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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

Invalidation and revocation proceedings for trademarks

The administrative procedure for invalidation and revocation of trademarks resulting from the PACTE Act (Act no. 2019-486 of 22 May 2019 relating to business growth and transformation) has been in effect before the INPI since 1 April 2020 (Order 2019-1169 of 13 November 2019).

The aim of this administrative procedure for invalidation and revocation is twofold:

1. to enable economic stakeholders to assert their rights more easily, more quickly and at a lower cost;
2. to facilitate the removal of trademarks that improperly block access to the market due to a lack of use or validity or in the event of harm to the general interest.

This administrative procedure, which is handled by a team of specialised legal experts at the INPI, replaces the procedure for challenging trademarks before the courts, which remains possible in certain specific cases (in particular in the case of conflict with certain earlier rights, or in the case of a related dispute such as court proceedings for infringement or unfair competition).

What are the main characteristics of the procedure?

The procedure for invalidity or revocation before the INPI:

- is a **written, exclusively online** procedure; applications must be filed via the INPI's E-procedures portal.

- is subject to a **fee of €600, plus €150** for each additional earlier right invoked (in addition to the first).
- is **subject to the adversarial principle**, whereby the parties can discuss and compare their arguments on several occasions throughout the proceedings if they so wish. The duration of the proceedings is therefore dependent on the will of the parties, and up to three rounds of written discussions can be arranged.
- **allows for the submission of oral observations.** These observations are made during a hearing organised at the end of the written discussions, either at the request of one of the parties or at the request of the INPI. **Approximately 50 proceedings** have already been the subject of an oral phase, held at the INPI's headquarters in Courbevoie before a committee made up of three INPI employees.

Applications for invalidity based on an absolute ground and applications for revocation may be filed by any person; **they are not required to prove any interest in bringing the proceedings.** However, applications for invalidity based on a relative ground must be filed by the holder of the earlier right invoked.

In any event, the applicant may act alone or be represented by a representative (in particular a lawyer or an industrial property attorney). In practice, it has been found that applicants **appoint a representative in more than 90% of proceedings.**

Initial assessment almost three years after these procedures were introduced

Applications received

The INPI receives **approximately 430 applications** per year, divided equally between applications for invalidity (52%) and revocation (48%):

- **Applications for invalidity** are mainly based on relative grounds, i.e., conflict with earlier rights such as trademarks, company names and domain names. To a lesser extent, they are based on absolute grounds, such as bad faith filing or a trademark that does not meet the conditions of validity provided for by law (in particular, lack of distinctiveness).
- **Applications for revocation** almost exclusively concern failure to use the trademark, with only a few applications relating to the “degeneration” of a trademark into a generic name or a misleading indication.

These applications are mainly submitted by **small and medium-sized enterprises and by foreign companies**.

Decisions handed down

The INPI issues **around 400 decisions per year**, 70% of which are decisions on the merits, while the remaining 30% either result in the proceedings being terminated (most

often following an agreement between the parties) or being declared inadmissible (for example, if the INPI lacks jurisdiction).

These decisions are handed down **within an average of 8 months** from the date of submission of the invalidity or revocation application.

Decisions on the merits result in **approximately 270 trademarks being invalidated or revoked** (either fully or partially) each year.

Under its decision, the INPI may order the losing party to pay all or part of the costs incurred by the winning party within the limits of a scale determined by ministerial decree, so as to prevent abusive or dilatory proceedings.

***45%** of decisions on the merits rule on costs; the average amount awarded is **€650**.*

Appeals against decisions issued by the INPI

Decisions on applications for invalidity or revocation can be appealed before one of the ten competent courts of appeal. Approximately **15% of decisions on the merits** are subject to appeal.

Such appeals have **suspensive** (the decision has no effect until the appeal has been resolved) and **devolutive** effect, i.e., the parties may put forward new grounds and arguments or submit new evidence before the court of appeal. ■

By Christine Lesauvage, Head of the Cancellation Unit

French Case Law

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

Trademarks

Court of Cassation, 22 June 2022: The Court of Cassation approved the Court of Appeal's ruling which held that the reputation of the TAITTINGER trademark did not prevent [a member of the family](#), who had worked for the company owning the trademark prior to being dismissed, **from using her surname** to promote the new champagne she was marketing and to communicate on her professional experience.

