



Promoting Intellectual
Property Rights in the
ASEAN Region

OPPOSITION PROCEEDINGS against EUTMs

Stanislava Stoyanova | Online | 19 Oct 2022



Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

- **Key features of opposition proceedings**
- **Notice of Opposition - Admissibility Check**
- **Notification - Cooling-off Period and Adversarial Part**
- **Substantiation and Online Evidence, Proof of Use**
- **Time Limits – Extensions and suspensions**
- **Opposition ready for Decision**

SOURCES

EUTMR, EUTMDR and EUTMIR

European Union applicable regulations

Guidelines

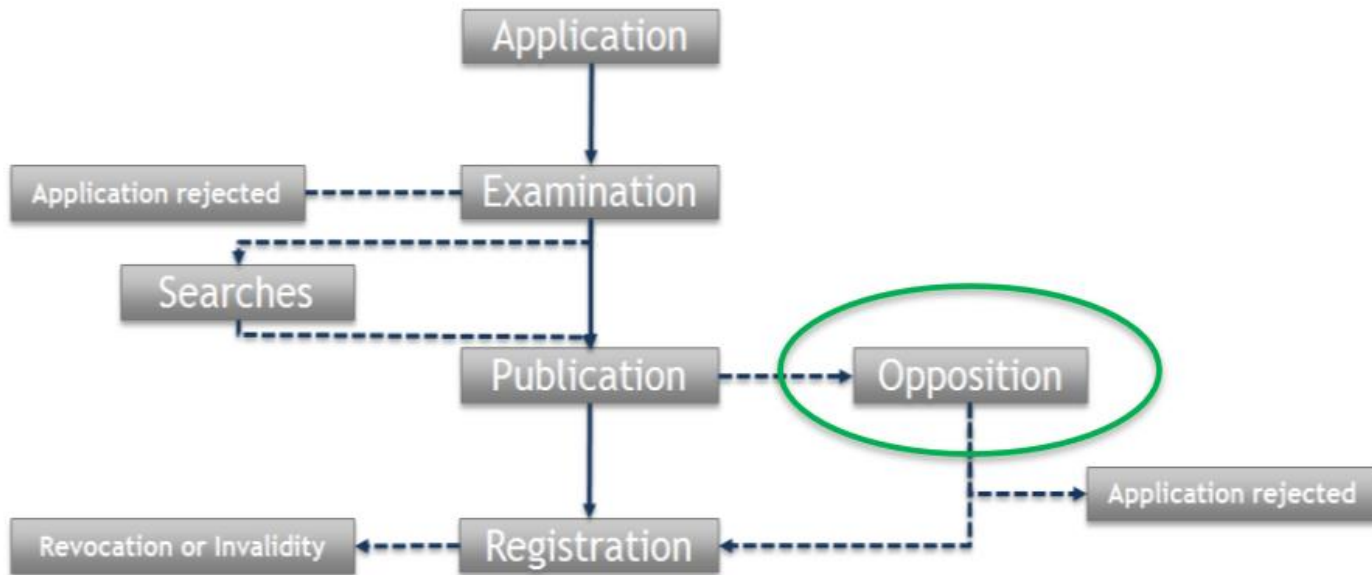
Part C: Opposition, Section 1: Opposition proceedings, *et al*

