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Trade mark oppositions: types of oppositions; filing requirements and common issues that may arise during opposition proceedings

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28/04/2026

EUIPO
EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

Funded by the European Union

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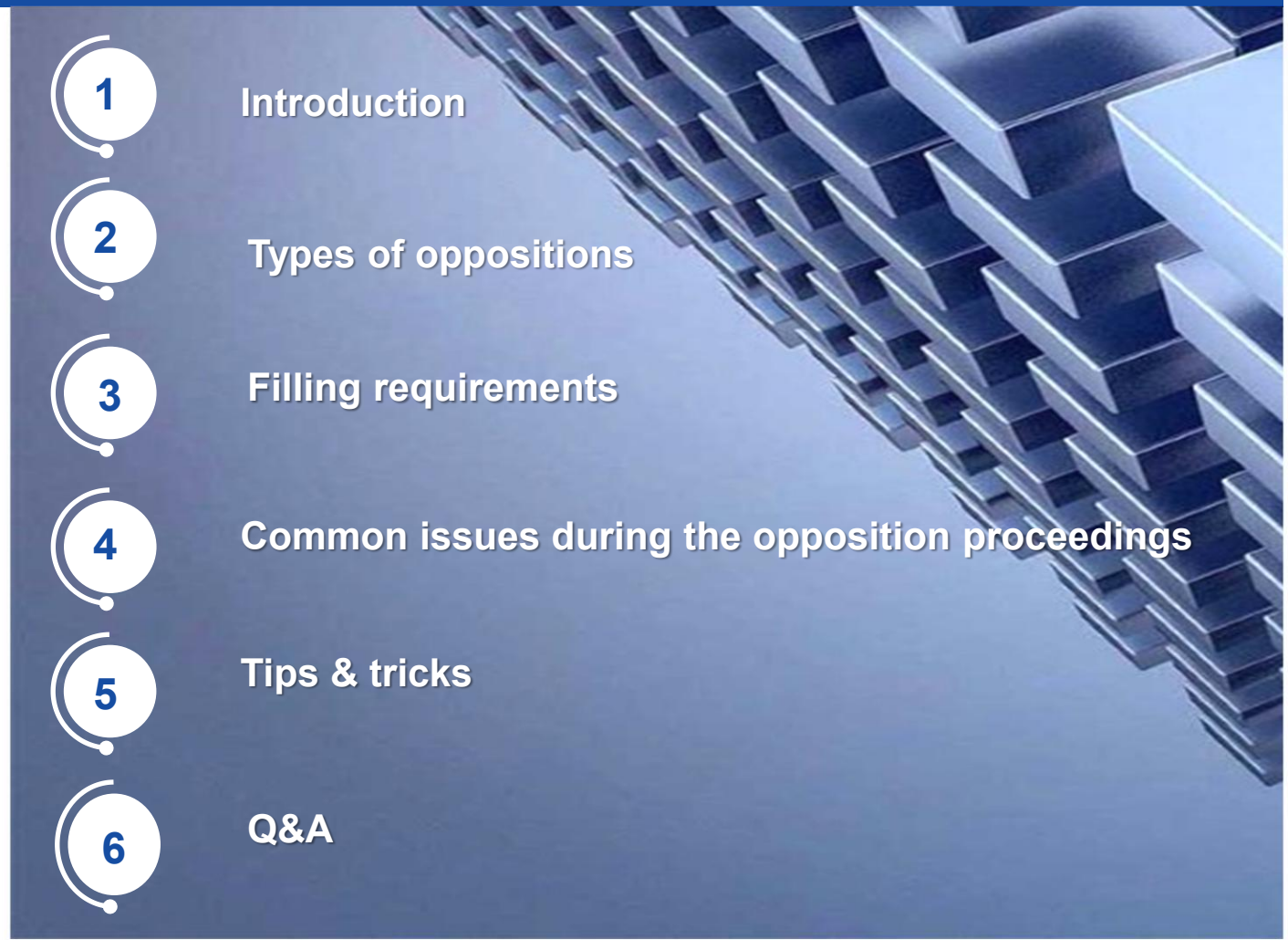
Agenda



1. Introduction
2. Types of oppositions
3. Filling requirements
4. Common issues during the opposition proceedings
5. Tips & tricks
6. Q&A

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1. Introduction

Statistics EUTMs from Caribbean area – EUTM registrations

Country	2023	2024	2025	2026
Antigua & Barbuda	5	3	11	1
Barbados	23	19	19	2
Bahamas	32	26	17	4
Belize	7	4	11	5
Cuba	2	11	14	
Dominica	1	0	1	
Dominican Republic	30	35	36	5
Grenada	0	0	0	
Guyana	0	2	0	
Haiti	0	0	4	
Jamaica	3	1	2	1
St Kitts and Nevis	4	19	6	6
Saint Lucia	1	9	4	1
Suriname	1	1	0	
Trinidad & Tobago	4	2	3	
St Vincent and the Grenadines	2	5	8	4
TOTAL	115	137	136	29

Source: *https://www.euipo.europa.eu/en/about-us/the-office/what-we-do/statistics*

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1. Introduction

Statistics EUTMs from Caribbean area – EUTM oppositions

	OPPO received			
Country	2023	2024	2025	2026
Antigua & Barbuda		1		1
Barbados	3	2		
Bahamas	9	11	3	2
Belize	2	1	1	
Cuba	13	3	2	
Dominica			1	
Dominican Republic	9	4	2	1
Grenada				
Guyana		1		
Haiti	1			
Jamaica				
St Kitts and Nevis	1		4	
Saint Lucia	1			2
Suriname				
Trinidad & Tobago				
St Vincent and the Grenadines			3	1
TOTAL	39	23	16	7

