

## FAQ - Opposition proceeding

### a) "Substantive" issues

#### What is the opposition procedure?

Since its creation by the French law of January 4, 1991, the opposition procedure makes it possible to prevent an application for registration of a new trademark, if the owner of prior rights considers that the latter infringes his rights. For example, the trademark application is identical or similar to the owner's prior rights and creates a risk of confusion in the public's mind. Fast and cheap, the French opposition procedure is an attractive strategy in the defence of French trademarks, European Union trademarks or international trademarks designating France but also company names and domain names.

In this sense, the opposition procedure has significant advantages over litigation before the judicial authority. This procedure offers the owner of prior rights the possibility of blocking an application for registration of a trademark likely to infringe his rights, even before the trademark is registered or put on the market. If the opposition procedure before the INPI is considered to be justified, the trademark application is refused for registration. However, it is recommended that one first contact the applicant to try to find an amicable solution.

This procedure is conducted directly with the French Trademark Office, the INPI, without the need to go to court and initiate legal proceedings. If the opposition is well-founded, the new trademark application will be rejected in whole or in part for all or part of the goods and/or services. The opposition procedure is adversarial, which means that any document sent to the INPI by one of the two parties must be communicated to the other.

#### How does the opposition procedure work?

This procedure is divided into two steps:

1. First of all, there is a written phase during which the parties exchange their arguments. This phase ends as soon as one of the parties stops responding. Indeed, following the Ordinance 2019-1169 of November 13, 2019, the number of possible exchanges between the parties has increased in order to reinforce the adversarial nature of the procedure.
2. At the end of this phase, the INPI delivers a decision within three months.

Parties may also request to make oral submissions.

The duration will therefore vary depending on the number of responses from the parties.

Finally following the Ordinance 2019-1169 of November 13, 2019, the procedure is no longer locked in a 6-month period. Instead, it is subject to the SVR principle "silence is equivalent to rejection", within a period of 3 months. In other words, if within a period of 3 months following the end of the exchange between the parties, the INPI has not ruled, the opposition is rejected.

### **How long does the opposition procedure last?**

In practice, depending on the number of exchanges between the parties during the instruction phase, the duration of this procedure varies between 6 and 12 months.

### **How to know if a trademark application similar to the opponent's trademark has been filed?**

When an application for registration of a trademark is filed, the INPI does not examine the relative grounds for refusal ex officio. These grounds constitute infringements of one or more prior rights. Therefore, in order to monitor your registered trademark, it is advisable to take out a monitoring subscription with Dreyfus Law Firm who can monitor the trademark at the French, European or worldwide level and advise you on the most appropriate actions. The monitoring subscriptions can concern trademarks, company names, domain names and also Web 3.0.

### **How to know if an opposition to a trademark registration has been filed?**

Opposition notices filed within two months of the publication of the trademark application are processed by INPI. The latter, after checking that payment has been made within the time limit, reviews the basic requirements that the notice of opposition must meet. If the INPI finds irregularities that can be corrected, it urges the opponent to remedy them. The notice of opposition is then notified to the trademark applicant.

As a preventive measure, it is strongly recommended to conduct a trademark clearance search before filing, in order to limit the risk of opposition to a trademark application.

### **Against which trademark can the opponent file an opposition?**

Before the INPI, the opposition can be filed either against a French trademark application or an international trademark designating France. In the latter case, the procedure will make it possible to prevent its protection for France.

As far as the application for a European trademark is concerned, the opposition must be filed before the European Trademark Office EUIPO.

### **What prior rights can the opponent invoke?**

Following the Ordinance 2019-1169 of November 13, 2019, the opponent benefits from a wider range of prior rights that he can invoke to file an opposition. Indeed, the prior rights are listed by Article L. 712-4 of the Intellectual Property Code, which are as follows:

- A French trademark (subject to subsequent registration) or registered;
- An international trademark with effect in France or the European Union;
- A European Union trademark filed (subject to subsequent registration) or registered;
- A well-known brand (not registered but very well known);

- A trademark with a reputation in France or, in the case of a European Union trademark, with a reputation in the European Union, under certain conditions;
- A name or company name if there is a risk of confusion in the public mind;
- A trade name, a sign or a domain name, whose scope is not only local if there is a risk of confusion in the public mind;
- An appellation of origin, a geographical indication protecting industrial and artisanal products as well as an appellation of origin or geographical indication protected under European Union law;
- The name of a territorial authority or a public establishment of inter-municipal cooperation;
- The name of a public entity if there is a risk of confusion in the public mind.