Decisions & Communications of the Executive Director

Available at: <https://euipo.europa.eu/ohimportal/en/law-and-practice>

Key features of opposition proceedings

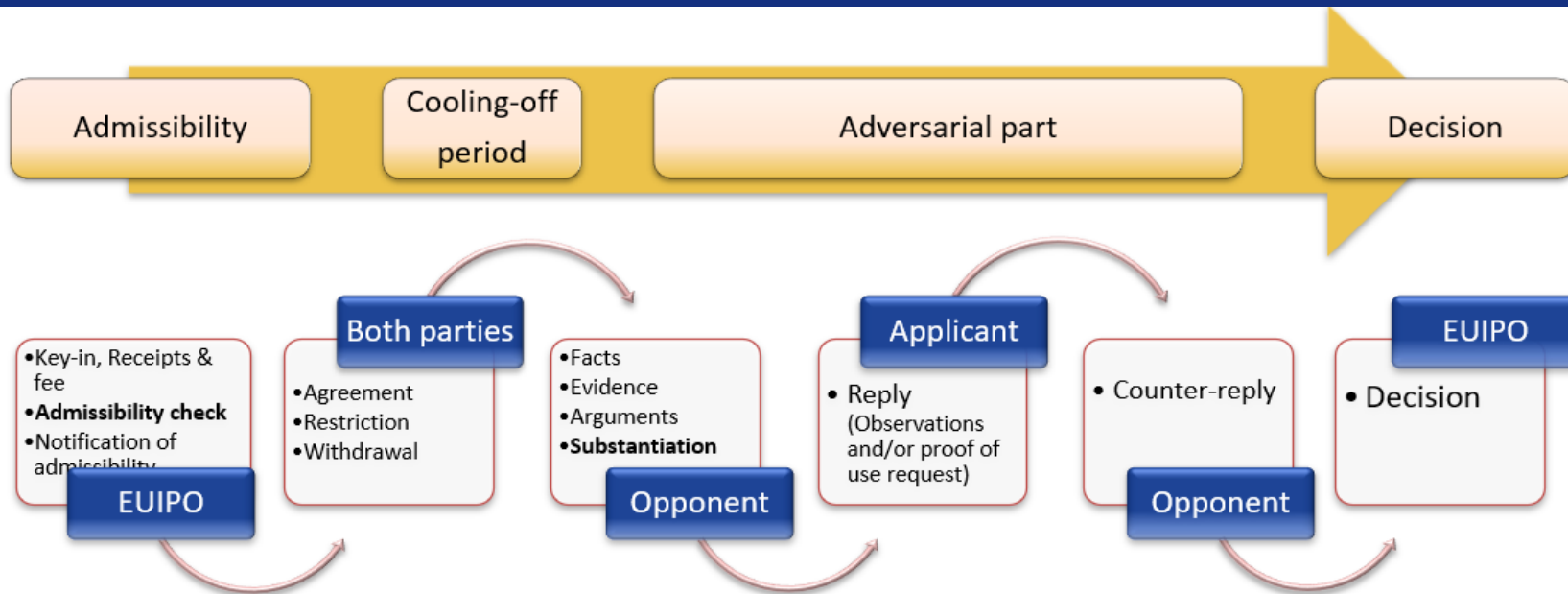
EUTM registration process



Key features of opposition proceedings

- After examination (Classification, Absolute Grounds, etc) and publication of the application
- At the request of the interested parties
- Decisions based on facts, arguments and evidence submitted by the parties
- An opposition may be based on several earlier rights and grounds
- 5 languages of the Office (EN, FR, DE, IT, ES)

Key features of opposition proceedings



*Additional round if proof of use is requested and submitted

Notice of Opposition



- Challenged entity
- Contested goods/services
- Earlier right(s)
- Grounds
- Opponent(s)
- Entitlement
- Language of proceedings
- Signature

Notice of Opposition

Filing

- Electronic filing
- Mail
- within 3-month opposition period

Payment

- 320 EUR
- Methods: current account, bank transfer or credit card (by e-filing)
- within 3-month opposition period

Formal requirements: The Admissibility Check

ABSOLUTE

admissibility requirements

RELATIVE

admissibility requirements*

Absolute Admissibility Requirements

- Identification of the contested trade mark application
 - Identification of grounds (Article 8(1) EUTMR, Article 8(4) EUTMR, etc)
 - Identification of the earlier marks or rights
 - Earlier mark is earlier
 - Language



Absolute Admissibility Requirements

Languages (Article 146 EUTMR)

- The notice of opposition must be filed in one of the languages of the Office that is a language of the contested EUTM application.

Example 1:

- EUTM application 1st language BG, 2nd EN = the opposition can only be filed in **EN**

Example 2:

- EUTM application 1st language EN, 2nd IT = the opposition can be filed in **EN and IT**

Relative Admissibility Requirements*

- Dates
- Representation of earlier marks/signs
- Goods and services
- Earlier mark with a reputation: territorial scope of reputation
- Identification of the opponent
- Professional representation (when needed)
- Signature

**Depending on the type of earlier right*

Notification

INADMISSIBLE



DECISION

rejecting the opposition
(Art 5(5) EUTMDR)

ADMISSIBLE



The opposition is notified
and time limits are set.
Cooling-off period begins.

Cooling-off Period

2-month period for negotiations between the parties and possible agreement to settle the opposition amicably.

- If certain conditions are met, the opposition fee will be refunded

May be extended up to 24 months

- upon bilateral request
- possibility to “opt out”

