



Caring for a balance of IP rights



Trade Mark Directive

WEBINAR SERIES

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Changes in trade mark administrative proceedings
(opposition, cancellation, invalidity, revocation)

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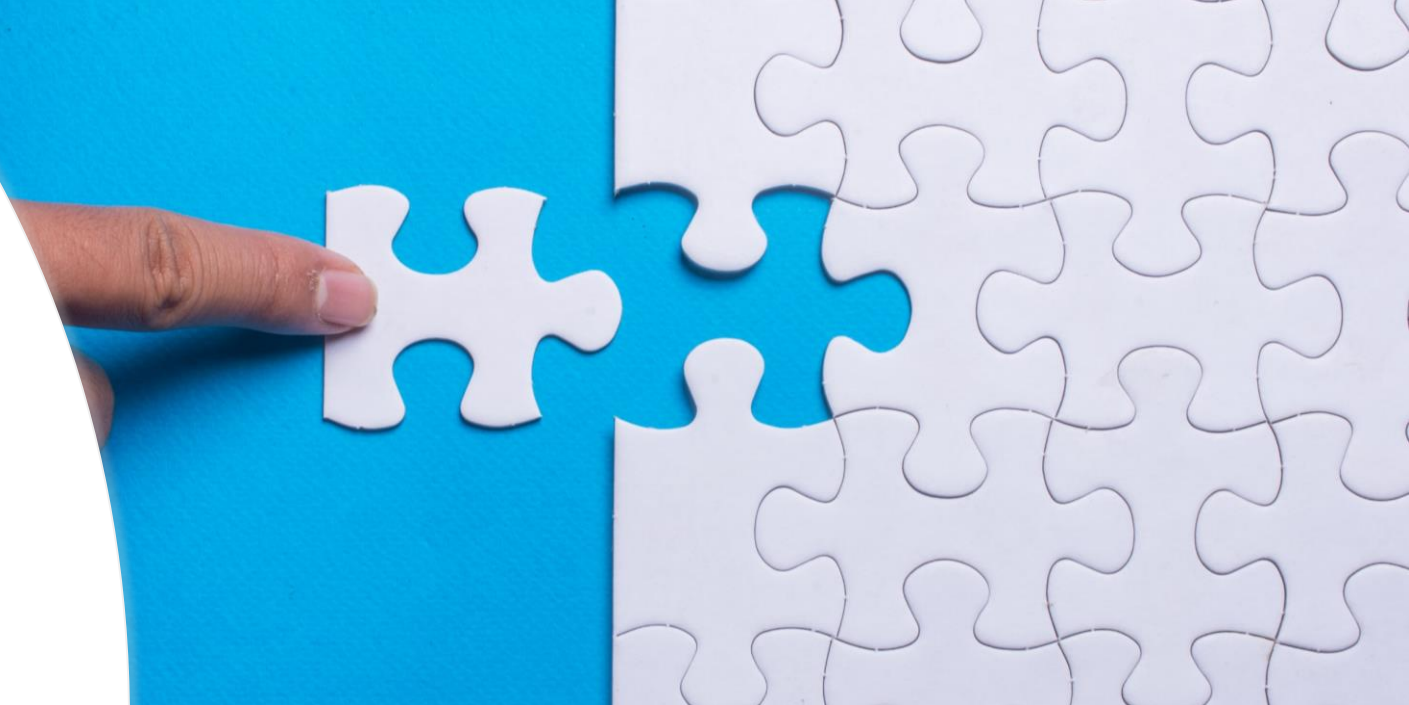
Filing and timing

