

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

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

Part C

Opposition

Section 1

Opposition proceedings

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1 Introduction — General Outline of Opposition Proceedings

Opposition proceedings start upon receipt of the notice of opposition, of which the applicant is informed and which can be accessed in the electronic file accessible on the Office's website.

Once the notice of opposition is received, the Office checks that the corresponding opposition fee has been paid. If the fee has not been paid, the opposition is deemed not to have been filed.

Next, the Office verifies the admissibility of the opposition. There are two kinds of admissibility deficiencies.

1. **Absolute deficiencies:** 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:** 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 2 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. The admissibility of the opposition will be determined only once the opposition period is over.

After the examination of admissibility of the opposition, a notification is sent to both parties to set the time limits for the proceedings. These start with a period during which the parties are encouraged 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 2 months from the notification of admissibility. It can be extended once by 22 months and can last up to a total of 24 months. The notice of opposition and other documents received are sent together with the notification to the applicant.

Once the cooling-off period has expired, the adversarial part of the proceedings begins. The opponent is then allowed 2 more months to submit all evidence and observations it considers necessary to make its case. After these 2 months have lapsed, and once the submitted evidence and observations (if any) have been forwarded, the applicant has 2 months to reply to the opposition.

At this stage, the applicant can file a request for proof of use, requiring the opponent to prove that any earlier marks registered for more than 5 years have been used. If such a request is filed, 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 2 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 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. The Guidelines, Part M, International Marks, cover the specific details of oppositions related to international registrations.

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-19-1 of the Executive Director of the Office of 18/01/2019 on communication by electronic means

The notice of opposition has to be received by the Office in written form within the opposition period, namely within 3 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 will be issued for the opponent. A notice of opposition may also be filed by fax or post, and in both of these cases the opponent will also be sent a receipt after the notice of opposition has been keyed into the Office's IT system.

2.1.1 Early oppositions against an international registration

Article 196(2) EUTMR

Article 77(3) EUTMDR

An opposition against an international registration designating the EU (IR) may be filed within a period of 3 months starting 1 month after the date of first republication. For example, if first republication is on 15/04/2016, then the opposition period starts on 15/05/2016 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 3 months starting 6 months after the date of first republication. For example, if first republication is on 22/03/2016, then the opposition period starts on 22/09/2016 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 3-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-17-7 of the Executive Director of the Office of 18/09/2017 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges](#)

If the opponent or its representative holds 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.

Failure to indicate or to correctly indicate 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 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 when the holder of a current account who wishes to exclude 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 the explicit authorisation of the holder of the current account that its account can be debited for that 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 convinces the Office that the loss of rights was incorrect and proves that the payment was made on time, a notification has to be sent, with a copy to the applicant; the applicant will also be sent the evidence submitted by the opponent.

If an opposition is deemed not to have been entered, the opponent has the right to request a formal decision within 2 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 has not been paid until after the opposition period, see paragraph 6.4.1 below.

2.3 Languages and translation of the notice of opposition

Article 146(5), Article 146(6)(a) and Article 146(7) EUTMR

Article 5(3) and (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 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 European 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 it is a language of the Office, or into the second language. The translation must be produced **within 1 month from the expiry of the 3-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 it is a language of the Office, or into the second language. The translation must be produced **within the 3-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. If it is not filed in a language of the Office, the 1-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 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 European 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 in a language that cannot be the language of the proceedings, all textual elements are in the wrong language and a language has been chosen that cannot be the language of the proceedings, the above principles apply: where the incorrect language chosen is a language of the Office, the opponent has 1 month to file a translation on its own motion; where the incorrect language chosen is not a language of the Office, the deficiency cannot be remedied after the expiry of the opposition period and the opposition will be deemed inadmissible.

2.3.2 Examples

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

1. 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, since 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 will therefore become the language of the proceedings.
2. 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, since 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 will therefore become the language of the proceedings.
3. 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 1 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 in EN.

2.4 Admissibility check

Articles 2(2) and 5(3) and (5) EUTMDR

Once the opposition period is over, the Office checks the admissibility of any opposition received. 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 that, if they are not submitted within the opposition period, trigger a deficiency notice from the Office, allowing the opponent to remedy the deficiency within a non-extendable time limit of 2 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 the 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 (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. The same applies where the opponent provides evidence by making reference to an online source pursuant to Article 7(3) EUTMDR.

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 notification of the time limits for the opposition proceedings is sent to the parties.

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

2.4.1 Absolute admissibility requirements

Article 2(2)(a) to (c) and Article 5(3) EUTMDR

Article 94(1) EUTMR

Absolute admissibility deficiencies can only be remedied on the opponent's initiative during the 3-month opposition period; otherwise the opposition is inadmissible. The opponent will be invited to submit comments on inadmissibility before the decision on admissibility of the opposition is taken.

2.4.1.1 Identification of the contested EUTM application

Article 2(2)(a) and Article 5(3) EUTMDR

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 that 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 earlier marks or rights

Invoked rights that are not earlier

Articles 8(2) and 46(1) EUTMR

Sometimes an opposition is based on one or more marks or other rights that are not earlier than the EUTM application. Whether at least one of the rights invoked is earlier is established 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 (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 not earlier, or when all the marks invoked 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 2(2)(b)(i) and Article 5(3) EUTMDR

Article 8(1) and Article 8(2)(a) and (b) EUTMR

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 listed here.

- 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.
- An indication of 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, an 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 3-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) EUTMR, the opponent must submit 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 2(2)(b)(i) and Article 5(3) EUTMR

Article 8(5) and Article 8(2)(a) and (b) EUTMR

Under Article 8(5) EUTMR an opposition can be based on a mark with reputation, which can be an earlier European Union, international, Benelux or national registration, or 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 marks under Article 8(2)(c) EUTMR

Article 2(2)(b)(i) and (ii) and Article 5(3) EUTMR

Article 8(2)(c) EUTMR

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 (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 2(2)(b)(iii) and Article 5(3) EUTMDR

Article 8(3) EUTMR

These are contested EUTM applications 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(s) 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;
- a representation of the earlier mark (in colour if applicable);
- an indication of whether the earlier mark is registered or applied for;
- 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 2(2)(b)(iv) and Article 5(3) EUTMDR

Article 8(4) EUTMR

This category consists of signs that are not registered and used as trade marks and of a great number of different earlier rights, such as rights to a company name, trade name, business sign, ensigns, titles of protected literary/artistic works and the right to a sign under passing off.

The absolute indications are listed here.

- 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 2(2)(b)(v) and Article 5(3) EUTMDR

Article 8(6) EUTMR

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 European 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 2(2)(c) and Article 5(3) EUTMDR

Article 46(3) EUTMR

An opposition without any indication of grounds is inadmissible if this deficiency is not remedied before expiry of the opposition period.

The specification of 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 options in the opposition form is selected or if this can be inferred from the opponent's arguments filed within the opposition period. In both cases, if it is possible to identify the grounds within the opposition period without any doubt, the opposition is admissible.

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.

2.4.2 Relative admissibility requirements

Article 2(2)(d) to (h) and Article 5(5) EUTMDR

Relative deficiencies are those that can be remedied after expiry of the opposition period. The Office invites the opponent to remedy the deficiency within 2 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 Article 5(5) EUTMDR

The dates to be indicated in the notice of opposition include the filing date and, where available, the registration date and 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 notices of opposition based on protected designations of origin or geographical indications, the date of application for registration or, if that date is not available, the date from which protection is granted should be indicated.

These indications can be important for eliminating 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

Article 2(2)(f) and Articles 5(5) and 63(3) EUTMDR

The relative admissibility requirement to submit a representation of the mark under Article 2(2)(f) EUTMDR applies to earlier national or international trade mark applications or registrations invoked under Article 8(1) or 8(5) EUTMR.

If no representation of the mark has been included in the notice of opposition, the opponent will be notified of the deficiency. The Office will also request a clear representation if the one submitted is incomplete or illegible. If the opponent does not

comply within the 2-month time limit given, the opposition based on that earlier right will be rejected as inadmissible.

If the mark is a word mark, the word that makes up the mark must be indicated in the notice of opposition.

If the mark is a figurative, three-dimensional/shape, or other type of mark, a representation of the mark as applied for or registered must be submitted.

If the mark is protected as a mark in colour, the representation must be submitted in colour. Even if no colour representation of such a mark is available in official publications of the competent registration authority because, at the relevant point in time, that authority was not yet publishing marks in colour, a colour representation that corresponds to the colours claimed still has to be submitted. This is because, for the purposes of **indicating** a mark in colour as the basis of an opposition, a colour representation of the mark must be submitted (not necessarily from an official source). On the other hand, **providing evidence** of such a mark (from an official source) is a question of substantiation, which is explained in detail in paragraph 4.2.3.6 below (25/10/2018, T-359/17, ALDI / ALDO (fig.), EU:T:2018:720, § 43-44; 04/06/2019, C-822/18 P, ALDI / ALDO (fig.), EU:C:2019:466, appeal dismissed).

If the notice of opposition or the documents attached to it contain an indication (available in or translated into the language of the proceedings) that the earlier mark is in colour, but are not accompanied by a representation of the mark in colour, the Office will notify this deficiency. If the opponent does not comply within the 2-month time limit given, the opposition based on that earlier right will be rejected as inadmissible.

2.4.2.3 Goods and services

Article 2(2)(g) and Article 5(5) EUTMDR

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 on 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' is accepted as sufficient indication 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 such as '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 if 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 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 for

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 an EUTM, 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(2)(h)(i) EUTMDR

Article 2(1)(b) EUTMIR

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(2)(h)(i) and (iii) EUTMDR

Article 2(1)(b) EUTMIR

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 of these registrations or applications, or by the licensees, 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 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(12) 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.

Oppositions 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 if it is indicated in the notice of opposition that it opposes in its capacity as licensee). However, 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

Articles 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-owners 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 2-month time limit set, the opposition will be rejected as inadmissible.

