

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

PART C

OPPOSITION

SECTION 1

PROCEDURAL MATTERS

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1 Introduction: General Outline of the Opposition Proceedings

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

When an opposition is filed against an International Registration designating the EU, any reference in ~~The~~the Guidelines to CTM applications must be read to include ~~International Registrations~~international registrations designating the EU. ~~The specific Manual, Part M, of the Guidelines, on International Marks, which~~ has been drafted specifically for International Marks and international marks, also makes reference to oppositions.

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:

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

It is important to note that in order to safeguard the principle of impartiality, the Office will not send any communication concerning the payment of the opposition fee or admissibility deficiencies during the opposition period.

After examination of admissibility of the opposition, a notification is sent to both parties to set the time limits for the proceedings. This starts with a period during which parties can negotiate an agreement (with or without any financial consequences) – this is known as the ‘cooling-off’ period. The cooling-off period is set to expire two months from the notification of admissibility. It can be extended once by 22 months and last up to a total of 24 months. Once the cooling-off period has expired, the adversarial part of the proceedings begins.

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

The Office may request the parties to restrict 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 its application. The applicant can question whether the earlier mark(s) have been used by filing a request for proof of use and it can file observations and evidence to convince the Office that the opposition should fail.

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

If the applicant files a request for proof of use of the earlier mark(s), 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 submit observations. If it does so, its observations are forwarded to the opponent, who will consequently be given an opportunity to file its final response.

In some other cases it may also be necessary or useful to have another exchange of observations. This may occur 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 may 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~~and~~, the file is ready for taking a decision on substance and the parties are informed accordingly.

2 Admissibility Check

2.1 Notice of Opposition in writing

Article 41(1)(3) CTMR Rules 16a and 17(4) CTMIR Decision EX-11-3 of the President of the Office

The Notice of Opposition has to be received by the Office in written form within the opposition period, namely within three months from the publication of the contested CTM application.

A Notice of Opposition received by fax or mail is keyed into the Office's IT system, and the opponent is sent a receipt. It is also possible to file electronic oppositions. The electronic opposition form is automatically collected and introduced into the Office's IT system.

The applicant immediately receives a copy of the Notice of Opposition (and of any document submitted by the opposing party) for information purposes. If the opposition is based on a Community trade mark, the applicant is also informed that it can access information about earlier Community trade marks via the online search tools, which are available on the Office's website.

2.1.1 Early oppositions against an international registration

Opposition against an international registration (IR) may be filed between the sixth and the ninth month following the date of first re-publication (Article 156(2) CTMR). For example, if first re-publication is on 15/02/2013, then the opposition period starts on 16/08/2013 and ends on 15/11/2013.

However, oppositions filed after the re-publication of the IR but prior to the start of the opposition period will be kept on hold and be deemed to have been filed on the first day of the opposition period. If the opposition is withdrawn before that date, the opposition fee will be refunded.

If the opposition is received before the beginning of the opposition period (Rule 114(3) CTMIR), a letter will be sent informing the opponent that the opposition will be deemed to have been received on the first day of the opposition period and that the opposition will be on hold until then.

2.1.2 Early opposition against a CTM application

Any Notice of Opposition against a CTM application received **by fax and/or post** before commencement of the opposition period in accordance with Article 41(1)-(3) CTMR will be kept on hold and be deemed to have been filed on the first day of the opposition period, namely the first day after the publication of the CTM application in part A.1. of the CTM Bulletin. If the opposition is withdrawn before that date or the CTM application is refused or withdrawn before publication (Article 39 CTMR), the opposition fee will be refunded.

The Office will inform the opponent that as the CTM application against which the opposition is directed has not yet been published in the Community Trade Marks Bulletin, it will be kept on hold and processed only after publication of the contested CTM application. The opponent is informed that the opposition will be deemed to be filed on the first day of the opposition period.

2.2 Payment

For general rules on payments, refer to The Guidelines, Part A, General [Rules](#)[rules](#), Section 3, Payment of [Fees](#)[fees, costs](#) and [Costs](#)[charges](#).

2.2.1 Notice of Opposition late, payment within the opposition period

Rule 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. In this case the Office will keep the opposition fee. The opponent must be notified and has two months to comment on the finding of inadmissibility.

If the opponent submits convincing evidence, such as fax reports, confirmation of receipt by messenger and/or delivery slips for registered mails, that proves that the Notice of Opposition was not late and was in fact correctly received by the Office within the three month opposition period, 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 evidence submitted by the opponent does not prove that the Notice of Opposition was received within the relevant time limit 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.

2.2.2 Time of payment

Article 41(3) CTMR
Article 8 CTMFR
Rule 17(1) CTMIR

The Office has to receive the full amount of the opposition fee within the opposition period.

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, the opposition can be saved if two conditions are met: 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 opponent submits proof that the payment instructions to the bank were given more than ten days before expiry of the time limit for payment. If the opposition fee was not 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.

Articles 5(2) and 8(1) CTMFR
Decision EX-06-1 of the President of the Office

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

Since the payment by current account 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.

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

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 for the account to be debited. This is true regardless of whether the opposition form is used 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 (e.g. indicating bank transfer).

Fee payment 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 its account can be debited for the benefit of the particular fee. In such cases the opponent must file an authorisation within the opposition period.

Payment is considered to be made on the date the Office receives the authorisation.

2.2.3 Consequences in the event of non-payment

Rules 17(1), (4) and 54 CTMIR

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

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

If within the two-month time limit allowed the opponent submits evidence that the Office finding concerning the loss of rights was inaccurate, and it 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.

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

2.2.4 Fee refund

Article 8(3), 9(1) CTMFR Rules 17(1) and 18(5) 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 Article 8(3) CTMFR.

2.3 Languages and translation of the Notice of Opposition

Article 119(5), (6) CTMR Rules 16, 17(3), 83(3) and 95(b) CTMIR
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According to Article 119(5) CTMR, the Notice of Opposition shall be filed in one of the languages of the Office. Several situations in relation to the choice of the language of proceedings can occur:

1. **OHIM's official opposition form has been used** and the opponent has chosen a possible language of proceedings.

The opposition complies with the language regime of the Regulations.

Examples

- a) The languages of the CTM application 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 proceedings. When the opposition is notified a blank official form in EN must be attached, and the language of the proceedings indicated.
 - b) The languages of the CTM application 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 proceedings. When the opposition is notified a blank official form in the indicated language must be attached.
2. **OHIM's official opposition form has been used** and the text in the form is in one of the languages of the Office but not in one of the possible languages of the proceedings.

If the textual elements important for admissibility cannot be translated (e.g. 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 admissibility. It does not 'exist'.

The Office will check if the opponent has indicated the language of the proceedings in the form.

- If not, or if a wrong language has been indicated, and both the first and the second language of the CTM application are languages of the Office, a letter asking the opponent to indicate the language of the proceedings will be sent. If no reply is received in the two month time limit the opposition must be rejected as inadmissible. When the opposition is notified, a blank form in the language of proceedings must be annexed.
- If not, or if a wrong language has been indicated and only one of the languages of the CTM application 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 proceedings is indicated in the letter.
- If the language of the proceedings is correctly indicated, a blank form in the language of the proceedings must be annexed when the opposition is notified.

The same applies if OHIM's official opposition form has been used and the text in the form is NOT in one of the languages of the Office.

3. **OHIM's official opposition form has not been used**, but the text of the opposition is written in a possible language of proceedings.

The opposition complies with the language regime of the Regulations.

4. **OHIM's official opposition form has not been used** and the text of the opposition is written in one of the languages of the Office, but not in one of the possible languages of proceedings.

In accordance with Article 119(6) CTMR and Rule 16(1) CTMIR, the opponent shall of its own motion file a translation in the language of the proceedings within one month. If none is received the opposition is inadmissible.

5. **OHIM's official opposition form has not been used** and the text of the opposition is written in one of the official languages but not in one of the languages of the Office.

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.

The list of goods and services has a special regime (see paragraph 2.4.2.3 below).

Explanation of grounds: when one of the boxes concerning grounds is ticked and additionally an explanation of facts or arguments is provided, 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 submitted later after expiry of the cooling-off period before expiry of the time limit for substantiating the opposition.

2.4 Admissibility check

Rules 15 and 17 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 submitted by the opponent on its own initiative within the opposition period are those laid down in Rule 15(1), (2)(a)-(c) CTMIR;
- the indications and elements which, if they are not provided within the opposition period, trigger a deficiency notice by the Office allowing the opponent to remedy this within a non-extendible time limit of two months are those laid down in Rule 15(2)(d)-(h) CTMIR;
- 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) CTMIR.

2.4.1 Absolute admissibility requirements

If the opposition is inadmissible due to absolute admissibility requirements, the opponent must be informed and invited to comment on the admissibility. If the

inadmissibility is confirmed, a decision rejecting the opposition is sent and copied to the applicant.

Oppositions against ~~CTM~~ACTMAs

The earlier marks/rights are examined to see if one is clearly identified. If 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 the inadmissibility before the decision on inadmissibility is taken. If the only earlier right on which the opposition is based is duly identified (absolute requirements), the Office will examine whether it also meets the relative admissibility requirements.

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.

Oppositions against ~~IR~~IRs with EU designation

Concerning oppositions against IRs with EU designation a full admissibility check is carried out. This check must extend to all earlier rights. If none of the earlier rights is duly identified, the opposition is inadmissible and the opponent is invited to comment on the inadmissibility before the decision on inadmissibility is taken.

2.4.1.1 Identification of the contested CTM application

Rules 15(2)(a) and 17 CTMIR

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

If, for example, the application number indicated does not correspond to the name of the applicant indicated, the Office will decide if it can be established without any doubt which is the contested CTM application. If the applicant's name is not indicated, it can be found in the Office's IT system.

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

Only one CTM application can be contested in one Notice of Opposition.

If the CTM application 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 the inadmissibility has to be sent. If the inadmissibility is confirmed, a decision rejecting the opposition is sent and copied to the applicant.

2.4.1.2 Identification of the earlier marks / rights

Article 8(2) CTMR Rules 15(2)(b) and 17(2) CTMIR

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 or any documents submitted within the opposition period.

An opposition can be based on five types of earlier rights: (1) earlier trade mark registrations or applications, (2) earlier trade mark registrations or applications with a reputation, (3) earlier well-known marks, (4) earlier unregistered trade marks and (5) earlier signs used in the course of trade.

Earlier rights that are not earlier

Articles 8(2) and 41(1) CTMR

For an earlier right to be earlier it must have, in the absence of any priority, an application date that is prior to the day on which the contested CTMA has been filed. In case of conflict between a national mark and a CTM application, the hour and the minute of filing of the national mark is not relevant for determining which mark is earlier (judgment of 22/03/2012, C-190/10, 'Génésis').

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 is done at the admissibility stage.

When the only earlier mark is or all earlier marks are not earlier, the Office will inform the opponent of the inadmissibility and invite it to comment on that issue before a decision on inadmissibility is taken.

Where the opposition is based on more than one right, one being earlier and one or more are not earlier, 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.

Earlier trade mark registrations or applications

Article 8(2)(a), (b) CTMR Rules 15(2)(b), 17(2) and 19(3) CTMIR
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These rights are Community trade mark registrations or applications, international registrations designating the European Union, 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.

In such a case, the opponent must base its opposition on the Community trade mark explicitly claiming within the three month opposition period that the national mark continues to exist through the seniority claimed in the CTM. A clear link must be established between the CTM indicated and the earlier mark for which the seniority was claimed in the CTM. Within the time limit set according to Rule 19(1) CTMIR, the opponent must provide sufficient proof, emanating from the OHIM, that the seniority claim has been accepted and proof, emanating from the administration by which the national trade mark was registered, that the national mark has been surrendered or allowed to lapse according to Article 34(2) CTMR.

The absolute identification elements for earlier trade mark registrations and applications 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 if the opponent indicates the number of the CTM(A) under conversion and the countries for which it 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. 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.

Trade marks filed by an agent

Article 8(3) CTMR, Rule 15(2)(b)(i) CTMIR

A trade mark filed by an agent is the contested CTM application for which the opponent claims that the applicant who has or had a business relationship with the opponent (its agent or its representative) applied for this mark without its consent.

The earlier marks or rights on which the opposition is based must be identified according to the same criteria as earlier trade mark registrations or applications. That is, the country and registration or application number must be given. The representation of the mark (in colour if applicable) must be given only if the earlier mark of the proprietor is an unregistered mark, because in this case no registration number can be provided to clearly identify the earlier mark. For unregistered word marks, the word that makes up the mark must be indicated. For unregistered figurative or other marks, the representation of the mark as it is used and claimed by the proprietor must

be provided. See also ~~The Manual~~[the Guidelines](#), Part C, Opposition, Section 3, Trade Mark Filed[mark filed](#) by an ~~Agent~~[agent](#).

Earlier trade mark registrations or applications with reputation

Article 8(1), (5) CTMR
Rule 15(2)(c), (g) CTMIR

Under Article 8(5) CTMR an opposition can be based on a mark with reputation, invoked against goods and services that are dissimilar- [and/or similar](#). The mark with a reputation can be an earlier Community, international, Benelux and national registration, and an earlier application subject to its registration.

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

Earlier well-known mark

Article 8(2)(c) CTMR
Rules 15([2](#))(b)(i), (ii) and 17(2) CTMIR

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 or an unregistered mark or a mark which in the territory where it is to be protected is not registered (irrespective of its registration in the territory of origin).

The absolute indications are:

- 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) CTMIR, 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 (in colour if applicable) as it is used and claimed to be well-known must be provided. [here](#) If 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 (decision of 17/10/2007, [R0160R 0160/2007-1 'QUART/Quarto'](#)).

