# 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, the references in the Guidelines to EUTM applications must be read as including international registrations designating the EU, unless indicated otherwise. The Guidelines, Part M, International Marks, cover the specific details of oppositions against international registrations designating the EU.

# 2 Notice of Opposition

## 2.1 Notice of opposition in writing

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| Article 46 EUTMR<br><br>Articles 4 and 63(1)(a) EUTMDR<br><br>Decision No EX-26-03 of the Executive Director of the Office of 1 July 2026 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 in the EUTM bulletin part A.

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

### 2.1.1 Early oppositions against an international registration

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| Article 196(2) EUTMR<br><br>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

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| 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

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| 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 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 EX-25-06 of the Executive Director of the Office of 07/04/2025 on 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

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| Article 99 EUTMR<br><br>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) andArticle 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 in this case) 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 in this case) 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 |
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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 admissibility requirements** are the indications and elements that must be present in the notice of opposition or submitted by the opponent on their own initiative within the opposition period, as laid down in Article 146(5) and (7) EUTMR and Article 2(2)(a) to (c) EUTMDR. If the opponent does not remedy an absolute admissibility deficiency within the opposition period on their own initiative, the opposition will be rejected as inadmissible.

**Relative admissibility requirements** are the indications and elements that, if they are not submitted within the opposition period, trigger a deficiency notice from the Office, as laid down in Article 2(2)(d) to (h) EUTMDR. The notification gives the opponent a non-extendable time limit of 2 months to remedy the deficiency. If the opponent does not remedy a relative admissibility deficiency within the specified time limit, the Office will reject the opposition as inadmissible.

The opponent need not submit a reasoned statement or supporting evidence with the notice of opposition (Article 2(4) EUTMDR), but may do so later, during the adversarial stage of the proceedings (Article 7(1) EUTMDR) (see paragraphs 4.1 and 4.2).

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

Identification elements for absolute and relative admissibility are to be looked for not only in the notice of opposition, but also in its annexes and any other documents submitted within the opposition period. The same applies where the opponent provides evidence by referring to an online source pursuant to Article 7(3) EUTMDR.

As long as the opposition is found to be admissible for one earlier right, the parties will be notified accordingly and the proceedings will continue. The admissibility of any other earlier right will be examined later during the proceedings if necessary (for example, if

the earlier right that has been found admissible is not substantiated, see paragraph 4.2 below, or where the opposition cannot be fully upheld on the basis of that earlier right).

Any decision to reject an opposition as inadmissible will also be communicated to the EUTM applicant (Article 5(6) EUTMDR) but can only be appealed by the opponent.

### 2.4.1 Absolute admissibility requirements

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|---|
| Article 2(2)(a) to (c) and Article 5(3) EUTMDR<br><br>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

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| Article 2(2)(a) andArticle 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

An opposition without an indication of the earlier mark or right or one that relies on an earlier mark or right that is not protected within the European Union is inadmissible (except for an opposition under Article 8(3) EUTMR, see point 4.2.4.5). As the earlier marks or rights relied on must be identified within the opposition period, the opposition is inadmissible to the extent the opponent relies on marks or rights that are identified after the expiry of that period (see, to this extent, 28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362, § 56).

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 the invoked right to be earlier it must have an application or priority date that is earlier than the filing date (or priority date if applicable) of the contested EUTM application. 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 must also be carefully examined to what extent the list of goods and services on which the opposition is based overlaps with the list of goods and services of the mark whose priority is claimed. For further information see also the Guidelines, Part B, Examination, Section 2, Formalities, point 11.

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 being 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

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

Articles 8(1), 8(5) and 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 having effect in a Member State, invoked under Article 8(1) or 8(5) EUTMR.

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 (see Part E, Section 2 Conversion, 2 Conversion of EUTMs and IRs Designating the EU, 2.1 Conversion of EUTMs). 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 (for more detailed information on International Registrations, see Part M, International marks).

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) EUTMDR, 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.

At the formality stage of the EUTM application (or International registration designating the European Union) the examination of seniority claims is limited to the formal requirements and to the identity of the marks (see Part B Examination, Section 2 Formalities, points 13.2 Seniority Examination and 13.3 Identity of the marks). The other substantive requirements of the triple-identity under Article 39(1) EUTMR (same owners and same goods and services) will be examined during *inter partes* proceedings, where necessary, and will be restricted to the extent of those *inter partes* proceedings.

Under Article 7(3) and (4) EUTMDR, when substantiating the seniority claim, the opponent may rely on online substantiation, provided that the evidence referred to is in the language of the proceedings or a translation into the language of the proceedings is submitted (for further information see Part C Opposition, Section 1 Opposition Proceedings, point 4.2 Substantiation).

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

Articles 2(2)(b)(i) and (ii) and 5(3) EUTMDR

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

Articles 2(2)(b)(iii) and 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

Articles 2(2)(b)(iv) and 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, a trade name, and titles of protected literary/artistic works or 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 (see, to this extent, 28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362, § 59-61).'Trade name', 'company name', 'passing off', 'title of a protected literary/artistic work' 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 will be rejected as inadmissible.
- An indication as to whether the right to the earlier mark or sign exists in the European Union as a whole, or in one or more Member States and, if so, an indication of those Member States. As explained in Part C, Section 4, paragraph 1 Introduction , given that non-registered marks are governed by national laws only, a European Union (EU) non-registered trade mark is not an eligible basis for opposition under Article 8(4) EUTMR.
- A representation of the earlier right (in colour if applicable).

In the absence of the previous indications, the relevant right will be inadmissible (28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362, § 57).

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

Articles 2(2)(b)(v) and 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. It also follows that the opposition is inadmissible to the extent the opponent relies on any further ground of opposition that is submitted after the expiry of the opposition period (28/06/2023, T-452/22, Hofmag / Hofmag, EU:T:2023:362, § 56).

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 in respect of each earlier right.

### 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), 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). In this regard, a representation that includes the colours in words in the language of

the proceedings or generally recognised colour codes (such as Pantone, Hex, RAL, RGB or CMYK) and their distribution within the mark (for example, by using arrows that clearly indicate to which element of the mark the specific colour applies) is considered a 'colour representation'.

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 (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 |
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Article 2(2)(g) EUTMDR stipulates that the notice of opposition must contain an indication of the goods and services on which the opposition is based in the language of the proceedings for each of the grounds. This applies to all types of earlier rights.

The opposition can be based on all the goods and services for which the earlier mark is registered or applied for, or 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 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, absent further clarification, assume that the opposition is directed against 'all the goods and services' in order to overcome the contradictory information contained in the notice of opposition.

#### 2.4.2.5 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.

#### 2.4.2.6 Identification of the opponent

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| Article 2(2)(h)(i) EUTMDR<br><br>Article 2(1)(b) EUTMIR |

For information on the identification of the opponent, see the Guidelines, Part A, General rules, Section 5, Parties to the proceedings and professional representation, paragraph 3.

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 that the opponent indicates 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 the opponent, even though it is no longer the owner of the earlier mark.

If the opposition is filed with B as the opponent and a copy of the registration certificate shows A as the 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. However, entitlement to file the opposition (e.g. evidence of the transfer in the language of proceedings and/or accompanied by a translation when applicable before the opposition was filed) has to be proved within the time limit for substantiation.

