

# ***THE MANUAL CONCERNING OPPOSITION***

## ***PART 1:***

### ***PROCEDURAL MATTERS***

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## **INTRODUCTION: GENERAL OUTLINE OF THE OPPOSITION PROCEEDINGS**

When an opposition is filed against an International Registration designating the EC, any reference in this Manual to CTM applications must be read to include International Registrations designating the EC. A Specific Manual has been drafted for International Marks including specificities about oppositions.

Opposition proceedings start with the reception of the notice of opposition. The applicant is immediately notified of the opposition notice filed and he receives a copy of the documents on file.

Thereafter, once the payment of the opposition fee has been checked, the notice of opposition is checked for compliance with other formal requirements of the Regulation.

In general, two kinds of admissibility deficiencies can be distinguished:

*Absolute deficiencies*, i.e. deficiencies that cannot be remedied after the expiry of the opposition period. If the opponent does not remedy these deficiencies on his own initiative within the opposition period, the opposition is inadmissible.

*Relative deficiencies*, i.e. deficiencies that can be remedied after the expiry of the opposition period. The Office invites the opponent to remedy the deficiency within a non extendible period of two months, failing which the opposition will be rejected as inadmissible.

After examination of admissibility of the opposition, a notification is sent to both parties to set the deadlines for the proceedings. It starts with a period during which parties can negotiate an agreement (with or without any financial consequences), the so-called “cooling-off” period. The cooling-off period is set to expire two months from the notification of admissibility. It can be extended once for 22 months and last up to a total of 24 months. Once the cooling-off ~~is~~ period has expired, the adversarial part of the proceedings begins.

The opponent is then allowed two more months to complete his file, i.e. to submit all evidence and observations he thinks necessary to make his case. After these two months, or once the submitted evidence and observations have been forwarded to him, the applicant has two months to reply to the opposition.

The Office may request the parties to limit their observations to particular issues, permitting observations on other issues at a later point in time.

The applicant has basically two possible ways to defend his application. He can question whether the earlier marks have been used by filing a request for

proof of use and he can file observations and evidence in order to convince the examiner that the opposition should fail.

If the applicant only files evidence and observations, the opponent is given two months to comment on the submissions of the applicant and after these exchanges the opposition is normally ready for decision.

The applicant can also request the opponent to prove that the earlier marks were used. The subsequent stage of the proceedings may be limited to that issue only and the issue of conflict may be addressed later.

The evidence of use submitted by the opponent is forwarded to the applicant, who will be given two months to comment. If he does so, his comments are forwarded to the opponent, who will consequently get an opportunity to file his final response.

In some other cases it may also be necessary or useful to have another exchange of observations. This can be when the case deals with complex issues or when the opponent raises a new point that is admitted to the proceedings. In this case the applicant must be given a possibility of replying. It is then up to the examiner to decide if another round should be given to the opponent.

Once the parties have filed their observations, the proceedings are closed the file is ready for taking a decision on substance.

## A. ADMISSIBILITY CHECK

### I. NOTICE OF OPPOSITION IN WRITING

Art. 41(1) (3) CTMR,  
R 16a CTMIR, R 17 (4) CTMIR  
Dec. N°EX-02-2 of 7/11/2002 as amended

The notice of opposition has to be received by the Office in written form within the opposition period.

The notice of opposition received by fax or mail is keyed into the database system (EUROMARC), and the opponent is sent a receipt. It is also possible to file electronic oppositions (see Decision ~~N° EX-02-2 of the President of the Office of 7 November 2002 concerning the electronic filing of Community trade marks applications and of opposition~~ [No EX-07-3 of the President of the Office of 16 July 2007 concerning electronic communications with and by the Office](#)). The electronic opposition form is collected by the system and introduced into EUROMARC.<sup>1</sup>

The applicant immediately receives a copy of the notice of opposition (and of any document submitted by the opposing party) for information.

### II. NOTIFICATION OF THE NOTICE OF OPPOSITION

R 16a CTMIR

Any notice of opposition and any document submitted by the opposing party, as well as any communication addressed to one of the parties by the Office prior to the commencement of the cooling-off period under Rule 18 CTMIR, shall be sent by the Office to the other party for the purposes of information .

Whenever the fax number of the opponent and applicant (or their representatives) is known, the Office usually notifies the opposition by fax. However, there are some exceptions to this rule. For example, if the opposition is based on an earlier trade mark registered or applied for in colour, the opposition will be notified to the applicant by mail.

The same applies, if for reasons of legibility the documents submitted by the opponent should not be sent by fax. In these cases an annotation in the file should be made.

Furthermore, if there are more than three oppositions against the same CTMA, the practice is to notify them by mail, to make it easier for the applicant to identify the different documents belonging to the different oppositions.

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<sup>1</sup> Amended on 29/02/2008

According to our current experience, the notification is usually not done before three weeks after the expiry of the opposition period, taking into account that most part of the oppositions are received within the last five days of the opposition period and that the service involved needs a minimum time to process the opposition. If the notice of opposition is filed at an early stage of the opposition period and the admissibility check is completed even before the expiry of the three-month period, the Office will however wait two or three weeks after the expiry of the opposition period to notify the opposition. This time is needed to check if other oppositions against the same CTM application have been filed.

### **III. PAYMENT**

For general rules on payments, refer to Part A of the Manual on General Provisions, Section 3 Payment of Fees and Costs, available on-line.

#### **1. Opposition notice late, payment within the opposition period**

##### **R 17(2) CTMIR**

If the payment was received by the Office within the opposition period but the notice of opposition was received late, the opposition is inadmissible. The Office keeps the opposition fee. The opponent must be notified and has two months to comment on the finding of inadmissibility.

If the opponent submits convincing arguments and evidence, the Office must reconsider its finding and accept the opposition as having been received within the opposition period. In this case the admissibility check can continue. If the arguments and evidence submitted by the opponent are not convincing or if the opponent does not reply within the two months, a decision ruling the opposition inadmissible has to be taken. When notifying the opponent of the decision, the applicant must be sent a copy.

#### **2. Time of payment**

The Office has to receive the full amount of the opposition fee within the opposition period (Art. 41 (3) CTMR).

If the opposition fee was received after the expiry of the opposition period but payment instructions to the bank had actually been given within the last ten days of the opposition period, under the terms of Article 8 FR the opposition can be saved if the opponent files evidence of having given payment instructions within the last ten days of the opposition period AND pays a surcharge of 10% of the opposition fee (double condition). This surcharge, however, shall not be payable if the person furnishes proof that the payment instructions to the bank have been given more than ten days before expiry of the period for payment. If the opposition fee has not been received within the

opposition period, or if the provision mentioned above does not apply, the notice of opposition is deemed not to have been entered (Rule 17 (1) CTMIR).

**Art. 8(1) FR, Art. 7(e) Dec EX-96-1, last amended by Dec. EX-03-3**

If the opponent or his representative hold a current account, the payment is considered effective on the day the opposition is received.

Since the payment is considered to have been made on the date of receipt of the opposition, if the notice of opposition arrived late, the payment is also late. Therefore, the opposition is deemed not to have been entered.

**Com 5/96 of 8.8.1996**

The system of current accounts is an automatic debiting system. That means that without any instructions and for all kinds of financial transactions such accounts may be debited by the Office.

The absence of an indication or incorrect indication of the amount of the opposition fee does not have any negative effect on the opposition, because it is clear that the opponent wanted to pay the amount of the opposition fee.

Even if there is no express request from the opponent, the existence of a current account would in such a case be sufficient in order for the account to be debited. This is true independently of the use of the opposition form or not.

The only exception to this rule is made when the holder of a current account who wishes to exclude the use of the current account for a particular fee or charge informs the Office thereof in writing.

**Fee by debiting a current account held by a third party:**

Payment of the opposition fee by debiting a current account held by a third party requires an explicit authorisation of the holder of the current account that his account can be debited for the benefit of the particular fee. In such cases it must be checked if there is an authorisation. If there is not, a letter is to be sent to the opponent asking him to submit the authorisation to debit the account held by a third party.

Once the authorisation has been received, it must be forwarded by mail to the Financial Department in order to allow the debiting. Payment is considered to be effected on the date the Office receives the authorization.

**3. Consequences in case of non-payment**

**R 17 (1) CTMIR**

An opposition for which the payment is not effected within the opposition period shall be deemed not to have been entered and this finding must be notified to the opponent.

**R 17 (4) CTMIR**

A copy of this letter must be sent to the applicant for information purposes at the same time.

If within the two-month period allowed the opponent provides evidence that the Office finding concerning the loss of rights was inaccurate, and he proves that the payment was made on time, a notification has to be sent with a copy to the applicant together with the evidence provided by the opponent.

**R 54 CTMIR**

An opponent has the right to request a decision within two months. If he does so, the decision must be sent to both parties.

**4. Fee refund**

**Art. 9(1) FR**

**R. 17 (1) CTMIR**

If an opposition is deemed as not entered and the opposition fee has not been paid in full or has been paid after the expiry of the opposition period, the amount paid must be refunded to the opponent.

The reimbursement of the opposition fee provided for in Rule 18 (5) CTMIR will include any surcharge paid by the opponent on the basis of Art. 8(3) FR.

**IV. LANGUAGES AND TRANSLATIONS OF THE NOTICE OF OPPOSITION<sup>2</sup>**

**Art. 119 (5), (6) CTMR,**

**R 16 , R 17 (3) CTMIR**

**R. 83 (3) CTMIR**

According to Article 119 (5) CTMR, the notice of opposition shall be filed in one of the languages of the Office. ~~If an opposition is filed in a language which is not one of the five languages of the Office, it is deemed not to have been entered and a notification is sent in the first language (if one of the Office) or the second language of the CTM application opposed.~~

~~Rule 83 (3) allows the use of forms in any languages of the Office. Therefore, it is acceptable to file a notice of opposition on any language version of the form provided that the form is completed in one of the languages of the Office. For example, an opposition form in Portuguese can be used if completed in Spanish. If not, a translation must be received by the Office within the~~

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<sup>2</sup> Complete Title IV. amended on 12/04/2010

~~opposition period of three months. Otherwise, the opposition will be deemed as not filed.~~

~~According to Article 119 (6) CTMR, the opposition has to be filed either in the second language of the contested application, which is always one of the languages of the Office, or, if both languages of the application are languages of the Office, in either of these two languages. If an opposition is filed in one of the languages of the Office that cannot be the language of the proceedings, the opponent will have to file a translation within one month from the expiry of the opposition period, on his own initiative.~~

~~If the opponent does not file the translation within the period of one month, the opposition is inadmissible. The opponent must be invited to comment prior to taking the decision on inadmissibility. The invitation and decision are copied to the applicant as a matter of principle.~~

~~R 17 (3) 2nd sentence CTMR~~

~~Incomplete translations:~~

~~When the translation submitted is incomplete, the part of the notice of opposition that has not been translated shall not be taken into account for the admissibility. (If the non translated part was not needed to make the opposition admissible, the translation must be filed with two months after the expiry of the Cooling-off period to be taken into account on its merits).~~

~~Language of the proceedings:~~

~~If the opponent must file on his own motion a translation into a language which is available as one of the proceedings, the language in which the translation will be filed will become the language of the proceedings, even if a different language has been indicated as language of proceedings in the notice of opposition.~~

~~Translation of forms:~~

~~If the form used to file the opposition is the standard form of the OHIM or is very much alike, the form itself does not need to be translated. When the notice of opposition is notified to the applicant, a blank OHIM form in the correct language must be attached to the OHIM form filed by the opponent (in our example, a blank Spanish form will be attached to the Portuguese opposition notice filed in Spanish). If the opponent uses a different form than the standard form, it will have to be fully translated into the language of proceedings.~~

~~Translation of textual elements:~~

~~All textual elements in a notice of opposition must be translated into the language of the proceedings. Names, addresses, numbers and dates cannot and need not be translated.~~

~~If an opposition is filed on an OHIM opposition form and only contains textual elements which cannot be translated such as names, dates etc., no translation is needed. Several situations can occur.~~

i. The text of the opposition is not in one of the languages of the Office, and the opposition form has not been used.

=> The opposition is inadmissible. Article 119(5) CTMR applies. A notification is sent in the first language (if one of the Office) or the second language of the CTM application opposed.

ii. The text of the opposition is in one of the languages of the Office but not in one of the possible languages of the proceedings, and the opposition form has not been used.

=> In accordance with Article 119(6) CTMR and Rule 16(1) CTM IR, the opponent shall of his own motion file a translation into the language of the proceedings within one month. If none is received the opposition is inadmissible.

iii. The opposition is in the language of the proceedings, and the opposition form has not been used.

=> The opposition complies with the language regime of the Regulations.

iv. The text of the opposition is not in one of the languages of the Office, and the opposition form has been used

=> If the textual elements important for the admissibility cannot be translated, eg. numbers, and all the appropriate boxes are ticked the opposition is admissible, even if it also contains textual parts that are in the wrong language such as an explanation of grounds. As an explanation of grounds is not obligatory at the admissibility stage, the fact that it is not in the right language does not affect the admissibility. It does not 'exist'.

=> It shall be verified if the opponent indicated the language of the proceedings.

- If not, and both the first and the second language of the CTMA are languages of the Office, the opponent will be asked to indicate the language of the proceedings.

- If not, and only one of the languages of the CTMA is a language of the Office, the language of proceedings can only be a language of the Office. When the opposition is notified, a blank form in the language of the proceedings must be annexed. The language of the language of the proceedings is indicated in the letter.

- If the language of the proceedings is correctly indicated, when the opposition is notified, a blank form in the language of the proceedings must be annexed.

**v.** The text of the opposition is in one of the languages of the Office but not in one of the possible languages of the proceedings, and the opposition form has been used.

=> If the textual elements important for the admissibility cannot be translated, eg. numbers, and all the appropriate boxes are ticked the opposition is admissible, even if it also contains textual parts that are in the wrong language such as an explanation of grounds. As an explanation of grounds is not obligatory at the admissibility stage, the fact that it is not in the right language does not affect the admissibility. It does not 'exist'.

=> It shall be verified if the opponent indicated the language of the proceedings.

- If not, and both the first and the second language of the CTMA are languages of the Office, a letter asking the opponent to indicate the language of the proceedings shall be sent. If no reply has been received in the two month period the opposition must be rejected as inadmissible.

- If not, and only one of the languages of the CTMA is a language of the Office, there is no need to ask for the language of the proceedings, as this can only be a language of the Office. When the opposition is notified, a blank form in the language of the proceedings must be annexed. The language of the language of the proceedings is indicated in the letter.

- If the language of the proceedings is correctly indicated, when the opposition is notified, a blank form in the language of the proceedings must be annexed.

**vi.** The opposition is in the language of the proceedings, and the opposition form has been used.

=> The opposition complies with the language regime of the Regulations.

Examples:

a) The languages of the CTMA are PT and EN. The Portuguese language version of the form has been sent, but none of the textual elements relevant for admissibility can be translated, and the appropriate boxes are ticked. The opposition is admissible. As the language of proceedings can only be EN, it is not necessary to ask the opponent to indicate the language of the opposition.

When the opposition is notified a blank form in EN must be attached, and the language of the proceedings indicated.

b) The languages of the CTMA are DE and EN. The French language version of the form has been sent, but either the opposition is filled in French or none of the textual elements can be translated, and the appropriate boxes are ticked. The opposition is admissible. As the language of proceedings can be either DE or EN, the opponent must be asked to indicate the language of the opposition. When the opposition is notified a blank form in the indicated language must be attached.

The list of goods and services has a special regime (see hereafter).

Explanation of grounds: when one of the boxes concerning grounds is ticked and additionally an explanation of facts or arguments is furnished, this explanation or indications like “see annex”, “see attachment”, “will be provided later” do not need to be translated at the admissibility stage. These must be furnished later after expiry of the cooling-off period.

## V. ADMISSIBILITY CHECK

**Art. 75 CTMR, R 17(2)(4) CTMIR**

The admissibility check comprises both the absolute and the relative requirements:

- The indications and elements that must be present in the notice of opposition or furnished by the opponent on his own initiative within the opposition period are those laid down in Rule 15 (1), (2) (a)-(c);
- the indications and elements which, if they are not furnished within the opposition period, trigger a deficiency notice by the Office allowing the opponent to remedy this within a non-extendible period of two months are those laid down in Rule 15 (2) (d)- (h);
- optional indications (that determine the scope of the opposition but do not lead to a finding of non-admissibility) are laid down in Rule 15 (3).

### 1. Absolute admissibility requirements

#### 1.1. Identification of the contested CTMA

**R 15(2)(a), R17(2) CTMIR**

The mandatory elements for identifying the contested CTMA are the application number and the name of the applicant.

If, for example,<sup>3</sup> the indicated application number does not correspond to the indicated name of the applicant, the examiner will decide if it can be

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<sup>3</sup> Amended on 16/07/2009

established without any doubt which is the contested CTMA. If the applicant's name is not indicated, it can be found in EUROMARC.

The date of publication is an optional indication, which helps to double-check the identification of the CTMA. Even if it is missing, the CTMA can be sufficiently identified through the other indications.

Only one CTMA can be contested in one notice of opposition.

If the CTMA cannot be identified, this deficiency can only be remedied on the opponent's initiative during the three-month opposition period, otherwise the opposition is inadmissible and an invitation to comment on inadmissibility has to be sent. If inadmissibility is confirmed, a decision rejecting the opposition is sent and copied to the applicant.

### 1.2. Identification of the earlier marks/rights

**R 15(2)(b), R 17(2) CTMIR, Art. 8(2) CTMR**

Each earlier mark/right has to be examined to see if ~~it~~ **one** is clearly identified. ~~If one of them is not duly identified, both the opponent and the applicant must be informed that this mark or right will not be taken into account. If it concerns the only earlier right on which the opposition is based, the opposition is inadmissible and the opponent is invited to comment on inadmissibility before the decision on inadmissibility is taken. If the opposition is based on more than one earlier right and one of them has been correctly identified, the opposition is partially inadmissible.~~ **the only earlier right on which the opposition is based is not duly identified, the opposition is inadmissible and the opponent is invited to comment on inadmissibility before the decision on inadmissibility is taken. If the opposition is based on more than one earlier right and one of them has been correctly identified, the examination of admissibility (relative requirements) can proceed based on that earlier right.** The parties are informed thereof when the notification of the time limits of the opposition proceedings is sent to the parties.<sup>4</sup>

Identification elements are to be looked for not only in the notice of opposition, but also in annexes or other documents filed together with the opposition. If the **only** claimed earlier right is in fact not earlier, this is a matter of substance (leading to a decision of rejection of an admissible opposition) and not of admissibility itself. The examination of admissibility must proceed as normal and only at the time of notification of the admissibility, it will be pointed out to the opponent that the earlier right appears not to be earlier.<sup>5</sup>

An opposition can be based on six types of earlier rights: earlier trade mark registrations or applications (1), earlier trade mark registrations or applications with a reputation (2), earlier well-known marks (3), agents' mark (4) and

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<sup>4</sup> Amended on 29/02/2008

<sup>5</sup> Amended on 29/02/2008

earlier unregistered trade marks (5) and earlier signs used in the course of trade (6).

*1.2.1. Earlier trade mark registrations or applications*

Art. 8(2)(a),(b) CTMR  
R. 15 (2) (b) (CTMIR)

These rights are Community trade mark registrations or applications, international registrations designating the European Community, national or Benelux trade mark registrations or applications (including “ex Community trade marks” for which a request for conversion has been filed) and international registrations under the Madrid Agreement or Protocol having effect in a Member State.

The seniority claimed in a CTM can be taken into account within the meaning of Article 8 (2) (a) CTMR provided that the proprietor of the CTM has surrendered the earlier mark or allowed it to lapse within the meaning of Article 34 (2) CTMR and that this fact is proved by the opponent.<sup>6</sup>

The absolute identification elements for these marks are:

- The registration/application number.

National applications deriving from the conversion of an earlier CTM(A) are considered to come into existence as soon as a valid conversion request is filed. Such rights will be properly identified for admissibility purposes under Rule 17(2) CTMIR if the opponent indicates the number of the CTM(A) under conversion and the countries for which he has requested the conversion.

- The indication whether the earlier mark is registered or applied for.

- The Member State including the Benelux where the earlier mark is registered/applied for or if applicable the indication that it is a CTM.

If the Member State is not indicated in the opposition notice but a certificate is attached, it is considered that the Member State is sufficiently identified, even if the certificate is not in the language of the proceedings. A translation of the certificate should not be asked for at this stage in the proceedings (Rule 19 (3) CTMIR). If it concerns a certificate of an International Registration it is assumed that the opposition is based on this mark in all the Member States and/or the Benelux countries indicated in the certificate.

*1.2.2. Earlier trade mark registrations or applications with a reputation*

Art. 8(5) CTMR, R 15(2)(c) CTMIR

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<sup>6</sup> Amended on 3/02/2009

Under Article 8 (5) an opposition can be based on a mark with reputation, invoked against goods and services that are dissimilar. The mark with a reputation can be a CTM or a national mark or an international registration, but it must necessarily be a registered mark.

The same identification requirements apply as for registered marks invoked under Article 8 (1) (b) CTMR: number and State /region of protection, (the indication where and for which goods/services the mark is reputed is a relative admissibility requirement, Rule 15 (2) (g))

### 1.2.3. *Agent's mark*

Art. 8(3) CTMR, R 15(2)(b)(i) CTMIR

An agent's mark is a mark for which the opponent claims that the applicant who has or had a business relationship with him (his agent or his representative) applied for this mark without his consent. It must be identified according to the same criteria as earlier trade marks registrations or applications. That is, the country and registration number must be given. Only if the earlier mark of the proprietor is an unregistered mark, the representation of the mark must be given because in that case, no registration number can be provided in order to clearly identify the earlier mark. For word marks, this is the indication of the word that makes up the mark. For figurative or other marks, the representation of the mark as it is used and claimed by the proprietor must be furnished.

### 1.2.4. *Earlier well known mark*

Article 8 (2) (c) CTMR protects well-known marks within the meaning of Article 6 bis of the Paris Convention. This can be a registered mark or a mark which in the territory it is to be protected is not registered (irrespective of its registration in the territory of origin).

