

Q&A – Opposition Proceedings

What is the opposition proceeding before the EUIPO?

The opposition procedure makes it possible to prevent the registration of an application for a new European trademark, if the holder of the earlier rights considers that it infringes his rights.

Precisely, the opposition procedure before the EUIPO takes place when a third party requests the Office to reject a European Union trademark application (TIN application) or an international registration designating the European Union on the basis of the earlier rights it holds.

In addition, the trademark application must be identical or similar to the proprietor's earlier rights, which creates a likelihood of confusion in the minds of the public. The opposition procedure before the EUIPO is an interesting strategy for defending trademark rights as it is quick and inexpensive. Due to the technical nature of the procedure, the service of a trademark specialist or an Intellectual Property P lawyer is strongly recommended.

In this sense, this procedure offers the holder of prior rights the possibility of blocking an application for registration of a trademark which may infringe his rights, even before the mark is registered or put on the market. If the opposition procedure before the EUIPO is considered justified, the trademark application is refused registration. However, it is advisable to first contact the applicant in order to try to find an amicable solution. It is also advisable to consult a specialist in trademark law or a lawyer specialising in intellectual property law.

This procedure is undergone directly via EUIPO's online platform. If the opposition is well-founded, the new trademark application will be rejected in whole or in part for all or some of the goods and/or services. The opposition procedure is adversarial, i.e. any documents sent to the EUIPO by one party must be communicated to the other.

What is the difference between a formal opposition and a substantive opposition?

A formal opposition is an opposition in which the application will only present elements that identify the parties all other documents related to the trademarks. The applicant must file a formal opposition within three months from the publication of the application trademark. On the contrary, a substantive opposition is an opposition in which the applicant will put his/her arguments and explanation on why he/she wants to oppose to the trademark.

Against which trademark can the opponent file an opposition?

Before the EUIPO, opposition can be filed either against an European Union trademark application or an international trademark designating the EU. In the latter case, the procedure will prevent its protection in the EU.

Can the opponent rely on absolute and/or relative grounds for the opposition?

An opposition must be based on at least one prior right held by the opponent.

According to Article 8 of the EUMR, the following prior rights can be invoked:

- Registered European Union trademarks and applications for such marks;
- Trademarks which, at the date of the application for registration of the European Union trademark or, where applicable, of the priority claimed in respect of the application for

registration of the European Union trademark, are well known in a Member State, within the meaning of the words "well known" in Article 6a of the Paris Convention;

- Trademarks registered in a Member State or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;
- Trademarks registered under international agreements having effect in a Member State;
- Trademarks registered under international agreements which have effect in the Union;
- An application for a designation of origin or geographical indication filed, in accordance with the European Union or national law, before the date of the application for registration of the European Union trademark or the date of the priority claimed for the application, subject to its subsequent registration, and which confers the right to prohibit the use of a subsequent trademark

Furthermore, it is also possible for the opponent to rely on an unregistered trademark or other sign used in the course of trade which does not have a mere local significance. Indeed, the trademark applied for is not registered if and to the extent that, according to the Union, the legislation of law of the Member State governing that sign:

- the rights in that sign were acquired before the date of the application for registration of the European Union trademark or the date of the priority claimed for the application for registration of the European Union trademark;
- this sign confers on its owner the right to prohibit the use of a subsequent mark.

Source :

<https://eurlex.europa.eu/legalcontent/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN#d1e753-1-1>

In which language should the opposition procedure be conducted?

The European Union recognises 5 official languages in which opposition proceedings can be filed: English, French, German, Italian and Spanish. The notice of opposition can only be filed in one of these languages, which must coincide with one of the two languages chosen by the applicant for the European Union trademark as indicated at the time of publication of the application in the European Union Trademarks Bulletin.

Is there a representation requirement for lodging an objection?

In principle, opponents are not obliged to be represented in order to lodge an opposition. However, if none of the opponents have their domicile, principal place of business or real and effective industrial or commercial establishment in the European Economic Area, they must be represented by a professional representative in all proceedings before the EUIPO.

Of course, an opponent may choose to have a representative even if he has his domicile, principal place of business or real and effective industrial or commercial establishment in the European Economic Area.

Dreyfus & Associés can represent you during the opposition procedure and advise you throughout the procedure. The assistance of a specialist in trademark law or a lawyer specialised in intellectual property law is essential, given the technical nature of the matter.

How do I know if a European Union trademark application similar to the opponent's mark has been filed?

When a trademark application is filed, the EUIPO does not examine ex officio the types of grounds for refusal. In order to monitor your registered trademark, you should take out a watch subscription with Dreyfus, which can monitor the trademark at French, European or global level and advise you on the most appropriate actions. The monitoring subscriptions can cover trademarks, company names, domain names and also Web 3.0.

What does it mean that the applicant can request a “proof of use” from the opponent?

The registered trademark must be in genuine and effective use for an uninterrupted period of five years from the date of registration in all European Union Member States. Therefore, where the opposition is based on a trademark that has been registered for more than five years, the applicant may request the opponent to provide evidence that the trademark is being put to genuine and effective use.

Therefore, goods and/or services for which the opponent has not been able to provide proof of use will be excluded from the opposition. If 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 is the 'cooling off' period of the opposition procedure?

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 start of the adversarial phase. This period can be extended for a maximum of 22 months, i.e. a total of 24 months. This period allows the parties to negotiate an amicable settlement. Furthermore, provided that the adversarial phase has not started, if the parties reach an agreement ending the opposition, then neither party will be ordered to bear any costs.

This period will give the parties time to negotiate an amicable agreement and thus close the opposition procedure, if such an agreement is reached.

When is the deadline to file an opposition?

It is possible to file an opposition within a period of three months from the publication of the European Union trademark application.

Particularly, the official date of publication is the date on which the application is published in Part A1 of the European Union Trademarks Bulletin.

What are the non-extendable time limits in the opposition proceedings before the EUIPO?

The non-extendable time limits are as follows:

- the three-month opposition period for lodging an opposition;
- the three-month period paying the opposition fee;
- the one-month period for paying the surcharge where the payment is made after the deadline and there is no evidence that the payment instruction was given at the latest 10 days before the expiry of the payment deadline;

- the two-month period to remedy irregularities

Is it possible to limit or withdraw an attacked application?

If the applicant wishes to withdraw or limit a contested application, it is imperative to do so in a separate document and more precisely in a separate submission or in a separate annex within a submission.

For this purpose, specific options in the "User Area" on the Office website have been set up. Therefore, if the withdrawal of the application is filed by selecting the corresponding e-action option, then the automatic submission will be considered as equivalent to an application filed by means of a separate document. No declaration will then be required.

Can I appeal against a decision of the Office?

Yes, it is possible to appeal against a decision of the EUIPO.

A party may submit an appeal within 2 months from the date of notification of the contested decision. A statement of the grounds of appeal must be submitted within 4 months of the date of notification.