FRANCE

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This material is only intended to provide an introduction to and simplified profile of an area of this jurisdiction's trademark law and practice and has primarily been prepared for practitioners considering the merits of filing an opposition in this jurisdiction. This material does not take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of this jurisdiction such as might be provided by a local trademark attorney.

For more information about particular areas of practice, please see INTA's companion online publications: Trademark Cancellations.

I. AVAILABILITY

A. Pre- or Post-Grant

• Opposition is available.
• Opposition is conducted pre-grant.
• Opposition is available for either all or part of the goods/services covered by a trademark application or registration.

B. International Registrations

• This jurisdiction is a member of both the Madrid Agreement and the Madrid Protocol.
• International Registration extensions to this jurisdiction can be opposed on the same opposition grounds as national applications.
• International Registration extensions to this jurisdiction may be used as a basis for an opposition on relative grounds.

C. Collective and Certification Marks

• Collective marks are registrable.
• Opposition to an application or registration for a collective mark is available.
• Certification marks are registrable.
• Opposition to an application or registration for a certification mark is available.

II. EFFECT ON REGISTRATION RIGHTS
• An opposition (even if unsuccessful or later withdrawn) will delay the grant of full registration rights to the applicant.

III. GROUNDS

A. Absolute, Relative and Other Grounds

• The following grounds are admissible for opposition:
  • relative grounds (based on proprietary rights, e.g., conflicting prior application/registration or rights in unregistered marks) (Community and French trade marks, registered either prior to the application for registration, or under priority of a previous trade mark. However, an opposition is not open on the ground of an unregistered trademark unless the trademark is well-known within the meaning of Art. 6 bis of the Paris Convention, see below.);
  • rights under Art. 6 bis of the Paris Convention or the equivalent thereto (notorious or well-known mark) (extensive evidence of the existence, fame and extent of use of the trademark must be provided).

B. First to Use or First to File

• In an opposition involving conflicting trademark registrations or applications, a later filing date prevails over an earlier use date (i.e., this is a first-to-file jurisdiction).

IV. FORUM

• The opposition authority is part of the Trade Marks Registry/Office.

V. COSTS AND FEES

A. To Initiate

• The government/official fees for filing an opposition based on a single prior registration are: Official fees are € 310 per opposition (one opposition must be made for each prior right invoked).
• The approximate range of attorney fees for filing an opposition based on a single prior registration is: € 800-1200.
• A listing of Government/official fees for oppositions can be found online at: http://www.inpi.fr/fr/marques/la-vie-de-votre-marque/s-opposer-a-l-enregistrement-d-une-marque.html.
• The website listing of Government/official fees for oppositions is presented in the following languages: French.

B. Monetary Bonds or Surety from Foreign Opponent

• There are no provisions requiring monetary bonds or other surety from a foreign opponent.

VI. BURDEN OF PROOF

• The burden of proof is neutral; i.e., both parties must prove any grounds, facts, allegations and defenses on which they rely in the opposition.
VII. SUBSTANTIVE EXAMINATION

- The trademark registration process includes an official, substantive examination.
- This system includes an official substantive examination of an application on:
  - absolute grounds but not relative grounds.
- The official, substantive examination of an application is conducted after publication for opposition. Examination by the Trademark Office and the opposition proceedings are both conducted after the date of publication of the trademark application.
- National applications and applications for International Registrations are examined at different times in the application process, i.e.: National applications are examined before applications for International Registrations.
- Any official substantive examination report is not open to public inspection before the end of the official opposition term. No official substantive examination report is open to public inspection; however, during a period of two months following publication of the application for registration, any concerned person may submit observations to the French Trademark Office.
- Opposition is not considered as part of the official substantive examination and is decided in a separate proceeding. This frequently creates problems. The opponent is notified of any changes made to the application as a result of the substantive examination and may then amend the opposition as a result.
- An official substantive examination will not be conducted after an opposition proceeding has been concluded or after an opposition proceeding has been withdrawn. The date of publication of the trademark application is the starting date for both examination by the Trademark Office (within a maximum of five months) and the filing of an opposition (within two months). In practice, the Trademark Office quickly examines the application, so that once opposition proceedings are over, no official substantive examination of an application may still be conducted.

VIII. STANDING AND OTHER OPPONENT ISSUES

A. Valid Opponent/"Person" and/or "Interested Person" Defined

- Standing to oppose extends to:
  - any interested person. Legal interest is required. For the definition of "interested person" see below.
- For purposes of standing, "person" is defined as:
  - both natural and juridical persons.
- For purposes of standing, an "interested person" is defined as:
  - someone who files an earlier pending application to register a conflicting trademark.
  - someone who owns an earlier conflicting trademark registration.
  - someone who is a licensee of any conflicting trademark or other intellectual property right (an exclusive licensee).