Approx. 45% of all oppositions
are settled by the end of CoP



Possible Settlement

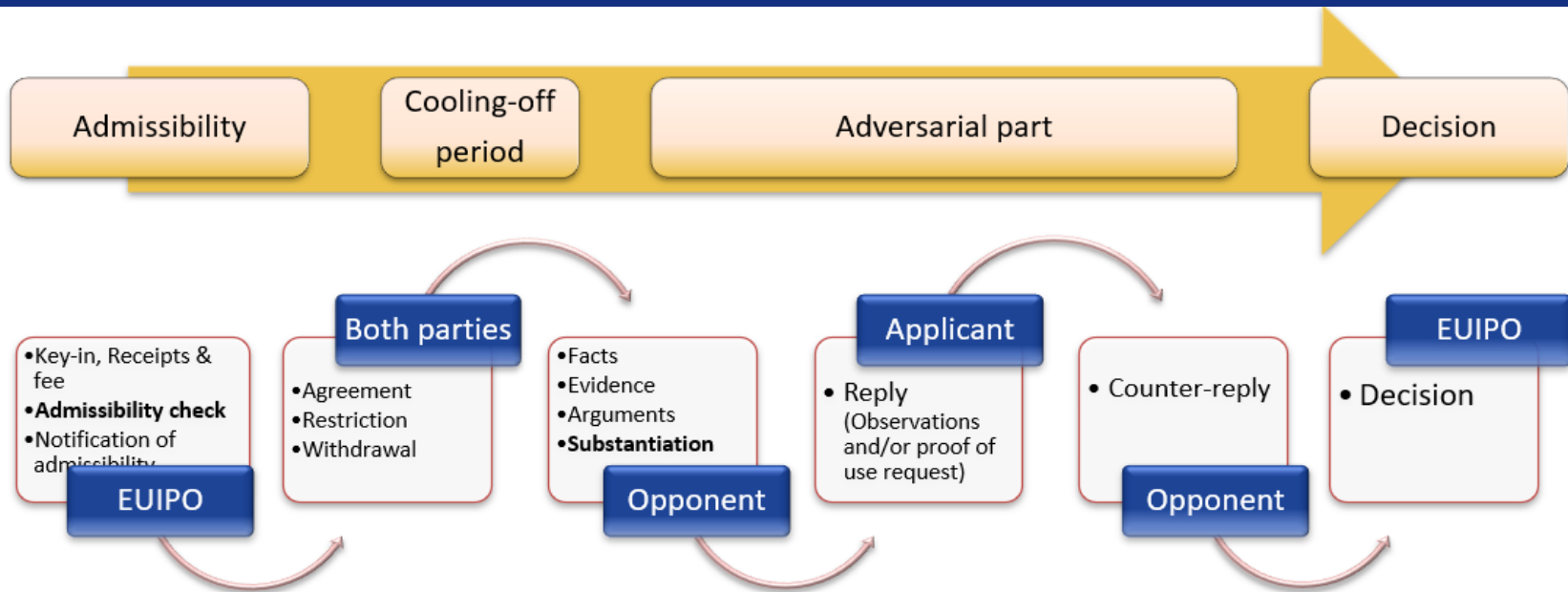
- **EUTM applicant:**

- Withdrawal of the EUTM application
- Deleting all G&S contested by the opponent
- Restriction of the contested G&S (opposition withdrawn as a result)

- **Opponent:**

- Withdrawal of the opposition (without previous restriction of the G&S)

Adversarial Part



*Additional round if proof of use is requested and submitted

Substantiation and Online Evidence

Defined by Article 7(2) EUTMDR:

- Proof of existence, validity and scope of protection of the earlier right
- Proof of the opponent's entitlement to file the opposition
- Other evidence, if relevant*
 - evidence of reputation and/or enhanced distinctiveness, etc
 - reference to national law, etc
- In language of proceedings

Substantiation and Online Evidence

- Explicit and unconditional declaration from the opponent that it relies on **online evidence**, accessible from a source recognised by the Office (Art.7(3) EUTMDR).
- Claimed in the Notice of opposition or before the expiry of the time limit of substantiation.
- The opponent has to identify the source by means of a clear identification of the database it relies on.
- Available in the language of proceedings or translated.

Proof of Use

According to **Article 47(2) EUTMR**, use of the earlier mark needs to be shown only if the EUTM applicant requests proof of use. The institution of proof of use is, therefore, designed in opposition proceedings as a defence plea of the applicant.

Earlier right must have been registered for at least **5 years**:

- for oppositions against EUTMAs: at the date of filing or at the date of priority of contested EUTMA;
- for oppositions against international registrations: at the date of registration or on the date of priority, or on the date of subsequent designation of the EU.

Proof of Use

5 year 'grace period'

For earlier EUTMs: the relevant date is the registration date of the EUTM.

For earlier international registrations designating the European Union: the date of second republication of the EU designation.

For national marks, the 'date of completion of the registration procedure' – determined by each Member State according to its own procedural rules.

If no proof of use is provided, the earlier right(s) for which proof of use has been requested will not be taken into account. If all earlier rights are affected, the Office will refuse the opposition.

