

***GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (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

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

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

Under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (the ‘CTMR’), 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, 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 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 is not totally rejected, and provided there are no other oppositions pending, it will proceed to registration.

Comment [RM1]: No need to specify ‘admissible’ here in the overview part

2 The grounds for opposition

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

Article 8 CTMR enables the proprietors to base oppositions on their earlier rights to prevent the registration of CTMs 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**, where likelihood of confusion is presumed, and need not be proved) to that of similarity (**Article 8(1)(b) CTMR**, 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).

Comment [RM2]: In line with the amendment of Section 2 Double Identity and Likelihood of Confusion.

Comment [DC3]: Not sure about this as the i.e. means that ‘double’ is explaining the meaning of ‘absolute’ which does not seem to make sense in the context.

Article 8(3) CTMR 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) CTMR 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 if the proprietor has the right to prohibit the use of such CTMA. Although likelihood of confusion is not expressly mentioned in this article, the application of the relevant laws that are brought into play under Article 8(4) CTMR will frequently require an analysis of likelihood of confusion (see the Guidelines, Part C, Opposition, Section 4, Non-Registered Rights).

Article 8(5) CTMR enables the proprietors of an earlier reputed registered trade mark to prevent registration of a later CTMA 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) CTMR 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' upon which opposition must be based

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) CTMR is defined in **Article 8(2) CTMR**, 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, including applicable claimed priority dates, or have become well known in a Member State before the CTMA 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, and how they differ from Article 8(5) marks with reputation, see the Guidelines, Part C, Opposition, Section 5: Trade marks with reputation, paragraph 2.1.2.

Under Article 8(3) CTMR, 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 based on earlier non-registered trade marks or on another sign used in the course of trade of more than mere local significance, in accordance with provisions of EU Member State law. The meaning of 'earlier' rights for Article 8(4), as regards the relevant date of acquisition, is thus defined by the relevant national law.

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

OHIM practice is based on the legal provisions of the CTMR 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) CTMIR 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) (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, if one of them suffices to reject the CTMA. 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 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 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, 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) or 8(5) are the next 'most effective' grounds (for example, if the goods and services of the earlier right and the CTMA 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 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.

ANNEX

Content and structure of Opposition Decisions

1 General remarks

Opposition decisions follow a **harmonised structure** (template) which, depending on the particular context, is adjusted to provide logical coherence to the decision. The use of the template also means that the decisions have a common **format**.

As regards **style and language**, opposition decisions are drafted in a formal style using a correct language. Language must be correct as regards both spelling and grammar, as well as in terms of formal aspects (for instance, coherent and complete sentences, correct references to the mark, to the goods and services, or to the parties, no repetition of paragraphs...). Decisions are sent for proofreading when that possibility is available.

Opposition decisions begin by setting out the **parties' details**: the names and addresses of the opponent, the applicant and their respective representatives (if any). The **date** of the decision is indicated.

This is followed by the Dictum (**'Decision'**) which states: whether the opposition is upheld or rejected; if relevant, the goods and services for which the opposition is (partially) upheld (except when the opposition is fully successful and the CTMA is rejected in its entirety); the decision on costs; and the fixation of costs. The final part of the decision also refers to 'costs' and is in line with the fixation of costs in the Dictum. Moreover, regarding costs, the decision contains a paragraph regarding the review of the fixation of costs (deleted when each party bears its own costs).

Next, the **'Reasons'** part of the decision starts with a 'factual part' identifying the contested mark by indicating the CTMA number, the contested goods and services, the earlier rights and all the grounds claimed by the opponent.

- *Earlier rights*: if an opposition is going to be entirely successful on the basis of one earlier right (and more than one has been invoked), the decision will only indicate the relevant earlier right (this will be done in the factual part). Where the opposition is partially or totally rejected, all the earlier rights invoked by the opponent will be identified in the decision (either in the factual part or at the end), by indicating territory (or territories for international registrations), registration number and including a reproduction of the sign¹.
- *Contested trade mark*: if the signs are not compared (e.g. the opposition is inadmissible, non-substantiated, rejected for insufficient proof of use or for dissimilarity of goods), the contested trade mark will be reproduced together with the CTMA number in the factual part.
- *Contested goods and services*: these will be listed in the comparison of goods and services section. If the comparison of goods and services is omitted (e.g.

