



**INPI LAW**  

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**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

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## Geographical indications for craft and industrial products on Europe's doorstep

**R**egulation (EU) 2023/2411 of the European Parliament and of the Council of 18 October 2023 on the protection of geographical indications for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753 was published in the *Official Journal of the European Union* on 27 October 2023.

The purpose of this Regulation is to provide craft and industrial products with protection equivalent to that enjoyed by agri-food products within the European Union since 1992<sup>1</sup>. The fragmentation of the internal market and the disparity of existing protection systems within the European Union lead to legal uncertainty. The aim of uniform protection throughout the European Union is to offer consumers high-quality, authentic products, to contribute to the fight against counterfeiting, and to stimulate the creation of sustainable jobs, often in rural areas.

Craft and industrial products with a quality, reputation or other characteristic linked to their geographical origin may benefit from a geographical indication protected at European level.

In this way, products derived from the cultural heritage and traditional know-how of Member States will be granted unitary protection throughout the territory of the European Union. In the jewellery, porcelain, cutlery and textile sectors, the European Commission estimates that more than eight hundred products are eligible for protection<sup>2</sup>.

French products, including those already protected by a national title under legislation introduced in 2014<sup>3</sup> (16 geographical indications

registered to date with the INPI<sup>4</sup>) will therefore gain wider recognition.

The Regulation sets out the rules governing the eligibility, registration, amendment, protection and control of geographical indications as well as the rules governing their administration under the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications ([Geneva Act](#)).

- **An initiative that has finally come to fruition**

The plan to introduce a uniform system for craft and industrial products is nothing new, since the Commission, supported by the Parliament, has been looking into this matter for almost fifteen years. However, despite the latter's fervent support, an initial European project was abandoned in 2014.

In 2020, the Commission returned to the subject and undertook to examine "whether to propose an EU protection system for non-agricultural geographical indications."<sup>5</sup> Following the enthusiasm of many Member States and craft industries, the Commission published its proposal for a Regulation on 13 April 2022, during the French Presidency of the Council of the European Union. France, which has its own legislation on geographical indications for craft and industrial products, and which campaigned strongly in favour of this text, thus had the honour of initiating legislative work on the Regulation.

A year and a half later, the European institutions reached an agreement, and on 18 October 2023 the Parliament and the Council adopted the

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<sup>1</sup> Council [Regulation \(EEC\) No 2081/92](#) of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

<sup>2</sup> [Impact-assessment report](#) accompanying the proposal for a regulation on geographical indication protection for craft and industrial products, p. 6.

<sup>3</sup> [Law No. 2014-344](#) of 17 March 2014 on consumer affairs, known as the Hamon Law.

<sup>4</sup> Cf. INPI [website](#).

<sup>5</sup> [Communication from the Commission](#): "Making the most of the EU's innovative potential - An intellectual property action plan to support the EU's recovery and resilience."

Regulation creating the geographical indication for craft and industrial products (CIGI).

- **Scope, products and persons concerned**

The Regulation applies to craft and industrial products. These are defined as products produced either entirely by hand or with the aid of manual or digital tools, or by mechanical means, whenever the manual contribution is an important component of the finished product, or products produced in a standardised way, including serial production and by using machines.

In order to cover as many different types of product as possible, the Regulation states that non-agricultural items may be industrial or craft products. This means that all products not falling within the scope of the regulations on geographical indications for agri-food products, wines and spirit drinks<sup>1</sup> are likely to be covered by this new system.

The legislators have opted for a definition of GIs for craft and industrial products identical to that used in the agri-food sector. A product originating in a specific place, region or country, whose quality, reputation or other characteristic is essentially attributable to its geographical origin, and for which at least one of the production steps takes place in the defined geographical area, is therefore eligible for protection.

However, any name that is contrary to public policy will be refused registration, which is not currently the case for agri-food product GIs.

Any producer group, including any operator engaged in one or more of the product's production steps, may apply to register a GI. Because of the specific nature of the craft and industrial sectors for the products concerned, the Regulation allows an 'isolated' producer to submit an application where they are the only one able to demonstrate local production.

- **The registration procedure for geographical indications**

The GI registration procedure has been modelled on that for agri-food products, and involves two

phases: a national phase, for which an authority designated by the Member State is responsible, and a European phase, entrusted to the European Union Intellectual Property Office (EUIPO). A specific feature of the system is the possibility offered by the Regulation to certain Member States of dispensing with the national procedure under certain conditions. In this case, producers will apply for registration directly to the EUIPO, which will then have exclusive responsibility for the procedure, in cooperation, for technical considerations, with the Member State from which the application originates, via the appointment of a point of contact.

- **The national phase**

The application for registration of a GI must be submitted to the competent national authority, which shall examine whether it complies with requirements relating to the applicant and the definition of a GI, and ensure that all necessary information has been provided. The application must contain the product specification, the single document (summarising the most important elements in the product specification) and accompanying documentation (listing any other type of information), the respective details of which are listed in the Regulation. In France, the competent authority will be the INPI.

If the application complies with the requirements of the Regulation, the national authority shall publish the application, opening an opposition period of at least two months.

This period gives any person with a legitimate interest residing or established on the national territory the opportunity to challenge registration of the geographical indication. By way of a reasoned statement, the opponent may base their opposition on one or more of the grounds provided for under the Regulation: the geographical indication does not meet the requirements for protection, the name applied for is generic, an earlier homonymous name is registered as a geographical indication, registration would jeopardise the existence of an identical or similar name used in the course of trade or of a trade mark, or the existence of products that have been legally on the market for at least five years, or there is an earlier trademark

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<sup>1</sup> Regulation (EU) No [1151/2012](#), Regulation (EU) No [1308/2013](#), and Regulation (EU) [2019/787](#).

with a reputation or well-known mark (under certain conditions).

This opposition procedure should be distinguished from that used for trademarks, and also differs from the public enquiry procedure currently provided for under French law. The competent authority cannot rule directly on the outcome of the opposition. Where it considers the opposition admissible, it shall invite the opponent and the applicant to enter into consultations with a view to reaching a friendly settlement. The outcome of such consultations, including any modifications agreed between the parties, shall be communicated to the competent authority which, after assessing this outcome, shall consider whether the requirements of the Regulation have been met, and shall make a decision. Where this decision is favourable, the competent authority shall lodge the application with the EUIPO. There is an option to confer temporary national protection, pending final approval at European level.