Source: https://www.euipo.europa.eu/en/about-us/the-office/what-we-do/statistics

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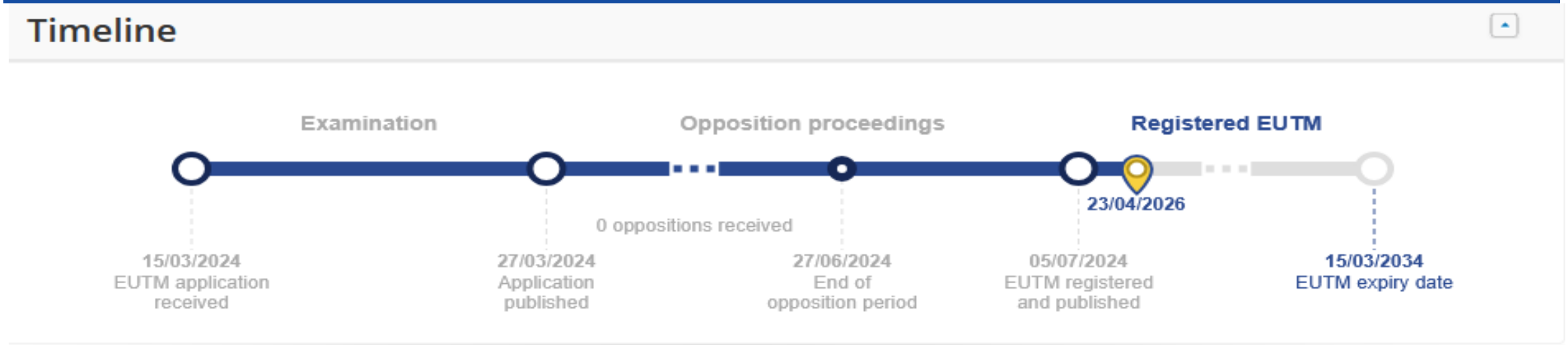
1. Introduction



AG examination

Opposition

Cancellation

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2. Types of oppositions

- Oppositions based on double identity or likelihood of confusion – Art. 8(1) EUTMR
- Oppositions against unauthorised trade mark filled by agent/representative – Art. 8(3) EUTMR
- Oppositions based on unregistered trade marks and other signs used in the course of trade – Art. 8(4) EUTMR
- Oppositions based on trade marks with reputation – Art. 8(5) EUTMR
- Oppositions based on designation of origin/geographical indications – Art. 8(6) EUTMR

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2. Types of oppositions

- Oppositions based on double identity or likelihood of confusion – Art. 8(1) EUTMR

Earlier rights:

– applications of EUTMs or national TMs (EU member states), IR designating EU or member states

– registered EUTMs, national TMs (EU member states), IR designating EU or member states

–well-known marks (Article 6bis of the Paris Convention).

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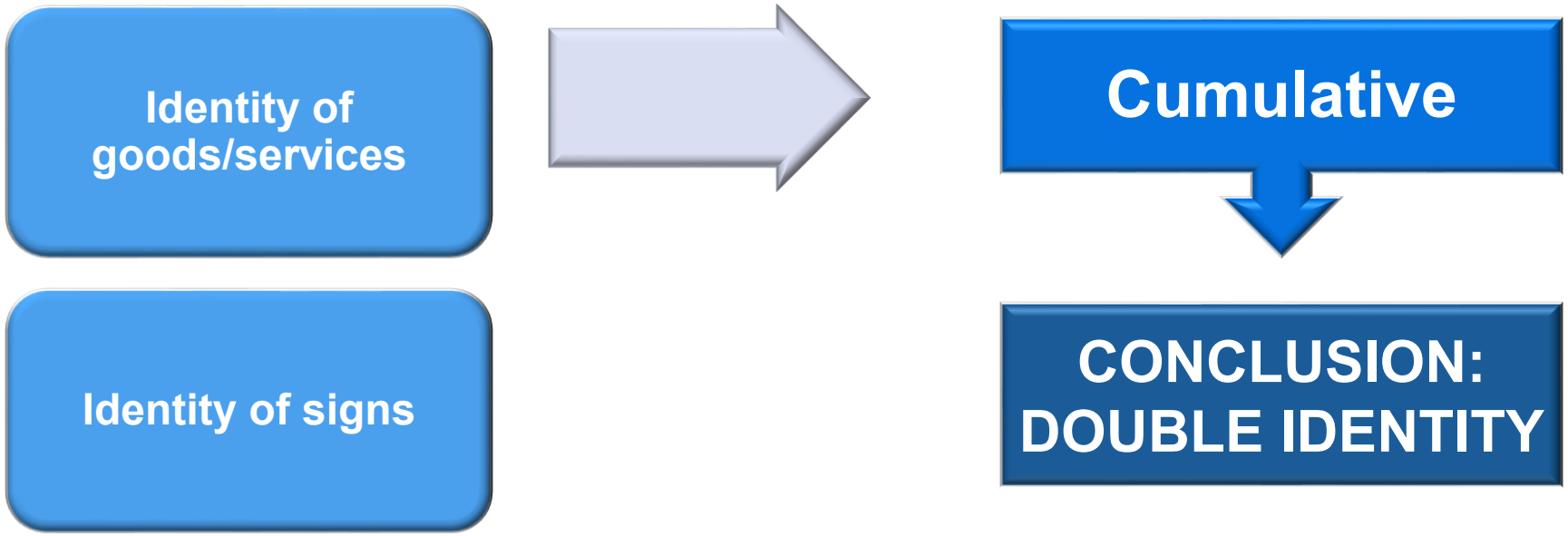
2. Types of oppositions

- Oppositions based on double identity or likelihood of confusion – Art. 8(1) EUTMR