Acceptable

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

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

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

Not acceptable

Earlier trade marks	1	2	3	4	5
Owners	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.

Earlier trade marks	1	2	3	4	5
Owners	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.

Earlier trade marks	1	2	3	4	5
Owners	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.

Earlier trade marks	1	2	3
Owner	A	A	A
Licensees	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.

Earlier trade marks	1	2	3
Owner	A	A	B
Licensees	B	C	A

Evidence

In cases where the opposition is based on earlier registered marks, the most common way of providing 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 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) EUTMR. 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 Representation.

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 by electronic means, 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 2 months to remedy the 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 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 must 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 when any other indication given 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 the goods and services in the notice of opposition or in the annexes, the Office will, in order to overcome the contradictory information contained in the notice of opposition, assume that the opposition is directed against 'all the goods and services'.

2.4.3.2 Reasoned statement on grounds

Article 2(4) EUTMDR

A 'reasoned statement' means any facts and arguments on which the opposition relies as well as any evidence in support of the opposition.

It is optional when filing an opposition. It may be included in the opposition, but otherwise may be submitted 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 admissibility of the opposition and the commencement of the adversarial part of the procedure

Articles 5 and 7 and Articles 6(1) and 8(2) and (9) EUTMDR

[Decision No EX-19-1 of the Executive Director of the Office of 18/01/2019 on communication by electronic means](#)

The Office notifies the parties when the opposition has been found admissible. That notification constitutes a decision (18/10/2012, C-402/11 P, Redtube, EU:C:2012:649, § 42-53). However, as it is a decision that does not terminate proceedings, it may only be appealed together with the final decision on the case (Article 66(2) EUTMR). Consequently, the Office is bound by this decision and may only revoke it, provided that the requirements of Article 103 EUTMR for the revocation of decisions are met.

By the same notification, the Office informs the parties that the adversarial part of the proceedings is deemed to commence 2 months after receipt of the notification. 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.

In practice, rather than setting separate 2-month time limits (2 months for the cooling-off period, 2 months for completing the opposition, 2 months for replying), the opponent's time limit to complete the opposition will be set at 4 months, while the applicant's time limit to reply to the opposition will be set at 6 months, from the date of the notification. Therefore, opponents should be aware that the time limit for completing the opposition is not 2 months after expiry of the cooling-off period, but 4 months from the date of notification. Likewise, applicants should be aware that the time limit to reply to the notice of opposition is not 2 months after expiry of the opponent's time limit, but

6 months from the date of notification. In any event, the Office indicates in the notification the exact dates to be observed by the parties.

Once the opponent has completed its opposition, any time after notification and before expiry of the 4 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 be forwarded to the applicant with a new time limit of 2 months set for replying to the opposition. This separately set 2-month time limit will run from the date of receipt of the notification of the additional material in order to ensure that the applicant always has a full 2 months to prepare its reply.

It is also important to note that due to different means of communication (e-communication, fax and post) the time limits mentioned in the notification on the commencement of the adversarial part of the proceedings 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 applicant receives the colour representation. In some cases this may require notification by post.

3 Cooling-off Period

3.1 Setting the cooling-off period

Article 6(1) EUTMDR

When the opposition is found admissible, the Office sends a notification to the parties to that effect, also informing them that the adversarial part of the proceedings is deemed to commence 2 months after receipt of the notification.

This 2-month period serves as a so-called 'cooling-off' period before commencement of the adversarial part of the proceedings. During this period, the parties are encouraged to negotiate an agreement in order to settle the opposition amicably. If certain conditions are met, the opposition fee will be refunded (see paragraphs 6.2.1.2 and 6.2.2.1).

3.2 Extension of the cooling-off period

Article 146(5) to (7) and (9) EUTMR

Article 6(1) EUTMDR

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 jointly requesting a suspension for negotiations. Such a suspension may be requested after 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 on the parties' own initiative within 1 month of filing. The Office does not send any communication requesting a translation of the request for extension.
- The request must be filed before expiry of the cooling-off period. Any request filed after 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 differentiated 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 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 2 weeks after the said notification. The adversarial part of the proceedings will commence the day after. The same notification will notify new time limits for substantiation of the opposition and the applicant's reply, which will be 2 and 4 months, respectively, 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 2 months of 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 the earlier rights it invoked, and submit proof of its entitlement to file the opposition.

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 material necessary for completing the file (see expressly Article 8(9), second sentence, EUTMDR). Rather, it will be for the opponent to decide what it wishes to submit.

4.2 Substantiation

Article 46 EUTMR

Article 7 and Article 8(1) EUTMDR

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), and the proof of entitlement to file the opposition.

After the parties have been notified of the admissibility of the opposition, the opponent has 2 months from the end of the cooling-off period to complete its file. In particular, the opponent must prove the existence, validity and scope of protection 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 submitted 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 submitting physical evidence of substantiation, in cases

where evidence concerning the filing or registration of the earlier rights or concerning the contents of the relevant national law is accessible online from a source recognised by the Office, the opponent may 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 asking the Office to access the necessary information for the earlier trade mark from the relevant online official sources. Consequently, as this 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 the opponent's obligation to check that the online sources reflect the most accurate and up-to-date relevant information. Moreover, in the event that the opponent, after such a declaration, still submits physical evidence without formally revoking its previous declaration, and there is a contradiction between the online evidence and the physical evidence, the most recent up-to-date evidence will apply.

A declaration may be introduced by the opposing party at any time before 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

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 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 (15/07/2008, R 1313/2006-G, CARDIVA (fig.) / 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 it becomes available.

4.2.3 Trade mark registrations or applications that are not EUTMs

Article 7(2)(a)(i) and (ii) EUTMDR

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 earlier marks the following documents:

- certificates issued by the competent registration authorities;
- extracts from the official databases of the competent registration authorities; and
- extracts from the official bulletins of the competent registration authorities.

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, whether issued by a national office or by WIPO (if it concerns an international registration), constitutes valid evidence. However, a renewal certificate is not sufficient on its own if it does not contain all the necessary data that determines the scope of protection of the earlier mark. For further requirements relating to evidence of renewal, see paragraph 4.2.3.4 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 submits 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.

Certificates have to be checked carefully since, in some cases, there are only a few differences between an application form and the registration certificate.

4.2.3.2 Extracts from official databases

The Office accepts, as evidence of the filing or registration of **national marks**, extracts from the official online databases of the competent registration authorities of Member States and, as evidence of **international registrations**, extracts from WIPO's Madrid Monitor database. Excerpts from unofficial databases are not acceptable.

Furthermore, the Office accepts, as evidence for **both national marks and international registrations**, extracts obtained through the Office's TMview portal (<https://www.tmdn.org/tmview/welcome>). Extracts generated through TMview reflect the information obtained **directly** from the competent registration authorities and therefore, qualify as documents equivalent to registration certificates from the competent registration authorities within the meaning of Article 7(2)(a) EUTMDR (by analogy, 06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61 and 70).

While the abovementioned database extracts can be obtained and annexed to the opponent's submission, it is more convenient to refer to the relevant online source pursuant to Article 7(3) EUTMDR. Any general reference to any of the abovementioned official online databases is acceptable; a direct link to the online source is not required. For opponents using the Office's opposition e-filing form, a claim to substantiate the

marks by reference to the relevant official online database (through TMview) is set by default.

Opponents must carefully check that the relevant official online database is up to date and contains all the relevant information necessary to prove the validity and scope of protection of the earlier mark invoked in the opposition. When the extract from an official database or the database accessed online does not contain all the information required, the opponent must supplement it with other documents from an official source that show the missing information. Some examples of this situation are shown below.

- 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.
- For figurative marks, database extracts sometimes show the image on a separate page. Consequently, when opponents file an extract as evidence for a figurative mark, they must ensure that the representation of the mark appears on the same page. If it does 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 a 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, no translation would in principle, be necessary. However, as regards the list of goods and/or services, where the extract itself only gives the class headings along with an indication that this reference to 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 (especially the list of goods and services) 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. The Office will invite the opponent to submit evidence of grant of protection of the international registration (where online substantiation was not claimed) only if (i) the applicant contests the protection of the mark in question in a given territory or for certain goods and services or (ii) the Office intends to uphold the opposition on the basis of the international registration (or its particular territorial extension). Failure to provide such evidence will result in the international registration (or its particular territorial extension) being deemed not substantiated.

4.2.3.4 Evidence of renewal

Trade marks are registered for a period of 10 years from the date of filing of the application; registration may be renewed for further 10-year periods (Article 48 of Directive (EU) 2015/2436, as implemented in the respective national legislation).

If the registration is due to expire before the expiry of the time limit for substantiation, the opponent 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 of renewing the mark within the 6-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 then communicated to the applicant (05/05/2015, T-715/13, *Castello (fig.) / Castelló y Juan S.A. (fig.) et al.*, EU:T:2015:256, § 68 et seq.).

If there is no proper evidence of renewal, the opposition based on that earlier right will be rejected as not substantiated.

4.2.3.5 Entitlement to file the opposition

Article 46 EUTMR

Article 2(2)(h)(iii) and Article 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 (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 submitted 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 Articles 25, 26 and 29 EUTMR, the Office registers and publishes licence agreements in respect of European Union trade marks. If the earlier mark basis of an opposition subject to a licence agreement is an EUTM, the opponent does not have to submit any evidence of the licence agreement as long as the licence has been registered and published at the Office in accordance with 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 even where the licence is registered and published at the Office, if this evidence was not attached to the original request submitted in accordance with Article 25(5) EUTMR. For more information on licences, see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDS as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings or Similar Proceedings. 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 the evidence

The Office verifies that the trade mark particulars **claimed** in the notice of opposition are **reflected** in the **evidence** submitted, as an official document originating from the competent registration authority, or in the evidence accessible online from a source recognised by the Office if the opponent relied on that.

