

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

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

### ***Part C***

### ***Opposition***

### ***Section 0***

### ***Introduction***

**Table of Contents**

**1 Overview of Opposition Proceedings — the Difference Between ‘Absolute Grounds’ and ‘Relative Grounds’ for Refusal of an EUTM Application..... 756**

**2 The Grounds for Opposition..... 756**

**3 The ‘Earlier Rights’ upon which an Opposition must be Based..... 757**

**4 The Purpose of Opposition Proceedings and the Most Expedient Way to Treat Them..... 759**

**4.1 Examination of the most effective opposition, ground and bases..... 759**

**4.2 No need to examine proof of use..... 760**

**4.3 Restricting the examination to part of the relevant public..... 760**

**4.4 Examining the likelihood of confusion without undertaking a comparison of goods and services..... 761**

**4.5 No need to examine evidence of enhanced distinctiveness..... 761**

## 1 Overview of Opposition Proceedings — the Difference Between ‘Absolute Grounds’ and ‘Relative Grounds’ for Refusal of an EUTM Application

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

When an opposition is filed against an international registration designating the EU, any reference in these Guidelines to EUTM applications must be read to cover international registrations designating the EU. The Guidelines, Part M, International Marks, cover the specific details of oppositions related to international registrations.

Under [Regulation \(EU\) 2017/1001](#) of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, an opposition must be based on rights held by the opponent in an earlier trade mark or other form of trade sign. The grounds on which an opposition may be based are called ‘relative grounds for refusal’, and the relevant provisions are found in [Article 8 EUTMR](#), which bears that title. Unlike absolute grounds for refusal, which are examined *ex officio* by the Office (and which may take into account third parties’ observations although third parties do not become parties to the proceedings), relative grounds for refusal are *inter partes* proceedings based on likely conflict with earlier rights. Such relative grounds objections are not raised *ex officio* by the Office. The onus is therefore on the proprietor of the earlier right to be vigilant concerning the filing of EUTM applications by others that could clash with such earlier rights, and to oppose conflicting marks when necessary.

When an opposition is filed within a prescribed time limit and the relevant fee has been paid, the proceedings are managed by the Office’s specialist service (the Opposition Division). The Opposition Division will first examine the admissibility of the opposition. If the opposition is found admissible, normally an exchange of observations from both the opponent and the applicant (the ‘parties’) will follow. After considering these observations, and if agreement has not been reached between the parties, the Opposition Division will decide (in an appealable ‘decision’) either to reject the contested application totally or in part or to reject the opposition. If the opposition is not well founded, it will be rejected. If the EUTM application is not totally rejected, and provided there are no other oppositions pending, it will proceed to registration for the goods and/or services for which it is not rejected.

## 2 The Grounds for Opposition

The grounds on which an opposition may be made are set out in [Article 8 EUTMR](#).

[Article 8 EUTMR](#) enables the proprietors to base oppositions on their earlier rights to prevent the registration of EUTMs in a range of situations progressing from that of double identity both between goods and/or services and between marks ([Article 8\(1\)](#))

[\(a\) EUTMR](#), where likelihood of confusion is presumed, and need not be proved) to that of identity only in one factor and similarity in the other, or similarity in both ([Article 8\(1\)\(b\) EUTMR](#), where a likelihood of confusion must be established) (see the Guidelines, [Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion](#)).

[Article 8\(3\) EUTMR](#) allows the proprietor of a mark to prevent the unauthorised filing of its mark by its agent or representative (see the Guidelines, [Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor](#)).

[Article 8\(4\) EUTMR](#) enables the proprietor of earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance to prevent registration of a later EUTM application if the proprietor has the right to prohibit the use of the EUTM application. It enables rights holders to invoke a wide variety of rights protected under EU legislation or Member State laws, subject to the conditions of their acquisition and scope of protection under the applicable laws, and further provided that the right invoked also fulfils the EU law condition of use in the course of trade of more than mere local significance [see the Guidelines, [Part C, Opposition, Section 4, Non-registered trade marks and other signs used in the course of trade \(Article 8\(4\) EUTMR\)](#)].

[Article 8\(5\) EUTMR](#) enables the proprietors of an earlier reputed registered trade mark to prevent registration of a later similar or identical EUTM application that, without due cause, would encroach on the earlier reputed mark. Likelihood of confusion is not a condition for the application of this article. This is because [Article 8\(5\) EUTMR](#) specifically (but not exclusively) protects functions and uses of trade marks that fall outside the ambit of the badge of origin protection offered by likelihood of confusion and, as such, is more directed at protecting the heightened effort and financial investment that is involved in creating and promoting trade marks to the extent that they become reputed and to facilitate full exploitation of the value of the marks (see the Guidelines, [Part C, Opposition, Section 5, Trade Marks with Reputation \(Article 8\(5\) EUTMR\)](#)).