The absolute indications elements are:

R 15(2)(b) (i), (ii), R 17(2) CTMIR

- An indication of the Member State where the mark is well known: if this indication cannot be deduced from the documents on file, the mark is inadmissible as a basis for opposition.
- If the mark is a registered mark, the indications referred to in Rule 15 (2) (b) (i), i.e. the registration number and the Member State where the mark is registered.
- If the mark is not registered, a representation of the mark. For word marks, this is the indication of the word that makes up the mark. For figurative or other marks, the representation of the mark as it is used and claimed to be well-known must be furnished. [Where the opposition is furthermore based on one registered trade mark, but no representation of the well-known mark is given, the Office assumes that both trade marks refer to the same sign and](#)

that the opponent claims the registered mark to be well known (R0160/2007-1 QUART/Quarto).<sup>7</sup>

### 1.2.5. *Earlier non-registered marks and earlier sign used in the course of trade*

#### Article 8(4) CTMR

This category consists of signs that are unregistered and used as trade marks or of a great number of different earlier rights, among others rights to a company name, trade name, business sign, ensigns, titles of protected literary/artistic work and the right to a sign under passing off.

The absolute indications elements are:

#### R 15(2)(b)(iii), R 17(2) CTMIR

- An indication of the kind or nature of the right. The nature of the right determines the scope of the opposition and the applicant's defence depends on it. "Trade name", "company name", "business sign", "passing-off", "titles of protected literary/artistic work" are acceptable indications of the nature of rights. On the contrary, general terms such as "common law" and "unfair competition" without an indication of the specific nature of the right are not accepted. This list is not exhaustive. If the opponent bases his opposition on a right that cannot be an earlier right under 8(4) CTMR, e.g. a copyright or a design, the opposition is admissible. However, after the proceedings have commenced the opposition will be rejected on substance.
- An indication of the Member State where the right is claimed to exist: if this indication cannot be deduced from the documents on file, the mark is inadmissible as an opposition basis.
- A representation of the earlier right. If the owner of an earlier right does not provide a representation of his right within the opposition period, this right will be inadmissible as a basis for opposition.

### 1.3. *Identification of grounds*

#### Art. 41(3), Art. 75 CTMR, R 15(2)(c), R 17 (2) CTMIR

An opposition without any indication of grounds in accordance with Rule 15 (2) (c) is inadmissible if this deficiency is not remedied before the expiry of the opposition period.

The specification of the grounds should consist in a statement to the effect that the respective requirements under Article 8 (1) (3) (4) and (5) CTMR are fulfilled. ~~This is to be distinguished clearly from furnishing further facts and evidence which is voluntary at this point in proceedings.~~<sup>8</sup>

~~In particular, the grounds are to be considered as properly indicated if one of the relevant boxes in the opposition form is checked. If not, before rejecting the opposition, a careful assessment of the entire notice of opposition must be~~

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<sup>7</sup> Amended on 18/11/2008

<sup>8</sup> Amended on 18/11/2008

~~made: it does not matter whether the grounds are indicated in the opposition form, its annexes or its supporting documents. The grounds must be unequivocally clear. If it is possible to deduce the grounds from the notice of opposition without any doubt, the opposition is admissible.<sup>9</sup>~~

In particular, the grounds are to be considered as properly indicated if:

- one of the relevant boxes in the opposition form is checked.
- the relevant box is not checked, but the earlier mark is identified and the opposition can be considered to be based on Art. 8(1)

In both cases it is possible to deduce the grounds from the notice of opposition without any doubt and the opposition is admissible.

If not, before rejecting the opposition, a careful assessment of the entire notice of opposition must be made: it does not matter whether the grounds are indicated in the opposition form, its annexes or its supporting documents. The grounds must be unequivocally clear.

In, all other cases, the opponent has to be invited to present comments on inadmissibility before taking the decision rejecting the opposition.<sup>10</sup>

## 2. Relative admissibility requirements

**R 15(2)(d)-(h) CTMIR**

The relative deficiencies are those that can be remedied after the expiry of the opposition period. The Office invites the opponent to remedy the deficiency within two months from the receipt of the notification of these deficiencies. If the opponent remedies the deficiencies, the opposition is considered admissible; if not, it will be rejected on the grounds of inadmissibility.

### 2.1. Dates

**R 15(2)(d), R 17(4) CTMIR**

- The filing date and, where available, the registration date and the priority date of the earlier mark.

This requirement applies to the following rights:

- earlier Community or national or international trade mark application or registration invoked under Article 8 (1) (a) or (b),
- earlier well-known mark invoked under Article 8 (2) (c), if it is registered in the Community,
- earlier mark under Article 8 (3) if it is registered,.
- earlier mark with a reputation invoked under Article 8 (5).

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<sup>9</sup> Amended on 18/11/2008

<sup>10</sup> Amended on 18/11/2008

These indications can be important in order to be able to eliminate possible errors when identifying the earlier mark. It is sufficient that these elements can be found in enclosed documents or by searching in a data base. If these elements are lacking the opponent must be notified of the deficiency.

## 2.2. Representation of earlier mark/sign

### **R 15(2)(e), R 17(4) CTMIR**

For rights that are not subject to registration this is an absolute admissibility requirement as otherwise the earlier right cannot be determined at all (see above).

The relative admissibility requirement to furnish a representation of the mark under Rule 15 (2) (e) applies to the following rights:

- earlier national or international trade mark application or registration invoked under Article 8 (1) (a) or (b),
- earlier well-known mark invoked under Article 8 (2) (c), if it is registered in the Community,
- earlier mark with a reputation invoked under Article 8 (5),
- mark filed by an agent (Article 8 (3) , if it is a registered mark).

If the earlier mark is a CTM, it is not requested to file a representation and the Office will make it available from its databases.

If the mark is a word mark, indication of the word is sufficient.

If the mark is a figurative, 3-D, other mark, etc. a representation of the mark as applied for or registered must be filed, in colour if applicable.

If the proper representation has not been enclosed in the opposition notice, the deficiency has to be notified as soon as the Office becomes aware of it. If the opponent does not comply within the 2 months time limit given, the earlier right will be rejected as inadmissible.

### **R15 (2)(e) CTMIR**

A colour representation of the mark is not compulsory if the national mark was not published (for technical reasons) in colour, as is the practice, for example, in Cyprus, Latvia, ~~Lithuania~~<sup>11</sup> and Hungary. In these cases we neither ask for a colour representation nor request the opponent to file a translation of the colour indications.<sup>12</sup>

The following countries have either always published in colour or do so in the meantime:<sup>13</sup>

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<sup>11</sup> Amended on 6/10/2010

<sup>12</sup> Amended on 3/06/2009

<sup>13</sup> Amended on 3/06/2009

Belgium, Bulgaria, Czech Republic (1999), Denmark, Germany, Estonia (2003), Ireland (2003), Greece (2007), Spain (1998) (as of 31/07/2002)<sup>14</sup>, France (1992), Italy, Lithuania (as of July 2009),<sup>15</sup> Luxembourg, Malta, Netherlands, Austria, Poland (2003), Portugal (2006), Romania, Slovenia (1992), Slovakia (2008), Finland (2005), Sweden, United Kingdom (2004).<sup>16</sup>

International Marks are published in colour since 1989.<sup>17</sup>

**R 80(2), R 17(4) CTMIR**

If the representation on file is not clear, the Office may ask for a clearer one. If the representation that is received is incomplete or illegible and the request to provide a clear one is not complied with, the representation will be deemed not to have been received and the right will be rejected as inadmissible.

2.3. *Goods and services*

**R 15 (2) (f), R 17(4) CTMIR**

The notice of opposition shall contain an indication of the goods and services on which the opposition is based in the language of the proceedings. This applies to all types of earlier rights.

For registered marks, this can be all the goods and services for which it is registered, or only some of the goods and services.

~~Preferably these goods should be listed.~~ If the goods and services on which the opposition is based is less than the goods and services for which the mark is registered, those other goods and services need not be indicated, as they are irrelevant for the proceedings.<sup>18</sup>

Instead of listing those goods and services in the opposition form, the opponent may refer to “all goods and services for which the earlier mark is registered”, provided, that the registration certificate is attached and is written in or translated into the language of the proceedings **or to the class numbers. The indication of the class number(s) is considered as a sufficient indication of the goods and services.**<sup>19</sup>

Even if the opponent has not indicated, or has not clearly indicated, on which goods and/or services he bases his opposition, it suffices when a registration certificate in the language of the proceedings is attached; it is then assumed that the opposition is based on those goods and services that appear in the certificate.

However, if the certificate is in a language other than the language of the proceedings, the deficiency must be notified.

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<sup>14</sup> Amended on 20/01/2010

<sup>15</sup> Amended on 6/10/2010

<sup>16</sup> Amended on 3/06/2009

<sup>17</sup> Amended on 16/09/2009

<sup>18</sup> Amended on 29/02/2008

<sup>19</sup> Amended on 29/02/2008

If an opposition is based on “all identical / similar goods and services”, clarification must be requested since this wording is not sufficiently clear to identify the basis of the opposition.

If an indication like “the opposition is based on all the goods in class 9” is used and no certificate in the language of the proceedings is attached, the Office will require a specification in the language of the proceedings.

Only when the opponent replies that he owns a registration with a description that mentions that the sign is registered for “all goods in class 9” this is acceptable.

For oppositions based on earlier unregistered trade marks or rights, the opponent must indicate the commercial activities in the course of which they are used.

#### 2.4. *Earlier-mark with a reputation: scope of reputation*

##### R 15 (2)(g) CTMIR

A specific requirement applies to marks with a reputation within the meaning of Article 8(5) CTMR: An indication of the Member State in which, and the goods and services for which, the mark has a reputation must be provided.

#### 2.5. *Identification of the opponent*

##### Art. 41(1) CTMR, R 15(2)(h)(i) CTMIR

The opponent can either be a natural or legal person. In order to be able to identify the opponent, there must be an indication of his name and address in accordance with Rule 1(1) (b).

Until now there have been no oppositions where the opponent was not identified. If only the name of the opponent and for example a fax number is indicated, the opponent must be asked to give the particulars of his address.

When examining if the opponent is clearly identified, attention should be given to the nature of the opponent, i.e. natural or legal person. If it is unclear whether the opponent is a natural or a legal person, or when the type of legal person (for example GmbH, KG, SA, Ltd) is not indicated the deficiency must be notified.

##### R 15(2)(h)(iii) CTMIR

Entitlement:

It is assumed that the opponent claims to be the owner of the earlier right, unless otherwise stated. Only if the opponent acts in the capacity of an authorised licensee or a person authorised under national law, does he have to make a statement to that effect, and he has to specify on which basis he is so entitled or authorised. If those details are not given, a deficiency must be notified.

In accordance with Rule 15 (2) (h) (i) an opponent who acts as a licensee or authorised person has to indicate his name and address in accordance with Rule 1 (1) (b).

- If the notice of opposition is based on the grounds of Article 8(1) or 8(5) CTMR and thus on trade mark registrations or applications, notice of opposition may be filed by the owner and by the licensees of these registrations or applications, provided they are authorised by the owner.

- If the notice of opposition is based on the grounds of Article 8(3) CTMR (an agent's trade mark), it may be filed by the owner of that trade mark.

- If the notice of opposition is based on the grounds of Article 8(4) CTMR (earlier marks or signs), it may be filed by the owner of that earlier mark or sign and by persons authorised under the relevant national law to exercise the rights to the earlier mark or sign.

As long as the opponent claims to own a right or registration in one of the Member States of the European Union, he is entitled to file an opposition, irrespective of his country of origin.

#### 2.5.1. *Change of owner (transfer of earlier mark) before the opposition is filed*

Where the earlier mark has been transferred before the opposition is filed, a distinction has to be made between oppositions based on an earlier CTM and oppositions based on national trade mark registrations (or applications).

#### 2.5.2. *Oppositions based on an earlier CTM*

Art. 17(6), (7) CTMR, R 15(2)(h)(iii) CTMIR

An opposition based on Community registrations or applications may be entered by the successor in title of a CTM only if the conditions set out in Article 17(6) of the CTMR are met, namely, only if the opponent has filed a request for the registration of the transfer when the opposition is filed. According to Article 17(7) CTMR, where there are time limits to be observed *vis-à-vis* the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office. ~~In the absence of such a request, the opposition is inadmissible.~~<sup>20</sup>

It is up to the opponent to provide this information, and it will not be checked by the examiner when doing the admissibility check. Only when the opponent in the explanation of his opposition mentions that he is the new owner (or similar terms), the opponent must be requested to indicate the date the request for registration of the transfer (was sent to or) received by the Office.

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<sup>20</sup> Amended on 03/06/2009

*2.5.3. Opposition based on a national registration or application:*

An opposition based on a national registration or application may be entered by the 'old' owner or by the successor in title, as there are different practices in the different Member States on the necessity of registration of the transfer in the national trade mark register in order to be able to claim rights arising from the registration.

In some cases the opposition is filed by opponent A whereas, after a transfer of the earlier mark on which the opposition is based, the mark is owned by B. As A may still appear in the relevant register as the owner, the Office nevertheless accepts the opposition as valid with A as opponent, even though he is no longer the owner of the earlier mark.

If the opposition is filed with B as opponent and a copy of the registration certificate shows A as owner of the earlier mark, the opposition is accepted as admissible on the assumption that the earlier mark was transferred to B before the opposition was filed. (Or, if so indicated in the notice of opposition that he opposes in his capacity as licensee.)

*2.5.4. Multiple opponents:*

R 15(1), R 75(1) CTMIR, BoA, Emultech R 623/1999-1

In some case there is more than one opponent indicated in the notice of opposition. There are only two situations in which the Office accepts two or more separate persons (either natural or legal) as multiple opponents, namely:

- if they are co-owners of the earlier mark or right;
- if the opposition is filed by the owner or co-owner of an earlier mark or right together with one or more licensees of these earlier marks/rights.

If there is no indication that the multiple opponents fulfil one of the two requirements mentioned above, they are to be asked to indicate their relationship (co-ownership or owner/licensee) or to indicate one of the multiple opponents as the only opponent.

If an earlier mark and/or an earlier right has more than one proprietor (co-ownership), the opposition may be filed by any or all of them.

However, if the opponents inform the Office that, for example, Company A B.V. owns five of the earlier rights and Company A PLC another five, they will have to indicate with whom the opposition will continue. As a consequence, five out of the ten earlier rights will not be taken into account. If the opponents do not respond appropriately within the two-month period set, the opposition will be rejected as inadmissible.

Acceptable

Earlier trade marks	1	2	3	4	5
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Owner	A/B	A	A	A	A
Earlier trade marks	1	2	3	4	5
Owner	A/B	A/C	A	A	A

The second combination is acceptable only if at least A is one of the opponents.

Not acceptable

Earlier trade marks	1	2	3	4	5
Owner	A	A	B	B	B

The opponents will have to be asked to indicate if they want to continue the proceedings with A or B as an opponent.

Earlier trade marks	1	2	3	4	5
Owner	A/B	A	A	B	B

The opponents will have to be asked to continue the opposition either as multiple opponents based on the first three earlier trade marks or as multiple opponents based on the first, fourth and fifth earlier trade marks.

Earlier trade marks	1	2	3	4	5
Owner	A/B/C	B/C	A	A	A

The opponents will have to be asked to continue the opposition either as multiple opponents B and C based on the first and the second earlier trade marks or as multiple opponents A and B based on the first, third, fourth and fifth earlier trade marks.

Indication of relationships other than co-ownership

Where two opponents are mentioned in the notice of opposition, one as owner of the earlier right, and another as licensee (authorised by the owner to file opposition), no objections will be raised if the owner of all earlier rights on which the opposition is based is the same legal or natural person, regardless of how many licensees join him in the case.

In the following example the opposition is acceptable with A, B and C as multiple opponents:

Earlier trade marks	1	2	3
Owner	A	A	A
Licensees	B	C	None

On the contrary, in the following case, although B is accepted as a multiple opponent as licensee for earlier mark 1, he cannot be accepted as a multiple opponent as owner of earlier mark 3. The Office will ask the opponents to

indicate if they want to continue the opposition with A or with B as an opponent. If the opponents do not reply, the opposition is inadmissible.

Earlier trade marks	1	2	3
Owner	A	A	B
Licensees	B	C	A

Evidence:

In cases where the opposition is based on earlier registered marks the most common means to furnish evidence of co-ownership is to submit a copy of the registration certificate. If the opposition is based on several earlier marks/rights but the opponents have already filed evidence of co-ownership of one earlier registered mark, the opponents will still be required to confirm the ownership of the other earlier rights. As at this stage of the opposition proceedings the opponents are not obliged to file evidence of their earlier marks/rights, a statement confirming their capacity to file an opposition together will be considered sufficient for admissibility purposes.

## 2.6. Professional Representation

**Art 92, 93 CTMR**

**R. 15(2)(h)(ii) CTMIR**

Representative:

Rule 15 (2) (h) (ii) provides that if the opponent has designated a representative, he must provide his name and business address in accordance with Rule (1)(1)(e).

If the opponent is from the EC (not obliged to be represented under Article 92), failure to appoint a representative, or failure to indicate the name or business address of the representative, merely has the consequence that the Office will communicate with the opponent directly.

If the opponent is obliged to be represented under Article 92, failure to appoint a representative, or failure to indicate the name or business address of the representative, constitutes a relative admissibility deficiency. The Office will invite him to appoint a representative and/or to indicate the name and address, failing which the opposition will be rejected as inadmissible.

**R 77 CTMIR**

Any notification of the Office sent to the duly authorised representative has the same effect as if it had been addressed to the represented person.

Any notification or letter of the duly authorised representative sent to the Office has the same effect as if it originated from the represented person.

**R 75 CTMIR**

Multiple representatives, common representative

It is possible for each party to have more than one representative who may act either jointly or separately. There is no fixed maximum number of representatives.

The Office, however, will communicate only with the first named representative. If there is more than one opponent and the notice of opposition does not name a common representative, the opponent first named in the opposition notice shall be considered to be the common representative.

However, if one of the opponents is obliged to appoint a representative (because he is from outside the European Union), such representative shall be considered to be the common representative, unless the opponent first named in the opposition notice has appointed a representative.

#### **R 76(8) CTMIR**

Where there is more than one opponent/applicant, the representative of the person named first shall be the common representative of all these persons. If the person first named has not appointed a representative and one of those persons is obliged to appoint a representative and has done so, such representative shall be considered to be the common representative for all these persons.

#### ***Change of representative***

#### **R 76 CTMIR**

During the oppositions proceedings the opponent's and the applicant's representative may change.

#### ***Authorization***

#### **Article 92(2) CTMR**

#### **R 76 CTMIR**

Where there are several parties to the proceedings in which a representative acts before the Office, representatives shall file a signed authorisation for entry into the file, either as an individual or as a general authorisation, only if the other party expressly asks for it. When it is required that a signed authorization shall be filed, the Office shall specify a time limit within which such an authorization shall be filed.

Details on representation and authorizations are set out in the Manual for Proceedings before the Office.

#### **2.7. *Signature***

#### **R 80 CTMIR**

An opposition notice sent by fax or by mail must be signed by the opponent or, if it is submitted by a representative, by the representative.  
An opposition notice sent by electronic communication needs not be signed and it is sufficient that the name of the sender is indicated (Rule 80 (3)).

**2.8. Relative admissibility requirements: sanctions**

**R 17(4) CTMIR**

If relative admissibility requirements are missing or not complied with the opponent or his representative is given two months to remedy. This time limit cannot be extended.

If the deficiency is not remedied in time, the opposition must be rejected as inadmissible or if the deficiency concerns part of the earlier rights, the opponent shall be notified that the opposition is admissible but that the earlier rights concerned cannot be taken into account.

**3. Optional indications**

**3.1. Extent of the opposition:**

**R 15(3)(a) CTMIR**

The opposition may contain an indication of the goods and services against which the opposition is directed; in the absence of such an indication, the opposition shall be considered to be directed against all of the goods and services of the opposed CTM application.

If the opponent indicates that the opposition is only directed against part of the goods and services of the CTM application, he will have to clearly identify these goods. If he does not do so, either in the notice of opposition or in the explanation, he must be notified of the deficiency. If the deficiency is not remedied within the deadline given, the opposition will be rejected as inadmissible.

There are cases where, in reply to our letter asking him to identify exactly which of the goods and services he opposes, the opponent indicates “all the goods and services which the CTM application is applied for”. In such cases, we cannot accept this indication as valid. This is because by indicating that the opposition is directed only against part of the goods and services of the CTM application, the opponent has clearly limited his opposition in this respect and cannot extend its scope after the opposition period of three months. In these rare cases, we send a second letter to the opponent explaining this legal situation and giving two further months for filing an indication which does not contain all the goods and services. If the opponent does not respond appropriately to this request, the opposition will be rejected as inadmissible.

The extent of the opposition is correctly indicated where the goods are specific goods encompassed by a broader term used in the contested

specification (e.g. opposition directed against trousers and the CTM application is filed for clothing). However, when the opponent uses ambiguous wording like “the opposition is directed against all goods similar to ...”, when the opponent’s goods are substituted for applicant’s goods, or any other indication that does not clearly identify the contested goods and services, a clarification must be requested. If the opponent does not respond appropriately to this request, the opposition will be rejected as inadmissible.

### 3.2. Reasoned statement

#### **R 15 (3) (b) CTMIR**

It is now clear from the wording of Rule 15 that one must distinguish

- the basis of the opposition, i.e. the earlier right invoked; it must be properly identified but can never be changed after expiry of the opposition period;
- the indication of the grounds of the opposition, i.e. “likelihood of confusion” (Rule 15 (2) (c), using the term “namely”),
- and a reasoned statement, i.e. any indication of arguments, facts or evidence in support of the opposition.

“Reasoned statement” includes proof of the existence of the earlier right, which (unlike the identification of the earlier right) is a matter of substance rather than admissibility.

The reasoned statement is optional (Rule 15 (3) (b)) at the stage of filing of the opposition, it has nothing to do with the admissibility check. It is acceptable if it is included in the opposition but otherwise it will have to be furnished after expiry of the cooling-off period (Rule 19 (1)) and concerns the substance, not the admissibility, of the opposition.

## **B. COOLING-OFF PERIOD (COP)**

### **I. SETTING THE COP IN MOTION**

#### **R 18 (1) CTMIR**

When the opposition is found admissible pursuant to Rule 17, the Office sends a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication (two months given for “cooling off” before the proceedings officially start with some legal consequences as regards fees in particular).