#### 2.4.2.7 Indication of entitlement

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|---|
| Article 46(1) EUTMR<br><br>Article 2(1) and Article 2(2)(h)(iii) EUTMDR |

Single opponent

The following persons are entitled to file an opposition.

- An opposition pursuant to Article 8(1) or (5) EUTMR may be filed by the **owner** of the earlier mark, or by a **licensee**, provided it is authorised by the owner.
- An opposition pursuant to Article 8(3) EUTMR may only be filed by the **owner** of the earlier mark.
- An opposition pursuant to Article 8(4) EUTMR may be filed by the **owner** of the earlier right or by a **person authorised under the applicable law** to exercise that right.
- An opposition pursuant to Article 8(6) EUTMR may only be filed by a **person authorised under the applicable law** to exercise the rights to an earlier geographical indication.

The opponent does not have to indicate its entitlement if it is the **owner** of the earlier mark or right on which the opposition is based. If the opponent is an **authorised licensee** or a **person authorised under the applicable law** they must submit a

**statement** to that effect and **specify the basis of their entitlement** (for example, licence agreement, specific authorisation from the proprietor, specific provision of the applicable law). If the basis of the entitlement is not specified, the Office will invite the opponent to remedy the deficiency. If the deficiency is not remedied, the opposition will be rejected as inadmissible for the earlier mark or right concerned.

Where an earlier mark has more than one proprietor ('co-ownership') or where an earlier right may be exercised by more than one person, the opposition may be filed by any one of them. Therefore, it is not necessary that all co-owners or authorised persons file the opposition together. Only one of them need to file the notice of opposition to avoid unnecessary complications resulting from 'multiple opponents' scenarios, particularly where the opposition is based on more than one earlier mark or right (see below).

When the owner of an earlier mark initiates opposition proceedings, there is a presumption that it has capacity to act under Article 3 EUTMR (see, to this effect, 05/11/2014, R 2463/2013-5, CHOCO FOR Slim (FIG. MARK) / SLIM CHOC, § 17). Nevertheless, this capacity might require to be proved at the substantiation stage of the proceedings (see point 4.2.3.5 for further details).

Multiple opponents

If the opposition is filed by several opponents, they may do so only if **all of them** are entitled to do so for **all** of the earlier marks or rights.

**Firstly,** each opponent's **individual entitlement** in relation to each earlier mark or right must be clarified.

In the absence of any indication of entitlement, the multiple opponents will be considered to be **co-owners**, applying the rule that only licensees and persons authorised under the applicable law need to indicate their entitlement (Article 2(2)(h)(iii) EUTMDR). If assumed ownership or any other indicated entitlement is contradicted by evidence attached to or relied on in the notice of opposition (e.g. online evidence shows that one of the opponents is not an 'owner' of one of the earlier marks) or by the particular ground or basis of opposition (e.g. geographical indications under Article 8(6) have no 'owners'; a 'licensee' is not entitled to invoke Article 8(3) EUTMR), the opponents will be invited to clarify their individual entitlement for each of the earlier marks or rights.

If the opponents fail to remedy the deficiency concerning the indication of their **individual entitlement**, the opposition will be deemed **inadmissible for the earlier marks or rights for which their entitlement has not been clarified**.

**Secondly**, the opponent's **joint entitlement** has to be verified, namely, whether they comply with the specific requirement laid down in Article 2(1) EUTMDR. If, based on the entitlements indicated, the opponents cannot be accepted as 'multiple opponents', they will be invited to remedy the deficiency (typically, to choose with which of the opponents the proceedings will continue — see below). The following are **examples** of acceptable and unacceptable scenarios of multiple opponent relationships.

*Acceptable*

| **Earlier trade marks** | 1 | 2 |
|---|---|---|
| **Co-owners** | A/B | A/B |

| **Earlier rights** | 1 | 2 |
|---|---|---|
| **Authorised persons** | A/B | A/B |

| **Earlier trade marks** | 1 | 2 |
|---|---|---|
| **Owner** | A | A |
| **Licensee** | B | B |

| **Earlier trade marks** | 1 | 2 |
|---|---|---|
| **Owner** | A | B |
| **Licensee** | B | A |

| **Earlier trade marks** | 1 | 2 |
|---|---|---|
| **Owner** | A | A |
| **Co-owner** | B | (none) |
| **Licensee** | (none) | B |

*Not acceptable*

| **Earlier trade marks** | 1 | 2 |
|---|---|---|
| **Owners** | A | B |

The opponents will be asked to indicate whether the proceedings should continue with ‘A’ as the sole opponent based on the first earlier mark only, or with ‘B’ as the sole opponent based on the second earlier mark only. The opposition will no longer be considered to be based on the earlier mark of the departing opponent.

| | | |
|---|---|---|
| **Earlier trade marks** | 1 | 2 |
| **Owners** | A/B | A |

The opponents will be asked to indicate whether the proceedings should continue with 'A' as the sole opponent based on both earlier marks or with 'A' and 'B' as multiple opponents based on the first mark only. In the latter case, the opposition will no longer be considered to be based on the second earlier mark.

| | | |
|---|---|---|
| **Earlier trade marks** | 1 | 2 |
| **Owner** | A | A |
| **Licensee** | B | none |

The opponents will be asked to indicate whether the proceedings should continue with 'A' as the sole opponent based on both earlier marks or with 'A' and 'B' as multiple opponents based on the first mark only. In the latter case, the opposition will no longer be considered to be based on the second earlier mark.

If the opponents do not remedy the deficiency concerning their **joint entitlement**, the opposition will be deemed **inadmissible in its entirety**.

#### 2.4.2.8 Professional representation

Articles 119 and 120 EUTMR

Article 2(2)(h)(ii) and Article 73 EUTMDR

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

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, including the requirement of non-EEA-based opponents to appoint a representative, communication with the professional representative and the 'common representative', see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraphs 1, 5 and 6.

#### 2.4.2.9 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.

For further details on signatures, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.4.

#### 2.4.2.10 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.

## 2.5 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-26-03 of the Executive Director of the Office of 1 July 2026 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.

In the case of different means of communication with the parties, the time limits set in the notification on the commencement of the adversarial part of the proceedings are set according to the 'slower' means of communication. Therefore, if the Office's notification is sent by post or courier to one of the parties but by electronic means to the other, the latter will also be granted the 10 additional days to which the former party is entitled (instead of the 5 additional days due for communication by electronic means), so that the time limits set for the commencement of the adversarial part of the proceedings coincide for both parties. 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.

# 3 Cooling-off Period

## 3.1 Setting the cooling-off period

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| 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

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| Article 46 EUTMR<br><br>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 opponent's submission of facts and arguments in support of the opposition as well as the evidence of filing or registration of the earlier rights or the applicable national law must be in the language of the proceedings or accompanied by a translation. The

translation must be submitted within the time limit for submitting the original, that is, within the time limit for substantiation. A translation must **accompany** the evidence in the original language; a translation alone is not considered sufficient. Any other evidence not in the language of the proceedings needs to be translated only at the Office's request. For further details see paragraph 4.3.1 below.