Earlier non-registered marks and earlier signs used in the course of trade

Article 8(4) CTMR Rules 15(2)(b)(iii) and 17(2) CTMIR
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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 are:

- 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 its 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;
- a representation of the earlier right (in colour if applicable).

In the absence of the previous indications, the relevant right will be inadmissible.

2.4.1.3 Identification of grounds

Article 41(3) and Article 75 CMTR Rule 15(2)(c) and Rule 17(2) CTMIR

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

The specification of the grounds should consist of a statement to the effect that the respective requirements under Article 8(1), (3), (4) and (5) CTMR are fulfilled. Arguments and evidence are voluntary at this point in the proceedings.

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 Article 8(1).

In both cases it is possible to identify 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 will be invited to present comments on inadmissibility before taking the decision rejecting the opposition.

2.4.2 Relative admissibility requirements

Rule 15(2)(d) – (h) CTMIR

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 the deficiencies. If the opponent remedies the deficiencies, the opposition is considered admissible; if not, it will be rejected on the grounds of inadmissibility.

2.4.2.1 Dates

Rule 15(2)(d) and Rule 17(4) CTMIR

These include 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) CTMR,
- earlier well-known mark invoked under Article 8(2)(c) CTMR, if it is registered in the Community,
- earlier mark under Article 8(3) CTMR if it is registered,
- earlier mark with a reputation invoked under Article 8(5) CTMR.

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 database.~~ If these elements are lacking the opponent must be notified of the deficiency.

2.4.2.2 Representation of earlier mark / sign

Rule 15(2)(e) and Rule 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 provide a representation of the mark under Rule 15(2)(e) CTMR applies to the following rights:

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

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

If the mark is 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~~ opponent must be notified ~~as soon as of~~ the ~~Office becomes aware of~~ it ~~deficiency~~. If the opponent does not comply within the two-month time limit given, the earlier right will be rejected as inadmissible.

If the earlier mark is a CTM, a representation is not requested since it is available on the Office's databases.

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 and Hungary. In these cases the Office neither asks for a colour representation nor requests the opponent to file a translation of the colour indications.

The following countries have either always published in colour or have done so since the date indicated:

- Austria
- Belgium
- Bulgaria
- Croatia (2009)
- Czech Republic (1999)
- Denmark
- Germany
- Estonia (2003)
- Finland (2005)
- France (1992)
- Germany
- Greece (2007)
- Ireland (2003)
- Greece (2007)
- Spain (as of 31/07/2002)
- France (1992)
- Italy
- Lithuania (as of July 2009)
- Luxembourg

- Malta
- Netherlands
- ~~Austria~~
- Poland (2003)
- Portugal (2006)
- Romania
- ~~Slovenia (1992)~~
- Slovakia (2008), ~~Finland (2005)~~
- Slovenia (1992)
- Spain (as of 31/07/2002)
- Sweden
- United Kingdom (2004)
- ~~Croatia (2009)~~

International marks have been published in colour since 1989.

Rules 80(2) and 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.

2.4.2.3 Goods and services

Rule 15(2)(f) and Rule 17(4) CTMIR Communication No 5/07 of the President of the Office
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Rule 15(2)(f) CTMIR stipulates that 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.

The opposition can be based on all the goods and services for which the earlier mark is registered or applied for, or only some of the goods and services.

According to Communication No 5/07 of the President of the Office of 12/09/2007 on changes of practice in opposition proceedings, an indication of the class number(s) is accepted as sufficient indication of the goods and services of the earlier rights on which the opposition is based. This is implemented as described below.

Part of the goods and services

If the opposition is based on part of the goods and services for which the earlier mark(s) is/are registered/applied for, these goods and services need to be listed in the language of the proceedings.

The Office will also accept an indication of the relevant class number(s) provided that a registration certificate or extract from an official source is attached (the registration certificate or extract must either be in the language of the proceedings or be translated

into the language of the proceedings or make use of national or INID codes so as to clearly identify the relevant class number(s)).

If the goods and services on which the opposition is based are fewer than the goods and services for which the mark is registered, the goods and services on which the opposition is not based need not be indicated, as they are irrelevant to the proceedings.

All of the goods and services

If the opposition is based on all of the goods and services for which the earlier mark(s) is/are registered/applied for, these must be listed in the language of the proceedings. However, instead of listing them, the opponent may refer to 'all goods and services for which the earlier mark is registered', provided that a registration certificate or extract from an official source is attached (the registration certificate or extract must either be in the language of the proceedings or be translated into the language of the proceedings or make use of national or INID codes).

The Office will also accept an indication of the relevant class number(s) provided that a registration certificate or extract from an official source is attached (the registration certificate or extract must either be in the language of the proceedings or be translated into the language of the proceedings or make use of national or INID codes so as to clearly identify the relevant class number(s)).

Additionally, where the opponent indicates in the opposition form that the opposition is based on 'all goods and services for which the earlier right is registered' but then lists only 'part' of these goods and services (when compared with the registration certificate or relevant official extract attached to the opposition form) the Office will, in order to overcome the contradictory information contained in the Notice of Opposition, assume that the opposition is based on 'all goods and services for which the earlier right is registered'.

Even if the opponent has not indicated, or has not clearly indicated, on which goods and/or services it bases its opposition, it is sufficient that 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 or if no certificate is attached, the deficiency must be notified.

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.

An indication of this type is only acceptable when the opponent replies that it owns a registration with a description that mentions that the sign is registered for 'all goods in Class 9'.

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.

Specific aspects: Oppositions filed against international registrations designating the European Union

For admissibility purposes, with regard to oppositions filed against international registrations designating the European Union, an indication of the class number(s) only in the Notice of Opposition is not sufficient to identify the goods and services on which the opposition is based. If the opposition is based on all or part of the goods and services for which the earlier mark(s) is/are registered/applied for, these goods and services need to be listed in the language of the opposition proceedings. This list must include all the goods or services covered by that mark or at least the relevant goods or services on which the opposition is based.

2.4.2.4 Earlier mark with a reputation: scope of reputation

Rule 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.

2.4.2.5 Identification of the opponent

Article 41(1) CTMR
Rules 1(1)(b) and 15(2)(h),(i) CTMIR

The opponent can either be a natural or a legal person. In order to be able to identify the opponent, there must be an indication of its name and address.

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 its 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.

Entitlement

Rule 1(1)(b) and Rule 15(2)(h)(i), (iii) CTMIR

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 it have to make a statement to that effect,

and it has to specify the basis on which it is so entitled or authorised. If those details are not given, a deficiency must be notified.

In accordance with Rule 15(2)(h)(i) CTMR an opponent who acts as a licensee or authorised person has to indicate its 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, the 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 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, it is entitled to file an opposition, irrespective of its country of origin.

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).

Opposition based on an earlier CTM

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) 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.

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

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 regarding the need to register the transfer in the national trade mark register 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 will accept the opposition as valid with A as opponent, even though it 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 it is indicated in the Notice of Opposition that it opposes in its capacity as licensee).

Multiple opponents

Rules 15(1) and 75(1) CTMIR
Decision of 11/10/2000, R 623/1999-1 'Emultech'

In some cases 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 will 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 owns 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 time limit set, the opposition will be rejected as inadmissible.

Acceptable

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

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

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

Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owners	<u>A/B</u>	<u>A/C</u>	<u>A</u>	<u>A</u>	<u>A</u>

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

Not acceptable

Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owner	<u>A</u>	<u>A</u>	<u>B</u>	<u>B</u>	<u>B</u>
Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owners	<u>A</u>	<u>A</u>	<u>B</u>	<u>B</u>	<u>B</u>

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	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owner	<u>A/B</u>	<u>A</u>	<u>A</u>	<u>B</u>	<u>B</u>
Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owners	<u>A/B</u>	<u>A</u>	<u>A</u>	<u>B</u>	<u>B</u>

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	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owner	<u>A/B/C</u>	<u>B/C</u>	<u>A</u>	<u>A</u>	<u>A</u>
Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>
Owners	<u>A/B/C</u>	<u>B/C</u>	<u>A</u>	<u>A</u>	<u>A</u>

The opponents will have to be asked to continue the opposition either as multiple opponents A, 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 it in the case.

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

Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>
Owner	<u>A</u>	<u>A</u>	<u>A</u>
Licensees	<u>B</u>	<u>C</u>	<u>None</u>
Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>
Owner	<u>A</u>	<u>A</u>	<u>A</u>
Licensees	<u>B</u>	<u>C</u>	<u>None</u>

By contrast, in the following case, although B is accepted as a multiple opponent as licensee for earlier mark 1, it 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
Earlier trade marks	<u>1</u>	<u>2</u>	<u>3</u>
Owner	<u>A</u>	<u>A</u>	<u>B</u>
Licensees	<u>B</u>	<u>C</u>	<u>A</u>

Evidence

In cases where the opposition is based on earlier registered marks the most common means to provide evidence of co-ownership is to submit a copy of the registration certificate or an extract from an official database. 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.

2.4.2.6 Professional representation

Representative

Articles 92 and 93 CTMR
Rule 15(2)(h)(ii) CTMIR

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

If the opponent is from the EU (not obliged to be represented under Article 92 CTMR), 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 CTMR, 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 the opponent to appoint a representative and/or to indicate the name and address of the representative, failing which the opposition will be rejected as inadmissible.

Rule 77 CTMIR

Any Office 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.

In addition, if the represented person itself files documents with the Office while being represented by a duly authorised representative, these documents will be accepted by the Office as long as the represented person has its domicile or its principal place of business or a real and effective industrial or commercial establishment in the EU. If this is not the case, the documents submitted will be rejected.

For further information, see the Guidelines, Part A, General rules, Section 5, Professional representation.

Multiple representatives, common representative

Rule 75 CTMIR

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 representative 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), this representative shall be considered to be the common representative, unless the opponent first named in the opposition notice has appointed a representative.

Rule 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, that representative shall be considered to be the common representative for all these persons.

For further information, see ~~The~~ Guidelines Part A, General ~~Rules~~ rules, Section 5, Professional ~~Representation~~ representation.

Change of representative

Rule 76 CTMIR

During the oppositions proceedings the opponent's and the applicant's representative may change. For further information, see [The Guidelines](#) Part A, General [Rules](#), Section 5, Professional [Representation](#).

Authorisation

Article 92(2) CTMR Rule 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 authorisation is filed, the Office will specify a time limit within which such an authorisation must be filed.

Details on representation and authorisations are set out in [The Guidelines](#) Part A, General [Rules](#), Section 5, Professional [Representation](#).

2.4.2.7 Signature

Rules 80(3) and 82(3) 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 telecopier electronically or by electronic means need not be signed and it is sufficient that the name of the sender is indicated.

2.4.2.8 Relative ~~inadmissibility~~[admissibility](#) requirements: sanctions

Rule 17(4) CTMIR

If relative admissibility requirements are missing or not complied with, the opponent or its 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 will be notified that the opposition is admissible but that the earlier rights concerned cannot be taken into account.

2.4.3 Optional indications

2.4.3.1 Extent of the opposition

Rule 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 mark.

If the opponent indicates that the opposition is only directed against part of the goods and services of the CTM application, it will have to clearly list these goods. If it does not do so, either in the Notice of Opposition or in the explanation, it must be notified of the deficiency. If the deficiency is not remedied by listing the goods and/or services against which the opposition is directed within the time limit given, the opposition will be rejected as inadmissible.

There are cases where, in reply to the Office's letter asking the opponent to list exactly which part of the goods and services it opposes, the opponent indicates 'all the goods and services which the contested mark is applied for'. The Office cannot accept this indication as valid and the opposition must be rejected as inadmissible. 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 its opposition in this respect and cannot extend its scope after the opposition period of three months.

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* – in this example, the only contested goods are considered to be *trousers*). 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.

Additionally, where the opponent indicates in the opposition form that the opposition is directed against 'part of the goods and services of the contested mark' but then lists 'all' of these goods and services in the Notice of Opposition or in the annexes, the Office will, in order to overcome the contradictory information contained in the Notice of Opposition, assume that the opposition is directed against 'all the goods and services'.

2.4.3.2 Reasoned statement

Rule 15(3)(b) CTMIR

It is now clear from the wording of Rule 15 CTMIR that a distinction must be made between:

- the basis of the opposition, i.e. the earlier right invoked; it must be properly identified and cannot 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) CTMIR, 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 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 may be provided after expiry of the cooling-off period (Rule 19(1) CTMIR) and concerns the substance, not the admissibility, of the opposition.

2.5 Notification of the Notice of Opposition

Rules 16a and 18 CTMIR
Decision EX-11-3 of the President of the Office

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, will be sent by the Office to the other party for the information purposes.

Once the opposition has been found admissible pursuant to Rule 17 CTMIR, the Office will send a notification to the parties informing them that the proceedings shall be deemed to commence two months after receipt of the communication. The notification will also set the time limit for the opponent to present the facts, evidence and arguments in support of its opposition, as well as the time limit for the applicant to submit its observations in reply. It is important to note that due to different means of communication (fax, e-communication and post) the time limits mentioned in this notification are set according to the ‘slowest’ communication channel. For example, if one of the parties is notified by e-communication through the official webpage of the Office, notification shall be deemed to have taken place on the fifth calendar day following the day on which the document was created by the Office’s systems. Therefore, if the notification to the other party is sent by fax, this latter party will also be granted the five additional days so that the time limits granted in the notifications coincide.

Whenever the opposition is based on an earlier trade mark registered or applied for in colour, the Office will ensure that the colour representation is received by the applicant. In some cases this may require notification by post.

Notification is not carried out before the expiry of the opposition period.