The decision of the competent authority may be appealed by any person having an interest in bringing proceedings. In France, appeals are brought before one of the appeal courts designated by decree. Such appeals shall suspend any proceedings before the EUIPO.

#### - **The European Union phase**

Within the EUIPO, a Geographical Indications Division has been established to examine applications. It checks that the application contains no manifest errors and that the information contained in the various documents is complete, taking account of the outcome of the national phase. Similarly, it runs an opposition procedure provided for persons demonstrating a legitimate interest, reserved for persons from other Member States and third countries. In view of the outcome of the opposition, the division will decide whether or not to register the GI.

It should be noted that the European Commission has the option of taking a decision on the application instead of the EUIPO for the most sensitive cases, in particular where the application might be contrary to public policy, or

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<sup>1</sup> Union register of geographical indications for craft and industrial products.

the outcome of the case might jeopardise the European Union's trade or external relations.

Decisions of the Geographical Indications Division may be appealed before the EUIPO's Boards of Appeal. In accordance with European law, decisions handed down by the latter may be challenged before the General Court, then appealed before the Court of Justice of the European Union.

Finally, the EUIPO has an Advisory Board, whose opinion may be sought in all proceedings (registration, opposition, appeal, etc.) and at any stage of such proceedings. This body, made up of a representative of each Member State and a representative of the Commission, will provide expertise on horizontal matters such as the assessment of the quality criteria, the establishment of a product's reputation, or the assessment of the link between the characteristics of a product and its geographical origin. The Board's non-binding opinion shall be delivered by a three-member panel. The aim of this measure is to enlighten the EUIPO on the specificities of GIs, drawing in particular on the practical experience of national experts.

Once approved by a final decision from the EUIPO, GI registrations are entered into the specially created Union register<sup>1</sup> and published in the *Official Journal of the European Union*.

With regard to amendments to product specifications, a distinction must be made between so-called "standard" amendments, which are considered to be minor changes and fall within the sole remit of the national authority, and more substantial Union amendments, which will follow the same procedure as that for registration, and will go through opposition phases at national level, then at EU level.

#### ▪ **The scope of protection of geographical indications**

Geographical indications enjoy a high level of protection. Because of their public-interest dimension and their intrinsic reputation, they enjoy extensive protection against any use that is detrimental to them or seeks to exploit their reputation<sup>2</sup>. In this respect, the Regulation incorporates the latest legislative developments

<sup>2</sup> Article 40 of Regulation (EU) 2023/2411 of the European Parliament and of the Council of 18 October 2023.



in the field of agricultural GIs and thus provides that the use of a GI for products not comparable to those covered by the registration constitutes an infringement of the GI, not only when such use exploits its reputation but also when it weakens, dilutes, or is detrimental to its reputation.

Similarly, the Regulation includes a definition of the concept of evocation, arising from the extensive case law of the Court of Justice of the European Union<sup>1</sup>.

CIGIs will therefore enjoy the same level of protection as their agri-food counterparts. They will also share the yellow and blue "PGI" logo, already familiar to consumers.

Digital issues have abounded in intellectual property in recent years. As such, the Regulation specifies that any information related to the advertising, promotion and sale of products that contravenes the protection of GIs, is considered illegal content within the meaning of the Digital Services Act<sup>2</sup>. The relevant national judicial or administrative authorities of the Member States may thus issue an order to act against such illegal content.

With regard to domain names, the Regulation conforms to the *acquis communautaire* whereby protection also applies to any fraudulent use of a GI in a domain name. As such, all registries administering country-code top-level domain names (.fr or .eu, for example) must offer an alternative dispute resolution procedure for domain names, and GIs constitute an earlier right that can be invoked in that procedure. For information, in France, this procedure exists through the *Association française pour le nommage Internet en coopération* (AFNIC).

In the future, such protection may be increased, since the Commission must assess the feasibility of an information and alert system against the abusive use of these GIs within the domain name system by mid-2026, and will present a legislative proposal where appropriate.

Finally, as in trademark law, in order to remedy the situation created by the Nokia-Phillips

judgment of the CJEU<sup>3</sup>, the Regulation provides that protection applies to goods entering the customs territory of the Union without being released for free circulation within that territory. Customs are therefore empowered to seize counterfeit products merely in transit through EU territory.

#### ■ Controls

To ensure fair competition, correct information and consumer trust, and to protect the efforts of producers, the GI system is subject to controls which must be effective. The added value of this scheme is based on complementary action between the public authorities and protection and management bodies of GIs. In certain situations, in addition to private initiatives by producer groups, State authorities are also subject to control obligations.

The first aspect of these controls involves checking with the producers concerned that their product complies with its specification, before and after it is first placed on the market. The competent authority, which may delegate this task to third-party certification bodies, therefore conducts audits, upon completion of which it issues a report. If non-compliances are identified, the competent authority takes the necessary measures to remedy the situation. Producer groups are also responsible for setting up internal compliance checks to ensure that production stages comply with the product specification and for providing associated penalties.

The Regulation allows Member States that so wish to set up a mechanism for verifying the compliance of products on the basis of self-declaration by producers, for which control arrangements are detailed in the Regulation.

The second aspect of controls relates to monitoring the use of GIs in the market. A competent authority designated by a Member State (in France, the Directorate General for Competition, Consumer Affairs and Prevention of Fraud known as DGCCRF) ensures that products and services produced, provided or marketed in

<sup>1</sup> See in particular the following judgments: CJEU, C-614/17, Queso Manchego, [PIBD 2019, 1118, III-304](#); CJEU, Glen Buchenbach, [C-44/17](#); CJEU, C-783/19, Champanillo, [PIBD 2021, 1167, III-8](#).

<sup>2</sup> Regulation (EU) [2022/2065](#) of the European Parliament and of the Council of 19 October 2022 on a single market

for digital services and amending Directive 2000/31/EC (Digital Services Act).

