

***GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)***

***PART C***

***OPPOSITION***

***SECTION 1***

***PROCEDURAL MATTERS***

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## 1 Introduction: General outline of opposition proceedings

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

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 Regulations.

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-extendable 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 the 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 the parties are incentivised to negotiate an agreement because, if certain conditions are met, the opposition fee will be refunded — 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 submit all evidence and observations it considers necessary to make its case. After these two months have lapsed, and once the submitted evidence and observations (if any) have been forwarded, the applicant has two months to reply to the opposition.

At this stage, the applicant can require the opponent to prove that any earlier marks registered for more than five years have been used by filing a request for proof of use. If such a request is made, the applicant may wait until the opponent has adduced such proof before filing its evidence and observations. The opponent is then given the opportunity to comment on the applicant’s observations.

If the applicant does not request proof of use but submits 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.

In some cases it may 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.

The Office may request the parties to restrict their observations to particular issues, permitting observations on other issues at a later point in time.

Once the parties have submitted their observations, the proceedings are closed, the file is ready for taking a decision on substance and the parties are informed accordingly.

When an opposition is filed against an international registration designating the EU, all references in the Guidelines to EUTM applications must be read as including international registrations designating the EU. Part M of the Guidelines, International Marks, which has been drafted specifically for international marks, also refers to oppositions.

## **2 Notice of opposition**

### **2.1 Notice of opposition in writing**

Article 46 EUTMR Article 4 and Article 63(1)(a) EUTMDR Decision No EX-13-2 of the President of the Office
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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 EUTM application.

A notice of opposition may be filed by using the electronic form available in the User Area of the Office's website. Once submitted, the electronic form will be processed automatically and a receipt for the opponent will be issued. A notice of opposition may also be filed by fax, post or personal delivery, and in all these cases the opponent will also be sent a receipt after the notice of opposition has been keyed into the Office's IT system.

The applicant 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 European Union trade mark, the applicant is also informed that it can access information about earlier European Union trade marks via the online search tools, which are available on the Office's website.

#### **2.1.1 Early oppositions against an international registration**

Article 196(2) EUTMR Article 77(3) EUTMDR
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An opposition against an international registration designating the EU (IR) may be filed within a period of three months starting one month after the date of first republication. For example, if first republication is on 15/04/2016, then the opposition period starts on 16/05/2016 and ends on 15/08/2016.

For international registrations whose date of first republication falls before the entry into force, on 23/03/2016, of the amendment of Article 196(2) EUTMR brought about by Regulation (EU) 2015/2424, the previous time limit applies, according to which an opposition must be filed within a period of three months starting six months after the date of first republication. For example, if first republication is on 22/03/2016, then the opposition period starts on 23/09/2016 and ends on 22/12/2016.

However, oppositions filed after the republication 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. The opponent will be informed accordingly. If the opposition is withdrawn before that date, the opposition fee will be refunded.

### 2.1.2 Early opposition against an EUTM application

Articles 44 and 46 EUTMR

Any notice of opposition against an EUTM application received before commencement of the opposition period 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 EUTM application in Part A.1 of the EUTM Bulletin. The opponent will be informed accordingly. If the opposition is withdrawn before that date or the EUTM application is refused or withdrawn before publication, the opposition fee will be refunded.

## 2.2 Payment

For general rules on payments, refer to the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

### 2.2.1 Notice of opposition late, payment within the opposition period

Article 5(2) EUTMDR

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 may comment on the finding of inadmissibility within the time limit set by the Office.

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 opposition period or if the opponent does not reply within the set time limit, 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 46(3) and Article 180 EUTMR  
Article 5(1) EUTMDR

The Office has to receive the full amount of the opposition fee within the opposition period. If the opposition fee was not received within the opposition period, the notice of opposition is deemed not to have been entered.

### 2.2.2.1 Payment by bank transfer

Payments by bank transfer received after the opposition period are considered to be made within the opposition period if the opponent (i) files evidence showing that it gave the transfer order to a banking establishment within the opposition period and (ii) pays a surcharge of 10 % of the opposition fee. No surcharge will be payable if the evidence shows that the order to the bank was given no less than 10 days before the expiry of the opposition period.

### 2.2.2.2 Payment by current account

Articles 179(1) and 180(1) EUTMR  
Decision No 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 a 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 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 will in such 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 an 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

Article 99 EUTMR  
Article 5(1) EUTMDR

An opposition for which the payment is not made within the opposition period will 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 time limit allowed, the opponent submits evidence that the Office finds that 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.

If an opposition is deemed not to have been entered, the opponent has the right to request a formal decision within two months. If it does so, the decision must be sent to both parties.

For cases in which the opposition fee has not been paid in full or after the opposition period, see paragraph 5.4.1 below.

## 2.3 Languages and translation of the notice of opposition

Article 146(5), (6)(a) and (7), EUTMR  
Article 5(3),(4) and Article 65 EUTMDR,

### 2.3.1 Language of proceedings

The notice of opposition must be filed in one of the five languages of the Office. The rules regarding the language of proceedings are explained in detail in the Guidelines, Part A, General Rules, Section 4, Language of Proceedings.

According to these rules, in opposition proceedings there are cases where the opponent has a choice between two possible languages of proceedings (the first and second languages of the contested EUTM application, both being languages of the Office), and cases where there is only one possible language of proceedings (when the first language is not one of the five languages of the Office, the language of the opposition proceedings can only be the second language of the contested EUTM application).

In cases where there is a choice, the language of proceedings will be that expressly indicated by the opponent in the notice of opposition or, in the absence of an express indication, the language in which the notice of opposition was filed, provided in both cases that it is one of the possible languages of proceedings.

Where the wrong language of the proceedings is chosen by the opponent, the EUTMR distinguishes between two different scenarios: where the incorrect language is a language of the Office, and where the incorrect language is one of the official languages of the Union (but not one of the Office). Depending on which of the above

applies, there are different consequences and time limits for the opponent to respect when choosing the correct language of the proceedings and submitting the translation of the notice of opposition.

- If the language chosen by the opponent is a **language of the Office**, but not one of the possible languages of the proceedings, the opposing party must produce, at its own expense, a translation of the notice of opposition into the first language, providing that it is a language of the Office, or into the second language. The translation must be produced **within one month from the expiry of the three-month opposition period**. The language into which the notice of opposition has been translated will then become the language of the proceedings. Where the opposing party does not submit the translation within this time limit, the opposition will be rejected as inadmissible. Article 146(7) EUTMR and Article 5(3) and (4) EUTMDR apply.
- If the language chosen by the opponent is **not a language of the Office**, the opposing party must produce, at its own expense, a translation of the notice of opposition into the first language, providing that it is a language of the Office, or into the second language. The translation must be produced **within the three-month opposition period**. Where the opposing party does not submit the translation within the opposition period, the opposition will be rejected as inadmissible. Article 146(5) EUTMR applies as it clearly specifies that the notice of opposition must be filed in a language of the Office. As it is not filed in a language of the Office, the one-month period to remedy the deficiency of Article 146(7) and Article 5(3) EUTMDR does not apply.

In the event that the language chosen by the opponent is not one of the possible languages of the proceedings, any correspondence issued by the Office in the opposition will be in the first language of the contested mark, providing that it is a language of the Office, or in the second language if the first one is not one of the five languages of the Office.

The language requirement of the notice of opposition is an absolute admissibility requirement and will be dealt with as explained under paragraph 2.4.1 below.

Concerning the use of official forms, the second sentence of Article 146(6) EUTMR states that when the form provided by the Office is used, it may be used in any official language of the Union, provided that it is completed in one of the languages of the Office as far as textual elements are concerned.

Where the opponent uses the official form, but chooses the wrong language, all textual elements are in the wrong language, and the wrong language has been chosen by the opponent, the above principles apply. Where the wrong language chosen is a language of the Office, the opponent has one month to file a translation. Where the wrong language chosen is not a language of the Office, this cannot be remedied.

### 2.3.2 Examples

As an illustration of what has been explained in paragraph 2.3.1 above, here are some examples.

- a) The languages of the EUTM application are PT and EN. The opponent files an opposition in PT, choosing PT as the language of the proceedings. As the language of the proceedings has not been correctly chosen, as PT is not a

language of the Office, the opponent must submit the translation of the notice of opposition into EN (the only correct language) before the expiry of the opposition period and EN, therefore, will become the language of the proceedings.

- b) The languages of the EUTM application are BG and EN. The opponent files an opposition in BG, and in BG expressly indicates that the language of the proceedings is EN. The Office cannot accept an indication in BG that the language should be EN. As the language of the proceedings has not been correctly indicated, as BG is not a language of the Office, the opponent must submit the translation of the notice of opposition into EN (the only correct language) before the expiry of the opposition period and EN, therefore, will become the language of the proceedings.
- c) The languages of the EUTM application are DE and EN. The opponent files an opposition in FR. As FR is a language of the Office and as the language of proceedings can be either DE or EN, the opponent must produce the translation within one month of expiry of the opposition period into DE or EN, which will become the language of the proceedings.

In all of the above examples, if the opponent does not submit the translation into a correct language within the relevant time limit, the opposition will be rejected as inadmissible. However, in the above examples, if the official form had been used in PT, BG and FR respectively, but had been completed in its entirety in EN expressly indicating EN as the language of the proceedings, this would be admissible without any need for a translation into EN to be submitted. There would be no need to submit a translation of the official form if all the textual elements, and the indication of language, were EN.

## 2.4 Admissibility check

Article 2(2) and 5(3) and (5) EUTMDR
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The admissibility check covers both absolute and relative requirements:

- absolute requirements are 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, as laid down in Article 2(2)(a) to (c) EUTMDR, and Article 146(5) and (7) EUTMR;
- relative requirements are 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-extendable time limit of two months, as laid down in Article 2(2)(d) to (h) EUTMDR;

In addition, there are optional indications laid down in Article 2(2)(i) and (4) EUTMDR, that do not lead to a finding of non-admissibility, namely a submission of a reasoned statement or an indication of the goods and services against which the opposition is directed.

For the purposes of assessing the admissibility of the opposition the Office must base itself solely on the claims contained in the documents submitted by the opponent within the opposition period (decision of 21/07/2014, R 1573/2013-4, OKAY/O-Key (fig.)).

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.

#### Extent of the admissibility check

The earlier marks/rights are examined to see if at least 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 at least 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.

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.

If necessary, the admissibility issue will be dealt with in the decision on the opposition.

#### 2.4.1 Absolute admissibility requirements

Absolute admissibility deficiencies can only be remedied on the opponent's initiative during the three-month opposition period, otherwise the opposition is inadmissible. An invitation to comment on the inadmissibility has to be sent. If the inadmissibility is confirmed, a decision rejecting the opposition as inadmissible is sent to the opponent and copied to the applicant.

##### 2.4.1.1 Identification of the contested EUTM application

Article 2(2)(a) and 5(3) EUTMDR
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The mandatory elements for identifying the contested EUTM 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 EUTM 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 EUTM application. Even if it is missing, the EUTM application can be sufficiently identified through the other indications.

Only one EUTM application can be contested in one notice of opposition.

#### 2.4.1.2 Identification of the earlier marks or rights

Article 8(2) EUTMR Article 2(2)(b) and 5(3) EUTMDR
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##### Invoked rights that are not earlier

Articles 8(2) and 46(1) EUTMR
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Sometimes an opposition is based on one or more marks or other rights that are not earlier than the EUTM application. Establishing whether at least one of the earlier rights is earlier takes place at the admissibility stage.