Art. 8 (1)(a) EUTMR – double identity



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Example – Article 8(1)(a) or (b)

Opposition B 3 235 609

Earlier mark:

Class 9: *Electronic scales; scales; electric scales; weight measuring instruments and apparatus.*

EUTM application:

Class 9: *Scales, weighing devices and related equipment.*

Decision:

- **SIGNS:** Identical
- **GOODS:** Identical
- **CONCLUSION:** **DOUBLE IDENTITY – 8(1)(a) EUTMR**

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2. Types of oppositions

- Oppositions based on double identity or likelihood of confusion – Art. 8(1) EUTMR

Art. 8 (1)(b) EUTMR – Likelihood of confusion

- **Identity or similarity of goods/services**
- **Identity or similarity of signs**
- **Relevant public and degree of attention**
- **Distinctiveness of earlier mark**

→ **Cumulative**

→ **CONCLUSION: LIKELIHOOD OF CONFUSION**

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QUIZ – Article 8(1)(a) or (b)

Opposition B 3 235 609

Earlier mark:

Class 9: *Electronic scales; scales; electric scales; weight measuring instruments and apparatus.*

EUTM application:

Class 37: *Repair and maintenance of scales.*

Decision:

- **SIGNS:** Identical
- **GOODS&SERVICES:** Similar
- **CONCLUSION:** **LIKELIHOOD OF CONFUSION – 8(1)(b)**

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Example – Article 8(1)(a) or (b)

Opposition B 3 235 609

Earlier mark:

Class 9: *Electronic scales; scales; electric scales; weight measuring instruments and apparatus.*

EUTM application:

Class 35: *Mediation of trade and services, in particular relating to scales devices.*

Decision:

- **SIGNS:** Identical
- **GOODS&SERVICES:** Dissimilar
- **CONCLUSION:** **NO LIKELIHOOD OF CONFUSION – 8(1)(b)**

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2. Types of oppositions

- Oppositions against unauthorised trade mark filled by agent/representative – Art. 8(3) EUTMR

Applicant is/was an agent/representative

Identity or sufficient closeness of signs

Identity or sufficient closeness of goods/services

No consent of the owner

Agent/representative fails to justify its acts

→ **Cumulative**

→ **OPPOSITION UPHELD ON ARTICLE 8(3)**

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QUIZ – Article 8(3)

Opposition B 3 162 070

Earlier mark:

灯彩集团
LANTERN GROUP

Class 11: *Light bulbs; lamps; Chinese lanterns; LED lighting apparatus; stage lighting.*

Class 41: *Conducting guided tours.*

EUTM application:

ZIGONG LANTERN GROUP

Class 35: *Promotion of special events.*

Class 41: *Special event planning; staging of light entertainment productions; entertainment in the nature of light shows.*

Decision:

- **SIGNS:** Not identical, but sufficiently close
- **GOODS:** Not identical but closely related in commercial terms
- **APPLICANT:** Agent of the opponent
- **OWNER CONSENT:** No
- **ABSENCE OF JUSTIFICATION:** Yes
- **CONCLUSION:** **WELL FOUNDED – 8(3)**

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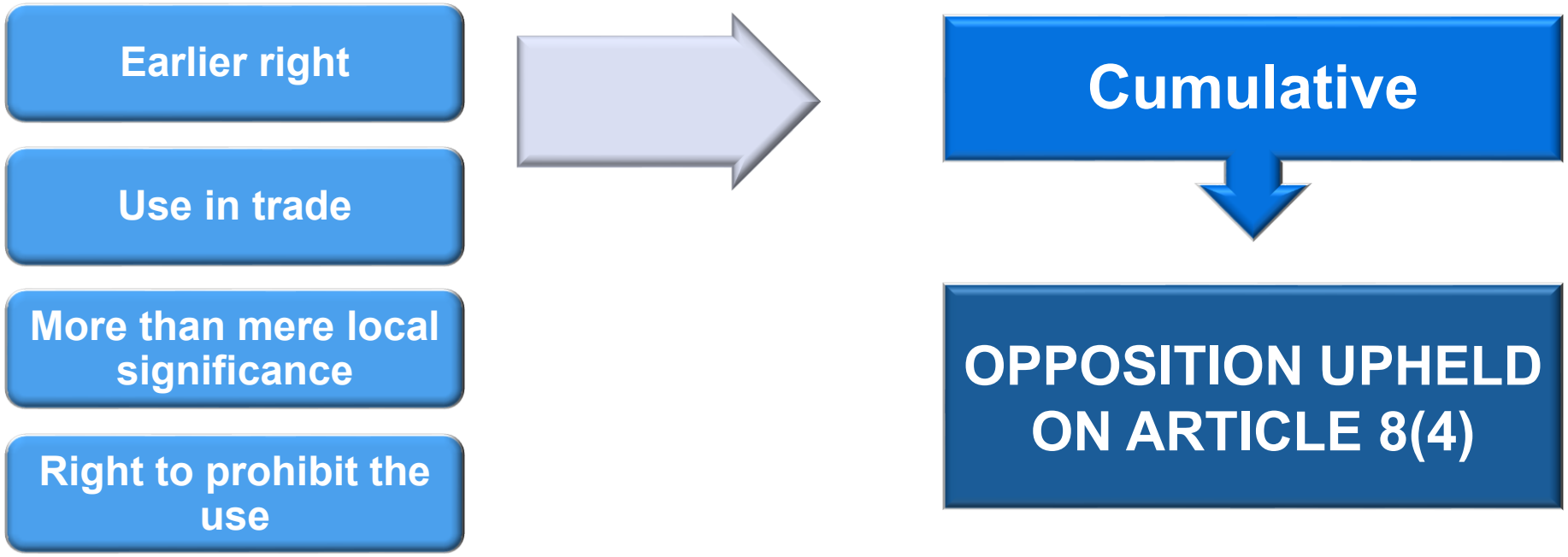
2. Types of oppositions