Paris Court of Appeal, 5 October 2022: According to a decision of the Paris Court of Appeal, the **SORTEZ COUVERTS !** trademark for condoms was [filed fraudulently](#). A television presenter and a pharmaceutical laboratory that manufactures and markets condoms had already been using the slogan for many years in connection with awareness-raising activities to combat AIDS, of which the applicant could not have been unaware.

Paris Court of Appeal, 12 October 2022: The Paris Court of Appeal partially overturned the ruling and declared the **partial revocation**, [for misleading use](#), of the JC DE CASTELBAJAC and JEAN-CHARLES DE CASTELBAJAC **family name trademarks** on the grounds that their use by the assignee was liable to convince the consumer that the goods acquired were designed by or under the artistic direction of the designer.

Court of Cassation, 19 October 2022: The Court of Cassation ruled that the **transfer of a business** ("**fonds de commerce**") including the transfer of the ownership of trademark rights [did not entail the transfer of the contract for the exclusive distribution of the products bearing those trademarks](#).

Patents

Paris Court of Appeal, 29 June 2022: The Paris Court of Appeal cancelled **an infringement seizure** ordered in the context of a dispute over the infringement of two European patents, due to the [abnormally long duration of the proceedings](#) (17 hours). In order to do so, it analysed proportionality between the rights of the seizing party and those of the seized party, who did not show any resistance.

Paris Court of Justice, 29 June 2022: The Paris Court of Justice denied **preliminary injunctions to prohibit the marketing of allegedly infringing generic drugs** due to [the existence of a serious challenge to the validity of the second medical use patent](#) invoked. Although the patent meets the requirement of sufficiency of disclosure, it would appear to lack inventive step in view of the publication, before the priority or publication date of the patent application, of a clinical study.

Designs

Paris Court of Appeal, 14 September 2022: The Paris Court of Appeal cancelled a key ring design, consisting of an Eiffel Tower and tassels, for **lack of novelty**. [An identical key ring was disclosed in the catalogue of a Chinese supplier, before the date of filing of the design](#). According to the Court of Appeal, this prior design was known to professionals in the souvenir market. Such catalogues, although written in English, are clearly aimed at all operators in this sector, particularly in Europe, who mainly buy their supplies from China and keep themselves reasonably informed of the trends on offer.

INPI Decisions

Below you can read about some of the decisions handed down by the INPI in relation to the new proceedings governing trademark invalidity and revocation and patent oppositions, commented on by the INPI's legal experts.

The use of the Lacoste figurative trademark, which represents a crocodile facing to the left, in a modified form does not alter its distinctive character

The application for revocation of the rights to the figurative trademark representing a crocodile facing to the left, filed by a Chinese company, is partially granted. The applicant is not required to demonstrate any interest in bringing such an application before the INPI. The argument that the application for revocation was intended solely for the purpose of obtaining a decision from the French IP Office in order to use it in the administrative and infringement proceedings underway in China is therefore unfounded.

It has not been established by the applicant that the figurative sign at issue, namely the depiction of a crocodile shown from the side, with its mouth open, tail raised and two legs visible, is **commonly used** to designate the goods and services concerned, which fall within the fields of clothing, eyewear, leather goods, perfume and cosmetics, household linen, sports goods, stationery and promotional sponsorship services. As such, in relation to these goods and services, the contested mark would appear to be distinctive.

Furthermore, it is apparent from the documents produced by the defendant that the trademark enjoys a **high level of recognition among the French public** on the market concerned owing to the fact that it has been around for almost 90 years, in addition

to its strong advertising presence in numerous French media publications, many displays in public areas and promotional partnerships.

The **distinctive character** of the contested trademark must therefore be considered as being **enhanced** by its substantial level of recognition in the relevant market.



By gpriccardi - stock.adobe.com

Consequently, even though the sign appears on the goods marketed by the owner of the trademark in **different colours** and **sizes**, its distinctive features, as described above, remain perfectly noticeable and recognisable. The addition of colours and availability of larger or smaller sizes does not alter the distinctive character of the trademark as registered, since these **aspects are purely ornamental and functional in nature**.

Furthermore, the fact that the crocodile is facing to the right or to the left is not a **determining characteristic** that alters the distinctive character of the trademark as registered. The **direction is relative** to each person's position and depends on whether a product or figurative element is worn on one's

person or seen on a person opposite. The direction is even less relevant in this case because of the enhanced distinctiveness of the contested trademark.