For an invoked 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 EUTM application was filed. In the case of conflict between a national mark and an EUTM 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, Rizo, EU:C:2012:157). If priority has been claimed, it should be determined to the extent that the relevant goods and services are earlier. For further information see also the Guidelines, Part B, Examination, Section 2, Formalities.

When the only invoked 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 not earlier, the Office will notify the admissibility of the opposition on the basis of the earlier one.

##### Earlier trade mark registrations or applications under Article 8(2)(a) and (b) EUTMR

Article 8(2)(a) and (b) and Article 39(3)EUTMR Article 2(2)(b), 5(3) and 7(1), (4) and (5) EUTMDR
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These rights are European Union trade mark registrations or applications, international registrations designating the European Union, national or Benelux trade mark registrations or applications (including 'ex European Union 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 absolute identification elements for earlier trade mark registrations and applications are:

- the registration/application number;

National applications deriving from the conversion of an earlier EUTM (application) are considered to come into existence as soon as a valid conversion request is submitted. Such rights will be properly identified for admissibility purposes if the opponent indicates the number of the EUTM (application) 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 Benelux, where the earlier mark is registered/applied for or, if applicable, the indication that it is an EUTM.

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. Where a certificate of an international registration is concerned it is assumed that the opposition is based on this mark in all the designated Member States and/or the Benelux countries indicated in the certificate. However, the basic registration is an independent earlier right, which may be claimed separately.

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

The seniority claimed in an EUTM can be taken into account within the meaning of Article 8(2)(a) EUTMR provided that the proprietor of the EUTM has surrendered the earlier mark or allowed it to lapse within the meaning of Article 39(3)EUTMR and that this fact is proved by the opponent.

In such a case, the opponent must base its opposition on the European Union trade mark, explicitly claiming within the three-month opposition period that the national mark continues to exist through the seniority claimed in the EUTM. A clear link must be established between the EUTM indicated and the earlier mark for which the seniority was claimed in the EUTM. Within the time limit set according to Article 7(1) EUTMDR, the opponent must provide sufficient 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 39(3)EUTMR.

#### Earlier trade mark registrations or applications with reputation under Article 8(5) EUTMR

Article 8(5) EUTMR Article 2(2)(b)(i) EUTMDR
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Under Article 8(5) EUTMR an opposition can be based on a mark with reputation, which can be an earlier European Union, international, Benelux and national registration, and an earlier application subject to its registration.

The same identification requirements apply as for earlier trade mark registrations or applications under Article 8(2)(a) and (b) EUTMR mentioned above.

#### Earlier well-known mark under Article 8(2)(c) EUTMR

Article 8(2)(c) EUTMR Article 2(2)(b)(i) and (ii) and 5(3) EUTMDR
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Article 8(2)(c) EUTMR protects well-known marks within the meaning of Article 6*bis* of the Paris Convention. This can be a registration or an application for registration, a

non-registered mark, or a mark that is not registered in the territory where the well-known character is claimed (irrespective of registration in the territory of origin).

The absolute indications are:

- an indication of the Member State where the mark is claimed to be well known;
- 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. 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, R 160/2007-1, QUART / Quarto).

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

#### Trade marks filed by an agent under Article 8(3) EUTMR

Article 8(3) EUTMR Article 2(2)(b)(iii) EUTMDR
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A trade mark filed by an agent is a contested EUTM application in relation to which the opponent claims that the applicant, who has or had an agent or representative relationship with the opponent, applied for the mark without its consent.

The absolute indications for earlier trade mark registrations/applications are:

- an indication of the territory in which the earlier trade mark is protected,
- the indication whether the earlier mark is registered or applied for (if applicable);
- the registration/application number.

The absolute indications for earlier non-registered trade marks are:

- an indication of the territory in which the earlier trade mark is protected,
- a representation of the earlier mark (in colour if applicable),

The representation of the mark (in colour if applicable) must be given only if the proprietor's earlier mark is a non-registered mark, because in this case no registration number can be provided to clearly identify the earlier mark. For non-registered word marks, the word that makes up the mark must be indicated. For non-registered figurative or other marks, the representation of the mark as it is used and claimed by the proprietor must be provided. See also the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR).

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



Earlier non-registered marks and earlier signs used in the course of trade under Article 8(4) EUTMR

Article 8(4) EUTMR  
Article 2(2)(b)(iii) and 5(3) EUTMDR

This category consists of signs that are not registered and used as trade marks or of a great number of different earlier rights, inter alia, 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 works' are acceptable indications of the nature of rights. By contrast, 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 Article 8(4) EUTMR, for example, 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.

Protected designation of origin and/or geographical indications under Article 8(6)EUTMR

Article 8(6)EUTMR  
Article 2(2)(b)(v) and 5(3) EUTMDR

Under Article 8(6) EUTMR, an opposition can be based on an earlier protected designation of origin or a geographical indication. The absolute indications are:

- an indication of the nature of the right, namely protected designation of origin or geographical indication;
- an indication of the territory where the protected designation of origin or geographical indication is claimed to be protected, namely the Union or a Member State;
- a representation of the protected designation of origin or geographical indication (word only).

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

#### 2.4.1.3 Identification of grounds

Article 46(3) and Article 94 EUTMR  
Article 2(2)(c) and 5(3) EUTMDR

An opposition without any indication of grounds 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 EUTMR 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 or it can be inferred from the opponent's arguments filed within the opposition period. In both cases it is possible to identify the grounds within the opposition period without any doubt and the opposition is admissible.

Otherwise, before rejecting the opposition, a careful assessment of the entire notice of opposition and other documents submitted must be made: whether indicated in the opposition form, its annexes or its supporting documents, the grounds must be unequivocally clear.

The opponent will be invited to present comments on inadmissibility before taking the decision rejecting the opposition.

#### 2.4.2 Relative admissibility requirements

Article 2(2)(d) to (h) EUTMDR

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 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

Article 2(2)(d),(e) and 5(5) EUTMDR

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 European Union or national or international trade mark applications or registrations invoked under Article 8(1)(a) or (b) EUTMR,
- earlier marks under Article 8(3) EUTMR if they are registered,

- earlier marks with a reputation invoked under Article 8(5) EUTMR

In case of opposition based on protected designation of origin or a geographical indication, the date of application for registration or, if that date is not available, the date from which protection is granted.

These indications can be important in order to be able to eliminate possible errors when identifying the abovementioned earlier marks/signs. It is sufficient that these elements can be found in enclosed documents.

#### 2.4.2.2 Representation of earlier marks/signs

Articles 2(2)(f), 5(5) and 63(3) EUTMDR
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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 Article 2(2)(f) EUTMDR applies to the following rights:

- earlier national or international trade mark applications or registrations invoked under Article 8(1)(a) or (b) EUTMR,
- earlier marks with a reputation invoked under Article 8(5) EUTMR,
- marks filed by an agent (Article 8(3) EUTMR, if they are registered marks).

If a proper representation of the mark/sign has not been enclosed in the opposition notice, the opponent will be notified of the 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 an EUTM, no representation is requested since it is available in the Office's database.

If the mark is a word mark, an indication of the word is sufficient to consider that a proper representation of the mark has been submitted.

For the same purpose, if the mark is figurative, 3D, other mark, etc., the representation of the mark as applied for or registered must be filed. When the trade mark is in colour, at least a representation of the mark in colour must be submitted.

An earlier mark will be identified as a trade mark in colour only when a representation of the mark in colour is enclosed, or an indication in this regard is mentioned in the opposition notice or in the documents attached to it. Therefore, when an indication in this regard is contained in the submitted documents without it being accompanied by a representation of the mark in colour (i.e. no graphical representation of the mark or a representation of the mark in B&W is filed), the Office will notify this deficiency. If the opponent does not comply within the two-month time limit given, the earlier right will be rejected as inadmissible.

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 and Latvia. In these cases the Office neither asks for a colour representation nor

requests the opponent to file a translation of the colour indications submitted in the original language.

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

- Belgium
- Bulgaria
- Czech Republic (1999)
- Denmark
- Germany
- Estonia (2003)
- Ireland (2003)
- Greece (2007)
- Spain (as of 31/07/2002)
- France (1992)
- Croatia (2009)
- Italy
- Lithuania (as of July 2009)
- Luxembourg
- Hungary
- Malta
- Netherlands
- Austria
- Poland (2003)
- Portugal (2006)
- Romania
- Slovenia (1992)
- Slovakia (2008)
- Finland (2005)
- Sweden
- United Kingdom (2004).

International marks have been published in colour since 1989.

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

Article 2(2)(g) and 5(5) EUTMDR
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Article 2(2)(g) EUTMDR stipulates that the notice of opposition must contain an indication of the goods and services on which the opposition is based in the language of the proceedings for each of the grounds. 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. These goods and services must be listed in the language of the proceedings.

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.

An indication of the class number(s) or a reference to 'all goods and services for which the earlier mark is registered', are accepted as sufficient indications of the goods and services of the earlier rights on which the opposition is based, provided that a registration certificate or extract from an official source containing the list of goods and services covered by that mark 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 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 of the goods 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'.

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 the 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.

For oppositions based on earlier non-registered 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 EU

For admissibility purposes, with regard to oppositions filed against international registrations designating the EU, 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: territorial scope of reputation

When the opponent invokes Article 8(5) EUTMR on the basis of a national trade mark, the Office assumes that reputation is claimed for the territory in relation to which the earlier national mark has protection.

When the opponent invokes Article 8(5) EUTMR on the basis of an International trade mark, the opponent will have to identify the territories for which it claims reputation of its mark. In the absence of that indication, the Office assumes that reputation is claimed for all the territories in relation to which the earlier mark has protection.

When the earlier mark is a EUTMR, no indication is requested since it is considered that the reputation is claimed for the EU.

#### 2.4.2.5 Identification of the opponent

Article 46(1) EUTMR Article 2(1)(b) EUTMIR Article 2(2)(h)(i) EUTMDR
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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 whether the opponent is clearly identified, attention should be given to the nature of the opponent, that is to say whether it is a 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 (e.g. GmbH, KG, SA, Ltd) is not indicated, the deficiency must be notified.

#### Entitlement

Article 2(1)(b) EUTMIR Article 2(2)(h)(i) and (iii) EUTMDR
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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 Article 2(2)(h)(iii) EUTMDR an opponent who acts as a licensee or authorised person has to indicate its name and address in accordance with Article 2(1)(b) EUTMIR.

- If the notice of opposition is based on the grounds of Article 8(1) or (5) EUTMR 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) EUTMR (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) EUTMR (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.
- If the notice of opposition is based on the grounds of Article 8(6) EUTMR, it may be filed by any person authorised under the relevant EU legislation or national law to exercise the rights to the earlier protected designation of origin or geographic indication.

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 EUTM and oppositions based on national trade mark registrations (or applications).

#### *Oppositions based on an earlier EUTM*

An opposition based on European Union registrations or applications may be entered by the successor in title of an EUTM only if the conditions set out in Article 20(11) EUTMR are met, namely, only if the opponent has submitted a request for the registration of the transfer when the opposition is filed. According to Article 20(12) EUTMR, 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 during the admissibility check. However, if the opponent mentions in the explanation of its opposition that it is the new owner (or 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 in order 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). However, the entitlement to file the opposition (e. g. evidence of the transfer or of the granting of a licence before the opposition was filed) has to be proved within the time limit for substantiation.

Multiple opponents

Article 2(1) and 73(1) EUTMDR

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*

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

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

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

*Not acceptable*

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



The opponents will have to be asked to indicate whether they want to continue the proceedings with A or B as an opponent.

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

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.