The following details of the evidence will be checked ⁽²⁷⁾:

- 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);
- the representation of the sign [531, 540, 541, 546, 554, 556, 557, 571, 591];

If the earlier mark is in colour, the opponent must submit evidence originating from an official source that contains a reproduction of the mark in colour.

If the opponent has indicated in the notice of opposition that the earlier mark is in colour, but submits evidence showing a black and white representation of the mark, the opposition based on that earlier right will be rejected as not substantiated (25/10/2018, T-359/17, ALDI / ALDO (fig.), EU:T:2018:720, § 45; 04/06/2019, C-822/18 P, ALDI / ALDO (fig.), EU:C:2019:466, appeal dismissed; 27/03/2019, T-265/18, Formata (fig.) / Formata (fig.) et al., EU:T:2019:197, § 48-53).

The **only exception** is where a colour representation of the mark is not available in official publications of the competent registration authority because, at the relevant point in time, that authority was not yet publishing marks in colour. This is typically the case where the official online evidence contains a black and white representation of the mark accompanied by a colour claim indicating the colours in words. In such a case, notwithstanding the black and white representation of the mark, it will be accepted as proof of a mark in colour as long as the colour indications (available in or translated into the language of proceedings) correspond to the colours of the mark indicated in the notice of opposition. In the rare situation where the official online evidence contains a black and white representation of the mark accompanied by a colour claim in general terms (such as 'colours claimed') but no indication of the colours in words, this will also be accepted (so long as this claim is available in or translated into the language of proceedings).

The above exception does not cover the situation where what is available in official publications of the relevant registration authority is not a colour representation as such, but a **representation that includes the colours in words and their distribution within the mark** (e.g. using arrows). Such a representation, even if technically black and white, will be considered a 'colour representation', and the opponent is required to provide a translation of the colour indications into the language of proceedings. Indications within the representation regarding the colours and their distribution will not be considered to be part of the representation as such, but as elements that affect the scope of protection of the mark.

If the opponent has provided no indication in the notice of opposition that the earlier mark is in colour, but submits evidence showing a mark in colour, the opposition based on that earlier right will be rejected as not substantiated.

²⁷ The numbers in square brackets stand for standard INID codes (see in paragraph 4.3.1 below).

- 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.).

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

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 either to allege and demonstrate that 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 these rights to be registered for protection, 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 submit evidence of 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 a reference to and the 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 online official publications and national databases will be accepted to the extent that they originate from the government or official body of the Member State concerned, provided they are publicly 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 Article 8(4) 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 that the right in question has been applied for, registered or granted (if the protected designation of origin or protected geographical indication was granted through administrative means other than registration). If these documents do not provide sufficient information regarding the opponent's entitlement to file the opposition, further documents must be submitted.

Furthermore, to prove that it is entitled to prohibit use of a subsequent trade mark under the relevant law, the opponent must provide a reference to and the 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 or protected geographical indications, or the evidence concerning the content of the relevant national law, is accessible from an online source recognised by the Office, the opponent may submit such evidence by making a reference to that source. All official publications and national databases are acceptable to the extent that they originate from the government or official body of the Member State concerned, provided they are publicly accessible and free of charge. In addition, references to all of the EU official databases online are accepted (e.g. E-Bacchus, E-Spirit-Drinks, DOOR).

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, Other Earlier Rights, Chapter 2, Geographical Indications (Rights under Article 8(6) EUTMR), paragraph 5.

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 registration of that trade mark 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 and Article 8(1) and (7) EUTMDR

The Office sets the opponent a time limit of **2 months**, 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 the opponent has **not provided any evidence** by the time of expiry of the substantiation time limit, or 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 what 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 has failed to submit **any evidence at all**, the opposition will be rejected. It must be deemed that no evidence has been submitted 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 the last sentence of Article 7(4) EUTMDR.

The evidence submitted is '**manifestly irrelevant**' if, by its nature, it cannot serve to establish the validity and existence of the earlier right invoked (for example, if it proves the existence of an earlier right that 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 submitted 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) EUTMDR, 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

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 can exercise any discretionary power and, **second**, if so, how to exercise it, that is, whether to admit or reject such late facts or evidence.

4.2.6.1 Whether discretionary power can be exercised

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 manifestly insufficient evidence, since the content required is precisely and exhaustively established by the regulations.

The Office will find that the late fact or evidence relates to the same legal requirement as 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 will be resumed only if the opponent requests continuation of proceedings in accordance with Article 105 EUTMR or *restitutio in integrum* in accordance with Article 104 EUTMR.

For further information on continuation of proceedings, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits; and for further information on *restitutio in integrum*, see the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*.

4.2.6.2 Whether 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 for why they are being 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 permit this conclusion, argues against the admission of late evidence. Also, the fact that the requirements to be proven are circumscribed in detail in the law or that the Office has explicitly drawn the opponent's attention to those requirements argues against admitting late evidence.

The natural difficulties involved in obtaining the evidence are not, as such, a valid reason for its belated submission.

4.2.6.3 Treatment of late evidence in proceedings

Facts or evidence received after the set time limit will be forwarded to the other party for information purposes without any indication of whether it has been accepted or refused, and 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 accepting late facts or evidence and the applicant has not yet had the opportunity to comment on them.

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 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

Articles 7(4) and (5) and 8(1) EUTMDR

Article 25(1) EUTMIR

On the basis of Article 24 EUTMIR, a distinction should be made between 1) evidence of filing, registration or renewal certificates or equivalent documents, and 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, and 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 for the evidence of substantiation to be translated 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 into that language’.

Article 25(1) EUTMIR requires the translation to reproduce the structure and contents of the original document. For translations of online evidence of substantiation, 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 provides 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 of Article 25(1) EUTMIR do not imply that the opponent has discretion to decide not to translate the elements required by the Regulation, specifically those listed in Article 7(2) EUTMDR as required for substantiating the earlier rights. Where the Regulation establishes that an element must be proven, as is the case for existence, validity, scope of protection of earlier rights and entitlement to file the opposition, and these particular 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. The opponent is not required to submit an explanation of the codes.

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

When the evidence from an official source contains a representation of the earlier mark in colour accompanied by colour indications, a translation of the colour indications into the language of proceedings is not compulsory.

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.

If the translation does not reproduce the structure and content of the online database evidence relied upon pursuant to Article 7(3) EUTMDR, the opponent will be requested,

pursuant to Article 97(1)(b)-(c) EUTMR, to submit a physical copy of the original database extract or an appropriate explanation of the discrepancy (such as that the structure of the database has changed in the meantime). 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 other than filing, registration or renewal certificates or equivalent documents, or 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 other than filing, registration or renewal certificates or equivalent documents, and provisions of applicable national law. Such evidence encompasses, for example, evidence of reputation (Article 8(5) EUTMR) and evidence of use of more than mere local significance (Article 8(4) EUTMR).

If the evidence is submitted in an EU language that is not the language of the proceedings, the Office may, pursuant to Article 24 EUTMR, and either 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. This language regime mirrors the one applicable to proof of use; hence, rules regarding the translation of proof of use apply equally to the abovementioned evidence for substantiation (see paragraph 5.6 below).

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

The Office may consider facts and arguments filed by the opponent in support of the opposition only 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 only a partial translation has been submitted within the time limit set, parts of written submissions that have not been translated into the language of proceedings will, pursuant to Article 7(5) EUTMDR, not be taken into account.

Articles 7(4) and (5) and 8(1) EUTMDR

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 1 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 20/07/2017. If it does file 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 expires 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 those translations as valid observations filed in the language of the proceedings within the set time limit.

Article 25(2) EUTMR

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 supporting documents other than observations

Article 24 and Article 25(2) EUTMIR

All evidence, with the exception of the evidence that the opponent must submit 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 is 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 filed late or not at all 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 verbal 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 Change of language during opposition proceedings

Article 146(8) EUTMR

Article 3 EUTMDR

According to Article 146(5) EUTMR the opposition should be filed in one of the languages of the Office. However, Article 146(8) EUTMR provides 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.

If the parties agree to change the procedural language, they are required, pursuant to Article 3 EUTMDR, 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.

According to Article 3 EUTMDR, when the opponent and the applicant agree to change the language of the proceedings before the start of the adversarial part of the proceedings, 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 a time limit during which the translation must be submitted, which will be 1 month from expiry of the cooling-off period. Where the translation is not filed or is 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 a contested application, it must do so by way of a separate document, that is to say in a separate submission or in a separate annex of a submission. Requests merged into observations would not be looked for and will not be accepted, even if included under a separate section, paragraph or header and even if they appear on the first or last page of the observations.

The same applies to requests for proof of use of an earlier mark pursuant to Article 47(2) or (3) EUTMR; these are only 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.

The Office has made available, to that effect, specific 'e-action' options in the User Area of the Office's website. When a withdrawal or restriction of a contested application or a request for proof of use is submitted by selecting the relevant e-action option, the automatically generated submission will be considered equivalent to a request made by way of a separate document, without any further statement being necessary.

A request, even if spotted, will be refused if it is not submitted 'separately' as defined above. The refusal will confirm the reason for the rejection and will be an interim decision appealable together with the decision on the substance.

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 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

Sometimes one of the parties requests the Office to keep certain documents confidential, even vis-à-vis 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 them confidential vis-à-vis 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 vis-à-vis 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 64(2) EUTMDR

Decision No EX-13-4 of the President of the Office of 26/11/2013 concerning the keeping of files

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, the party concerned must, pursuant to Article 64(2) EUTMDR, 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. Article 146(9) EUTMR, Articles 7(5) and 10(6) EUTMDR and Article 24 EUTMIR 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 what 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 5 years after their receipt in accordance with Article 115 EUTMR and Decision No EX-13-4 of the President of the Office of 26/11/2013 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 8(2), (4), (6) and (9) EUTMDR

Article 24 and Article 25(2) EUTMIR

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 occur when the case deals with complex issues or when the opponent raises a new point and it is admitted to the proceedings. In this case, the applicant must be

given a possibility of replying. The Office may exercise its discretion in deciding whether 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).