B. On Basis of Grounds

- Where opposition is based on relative grounds (i.e. a prior registered or unregistered right) then:
  - only the owner of a prior right can use that right as a ground of opposition.
• Relevant prior rights must be locally established rights (e.g., local national registration rights, applicable regional rights or relevant International Registration extensions or local rights in unregistered marks). Except for rights under Art. 6 bis of the Paris Convention, if well-known to the public in France (which implies that such trademarks ought to be used in France to constitute sufficient grounds for opposition).

C. Assignees and Licensees

• An unregistered assignee of a relevant prior right may not be a valid opponent.
• A registered licensee of a relevant prior right may be a valid opponent only if the licensee is exclusive and if the license does not contain provisions to the contrary.
• An unregistered licensee of a relevant prior right may not be a valid opponent.

D. Concealing Identity of Opponent

• An opposition filed in the name of the legal representative for purposes of concealing the identity of the principal is not considered validly filed even if all other criteria are met by the opponent.

E. Joint Opponents

• Two or more opponents may jointly file a single opposition only if registered as joint owners.
• A parent company and its trading subsidiary may be indicated together as opponents in a single joint opposition only if registered as joint owners.
• Two otherwise unrelated companies may not file a single joint opposition.

F. Foreign Opponent

• Oppositions can be filed from abroad directly by the opponent or its foreign agent/attorney, but only within the European Union or European Economic Area and if the trademark is owned by one person.
• A foreign opponent (or the opponent’s foreign agent/attorney) can file an opposition directly with the opposition authority:
  • by mail;
  • by fax.

G. Opponent’s Prior Rights and Use

• If an opponent relies on a prior registration, the applicant or opposition authority:
  • can only require proof of use of an earlier registered mark when the following amount of time has passed since its application or registration date: five years from the grant of the cited registration.
• If the opponent does not produce satisfactory proof of use of its prior mark for relevant goods/services, the result would be that:
  • the opposition would be defeated only in respect of the goods/services relied upon, for which satisfactory proof was not provided.
• Additionally, if the opponent does not produce satisfactory proof of use of its prior mark:
• the registration of the prior mark is not affected by the opposition proceeding, but a separate non-use cancellation action can be brought. This type of action is called: a revocation action for non-use which may be brought before a First Instance Court by any person who has a legal interest in doing so.

IX. TERM AND EXTENSION

A. Opposition Term: National Applications/Registrations
• The system provides a fixed initial term within which an opposition may be filed.
• With respect to national applications/registrations, the initial opposition term begins:
  • on the date that the details of the application are published for opposition in the local official IP bulletin, journal or gazette. This publication is called: Bulletin Officiel de la Propriété Industrielle.
• With respect to national registrations in this jurisdiction, the initial opposition term expires the following number of days or months following the date mentioned above: two months from the exact date of the publication in the IP Gazette. For example, if publication is on September 30, 2012, the opposition terms expires on November 30, 2012.

B. Opposition Term: International Registrations
• With respect to International Registrations extended to this jurisdiction, the opposition term begins:
  • on the date that the details of the International Registration are published in the WIPO Gazette.
• With respect to International Registrations extending to this jurisdiction, the initial opposition term expires on the following date: Two months after publication of the international registration by WIPO in the Gazette.
• Once opposition to an International Registration extending to this jurisdiction has been filed, there is no difference between the IR opposition process and that for a national application.

C. Deadline Not on Normal Business Day
• An opposition deadline that does not fall on a normal business day or that falls on a local public holiday or other officially excluded days may be met by action on the next business day.
• Normal business days of the week are:
  • Monday through Friday.

D. Extensions
• The initial opposition term is not extendable.

X. FILING REQUIREMENTS

A. Minimum Filing Requirements
• The minimum filing requirements to initiate an opposition (i.e., to obtain a filing date) are: two copies of the opposition form; arguments as to comparison of goods and
services; arguments as to comparision of signs; summary of arguments; copy of publication; copy of the earlier mark (extract from INPI, OHIM, WIPO website) and proof of payment of fees.

• The following additional actions or documentation are required to complete the required filing formalities (i.e., to shift the burden of action to the registration applicant) and will be accepted after the opposition term has expired: none. After the opposition term has expired, no further documentation is accepted.