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 such evidence. The Office will not check on its own initiative the substantiation of any rights online where the opponent has not expressly and unconditionally declared its intention to rely on 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 another earlier right that is substantiated, the absolute admissibility requirements for that earlier right 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

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| 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 an 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 |
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To substantiate an earlier trade mark application or registration, the opponent must provide the Office with evidence of its filing or registration. The Office accepts as evidence of the filing or registration of 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 paragraph 4.2.3.2 below).

#### 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, 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

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| Article 46(1)(a) EUTMR<br><br>Article 2(2)(h)(iii) and Article 7(2) EUTMDR |

The opponent must submit evidence concerning its entitlement as indicated in the notice of opposition (see point 2.4.2.7).

The evidence must support the claim of entitlement indicated in the notice of opposition. For instance, if the opponent claimed to be the owner of the earlier right, but the evidence shows that it is a licensee, the claim is not substantiated. Conversely, if the opponent claimed to be a licensee, and the evidence shows that it is the owner, the claim will be considered to be substantiated. The same principle applies by analogy to cancellation proceedings, seePart D, Cancellation, Section 1, Cancellation proceedings, paragraph 2.1, Persons entitled to file an application for cancellation.

Single opponent

If the opposition is filed with 'B' as the opponent and the evidence shows 'A' as the **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. A difference in the legal form may, depending on the jurisdiction, indicate different legal entities.

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. This authorisation cannot be presumed from the licensee status (16/05/2019, T-354/18, SKYFi /SKY et al., EU:T:2019:33, § 21-26). 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 to file the opposition.

According to Articles 25, 26 and 29 EUTMR, the Office registers and publishes licences for EUTMs (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and EUDs as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings, Entitlement Proceedings or Similar Proceedings). If the earlier mark is an EUTM, the registration of the licence in itself constitutes sufficient proof of the opponent's licensee status. On the other hand, the opponent will still have to submit evidence to prove that it is authorised to file the opposition. If the opponent's authorisation to file the opposition can be proved on the basis of a document previously submitted to the Office, pursuant to Article 25(5) EUTMR, the opponent is not required to submit the same document in oppositions it subsequently files. Nevertheless, the opponent must specifically rely on and clearly identify the document and the provision that proves its authorisation to file the opposition (registration number of the licence, date and title of the document, number of the relevant clause, etc). Once identified, that document will be included in the case file and forwarded to the applicant for observations.

As stated inpoint 2.4.2.6, an opponent is generally presumed to have the legal capacity to act under Article 3 EUTMR at the moment of filing the opposition. However, where, in the course of proceedings, this presumption is questioned on the basis of concrete elements (e.g. evidence indicating that the opponent has ceased to exist following insolvency proceedings or a merger with another company), the Office will invite the opponent to prove its legal capacity to act under the terms of the applicable national law pursuant to Article 3 EUTMR. This may be done by submitting, for instance, extracts of relevant legislation and official documentation (including, if needed, decisions from the competent national authorities) indicating its legal status.

Multiple opponents

Multiple opponents are required to prove their individual entitlement to each of the earlier marks or rights relied on in the notice of opposition. If one of them fails to prove its entitlement in relation to any of the earlier marks or rights, the opposition will be rejected as non-substantiated in relation to this opponent. The opposition will continue with the other opponent and its earlier marks or rights.

For example, opponent 'A' has indicated and proves that it owns both earlier marks. Opponent 'B' has indicated that it is co-owner of the first earlier mark and licensee for the second. It proves co-ownership of the first earlier mark, but fails to submit evidence of its licensee status for the second one. As opponent 'B' has failed to substantiate its entitlement in relation to one of the earlier marks, the opposition will be rejected in relation to opponent 'B' for all its earlier marks. This is because the opponents no longer fulfil the requirement of 'multiple opponents' within the meaning of Article 2(1) EUTMDR (see paragraph 2.4.2.6). Nevertheless, the opposition may continue with opponent 'A' and its earlier marks.

#### 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 ([59]):

- 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

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

a black and white representation of the mark accompanied by a colour claim in general terms (e.g. ‘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. by using arrows that clearly indicate to which element of the mark the specific colour applies). 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. The indication of generally recognised colour codes (e.g. Pantone, Hex, RAL, RGB or CMYK) is considered equivalent to the indication of the colours in words in the language of the 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.

- 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. restrictions, renewals, transfers, pending actions, the fact that the mark was registered due to acquired distinctiveness through use, etc.).

### 4.2.4 Substantiation of other grounds and basis of opposition

#### 4.2.4.1 Well-known marks

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| Article 8(2)(c) and Article 46(1)(a) EUTMR<br><br>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) and Article 46(1)(a) EUTMR

Article 7(2)(f) EUTMDR

An opposition under Article 8(5) EUTMR is based on an earlier trade mark that has a reputation.

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.

For more details, see the Guidelines, Part C, Opposition, Section 5, Trade marks with reputation (Article 8(5) EUTMR).

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

Article 8(4) and Article 46(1)(c) EUTMR

Article 7(2)(d) EUTMDR

Oppositions under Article 8(4) EUTMR are based on earlier non-registered trade marks or other signs used in the course of trade governed by the applicable law invoked.

The opponent must specify the provisions of the applicable law it intends to rely on. If the law invoked is national law, it must also provide the contents of that law by adducing official publications of the relevant provisions or jurisprudence.

The opponent must then prove that it fulfils the conditions of **acquisition** and **scope of protection** of the applicable law invoked. In particular, the opponent must submit evidence of the existence and scope of protection of the earlier right and must prove

that it owns or is authorised under the applicable law to exercise the right. In the case of non-registered rights, the opponent must submit evidence of acquisition of protection through use in accordance with the standard of use required by the applicable law. In the case of registered rights (e.g. company names), evidence of registration is required. The opponent must further show that it may prohibit the use of a subsequent trade mark pursuant to the applicable law.

Finally, the opponent must submit evidence of use of the sign in the course of trade of more than mere local significance.

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. To prove the existence of **registered rights**, the Office will accept any reference to an online database of the competent registration authority which is publicly accessible and free of charge, as long as the search environment is in the language of the proceedings.

To prove the **content of national law**, a reference to any online database will be accepted to the extent that it provides official legal text originating from the government or official body of the Member State concerned, is publicly accessible, free of charge and its search environment is in the language of the proceedings. In that regard, the WIPO Lex database (available at wipolex.wipo.int) is a useful source as it compiles official texts for intellectual property legislation in the original language received from the Member States concerned or from other verified sources (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), paragraph 4.2.1), provided that the search environment coincides with the language of the proceedings.

Furthermore, if the original text of the law is not in the language of the proceedings, its translation must also be available at the indicated online source, or should be submitted separately within the time limit for substantiation of the opposition (see paragraph 4.3.1.1).

For more details, 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).

#### 4.2.4.4 Geographical indications

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| Article 8(6) and Article 46(1)(d) EUTMR<br><br>Article 7(2)(e) EUTMDR |

Oppositions under Article 8(6) EUTMR are based on earlier geographical indications and designations of origin (GIs) governed by the applicable law invoked.

To substantiate these rights, the opponent must provide the Office with evidence of the existence and scope of protection of the GI invoked and must prove that it is authorised

under the applicable law to exercise the rights arising from the GI. It must further show that it may prohibit the use of a subsequent trade mark.

