



SIPO/OHIM TRAINING SEMINAR
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Examination of Relative Grounds

Opposition Proceedings

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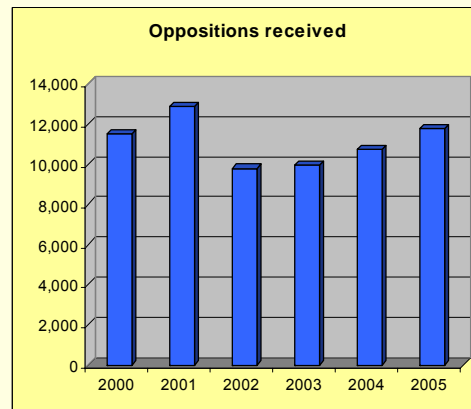
HISTORY

- 1997: Reception of First OPPOSITION
- 1997 = 851 oppositions \Rightarrow 1998 = 11,000
- 2002: more than 100 people working in OD
- April 2003: Merger of ED and OD > TMD
 - Examination of application and oppositions now done by 4 Services + Task Force of \approx 140 people
- enormous experience gained in first 8 years
 - \Rightarrow is reflected in the new Regulation (25/07/2005)
 - = codification of existing practice



OPPOSITION STATISTICS

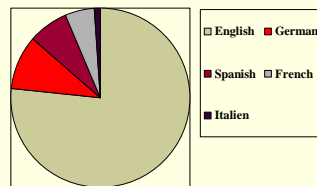
Oppositions received *		
1997-1999	34,018	22,518
2000	11,500	34,018
2001	12,879	46,897
2002	9,800	56,697
2003	9,938	66,635
2004	10,715	77,350
2005	11,752	89,108



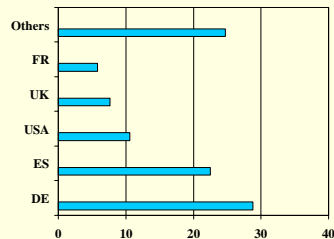
OPPOSITION STATISTICS

- ≈ 20% of all applications are opposed
- 78% receive one, 22% receive several oppositions

■ Language of proceedings



■ Nationality of opponent



INTRODUCTION

- **RECAPITULATION:**
 - Filing of a Community Trade Mark Application (CTMA)
 - Examination of the CTMA:
 - Filing date awarded
 - Classification
 - Examination on absolute grounds
 - Release for publication
 - Publication of the CTMA in the CTM BULLETIN



PRINCIPAL FEATURES

- Before Registration
- Not *ex officio* proceedings (only on request)
- Who may file an opposition?
 - Owners of earlier rights or authorised licensees
 - Oppositions are NOT open to the general public
 - Opponent can be from outside the EU
 - representation by an agent mandatory
- Only in the 5 language of the Office



REASONS FOR AN OPPOSITION

- Protection of financial investments and legal interests:



- In comparison to legal actions before courts, opposition proceedings
 - have lower risk and lower costs
 - € 350 opposition fee + € 300 representation costs
 - are generally faster (exception: preliminary injunctions)

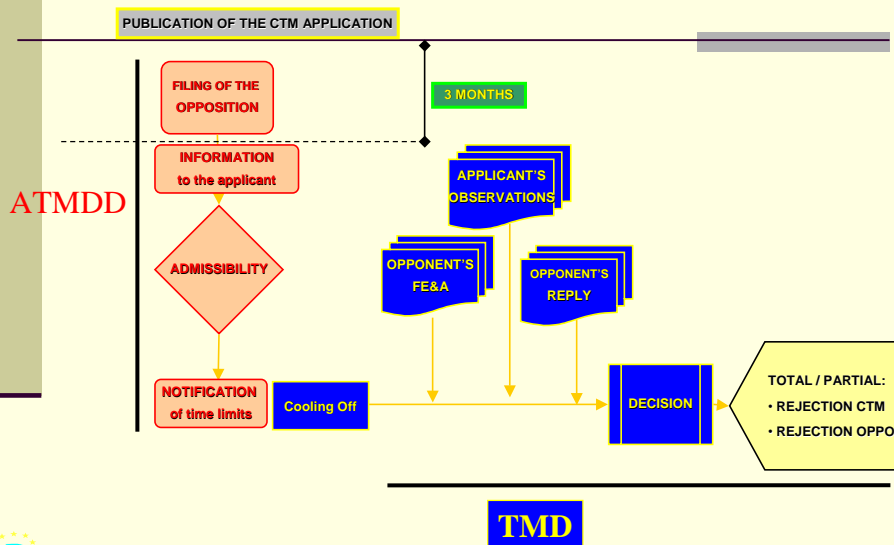


INTRODUCTION

- What rights are protected?
 - EARLIER COMMUNITY TRADE MARKS
 - EARLIER NATIONAL RIGHTS
 - Registered trade marks (also applications), including IR marks
 - Non-registered trade marks (insofar protected by national law)
 - well-known marks
 - non-registered signs (insofar protected by national law), e.g. company or trade name, titles of publications