#### **R 19 CTMIR**

The notification of admissibility to the opponent includes an annex that advises him about the nature of the information he should submit to the Office to substantiate the earlier rights that he claims.

The cooling-off period will be set to expire two months from the notification. The exact day of the expiry is indicated. This day will always be two months from the notification date, even if this is a day on which the Office is not open, e.g. a Saturday or Sunday.

#### **R 18 (1) CTMIR**

#### **Com. N°1/06 of 2/2/2006**

The period of the cooling-off may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires. The Office will grant an extension of 22 months, irrespective of what length of the extension is requested.

It is not possible to circumvent the limitation of the cooling-off period to 24 months by requesting a suspension (Rule 20 (7) CTMIR). When the parties invoke ongoing negotiations, the proceedings will not be suspended during the cooling-off but a request for such a suspension may be made after the expiry of the cooling-off period.

The opponent will be given a period of two months after the expiry of the cooling-off period to submit facts, evidence or arguments in accordance with Rule 19 CTMIR, irrespective of whether he has already submitted such facts, evidence or arguments in the notice of opposition.

Within the same period, the opponent shall also file the proof of the existence and continuous validity of the earlier right (Rule 19 (2) CTMIR).

The request to the opponent is a general invitation to complete the file within the meaning of Rule 19 CTMIR. The Office will not indicate the nature and type of the material necessary for a completion of the file (see expressly Rule 20 (6), 2<sup>nd</sup> sentence CTMIR). Rather, it will be for the opponent to decide what

he wishes to submit. In order to facilitate the task of opponents, the Office has prepared a list that enumerates the type of evidence generally required, depending on the nature of each right. This list may be referred to by opponents as a check-list in preparing their oppositions.

**R 18(1)(2), 20(2) CTMIR**

In practice, the period for submitting such additional material will be set at four months from the date of notification. Therefore, opponents should be aware that the period for submitting such additional material is not a period of two months beginning after the cooling-off period has expired, but a period of four months from the notification. The difference will be of significance when the cooling-off period itself expires on a day when the Office is not open.

The applicant will be given an additional period of two months for replying to the opposition in accordance with Rule 20(2). Rather than setting a separate period of two months (two months for the cooling-off period, two months for completing the opposition, two months for replying), the period for replying to the opposition will be set at six months from the day of the start of the cooling-off period.

When the opponent completes his opposition any time after the notification and before the expiry of the four months available to him, the additional material will be forwarded to the applicant without any change in the period available for responding to the opposition. However, if the additional material arrives at the Office without sufficient time to forward it to the applicant within the period set for the opponent, the additional material will then be forwarded to the applicant together with the setting of a new time limit of two months for replying to the opposition. This separately set two-month period will run from the date of the receipt of the notification of the additional material in order to ensure that the applicant always has a full period of two months for preparing his reply.

## **II. EXTENSION OF THE COOLING OFF PERIOD**

**R 18(1), 96(1) CTMIR, Art. 119(5, 6) CTMR**

To extend the cooling-off period the following is necessary:

- A signed request from both parties. It may either take the form of two separate requests or one joint request. It is not necessary to state a reason for the extension.
- In the language of the proceedings. A translation can be filed within one month of filing. The Office does not send any letter requesting a translation of the request for extension.
- Request filed on or before the expiry of the cooling-off period. Any request filed after the expiry of the cooling-off period will have to be rejected. If one

party files the request within, but the other after expiry of the cooling-off period, the extension is also to be refused.

However, if it is clear that the parties meant to ask for an extension of a time limit or a suspension of the proceedings, it may be interpreted and accepted as such.

Priority has to be given to answering requests for extension of the cooling-off period. The parties should be informed as soon as possible whether or not the Office has accepted their request. If the request is to be refused, it must be notified immediately. The time limits fixed will then remain unchanged.

If an extension of the cooling-off period is refused, the parties can always ask for an extension of a time limit or for a suspension of the proceedings.

The extension is granted until a period of 24 months to be counted from the date of the start of the cooling-off period. This new procedure avoids multiple extensions and at the same time leaves parties maximum freedom to decide when they want to continue with the adversarial stage of the proceedings, (see Communication No 1/06 of the President of the Office of 2 February 2006).

Any party can then bring the cooling-off period to an end, by simply addressing a letter to the Office stating “I want the cooling-off period to finish” or “I want the proceedings to enter the adversarial stage”.

It is immaterial whether the other party agrees with this or has consented to it.

When one of the parties opts out before expiry of the extended cooling off period, the Office will confirm this to both parties and set the cooling off period to expire two weeks after said notification. The adversarial part of the proceedings will commence the day after. In the same notification new deadlines are notified for the substantiation of the opposition and the reply of the applicant, which shall be 2 and 4 months from the date of that letter.

Opting out is irrevocable. Opting out during the last month before commencement of the proceedings will not be accepted.

### **III. SUSPENSION**

**R 20(7), R 21(2) CTMIR**

According to Rule 20(7)(a), the Office “may” suspend opposition proceedings where the opposition is based on a CTM application or national trade mark application until a final decision is taken. Therefore, the question of suspension in these cases is always a discretionary decision of the examiner in charge of the opposition.

Opposition proceedings can be suspended on request of one of the parties before commencement of the adversarial part of the proceedings, and even during the cooling-off period on the grounds mentioned in Rule 20 (7) (a) and (b). However, during the cooling-off period, they cannot be suspended on the grounds that negotiations take place. It is exactly the purpose of the cooling-off period to open a time frame for negotiations before the adversarial stage begins.

When the proceedings is to be suspended, this will preferably be done when the admissibility of the opposition is notified in order to “save” the cooling-off period for the time after the proceedings are resumed.

~~If a request for a second suspension is sent and the Office grants it, it will automatically be for a period of one year, giving the parties the possibility to opt out. The process for opting out is the same as for the extension of the cooling-off period: if one of the parties opts out, the suspension will end 14 days after informing the parties thereof. The proceedings will resume the day after. In case a time limit was running at the moment of the suspension, the party concerned will be given 2 months to submit observations.<sup>24</sup>~~

In cases of suspensions requested by both parties (whenever they are possible), and regardless the period requested by the parties, the first request will be given for a period of one year giving the parties the possibility to opt out. The process for opting out is the same as for the extension of the cooling-off period: if one of the parties opts out, the suspension will end 14 days after informing the parties thereof. The proceedings will resume the day after. In case a time limit was running at the moment of the suspension, the party concerned will be given 2 months to submit observations. The previous two-step-practice where the first extension was granted for the period the parties' requested and the second for one year is abolished: the period of one year will be granted from the first request irrespectively from what it is requested.<sup>22</sup>

#### **IV. EARLIER RIGHTS THAT ARE NOT EARLIER**

**Art. 8(2), Art. 41(1) CTMR**

Sometimes an opposition is based on one or more marks or other rights that are not earlier than the CTM application, within the meaning of Article 8(2) CTMR. The establishment of whether a right is earlier or not is not done at the admissibility stage (a decision on substance must be taken) but if it is obvious at that stage that a right is not earlier, two cases have to be distinguished:

##### **1. Opposition only based on a mark/ right that is not earlier**

The practice in these cases is to notify the admissibility of the opposition and to inform the parties that the Office will take a decision of refusal of the opposition, after the expiry of the cooling-off period, based on the finding that

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<sup>24</sup> Amended on 29/02/2008

<sup>22</sup> Amended on 15/09/2010

the “earlier” right(s) on which the opposition is/are based are not actually earlier rights within the meaning of Article 8(2) CTMR. No time limit to file observations will be granted. However, the opponent will have the two months of the cooling off period to react to the letter. The opponent may choose to withdraw the opposition during the cooling off period or he may want to put forward arguments contesting the findings.

The following paragraph should be used:

“Please note that the examination of the notice of opposition has shown that the mark on which the opposition is based is not actually an earlier right within the sense of Article 8(2) CTMR. Consequently the Office will issue a decision rejecting the opposition as unfounded as soon as the cooling-off period expires.”

## **2. Opposition based on earlier and non-earlier marks/rights**

Where the opposition is based on more than one right, **one being earlier** and one or more are **not** earlier, and some or more are not, the Office will notify the admissibility of the opposition as usual and no mention will be made of the fact that one or more marks/rights are not earlier. The issue will then be dealt with in the decision.<sup>23</sup>

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<sup>23</sup> Amended on 29/02/2008

## C. ADVERSARIAL STAGE

### I. COMPLETION OF THE OPPOSITION

Within two months after expiry of the cooling-off period, the opponent may file additional facts, evidence and arguments in support of his opposition (see Chapter above.)

Within the same period, he must prove the existence and validity of his earlier rights (See the following Chapter).

### II. PROOF OF EXISTENCE AND VALIDITY OF EARLIER RIGHTS

R 19(1) CTMIR

R 19(3) CTMIR

R 79 CTMIR

R 20(1) CTMIR

After the parties have been notified of the admissibility of the opposition, the opponent has two months counted from the end of the cooling-off period in which he may not only complete his file, that is, present all the evidence he deems necessary to win his opposition, but within which he also has to prove the existence and validity of the earlier rights invoked. At the end of this period, the opponent must have filed evidence of the existence and validity of his earlier trade mark registrations, evidence of reputation, evidence of the existence and the scope of protection of his earlier sign etc.

The evidence must be in the language of the proceedings or accompanied by a translation. The translation must be furnished within the time limit for furnishing the original. The Office will not take into account documents or parts thereof that have not been submitted or that have not been translated into the language of the proceedings within the time limit set by the Office.

~~The~~ Unless submitted by fax transmission, any supporting document or other evidence shall be presented in two copies, one being for transmission to the other party. Items that ~~cannot be properly scanned or photocopied and that~~ are not presented in two copies (so that one can be transmitted to the other party) cannot be taken into account. Any document or item of evidence, other than that consisting of loose sheets, that has been submitted to the Office by post, personal delivery or any other means shall be accompanied by a copy. If no copy is provided, these documents or items of evidence will not be taken into account.<sup>24</sup>

If the opponent has not proven the existence of at least one earlier rights, the opposition must be refused as unfounded. The substantiated mark does not necessarily have to be the same as that which was found admissible. If the mark chosen has not already been subject to an admissibility check, it must be verified that it also has been correctly identified and thus admissible under

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<sup>24</sup> Amended on 29/02/2008

absolute requirements at the time the opposition was filed. The relative admissibility of an earlier right that has not been used at the admissibility stage gets overhauled by its substantiation. This means that all absolutely (correctly identified) marks that have been substantiated are valid and taken into account.<sup>25</sup>

If the earlier mark is a CTM, no documents regarding the substantiation have to be submitted. However, the relevant data will have to check.<sup>26</sup>

## 1. Trade mark registrations or applications that are not CTMs

### R 19 (2) (a) (i) (ii) CTMIR

To prove the validity of an earlier trade mark registration or application the opponent must provide the Office with evidence of its filing or registration. The Office accepts the following documents.

#### 1.1. *Certificates issued by the appropriate official body*

Any certificate of registration or the most recent renewal certificate showing the validity of the earlier mark beyond the time limit that was given to him to substantiate his opposition, issued by a national office or by WIPO if it concerns an international registration are valid evidence. For further requirements relating to renewal certificates, see below.

If the opposition is based on an application, the opponent must file evidence that the application was filed at the national office or that an international application was filed with WIPO. An application certificate is not sufficient to prove that the trade mark has been registered. In other words, it cannot serve to prove the existence of a trade mark registration.

Some certificates, for example the Spanish certificates, have to be checked carefully as the only differences between an application and registration certificate is the registration date and official seal of the office.

Equivalent documents are also accepted if they are issued by the administration with which the mark is registered (such as a certificate of registration).

#### 1.2. *Extracts from official databases*

### R 19(2) (a) (i) (ii) CTMIR

Extracts from databases are accepted only if their origin is an official database, i.e. the official database of one of the national offices or WIPO and if they are equivalent to a certificate of registration or last renewal. Extracts

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<sup>25</sup> Amended on 29/02/2008

<sup>26</sup> Amended on 29/02/2008

from commercial database are not accepted, even if they reproduce exactly the same information as the official extracts.

Officially accepted databases are, for example:

- **TM View**: for CTMs, International Registrations, and trade marks applied for or registered with the participating offices. For further information check <http://www.tmview.europa.eu/tmview/welcome.html>.<sup>27</sup>
- **BENELUX-MERKEN** (for Benelux trade marks),
- **DPINFO** (for German trade marks),
- **SITADEX** (for Spanish trade marks),
- **OPTICS** and extracts from UKPO web site (for UK trade marks),
- ~~UIBM on-line from the UIBM web site and Telemaco from Italian Chambers of Commerce (for Italian marks),~~ **S.A.R.A, UIBM** on-line from the UIBM web site and Telemaco from the Italian Chambers of Commerce (for Italian marks),<sup>28</sup>

As regards International registrations, the following databases are accepted:<sup>29</sup>

- **ROMARIN** and **MADRID EXPRESS DATABASE** (~~for international registrations~~)<sup>30</sup>
- **CTM-ONLINE** for EU designations in International Registrations
- **TM VIEW**
- **SITADEX** for Spanish designations in International Registrations

Extracts from other national offices are also accepted as long as they come from an official database.

Extracts from commercial databases are not acceptable. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK or COMPUMARK.

When the extract from an official database does not contain all the required information, the opponent must supplement it with other documents from an official source showing the missing information.<sup>31</sup>

For example, extracts from SITADEX sometimes do not contain the list of goods and/or services, in such a case, the opponent must file an additional

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<sup>27</sup> Amended on 6/10/2010

<sup>28</sup> Amended on 18/11/2009

<sup>29</sup> Amended on 6/10/2010

<sup>30</sup> Amended on 6/10/2010 as well as the three indents below

<sup>31</sup> Amended on 6/10/2010 as well as the three following paragraphs

document (for example, a publication in the official bulletin) showing the list of goods and services.

SITADDEX extracts do not show in the same page the image when the mark is figurative. The image normally appears on a blank page. Consequently, as regards figurative Spanish trade marks, when opponents file as evidence an extract from SITADDEX they must also file an additional document showing the image. This can be from SITADDEX itself (which reproduces the image on a separate blank page) or from another official source (such as its publication on the official bulletin).

When English is the language of the proceedings, and as far as Portuguese trade marks are concerned, it should be noted that INPI also provides an English version of the Portuguese trade mark extract so, in principle, no translation would be necessary. However, as regards the list of goods and/or services, the extract itself only gives the class headings along with a warning indicating that this reference to the class heading does not necessarily reflect the goods and/or services protected under the trademark. In this regard, the opponent must always file the original list in Portuguese (from an official source) and, where the list does not consist of a class heading, an accurate translation into English.

### *1.3. Extracts from official bulletins of the relevant national trade mark offices and WIPO*

In all Member States the trade mark application and/or registration is published in an official bulletin. Copies of publication are accepted as long as the document (or the accompanying observations of the opponent) indicates the origin of the publication. If this indication is missing, the evidence is insufficient to prove the validity of the mark.

Furthermore a copy of publication of the application is not sufficient to prove that the trade mark has been registered. In other words, it cannot serve to prove the existence of a trade mark registration.

The Office accepts the first WIPO publication of the international registration as sufficient evidence of registration although once registered, it still can be refused by national offices during the following 12 or 18 months. Only if the applicant contests the protection of the mark in question in a given territory or for certain goods and services will the opponent have to provide evidence that the mark was not refused.

### *1.4. Duration of a trade mark registration*

In general, the registration of a mark lasts 10 years, After this period has elapsed, the registration of the mark can be renewed every 10 years. In most of the countries, the starting point of the 10 years is the filing date but there are exceptions.

Countries	Term of Protection	Starting Point
Austria	10 years	Registration date
Benelux (Belgium, Luxembourg, The Netherlands)	10 years	Filing date
Bulgaria	10 years	Filing date
Cyprus	7 years first term/14 years renewal	Filing date = Registration date
Czech Republic	10 years	Filing date
Denmark	10 years	Registration date
Estonia	10 years	Registration date
France	10 years	Filing date
Finland	10 years	Registration date
Germany	10 years	Filing date
Greece	10 years	Filing date
Hungary	10 years	Filing date
Italy	10 years	Filing date
Ireland	10 years for TM registered since 1/7/96 (7/14 years renewal before that).	Registration Date = Filing date
Latvia	10 years	Filing date
Lithuania	10 years	Filing date
Malta	10 years	Registration date = Filing date
Portugal	10 years	Registration date
Poland	10 years	Filing date = Registration date
Romania	10 years	Filing Date
Sweden	10 years	Registration date
Slovakia	10 years	Filing date
Slovenia	10 years	Filing date
Spain	10 years for TM applied for since 12/05/89 (20 years for TM applied for before that, counting from date of registration)	Filing date
United Kingdom	10 years since 31/10/94 (TM applied for prior to that were, upon the completion of the registration formalities, in force for 7 years from the date of the application. TM marks with renewal date prior to 31/10/1994 renewed for a period of 14 years).	Filing date = Registration date
International registration	10 years (even if 20 years for Madrid Agreement Registrations, fees must be paid in two installments of 10 years equivalent to a renewal fee)	International Registration date

### *1.5. Verification of the evidence*

The number in square brackets is the international code number used to identify the information on many, but not all, registration certificates. The opponent is not obliged to submit an explanation of the codes, either for the INID or for the national codes.

The following things should be checked:

- The issuing authority;
- The filing [210] and/or registration numbers [111] (in certain countries these are, or were, different);
- The territorial extent for international registrations (that is, in which countries the mark is protected and for what goods and services);
- The filing [220], priority [300] and registration dates [115] (in certain countries, e.g. France, the filing and registration dates found on the certificate are the same);
- A representation of the sign as filed or registered [531, 541, 546, 554, 556, 557, 571, 591] and as claimed in the notice of opposition. If at that stage, the Office becomes aware that the representation on file of the earlier right is not correct because for example the opponent has failed to indicate that his figurative mark was in colour in the notice of opposition and has only sent a black and white representation to the Office, the earlier right will not be taken into account.
- The goods and services covered [511];
- The expiry date of the registration;
- The owner [731, 732];
- Other inscriptions affecting the legal status or the scope of protection of the mark (e.g. disclaimers [526], limitations, renewals, transfers, pending actions etc).

#### *1.5.1. Renewal certificates*

If the opponent has submitted a certificate of registration but the registration is due to expire before the expiry of the two months substantiation period, he must file a renewal certificate in order to prove that the term of protection of the trade mark extends beyond the time limit given to him to substantiate his opposition. What counts is the date on which the registration would expire, and not the possibility to renew the mark within the six months grace period under the Paris Convention. (Contrary BoA decisions should not be followed.).

Only if the renewal certificate contains all the necessary data that determines the scope of the protection of the earlier mark, will it suffice to file the renewal certificate without a copy of the registration certificate.

Nevertheless, in these cases it has to be carefully verified if the renewal certification contains all the necessary information. Some renewal certificates are merely confirmations that the registration was renewed without any other data than the registration number and some dates. In these cases, for example with ~~Spanish and German renewals~~ and, sometimes, Spanish renewals, the renewal certificate alone is insufficient to determine the scope of the protection of the earlier mark.<sup>32</sup>

However, if the opponent provides an equivalent document emanating from the administration by which the trade mark was registered, he does not need in addition to provide a renewal certificate.

If there is no proper evidence of renewal, the earlier registration will not be taken into account (when there are other earlier rights that have been substantiated) or the opposition will be rejected as not substantiated.

*1.5.2. The opponent must be the proprietor of the earlier registered trade marks.*

If the opponent is a corporation, the name of the corporation must be carefully compared with the name of the corporation that owns the prior trade mark. For instance with British companies, John Smith Ltd, John Smith PLC and John Smith (UK) Ltd are different legal entities.

If the opposition is filed with B as opponent and a copy of the registration certificate shows A as owner of the earlier mark, the opposition will be rejected as not substantiated, unless the opponent has provided evidence of the transfer and, if already available, the registration of the transfer in the relevant register.

**Art. 41 (1)(a) CTMR, R 15 (2)(h)(iii) CTMIR<sup>33</sup>**

An exception to the above is that a licensee of the trade mark proprietor may be an opponent. In this case there is a discrepancy between the owner of the earlier registration and the opponent. The extract of the registration will normally reflect when a license has been registered. However, in some Member States such records of licenses are not made. In all cases, it is up to the licensee to demonstrate that he is authorised by the trade mark owner to bring an opposition. As the number of oppositions filed by licensees is extremely low, there is no practice on what evidence needs to be filed to support such an authorisation. However, an express authorisation or a license contract that authorises the licensee to act in defence of the mark are deemed sufficient.

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<sup>32</sup> Amended on 6/10/2010

<sup>33</sup> Amended on 23/02/2009

## 2. Translations of evidence of trade mark registrations<sup>34</sup>

### R 19(3)(4) CTMIR

The Office can only consider evidence that is submitted in the language of the opposition proceedings within the time limit specified for submitting the original document. Rule 19 (3) CTMIR is a “lex specialis” to Rule 96 CTMIR.

### R 20 (1) CTMIR

Thus, both the evidence submitted by the opponent for the first time at the end of the ~~2 + 2 months~~ period **for substantiation of the opposition**, as well as any other previously submitted document or certificate, must be either in the language of the proceedings, or be accompanied by a translation. Only what is filed and translated within this period is taken into account. If it is insufficient, the opposition is rejected as unfounded.

### R. 98 (1) CTMIR

Rule 98 (1) CTMIR requires that the translation reproduces the structure and contents of the original document.

~~In~~ **Thus, the principle, is that the whole entire document must be translated, in the correct order and follow the structure of the original document.**

~~In particular, it is not acceptable that the translation is limited to parts that the opponent considers “essential”, nor that it is limited to those parts which the applicant is “not expected to understand”. All the less acceptable is a translation that only emerges as a piecemeal puzzle from different documents.~~

The Office does not consider that information already given in the language of the proceedings in the notice of opposition, or in documents attached thereto or submitted later (e.g. explanation of grounds, lists of earlier marks etc.) amounts to a valid translation of a registration document, such as a registration certificate, even where such indications have been accepted for admissibility purposes. The translation has to be on a stand-alone basis and cannot be ~~taken piecemeal~~ **assembled from fragments taken** from other documents.