For more details on the specifics of substantiation of oppositions under Article 8(6) EUTMR, see the Guidelines, Part C, Opposition, Section 6, Geographical indications (Article 8(6) EUTMR), paragraph 2.4, Substantation.

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

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| Article 8(3) and Article 46(1)(b) EUTMR<br><br>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.

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.

For more details, see the Guidelines, Part C, Opposition, Section 3, Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR).

### 4.2.5 Non-compliance with the substantiation requirements

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| Article 46(4) EUTMR<br><br>Article 7and 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

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| Article 95(2) EUTMR<br><br>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.

For further information, also see the Guidelines, Part A, Section 10, Evidence, 5 Belated 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 reopened 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 facts, evidence and arguments submitted by the opponent to complete its file

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| Articles 7(4) and (5) and 8(1) EUTMDR<br><br>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. Where the opponent submits a partial translation of the goods and services on which the opposition is based, only the translated goods and services will be deemed properly substantiated. No account will be taken of the goods and services that have not been translated.

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 EUTMIR, 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.

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| 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 and other requests

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| Article 146(9) EUTMR<br><br>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) EUTMIR |
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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.

The above considerations apply to other requests made during opposition proceedings (e.g. requests for extension, requests for suspension, requests for proof of use, requests for *restitutio in integrum* or continuation of proceedings, withdrawal of the opposition).

### 4.3.3 Translation of supporting documents other than observations

| Article 24 and Article 25(2) EUTMIR |
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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

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| Article 146(8) EUTMR<br><br>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 will 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 (for more information on requests for proof of use, see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings.

The Office has made available, to that effect, specific 'e-action' options in the User Area of the Office 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 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 or to submit the signed original by post or courier.

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 the 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 that 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 disclosing or withdrawing the documents. It is up to the party to decide which of these possibilities is appropriate for its case and to 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 be made 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 the Guidelines, Part A, General Rules, Section 1, Means of communication, time limits and Part E, Register Operations, Section 5, Inspection of Files.

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

In their observations, the parties may refer to documents or evidence submitted in other proceedings, for instance, to evidence of use that has already been submitted in a different opposition.

For more information on how these documents or items should be identified, and how the Office will process these requests, see the Guidelines, Part A, Section 10, Evidence, 3.1 Reference made to documents or evidence in other proceedings before the Office.

## 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

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| Article 45 EUTMR<br><br>Communication No 2/09 of the Executive Director of the Office of 9 November 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 Executive Director 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

The request for proof of use must be made within the time limit for the applicant specified by the Office pursuant to Article 8(2) EUTMDR (Article 10(1) EUTMDR).

Nevertheless, the Office also accepts requests for proof of use submitted during the cooling-off period or during the 2-month period given to the opponent to substantiate the opposition. If the request for proof of use is admissible, the Office will invite the opponent to submit proof of use, ensuring that it always has at least 2 months to do so.

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

The owner must put the mark to genuine use within a period of 5 years following its registration (Article 18(1) EUTMR). However, the owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use of the mark in order to rely upon it. During the 'grace period', the mere formal registration gives the

mark full protection. Once this period lapses, the proprietor may be required to prove genuine use of the earlier mark.

For oppositions filed **against EUTM applications**, the opponent may be required to prove genuine use if, on the date of filing or on the date of priority ([60]) of the EUTM application, the earlier mark has been registered for not less than 5 years (Article 47(2) EUTMR).

For oppositions filed against **international registrations designating the EU**, the opponent may be required to prove genuine use if, on the date of registration of the IR (INID code 151) or on the date of its priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891) ([61]), the earlier mark has been registered for not less than 5 years.

If the earlier mark is still within the grace period for non-use, any request for proof of use will be refused. This will be the case even if the applicant alleges that the earlier mark had been refiled with the intention of circumventing the limitation of the grace period, since such a claim cannot be examined in opposition proceedings (19/10/2017, T-736/15, SKYLITE (fig.) / SKY et al., EU:T:2017:729, § 20-28; 16/05/2019, T-354/18, SKYFi / SKY et al., EU:T:2019:33, § 41-43, 46-48).

#### 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(1) and Article 47(2) EUTMR, the **registration date** of the earlier EUTM, that is to say, the date of entry of the EUTM in the Register as published, pursuant to Article 111(2)(o) EUTMR, under INID code 151. 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 international registrations designating the European Union

For earlier international registrations designating the European Union, the date of **second republication of the EU designation** pursuant to Article 190(2) EUTMR marks the beginning of the calculation of the 5-year grace period for non-use (Article 203 EUTMR). This date corresponds to the date of publication of the EU designation in part M.3.1 of the EUTM Bulletin.

#### 5.1.2.3 Earlier national marks

For national marks, the ‘date of completion of the registration procedure’, as provided for in Article 16(1) of Directive (EU) 2015/2436, serves for calculating the starting point of the 5-year grace period for non-use. That date is determined by each Member

60 For EUTM applications filed before 23/03/2016, the relevant date is the date of publication.
61 For international registrations designating the EU 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.

State according to its own procedural rules (14/06/2007, C-246/05, Le Chef de Cuisine, EU:C:2007:340, § 26-28).

Some Member States in particular provide for opposition proceedings **following registration** ([62]). For these national marks, the 'registration date' cannot be the relevant date for calculating the 5-year grace period. Instead, the 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 (Article 16(2) of Directive (EU) 2015/2436, as implemented in the respective national legislation).

Pursuant to Article 16(4) of Directive (EU) 2015/2436, Member States are required to enter the date of commencement of the 5-year period in the register. Until this information becomes readily available in the respective official trade mark databases, the relevant date in the respective jurisdictions can be consulted in the table in the Annex to this section. The Office will rely on the information in that table to determine whether a request for proof of use against a particular national mark is admissible.

#### 5.1.2.4 Earlier international registrations designating a Member State

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.

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. If no provisional refusal is notified to the International Bureau within the applicable time limit, the international registration is deemed to be protected in the designated country (principle of tacit acceptance, Article 4(1) of the Madrid Protocol).

Member States that use the **12-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Belgium, Czech Republic, Germany, Spain, France, Croatia, Latvia, Luxembourg, Hungary, Netherlands, 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 and Sweden.

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

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:

| Designated country ([63]) | Country of origin | Deadline to issue a refusal |
|---|---|---|
| *Belgium, Czech Republic, Germany, Spain, France, Croatia, Latvia, Luxembourg, Hungary, Netherlands, Austria, Portugal, Romania* and *Slovenia*<br><br>(Contracting EU parties bound by **both** the Agreement and the Protocol) | *All contracting parties*<br><br>[Status 06/04/2022: 112 members] **([64])**<br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only) | 12 months |
| *Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden*<br><br>(Contracting EU parties bound by the Protocol **only**) | *All contracting parties*<br><br>[Status 06/04/2022: 112 members]<br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only) | 18 months |
| *Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated before 01/09/2008* ([65])<br><br>(Contracting EU parties bound by both the Agreement and the Protocol that have opted for an **extended** deadline) | *All contracting parties*<br><br>[Status 06/04/2022: 112 members]<br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only) | 18 months |

63 Malta is not part of the Madrid System.

64 See the full list of all Member States to the Regulations under the Protocol relating to the Madrid Agreement Concening the International Registration of Marks (also as Regulations under the Protocol).