- Oppositions based on unregistered trade marks and other signs used in the course of trade – Art. 8(4) EUTMR



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2. Types of oppositions

➢ Oppositions based on unregistered trade marks and other signs used in the course of trade – Art. 8(4) EUTMR

Eligible business identifiers

(subject to the conditions of the applicable law):

- **trade names**
- **company names**
- **domain names**
- **titles of publications or similar works**
- **passing-off?**
- **others**

Not eligible under

- **copyright**
- **right to name**
- **right to personal portrayal**
- **other industrial property rights (e.g. designs, patents)**

*The opponent must **prove that the applicable law** gives the proprietor the right to prohibit the use of a subsequent mark.*

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QUIZ – Article 8(4)

Opposition B 3 191 276

Earlier commercial name under German law:	EUTM application:
P&C Used for: *Production and retail of clothing, headgear, footwear and accessories such as bags, wallets, other carrying cases (including of leather and imitation leather) and jewelery.*	 PATRI CADENAS Class 35: *Wholesaling and retailing services in relation to the linen and parts of clothing, clothing, footwear, handbags, bands of leather, wallets, clothes made of leather and imitations of leather, carriers, baggage, costume jewellery, jewellery, watches and headgear.*

Decision:

- **EARLIER RIGHT:** Business designation under German law
- **USED IN COURSE OF TRADE:** Used for retail of clothing and headgear
- **RIGHT UNDER APPLICABLE LAW:** Commercial name protected under German law
- **SIGNS AND DISTINCTIVENESS:** Similar signs and inherent distinctiveness of earlier sign
- **GOODS AND SERVICES:** Sector identity for clothing and sector proximity for wallets, carriers, baggage, costume jewellery, jewellery, watches
- **LIKELIHOOD OF CONFUSION:** Yes - the contested sign could be seen as a sub-brand
- **CONCLUSION:** **OPPOSITION WELL FOUNDED – 8(4)**

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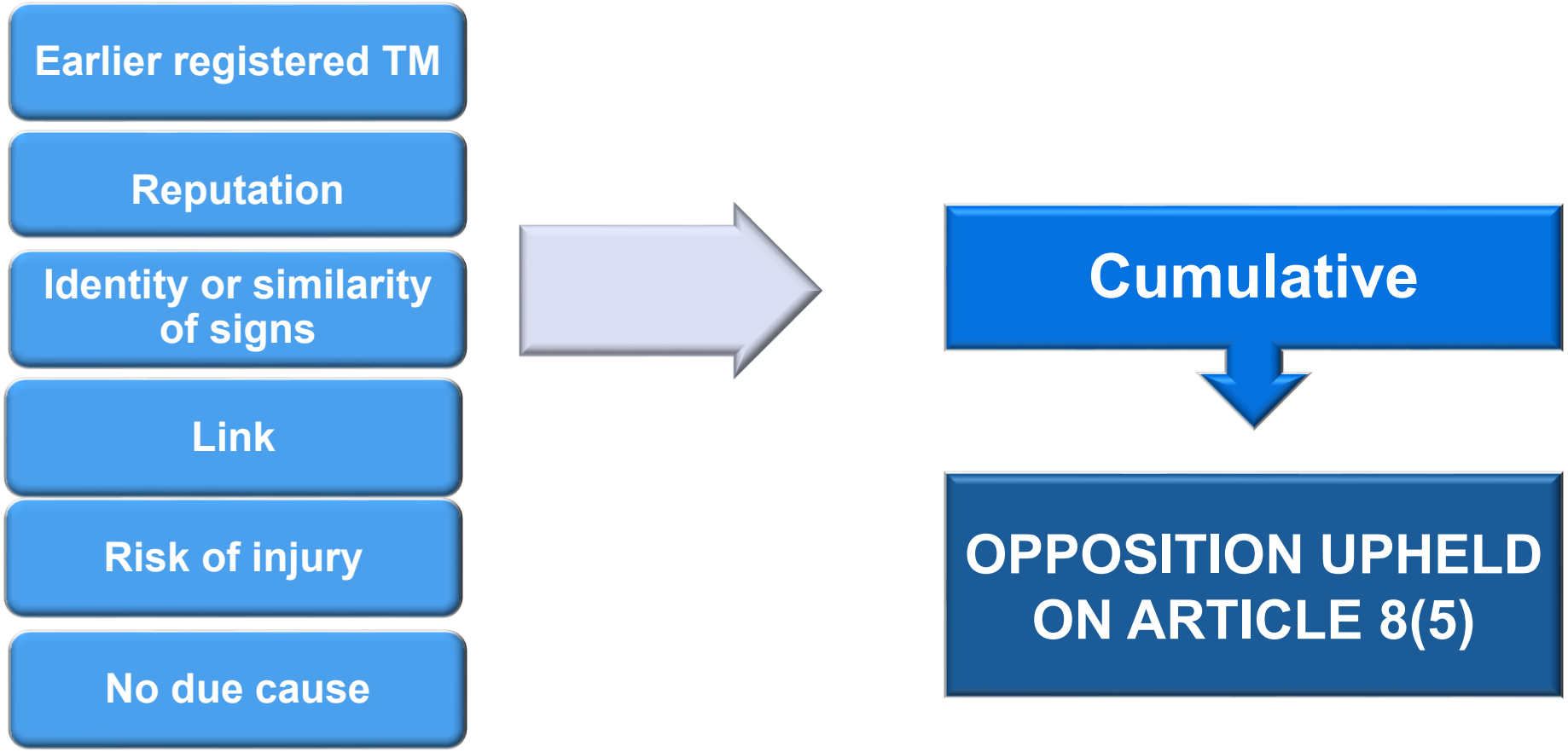
2. Types of oppositions

