

# European Union Trade Mark Opposition Procedure



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## Introduction

The European Union trade mark (“EUTM”) opposition procedure is a process that enables third parties to prevent EUTM applications from achieving registration in certain circumstances.

The opposition is commenced by filing a Notice of Opposition at the European Union Intellectual Property Office/EUIPO (“Office”).

As EUTMs no longer cover the UK, it is important to consider whether a comparable UK right has been created and whether separate UK opposition proceedings are necessary.

Lewis Silkin has offices in both the UK and Ireland so Brexit does not affect our continuing ability to represent clients in respect of their EUTM applications, disputes or in EU litigation.

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## Who can bring an opposition?

Any natural or legal person may become an Opponent by filing a Notice of Opposition against an EUTM application. Unlike the UK, opposition can only be based on the Opponent’s “Earlier Rights”, namely:

- a) its earlier trade mark application or registration
- b) common law rights protectable by passing off
- c) other earlier intellectual property rights such as copyright

Earlier Rights can prevent registration of a subsequent third party EUTM application which conflicts with those Earlier Rights. A conflict may occur where the mark applied for as an EUTM is identical or similar to the Earlier Rights and where the EUTM covers identical and/or similar goods or services to those protected by the Earlier Rights.

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## What is the deadline to file the opposition?

Once an EUTM application has been filed it is then examined by the Office. If it is acceptable it is then published in the European Union Trade Marks Bulletin. Once advertised, third parties have three months from the date of publication to oppose the application by filing a Notice of Opposition at the Office. If an opposition is filed and is successful then the application will be refused. If no Notice of Opposition is filed, or if any such opposition is overcome, then the application will proceed to registration. The three month deadline to oppose is non-extendible.

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## What is the language of the Proceedings?

When an EUTM application is filed, two languages must be nominated. When an opposition is filed it must be in one of the nominated languages. Where neither language is English for example, then this naturally adds to the cost of dealing with an opposition because of the translation requirements.

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## What happens once the Notice of Opposition has been filed?

Once the Notice of Opposition is received at the Office and given an opposition number it then conducts an admissibility check. This involves checking that all the formalities have been complied with and the official opposition fee of €320 has been filed. Once the application has been accepted a copy of the Notice of Opposition is sent to the EUTM Applicant, or their representative, if applicable. The Office will also write to the Opponent and Applicant providing them with the timetable of procedural deadlines and initiates the “cooling-off” period.

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## What is the “cooling-off” period?

The “cooling-off” period is intended to give the parties time to negotiate and settle the matter amicably without the need to proceed to the adversarial stage of the opposition. Although the “cooling-off” period initially lasts for two months, it is extendible for a further 22 months, provided that both parties jointly agree to the extension. Either party may at any point unilaterally opt-out of the “cooling-off” period without notice to the other party and proceed with the adversarial part of the opposition. If an agreement is reached, in the cooling-off period, neither party will be ordered to pay costs.

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## What happens if the Applicant withdraws or restricts the scope of the application during the cooling-off period?

If the Applicant restricts the scope of the goods or services of the application so that they do not conflict with the Earlier Rights or withdraws the application altogether, then the opposition is terminated and the opposition fee will be refunded to the Opponent. There will be no award of costs.

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## What happens at the end of the “Cooling-Off” period?

If the “cooling-off” period ends without the dispute having been settled then the adversarial



part of the proceedings commence. The Opponent is given two months within which to submit further facts, observations and evidence to substantiate the opposition. The Applicant is then given two months in which to file observations in response.

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### What is Proof of Use and what evidence can be submitted?

The Applicant may challenge the opposition on the basis that there is no conflict between the trade marks. Where the Earlier Right has been registered for more than five years prior to the date of the publication of the application, one can request that the Opponent furnishes proof that the trade mark has been used in relation to the relevant goods and services. If the Opponent fails to provide sufficient evidence, or fails to show genuine reasons for non-use, then the opposition may be rejected in full or in part.

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### The opposition is only directed at some of the goods and services, can it proceed to registration for the unaffected goods and services?

If the opposition is only brought against part of the goods and services, then the Applicant may, provided that there is no overlap, divide the application into two separate trade mark applications. The part that has not been opposed will proceed to registration (upon payment of the appropriate fee), whilst the other goods and services remain subject to the opposition.

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### When does the Office reach its decision?

The Office may request that either party provide further evidence in support of their arguments. If the Office believes that both parties have provided enough evidence they will inform the parties that the Opposition Division will make

a decision on the basis of the information provided.

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### Conversion of the European Union Trade Mark application into national rights

If the opposition is successful and the application fails, then the Applicant has the option to convert the EUTM application into national applications in the member states except in the territories where an Earlier Right is held. For example, if the successful opposition is based on the Opponent's Earlier Rights in three member states, (i.e. France, Germany and Italy) the Office will not allow conversion in these territories.

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### Can a decision be appealed?

A party may appeal the decision within two months of receiving the decision by filing a notice of appeal and paying the official appeal fee of €800.

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### What are the costs of proceedings?

The losing party will bear all costs of the opposition. The costs awarded do not relate to the professional cost actually incurred by the successful party but are awarded on a scale which is unlikely to exceed €650, if there has been a successful appeal then costs can rise to around €1,650. The Office may decide on an apportionment of costs if the party has succeeded on some grounds of the opposition.

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### How does the owner of Earlier Rights find out if someone has filed for a conflicting trade mark?

The most effective way to monitor for conflicting trade marks is to set up an automated watch service. We routinely arrange these for clients and notify them of any conflicting trade marks that have been accepted for publication. We also provide our opinion on the chances of success and the likely costs and time scales involved.

#### For further information on this subject please contact:

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