65 The date of entry into force of Article 9*sexies*(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.

| Designated country ([63]) | Country of origin | Deadline to issue a refusal |
|---|---|---|
| *Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated on or after 01/09/2008*<br><br>(Contracting EU parties bound by both the Agreement and the Protocol that have opted for an **extended** deadline) | *Contracting parties bound by **both** the Agreement and the Protocol*<br><br>[Status 06/04/2022: 55 members] | 12 months |
| | *Contracting parties bound by the Protocol **only***<br><br>[Status 06/04/2022: 57 members] | 18 months |

To determine whether the earlier international registration designating a Member State is subject to the requirement to prove use, the Office first verifies that the designation in question is not pending a provisional refusal of protection or has been refused by a final decision. If a provisional refusal is pending, the registration procedure cannot yet be deemed to be completed. If the provisional refusal has been confirmed by a final decision, the relevant designation cannot be taken into account as a basis of opposition, to the extent it has been refused.

Next, the Office checks whether a statement of grant of protection has been issued. If so, the Office will, on its own motion, consider the **date of publication of the statement of grant of protection** in the WIPO Gazette (indicated by INID code 450 under the relevant heading of the Madrid Monitor extract) as the start date for calculating the 5-year grace period (Rule 18*ter*(1) and (2) of the Regulations under the Protocol Relating to the Madrid Agreement).

Where no statement of grant of protection has been issued, the Office will, on its own motion, consider the **date of expiry of the time limit to notify a refusal** as the start date for calculating the 5-year grace period. That date is calculated by adding the relevant 12-month or 18-month period, according to the above rules, to the date of notification of the international registration or its subsequent designation from which the time limit to notify the refusal starts (indicated by INID code 581 under the relevant heading of the Madrid Monitor extract, see Rule 18(1)(a)(iii) of the Regulations under the Protocol Relating to the Madrid Agreement).

Only when it is decisive for determining whether the earlier mark is subject to the requirement to prove use can the opponent claim a date that is **later** than the one taken into account by the Office on its own motion (e.g. when 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 Madrid Protocol, or when all the procedures concerning the protection of the mark before the designated office have been completed subsequent to the issuing of the statement of grant of protection, pursuant to Rule 18*ter*(4) of the Regulations under the Protocol Relating to the Madrid Agreement). This is also true should the applicant or holder wish to claim a date that

63 Malta is not part of the Madrid System.

is **earlier** than these dates (e.g. the date following the expiry of the opposition period, where no opposition has been filed – see Article 16(3) of Directive (EU) 2015/2436). Conclusive evidence to support these claims must be submitted to the Office.

#### 5.1.2.5 Summary of calculation of the beginning of the grace period

| Earlier mark | Calculation of the beginning of the 5-year grace period |
|---|---|
| **EUTM** | Date of registration. |
| **IR designating the EU** | Date of the second republication of the EU designation in part M.3.1 of the EUTM Bulletin. |
| **National mark** | The date of completion of the registration procedure, as defined in national law (see table in Annex). |
| **IR designating Member States** | By default, the date of publication of the statement of grant of protection in the WIPO Gazette (INID code 450 of the relevant heading). |

### 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 / CONTXTA).

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(1) EUTMDR in conjunction with Article 8(2) EUTMDR, the request for proof of use is only admissible if it is submitted as an unconditional request in a separate document within the period specified by the Office ( 28/06/2021, R 2142/2018-G, DIESEL SPORT beat your limits (fig.) / Diesel et al., § 54).

The requirement for filing by way of a separate document is fulfilled when the proof of use request is filed as a **separate submission** or in a **separate annex** of a submission. Requests merged into observations will 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.

For submission of requests for proof of use via e-communication, the Office has made available the specific '**e-action**' option '**Request proof of use**'. When 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. It is recommended that the e-action option 'Request proof of use' be used when a request for proof of use is filed via the User Area.

The 'separate document' requirement can also be fulfilled by submitting the request for proof of use via the e-action 'Submit observations'. This could be the case when the request is submitted as a separate annex of a submission, but not merged into the applicant's observations. The request has to be annexed to the applicant's observations in a clearly defined manner (e.g. Annex 1 – Restriction of the list of goods and services; Annex 2 – Request for proof of use; etc.)

Furthermore, the requirement to submit a request for proof of use by way of a 'separate document' is not to be equated to submitting it by way of a 'separate electronic file attachment'. Joining submissions for the purposes of communication does not preclude the presentation of the request by way of a 'separate document'. The applicant's observations and the request for proof of use can be submitted in a single electronic file attachment (e.g. in a single PDF file), as long as the request for proof of use forms a separate annex of the submission (28/06/2021, R 2142/2018-G, DIESEL SPORT beat your limits (fig.) / Diesel et al., § 46-48).

### 5.1.5 Applicant's option 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. If the applicant chooses to limit its first observations to requesting proof of use, the applicant is not obliged to submit its observations in reply to the opposition at this point. However, in that case, the applicant must then reply to the opposition when it is given the opportunity to reply to any evidence of use that was submitted. It may also do this if only some earlier rights are subject to the use requirement, as the applicant should not be obliged to split its observations.

When submitting a request for proof of use, the applicant must ensure that the request duly complies with the requirements set out in Article 10(1) and (2) EUTMDR (see points5.1.2, 5.1.3 and 5.1.4 above).

Where an inadmissible request for proof of use is accompanied by observations on the opposition, the Office informs the parties about the inadmissibility of the request and continues the proceedings without inviting the opponent to submit evidence of use of the earlier marks.

Where an inadmissible request for proof of use is not accompanied by observations on the opposition, the Office informs the parties about the inadmissibility of the request and grants the applicant one month to submit its observations. This approach takes into account that Article 10(5) EUTMDR allows the applicant to limit its first reply to requesting evidence of use of the earlier marks and that the Office can extend the time limit established in Article 8(2) EUTMDR.

If the request is inadmissible only for some of the earlier marks on which the opposition is based (e.g. where some of the earlier marks are subject to the obligation to prove genuine use but others are not), the Office expressly limits the invitation to the opponent to submit proof of use to the earlier marks that are subject to the obligation to prove genuine use.

## 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; 22/08/2016, R 1691/2014-2, CINEMA 3D (FIG. MARK) / CINEMA 4D et al. § 62).

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 below).

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. However, if the opposition is also based on other earlier marks that are not subject to the proof of use requirement, the proceedings will continue based on those earlier marks.
- 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 submission 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, and recommendations on the structure of written evidence, see the Guidelines, Part A, Section 10, Evidence, 2 How to submit evidence.

The 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.

The requirement of proof of use always raises the question of the **probative value** of the submitted material. For further information, see the Guidelines, Part A, Section 10 Evidence, 4.2 Affidavits.

#### 5.3.2.2 References to other proceedings

The opponent may avail itself of the findings of the national offices and courts in parallel proceedings. Although the Office is not bound by the findings of the national offices and courts, such decisions must be duly considered 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 considers the different procedural and substantive requirements that may exist before the respective national body (25/08/2003, R 1132/2000-4, VANETTA / VIENNETTA (FIG. MARK), § 16; 18/10/2000, R 550/1999-3, DUKE (FIG. MARK) / DUKE, § 23). For further information, see the Guidelines, 3.4.2 References to national office and court decisions, and decisions of the Office on page 186.