- Oppositions based on TM with reputation – Art. 8(5) EUTMR



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2. Types of oppositions

➢ Oppositions based on TM with reputation – Art. 8(5) EUTMR

Types of injuries

- **Take unfair advantage** – *free-riding*
- **Be detrimental to the distinctive character of earlier trade mark - *Dilution, blurring, watering down***
- **Be detrimental to the repute of the earlier trade mark – *Tarnishment***

*The opponent must **argue** on the type of injury, one of the type being sufficient for upheld the opposition on Art 8(5).*

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Example – Article 8(5)

Opposition B 3 183 663

Earlier mark:	EUTM application:
TAG HEUER	**TAG**
Class 12: *Horological instruments, namely watches, chronographs.*	Class 14: *Precious metals and their alloys; Jewellery; Precious and semi-precious stones;* *Class 18: Leather and imitations of leather; Luggage, bags, wallets and other carriers; All-purpose carrying bags; Animal carriers [bags].* *Class 25: Footwear.* Class 35: *Retail services connected to the goods in Classes 14, 18 and 25.*

Decision:

- **SIGNS:** Similar
- **GOODS&SERVICES:** Dissimilar
- **REPUTATION:** Established for *watches and chronographs*
- **LINK:** Established – target the same public, and belongs to the same to the fashion industry, the goods may be aesthetically coordinated with one another
- **TYPE OF INJURY:** Unfair advantage
- **CONCLUSION:** **OPPOSITION WELL FOUNDED – 8(5)**

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QUIZ – Article 8(5)

Opposition B 3 113 490

Earlier mark:

DUCATI

Class 12: *Vehicles; motorcycles.*

EUTM application:

DUCATI

Class 19: *Windows and doors, not of metal; non-metallic rigid pipes for building.*

Decision:

- **SIGNS:** Identical
- **GOODS:** Dissimilar
- **REPUTATION:** Established for *motorcycles*
- **LINK:** Not established
- **CONCLUSION:** **OPPOSITION NOT WELL FOUNDED – 8(5)**

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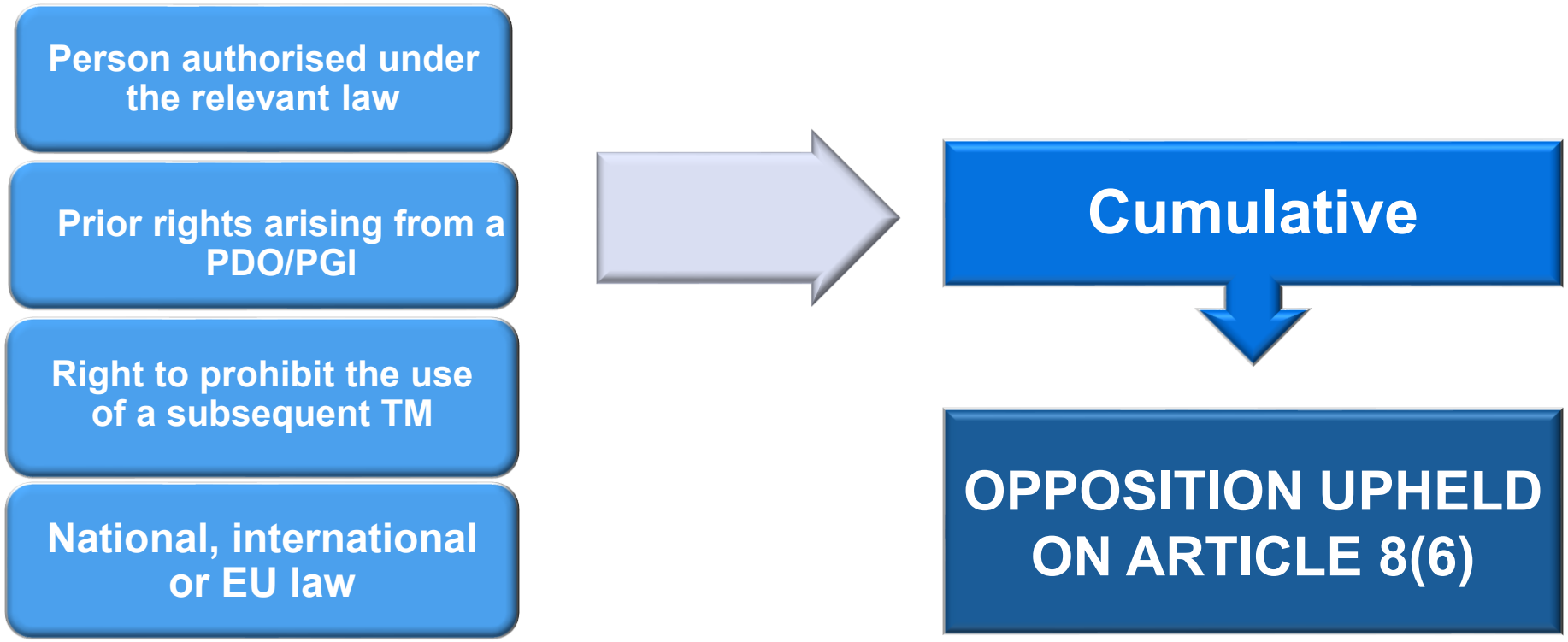
2. Types of oppositions

- Oppositions based on a Protected Designation of Origin/Geographical Indication – Art. 8(6) EUTMR



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Example – Article 8(6)

Opposition B 3 207 890

Earlier PDO:

CHAMPAGNE

PDO: *Wine.*

EUTM application:

CHAMPRICE

Class 43: *Services for providing food and drink; serving food and drinks.*

Decision:

- **AUTHORISED PERSON:** Yes
- **PDO:** Yes
- **RIGHTS TO PROHIBIT USE:** Yes
- **LAW:** Art 8(6) EUTMR & Art 103(2) EU Regulation 1308/2013
- **CONCLUSION:** **WELL FOUNDED – 8(6)**

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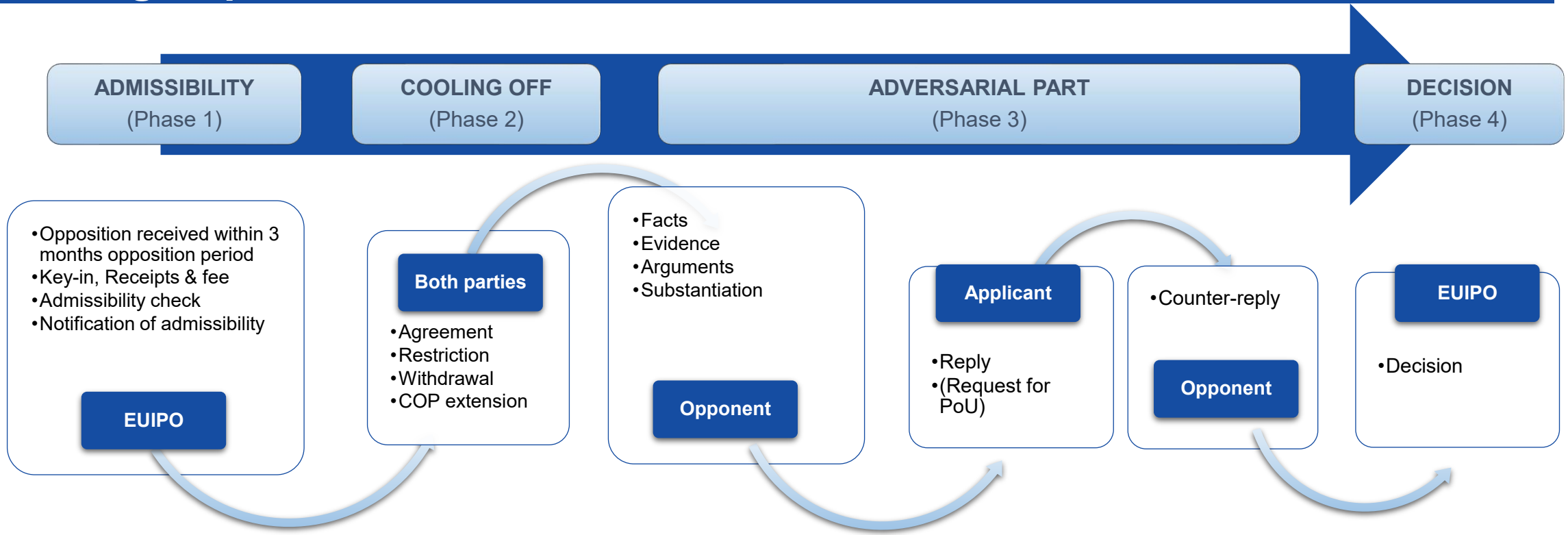
3. Filling requirements



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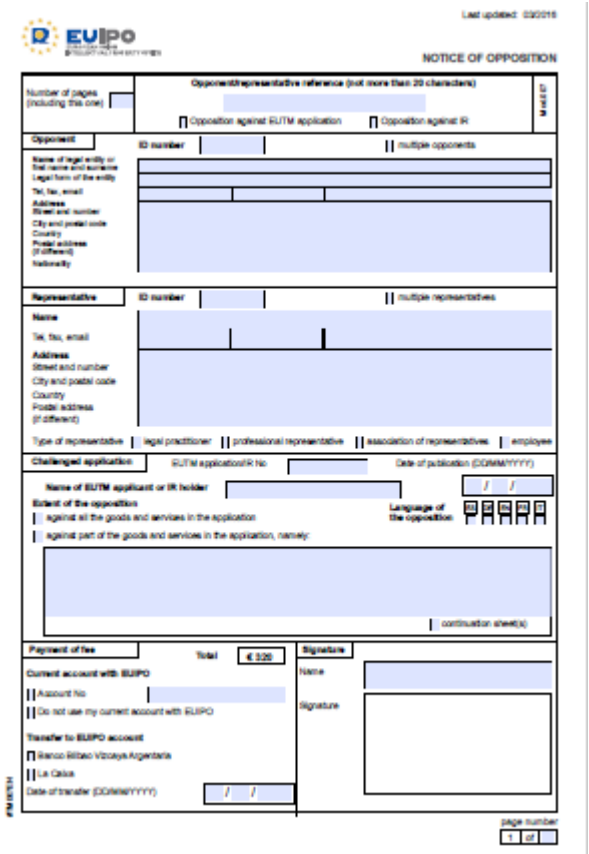
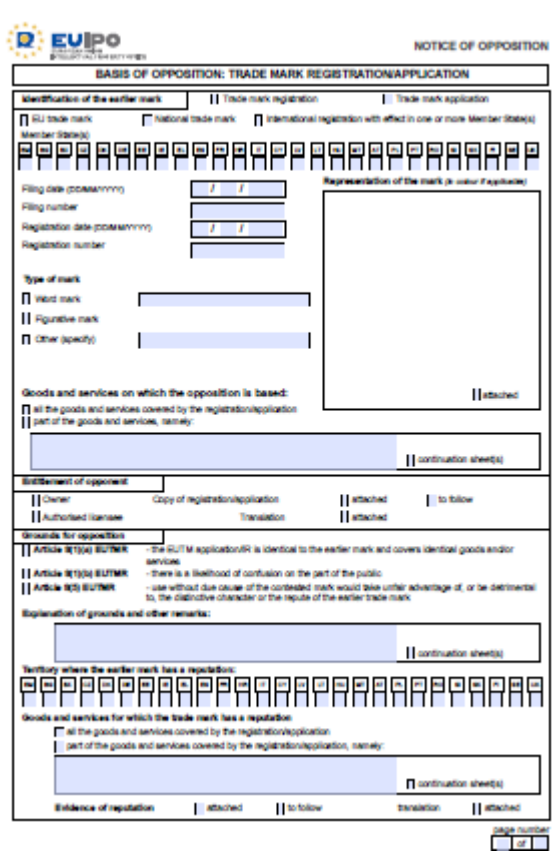
3. Filling requirements