4.6 Observations by third parties

Article 45 EUTMR

[Communication No 2/09](#) of the President of the Office of 09/11/2009

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 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 (30/11/2004, R 735/2000-2, Serie A (fig.) / LEGA PALLAVOLO 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 EUTMR, and proceedings will remain suspended until a final decision has been taken. Where the third-party observations are received within the 3-month opposition period, the Office will first 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 no provision for such refund is made in the regulations (see Article 6(5) EUTMDR).

5 Procedure related to the request for proof of use

5.1 Admissibility of the request for proof of use

According to Article 47(2) EUTMR, use of the earlier mark needs to be shown only if the applicant requests proof of use. The institution of proof of use is, therefore, designed in opposition proceedings as a **defence plea of the applicant**.

The Office may neither inform the applicant that it could request proof of use nor invite it to do so. In view of the Office's impartial status in opposition proceedings, it is left to the parties to provide the factual basis and to argue and defend their respective positions (see second sentence of Article 95(1) EUTMR). It follows that the applicant may also limit its request for proof of use to one or some of the earlier marks relied on (even if all would be subject to the genuine use requirement), or to only some of the goods or services on which the opposition is based. In such a case, the Office will require the opponent to prove genuine use of its mark within the limited scope requested by the applicant.

Article 47(2) EUTMR is not applicable when the opponent, on its own motion, submits material relating to use of the earlier mark invoked (for example, for the purposes of proving enhanced distinctiveness under Article 8(1) EUTMR, well-known character under Article 8(2)(c) EUTMR, or reputation under Article 8(5) EUTMR). As long as the EUTM applicant does not request proof of use, the issue of genuine use will not be addressed by the Office *ex officio*. In such cases, in principle, it is even irrelevant that the evidence produced by the opponent might demonstrate only a particular type or manner of use, or use that is limited to only part of the goods or services for which the earlier mark is registered.

5.1.1 Time of request

Pursuant to Article 10(1) EUTMDR, the request for proof of use pursuant to Article 47(2) or (3) EUTMR will be admissible only if the applicant submits such a request within the period specified by the Office. The request for proof of use must be made within the first time limit for the applicant to reply to the opposition under Article 10(2) EUTMDR.

If the request for proof of use is submitted during the cooling-off period or during the 2-month period given to the opponent for filing or amending facts, evidence and arguments, it is forwarded to the opponent without delay.

5.1.2 Earlier mark registered for not less than 5 years (mark outside the 'grace period')

The obligation of use is not applicable immediately after registration of the earlier mark. Instead, the owner of a registered mark has a 'grace period' of 5 years, during which it is not necessary to demonstrate use of the mark in order to rely upon it — including in opposition proceedings before the Office. During the 'grace period', the mere formal registration gives the mark full protection. However, once this period lapses, the proprietor may be required to prove genuine use of the earlier mark.

In accordance with Article 47(2) EUTMR, the obligation to provide proof of use requires that the earlier registered mark has, at the date of filing or the date of priority ⁽²⁸⁾ of the EUTM application, been registered for not less than 5 years.

For oppositions filed against international registrations designating the EU, the opponent's mark is under use obligation if on the date of registration (INID code 151) or on the date of priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891) ⁽²⁹⁾, it has been registered for not less than 5 years.

5.1.2.1 Earlier EUTMs

The decisive date for establishing whether a trade mark has been registered for not less than 5 years at the relevant date is, according to Article 18 and Article 47(2) EUTMR, the registration date of the earlier EUTM. If 5 years or more have elapsed between the registration date of the earlier EUTM and the relevant date, the applicant (or in the case of a contested IR, the holder) is entitled to request proof of use.

5.1.2.2 Earlier national marks

For national marks, it is necessary to determine the date that is equivalent to the registration date for EUTMs. In interpreting this term, it should be taken into account that some national trade mark systems have an opposition procedure **after** registration.

In view of these differing national proceedings, Article 16(1) of Directive (EU) 2015/2436 refers, as concerns the use requirement for national marks, to the period of 'five years following the date of the completion of the registration procedure'.

The 'date of completion of the registration procedure' that serves for calculating the starting point of the 5-year period for the obligation of use for national and international registrations (Article 47(2) and (3) EUTMR) is determined by each Member State according to its own procedural rules (14/06/2007, C-246/05, *Le Chef de Cuisine*, EU:C:2007:340, § 26-28).

In general, the 'completion of the registration procedure' occurs when the trade mark is entered in the register. Pursuant to Article 16(2) of Directive (EU) 2015/2436, where a

²⁸ For oppositions filed before 23/03/2016, the relevant date is the date of publication.

²⁹ For oppositions filed before 23/03/2016, the relevant date is the date of first publication of the contested IR or its subsequent designation in the EUTM Bulletin.

Member State provides for opposition proceedings **following registration** ⁽³⁰⁾, the relevant 5-year period must be calculated from the date when the mark can no longer be opposed or, in the event that an opposition has been lodged, from the date when a decision terminating the opposition proceedings becomes final or the opposition is withdrawn. However, Article 16(4) of Directive (EU) 2015/2436 provides that the date of commencement of the relevant 5-year period must be entered in the register.

5.1.2.3 Earlier international registrations designating a Member State

Under Article 5(2)(a) and (b) of the Madrid Protocol, the Designated Offices have a period of 12 or 18 months from the date of notification of the designation to issue provisional refusals.

Where the Member State has not been designated in the international application but in a subsequent designation, the 12 or 18 months start from the date the subsequent designation was notified to the Designated Offices.

Member States that use the **12-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia.

Member States that have opted for the **18-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden and the United Kingdom.

The applicable deadline (12 or 18 months) for Bulgaria, Italy, Cyprus, Poland and Slovakia when acting as a designated party depends on whether (i) such country was designated or subsequently designated before or after 01/09/2008 and (ii) the Office of origin is bound by both the Agreement and the Protocol (deadline: 12 months) or only the Protocol (deadline: 18 months).

See overview table below:

³⁰ Germany, Austria, Finland, Sweden, and in the case of marks registered via the 'accelerated procedure', in the Benelux.

Designated country ⁽³¹⁾	Country of origin	Deadline to issue a refusal
<i>Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia</i> (Contracting EU parties bound by both the Agreement and the Protocol)	<i>All contracting parties</i> [Status 01/08/2019: 105 members] ⁽³²⁾ (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	12 months
<i>Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden, United Kingdom</i> (Contracting EU parties bound by the Protocol only)	<i>All contracting parties</i> [Status 01/08/2019: 105 members] (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	18 months
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated before 01/09/2008 ⁽³³⁾</i> (Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline)	<i>All contracting parties</i> [Status 01/08/2019: 105 members] (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	18 months
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated on or after 01/09/2008</i> (Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline)	<i>Contracting parties bound by both the Agreement and the Protocol</i> [Status 01/08/2019: 55 members]	12 months
	<i>Contracting parties bound by the Protocol only</i> [Status 01/08/2019: 50 members]	18 months

The Office will, on its own motion, apply the 12-month or 18-month deadline according to the above rules. Deadlines are calculated by adding the relevant periods to the date of notification from which the time limit to notify the refusal starts, indicated by INID

³¹ Malta is not part of the Madrid System.

³² For the full list of all Member States to the Madrid Agreement and to the Madrid Protocol see: http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

³³ The date of entry into force of Article 9sexies(1)(b) of the Protocol, which rendered inoperative any declaration under Article 5(2)(b) or (c) of the Protocol (extension of the time limit for notifying a provisional refusal) between Contracting Parties bound by both the Agreement and the Protocol.

code 580 on the Madrid Monitor extract (i.e. not the date of international registration or subsequent designation) (Rule 18(1)(a)(iii) and Rule 18(2)(a) of the Common Regulations).

Only when it is decisive for determining whether the earlier mark is subject to the proof of use obligation is it for the opponent to claim a date that is later (e.g. when a provisional refusal has been lifted after these dates or if the designated country opted for a period even longer than 18 months for notifying a refusal based on an opposition pursuant to Article 5(2)(c) of the Protocol) and for the applicant or holder to claim a date that is earlier than these dates (e.g. when a Statement of Grant of Protection has been issued before these dates) and to provide the Office with conclusive documentation thereof.

In particular, the Court confirmed, in relation to an earlier international registration designating Germany, that the date on which an earlier international registration was deemed to have been 'registered' had to be established in accordance with the German law giving effect to the earlier right, and not by reference to the date of registration with the International Bureau of WIPO. Under German trade mark law, if protection for an internationally registered trade mark is provisionally refused but subsequently granted, the registration is regarded as having taken place on the date of receipt by the International Bureau of WIPO of the final notification that protection has been granted. Proper application of Article 47(2) and (3) EUTMR and of Article 4(1) of the Madrid Agreement cannot lead to a breach of the principle of non-discrimination (16/09/2010, C-559/08 P, Atoz, EU:C:2010:529, § 44, 53-56).

However, Article 16(3) of Directive (EU) 2015/2436 provides that, for international registrations having effect in a Member State, the relevant 5-year period must be calculated from the date when the mark can no longer be rejected or opposed. Where an opposition has been lodged or when an objection on absolute or relative grounds has been notified, the period must be calculated from the date when a decision terminating the opposition proceedings or a ruling on absolute or relative grounds for refusal becomes final or the opposition is withdrawn.

5.1.2.4 Earlier international registrations designating the European Union

For international registrations designating the European Union, Article 203 EUTMR provides that:

For the purposes of applying Article 18(1), Article 47(2), Article 58(1)(a) and Article 64(2), the date of publication pursuant to Article 190(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the Union shall be put to genuine use in the Union.

As from that publication, the international registration has the same effects as a registered EUTM pursuant to Article 189(2) EUTMR.