Extension of Time Limits

Non-extendable time limits:

- The 3-month opposition period to file an opposition and pay the opposition fee
- The 1-month time limit to pay the surcharge when payment arrives late
- The 2-month time limit to remedy
relative admissibility deficiencies
- The 2-month time limit to request
continuation of proceedings or *restitutio in integrum*



Extension of Time Limits

Extendable time limits:

- The time limits during the adversarial part are for the most part extendable.
- Usually set for 2 months



Extension of Time Limits

Unilateral requests*

- 1st request – if duly submitted, always granted for 2 months even without justification
- 2nd and subsequent requests – refused unless the party demonstrates “exceptional circumstances” and must be accompanied by evidence

Bilateral requests

during the adversarial part always granted even without justification

Suspension of Proceedings

Article 71 EUTMDR

- *ex officio*
- unilateral requests
- bilateral requests

Requested by both parties

→ for ongoing negotiations between the parties after expiry of the cooling-off period is always granted: for 6-month periods at a time, with an overall maximum of 2 years, set out in Article 71(2) EUTMDR.

Suspension of Proceedings

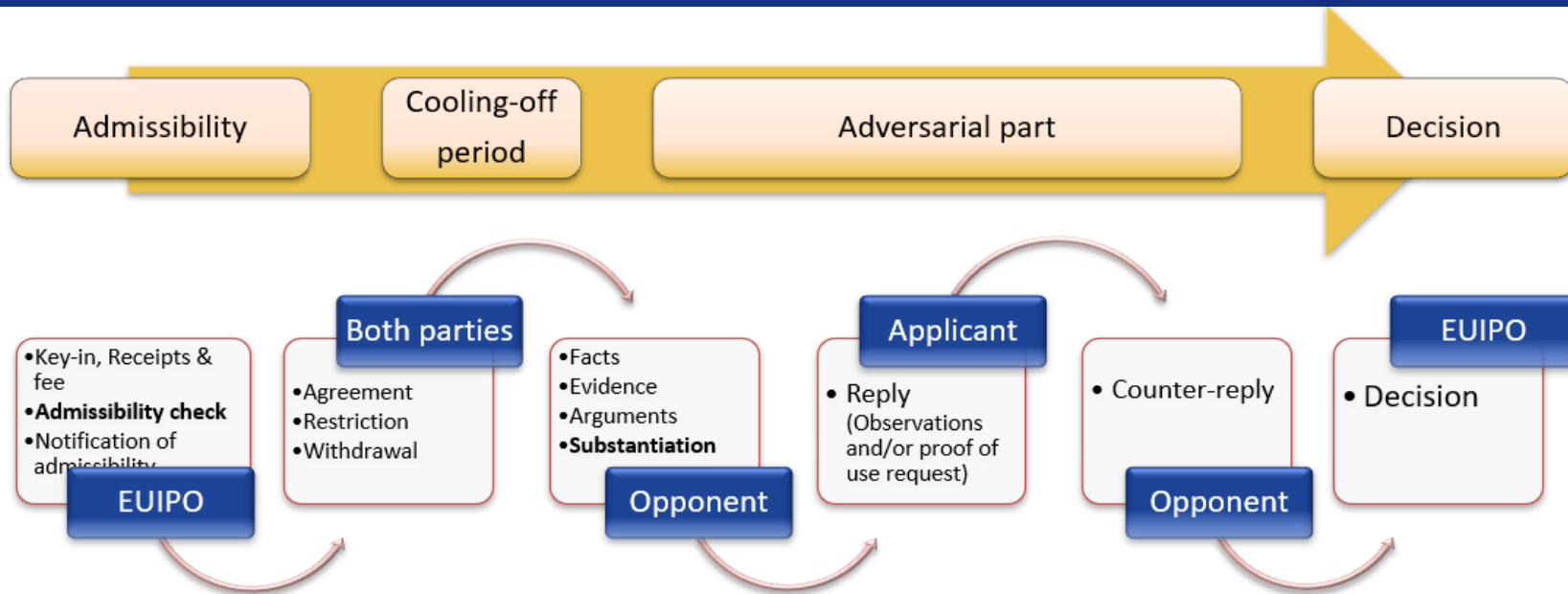
The Office may suspend the opposition proceedings *ex officio* or at the request of one party where, for example:

- earlier right is an application or at risk.
- third party observations
- other reasons (justification needed - strict criteria).



During such suspensions no time limits are usually set by the Office and no action is required from the parties for the opposition in question.

Opposition ready for Decision



*Additional round if proof of use is requested and submitted





Promoting Intellectual
Property Rights in the
ASEAN Region

THANK YOU



Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

Presentation		
Status	DRAFT / APPROVED	
Approved by owner	-	
Authors	16/10/2022	Stanislava Stoyanova
	-	
Contributors	-	
	-	

Revision history			
Version	Date	Author	Description
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		