Notice of opposition

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


NOTICE OF OPPOSITION


NOTICE OF OPPOSITION

BASIS OF OPPOSITION: TRADE MARK REGISTRATION/APPLICATION

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4. Common issues during the opposition proceedings

Deficiencies in opposition proceedings - Article 2(2) EUTMDR

Absolute deficiencies

cannot be remedied after the expiry of the opposition period. If the opponent does not remedy these deficiencies on its own initiative within the opposition period, the opposition is inadmissible

Relative deficiencies

can be remedied after the expiry of the opposition period. The Office invites the opponent after the expiry of the opposition period to remedy the deficiency within a non-extendable time limit of 2 months, failing which the opposition will be rejected as inadmissible

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4. Common issues during the opposition proceedings

Absolute deficiencies

Absolute deficiencies (concerning the opposition form)

- Filing after the 3-month opposition period
- No identification of the contested EUTM application
- No identification of the grounds

Absolute deficiencies (concerning the earlier rights)

- No identification of earlier mark/right (missing file/registration number, Member State)
- The earlier mark(s) is/are not earlier

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4. Common issues during the opposition proceedings

Absolute deficiencies

Identification of earlier rights

- Earlier registered trade mark or application
- Earlier registered trade mark with reputation
- Earlier well-known mark
- Earlier non-registered mark/earlier sign used in the course of trade
- Earlier protected designation of origin (PDO) or geographical indication (PGI)

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4. Common issues during the opposition proceedings

Absolute deficiencies

Earlier right must be **earlier**

- ✓ Check the application date for national/EU trade marks
- ✓ Check for designation date for international registrations
- ✓ Check for priority: ‘triple identity’

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Example – EARLIER SIGN IS NOT EARLIER

Opposition B 3 227 284

Earlier mark:

Application date: 28/05/2024

EUTM application:

abc energy

Application date: 14/05/2024

Decision:

- **EARLIER MARK:** Not earlier
- **CONCLUSION:** **OPPOSITION REJECTED AS INADDMISSIBLE**

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QUIZ – EARLIER SIGN IS NOT EARLIER

Earlier mark:

Application date: 27/02/2026
Priority date: 06/10/2025

EUTM application:

abc energy

Application date: 15/10/2025

Decision:

- **EARLIER MARK:** Earlier considering the priority date
- **CONCLUSION:** **OPPOSITION FOUND ADMISSIBLE**

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4. Common issues during the opposition proceedings

Relative deficiencies

Relative deficiencies (concerning the opposition form)

- Opposition notice not signed
- Opponent's name, address or entitlement missing
- Multiple opponents, no information regarding capacity to act in common
- Lack of mandatory representation (EEA)
- Indication of extent (contested goods & services)

Relative deficiencies (concerning the earlier rights)

- Filing/registration/priority dates of the earlier mark(s)
- Representation of figurative marks/signs; colour representation
- Indication of goods & services of the earlier marks/signs in language of proceedings

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

1. Earlier registered trade mark or application

Absolute requirements	Relative requirements
Article 2(2)(b)(i) EUTMDR	**Article 2(2)(d), (f) and (g) EUTMDR**
• Indication of territory • Registration/application number	• Filing date /registration date/priority date • Representation of the mark (in colour) • Indication of the list of goods & services on which the opposition is based

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

2. Mark filed by an agent

Absolute requirements	Relative requirements
Article 2(2)(b)(iii) EUTMDR	**Article 2(2)(d), (f) and (g) EUTMDR**
• Application/registration number (if registered) • A reproduction of the mark • The territory in which it is protected	• A representation of the sign in colour, if applicable • An indication of the goods & services on which the opposition is based • Filing date/registration date

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

3. Earlier non-registered mark/earlier sign used in course of trade

Absolute requirements	Relative requirements
Article 2(2)(b)(iv) EUTMDR	**Article 2(2)(g) EUTMDR**
• Reproduction of the sign • Territory in which it is protected • Nature of the right	• An indication of the goods & services on which the opposition is based • National law if applicable

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

4. Earlier registered marks with reputation

Absolute requirements	Relative requirements
Article 2(2)(b)(i) EUTMDR	**Article 2(2)(d), (f) and (g) EUTMDR**
• Indication of territory where the mark is reputed • Registration/application number	• Filing date/registration date/priority date • Representation of the mark (in colour) • Indication of the list of goods & services on which the opposition is based • Indication of the goods & services for which it has reputation

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

5. Earlier well-known mark

Absolute requirements	Relative requirements
Article 2(2)(b)(ii) EUTMDR	**Article 2(2)(d), (f) and (g) EUTMDR**
• Indication of the Member State where the mark is well known • **Either** registration number and territory **or** representation of the mark	• Representation of the mark (in colour) • Indication of the list of goods and services on which the opposition is based • Filing date/registration date

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies

6. Earlier protected designation of origin (PDO) or protected geographical indication (PGI)

Absolute requirements	Relative requirements
Article 2(2)(b)(v) EUTMDR	**Article 2(2)(e) and (f) EUTMDR**
• Reproduction of the sign • Territory in which it is protected • Nature of the right	• An indication of the goods & services on which the opposition is based • Date of application of the PDO/PGI or date from which protection is granted