3 Cooling-Off Period

3.1 Setting the cooling-off period in motion

Rules 17, 18(1), 19 and 20(2), (6), (7) CTMIR
Communication 1/06 of the President of the Office

When the opposition is found admissible, the Office sends a notification to the parties informing them that the opposition is deemed admissible and that the proceedings shall be deemed to commence two months after receipt of the [communication notification](#) (a two-month 'cooling-off' period is granted before the proceedings officially start with [some](#) legal consequences as regards the opposition fees in particular).

According to the judgment of the Court of Justice of 18/10/2012 in case C-402/11 P, 'REDTUBE', the notification sent to the parties informing them that the opposition is admissible in accordance with Rule 18(1) CTMIR constitutes a decision that may be appealed together with the final decision on the case as stated in Article 58(2) CTMR. Consequently, the Office is bound by this decision.

The cooling-off period will be set to expire two months from the notification. The exact day of the expiry is indicated in the Office's [communication notification](#). 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.

The cooling-off period may last up to a total of 24 months if both parties submit requests for 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. [Requests can be accepted at this stage but will only have effect once the cooling-off period has expired.](#) When the parties invoke on-going negotiations, the proceedings will not be suspended during the cooling-off period, but a request for such a suspension may be made after the expiry of the cooling-off period.

The opponent will be given a time limit of two months after the expiry of the cooling-off period to submit facts, evidence or arguments irrespective of whether it has already submitted such facts, evidence or arguments together with the Notice of Opposition. Within the same time limit, the opponent shall also substantiate its earlier right(s).

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), 2nd sentence CTMIR). Rather, it will be for the opponent to decide what it 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 is forwarded to the opponents as an annex to the notification of the admissibility of the opposition and it may be referred to by opponents as a check-list in preparing their oppositions.

In practice, the time limit for submitting such additional material will be set at four months from the date of notification. Therefore, opponents should be aware that the time limit for submitting such additional material is not a time limit of two months

beginning after the cooling-off period has expired, but a time limit of four months from the notification.

The applicant will be given an additional time limit of two months for replying to the opposition. Rather than setting a separate time limit of two months (two months for the cooling-off period, two months for completing the opposition, two months for replying), the time limit for replying to the opposition will be set at six months from the notification of admissibility (day of the start of the cooling-off period).

When the opponent completes its opposition any time after the notification and before the expiry of the four months available to it, the additional material will be forwarded to the applicant without any change in the time limit 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 time limit 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 time limit 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 time limit of two months to prepare its reply.

3.2 Extension of the cooling-off period

Article 119(5), (6) CTMR
Rules 18(1) and 96(1) CTMR
Communication 1/06 of the President of the Office

The cooling-off period may be extended up to a total of 24 months.

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

- A signed request from both parties. This may either take the form of two separate requests or one joint request. It is not necessary to state a reason for the extension.
- The request must be in the language of the proceedings. Alternatively, the request can be filed in one of the Office languages. However, a translation must be filed within one month of filing on the parties' own motion. The Office does not send any letter requesting a translation of the request for extension.
- The request must be filed 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.

The extension of the cooling-off period must be distinguished from requests for extension of a time limit or a suspension. In the event that the request for extension is inadmissible because it has been filed late or because the cooling-off period had already been extended, it will be treated as a request for suspension provided that the conditions of such a request are fulfilled.

The extension is granted for a period of 24 months to be counted from the date of the start of the cooling-off period. This procedure avoids multiple extensions and at the

same time leaves the parties maximum freedom to decide when they want to continue with the adversarial stage of the proceedings.

Any party can then bring the extended cooling-off period to an end (~~opting out~~), ~~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'~~ opt out), by expressly indicating this in writing.

It is immaterial whether the other party agrees with this or not.

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 time limits are notified for the substantiation of the opposition and the reply of the applicant, which shall be two and four months from the end of the cooling-off period.

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

4 Adversarial Stage

4.1 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 its opposition.

Within the same time limit, the opponent must prove the existence and validity of its invoked earlier rights.

4.2 Substantiation

Article 41 CTMR Rules 19, 20(1) and 79 CTMIR

Substantiation is defined by Rule 19(2) CTMIR and refers to the proof of existence, validity and scope of protection of the earlier mark(s) or right(s) as well as the proof of the entitlement to file the opposition.

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 it may not only complete its file, that is, present all the evidence ~~it deems necessary to win~~ in support of its opposition, but within which it also has to prove the existence and validity of the earlier rights invoked and its entitlement to file the opposition. When it is relevant for the opposition, the opponent shall also submit evidence of reputation, enhanced distinctiveness or any other aspect affecting the scope of protection of its earlier right(s) etc.

The evidence must be in the language of the proceedings or accompanied by a translation for substantiation purposes. The translation must be provided within the time limit for submitting 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.

Unless submitted by fax transmission or electronic communication, any supporting document or other evidence must be presented in two copies, one being for transmission to the other party. Items submitted by post or personal delivery 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 or personal delivery must be accompanied by a copy. If no copy is provided, these documents or items of evidence will not be taken into account.

If the opponent has not proven the existence of at least one earlier right, the opposition will be refused as unfounded.

If the earlier right that has been found admissible is not substantiated at the substantiation stage and there is/are another/other earlier right~~(s)~~ that is/are substantiated, the absolute admissibility requirements for that/those earlier right(s) must be checked ~~for this/these earlier right/s~~.

The opponent has to show its entitlement to file the opposition for the purpose of substantiation (see paragraph 4.2.3.4 below ~~point 2.7~~).

4.2.1 CTMs and CTM applications

If the earlier mark or application is a CTM, the opponent does not have to submit any documents as far as the existence and validity of the CTM(A) is concerned. The examination of the substantiation will be done ex officio with respect to the data contained in the database of the Office.

4.2.2 Converted CTM(A)s

Article 112(1) CTMR

This section will only deal with specific aspects of conversion in opposition proceedings. For further information on conversion, see the Guidelines, Part E, Register Operations, Section 2, Conversion.

~~4.2.2.1 Contested converted CTM application~~

~~During opposition proceedings, the applicant may file a request for conversion where the contested CTM application is refused totally or partially, and when it withdraws or restricts the contested CTM application.~~

4.2.2.2 Opposition based on (to be) converted CTM(A)

National applications deriving from the conversion of an earlier CTM or CTM application 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 (or CTM application) under conversion and the countries for which it has requested the conversion.

When during opposition proceedings the CTM application (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 and~~ a request for conversion is filed, the proceedings can continue. This is because national trade mark registrations resulting from a conversion of a CTM application can constitute the basis of the opposition procedure originally made on the basis of that CTM application (decision of 15/07/2008, ~~R4343R~~ 1313/2006-G, 'CARDIVA/CARDIMA').

In such a case the Office will request the opponent must in writing to inform the Office ~~in writing whether it maintains the opposition in view of the intention withdrawal, surrender or rejection of the earlier CTM application(s) or registration(s) and whether it intends~~ to rely on a right arising the national applications which result from the conversion of the earlier CTM. If the ~~opposition is at a stage before the opponent does not inform the Office within the established time limit for substantiation of the rights, the time limit to file such a notification is the same as that for substantiation. In this situation, the opponent must file evidence it wishes to rely on the national applications, the opposition will be rejected as unfounded.~~

Evidence of the existence of the national application(s) within the time limit for substantiation. In all other cases the time limit 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 becomes final, etc.) and in any case before a decision on the opposition is taken. At the same time earlier national applications must be filed by the opponent must file evidence of the existence of the national application(s). The opponent must notify the Office of the outcome of the conversion request(s) at its earliest convenience.

~~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 the decision is taken.~~

4.2.3 Trade mark registrations or applications that are not CTMs

Rule 19 (2)(a)(i)(ii) CTMIR

To substantiate 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:

- certificates issued by the appropriate official body
- extracts from official databases

- extracts from official bulletins of the relevant national trade mark offices and WIPO.

4.2.3.1 Certificates issued by the appropriate official body

Any registration certificate or the most recent renewal certificate showing the validity of the earlier mark beyond the time limit that was given to the opponent to substantiate its 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. Once the earlier application has proceeded to registration, the opponent must file evidence of registration. If, after the adversarial part of the proceedings, the opponent provides evidence that the national application in fact proceeded to registration before the time limit set in Rule 19(1) CTMIR, the earlier mark will be rejected as unfounded under Rule 20(1) CTMIR. 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 present only few differences between an application form and the registration certificate and have to be checked carefully.

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

4.2.3.2 Extracts from official databases

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. The unaltered electronic image of an online database extract reproduced on a separate sheet is also acceptable as long as it contains an official identification of the authority or database from which it originates. Extracts from commercial database are not accepted, even if they reproduce exactly the same information as the official extracts.

Officially accepted databases include:

- **TMview**: for CTMs and trade marks applied for or registered with the participating offices (as long as it contains the relevant data). For further information see: <http://www.tmview.europa.eu/tmview/welcome.html>.
- **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),
- **S.A.R.A, UIBM** on-line from the UIBM web site and Telemaco from the Italian Chambers of Commerce (for Italian marks).

As regards international registrations, the following databases are accepted:¹

- **ROMARIN** (the 'short' version of the extract being sufficient as long as it contains all the necessary information),
- **TMview** (as far as it contains all the relevant data).

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

Extracts from commercial databases are not acceptable even if they reproduce all the necessary information. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK, SAEGIS 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.

Examples

Extracts from SITADEX (Official database from the Spanish Office) sometimes do not contain the list of goods and/or services, in such cases, the opponent must file an additional document (e.g., a publication in the official bulletin) showing the list of goods and services.

SITADEX extracts sometimes do not show the image on the same page when the mark is figurative. The image sometimes appears on a separate page. Consequently, as regards figurative Spanish trade marks, when opponents file an extract from SITADEX as evidence they must ensure that the representation of the mark appears on the same page and if not an additional document/page showing the image must be filed. This can be from SITADEX itself (which reproduced the image on a separate page which when printed or saved to .pdf, for example, includes an identification of the source) or from another official source (such as its publication in the official bulletin). Copying the image from SITADEX and including it electronically or otherwise in the Notice of Opposition form is not sufficient.

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 trade mark. 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

¹ The practice of the Office has been to accept printouts of the CTM-Online database for international registrations with EU designation. This practice will not continue since this approach contravenes Rule 19(2)(a) CTMIR. An exception to this rule is not provided in Title XIII of the CTMR. This new practice came into force on 01/07/2012 and applies to all oppositions filed as from this date (on or after). The information contained in the standard letters for the notification of admissible oppositions was updated as from 01/07/2012. The old practice continues to apply to all oppositions with a filing date before 01/07/2012.

translation into English. The same also applies to official extracts of other national offices which provide the English version of their extracts, such as in Slovenia.

4.2.3.3 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 the 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 the 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 can still be refused by national offices during the following 12 to 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.

4.2.3.4 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
Croatia	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 01/07/1996 (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 trade marks applied for since 12/05/89 (20 years for trade marks applied for before that, counting from the date of registration, and with a renewal from the filing date)	Filing date
United Kingdom	10 years since 31/10/94 (trade marks applied for prior to that were, upon the completion of the registration formalities, in force for 7 years from the date of the application. Trade 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 instalments of 10 years equivalent to a renewal fee)	International registration date

According to Rule 19(2)(a)(ii) CTMIR, if the trade mark is registered, the opponent must provide evidence of registration. If the evidence submitted does not prove that an application is registered, and later, one of the parties proves that upon expiry of the time limit set under Rule 19(1) CTMIR the opponent failed to prove this, Rule 19(2)(a)(ii) CTMIR will apply, and the earlier mark will be rejected as unfounded.

4.2.3.5 Verification of 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 (i.e. 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. It must be verified that the claim submitted by the opponent within the three-month opposition period is reflected in the evidence submitted. Therefore, if for example the earlier mark is in colour and this was correctly identified during the three-month opposition

period, there are two acceptable scenarios. The first is that an official colour representation of the mark should be submitted (registration certificate, renewal certificate, official extract, etc.) that contains a reproduction of the mark in colour. The second is that an official document is presented with the representation of the mark in black and white, together with a colour claim and a colour description, both of which are translated into the language of the proceedings. However, this second scenario is only acceptable if the opponent has also submitted a colour representation of the mark from an unofficial origin (separate sheet of paper, within the observations, attached to the Notice of Opposition, etc.). Where the national trade mark office does not provide a detailed colour claim identifying the colours, and instead it says 'Colours claimed' (or similar wording), this is acceptable as long as this entry is translated into the language of the proceedings and as long as it is accompanied by a colour representation of the mark (as seen in scenario 2).

In other words, if for example the opponent has correctly claimed during the three-month opposition period that its figurative mark was in colour and has only sent a black and white representation to the Office with no further evidence of a colour claim, the [opposition based on that](#) earlier right will be rejected as not substantiated in accordance with Rule 20(1) CTMIR.

The above applies regardless of whether the opposition is based on one or more earlier marks.

In addition, where the national office does not provide any indication of a colour claim on its certificate or official extract, further documents must be submitted to prove this claim (e.g. a copy of the publication of the mark in the bulletin). Furthermore, in case the national office (e.g. the Portuguese Trade Mark Office) publishes the trade mark representation in colour, but the information contained in the certificate does not show the colour claim in writing, the opponent must submit a colour version of the certificate or extract within the time limit specified in Rule 19(1) CTMIR.

- the goods and services covered [511];
- the expiry date of the registration (if contained);
- the owner [731, 732];
- other inscriptions affecting the legal or procedural status or the scope of protection of the mark (e.g. disclaimers [526], restrictions, renewals, transfers, pending actions, the fact that the mark was registered due to acquired distinctiveness through use etc.).

4.2.3.6 Renewal certificates

Rule 19(2)(a)(ii) CTMIR

If the opponent has submitted a certificate of registration but the registration is due to expire before the expiry of the time limit for substantiation, it must file a renewal certificate in order to prove that the term of protection of the trade mark extends beyond the time limit or an extension thereof given to it to substantiate its 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.