The opponent may wish to refer to material submitted as proof of use in previous proceedings before the Office. 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. For further information, see the Guidelines, Part A, Section 10, Evidence, 3.1 Reference to documents or evidence in other proceedings before the Office.

#### 5.3.2.3 Affidavits

Although 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. For general information, see the Guidelines, Part A, Section 10, Evidence, 4.2 Affidavits.

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, among which are sworn or affirmed written statements or other statements with 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.

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).

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.

Generalisation should be avoided, since the exact value of such statements always depends on their concrete form and content, and the final outcome depends on the overall assessment of the evidence in each individual case.

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, § 23-24).

Nevertheless, in the case of a transfer or other succession in title, any new owner may rely on use by their predecessors within the grace period concerned. Use made by a 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 (e.g. surveys) drawn up **by an independent source** are given more probative weight (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (FIG. MARK), § 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.

## 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 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 earlier trade mark registrations 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).

Where only some of the earlier marks are subject to the proof of use requirement and the opponent submits no evidence, or the evidence is manifestly irrelevant, the applicant will be invited to submit observations to the opposition in relation to the remaining earlier marks, irrespective of whether it had limited its first observations to requesting proof of use or whether it had also submitted initial observations to the opposition.

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.

Failure to allow the opponent to comment in such a case would be a substantial procedural violation and a breach of the right to be heard.

For further details on the submission of additional evidence, see point 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(6) 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

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| Article 47(4) EUTMR<br><br>Article 6(2) EUTMDR |

Part C, Opposition, Section 1 Opposition proceedings, 6 Termination of proceedings, 6.5 Decision on the apportionment of costs, 6.5.3 Standard cases of decisions on costs.

The parties are free to decide on the measure that brings the opposition proceedings to a conclusion. Furthermore, the parties are encouraged to negotiate with a view of reaching an amicable settlement at any time during the proceedings, even after the cooling-off period. Possible ways to settle an opposition include limitations of the EUTM application that lead to a withdrawal of the opposition (for detailed information, please refer to the Trade mark Guidelines, Part C Opposition, Section 1 Opposition proceedings, 6. Termination of proceedings, 6.2 Restrictions and withdrawals and Part C, Section 1 Opposition proceedings, 4. Adversarial stage, 4.4.1 Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document). Once the parties reach an agreement and have taken the agreed steps to close the proceedings (e.g. by withdrawing the opposition or withdrawing the the EUTM application), they should inform the Office which will proceed accordingly. .

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 cases where a settlement between the parties appears desirable.

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. Friendly settlement may be preceded by a request for suspension (for detailed information please refer to the Trade mark Guidelines, Part C Opposition, Section 1 Opposition proceedings, 7 Other Procedural Issues, 7.3 Suspension).

Regarding the refund of fees and decision on costs in case of friendly settlement, you may find detailed information in the Trade mark Guidelines, Part C Opposition, Section 1 Opposition proceedings, 6. Termination of proceedings, 6.4 Fee refund and 6.5 Decision on the apportionment of costs).

## 6.2 Restrictions and withdrawals

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

### 6.2.1 Restrictions and withdrawals of EUTM applications

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| Article 49 EUTMR<br><br>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 5.3.5). 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, paragraph 5.3 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 expressly refer to the restriction, as long as it is received on or after the date of 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.

As long as the applicant's restriction is received before the expiry of the cooling-off period, the opposition fee will be refunded, even if the consequent withdrawal of the opposition is received and the proceedings are closed after expiry of the cooling-off period.

Furthermore, 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 have been made in consequence of the restriction and the opposition fee is also refunded.

The opponent's letter does not have to expressly refer to the restriction, as long as it is received on or after the date of 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

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.

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

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 of the EUTM application and close the case. Confirmation of the withdrawal is sent to the parties. The same applies when a restriction deletes or excludes all the goods and services opposed. The Office's database is updated accordingly to reflect the restriction or 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 |
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During opposition proceedings a restriction may be submitted either in the first or the second language of the EUTM application.

When the restriction is submitted in the first language of the EUTM application, which is not the language of proceedings, and when the restriction does not cover the whole extent of the opposition, the restriction is forwarded to the opponent, requesting it to inform the Office whether or not it maintains its opposition. The opponent can object to the language of the restriction and ask for a translation into the language of proceedings. The Office will then provide for the translation.

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

### 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 because of a restriction of the EUTM application, see paragraphs 6.2.1.1-6.2.1.3 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. In the event that the opposition is withdrawn during the cooling-off period, and this is not due to a restriction of the EUTM application (see point 6.2.1.2 above), the Office does not refund the opposition fee. No decision on costs will be taken.

#### 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

The Office accepts withdrawals of oppositions 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 of the opposition and close the case. Confirmation of the withdrawal is sent to the parties. 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 (see also the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.2.1).

## 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 ceases 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 ceases to exist

If, in the course of the proceedings, the earlier right ceases to exist, 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.

It follows from the wording of Article 8 EUTMR that, for an opposition to be upheld, the earlier right relied on must exist at the filing date of the contested mark or, where applicable, its priority date, and must remain valid until the date on which the final decision is taken. Therefore, before assessing whether the opposing party has proved that the earlier right satisfies the substantive conditions, the Office must ascertain whether there is still a validly protected earlier right (05/02/2026, C-337/22 P, Ape tees (fig.)/DEVICE OF APE HEAD (fig.) et al., EU:C:2026:71, § 107-112). The reason why the earlier right ceases to have effect does not matter.

The same principles apply by analogy to cancellation proceedings.

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

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| Articles 46(3) and 181(1) EUTMR<br><br>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 the EUTM application

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

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

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 (see paragraphs 6.2.1.1 and 6.2.1.2 above).

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

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 (see paragraphs 6.2.1.1 and 6.2.1.2 above).

### 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 |
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In the event that the opposition is withdrawn before the end of the cooling-off period, and this is not due to a restriction of the EUTM application, the Office does not refund the opposition fee. No decision on costs will be taken (see point 6.2.2.1 above).

#### 6.4.4.2 Opponent's withdrawal is earlier

| Article 6(3) and (5) EUTMDR |
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When the opposition is withdrawn before the applicant restricts its application, the fee is not refunded (see paragraphs 6.2.1.1 and 6.2.1.2 above). 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 |
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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 119(2) EUTMR<br><br>Articles 5 and 6 EUTMDR |
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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

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| Article 109 EUTMR<br><br>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 or upon request of the parties 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

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| Article 109(6) EUTMR |

The parties may settle the opposition proceedings with an agreement that includes the costs. In this case, if both parties inform the Office that they have reached an agreement, no decision on costs will be issued. This notification could be signed by both parties (joint notification) or it could be sent in two separate letters by each party and may also be accompanied by the agreement on costs. In any event, notification must be received by the Office before it has confirmed the closure of the proceedings.

If the communication from the parties reaches the Office after the decision on costs has been issued, the decision will not be revised.

#### 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 |
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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 were 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, Vitataste, EU:T:2004:116, § 56). In principle each party bears its own costs.

A different apportionment of costs can, however, be justified for reasons of equity.

This may be the case where the application is restricted in such a limited way that it would clearly not overcome the extent of the opposition and would simply lead to unjustly prolonged proceedings.

