguay, Coordinator of France's National Anti-Counterfeiting Committee (CNAC)

¹¹ See EUIPO (2021), Illicit Trade, [Global Trade in Fakes: A Worrying Threat](#).

¹² See EUIPO (2022), [Trade in counterfeit and pirated goods increased during the pandemic](#).

¹³ French customs officials seized 9.1 million counterfeit items in 2021, up 62.5% from 5.6 million in 2020. Among the counterfeit goods seized were 1.7 million personal care products, 1.6 million toys and games and more than 200,000 food and drink items. Express courier and postal shipments accounted for 31.3% of all seizures. (Source: [Presentation](#) of French customs results for 2021, 14 February 2022).

¹⁴ INPI serves as the General Secretariat for France's National Anti-Counterfeiting Committee (CNAC), a public-private partnership tasked with facilitating the

sharing of information and best practices, coordinating concrete initiatives and coming up with new ideas. Set up in 1995, CNAC brings together industrial and artistic federations, trade associations and businesses, as well as public agencies involved in combating counterfeiting.

¹⁵ See INPI ["press release"](#), "Rencontre internationale des comités de lutte contre la contrefaçon, 3 et 4 juillet 2018" [International gathering of anti-counterfeiting committees].

¹⁶ Since the 1990s, INPI has developed an [international network of regional counsellors](#) tasked with raising awareness about intellectual property issues among companies and public authorities in countries deemed strategic for France.

¹⁷ Senator Richard Yung was the President of CNAC between July 2013 and September 2021.

Signing of a PPH agreement between INPI and its Brazilian counterpart

Bilateral meeting with our Brazilian counterpart, followed by a ceremony held during the congress of the São Paulo Intellectual Property Association (ASPI) for the signing of a Patent Prosecution Highway (PPH) agreement and a new memorandum of understanding (MoU) between our two offices.

After stepping up its cooperation with offices in North America in late 2021 by signing PPH agreements with the United States Patent and Trademark Office (USPTO)¹⁸ on 8 November and with the Canadian Intellectual Property Office (CIPO)¹⁹ a few weeks later, INPI forged closer ties with the office of a key country in Latin America on 15 March 2022, by signing both a PPH agreement and an MoU with its Brazilian counterpart.

The PPH agreement came into effect on **1 May 2022**. Applicants can now request accelerated examination of a patent application filed with the Brazilian office – whether a national application or a Brazilian national phase application under the Patent Cooperation Treaty (PCT) – provided that the claims contained in the application are sufficiently similar to those used in a corresponding application found patentable by INPI. The reciprocal agreement allows applicants to request accelerated examination in France of patent applications claiming priority from a Brazilian national application or a PCT application for which the Brazilian office is the International Searching Authority (ISA) and the International Preliminary Examining Authority (IPEA)²⁰.

In terms of applicant origin, France ranks fifth among all applications filed with the Brazilian IP office (also known as INPI). Thanks to this agreement, applicants have a new solution for obtaining a Brazilian patent more quickly, via a prior French application, enabling them to take full advantage of the PPH system's time-saving

benefits. In fact, the combination of an extremely fast patent granting procedure in France with a particularly efficient PPH system in Brazil will significantly speed up the patent examination process for applicants.

The PPH agreement attests to the two offices' confidence in each other's procedures and further enhances INPI's visibility on the international stage.

Partners for close to twenty years, the two offices chose to further strengthen their bilateral ties by signing – on the same day as the PPH agreement – an MoU setting out the new framework for their renewed cooperation. The meeting between INPI France and INPI Brazil provided an opportunity to discuss the main focus areas for our future work plan, i.e. the roadmap for our cooperation in 2022-2023. Key topics include geographical indications, artificial intelligence and support for businesses.

By Céline Boisseau, International Network Coordinator, INPI

Decision No. 2022-46 of 14 March 2022 on the extension of time limits due to the situation in Ukraine

By virtue of [Decision No. 2022-46](#) issued by the Chief Executive Officer of INPI on 14 March 2022, certain procedural time limits have been extended.

In light of the situation in Ukraine and the difficulties encountered by those based there to communicate with INPI or with a representative based in the European Economic Area (EEA), INPI has extended certain time limits for parties that have their residence or registered office in Ukraine to four months. This extension applies to the time limits set out in Articles [R.514-1](#), [R.618-4](#) and [R.718-1](#) of the French Intellectual Property Code that had not expired as of 24 February 2022. ■

¹⁸ See: [PIBD 2021, 1171, I-3](#).

¹⁹ See: [PIBD 2021, 1172, I-3](#).

²⁰ For more information on this topic, see: INPI, "[La Propriété intellectuelle au Brésil](#)", 2021; J. Vieira da Cunha, H. Cazerta de Godoy Bueno, A. Ribeiro Rodrigues,

"Prosecution Highway (PPH) as a measure to reduce backlog of unexamined patent applications in Brazil and the cooperation between European and Brazilian patent offices", *GRUR IT*, Nov. 2019, p. 997-1005; G. Sartori, "Accelerating patent examination in Brazil", *CIPA*, (48), May 2019, p. 9-11.

Agenda

6 May 2022

CEIPI – Latest European IP Case Law ■ ■

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CEIPI – Pascal Faure “Intellectual Property: Challenges and Opportunities” ■ ■

[Details](#)

18 May 2022

IRPI – Design Law ■ ■

[Details](#)

19 May 2022

CCI Morbihan – Use Industrial Property to Protect your Products and Services Internationally ■ ■

[Details](#)

20 May 2022

**INPI
“IP Strategy Day”** ■ ■

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23 May 2022

IRPI – Law of Trademarks and other Distinctive Signs ■ ■

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IRPI – “Big Data, Intellectual Property and Personal Data” ■ ■

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10 June 2022

IRPI – Patent Law and Protection of other Technical Creations ■ ■

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21 June 2022

IRPI – Employees’ Creations: “How to Manage Employees’ Creations” ■ ■

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28 June 2022

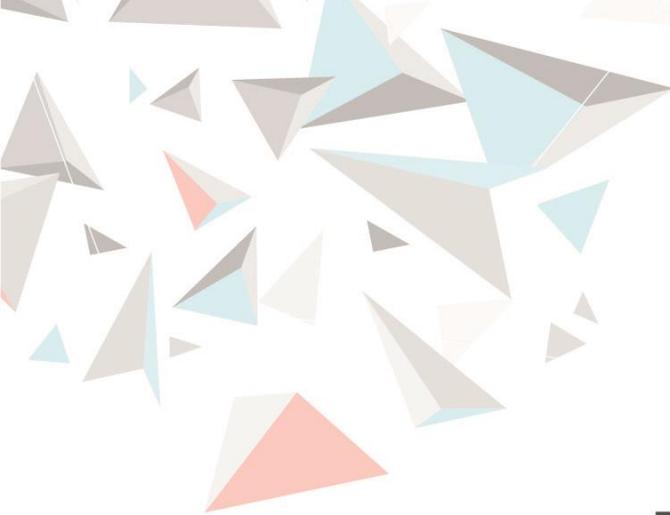
Regional Economic Department - Rome – Seminar on the Fight against Counterfeiting ■ ■

[Details](#)

7 & 8 July 2022

EUIPO Academy - IP Case Law Conference (IP Seminar 1) 

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