<sup>3</sup> CJEU, joined cases [C-446/09](#) and [C-495/09](#), 1 December 2011.

its territory do not contravene the protection of GIs. This authority acts on its own initiative, based on a risk analysis or on notifications from interested producers, and takes, if necessary, the administrative and judicial measures required to prevent or put an end to infringement.

- **The Regulation in the international landscape**

A further reason for the European Regulation is to enable the European Union to fulfil its international obligations under the Geneva Act, which is administered by the World Intellectual Property Organization (WIPO), and to which it acceded in 2019. Indeed, the Geneva Act provides for international registration of both agri-food GIs and CIGIs. It was therefore necessary for the European Union to equip itself with an autonomous system for such GIs.

For future European CIGIs, producers will be able to apply for international protection in all countries that have acceded to the Geneva Act, subject to acceptance by the national competent authorities notified by the Member States to WIPO's International Bureau. Conversely, the EUIPO is designated as a competent authority and will therefore process international applications seeking protection for a GI in EU territory pursuant to the Geneva Act.

In addition to international registration with WIPO, the Regulation also sets out procedures for registering in the European Union geographical indications originating in third countries. The application for registration is submitted directly to the EUIPO.

The creation of European CIGIs is advantageous to the European Union's external policy, as it means that lists of these GIs can be included in free trade agreements (FTAs) between the EU and a third country. Under such agreements, both parties undertake to grant direct mutual protection to the GIs included in the agreement, without having to complete any additional formalities in the third country.

The new Regulation also gives the European Union additional negotiating leverage with some of its trading partners, such as India and China, which have a large number of craft and industrial GIs they would like to see protected internationally.

The introduction of the European system is therefore an effective tool for promoting products derived from European know-how beyond Europe's borders, and offers the possibility of reaching new markets.

- **Entry into application**

Although the Regulation entered into force on 16 November 2023, application of the system has been deferred until 1 December 2025 to give Member States a reasonable amount of time to create or adapt their national legislation.

The French system, which came into force in 2015, will require legislative and regulatory adjustments to ensure its full conformity with EU law. EU law leaves Member States some room for manoeuvre on certain aspects.

This period is also necessary to enable the Commission to issue implementing and delegated acts intended to supplement certain technical elements of the Regulation and to ensure uniform conditions for its implementation.

In order to give the European system its full unitary and exclusive character, the national GI protection systems for craft and industrial products will cease to exist as of 2 December 2026.

To ensure a smooth transition, the Regulation provides a procedure according to which, before this deadline, the Member States will notify the Commission and the EUIPO of the names that are legally protected or, in Member States where there is no protection system, of the names established by usage they wish to register and protect at European level. The EUIPO will examine whether the applications meet the requirements of the Regulation and, where applicable, will register the GIs without recourse to an opposition procedure.

As such, French CIGIs now have a European and international future ahead of them. ■

*By Léonard Munsch, Legal and international Department, INPI*

# 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, 22 March 2023:** The Court of Cassation considers that the [infringement seizure](#), a protective measure to preserve evidence, may be authorised after the infringement proceedings have been initiated and without the need to justify any particular circumstances. Accordingly, at this stage of the proceedings, the owner of the intellectual property rights may exercise the **right to information** to demonstrate the extent of the infringement, but also apply for an infringement seizure even though the proceedings are *ex parte*. The Court maintains that on this point French law is in conformity with Article 7.1 of **Directive 2004/48/EC** on the enforcement of intellectual property rights and Article 50.1 of the **TRIPS Agreement**.

**Paris Court of Justice (tribunal judiciaire de Paris), 12 May 2023:** The application for a declaration of invalidity of the [French word mark NOAH](#), consisting of the surname of a famous tennis player, on the grounds of **fraudulent filing** is rejected. It has not been shown that the sportsman who filed the trademark was aware of the earlier filing of an American semi-figurative mark composed in particular of the term 'Noah' by the American plaintiff company, which markets men's clothing and accessories. The fact that he already holds the European Union word mark YANNICK NOAH, together with several semi-figurative marks including his name 'Noah', renders it unfitting to question the **presumption of good faith of the trademark applicant**. The word mark 'Noah' was better suited for defending his rights than the earlier trademarks, while his appointment as captain of the French Davis Cup team was likely to relaunch his career in the media.

**Paris Court of Appeal, 26 May 2023:** The Paris Court of Appeal orders the **termination, due to the French licensor's fault**, of the licence contract for the Chinese [trademark CHRISTIAN LACROIX](#), entered into for the distribution of cosmetic products on Chinese e-commerce sites. The **trademark was no longer in force** following a decision by the court of Beijing ruling on an appeal against the decision of the Chinese intellectual property office, which had cancelled it for non-use. There was therefore uncertainty as to the licensor's rights in China, of which it did not inform the French licensee company, even though the latter had inquired about the renewal of the trademark. As a result, the licensor did not provide the licensee with **peaceful enjoyment** of the licensed trademark.

### Paris Court of Appeal, 5 July 2023:

The use of the semi-figurative trademark TOUR DE FRANCE A LA RAME to designate a boat race **is not detrimental to the reputation** of the [TOUR DE FRANCE trademark](#) for services involving the organisation of cycling events. The visual, phonetic and conceptual similarity between the signs is low and, despite the similarity of the services in issue, the general public concerned will not be led to establish a link between the trademarks. Moreover, there is no evidence of undue exploitation or likelihood of dilution of the reputed trademark.



**Court of Cassation, 27 September 2023:** The Court of Cassation agrees with the Versailles Court of Appeal, which held that the three-dimensional sign applied for, consisting of a yellow coil, to designate cheeses, **did not depart**



significantly from the standard or usual practices of the food sector and was thus devoid of any [distinctive character](#).

## Designs

**Paris Court of Appeal, 14 April 2023:** A communication agency which, following an order from a pharmaceutical group, [designs drug packaging](#) may claim the copyright on that packaging as a collective work once it has been made available to the public under its name. However, the infringement action is rejected on the grounds that the packaging lacks originality. The pharmaceutical company's filing of a **three-dimensional trademark** representing the packaging is not fraudulent and the application to transfer the trademark to the communication agency must be rejected. Indeed, the defendant could legitimately file the shape of a packaging whose design it ordered and which was billed to it by its provider as a trademark to designate the products it markets.