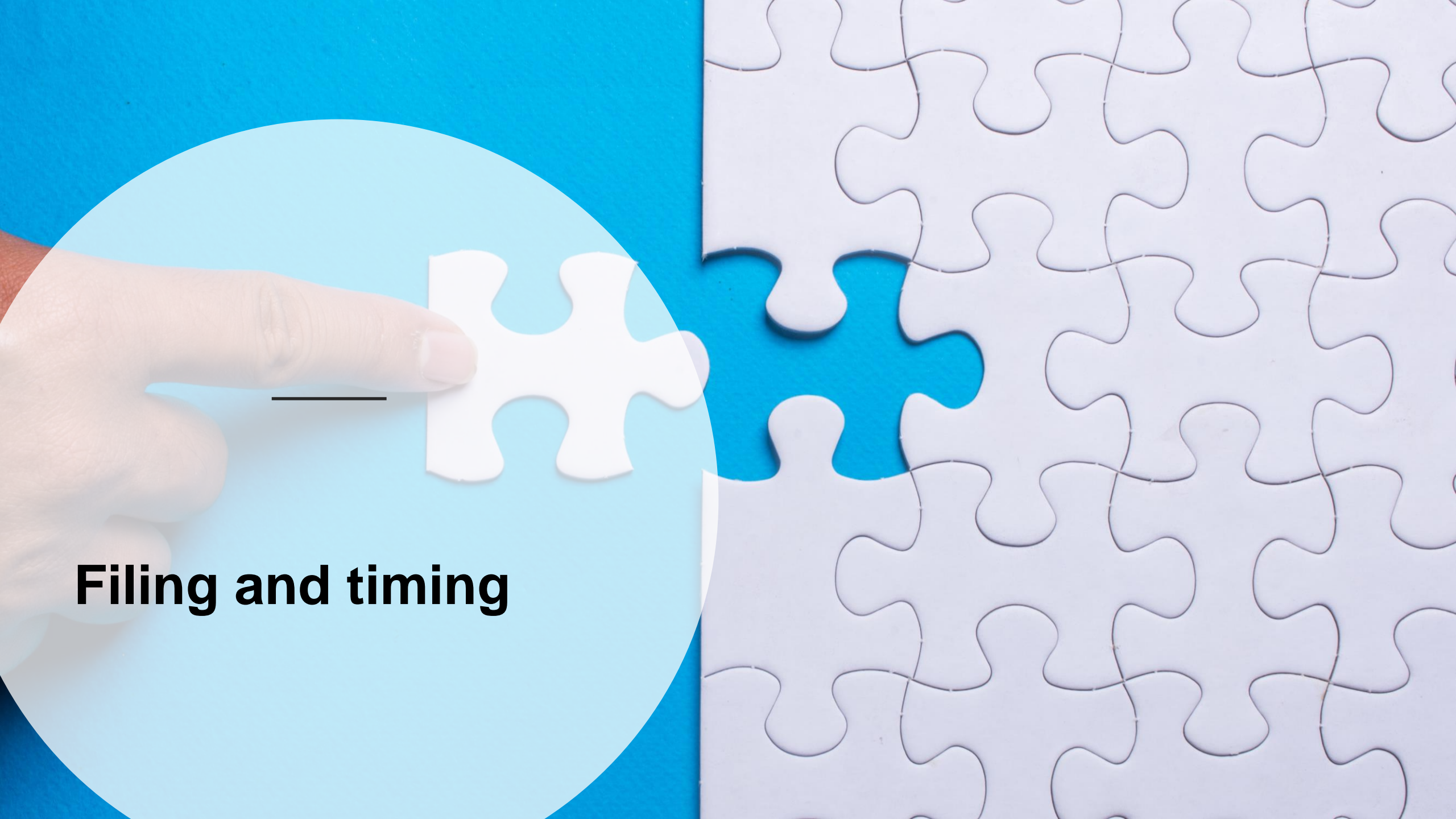
Communication issues

Procedural aspects

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Decision





Filing and timing

Deadline for filing an opposition

2 months	3 months
BX, EE, FI, FR, PT, RO, ES	AT, BG, CR, CY, CZ, DE, GR, HU, LV, LT, PL, SK, SL, SE

Deadline for filing an opposition

Exceptions	
IE	3 months minus 1 day from the date of publication
IT AT	Different for national and International marks, namely: <ul style="list-style-type: none">• national marks: 3 months from the date of publication of the application in the Italian/Austrian Official Bulletin;• International marks: 3 months from the first day of the month following the month in which the International trade mark was published in the Bulletin of the WIPO.
MT	90 running days following publication of the trade mark application

'Formal' action possible?