### **Can the applicant file an opposition on the basis of several rights?**

Following the Ordinance 2019-1169 of November 13, 2019, it is possible to file the same opposition based on several prior rights, which significantly reduces costs. Indeed, before the reform, the opponent had to file as many oppositions as there were prior rights invoked.

### **Can the opponent base his opposition on several different trademarks that one owns?**

Yes, the opponent can base his opposition on several different trademarks, provided he is the owner.

### **Can an opponent file an opposition on marks that are owned by his company or a subsidiary?**

It is not possible for an opponent to base his notice of opposition on marks that are owned by a company, as he will not be the owner of the marks. However, several persons can be listed as opponents in a notice of opposition, but only if they are joint owners of the marks subject of the opposition.

### **What does it mean that the applicant can request "proof of use" from the opponent?**

According to Article L. 714-5 of the French Intellectual Property Code, the owner of a registered trademark must make serious use of it for an uninterrupted period of five years. Therefore, when the opposition is based on a mark that has been registered for more than five years, the applicant may ask the opponent to provide evidence that the mark is being used effectively and in good faith.

Thus, proof of use for goods and/or services for which the opponent has not been able to provide proof of use, they will be excluded from the opposition. In the event that proof of use has not been provided for any of the goods and/or services for which the earlier mark(s) is/are registered, the opposition will be rejected.

### **What evidence will the opponent need to present to establish use?**

The opponent must provide evidence of serious and effective use of the mark. These elements include: the duration, the territorial scope of the exploitation of the mark, the intensity and the nature of the use that has been made of the mark for the goods and/or services for which it is registered and on which the opposition is based.

In practice, this evidence can be: packaging, catalogs, invoices, photographs, advertisements, labels, etc.

## **What is the "cooling off" period of the opposition procedure?**

Originally, this period concerns opposition before the EUIPO. The "cooling off" period is a period of reflection which takes place during the two months following the notification of the opposition and precedes the beginning of the adversarial phase and can be extended for a maximum of 22 months. This period allows the parties to negotiate an amicable agreement. In addition, provided that the adversarial phase has not begun, if the parties reach an agreement ending the opposition neither of them will be ordered to bear any costs.

What about litigations before the INPI? According to article 43 of the Directive 2015/2436, the Member States must provide the possibility for the parties to have a period of at least two months to allow for an amicable settlement. Therefore, the Intellectual Property Code provides in its article R. 712-17, 4° that the parties may suspend the time limit for a period of four months, renewable twice.

During this period of time the parties will be able to negotiate an amicable agreement and thus close the opposition procedure, if they have reached such an agreement.

### **b) Questions of "form"**

#### **Who can file an opposition?**

The opposition may be filed by the trademark owner himself (or the owner benefiting from prior rights following the Ordinance 2019-1169 of November 13, 2019), or by a proxy, i.e. a person charged with representing him. This agent may be:

- An industrial property attorney ;
- An attorney ;
- A contractually related company having its domicile, registered office or place of business in a Member State of the European Union or in a Member State of the European Economic Area.

However, it is strongly recommended to use a proxy because of the strict eligibility requirements.

#### **Is there a representation requirement for filing an opposition?**

In principle, there is no obligation of representation to file an opposition. However, the appointment of a representative is mandatory in two situations: when the opposition is filed on the basis of a trademark belonging to several owners (i) or when the opponent is neither established nor domiciled in a Member State of the European Union or the European Economic Area (ii).

#### **How does the opposition procedure work?**

Since 2016, the opposition procedure is dematerialized and is done entirely and solely electronically through the INPI portal.

#### **What is the cost of the opposition act?**

The cost is €400 for an opposition based on a single right. Following Ordinance 2019-1169 of November 13, 2019, if more than one right is invoked, €150 will be added per additional prior right.

### **What is the deadline for filing an opposition?**

Under Article L. 712-4 of the Intellectual Property Code, it is possible to file an opposition for a period of two months from the publication of the registration in the Official Industrial Property Bulletin (BOPI) or in the WIPO Gazette of International Marks if the challenged trademark application is an international trademark application designating France. According to Article L. 712-15 of the Intellectual Property Code, any opposition filed after the deadline will be declared inadmissible.

The opposition date is the date of the electronic payment.

### **How is the opposition notified to the applicant?**

If the opposition concerns a French trademark application, then notification of the opposition is sent to the holder of the application by registered mail with acknowledgement of receipt.