Lastly, while the sign is in some cases used on goods **in combination with the name “Lacoste”**, it must be noted that in the sector of activity concerned, it is common for goods to bear two trademarks, for example their individual trademark and the company’s parent trademark, or a word mark and a logo. In the case in point, the crocodile, which is positioned separately from the word “Lacoste” on the goods, constitutes an independent trademark.

On the basis of these considerations, it has been clearly demonstrated that the contested trademark is used in forms that do not alter its distinctive character. Furthermore, the documents submitted by the defendant provide sufficient information concerning **the volume of trade, the geographical scope, duration, frequency and nature of the actual use** made of the trademark by its owner, during the relevant period, in the areas of clothing (garments, footwear, headwear), eyewear, leather goods, sports goods, perfume and cosmetics, household linen, stationery and promotional sponsorship services.

However, the **genuine use** of the contested trademark **has not been demonstrated**, in light of all the relevant factors, for many other goods and services such as, in particular, soaps and essential oils, devices for recording, transmitting and reproducing sound and images, cash registers, diving goggles, jewellery, paper and cardboard, materials for artists, table linen or even advertising, as the documents provided by the owner do not relate to any of these goods and services.

INPI Decision, 2 December 2022, DC 21-0166 ([DC20210166](#))
Nanji E-Commerce Co., Ltd vs. Lacoste SA

By Chloé Denizot, Legal expert, INPI

Patent opposition proceedings before the INPI – Partial revocation due to lack of inventive step

The opposition filed against the patent entitled “Capture device, receiving device, processing device and calibration device” is recognised as partially justified and the patent has been partially revoked.



By New Africa- stock.adobe.com

Lack of clarity in the wording of a claim is not included in the grounds for opposition listed in Article [L.613-23-1](#) of the French Intellectual Property Code (Code de la propriété intellectuelle or “CPI”). However, an opposition may be filed on the grounds that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Furthermore, the assessment of the sufficiency of disclosure of the invention is carried out by taking into account the entire patent, not just the description. It is therefore necessary to determine whether, with respect to each claim in question, the person skilled in the art, based on his/her general knowledge and the teachings of the patent as a whole, including the description and the drawings, would be able to carry out the invention as defined by the claim in question without undue effort.

A person skilled in the art is defined as being a person skilled in the field in which the technical problem solved by the invention is posed. The

latter concerns the development of a system for monitoring the temperature of a large number of pharmaceutical packages in real time, while remaining compact and capable of withstanding the mechanical stress exerted by a stack of packages. The technical problem that needs to be solved is therefore multidisciplinary and the person skilled in the art must be able to manage both the standard challenges associated with a measuring chain and those associated with packages and the transport thereof. The person skilled in the art is therefore defined as a practitioner in measuring chains with average knowledge of electronic systems, assisted by a packaging manufacturer with average knowledge of mechanical assembly.

The person skilled in the art must be capable of carrying out the invention across the entire scope of the claim. However, the fact that some methods of carrying out the invention, however numerous, are not explicitly described in the patent, does not mean that they would not be attainable by the person skilled in the art. The description of a method of carrying out the invention that can be reproduced by the person skilled in the art is considered sufficient in terms of fulfilling the requirement of a sufficiently clear and complete disclosure of the invention. As this requirement is met, the patent contains all the information necessary for the person skilled in the art to determine the disputed features and to reproduce the invention without undue effort. The ground for opposition stating that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art is therefore unfounded.

To assess the inventive step, it is preferable to adopt the problem-solution approach. This involves determining the closest prior art, followed by formulating the objective

technical problem to be solved before assessing obviousness. In the case in point, the objective of the invention is to provide a reliable and compact system for detecting and locating in real time a break in the cold chain during the transport of heat-sensitive pharmaceutical packages.

Several documents can be considered as constituting the closest prior art: documents D1 (a US patent application relating to a system for monitoring the storage temperature of a perishable product) and D4 (an international patent application relating to a system for dispensing medicinal tablets individually) produced by the opponent are each considered to be the closest prior art, since these documents, which fall within the same technical field as the invention, aim to achieve the same objective as the subject matter of the contested patent.

A set of distinctive technical features¹ is regarded as a combination of features if the interaction between the features achieves a combined technical effect that is significantly different from, for example, greater than the sum of the technical effects they individually produce. In other words, the interaction between the individual features must produce a synergistic effect. If the all the distinctive features combined do not produce a synergistic effect, it is not possible to formulate a single technical problem that can coherently link the technical effects produced by the distinctive features. The objective technical problem must therefore be regarded as an aggregation of several “partial problems”. In order for the claim as a whole to meet the inventive step requirement, only one of the partial problems needs to be solved in an inventive manner.