OUTLINE



PHASES OF PROCEEDINGS

- 1. Phase: filing of the opposition, examination of the admissibility and information of the parties of the time limits.
- 2. Phase: *Cooling off* – period
- 3. Phase: Adversarial part of the proceedings

- ⇒ **DECISION** (if proceedings not closed by other incidents, e.g. withdrawals)



1. PHASE: Admissibility

- **Filing of notice of opposition**
 - within time limit (3 months after publication)
 - in writing
 - before the Office
 - unlike CTM applications which may be filed through the national offices.
 - opposition fee of € 350,-- must be paid within the 3-months opposition period



1. PHASE: Admissibility

■ Language

- It must be filed in one of the 5 languages of the Office
 - English, German, French, Spanish, Italian
- Depending on first + second language of CTMA
- At least the second language needs to be one of the five languages of the Office
- Translation possible within 1 month from the expiry of opposition period



1. PHASE: Admissibility

■ Contents of the notice of opposition (1)

- **Absolute** identification elements:
 - Contested CTMA (file number)
 - Clear identification of earlier mark or earlier right (e.g. registration number, representation of the unregistered mark, Member States)
 - Grounds on which the opposition is based (e.g. likelihood of confusion)
- Deficiencies can only be remedied before expiry of opposition period, otherwise inadmissible

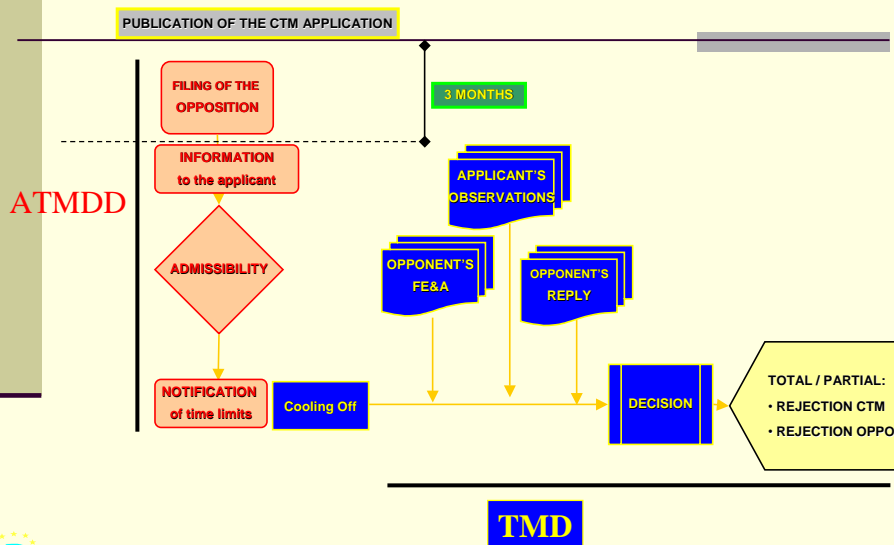


1. PHASE: Admissibility

- Contents of the notice of opposition (2)
 - **Relative** identification elements:
 - (Colour) Representation of registered mark
 - Goods and services on which the opposition is based
 - Goods and services against which the opposition is directed (extent of opposition)
 - Office informs opponent and gives a time limit of two months to remedy the deficiencies.



OUTLINE

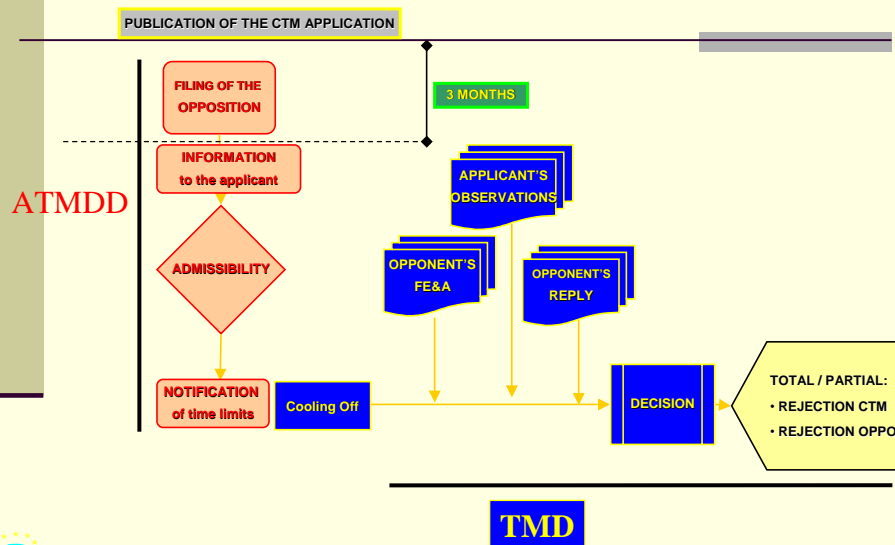


2. PHASE: COOLING-OFF PERIOD

- Period for negotiating and finding a possible settlement
 - 2-months period can be extended up to 24 months in total on request by both parties
- Special feature:
 - refund of opposition fee possible
 - in case of withdrawal
 - limitation of CTM
 - No decision on costs