B. Payment of Official Fees

• Opposition fees can be paid using the following payment modes:
  • credit card (only if you go to the INPI Office to file your opposition);
  • money transfer;
  • debit of deposit account/current account;
  • cash (only if you go to the INPI Office to file your opposition).

C. Public Inspection of Documents

• Documentation submitted in an opposition is not open to public inspection.

D. Additional Grounds

• Additional grounds of opposition may not be introduced into an opposition after the opposition period has expired. However, a new opposition may be filed within the opposition period, based on another prior right, or on other products and services (covered by the prior right on which the first opposition was based, but not mentioned in the first opposition).

E. Representation

• The opponent is not required to act through a locally authorized representative, except outside the European Union or if the earlier trademark belongs to several proprietors, then a European based representative is mandatory.

F. Language and Translations

• Opposition documents must be submitted in the following local official language(s): French. A French translation of any document written in a foreign language which is submitted to the National Institute of Industrial Property (French Trademark Office) must be provided.
  • Opposition documents may not be submitted in a language (or languages) other than the one(s) listed above.

XI. POST-FILING STAGES AND PROCEDURES

A. Sequence and General Considerations

• Depending on the jurisdiction, opposition proceedings generally involve a number of stages between the filing of the opposition and the official decision or judgment. Typically, the post-filing stages will require either that alternating actions be taken by
one party after the other in consecutive steps or that actions be taken concurrently by both parties.

• This jurisdiction does not conform to the general description provided above, in that: The applicant for registration is awarded a period of time of no less than two months to submit counter observations, failing which the opposition is ruled. If the applicant provides observations, a draft decision is drafted, which may be challenged by both parties concurrently or become final if unchallenged. If the draft decision is challenged, a final ruling shall be made.

• A full discussion of the opposition stages is beyond the scope of this publication. Please consult a local attorney for specifics about the sequence of stages and the duration of and requirements for each. The following is a non-exhaustive list of issues to consider when consulting your local counsel:
  • 1) The general sequences of stages from filing the opposition until the official judgment or decision.
  • 2) If and when the parties (or their representatives) are required to appear in person before the opposition authority, or whether written statements may be submitted.
  • 3) When each party must submit documentation/evidence.
  • 4) What documentation/evidence is required.
  • 5) The approximate duration of particular phases as well as the approximate length of the entire proceeding.
  • 6) Whether either party can request extensions.
  • 7) If extensions can be requested, when, for what reasons and for what length of time.
  • 8) The consequences of either party not performing its responsibilities during any stage of the opposition.
  • 9) The official fees or other official expenses that will apply to an opposition procedure.

B. Length of Opposition Procedure
• The approximate length of time from the filing of an opposition to an official decision concluding the opposition procedure is: six months.

C. Monetary Awards
• The opposition authority has no power to make formal monetary awards (costs such as official or attorney fees or other compensation) to the parties.

D. Withdrawal of Oppositions or Applications
• Withdrawal of an opposition with or without the agreement of the applicant to the terms of the withdrawal automatically terminates the proceedings.
• Withdrawal of an opposition without the agreement of the applicant to the terms of the withdrawal does not have any consequences with regard to the award of costs.
• Withdrawal of an opposed application with or without the agreement of the opponent to the terms of the withdrawal automatically terminates the proceedings.
• Withdrawal of an opposed application without the agreement of the opponent to the terms of the withdrawal does not have any consequences with regard to the award of costs.
Withdrawal of an opposition or of an opposed application outside of this jurisdiction (either with or without the agreement of the other party to the terms of the agreement) can have an effect on opposition or other proceedings in this jurisdiction.

If the opponent has withdrawn an opposition, the opposition authority cannot reject the opposed application on any of the opposition grounds. In theory, the French Trademark Office does not consider relative grounds when examining a trademark application. Moreover, examination by the Trademark Office occurs in practice before examination of the opposition, so that if the opposition is withdrawn, there is generally no obstacle left to registration.

A formal basis is not required for withdrawal of an opposition.

The limitation or restriction of the applicant's goods/services, with or without a written settlement agreement, is commonly a basis for withdrawal of the opposition.

The terms of a settlement agreement need not be disclosed to the opposition authority. However, the parties can decide to publish their agreement in the Register of Trademarks held by the National Institute of Industrial Property (French Trademark Office).

The opposition authority need not approve any settlement reached and/or formal withdrawal of the opposition.

XII. APPEALS

A. Availability/Deadline

An opposition decision may be appealed.

The following party or parties may file an appeal: the opponent or the applicant.

The deadline for filing an appeal is: one month from the date of notification of the decision, with the following exceptions: two months from the date of notification of the decision for French overseas departments and three months from the date of notification of the decision for foreign parties.