In view of the elements presented, the subject matter of independent claims 1 and 7 and of

¹ A distinctive feature is a feature not disclosed in the documents cited by the opponent. It may or may not be of a technical nature.

dependent claims 2 to 5 dependent on claim 1 of the contested patent is considered to involve an inventive step.

However, the subject matter of independent claims 6 and 8 is obvious in the light of the cited prior art, in that the person skilled in the art, in order to solve the objective technical problem, would have to combine the teachings of the cited documents with his/her general knowledge. The ground for opposition stating that the subject matter of claims 6 and 8 lacks inventive step is therefore well founded and the patent is partially revoked for these claims².

Lastly, and in accordance with Article [R.613-44-7](#) of the CPI, the auxiliary request submitted by the joint owners of the

contested patent during the oral phase shall be admissible provided that the parties have been able to discuss it on an adversarial basis. However, the amendments made to the claims must meet one of the grounds for opposition (Article [L.613-23-3, para. 1](#) of the CPI). The amendments made to the claims in this case concern their punctuation. They therefore do not meet one of the grounds for opposition put forward by the opponent and the auxiliary request submitted by the joint owners was therefore rejected. ■

INPI Decision, 4 July 2022, OPP 21-0005 ([OB20210005](#))

Cabinet Lavoix vs. Adrien C., Raphaël V. and Yohann C.

By Maxime Bessac, Head of Legal Division, INPI

² Article [L.613-23-6](#) of the CPI provides that where an opposition decision partially revokes the patent, the owner must apply to the INPI for an amendment of

his/her patent in accordance with the decision. However, this request shall only be admissible if the decision ruling on the opposition is no longer subject to appeal.

About INPI

The “crème de la crème” of culinary inventions

A dip into INPI's heritage archives to spotlight four key figures of culinary innovation in France: Appert, Godin, Christofle and Escoffier

Among the 10 million or so documents that make up INPI's heritage archives, a considerable number relate to a field that French people hold dear – food, and more particularly, gastronomic food! Examples include the trademarks and patents filed by Nicolas Appert, Jean-Baptiste André Godin, Charles Christofle and Auguste Escoffier, four key figures of French culinary innovation whose contributions can still be found in INPI's archives today.

Thousands of patents, trademarks and designs bear witness to the changes that occurred during the 19th century, not only in cooking but also in how food was prepared, presented and shared. Among the people who contributed to these changes were Nicolas Appert, Jean-Baptiste André Godin, Charles Christofle and Auguste Escoffier. The discoveries and activities of these four French entrepreneurs helped to modernize culinary practices and techniques, contributing to the advent of “gastronomy” as defined by Brillat-Savarin in his 1823 *Physiology of Taste*. While they focused on very different facets of the culinary industry, from the preparation, preservation and cooking of food to its presentation on the table, all four men made a point of protecting their innovations and the resulting products and enterprises.

Canned goods: an origin story

The 19th century was a period of great discoveries in many areas, and food was no exception. Drawing on the progress made in industrial sectors like chemicals and metalwork, and encouraged by population growth, cultural movements and advances in health and hygiene, the preparation and consumption of

food underwent numerous changes. The production of sugar beet, the creation of the first industrial dairies and the invention of margarine, patented in 1869, are just a few examples. As early as 1795, an ingenious confectioner named Nicolas Appert (1749-1841) developed a heat-based sterilization process for preserving food, which came to be known as appertization. In those days, food was still being preserved through salting, sugaring, smoking, pickling with alcohol or vinegar, or packing with fat. These techniques were only partially successful and inevitably altered the food in some way. Appertization allowed food to be preserved more effectively, first in bottles and later in hermetic tin cans. As a result, food could be kept for longer and was able to travel and be traded more easily. This was the case not only for preparations like patés and prepared dishes, but also for fresh produce such as fish, seafood, fruits and vegetables. This development resulted in the availability of new products, creating ample opportunity to experiment with new recipes.

While Appert's name continues to be associated with the process he invented, it was also included in the brand names used by those who took over his business. Thanks to Prieur-Appert and later Chevallier-Appert, the inventor's surname was synonymous with the production of canned goods right up until the start of the 20th century.