**Paris Court of Appeal, 27 September 2023:** The Paris Court of Appeal considers that the lamp invoked is protected by copyright and is infringed. The defendant, an interior designer, ordered several copies of the lamp to decorate a hotel in Switzerland. The lamp's appearance in two photographs posted on his Facebook and Instagram accounts is **by deliberate choice of the photographer or defendant**, who literally appears with the lamp. Therefore, the latter cannot benefit from the [exception of incidental inclusion](#) in other material to argue the absence of infringement. This concept, which stems from Directive 2001/29/EC of 22 May 2001 and has been taken up by French case-law in the context of the incidental character theory, should be understood as "an incidental and involuntary representation in relation to the subject involved or represented". The right of paternity of the creator of the lamp was thus infringed.

## Patents

**Paris Court of Appeal, 21 April 2023:** The divisional European patent invoked for a video game console controller, the main claim of

which was modified during the EPO granting procedure of the patent, is invalidated by the Paris Court of Appeal on the grounds of **extension of the subject matter beyond the content of the initial application** by [inadmissible intermediate generalization](#).

## Geographical Indications

**Court of Nanterre, 23 January 2023:** The **protected designations of origin (PDO)** 'Côtes de Provence', 'Les Baux de Provence', 'Côteaux d'Aix-en-Provence' and 'Côteaux Varois de Provence' are infringed by evocation, as defined in [Article 103, § 2, b\)](#) of Regulation (EU) No. 1308/2013, as a result of a tourism office in the Luberon using the names 'Cœur de Provence' and 'Luberon Cœur de Provence' in its domain name and on its website to present wines and wineries of the Luberon or the Ventoux not covered by the PDOs of Provence invoked.

**Court of Cassation, 27 September 2023:** The Supreme Court ends the dispute concerning the approval of the [geographical indication 'Linge basque'](#) by the INPI. The product in question (household and table linen woven in linen or cotton) is made using a traditional know-how mainly attributed to the Pyrénées-Atlantiques Department. It can therefore benefit from the geographical indication even if the know-how exists outside this geographical area. The Court of Cassation **thus endorses the practice of the INPI** in this matter, already confirmed in a dispute concerning the geographical indication 'Porcelain de Limoges'. It was held that the raw materials used to produce the manufactured products, as well as the manufacturing techniques, did not necessarily have to come exclusively from the geographical area delimited by the geographical indication. This case-law is of particular importance for the implementation of the new European system of geographical indications for artisanal and industrial products at the end of 2025, which was adopted on 9 October 2023.

# INPI Decisions

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## Filing in bad faith of the trademark **Wormbox** with the intention of depriving a third party of a sign necessary to his business in the niche market of worm composting

### WORMBOX

The contested word mark, WORMBOX, registered to the following goods and services: « packaging containers of plastic; dustbins; providing information relating to material treatment; waste treatment (transformation); recycling of waste and trash »: is invalidated pursuant to Articles L.714-13 and L.711-2 of the French intellectual Property Code according to which the registration of a trademark which was **filed in bad faith** by the applicant is declared invalid.

The invalidity applicant (hereafter the « applicant »), who was using an identical trademark to designate a worm composter and had forgotten to renew it, alleges bad faith filing on the part of the owner of the contested trademark.



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In accordance with the principles set out by the Court of Justice of the European Union, in

assessing bad faith on the part of the owner, all relevant factors specific to the case in question must be taken into account, in particular the applicant's intention.

Bad faith is likely to be found when it is apparent "from relevant and consistent indicia that the proprietor of a trade mark has filed the application for registration of that mark not with the aim of engaging fairly in competition, but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin" (CJEU, 4<sup>th</sup> Chamber, 29 Jan. 2020, Sky, C-371/18, §75).

A relevant factor of bad faith is, in particular, the fact that the trademark applicant knows or must know that a third party is using an identical or similar sign for identical or similar goods and/or services, causing confusion with the sign whose registration is contested (CJEU, 1<sup>st</sup> Chamber, 11 June 2009, Chocoladefabriken Lindt & Sprüngli AG, C-529/07). Such knowledge may be presumed, in particular, where there is general knowledge in the economic sector concerned of such use (CJEU, 5<sup>th</sup> Chamber, 12 Sept. 2019, Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ, C-104/18) or when both parties operate in a restricted market (French Court of Cassation, Commercial Division, 2 Feb. 2016, Maviflex SAS v. Nergeco France SAS).

The **fraudulent nature** of the filing is assessed on the filing date and cannot be presumed, as the burden of proof rests with the party alleging fraud.

In this case, it is clear from the documents provided by the applicant that he has made repeated and intensive use of the sign WORMBOX to designate a model of worm composter since 2011, namely a period prior to the filing of the contested trademark.

The owner of the contested trademark and the applicant operate in the same **niche market of worm composting** ; a market in which the applicant enjoys proven media coverage. As a result, on the filing date of the contested trademark, the owner of the contested trademark could not have been unaware of the prior use of the sign WORMBOX on the part of the applicant to designate a model of worm composter.

Regarding the **intention to illegitimately deprive a third party of a sign necessary to his business**, in this case, the contested trademark relates to a sign identical to the earlier sign **used intensively** by the applicant and designates goods and services identical and similar to the applicant's activities, relating to the treatment and recycling of waste and trash.

It is also important to emphasise that the contested trademark was filed just three months after the applicant's WORMBOX trademark had expired.

Moreover, the applicant used the ® symbol on his website to designate its WORMBOX worm composter, thus drawing the public's attention to the protection afforded to this sign. Even if there is no legal value attached to this symbol, it is readily understood by the French public as an indication that the sign is protected as a trademark, thereby identifying the commercial origin of the product on which it is affixed.

Given the sequence of events (filing of the contested trademark subsequent to the non-renewal of the applicant's trademark), the competitive situation between the parties in a niche market, as well as the identity between the contested trademark and the sign used intensively by the applicant, the filing of the

contested trademark **cannot be mere coincidence** (GCEU, 6th Chamber, 28 January 2016, Mr. J-M D, T-335/14).