¹ If a two letter code is used, it should be one of those available at <http://www.wipo.int/standards/en/pdf/03-03-01.pdf> except for Community trade marks where the abbreviations CTM or CTMA will be used instead of EM.

dissimilarity of signs), then the decision will normally only indicate, in the factual part, the classes to which the contested goods and services belong.

Thereafter, the Office sets out the procedural and substantive aspects of the decision in the order below. However, when deemed appropriate, taking into account the specific circumstances of a particular case, the Office may change the order in which the different factors are examined.

In the decisions of the Office certain procedural and substantive aspects (listed below) are only examined to the extent they are relevant to the outcome of the decision. This can also lead to a process of first examining one or some of the earlier rights invoked (usually those signs that have more similarities with the contested sign and/or cover a broader scope of identical or similar goods/services) and then dealing with the remaining earlier rights only to the extent that this is strictly necessary.

All opposition decisions have to incorporate the '**conclusion**' and/or '**global assessment**' part (in case of Article 8(1)(b) CTMR) where the result of the decision is reasoned in a coherent way supported by the arguments developed in the previous sections of the decision.

The decision will also address any remaining issues such as the relevance of other earlier opposing rights, the need to examine other heads of claim such as that under Article 8(5), 8(4), 8(3) and other pertinent matters.

- If an opposition is fully successful on the basis of one of the earlier rights then the Office will not decide on the other earlier rights. A brief statement that these will not be examined for economy of proceedings will be included.
- If an opposition is not successful on the basis of the earlier right that is considered 'closest' to the contested sign then it will normally be refused as regards the other earlier rights with a general statement which: fully identifies them (trade mark number, name (graphic representation) and goods and services) and explains that these earlier rights are considered even less similar to the one examined or, if they cover a broader list of goods and services than the one examined, explains why there is no likelihood of confusion as regards this other earlier right.
- Finally, the decision will address any other relevant arguments of the parties (especially the non-standard arguments of the losing party) or relevant procedural issues (such as *restitutio in integrum* requests, extensions/suspensions requested and strongly contested by the parties, requests for continuation requested and rejected or strongly contested by the parties).

2 Procedural rules – admissibility, substantiation

An opponent must comply with a range of procedural requirements in order for the opposition to proceed to the judgment on substance, in particular whether the earlier right or rights on which the opposition is based are (i) **admissible** and (ii) **properly substantiated**².

² See the Guidelines Concerning Opposition. Part 1: Procedural Matters.

A section dealing with these issues will be included at the beginning of the decision only when it is judged relevant for the outcome.

- As regards *admissibility*: if the opposition is entirely successful on the basis of one of the earlier rights that has been found admissible, the question of admissibility of the other earlier rights is not addressed. However, if the opposition is totally or partially rejected on the basis of an admissible and substantiated right that is not the most effective right, the question of admissibility of the most effective right will be dealt with.
- As regards *substantiation*: if the opposition is successful on the basis of one of the earlier rights that have been substantiated properly, the question of substantiation of other earlier rights will not be addressed. If the opposition is totally or partially rejected on the basis of an admissible and substantiated right that is not the most effective right, the question of substantiation of the most effective right will be dealt with. If the opposition has not been properly substantiated, it will be rejected on this ground only. Likelihood of confusion will not be dealt with. In principle, there is no need to examine the substantiation of one of the two earlier rights invoked when, in any event, it is concluded that there is no likelihood of confusion between the trade marks in conflict.

3 Proof of use

When proof of use of the earlier rights has been requested by the applicant, the Office will also examine whether, and to what extent, use has been proven for the earlier marks, again provided this is relevant for the outcome of the decision at hand.³

4 Article 8(1)(a) CTMR

This ground can only be accepted when there is double identity, namely, the signs are identical and the goods and services are identical.

The examination of identity normally opens with a comparison of the relevant goods/services followed by a comparison of the signs. If double-identity is found, there is no need for an assessment of likelihood of confusion. The conclusion that the opposition is upheld is automatic.