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

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.

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

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 whether they want to continue the opposition with A or with B as an opponent. If the opponents do not reply, the opposition is inadmissible.

<b>Earlier trade marks</b>	1	2	3
<b>Owner</b>	A	A	B
<b>Licensees</b>	B	C	A

*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 submitted 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 submit 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 119 and 120 EUTMR  
Article 2(2)(h)(ii) and Article 73 EUTMDR

Article 2(2)(h)(ii) EUTMDR provides that if the opponent has designated a representative, it must provide the name and business address of the representative in accordance with Article 2(1)(e) EUTMIR. Where there is more than one opponent before the Office a common representative must be appointed.

If the opponent is from the European Economic Area (EEA) (not obliged to be represented under Article 119 EUTMR), 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 119 EUTMR, 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.

For further details on professional representatives, see the Guidelines, Part A, General rules, Section 5, Professional representatives.

#### 2.4.2.7 Signature

Article 63(1)(a) EUTMDR

A notice of opposition must be signed by the opponent or, if it is submitted by a representative, by the representative.

If a notice of opposition is filed electronically, the indication of the name of the sender is deemed equivalent to a signature.

#### 2.4.2.8 Relative admissibility requirements: sanctions

Article 5(5) EUTMDR

If relative admissibility requirements are missing or not complied with, the opponent or its representative is given two months to remedy this deficiency. 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 some 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

##### Article 2(2)(i) EUTMDR

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 will 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 EUTM application, it will have to list these goods **clearly**.

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 EUTM application is filed for *clothing* — in this example, the only contested goods are considered to be *trousers*). However, when the opponent uses ambiguous wording such as ‘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, the opposition will be considered to be directed against all of the goods and services of the opposed mark.

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 statements on the grounds

##### Article 2(4) EUTMDR

‘Reasoned statement’ corresponds to any facts and arguments on which the opposition relies as well as to evidence in support of the opposition.

It is optional at the stage of filing of the opposition. It is acceptable if it is included in the opposition, but otherwise it may be provided after expiry of the cooling-off period (Article 7(1) EUTMDR) and concerns the substance, not the admissibility, of the opposition.

## 2.5 Notification of the notice of opposition

##### Articles 4, 5, and 6 EUTMDR Decision No EX-13-2 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 information purposes.

Once the opposition has been found admissible, the Office will send a notification to the parties informing them that the adversarial part of the proceedings are 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 (e-communication, fax 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 web page of the Office, notification is 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. For more information on communication with the Office, please refer to the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

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**

Articles 5, 7 and Articles 6(1), 8(2) and (9) EUTMDR Communication No 1/06 of the President of the Office
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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 adversarial part of the proceedings are deemed to commence two months after receipt of the notification (a two-month 'cooling-off' period is granted before the proceedings officially start, with 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, EU:C:2012:649, the notification sent to the parties informing them that the opposition is admissible in accordance with Article 6(1) EUTMDR constitutes a decision that may be appealed together with the final decision on the case as stated in Article 58(2) EUTMR. Consequently, the Office is bound by this decision.

The cooling-off period will be set to expire two months from the notification. This period may be extended.

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 must also substantiate its earlier right(s).

The request to the opponent is a **general invitation** to complete the file within the meaning of Article 7 EUTMDR. The Office will **not** indicate the nature and type of the material necessary for completion of the file (see expressly Article 8(9), second sentence, EUTMDR). Rather, it will be for the opponent to decide what it wishes to submit.

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 146(5) to (7) and (9) EUMTR Article 6(1) EUTMDR Communication No 1/06 of the President of the Office
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The cooling-off period may be extended 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 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.

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

- A signed request from both parties. This may take the form of either 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 initiative. 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 (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 the 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 will 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 submit additional facts, evidence and arguments in support of its opposition.

Within the same time limit, the opponent must prove the existence, validity and scope of protection of its invoked earlier rights, as well as submit evidence proving its entitlement to file the opposition.

### **4.2 Substantiation**

Article 46 EUTMR Articles 7, 56 and Article 8(1) EUTMDR
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Substantiation is defined by Article 7(2) EUTMDR 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 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 not only to complete its file, that is, present all the evidence in support of its opposition, but also to prove the existence and validity of the earlier rights invoked and its entitlement to file the opposition. Where relevant for the opposition, the opponent must also submit evidence of reputation, enhanced distinctiveness or any other aspect affecting the scope of protection of its earlier right(s).

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. For the specific rules on translation of substantiation evidence, reference is made to paragraphs 4.3.1.1 and 4.3.1.3 for facts evidence and arguments that must be translated within the substantiation time limit, and to paragraph 4.3.1.2 for substantiation evidence that must be translated only upon the Office's request.

For the purpose of substantiation the opponent must provide the Office with the necessary proof. Apart from providing physical evidence of substantiation, in cases where evidence concerning the filing or registration of the earlier rights or the evidence concerning the contents of the relevant national law is accessible online from a source recognised by the Office, the opponent may instead formally declare to the Office that it relies on online evidence, and that this online evidence may take the place of any physical evidence.

It is understood from the wording of Article 7(3) EUTMDR, that in order to rely on online evidence, there must be a formal declaration from the opponent by which it asks the Office to access the necessary information for the earlier trade mark from the relevant online official sources. Consequently, as it is optional, the opposing party should formally and proactively let the Office and the other party know it wishes to rely on this option. The declaration must be explicit and unconditional to be accepted. Therefore, the Office will not check the substantiation of any rights online where the opposing party has not expressly and unconditionally consented to the use of online evidence.

It is noted that even if the opponent formally declares that online evidence may be relied on, it is its obligation to check that the online sources reflect the most accurate and up to date relevant information. Moreover, where the opponent after such a declaration still submits physical evidence without formally revoking its previous declaration, in the event there is a contradiction between the online evidence and the physical evidence, the most recent up-to-date will apply.

A declaration may be introduced by the opposing party at any time before the expiry of the time limit of substantiation. In the absence of any formal declaration (including when such declaration has been withdrawn), the opposition should be rejected as non-substantiated if no physical evidence is presented in due time.

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) will be checked.

In relation to the submission of supporting documents, see the Guidelines, Part A, General Rules, Section 1, Means of communication, Time limits.

#### 4.2.1 EUTMs and EUTM applications

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

#### 4.2.2 Converted EUTMs and EUTM applications

Article 139(1) EUTMR
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This section will deal only 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 Opposition based on EUTM (application) (to be) converted

National applications deriving from the conversion of an earlier EUTM or EUTM application are considered to come into existence as soon as a valid conversion request is submitted. Such rights will be properly substantiated under Article 7(2) EUTMDR if the opponent indicates the number of the EUTM (or EUTM application) under conversion and the countries for which it has requested the conversion.

##### 4.2.2.2 Opposition based on EUTM (application) that is subsequently converted

When during opposition proceedings the EUTM application (or EUTM) on which the opposition is based ceases to exist (or the list of goods and services is restricted), and a request for conversion is submitted, the proceedings can continue. This is because national trade mark registrations resulting from a conversion of an EUTM application can constitute the basis of the opposition procedure originally made on the basis of that EUTM application (decision of 15/07/2008, R 1313/2006-G, CARDIVA / CARDIMA (fig.)).

In such a case the Office will request the opponent in writing to inform the Office whether it maintains the opposition in view of the withdrawal, surrender or rejection of the earlier EUTM application(s) or registration(s) and whether it intends to rely on the national applications that result from the conversion of the earlier EUTM. If the opponent does not inform the Office within the established time limit that it wishes to rely on the national applications, the opposition will be rejected as unfounded.

Evidence of the existence of the earlier national applications must be submitted by the opponent as soon as they become available.



### 4.2.3 Trade mark registrations or applications that are not EUTMs

Article 7(2)(a)(i) and (ii) EUTMDR
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To substantiate an earlier trade mark application or registration the opponent must provide the Office with evidence of its filing or registration. The Office accepts as evidence of the filing or registration of the earlier marks 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.

As mentioned above, the opponent may instead ask the Office to access the necessary information for this trade mark from the relevant online official database (see below under 4.2.3.2).

#### 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, constitutes valid evidence. For further requirements relating to renewal certificates, see below.

If the opposition is based on an application, the opponent must submit 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 submit 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 Article 7(1) EUTMDR, the earlier mark will be rejected as unfounded under Article 8(7) EUTMDR. 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 a few differences between an application form and the registration certificate and have to be checked carefully.

#### 4.2.3.2 Extracts from official databases

Extracts from databases are accepted only if their origin is an official database, that is to say, the official database of one of the national offices or WIPO, and if they are equivalent to a certificate of registration or last renewal.

In case of the submission of the extract, 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 databases are not accepted, even if they reproduce exactly the same information as the official extracts. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK, SAEGIS or COMPUMARK.

As regards international registrations, the following database is accepted (judgment of 26/11/2014, T-240/13, Alifoods, EU:T:2014:994)<sup>1</sup>: **ROMARIN** (the 'short' version of the extract being sufficient as long as it contains all the necessary information, but the extended or long version of the WIPO extract being preferable as it contains all the individual indications for each designated country, including the Statement of Grant of Protection)

Extracts from TMView are acceptable evidence concerning International registrations and trade marks applied for or registered with the participating offices, as long as it contains the relevant data, since it reflects the information obtained directly from the WIPO database and databases of those national offices respectively. For further information see: <https://www.tmdn.org/tmview/welcome>.

In case the opponent relies on the online evidence, the opponent has to identify the source by means of a direct link to the source or a clear identification of the database.

The Office accepts ROMARIN and all of the databases of the national IP Offices, whereas TMView is acceptable as a portal through which WIPO and the national offices are 'accessed'. General references to such databases and sources are sufficient, and the use of a direct hyperlink is optional. For example, in case the opponent relies on an earlier Spanish trade mark, the Office will accept indications such as 'the Spanish national intellectual property', or 'OEPM', or 'Spanish CEO database', or 'www.oepm.es', or 'the administration with which the mark was registered', etc.

When the extract from an official database or the database accessed online does not contain all the required information, the opponent must supplement it with other documents from an official source showing the missing information.

### Examples

Database extracts sometimes do not contain the list of goods and/or services; in such cases, the opponent must submit an additional document (e.g. a publication in the official bulletin) showing the list of goods and services.

Database 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 trade marks, when opponents file an extract 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 the database itself (which reproduces the image on a separate page that, when printed or saved as 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 the database and including it electronically or otherwise in the notice of opposition form is not sufficient.

When English is the language of the proceedings, and where the national office also provides an English version of the trade mark extract, in principle, no translation would be necessary. However, as regards the list of goods and/or services, where the extract itself only gives the class headings along with a warning indicating that this reference to

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<sup>1</sup>. The old practice of accepting printouts from eSearch plus (previously CTM-Online) for international registrations with EU designation only applies to oppositions with a filing date before 01/07/2012.

the class heading does not necessarily reflect the goods and/or services protected under the trade mark, the opponent must always file the original list in the original language (from an official source) and, where the list does not consist of a class heading, an accurate translation into English. Such translations are also required if the opponent relies on evidence accessible online from a source recognised by the Office if such evidence or part of it is not in the language of the proceedings.