- What does 'formal' mean?
- Formal opposition check list:
 - Against all / part of G&S
 - Risk of confusion, dilution, other grounds
 - Earlier rights
- Is a full argumentative brief required upfront?
 - Benelux, France, Germany, Italy: arguments can be filed later
 - Finland, Portugal, Spain: due upfront

PoA requirement

- **Benelux**
 - In general, no PoA needed
 - Only in case BOIP has concerns (hardly ever happens)
 - In said case: simple (digital) copy of a PoA suffices
 - Do note: the (copy of the) PoA needs to contain a handwritten signature (an electronic one will not suffice)
- **Other jurisdictions**

Capacity of the representative

- **Benelux**

- All activities at BOIP may be performed through a representative
- Can be (in-house) IP counsel, TM lawyer, attorney-at-law
- Representative must be located in EEA
- Sanction absent a correspondence address in EEA: if not remedied within 2 months, examination of the action abandoned



- **Other jurisdictions**

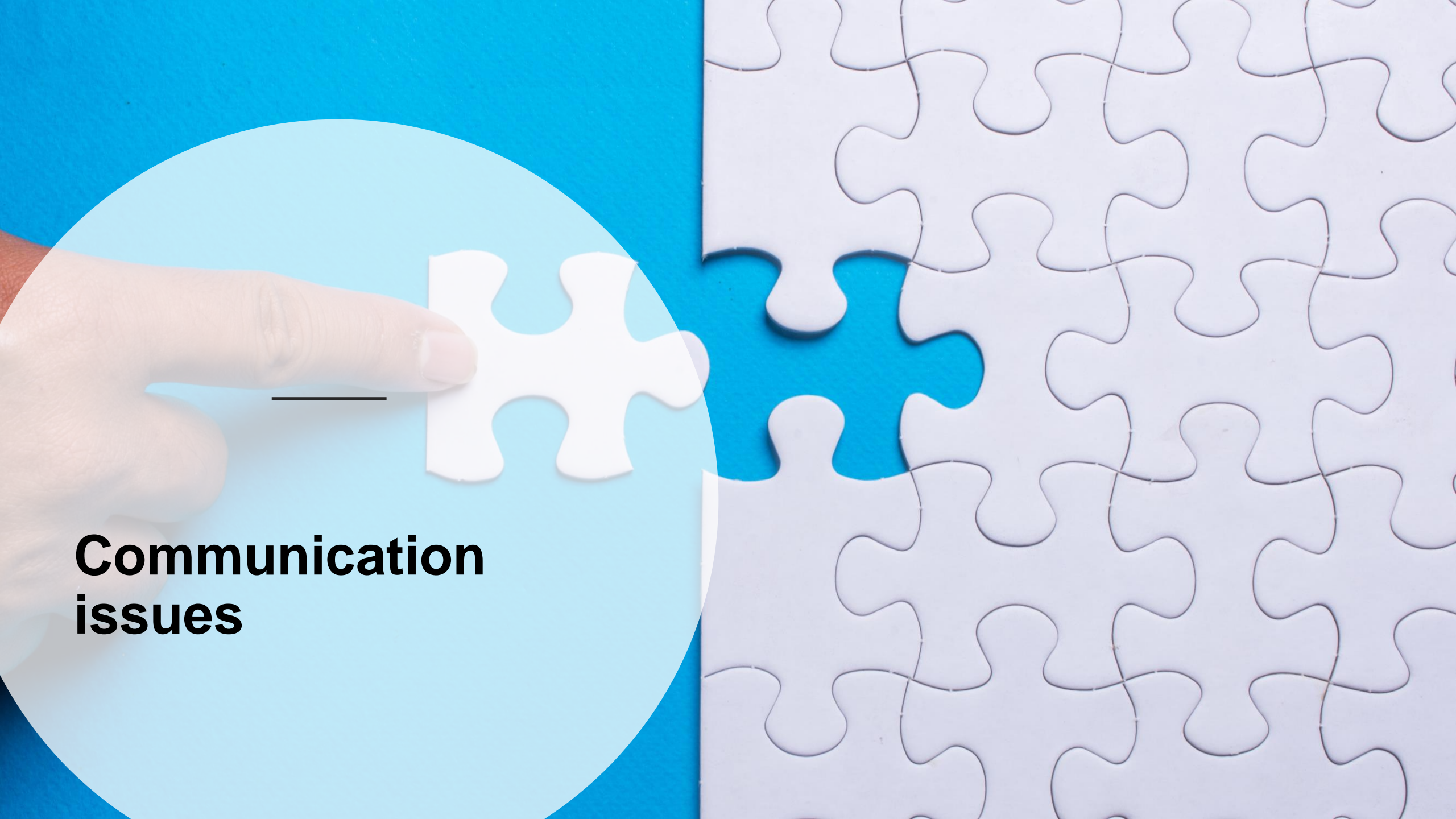
Regularisation (late payment)

