

Guide to TM opposition procedure at the EUIPO

Types of rights against which an EU opposition can be filed

An EU opposition can be filed against an EU trade mark application or against an international registration designating the EU.

Opposition period

EUTM applications are open to opposition for **3 months** from publication.

Oppositions can be filed against an international registration designating the EU **between the first month and the fourth month following the date of first republication.**

These periods are not extendible.

Requirements to file an opposition:

- Name of the Opponent
- Identification of the challenged entity including the name of the owner and the representation of the contested trade mark application
- Identification of earlier marks or rights and identification of grounds of opposition:
 - Earlier TM registrations having effect in Member State of the EU (likelihood of confusion and/or reputation)*
 - Unauthorized filing of mark by an agent or representative
 - Earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance protected under EU legislation or Member State laws
 - Designation of origin or a geographical indication protected under EU legislation or Member State laws

An opposition must be based on at least one earlier right owned by the opponent.

An opposition can be based on several grounds and can be based on different earlier rights. If different earlier rights are alleged in the same opposition procedure, the owner will have to be the same.

No Power of Attorney is required to file an opposition.

* **Post-Brexit practice point:** *It is no longer possible to base an EU opposition on a UK trade mark.*

Procedure after filing opposition

- EUIPO verifies the admissibility of the opposition
- Once opposition is admitted a notification is sent to both parties to set the time limits for the proceedings
- These start with a period known as the “cooling-off” period during which the parties can negotiate an agreement. The cooling-off period is set to expire 2 months from the notification of admissibility. It can be extended once by 22 months and can last up to a total of 24 months.
- Once the cooling-off period has expired, the adversarial part of the proceedings begins.

Procedure after the expiration of the cooling off

- The Opponent is allowed 2 more months to submit all evidence and observations it considers necessary to make its case.
- After these 2 months have lapsed, and once the submitted evidence and observations (if any) have been forwarded, the applicant has 2 months to reply to the opposition.
- The applicant can file a request for proof of use, requiring the Opponent to prove that any earlier marks registered for more than 5 years have been used. If such a request is filed, the applicant may wait until the Opponent has adduced such proof before filing its evidence and observations. The opponent is then given the opportunity to comment on the applicant's observations.
- If the applicant does not request proof of use but submits evidence and observations, the opponent is given 2 months to comment on the applicant's submissions and after these exchanges the opposition is normally ready for decision.

When the opponent raised a new point that is admitted to the proceedings or when the cases deals with complex issues, the applicant may be given a possibility of replying. It is then up to the EUIPO to decide if another round should be given to the opponent.

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Procedure after submission of the parties' observations

- Once the parties have submitted their observations, the proceedings are closed, the file is ready for a decision on substance and the parties are informed accordingly.
- Once a decision is reached the parties may file an appeal against this decision within 2 months of the date of notification of the contested decision, and the grounds for appeal have to be presented within 4 months from the same date of notification. The Boards of Appeal of the EUIPO are responsible for deciding on appeals against first instance decisions taken by EUIPO.

Miscellaneous practice points:

Multiple oppositions

Multiple oppositions are when different oppositions are filed against the same EUTM application.

In this case, the EUIPO is allowed to examine only the 'most effective' opposition(s), suspending the rest and eventually deeming them to have been dealt with if the application is rejected on the basis of the chosen opposition.

Practice point: It is not possible to file the same opposition on behalf of multiple parties or to consolidate related opposition proceedings.

Multiple earlier rights in one opposition

The EUIPO considers that grouping various earlier rights in one opposition is, for practical purposes, the same as presenting multiple oppositions, making it possible for the EUIPO to base the rejection of the application on the 'most effective' right(s).

Multiple legal grounds in opposition(s)

If the opposition is successful in its entirety on the basis of the 'most effective' legal ground(s), it is not mandatory for the EUIPO to examine the remaining legal grounds. If a necessary requirement of a legal ground is not fulfilled, it is not mandatory for the EUIPO to examine the remaining requirements of that provision.

Arguments and any evidence filed in support of the opposition

They are optional when filing an opposition. It may be included in the opposition, but otherwise may be submitted after expiry of the cooling-off period and concerns the substance, not the admissibility, of the opposition.

Extensions and suspensions

It is possible to request extensions for deadlines unilaterally; it is also possible for parties jointly to request suspension of proceedings after expiry of the cooling-off period. In this case, and regardless of the period requested by the parties, the first suspension will be granted for a period of 6 months, with the parties being given the possibility of opting out. Upon a joint request by the parties, the suspension will be extended, without any need for the request to be justified. However, the maximum duration of this suspension of the proceedings is limited to 2 years.