It is clear from these elements that the owner of the contested trademark has **knowingly acted in disregard of the applicant's interests** by depriving him in advance of the sign he is likely to use in the course of his business, and in order to **create an association** with the prior sign used by the applicant in the area of worm composting. It is on these elements that the finding of bad faith is based. ■

**INPI decision, 12 July 2023**, NL 23-0021 ([NL20230021](#))

La Ferme du Moutta v. Mr. N.

*By Marie Jaouen, Head of the Publishing and Translation Unit, INPI*

# French IP Law Updates

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## INPI approves two new geographical indications: 'ARGILES DU VELAY' and 'PIERRE DU MIDI'



Left: crushed clay © Association de protection et de valorisation des Argiles du Velay  
Right: Marguerites Training Centre (Var department) © Association Pierre du Midi

On 13 October 2023, the day when the corresponding notices were published in the Official Journal, the French Patent and Trademark Office (INPI) approved two new geographical indications: 'Argiles du Velay' (Velay clays) and 'Pierre du Midi' (Midi stone).

Pascal Faure, CEO of INPI, said: *"INPI is proud to include Velay clays and Midi stone among geographical indications. The geographical indication 'Argiles du Velay' recognises the high quality of the minerals found in the Velay Basin and the expertise required for the processing of clay. Considering that the beauty and cosmetics industry is among the worst hit by counterfeiting, the geographical indication is a key approach for ensuring high-quality goods. As for 'Pierre du Midi', the fact that the geographical indication has been approved highlights how rare and distinctive the material is. It also promotes the techniques involved in its extraction and processing. We congratulate the players in both sectors who were able to work in a collaborative and efficient manner"*.

### ARGILES DU VELAY

Velay clays are among the purest on the French market. Unlike other clays, they contain neither quartz nor silica. They are made up of three minerals – illite, kaolin and montmorillonite – which contain active ingredients prized for their digestive and wound healing properties. There is only one deposit in the Puy-en-Velay Basin, which makes the clays all the more rare and precious. Local businesses use and transform the clays mainly in the fields of cosmetics and animal feed.

The benefits of Velay clays have been known for thousands of years and they were first used to make pottery. With time, they became used in various sectors (such as cosmetics, farming, animal care and even industrial absorbents). Now, almost 100,000 tonnes of clay are extracted and processed every year.

**The geographical indication 'Argiles du Velay'** covers products from primary processing (powdered, granulated, raw, packaged and bulk clay) and products from secondary processing (capsules, clay mud, clay paste, clay mask).

Clay processing must be natural and not involve any chemical treatment.

The geographical area defined in the specification is limited to the Haute-Loire department (43), where all extraction and processing operations must take place.

Four SMEs are concerned by the approval of this geographical indication. They have 75 employees and a turnover of around €20 million.



The Association pour la protection et la valorisation des Argiles du Velay ('Association for the Protection and Promotion of Velay Clays') is the protection and management body of this geographical indication.



Source: specification of the Association de protection et de valorisation des Argiles du Velay ('Association for the Protection and Promotion of Velay Clays')

## PIERRE DU MIDI

Midi stone has been used to build an exceptional immovable heritage throughout Provence, including the amphitheatres in Nîmes and Arles, the Roman Theatre of Orange, and many aqueducts. Several families of stone fall under the Pierre du Midi category, all of which are linked to the municipalities where their quarries are located. The most famous ones are the Fontvieille stone, the Rognes stone and the Pont-du-Gard stone.

This limestone rock comes in several varieties, colours, densities and degrees of hardness depending on the cements it contains. Locals value it for its robust nature and thermal properties. Both characteristics made it popular beyond Provence, especially when large cities (Lyon, Geneva, New York, Algiers) were being renovated in the 19th century.

Midi stone has been appreciated since Roman times, when it was used to erect buildings. Across many generations, this distinctive deposit has attracted professionals in stonework, architecture and design to the region. Their expertise has been maintained and honed, in particular in several training centres.

The geographical indication 'Pierre du Midi' covers raw products (blocks, riprap), semi-finished products (slices), stones cut from quarried blocks, veneer stones and replacement stones.

The following operations must take place in the geographical area defined in the specification:

- Extraction. The following departments: Hérault (34), Gard (30), Bouches-du-Rhône (13), Vaucluse (84), Drôme (26), Alpes-de-Haute-Provence (04)
- Processing. The departments above + Pyrénées-Orientales (66), Aude (11), Lozère (48), Ardèche (07), Hautes-Alpes (05), Var (83), Alpes-Maritimes (06).

The approval concerns fifteen businesses across three regions (details can be found in the specification). The businesses employ around 90 employees and have a turnover of €12 million.

The Association Pierre du Midi ('Pierre du Midi Association') is the protection and management body of this geographical indication.

Sixteen geographical indications have been approved by INPI since the system was introduced in 2016. ■



Source: specification of the Association Pierre du Midi ('Pierre du Midi Association')



# About INPI

## INPI Awards 2023

The annual ceremony for the INPI Awards 2023 took place on Thursday 23 November, in Paris, in the presence of Pascal Faure, CEO of INPI, along with various guests from the innovation and intellectual property ecosystem.

The jury, chaired this year by Géraldine Guéry-Jacques, President of the French Association of Industrial Property Specialists in Industry (ASPI), rewarded:

**BARRISOL NORMALU** (Kembs, Grand Est)  
Winner in the 'Export' category, BARRISOL NORMALU is a mid-cap specialising in stretch ceiling design.

**EDAP TMS** (Vaulx-en-Velin, Auvergne-Rhône-Alpes)  
Winner in the 'Industry' category, EDAP TMS develops medical solutions based on the use of therapeutic ultrasound.

**VALOREX** (Combourtillé, Brittany)  
Winner in the 'Responsible Innovation' category, VALOREX Green develops processes for manufacturing cooked seed-based food and feed.

**LIFY AIR** (Saint-Denis-en-Val, Centre-Val de Loire)  
Winner in the 'Research Partnership' category, LIFY AIR detects airborne pollen in real-time.

**DRONISOS** (Bègles, Nouvelle-Aquitaine)  
Winner in the 'Start-up' category, Dronisos specialises in the creation of autonomous drone light shows.