- **Benelux**
 - 40% of opposition fee must be paid for admissibility
 - cannot be remedied
 - option: file a cancellation action once trade mark application is registered
 - 60% must be paid no later than actual commencement of proceedings
 - If not: BOIP will provide another month;
 - If still not paid: examination of opposition will be abandoned;
 - Note: difference between closure of proceedings vs. abandonment:
 - in case of closure: refund of part of the fees paid
 - in case of the abandonment: no refund of the fees paid
- **Other jurisdictions**

Co-ownership and plurality of claimants

- **Romania and Spain**
- **Benelux**

- Action can be based on one or more prior rights, but they must all belong to the same owner; otherwise, separate actions required
- Multiple actions against 1 TM (application): BOIP can prioritise in view of a likely success, putting the other actions on hold
- One action per challenged right
- Co-ownership of earlier rights: each co-owner may lodge an individual action and BOIP will not seek consent of other proprietors *“since this will be deemed a defensive act for the purpose of the trade mark”* (BOIP Opposition Guidelines)
- Co-ownership of challenged registration/application: no specific provisions. See Art. 4.8bis BCIP (trade mark as object of property is governed by laws of BX country where first mentioned co-owner is registered, and NL by default).



**Communication
issues**

Manner of communication by the Office

- **Benelux**
 - Written procedures - BOIP communication inbox
 - Regular mail (decision)
 - E-mail (e.g. receipt confirmation of submissions through an electronic contact form)
- **Other jurisdictions**
 - Manner of communication by the IPOs in Romania, Germany, France

Communication of all procedural acts to the parties by the Office?

- **Benelux**

- Yes, even when action is inadmissible, each relevant document submitted to the Office by one party is sent by the Office to the other party
- Consequence of the principle of hearing both sides

- **Romania**

Communication of all procedural acts to the parties by the IPO in Romania

Availability of oral proceedings?

- Oral hearing are normally unavailable in first instance proceeding, with some exceptions, such as Benelux, France
- More common in appeal, e.g. Germany, Italy
- Pandemic consequences on oral proceedings

Requirements concerning format of the documents to be filed

- **Romania, Germany, France, Spain, Portugal, Italy**
 - Requirements about format of the documents to be filed with the IPO in Romania. Brief remarks for Germany, France, Spain, Portugal
- **Benelux**
 - The document is deemed not to have been submitted

Language of the proceedings?

- **Benelux**

- French, Dutch (official languages) or English (working language)
- Claimant indicates preferred language when filing the action
- Defendant can make a choice of language within 1 month from notification of admissibility of the action
- Absent language choice by defendant: language of G/S classification of the challenged mark and – when G/S are in English – language choice of claimant
- But: evidence can be submitted in the original language if the evidence can be sufficiently understood (e.g. for proof of use: invoices, advertising)

- **Romania and Italy**



Procedural aspects

Consequence of absence of a reply?

- **Italy, Ireland, Germany, France, Spain, Portugal and Romania**
 - Failure to respond may lead to the IPO taking its decision on the basis of the Opponent's arguments alone, which is the case in most countries
 - Generally, no presumed abandonment of the opposed application
 - The "Italian exception"

Consequence of absence of a reply?