Trademark for canned goods and other food products, registered on 21 October 1907 by Chevallier-Appert (1MA175_198_1, INPI archives)

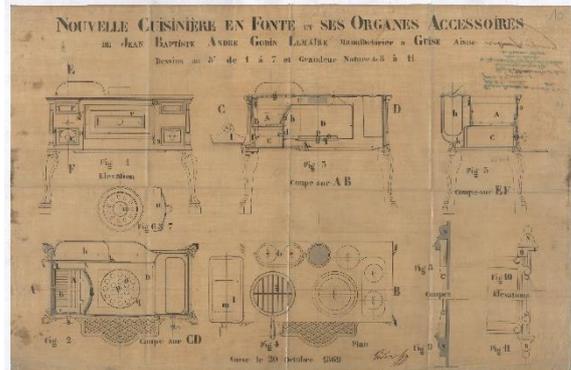


Patent filed on 11 March 1823 by Nicolas Appert for a process for melting tallow (1BA1193, INPI archives)

All fired up

Of course, well before its contribution to food preservation, heat was already playing another important role in the kitchen. Eminent French chef Jules Gouffé, the founding father of cookbooks as we know them today, describes three different kinds of fire used for cooking in his *Livre de Cuisine* published in 1867: “stock-pot fire”, which provides the slow, continuous heat required for stews, “broiling fire”, which must always be even, and the strong, steady fire he calls “roasting fire”. Around the same time, cooking techniques such as braising and pan-cooking were also emerging. Originally a closed structure made of brick or stone, the kitchen stove was a direct descendant of bygone ovens, where food was cooked inside a heated interior space and the fire was enclosed. With this type of stove, known as a potager in French, the food – often soup – was cooked thanks to the embers inside. In the 19th century, these brickwork stoves were gradually replaced by more modern stoves in which the section that contained the embers, and later the coal, was made up of cast-iron plates. These stoves were designed to serve more than one purpose. In addition to being space heaters, those installed in kitchens became “cooking stoves” and could even be used to produce hot water. One of the key contributors to this change was Jean-Baptiste

André Godin (1817-1888). An enlightened industrialist inspired by utopian socialism, Godin wanted his creations to be adaptable to different uses. Godin stoves revolutionized the cooking space completely, becoming a central component in many households, initially among the wealthy but eventually across all classes of society. They also played a key role in many restaurants.



Patent filed on 8 March 1872 by Jean-Baptiste-André Godin for a cast-iron cooker, its accessory components and the new construction processes used for its production (1BB87600, INPI archives)

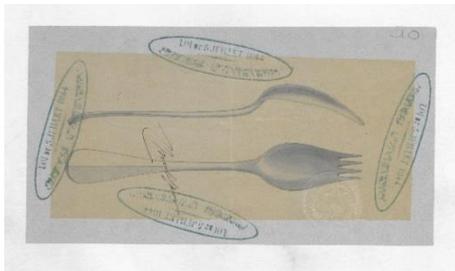


Trademark for heating devices, registered on 19 November 1901 by Louis Victor Colin, managing director of the former Godin company (1MA115_066_1, INPI archives)

Service with style

The emergence and development of these new establishments – some of which became all-out temples of tasting pleasure – also contributed to the culinary world’s transformation and paved the way for what’s now known around the globe as “haute cuisine”. A more simplified form of

table service “à la russe” (“Russian-style”), where dishes are served one after the other, was introduced in certain dining rooms in the 1810s. Around the same time, the bourgeoisie started using the dining table as a symbol of their social success, striving to impress guests not only through the food served but also its presentation: a well-laid table and fine silverware heightened the pleasure derived from the culinary delights on offer. Every utensil used for eating and drinking – from plates and glasses to knives and forks – came to exist in numerous versions. Each variant was designed to suit a specific purpose or type of food, such as soup, fish, meat, cheese, snails, oysters or dessert.