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. For example, German renewals and sometimes Spanish renewals do not contain all the necessary data and therefore alone are not sufficient to substantiate the earlier mark.

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

If there is no proper evidence of renewal, the earlier registration is not substantiated and will not be taken into account.

4.2.3.7 Entitlement to file the opposition

Article 41 CTMR Rules 19(2) and 15(2)(h)(iii) CTMR

Depending on the ground invoked the following are entitled to file an opposition:

1. proprietors and authorised licensees for Article 8(1) and (5);
2. proprietors (only) for trade marks referred to in Article 8(3);
3. proprietors of earlier rights referred to in Article 8(4) and persons authorised under the relevant applicable national law.

Example

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 or the opponent has shown that A and B are the same legal entity which only has changed its denomination.

If the opponent is a licensee of the trade mark proprietor, the extract of the registration will normally show when a license has been registered. However, some Member States do not record licenses in their registers. In all cases, it is up to the opponent to demonstrate that it is a licensee and also that it is authorised by the trade mark owner to file an opposition. There are no restrictions on what evidence can be filed to support such an authorisation: for example, any express authorisation on behalf of the trade mark proprietor such as the license contract is deemed sufficient, so long as it contains indications concerning the authorisation or entitlement to file the opposition.

The same applies to persons authorised under the relevant applicable national law for the ground of Article 8(4) CTMR. The opponent has the burden to show its entitlement to file the opposition under the applicable national law.

According to Article 22 CTMR and Rules 33, 34 and 35 CTMIR, the Office registers and publishes license agreements in respect of Community trade marks. If the earlier mark basis of the opposition subject to the license agreement is a CTM, the opponent does not have to submit any evidence of the license contract as long as the licence has been registered and published at the Office according to Article 22 CTMR. On the other hand, the opponent will still have to submit evidence that proves that this license agreement entitles it to act in defence of the mark if the license is registered and published at the Office, if this evidence was not attached to the original request filed according to Article 22(5) CTMR. For more information of licenses, see [The Manualthe Guidelines](#), Part E, Register Operations, Section 3, Chapter 2, [LicensesLicences](#). It is not sufficient to prove the registration of the license agreement – the opponent's entitlement to defend the CTM must also be submitted in writing.

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

4.2.4.1 Well-known marks

Article 8(2) CTMR
Rule 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 its 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. See also [The Manualthe Guidelines](#), Part C, Opposition, Section 5, Trade [Marksmarks](#) with [Reputationreputation](#).

The opponent needs to show that it 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. In order to substantiate its mark it will have to submit evidence of the mark being well-known.

4.2.4.2 Marks with a reputation

Article 8(5) CTMR
Rule 19(2)(c) CTMIR

An opposition under Article 8(5) CTMR is based on an earlier trade mark that has a reputation. See also [The Manualthe Guidelines](#), Part C, Opposition, Section 5, Trade ~~Marksmarks~~ with ~~Reputationreputation~~.

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 its case under Article 8(5) CTMR, the opponent has to submit evidence of reputation. In addition, the opponent has to allege and demonstrate that the use of the mark which is the subject-matter of the contested CTM application would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark or to indicate that this is probable in the ordinary course of events.

4.2.4.3 Non-registered trade mark or another sign used in the course of trade

Article 8(4) CTMR
Rule 19(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~~. [It must further](#) show that it may prohibit the use of a subsequent trade mark.

The opponent must file evidence that it has used its sign (earlier right, either registered or not) of more than local significance. Furthermore, it also needs to indicate the provisions of the national law on which it bases its case and make out its case under this law. See also [The Manualthe Guidelines](#), Part C, Opposition, Section 4, Rights ~~Underunder~~ Article 8(4) CTMR.

4.2.4.4 Mark filed by an agent or representative

Article 8(3) CTMR
Rule 19(2)(e) CTMIR

This concerns the case where someone (an agent or representative) of the proprietor of a trade mark applies for its registration at the Office. The proprietor can oppose the application of the disloyal applicant. See also [The Manualthe Guidelines](#), Part C, Opposition, Section 3, Trade ~~Mark Filedmark filed~~ by an ~~Agentagent~~.

The opponent has to prove its 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 anywhere in the world or evidence of acquisition of rights through use. The opponent also has to submit evidence of an agent-representative relationship.

4.2.5 Sanction

Rule 20(1) CTMIR

To the extent that the invoked earlier rights have not been substantiated, the opposition will be refused as unfounded. 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 it owns a valid earlier right, the whole opposition must be rejected immediately after expiry of the two-month substantiation time limit, without waiting for the reply of the applicant.

In no case is the Office required to inform the parties which facts or evidence could be or have not been submitted. This will be detailed in the final decision which can be appealed.

4.3 Translation / changes of language during the opposition proceedings

Most 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 examples of such a *lex specialis*.

4.3.1 Translations of evidence of trade mark registrations and of facts, evidence and arguments filed by the opponent to complete its file

Rules 19(3)(4) and 20(1) 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 any other rule on the language regime.

Therefore, both the evidence submitted by the opponent for the first time at the end of the time limit 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 time limit is taken into account. If no translation or an insufficient translation has been submitted, the opposition will be partially or entirely rejected as unfounded.

Rule 98(1) CTMIR

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

Therefore, the principle is that the entire document must be translated and follow the structure of the original document.

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 assembled from fragments taken from other documents.

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

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 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 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 only the goods and services on which the opposition is based.

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. In this case, 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.

When the national offices provide an English translation, **all** elements must be translated, for example entries concerning the type of mark, or the mark status

(registered, opposed etc.) because these have a bearing on the case (see judgment of 29/09/2011, T-479/08, 'adidas v. OHIM – Patrick Holding').

Rule 98(1) CTMIR

The Office accepts simple translations, drawn up by anybody. The Office normally does not make use of its faculty 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 text 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 oblige 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.

4.3.1.1 Sanction

Rules 19(3), 19(4) and 20(1) CTMIR

If the 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 that documents which have not been translated in this time limit 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.

4.3.2 Translation of further observations

Rules 20(2), (4) and 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 or the reply by the opponent to the applicant's observations may be in any language of the Office.

It is to be noted that if the first reply of the applicant or the counter reply of the opponent are not in the language of proceedings but in one of the languages of the Office, the submission will not be taken into account unless the applicant or the opponent submit a translation of these documents in the language of the proceedings within the time limit of one month from the date of receipt of the original by the Office. The Office will not request the parties to send a translation; the parties have to send the translation on their own initiative.

Example 1

The language of opposition is English and the applicant has until 26/06/2002 to file observations in reply to the Notice of Opposition. If on 20/06/2002 it files its observations in reply to the opposition in German, it must file its translation by 20/07/2002. If it 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.

Example 2

The language of opposition is English and the applicant has until 26/06/2002 to file observations in reply to the Notice of Opposition. If on 18/05/2002 it files its observations in reply to the opposition in German, it must file its translation by 18/06/2002. However, as its time limit only finishes on 26/06/2002, if it has not filed a translation by 18/06/2002, it can still validly file documents until 26/06/2002. If it then files the translations before the end of the time limit the Office considers the translation as valid observations filed in the language of the proceedings within the set time limit.

Rule 98(2) CTMIR

~~If it does not do self~~ no translation has been submitted, the observations are deemed not to have been received by the Office and they will not be taken into account.

4.3.3 Translation of documents other than observations

Rule 96(2) CTMIR

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

Examples of this type of evidence are catalogues, magazine articles, decision of national courts or signed agreements that are submitted by the applicant together with its 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.

Rule 98(2) 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. However, 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 time limit.

Rule 98(2) will operate only if the Office does so, 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 fact that 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.

4.3.4 Proof of use

Rule 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 EU 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 time limit.

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 may require a translation within a specified time limit. However, a rejection of such a request is feasible where it appears that the applicant's request, in view of the self-explanatory character of the submitted evidence, is exaggerated or even unjust.

For further information on proof of use, see [The Guidelines](#), Part C, Opposition, Section 6, Proof of [Use](#).

Rule 22(2) CTMIR

Rule 22(2) CTMIR has the effect that the opposition must be rejected if (1) [theno](#) proof of use is ~~not~~ filed within the time limit given, or (2) proof of use was filed within the time limit given but the Office requested it to be translated and no translation was submitted within the time limit set.

If the opponent provides evidence of use in a language other than the language of the proceedings within the time limit established and then on its own motion files a translation of this evidence into the language of the proceedings after the expiry of the time limit but before the time limit set to the applicant to file observations in reply has expired, this evidence will be taken into account. This applies even if the Office has not

required the opponent to file a translation and even if the applicant has not contested the evidence yet.

4.3.5 Change of language during opposition proceedings

Article 119(7) CTMR Rule 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 be 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 will not be accepted by the Office.

When the opponent and the applicant agree to change the language of the proceedings before the start of the adversarial part of the proceedings, Rule 16(2) CTMIR requires the opponent to 'file a translation of the Notice of Opposition in that language'. It 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 the proceedings shall remain unchanged.

4.4 Documents not readable / reference to other files

4.4.1 Documents not readable

Rule 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 will inform the sender accordingly and invite it, within a time limit to be specified by the Office, to retransmit the original by telecopy or to submit the original in accordance with Rule 79(a) CTMIR.

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

4.4.2 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 a fee. For further details, see information displayed on the Office's webpage under: Inspection of files and copies.

4.4.3 Confidential information

Rule 88(c) CTMIR

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 it](#) should have full access to all material filed by the other party.

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. Therefore, if one of the parties requests certain documents be kept confidential without mentioning whether this should be vis-à-vis third parties, the Office will take it for granted that this is the case and will forward them to the other party and mark them as confidential in the electronic file.

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 the sender 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 its case.

If it confirms confidentiality, the documents will not be sent to the other party and will not be taken into account. They will be marked as confidential in the electronic file.

If it 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 the electronic file.

If it does not reply, the documents will not be sent to the other party and will not be taken into account. They will be marked as confidential in the electronic file.

4.4.4 References made to documents or items of evidence in other proceedings

Rules ~~19(4), 22(6), 79(a), 91 and 96~~ CTMIR
~~Decision EX-11-3~~ Decision EX-13-4 of the President of the Office

~~From time to time the~~ The Office ~~receives~~ may receive observations from the opponent or applicant in which they refer to documents or evidence filed in other ~~opposition~~ proceedings, for instance to evidence of use that has already been filed in a different opposition.

Such requests are accepted at any stage of the proceedings when the opponent/applicant clearly identifies the documents that it refers to. ~~Clear identification means precise indication.~~ The party must indicate the following: (1) the number of the opposition it refers to; (2) the title of the document it refers to; (3) the amount of pages of this document; and (4) the date this document was sent to the Office; e.g. '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 or evidence submitted before the Boards of Appeal, provided that such references clearly identify the documents referred to.~~

Should the documents referred to by the opponent or the applicant consist originally of evidence other than loose sheets, in accordance with Rule 79a CTMIR the party concerned shall submit by mail a second copy for transmission to the other party within the original time limit. If no copy is provided, these items of evidence will not be taken into account.

In addition, it should be noted that the documents or evidence referred to might need translation into the language of the opposition proceedings. Rule 19(4), Rule 22(6) and Rule 96 CTMIR apply accordingly.

A general reference to documents or evidence submitted in other ~~opposition/appeal~~ proceedings will not be accepted. In such a situation the party making general reference to other documents or evidence ~~should~~ may be invited to be sufficiently specific within a given time limit. The party should be informed that the time limit granted by the Office is only meant for the clear and precise indication of the documents or evidence referred to and that under no circumstances will an extension of the original time limit be granted. Moreover, the party should also be informed that if it does not specify which documents are being referred to within the time limit set, those other documents will not be considered.

The parties should be aware that material submitted in other proceedings may have been destroyed five years after their ~~reception~~ receipt in accordance with Rule 91 CTMIR and ~~the~~ Decision No EX-~~11-3~~ 13-4 of the President of the Office of ~~18 April 2011~~ 26 November 2013 concerning ~~electronic communication with and by the Office~~ the keeping of files. In this case, the reference to documents or evidence filed in other opposition proceedings has no effect.

4.5 Further exchanges

Rules 20(2), (4), (6), 22(5), 96(2) and 98(2) CTMIR

The Office invites the applicant to file observations in the time limit set by ~~the Office~~^{it} in accordance with Rule 20(2) CTMIR.

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 observations at the same time 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.

Once the applicant has submitted its observations in reply, the opponent is granted a final time limit to file its counter reply if the Office considers it necessary. After this the adversarial part of the proceedings is usually closed and the opposition is ready for decision.

The Office may, however, grant the possibility of 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 ~~may~~^{must} be given a possibility of replying. It is ~~then up to~~^{at} the ~~examiner's~~^{discretion of the Office} to decide if another round for observations should be granted to the opponent.

~~Parties to proceedings before the Office will only be allowed to submit facts and evidence after the expiry of the time limit specified for that purpose on the condition that there is no provision to the contrary. Only if that condition is met will the Office have the discretion to take into account — together with observations — any facts or evidence submitted outside the time limit (see judgement of 12/12/2007, T-86/05, 'CORPO LIVRE').~~

Therefore, a further exchange of observations may only be granted where the opponent's final observations are ~~strictly~~^{purely} in reply to the applicant's observations and are supported by evidence which is not meant to remedy flaws such as those related to substantiation ~~or evidence of use~~, e.g. if the applicant raises new issues such as the coexistence of the marks, the invalidity of the earlier right or an agreement between parties. If the opponent files evidence to ~~prove~~ the contrary, the applicant may be granted a second chance ~~for the applicant~~ to file further observations ~~may be granted~~. Nevertheless, this is not automatic as it depends on the circumstances of the case.