- **The “Benelux exception”**
 - Two situations:
 - Failure to respond to a regularisation (in relation to correspondence address/ designating a representative)
 - Failure to take (any) action

Consequence of absence of a reply?

- Failure to take any action



- very strict interpretation BOIP since decision on opposition number 2000061 from 6 December 2006
- only if the defendant has not undertaken any action at all (an action in relation to merely procedural aspects is an action) for the purpose of the opposition:
 - the opposition will be closed
 - the defendant's trade mark application will be deemed to be renounced

Request for a proof of use – when and how?

- **Practices vary considerably from Office to Office**
 - The Italian case
 - The German case

Request for proof of use – when and how?

- **The Benelux case**

- Up until recently: request for proof of use had to be **explicit**
- However Benelux Court of Justice “softened” this requirement beginning of this year; somewhat **implicit requests will also have to be accepted**
 - Major change for both BOIP and users!
- Request may be combined with substantive response (observations in reply), no particular format required
- very different to at the EUIPO which is extremely strict, see in relation thereto also Grand BoA [R2142/2018-G](#) dated 3 October 2019, *Diesel*

Acceptance of proof of use

- **Jurisdiction specific assessment**
 - Open catalogue of means of evidence
 - Global evaluation of evidence
 - Experience from the Italian case law

Acceptance of proof of use

- **Benelux**

- **Fun fact:** decision BOIP gave rise to ECJ Leno Merken Hagelkruis (ONEL OMEL), C-149/11, 12 December 2012

BOIP decision 2004448 15 January 2010, ONEL/OMEL:

'All things considered, the Office is of the opinion that the view expressed in the Joint Statements that genuine use in one country is by definition genuine use in the Community cannot be upheld.'

'The right relied on is a Community trade mark and it is common ground between the parties that it has been used only in the Netherlands. The services for which the right sought to be registered are by their very nature intended for a wide public throughout the Community. In view of these elements, no genuine use of the right relied on has been demonstrated.'

- Documents serving to support arguments or to prove the use of a trade mark may be submitted in their original language will however only be considered if the Office finds that they can be sufficiently understood

Relation to pending court claims

- **Benelux**
 - Court claims have priority over administrative proceedings
 - *Ex officio* suspension of administrative proceedings
- **Romania and Italy**

Availability of suspensions

- **Romania and Italy**
- **Benelux**
 - Suspensions possible at a joint request
 - For four months
 - Can be repeated indefinitely (no limit to number of suspensions)
 - First three requests: no fees
 - Fourth request and beyond: fees (EUR 150)
 - Either party can 'opt-out' at any given moment
 - by a written request

Extension of terms

- **Italy, Ireland, Germany, France, Spain, Portugal**
- **Benelux**
 - See suspension
 - Unilateral extension of terms is not possible, contrary to the EUIPO practice

A hand is shown placing a white puzzle piece into a missing spot in a larger puzzle. The puzzle is composed of white pieces with a blue background. The hand is positioned on the left side of the frame, with the index finger pointing towards the white puzzle piece. The puzzle piece is being placed into a hole in the puzzle. The background is a solid blue color. The puzzle pieces are white with a blue outline. The hand is light-skinned. The puzzle piece being placed is a standard interlocking shape. The hole in the puzzle is a matching shape. The overall scene is a close-up of the hand and the puzzle piece.

**Grounds and other
substantive matters**

Legal grounds for an Opposition

As a consequence of the implementation of the New Trade Mark Directive, at least the following are common grounds in all MS:

- Double identity or likelihood of confusion with an earlier mark (registered or pending)
- Unfair advantage /detriment vs earlier mark with reputation (registered or pending)
- Earlier designations of origin or geographical indications

Legal grounds for an Opposition

- But jurisdiction specific grounds remain:
 - Non-registered marks
 - Marks filed by agents
 - Bad faith
 - Rights to name, portraits
 - Opposition on absolute grounds

Legal grounds – Benelux overview

- **Opposition**
 - Double identity
 - LoC
 - Well-known mark (Art. 6bis Paris Convention)
 - Reputation
 - Filing by agent or representative without authorisation
 - PDO/PGI
- **Cancellation:**
 - Absolute grounds
 - Relative grounds (same as opposition grounds)
- **Revocation:**
 - No genuine use
 - Generic
 - Misleading

Weight of the EUIPO case law

- **Benelux**

“The Office is neither bound by its own decisions, nor decisions issued by other authorities in similar or other cases.