Patent filed on 11 November 1867 by Christofle et Cie for an improved fork (1BB 76458, INPI archives)

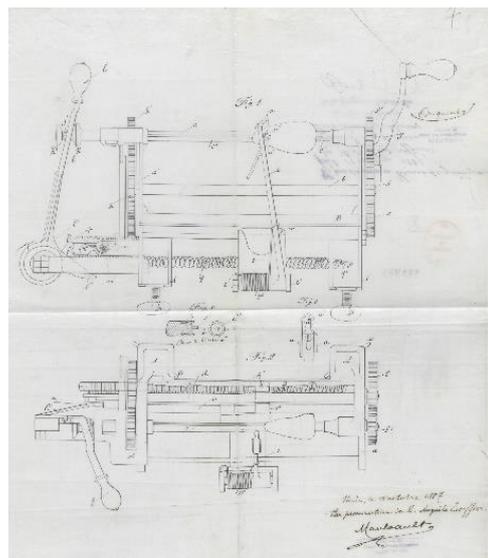
Certain silversmiths, including Charles Christofle (1805-1863), made tableware one of their specialties. Christofle improved the techniques used for producing flatware and even patented, in 1846, a portable stove suitable for table service. Today, the Christofle brand continues to produce exceptional pieces that can transform a dining table into a veritable work of art.



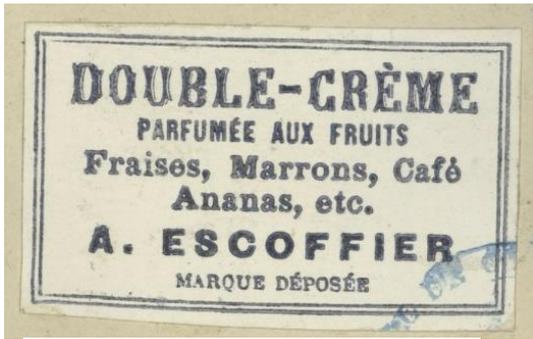
Trademark for silverware, registered on 12 January 1911 by Christofle et Cie (1MA175_198_1, INPI archives)

Dishes, daring and delicious

While culinary creations are theoretically not patentable, certain exceptions can be found in INPI’s heritage archives. One example is a dish of Burgundy snails and small grey vineyard snails in Chablis white wine, which was patented in 1890 and may well appeal to certain palates even today. The archives also contain various documents relating to the composition and creation of cakes, such as the “Chaumontais” travelling cake patented in 1882, and the production of terrines, like the “Parisian pâté” patented in 1874. A certain Auguste Sacaron filed a patent in 1880 for the confection of a foie gras pâté en croute made with an edible pastry crust. Up until then, the pastry wrapping was not designed to be eaten but merely to keep the filling fresh! Auguste Escoffier (1846-1935), “the king of chefs and the chef of kings”, also left his mark. A revolutionary in the culinary sphere and the initiator of a vast trend towards simplification, Escoffier believed that a good meal should be enjoyable to eat but also easy to digest. He notably patented an improved machine for turning fruits and vegetables, dubbed “L’Express”, and a double-cream flavoured with fruits. An astute businessman, Escoffier registered not only his creations but also his name as a trademark.



Patent filed on 15 October 1887 by August Escoffier for an improved machine for turning fruits and vegetables dubbed “L’Express” (1BB186424, INPI archives)



Trademark for cheeses, registered on 1 April 1893 by Auguste Escoffier (1MA521_004_1, INPI archives)

By inscribing the “gastronomic meal of the French” on its Representative List of the Intangible Cultural Heritage of Humanity in 2010, UNESCO recognized cooking and meal-sharing as an integral part of French culture. As is often the case, this social practice has been shaped by developments in science and technology. The innovations that came about in the 19th century in particular had a long-term impact on the way food is produced, preserved and processed, and the way meals are served and presented in France. INPI’s heritage archives provide invaluable insight into these changes and serve as a key source of information on France’s culinary history.

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

(This article also appeared in *Journal Spécial des Sociétés*, No. 1, page 1, on 5 January 2022).

Launch of « France Against Counterfeiting » Project

The INPI-led project *France Anti-Contrefaçon* (“France Against Counterfeiting”) was launched on 14 September 2022 at the general assembly of France’s National Anti-Counterfeiting Committee (CNAC)³. The project’s aim is to gain a better understanding of counterfeiting issues and trends in France in

order to deal with counterfeiting more effectively.

A [report](#) published by the French Court of Audit in February 2020 pointed out the need to more closely evaluate the extent of counterfeiting in France and the impact of initiatives already being carried out⁴. This report was followed by a second [document](#) – presented to the National Assembly on 9 December 2020 – setting out 18 proposals for tackling counterfeiting in France including one that addresses the need to better quantify the problem⁵.