5.1.2.5 Summary of calculation of the grace period

Earlier mark	Calculation of the beginning of the 5-year period (grace period)
EUTM	Date of registration.
National mark	The date of completion of the registration procedure, as defined in national law and published in the register.
IR designating Member States	By default, 12 or 18 months after the date of notification from which the time limit to notify the refusal starts (INID code 580). Can be earlier or later if proven by parties.
IR designating the EU	Date of the second republication of the EU designation in part M.3. of the Bulletin.

5.1.3 Request must be unconditional, explicit and unambiguous

The applicant's request is a formal declaration with important procedural consequences.

Pursuant to Article 10(1) EUTMDR, the request has to be **unconditional**. Phrases such as 'if the opponent does not limit its goods/services in Classes 'X' or 'Y', we demand proof of use', 'if the Office does not reject the opposition because of lack of likelihood of confusion, we request proof of use' or 'if considered appropriate by the Office, the opponent is invited to file proof of use of its trade mark' contain conditional or auxiliary claims and, therefore, are not valid requests for proof of use (26/05/2010, R 1333/2008-4, RFID SOLUTIONS (fig.) / rfid (fig.)).

Moreover, the request has to be **explicit and unambiguous**. In general, the request for proof of use must be expressed in positive wording. As use or non-use can be an issue in manifold constellations (for example, to invoke or deny a higher degree of distinctiveness of the earlier mark), mere observations or remarks by the applicant in respect of the (lack of) use of the opponent's mark are not sufficiently explicit and do not constitute a valid request for proof of genuine use (16/03/2005, T-112/03, Flexi Air, EU:T:2005:102).

Examples

Sufficiently explicit and unambiguous request:

- 'I request the opponent to submit proof of use ...';
- 'I invite the Office to set a time limit for the opponent to prove use ...';
- 'Use of the earlier mark is hereby contested ...';
- 'Use of the earlier mark is disputed in accordance with Article 47 EUTMR.';

- ‘The applicant raises the objection of non-use.’ (05/08/2010, R 1347/2009-1, CONT@XT / CONTEXTA).

Not sufficiently explicit and unambiguous request:

- ‘The opponent has used its mark only for ...’;
- ‘The opponent has not used its mark for ...’;
- ‘There is no evidence that the opponent has ever used its mark ...’;
- ‘[T]he opponents’ earlier registrations cannot be “validly asserted against the [EUTM] application...”, since “...no information or evidence of use ... has been provided...” (22/09/2008, B 1 120 973).

Not only the request, but also the scope of the request, has to be explicit and unambiguous. The Office will accept the request only for goods and services listed literally in the specification of the earlier mark and on which the opposition is based. The following are examples where the scope of the request is not explicit and unambiguous:

- ‘I request that the opponent prove genuine use of the earlier mark for the goods applied for in the contested mark’ — the applicant cannot request that the opponent prove use of the applicant’s own goods (see, for example, 24/09/2008, R 1947/2007-4, HOKAMP / HOLTKAMP, § 20);
- ‘I request that the opponent prove genuine use of the earlier mark for goods that are identical or similar to the goods applied for’ — the scope of the request cannot be defined by reference to the applicant’s goods and cannot be subject to interpretation;
- ‘I request that the opponent prove genuine use for *trousers* and *shirts*’ — where the goods of the earlier mark are *clothing, footwear and headgear*. The scope of an explicit request cannot be subject to interpretation. Neither the Office nor the opponent is required to determine whether an item is covered by a broader category of the specification of the earlier mark. Furthermore, the opponent cannot be required to prove use of a specific item within a category because he may prove genuine use for that category by other items included therein (see, for example, 24/09/2008; R 1947/2007-4, HOKAMP / HOLTKAMP, § 23; 07/07/2009, R 1294/2008-4, ORDACTIN / Orthangin, § 16; 08/10/2010, R 1316/2009-4, miha bodytec / bodytec, § 18).

The Office will refuse a request for proof of use whose scope is not explicit and unambiguous.

5.1.4 Request made in a separate document

Pursuant to Article 10(2) EUTMDR, the request for proof of use must be submitted in a separate document. For more information, see paragraph 4.4.1 above.

5.1.5 Applicant’s interest to deal with proof of use first

Under Article 10(5) EUTMDR a request for proof of use may be submitted at the same time as observations. The applicant may limit its first observations to requesting proof

of use. It must then reply to the opposition in its second observations, namely when it is given the opportunity to reply to the proof of use submitted. It may also do this if only one earlier right is subject to the use requirement, as the applicant should not be obliged to split its observations.

If, however, the request is completely invalid, the Office will close proceedings without granting the applicant a further opportunity to submit observations (see paragraph 5.1.6).

5.1.6 Reaction if request is invalid

If the request is invalid on any of the above grounds or if the requirements of Article 47(2) and (3) EUTMR are not met, the Office nevertheless forwards the applicant's request to the opponent but advises both parties of the invalidity of the request.

The Office will immediately terminate the proceedings if the request is completely invalid and not accompanied by any observations by the applicant. However, the Office can extend the time limit established in Article 8(2) EUTMDR if such an invalid request was received before expiry of the time limit set for the applicant but was not dealt with by the Office until after expiry thereof. Because refusal of the request for proof of use after expiry of the time limit will disproportionately harm the interests of the applicant, the Office extends the time limit by the number of days that were left when the party submitted its request. This practice is based on the rules of fair administration.

If the request is only invalid as regards part of the earlier rights on which the opposition is based, the Office expressly limits the invitation to the opponent to submit proof of use to the rights that are subject to the use requirement.

5.2 Express invitation by the Office

If the applicant's request for proof of use is valid, the Office gives the opponent two months to submit proof of use or show that there are proper reasons for non-use. Taking a decision on use in the absence of an explicit invitation by the Office to submit proof of use constitutes a substantive procedural violation, even if the applicant's request is clear, and the opponent understands it and submits the requested evidence of use (28/02/2011, R 16/2010-4, COLORPLUS, § 20; 19/09/2000, R 733/1999-1, AFFINITÉ / AFFINAGE).

In cases where the request for proof of use arrives during the cooling-off period and is communicated to the opponent during that period, the deadline for submitting proof of use will coincide with the deadline for providing initial or additional facts, evidence and arguments. The time limit will be extended automatically if the cooling-off period is extended.

If the request reaches the Office before the end of the period for submitting or amending facts, evidence and arguments, and is dealt with in this period, the deadline

for submitting such facts, evidence and arguments will be extended to coincide with the deadline of 2 months for submitting proof of use.

5.3 Reaction from the opponent: providing proof of use

5.3.1 Time limit for providing proof of use

The Office gives the opponent 2 months to submit proof of use. The opponent may request an extension of the deadline in accordance with Article 68 EUTMDR. The common practice on extensions is applicable to these requests (see paragraph 7.2.1 above).

Article 10(2) EUTMDR expressly states that the Office will reject the opposition if the opposing party does not provide proof of use before the time limit expires.

Three scenarios are to be differentiated.

- Any evidence that has been submitted by the opponent at any time during the proceedings before the expiry of the time limit for providing proof of use, even before the applicant's request for proof of use, has to be automatically taken into account when assessing proof of use.
- The opponent has not submitted **any or any relevant indication or evidence** within the time limit: the submission of relevant indications or evidence of proof of use for the first time after the expiry of the time limit results in rejection of the opposition **without the Office having any discretionary powers**. Article 10(2) EUTMDR is an essentially procedural provision and it is apparent from the wording of that provision that when no proof of use of the mark concerned is submitted within the time limit set by the Office, the opposition must automatically be rejected.
- The opponent has submitted **relevant indications or evidence** within the time limit and presents **additional indications or evidence** after the time limit has expired. The Office may take into account the evidence submitted out of time by **exercising the discretion** conferred on it by Article 95(2) EUTMR.

In that context, it must be assessed **first**, whether the Office may exercise discretion, and, if so, **second**, how to exercise its discretion, that is, whether to admit or reject such late facts or evidence.

According to Article 10(7) EUTMDR, the Office must exercise its discretion if the late indications or evidence merely supplement, strengthen and clarify the prior relevant evidence submitted within the time limit with the purpose of proving the same legal requirement laid down in Article 10(3) EUTMDR, namely, place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which opposition is based. It follows that the Office may not exercise any discretion if the late evidence intends to prove a legal requirement for which no initial evidence at all had been submitted. For example, if no indications or evidence related to the place of use were submitted at all within the relevant time limit, any evidence submitted in this respect after the time limit must be discarded.

When exercising its discretion, 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.

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 indications 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 justification for why they are 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 the admission of late evidence.

The natural difficulties in obtaining the evidence are not, as such, a valid reason for its belated submission.

The Office will duly provide reasons for why it rejects or takes into account 'additional evidence' in the decision.

5.3.2 Means of evidence

5.3.2.1 Principles

The evidence of use must be provided in a structured manner.

Article 95(1) EUTMR provides that '... in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties ...' The filing of evidence must be sufficiently clear and precise to enable the other party to exercise its right of defence and the Office to perform its examination, without reference to extraneous or supportive information.

Essentially, the Office is prevented from making the case for one or other party and cannot take the place of the opponent, or its counsel, by itself trying to locate and identify among the documents on file the information that it might regard as supporting proof of use. This means that the Office should not seek to improve the presentation of any party's evidence.

Responsibility for putting evidence in order rests with the party. Article 10(4) EUTMDR provides that the evidence of use must be submitted in accordance with Article 55 EUTMDR, which defines the basic structure and format of written evidence. This provision means that the submission must clearly identify the evidence and arguments raised by the parties and thus assure expeditious proceedings.

For further information on the format and structure requirements for annexes to communications, refer to the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.3.