~~The translation must include the whole list of goods and services even if it is already contained in the notice of opposition. Where the opposition is based on only a part of the goods and services covered by the earlier right, it is sufficient to provide a translation of the goods and services on which the opposition is based only.~~

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<sup>34</sup> All amendments in Title 2. done on 21/02/2011

Extracts from commercial databases cannot be considered valid translations of an official document, unless they reproduce the structure and contents of the original document.

~~However, the~~ The Office accepts that no translation of the information headers in the ~~extracts/certificates~~ (such as, 'filing date' 'colour claim', etc) is needed, provided that they are also identified using standard INID codes or national codes.

~~The opponent is not obliged to submit a translation of the explanation of the INID or of the national codes in the language of proceedings.~~

The list of INID codes and their explanations are attached as Appendix 1 to Standard ST.60- Recommendation Concerning Bibliographic Data Relating to Marks, available on WIPO's website.

Irrelevant administrative indications ~~or parts with no bearing on the case,~~ with no bearing on the case, may be omitted from the translation.

Where the opposition is based on only a part of the goods and services covered by the earlier right, it is sufficient to provide a translation of the goods and services on which the opposition is based only.

The only exception to the above principle that the entire document must be translated and follow the structure of the original document can be made when the entire original document is in the language of the proceedings except for the list of goods and services.

For example, the German Office can issue its official database extract in the English language but the list of goods and services in it will **still** be in German. In this case, if the language of proceedings is English, it is acceptable if only the goods and services on which the opposition is based have been translated separately in the notice of opposition, in documents attached thereto or submitted later within the time limit to substantiate the opposition. The same applies to extracts/certificates which make use of INID or national codes, where the only information which still needs to be translated into the language of the proceedings is the list of goods and services.

#### **R 98 (1) CTMIR**

The Office accepts simple translations, drawn up by anybody. The Office normally does not make use of its faculty under Rule 98 (1), 2nd sentence, to require the translation to be certified by a sworn or official translator. Where the representative adds a declaration that the translation is true to the original, the Office will not question this. The Office even accepts hand-written inscriptions on the copies of the original certificates giving the meaning of the various entries in the language of the proceedings, provided of course that they are complete and legible.

The Office does not make the obligation of the opponent to provide translations of the evidence dependant on the reaction of the applicant because Rule 19 (3) CTMIR does not provide for any exception to the principle that the evidence needs to be translated.

**R 19 (2)(b)- (e) CTMIR**

**3. Substantiation of well-known marks, claims of reputation, trade marks filed by an agent, earlier signs used in the course of trade**

*3.1. Well-known marks*

**Art. 8(2), CTMR, R 19 (2) (b) CTMIR**

An earlier well known mark is a trade mark that is well known in a Member State, in the sense in which the words well-known are used in Article 6 bis of the Paris Convention. Such a mark may be unregistered, but it may also be registered.

If the opponent invokes a registered trade mark and claims the same mark in the same country as a well-known mark, this will in general be taken as a claim that his registered mark has acquired a high degree of distinctiveness by use.

It is very common for opponents to confuse “well-known” marks with “marks with a reputation” under Article 8(5) CTMR. Depending on the ground of opposition that is indicated, the case will have to be considered under Article 8(2) and/or Article 8(5) CTMR.

The opponent needs to show that he is the owner of an earlier trade mark that has become well-known in the relevant territory, for the goods and services on which the opposition is based. He will have to submit evidence of use and of the mark being well-known.

*3.2. Marks with a reputation*

**Art. 8(5) CTMR, R19 (2) (c) CTMIR**

An opposition under Article 8(5) CTMR is based on an earlier trade mark that has a reputation.

The earlier trade mark in these cases is a registered trade mark. The opponent therefore has to submit registration certificates, etc, as set out above.

In order to make his case under Article 8(5) CTMR, the opponent has to submit evidence of reputation. In addition the opponent has to allege and demonstrate the potential detriment he would suffer, or the unfair advantage that would be taken by the applicant, if the applicant used the mark which is

the subject-matter of the contested CTM application or to indicate that this is probable in the ordinary course of events.

3.3. *Non-registered trade mark or another sign used in the course of trade*

**Art. 8(4) CTMR, R19 (2) (d) CTMIR**

For these rights the Office applies the protection provided by the relevant national law. Not all Article 8(4) CTMR rights are unregistered, e.g. in some countries company and commercial names are registered. If it is a matter of a registered right then a copy of the registration and renewal certificates, etc, is required as set out above for trade mark registrations. In the case of unregistered marks or signs the opponent must provide evidence of the acquisition of the earlier right and evidence that it is of more than local significance.

The opponent must file evidence that he has used his sign (earlier right, either registered or not). Furthermore, he also needs to state on which national law he bases his case and to make out his case under this law.

3.4. *Mark filed by an agent or representative*

**Art. 8(3) CTMR**

**R 19 (2) (e) CTMIR**

This concerns the case where someone (an agent or representative) other than the real proprietor of a mark applies for its registration at the Office. The real proprietor can oppose the registration.

The opponent has to prove his ownership of the trade mark and the time of acquisition of that mark. As the trade mark can be either a registered trade mark or an unregistered trade mark, the opponent will have to submit evidence of registration somewhere in the world or evidence of acquisition of rights through use. The opponent also has to submit evidence of an agent-representative relationship.

**4. Sanction**

**R 20 (1) CTMIR**

When the evidence check reveals that none of the earlier rights on which the opposition is based has been substantiated, i.e. the opponent has not provided sufficient evidence to prove that he owns a valid earlier right, the opposition must be rejected immediately after expiry of the two-month substantiation period, without waiting for the reply of the applicant.

In no case the Office is required to inform the parties which facts or evidence could be or have not been submitted.

### III. TRANSLATIONS / CHANGES OF LANGUAGE DURING THE OPPOSITIONS PROCEEDINGS

#### 1. Translation of submissions other than the opposition notice

Most of submissions of the parties in opposition proceedings have to be in the language of the proceedings in order to be taken into account. For different submissions there are different rules to be applied. The general rule is Rule 96 CTMIR. Rule 96(1) CTMIR applies to written statements/submissions filed within the opposition procedure. Rule 96 (2) CTMIR applies to evidence attached to a written submission filed within the opposition procedure. However, Rule 96 CTMIR does not apply if there is a “lex specialis”. Rule 19(3) CTMIR for facts, evidence and arguments filed by the opponent and Rule 22(6) CTMIR for evidence of use (always filed by the opponent) are such a “lex specialis”.

##### 1.1. *Translation of facts, evidence and arguments filed by the opponent to complete his file*

R 19(3) CTMIR

R 19(4), R 20(1) CTMIR

Rule 19(3) CTMIR applies to both the first observation of the opponent and the attachments thereto (facts evidence and arguments in support of the opposition, proof of earlier right), i.e. anything the opponent brings forward to complete his file as from the notification of admissibility of his opposition. It also applies to the notice of opposition itself, as concerns facts, evidence and arguments, and proof of the earlier right: Documents included in the notice of opposition but not translated at that stage must be translated until expiry of the time limit for substantiating.

If these submissions are not in the language of the proceedings, they must be translated within the time limit specified for submitting the original document. If this is not done, the legal consequence is: Documents that have not been translated in this period are not taken into account. However, if documents proving the existence and validity of the earlier right have not been translated, the opposition must be refused as unfounded straight away, as Rule 20(1) CTMIR is “lex specialis”:

The facts, evidence and arguments shall be presented in two copies, one being for transmission to the other party (Rule 79a CTMIR).

For ~~paper~~ **faxed** documents, non-compliance with this Rule is without sanction for the opponent: The Office will copy the documents and send it to the other party.<sup>35</sup>

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<sup>35</sup> Amended on 29/02/2008

However, ~~items that are furnished in only one copy but cannot be properly scanned or photocopied (such as physical specimens of the earlier mark, packaging of goods, CDs, videotapes), cannot be transmitted to the other party and cannot~~ any document or item of evidence, other than consisting of loose sheets, that has been submitted to the Office by post, personal delivery or any other means shall be accompanied by a copy. If no copy is provided, these documents or items of evidence will not be taken into account. ~~Rule 79a CTMIR rules out the previous practice to expect the other party to travel to Alicante to inspect the item.~~<sup>36</sup>

## 1.2. Translation of further observations

### R 96(1) CTMIR

There is no special rule for translations of the first reply of the applicant or other observations drawn up by the applicant or opponent at a later stage in the proceedings. Consequently for these submissions Rule 96(1) CTMIR applies. This means that the first reply of the applicant under Rule 20 (2) CTMIR or the reply by the opponent to the applicant's observations under Rule 20 (4) CTMIR may be in any language of the Office.

The applicant or opponent has one month from the date of receipt of the original by the Office to submit a translation of these documents in the language of the proceedings. The Office does not request the parties to send a translation; it has to be sent on their own initiative.

Example 1: The language of opposition is English and the applicant must file observations in reply to the notice of opposition by 26/06/2002. If on 20/06/2002 he files his observations in reply to the opposition in German, he must file his translation by 20/07/2002. If he then files the translation on or before 20/07/2002, both the original submission and the translation must be taken into account, notwithstanding that the original time limit for filing observations expired on 26/06/2002.<sup>37</sup>

~~For example,~~ Example 2:<sup>38</sup> the language of opposition is English and the applicant must file observations in reply to the notice of opposition by 26/06/2002. If on 18/05/2002 he files his observations in reply to the opposition in German, he must file his translation by 18/06/2002. However, as his deadline only finishes on 26/06/2002, if he hasn't filed a translation by 18/06/2002, he can still validly file documents till 26/06/2002. If he then files the translations before the end of the period we consider the translation as valid observations filed in the language of the proceedings within the set period.

### R 98 (2), R 19(4) CTMIR

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<sup>36</sup> Amended on 29/02/2008

<sup>37</sup> Amended on 9/11/2010

<sup>38</sup> Amended on 9/11/2010

If he does not do so, the observations are deemed not to have been received by the Office and shall not be taken into account Rule 98 (2) CTMIR. Furthermore, Rule 19(4) CTMIR excludes that the translation be taken into account, i.e. that new time limits or opportunities to submit documents are opened.

### 1.3. Translation of documents other than observations

#### R 96(2) CTMIR

All evidence other than the evidence that the opponent must provide within the time limit given to substantiate his opposition can be filed in any official language of the Community, as Rule 96(2) applies. This evidence concerns all documents other than observations, filed by the parties after the period for the opponent to complete his file.

Examples of this type of evidence are catalogues or magazine articles that are submitted by the applicant together with his observations in reply to the opposition.

For this evidence, a translation is needed only if the Office requests it. Therefore, the parties are not under an automatic obligation to furnish a translation.

#### R. 98 (2), R19(4) CTMIR

The Office exercises its discretion as follows (this practice corresponds *mutatis mutandis* to that concerning evidence of use):

In principle the Office does not *ex officio* require a translation. Yet it is vital that the party to whom the documents are addressed should be able to understand the meaning of their substantive content. If this is doubtful or contested by the party-addressee, the Office requires a translation within a specified period.

Only if the Office does so, Rules 98(2) and 19(4) CTMIR operate with the effect that translations that are filed late as well as the original to be translated must be disregarded.

Together with the invitation to furnish a translation, the Office will draw the attention of the party concerned to the following.

It is up to the party to evaluate whether a complete translation of all the evidence submitted may be necessary. However, the documents in question will only be taken into account in so far as a translation is submitted or in so far as the documents are self-explanatory, regardless of their word components.

*Example:* In the case of a national court decision it may be sufficient to translate those parts only that are relevant for the opposition proceedings.

#### 1.4. *Proof of use*

##### R 96 (2), R 22(6) CTMIR

For proof of use, Rule 22 (6) CTMIR is “lex specialis” as regards translations. If the evidence is submitted in a language of the Community which is not the language of the proceedings, the Office may require the opponent to submit a translation of the evidence into the language of the proceedings within a specified period.

Therefore, it is at the discretion of the Office whether or not to request a translation. In exercising this discretion, the Office balances the interests of both parties.

It is vital that the applicant should be able to understand the meaning of the substantive content of the evidence submitted. If this is doubtful or contested by the applicant, the Office requires a translation within a specified period.

##### R 22(2), R 19(4) CTMIR

Rule 22(2) CTMIR, together with Rule 19(4) CTMIR, has the effect that the opposition must be rejected if the proof of use is not filed within the time limit given or if it was filed within the time limit given but the Office requested it to be translated, if that was not done within the time limit set.

## **2. Change of language during opposition proceedings**

##### Art 119(7) CTMR, R 16(2) CTMIR

According to Article 119(7) CTMR, the parties to opposition proceedings may agree to change the procedural language and choose any official language of the European Union for that purpose.

Rule 16(2) CTMIR sets forth the conditions under which such a change of language may occur. It requires that the opposition was filed in a language of the Office at the outset. It states that the parties may agree to change the procedural language and are required to inform the Office accordingly prior to the expiry of the cooling-off period. A request to change the language after the expiry of the cooling-off period is not accepted by the Office.

When, before the start of the adversarial part of the proceedings, the opponent and the applicant agree to change the language of the proceedings, Rule 16(2) CTMIR requires the opponent to “file a translation of the notice of opposition in that language”. He has to do so within one month of the expiry of the cooling-off period.

Where the translation is not filed or filed late, the language of proceedings shall remain unchanged.

## **IV. DOCUMENTS NOT READABLE/ REFERENCE TO OTHER FILES**

### **1. Documents not readable**

**R 80(2) CTMIR**

Where a communication received by fax is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office informs the sender accordingly and invites him, within a period to be specified by the Office, to retransmit the original by telecopy or to submit the original in accordance with Rule 79(a) CTMIR. Mailroom will deal with these re-fax requests.

When this request is complied with within the period specified, the date of the receipt of the retransmission shall be deemed to be the date of the receipt of the original communication.

### **2. No return of original documents**

Original documents become part of the file and therefore cannot be returned to the person who submitted them.

However, the party always has the possibility of obtaining a certified or uncertified copy of the original documents, subject to the payment of EUR 30 (EUR 10 when uncertified) plus EUR 1 for each page exceeding 10.

### **3. Confidential information**

In some cases one of the parties requests the Office to keep certain documents confidential even from the other party in the proceedings. Although the Office can keep documents confidential vis-à-vis third parties (inspection of files), it can under no circumstances keep documents confidential with regard to the other party in inter partes proceedings.

Each party to the proceedings must always have a right to defend itself. That means that he should have full access to all material filed by the other party.

From this it follows that all material filed by a party should be disclosed to the other party of the proceedings. The Office has an obligation to communicate all material received to the other party.

If in the course of opposition proceedings the Office receives documents with a request that they be kept confidential inter partes, the sender should be informed that the documents cannot be kept confidential with respect to the other party to the proceedings.

To this end, a letter has to be sent, clearly explaining that he may choose between disclosure of the documents or withdrawal of the documents. It is up to the party to decide which of these possibilities is appropriate for his case.

If he confirms the confidentiality, the documents will not be sent to the other party and will not be taken into account. They will have to be marked as confidential in Filenet.

If he wants the documents to be taken into account but not available for third parties, the documents can be forwarded to the other party, but must be marked confidential in Filenet.

If he does not reply, the documents will not be sent to the other party and will not be taken into account. They will have to be marked as confidential in Filenet.

#### **4. References made to documents in other proceedings**

From time to time the Office receives observations from the opponent or applicant in which he refers to documents filed in other opposition proceedings, for instance to proof of use that has already been filed in a different opposition.

Such requests are accepted when the opponent/applicant clearly identifies the documents that he refers to. Clear identification means precise indication. The party must indicate the following: the number of the opposition he refers to, the title of the document he refers to, the amount of pages of this document and the date this document was sent to the Office, for instance “the statutory declaration that was submitted to the Office on dd/mm/yy in opposition proceedings B xxx xxx, together with exhibits 1 to 8, consisting of xx pages”.

This also includes documents submitted before the Boards of Appeal, provided that such references clearly identify the documents referred to.

However, a general reference to observations or documents submitted in other opposition/appeal proceedings will not be accepted.

In such a situation the party referring generally to such other documents should be invited to be sufficiently specific. The party should also be informed that unless such specification is received within the time limit set, such other documents will not be considered.

## **V. FURTHER EXCHANGES**

**R 20 (2) CTMIR**

**R. 20 (6) CTMIR**

**R 22 (5) CTMIR**

**R 98(2) CTMIR**

**R 19(4)CTMIR**

**R 96 (2) CTMIR**

The Office invites the applicant to file observations in the time limit set by the Office.

In appropriate cases, the Office may invite the parties to limit their observations to particular issues. In that case, the party is allowed to raise the other issues at a later stage of the proceedings. For example, the applicant can request proof of use of the earlier right with or without submitting at the same time observations on the grounds on which the opposition is based. In that case, the observations may be filed together with the observations in reply to the proof of use.

The first reply by the applicant under Rule 20(2) CTMIR may be in another language of the Office than the language of the proceedings. In that case, it must be translated into the language of proceedings within one month from the date of submission of the original document. [\(See further information and examples under point C/III/1.2. 'Translation of further observations'\)](#).<sup>39</sup>

~~If the translation arrives after the time limit, the original document is deemed not to have been received and shall not be taken into account. Rule 19 (4) CTMIR excludes that the translation be taken into account, i.e. that new time limits or opportunities to submit documents are opened.~~<sup>40</sup>

Attachments to the applicant's reply (e.g. Court decision denying likelihood of confusion) can be in any of the official languages of the EC, and a translation is needed only if the Office requests it. Only if the Office does so, Rules 98(2) and 19(4) CTMIR operate with the effect that translations that are filed late as well as the original to be translated must be disregarded.

## **VI. ORAL PROCEEDINGS BEFORE THE OPPOSITION DIVISION**

### **Art. 77(1) CTMR**

The granting of an oral hearing is discretionary; the Office does not have to follow such a request if it thinks that it is not expedient to do so.

The practice of the Office is that written proceedings are sufficient and that having oral proceedings are not necessary.

## **VII. OBSERVATIONS BY THIRD PARTIES**

### **Art. 40 CTMR**

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<sup>39</sup> Amended on 9/11/2010

<sup>40</sup> Amended on 9/11/2010

According to Article 40 CTMR, third parties can make observations explaining why the CTM application the trade mark should not be registered based on one of the absolute grounds of Article 7 CTMR. The observations are dealt with by the examiner in charge of the examination on absolute grounds.

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Article 40 (previously 41) CTMR mentions that these observations can be made “following the publication of the Community trade mark application”. In Communication N° 02/2009, the President of the Office establishes that as regards observations received concerning CTM applications against which opposition has been filed, the observations will be dealt with as regular if they are received before the termination of the opposition proceedings.

As anybody may file third parties observations, it can also be the opponent. However, if he does so, he should do so in a manner that leaves no doubt. According to the above mentioned Communication of the President of the Office, the observations must be presented in a separate submission. However, a decision of the Boards of Appeal 735/2000-3, Serie A, establishes that the “separate submission” requirement is deemed to be satisfied when the observations are clearly separable from the grounds and arguments supporting the opposition, even if they are included in the same document. As long as the opponent expressly mentions that he wishes to make observations under Article 40 CTMR they will be dealt with, even if they are not made in a separate submission. However, if in his observations the opponent argues that the CTM application is weak and should have been refused under Article 7 CTMR, without any reference to the contents of Article 40 CTMR, this argument will only be taken into account as an argument under Article 8 CTMR. It is not regarded as observations by third parties under Article 40 CTMR.

The observations are dealt with by the examiner responsible for the file. When an opponent makes third party observations, the examiner will consider if the observations raise serious doubts as to the registrability of the CTMA, or if they will only be sent to the applicant for information.

If the observations raise serious doubts, the examiner must suspend the opposition until a decision on the observations is taken. In cases where the observations do not raise serious doubts (i.e. when the observations have only been sent to the applicant for information), or do not affect the contested goods or services, the opposition proceedings should not be suspended.

## **D. TERMINATION OF PROCEEDINGS**

### **I. FRIENDLY SETTLEMENT**

#### **Art. 42(4) CTMR**

The Office may, if it thinks fit, invite the parties to make a friendly settlement. The Office, as well as the parties, may therefore initiate a settlement procedure.

To this end it may issue proposals for friendly settlement. As, in principle, the Office cannot (and does not wish to) replace the parties, it will take action only if a settlement between the parties appears desirable in the light of the case or if there are good reasons for considering that the proceedings can be ended by a settlement, in particular because one party has made known that it wishes to negotiate.

The Office can, moreover, if expressly requested by the parties, offer assistance with their negotiations, for instance by acting as an intermediary or by providing them with any material resources that they need. Any costs incurred are borne by the parties. Friendly settlement may be preceded by a request for suspension.

#### **R 18(2) CTMIR**

The parties are free to decide on the measure that brings the opposition proceedings to conclusion. While they can decide on the withdrawal of the opposition, they can also simply ask the Office without giving specific reasons to rule that the case will not proceed to judgment. It suffices to communicate the written agreement of the parties, which does not have to include a statement of grounds, to the Office for the proceedings to be 'closed' by a decision not to proceed to judgment. The Office then takes the steps needed to close the proceedings on the basis of this agreement.

An example of a proposal made by the Office could be the one made in opposition B 7 023. In this case the CTM application was KINESYS for

Non-medicated toilet preparations; cosmetics; preparations for removing cosmetics; soaps; shampoos; washing preparations; preparations for the care of the skin and for the hair; anti-perspirants; deodorants for personal use; depilatory preparations; preparations for the nails; astringent preparations; sun screening and sun tanning preparations, and preparations for use on the skin after sun tanning; moisturising preparations in class 3, and

Pharmaceutical preparations and substances; medicated preparations for topical application; anti-fungal preparations; analgesic preparations;

ointments; liniments; disinfectants; anaesthetics; antibiotics; anti-inflammatory preparations in class 5.

The CTM application was contested on the basis of the earlier registration KINESIA, registered for

Preparations for bleaching and other substances for washing; preparations for cleaning, brightening, degreasing and polishing; soaps; perfumery essential oils, cosmetics, hair lotions; toothpastes in class 3.

During the proceedings the applicant submitted samples of all the goods he intended to market. It became clear that his goods were aimed at professional, or at least serious, athletes.