[Article 8\(6\) EUTMR](#) enables beneficiaries of the protection of designations of origin and geographical indications under the Union legislation or Member State laws to oppose the registration of a later EUTM application even beyond the limited scope of *ex officio* protection of such rights on absolute grounds ([Article 7\(1\)\(j\) EUTMR](#)). In order to be eligible as a ‘relative’ ground for refusal, the right invoked must vest in its beneficiary a direct right of action against unauthorised use [see the Guidelines, [Part C, Opposition, Section 6, Geographical indications \(Article 8\(6\) EUTMR\)](#)].

### **3 The ‘Earlier Rights’ upon which an Opposition must be Based**

An opposition must be based on at least one earlier right owned by the opponent.

The meaning of ‘earlier’ rights for [Article 8\(1\) and \(5\) EUTMR](#) is defined in [Article 8\(2\) EUTMR](#), meaning such rights having an earlier date (not hour or minute, as confirmed by the Court in its judgment of 22/03/2012, [C-190/10](#), Rizo, EU:C:2012:157) of

application for registration than the EUTM application, including applicable claimed priority dates, or have become well known in a Member State before the EUTM application or, if appropriate, its claimed priority date. See the Guidelines, [Part C, Opposition, Section 1, Opposition Proceedings](#).

In essence, these rights consist of EU registered trade marks and applications for such, and ‘well-known’ marks in the sense of [Article 6bis of the Paris Convention](#) (which need not be registered). For a detailed explanation of these ‘well-known’ marks under [Article 8\(2\)\(c\) EUTMR](#), and how they differ from [Article 8\(5\) EUTMR](#) marks with reputation, see the Guidelines, [Part C, Opposition, Section 5: Trade Marks with Reputation \(Article 8\(5\) EUTMR\), paragraph 2.1.2](#).

Under [Article 8\(3\) EUTMR](#), the opponent must show that it is the proprietor of a trade mark, acquired anywhere in the world by registration or by use (to the extent that the law of the country of origin recognises this kind of trade mark right), for which an agent or representative of the proprietor has applied for registration in its own name without the proprietor’s consent.

[Article 8\(4\) EUTMR](#) is the ground for opposition based on earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance protected under EU legislation or Member State laws that confer on their proprietor the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that it acquired the right invoked, which may be use or registration based, before the application date or, as the case may be, before the priority date of the contested mark, in accordance with the conditions of protection of the applicable law. In addition, the opponent must also prove use of more than mere local significance of such a right before the date of priority of the contested mark.

[Article 8\(6\) EUTMR](#) is the ground for opposition based on designations of origin or geographical indications protected under EU legislation or Member State laws that confer on the person authorised under such laws the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that the designation of origin or geographical indication invoked is earlier than the date of application or, as the case may be, the priority date of the contested mark.

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

The Office’s practice is based on the legal provisions of the EUTMR applied directly or by analogy, as confirmed by the case-law of the General Court (16/09/2004, [T-342/02](#), Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, [T-194/05](#), Telettech International, EU:T:2006:124). Namely:

- **multiple oppositions.** [Article 9\(2\) and \(3\) EUTMDR](#) allows the Office to examine only the ‘most effective’ opposition(s), suspending the rest and eventually deeming them to have been dealt with if the application is rejected on the basis of the chosen opposition. With regard to the ‘most effective’ opposition, see below.
- **multiple earlier rights in one opposition.** The Court has observed that grouping various earlier rights in one opposition is, for practical purposes, the same as presenting multiple oppositions, making it possible for the Office to base the

rejection of the application on the ‘most effective’ right(s). With regard to the ‘most effective’ earlier right, see below.

- **multiple legal grounds in opposition(s).** If the opposition is successful in its entirety on the basis of the ‘most effective’ legal ground(s), it is not necessary to examine the remaining legal grounds. If a necessary requirement of a legal ground is not fulfilled, it is not necessary to examine the remaining requirements of that provision. With regard to the ‘most effective’ legal ground(s), see below.

## 4 The Purpose of Opposition Proceedings and the Most Expedient Way to Treat Them

The Court of Justice has stated that the sole purpose of opposition proceedings is to decide whether the application may proceed to registration and not to pre-emptively settle potential conflicts (e.g. at a national level arising from the possible conversion of the EUTM application) (11/05/2006, [T-194/05](#), Teletch International, EU:T:2006:124, § 25-27).