#### 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
Benelux (Belgium, Luxembourg, The Netherlands)	10 years	Filing date
Bulgaria	10 years	Filing date
Czech Republic	10 years	Filing date
Denmark	10 years	Registration date
Germany	10 years	Filing date
Estonia	10 years	Registration date
Ireland	10 years for TM registered since 01/07/1996 (7/14 years renewal before that)	Registration date = filing date
Greece	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
France	10 years	Filing date
Croatia	10 years	Filing date
Italy	10 years	Filing date

Countries	Term of protection	Starting point
Cyprus	7 years first term/14 years renewal	Filing date = registration date
Latvia	10 years	Filing date
Lithuania	10 years	Filing date
Hungary	10 years	Filing date
Malta	10 years	Registration date = filing date
Austria	10 years	Registration date
Poland	10 years	Filing date
Portugal	10 years	Registration date
Romania	10 years	Filing date
Slovenia	10 years	Filing date
Slovakia	10 years	Filing date
Finland	10 years	Registration date
Sweden	10 years	Registration 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 Article 7(2)(ii) EUTMDR, if the trade mark is registered, the opponent must provide evidence of registration.

If the opponent has submitted a registration certificate but the registration is due to expire before the expiry of the time limit for substantiation, it must file a renewal certificate or equivalent document in order to prove that the term of protection of the trade mark extends **beyond** this time limit or any extension given to substantiate its opposition. Such information must be accessible from a source recognised by the Office if the opponent relied on it. What counts is the date on which the registration would expire, and not the possibility to renew the mark within the six-month grace period under the Paris Convention.

When an earlier right on which the opposition is based reaches the end of protection after expiry of the time limit set by the Office to substantiate the opposition, the opposition is not automatically rejected in the absence of further communications or proof from the opponent. Rather a communication is issued to the opponent in which it is invited to submit evidence of renewal which is communicated to the applicant (judgment of 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 68 et seq.).

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 are on their own not sufficient to substantiate an earlier mark.

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

#### 4.2.3.5 Entitlement to file the opposition

Article 46 EUTMR  
Article 2(2)(h)(iii) and 7(2) EUTMDR

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

1. proprietors and authorised licensees for Article 8(1) and Article (5) EUTMR;
2. proprietors (only) for trade marks referred to in Article 8(3) EUTMR;
3. proprietors of earlier rights referred to in Article 8(4) EUTMR and persons authorised under the relevant applicable national law;
4. any person authorised under the relevant European Union legislation or national law to exercise the rights referred to in Article 8(6) EUTMR.

#### 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 has merely changed its name.

If the opponent is a licensee of the trade mark proprietor, the extract of the registration will normally show when a licence has been registered. However, some Member States do not record licences 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 submitted to support such an authorisation: for example, any express authorisation on behalf of the trade mark proprietor, such as the licence contract, is deemed sufficient, so long as it contains indications concerning the authorisation or entitlement to file the opposition.

The same applies to any person authorised under the relevant applicable European Union legislation or national law for the grounds of Article 8(4) and (6) EUTMR. The opponent must prove its entitlement to file the opposition under the applicable European Union legislation or national law.

According to Article 25 EUTMR and Articles 26 and 29 EUTMR, the Office registers and publishes licence agreements in respect of European Union trade marks. If the earlier mark basis of the opposition subject to the licence agreement is an EUTM, the opponent does not have to submit any evidence of the licence contract as long as the licence has been registered and published at the Office according to Article 25 EUTMR. On the other hand, the opponent will still have to submit evidence that proves that this licence agreement entitles it to act in defence of the mark if the licence is registered and published at the Office, if this evidence was not attached to the original request filed according to Article 25(5) EUTMR. For more information of licences, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDS as Objects

of Property, Chapter 2, Licences. It is not sufficient to prove the registration of the licence agreement — the opponent's entitlement to defend the EUTM must also be submitted in writing.

#### 4.2.3.6 Verification of evidence

The Office verifies that the claims submitted by the opponent within the three-month opposition period are reflected in the evidence submitted or in the evidence accessible online from a source recognised by the Office if the opponent relied on it.

The following details 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 [151] (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, 540, 541, 546, 554, 556, 557, 571, 591] and as claimed in the notice of opposition;

Where the earlier mark has been identified as being in colour during the three-month opposition period, there are two acceptable scenarios.

- 1) An official colour representation of the mark such as a registration certificate, renewal certificate, official extract, etc. is submitted or available online that contains a reproduction of the mark in colour.
- 2) An official document is presented with the representation of the mark in black and white, together with a colour claim and a colour indication, both of which are translated into the language of the proceedings.
  - a. Where the national trade mark office does not provide a detailed colour claim identifying the colours, and instead says 'Colours claimed' (or similar wording), this is acceptable as long as this entry is translated into the language of the proceedings.
  - b. Where the national office (e.g. the Portuguese Trade Mark Office) does not provide any indication of a colour claim in its certificate or official extract and the opponent does not rely on online evidence, further official documents must be submitted to prove this claim (e.g. a copy of the publication of the mark in the bulletin).

However, the latter 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.).

Therefore, if the opponent has identified during the three-month opposition period that its figurative mark is in colour and has only submitted 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.

Likewise, if the opponent has provided no indication during the opposition period that the earlier mark is in colour (representation in colour, or colour claim), and has only submitted a colour representation to the Office in order to substantiate its opposition, the opposition based on that earlier right will be rejected as not substantiated.

- the goods and services covered [511];
- the expiry date of the registration (if given);
- the owner [731, 732];
- other entries in the register 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.).

The number in square brackets is the international code number used to identify the information in many, but not all, pieces of evidences such as extracts from official databases or registration certificates. The opponent is not obliged to submit an explanation of the codes, either for the INID or for the national codes.

#### 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, designations of origin or geographical indications

##### 4.2.4.1 Well-known marks

Article 8(2)(c) EUTMR Article 7(2)(b) EUTMDR
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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 non-registered, but it may also be registered.

The opponent needs to demonstrate 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.

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 an additional 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) EUTMR. Depending on the ground of opposition that is indicated, the case will have to be considered under Article 8(2)(c) and/or Article 8(5) EUTMR. See also the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

#### 4.2.4.2 Marks with reputation

Article 8(5) EUTMR  
Article 7(2)(f) EUTMDR

An opposition under Article 8(5) EUTMR is based on an earlier trade mark that has a reputation. See also the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

The earlier trade mark in these cases is a registered trade mark. The opponent therefore has to submit registration certificates, etc. or rely on online evidence as set out above.

In order to make its case under Article 8(5) EUTMR, the opponent has to submit evidence of reputation. In addition, the opponent has to allege and demonstrate that the use of the mark that is the subject matter of the contested EUTM 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) EUTMR  
Article 7(3) EUTMDR

For these rights the Office applies the protection provided by the relevant law.

Not all Article 8(4) EUTMR rights are non-registered (for example, in some countries company and commercial names are registered). Thus, when the relevant law requires for the protection of these rights its registration, copies of the registration and, if applicable, documents such as renewal certificates are required. In the case of non-registered marks or signs the opponent must provide evidence of the acquisition of the earlier right. It must further show that it may prohibit the use of a subsequent trade mark. Furthermore, it also needs to provide the reference to and wording of the provisions of the national law on which it bases its case by adducing official publications of the relevant provisions or jurisprudence and to make out its case under that law.

Where the evidence concerning the filing or registration of the sign claimed or the evidence concerning the content of the relevant national law is accessible online from a source recognised by the Office, the opponent may provide such evidence by making a reference to that source. For that purpose, all of the online official publications, national databases will be accepted to the extent that they originate from the Government or official body of the respective Member State, if they are publically accessible and free of charge. For cases where the provisions of national law are governed by common law rules, the acceptable source may include online official publications (jurisprudence).

Finally, the opponent must submit evidence that the use of its right, either registered or not, has been of more than mere local significance. See the Guidelines, Part C, Opposition, Section 4, Rights under Articles 8(4) and 8(6) EUTMR.



#### 4.2.4.4 Protected designations of origin, protected geographical indications

Article 8(6) EUTMR  
Article 7(2)(e) EUTMDR

Under Article 8(6) EUTMR, protected designations of origin and protected geographical indications applied for prior to the date of application of the EUTM (or the date of priority claimed, if applicable) can be invoked as the basis for oppositions. For these rights the Office applies the protection provided by the relevant European Union legislation or national law.

In order to substantiate these rights the opponent must provide the Office with evidence of the existence, validity and scope of protection of the earlier right. It must further show that it may prohibit the use of a subsequent trade mark.

To prove the existence, validity and scope of protection of the earlier right, the opponent must submit pertinent documents emanating from the competent authority proving the application for, or the registration or grant (if the protected designation of origin or protected geographical indication was granted through administrative means other than registration) of, the right in question. If these documents do not provide sufficient information of the opponent's entitlement to file the opposition, further documents must be submitted.

Furthermore, to prove the opponent is entitled to prohibit use of a subsequent trade mark under the relevant law, it must provide reference to and wording of any national law on which it bases its case. The wording is not required if the opposition is based on European Union legislation. The opponent must also prove that the case fulfils all the conditions under the relevant provisions.

Where the evidence concerning the filing or registration of the earlier protected designations of origin, protected geographical indications or the evidence concerning the content of the relevant national law is accessible from a source recognised by the Office, the opponent may provide such evidence by making a reference to that source. All of the official publications, national databases are acceptable to the extent that they originate from the Government or official body of the respective Member State, if they are publically accessible and free of charge. In addition, references to all of the EU official databases online are accepted (CPVO, E-Bacchus, E-Spirits, E-door, etc.).

Unlike for earlier rights invoked under Article 8(4) EUTMR, the requirement to submit evidence that use of the sign has been of more than local significance does not apply to earlier rights invoked under Article 8(6) EUTMR.

For more details regarding substantiation of protected designations of origin and protected geographical indications, see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(6) EUTMR, paragraph 5 (Article 8(6) EUTMR — the Protection of Geographical Indications).

#### 4.2.4.5 Mark filed by an agent or representative

Article 8(3) EUTMR  
Article 7(2)(c) EUTMDR

This concerns the case where 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 Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR).

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 a non-registered trade mark, the opponent may submit either 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 Non-compliance with the substantiation requirements

Article 46(4) EUTMR  
Article 7, Article 8(1) and (7) EUTMDR

The Office sets a time limit of **two months** for the opponent, starting on the date when the adversarial part of the proceedings is deemed to commence, to complete the opposition by submitting facts, evidence and arguments in support ('substantiation time limit'). This time limit can be extended pursuant to Article 68 EUTMDR or, if missed, the opponent can apply for a reinstatement into the missed time limit subject to the conditions of Article 104 EUTMR (*restitutio in integrum*) or Article 105 EUTMR (continuation of proceedings).

Article 8(1) EUTMDR provides that if until the expiry of the substantiation time limit the opponent has **not provided any evidence**, or where the evidence provided is **manifestly irrelevant** or **manifestly insufficient** to meet the requirements laid down in Article 7(2) EUTMDR for any of the earlier rights, the opposition will be rejected as unfounded.

If none of the earlier rights on which the opposition is based has been substantiated, the Office **closes the adversarial part** of the proceedings without inviting the applicant to submit observations in reply. The Office is not required to inform the opponent which facts or evidence could have been submitted (17/06/2008, T-420/03, BoomerangTV, EU:T:2008:203, § 76). Subsequently, the opposition is rejected pursuant to Article 8(1) EUTMDR.

It follows that where the opponent failed to provide **any evidence at all**, the opposition will be rejected. It must be deemed as if no evidence was provided if the evidence is not accompanied by a translation into the language of the proceedings, as such non-translated evidence cannot be taken into account pursuant to Article 7(4) EUTMDR, last sentence.

The evidence submitted is '**manifestly irrelevant**' if, by its nature, it cannot serve to establish the validity and existence of the earlier right invoked (as, for example, if it proves the existence of an earlier right which was not invoked in the notice of opposition). The evidence submitted is '**manifestly insufficient**' if it does not meet the formal requirements of substantiation.

