

**GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET (ON EUROPEAN
UNION TRADE MARKS AND DESIGNS) ON
COMMUNITY TRADE MARKS**

PART C

OPPOSITION

SECTION 0

INTRODUCTION

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1 Overview of Opposition Proceedings – the **difference between ‘absolute grounds’ and ‘relative grounds’ for refusal of a CTM application and an EUTM Application**

‘Opposition’ is a procedure that takes place before ~~OHIM~~the EUIPO when a third party, on the basis of the earlier rights it holds, requests the Office to reject a ~~Community~~European Union trade mark application (~~the ‘CTMA’~~EUTM application) or an international registration designating the EU.

When an opposition is filed against an international registration designating the EU, any reference in these Guidelines to ~~CTMA~~EUTM applications must be read to cover international registrations designating the EU. Specific Guidelines have been drafted for International Marks including specificities about oppositions.

Under Council Regulation (~~EC~~EU) No ~~207~~/2009 of 26 ~~February~~ 2009 on the ~~Community~~European Union trade mark (~~the ‘CTMR’~~EUTMR), an opposition must be based on rights held by the opponent in an earlier trade mark or other form of trade sign. The grounds on which an opposition may be based are called ‘relative grounds for refusal’, and the relevant provisions are found in Article 8 ~~CTMR~~EUTMR, which bears that title. Unlike absolute grounds for refusal, which are examined *ex officio* by the Office (and which may take into account third parties’ observations although third parties do not become parties to the proceedings), relative grounds for refusal are *inter partes* proceedings based on likely conflict with earlier rights. Such relative grounds objections are not raised *ex officio* by the Office. The onus is therefore on the earlier right owner to be vigilant concerning the filing of ~~CTMAs~~EUTM applications by others which could clash with such earlier rights, and to oppose conflicting marks when necessary.

When an opposition is filed within a prescribed time limit and the relevant fee has been paid, the proceedings are managed by the Office’s specialist service (the Opposition Division) and will normally include an exchange of observations from both the opponent and the applicant (the ‘parties’). After considering these observations, and if agreement has not been reached between the parties, the Opposition Division will decide (in an appealable ‘Decision’) either to reject the contested application totally or in part or to reject the opposition. If the opposition is not well founded, it will be rejected. If the ~~CTMA~~EUTM application is not totally rejected, and provided there are no other oppositions pending, it will proceed to registration.

2 The **grounds** Grounds for **opposition** Opposition

The grounds on which an opposition may be made are set out in Article 8 ~~CTMR~~EUTMR.

Article 8 ~~CTMR~~EUTMR enables the proprietors to base oppositions on their earlier rights to prevent the registration of ~~CTMs~~EUTMs in a range of situations progressing from that of absolute (i.e. double) identity both between goods and/or services and between marks (**Article 8(1)(a)** ~~CTMR~~EUTMR, where likelihood of confusion is presumed, and need not be proved) to that of similarity (**Article 8(1)(b)** ~~CTMR~~EUTMR,

where there must be a likelihood of confusion) (see the ~~Guidelines of Trade Mark Practice~~, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion).

Article 8(3) ~~CTM~~EUTMR allows the proprietor of a mark to prevent the unauthorised filing of its mark by its agent or representative (see the Guidelines, Part C, Opposition, Section 3, Trade Mark Filed by an Agent).

Article 8(4) ~~CTM~~EUTMR enables the proprietor of earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance to prevent registration of a later ~~CTMA~~EUTM application if the proprietor has the right to prohibit the use of ~~such CTMA. Although likelihood~~the EUTM application. ~~It enables right holders to invoke a wide variety of confusion is not expressly mentioned in this article, the application of the relevant rights protected under EU legislation or Member State laws, subject to the conditions of their acquisition and scope of protection under the applicable laws, and further provided that are brought into play under Article 8(4) CTMR will frequently require an analysis of likelihood~~the right invoked also fulfils the ~~EU law condition of confusion~~use in the course of trade of more than mere local ~~significance~~ (see the Guidelines, Part C, Opposition, Section 4, ~~Non-Registered~~Rights under Article 8(4) and 8(4a) EUTMR).