Given that INPI was designated in this second report as a possible candidate to lead efforts in this regard, this proposal was included in our objective and performance contract for 2021-2024. That is how the “France Against Counterfeiting” project came to be launched on 14 September 2022.

Background to the project

A [European observatory](#) currently collects a significant amount of general data about counterfeiting in the European Union but very little country-specific data. A more comprehensive understanding of counterfeiting in France is therefore needed to enable the development of an effective anti-counterfeiting strategy.

The “France Against Counterfeiting” project launched by INPI aims to improve our understanding of the challenges faced by all involved – from right holders and industrial property professionals to law enforcement authorities – so that appropriate strategies and resources can be implemented to combat counterfeiting in France.

³ See [PIBD 2022, 1191, IV-1](#).

⁴ See [PIBD 2020, 1134, IV-6](#).

⁵ See [PIBD 2020, 1150, IV-2](#).

Objectives of the project

The project unites representatives from the legal, business and academic spheres around three key objectives:

1. Bringing together and hearing from all the various stakeholders so that our vision of counterfeiting in France is as comprehensive as possible;
2. making the most of existing data and collecting the information necessary to characterize the nature and impact of counterfeiting in France; and
3. proposing the development of new tools to facilitate the fight against counterfeiting.

Participants in the project

INPI signed three partnerships during the CNAC's general assembly on 14 September, with:

- France's SME confederation (CPME), to improve our understanding of how counterfeiting impacts SMEs and why they're not particularly active in anti-counterfeiting efforts;
- France's Centre for International Intellectual Property Studies (CEIPI), with the aim of

enhancing discussion about counterfeiting through conferences, academic research and awareness-raising initiatives among students; and

- French anti-counterfeiting association Unifab, to gain insight into the behaviour of French consumers with regard to counterfeit goods, with a view to boosting the effectiveness of awareness campaigns, for example.

Two other historic INPI partners are also involved in the project:

- French Customs, which plans to share its data to enable the creation of national indicators; and
- France's Mechanical Engineering Industries Federation (FIM), which will conduct a study on counterfeiting in the mechanical engineering sector.

More partners will be added in the coming months, and the project will produce its first deliverables in 2023.

The work carried out as part of this project will notably be used to guide the initiatives implemented by the CNAC, for which INPI serves as General Secretariat. ■

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

International IP Law news

OAPI Joins Geneva Act of the Lisbon Agreement

Following a decision made during the 62nd ordinary session of its Administrative Council, which took place in Douala, Cameroon on 8 December 2022, the African Intellectual Property Organization (OAPI) deposited, on 15 December 2022, its instrument of accession to the Geneva Act of the Lisbon Agreement on **Appellations of Origin** and **Geographical Indications** and their International Registration, which was adopted on 20 May 2015 and entered into force on 26 February 2020.

According to the WIPO news article on the topic, OAPI is the second intergovernmental organization to join the Lisbon System⁶, and “geographical coverage of the Geneva Act now extends to all 17 OAPI member states”⁷.

In a video accompanying the article, WIPO Director General **Daren Tang** applauds OAPI’s accession and acknowledges the associated benefits in terms of economic growth, employment and the preservation of artisanal skills.

This is followed by a statement in French by OAPI Director General **Denis L. Bohoussou**, who points out the “enormous potential” that geographical indications represent for OAPI member countries, which “have a lot of valuable agricultural resources”. He cites several examples of geographical indications that are already protected – such as “**Penja Pepper**”, “**Oku White Honey**” from Cameroon and “**Ziama Macenta**” coffee from

Guinea – and goes on to say that, with WIPO’s collaboration, OAPI is supporting “about 15 other products, which we hope will be on the market very soon as geographical indications.”

As Chair of the Lisbon Union Assembly, INPI CEO **Pascal Faure** attended the ceremony organized by WIPO to mark OAPI’s accession⁸. He commented that it was “a big step forward, which reflected the impetus provided by the high-level conference on geographical indications held last June in Abidjan, to which INPI contributed alongside WIPO.”

The Geneva Act will enter into force with respect to OAPI on **15 March 2023**⁹.

Draft amendment to China’s trademark law open for public comment

On 13 January 2023, a draft amendment to China’s trademark law was published for public consultation by the China National Intellectual Property Administration (CNIPA).

The Chinese office had announced that it was working on this topic in September last year, citing 14 research projects it had been working on, on issues such as combating bad-faith filings, strengthening the requirement to use trademarks and improving grant procedures. These research projects generally involve academics and other legal practitioners who specialize in the issues addressed.