B. Forum

There is a single appeal authority, the name of which is: The Court of Appeal.

The following appeal authority/authorities is/are independent of the Trademarks Registry/Office: The Court of Appeal.

C. Cost/Monetary Bonds or Surety

The government/official fees for filing an appeal are: € 100.

The approximate range of attorney fees for filing an appeal is: € 500-1000.

The government/official fees for prosecuting an appeal to conclusion are: € 100.

The approximate range of attorney fees for prosecuting an appeal to conclusion is: € 2000-4000.

Monetary bonds or other surety are not required of foreign appellants.

D. Other Circumstances

Important circumstances of appeal that are not mentioned above include: none.
E. Higher Appeals: Availability/Monetary Bonds or Surety

• An appeal decision is not final. Higher appeals are possible and can be made to: possibly the French Supreme Court (‘Cour de Cassation’) on legal grounds; or, under relevant circumstances, to request that the Appeal Court or the Cour de Cassation refer a point of law to the European Court of Justice.
• On higher appeal, monetary bonds or other surety are not required of foreign appellants.

XIII. OTHER ISSUES

A. Subsequent Infringement Proceedings

• In subsequent equivalent infringement proceedings, an opposition decision is binding on the court.

B. Local Requirements/Perspectives

• Particular local requirements that are not covered above and that are not common in other jurisdictions or familiar to foreign practitioners include: An opposition can be based only on one earlier trademark.

C. Anticipated Revisions of the Law

• The following important changes in relevant law recently occurred: Special Court of Appeal barristers (“avoués”) disappeared from the French legal system in 2011. Any lawyer is now allowed to represent a party before the Court of Appeal.

XIV. ALTERNATIVES

A. Cancellation

• There are procedures available whereby third parties can apply to cancel or partially cancel a registration (whether or not an opposition has been filed). These procedures are not conducted before the Trademark Office, but rather before the competent civil court.
• These procedures are known (or translate into English) as:
  • invalidation;
  • action for recovery of property.
• The grounds to initiate an invalidation are:
  • the mark is descriptive;
  • the mark is misleading and/or deceptive;
  • the mark lacks distinctiveness;
  • the mark is generic;
  • the mark consists of a geographical indication;
  • the mark is functional;
  • the mark is against public policy or principles of morality;
  • the mark has not been authorized by competent authorities pursuant to Article 6ter of the Paris Convention;
• the mark includes a badge or emblem of particular public interest;
• the mark is used in a misleading and/or deceptive manner;
• the mark is prohibited in this jurisdiction;
• there is an earlier application or registered mark;
• there are earlier use-based rights in an unregistered mark;
• the mark is covered by a copyright;
• the mark is a company name;
• the mark is notorious or well known (Article 6bis of the Paris Convention);
• the trademark application was filed or the registration was granted in the name of an agent or other person with a business connection to the owner of the mark (Article 6septies of the Paris Convention);
• the mark is a trade or business name;
• the mark is a domain name.

• The grounds to initiate an action for recovery of property are:
  • the application for or registration of the mark was made in bad faith;
  • the trademark application was filed or the registration was granted in the name of an agent or other person with a business connection to the owner of the mark (Article 6septies of the Paris Convention).

• To compare the grounds for the above procedures to the grounds for opposition, please see Section III. Grounds: A. Absolute, Relative and Other Grounds

• The burden of proof is on the applicant of the cancellation proceeding to prove the grounds for cancellation (for invalidation actions). The burden of proof is on the registered proprietor to deny the grounds of the cancellation (for revocation actions).

• The burden of proof in an opposition differs from the burden of proof in a cancellation in that in an opposition:
  • the burden of proof is on both parties.

• It cannot be said that cancellation or equivalent proceedings are or are not preferable to opposition proceedings in some circumstances, as they seek different results and are not alternatives to one another.

B. Observations and Letters of Protest

• There are procedures for official consideration of third party objections to grant (e.g., observations, letters of protest, etc.), and these will be reviewed and result in official objection if well based. There is a procedure allowing any party to file observations with the Registry, giving reasons why an application should be rejected on absolute grounds. One does not, however, become a party to proceedings, and no information is provided as to the follow-up or outcome. These observations are however transmitted without delay by the Trademark Office to the trademark applicant, unless they are considered ill-founded.

• The deadline for raising such objections is: the same as that for opposition, two months from the publication date.

• Such objections must be made to the Trademarks Registry/Office.

• The legal representative must identify his client in such objections.

• The following grounds may be raised in such objections:
  • only absolute grounds but not relative grounds.
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