In addition, bearing in mind that proceedings before the Office should be effective, efficient and expedient, the Office may decide on a different apportionment of costs in exceptional cases in which the behaviour of a party was clearly abusive, resulting in unnecessary complications and/or delaying the proceedings.

Factors that **might be taken into account** include:

- disregarding rules and Office guidance on effective, efficient and expedient proceedings in a manner that requires considerable extra time and work from the other party or the Office;
- blatantly ignoring **a party's bona fide** attempts at friendly settlement (or other alternative means of resolving the dispute) where there is no justification or underlying reasons for not responding (albeit negatively).

Any different apportionment of costs will be decided on a case-by-case basis taking into account all the facts.

### 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 EUTMDR |
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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

Article 18 EUTMIR

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, Parties to the Proceedings and 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

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| Article 49(2) 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. Examples of obvious mistakes are misspellings, typographical errors, errors of transcription or the use of an abbreviated form in the names of natural persons.

However, amendments that change the scope of the opposition are not considered 'obvious' mistakes and requests for such amendments cannot be accepted after the end of the opposition period (Article 46(1) EUTMR). For instance, in the following invented examples, the request for amendments in the notice of opposition cannot be accepted when:

- the opponent 'ABC' is requested to be corrected to opponent 'DEF';
- the ground of the opposition 'Article 8(1)(b) EUTMR' is requested to be corrected to 'Article 8(5) EUTMR';
- the earlier EUTM No 123 456, on which the opposition is based, is requested to be corrected to EUTM No 789 123.

For information on corrections in the name and address of an opponent or its representative, see the Guidelines, Part A, General Rules, Section 5, Parties to the Proceedings and Professional Representation, paragraph 11.

### 7.1.2 Correction of mistakes and errors in publications

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| 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

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| Article 101 and Article 146(9) EUTMR<br><br>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 equal to the original term (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.

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, see Part A, General Rules, Section 1, Means of Communication, Time Limits Specified by the Office.

#### 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. In principle, this applies to time limits that, under the EUTM Regulations, are 'specified by the Office'. For example, Article 10(2) EUTMDR confers on the Office the power to establish a time limit, and, therefore, necessarily the power to extend it (see, to this effect, 20/11/2024, T-482/23, CLEOPATRA / CLEOPATRA, EU:T:2024:838, § 21), which applies by analogy to Article 8(2) EUTMDR. To this extent, there might be 'particular reasons' when the EUTM applicant, after having requested proof of use of the earlier mark, submits observations on the opposition without waiting to receive the opponent's proof of use or for the expiry of the original time limit for the opponent to submit proof of use. These 'particular reasons' justify extending the time limit for proof of use to align it with the time limit for the opponent to reply to the observations, for reasons of fair and sound administration. An *ex officio* extension such as this is neither biased nor arbitrary, as it results from the EUTM applicant's own choice to submit observations on the opposition before receiving any proof of use of the earlier mark (20/11/2024, T-482/23, CLEOPATRA / CLEOPATRA, EU:T:2024:838, § 24-25).

## 7.3 Suspension

| Article 71 and Article 9(2) EUTMDR |
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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. The maximum duration of the suspension of the proceedings is limited to **two** years, as set out in Article 71(2) EUTMDR, a duration that is to be understood as two cumulative years over the course of the proceedings. Regardless of the period requested by the parties, the first suspension will be granted for a period of six months, with the parties being given the

possibility of opting out. The process for opting out is the same as for the extension of the cooling-off period: if one party opts out, the suspension will end 14 days after the parties have been informed thereof. The proceedings will resume the day after, and the party whose time limit was pending at the moment of suspension will be granted 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. The extension of the suspension will be granted for a period of 18 months (or for the remaining period of up to two years), regardless of the period requested by the parties, but with the possibility of opting out.

A joint request for suspension will be rejected as inadmissible if the parties have used up the total maximum of two 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 |
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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 commencement of the adversarial part of the proceedings) 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 undefined period, the Office will monitor the opposition every 6 months.

Where the earlier right is an application for a national registration or a national/ international registration at risk, the parties are expected to promptly inform the Office about any change in the status of the proceedings affecting the application or registration and submit evidence to this effect. Nevertheless, the Office will consult

the online evidence referred to in the notice of opposition every 6 months. Where it appears that the pending proceedings affecting the earlier right have concluded, it will resume the proceedings. Alternatively, it will request the parties to provide an update.

#### 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 goods and services which overlap with those of the other oppositions 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 |
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Article 9(1) EUTMDR allows the Office to deal with multiple oppositions in one set of proceedings. If it is decided to join the oppositions, the parties must be notified.

Oppositions may be joined upon the request of one of the parties if they are directed against the same EUTM application. It is more likely that the Office would join them if, in addition, they were filed by the same opponent or if there 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 |
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A transfer or assignment of an earlier right is a change of ownership of this right. 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. For further information see the Guidelines, Part E, Register operations, Section 3 EUTMs and EUDs as objects of property, Chapter 1 Transfer.

When a transfer is made **during** opposition proceedings, several situations can arise. In all of these situations, once the Office becomes aware of an effective transfer of ownership, it will update the official database to include the new owner(s) and will inform the parties for information purposes only. However, the mere fact that a

transfer has taken place will never justify the granting of a new time limit for submitting observations or any other documents once the original time limit has expired.

For earlier EUTMs or EUTM applications on which the opposition is based, 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, Article 20(12) EUTMR provides that, where there are time limits to be observed vis-à-vis the Office, the successor in title (e.g. the new opponent or EUTM applicant) may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

For earlier national registrations or applications, the new owner only needs to file evidence of the transfer.

The Office's practice for dealing with transfers is described in paragraphs 7.5.1.2 (Transfer of the earlier rights on which the opposition is based (EUTMs and/or national registrations)), 7.5.1.3 (Transfer of only one or some of the earlier rights on which the opposition is based (EUTM and/or national registration)), 7.5.1.4 (Partial transfer of the earlier rights (EUTM or national registration) on which the opposition is based),7.5.1.5 (Transfer of the contested EUTM application), 7.5.1.6 (Partial transfer of a contested EUTM application), 7.5.2 (Parties are the same after transfer).

For transfers made **before** the opposition is filed see paragraph 2.4.2.6, Identification of the opponent.

#### 7.5.1.2 Transfer of the earlier right(s) on which the opposition is based (EUTMs and/or national registrations)

The effect of the transfer(s) of the earlier right(s) on which the opposition is based (EUTMs and/or national registrations) is that the new owner substitutes the old owner as the opponent in the proceedings.

With this in mind, either the old or the new owner will have to inform the Office that the EUTM(s) and/or the earlier national registration(s) on which the opposition is based have been transferred.

When the earlier right is an EUTM, a request for registration of the transfer should be submitted. In practice, once the Office is informed that a request for registration has been received, the proceedings can continue with the new owner, unless it withdraws the opposition (see point 6.2.2). Nevertheless, the transfer has to be registered before a decision on the opposition can be taken. If the opposition is ready for decision but the transfer has not been registered, the opposition must be suspended.

