



# HSM IP Trade Mark Client Guide

## FRANCE & THE FRENCH CARIBBEAN (INC. FRENCH POLYNESIA)

### Registration

A trade mark can be registered in France pursuant to *Law No. 91-7 of January 4, 1991* on Trademarks and Service Marks which provides for local trade mark applications dating from receipt of the application.

The following information and documentation is required:

1. name of the trade mark
2. one copy of the mark (unless mark is word only)
3. class(es) and specification of goods
4. applicant's name and address (and state or country of incorporation if applicant is a company)
5. copy of priority document (if priority is claimed) (with French translation)

It usually takes about eight months for the Director General at the National Institute of Industrial Property (INPI) to process an application for registration. Paris Convention priority can be claimed. Once the registration is complete the Director General will issue a Certificate of Registration.

Trade marks registered in France automatically provide registered protection in French Overseas Departments and Territories (DROM) namely Guadeloupe, French Guiana, Martinique, Mayotte and Reunion and the Overseas Communities (COM) which are Saint Barthelemy, Saint Pierre and Miquelon, Wallis and Futuna, Saint Martin and New Caledonia. No separate cover is possible.

Since 1 February, 2014 it is possible to extend coverage to French Polynesia pursuant to *Law No. 2013-14 of May 6, 2013, Article LP 138* and *Order No. 1002 CM of July 22, 2013*. The extension must be expressly requested in the application and will be effective only if the French application is granted.

### Classes

The International Classification system is used. Multi-class applications are allowed.

### Searches

In order to conduct a search the documentation required is the name of the trade mark, one copy of the mark (unless mark is word only) and a list of the proposed goods and/or services. The result can usually be provided within two weeks.

### Renewal

A trade mark registration is valid for 10 years after which it can be renewed for like periods. Two months before the renewal date we will send you an Expiry Notice asking whether you wish us to renew the registration or allow the mark to lapse.

The application for renewal should be filed prior to the expiration date of the registration. A grace period of six months, however, is allowed from the expiration date for the filing of the application for renewal upon payment of a late fee. After that time a new application for registration is required.

It usually takes about 4-5 months for the Director General to process an application for renewal. Once the renewal is complete the Director General will issue a Notice of Renewal.

Renewal of an extension to French Polynesia must be expressly requested in the application and will be effective only if the French application is granted.

If you do not wish to renew the mark please inform us so that we can advise the Director General accordingly.

## **Abandonment**

Please inform us as soon as possible if you wish to abandon your trade mark or allow it to lapse so that we can update our records and advise the Director General accordingly. This will avoid us sending out unnecessary Reminder Notices.

## **Assignment**

Please inform us as soon as possible if the trade mark has been assigned so that we can file an application to record the assignment in France.

To record the assignment of a trade mark registration the only documentation required is the Deed of Assignment (with French translation).

It usually takes about 2-3 months for the Registrar to process an application to record an assignment. Once the recording is complete the Director General will issue a Certificate of Registration of Assignment.

All records entered on the French Register against registrations extended to French Polynesia automatically have effect in French Polynesia.

## **Change of Particulars**

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change in France.

To record a change of name for a trade mark registration the only documentation required is a copy of the document evidencing the change (with French translation). To record a change of address no documentation is required.

It usually takes about 2-3 months for the Director General to process an application to record a Change of Particulars. Once the recording is complete the Director General will issue a Certificate of Recording showing the change.

All records entered on the French Register against registrations extended to French Polynesia automatically have effect in French Polynesia.

## **Our Firm**

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other offshore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, ASIPI, CITMA, MARQUES and IPCA.

## Contact Us

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*HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).*

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