If the opposition concerns an international trademark application designating France, the notification of opposition is sent in one copy by registered letter with acknowledgement of receipt to the World Intellectual Property Organization.

### **Can the deadline for filing an opposition be extended?**

No, it is not possible to ask for a deadline extension, even if the opponent argues a legitimate excuse. Indeed, this procedure is carried out within a short period of time.

### **Are there any conditions for suspending the deadline during the opposition procedure?**

Yes, there are certain conditions that can suspend the time limits during the opposition procedure, which are as follows:

- At the request of the parties to negotiate a coexistence agreement. This request will suspend the deadline for 4 months and is renewable twice;
- Pending registration of a prior right;
- If one of the earlier marks on which the opposition is based is the subject of an application for invalidity, revocation or claim of ownership;
- In case of an action against the company name, domain name, trade name or sign.

### **Are there any events that can cause the opposition period to run again?**

Yes, but in a very specific case: the trademark application is re-published due to an error. If this error is such as to affect the scope of the application, a new opposition period will run.

### **In which language must the notice of opposition be filed?**

In accordance with the law n°94-665 of August 4, 1994 relating to the use of the French language, known as the "Toubon Law", the opposition document must be presented in French. Similarly, if the evidence is in a foreign language, it must be accompanied by a French translation.

### **What information must the opponent bring to the online process?**

According to article R. 712-14 of the Intellectual Property Code, in order to file an opposition, the opponent must mention:

1. The identity of the opponent;
2. Indications suitable for establishing the existence, nature, origin and scope of the prior rights invoked;
3. The references of the application against which the opposition is filed;
4. Indication of the goods or services to which the opposition relates;
5. Identification of the agent, if any;
6. Name and capacity of signatory;
7. Proof of payment of the opposition fee.

### **What documents must be included with the opposition?**

According to article R. 712-4 of the Intellectual Property Code, several documents must be attached to the opposition, as follows:

- Documents that identify the opponent;
- Documents to establish the existence, nature, origin and scope of the prior rights invoked;
- A copy of the contested mark, and the indication the goods or services to which the opposition relates;
- Statement of the grounds on which the opposition is based;
- Proof of payment of the prescribed fee;
- Power of attorney, if required.

### **Can the opponent be given more time to provide the required documents?**

Yes, the opponent can benefit from an additional period of one month according to article R. 712-14 of the Intellectual Property Code.

Nevertheless, the opponent may not during this period:

- Expanding the scope of the opposition;
- Invoke other prior rights or other products or services.

In other words, during the two-month period, the opponent files a so-called "formal" opposition, in which he must provide the mandatory information (see above). Then, during a further period of one month, he will have to provide the required documents or complete them, subject to the conditions mentioned above.

Moreover, this time limit cannot be suspended.

### **Can the opponent make changes once the opposition is filed?**

Once an opposition has been filed, it can be corrected or completed by the opponent, but only with regard to the mandatory information, provided that the two-month period for filing an opposition has not yet expired.

### **Is there any formality to the documents provided?**

Article R. 712-16 of the Intellectual Property Code provides that the documents provided by the parties must be presented according to a strict formalism, on pain of inadmissibility.

Indeed:

- The documents provided must be numbered;
- Documents are accompanied by a slip indicating precisely to which pattern each piece relates (piece number, piece description) ;
- In the context of proof of use of a trademark, the parties must indicate in their submissions which goods and services are covered by each proof of use.

### **Can the opponent limit his or her opposition during the proceedings?**

If the opponent cannot invoke additional prior rights in the course of the proceedings, he may however limit his opposition by express request, according to Article R. 712-16-1 of the Intellectual Property Code.

The opponent will be able to limit the latter by waiving:

- To invoke one or more prior rights.
- To invoke one or more product(s) and/or service(s) as the basis for the opposition
- To target one or more of the goods and/or services in the application for registration of the contested mark.

### **What are the causes that close an opposition procedure?**

Article R. 712-18 of the Intellectual Property Code lists 4 cases that close an opposition procedure:

- The opponent has withdrawn the opposition or lost standing;
- The opponent has become moot;
- The effects of all prior rights have ceased (failure to maintain in force, cancellation of prior trademarks, etc.);
- No answer is given after a suspension of the opposition procedure in the cases provided for in 2° and 3° of Article R. 712-17 of the Intellectual Property Code (legal or administrative action taken against the prior right or rights).

### **Is there any way to appeal against the decision of the Director of the National Institute of Industrial Property?**

Yes, it is possible to appeal to the Paris Court of Appeal.