Article 8(4a) EUTMR enables beneficiaries of the protection of designations of origin and geographical indications under U legislation or Member State laws to oppose the registration of a later EUTM application even beyond the limited scope of *ex officio* protection of such rights on absolute grounds (Article 7(1)(j) EUTMR). In order to be eligible as a ‘relative’ ground for refusal, the right invoked must vest in its beneficiary a direct right of action against unauthorised use (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(4a) EUTMR).

Article 8(5) ~~CTM~~EUTMR enables the proprietors of an earlier reputed registered trade mark to prevent registration of a later ~~CTMA~~EUTM application that, without due cause, would encroach on the earlier reputed mark. Likelihood of confusion is not a condition for the application of this article. This is because Article 8(5) ~~CTM~~EUTMR specifically (but not exclusively) protects functions and uses of trade marks that fall outside the ambit of the badge of origin protection offered by likelihood of confusion and, as such, is more directed at protecting the heightened effort and financial investment that is involved in creating and promoting trade marks to the extent that they become reputed and to facilitate full exploitation of the value of the marks (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation).

3 The ‘~~earlier rights~~Earlier Rights’ upon which ~~opposition~~Opposition must be basedBased

An opposition must be based on at least one earlier right owned by the opponent.

The meaning of ‘earlier’ rights for Article 8(1) and 8(5) ~~CTM~~EUTMR is defined in **Article 8(2) ~~CTM~~EUTMR**, meaning such rights having an earlier date (not hour or minute, as confirmed by the Court in its judgment of 22/03/2012, C-190/10, ‘Génesis Seguros’) of application for registration than the ~~CTMA~~EUTM application, including applicable claimed priority dates, or have become well known in a Member State before the ~~CTMA~~EUTM application or, if appropriate, its claimed priority date. See the ~~Guidelines of Trade Mark Practice~~, Part C, Opposition, Section 1, Procedural Matters.

In essence, these rights consist of EU registered trade marks and applications for such, and 'well known' marks in the sense Article 6bis of the Paris Convention (which need not be registered). For a detailed explanation of these 'well known' marks under Article 8(2)(c) ~~CTMR~~EUTMR, and how they differ from Article 8(5) marks with reputation, see the Guidelines, Part C, Opposition, Section 5: Trade ~~marks~~Marks with ~~reputation~~Reputation, paragraph 2.1.2.

Under Article 8(3) ~~CTMR~~EUTMR, the opponent must show that it is the proprietor of a trade mark, acquired anywhere in the world by registration or by use (to the extent that the law of the country of origin recognises this kind of trade mark right), for which an agent or representative of the proprietor has applied for registration in its own name without the proprietor's consent.

Article 8(4) ~~CTMR, by contrast, deals with oppositions~~EUTMR is the ground for opposition based on earlier non-registered trade marks or ~~on another sign~~other signs used in the course of trade of more than mere local significance protected under EU legislation or Member State laws that confer on their proprietor the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that it acquired the right invoked (which may be use or registration based) before the application date or, as the case may be, before the priority date of the contested mark, in accordance with ~~provisions of EU Member State~~the conditions of protection of the applicable law. The meaning of 'earlier' rights for In addition, the opponent must also prove use of more than mere local significance of such a right before the date priority of the contested mark.

Article 8(4), ~~as regards the relevant date of acquisition, is thus defined by the relevant national law~~4a) EUTMR is the ground for opposition based on designations of origin or geographical indications protected under EU legislation or Member State laws that confer on the person authorised under such laws the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that the designation of origin or geographical indication invoked is earlier than the date of application or, as the case may be, the priority date of the contested mark.

Various legal grounds, based on different earlier rights, may be alleged in either the same or multiple oppositions to the same ~~CTMR~~EUTM application.

