



**Communication N° 5/07 of the President of the Office**  
**of 12 September 2007**  
**on changes of practice in opposition proceedings**

**1. Background**

In order to streamline opposition proceedings, the Office has decided to make a number of changes to both the admissibility and the adversarial phases. The main aims are to simplify the admissibility check process; provide clarity on the division of costs when either an opposition or a CTM application is withdrawn; and reduce the administrative burden associated with requests for repeated extensions of suspension periods.

**2. Admissibility check**

Two minor changes will be introduced in the admissibility check process.

First of all, oppositions will be considered admissible if all absolute and relative requirements for admissibility are complied with for at least for one of the earlier rights.

The second change will consist in accepting the indication of the class number(s) as a sufficient indication of the goods and services of the earlier rights on which the opposition is based.

Both changes enhance swift notification of almost all oppositions to the applicant avoiding the submission of deficiency letters to the opponent that often cause a three months delay in the proceedings.

These changes only affect oppositions against direct CTM applications. The changes will not apply to oppositions against designations of the EC under the Madrid Protocol.

### **3. Adversarial part of proceedings**

With the aim of dealing with the opposition files more diligently during the adversarial part of the proceedings, the following three further improvements will be made:

- (1) Cost decisions will be issued together with the confirmation of the withdrawal, either of the opposition or of the CTM application

Until now, when one of the parties withdrew during the adversarial part of the proceedings, but no indication was given as to whether the parties had agreed on the costs, the Office would give the parties two months to confirm if a cost agreement had been reached.

From now on, in these cases the decision on costs will be taken immediately, i.e. together with the confirmation of the withdrawal. Only if the parties inform the Office in advance of their agreement on the costs will no decision on costs be taken. While the Office's cost decisions, once taken, will not be revised, the parties remain free to respect any voluntary cost agreements that they may reach.

The implementation of this change will mean that parties will not have to wait for the cost decision anymore, and that the proceedings are closed immediately after the withdrawal.

- (2) Renewed requests for suspensions

In order to avoid repetitive joint requests to continue suspensions every two months if the parties have not finished their negotiations, the Office will now *ex officio* grant the second request for suspension for a period of one year, giving the parties the possibility to opt out. The process is the same as for the extension of the cooling off period.

- (3) Rule 79a CTM IR

Rule 79a sets out that in *inter partes* proceedings the parties must provide a copy of the documents submitted unless these are submitted by fax.

From now on evidence without a copy as mentioned above, will be rejected and not taken into account. No period of time will be given for providing a copy. (standard letters have been updated and contain a warning that observations and evidence not sent by fax and not consisting of loose sheets must be sent together with a copy).

### **4. Entry into force**

The changes will be implemented as of 17/09/2007, and will apply to all oppositions, including pending oppositions, apart from the exception made in Paragraph 2 of this communication. All standard letters have been updated to reflect the changes so that the parties are informed in each case.

Wubbo de Boer  
President