In addition, the Office recommends that the following be taken into account as key aspects of a structured presentation:

1. the corresponding **file number** (EUTM, Opposition, Cancellation and Appeal) should be included at the top of all correspondence;
2. the Office strongly recommends that the opponent does not exceed a maximum of 110 pages in its correspondence;
3. if the documentation is sent in different packages, an indication of the number of packages is recommended;
4. if a large amount of documentation is submitted by fax in different batches, an indication of the total number of pages, number of batches and identification of the pages contained in each batch is recommended;
5. plain DIN-A4 sheets should be used in preference to other formats or devices for all the documents submitted, including separators between annexes or enclosures, as they can also be scanned;
6. physical specimens, containers, packaging, etc. should not be sent but, instead, a picture should be taken of them, which should be printed (if relevant in colour, otherwise in black and white) and sent as a document;
7. original documents or items sent to the Office should not be stapled, bound or placed in folders;
8. the second copy for forwarding to the other party should be clearly identified;
9. if the original is submitted to the Office only by fax, no second fax copy should be sent;
10. the front page should clearly indicate whether the correspondence submitted contains colour elements of relevance to the file;
11. a second set of colour elements should be included for sending to the other party.

These recommendations together with the requirements for written evidence set in Article 55(2) EUTMDR are sent to the opponent together with the Office's communication of the applicant's request for proof of use.

According to Article 10(4) EUTMDR, the evidence is to be submitted in accordance with Article 55(2) and Articles 63 and 64 EUTMDR and, in principle, is confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR. Article 10(4) EUTMDR also allows market surveys and quotations of the mark in lists and publications of associations of the relevant profession as suitable means of evidence (14/03/2011, B 1 582 579; 18/06/2010, B 1 316 134).

Price lists and catalogues are examples of 'material stemming directly from the party itself'. A company's annual report and accounts would also come under that heading.

Article 10(4) EUTMDR is to be read in conjunction with Article 64 EUTMDR. This means that annexes to communications may be submitted on data carriers in accordance with technical specifications determined by the Executive Director. Nevertheless, material that cannot be scanned or photocopied (such as CDs, physical items) cannot be taken into account unless submitted in two copies so that one can be forwarded to the other party.

The requirement of proof of use always raises the question of the **probative value** of the submitted material. The evidence must at least have a certain degree of reliability. As a general rule, the Office considers material produced by third parties as being of a higher probative value than material produced by the owner itself or by its representative. Reference by the opponent to internal printouts or hypothetical surveys or orders is particularly problematic. However, where material must regularly be produced for use by the public and/or authorities according to statutory rules, for instance, company law and/or stock exchange regulations, and where it may be assumed that such material is subject to certain official verification, its probative value is certainly higher than ordinary 'personal' material produced by the opponent (see also paragraph 5.3.2.3, 'Declarations', below).

5.3.2.2 References

The opponent may avail itself of findings of national offices and courts in parallel proceedings. Although the Office is not bound by findings of the national offices and courts, such decisions must be taken into account and may influence the Office's decision. It is important for the Office to have the possibility of considering the kind of evidence that led to the relevant decision at national level. The Office takes into account the different procedural and substantive requirements that may exist before the respective national body (25/08/2003, R 1132/2000-4, VANETTA / VIENNETTA (fig.), § 16; 18/10/2000, R 550/1999-3, (DUKE) (fig.) / DUKE, § 23).

The opponent may wish to refer to material submitted as proof of use in previous proceedings before the Office (confirmed by the General Court in 'ELS' quoted above). The Office accepts such references on condition that the opponent clearly identifies the material referred to and the proceedings in which it was submitted. If the reference does not sufficiently identify the relevant material, the Office requires the opponent to clearly specify the material referred to or to file it (30/11/2010, B 1 080 300). For further details on the conditions for identifying relevant material, see paragraph 4.4.5 above.

The onus of providing proof of use is on the opponent and not on the Office or the applicant. Therefore, a mere indication of the website where the Office can find further information is insufficient, as this does not provide the Office with sufficient indications about place, nature, time and extent of use (31/10/2001, B 260 192).

5.3.2.3 Declarations

Whereas the means of evidence listed, such as packages, labels, price lists, catalogues, invoices, photographs and newspaper advertisements, do not present any particular problems, it is necessary to consider in some detail declarations as referred to in Article 97(1)(f) EUTMR.

The opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. It is up to the opposing party to select the form of evidence that it considers suitable for the purpose of establishing that the earlier trade

mark was put to genuine use during the relevant period (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 37).

The role of the affidavit is to give facts or an explanation of the supporting documents, not to give a legal opinion (06/11/2014, T-463/12, MB, EU:T:2014:935, § 56).

Distinction between admissibility and relevance (probative value)

The importance of declarations has been much debated. In this regard, there must be a clear differentiation between the admissibility and the probative value of such evidence.

As far as **admissibility** is concerned, Article 10(4) EUTMDR expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1) EUTMR cites means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. Therefore, it has to be evaluated whether the statement submitted constitutes a statement within the sense of Article 97(1)(f) EUTMR. Only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 40; confirmed 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 49). Where there are doubts as to whether a statement has been sworn or affirmed, it is up to the opponent to submit evidence in this regard. Failing this, the statement will not be considered a statement within the sense of Article 97(1)(f) EUTMR.

Article 97(1)(f) EUTMR does not specify by whom these statements should be signed, so there is no reason to consider that statements signed by the parties to the proceedings themselves are not covered by this provision (16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 46).

The EUTMR, the EUTMDR and the EUTMIR do not support the conclusion that the evidential value of items of evidence of use of the mark, including affirmations, must be assessed in the light of the national law of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33; 09/12/2014, T-278/12 PROFLEX, EU:T:2014:1045, § 53). The probative value of a statement depends first and foremost on the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42).

As far as the **probative value** of this kind of evidence is concerned, the Office, following the established case-law, makes a distinction between statements coming from the sphere of the opponent themselves or their employees and statements drawn up by an independent source (09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 51; 06/11/2014, T-463/12, MB, EU:T:2014:935, § 54).

Declarations by the proprietor or its employees

Statements coming from the sphere of the owner of the earlier mark (drawn up by the interested parties themselves or their employees) are generally given less weight than

independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter (11/01/2011, R 490/2010-4, BOTODERM / BOTOX, § 34; 27/10/2009, B 1 086 240 and 31/08/2010, B 1 568 610).

Such a statement cannot in itself sufficiently prove genuine use (09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 54). However, this does not mean that such statements are totally devoid of all probative value (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 30). Generalisation should be avoided, since the exact value of such statements always depends on their concrete form and content. Statements including detailed and concrete information have a higher probative value than very general and abstractly drafted statements.

The final outcome depends on the overall assessment of the evidence in each individual case. In general, further material is necessary for establishing evidence of use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources. Therefore, the probative strength of the further material submitted is very important. An assessment should be made of whether the content of the affidavit is sufficiently supported by the further material (or vice versa). The fact that the national office concerned may adopt a certain practice in assessing such kind of evidence of use does not mean that it is applicable in proceedings concerning European Union trade marks (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 41 et seq.).

A change of ownership after the filing or priority date of the EUTM application may render declarations made by the new owners void as the latter generally do not have any direct knowledge to form a basis for making declarations concerning use of the mark by the previous owner (17/06/2004, R 16/2004-1, REPORTER / REPORTER).

Nevertheless, in the case of a transfer or other succession in title, any new owner may rely on use by their predecessor(s) within the grace period concerned. Use made by the predecessor may be evidenced by the predecessor and by all other reliable means, for instance, information from business records if the predecessor is not available.

Declarations by third parties

Statements (such as e.g. surveys) drawn up **by an independent source**, for example by experts, professional organisations, Chambers of Commerce, suppliers, customers or business partners of the opponent, are given more probative weight (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (fig.), § 31).

This practice is in line with the case-law of the Court of Justice in the *Chiemsee* judgment (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230), where the Court gave some indications of appropriate evidence for proving the acquired distinctiveness of a mark in the market place. Although acquisition of distinctiveness is not per se the same as genuine use, the former does comprise elements of evidence of use of a sign on the market. Consequently, case-law relating to these can be used by analogy.

Statements drawn up by the parties themselves are not 'third-party evidence' whereas all other evidence, such as opinion polls, statements from Chambers of Commerce, or from professional organisations or from experts, does originate from third parties.

5.4 Reaction from the applicant

5.4.1 Forwarding of evidence

After having received the evidence of use submitted by the opponent, the Office forwards the complete evidence to the applicant.

The Office, in general, allows the applicant 2 months to file its observations in reply to the evidence of use (and to the opposition).

5.4.2 No evidence or no relevant evidence submitted

However, the Office may close the proceedings immediately if, within the time limit given, the opponent has submitted **no evidence, or the evidence is manifestly of no relevance**, and all the earlier rights of the opposition are affected. The rationale behind this practice is to avoid the continuation of proceedings when their outcome is already known, that is, the opposition is to be rejected for lack of proof of use (principle of economy and good administration of proceedings).

In all other cases the evidence is forwarded to the applicant, which is given 2 months to file its observations. The Office must not indicate to the opponent that the sufficiency of the evidence is doubtful, or even invite the opponent to file further evidence in such cases. Such acts would be against the impartial position of the Office in adversarial proceedings (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.) § 19).

5.4.3 No reaction from applicant

If the applicant does not react within the time limit, the Office will give a decision on the basis of the evidence before it. The fact that the applicant does not reply does not mean that it accepts the submitted evidence as sufficient proof of use (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 79).

5.4.4 Formal withdrawal of the request

Where the applicant reacts to the proof of use by formally withdrawing its request for proof of use, the issue will no longer be relevant. As it is the applicant who sets in motion the respective procedure, the applicant logically is in a position to bring an end to this part of the proceedings by formally withdrawing its request (21/04/2004, R 174/2003-2, SONNENGARTEN / SOMMERGARTEN, § 23).

5.5 Further reaction from the opponent

The opponent is entitled to file observations in reply to the applicant's observations. This is of particular importance in cases where the decision to be taken might be based in part on the arguments put forward by the applicant to the effect that the evidence does not prove the use of the mark.