Upon expiry of the substantiation time limit, the Office carries out a preliminary examination of substantiation. If the opponent provided evidence for at least one of the earlier rights invoked in the opposition that cannot be qualified as 'manifestly irrelevant' or 'manifestly insufficient', the Office **continues the adversarial part** of the

proceedings by forwarding the opponent's submission to the applicant with an invitation to submit observations.

If, upon further examination of the file, the evidence submitted within the substantiation time limit is **still** deemed **insufficient** to meet the requirements laid down in Article 7(2), the opposition will be rejected in relation to that earlier right pursuant to Article 8(7) EUTMDR.

Furthermore, since the initial substantiation check is limited to finding one substantiated earlier right on the basis of which the procedure can continue, if the opposition cannot be fully upheld on the basis of this substantiated earlier right, a further examination of the file in relation to the remaining earlier rights is required. If this examination reveals that the evidence relating to these earlier rights is non-existent, manifestly irrelevant, manifestly insufficient or otherwise insufficient to meet the requirements laid down in Article 7(2), the opposition will also be rejected in relation to these rights pursuant to Article 8(7) EUTMDR.

#### 4.2.6 Facts and evidence submitted after the substantiation time limit

Article 95(2) EUTMR Article 8(5) EUTMDR
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All facts and evidence on which the opponent bases its opposition have to be submitted within the substantiation time limit established in Article 7(1) EUTMDR. Any fact or evidence submitted after the substantiation time limit is, therefore, late.

Nevertheless, if the opponent submits facts or evidence to substantiate the opposition after the substantiation time limit, the Office may take into account such facts or evidence in exercise of its discretionary power pursuant to Article 95(2) EUTMR, subject to the conditions of Article 8(5) EUTMDR.

In that context, it must be assessed **first**, whether the Office's discretionary power is available, and, **second**, if it is available, how to exercise that discretion, that is, whether to admit or reject such late facts or evidence.

##### 4.2.6.1 Whether the discretionary power is available

According to Article 8(5) EUTMDR, first sentence, the Office may exercise its discretionary power if the late facts or evidence supplement relevant facts or evidence submitted by the opponent in due time ('initial facts or evidence').

It is clear therefore, that no discretionary power applies if the late facts or evidence relate to an earlier right or ground of opposition invoked in relation to which **no initial evidence** was filed at all within the substantiation time limit. The same applies regarding facts.

However, where **some initial fact or evidence** was submitted, the Office will exercise its discretionary power whether to admit late facts or evidence only if the following conditions are met:

- initial evidence submitted within the substantiation time limit is relevant and not manifestly insufficient, and

- the late fact or evidence relates to the same legal requirement that the initial fact or evidence purported to prove.

Registration certificates that do not contain all the information necessary to establish the existence, scope or validity of the earlier mark concerned would, in principle, be found to be evidence manifestly insufficient, since that required content is precisely and exhaustively established by the regulations.

The Office will find that the late fact or evidence relates to the same legal requirement that the initial fact or evidence only when both sets refer to the same earlier mark, to the same ground and, within the same ground, to the same requirement.

No discretionary power applies where the Office has informed the parties that the opposition will be rejected as unfounded under Article 8(1) EUTMDR. In those cases, the proceedings would be resumed only if the opponent requests continuation of proceedings according to Article 105 EUTMR or *restitution in integrum* according to Article 104 EUTMR.

#### 4.2.6.2 Whether the late facts or evidence should be admitted or rejected

For the purposes of exercising its discretionary power, the Office must take into account, in particular, the **stage of proceedings** and whether the facts or evidence are, *prima facie*, **likely to be relevant** for the outcome of the case and whether there are **valid reasons** for the late submission of the facts or evidence.

- The **stage of the proceedings** indicates how advanced the proceedings are at the time of submitting the late evidence.
- The late evidence is ***prima facie* relevant**, if it appears to have an impact on the assessment and outcome of the case.
- **Valid reasons** are typically where the supplementing evidence was not yet available before the expiry of the substantiation time limit. There may be other valid reasons.

These factors are interdependent. The later the stage of proceedings, the stronger must be the reason for late submission or the relevance of the evidence. Therefore, additional facts or evidence can be accepted if, *prima facie*, they are likely to be relevant for the outcome of the case and are submitted at an early stage of the proceedings with a justification why it is submitted at this stage of the proceedings.

There may be **other relevant factors**. The intention to prolong the proceedings by submitting evidence in parts (delaying tactics), if the circumstances of the case allow that conclusion, argues against admission of late evidence. Also, where the requirements to be proven are circumscribed in detail in the law or the fact that the Office has explicitly drawn the opponent's attention to those requirements, argue against admitting late evidence.

The natural difficulties in obtaining the evidence are not, as such, a valid reason for its belated submission. Also, erroneous assumption by the party, that the documents initially submitted were correct and sufficient is not a valid reason for late submission and thus goes against exercising the discretion in its favour.

#### 4.2.6.3 Treatment of late evidence in proceedings

Facts or evidence received after the given time limit will be forwarded to the other party for information purposes without informing as to its acceptance or refusal. They will be examined at a later stage when taking the decision. The proceedings will be re-opened and a second round of observations will be granted if necessary, namely, if the Office is considering the acceptance of late facts or evidence and the applicant had not yet the opportunity to comment on them.

The application of the discretionary power must be reasoned in the decision concluding the opposition. However, where the initial evidence is in itself sufficient to prove the earlier rights and grounds of opposition invoked, there is no need to consider the issue of late additional evidence.

### **4.3 Translation/changes of language during the opposition proceedings**

Pursuant to general rules set in Article 146(9) EUTMR and Article 24 EUTMIR, most submissions of the parties in opposition proceedings have to be in the language of the proceedings in order to be taken into account. However, for different submissions there are different rules to be applied.

#### 4.3.1 Translations of evidence submitted to substantiate the opposition and of facts, evidence and arguments submitted by the opponent to complete its file

Article 25(1) EUTMIR Articles 7(4),(5) and Article 8(1) EUTMDR
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On the basis of Article 24 EUTMIR, the differentiation should be made between 1) evidence of filing, registration or renewal certificates or equivalent documents, any provisions of the applicable national law, 2) other evidence submitted to substantiate the opposition and 3) facts and arguments submitted by the opponent to complete its file.

##### 4.3.1.1 Translation of evidence of filing, registration or renewal certificates or equivalent documents, any provisions of the applicable national law

Pursuant to Article 7(4) EUTMDR, any filing, registration or renewal certificates or equivalent documents as well as any provisions of the applicable national law governing the acquisition of rights and their scope of protection submitted by the opponent to substantiate the opposition must be either in the language of the proceedings, or be accompanied by a translation into that language. Such translations must be submitted by the opponent on its own motion and within the time limit for substantiation of the opposition. Only what is submitted and translated within this time limit is taken into account.

The requirement of translating the evidence of substantiation also relates to online evidence referred to by the opponent, where the language of the online evidence is not the same as the language of the proceedings. This follows from Article 7(4) EUTMDR, which states that 'evidence accessible online' shall also either be in the language of the proceedings, or shall be accompanied by a translation.

Article 25(1) EUTMIR requires that the translation reproduces the structure and contents of the original document. In case of translations of online evidence of substantiation, the submission of the translation without the original will be accepted, as long as the document to which it refers is identified correctly.

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.

Article 25(1) EUTMIR foresees that the opponent may indicate that only parts of the document are relevant, and therefore the translation may be limited to those parts only.

However, only irrelevant administrative indications (e.g. previous transfers of ownership that do not affect the opposition, administrative entries on fees, etc.) with no bearing on the case may be omitted from the translation. The provisions set in Article 25(1) EUTMIR do not imply that the opponent has discretion to decide not to translate the elements required by the Regulation, specifically the requirements needed for substantiation of the earlier rights as listed in Article 7(2) EUTMDR. Where the Regulation establishes that an element must be proven, as it is the case for existence, validity, scope of protection of earlier rights and entitlement to file the opposition, and these specific parts of the evidence are not translated, the opposition may be rejected as non-substantiated.

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 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.

Where the opposition is based on only some of the goods and services covered by the earlier right, it is sufficient to provide only a translation of the goods and services on which the opposition is based.

When the entire original document is in the language of the proceedings except for the list of goods and services, there will be no need to provide a complete translation following the structure of the original document. 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, or in documents attached thereto or submitted later within the time limit to substantiate the opposition. The same applies to extracts/certificates that make use of INID or national codes, where the only information that still needs to be translated into the language of the proceedings is the list of goods and services.

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 unless serious doubts arise regarding the accuracy or content of the translation. Where the representative adds a declaration that the translation is true to the original, the Office will, in principle, not question this. The Office even accepts handwritten 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.

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

In cases where when assessing the substantiation it is detected that the translation does not accurately reflect the structure and content of the online database relied upon by the opponent, the Office will, pursuant to Article 97(1)(b) EUTMR, ask the opponent for clarification. This would require the opponent to submit evidence of the contents of the original extract to which the translation relates. In the absence of such evidence or if the evidence shows a discrepancy between the translation submitted and the original extract as regards the structure and content, the earlier mark will be deemed to be non-substantiated.

#### 4.3.1.2 Translations of evidence submitted to substantiate the opposition, which are other than filing, registration or renewal certificates or equivalent documents, any provisions of the applicable national law

Article 7(4) EUTMDR also addresses the language regime applicable to evidence submitted by the opposing party to substantiate the opposition, which are other than filing, registration or renewal certificates, or equivalent documents and provisions of applicable national law. They encompass evidence of reputation (Article 8(5) EUTMR) and evidence of use of more than of mere local significance (Article 8(4) EUTMR).

If the evidence is submitted in an EU language that is not the language of the proceedings, pursuant to Article 24 EUTMIR the Office may, of its own motion or upon reasoned request by the applicant, require the opponent to submit a translation of the evidence into the language of the proceedings within a specified time limit. In other words, the opponent has no obligation to submit the translation on its own motion, unless it is requested to do so by the Office. Such language regime mirrors the one applicable to proof of use and, hence, rules regarding translation of proof of use equally apply to the abovementioned evidence for substantiation. For further information on applicable rules, see the paragraph 4.3.4, Proof of use.

#### 4.3.1.3 Translations of facts and arguments submitted by the opponent to complete its file

The Office may consider only facts and arguments filed by the opponent in support of the opposition if they are submitted in the language of the proceedings or are accompanied by a translation within the time limit for substantiation. The Office will not request the opponent to send a translation; it has to send one on its own initiative. If no translation or a partial translation has been submitted within the time limit set, pursuant to Article 7(5) EUTMDR, parts of written submissions which have not been translated into the language of proceedings will not be taken into account.

Article 7(4), (5) and Article 8(1) EUTMDR
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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, namely within the time limit for substantiation of the opposition.

If this is not done, the legal consequence is that written submissions, or parts thereof, that 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

Article 146(9) EUTMR  
Article 8(2), (4) and (6) EUTMDR

According to Article 146(9) EUTMR, the applicant's first reply or the opponent's reply to the applicant's observations may be in any language of the Office.

It is to be noted that if the applicant's first reply or the opponent's counter-reply is 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 submits 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 one on their own initiative.

##### Example 1

The language of opposition is English and the applicant has until 26/06/2017 to submit observations in reply to the notice of opposition. If, on 20/06/2017, it submits its observations in reply to the opposition in German, it must file its translation by 20/07/2012. If it then files the translation on or before 20/07/2017, both the original submission and the translation must be taken into account, notwithstanding that the original time limit for filing observations expired on 26/06/2017.