4.5.1 Additional evidence for proof of use

The Office may take into account additional evidence for proof of use that is submitted after the expiry of the corresponding time limit under certain circumstances, namely where the opponent submitted relevant evidence within the time limit and the additional evidence is only supplementary (judgment of 18/07/2013, C-621/11 P, 'Fishbone', paras 28 and 30). Additional evidence will be examined on a case-by-case basis. If necessary, a second round of observations will be granted. For further details, see the Guidelines, Part C, Opposition, Section 6, Proof of use.

4.6 Observations by third parties

Article 40 CTMR
Communication 2/09 of the President of the Office

Third parties can make observations explaining why the CTM application should not be registered based on one of the absolute grounds of Article 7 CTMR. For further details, see [The Manualthe Guidelines](#), Part B, Examination, Section 4, Absolute Groundsgrounds for [Refusalrefusal](#) and [CollectiveCommunity collective](#) Marks and [The Manualthe Guidelines](#), Part B, Examination, Section 1, Proceedings.

~~As anybody may~~[Anybody can](#) file third ~~partiesparty~~ observations; even the opponent is entitled to do so. However, it should do so in a manner that leaves no doubt that they are third party observations. According to the ~~above-mentioned~~[abovementioned](#) Communication of the President of the Office, the observations must be ~~presented in a separate submission~~[submitted separately](#). However, [in practice \(see decision of the Boards of Appeal \(decision of 30/11/2004, R 735/2000-2, 'SERIE A'\) 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 it wishes to make observations under Article 40 CTMR, these will be dealt with, even if they are not ~~made in a separate submission~~[submitted separately](#). However, if in its ~~observations~~[submission](#) 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 ~~arguments~~[submission](#) will ~~only be taken into account as an argument under Article 8 CTMR. It is not~~ [be](#) regarded as ~~third party~~ observations ~~by third parties~~ under Article 40 CTMR.

When an opponent makes third party observations, the Office will consider if the observations raise serious doubts as to the registrability of the CTM application, or if they will only be sent to the applicant for information purposes.

If the observations raise serious doubts, the Office must suspend the opposition proceedings 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 purposes), or do not affect the contested goods or services, the opposition proceedings will not be suspended. If the opposition proceedings need to be suspended, the suspension will take effect from the date when the Office issues the objection under Article 7, and proceedings will remain suspended until a final decision has been taken. For cases where the third party observations are received within the three-month opposition period, the Office will deal with the admissibility of the opposition, and once the decision on admissibility has been notified, the opposition proceedings will be suspended.

For all oppositions closed due to third party observations, the opposition fee will never be refunded, as this refund is not foreseen in the regulations (see Rule 18(5) CTMIR).

5 Termination of Proceedings

5.1 Friendly settlement

Rule 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 to close the case without giving specific reasons. It suffices to communicate the written signed agreement of the parties, which does not have to include a statement of grounds. The Office then takes the steps needed to close the proceedings on the basis of this agreement.

Regarding the refund of fees and decision on costs in case of friendly settlement, please see the relevant paragraph below.

Article 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 only take action in very rare cases where a settlement between the parties appears desirable and if there are good reasons for considering that the proceedings can be ended by a settlement.

If expressly requested by the parties, the Office can also 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.

5.2 Restrictions and withdrawals

Articles 58(1), 64(3) and Article 85 CTMR Rules 18(2), (3), (4), 95(a) and 96 (1) CTMIR
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5.2.1 Restrictions and withdrawals of CTM applications

Article 43 CTMR

It is possible for the applicant to restrict the goods and services of its application or to withdraw the entire application at any stage of the opposition proceedings.

Withdrawals and restrictions must be explicit and unconditional. Silence on the part of the CTM applicant during the proceedings will never be considered as a tacit withdrawal.

Conditional or ambiguous withdrawals or restrictions will not be accepted and shall be forwarded to the other party merely for information purposes, informing the parties that it will not be taken into account.

The Office does not accept restrictions that are conditional. For example, the applicant argues in its observations in reply to the opposition that the signs are dissimilar. However, the applicant adds that if the examiner finds them similar, it will restrict the list of goods and services of the CTM application. In this case the restriction is not acceptable, and the applicant must be informed that the restriction must be express and unconditional.

For further information on restrictions of a CTM application, see [The Manualthe Guidelines](#), Part B, Examination, Section 3, Classification and Part B, Examination, Section 1, Proceedings, paragraph 5.2.

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

If a restriction is partly acceptable and partly unacceptable (e.g. it constitutes an extension), the Office accepts the restriction for the acceptable part. However, before proceeding with the restriction, 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 restriction 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 restriction can be processed taking into account the date of filing of the first request for restriction. On the other hand, if the applicant does not react, the restriction is only processed insofar as it is acceptable.

If the opponent withdraws its opposition after an unacceptable restriction has been filed, the withdrawal will not be taken into account if it clearly refers to the unacceptable restriction. Once the restriction has become acceptable, the opponent will be informed of the new list of goods and services and it will be granted a new time limit to confirm the withdrawal of the opposition.

If the restriction is acceptable, a confirmation is sent to the applicant.

Depending on the moment in the proceedings, the restriction or withdrawal has different consequences, described below.

5.2.1.1 Withdrawal ~~of~~[for](#) restriction before admissibility check is made

Restriction covers the whole extent of opposition~~+/~~withdrawal

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

No decision on costs will be taken.

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

In the case of a restriction that may still include contested goods and services, an admissibility check is done.

The restriction is notified to the opponent together with the notification of the admissibility or with the communication informing the opponent there is an absolute or relative admissibility deficiency.

If the opposition is withdrawn, the opposition fee is refunded. This is the case even if irremediable deficiencies exist.

No decision on costs will be taken.

5.2.1.2 Restrictions and withdrawals of CTM applications before the end of the cooling-off period

| Restriction covers the whole extent of the opposition ~~+/~~ withdrawal

If it is absolutely clear that the restriction covers the whole extent of the opposition or when the CTM application is withdrawn, this is notified to the parties and the proceedings are closed. The opponent is refunded the opposition fee.

| No decision on costs will be taken.

| Restriction does not (seem to) cover the whole extent of opposition ~~+/~~ withdrawal

If it is not completely clear that the restriction covers the whole extent of the opposition or the restriction does not cover the whole extent of the opposition, the opponent is invited to inform the Office whether it wishes to maintain or withdraw its opposition. The parties are notified of its reply. If the opposition is withdrawn, the opposition fee is refunded to the opponent.

No decision on costs will be taken.

The relevant time to assess whether the opposition proceeding is closed during the cooling-off period is the date a request for restriction was filed before the Office.

5.2.1.3 Restrictions and withdrawals of CTM applications after the end of the cooling-off period

| Restriction covers the whole extent of the opposition ~~+/~~ withdrawal

If it is absolutely clear that the restriction covers the whole extent of the opposition, the case is closed by the Office and the parties will be notified. At the same time the restriction is forwarded to the opponent.

Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 5.5.3 of these Guidelines.

Restriction does not (seem to) cover the whole extent of opposition ~~and~~/withdrawal

If it is not completely clear that the restriction covers the whole extent of the opposition or the restriction does not cover the whole extent of the opposition, the opponent is invited to inform the Office whether it wishes to maintain or withdraw its opposition. The parties are notified of its reply. If the opposition is withdrawn, the opposition proceedings are closed.

Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 5.5.3 of these Guidelines.

5.2.1.4 Restrictions and withdrawals of CTM applications after a decision has been taken

Following decision of the Grand Board of Appeal of 27/09/2006 in case R 0331/2006-G, 'Optima', the Office accepts withdrawals and restrictions received during the appeal period after a decision on the opposition has been rendered, even if no appeal has been filed. However, the withdrawal or restriction will not have any effect on the decision which remains valid.

This means that the Office will take note of the withdrawal and close the case. Confirmation of the withdrawal is sent to the parties (however, no decision on costs is included in this communication). The part on cost of the initial decision remains valid and can be enforced by the winning party. The Office's database is updated accordingly to reflect the withdrawal of the CTM application.

For further information, see ~~The Manual~~ [the Guidelines](#), Part B, Examination, Section 1, Proceedings and ~~The~~ [the](#) Guidelines, Part E, Register Operations, Section 2, Conversion.

Once a decision rejecting the CTM application in full has become final, i.e. after the two month period for appeal, it is too late to withdraw the CTM application as there is nothing left to withdraw.

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

5.2.1.5 Language

During opposition proceedings a restriction may be submitted either in the first or the second language of the CTM application (Rule 95(a) CTMIR).

When the restriction is submitted in the first language of the CTM application, 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 it to inform the Office whether or not it maintains its 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.

If an acceptable restriction is submitted in the first and the second language, the examiner must reflect this restriction in the two languages in the Office's database and confirm the new list of goods and services in the two languages to the applicant.

5.2.2 Withdrawal of oppositions

The opponent can withdraw its opposition at any time during the proceedings.

A withdrawal of the opposition must be explicit and unconditional. Conditional or ambiguous withdrawal will not be accepted and shall be forwarded to the applicant merely for information purposes, informing the parties that it will not be taken into account.

If the opponent withdraws its opposition independent of any restriction of the CTM application, three situations can arise depending on the status of the opposition (when the opponent withdraws its opposition because of a restriction of the CTM application, see above.)

5.2.2.1 Withdrawal of the opposition before the end of the cooling-off period

If the opposition is withdrawn before the end of the cooling-off period the parties are notified. If the opponent withdraws its 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.

5.2.2.2 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. The opposition fee is not refunded. Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 5.5.3 of these Guidelines.

5.2.2.3 Withdrawal of the opposition after a decision has been taken

Following decision of the Grand Board of Appeal of 27/09/2006 in case R 0331/2006-G, 'Optima', the Office accepts withdrawals of the opposition received during the appeal period after a decision on the opposition has been taken, even if no appeal has been filed. However, the withdrawal will not have any effect on the decision, which remains valid.

This means that the Office will take note of the withdrawal and close the case. Confirmation of the withdrawal is sent to the parties (however, there is no decision on costs included in this communication). The part on cost of the initial decision remains valid and can be enforced by the winning party. The database of the Office is updated accordingly to reflect the withdrawal of the opposition and the application is sent to registration.

For further information, see [The Manual](#)[the Guidelines](#), Part B, Examination, Section 1, Proceedings and [The](#)[the](#) Guidelines, Part E, Register Operations, Section 2, Conversion.

5.2.2.4 Language

A withdrawal of the opposition must be in the language of the procedure. Rule 96(1) CTMIR applies. Should the withdrawal be submitted in a language that is not the language of proceedings a translation must be filed in accordance with Rule 96(1) CTMIR. Otherwise the withdrawal will be refused.

5.2.3 Withdrawals of withdrawals / restrictions

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.

5.3 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.

There are two exceptions:

- earlier right not proven
- ceasing of existence of the earlier right.

5.3.1 Earlier right not proven

Rule 20(1) CTMIR

If for none of the earlier rights invoked proof of existence and validity has been filed properly, the opposition is rejected as soon as the time limit given to the opponent to complete its file has expired.

However, if only some earlier rights are not proven but one is, the proceedings will continue normally, and the non-substantiated rights shall not be taken into account in the final decision on substance.

5.3.2 Ceasing of existence of the earlier right

If, in the course of the proceedings, the earlier right ceases to exist (e.g. because it has been declared invalid, or it has not been renewed), the final decision cannot be based on it. The opposition may only be upheld with respect to an earlier right which is valid at the moment when the decision is taken. The reason why the earlier right ceases to have effect does not matter. Since the CTMA and the earlier right which has ceased to have effect cannot coexist anymore the opposition cannot be upheld to this extent. Such a decision would be unlawful (see judgment of 13/09/2006, T-191/04, 'METRO/METRO', paras 33 and 36).

An invalidation of the earlier right other than of a CTM cannot be detected by the Office. However, if one of the parties 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 Office will check whether the earlier right invoked has become due for renewal in the meantime. If so, the Office will invite the opponent to prove the renewal of the mark. If the opponent does not submit the proof, the opposition must be rejected.

5.4 Fee refund

5.4.1 Opposition deemed not entered

Article 41(3) CTMR Article 9(1) CTMFR Rule 17(1) CTMIR
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If an opposition is deemed as not entered because of late or insufficient payment, [\(see paragraph 2.2.2, Time of payment, above\)](#), the opposition fee, [including any surcharge](#), must be refunded to the opponent. If a surcharge has been charged, then it must also be refunded.

5.4.1.1 Opposition and withdrawal of the opposition filed the same date

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

5.4.1.2 Refund after re-publication

If after re-publication of the CTM application in part A.2. of the Bulletin further to a mistake of the Office, a 'first publication opponent' wishes to withdraw its 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.

5.4.2 Refund in view of withdrawals / restrictions of CTM application

5.4.2.1 CTM application withdrawn / restricted before the end of the cooling-off period

Rule 18(2), (4), (5) CTMIR

If the applicant withdraws its CTM application or withdraws all those goods and services against which 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.

5.4.2.2 Opposition withdrawn due to restriction of CTM application within the cooling-off period

Rule 18(3), (4), (5) CTMIR

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

The opponent's letter does not have to make an express reference to the restriction, as long as it is later in time than the applicant's restriction.

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 it but subsequently withdraws its opposition within the cooling-off period (that has been extended).
- The opponent responds by maintaining its opposition, but nevertheless withdraws the opposition still within the extended cooling-off period.