The Board of Appeal has regarded failure to allow the opponent to comment in such a case as a substantial procedural violation (28/02/2011, R 16/2010-4, COLORPLUS, § 20).

For further details on the submission of additional evidence, see paragraph 5.3.1 above.

5.6 Languages in proof of use proceedings

According to Article 10(6) EUTMDR, where the evidence submitted pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office **may** require the opponent to submit a translation of that evidence in that language, within a period specified by the Office.

It is left to the discretion of the Office whether the opponent has to submit a translation of the evidence of use into the language of the proceedings. In exercising its discretion, the Office balances the interests of both parties.

It has to be borne in mind that it might be extremely costly and burdensome for the opponent to translate the evidence of use submitted into the language of the proceedings.

On the other hand, the applicant has the right to be informed about the content of the evidence submitted in order to be capable of defending its interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use submitted by the opponent. In this regard, the nature of the documents submitted has to be taken into account. For example, it might be considered that 'standard' invoices and samples of packaging do not require a translation in order to be understood by the applicant (15/12/2010, T-132/09, Epcos, EU:T:2010:518, § 51 et seq.; 30/04/2008, R 1630/2006-2, DIACOR / DIACOL PORTUGAL, § 46 et seq. (appealed 24/01/2017, T-258/08, DIACOR / DIACOL, EU:T:2017:22); 15/09/2008, R 1404/2007-2 & R 1463/2007-2, FAY (fig) / FAY & CO, § 26 et seq.).

If the applicant explicitly requests a translation of the evidence in the language of the proceedings and provides reasons for its request (see Article 10(5) EUTMDR in conjunction with Article 24 EUTMIR), the Office, in principle, will require a translation from the opponent. 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 abusive.

Where the Office requires translation of the evidence, it gives the opponent a period of 2 months to submit it. Where the evidence of use submitted by the opponent is voluminous, the Office may explicitly invite the opponent to translate only the parts of the submitted material that the opponent regards as sufficient for establishing genuine use of the mark within the relevant period. It is in general up to the opponent to evaluate whether a complete translation of all the evidence submitted is necessary. The evidence will only be taken into account insofar as a translation has been produced or insofar as it is self-explanatory regardless of its textual components.

If the opponent submits evidence of use in a language other than the language of the proceedings within the time limit established for submitting proof of use and then on its own initiative submits a translation of this evidence into the language of the proceedings after the expiry of that time limit, this evidence will be taken into account and forwarded to the applicant for its observations. This applies even if the Office has not required the opponent to file a translation and even if the applicant has not yet contested the evidence.

6 Termination of Proceedings

6.1 Friendly settlement

Article 47(4) EUTMR

Article 6(2) EUTMDR

The parties are free to decide on the measure that brings the opposition proceedings to a conclusion. While they can decide to withdraw 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 the Office 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.

6.2 Restrictions and withdrawals

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

6.2.1 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.

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

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, with the parties being informed that it will not be taken into account.

The Office does not accept conditional restrictions. For example, the applicant argues in its observations in reply to the opposition that the signs are dissimilar but 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.

If the restriction is not acceptable, even if only in part, the Office will invite the applicant to remedy the deficiency. If the applicant remedies the deficiency, the restriction will be recorded with the effective date of the initial request. If the applicant does not remedy the deficiency, the restriction will be refused in its entirety and the proceedings will continue on the basis of the original list of goods and services (Guidelines, Part B, Examination, Section 3, Classification, paragraph 5.3.3). The opponent will be informed about the above steps.

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, 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, paragraphs 5.1 and 5.2.

6.2.1.1 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 regarding admissibility of the opposition has been issued, the opposition proceedings are closed and the opposition fee is refunded. In other words, dealing with the withdrawal or restriction in such cases takes priority over the admissibility of the opposition.

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 regarding admissibility or 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.

6.2.1.2 Restrictions and withdrawals of EUTM applications before the end of the cooling-off period

Restriction covers the whole extent of the opposition/withdrawal

When 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 for assessing whether the opposition proceedings have been closed during the cooling-off period is the date when 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.

6.2.1.3 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 are 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 6.5.3 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 6.2.2.2 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 6.5.3 below.

6.2.1.4 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 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.

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 could be enforced by the winning party unless a different agreement is reached. 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, paragraph 5.1 and Part E, Register Operations, Section 2, Conversion, paragraph 4.3.

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.

The **withdrawal of any pending appeal** (before the Boards of Appeal, the General Court or the Court of Justice) means that the **contested decision becomes final**. Consequently, the contested EUTM application may no longer be withdrawn thereafter.

6.2.1.5 Language

Article 146(6)(a) EUTMR

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.

6.2.2 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, with the parties being informed that it will not be taken into account.

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 6.2.1 above.

6.2.2.1 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 in the event of a withdrawal of the opposition following a restriction of the EUTM application during the cooling-off period (see paragraph 6.2.1.2 above), the Office neither refunds the opposition fee nor takes a decision on costs.

6.2.2.2 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 6.5.3 below.

6.2.2.3 Withdrawal of the opposition after a decision has been taken

Following the decision of the Grand Board of Appeal of 27/09/2006 in 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.

The Office will take note of the withdrawal and close the case. Confirmation of the withdrawal is sent to the parties, without any decision on costs being 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 opposition, and the application proceeds to registration.

The **withdrawal of any pending appeal** (before the Boards of Appeal, the General Court or the Court of Justice) means that the **contested decision becomes final**. Consequently, the opposition may no longer be withdrawn thereafter.

For further information on withdrawals during appeal proceedings, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.

6.2.2.4 Language

Article 146(9) EUTMR

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 1 month from the date of submission of the original document. Otherwise, the withdrawal will be refused.

6.2.3 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.

6.3 Decision on substance

The decision on substance is taken only once the parties have submitted all that is required, and should deal only with those issues or earlier rights that are relevant for the outcome.

There are two exceptions, which are when:

- the earlier right is not proven;
- the earlier right has ceased to exist.

6.3.1 Earlier right not proven

Article 8(1) EUTMDR

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 have been proven, the proceedings will continue normally, and the non-substantiated rights will not be taken into account in the final decision on substance.

6.3.2 Earlier right has ceased to exist

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. This is because the requirement to refuse registration of a trade mark if any of the grounds of opposition applies is worded in the present tense in Article 8 EUTMR, which requires the presence of a conflict at the time

when the decision is taken. The reason why the earlier right ceases to have effect does not matter.

Invalidation of any earlier right other than an EUTM cannot be detected by the Office. However, if one of the parties informs the Office of such invalidation, the other party must be heard, and it may be that 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 applies 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 submit evidence of the final outcome of the national proceedings. If the opponent submits 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.

6.4 Fee refund

6.4.1 Opposition deemed not entered

Articles 46(3) and 181(1) EUTMR

Article 5(1) EUTMDR

If an opposition is deemed as not entered because of late or insufficient payment (see paragraph 2.2.2 above), the opposition fee, including any surcharge, must be refunded to the opponent.

6.4.1.1 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.

6.4.1.2 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.

6.4.2 Refund in view of withdrawals/restrictions of EUTM application

6.4.2.1 EUTM application withdrawn/restricted before end of cooling-off period

Article 6(2), (3), (4) and (5) EUTMDR

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.

6.4.2.2 Opposition withdrawn due to restriction of EUTM application within cooling-off period

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

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 so, against which of the remaining goods and services) or whether 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.

6.4.3 Multiple oppositions and refund of 50 % of opposition fee

Article 9(4) EUTMDR

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, as illustrated in the following example.

- One of the opposition proceedings was terminated by the rejection of the contested EUTM application in parallel opposition proceedings. For example, 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.
- 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.

6.4.4 Cases where the opposition fee is not refunded

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

Article 6(3), (4) and (5) EUTMDR

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.

6.4.4.2 Opponent's withdrawal is earlier

Article 6(3) and (5) EUTMDR

When the opposition is withdrawn before the applicant restricts its application, the fee is not refunded. Additionally, if the applicant withdraws its application following (e.g. as a reaction to) the withdrawal of the opposition, the fee is not refunded.

The same applies when the applicant restricts the application following a partial withdrawal of the opposition.

6.4.4.3 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.

6.4.4.4 Termination of proceedings for other reasons

Articles 7 and 45 and Article 92(2) EUTMR

Articles 5 and 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), or
- Article 119(2) EUTMR (representation for non-EEA applicants),

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

6.5 Decision on the apportionment of costs

6.5.1 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 both 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.

6.5.2 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.

6.5.2.1 Agreement on costs

Article 109(6) EUTMR

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 its 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.

6.5.2.2 Information from potential 'successful party'

When the party that would be entitled to be awarded costs according to the general rules described in paragraph 6.5.3 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 therefore have to be checked carefully before issuing a decision.

However, any such request sent by the losing party to the Office will simply be forwarded to the other party, and the decision on costs will be taken *ex officio* under normal rules.

6.5.3 Standard cases of decisions on costs

Article 109 EUTMR

The general rule is that the losing party or the party that terminates the proceedings, whether 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 (28/04/2004, T-124/02 & T-156/02, Vitatoste, 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.

6.5.4 Cases that did not proceed to judgment

6.5.4.1 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 109(5) 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 opposition decision 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.

6.5.4.2 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 *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.

6.5.4.3 Cases of joinder

Article 9 EUTMR

For further information on joinder, see paragraph 7.4.3, 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.

6.5.4.4 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.

6.6 Fixing of costs

Article 109(1), (2), (7) and (8) EUTMR
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Article 18 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), except where the parties are ordered to bear their own costs.

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.

6.6.1 Amounts to be fixed

The costs to be borne comprise (i) the opposition fee and (ii) the costs essential to the proceedings, as referred to in Article 109(1) EUTMR. They are always fixed in euros, regardless of the currency in which the party had to pay its representative.