##### Example 2

The language of opposition is English and the applicant has until 26/06/2017 to submit observations in reply to the notice of opposition. If, on 18/05/2017, it submits its observations in reply to the opposition in German, it must file its translation by 18/06/2017. However, as its time limit only finishes on 26/06/2017, if it has not filed a translation by 18/06/2017, it can still validly file documents until 26/06/2017. 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.

Article 25(2) EUTMIR

If no translation has been submitted or the translation is received after the expiry of the relevant period, 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 other supporting documents, other than observations

Article 24 and Article 25(2) EUTMIR



All evidence, with the exception of the evidence that the opponent must provide within the time limit given to substantiate its opposition, can be submitted in any official language of the European Union, as Article 24 EUTMIR applies. This evidence concerns all documents, other than observations, submitted by the parties after the time limit for the opponent to complete its file.

Examples of this type of evidence are catalogues, magazine articles, decisions 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, on its own motion or upon reasoned request by the other party, requests it. Therefore, the parties are not automatically obliged to file a translation.

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 addressed, the Office requires a translation within a specified time limit.

Article 25(2) EUTMIR will apply only if the Office requires a translation, with the effect that translations that are filed late must be disregarded; likewise the original for which a translation is late or missing must also be disregarded.

Together with the invitation to file a translation, the Office will draw the attention of the party concerned to the fact that it is up to that 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 insofar as a translation is submitted or insofar 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 only those parts that are relevant for the opposition proceedings.

#### 4.3.4 Proof of use

Article 10(2) and (6) EUTMDR
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For proof of use, Article 10(6) EUTMDR is *lex specialis* as regards translations. If the evidence is submitted in an EU language that 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 Office's discretion 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.

Article 10(2) EUTMDR has the effect that the opposition must be rejected if (1) no proof of use is submitted within the time limit given, or (2) proof of use was submitted 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 initiative submits a translation of this evidence into the language of the proceedings after the expiry of the time limit but before the time limit set for the applicant to submit 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.

For further information on proof of use, see the Guidelines, Part C, Opposition, Section 6, Proof of Use.

#### 4.3.5 Change of language during opposition proceedings

Article 146(8) EUTMR Article 3 EUTMDR
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According to Article 146(5) EUTMR the opposition should be filed in one of the languages of the Office. However, Article 146(8) EUTMR foresees that the parties to opposition proceedings may agree to change the procedural language and choose any official language of the European Union for that purpose.

Pursuant to Article 3 EUTMDR if the parties agree to change the procedural language they are required to inform the Office accordingly prior to the commencement of the adversarial part of the opposition proceedings. A request to change the language after the commencement of the adversarial part 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, according to Article 3 EUTMDR the applicant may request that the opponent files a translation of the notice of opposition in that language. In other words the opponent only has to submit a translation of the notice of opposition if the applicant requests it. The request for translation must be received before the start of the adversarial part of the proceedings. If the translation request is not filed or is filed late, the language of the proceedings will be changed to the language requested.

If a request to submit a translation of the notice of opposition has been filed and it was filed on time, the Office will set the opponent the time limit during which the translation must be submitted, which will be one month (or two months in case the opponent comes from outside the EEA) of expiry of the cooling-off period. Where the translation is not filed or filed late, the language of the proceedings will remain unchanged.

## 4.4 Requests and other documents related issues

### 4.4.1 Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document

Articles 8(8) and 10(1) EUTMDR

Where the applicant wishes to withdraw or restrict the contested application, it must do so by way of a separate document. The request must be 'separate' from other submissions; therefore it may be submitted together with more pages, however it must be presented separately (either on a separate sheet, or in a clearly identified separate section/paragraph). Consequently, a request will never be accepted where it is 'merged' into observations.

The same applies to requests for proof of use of an earlier mark pursuant to Article 47(2) or (3) EUTMR, these are admissible if they are submitted as an unconditional request in a separate document within the period specified by the Office pursuant to Article 8(2) EUTMDR.

When the party submits such request electronically by selecting the specific options 'submit a restriction of goods and services', 'withdrawal', 'submit a request for proof of use' or 'submit observations and a request for proof of use', the automatic cover page in itself as generated and as inserted in the file will be considered as equivalent to a request in a 'separate document'.

In case of requests not filed electronically, even if a request is identified, it is inadmissible because it is not submitted 'separately' in the way defined above, and the Office will refuse the request. The refusal will confirm the reason for the rejection and will be an interim decision appealable together with the decision on the substance.

For more details on requests for proof of use in Opposition Proceedings, see the Guidelines, Part C, Opposition, Section 6, Proof of Use.

### 4.4.2 Documents not readable

Article 63(3) EUTMDR

Where a communication received by electronic means, including 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 fax or to submit the original in accordance with Article 63(1)(b) EUTMDR.

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

For more details, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

#### 4.4.3 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 web page under 'Inspection of files and copies'.

#### 4.4.4 Confidential information

Article 114(4) EUTMR
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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 it should have full access to all material submitted by the other party.

It follows that all material submitted 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 and inform the Office accordingly.

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 within the time limit specified, 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.

For more information on confidentiality claims, reference is made to paragraph 5.1.3 of the Guidelines, Part E Register Operations, Section 5 Inspection of files.

#### 4.4.5 References made to documents or items of evidence in other proceedings

Article 115 EUTMR  
Article 63(1)(b) EUTMDR  
Decision No EX-13-4 of the President of the Office

The Office may receive observations from the opponent or applicant in which they refer to documents or evidence submitted in other proceedings, for instance to evidence of use that has already been submitted 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. 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 number of pages of this document; and (4) the date this document was sent to the Office. For example, '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'.

Should the documents referred to by the opponent or the applicant consist originally of items of evidence not having been filed in paper format up to and including A3 size and should this evidence not be available in the electronic file of the Office, in accordance with Article 63(1)(b) EUTMDR the party concerned must 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. Articles 7(5) and 10(6) EUTMDR, Article 24 EUTMIR and Article 146(9) EUTMR apply accordingly.

A general reference to documents or evidence submitted in other proceedings will not be accepted. In such a situation the party making general reference to other documents or evidence 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 receipt in accordance with Article 115 EUTMR and Decision No EX-13-4 of the President of the Office of 26 November 2013 concerning the keeping of files. In this case, the reference to documents or evidence submitted in other opposition proceedings has no effect.

## 4.5 Further exchanges

Article 24 and Article 25(2) EUTMIR  
Article 8(2), (4), (6) and (9) EUTMDR

The Office invites the applicant to file observations within the time limit set by it in accordance with Article 8(2) EUTMDR.

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 submitted together with the observations in reply to the proof of use.

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.

Once the applicant has submitted its observations in reply, the opponent is granted a final time limit to submit 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 must be given a possibility of replying. It is at the discretion of the Office to decide if another round of observations should be granted to the opponent (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).

Pursuant to Article 10(7) EUTMDR, 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. Additional evidence will be examined on a case-by-case basis. For further details, see the Guidelines, Part C, Opposition, Section 6, Proof of Use. If necessary, a second round of observations will be granted.

## 4.6 Observations by third parties

Article 45 EUTMR  
Communication No 2/09 of the President of the Office

Third parties can make observations explaining why the EUTM application should not be registered under Article 5 EUTMR or on the basis of one of the absolute grounds of Article 7 EUTMR. For further details, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Collective Marks, and the Guidelines, Part B, Examination, Section 1, Proceedings.

Anybody can submit third party 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 abovementioned Communication of the President of the Office, the observations must be submitted separately. However, in practice (decision of 30/11/2004, R 735/2000-2, SERIE A), 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 45 EUTMR, these will be dealt with, even if they are not submitted separately. However, if in its submission the opponent argues that the EUTM application should have been refused under Articles 5 and 7 EUTMR, without any reference to the contents of Article 45 EUTMR, this submission will not be regarded as third party observations under Article 45 EUTMR.

When an opponent makes third party observations, the Office will consider if the observations raise serious doubts as to the registrability of the EUTM 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 oppositions closed due to third party observations, the opposition fee will not be refunded, as such refund is not foreseen in the regulations (see Article 6(5) EUTMDR).

## **5 Termination of proceedings**

### **5.1 Friendly settlement**

Article 47(4) EUTMR Article 6(2) EUTMDR
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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.

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 66(1), 71(3), 146(6)(a) and 146(9) and Article 109 EUTMR  
Article 6(2), (3) and (4) EUTMDR

### 5.2.1 Restrictions and withdrawals of EUTM applications

Article 49 EUTMR  
Article 6(5) EUTMDR

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 EUTM applicant during the proceedings will never be considered as a tacit withdrawal.

A conditional or ambiguous withdrawal or restriction will not be accepted and will 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 EUTM application. In this case the restriction is not acceptable, and the applicant must be informed that the restriction must be express and unconditional.

Such requests must be filed by way of separate documents as stated above under point 4.4.1.

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

If a restriction is partly acceptable and partly unacceptable, the Office will proceed with the restriction for the acceptable part and will inform the applicant of the part that cannot be accepted, giving a time limit of 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 new proposal for the unacceptable part of the restriction, which the Office can now accept, the restriction will be processed taking into account the date of filing of the first request for the restriction. On the other hand, if the applicant does not react, the restriction is only processed insofar as it is acceptable (judgment of 11/12/2014, C-31/14 P, Premeno, EU:C:2014:2436, § 43-51).

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 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.

For further information on restrictions of an EUTM application, see the Guidelines, Part B, Examination, Section 3, Classification and Part B, Examination, Section 1, Proceedings, paragraph 5.2.

#### 5.2.1.1 Withdrawal or restriction before the admissibility check is made

##### Restriction covers the whole extent of opposition/withdrawal

When the EUTM 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 of 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.

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.

No decision on costs will be taken.

#### 5.2.1.2 Restrictions and withdrawals of EUTM 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 EUTM 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.

If the withdrawal of the opposition is received by the Office before the official notification of the restriction is forwarded to the opponent, the withdrawal is considered to be 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 (which has been extended).
- The opponent responds by maintaining its opposition, but nevertheless withdraws the opposition still within the extended cooling-off period.

5.2.1.3 Restrictions and withdrawals of EUTM 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 below.

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 any reply. If the opposition is maintained, the proceedings continue. If the opposition is withdrawn, the opposition proceedings are closed. If the opponent first maintains its opposition and then subsequently withdraws, this is treated as a withdrawal of the opposition in accordance with paragraph 5.2.2.2 below.

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 below.

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

Following the decision of the Grand Board of Appeal of 27/09/2006 in case R 331/2006-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 costs 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 EUTM application.

For further information, see the Guidelines, Part B, Examination, Section 1, Proceedings and Part E, Register Operations, Section 2, Conversion.

An EUTM application cannot be withdrawn once a decision rejecting the EUTM application in full has become final.

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

#### 5.2.1.5 Language

Article 146(6)(a) EUTMR
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During opposition proceedings a restriction may be submitted either in the first or the second language of the EUTM application.

When the restriction is submitted in the first language of the EUTM 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. A conditional or ambiguous withdrawal will not be accepted and will be forwarded to the applicant

merely for information purposes, informing the parties that it will not be taken into account. Such requests must be filed by way of separate documents as stated above under paragraph 4.4.1.

If the opponent withdraws its opposition independent of any restriction of the EUTM application, three situations can arise depending on the status of the opposition (for information about the consequences of the withdrawal of an opposition following a restriction of the EUTM application, see paragraph 5.2.1 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. Unlike a withdrawal of the opposition following a restriction of the EUTM application during the cooling-off period (see paragraph 5.2.1.2 above), 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 below.