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4. Common issues during the opposition proceedings

Absolute and relative deficiencies – admissibility check

Decision rejecting the opposition (Article 5(5) EUTMDR)

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

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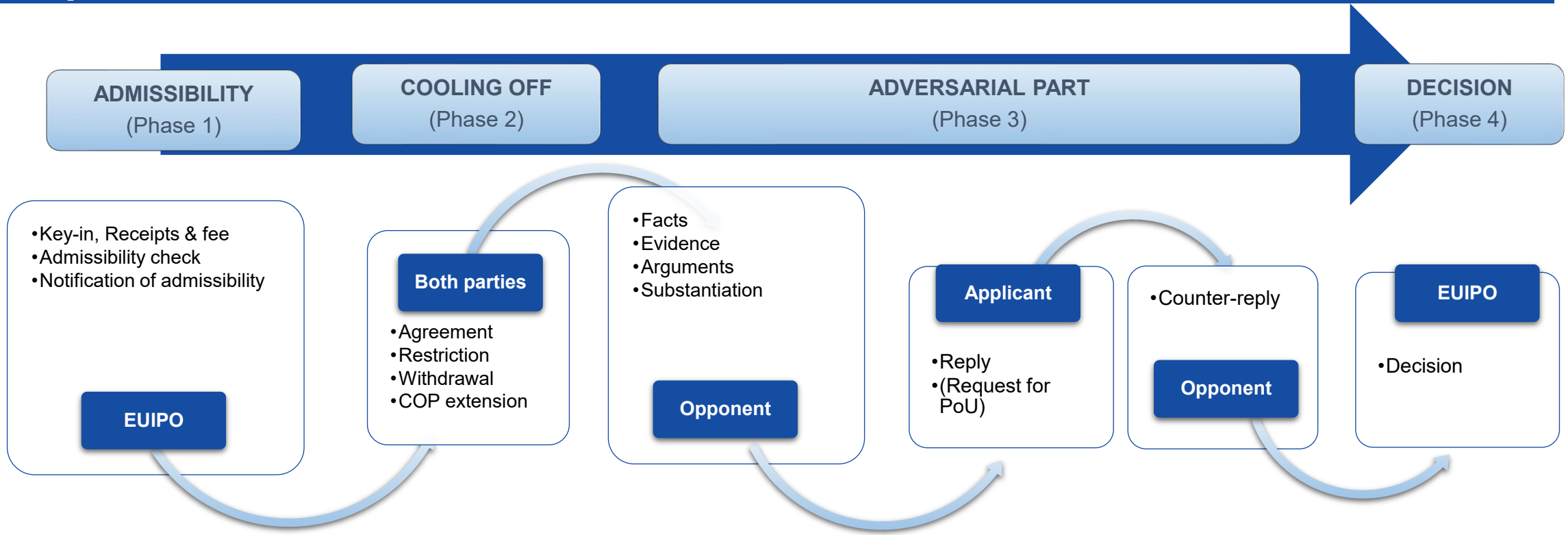
5. Tips&tricks



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5. Tips&tricks

- Evidence in Opposition Proceedings – General considerations

Office is restricted in its examination to the facts, evidence and arguments provided by the parties (Art 95(1) EUTMR)

Evidence must be filed in the language of proceedings or any official language of the EU accompanied by a translation in the language of proceedings

Basic structure and format – must be filed together with the index containing the number of annexes, short description and number of pages thereof, page number of the submission where annex is mentioned

Belated evidence - discretionary power of EUIPO considering stage of the proceedings, relevant for outcome, valid reasons for late submission

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5. Tips&tricks

- Evidence in Opposition Proceedings – Means of evidence

- ✓ Company profiles, annual reports, affidavits
- ✓ Market surveys
- ✓ Ranking, recognitions, awards
- ✓ Press articles
- ✓ Statements from third parties
- ✓ Sales turnover, market share
- ✓ Presence and activity on the internet
- ✓ Invoices, delivery notes
- ✓ Advertising expenditure
- ✓ Advertising and promotional material
- ✓ Sponsorship of cultural, sports events, merchandising
- ✓ Previous national court/EUIPO/CJ decisions, successful enforcement track record

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5. Tips&tricks

• Priority – triple identity

Formal requirements:

- ✓ priority claim filed together with the EUTM application;
- ✓ number, date and country of the previous application;
- ✓ availability of official online sources to verify the priority data, or submission of priority documents and translations, where applicable

Substantive requirements:

- ✓ Principle of first filing: it may be claimed during the 6 months (cannot be of the same date as the EUTM application)
- ✓ **Triple identity** (marks, G&S, owner)
- ❑ Mark: (colours, punctuation, lower/upper case) “insignificant differences“ accepted)
- ❑ G&S: of the EUTM application that are relevant in inter partes
- ❑ Owner: applicant or successor in title (transfer must have taken place prior to filing EUTM application, if change of name it is OK)

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QUIZ – PRIORITY

First Filling	Country	G&S	EUTM	G&S
06/04/2020	Japan	Perfumes	15/09/2020	Perfumes, clothing
09/05/2020	Japan	Clothing		

✓

First Filling	EUTM
Word mark: Percy & Reed Figurative mark:	Word mark: PERCY & REED Figurative mark:

✓

Word mark: POPEYE Figurative mark:	Word mark: POPEYES Figurative mark:

✗

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6. Q&A

Questions & Answers?

FAQ section: https://www.euipo.europa.eu/en/help-centre/tm/faq-opposition

EUIPO Guidelines: https://guidelines.euipo.europa.eu/2302857/2231846/trade-mark-guidelines/1-introduction

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