In his keynote address, **Olivier Becht, Minister Delegate for Foreign Trade, Economic Attractiveness and French Nationals Abroad**, emphasised the "absolutely essential" nature of intellectual and industrial protection "to ensure the competitiveness of French businesses on the global scene".



By Jean-Marie Cras

After mentioning the entry into force of the European patent with unitary effect and of the Unified Patent Court, on 1 June 2023, which will enable French businesses "to protect their innovations more effectively", he encouraged all French economic operators to "take full advantage of this supportive environment by building industrial property into their development strategy, for the sake of creating value and attracting investment in France".

He also highlighted the ties forged over the past five years between INPI and Team France Export, thanks to which "French export firms and companies looking to expand into foreign markets can get a clearer idea of the key issues associated with industrial property". Olivier Becht ended by congratulating the winners of the INPI Awards 2023.

*"Well done to the winners of the INPI Awards 2023. It is an immense honour for me to support and encourage these companies' innovation strategies. There is an industrial property strategy for each of them, and I am delighted to see that these business leaders and their teams have leveraged this tool to better guarantee the income associated with their innovations."*

**Géraldine Guéry-Jacques**

*"Congratulations to the winners of the INPI Awards 2023. It is a joy, once again, to celebrate these innovative companies and the inspiring careers of their leaders. INPI is proud to reward their efforts to turn industrial property into a driver for growth – this is a tremendous testament to the support for innovation!"*

**Pascal Faure**

At the end of the ceremony, the guests had the opportunity to see the innovations of the 15 finalists of these INPI Awards 2023, and to find out the winner of the first 'INPI pitch contest' organised at the last Viva Technology event. ■

## Skis by Rossignol (1942)



Patent 888077, filed on 18 March 1942

*Although the concept of skiing is thousands of years old, the first Olympic laminated wood skis were only patented in 1942 by Abel Rossignol*

**F**ossil skis unearthed from Scandinavian peat bogs are proof that people have been using wooden planks attached to their feet with strips of hide since as early as 4000 BC. In the Arctic, for centuries people have been cobbling skis together with the wood they could find.

In France, skis were first used by the military at the turn of the 20th century. Until after World War II, skis were made exclusively by carpenters and clever DIY enthusiasts. One of them was **Abel Rossignol**, the head of a small manufacturing company of wooden goods in Voiron, who built his first pair of skis in solid wood in 1907. **In 1942**, when filing the **patent for the Olympic 41 laminated wood ski**, Rossignol laid the groundwork for recreational and competitive skiing.

It was also the beginning of the feud between him and his competitor Salomon from Anancy, who invented heel release ski bindings (in 1966) and rear entry ski boots (in 1979). Meanwhile, Rossignol strengthened France's top position on the global ski market and his own position as leader with the Allais 60 (1960), the company's first wood and metal ski, and the Strato (1964), its first fibreglass ski.

Ski equipment benefited from the huge boom in materials. Skiing was driven by competition. The popularity of winter sports in the 1970s also played a role... but only for a while. Now, only 3.5 million pairs of skis are sold per year. As opposed to 11 million in 1979. ■

# International IP Law news

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## UPC Update

The European patent with unitary effect and the Unified Patent Court (UPC) entered into force on 1 June 2023. Until then, there had been no unitary title for patents in Europe, resulting in a fragmented European market with bundles of national patents and national decisions. The unitary patent and the Unified Patent Court have been introduced to overcome this fragmentation by offering a single title covering multiple European territories and a single court for European patents. As such, they help to deepen the single market.

Six months after its launch, we can take a look at **initial statistics from the Unified Patent Court**, whose central division has its main seat in Paris with two sections in Munich and Milan (in 2024). The Court as a whole has 37 judicial judges (legally qualified) and a pool of 68 technical judges (technically qualified). As of 8 December, a total of 120 cases had been brought before the UPC since it was set up: 54 infringement cases, 77 revocation actions, 29 revocation counterclaims, and 8 preliminary measures and preserving of evidence.

Actions brought before the UPC are listed in the UPC registry, which can be accessed online:

<https://www.unified-patent-court.org/en/registry/cases>

*By Elodie Durbize Head of the International and legal Unit, INPI*

## Cooperation initiative between France and Mexico concerning the potential IGs

In 2023, the French Patent and Trademark Office (INPI) and its counterpart, the Mexican Institute for Industrial Property (IMPI), decided to strengthen their cooperation with regard to geographical indications (GIs) in particular.

Earlier this year, INPI's CEO took part in the inauguration of **the first seminar devoted to GIs for craft and industrial products** during his visit to Mexico City. At that time, in conjunction with the French Embassy in Mexico City, the two IP Offices agreed that 2023 would be the "Franco-Mexican Year of GIs" and set the objective of organising another major event by the end of the year.

Accordingly, a **new cooperation initiative** on GIs took place on 3 and 4 October 2023 with two key events:

- An informal meeting behind closed doors directed towards a technical exchange on GIs to identify avenues for future cooperation between our two countries.
- A seminar in hybrid format held in Mexico City, involving a strong collaborative effort between our two countries to bring together experts from France, Mexico and other countries (Colombia) who were invited to share their experience with the objective of supporting rural communities and public authorities by helping them become aware of the potential offered by GIs.

This event was organised jointly with the French Embassy in Mexico, the Ministry of Agriculture and INPI on the French side, and

IMPI together with the Ministry of Agriculture on the Mexican side.

In this context, Stéphanie Leparmentier<sup>1</sup>, INPI Regional IP Counsellor for North America, and Antoine Ginestet<sup>2</sup>, INPI Head of Geographical Indications, also travelled to Mexico City to take part in the seminar.

Antoine Ginestet highlighted the potential of GIs for craft and industrial products, as well as the main difficulties encountered in creating new GIs in France.

Numerous stakeholders also participated in this seminar, in particular, on the French side, the National Institute of Origin and Quality (INAO) which reported on France's experience with GIs, and stakeholders in the field with representatives of the Beaufort cheese GI (Beaufort) and the Basque Linen GI (Linge basque).