5.4.3 Multiple oppositions and refund of 50% of the opposition fee

Rule 21(4) CTMIR

In certain special cases concerning multiple oppositions, it is possible to refund 50% of the opposition fee to an opponent. Two conditions must be met:

- one of the opposition proceedings was terminated by the rejection of the contested CTM application in parallel opposition proceedings. For example, if there are four oppositions A, B, C and D (opponents A, B, C, D) against CTM application X, and CTM application X is rejected due to opposition A, and
- the other oppositions (B, C and D) had 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 CTM application X would probably be rejected in its entirety because of opposition A.

In this case, opponents B, C and D are refunded 50% of the opposition fee.

5.4.4 Cases where the opposition fee is not refunded

5.4.4.1 Opposition withdrawn before the end of the cooling-off period NOT due to a restriction

Rule 18(3), (4), (5) CTMIR

If the opponent withdraws its 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.

5.4.4.2 Opponent's withdrawal is earlier

Rule 18(3), (5) CTMIR

When the opposition is withdrawn earlier than the applicant restricts its application, the fee is not refunded. For example, if the applicant withdraws its 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.

5.4.4.3 Settlement between the parties before commencement of proceedings

Rule 18(2), (4), (5) CTMIR

As regards the refund of the opposition fee, Rule 18(5) CTMIR only mentions this possibility if there is either a withdrawal or a restriction of the CTM application. Therefore, if the proceedings end by an agreement which contains a mention of a withdrawal or restriction of the CTM application, the opposition fee is refunded. In the other cases, the opposition fee is not refunded.

5.4.4.4 Termination of proceedings for other reasons

Articles 7, 40 and Article 92(2) CTMR
Rules 17, 18 and 76(1), (4) CTMIR

In cases where the application is rejected in accordance with:

- Article 7 CTMR (rejection of an application on absolute grounds; on the Office's own motion or because of third party observations)
- 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 is not refunded as none of these situations is contemplated in the CTMIR as a reason for refunding the opposition fee.

5.4.4.5 Reaction on disclaimer

Article 37(2) 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~~ as this situation is not contemplated in the CTMIR as a reason for refunding the opposition fee. The disclaimer does not constitute a restriction of the list of goods and services of the CTM application.

5.4.5 Mistaken refund of the opposition fee

Where the opposition fee has been mistakenly refunded due to a technical error of the Office and if the opponent has a current account, the Office automatically re-debits this account ~~when receiving the information about the mistake.~~

For further information please refer to the Guidelines, Part A, General rules, Section 3, Fees, costs and charges.

5.5 Decision on the apportionment of costs

5.5.1 Cases in which a decision on costs must be taken

Article 85 CTMR Rule 18(4) CTMIR

A decision on costs is taken in opposition proceedings that have passed the cooling-off period, i.e. where the adversarial part of the proceedings has started and come to an end. No decision on costs is taken for oppositions that are closed before or during the cooling-off period.

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 closes the case, a decision on costs is issued together with the closure letters unless the parties have informed that Office about an agreement on costs.

5.5.2 Cases in which a decision on costs is not taken

5.5.2.1 Agreement on costs

Article 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. This

information must be received before the Office has confirmed the closure of the proceedings.

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/restriction. If the parties inform the Office that they had reached an agreement on costs after the withdrawal/restriction, 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.

5.5.2.2 Information from ~~'potential winning'~~'successful' party'

When the party ~~that will eventually win~~who would be entitled to be awarded costs according to the proceedingsgeneral rules described in paragraph 5.5.3 below informs the Office that it accepts each party bearing their own costs, no decision on costs is necessary. The Office will refrain from taking a decision on costs whenever the potential ~~'winning'~~'successful' party' informs the Office that it agrees to share the costs even if the 'losing party' does not confirm its 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.

5.5.3 Standard cases of decisions on costs

Article 85(1), (2), (3) CTMR
Rule 94 CTMIR

The general rule is that the ~~losing party, or the~~ party who terminates the proceedings, by withdrawing the CTM application (wholly or partially) or by withdrawing the opposition, shall bear the fees incurred by the other party as well as all costs incurred by it that are 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.

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 its 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 its 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 (see judgment of 28/04/2004, T-124/02, 'VITATASTE', para. 56). In principle each party bears its own costs.

A different apportionment of costs can however be justified for reasons of equity (for example if the application was only restricted to a very small extent).

The Office will ~~take into account any agreement provided in time before the decision on costs is taken, but will not take into account parties' 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.~~

5.5.4 Cases that did not proceed to judgment

5.5.4.1 Multiple oppositions

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 determination of costs is at the discretion of the Opposition Division (Article 85(4) CTMR). The Office is not able to determine who the 'winning or losing party' is, and the applicant should not be required to pay the costs of several other opponents if it loses in one decision on substance. Therefore, applying a principle of equity, each party will be ordered to bear its own costs.

Partial rejection of the CTM application

In cases of multiple oppositions which are partially directed against the same goods and services of the contested trade mark, the decision in relation to the opposition which is taken first may affect the other oppositions.

Example

Opposition A is directed against Class 1 and opposition B against Classes 1 and 2 of the contested CTM application. A decision is taken first in opposition A rejecting the contested application for Class 1. When the decision is notified to the parties of opposition A, opposition B must be suspended until the decision in opposition A is final and binding. Once the decision is final, the opponent of opposition B will be invited to inform the Office whether it wishes to maintain or withdraw its opposition in view of the amendment of the list of goods. If the opponent withdraws the opposition, the case is closed.

In this situation, and if the case is closed after commencement of the adversarial part of the proceedings the Office will issue a decision on costs in accordance with

Article 85(2) CTMR. The opponent withdrew its opposition following the partial rejection of the contested trade mark. To this extent the opponent was successful in the proceedings. However, the partial rejection of the trade mark was more restricted than the scope of the opposition. To this extent the applicant/holder was also successful in the proceedings. Consequently, it is equitable that each party should bear its own costs.

If the opponent maintains its opposition after the partial rejection, the proceedings continue and in the final decision on the substance the decision on costs is taken according to normal rules.

5.5.4.2 Rejection of an application on the basis of absolute grounds or formalities

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 (e.g. if an applicant from outside the EU 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 the 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 determined at the discretion of the Office. Then each party should bear their own costs.

- ~~If on the other hand~~ If the same situation arises before commencement of the adversarial part, no decision on costs is to be taken.

5.5.4.3 Cases of joinder

Rule 21 CTMIR

For further information on joinder, see ~~below under~~ paragraph 6.4.3. Joinder of proceedings, below.

In cases where the joint 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, its 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 its own costs.

5.5.4.4 The meaning of 'bear one's own costs'

The notion of 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. In

most cases the costs cover the remuneration of an agent within the limits of the scales set by the Regulation.

‘Each party shall bear their own costs’ means that no party has a claim to the other party.

5.6 Fixing of costs

Article 85(6) CTMR
Rule 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~~

This means that in 99%the vast majority of cases ~~a separate fixing of, it will not be necessary to fix~~ the amount of costs will be unnecessaryseparately.

The only exceptions are ~~only~~:

- when an oral hearing took place,
- ~~when the decision was taken before 25/07/2005 (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.

5.6.1 Amounts to be reimbursed / fixed

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

Rule 94(6) CTMIR

~~As regards fees, the amount is limited to~~ if the opponent wins, the opposition fee of EUR-350 ~~if the opponent wins~~ will be reimbursed.

Rule 94(3) CTMIR

As regards representation costs, the amount is limited to EUR 300. This applies both to the opponent and the applicant, under the condition that they were represented in the opposition procedure by a professional representative within the meaning of Article 93(1) CTMR, irrespective of whether these costs have been actually incurred.

If the winning party was represented at some stage of the proceedings by a professional representative, but is no longer represented at the time of taking the decision on costs, it is also entitled to an award of costs regardless of when in the proceedings professional representation ceased.

Representation costs for employees, even from another company with economic connections, are not reimbursable and will not be fixed. They will not be addressed in the decision on costs.

For further information on representation, see [The Guidelines](#), Part A, General [Rules](#), Section 5, Professional [Representation](#).

~~When a case is remitted by the Boards of Appeal (BoA) to the Opposition Division, this means that the first decision (which was appealed) has not become final (even as regards apportionment or fixing of costs).~~

~~In the case of a joinder under Rule 21(1) CTMIR, where the oppositions are successful, the Office will fix both (or all) opposition fees (one for each opposition) but only one representation fee, in which case the costs to be paid by the applicant to the opponents would be EUR 1 000.~~

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.

~~If a decision is annulled by the Boards of Appeal and remitted by the BoA to the Opposition Division, the decision of the Opposition Division has not become final (even as regards apportionment or fixing of costs) and there is, at that stage of the procedure, no winning or losing party. As regards the costs of the appeal proceedings the Board will therefore to decide that it deems it equitable, pursuant to Article 85(2) CTMIR, that each party bears its own costs in the appeal. This applies in principle to the costs and fees.~~

~~However, with regard to the appeal fee the Board may decide that this fee may be reimbursed pursuant to Rule 51(b) CTMIR in case the remittal is the consequence of a substantial procedural violation of the Opposition Division. As regards the costs of the opposition proceedings the Board decides that these must be fixed by the Opposition Division in its forthcoming decision.~~

~~Subsequently, the Opposition Division has to decide on the case again and will take a decision on and fix the costs, in the usual way, only for the opposition proceedings.~~

If this decision is appealed again (and not remitted for a second time) the Board will decide on and fix the costs in the usual way.

5.6.2 Procedure if the fixing of costs is contained in the main decision

Rule 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. The Office knows that the opposition fee was paid, and if there is a representative EUR 300 must be awarded irrespective of any evidence. It is assumed that the costs of representation have been of at least EUR 300.

Therefore, no correspondence with the parties about the amount to be fixed is necessary. The fixing of the amount is automatic.

5.6.3 Procedure if a separate fixing of costs is needed

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

- admissibility
- evidence.

5.6.3.1 Admissibility

Article 85(6) CTMR

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

5.6.3.2 Evidence

Rule 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 are needed, but it suffices that they establish a plausibility (rather than full-fledged proof) that the costs have been incurred.

5.6.4 Review of fixing of costs

Article 85(6) CTMR Rule 94(4) CTMIR
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| If one of the parties disagrees with the ~~fixation of costs~~amounts fixed, it can ask for a review of the decision. The request must state the reasons and be filed within one month after the date of notification of the fixation. The request is only deemed to be filed when the fee for review of EUR 100 has been paid.

There are no reimbursable costs in the review procedure (see decision of 16/12/2004, R 0503/2001-4, 'BIOLACT/BIO').

6 Procedural Issues

6.1 Correction of mistakes

Article 43(2) CTMR

6.1.1 Correction of mistakes in the Notice of Opposition

There are no special provisions in the Regulations on correction of mistakes in the Notice of Opposition. Applying Article 43(2) CTMR which refers to the CTM application, by analogy, obvious mistakes in the Notice of Opposition may be ~~amended~~corrected.

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

The Office defines ‘obvious error’ in relation to Article 44(2) CTMR and Rule 53 CTMIR as in No B.16 of the Joint Statements by the Council and the Commission entered in the minutes of the Council meeting at which the CTMR was adopted: ‘... the words “obvious mistake” should be understood as meaning mistakes which obviously require correction, in the sense that nothing else would have been intended than what is offered as the correction’.

For example, if the opponent’s details appear where the representative’s should appear, this can be considered an obvious mistake. ~~By contrast, if the opponent in the Notice of Opposition is Dundee Ltd, but the opponent informs the Office later on in the proceedings that it 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’s legal form should have been Dundee PLC when examining the opposition. Consequently, the mistake cannot be corrected upon expiry of the three months opposition period.~~

6.2.2 Correction of mistakes and errors in publications

Rule 14 CTMIR

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 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~~leads to an extension of the list of goods or services or concerns the representation of the mark, a new opposition period is opened, but only in respect of the corrected parts.

If oppositions were filed after the ‘first’ publication of the CTM application, 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~~ If a 'first publication opponent' wishes to withdraw its opposition as a consequence of the re-publication, ~~In this case the proceedings should be closed and the opposition fee should be refunded (see paragraph 5.4.1.2 above).~~

6.2 Time limits

Rules 71(1), 79, 80(3), 82(3) and 96(1) CTMIR

~~Non-compliance with a given time limit 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 time limit. This is irrespective of whether such materials are specifically mentioned in the initial letter. Any written submission or document that has not been submitted 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 submitted within the time limits set: the Office must reject the opposition. Again, there is no discretion to act otherwise.~~

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary for ensuring clarity and legal certainty.

For general information on time limits and continuation of proceedings, see The Manualthe Guidelines, Part A, General Rulesrules, Section 1, Means of Communication, Time Limitscommunication, time limits.

6.2.1 Extension of time limits in opposition proceedings

6.2.1.1 Non-extendable and extendable time limits

Rule 71(1) CTMIR

A time limit cannot be extended if its length is set by the Regulation. Non-extendable time limits include:

Article 41(1) CTMR

- the three-month opposition period to file an opposition;

Article 41(3) CTMR

- the three-month time limit to pay the opposition fee;

Article 8(3)(b) CTMFR

- the one-month time limit 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;

Rule 17(4) CTMIR

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

Rule 71(1) CTMIR

Extendable time limits have a length which is specified by the Office. For example, the time limit to submit observations in reply to the Notice of Opposition is an extendable time limit.

6.2.1.2 Request made in time

Note: Extensions of the cooling-off period have a special regime. For further details, see above under paragraph 3.2 Extension of the cooling-off period.

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 or jointly by both parties;
- the request has to be signed;
- the original time limit must not have expired already;
- the language regime must be respected, i.e. 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.

An extension will only be possible if the relevant request is made filed and received before the expiry of the original term (see order of 30/01/2014, C-324/13 P, 'Patricia Rocha') before the expiry of the original term. If a request for extension is received by the Office after the expiry of the time limit, it must be rejected.