### 4.1 Examination of the most effective opposition, ground and bases

The Court of Justice has confirmed clearly that the Office is under no obligation to examine all the earlier oppositions, rights and legal grounds invoked against the same EUTM application, if one of them suffices to reject the EUTM application. Nor is it obliged to choose the earlier right with the widest territorial scope so as to prevent the eventual conversion of the application in as many territories as possible (16/09/2004, [T-342/02](#), Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, [T-194/05](#), Teletch International, EU:T:2006:124).

This principle allows for a more expedient treatment of oppositions. The Office is free to choose what it regards as the ‘most effective’ opposition(s), earlier right(s) and legal ground(s) and which one to examine first in light of the principle of procedural economy.

**The ‘most effective’ opposition** can normally be defined as the opposition that allows the Office to refuse the registration of the opposed EUTM application to the broadest possible extent and in the simplest manner.

**The ‘most effective’ earlier right** can normally be defined as the most similar (the closest) sign covering the broadest scope of goods and services and/or the right covering the most similar goods and services.

**The ‘most effective’ legal ground** can normally be defined as the opposition ground that presents the Office with the simplest manner of refusing the registration of the opposed EUTM application to the broadest possible extent.

Generally speaking, if applicable, [Article 8\(1\)\(a\) EUTMR](#) will be the simplest ground in terms of procedural economy on which to reject an EUTM application, since the Office

will not need to enter into an analysis of similarities and differences between the signs or goods/services, nor will a finding of likelihood of confusion be necessary. Failing that, the factual circumstances of each opposition will determine whether [Article 8\(1\)\(b\)](#), [Article 8\(3\)](#), [\(4\)](#), [\(5\)](#) or [\(6\) EUTMR](#) are the next 'most effective' grounds (e.g. if the goods and services of the earlier right and the EUTM application are dissimilar, [Article 8\(1\)\(b\)](#) and [Article 8\(3\) EUTMR](#) cannot serve as a valid basis for opposition).

## 4.2 No need to examine proof of use

If evidence of use has been requested by the applicant in relation to some of the earlier rights, the Office will normally firstly consider if the opposition can be fully upheld on the basis of one or more earlier rights not subject to the requirement to prove use. In such a case, the EUTM application will be rejected without it being necessary to consider proof of use. Only if no such earlier right(s) is (are) available, will the Office consider those earlier rights for which proof of use was requested.

For further examples of where the assessment of the proof of use may be dispensed with, see the Guidelines, [Part C, Opposition, Section 7, Proof of Use, paragraph 10.2](#).

## 4.3 Restricting the examination to part of the relevant public

When an opposition is filed pursuant to [Article 8\(1\)\(b\) EUTMR](#) and a likelihood of confusion can be found on the basis of a (substantial) part of the public, the reasoning of the decision should concentrate on that part of the public that **is most prone to confusion** and the analysis should not extend to all parts. This would apply in particular in the following situations.

- Where there is likelihood of confusion in a specific linguistic area, the Office's analysis need not extend to the whole EU but may instead focus on that part (see the Guidelines, [Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 1.3, Relevant territory and relevant public](#)). For example, if the degree of similarity between the marks is higher from the perception of a particular language, the examination of the perception of the marks by the public in other language areas (e.g. examining specific pronunciations or meanings of marks in several languages) is superfluous.
- Where the relevant public consists of both general and professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold an opposition. Usually it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals.

In such circumstances, it should be explained from the beginning of the decision why such a focus has been chosen.

#### 4.4 Examining the likelihood of confusion without undertaking a comparison of goods and services

When the opposition is based on [Article 8\(1\)\(b\) EUTMR](#) and the likelihood of confusion cannot be ruled out on the basis of a ‘dissimilarity of the goods and services’ or ‘dissimilarity of the signs’, the Office could decide, for reasons of procedural economy, to proceed on the basis of the **assumption that all the goods and services at issue are identical** (20/09/2019, [T-367/18](#), UKIO / <IO (fig.), EU:T:2019:645, § 27-28, 31, 63). The comparison of the goods and services may be dispensed with, even in the absence of any identical pair of goods and services, if upon examining all the other relevant factors (such as the degree of similarity of the signs, distinctiveness of the earlier mark, degree of attention of the relevant public and the principle of interdependence) **any likelihood of confusion can be ruled out**.

#### 4.5 No need to examine evidence of enhanced distinctiveness

The Office may decide not to examine the opponent’s claim and evidence of enhanced distinctiveness of the earlier marks, if based on the other relevant factors a **likelihood of confusion can be established** on the basis of the inherent distinctiveness of the marks.

Where appropriate, the Office may decide to proceed on the basis of the **assumption that the earlier marks enjoy enhanced distinctiveness**. The examination of the claim and evidence of enhanced distinctiveness of the earlier marks may be dispensed with if upon examining all the other relevant factors **any likelihood of confusion can be ruled out**.