If identity between the goods/services and/or the signs cannot be established, the opposition fails under Article 8(1)(a) CTMR but the examination continues on the basis of Article 8(1)(b) CTMR.⁴

5 Article 8(1)(b) CTMR

The following sections must in principle be dealt with.

³ Comprehensive guidance on proof of use can be found in the Guidelines, Part C, Opposition, Section 6, Proof of Use.

⁴ See the Guidelines, Part C, Opposition, Part 2, Identity and Likelihood of Confusion, Chapter 1, General Principles and Methodology, paragraph 1.2.1.1.

5.1 Comparison of goods and services

Similarity of goods/services is a *sine qua non* for likelihood of confusion. As such, the examination of likelihood of confusion normally opens by comparing the relevant goods/services.

Comprehensive guidance on the comparison of goods/services can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services.

The decision will however not contain a full comparison of the goods and services:

- where the signs have been found **dissimilar**; and
- where in certain circumstances, for procedural economy, the Opposition Division may carry out an **expedited check of goods/services** on the assumption that, because there is identity or similarity between some of the relevant goods/services, all are identical or similar. This procedure is normally followed when, even if the degree of similarity of the goods/services were fulfilled to the maximum extent, having considered the remaining factors, no likelihood of confusion would be found. Naturally, this expedited check is only used where it does not affect the rights of either party.

If there is no degree of similarity between the goods/services, the examination will be terminated at this point in so far as likelihood of confusion is concerned.

Otherwise, if there is at least some degree of similarity, the examination continues.

5.2 Comparison of signs

At least some degree of similarity between the signs is a condition for a finding of likelihood of confusion. As seen above, the comparison of signs involves a global appreciation of the visual, aural and/or conceptual characteristics of the signs in question. If the comparison on one of the levels is not possible (e.g. the phonetic comparison as the mark is figurative), then this level may be left out. If there is similarity on at least one of the three levels, then the signs are similar. Whether the signs are sufficiently similar to result in a likelihood of confusion is dealt with in the global assessment of likelihood of confusion. Comprehensive guidance on the comparison of signs can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 3, Comparison of Signs.

The decision begins by setting out the relevant territory.

The decision then carries out an objective comparison of the signs which highlights the material visual, aural and conceptual similarities and differences between the signs. No consideration or weight is normally given *at this point* to the importance of the various coinciding or differing elements of the signs (this happens later in the decision). The objective comparison establishes that there is at least a *prima facie* case for likelihood of confusion by confirming that there is some degree of similarity between the signs.

This objective comparison of the signs also serves as a reference point when the Office later evaluates the dominant and distinctive components of the trade marks. If the

opposition is based on Article 8(5) and/or 8(4), the objective comparison acts as a reference point for the separate analysis that will be carried out under these headings.

If there is no degree of similarity between the signs, the examination of likelihood of confusion will be terminated at this point. The signs are **dissimilar** only if no similarity can be found on any of the three levels. If the signs are found to be dissimilar, no comparison of goods and services (including assumption of identity), no assessment of enhanced distinctiveness of the earlier trade mark or overall assessment will be made. The opposition will be rejected, as far as likelihood of confusion is concerned, in the '**Conclusion**' part, exclusively on the basis of the dissimilarity of the signs. Otherwise, where the signs are found to be similar visually, aurally or conceptually, the examination will continue.

5.3 Distinctive and dominant elements of the trade marks

The global appreciation of the conflicting trade marks must be based on the overall impression given by the trade marks, bearing in mind, in particular, their *distinctive and dominant* components. Therefore, in this section of the decision, the dominant and/or distinctive elements in the signs are explained and established.

Comprehensive guidance on the analysis of the *distinctive and dominant* components can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Distinctiveness, and Chapter 5, Dominant Character.

5.4 Distinctiveness of the earlier mark

Where an opponent explicitly claims that an earlier trade mark is particularly distinctive by virtue of intensive use or reputation, this claim will be examined and evaluated. Comprehensive guidance on the *distinctiveness of the earlier trade mark* can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Distinctiveness.