The opposition fee is EUR 320 (as laid down in the Annex to the EUTMR).

The costs essential to the proceedings include the costs of representation, travel and subsistence. In the absence of an oral hearing, only the costs of representation are relevant.

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.

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.

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

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.

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

6.6.3 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 which case the party concerned must also comply with the applicable requirements):

- admissibility
- evidence.

6.6.3.1 Admissibility

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 up to 2 months after that date.

6.6.3.2 Evidence

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 or not 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.

6.6.4 Review of fixing of costs

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 1 month of 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 (16/12/2004, R 503/2001-4, BIOLACT / BIO).

7 Other Procedural Issues

7.1 Correction of mistakes

Articles 49(2) and 102(1) EUTMR

7.1.1 Correction of mistakes in the notice of opposition

There are no special provisions in the Regulations regarding the 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 considers 'obvious error' in relation to Article 49(2) EUTMR and Article 102(1) EUTMR to be understood as meaning mistakes that 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.

7.1.2 Correction of mistakes and errors in publications

Article 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 6.4.1.2 above).

7.2 Time limits

Article 101 and Article 146(9) EUTMR

Articles 63 and 68 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.

7.2.1 Extension of time limits in opposition proceedings

7.2.1.1 Non-extendable and extendable time limits

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

- the 3-month opposition period to file an opposition (Article 46(1) EUTMR);
- the 3-month time limit to pay the opposition fee (Article 46(3) EUTMR);
- the 1-month time limit to pay the surcharge when 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 141(3) EUTMR);
- the 2-month time limit to remedy deficiencies (Article 5(5) EUTMDR).

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.

7.2.1.2 Conditions of the request

Note that 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.

The request for extension has to fulfil the following conditions:

- the time limit must be extendable;
- the extension has to be requested by the party concerned;
- the request has to be signed (if submitted by electronic means, the indication of the name of the sender is deemed to be equivalent to its signature);
- the request must be received by the Office at the latest on the date of expiry of the time limit;
- 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 1 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. 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 2 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.

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.

This does not preclude the requesting party from obtaining the other party's written consent to the request. However, **consent** provided by the other party does not divest the Office of its **power of discretion** as to whether to allow such extension. In any event, the consent given by the other party will be duly considered by the Office in the exercise of its discretion.

For the consent of the other party to be taken into account, it is not sufficient that the requesting party assures the Office that such consent was given. The other party must express its consent by separate submission or by signing the requesting party's submission. In the latter case, if submitted by electronic means, the indication of the name of the sender is deemed to be equivalent to its signature; however, the signature of the other party must be present in order for the consent to be acceptable.

For more information on extensions of time limits, consult the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

7.2.1.3 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 is not dealt with until after expiry of the time limit. Because 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 submitted 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 is filed and received before expiry of the time limit, the party concerned will be granted at least 1 day, even if the request for extension arrived on the last day of this time limit.

7.3 Suspension

Article 71 and Article 9(2) EUTMDR

The Office can suspend opposition proceedings either *ex officio* or at the request of either one or both parties.

7.3.1 Suspension requested by both parties

According to Article 71(2) EUTMDR, if both parties request the suspension of the proceedings after expiry of the cooling-off period, the suspension will be granted, without any need for the request to be justified. In this case, and regardless of the period requested by the parties, the first suspension will be granted for a period of 6 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 the same period of time in full. 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.

Upon a joint request by the parties, the suspension will be extended, without any need for the request to be justified.

However, the maximum duration of this suspension of the proceedings is limited to **2 years**, as set out in Article 71(2) EUTMDR — a duration that is to be understood as 2 years cumulative over the course of the proceedings.

Such joint requests for the extension of a suspension will be granted for further 6-month periods (regardless of the period requested by the parties, but with the possibility of opting out) or for the remaining time if less than 6 months remain out of the total maximum of 2 years. A joint request for suspension will be rejected as inadmissible if the parties have used up the total maximum of 2 years.

7.3.2 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, for example where:

- the opposition is based on an application for registration of a trade mark (including conversion);
- the opposition is based on an application for registration of 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 a contested application that require the mark to be republished;
- a transfer is pending on earlier EUTMs/EUTM applications or contested EUTM applications;
- a deficiency has been raised in connection with the restriction of a contested application;
- a deficiency has been raised in connection with professional representation.

It should be noted that there is no obligation in any of the abovementioned cases to suspend the proceedings. The Office will decide whether suspension is appropriate under the circumstances of each case. Therefore, the decision is at the Office's discretion. If requested by one of the parties, the request must be duly justified. Ongoing negotiations between the parties do not constitute an appropriate justification for a suspension requested by only one of the parties.

The proceedings will normally be suspended until the completion of the proceedings that led to the suspension. The limitation as to the total duration of suspension set out in Article 71(2) EUTMDR does not apply.

7.3.2.1 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 submit 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.

7.3.2.2 Earlier EUTM applications or registrations

In this case, 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.

7.3.2.3 Earlier national/international marks (applications or registrations/rights)

In this case, the issue of suspension will have to be raised by the parties (normally the applicant) and evidence will have to be submitted 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 concerned 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 party raises the question of suspension, then the general principle applies and the Office only has to decide on 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 of the status of its earlier application or registration.

7.3.2.4 Examples

Here are some examples where, according to the general practice indicated above, the situation apparently does not require the proceedings to be suspended but they can be 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. 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.

7.3.3 Multiple oppositions

Article 9(2) EUTMDR

Except 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.

7.3.3.1 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 the Board of Appeal reverses the decision, the other proceedings will be resumed immediately, without having to wait for that decision to become final.

7.3.4 Procedural aspects

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

7.3.4.1 Monitoring suspended files

In cases where the proceedings are suspended for an indefinite period, the Office will monitor the opposition every 6 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 6 months, in which the parties may also be requested to submit the evidence.

7.3.4.2 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 re-set in full, 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 a decision taken in national proceedings invalidates, revokes, or in some other way extinguishes a right, or transfers an 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.

7.3.4.3 Calculation of time limits

If the suspension is decided for a definite period of time, the Office's notification 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 6 months, regardless of the period requested by the parties.

For example, if a request for a 2-month suspension signed by both parties and submitted on 15/01/2017 (5 days before the expiry of the time limit of the opponent for

completing the opposition — 20/01/2017) is dealt with on 30/01/2017, the result will be that:

- the Office has suspended the opposition proceedings at the request of both parties;
- the suspension takes effect as from 15/01/2017 (the date when the suspension request was received at the Office) and will expire on 15/07/2017;
- the proceedings will be resumed on 16/07/2017 (6 months, irrespective of the period requested by the parties), with no further notification from the Office;
- the time limit for the opponent is now 15/09/2017 (two full months for the opponent to complete the file);
- the time limit for the applicant is now 15/11/2017 (two full months after the opponent's time limit).

7.4 Multiple oppositions

Article 9 EUTMDR

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.

Firstly, 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 some of them being suspended 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.

7.4.1 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 means of an appropriate letter insofar as the restriction concerns the goods or services contested by the other oppositions.

However, if there is no connection between the goods or services in the restriction and the contested goods and services, the opponent need 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 affecting opposition 2, deleting *clothing* and *headgear*. The relevant letters should be sent not only in opposition 2, but also in oppositions 3 and 4. As the restriction does not affect the contested goods of opposition 1, no action is necessary in this opposition.

7.4.2 Multiple oppositions and decisions

Once an opposition reaches the decision stage, it is important to take account of any other multiple oppositions pending against the same EUTM application. Before a ruling can be given on an 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.

7.4.2.1 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 the oppositions 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 7.4.1, 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 have 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.

7.4.2.2 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. Once the appeal period has expired and no appeal has been 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 have 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, 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.

7.4.2.3 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.

7.4.3 Joinder of proceedings

Article 9(1) EUTMDR

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 were an economic link between the opponents, for example a parent and subsidiary company. The oppositions must be at the same procedural stage.

When the Office decides to join the oppositions, it should verify 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.

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

7.5.1 Transfer and opposition proceedings

7.5.1.1 Introduction and basic principle

Article 20 EUTMR

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), 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 the simple sale of an earlier mark from A to B, a company C being 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.

7.5.1.2 Transfer of earlier EUTM

Article 20(11) and (12) EUTMR

For earlier EUTMs or EUTM applications, Article 20(11) EUTMR provides that, 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 receipt 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 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 both opponents and will not invite the new opponent to appoint a new representative. However, the new opponent always has the option of appointing a representative of its 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.

7.5.1.3 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, that is, 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 submit 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 a transfer must be registered in order 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 required to submit evidence of registration of the transfer.

If the new owner does not submit 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 submits 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 both opponents and will not invite the new opponent to appoint a new representative. However, the new opponent always has the option of appointing a representative of its 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.

7.5.1.4 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 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 once the original time limit has expired.

7.5.1.5 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.

7.5.1.6 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).

7.5.2 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.

7.5.3 Change of names

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

7.5.4 Change of representatives

Article 119 EUTMR

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 any authorisation submitted.

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

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

Article 106 EUTMR

Article 72 EUTMDR

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.

7.5.5.1 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.

7.5.5.2 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 has not resigned, 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 is resigning, how the Office proceeds will depend on whether the representative also indicates who will act as trustee or liquidator in the bankruptcy.

- If the representative does indicate a trustee or liquidator, the Office will continue to correspond with that 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 2 months to file those observations.
- If the representative does not give any information regarding 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.

Evidence submitted about the appointment of the liquidator or trustee need not be translated into the language of the proceedings.

Once the Office has been 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, if the proceedings were interrupted ten days before the applicant had to submit observations, a new time limit will start — of 2 months rather than the ten days left at the time of the interruption. For clarification, the letter sent by the Office informing the parties about the resumption will fix a new time limit.

7.5.5.3 Death or legal incapacity of the applicant's representative

Article 106(1)(c) and Article 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 3 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.

- 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.
- 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 once the proceedings are resumed.