The Office then proposed the following to the parties:

I. The applicant is to restrict his application to:

Sun screening and sun tanning preparations for athletes in class 3, and

Pharmaceutical preparations and substances; medicated preparations for topical application; anti-fungal preparations; analgesic preparations; ointments; liniments; disinfectants; anaesthetics; antibiotics; anti-inflammatory preparations; all the aforementioned products for athletes in class 5.

## **II. RESTRICTIONS AND WITHDRAWALS**

### **1. Restrictions and withdrawals of CTM applications**

For the restriction of an (opposed) CTM application, see the Manual, Part E, Section 3.4.

The Office does not accept restrictions that are conditional. For example, if, in his observations in reply to the opposition, the applicant argues that the signs are dissimilar but should the examiner find them similar, he will limit the list of goods and services of the CTM application. This restriction is not acceptable. The applicant must be informed that the limitation must be express and unconditional.

Restrictions are acceptable unless:

- a. the applicant excludes goods that cannot possibly be comprised in the goods and services as applied for;
- b. it contains a reference to a trade mark;
- c. it contains a territorial limitation as to use;
- d. a non-sensical restriction in order to overcome an Absolute Grounds objection (see ECJ Case C-363/99 Postkantoor).

Restrictions formulated in a negative way are acceptable, provided that they do not fall foul of the 'unacceptable restrictions'.<sup>41</sup>

If the restriction is not acceptable the applicant must be notified.

If a restriction is partly acceptable and partly unacceptable (for example because it constitutes an extension), the Office accepts the restriction for the acceptable part. However, before proceeding with the limitation, the applicant is informed of the part that cannot be accepted and is given two months to react. The opponent must be sent a copy of the limitation and the reply of the Office to the applicant. If within the two months the applicant reacts with a corrected version that is acceptable, the limitation can be processed. On the other hand, if the applicant does not react, the limitation is only processed insofar as it is acceptable.

If the opponent withdraws his opposition because of an unacceptable limitation (even before the Office has officially informed him), the withdrawal will not (yet) be taken into account, and will be dealt with only after the limitation has become acceptable.

If the restriction is acceptable, a confirmation is sent to the applicant. Depending on the moment in the proceedings (and thus the status), the limitation or withdrawal has different consequences, described below.

## **2. Withdrawal or restriction before admissibility check is made**

When the CTMA is withdrawn or restricted to non-contested goods before notification of admissibility of the opposition, the opposition proceedings are closed. In other words dealing with the withdrawal or restriction in these cases has priority over the admissibility.

In the case of a restriction that may still include contested goods and services, an admissibility check is done and the opponent is invited to remedy any deficiencies at the same time as the restriction is notified. If the opposition is withdrawn, the opposition fee is refunded. This is the case even if irremediable deficiencies exist.

## **3. Restrictions and withdrawals of CTM applications before the end of the cooling-off period**

### *3.1. Restriction covers whole extent of the opposition / withdrawal*

**R 18(2), (3), (4) CTMIR**

If it is absolutely clear that the restriction covers the whole extent of the opposition or when the CTMA is withdrawn this is notified to the parties. The opponent is refunded the opposition fee. No decision on costs will be taken.

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<sup>41</sup> Amended on 19/02/2009

3.2. *Restriction does not (seem to) cover the whole extent of the opposition*

If it is not completely clear that the restriction covers the whole extent of the opposition and when the restriction does not cover the whole extent of the opposition clarification must be requested. If the opponent then agrees to the restriction and withdraws his opposition the parties are notified. The opponent is refunded the opposition fee. No decision on costs will be taken.

The same applies when the opponent withdraws his opposition within the period of time given to reply to the restriction but after expiry of the cooling-off period as a consequence of a restriction made by the applicant during the cooling-off period.

**4. Restrictions and withdrawals of CTM applications after the end of the cooling-off period**

Withdrawals must be explicit and silence on the part of the CTM applicant during the adversarial part of the proceedings will not be considered as a tacit withdrawal.

4.1. *Restriction covers whole extent of the opposition/withdrawal*

**Art. 85 CTMR**

If it is absolutely clear that the restriction covers the whole extent of the opposition the parties will be notified. Unless the parties submit an agreement on costs, the Office will take a decision on costs.

4.2. *Restriction does not (seem to) cover the whole extent of the opposition*

If it is not completely clear that the restriction covers the whole extent of the opposition clarification must be requested. If the opponent then agrees to the restriction and withdraws his opposition the parties are notified. Unless the parties submit an agreement on costs, the Office will take a decision on costs.

**5. Restrictions and withdrawals of CTM applications after a decision has been rendered**

**Art. 58 (1) CTMR**

Occasionally the applicant withdraws his CTM application after a decision on the opposition has been rendered and during the two months for appeal but without filing an appeal. Following Decision of the Grand Board of Appeal in case R331/2006, "Optima" the Office will now accept withdrawals received during the appeal period including in *inter partes* cases. However, the withdrawal will not have any effect on the decision, which remains valid.

This means that conversion of the rejected application will not be admissible in respect of the Member States to which the relative grounds of refusal apply.

Additionally, the Office will not decide on a new apportionment/fixation of costs.

If the decision rejected the CTM application in full and once it has become final, i.e. after the two month period for appeal, it is too late to withdraw the CTMA as there is nothing left to withdraw.

If the decision rejected the opposition, the application can at any time be withdrawn or restricted.

## **6. Language**

### **R 95(a) CTMIR**

A restriction may be submitted either in the first or the second language of the CTMA (Rule 95(a) CTMIR). When the restriction is submitted in the first language of the CTMA, which is not the language of proceedings, and when the restriction does not cover the whole extent of the opposition, the restriction is forwarded to the opponent requesting him to inform the Office whether or not he maintains his opposition. The opponent can object to the language of the restriction and ask for a translation into the language of proceedings. The Office will then provide for the translation.

### **R 18(3) CTMIR**

## **7. Withdrawal of oppositions**

The opponent can withdraw his opposition at any time during the proceedings. If he withdraws his opposition independent of any restriction of the CTM application, three situations can arise depending on the status of the opposition (when the opponent withdraws his opposition because of a restriction of the CTM application, see above.)

### *7.1. Withdrawal of the opposition before the end of the cooling off period*

#### **R 18(3), (4) CTMIR**

If the opposition is withdrawn before the end of the cooling-off period the parties are notified. If the opponent withdraws his opposition during the cooling off period and there has been no restriction of the CTM application, the Office neither refunds the opposition fee nor takes a decision on costs.

### *7.2. Withdrawal of the opposition after the end of the cooling off period*

If the opposition is withdrawn after the end of the cooling off period the parties are notified. Unless the parties submit an agreement on costs, the Office will take a decision on costs.

### 7.3. *Withdrawal of the opposition after rendering a decision*

Art. 58 (1) CTMR

Art. 64 (3) CTMR

Occasionally the opponent withdraws his opposition after a decision on his opposition has been rendered and during the appeal period. Following Decision of the Grand Board of Appeal in case R331/2006, “Optima” the Office will now accept withdrawals of oppositions received during the appeal period. However, the withdrawal will not have any effect on the decision, which remains valid. This means that the Office will not decide on a new apportionment/fixation of costs.

Withdrawals during the time limit to file an appeal against the decision of the Board of Appeal are also accepted without the applicant having to effectively file the appeal before the CFI because the regulation explicitly foresees that decisions of the Board of Appeal shall take effect only after the time limit to lodge an appeal before the CFI (Article 64(3) CTMR). They only become definitive once the two month period to appeal is over.

### 7.4. *Revocation of withdrawal/restriction*

A party is only permitted to withdraw a previously submitted withdrawal/restriction if the Office receives its letter withdrawing the earlier withdrawal/restriction on the same day as the first submission.

### 7.5. *Language*

A withdrawal of the opposition must be in the language of the procedure. Rule 96 (1) CTMIR applies.

## **III. DECISION ON SUBSTANCE**

The decision on substance is taken once all the required submissions of the parties have been filed. It should deal only with those issues or earlier rights that are relevant for the outcome. The internal Standard Template should be used.

There are two exceptions:

### **1. Earlier right not proven**

If for none of the earlier rights invoked proof of its existence and validity has been filed properly, the opposition is rejected immediately, see Rule 20 (1) CTMIR. However, if only some earlier rights are not proven **but one is**, the

proceedings will continue normally, and ~~these~~ **the non-substantiated rights shall** ~~will~~ not be taken into account in the final decision on substance.<sup>42</sup>

## 2. Ceasing of existence of the earlier right

If, in the course of the proceedings, the earlier right ceases to exist (for example, because it has been declared invalid, or it has not been renewed, the final decision cannot be based on it.

An invalidation of the earlier right (other than of a CTM) cannot be detected by the Office but if one of the party informs the Office that this is the case, the other party must be heard, and eventually, the opposition will have to be rejected.

Before the decision is taken, the examiner shall check whether the earlier right invoked has become due for renewal in the meantime. If so, he shall invite the opponent to prove the renewal of the mark. If the opponent does not furnish the proof, the opposition must be rejected.

## IV. FEE REFUND

### 1. Opposition deemed not entered

Art. 41(3) CTMR

R 17 (1) CTMIR

Art. 9(1)CTMFR

If an opposition is deemed as not entered because of late or insufficient payment, the opposition fee must be refunded to the opponent. If a surcharge has been charged, then it must also be refunded.

Art. 119 (5) CTMR

#### 1.1. *Wrong language/Opposition deemed not entered*

If the notice of opposition is filed in a language which is not one of the Office, it is deemed not entered and the opposition fee must be refunded as it is without object.

#### 1.2. *Opposition and withdrawal arriving on the same date*

In cases where the opposition is withdrawn the same day it was filed, the Office refunds the opposition fee.

#### 1.3. *Refund after re-publication*

If after re-publication of the CTMA in part A.2. of the Bulletin further to a mistake of the Office, a “first publication opponent” wishes to withdraw his

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<sup>42</sup> Amended on 29/02/2008

opposition as a consequence of the re-publication, the proceedings should be closed. As the Office made a mistake with the first publication, the opposition fee should be reimbursed.

## **2. Refund in view of withdrawals of CTM application**

### *2.1. CTMA withdrawn/restricted before the end of the cooling off period*

**R 18(2), (4) (5) CTMIR**

If the applicant withdraws his CTM application or withdraws all those goods and services against the opposition is directed before or during the cooling off period, the opposition proceedings are closed, there is no decision on costs and the opposition fee must be refunded.

### *2.2. Opposition withdrawn due to restriction of CTMA within the cooling off period*

**R 18(3), (4) (5) CTMIR**

If during the cooling-off period, the applicant withdraws some of the goods and services against which the opposition is directed, the Office invites the opponent to state whether he maintains the opposition (and if yes, against which of the remaining goods and services) or if he withdraws it in view of the restriction.

If the opposition is then withdrawn, the opposition proceedings are closed, there is no decision on costs and the opposition fee must be refunded.

If the withdrawal of the opposition is received by the Office before the official notification of the restriction is copied to the opponent, the withdrawal is considered to be as a consequence of the restriction and the opposition fee is also refunded.

When for example the letter withdrawing the opposition is received by the Office before the Office has sent the notification to the opponent but after the applicant's letter limiting the CTMA was received by the Office, the opposition fee will be refunded. In some cases, in one of the two letters received from the parties a reference is made to the content of the other letter, e.g. "...the opposition is withdrawn because of the limitation of the goods and services...". But the opponent's letter does not have to make an express reference to the limitation, as long as it is later in time than the applicant's withdrawal.

The initial reaction of the opponent to the notification does not matter, as long as the withdrawal is declared later. Examples:

- The opponent does not reply within the time limit given to him but subsequently withdraws his opposition within the cooling-off period (that has been extended)

- The opponent responds by maintaining his opposition, but nevertheless withdraws the opposition still within the extended cooling-off period.

### **3. Cases where the opposition fee is not refunded**

#### *3.1. Opposition withdrawn before the end of the cooling-off period NOT due to a restriction*

**R 18(3)(4)(5) CTMIR**

If the opponent withdraws his opposition before the end of the cooling-off period and there has been no restriction of the CTM application, the Office neither refunds the opposition fee nor takes a decision on costs.

#### *3.2. Opponent's withdrawal is earlier*

**R 18 (3)(5) CTMIR**

When the opposition is withdrawn earlier than the applicant limits his application, the fee is not refunded. For example, if the applicant withdraws his application following (as a reaction to) the withdrawal of the opposition, the fee is not refunded, as this is the opposite situation.

The same applies when the applicant restricts the application following a partial withdrawal of the opposition.

#### *3.3. Settlement between the parties before commencement of proceedings*

**R 18 (2) (4) CTMIR**

If the Office is informed about a settlement between the parties during the cooling off period, the opposition proceedings are closed without decision on costs.

As regards the refund of the opposition fee, Rule 18(5) CTMIR only mentions this possibility if there is either a withdrawal or a limitation of the CTMA. If the proceedings end by an agreement, but this agreement does not contain any mention of a withdrawal or limitation of the CTMA (e.g. "We hereby terminate the proceedings because both parties have reached an agreement."), then the opposition fee is NOT refunded as this situation is not contemplated in the CTMIR as a reason for refunding the opposition fee.

#### *3.4. Termination of proceedings for other reasons*

**Art. 40, 92 (2) CTMR, R 17, 18, 76(1) (4) CTMIR**

In cases where the application is rejected in accordance with:  
Article 40 CTMR (observations from third parties),  
Article 92(2) CTMR (representation for non-EU applicants) and

Rule 76(4) CTMIR (authorisations when expressly asked for by one of the parties), the opposition fee must not be refunded as none of these situations is contemplated in the CTMIR as a reason for refunding the opposition fee.

### 3.5. *Reaction on disclaimer*

#### **Art. 37 CTMR**

If the applicant makes a disclaimer (disclaims an element of the opposed CTM application as being non-distinctive), and if thereafter the opponent withdraws the opposition, the opposition fee shall not be refunded, as a disclaimer does not constitute a limitation of the list of goods and services of the CTM application.

### **4. Mistaken refund of the opposition fee due to a wrong status**

Where the opposition fee has been mistakenly refunded due to the fact that the opposition had been put in the wrong status (in particular, when 254 letters were sent) and if the opponent has a current account, the Financial Department automatically redebits this account when receiving the information about the mistake. In such cases we should send a letter to the opponent explaining the situation before informing the Financial Department.

### **5. Multiple oppositions**

#### **R 21(4) CTMIR**

In certain special cases concerning multiple oppositions, it is possible to refund 50% of the opposition fee to an opponent if one of the opposition proceedings was terminated by the rejection of the contested CTMA in parallel opposition proceedings. For example, if there are four oppositions A, B, C and D (opponents A, B, C, D) against CTMA X, and CTMA X is rejected due to opposition A, then opponents B, C and D have the possibility of receiving a 50% refund of the opposition fee.

Where there are multiple oppositions and the CTM application is rejected due to one of the oppositions, this 50% refund of the opposition fee is given if the other oppositions (B, C and D) have been suspended at an early stage of the proceedings, (i.e. before the expiry of the cooling-off period) because a preliminary examination revealed that CTMA X would probably be rejected in its entirety because of opposition A.

## **V. DECISION ON THE APPORTIONMENT OF COSTS**

### **1. In which cases must a decision on costs be taken?**

#### **Art. 85 CTMR, R 18 (4), 94 CTMIR**

#### **Art. 85 (4) CTMR**

A decision on costs has to be taken in all opposition proceedings that have passed the cooling off stage, i.e. where the adversarial part of the proceedings has started, and that have come to an end. No decision on costs is taken for oppositions that are closed before or during the cooling off period. (See express provision in Rule 18 (4) CTMIR)

If a decision on substance is taken, the decision on apportionment of costs is given at the end of the decision. In all other cases where the Opposition Division close the case, a separate decision on costs is issued on request.

The Office informs both parties when it will render a decision on costs. The parties may send arguments.

## **2. In which cases is a decision on costs not to be taken?**

### *2.1. Agreement on costs*

#### **Art. 85 (5) CTMR**

Whenever the parties have settled the opposition proceedings with an agreement that includes the costs, the Office will not issue a decision on costs. The same is true if the Office receives information signed by both parties stating that the parties have agreed on costs. Such a request can also be sent in two separate letters to the Office.

If the parties settle the opposition by mutual agreement, they are free not to include the cost issue. ~~If no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs immediately, together with the confirmation of the withdrawal. If the parties inform the Office that they had reached an agreement on costs after the withdrawal, the already issued decision on costs will not be revised by the Office. It is left to the parties to respect the agreement and not to “execute” the Office’s decision on costs. They can ask the Office to decide on the costs and the Office will proceed accordingly.~~<sup>43</sup>

### *2.2. Information from “potential winning party”.*

When the party that will eventually win the proceedings informs the Office that he accepts each party bearing their own costs, no cost decision is necessary. The Office will refrain from taking a decision on costs whenever the potential “winning party” informs the Office that he agrees to share the costs even if the “losing party” does not confirm his agreement. The latest letters from both parties have therefore to be checked carefully before issuing a decision.

If however the losing party sends such a request to the Office, it will simply be forwarded to the other party, but the decision on costs will be taken ex officio under normal rules.

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<sup>43</sup> Amended on 29/02/2008

### 3. Standard cases of decisions on costs

Art. 85 (1) CTMR,

R 94 CTMR

Art. 85 (2) CTMR

The general rule is that the losing party, or the party who terminates the proceedings by withdrawing the CTM application or opposition, shall bear the fees incurred by the other party as well as all costs incurred by it essential to the proceedings.

If both parties lose in part, a “different apportionment” has to be decided. As a general rule, it is equitable that each party bears its own costs. ~~unless the goods and services on which one party loses are clearly negligible. As it is almost impossible to make an analysis just on the number of goods and services (they may be general or specific, and economically relevant for the parties or not), an apportionment different from that each party bears its own costs is only advisable if the goods and services on which one party loses are clearly negligible.~~

~~A “different apportionment” can also be decided on reasons of equity, for example to sanction improper procedural behaviour that has artificially extended the procedure or created unnecessary processing costs for the other party. However, the correctness of the behaviour of the parties during the proceedings cannot and will not be assessed by the Office.<sup>44</sup>~~

A party which terminates the proceedings is deemed to have given in. The hypothetical outcome of the case if a decision on substance had become necessary is absolutely irrelevant.

In standard cases the result is the following.

- The applicant withdraws or restricts his application to the goods and services the opposition is not directed at (partial withdrawal). In these cases the applicant has to pay the costs.
- The opponent withdraws his opposition without any restriction of the CTM application as regards the contested goods and services after the cooling off period. The opponent has to pay the costs.
- Restriction of the application followed by withdrawal of the opposition. In principle each party bears their own costs. The correct provision is Article 85 (3) in conjunction with (2) CTMR (see Judgment of the CFI T-124/02, Vitataste, par. 56). The relevant paragraph of the costs template reads:

“In the present case the opponent withdrew his opposition following a restriction of the applicant’s specification. Such a restriction is equivalent to the partial withdrawal of the application. To this extent the opponent was

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<sup>44</sup> Amended on 6/10/2010

successful in the proceedings. However, the restriction of the application was more limited than the scope of the opposition. To this extent the applicant was also successful in the proceedings. Consequently, the Office concludes that it is equitable that each party should bear its own costs.”

A different apportionment of costs is justified if the application was only limited to a very small extent (see Article 85(2) CTMR).

~~Prior to taking a decision the parties must be given an opportunity to submit a cost agreement.~~ The Office will take into account any agreement furnished **in time before the decision on costs is taken** but will not take into account arguments of the parties as to who should pay and in particular will not judge the correctness of the behaviour of the parties during the proceedings. **Once again, if the parties inform that they have reached an agreement after the withdrawal, the decision on costs already issued by the Office will not be revised.**<sup>45</sup>

#### **4. Cases that did not proceed to judgment**

##### *4.1. Multiple oppositions*

##### *4.1.1. Complete rejection of the CTM application*

In cases where there are multiple oppositions against the same CTM application and these have not been suspended by the Office in accordance with Rule 21 (2) CTMIR, and one opposition leads to the rejection of the CTM application, the Office does not take any action in the other oppositions until the appeal period has elapsed.

If the appeal period elapses without an appeal being filed, the Office closes the other opposition proceedings and the cases do not proceed to judgment.

In this case the costs are at the discretion of the Opposition Division (Article 85(4) CTMR). The Office is not able to determine who is the “winning or losing party”, and the applicant should not be required to pay the costs of several other opponents if he loses by one decision on substance. Therefore, applying a principle of equity, each party shall be ordered to bear her own costs.

It is not appropriate to ask the parties to submit a cost agreement in an opposition which was neither terminated by the parties themselves, nor decided on by the Office.

Therefore, when these oppositions are closed no “cost agreement-paragraph” is added to the notification.

##### *4.1.2. Partial rejection of the CTM application*

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<sup>45</sup> Amended on 29/02/2008

In cases of multiple oppositions which are partially directed against the same goods and services of the CTM application, the outcome of the decision which is taken first might affect the other opposition.

Example: if opposition A is directed against class 1 and opposition B against classes 1 and 2 of the CTM application, the situation may arise that first a decision is taken in opposition A rejecting the application as regards class 1. In this case, further processing depends on whether this decision has been appealed or not.

If the decision has been appealed, a decision must be taken in opposition B evaluating the conflict as regards classes 1 and 2 of the CTM application, since the decision in opposition A has not become final yet.

If the decision has become final, a decision must be taken in opposition B only evaluating the conflict as regards class 2 of the CTM application, since the decision in opposition A has become final and class 1 of the CTM application no longer exists.

This leads to the question of how to apportion the costs in cases where opposition B is unsuccessful as regards the remaining class 2.

In spite of the fact that the opponent loses the (remaining scope of the) opposition in total, the situation is comparable to the complete rejection in another opposition and the applicant cannot be considered the 100 % winner when looking at the scope of the opposition. In such (or similar) situations the discretionary power based on equity reasons pursuant to Article 85(2) CTMR should be exercised in such a way that each party shall bear their own costs. The special circumstances leading to this finding have to be sufficiently explained in the cost-part of the decision, refraining, however, from a hypothetical analysis whether the opposition would also have been successful as regards class 1.

#### *4.2. Rejection of application by an Examiner*

A CTM application can be rejected during an opposition procedure on absolute grounds for refusal (either on the basis of third party observations, Article 40 CTMR, or even ex officio if the case is re-opened) or on formalities (for example if an applicant from outside the EC is no longer represented under Article 92 (2) CTMR).