On the Mexican side, the panels included representatives from both IMPI and the Mexican Ministry of Agriculture, as well as representatives of GIs from Mexico: Chiapas Amber (Ámbar de Chiapas) and Cajeta de Celaya, a sweet from the city of Celaya.

This seminar also featured participation of a lawyer representing Colombian artisans, thus giving the audience an insight into Colombia's vision of the importance of GIs in the development of rural communities and the support provided to these communities.

These exchanges have undoubtedly enabled us to share best practices for how authorities can support rural communities in the use of GIs, and optimise awareness of the potential of GIs for rural development, rural tourism and exports. ■

*By Stéphanie Leparmentier, INPI Regional Counsellor for North America*

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The members of INPI's "international network" (ten counsellors covering around 100 countries) implement international cooperation initiatives with its public and private partners worldwide. They also support companies

## Saudi Arabia Forum on Geographical Indications

*On 28 & 29 November, a regional forum on geographical indications (GIs) was held in Riyadh, Saudi Arabia, attended by a dozen Arab League nations.*

This forum was put on by INPI and the Saudi Authority for Intellectual Property (SAIP), as part of their close cooperation on the subject of geographical indications. WIPO was also involved in the event's organisation.

Dedicated to authorities in charge of GIs in the Arab countries represented, this forum had the following main objectives:

- to present the Lisbon Agreement and the Geneva Act and to discuss their advantages;
- to highlight the differences between the system specific to GIs and the one concerning collective and certification marks;
- to initiate discussions on the structures required – both legal and administrative – for implementing the GI system;
- to talk about the GI schemes in France and the Arab countries.

Participants at the event were from a variety of backgrounds, all in connection with GIs, including IP offices, ministries of agriculture or handicrafts, and harked from countries across the Arab world (Saudi Arabia, Bahrain, Egypt, Jordan, Morocco, Oman, Tunisia and United Arab Emirates, among them).

Various experts, from INPI (Antoine Ginestet<sup>2</sup>), INAO (the French Institute of Origin and Quality) (Sarah Mezerette) and WIPO (Alexandra Grazioli and Walid Abdelnasser), as well as a professor from Université de Lille, Caroline Le Goffic, spoke during the panel discussions, drawing on their expertise to bring

in their export activities, in liaison with the French Treasury Department

<sup>2</sup> [aginetet@inpi.fr](mailto:aginetet@inpi.fr)

an interactive and practical approach to the GI theme.

In addition to these specialists, many GI representatives, such as in France with the examples of the Absolve Pays de Grasse GI and the Espelette pepper GI, or in Arab nations (from OMPIC, SAIP or the Tunisian Ministry of Agriculture) also took part in the discussions to present their respective GI systems.

These two days of talks and feedback shed light on the importance and potential of GIs, not least the economic, social and tourism-related impact that they represent for agriculture and handicrafts.

*By Céline Boisseau, Coordinator of INPI International Network<sup>1</sup>*

## Signature on 28 November 2023 of a Patent Prosecution Highway (PPH) agreement with the Saudi Authority for Intellectual Property (SAIP).

On 28 November, a bilateral meeting was held in Riyadh between the French Patent and Trademark Office (INPI) and its Saudi counterpart, the SAIP, at the end of which the two offices signed an agreement designed to accelerate the granting of patents (Patent Prosecution Highway (PPH)).



*Pascal Faure, CEO of INPI*

*Ludovic Pouille, France's Ambassador in Saudi Arabia*

*Abdulaziz AlSwailem, CEO of SAIP*

On the international scene, this is the **eighth agreement of this kind signed by the INPI**, and the **first with a Middle Eastern country**,

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since the first PPH agreement was signed with the Japanese Patent Office (JPO) on 26 November 2020.

The INPI has also signed PPH agreements with the United States Patent and Trademark Office (USPTO) and the Canadian Intellectual Property Office (CIPO), concluded at the end of 2021. Other agreements include those with the Brazilian Office (INPI Brazil) and the Korean Intellectual Property Office (KIPO), signed in 2022, and finally this year with the China National Intellectual Property Administration (CNIPA) and the Moroccan Industrial and Commercial Property Office (OMPIC).

The agreement signed with SAIP will not come into force until 30 April 2024. From this date onwards, applicants will be able to request the acceleration of the grant procedure for a second patent application filed with the SAIP, whether it is a national application or a Saudi national phase of a PCT application, provided that the latter contains claims sufficiently similar to those mentioned in the application examined and deemed patentable by the INPI. Reciprocally, this PPH agreement will apply to applicants wishing to benefit from accelerated processing of patent applications in France, whether they claim priority from a Saudi national application or a PCT application.

A closer look at patent filings with the Saudi Authority shows that French applicants are relatively active, ranking sixth among all foreign applicants.

Given the interest shown by French applicants in obtaining protection for their innovations on the Saudi market, this agreement will provide them with a new and faster route for obtaining a patent in Saudi Arabia. This signature strengthens the INPI-SAIP cooperation in patent matters, further strengthening their ties.

*By Céline Boisseau, Coordinator of INPI International Network*



## The INPI joins forces with the Universities of Paris-Saclay and Tsinghua to organise a conference on comparative French-Chinese intellectual property law



*Opening of the conference by the Minister Counsellor of the French Embassy in China*

On 9 November, a comparative law conference entitled Franco-Chinese Intellectual Property Day was held. Organised by a number of Intellectual Property (IP) players, including the INPI, the French Embassy in China and two universities in France and China, the event provided an opportunity to share experience and knowledge on a variety of IP topics.

This conference is part of the university cooperation partnership currently being signed between the law faculties of Paris-Saclay and Tsinghua universities. This agreement on cooperation in the field of intellectual property will have two components: a research component, designed to ensure the long-term viability of scientific exchanges between the two universities and between France and China more generally, and a student mobility component at Masters level. Through its involvement in the organisation of the conference, the INPI is supporting these academic players in their desire to contribute to Franco-Chinese cooperation in the field of intellectual property.

The conference, designed to give French and Chinese intellectual property professionals a better understanding of the similarities and differences between our legal systems, was a

resounding success, with a total of almost 240 participants, both in person and on Zoom. This excellent turnout was facilitated in particular by the support of the French National Company of Industrial Property Attorneys (CNCPI) in France and several Chinese organisations such as the Chinese Bar Association as well as the Chinese Trademark Association, who were instrumental in relaying the invitation to their members.