⁶ See the European Union’s accession (*PIBD* 2019, 1127, I-65) and [the list](#) of contracting parties to the Lisbon Agreement.

⁷ Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d’Ivoire, Gabon, Guinea, Guinea Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Senegal and Togo.

⁸ See INPI, [News](#), 16 Dec. 2022.

⁹ The Geneva Act entered into force in 2022 for the following countries: Ghana (see *PIBD* 2021, 1170, I-3), Cape Verde (*PIBD* 2022, 1180, I-4), Czech Republic (*PIBD* 2022, 1184, I-3), Peru (*PIBD* 2022, 1187, I-5).

This latest draft amendment seems to place particular emphasis on strengthening the mechanisms designed to combat bad-faith filings. This practice continues to significantly penalize foreign companies in China and is also a problem for Chinese brands. For its part, the CNIPA is evidently on guard against the fraudulent registration of names such as those of athletes during major sporting events, like the Winter Olympics in Beijing and the football World Cup in 2022, and other names widely referenced by the media. Examples include the names of the hospitals built in record time in Wuhan at the start of the Covid-19 pandemic, which were the subject of numerous trademark applications.

Creating 23 new articles and modifying more than 50 others, the draft amendment appears to represent an in-depth revision of China's trademark legislation. Among the proposed additions is an article aimed at clarifying what constitutes a bad-faith trademark application. Specific mention is made of several situations, namely bulk filings, deceitful applications and

– importantly – applications filed with the intention of infringing on a third party's rights. The draft also addresses the issue of administrative sanctions for bad-faith applicants, providing for fines of up to RMB 50,000 and allowing for this amount to be increased to RMB 250,000 in serious cases.



By Song_about_summer - stock-adobe.com

The draft amendment is accessible, in Chinese, via the CNIPA's website. It was open for comment until 27 February 2023. ■

By Julie Hervé, INPI Regional Counsellor for China¹⁰

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cooperation initiatives with its public and private partners worldwide. They also support companies in their export activities, in liaison with the French Treasury Department.

Agenda

7-17 March 2023

Business France – Forum on consumer goods in China

[Details](#)

14 March 2023

EUIPO – IpforYou France

[Details](#)

16 March 2023

ASPI – IP rights in China: Prospects for 2023

[Details](#)

16-17 March 2023

CEIPI – Taxation of patents, inventions and software

[Details](#)

16 March 2023

FNDE – Patent and know-how contracts

[Details](#)

16 March 2023

Business France – Algeria Meeting 2023

[Details](#)

28 March 2023

CCI PARIS Île-de-France/CCI ESSONNE – Techinnov, Parc Floral de Paris

[Details](#)

28 March 2023

FNDE – Trademark law: Legislative and case law developments in the second half of 2022

[Details](#)

30-31 March 2023

UNIFAB – European Forum of Intellectual Property

[Details](#)

3-6 April 2023

INPI – Focus on the international patent application procedure (PCT)

[Details](#)

12-14 April 2023

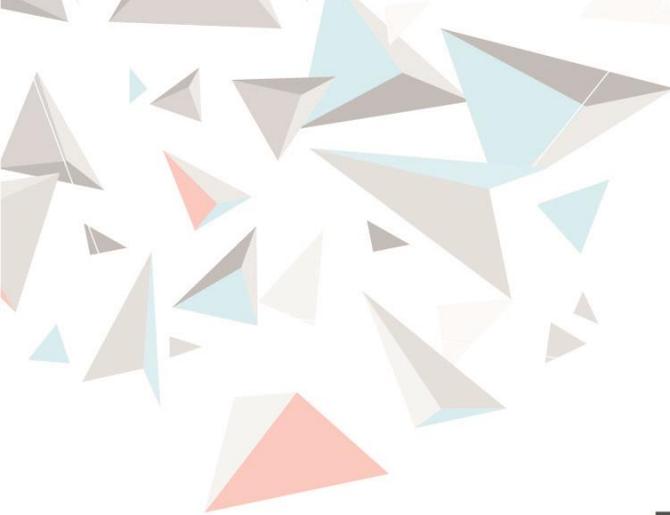
CEIPI – 14th edition of the CN2PI - National Intellectual Property Litigation Competition

[Details](#)

17-21 April 2023

INPI – Training: Patents - advanced level

[Details](#)



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