Any first request for an extension which is received in time will always be granted for a period of two months (or less if so requested), independently of the explanation given by the party requesting it. However, any subsequent request for an extension of the same time limit will be refused, unless the party requesting it duly explains and justifies the exceptional circumstances that prevented it from meeting the original time limit and the first extension and why a further extension is necessary. General or vague explanations will not justify a second extension. The request must always be accompanied by evidence and/or supporting documentation.

On the other hand, circumstances that are under the control of the party concerned are not 'exceptional circumstances'. For example, last minute discussions with the other party are not 'exceptional circumstances'. They are under the control of the parties.

The request has to be filed by the party concerned by the time limit. For example, if the applicant has to file observations in reply to the Notice of Opposition, it can only be the applicant that asks for an extension.

For more information on extensions of time limits ~~The Manual~~[the Guidelines](#), Part A, General [Rules](#)~~rules~~, Section 1, Means of ~~Communication, Time Limits~~[communication, time limits](#), paragraph 3.1.3 Extension of time limits should be consulted.

6.2.1.3 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 time limit 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 its request, in this case 20 days. This practice is based on the rules of fair administration.

Where a request for extension of an extendable time limit has been filed [and received](#) before the expiry of this time limit, [\(see order of 30/01/2014, C-324/13 P, 'Patricia Rocha'\)](#), the party concerned shall be granted at least one day, even if the request for extension arrived on the last day of this time limit.

6.2.1.4 Signature

If one of the requests is not signed, it has to be checked if a second, signed, request was received at a later time [but still within the time limit](#). This is because parties sometimes forget to sign, but realise their error after having sent the request, so they sign it and send it again.

A joint request has to be signed by both parties and has to be received within the time limit for which an extension is requested. A request signed by one of the representatives who assures the Office that the other party agrees to the extension is not acceptable.

6.3 Suspension

Rules 20(7) and 21(2) CTMIR

~~A suspension of opposition proceedings can be decided by the~~[The](#) Office ~~acting~~[can](#) ~~suspend opposition proceedings~~ [ex officio](#), at the request of [either](#) both parties or ~~at the request of one of the parties~~[party](#).

According to Rule 20(7), the Office 'may' suspend opposition proceedings. Therefore, the ~~question of suspension 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)~~

~~CTMIR. 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 suspend is always taken at the adversarial stage begins.~~

~~When the proceedings are to be suspended at an early stage, this will preferably be done when the admissibility discretion of the opposition is notified in order to 'save' the cooling-off period for the time after the proceedings are resumed Office.~~

6.3.1 Suspension requested by both parties

~~If the suspension is requested by both parties request suspension after expiry of the cooling-off period, the Office will suspend the proceedings, even when no reasons are given. they do not have to give any specific justification and the suspension is always granted. In these cases this case, and regardless of the period requested by the parties, the first suspension will be given granted for a period of one year giving, with the parties being given the possibility to opt of opting out. The process for opting out is the same as for the extension of the cooling-off period: if one of the parties party opts out, the suspension will end 14 days after informing the parties have been informed thereof. The proceedings will resume the day after and the party to submit observations will be given whose time limit was pending at the moment of suspension will be granted two months to file observations. It is not possible to opt out during the last month of the suspended period and any requests to do so- will be rejected.~~

~~A joint request for suspension because of ongoing negotiations will not be granted if it is received within the cooling-off period because the purpose of the cooling-off period to precisely to set a time frame for negotiations before the adversarial stage begins.~~

~~In principle, the parties may jointly request extensions of the suspension for negotiations. Such requests will be granted automatically for further one-year periods. However, after three years of suspension the parties are expected to provide an explanation as to why the negotiations have still not come to an end. In order to avoid any possible abuse, the Office may apply its discretion and decide not to further suspend the proceedings.~~

~~Requests submitted by only one of the parties will in principle be rejected. It is common for parties to negotiate during opposition proceedings. However, it may be the case that one party wishes to negotiate only provided that such negotiations do not delay the proceedings. This is why negotiations do not give either of the parties the right to ignore a pending time limit, to obtain an extension thereof or to obtain a suspension of the proceedings. Such requests are therefore rejected.~~

6.3.2 Suspensions by the Office *ex officio* or at the request of one of the parties

~~#The Office may suspend the opposition is suspended by the Office acting proceedings ex officio or at the request of one party under a variety of the parties, the decision of suspension must be based on proper reasons. circumstances.~~

The CTMIR contemplates ~~three~~two specific cases where the proceedings may be suspended:

- ~~the~~The opposition is based on an application for registration of a trade mark;
- ~~the~~The opposition is based on an application for registration for a geographical indication or designation of origin;
- ~~there are multiple oppositions.~~

~~Apart from these three specific cases,~~

~~In addition, according to the CTMIR stipulates that opposition, the proceedings may be suspended where circumstances are such that a suspension is appropriate. The most common unspecified cases where in principle oppositions may be suspended are under the circumstances, for example in the following situations:~~

- ~~the trade mark registration on which the opposition is based is subject to administrative or judicial proceedings that may affect the registration or the opponent's entitlement to it. The reason for this is that an opposition may not be upheld based on an earlier right which at the date of the decision ceased to have effect (see paragraph 5.3.2 of these Guidelines).~~
- ~~the parties are negotiating the settlement of the opposition.~~
- The earlier right is at risk (under opposition or cancellation).
- There are some other situations where the suspension may also be advisable or even necessary, such as third party observations, that raise serious doubts as to the registrability of the CTM application (see page 51).
- There are errors in the publication of the contested application which require the mark to be re-publication, published.
- A transfer is pending on earlier CTMs/CTM applications or contested CTM applications, withdrawal of the
- The representative withdraws.

~~It should be noted that in none of the abovementioned cases is there an obligation in any of the abovementioned cases to suspend the proceedings. The decision is at the Office's 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 the suspension of the proceedings are explained.~~

6.3.3—~~The opposition is based on a trade mark application / an application for a geographical indication or designation of origin~~

6.3.3.1 Explanation of the basic principle, ~~moment to suspend~~timing of suspension

Rule 20(7) CTMIR

In principle, oppositions based on applications or on earlier rights that are at risk are not to be suspended, ~~at least not~~ **ex officio** at the very beginning of the proceedings. The assumption is that in most cases ~~the~~ applications mature into registrations, and oppositions or cancellation actions against earlier rights might be solved during the proceedings.

~~Assuming that the opponent files sufficient evidence of substantiation of a national application, the opposition will proceed~~In these cases the opposition proceeds until a decision is ready to be taken. Consideration must then be given as to 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 same will happen with earlier CTM applications which do not require any evidence). Before closing the proceedings, the ~~CTM application~~status of the earlier mark must be checked or, in the case of a national application or an earlier national mark at risk, the opponent must be requested to provide information on the status of the application. ~~If at this stage the opponent provides evidence that the national application in fact proceeded to registration before the time limit set in Rule 19(1) CTMIR, the earlier mark will be rejected as unfounded under Rule 20(1) CTMIR or registration.~~

However, the Office may suspend the proceedings if ~~the earlier right is an application and if the suspension is~~ this is requested by one of the parties. ~~In this case and the earlier right is an application or is at risk. If the earlier right is a national one the parties must provide evidence that the application is facing problems. In this case the outcome of the proceedings against the earlier mark must have some impact on the opposition. Therefore, the probable outcome of the opposition will be considered in order to decide on the suspension. If the earlier right is a national application the parties must provide evidence that the application is facing problems.~~

6.3.3.2—~~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~~suspension. This is the case in particular where the final-

2. ~~The final decision on the opposition cannot be issued without taking into account the earlier application. This is when or earlier registration. In such a situation, the circumstances of the case do not allow~~ the Office 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 CTM application mark for all the contested goods and services).

~~The second condition deserves a closer look whether the application in question makes a difference to the outcome of the opposition.~~

~~When the answer is clearly negative, the proceedings should not be suspended. This includes cases where the opposition will be rejected anyway and 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/However, 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 or registration 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 CTM application.

~~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.~~

6.3.3-32.2 Earlier CTM applications or registrations

~~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 period has expired. For example, the opposition is based on a similar CTM~~The opposition is based on an application but it is not suspended because there is another earlier right (a registered trade mark) on the basis of which the contested application ~~must~~may be rejected. If the opponent fails to substantiate this other earlier right, the earlier application, ~~which before was not relevant to the outcome~~, becomes crucial for the decision. If according to the records the only earlier application or registration is facing problems, the opposition should be suspended.

6.3.2-34 Earlier national-/international marks (applications or registrations / rights)

The issue of suspension will have to be raised by the parties (normally the applicant). In this case the party has to submit evidence that the earlier mark (application or registration / right) is facing problems. This evidence must be official, it must clearly identify the proceedings leading to the suspension and it must indicate the relief sought~~application is facing problems.~~ 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.

Upon such a 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, then the general principle applies and the Office only has to decide on the suspension if the proceedings reach the end of the adversarial part and there is no information that the application has matured to registration or that national proceedings against the earlier mark have come to an end. In this case the opponent should be required to inform the Office on the status of its earlier application or registration.

~~In any case, the question of whether to suspend the proceedings because of earlier applications may appear in many different forms and therefore it is a matter to be decided on a case-by-case basis. There are no rigid rules here and good sense is the key.~~

6.3.2.4 Examples

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~~Office finds it appropriate.

- The opposition is based on a French mark and on a CTM application, neither of which faces problems. Both cover the same sign and the same goods, which are confusingly similar to the contested trade mark. Therefore, the opposition may be dealt with on the basis of the French mark only. If likelihood of confusion can occur only in Member States other than France, the decision will be more solid if based on the CTM application and therefore it is appropriate to suspend the proceedings to await the outcome of the CTM application.
- The earlier application does not make ~~too much~~any difference to the outcome, but the applicant requests a suspension. If the earlier right is a CTM application and the Office concludes that it is facing problems or, in the 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 party most interested in getting a fast decision, the Office should not insist on the continuation of the proceedings if the applicant prefers to wait.~~

The following examples fall into the category of earlier national marks at risk:

- 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 its own name.

6.3.3.5 ~~Monitoring suspended files~~

~~In cases where the proceedings are suspended without a fixed time limit (so-called open suspension), the Office's database will create due dates every six months in order to monitor the opposition.~~

~~In cases where the earlier right is an application for a national registration, the resumption of 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. The opponent may also be requested to inform the Office.~~

6.3.3.6 ~~Resuming the proceedings~~

~~When the time comes to resume 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.~~

6.3.4 Multiple oppositions

Rule 21(2) CTMIR

6.3.4.1 ~~Explanation of the basic principle, moment to suspend~~

~~When there is more than~~Save exceptional circumstances where one opposition pending against the same CTM application, and if there is an obvious case which can lead to the total earlier mark clearly leads to the rejection of the CTM application (or at least of contested mark including all goods and services contested by the sum of all oppositions), the Office ~~may~~will not suspend the other proceedings until a final decision is reached.

~~In principle, an opposition will be considered as an obvious case if it is for example founded on Article 8(1)(a) CTMR (identity) and based on a registered trade mark.~~

~~The opposition justifying the suspension of all others must not only be obvious, but it must also be directed against all the goods and services contested by all the oppositions that are to be suspended.~~

~~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 'active' 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 'active' 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.~~

6.3.3.4.21 After rejection of the CTM application

When the CTM application is subsequently rejected because of an 'active' 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 oppositions which were suspended at an early stage (before the cooling-off period) will be closed and 50% of the opposition fee will be refunded to each opponent, in accordance with 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 that decision to become final.

6.3.4 Procedural aspects

Letters suspending the proceedings should always indicate the date the suspension takes effect, generally the date when a valid request was submitted.

~~3~~

6.3.4.1 Monitoring suspended files

In cases where the proceedings are suspended for an indefinite period, the Office will monitor the opposition every six months.

In cases where the earlier right is an application for a national registration or a national/international registration that faces problems, the resumption of proceedings will always depend on the reaction of the parties, who are expected to inform the Office about any changes in the status of the application or registration and submit evidence to this effect. Nevertheless, the Office issues reminders every six months in which the parties may also be requested to furnish the evidence.

6.3.4.2 Resuming the proceedings

~~If the suspended~~ In all the cases the parties will be informed of the resumption of the proceedings are to be resumed in a case where they have been suspended and of any pending time limit if applicable. Any time limit that was pending at the very beginning, all the dates for the cooling-off period and subsequent time limits will have to moment of the suspension will be set, and all the usual information and warnings will have to be issued again. If the suspension took place after with a full two-month time limit with the endexception of the cooling-off period, the proceedings will be resumed at the stage at which they were at the time of suspension.

6.3.5 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.~~

can never exceed 24 months according to Rule 20(718(1)) CTMIR.

6.3.5.1 Cases

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.

If an opposition is based on an earlier mark that is subject to cancellation proceedings, the Office may suspend the proceedings if this is requested by one of the parties. In this case the outcome of the cancellation proceedings against the earlier mark must have some impact on the opposition. Therefore, the probable outcome of the opposition will be considered in order to decide on the suspension. If the earlier right is a national trade mark, the parties must provide evidence that the mark is facing problems.

The following examples fall into this category of earlier national marks:

- 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 its own name.

Criminal actions brought against the opponent or actions seeking compensation from the opponent, no matter how they are related to the earlier trade mark, will not have any impact on the outcome of the opposition proceedings and therefore do not justify suspension.

6.3.5.2 Factors to consider

If one of the parties requests the suspension or if the Office knows 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, the Office 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 its finding if the other party reacts to the granting of the suspension.