Once the rejection becomes final, the opposition proceedings are closed by issuing a notification.

In these situations the practice on costs is as follows. If the refusal becomes final after expiry of the cooling off period, a decision on costs is taken pursuant to Article 85(4) CTMR. This article provides that in cases that do not proceed to judgment the costs are at the discretion of the Office. Then each party should pay their own costs.

If on the other hand, the same situation arises before commencement of the adversarial part, no decision on costs is to be taken. Nor can the opposition fee be refunded as the application was not withdrawn or restricted.

#### 4.3. Cases of joinder

##### R 21 (4) CTMIR

Rule 21 CTMIR provides for the Office to deal with multiple oppositions in one set of proceedings (joinder). A typical example would be where there are three oppositions against the same mark and the three opponents are related companies and have the same representative. In case of joinder, the Office shall refund 50 % of the opposition fee paid by each opposing party whose opposition is deemed to have been disposed of.

When the examiner has not suspended any of the oppositions the provisions on costs and fees of Rule 21(3) and (4) CTMIR do not apply.

In cases where the opposition succeeds in its entirety the applicant should pay the opposition fees paid by each of the opponents but representation costs only once. If the applicant wins, his representation costs will be awarded once but each of the joint opponents will be liable for them. A different apportionment of costs might be equitable. In cases of partial success or if equitable for other reasons, each party should bear her own costs.

#### 4.4. The meaning of “bear one’s own costs”

The notion of fees and costs comprises the opposition fee and the costs essential to the proceedings, as referred to in Article 85 (1) CTMR and Rule 94 (6) and (7) CTMIR, which in most cases are the costs of the remuneration of an agent within the limits of the scales set. “Each party shall bear her own costs” means that no party has a claim to the other party. If the amount in issue, is the claim to the opposition fee paid by the opponent, it is not shared between the parties.

## VI. FIXING OF COSTS

##### Art. 85(6) CTMR

##### R 94 CTMIR

Where the costs are limited to representation costs and the opposition fee, the decision fixing the amount of costs shall be included in the decision on the apportionment of the costs (i.e. as a rule, in the decision on substance).

That means that in 99 % of the cases a separate fixing of the amount of costs will be unnecessary.

The exceptions are only:

- when an oral hearing took place,
- when the decision was taken before 25 July 2005 (i.e. before the amendment of Article 85 CTMR entered into force),

- when the fixing of costs was inadvertently omitted (“forgotten”) in the main decision.

## 1. Amounts to be reimbursed

### R 94 (6) CTMIR

As regards fees, the amount is limited to the opposition fee of 350 euro if the opponent wins.

### R. 93 (3) CTMIR

As regards representation costs, the amount is limited to 300 euro. This applies both to the opponent and the applicant, under the condition that he/she was represented in the opposition procedure by a professional representative within the meaning of Article 93 CTMR irrespective of whether they have been actually incurred. *The winning party who is no longer represented by a professional representative at the time of taking a decision (or closing the proceedings after the cooling off period, as the case may be) is also entitled to an award of costs regardless of the stage of the proceedings when professional representation ceased. This is without prejudice to the need to appoint a professional representative where it is mandatory.*<sup>46</sup>

Representation costs for employees, even from another company with economic connections, are not reimbursable.

When the case is remitted by the Boards of Appeal, the situation is:

- The first decision (which was appealed) has not become final, even not as regards apportionment or fixing of costs.
- As regards the costs of the opposition procedure, one single decision on the apportionment and on the fixing of costs must be taken for the opposition procedure as a whole.
- As regards the costs of the appeal procedure, it has to be ascertained whether the Boards did decide on them. The notion of “winning party” has to be applied to the outcome of the appeal procedure with the result that the decision can be different for the two instances. The amount of reimbursable representation costs for the appeal procedure is 550 euro, which apply in addition to the representation costs for the opposition procedure.

The amount to be reimbursed is always fixed in euro, regardless of the currency in which the party had to pay her representative.

## 2. Procedure if the fixing is contained in the main decision

### R 94 (3) CTMIR

Where the decision fixing the amount of costs is included in the decision on the apportionment of the costs, no bill or proof whatsoever is needed. We know that the opposition fee was paid, and if there is a representative the 300

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<sup>46</sup> Amended on 9/11/2010

euro must be awarded irrespective of whether the costs have actually been incurred. In fact, no representative would work for less than 300 euro.

No correspondence with the parties about the amount to be fixed is necessary. The fixing of the amount will be standardised and automatic.

### **3. Procedure if a separate fixing is needed**

The following procedural requirements apply in the rare cases where a separate fixing must be made (including when it was inadvertently omitted, also in that case the party concerned must comply with the applicable requirements):

#### *3.1. Admissibility*

**Art. 85(6) CTMR**

The request for fixation of costs is only admissible once the decision in respect of which the fixing of cost is required has become final and until two months after that date.

#### *3.2. Evidence*

**R 94(3) CTMIR**

For awarding the opposition fee, no evidence is needed.

For awarding the representation costs at the standard rate, an assurance by the representative that the costs have been incurred is sufficient. A fortiori, if a bill is presented, it suffices that it shows at least the reimbursable amount, and it does not matter whether it is addressed to the party to the proceedings, as submitting a bill equals an assurance.

For all other costs (which will apply in extremely rare cases), a bill and supporting evidence is needed but it suffices that they establish a plausibility (rather than full-fledged proof) that the costs have been incurred.

#### *3.3. Confidentiality*

In some cases representatives do not want their tariffs to be known to third parties. However it is not possible to keep the evidence confidential *vis-à-vis* the paying party, as this party must know on what grounds the fixation is made.

If the winning party requests the Office to keep the evidence confidential, the Office must inform him that this is not possible, and proceed directly to the fixing of the costs.

### **4. Review of fixings of costs**

**Art. 85(6) CTMR, R 94(4) CTMIR**

If one of the parties disagrees with the fixation of costs, he can ask for review of the decision. The request must state the reasons and be filed within one month after the date of notification of the fixation. If the fixation was contained in the decision on costs, the one month period shall start with the date on which that decision becomes final. The request is only deemed to be filed when the fee for review of 100 euro has been paid.

There are no reimbursable costs in the review procedure (see Decision R0503/2001-4.- BIOLACT/BIO).

## **E. PROCEDURAL ISSUES**

### **I. CORRECTION OF MISTAKES**

#### **1. Correction of mistakes in the opposition notice**

There are no special provisions in the Regulations on correction of mistakes in the notice of opposition. Applying Article 43(2) CTMR by analogy, obvious mistakes in the notice of opposition may be amended.

If it is clear what the right indication should have been, the mistake can be deemed obvious and may be amended.

For example, if the data of the opponent appear where the data of the representative should appear, this can be considered an obvious mistake. On the contrary, if the opponent in the notice of opposition is Dundee Ltd, but the opponent informs the Office later on in the proceedings that he made a mistake and that the real opponent is Dundee PLC, this cannot be considered an obvious mistake, as the Office could not have guessed that the opponent should have been Dundee PLC when examining the opposition. Consequently the mistake cannot be corrected.

#### **2. Correction of mistakes and errors in publications**

**R 14 CTMIR, Art. 41(2)CTMR**

Where the publication of the application contains a mistake or error attributable to the Office, the Office shall correct the mistake or error acting on its own initiative or at the request of the applicant. The request is not subject to the payment of a fee.

The corrections effected under this Rule have to be published. If the correction concerns mistakes that do not affect the opposition, it will be published when the CTM is registered. Where the correction concerns an extension of the list of goods or services or the representation of the mark, a new opposition period is open.

If oppositions were filed after the “first” publication of the CTMA, the opponents will have to be informed of the re-publication. The opponents that opposed the “first” publication do not have to file a new opposition. The proceedings must be suspended until the opposition period following the “second” publication has expired.

Although it is only a remote possibility, it could be that a “first publication opponent” wishes to withdraw his opposition as a consequence of the re-publication. In this case the proceedings should be closed and the opposition fee should be refunded. (See Chapter D. IV Fee refund, 1.3)

## II. TIME LIMITS

### 1. Function of time limits

**Com. N°6/05 of 16/9/2005**

Time limits are regarded as an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is calculated to ensure clarity and legal certainty. They are not subject to the will or discretion of the parties and it is not for the parties to extend them at their own convenience.

New Article 82 CTMR provides for the availability of further processing when time limits have been missed. By completing the missed action and applying for further processing, and paying the corresponding fee (€ 400), the effects of having missed the time limit are avoided. There is no need to prove due care, and there is no other substantive requirement.

Article 82 (2) CTMR contains a list of time limits that are excluded from further processing. Where the question of whether further processing is available or not can be answered by checking Communication N° 6/05 of the President of the Office of 16 September 2005 on restoration into missed time limits

Therefore, time limits have to be strictly observed by the parties. As a counterpart, in case of a missed time limit, a party can benefit from continuation of proceedings under the conditions mentioned above.

Non-compliance with a given deadline will necessarily lead to the rejection of submissions made after its expiry, meaning that belated evidence, observations, or proof of use will not be taken into account, with all the adverse consequences this might entail for the party concerned.

The same applies to supplementary materials attached only to the confirmation copy of a letter that was in itself sent on time (usually by fax), where this confirmation mail arrives after the expiry of the deadline. This is irrespective of whether such materials are specifically mentioned in the initial letter.

Rule 19 (4) CTMIR, which is applicable to the whole opposition proceedings, expressly mandates that any written submission or document that has not been furnished within the time limits set by the Office has necessarily to be disregarded. This legal sanction is clear and leaves no discretion for the Office.

Furthermore, for proof of use, Rule 22 (2) CTMIR expressly provides a sanction if this was not furnished within the time limits set: the Office must reject the opposition. Again, there is no discretion to act otherwise.

**R 71(1) CTMIR**

The Office is obliged to set time limits no shorter than one month for persons who have their domicile or for companies that have their seat within the EU. A

two-month time limit has to be given to persons who have their domicile or companies that have their seat outside the EU.

The Office normally sets time limits of two months as the two months given to the applicant to submitting observations in reply to the opposition under Rule 20(2) CTMIR.

For calculation of time limits and calculating the legal notification dates, see the Manual, Part A.

## 2. Extension of time limits

### 2.1. Request made in time<sup>47</sup>

Note: Extensions of the cooling-off period have a special regime,

For an extension to be granted the request has to fulfil the following conditions:

- The time limit must be extendable.
- The extension has to be requested by the party concerned.
- The request has to be signed.
- The original time limit must not have expired already.
- Language regime: if the request is not in the language of the proceedings a translation must be submitted within one month of filing, otherwise the request will not be taken into account.
- ~~- Reasons must be given.~~

An extension will only be possible if ~~(a) the relevant request is made before the expiry of the original term and (b) it is appropriate in the circumstances, or the other party agrees with it.~~ If a request for extension is received by the Office after the expiry of the period of time it must be rejected.

Any first request for an extension which is received in time will always be granted independently of the explanation given by the party requesting it. However, any subsequent request for an extension of the same period of time will be refused, unless the party requesting it duly explains and justifies which are the exceptional circumstances that did not allow it to meet the original period and the first extension and why it is necessary a further extension. General, vague or standard explanations will not justify a second extension.

~~If both parties request an extension of an extendable time limit, or the requesting party furnishes the written agreement of the other party, no further justification will have to be given.~~

~~If only one party requests the extension, this~~ The request has to be filed by the party concerned **by the deadline**. For example, if the applicant has to file observations in reply to the notice of opposition, it can only be the applicant who asks for the extension. ~~In this case a justification has to be given.~~

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<sup>47</sup> Paragraph 2.1. amended on 15/09/2010

~~If no justification is given for the request, it will be rejected.~~

Extensions of time limits shall be for the period requested, which may be a period which is not in full months (for example, for “three weeks” or “until 2 September”).

## 2.2. *Non-extendable and extendable time limits*

**R 71(1) CTMIR**

Time limits the length of which is set by the Regulation cannot be extended. Non-extendable time limits are:

**Art. 41(1) CTMR**

The three month opposition period to file opposition.

**Art. 41(3) CTMR**

The three month period to pay the opposition fee.

**Art. 8(3) (b) FR**

The one month period to pay the surcharge where payment arrives late and no proof is made that it was initiated at least 10 days before expiry of the time limit for payment.

**R 17(4) CTMIR**

The two month time limit to remedy deficiencies according to Rule 17(4) CTMIR.

**R 71(1)CTMIR**

Extendable time limits are time limits the length of which is to be specified by the Office, for example the time limit to submit observations in reply to the notice of opposition.

## 2.3. *Reasons, justification*<sup>48</sup>

**R 71(1), 79, 80(3), 82(3), 96(1) CTMIR**

As mentioned before, any first request for an extension which is received in time will always be granted independently of the explanation given by the party requesting it. However, any subsequent request for an extension of the same period of time will be refused, unless the party requesting it duly explains and justifies which are the exceptional circumstances that did not allow it to meet

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<sup>48</sup> Paragraph 2.3. amended on 15/09/2010

the original period and the first extension and why it is necessary a further extension. General, vague or standard explanations will not justify a second extension.

This is because, in accordance with Rule 71(1) CTMIR, the Office may grant an extension “when this is appropriate under the circumstances”. It is the party requesting the second extension that has to put forward the “appropriate circumstances”. The evaluation of these circumstances is made by the Office on a case by case basis, taking into account not only the justification given in the request, but also any other relevant factors, such as the number of extensions already granted, the interest of the other party, etc.

~~In general~~ As indicated above, general, vague or standard explanations will not justify a second extension. In this regard, mere declarations stating that an additional period is needed (the consequence) ~~cannot be considered as~~ **are not** valid justifications (such as “An extension is needed”). ~~It has to be reasonably explained why a period of time was insufficient to comply with the Office’s request (reason).~~

~~Although the practice is a flexible one, the following examples are deemed insufficient to justify an extension, as they only state the consequence: “An extension is needed”, “The opponent/applicant has not yet provided instructions or is not available” or “More time is requested to gather the evidence requested”.~~

~~Examples of justifications that can be accepted (where a reason is given): “Evidence is being gathered from distribution channels in several Member States/all our licensees/our suppliers”, “As there have been last minute discussions with the other party, the observations/evidence have not yet been completed”, “The parties started negotiations” or “the lawyer who is handling this file is recovering from a serious illness”.~~

Considering that the first extension is given automatically, the practice as regards the second extension is much stricter: “exceptional circumstances” are required. “Exceptional circumstances” entail events that are beyond reasonable control of the parties.

The party requesting an extension must explain and justify which are the exceptional circumstances that (a) prevented it from performing the required action during the previous two periods and (b) still prevent it from performing it, so that more time is needed.

Examples of justifications that can be accepted:

- “Evidence is being gathered from distribution channels in several Member States/all our licensees/our suppliers, so far we have gathered documents from part of them but, due to a change in the commercial structure of the company (as shown in the document enclosed), only recently we have been able to get in contact with the rest”.

- “In order to show that the mark has acquired reputation we started market polls at the beginning of the period (on date X), the field work was, however, only concluded recently (as shown in the enclosed documents), as a consequence, we need a second extension to finish the analysis and prepare our submissions to the Office”

Death is also considered “exceptional circumstances”. The same applies to serious illness, provided that no reasonable substitution was available.

Finally, “exceptional circumstances” also include “force majeure” situations. “Force majeure” is defined as a natural and unavoidable catastrophe that interrupts the expected course of events. It includes natural disasters, wars and terrorism, unavoidable events that are beyond the party's control.

On the other hand, circumstances that are within the control of the party concerned are not “exceptional circumstances”. For example, last minute discussions with the other party are no “exceptional circumstances”. These are within the control of the parties.

#### 2.4. *Conditions for granting ~~a further~~ third and subsequent extensions*<sup>49</sup>

The Regulations do not put any limit to the number and duration of the extensions that can be granted by the Office. Nevertheless after having extended a time ~~limit once~~ **twice** at the request of one party, the party will need to indicate some new ~~grounds or a further explanation~~ **“exceptional circumstances”** when asking for another extension. In addition, the Office always has the possibility of subjecting the extension to the agreement of the other party (R 71(2) CTMIR). Since this option is time consuming, it is not frequently used. The Office will refuse to extend a time limit when it is not appropriate under the circumstances (R 71(1) CTMIR), see above.

#### 2.5. *Extension of a time limit by the Office on its own initiative*

The Office can extend a time limit on its own initiative, if and when particular reasons make it necessary. For example, a request to extend a time limit without any justification is received by the Office 20 days before the end of the period to file observations, but it was not dealt with until after expiry of the time limit. Because the refusal of the request after expiry of the time limit will disproportionately harm the interests of the party who requested the extension, the Office extends the time limit by the number of days that were left when the party sent in his request, in this case 20 days. This practice is based on the rules of fair administration.

#### 2.6. *Signature*

**R 79 CTMIR**

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<sup>49</sup> Paragraph 2.4. amended on 15/09/2010

If one of the requests is not signed, first it has to be checked if a signed request was received later. Sometimes parties forget to sign but realise this after having sent it, sign and send it again.

A joint request has to be signed by both parties and to be received within the cooling-off period. A request signed by one of the representatives who assures the Office that the other party agrees to the extension of the cooling-off period is not acceptable. Both parties will have to sign.

If the signature of one of the parties is missing, the extension is to be rejected.

### III. SUSPENSION

#### R 20(7) CTMIR

A suspension of opposition proceedings can be decided by the Office acting ex officio, at the request of both parties or at the request of one of the parties.

~~If the suspension is requested by both parties after expiry of the cooling-off period, the Office will suspend the proceedings, even when no reasons are given. In this case the parties have to indicate the period for which the suspension is requested (although a proper reason should be given if the period of the suspension requested is abnormally very long, e.g. one two years or more). If the parties do not indicate the period, the proceedings will be suspended for two months. If the parties ask for a new suspension after a first suspension has been granted and if it is granted, the Office automatically grant a period of one year, giving the parties the possibility to opt out. The process for opting out is the same as for the extension of the cooling-off period: if one of the parties opts out, the suspension will end 14 days after informing the parties thereof. The proceedings will resume the day after and the party to submit observation will be given two months to do so.~~<sup>50</sup>

If the suspension is requested by both parties after expiry of the cooling-off period, the Office will suspend the proceedings, even when no reasons are given. In these cases, and regardless the period requested by the parties, the first suspension will be given for a period of one year giving the parties the possibility to opt out. The process for opting out is the same as for the extension of the cooling off period: if one of the parties opts out, the suspension will end 14 days after informing the parties thereof. The proceedings will resume the day after and the party to submit observation will be given two months to do so. The previous two-step-practice where the first extension was granted for the period the parties' requested and the second for one year is abolished: the period of one year will be granted from the first request irrespectively from what it is requested.<sup>51</sup>

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<sup>50</sup> Amended on 29/02/2008

<sup>51</sup> Amended on 15/09/2010

If the opposition is suspended by the Office acting *ex officio* or at the request of one of the parties, the decision of suspension must be based on proper reasons. The CTMIR contemplates three specific cases where the proceedings may be suspended:

- The opposition is based on an application for registration of a trade mark
- The opposition is based on an application for registration for a geographical indication or designation of origin
- Multiple oppositions;

Apart from these three specific cases the CTMIR stipulates that opposition proceedings may be suspended:

- Where circumstances are such that such suspension is appropriate.

The most common unspecified cases where in principle oppositions may be suspended are the following:

- The trade mark registration on which the opposition is based is subject of administrative or judicial proceedings that may affect the registration or the opponent's entitlement to it.
- The parties are negotiating the settlement of the opposition.

There are some other situations where the suspension may also be advisable or even necessary, such as third party observations, errors in the publication of the contested application which require re-publication, transfer pending on earlier CTMs/CTMAs or contested CTMA, withdrawal of the representative. This chapter does not deal with these cases.

It should be noted that in none of the above-mentioned cases is there an obligation to suspend the proceedings. The decision is at the discretion of the Office. This means that none of the above situations, *per se*, confer on any of the parties the right to have the proceedings suspended. On the other hand, when the circumstances of the case call for a halt in the proceedings, the examiner is expected to suspend the proceedings.

Moreover, the fact that the CTMIR contains specific rules for the case of multiple oppositions and the case where the opposition is based on an application for registration, or an application for registration for a geographical indication or designation of origin, does suggest that the proceedings should be suspended or at least that the possibility of suspending the proceedings should be duly considered. The decision of suspending the proceedings or not ultimately depends on the circumstances of the case. In the following sections, the most common circumstances that may lead to declare or exclude the suspension of the proceedings are explained.

## **1. The opposition is based on a trade mark application/an application for a geographical indication or designation of origin**

### *1.1. Explanation of the basic principle, moment to suspend*

**R 20(7) CTMIR**

In principle oppositions based on applications are not to be suspended, at least not at the very beginning of the proceedings. The assumption is that in most of the cases the applications mature into registrations, during the proceedings.

Assuming that the opponent files sufficient evidence of ownership of a national application, the opposition will proceed until it is ready to be decided (the same will happen with earlier CTMAs which do not require any evidence). Before closing the proceedings EUROMARC must be checked (in cases of an earlier CTMA) or, in the other cases, the opponent must be requested to provide information on the status of the application. If at that stage the application is still pending, the possibility of suspending the proceedings must be considered.

In the following exceptional cases the Office suspends during the proceedings:

- Earlier right is a CTMA: check if the application is facing problems. If so, consider the probable outcome of the opposition in order to decide on the suspension.
- Earlier right is a national application: one of the parties requests the suspension and brings evidence that the application is facing problems. If so, consider the probable outcome of the opposition in order to decide on the suspension.

### *1.2. Exceptions to the basic principle*

Exceptions will only occur when two cumulative conditions are fulfilled:

(1) The earlier application is facing problems. When the Office has information that the earlier application is facing problems the general assumption that the application will mature to registration is no longer valid. The earlier application is considered as facing problems when objections are raised by the trade mark office, when oppositions are pending against it or when there is a refusal waiting to become final.

(2) The final decision cannot be issued without taking into account the earlier application. This is when the circumstances of the case do not allow us to say that in any case the opposition will be rejected (e.g. because there is no likelihood of confusion) or upheld (because there are other earlier rights that are sufficient to reject the contested CTMA).

The second condition deserves a closer look. Does the application in question make a difference to the outcome of the opposition?

