

# Protecting your trademark

Your trademark is the first point of contact between your business and your customers: it carries your reputation, embodies your values and accounts for a growing share of your company's worth. Protecting it means securing your growth.



| TERM                             | OFFICES             | PRIORITY                    | WATCH OUT                            |
|----------------------------------|---------------------|-----------------------------|--------------------------------------|
| 10 years, renewable indefinitely | INPI · EUIPO · WIPO | 6 months (Paris Convention) | Revocation for non-use after 5 years |

## What a trademark protects, and on what conditions

A trademark is a sign that distinguishes your goods and services from those of your competitors: a name, a logo, a slogan, but also a shape, a colour, a sound or an animated sequence. Once registered, it gives you a ten-year exclusive right, renewable indefinitely, the only industrial property title that can potentially last forever.

To be valid, the sign you choose must be distinctive (it cannot merely describe your goods or their qualities), lawful, non-deceptive and available, that is, it must not infringe earlier rights: trademarks, company names, domain names, copyright... Protection is also governed by the principle of speciality: it applies only to the goods and services designated at filing, spread across the 45 classes of the Nice international classification. Choosing the sign and drafting the specification are therefore the two founding decisions of your protection.

## Why is a prior-rights search essential?

Because no office will do it for you. Neither the INPI nor the EUIPO checks, at filing, whether the sign you have chosen is available: a trademark can sail through registration and yet remain exposed to an opposition, an invalidity action or infringement proceedings brought by the holder of an earlier right, sometimes years after launch. The cost of that scenario far exceeds the cost of the search: rebuilding your identity, packaging and materials, losing your search rankings and hard-won recognition, and possibly paying damages. Filing without searching is building on land whose title you never checked.

A serious search is not limited to identical marks: it extends to similar signs, in sound, spelling or connotation, likely to create a likelihood of confusion for related goods or services, and covers every enforceable earlier right: French, European Union and international trademarks designating France, but also company and trade names, shop signs, domain names, geographical indications and even copyright. The value lies in the analysis: assessing the likelihood of confusion legally, sign by sign and product by product, then turning it into a strategy, adapting the sign or the specification, negotiating coexistence, obtaining consent, buying out the conflicting right, or changing course while there is still time. This is also why the search belongs inside the naming process: a quick screening of several candidate names, then an in-depth investigation of the chosen one.

## How do you file and register your trademark?

In France, trademark rights are acquired by registration: the first to file obtains the right, regardless of use. The INPI procedure unfolds in four stages: filing of the application (the sign and the specification of goods and services), examination by the office of formal requirements and absolute grounds (distinctiveness, lawfulness), publication in the

Official Bulletin opening a two-month opposition window for holders of earlier rights, then registration, within a few months if nothing stands in the way. The office, remember, will not have checked availability: everything rests on the prior-rights search carried out beforehand.

The European Union trademark, filed with the EUIPO, protects all twenty-seven Member States under a single title through a comparable procedure (three-month opposition window). Internationally, the Madrid System administered by WIPO lets you designate nearly 130 countries in a single application based on a French or EU mark, with centralised management of renewals. We represent you before each of these offices and, beyond them, through our network of foreign associates.

## **The international trademark: the Madrid System in practice**

Based on a French or EU basic mark, the international registration administered by WIPO lets you designate nearly 130 countries in a single application, in one language and for one set of fees, then add subsequent designations at any time: your coverage follows your markets without multiplying filings. Management is centralised: one ten-year renewal and one recordal for any change of owner or representative, across every designated country.

The tool has rules of its own, all of them manageable. Each designated office examines the application under its national law and may issue a provisional refusal, to be handled locally, we coordinate our network of associates for this, and some countries impose specific obligations, such as the periodic declarations of use required in the United States. Above all, the international registration depends on the basic mark for five years: if the basic mark falls, the so-called central attack, the registration falls with it, unless converted within three months into national applications that keep the original date. That link guides the choice of basis: a solid, already-examined French mark is often a safer foundation than an EU mark exposed to oppositions from twenty-seven countries. Finally, a few markets remain outside the system and call for direct national filings: we weigh, country by country, the Madrid route against the national route in light of your commercial priorities, timetable and budget.

## **What filing strategy for your trademark?**

File early, first, before any public communication, trade show or visible domain-name registration, because in trademark law, priority belongs to the first to file. File accurately, next: we help you decide between filing the word element (the broadest protection), the logo, or both; and calibrate the specification to cover your current activities and foreseeable developments, without inflating fees or exposing yourself to revocation for non-use, incurred after five years.

File where your market is, finally: the priority right under the Paris Convention gives you six months from the first filing to extend your protection abroad while keeping your original date. We build the optimal sequence with you, French mark, EU mark, international registration or direct national filings, in light of your sales, production and three-to-five-year expansion territories, and your budget. A watch service is set up from registration onwards to detect and block third-party filings in time.

## **After registration: use, watch, monetise**

Registration is only the beginning: a trademark lives through use. Without genuine use for an uninterrupted period of five years (three years in some countries), it becomes vulnerable to revocation for non-use, any third party may then have it struck out for the goods and services concerned, and revocation has become an almost systematic counter-move in disputes. Hence a twofold discipline: use the mark as registered (or in a form that does not alter its distinctive character), and build up proof of that use as you go, dated invoices, catalogues, price lists, campaigns, website captures, sales volumes by territory. A use file kept up to date takes a few hours to assemble; reconstructed in the urgency of proceedings, it can prove impossible to find.

Nor is protection automatic against third parties: offices do not alert owners when a similar application is filed. Only organised watching, of the French, European and international registers, but also of domain names and marketplaces, detects troublesome filings and uses in time. Detecting early means acting at the best cost: opposition, within two months in France (three before the EUIPO), remains the fastest and most economical way to block an application; once

that window closes, there remain invalidity actions and, against uses, infringement proceedings, formal notice, infringement seizure, action on the merits. Tolerance, moreover, has a price: knowingly allowing a later sign to prosper for five years forfeits your right to act against it.

Finally, a trademark is an asset that creates value through contracts. A licence, exclusive or not, full or limited to certain goods or territories, generates royalties or structures a network (distribution, franchising, co-branding) without giving up the title; an assignment transfers ownership outright. These contracts deserve careful drafting: scope, product quality, control of use (a licensee's use counts to defeat revocation), and recordal in the trademark register to make the transaction enforceable against third parties. Well managed, a trademark stops being a cost centre and becomes a source of revenue, and a pillar of your company's valuation.

## Our services

- ✓ Sign, specification and territory strategy
- ✓ Availability searches and risk analyses
- ✓ Filings with the INPI, EUIPO, WIPO and foreign offices
- ✓ International marks: subsequent designations and provisional refusals
- ✓ Prosecution, responses to objections and oppositions
- ✓ Renewals and recordals
- ✓ Register and market watch
- ✓ Pre-litigation and litigation
- ✓ Contracts (assignment, licensing, coexistence)
- ✓ Protection online and on social media

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