

PRACTICAL ASPECTS OF THE OPPOSITION PROCEDURE IN FRANCE

The procedural aspects of oppositions vary depending on the countries, and what is allowed in a country is not possible in another. This article aims to be a practical guide on the opposition procedure in France, based on the most frequently asked questions from foreign associates and clients.

Opposition deadline:

2 months as from the date of publication. This deadline cannot be extended.

Who can oppose:

The trademark owner or an exclusive licensee (unless otherwise stipulated in the licence agreement).

Possible basis for an opposition:

- an earlier registered or applied for identical or similar trademark for identical or similar goods and/or services
- an earlier non registered or applied for trademark for identical or similar good if it is famous in the sense of article 6bis of the Paris Convention

An opposition cannot be based on a famous trademark for non identical or similar goods, on a company name, a trade name, a copyright, a design, a prior use ... The fame of the earlier mark may nevertheless sometimes influence the examiner and incite him to have a wider appraisal of the similarity of goods and services but will not be taken into account if the products/services are clearly distinct.

For all the kind of right for which an opposition is not open, the way to enforce them is an invalidation before the Courts.

The opposition form :

It is not possible to file a single opposition based on different rights. In this case, several oppositions have to be filed which entails the payment of several official fees.

It has to be completely filled in, with all the arguments developed; formal oppositions are not possible in France. If the opposition is based on a non registered famous mark, all the evidence of this fame has to be filed at the same time as the opposition.

If the trademark on which the opposition is based has been subject to an assignment, it is always better to indicate to the agent in charge of the opposition the number of the recordal of this assignment as this information must be mentioned on the opposition form.

Registered trademark attorneys do not need a power form.

The procedure:

The opposition is notified to the applicant who is given two months to answer.

If he does not answer, the Trademark Office will directly issue a decision.

If he answers, the opponent does not have the possibility at that stage to file new arguments. The Trademark Office issues a draft decision and both parties have one month to contest it

and/or ask for a hearing. If no new arguments are filed, the draft decision becomes automatically definitive. If new arguments are filed, the Trademark Office issues a decision.

In his first answer to the opposition, the applicant can, if the earlier mark has been registered for more than five years, ask for proof of use thereof. This evidence has to show use of the mark in France (except if the earlier mark is a CTM, in which case use in one or more countries of the EU is accepted provided the documents are translated), be dated and concern at least one of the goods or services on which the opposition is based.

The applicant has only one month to provide this evidence. If he fails to do so, the procedure is closed and the contested mark matures into registration.

If the parties are discussing an agreement, they can jointly ask for the suspension of the procedure. The suspension is automatically granted for three months and can be further extended for a maximum of three additional months.

In any case (except if the opposition is suspended), a decision must be rendered maximum eight months after the date of publication of the application.

After the decision:

The failing party can file an appeal against the decision before the Court of Appeal (for foreigners, the Paris Court of Appeal). He has one month to do so if he is located in France, three months if he is in another country.

This procedure is between the failing party and the Trademark Office, the other party is informed, does not need to be represented but can if he wishes.