OUTLINE



3. Phase: ADVERSARIAL PART

- The opponent has two months to file evidence of the earlier rights on which the opposition is based
 - Evidence: registration certificates or equivalent documents emanating from the administration by which the trade mark was registered, e.g. extracts of official database (ROMARIN, MADRID EXPRESS DATABASE)
 - Opponent must provide translation into the language of the proceedings within this time limit



3. Phase: ADVERSARIAL PART

- Substantiation of earlier rights have caused many problems in practice
 - private documents (database)
 - no renewal certificates
 - no evidence of transfer of earlier right
 - missing or incomplete translations
- OHIM only submits info sheet on evidence, no obligation to point out deficiencies
 - confirmed by CFI in “CHEF”-Case (T-232/00)



3. Phase: ADVERSARIAL PART

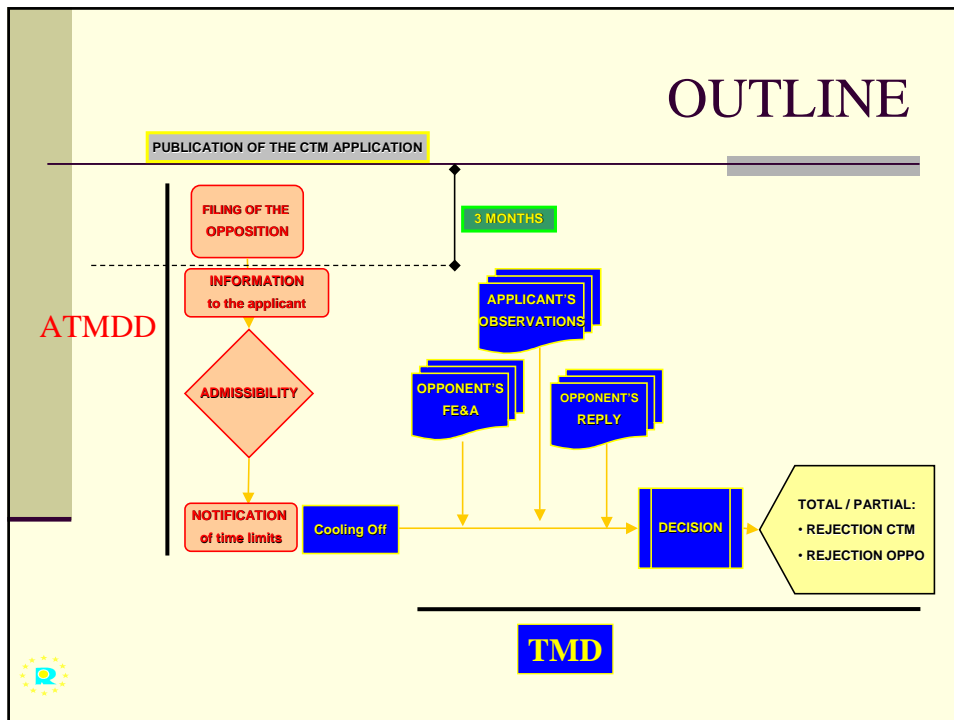
- Possible DEFENSES of the applicant:
 - OBSERVATIONS
 - REQUEST PROOF OF USE
 - WITHDRAWAL / LIMITATION OF CTMA
 - DIVISION OF THE APPLICATION (new)
 - Opposition only directed against part of CTMA
 - Non-opposed part can be registered
 - Proceedings continue with opposed part only



3. Phase: ADVERSARIAL PART

- Proof of Use
 - Request of applicant:
 - within first time limit to file observations (not at later stage)
 - Registration of the earlier mark for at least 5 years before the publication of the CTM application
 - Obligations upon opponent
 - genuine use of the trade mark in the EU/Member State in connection with the registered goods/services
 - “genuine” = not merely token
 - means: affidavits, invoices, advertising material, etc.





- ## DECISIONS
- Possible outcome:
 - (1) Opposition rejected
 - Opponent bears costs
 - (2) CTMA rejected
 - Applicant bears fees and costs
 - (3) CTMA rejected in part
 - Each party bears own costs
 - Approx. 9 months until decision is issued after closure of proceedings
 - Decision is signed by three examiners

DECISIONS

- Appeal:
 - within two months after notification of decision
 - after payment of fee € 800
- Interlocutory Revision:
 - Before deciding on appeal BoA inform TMD and give opportunity to rectify its decision