As the Minister Counsellor of the French Embassy in China pointed out at the opening of the conference, "knowledge-sharing of this kind is necessary, as it enables us to increase mutual understanding of our legal environments. This is essential in the context of Franco-Chinese cooperation on intellectual property, but also crucial if we are to be able to draw inspiration from each other".

In addition to the organisational and logistical aspects, the INPI's involvement included a presentation by Laurent Mulatier, Head of the INPI's Litigation Department, on the French system for employee inventions.

The half-day conference also sparked a rich exchange of views, and the number of questions asked by the audience testified to the genuine interest generated by the issues addressed.

*By Julie Hervé, INPI Regional Counsellor for China <sup>1</sup>*

## INPI CEO's visit to the Ivory Coast

On 12 and 13 October, Pascal Faure travelled to Abidjan, Ivory Coast, where a major annual Intellectual Property (IP) event was being held: "the days of the innovation Ivorian trademark", the aim of which is to develop a genuine trademark culture in the Ivory Coast through judicious use of the IP system and raising consumer awareness of the dangers of counterfeiting and piracy. On 12 October, our CEO took part in the opening ceremony of the

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training seminar for magistrates from around twenty African countries.

On the same day, a joint committee was organised between the National Anti-Counterfeiting Committee (CNAC) and its Ivorian counterpart, the CNLC (National Committee for the Fight against Counterfeiting), to enable the two committees to sign a work programme aimed at improving the exchange of information, structuring training programmes and promoting the establishment of similar committees in other countries in the zone.

The meeting was attended by Michel N’Zi, President of the CNLC, Christophe Blanchet French MP, President of the CNAC, Pascal Faure, Delphine Sarfati, Director General of Unifab (Manufacturers’ Association, and Caroline Rolshausen<sup>1</sup>, our Regional Counsellor.

Another highlight of Pascal Faure’s visit to the Ivory Coast was the annual joint committee meeting with the OAPI<sup>2</sup>, the African Intellectual Property Organization.

Primarily, this joint committee provided an opportunity for an exchange on the respective news of the two offices.

The Director General of the OAPI, Denis Bohoussou, presented the news for the years 2022-2023, notably in terms of support for SMEs, with the organisation of the Innovation Fair in Abidjan in July and the Trademark Awards in Lomé in September.

He also reviewed the major events relating to Geographical Indications (GIs), in particular the OAPI’s recent accession to the Geneva Act of the Lisbon Agreement and the registration of eleven GIs, including three from the Ivory Coast, last July.



Pascal Faure spoke in particular about trends in IP filings, the new patent procedures implemented under the Pacte Act, and news relating to the one-stop shop and the national register of companies.

Given that pre-diagnosis in IP matters is a subject of cooperation between the two offices, Mr Faure presented the range of support services available to companies, as well as the training courses offered by the INPI.

He also discussed the reform of GIs at European level, as well as France’s attractive position in the context of the Unified Patent Court and the patent with unitary effect.

This joint committee also provided an opportunity to take stock of the past cooperation programme and to review the key points of the future 2023/2024 programme, which aims to bring the INPI and the OAPI even closer together:

- by harmonising our procedures;
- by cooperating to promote IP for businesses;
- by promoting the French-speaking world in IP matters.

*By Céline Boisseau, Coordinator of INPI International Network*

<sup>1</sup> [caroline.rolshausen@dgtrésor.gouv.fr](mailto:caroline.rolshausen@dgtrésor.gouv.fr)

<sup>2</sup> The African Intellectual Property Organisation (OAPI) is a regional office covering 17 West African countries: Benin, Burkina Faso, Cameroon, Central African Republic,

Chad, Comoros, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

# Agenda

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## 11 January 2024

**Café ASPI – A strong patent to ward off potential suits**

[Details](#)

## 23-25 January 2024

**WIPO – Advanced Patent Analytics Training Seminar and Workshop, CIPC**

[Details](#)

## 30 January- 1<sup>st</sup> February 2023

**Business France – Forum on consumer goods in Northeast Asia**

[Details](#)

## 1<sup>st</sup> February 2024

**Café ASPI – Patentability of computer-implemented simulations – Decision G1/19: what now?**

[Details](#)

## 23-24 February 2024 / 22-23 March 2024 / 19-20 April 2024

**CEIPI – Training Program on the Unified Patent Court**

[Details](#)

## 4-8 March 2024

**INPI – Training: Patents - advanced level**

[Details](#)

## 5-7 March 2024

**Business France – Algeria Meeting 2024**

[Details](#)

## 21-22 March 2024

**UNIFAB – SAVE THE DATE!**

**28th European forum on intellectual property**

[Details](#)

## 26 March 2024

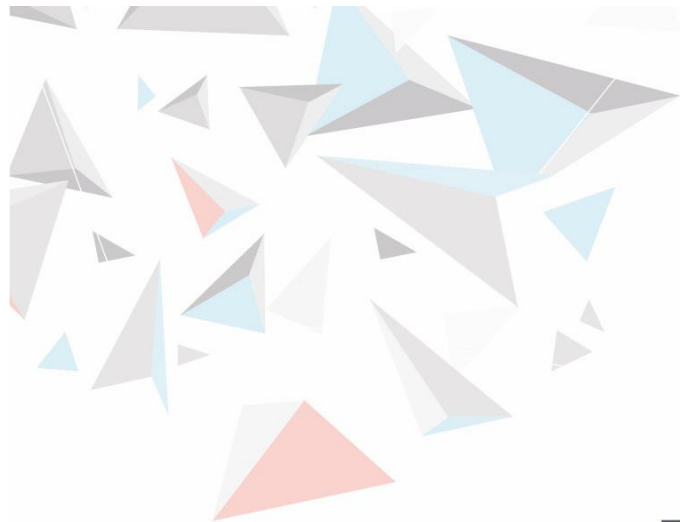
**FNDE – « Trademark law »**

[Details](#)

## 10-11 April 2024

**INPI – Focus on international trademark procedures**

[Details](#)



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