In certain circumstances, in the interests of procedural economy, the Office may not investigate a claim to enhanced distinctiveness where it is immaterial to the outcome of the decision. This will only occur where it does not affect the rights of either party.

If no claim is made on distinctiveness, or if the claim is not supported by the evidence, the assessment of the distinctiveness of an earlier trade mark will rest on its distinctiveness per se (in other words, its inherent distinctiveness).

5.5 Relevant public – level of attention

Comprehensive guidance on the *relevant public and level of attention* can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 6, Relevant Public and Level of Attention.

The decision describes who the relevant consumer is for the relevant goods/services and the significance of this finding. If relevant, it will also indicate the level of attention applied by the relevant consumer.

5.6 Global assessment, other arguments and conclusion

Comprehensive guidance on *Other factors* and *Global Assessment* can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 7, Other factors, and 8, Global Assessment. In addition to what has been mentioned above in relation to 'conclusion' and/or 'global assessment' the Global Assessment both:

- sets out and evaluates other factors and principles relevant to the evaluation of likelihood of confusion (such as, a family of marks, coexistence, or the mode of purchase of the goods/services);
- assesses the relative importance of *all* of the interdependent factors, which may complement or offset each other, in order to reach a decision on likelihood of confusion (for example, the marks may be distinctive for some of the goods or services but not for others and thus likelihood of confusion may only exist in relation to the goods and services for which the earlier mark is considered distinctive).

6 Article 8(3) CTMR

The grounds for refusal of Article 8(3) CTMR are subject to the following requirements:

- the opponent is the owner of the mark on which the opposition is based;
- the applicant is an agent or representative of the owner of the earlier mark;
- the application is filed in the name of the agent or representative;
- the application was filed without the owner's consent;
- the agent or representative fails to justify its acts;
- the signs are identical or have slight differences and the goods/services are identical or equivalent.

These conditions are **cumulative**. Therefore, where one of the conditions is not satisfied, the opposition based on Article 8(3) CTMR cannot succeed.

The following sections are in principle contained within the Opposition Decision:

- 1) Entitlement of the opponent;
- 2) Agent or representative relationship;
- 3) Application in the agent's or representative name;
- 4) Application without the owner's consent;
- 1) Absence of justification on the part of the applicant;
- 6) Comparison of signs;
- 7) Comparison of goods and services;
- 8) Conclusion.

However, depending on the case and its outcome, it might not be necessary to include all the above sections in the decision. The order of the sections can be modified, e.g. if the opposition can be rejected because the signs are dissimilar, comparison of the signs can be the first and the only section to be included in the decision.

Arguments and evidence provided by the parties must be examined and the reasoning provided in order to establish whether the requirements have been met.

Under the sections 'Comparison of signs' and 'Comparison of goods and services', it has to be established whether or not the signs are identical (or have slight differences which do not substantially affect their distinctiveness) and whether or not the goods/services are identical (or equivalent in commercial terms).

Comprehensive guidance on Article 8(3) can be found in the Guidelines, Part C, Opposition, Section 3, Unauthorised filing by agents of the trade mark proprietor.

7 Article 8(4) CTMR

Comprehensive guidance on *types of rights falling under Article 8(4) CTMR* can be found in the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) CTMR, paragraph 3.1 Types of rights falling under Article 8(4) CTMR.

The grounds for refusal of Article 8(4) CTMR are subject to the following **cumulative** requirements:

- the earlier right must be a non-registered trade mark or a similar sign;
- the sign must be used in the course of trade;
- the use must be of more than mere local significance;
- the right must be acquired prior to the filing date of the contested mark;
- the proprietor of the sign must have the right under the terms of the national law governing this right to prohibit the use of the contested mark.

However, if one of the abovementioned requirements is not met the opposition must be rejected, and it becomes unnecessary to address the other requirements.

Accordingly, the following sections must in principle be dealt with in the opposition decision.

7.1 Use in the course of trade of more than mere local significance

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights.

Comprehensive guidance on the *use in the course of trade* can be found in the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) CTMR.