The Office is required to take an independent decision on the basis of the applicable statutory law and case law in the Benelux.”

(BOIP Opposition Guidelines, with reference to Curon (GC, T-353/04, 13 February 2007, par. 77))

- **Romania and Italy**

Weight of distinctive character - National vs EUIPO practice

EUIPO practice differs from several national practices

- **Italy, Ireland, Germany, France, Spain, Portugal**
- **Benelux**
 - one of the factors in the global assessment of LoC: higher distinctive character means greater LoC, but weak distinctive character does not preclude LoC
 - reputation is not a ground for presuming there is a LoC

Weight of distinctive character - National vs EUIPO practice

- Benelux test for descriptiveness (BCJ in PET'S BUDGET):

'The two components that make up the syntagma can therefore refer to goods for animals and especially to their destination and their characteristics.

So: "could serve" read as "could refer" -> broader test than "*immediately and without further reflection*" as the General Court, as now also specifically stated in BOIP Guidelines:

*It follows that it is not necessary for the relevant public to perceive "*immediately and without further reflection*" a description of one of the characteristics of those goods or services. Such marks are also descriptive, of course, but the category of descriptive marks is broader than marks which do so in that way.*

Goods and Services comparison - National vs EUIPO practice

- Country specific attention towards some goods and services
- Consequences on evaluation of similarity

Bad faith and public policy/morality

- **Benelux**

- Bad faith

- New ground for opposition/cancellation since new EU legislation
 - Against wishes of the BOIP (very factual rather than only legal)
 - Review can be suspended when a court claim is also pending
 - BOIP may suspend proceedings 'if BOIP considers this necessary'
 - If not claimed within opposition, possible to invoke bad faith in cancellation

Bad faith and public policy/morality

- Public policy/morality
 - BOIP not very strict: ‘Benelux public is not easily offended’
 - Only for “very bad” cases, such a “JODEN” (“JEWS”) for showers, or a gnow performing the greeting from World War II
 - In particular, difference with the EUIPO: trade marks (possibly) relating to marihuana
 - DUTCH WEEDBURGER: accepted in Benelux
 - BAVARIA WEED: not accepted in EU (GEU T178/20, 12 May 2021, *BAVARIA WEED*: ‘promoting use of illegal substance’)
- **Bad faith and public policy/morality in Romania**



Decision

Decision on costs

Recovery of opposition costs possible?	
YES	BX (limited to 1,045 €), CR, CY, HU, IE, IT, LT, PL (limited), UK
NO	AT, BG, CZ, EE, DE (exceptions only in very rare cases) FI, FR, MT, PT, RO, SK, SL, ES, SE
Return of official fee (partly or fully):	EE, GR, LV

Deadline for filing an appeal

15 days:	MT
28 days:	UK
30 days:	HU, RO, SK
1 month:	CZ, DE
60 days:	FI, GR, IT
2 months:	AT, BX, EE, PT, SE
75 days:	CY (appeal to the Administrative Court)
3 months:	BG, IE, LV
6 months:	LT

Deadline for filing an appeal

ES	1 month for appeal with the local Office, 2 months to the Administrative Court
FR	Depending whether local person or not (1, 2 or 3 months) (1 month from the notification of the decision, 2 months if the appellants is living in French overseas departments and territories, 3 months if the appellants is living abroad)
PL	2 months for motion for re-consideration to the local Office, 30 days for complaint to the administrative court
SL	No appeal possible, but administrative action (within 30 days)

First instance vs appeal decisions

- Consistency of first case law
- Consistency of appeal case law
- Double assessment of chances of success

Do the IPO's decisions have *res judicata*?

- Cancellation action following unsuccessful opposition?
- Cancellation action following unsuccessful opposition and appeal?
- Is administrative cancellation alternative to judicial cancellation or coexisting?





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