When the answer is clearly negative, the proceedings should not be suspended. This includes the cases where the opposition will be rejected anyway and the opposite cases where the opposition will be successful anyway (because the opposition is also based on other earlier rights, one or some of which are clear “winners”).

When an opposition is based on an application for registration, it may be appropriate to suspend the opposition proceedings under Rule 20(7) CTMIR, to await registration of the opponent's earlier mark. Nevertheless, if an opposition is to be rejected, either for formal or for substantive reasons, a suspension would be meaningless and would simply prolong the proceedings unnecessarily.

When there are no other earlier rights to take into account (because there are no other earlier rights or they were not substantiated) or when the application must nevertheless be taken into account (because the other earlier rights are not "winners"), an assessment must be made of whether the opposition will be successful on the basis of the application, in order to decide on the suspension. Proceedings will only be suspended if it is found that the earlier application, if registered, will lead to the total or partial rejection of the contested CTMA.

If this assessment is done at an early stage of the proceedings, one must take into account that a preliminary examination of the case is never as deep and thoughtful as when the decision is being drafted. Therefore a certain degree of precaution must be used here. In borderline cases, when the outcome is not clear, the proceedings should in principle be suspended.

### *1.3. Earlier CTM applications*

It should be kept in mind when dealing with the adversarial part of the proceedings that the issue of the suspension may only arise after the cooling-off has expired. For example, the opposition is based on a confusingly similar CTMA but it is not suspended because there is another earlier right (a registered trade mark) on the basis of which the contested application must be rejected. If the opponent fails to substantiate this earlier right, the earlier application, which before was not relevant to the outcome, becomes crucial for the decision. If according to the records the earlier application is facing problems, the opposition should be suspended.

### *1.4. Earlier national applications*

The issue of the suspension will have to be raised by the parties (normally the applicant). In this case the party has to submit evidence that the earlier application is facing problems. Upon such request the Office will consider whether under the circumstances of the case it is advisable to suspend the proceedings.

If no one raises the question the general principle applies, the Office only has to decide on the suspension if the proceedings reach the end and there is no information that the application has matured to registration. In this case the opponent should be required to inform the Office on the status of his earlier application.

In any case, the question of whether to suspend the proceedings because of earlier applications may appear in many different shapes and therefore is a

matter to be decided on a case by case basis. There are no rigid rules here and good sense is the key.

Here are some examples where according to the general practice indicated above the situation apparently does not require a suspension of the proceedings, but the suspension can nevertheless be decided if the examiner finds it appropriate:

The opposition is based on a French trade mark registration and on a CTM application, which does not face problems, both covering the same sign and goods, which are confusingly similar to the contested trade mark. Thus, the opposition may be dealt with on the basis of the French trade mark only. However, confusion can be more likely to occur in Member States other than France (because for example the phonetic similarities are stronger in other Member States). In such a case our decision will be more solid if based on the CTM.

The earlier application does not make too much difference to the outcome, but the applicant requests a suspension. If the earlier right is a CTMA and we conclude that it is facing problems or, in case of a national application, if the applicant files evidence that the opponent's application is facing problems, the proceedings may be suspended. Since in principle the applicant is the most interested party in getting a fast decision, the Office should not insist on the continuation of the proceedings if he prefers to wait.

#### *1.5. Monitoring suspended files*

In the cases where the proceedings are suspended [without a fixed time-limit \(open suspension\)](#), EUROMARC will create due dates every six months. These due dates will help us to check the status of the earlier CTMA and check whether the suspension is still necessary.<sup>52</sup>

In cases where the earlier right is an application for a national registration the resumption of the proceedings will always depend on the initiative of the parties, who are expected to inform the Office when the application matures to registration or is rejected. In any case as the due dates are created automatically by EUROMARC, it must be checked whether there are any "forgotten" links where the parties furnish information on the matter. The opponent may also be requested to inform the Office.

#### *1.6. Resuming the proceedings*

When the time comes for resuming the proceedings, because the earlier application has matured to registration or has been rejected, the parties must obviously be informed of the time limits pending upon resumption. In a case where the proceedings have been suspended from the very beginning, all the dates for the cooling-off period and subsequent time limits are to be set.

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<sup>52</sup> Amended on 29/02/2008

## 2. Multiple oppositions

### R 21(2) CTMIR

#### 2.1. *Explanation of the basic principle, the moment to suspend*

When there is more than one opposition pending against the same CTMA, and if there is a strong case which can lead to the total rejection of the CTMA (or at least of all goods and services contested by the sum of all oppositions), the opposition examiner will regularly suspend the other proceedings until a final decision is reached.

In principle an opposition can only be considered as a very good case if it is founded on Article 8(1)(a) CTMR (identity) and based on a registered trade mark. Experience shows that claims based on well known trade marks or on the reputation allegedly achieved by registered trade marks have more possibilities of being rejected. Thus, suspensions are not very appropriate in these cases - at least at the very beginning of the proceedings. Also, an opposition cannot in principle be considered as strong, for the purpose of suspending all the others, if it is based on an earlier application.

The opposition justifying the suspension of all others must not only be strong. It must be “lethal”, that is, it must be directed against all the goods and services contested by all the oppositions that are to be suspended. This means that only “strong” oppositions directed against all the goods and services contested by the “weaker” oppositions may be considered as “lethal”. Thus, if the CTMA covers all goods in class 9 and the “strong” opposition (sign identical to the CTM) only covers *computers* in class 9, whereas a “weaker” opposition (sign only slightly similar to the CTM) covers all goods in class 9, the “strong” one is not considered “lethal” and Rule 21(2) does not apply. Obviously the opposition must be strong in relation to all the contested goods. No matter how strong it is in relation to a particular category of goods or services, one opposition will not lead to the suspension of all the others in cases where it is weak in relation to some goods or services which are contested in other oppositions.

Finally, nothing prevents the Office from suspending all oppositions except two or more, which combined are “lethal”.

The suspension of oppositions at an early stage involves some risks. The examiner must take care when dealing with withdrawals, substantiation of earlier rights and proof of use in the active proceedings. If the “lethal” opposition is settled or withdrawn (e.g. during the cooling-off period), the suspension of the remaining proceedings must come to an end. If the “lethal” opposition is not substantiated properly, the suspension of the remaining proceedings must be reconsidered and possibly come to an end. The same applies when the opponent fails to furnish proof of use or submits evidence that is clearly insufficient to establish genuine use.

## 2.2. *After rejection of the CTM application*

When the CTMA is subsequently rejected because of the “lethal” opposition, the suspended oppositions will be deemed to have been disposed of after the decision becomes final. Therefore, three months later a check must be made whether any appeal has been entered against the opposition decision. If the decision has become final, the parties to the other proceedings must be informed, the suspended oppositions will be closed and 50% of the opposition fee will be refunded to each opponent, Rule 21(4) CTMIR.

If an appeal has been filed against the decision the oppositions remain suspended. If the BoA reverses the decision the other proceedings will be resumed immediately, without having to wait for such decision to become final.

## 2.3. *Resuming the proceedings*

If the suspended proceedings are to be resumed, in a case where they have been suspended at the very beginning, all the dates for the cooling-off period and subsequent time limits will have to be set, repeating all the usual information and warnings. If the suspension took place after the end of the cooling off period, the proceedings will be resumed at the stage in which they were at the time.

## 3. **Earlier right at risk**

The opposition is suspended if the earlier right on which the opposition is based is under attack, unless this earlier right might not affect the outcome of the opposition.

If the earlier right is a CTM and a cancellation is pending against it, it is suspended *ex officio* at the time of notification of the time limit of the opposition proceedings, unless this earlier right is irrelevant for the outcome of the opposition.

### **R 20(7) CTMIR**

#### 3.1. *Cases*

It should be noted first of all that these situations are similar to the cases where the opposition is based on an application. In both cases there is some uncertainty about the earlier right on which the opposition is based. Nevertheless there are some differences between them which justify a different section. The cases in question here can be divided in two different groups:

Case 1 - The opposition is based on a CTM that is subject to cancellation proceedings. The status of the registration in EUROMARC will have to be checked. In any case the applicant will be informed of the existence of such

proceedings, since the opposition has been notified to him at a very early stage.

Case 2 – In the remaining cases the earlier right is subject to national proceedings. Here the suspension is not decided *ex officio*. The suspension is usually requested by the applicant, who is normally a party to other proceedings where the earlier right or the opponent's entitlement to it is at stake. The outcome of these proceedings must have some impact on the opposition.

The following examples fall into this category:

- the applicant (or a third party) has filed an action or a counterclaim seeking the invalidation or revocation of the earlier registration;
- the applicant (or a third party) has filed an action or a counterclaim seeking the transfer of the earlier right to his own name.

Criminal actions brought against the opponent or actions seeking compensation from the opponent, no matter how related to the earlier trade mark, will not have any impact on the outcome of the opposition proceedings and therefore do not justify suspension.

### *3.2. Factors to consider*

If one of the parties requests the suspension or if we know that there are cancellation proceedings against the earlier CTM, consideration must be given whether the earlier right in question could make a difference, in a *prima facie* opinion, to the outcome of the opposition.

If the opposition is deemed to be successful or rejected anyway, regardless of the fate of the earlier right at risk, the proceedings should not be suspended. If, in contrast, the earlier right at risk must necessarily be taken into account in the decision on the opposition, the proceedings will be suspended. The Office will not judge on the possible success of the national action. Nevertheless, if the other party argues this point, we should invite the parties to file evidence or observations.

If it is concluded that the suspension may take place, the other party may be given the opportunity to comment on the request, in particular if the evidence submitted is not absolutely clear. When the other party is not invited to comment, the examiner may still reverse his finding if the other party reacts to the granting of the suspension.

### *3.3. Evidence*

Be it requested by the opponent or by the applicant, the request for suspension must be supported by evidence. This evidence must be official, clearly identify the proceedings leading to the suspension, and indicate the relief sought.

In particular, the evidence must be clear as to the possible consequences for the earlier right on which the opposition is based. If necessary, the party may be requested to submit a translation of the evidence.

The insufficiency of the evidence may be remedied, if the other party is invited to comment and does not respond or does not contest the existence of such proceedings or their influence on the opposition.

### *3.4. Monitoring suspended files*

In the cases where the proceedings are suspended **without a fixed time-limit (open suspension)**, due dates must be created every six or nine months in order to check if the parties have furnished any new information on the state of the proceedings. The examiner may also invite the parties to inform the Office of the state of the proceedings.<sup>53</sup>

### *3.5. Resuming the proceedings*

Proceedings must be resumed as soon as national proceedings come to an end. If the decision taken in the national proceedings invalidates, revokes, results in some other way in the extinguishment of the right, or transfers the opponent's earlier right, the opposition will be deemed non-substantiated insofar as it is based on that earlier right.

## **4. Ongoing negotiations**

If the request is signed by both parties the proceedings are suspended.

If the request is signed by one of the parties only, we do not, in principle, grant the suspension, unless it is accompanied by a consent signed by the other party.

### **R 20(7) CTMIR**

Generally, when the parties are negotiating they request that the proceedings be suspended, in order to avoid further costs. However, when both parties request the suspension they do not have to give a specific justification. The suspension is always granted. So the question of whether or not ongoing negotiations justify a suspension of the proceedings is only worth considering when one party alone submits the request.

Contrary to our practice for extensions of time, in these cases that answer is generally no. Requests for suspension of proceedings submitted by one of the parties based on ongoing negotiations between the parties will in principle be rejected. Negotiations between the parties are a common occurrence during opposition proceedings and it may be the case that the other party may wish to negotiate provided that such negotiations do not cause any delay to the

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<sup>53</sup> Amended on 29/02/2008

proceedings. Thus, negotiations do not give either of the parties the right to ignore a pending time limit, to get an extension of it or to get a suspension of the proceedings.

Thus, in these cases the request is rejected but the party in question is informed that the Office will suspend the proceedings if both parties submit the request.

As to the period to be granted, please see above under III. SUSPENSION.<sup>54</sup>

## 5. Procedural aspects

Letters suspending the proceedings should always indicate the date the suspension takes effect, generally the date when a valid request was submitted.

If the suspension is decided for a fixed period of time, the letters must also indicate the date when the proceedings are resumed, and what happens after that. Note that when the suspension is requested by both parties because there are on-going negotiations, the period will always be of one year regardless the period requested by the parties.<sup>55</sup>

The date on which the suspension ends will be deleted from the standard letter. It should be noted that suspension periods are not time limits. There are therefore some differences between them.

If on 30/01/2012 a request for a two month suspension signed by both parties and submitted on 15/01/2012 (five days before the expiry of the time limit of the opponent for completing the opposition - 20/01/2012) is dealt with, the result will be:<sup>56</sup>

The Office has suspended the opposition proceedings at the request of both parties.

This suspension takes effect as from 15/01/2012 (the date when the suspension request was received at the Office).

The proceedings will be resumed on ~~15/03~~ 15/01/2013 (one year, regardless the period requested by the parties), with no further notification from the Office.

The time limit for the opponent is now ~~20/03~~ 15/03/2013 (two-fresh full months for the opponent to complete the file).

The time limit for the applicant is now ~~20/05~~ 15/05/2013 (two full months after the opponent's period).

In principle therefore, the pending time limit will continue after resumption of the proceedings and the days that are left until expiry are the same as those that were left at the date of filling of the suspension request.

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<sup>54</sup> Amended on 15/09/2010

<sup>55</sup> Amended on 15/09/2010

<sup>56</sup> Amended on 15/09/2010 (as well as the following five provisions)

However, the situation is not so clear in cases where the proceedings are suspended **without a fixed time-limit (open suspension)** indefinitely. If in the example referred to above the suspension is granted because the opposition is based on a CTM application, the period of suspension will be undetermined. Proceedings will be resumed when the Office says so. In this case, when a year later, after having confirmed that the CTMA will mature into registration, we resume the proceedings, we cannot grant the opponent only five days to complete the opposition file. This is because the proceedings would have been stopped for a year and the resumption would come too suddenly. Under these circumstances five days are not enough to allow the opponent's representative to be in full command of the file. Thus, in situations like this it is advisable, because it is more equitable, to give the opponent a full two-month period once again.<sup>57</sup>

## IV. MULTIPLE OPPOSITIONS

### **R 21 CTMIR**

Multiple oppositions are involved when different oppositions are filed against the same CTM application. Around 20% of all contested applications are opposed by more than one opposition.

In case of multiple oppositions, some extra factors have to be taken into account.

First of all, unless there is a major delay during the admissibility stage concerning one of the oppositions, it is practice to notify the applicant of admissibility of all the oppositions at the same time. Secondly, multiple oppositions may lead to suspension of some of them for reasons of economy of proceedings. Thirdly, a limitation made by the applicant in the course of one of the proceedings may have an impact on the other oppositions. Furthermore, it may be practical to take the decisions in a certain order.

Finally, under certain circumstances multiple oppositions may be joined and dealt with in one set of proceedings.

### **1. Multiple oppositions and limitations**

When there are multiple oppositions and the applicant restricts the goods and services in one of the opposition proceedings, all the other opponents will have to be informed by sending the appropriate letter, insofar as the limitation concerns contested goods or services of the other oppositions.

However, if there is no relation between the goods or services in the limitation and the contested goods and services, the opponent should not be informed.

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<sup>57</sup> Amended on 29/02/2008

For example, there are four oppositions against the same CTM application, applied for goods in classes 3, 14, 18 and 25. Opposition 1 is directed against class 3, opposition 2 against class 25 (*clothing, footwear, headgear*), opposition 3 against classes 18 and 25, and opposition 4 against classes 14 and 25. The applicant sends a limitation in opposition 2, deleting *clothing* and *headgear*. Apart from the appropriate letters in opposition 2, the appropriate letters should also be sent in oppositions 3 and 4. As the limitation does not affect the contested goods of opposition 1, no action is necessary in this opposition.

## **2. Multiple oppositions and decisions**

When none of the oppositions were suspended at a preliminary stage in accordance with Rule 21(2) CTMIR (the case of the 'lethal' opposition), the order in which to take the decisions in the multiple oppositions is to be determined.

Although the order is at the discretion of the examiner, the following has to be taken into account.

If all oppositions will fail the decisions can be taken in any order, as the rejection of the opposition does not affect the CTM application. Even if one of the decisions were to be appealed before the others are taken, it would seem preferable not to suspend as the procedure before the Board of Appeal can take some time.

If all the oppositions (which are ready for decision at about the same time) will be successful, first the opposition eliminating most goods and services of the CTM application (the widest extent of the opposition) should be taken, followed by decisions on the opposition contesting goods or services different from the goods and services contested by the first. In the example mentioned above, the first decision should either be taken in opposition 3 or in opposition 4 and afterwards opposition 1.

Suppose the first decision is taken in opposition 4, and the CTM application is rejected for classes 14 and 25.

If the appeal period has expired and no appeal is filed, opposition 2 is disposed of, as it has become without object. The opponent should be informed and the opposition must be closed. As the opposition was not suspended before commencement of the adversarial part of the proceedings there will be no refund of the 50% of the opposition fee. The case is considered to be a case that has not proceeded to judgement within the meaning of Article 85(4) CTMR. Consequently, the costs are at the discretion of the Office. If the parties inform the Office that they agree on the costs, a decision on costs will not be taken. Generally, the decision will be that each party bears their own costs.

If the appeal period has expired and the decisions are taken more or less at the same time, each and every one of the four decisions should deal with all the contested goods and services of the CTM application.

In the previous example, if opposition 4 is the first that is decided, even though the CTM application has already been rejected for the goods in class 25, the decision in opposition 3 should not only deal with class 18 but also with class 25.

### **3. Joinder of proceedings**

#### **R 21(1) CTMIR**

Rule 21 (1) CTMIR allows the Office to deal with multiple oppositions in one set of proceedings. If it is decided to join the oppositions the parties must be notified.

Oppositions may be joined if they are directed against the same CTM application. It is more likely that the Office would join them if in addition, they were filed by the same opponent or if there is an economic link between the opponents, for example a parent and subsidiary company.

When it is decided to join the oppositions it should be verified whether the opponents have the same representative. If not, they must be asked to appoint one single representative. Also, the earlier rights must be identical or very similar. If the representatives do not reply or do not want to appoint a single representative, the oppositions must be disjoined and dealt with separately.

If at any stage these conditions are no longer fulfilled, for example the one and only earlier right of one of the joined oppositions is transferred to a third party, the joinder may be undone.

Unless the joinder is dissolved before the decision is taken, only one decision is taken.

## **V. NOTIFICATION BY POST; PUBLIC NOTIFICATION**

#### **R 61(2)(a),(d) (e), (3) CTMIR**

The Office has the choice between the various means of notification. The Office will normally communicate with the parties by fax. However, when the party in question does not have a fax machine or when the volume of the documents that is to be sent surpasses 40 pages, notification will be done by post. This is also the case where the colour of the marks is decisive for the outcome of the decision. If these two ways of communicating (fax and post) fail, public notification is the last resort. Finally, there is also the possibility to communicate through MYPAGE.

## 1. Notification by post

### R 62(1) CTMIR

If notification by post is chosen, the means of transmission depend on the nature of the document:

Decisions which are subject to appeal, as well as summonses for an oral hearing, shall be sent by registered mail against advice of delivery, except if the addressee is located outside of the EC.

### R 62(4) CTMIR

Such notification shall be deemed to have been effected even if the addressee refuses to accept the letter.

### R 62 (3) CTMIR

Such notification shall be deemed to have been effected on the 10<sup>th</sup> day after the posting of the letter.

Only if it is proven that the letter failed to reach the addressee, that is, if the letter comes back as undeliverable, notification must be repeated, or we must proceed to public notification.

If the addressee proves that he actually received the letter at a later date that date will constitute the date of notification.

## 2. Public notification

### R 66 CTMIR

### Dec. EX-05-6

Public notification, provided in Rule 66 CTMIR, is only made when the address of the addressee (applicant or opponent within the EU) cannot be established and/or if notification pursuant to Rule 62 CTMIR has failed after at least one attempt.

If notification by fax fails, notification shall first be attempted by mail and only if that fails as well, public notification is available.

According to Decision No EX-05-6 of the President of 27/07/2005, the text of these notifications consists of:

- a) an indication of the proceedings to which the publication relates;
- b) the file number of the Community trade mark application the file number of the proceedings;
- c) the name of the addressee
- d) the address of the addressee known to the Office;
- e) the type of document to be notified;
- f) the date of the document; and,
- g) the place where the document can be inspected;

h) the date on which the notice is made available on the Website.

**Art. 120(1) CTMR**

According to ~~Article~~ Decision No EX-05-6 of the President of the Office, public notification shall be made on the Office's Website, in the language of the proceedings only.<sup>58</sup>

The letter is deemed to be received 1 month after the date of publication. This latter date plus 2 months equals the time limit to be given. For example, if the letter is published on OAMI Online dated 10/05/2005, it is deemed to have been notified on 10/6/2005 and a 2 months deadline to be complied with expires on 10/08/2005.

### **3. Notification through MYPAGE**

**Dec. No ~~EX-04-6~~ EX-07-4<sup>59</sup>**

Pursuant to Decision No ~~EX-04-6~~ EX-07-4 of the President of the Office of ~~14/12/2004~~ 16 July 2007, notification may also be made through MYPAGE if the holder of MYPAGE has accepted this means of notification. Notification consists of making available to the party to the proceedings the electronic document, by placing it on the MYPAGE holder's inbox. The document is deemed to have been notified on the 5th day following its posting, irrespective of whether the recipient actually opened and read the document. The date on which the document was placed shall be mentioned in MyMailbox and shall be recorded by the Office.<sup>60</sup>

For further details on means of notification please refer to Section 1.3 of the Manual, part A. General provisions, notification and communication of documents.

## **VI. CONVERSION**

There is a chapter on conversion in the Office's Manual and there is also a Guide to Conversion Procedure, both available in OAMI ONLINE. For information on conversion in general reference is made to this Manual.

During opposition proceedings, the applicant may file a request for conversion where the contested CTMA is refused totally or partially – Article 112(1) CTMR, and when he withdraws the contested CTMA - Article 112(1) CTMR.

### **1. Informing the applicant**

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<sup>58</sup> Amended on 29/02/2008

<sup>59</sup> Amended on 29/02/2008

<sup>60</sup> Amended on 29/02/2008

Since March 2004, it is no longer required to inform the parties about the possibility of conversion when a decision has been taken.