6.3.5.3 Evidence

The request for suspension must be supported by evidence, be it requested by the opponent or by the applicant. This evidence must be official, it must clearly identify the proceedings leading to the suspension and it must 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.~~

~~6.3.5.4 Monitoring suspended files~~

~~In cases where the proceedings are suspended without a fixed time limit (so-called open suspensions), due dates are created every six months in order to check if the parties have provided any new information on the state of the proceedings. The Office may also invite the parties to provide information about the state of the proceedings.~~

~~6.3.5.5 Resuming the proceedings~~

Proceedings must be resumed as soon as a final decision has been rendered in the course of the national proceedings: or an earlier application has been registered or refused. 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 unfounded insofar as it is based on that earlier right. If all the earlier rights on which an opposition is based cease to exist, the opponent will be granted the opportunity to withdraw its opposition. If it does not do so, the Office will take a decision rejecting the opposition.

~~6.3.6 On-going negotiations~~

~~If the request is signed by both parties the proceedings are suspended.~~

~~If the request is signed by one 4.3 Calculation of the parties only, the Office does not, in principle, grant the suspension, unless it is accompanied by a letter of consent signed by the other party.~~

Rule 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 on-going negotiations justify a suspension of the proceedings is only worth considering when one party alone submits the request.~~

~~Requests for suspension of proceedings submitted by one of the parties based on on-going 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 proceedings. Therefore, negotiations do not give either of the parties the right to ignore a~~

~~pending time limit, to obtain an extension of it or to get a suspension of the proceedings limits~~

~~Therefore, 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 paragraph 6.3 Suspension.~~

~~6.3.7 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/definite period of time, the letters must also indicate the date when the proceedings are to be resumed, and what happens after that. ~~Note that when~~When the suspension is requested by both parties because there are on-going negotiations, the period will always be one year regardless of the period requested by the parties.

If on 30/01/2015 a request for a two month suspension signed by both parties and submitted on 15/01/2015 (five days before the expiry of the time limit of the opponent for completing the opposition – 20/01/2015) is dealt with, the result will be:

- the Office has suspended the opposition proceedings at the request of both parties;
- this suspension takes effect as from 15/01/2015 (the date when the suspension request was received at the Office) and will expire on 15/01/2016;
- the proceedings will be resumed on 16/01/2016 (one year, irrespective of the period requested by the parties), with no further notification from the Office;
- the time limit for the opponent is now 15/03/2016 (two full months for the opponent to complete the file);
- the time limit for the applicant is now 15/05/2016 (two full months after the opponent's time limit).

~~Where proceedings are suspended with no fixed time limit (so-called open suspensions) the period of suspension will be undetermined. Proceedings will be resumed upon written confirmation by the Office and a full two-month time limit will be granted, where applicable, depending on the stage of the proceedings.~~

6.4 Multiple oppositions

Rule 21 CTMIR

Multiple oppositions are when different oppositions are filed against the same CTM application.

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 the 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 restriction 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.

6.4.1 Multiple oppositions and restrictions

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 restriction concerns contested goods or services of the other oppositions.

However, if there is no relation between the goods or services in the restriction and the contested goods and services, the opponent should not be informed.

For example, there are four oppositions against the same CTM application, applied for goods in Classes 3, 14, 18 and 25. The oppositions are directed against the following classes:

Opposition	Extent
No 1	Class 3
No 2	Class 25
No 3	Classes 18 and 25
No 4	Classes 14 and 25

The applicant sends a restriction in opposition 2, deleting *clothing* and *headgear*. Apart from the relevant letters in opposition 2, the relevant letters should also be sent in oppositions 3 and 4. As the restriction does not affect the contested goods of opposition 1, no action is necessary in this opposition.

6.4.2 Multiple oppositions and decisions

Once an opposition reaches the decision stage, it is important to take account of the possible multiple oppositions that are pending against the same CTM application. Before a ruling can be given on the opposition, the stage of proceedings of the multiple oppositions must be analysed, and depending on the situations a decision may be taken or the opposition must be suspended. The general principle to be applied is that contested goods and services should not be rejected more than once at different points in time. The three situations that may occur are described in the following.

1. All oppositions against the same CTM application are ready for decision at the same time

The order in which the decisions are taken is at the discretion of the examiner. However, 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 will be successful, first the decision on the opposition eliminating most goods and services of the CTM application (the widest extent of the opposition) should be taken, and once final it will be 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 under paragraph 6.4.1, 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. In this case, opposition 2 needs to be suspended.

If the appeal period has expired and no appeal is filed, opposition 2 is disposed of, as it no longer has an object. The parties should be informed and the opposition must be closed. 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 its own costs.

2. Only one opposition is ready for decision and the other oppositions are still in the adversarial phase of the proceedings

If the opposition is to be rejected a decision can be taken without further impact on the pending multiple oppositions because the rejection does not have any effect on the CTM application.

If the opposition is successful and the decision rejects the contested CTM application in its entirety, the pending multiple oppositions must be suspended until the decision is final. If the appeal period has expired and no appeal is filed, the multiple oppositions are disposed of, as they no longer have an object. The parties should be informed and the opposition must be closed. The case is considered to be a case that has not proceeded to judgment 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 its own costs.

The same applies if the decision on the opposition rejects **part** of the goods and services of the contested CTM application but **all** of the goods and services against which the multiple oppositions are directed.

However, multiple oppositions must be suspended if the decision on the opposition rejects **part** of the goods and services of the contested CTM application but only **part** of the goods and services against which the multiple oppositions are directed. The suspension will last until the decision has become final. If this is the case, the opponents of the multiple oppositions will be invited to inform the Office whether they wish to maintain or withdraw the opposition. In the case of a withdrawal of the

opposition, the proceedings are closed and both parties are informed. If the proceedings are closed after the expiry of the cooling-off period, the Office will decide on the costs in accordance with Article 85(2) CTMR that each party bears its own costs. If the parties inform the Office before the closure of proceedings that they agree on the costs, a decision on costs will not be taken.

3. Two or more oppositions are ready for decision and others are still in the adversarial phase of the proceedings

It may happen that some of the oppositions against a CTM application are ready for a ruling and some are still at different stages of the adversarial phase. In this situation the principles described under [a\)1.](#) and [b\)2.](#) apply in combination. Depending on the outcome of the decisions and on the scope of the pending cases whether a decision may be taken in both opposition and whether the multiple oppositions must be suspended.

6.4.3 Joinder of proceedings

Rule 21(1) CTMR 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 [upon the request of one of the parties](#) 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, e.g. 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. In addition, 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.

6.5 Change of parties (transfer, change of name, change of representative, interruption of proceedings)

6.5.1 Transfer and opposition proceedings

6.5.1.1 Introduction and basic principle

Article 17 CTMR

A transfer or assignment of an earlier right is a change of ownership of this right. For further information see [The Manualthe Guidelines](#), Part E, Register Operations, Section 3, CTMs as [Objectsobjects](#) of [Propertyproperty](#), Chapter 1, 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 6.5.1.2 (the earlier registration is a CTM registration), 6.5.1.3 (the earlier registration is a national registration), 6.5.1.4 (the earlier registrations are a combination of CTM registrations and national registrations) and 6.5.1.5 (transfer of a contested CTM application during opposition proceedings).

A transfer can be made in several ways, including a simple sale of an earlier mark from A to B, a company C that gets bought (trade marks included) by company D, a merger of companies E and F into company G (universal succession), or 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 6.5.1.2 (the earlier registration is a CTM registration), 6.5.1.3 (the earlier registration is a national registration), 6.5.1.4 (the earlier registrations are a combination of CTM registrations and national registrations) and 6.5.1.5 (transfer of a contested CTM application during opposition proceedings).~~

6.5.1.2 Transfer of earlier CTM

Article 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.

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 it 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, it 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 it does not want to continue the proceedings, the opposition is considered withdrawn.

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 is transferred to a new owner. The same principles apply to partial transfers as for transfer of only one of more CTM registrations on which the opposition is based. These principles are described in the paragraph immediately below.

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. The situation is, however, different when only one of the earlier CTMs is/has been transferred. In this case the new owner may also become an opponent, so that there are two opponents. However, the opposition will be kept as one. In general both opponents have the same representative.

If one of the opponents wants to withdraw, this will be accepted independently of whether the other wants to continue. Should the proceedings be continued, they will only be based on the rights of the opponent that 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.

6.5.1.3 Transfer of earlier national registration

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 it 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 it 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 time limit of two months 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 it is not the owner anymore, the opposition has become unfounded, as the opponent is no longer the owner of the earlier right. The owner must be informed that the opposition will be rejected as such unless it withdraws the opposition.

If the new owner provides the required evidence and informs the Office that it does not want to continue the proceedings, the opposition is considered withdrawn.

Any evidence showing the agreement of the parties to the transfer/change of ownership is acceptable.

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. The same principles apply to partial transfers as for transfer of only one of more national registrations on which the opposition is based. These principles are described in the paragraph immediately below.

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 apply.

The situation is, however, 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 opponents. However, the opposition will be kept as one. In general both opponents have the same 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.

6.5.1.4 Opposition based on ~~more than one earlier~~ a combination of CTM registrations and national registrations

When an opposition is based on one or more CTM registrations **and** one or more national registrations at the same time and one of these marks are/have been transferred to the same new owner during the opposition proceedings, the foregoing applies. In this case the new owner may also become opponent, so that there are two opponents. However, the opposition will be kept as one. In general both opponents have the same representative.

In all of these situations, once the Office becomes aware of the transfer of ownership, it will update the official database to include the new opponent/both opponents, and it will inform the parties for information purposes only. However, the mere fact that the earlier registrations have been transferred will never justify the granting of a new time limit for submitting observations or any other documents.

6.5.1.5 Transfer of the contested CTM application

When during opposition proceedings the contested CTM application 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 CTM application and the opponent.

6.5.1.6 Partial transfer of a contested CTM application

Rule 32(4) CTMIR

When there has been a partial transfer of a (contested) CTM application, 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' CTM application and some in the newly created CTM application. For example: Opponent X opposes all the goods of CTM application Y, applied for in Class 12 for *apparatus for locomotion by land and air*, and for *clothing and footwear* in Class 25. CTM application Y is partially transferred, and split into CTM application Y' for *apparatus for locomotion by land and clothing*, and CTM application Y'' for *apparatus for locomotion by air*, and *footwear*.

Articles 17 and 23 CTMR

Since there was only one opposition fee to be paid when the opponent filed its opposition, it is not requested to pay a second fee for the new opposition created after the split of the CTM application.

The transfer, even if it was requested before the opposition was filed, has effect vis-à-vis third parties only after entry in the Office's database. Therefore, 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).

6.5.2 Parties are the same after transfer

In the event that as a result of a transfer the opponent and the applicant become the same persons or entities, the opposition becomes devoid of any purpose and will accordingly be closed *ex-officio* by the Office.

6.5.3 Change of names

As mentioned above, a change of name does not imply a change of ownership.

6.5.4 Change of representatives

Article 92 CTMR

~~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 it wishes to designate a (new) representative. It can happen that the representative itself 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).

Article 92 CTMR

~~When a representative resigns, the proceedings are continued with the opponent or applicant themselves 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.~~

For ~~implicit appointment or change of a representative~~[detailed information](#) please refer to ~~The~~[The](#) Guidelines, Part A, General ~~Rules~~[rules](#), Section 5, Professional ~~Representation~~[representation](#).

6.5.5 Interruption of the proceedings due to death, legal incapacity of the applicant or its representative

Rule 73 CTMIR

Rule 73 CTMIR deals with interruption of proceedings. Paragraph 1 distinguishes three situations:

Opposition proceedings before the Office shall be interrupted:

1. when the CTM *applicant* has died or ~~cannot take legal actions (e.g. because they have been declared insane by a court)~~[is under legal guardianship](#);
2. when the CTM *applicant* is ~~prevented from continuing the~~[subject to bankruptcy or any similar](#) proceedings ~~before the Office owing to legal reasons (e.g. when the applicant is in a process of levy of execution)~~;
3. when *the representative of an applicant* has died or ~~cannot take legal actions as a result of some action taken against its property~~[is otherwise prevented from representing the applicant](#). For further information see ~~The~~[The](#) Guidelines, Part A, General ~~Rules~~[rules](#), Section 5, Professional ~~Representation~~[representation](#).

Rule 73 CTMIR only refers to the applicant and its 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. Therefore, 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 CTM application/CTM). The uncertainty of the legal status of an opponent or its representative shall not be 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.

6.5.5.1 Death or legal incapacity of the applicant

In cases of the death of the applicant or of the person authorised by national law to act on their 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.

6.5.5.2 Applicant prevented from continuing the proceedings before the Office owing to legal reasons (e.g. 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 the representative does so, the Office will continue to correspond with the trustee or liquidator. If there were time limits affecting the applicant which had not yet expired when it went bankrupt, the Office will re-start these time limits. Therefore, 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 time limit 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.

Rule 73(4) CTMIR

~~Interruption of proceedings means that time~~Time limits ~~which~~that had 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 time limit of two months starts again, not the ten days it had left at the moment of the interruption. For clarification, the letter sent by the Office informing the parties about the resumption shall fix a new time limit.

6.5.5.3 Death or prevention for legal reasons of the representative of the applicant before the Office to act

In the case referred to in Rule 73(1)(c) CTMIR, the proceedings must be interrupted and will 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:

1. If the appointment of a representative is compulsory under Article 92(2) CTMR because the applicant has neither its domicile nor its seat in the EU, the Office will contact the applicant and inform it that the CTM application will be deemed withdrawn if it does not appoint a representative within a time limit of two months. If the applicant does not appoint a representative on or before the end of the time limit, the CTM application will be then deemed withdrawn.
2. If appointment of a representative is **not** compulsory under Article 92(2) CTMR, 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.