7.2 The right under national law

It has to be demonstrated in the decision whether the opponent has acquired the invoked right in accordance with the law governing the sign in question (e.g. in some cases national laws demand registration, or reputation), whether the right was acquired prior to the filing date and whether and under what conditions the law governing the sign in question confers to its proprietor the right to prevent the use of a subsequent trade mark.

For the abovementioned purposes the information provided in the Guidelines (list of 'earlier rights' in the sense of Article 8 CTMR) and/or the evidence submitted by the parties has to be checked.

7.3 The opponent's right vis-à-vis the contested trade mark

This part of the decision examines whether the conditions set by the law governing the earlier sign are met in respect of the contested trade mark. This usually also requires a comparison of the signs and of the goods and services or business activities, and a conclusion in this regard.

7.4 Compliance with the criterion of national law

Once the goods and services and the signs have been compared, it has to be established whether the conditions set down by national law as established in the section 'The right under national law' are met, e.g. likelihood of confusion.

8 Article 8(5) CTMR

The grounds for refusal of Article 8(5) CTMR are subject to the following requirements:

- The signs in conflict must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the contested trade mark; it must exist in the territory concerned and in connection to the goods and/or services on the basis of which the opposition was entered.
- Encroachment upon reputation: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The abovementioned requirements are **cumulative** and therefore the absence of any of them leads to the rejection of the opposition under Article 8(5) CTMR. However, the fulfilment of all the above mentioned conditions may not be sufficient. The opposition may still fail if the applicant/holder establishes a due cause for the use of the contested trade mark.

Accordingly, the following sections must in principle be dealt with in the opposition decision.

8.1 Comparison of signs

The application of Article 8(5) CTMR requires a positive finding of similarity between the signs. Provided that the signs have already been compared under the examination of the grounds of Article 8(1)(b) CTMR, reference is made to the respective findings which are equally valid under Article 8(5) CTMR. It follows that, if in the examination of Article 8(1)(b) CTMR the signs were found to be dissimilar, the opposition will necessarily fail under Article 8(5) CTMR. However, the mere fact that the signs at issue

are similar is not sufficient for it to be concluded that a link between the signs will be established in the mind of the relevant public. The existence of such a link must necessarily be proven once the signs have been found to be similar.

Comprehensive guidance on the *Similarity of the signs* and *The link between the signs* can be found in the Guidelines Part C, Opposition, Section 5, Trade Marks with Reputation Article 8(5), paragraph 3.2, Similarity of the signs, and paragraph 3.3, The link between the signs.

8.2 Reputation of the earlier mark

The evidence filed in order to prove reputation should be properly indicated. There is no need to list and describe each and every item. Only the evidence relevant for the respective conclusion (whether it is sufficient or not in order to prove reputation) should be mentioned, in a general manner.

Comprehensive guidance on *Scope, assessment and proof of reputation* can be found in the Guidelines, Part C, Opposition, Section 5, Trade marks with reputation Article 8(5), paragraph 3.1.2, Scope of reputation, paragraph 3.1.3, Assessment of reputation, and paragraph 3.1.4, Proof of reputation.

8.3 Encroachment upon reputation

This section deals with the examination of whether detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose the opponent should file evidence or at least put forward a coherent line of argument, showing what the detriment or unfair advantage would consist of and how it would occur, which could lead to the *prima facie* conclusion that such an event is indeed likely in the ordinary course of events.

The examination of the opponent's claim(s) concerning encroachment should be preceded by identification against which goods and/or services the opposition is directed and in relation to which goods and/or services the reputation has been found.

Comprehensive guidance on *Forms of encroachment* and *Proof of encroachment* can be found in the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation Article 8(5), paragraph 3.4.3, Forms of encroachment, and paragraph 3.4.4, Proof of encroachment upon reputation.

If the opposition is entirely successful on the basis of one of the forms of encroachment there is no need to examine whether other forms also apply.

8.4 Due cause

Due cause is examined only if the CTM applicant has claimed it, and provided that there is similarity of signs, existence of reputation and existence of at least one of the forms of encroachment.

Comprehensive guidance on *Due cause* can be found in the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation Article 8(5), paragraph 3.5, Use without due cause.