#### 5.2.2.3 Withdrawal of the opposition after a decision has been taken

Following the decision of the Grand Board of Appeal of 27/09/2006 in case R 331/2006-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 costs 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 on withdrawals during appeal proceedings, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.

#### 5.2.2.4 Language

Article 146(9) EUTMR
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A withdrawal of the opposition must be in the language of the proceedings. Should the withdrawal be submitted in a language that is not the language of proceedings a translation must be filed within one month from the date of submission of the original document. 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

Article 8(1)EUTMDR
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If proof of existence, validity and scope of protection has not been filed properly for any of the earlier rights invoked, the opposition is rejected as soon as the time limit given to the opponent to complete its file has expired.

However, if the existence, validity and scope of protection of at least one earlier right has been proven, the proceedings will continue normally, and the non-substantiated rights will 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 that 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 EUTM application and the earlier right that has ceased to have effect cannot coexist anymore the opposition cannot be upheld to this extent. Such a decision would be unlawful (judgment of 13/09/2006, T-191/04, Metro, EU:T:2006:254, § 33-36).

Invalidation of any earlier right other than an EUTM 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 not be able to proceed on the basis of that earlier right.

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. This is the case even if the mark is still within the grace period for renewal, if applicable. If the opponent does not submit the proof, the opposition will not be able to proceed on the basis of that earlier right.

Before the decision is taken, the Office may also check the documents on file to see whether the earlier right invoked is the subject of national post-registration proceedings. If so, the Office will invite the opponent to provide evidence of the final outcome of the national proceedings. If the opponent provides evidence showing that the national proceedings are still pending, the Office may suspend the opposition proceedings until a final decision has been taken in the proceedings that led to the suspension.

## **5.4 Fee refund**

### **5.4.1 Opposition deemed not entered**

Articles 46(3) and 181(1) EUTMR Article 5(1)EUTMDR
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If an opposition is deemed as not entered because of late or insufficient payment (see paragraph 2.2.2 above, Time of payment), the opposition fee, including any surcharge, must be refunded to the opponent.

#### **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 republication**

If after republication of the EUTM application in Part A.2 of the Bulletin due to a mistake by the Office, a 'first publication opponent' wishes to withdraw its opposition as a consequence of the republication, the proceedings should be closed. As the Office made a mistake with the first publication, the opposition fee will be reimbursed.

### **5.4.2 Refund in view of withdrawals/restrictions of EUTM application**

#### **5.4.2.1 EUTM application withdrawn/restricted before the end of the cooling-off period**

Article 6(2), (3) and (4) EUTMDR
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If the applicant withdraws its EUTM 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 EUTM application within the cooling-off period**

Article 6(2), (3) and (4) EUTMDR
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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.

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

Article 9(4)EUTMDR
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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 EUTM application in parallel opposition proceedings. For example, if there are four oppositions A, B, C and D (opponents A, B, C, D) against EUTM application X, and EUTM application X is rejected due to opposition A, and
- the other oppositions (B, C and D) had been suspended before the commencement of the adversarial part, because a preliminary examination revealed that EUTM 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

Article 6(3), (4) and (5) EUTMDR
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If the opponent withdraws its opposition before the end of the cooling-off period and there has been no restriction of the EUTM application, the Office neither refunds the opposition fee nor takes a decision on costs.

##### 5.4.4.2 Opponent's withdrawal is earlier

Article 6(3) and (5) EUTMDR
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When the opposition is withdrawn before 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

Article 6(2), (4) and (5) EUTMDR

As regards the refund of the opposition fee, Article 6(5)EUTMDR only mentions this possibility if there is either a withdrawal or a restriction of the EUTM application. Therefore, if the proceedings end by an agreement that contains a mention of a withdrawal or restriction of the EUTM 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, 45 and Article 92(2) EUTMR  
Articles 5, 6 and Article 74(1) and (3)EUTMDR

In cases where the application is rejected in accordance with:

- Article 7 EUTMR (rejection of an application on absolute grounds; on the Office's own initiative or because of third party observations)
- Article 119(2) EUTMR (representation for non-EEA applicants).

the opposition fee is not refunded as none of these situations is contemplated in the EUTMR as a reason for refunding the opposition fee.

## 5.5 Decision on the apportionment of costs

### 5.5.1 Cases in which a decision on costs must be taken

Article 109 EUTMR  
Article 6(4) EUTMDR

A decision on costs is taken in opposition proceedings that have passed the cooling-off period, that is to say, where the adversarial part of the proceedings has started and come to an end.

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 the Office about an agreement on costs.

### 5.5.2 Cases in which a decision on costs is not taken

No decision on costs is taken for oppositions that are closed before or during the cooling-off period.



### 5.5.2.1 Agreement on costs

Article 109(6) EUTMR
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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 have reached an agreement on costs after the withdrawal/restriction, the decision already issued 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 'successful party'

When the party that would be entitled to be awarded costs according to the general 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 '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 109 EUTMR
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The general rule is that the party that terminates the proceedings, by withdrawing the EUTM application (wholly or partially) or by withdrawing the opposition, will 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 that 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 EUTM 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 (judgment of 28/04/2004, T-124/02 and T-156/02, Vitataste, EU:T:2004:116, § 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 restricted only to a very small extent).

The Office will not take into account parties' arguments as to who should pay.

#### 5.5.4 Cases that did not proceed to judgment

##### 5.5.4.1 Multiple oppositions

###### Complete rejection of the EUTM application

In cases where there are multiple oppositions against the same EUTM application that have not been suspended by the Office in accordance with Article 9(2)EUTMDR, and one opposition leads to the rejection of the EUTM 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) EUTMR). 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 EUTM application

In cases of multiple oppositions that are partially directed against the same goods and services of the contested trade mark, the decision in relation to the opposition that 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 EUTM 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 109(3) EUTMR. 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 the normal rules.

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

An EUTM application can be rejected during an opposition procedure on absolute grounds for refusal (either on the basis of third party observations, Article 45 EUTMR, or even *ex officio* if the case is reopened) or on formalities (e.g. if an applicant from outside the EEA is no longer represented under Article 119(2) EUTMR).

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 109(5) EUTMR. 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

Article 9 EUTMDR
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For further information on joinder, see 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 109(1) EUTMR. 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 against the other party.

## 5.6 Fixing of costs

### Article 109(7) EUTMR

Where the costs are limited to representation costs and the opposition fee, the decision fixing the amount of costs will be included in the decision on the apportionment of the costs (i.e. as a rule, in the decision on substance).

This means that in the vast majority of cases, it will not be necessary to fix the amount of costs separately.

The only exceptions are:

- when an oral hearing took place;
- when the fixing of costs was inadvertently omitted (‘forgotten’) in the main decision.

#### 5.6.1 Amounts to be reimbursed/fixed

### Article 85(1) and (6) EUTMDR

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

If the opponent wins, the opposition fee of EUR 320 will be reimbursed.

As regards representation costs, the amount is limited to EUR 300. This applies both to the opponent and the applicant, provided that they were represented in the opposition procedure by a professional representative within the meaning of Article 120(1) EUTMR, irrespective of whether these costs have actually been 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.

In the case of a joinder under Article 9(1) EUTMDR, 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 940.

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.

When a decision is annulled by the Boards of Appeal and remitted to the Opposition Division, the Opposition Division has to decide on the case again and will take a decision on and fix the costs in the usual way.

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

Article 85(6)EUTMDR
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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; in that case the party concerned must also comply with the applicable requirements):

- admissibility
- evidence.

#### 5.6.3.1 Admissibility

Article 109(7) EUTMR
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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

Article 85(6)EUTMDR
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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; 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 these make it plausible (rather than provide fully fledged proof) that the costs have been incurred.

#### 5.6.4 Review of fixing of costs

Article 109(7) EUTMR  
Article 85(7)EUTMDR

If one of the parties disagrees with the 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 (decision of 16/12/2004, R 503/2001-4, BIO / BIOLACT).

## 6 Procedural issues

### 6.1 Correction of mistakes

Article 49(2) and 102(1) EUTMR

#### 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 49(2) EUTMR, which refers to the EUTM application, by analogy, obvious mistakes in the notice of opposition may be corrected.

The Office defines 'obvious error' in relation to Article 49(2) EUTMR and Article 102(1) EUTMR 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 EUTMR 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.

#### 6.1.2 Correction of mistakes and errors in publications

Rule 44(3) EUTMR

Where the publication of the application contains a mistake or error attributable to the Office, the Office will correct the mistake or error 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 EUTM is registered. Where the correction 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 EUTM application, the opponents will have to be informed of the republication. 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.

If a 'first publication opponent' wishes to withdraw its opposition as a consequence of the republication, the proceedings should be closed and the opposition fee should be refunded (see paragraph 5.4.1.2 above).

## 6.2 Time limits

Article 101(1) and 146(9) EUTMR  
Article 63 and Article 63(1)(a) EUTMDR

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 Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

### 6.2.1 Extension of time limits in opposition proceedings

#### 6.2.1.1 Non-extendable and extendable time limits

Article 101(1) EUTMR

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

Article 46(1) EUTMR

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

Article 46(3) EUTMR

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

Article 141(3) EUTMR

- 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;

Article 5(5) EUTMDR

- the two-month time limit to remedy deficiencies according to Article 5(5)EUTMDR.

Rule 101(1) EUTMR

The length of extendable time limits 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 filed and received before the expiry of the original term (order of 30/01/2014, C-324/13 P, Patricia Rocha, EU:C:2014:60). If a request for extension is received by the Office after the expiry of the time limit, it must be rejected.

As a general rule, the first request for an extension that is received in time will be considered appropriate and will be granted for a period of two months (or less if so requested). 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 within 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 within the control of the parties.



The request has to be filed by the party affected by the time limit. For example, if the applicant has to submit 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, consult the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.3.

#### 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 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 (order of 30/01/2014, C-324/13 P, Patricia Rocha, EU:C:2014:60), the party concerned will 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, assuring the Office that the other party agrees to the extension is not acceptable.

## 6.3 Suspension

Article 9(4) and Article 71 EUTMDR
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The Office can suspend opposition proceedings either *ex officio*, or at the request of either one or both parties.

### 6.3.1 Suspension requested by both parties

According to Article 71(2) EUTMDR if both parties request suspension after expiry of the cooling-off period, upon a reasoned request (for example, negotiations towards a friendly settlement), the suspension is granted. In this case, and regardless of the period requested by the parties, the first suspension will be granted for a period of six months, with the parties being given the possibility of opting out. The process for opting out is the same as for the extension of the cooling-off period: if one party opts out, the

suspension will end 14 days after the parties have been informed thereof. The proceedings will resume the day after and the party whose time limit was pending at the moment of suspension will be granted a time limit of two months. 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 will not be granted if it is received within the cooling-off period because the purpose of the cooling-off period is to set a time frame for negotiations before the adversarial stage begins.

In principle, the parties may obtain extensions of the suspension by jointly filing a reasoned request (for example indicating that the negotiations towards a friendly settlement are on-going). Such requests will be granted for further six-month periods.

However, the maximum duration of this suspension of the proceedings is limited to **two** years as set out in Article 71(2) EUTMDR, a duration that is to be understood as two years cumulative over the course of the proceedings. Consequently, requests for suspension submitted by both parties must be rejected if the suspended period exceeds the maximum of two years as a whole.

