CHALLENGING TRADEMARKS IN EUROPE

OPPOSITION AND CANCELLATION PROCEEDINGS AT THE BENELUX OFFICE OF INTELLECTUAL PROPERTY AND THE EU IPO

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Arie Mout is a European and Benelux Trademark and Design Attorney with AWA. Located in Brussels, Belgium, he has extensive experience in trademark and design registration in Benelux, the EU and globally. He has over 20 years of experience as legal counsel with expert knowledge of intellectual property, both in-house and in private practice. He has extensive experience in the fast-moving consumer goods (FMCG) segment and advises clients from various industries on legal protection for their brands, from innovation and development to registration, opposition, litigation and enforcement, including settlement negotiations with conflicting prior rights holders. Arie also has relevant experience in managing and licensing IP in an offshore holding structure and developing IP strategies.

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Stéphanie Dujardin is a European and Benelux Trademark and Design Attorney with AWA. Located in Brussels, Belgium, he has extensive experience in trademark and design registration in Benelux, the EU and globally. Stéphanie was previously a lawyer at the Brussels Bar specialising in IP matters. Before joining Pronovem (Part of the AWA Group), she worked as a Trademark Attorney at a major IP law firm in Brussels. She is competent in all IP matters, including consultancy and litigation. Stéphanie formulates practical and custom solutions for clients related to trademarks, designs, copyrights and domain names. She also consults clients on strategies, management and valuation of IP rights. Stéphanie is a designated expert before the courts during counterfeiting proceedings. Since 2009, she has been a visiting professor on trademark and design rights at IHECS (Institut des Hautes Études des Communications Sociales), the Brussels School of Journalism and Communication.
Trademark opposition proceedings provide trademark owners a relatively quick means to challenge the trademark application of another prior the challenged application being granted. Meanwhile, a cancellation proceeding offers a trademark owner a procedural mechanism to challenge an issued trademark at the Intellectual Property Office rather than in court.

Different timelines, grounds for challenge, standards of proof, and appeals rules apply to both proceedings, and different rules apply depending upon whether an applicant elects to use the Benelux Office for Intellectual Property (BOIP), the registration office for trademarks and designs in Belgium, the Netherlands, and Luxembourg, or the European Union Intellectual Property Office (EUIPO), the office responsible for registration of European Union trademarks and the registered Community design across the 27 Member States of the EU (of which Belgium, the Netherlands, and Luxembourg are members).

Today we will discuss the guidelines for the trademark opposition and cancellation proceedings in the BOIP and EUIPO, including terms of deadlines, grounds, the contradictory procedure, use obligation, observations on proofs of use, condemnation of costs and appeal.
Main guidelines for trademark oppositions in the Benelux and in the European Union

- Deadlines
- Grounds for opposition
- Contradictory procedure
- Proof of use
- Suspension of the procedure
- Condemnation of costs
- Appeal
- Cancellation
Deadlines

- Benelux application: 2 months after publication by BOIP
- International trademark designating Benelux: 2 months after notification by WIPO to BOIP

- EU application: 3 months after publication by EUIPO
- International trademark designating EU: 3 months after notification by WIPO to EUIPO

NO EXTENSION OF TIME POSSIBLE
Grounds for opposition

- Earlier trademark application or registration
- Well-known trademark
- Protected Designation of Origin
- Protected Geographical Indication
- Unauthorised filing by agent

- Earlier trademark application or registration
- Trademark with reputation
- Earlier non-registered trademark or sign (company name, trade name, sign, domain name)
- Protected Designation of Origin
- Protected Geographical Indication
- Unauthorised filing by agent
Grounds for opposition

- Possibility to invoke several rights
- One type of right per opposition

- Fees: €1,045 and additional fee €105 for each additional right invoked beyond the third

- Arguments needs not be submitted until the contradictory procedure has started

- Details of invoked rights must be stated

- Possibility to invoke several rights
- Possibility to invoke different types of rights

- Fees: €320 (no additional fee)

- Arguments needs not be submitted until the contradictory procedures has started

- Details of invoked rights must be stated
Contradictory procedures

- Language choice (within the first month of the cooling off period)
- Cooling off period (2 months)
- 2 months for statement of grounds
- 2 months for the observations by the applicant
- No time frame for the decision of the BOIP

- English, French, German, Spanish or Italian (first and/or second language of the application)
- Cooling-off period (2 months)
- 2 months for statement of grounds
- 2 months for the observations by the applicant
- 2 months for replying to the observations
- No time frame for the decision of the EUIPO
Proof of use

- Upon demand by the applicant
- The opponent must prove genuine use within the 5 years preceding the filing date or priority date of the opposed trademark
- For the goods/services on which the opposition is based
- Deadline for opponent to submit proof of use: 2 months
- No proof of use = opposition rejected
- Deadline for applicant to comment on proof of use: 2 months

- Upon demand by the applicant
- The opponent must prove genuine use within the 5 years preceding the filing date or priority date of the opposed trademark
- For the goods/services on which the opposition is based
- Deadline for opponent to submit proof of use: 2 months (extendible)
- No proof of use = opposition rejected
- Deadline for applicant to comment on proof of use: 2 months (extendible)
Suspension of the procedure

- Upon joint request
  4 months

- Ex officio
  When the opposition is based on a trademark application
  Where an invalidity or revocation action is pending
  In the course of proceedings for refusal on absolute grounds

- Upon joint request
  6 months extendible for maximum 2 years

- Ex officio
  When the opposition is based on a trademark application
  Where an invalidity or revocation action is pending
  In the course of proceedings for refusal on absolute grounds
Condemnation of costs

- Losing party ordered to pay the costs: € 1.045
- If opposition granted in part, no costs awarded
- BOIP costs award decision = enforceable order

- Losing party ordered to pay the costs: € 300 (+ € 320 opposition fees)
- If opposition granted in part, no costs awarded
- EUIPO costs award decision = enforceable order
Appeal

- Within 2 months from the date of the decision
- The competent court is the Benelux Court of Justice (Second Chamber: Attorney-at-Law or Authorised Representative)
- First Chamber: Attorney-at-Law (required)
- Within 2 months from the date of the decision
- Board of Appeal (EUIPO)
- Attorney-at-Law or Authorised Representative
- General Court of the European Union: Attorney-at-Law (required)
- Court of Justice of the European Union: Attorney-at-Law (required)
Cancellation

- Administrative procedure before BOIP for invalidity or revocation claims

- The validity of a registered trademark can still be disputed through court

- Why administrative procedure before BOIP?
  - Simple and fast administrative procedure which allows for the cancellation of a registered trademark from the register
  - Fees € 1.420

- Administrative procedure before EUIPO for invalidity and revocation claims

- Fees € 630
Cancellation

- Similar procedure as Oppositions
- Revocation
  - No genuine use
  - Become generic
  - Misleading as a result of the use

Invalidation on Absolute grounds
  - devoid of distinctive character / generic
  - Misleading
  - Art 6ter Paris Convention / PDO-PGI
  - Bad faith
  - Etc.

Invalidation on Relative grounds
  - Same as for Oppositions

- Similar procedure as Oppositions
- Revocation
  - No genuine use
  - Become generic
  - Misleading as a result of the use

Invalidation on Absolute grounds
  - devoid of distinctive character / generic
  - Misleading
  - Art 6ter Paris Convention / PDO-PGI
  - Bad faith
  - Etc.

Invalidation on relative grounds
  - Same as for Oppositions
  - Right to a name, Copyright, etc.
Thank You!

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