## 2. Requests made in observations

Even though it is the Recordal Section (hereafter the RS) that deals with conversion requests, the opposition examiner may sometimes directly receive requests for conversion. For example, an applicant may in the same observations reply to the notice of opposition, restrict his CTM application and request a partial conversion.

In these cases, RS might not have a copy of the request. Thus, the examiner should enquire whether a copy was dispatched to RS. If RS has not received the request the examiner must inform RS by copying the request and sending it to them.

## 3. Opposition based on (to be) converted CTM(A)

National applications deriving from the conversion of an earlier CTM(A) are considered to come into existence as soon as a valid conversion request is filed. Such rights will be properly identified for admissibility purposes under Rule 18(1) CTMIR if the opponent indicates the number of the CTM(A) under conversion and the countries for which he has requested the conversion.

~~When during opposition proceedings the CTM(A) on which the opposition is based ceases to exist but at the same time a request for conversion is filed the proceedings must be closed. This is because the earlier right on which the opposition was based has ceased to exist and the subsequent national applications, autonomous and independent, were never the basis of the opposition.<sup>61</sup>~~

When during opposition proceedings the CTMA (or CTM) on which the opposition is based ceases to exist (or the list of goods and services is restricted), but at the same time a request for conversion is filed, the proceedings can continue. This is because national trade mark registrations resulting from a conversion of a CTMA can constitute the basis of the opposition procedure originally made on the basis of that CTMA (See Decision R1313/2006-G).<sup>62</sup>

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<sup>61</sup> Amended on 3/11/2008

<sup>62</sup> Amended on 3/11/2008

In such a case the opponent must notify the office in writing of the intention to rely on a right arising from conversion or submit a copy of the actual request(s) for conversion. If the opposition is at a stage before the deadline for substantiation of the rights, the deadline to file such a notification is the same as that for substantiation. In all other cases the deadline for notification, of the intention to rely on a right arising from conversion, is the date on which the event that triggers the possibility of conversion occurs (e.g. date of withdrawal, date when a decision becoming final, etc). The opponent must notify the Office of the outcome of the conversion request(s).<sup>63</sup>

If the opponent fails to notify the office of the intention to rely on a right arising from conversion, the opposition decision will be made on the basis of the status of the CTM itself at the time when the decision is made.<sup>64</sup>

## VII. REVOCATION

### Art. 80 CTMR

Where the Office has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to the Office, it may now ensure that the entry is cancelled or the decision is revoked.

### R 53a CTMIR

This applies for example when the opposition or the CTMA had been withdrawn prior to the date the decision was rendered, or when a CTM was registered although an opposition was still pending (the “overlooked opposition”).

The procedural error must be clear. Article 80 CTMR is not a vehicle for the Office to revoke decisions which result from an error of assessment or appreciation. For example, a wrong assessment of likelihood of confusion, or a decision based on an already expired earlier mark, cannot be revoked.

Revocation requires prior hearing of the affected party. ~~For details, see~~ See Rule 53a CTMIR.

For details see Part A of the Manual regarding General Provisions on Proceedings before the Office, section 7.<sup>65</sup>

[http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/part\\_a\\_genprov.pdf](http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/part_a_genprov.pdf)

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<sup>63</sup> Amended on 3/11/2008

<sup>64</sup> Amended on 3/11/2008

<sup>65</sup> Amended on 6/05/2009

## **VIII. CHANGE OF PARTIES (TRANSFER, CHANGE OF NAME, CHANGE OF REPRESENTATIVE, INTERRUPTION OF PROCEEDINGS)**

### **1. Transfer and opposition proceedings**

#### *1.1. Introduction and basic principle*

##### **Art. 17 CTMR**

A transfer or assignment of an earlier right is a change of ownership of this right.

A transfer can be made in several ways, from a simple sale of an earlier mark from A to B, to a company C that gets bought (trade marks included) by company D, to a merger of companies E and F into company G (universal succession), to legal succession (after the owner has died, the heirs become the new owners). This is not an exhaustive list.

When a transfer is made during opposition proceedings, several different situations can arise. Whereas for earlier CTM registrations or applications on which the opposition is based the new owner can only become party to the proceedings (or file observations) once the request for registration of the transfer has reached the Office, for earlier national registrations or applications it suffices that the new owner files evidence of the transfer.

The basic principle is that the new owner substitutes the old owner in the proceedings. The practice of the Office when dealing with transfers is described in paragraphs 1.2 (the earlier registration is a CTM registration), 1.3 (the earlier registration is a national registration) and 1.4 (transfer of a contested CTM application during opposition proceedings).

#### *1.2. Transfer of earlier CTM*

##### **Art. 17(6), (7) CTMR**

Concerning earlier CTM(A's), according to Article 17(6) CTMR, as long as a transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the CTM(A). However, in the period between the date of reception of the request for registration of the transfer and the date of registration of the transfer, the new owner may already make statements to the Office with a view to observing time limits.

##### *1.2.1. Opposition based on one CTM only*

When an opposition is based on one earlier CTM only and this CTM is/has been transferred during the opposition proceedings the new owner becomes the new opponent. The new owner will substitute the old owner.

To this end, either the old or the new owner will have to inform the Office that the CTM on which the opposition is based has been transferred and he must file a request for registration of the transfer. As mentioned above, as soon as the request is received by the Office, the new owner may already make statements. However, he only becomes party to the proceedings once the transfer is registered.

In practice, once the Office is informed that a request for registration is received, the proceedings can continue with the new owner. Nevertheless, the transfer has to be registered before a decision on the opposition is taken. If the opposition is ready for decision but the transfer has not been registered the opposition must be suspended.

If the new owner informs the Office that he does not want to continue the proceedings, the opposition is considered withdrawn.

If, for one reason or another, the transfer is never registered, but there is evidence of the transfer, the opposition has become unfounded, as the opponent is no longer the owner of the earlier right. He must be informed that the opposition examiner will reject the opposition as such unless he withdraws the opposition.

#### *1.2.2. Partial transfer of the only CTM on which the opposition is based*

In cases of a partial transfer one part of the earlier CTM remains with the original owner, and another part by a new owner. To partial transfers the same principles as for transfer of only one of more CTM registrations on which the opposition is based apply. These principles are described in paragraph 1.2.3 below.

#### *1.2.3. Opposition based on more than one earlier CTM*

When an opposition is based on more than one earlier CTM and these marks are/have been transferred to the same new owner during the opposition proceedings, the foregoing applies. It becomes different when only one of the earlier CTMs is/has been transferred. In this case the new owner may also become opponent, so that there are two. The opposition will be kept as one. In general both opponents have one representative.

If one of the opponents wants to withdraw, this is to be accepted independently of whether the other wants to continue. Of course, if the proceedings are continued it will be based only on the rights of the opponent who did not withdraw. No separate decision on costs will be taken.

The new opponents will be treated as “joint opponents”, meaning that the Office will continue dealing with the case in exactly the same way as before, i.e. as one opposition, albeit with more than one opponent. Moreover, the Office will consider the original representative as the “common” representative for all the opponents and will not invite the new opponents to appoint a new

one. However, the new opponents always have the option of appointing a representative of their choice.

Common representation does not mean that opponents may not act independently, to the extent that their earlier rights remain independent: if for instance one of the opponents enters into a friendly settlement with the applicant, the opposition will be treated as partially withdrawn in respect of the earlier rights owned by this opponent.

### *1.3. Transfer of earlier national registration*

#### *1.3.1. Opposition based on one national registration only*

When an opposition is based on one earlier national registration only and this registration is/has been transferred during the opposition proceedings, the new owner also becomes the new opponent. The new owner will substitute the old owner.

To this end, either the old or the new owner will have to inform the Office that the earlier national registration on which the opposition is based has been transferred and must file evidence thereof, i.e. the deed of transfer. As there are different national practices, it is not obligatory to submit a copy of the request to register the transfer with the national office.

The Office does not require the new owner to confirm that he wishes to continue the proceedings. As long as the evidence of the transfer is in order, the new owner is accepted as new opponent. If he informs the Office of the transfer, but does not submit (sufficient) evidence thereof, the opposition proceedings have to be suspended while the new owner is given two months to provide evidence of the transfer.

Nevertheless, in those Member States where this is a requirement for a transfer to have effect against third parties, the transfer must have been registered before a decision on the opposition is taken. If the opposition is ready for decision but the transfer has not been registered the opposition must be suspended and the opponent is to be required to provide evidence of registration of the transfer.

As it is not in the interest of the applicant if the proceedings are delayed, the new owner must be set a reasonable time limit to provide this evidence.

If the new owner does not provide the required evidence, the proceedings must be continued with the old owner. If the old owner maintains that he is not the owner anymore the opposition has become unfounded, as the opponent is no longer the owner of the earlier right. He must be informed that the opposition examiner will reject the opposition as such unless he withdraws the opposition.

If the new owner provides the required evidence and informs the Office that he does not want to continue the proceedings, the opposition is considered withdrawn.

A deed of transfer, signed by assignor and assignee, will normally be submitted as evidence of a transfer. A full contract that shows the change of ownership of the registration is of course also acceptable.

Although it is the opposition examiner that is in charge of the substantive implications of the change, the changes in EUROMARC are made by the RS. It may be that the RS informs the opposition examiner that a claim to a change of owner has been received at the Office. It is however up to the opposition examiner to verify if evidence of the transfer has been submitted. If not, the opposition proceedings have to be suspended while the new owner is given two months to provide evidence of the transfer. The RS will have to be informed if and when the change in EUROMARC can go ahead.

### *1.3.2. Partial transfer of the only national registration on which the opposition is based*

In cases of a partial transfer one part of the earlier national registration remains with the original owner, and another part with a new owner. To partial transfers the same principles as for transfer of only one of more national registrations on which the opposition is based apply. These principles are described in paragraph 1.3.3 below.

### *1.3.3. Opposition based on more than one earlier national registration*

When an opposition is based on more than one earlier national registration and these are/have been transferred to the same new owner during the opposition proceedings, the foregoing applies.

It becomes different when only one of the earlier national rights is/has been transferred. In this case the new owner may also become opponent, so that there are two. The opposition will be kept as one. In general both opponents have one representative.

If one of the opponents wants to withdraw, this is to be accepted independently of whether the other wants to continue. Of course, if the proceedings are continued it will be based only on the rights of the opponent that did not withdraw. No separate decision on costs will be taken.

In practice, the new opponents will be treated as “joint opponents”, meaning that the Office will continue dealing with the case in exactly the same way as before, i.e. as one opposition, albeit with more than one opponent. Moreover, the Office will consider the original representative as the “common” representative for all the opponents and will not invite the new opponents to appoint a new one. However, the new opponents always have the option of appointing a representative of their choice.

## 2. Transfer of the contested CTMA

When during opposition proceedings the contested CTMA is/has been transferred, the opposition follows the application, i.e. the opponent is informed of the transfer and the proceedings continue between the new owner of the CTMA and the opponent.

When RS receives a request for registration of the transfer, it informs the opposition examiner. As soon as the request has been received, the “new” applicant may make statements to the Office with a view to observing time limits; there is no need to suspend the procedure. The opposition examiner informs the opponent of the transfer and the proceedings can continue. Of course, before a decision is taken the transfer will have to be registered.

### 2.1. *Partial transfer of a contested CTM application*

#### **R 32(4) CTMIR**

When there has been a partial transfer of a (contested) CTMA, the Office must create a separate file for the new registration (application) with a new registration (application) number.

In this case, when the transfer is recorded in the Register and a new CTM application is created, the opposition examiner also has to create a new opposition(s) file against the new CTM application, since it is not possible to deal with one opposition against two separate CTM applications.

Please note however that this is only the case when some of the originally contested goods and services are maintained in the ‘old’ CTMA, and some in the newly created CTMA. For example: Opponent X opposes all goods of CTMA Y, applied for in class 12 for *apparatus for locomotion by land and air*, and for *clothing and footwear* in class 25. CTMA Y is partially transferred, and split into CTMA Y' for *apparatus for locomotion by land and clothing*, and CTMA Y'' for *apparatus for locomotion by air, and footwear*.

#### **Art. 17, 23 CTMR**

As when the opponent filed his opposition there was only one opposition fee to be paid, he is not requested to pay a second fee for the new opposition created after the split of the CTMA.

The transfer, even if it was requested before the opposition was filed, has effect vis-à-vis third parties only after the entry in the Register. Thus the payment of only one opposition fee was properly effected because at the time of filing the opposition was only directed against one CTM application (the only one). Therefore the new opposition will be created without the payment of a new opposition fee.

Regarding the apportionment of costs, the opposition examiner will take into account the fact that only one opposition fee was paid.

Moreover, depending on the circumstances of the case, it could be possible to join the proceedings (e.g. when the representative of the “old” and “new” applications is the same).

### 3. Change of name

As mentioned above, a change of name does not imply a change of ownership. The RS is in charge of such changes and will inform the opposition examiner about any changes in the name of the CTM applicant.

### 4. Change of representatives

During the proceedings there may be changes of representatives. This can occur in several different situations.

It can happen that either the opponent or the applicant informs the Office that he wishes to designate a (new) representative. It can happen that the representative himself resigns or that the representative is deleted or suspended from the list of professional representatives. It can also happen that due to a transfer the opponent or applicant changes and that they wish to be represented by new representatives.

When there is a change of representative during opposition proceedings, the other party will have to be informed by sending the other party a copy of the letter and of the authorisation (if submitted).

#### Art. 92 CTMR

When a representative resigns, the proceedings are continued with the opponent or applicant himself if they are from the EU. The other party is informed of the resignation of the representative. If the party whose representative has resigned is from outside the EU, a letter has to be sent indicating that a new representative must be appointed.

### ~~5. Interruption of proceedings due to decease, legal incapacity of a party or a representative<sup>66</sup>~~

#### ~~R 73 CTMIR~~

~~Rule 73 CTMIR deals with interruption of proceedings. Paragraph 1 distinguishes three situations:~~

#### ~~R 73 (1) CTMIR~~

~~Opposition proceedings before the Office shall be interrupted:~~

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<sup>66</sup> Complete paragraph 5 amended on 1/03/2010

~~(a) when the CTM applicant has died or cannot take legal actions (for example because he has been declared insane by a court).~~

~~(b) when the CTM applicant is prevented from continuing the proceedings before the Office owing to legal reasons (for example when the applicant is in a process of bankruptcy).~~

~~(c) when the representative of an applicant has died or cannot take legal actions as a result of some action taken against his property.~~

~~Rule 73 CTMIR only refers to the applicant and his representative and does not mention anything about other parties, such as opponents. In the absence of relevant provisions, the Office will continue the procedure with the opponent without any interruption. The uncertainty of the legal status of an opponent or his representative shall not go to the detriment of the applicant.~~

#### ~~5.1. Death or legal incapacity~~

~~In cases of death of the applicant or of the person authorised by national law to act on his behalf, because of the legal incapacity of the applicant, the proceedings are only interrupted when this is requested by the representative of the applicant/authorised person.~~

#### ~~5.2. Bankruptcy~~

~~Bankruptcy or insolvency proceedings: Rule 73(1)(b) CTMIR applies as from the point in time on which the party to the proceedings is no longer entitled to dispose of the procedure, i.e. to dispose of its assets, and until the point in time a liquidator or trustee is appointed who will then continue to represent the party as of law.~~

~~When the party is represented by a professional representative who continues to represent, there is no need to interrupt the proceedings as the representative acts on behalf of the party, whoever may be entitled to act on behalf of the party.~~

~~If the representative informs the Office that he resigns as court action has been initiated to declare his client bankrupt, it depends whether the representative further indicates who acts as the trustee or liquidator in the bankruptcy. If he does so, the Office will continue to correspond with the trustee or liquidator and no interruption of the proceedings applies.~~

~~If there is no information as to a liquidator or trustee, the Office has no choice but to communicate with the bankrupt party himself and to declare an interruption of the proceedings. It is not up to the Office to investigate who the liquidator is. Even though the bankrupt party is not allowed to undertake binding legal acts, generally he still receives post, or, if not, the post is delivered automatically to the trustee as long as there is one.~~

~~When the notification is returned to the Office as undeliverable, the normal rules for public notification apply.~~

~~If evidence about the appointment of the liquidator or trustee is filed, this need not be translated into the language of the proceedings.~~

~~Once the previous representative or the party itself informs the Office who the liquidator or trustee in the bankruptcy is, the proceedings are resumed from a date to be fixed by the Office. The other party must be informed.~~

#### ~~R 73 (4) CTMIR~~

~~Interruption of proceedings means that time limits which were not yet expired when the proceedings were interrupted, start running again when the proceedings are resumed. For example, when the proceedings were interrupted ten days before the opponent had to file observations, a new period of two months starts again, not the ten days he had left at the moment of the interruption. For clarification, the letter of Office informing the parties about the resumption shall fix a new time limit.~~

~~5.3. Death or prevention for legal reasons of the representative of the applicant/opponent before OHIM to act~~

#### ~~R 73(3) CTMIR~~

~~In the case referred to in paragraph 1(c) of Rule 73 CTMIR, the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the CTM applicant.~~

~~According to Rule 73(3) CTMIR, if the Office has not been informed of the appointment of a new representative within three months after the beginning of the interruption of the proceedings, it shall inform the applicant that his CTM application is deemed withdrawn in the cases where he is obliged to have a representative because he does not have a domicile or seat in the EU. However, this is only the case when the applicant, after having been asked to appoint a new representative, does not comply.~~

~~In all other cases, the proceedings will continue with the applicant/opponent himself.~~

## **5. Interruption of proceedings due to decease, legal incapacity of the applicant or its representative**

#### **R 73 CTMIR**

**Rule 73 CTMIR deals with interruption of proceedings. Paragraph 1 distinguishes three situations:**

#### **R 73 (1) CTMIR**

Opposition proceedings before the Office shall be interrupted:

(a) when the CTM *applicant* has died or cannot take legal actions (for example because he has been declared insane by a court).

(b) when the CTM *applicant* is prevented from continuing the proceedings before the Office owing to legal reasons (for example when the applicant is in a process of bankruptcy).

(c) when *the representative of an applicant* has died or cannot take legal actions as a result of some action taken against his property.

Rule 73 CTMIR only refers to the applicant and his representative and does not mention anything about other parties, such as opponents. In the absence of relevant provisions, the Office will apply this provision only to cases where the applicant (or its representative) is not able to continue the proceedings. Thus, if, for example, the opponent is declared bankrupt the proceedings will not be interrupted (even in the cases where the opponent is the applicant/proprietor of an earlier CTMA/CTM). The uncertainty of the legal status of an opponent or its representative shall not go to the detriment of the applicant. In such a case, when the notification is returned to the Office as undeliverable, the normal rules for public notification apply.

#### 5.1. *Death or legal incapacity of the applicant*

In cases of death of the applicant or of the person authorised by national law to act on his behalf, because of the legal incapacity of the applicant, the proceedings are only interrupted when this is requested by the representative of the applicant/authorised person or when the representative resigns.

#### 5.2. *Applicant prevented from continuing the proceedings before the Office owing to legal reasons (for example, such as bankruptcy)*

Rule 73(1)(b) CTMIR applies as from the point in time on which the party to the proceedings is no longer entitled to dispose of the procedure, i.e. to dispose of its assets, and until the point in time a liquidator or trustee is appointed who will then continue to represent the party as of law.

When the applicant is represented by a professional representative who does not resign, there is no need to interrupt the proceedings. The Office considers the applicant's representative to be entitled to represent the applicant until the Office is informed otherwise by the representative itself, by the designated trustee or the court dealing with the legal action in question.

If the representative informs the Office that it resigns, it depends whether the representative further indicates who acts as the trustee or liquidator in the bankruptcy:

- If it does so, the Office will continue to correspond with the trustee or liquidator. If there were time limits affecting the applicant which were not

yet expired when it went bankrupt, the Office will re-start these time limits. Thus, in this case the proceedings are interrupted and immediately resumed. For example, if the applicant still had ten days to file observations when it went bankrupt, the new letter of the Office to the trustee will give a fresh period of two months to file those observations.

- If there is no information as to a liquidator or trustee, the Office has no choice but to declare an interruption of the proceedings. A communication to that effect will be sent to the bankrupt applicant directly and to the opponent. Although, it is not up to the Office to investigate who the liquidator is, the Office will keep on trying to communicate with the bankrupt applicant with an aim to resume the proceedings, this is because although the bankrupt applicant is not allowed to undertake binding legal acts, generally it still receives post, or, if not, the post is delivered automatically to the trustee as long as there is one. The Office might also consider information on the identity of the trustee provided by the opponent.

When the notification is returned to the Office as undeliverable, the normal rules for public notification apply.

If evidence about the appointment of the liquidator or trustee is filed, this need not be translated into the language of the proceedings.

Once the Office is informed of who the liquidator or trustee is, the proceedings are resumed from a date to be fixed by the Office. The other party must be informed.

#### **R 73 (4) CTMIR**

Interruption of proceedings means that time limits which were not yet expired when the proceedings were interrupted, start running again when the proceedings are resumed. For example, when the proceedings were interrupted ten days before the applicant had to file observations, a new period of two months starts again, not the ten days it had left at the moment of the interruption. For clarification, the letter of Office informing the parties about the resumption shall fix a new time limit.

#### **5.3. *Death or prevention for legal reasons of the representative of the applicant before OHIM to act***

#### **R 73(3) CTMIR**

In the case referred to in Rule 73(1)(c) CTMIR, the proceedings must be interrupted and shall be resumed when the Office is informed of the appointment of a new representative of the CTM applicant.

This interruption will last a maximum of three months and, if no representative is appointed before the end of this period, the proceedings will be resumed by the Office. When resuming the proceedings, the Office will proceed as follows:

(a) If the appointment of a representative is compulsory under Article 92(2) CTMR (former Article 89(2)) because the applicant has neither its domicile nor its seat in the EU, the Office will contact the applicant and inform it that the CTMA will be deemed withdrawn if it does not appoint a representative within a period of two months. If the applicant does not appoint a representative on or before the end of the time limit, the CTMA will be then deemed withdrawn.

(b) If appointment of a representative is **not** compulsory under Article 92(2) CTMR (former Article 89(2)), the Office will resume the proceedings and will send all the communications to the applicant directly.

In both cases resuming the proceedings will mean that any time limits pending for the applicant when the proceedings were interrupted start running again when the proceedings are resumed.