Requests for suspension based on ongoing negotiations submitted by only one of the parties will be 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 proceedings *ex officio* or at the request of one party under a variety of circumstances:

- the opposition is based on an application for registration of a trade mark (including conversion);
- the opposition is based on an application for registration for a geographical indication or designation of origin.
- the earlier right is at risk (under opposition or cancellation);
- there are third party observations that raise serious doubts as to the registrability of the EUTM application (see paragraph 4.6 above);
- there are errors in the publication of the contested application that require the mark to be republished;
- a transfer is pending on earlier EUTMs/EUTM applications or contested EUTM applications.

It should be noted that there is no obligation in any of the abovementioned cases to suspend the proceedings. The Office will decide whether a suspension is appropriate under the circumstances of each case. Therefore, the decision is at the Office's discretion.

It is remarked that the proceedings may be suspended for a period of time longer than the one set out in Article 71(2) EUTMDR where the reasons indicated in Article 71(1)(a) or (b) EUTMDR are complied with.

## 6.3.2.1 Explanation of the basic principle, timing of suspension

## Article 71(1)(a) and (b) EUTMDR

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

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 and, 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 or registration. For earlier EUTMs, the Office has this information at its disposal.

However, the Office may suspend the proceedings earlier if this is **requested by one of the parties** 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 it 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 suspension — in particular, whether the final decision on the opposition cannot be issued without taking into account the earlier application or earlier registration. This will be the case if the circumstances of the case do not allow the Office to say that 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 mark for all the contested goods and services).

When an opposition is based on an application for registration, it may be appropriate to suspend the opposition proceedings under Article 71(1)(a) EUTMDR to await registration of the opponent's earlier mark. 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 EUTM application.

## 6.3.2.2 Earlier EUTM applications or registrations

The opposition is based on an application but is not suspended because there is another earlier right (a registered trade mark) on the basis of which the contested application may be rejected. If the opponent fails to substantiate this other earlier right, the earlier application becomes crucial for the decision. If, according to the records, the

only earlier application or registration is facing problems, the opposition should be suspended.

#### 6.3.2.3 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. 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.

#### 6.3.2.4 Examples

Here are some examples where, according to the general practice indicated above, the situation apparently does not require suspension of the proceedings but the suspension can nevertheless be decided if the Office finds it appropriate.

- The opposition is based on a French mark and on an EUTM 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 EUTM application and therefore it is appropriate to suspend the proceedings to await the outcome of the EUTM application.
- The earlier application does not make any difference to the outcome, but the applicant requests a suspension. If the earlier right is an EUTM application and the Office concludes that it is facing problems or, in the case of a national application, if the applicant submits evidence that the opponent's application is facing problems, the proceedings may be suspended.

The following examples fall into the category of earlier national marks facing problems:

- 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 Multiple oppositions

Article 9(2) EUTMDR
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Except for under exceptional circumstances, such as where one opposition clearly leads to the rejection of the contested mark including all goods and services, the Office will not suspend the other proceedings.

#### 6.3.3.1 After rejection of the EUTM application

When the EUTM application is subsequently rejected because of an ‘active’ opposition, the suspended oppositions are deemed to have been disposed of after the decision becomes final. If the decision has become final, the parties to the other proceedings must be informed, the oppositions that 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 Article 9(4) EUTMDR.

If an appeal has been filed against the decision, the oppositions remain suspended. If 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.

#### 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, which 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 submit the evidence.

#### 6.3.4.2 Resuming the proceedings

In all cases the parties will be informed of the resumption of the proceedings and of any pending time limit if applicable. Any time limit that was pending at the moment of the suspension will be set again with a full two-month time limit with the exception of the cooling-off period, which can never exceed 24 months according to Article 6(1) EUTMDR.

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, or results in some other way in the extinguishment of the right, or transfers the opponent’s

earlier right, the opposition is 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.

#### 6.3.4.3 Calculation of time limits

If the suspension is decided for a definite period of time, the letters must also indicate the date when the proceedings are to be resumed, and what happens after that. When the suspension is requested by both parties because there are ongoing 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 that:

- 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).

## 6.4 Multiple oppositions

Article 9 EUTMDR
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Multiple oppositions are when different oppositions are filed against the same EUTM application.

In the 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, the practice is 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 EUTM application, applied for in respect of 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 EUTM 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 situation, 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 EUTM 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 EUTM 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 several oppositions will be successful against overlapping goods and services, first the decision eliminating most goods and services of the EUTM application (the widest extent of the opposition) should be taken and the remaining oppositions suspended. Once the first decision is final, the opponents in the remaining oppositions must be consulted on whether they wish to maintain or withdraw their oppositions.

Assuming that the oppositions are maintained, the next 'widest' opposition is decided and the same process continues until all of the oppositions are dealt with.

When two oppositions are of the same extent, the general principles apply when taking the decisions.

In the example mentioned above under paragraph 6.4.1, the first decision should either be taken in opposition 3 or in opposition 4. Opposition 1 has no overlapping goods and services and can therefore be taken independently.

Suppose the first decision is taken in opposition 4, and the EUTM application is rejected for Classes 14 and 25. In this case, oppositions 2 and 3 need 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 judgment within the meaning of Article 109(5) EUTMR. 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 EUTM application.

If the opposition is successful and the decision rejects the contested EUTM 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 109(5) EUTMR. 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 EUTM 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 EUTM 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 109(3) EUTMR 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 an EUTM application are ready for a ruling and some are still at different stages of the adversarial phase. In this situation the principles described under 1 and 2 apply in combination. It depends on the outcome of the decisions and on the scope of the pending cases whether a decision may be taken in some oppositions and whether the multiple oppositions must be suspended.

#### 6.4.3 Joinder of proceedings

Article 9(1)EUTMDR
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Article 9(1)EUTMDR 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 EUTM 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, for example a parent and subsidiary company. The oppositions must be at the same procedural stage.

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 joinder must be undone and the oppositions 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 undone 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 20 EUTMR
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A transfer or assignment of an earlier right is a change of ownership of this right. For further information see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer.

The basic principle is that the new owner substitutes the old owner in the proceedings. The Office's practice for dealing with transfers is described in paragraphs 6.5.1.2 (the earlier registration is an EUTM registration), 6.5.1.3 (the earlier registration is a national

registration), 6.5.1.4 (the earlier registrations are a combination of EUTM registrations and national registrations) and 6.5.1.5 (transfer of a contested EUTM 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 is 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 situations can arise. Whereas for earlier EUTM 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.

#### 6.5.1.2 Transfer of earlier EUTM

Article 20(11) and (12) EUTMR
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Concerning earlier EUTMs or EUTM applications, according to Article 20(11) EUTMR, 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 EUTM (application). 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 EUTM only

When an opposition is based on one earlier EUTM only and this EUTM 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 EUTM on which the opposition is based has been transferred and it must submit 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 EUTM on which the opposition is based

In cases of a partial transfer one part of the earlier EUTM remains with the original owner and another part is transferred to a new owner. The same principles apply to partial transfers as to the transfer of only one of a number of EUTM registrations on which the opposition is based, as described in the paragraph immediately below.

### Opposition based on more than one earlier EUTM

When an opposition is based on more than one earlier EUTM and all these marks are/have been transferred to the same new owner during the opposition proceedings, the situation is the same as for an opposition based on a single EUTM, as described above.

The situation is, however, different when only one of the earlier EUTMs is/has been transferred. In this case the new owner may also become an opponent, with the result that there are two opponents. 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, that is to say, 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.

If one of the joint 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.

#### 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 or any other evidence showing the agreement of the parties to the transfer/change of ownership.

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 the 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 a time limit within which to provide evidence of the transfer.

As there are different national practices, it is not always obligatory to submit a copy of the request to register the transfer with the national office. Nevertheless, in those Member States where there 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.

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 any more, the opposition has become unfounded, as the opponent is no longer the owner of the earlier right. The old 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.

#### 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 to transfers of only one of a number of national registrations on which the opposition is based, as 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 situation is the same as for the transfer of a single mark upon which an opposition is based, as described above.

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 an opponent, with the result that there are two opponents. 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, that is to say, 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.

If one of the joint 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.

#### 6.5.1.4 Opposition based on a combination of EUTM registrations and national registrations

When an opposition is based on one or more EUTM registrations **and** one or more national registrations at the same time and one of these marks is/has been transferred to the same new owner during the opposition proceedings, the principles set out above apply *mutatis mutandis*.

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 when the original time limit has expired.

#### 6.5.1.5 Transfer of the contested EUTM application

When during opposition proceedings the contested EUTM application is/has been transferred, the opposition follows the application, that is to say, the opponent is informed of the transfer and the proceedings continue between the new owner of the EUTM application and the opponent.

#### 6.5.1.6 Partial transfer of a contested EUTM application

##### Article 14(2) EUTMIR

When there has been a partial transfer of a (contested) EUTM 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 EUTM application is created, the opposition examiner also has to create a new opposition file against the new EUTM application, since it is not possible to deal with one opposition against two separate EUTM applications.

However, this is only the case when some of the originally contested goods and services are maintained in the 'old' EUTM application and some in the newly created EUTM application. For example: Opponent X opposes all the goods of EUTM application Y, applied for in Class 12 for *apparatus for locomotion by land and air*, and for *clothing and footwear* in Class 25. EUTM application Y is partially transferred, and split into old EUTM application Y for *apparatus for locomotion by land and clothing*, and new EUTM application Y for *apparatus for locomotion by air*, and *footwear*.

##### Articles 20 and 27 EUTMR

Since there was only one opposition fee to be paid when the opponent filed its opposition, a second fee for the new opposition created after the split of the EUTM application is not required because, at the time of filing, the opposition was only directed against one EUTM application.

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 applicant become the same person or entity, 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 119 EUTMR
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When there is a change of representative during opposition proceedings, the other party will have to be informed by sending it a copy of the letter and of the authorisation (if submitted).

For detailed information please refer to the Guidelines, Part A, General Rules, Section 5, Professional Representation.

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

Article 106 EUTMR Article 72 EUTMDR
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Article 106 EUTMR deals with interruption of proceedings. Paragraph 1 distinguishes three situations:

Opposition proceedings before the Office will be interrupted:

1. when the EUTM **applicant** has died or is under legal guardianship;
2. when the EUTM **applicant** is subject to bankruptcy or any similar proceedings;
3. when **the representative of an applicant** has died or is otherwise prevented from representing the applicant. For further information see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

Article 106 EUTMR 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 where the opponent is the applicant/proprietor of an earlier EUTM application/EUTM). The uncertainty of the legal status of an opponent or its representative will 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 the event 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)

Article 106(1)(b) EUTMR  
Article 72(3) EUTMDR

Article 106(1)(b) EUTMR applies from the point in time from which the party to the proceedings is no longer entitled to dispose of the procedure, i.e. to dispose of its assets, until the point in time a liquidator or trustee is appointed who will then continue to represent the party under the 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 that 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 the aim of resuming the proceedings. This is because, although the bankrupt applicant is not allowed to undertake binding legal acts, generally it still receives correspondence, or, if not, the correspondence 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 submitted, 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.

Time limits 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 submit 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 will 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.

Article 106(1)(c) and 119(2) EUTMR
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In the case referred to in Article 106(1)(c) EUTMR, the proceedings must be interrupted and will be resumed when the Office is informed of the appointment of a new representative of the EUTM 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 119(2) EUTMR because the applicant has neither its domicile nor its seat in the EEA, the Office will contact the applicant and inform it that the EUTM application will be refused if it does not appoint a representative within a specified time limit.
2. If appointment of a representative is **not** compulsory under Article 119(2) EUTMR, 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.