~~OHIM~~The Office's practice is based on the legal provisions of the ~~CTMR~~EUTMR applied directly or by analogy, as confirmed by the case-law of the General Court (judgment of 16/09/2004, T-342/02, 'MGM' and 11/05/2006, T-194/05, 'TeleTech'). Namely:

- **Multiple oppositions:** Rule 21(2) and (3) ~~CTMR~~EUTMR allows the Office to examine only the 'most effective' opposition(s), suspending the rest and eventually deeming them to have been dealt with if the application is rejected on the basis of the chosen opposition. With regards to the 'most effective' opposition, see below.
- **Multiple earlier rights in one opposition:** the Court has observed that grouping various earlier rights in one opposition is, for practical purposes, the same as presenting multiple oppositions, making it possible for the Office to base the rejection of the application on the 'most effective' right(s). With regards to the 'most effective' earlier right, see below.

- **Multiple legal grounds in opposition(s)**: if the opposition is successful in its entirety on the basis of the ‘most effective’ legal ground(s), it is not necessary to examine the remaining legal grounds. If a necessary requirement of a legal ground is not fulfilled, it is not necessary to examine the remaining requirements of that provision. With regards to the ‘most effective’ legal ground(s), see below.

4 The purpose of opposition proceedings and the most expedient way to treat them

The Court of Justice has stated that the sole purpose of opposition proceedings is to decide whether the application may proceed to registration and not to pre-emptively settle potential conflicts (e.g. at a national level arising from the possible conversion of the CTMA/EUTM application) (judgment of 11/05/2006, T-194/05, ‘TeleTech’, paragraphs 25-27).

The Court of Justice has confirmed clearly that the Office is under no obligation to examine all the earlier oppositions, rights and legal grounds invoked against the same CTMA/EUTM application, if one of them suffices to reject the CTMA/EUTM application. Nor is it obliged to choose the earlier right with the widest territorial scope so as to prevent the eventual conversion of the application in as many territories as possible (judgment of 16/09/2004, T-342/02, ‘MGM’ and 11/05/2006, T-194/05, ‘TeleTech’).

This principle allows for a more expedient treatment of oppositions. The Office is free to choose what it regards as the ‘most effective’ opposition(s), earlier right(s) and legal ground(s) and which one to examine first in light of the principle of procedural economy.

The ‘most effective’ opposition can normally be defined as the opposition which allows the Office to refuse the registration of the opposed CTMA/EUTM application to the broadest possible extent and in the simplest manner.

The ‘most effective’ earlier right can normally be defined as the most similar (the closest) sign covering the broadest scope of goods and services and/or the right covering the most similar goods and services.

The ‘most effective’ legal ground can normally be defined as the opposition ground which presents the Office with the simplest manner of refusing the registration of the opposed CTMA/EUTM application to the broadest possible extent.

Generally speaking, if applicable, Article 8(1)(a) will be the simplest ground in terms of procedural economy on which to reject a CTMA/EUTM application, since the Office will not need to enter into an analysis of similarities and differences between the signs or goods/services, nor will a finding of likelihood of confusion be necessary. Failing that, the factual circumstances of each opposition will determine whether Article 8(1)(b), 8(3), 8(4), 8(4a) or 8(5) are the next ‘most effective’ grounds (for example, if the goods and services of the earlier right and the CTMA/EUTM application are different, Articles 8(1)(b) and (3) cannot serve as a valid basis of opposition, the former requiring at least some similarity in this respect, and the latter requiring at least closely related or commercially equivalent goods and services).

If evidence of use has been requested by the applicant in relation to some of the earlier rights, the Office will normally firstly consider if one earlier right not yet under the use obligation is capable of fully sustaining the opposition. If not, other earlier rights not yet under the use obligation will be examined to see if the opposition can be fully sustained on such a cumulative basis. In these cases, the ~~CTMA~~EUTM application will be rejected without it being necessary to consider proof of use. Only if no such earlier right(s) is (are) available, will the Office consider those earlier rights against which proof of use was requested.