When the earlier right is a national registration, the Office does not require the new owner to confirm that it wishes to continue the proceedings. It sufficies that the new owner files evidence of the transfer. This evidence should consist of the deed of transfer or any other evidence showing the agreement of the parties to the transfer/ change of ownership. 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 will be suspended while the new owner is given a time limit within which to submit evidence of the transfer.

Where evidence is accessible online from a source recognised by the Office, the opponent may formally declare to the Office that it relies on this particular evidence or, if the online evidence is not complete or accurate, it may supplement it with evidence from an official source. The Office will not check on its own initiative the substantiation of any rights online unless the opponent has expressly and unconditionally declared its intention to rely on online evidence. The new opponent must provide a translation reproducing the structure and content of the original online extract if it is not in the language of the proceedings. For more information on substantiation requirements see Part C, Opposition, Section 1, Opposition proceedings, paragraph 4.2.

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 becomes 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.

#### 7.5.1.3 Transfer of only one or some of the earlier rights on which the opposition is based (EUTM and/or national registration)

The situation is different when only one or some of the earlier EUTMs and/or national rights have 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 one of the joint opponents wants to withdraw (e.g., because they reached a friendly settlement with the applicant), this will be accepted independently of whether the other

wants to continue. Should the proceedings continue, they will only be based on the rights of the opponent that did not withdraw. No separate decision on costs will be taken.

#### 7.5.1.4 Partial transfer of the earlier rights (EUTM or national registration) on which the opposition is based

In cases of a partial transfer which affects some of the goods/services on which the opposition is based, one part of the earlier EUTM or national registration 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 or only one of a number of national registrations on which the opposition is based, as described above. For partial transfers the decision must also take account of the fact that a new mark is created as a result of the partial transfer. The new mark maintains the same filing date and, where applicable, date of priority as the original mark and it becomes an earlier mark in the opposition proceedings.

#### 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 |
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When there has been a partial transfer of a (contested) EUTM application, the opposition continues to follow the application with the difference that 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

A change of name does not imply a change of ownership.

### 7.5.4 Change of representatives

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| 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, Parties to the Proceedings and Professional Representation.

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

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| Article 106 EUTMR<br><br>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, Parties to the Proceedings and Professional Representation.

Article 106 EUTMR refers to the applicant, or proprietor, and its representative, and does not mention other parties, such as opponents. The Office applies this provision only to cases where the applicant (or its representative) cannot continue the proceedings. If, for example, the opponent is declared bankrupt, in principle, the proceedings will not be interrupted under Article 106 EUTMR.

As a general principle, there is a presumption that the opponent has a legal capacity to act (see point 2.4.2.7). However, where, in the course of the proceedings, the opponent's capacity to act is questioned on the basis of concrete elements due to legal reasons (e.g. evidence indicating that the opponent has ceased to exist following insolvency proceedings or a merger with another company), the Office will invite the opponent to prove its capacity to act under the terms of the applicable national law pursuant to Article 3 EUTMR (see point 4.2.3.5).

In the event that the notification to the parties 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)

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| Article 106(1)(b) EUTMR<br><br>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. In the absence of this information, the proceedings will remain interrupted.

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.

## Annex — Calculation of the grace period for non-use in the case of national marks

The following table sets out the **national provisions** defining the date of commencement of the 5-year grace period for non-use for **national marks** (last general update on 15/09/2020). The abbreviations 'TMA' or 'IPL' have been used as a generic reference to the relevant legislative act (Trade Mark Act or IP Law). The table also provides the **headings** of the national database extracts where the relevant date can be found.

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Austria** | Article 33a(1a) AT-TMA<br>'5 years after **the end of the opposition period** or after **the final decision on opposition** or after **the closure of opposition procedure** …' | The beginning of the use period (Fristbeginn für Benutzung) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Benelux** | Article 2.23bis(1) BX-TMA<br>'… 5 years following **the date of completion of the registration procedure** …'<br>Article 2.23bis(2) BX-TMA<br>'… the 5-year period ... shall be calculated from the date when the mark can no longer be subject of a refusal on absolute grounds or an opposition or, in the event that a refusal has been issued or an opposition has been lodged, from the date when a decision lifting the Office's objections on absolute grounds or terminating the opposition proceedings became final or the opposition was withdrawn.' | **Regular registration proceedings:**<br>Registration date (Inschrijvingsdatum / Date de l'enregistrement)<br>**Accelerated registration proceedings:**<br>Status accelerated registration (Status van spoedinschrijving / Phase d'enregistrement accéléré) | In **accelerated registration**, Benelux applies a post-registration opposition procedure and, therefore, the date of completion of the registration procedure is the date appearing under a separate heading 'status accelerated registration'. |
| **Bulgaria** | Article 21(1) BG-TMA<br>'... within a period of 5 years as from **the date of registration** …' | Registration date (Дата на регистрация) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Croatia** | Article 20 HR-TMA<br>'… 5 years from **the date of completion of the registration procedure** …'<br>Article 47(1) HR-TMA<br>'… during the 5-year period preceding the date of filing the application or the date of claiming the priority right of the trade mark, the earlier trade mark has been in genuine use …, the earlier trade mark has **been registered** for not less than 5 years.' | Registration Date<br>(Datum priznanja) (INID code 151) | |
| **Cyprus** | Article 39(1)(a) CY-TMA<br>'… within a period of five consecutive years from **the registration** …'<br>Article 33(3) CY-TMA<br>'A mark … is considered to have been registered on **the date of completion of the registration procedure**.' | Date of registration (Ημερομηνία Εγγραφής) | In **TMview**, the relevant date is **not** the 'Registration date' (which, according to a previous legal definition, coincided with the 'Application date'). The relevant date can often be found in the 'Recordals' section, under 'Event description: Trade mark registered on …'. |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Czech Republic** | Article 13(1) CZ-TMA<br>'... 5 years following **the registration** …'<br>Article 28(1), (3) CZ-TMA<br>'(1) … The Office will register the trade mark in the Register together with stating the registration date therein …<br>(3) The registration of the trade mark in the Register takes effect as of the registration date.' | Registration date (Datum zápisu)<br>(INID code 151) | |
| **Denmark** | Article 10c(1) DK-TMA<br>'… for a continuous period of 5 years from the **date of completion of the registration procedure** …'<br>Article 10c(2)(i) DK-TMA<br>'The registration procedure shall be deemed completed when a trade mark **is registered** …' | Registration procedure terminated (Reg. procedure slut) | **Trade marks registered as of 01/01/2019:**<br>Date of registration<br>**Trade marks registered before 01/01/2019:**<br>**Where no opposition has been filed:**<br>First day after the end of the opposition period.<br>**Where an opposition has been filed:**<br>(a) date when the decision terminating the opposition proceedings became final, or<br>(b) date of withdrawal of the opposition. |
| **Estonia** | Article 17(3) EE-TMA<br>'… 5 years have passed since **the registration** of the earlier trade mark.' | Registration date (Registreerimise kuupäev) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Finland** | Article 46 FI-TMA<br>'… 5-year period shall be calculated from **the date on which the mark can no longer be opposed** … if an opposition has been lodged, from **the date when a decision terminating the opposition proceedings became final** or the **opposition was withdrawn**.' | **Trade marks filed as of, or pending completion of the registration procedure on, 01/05/2019:**<br>Date of commencement of 5-year use period (5 vuoden käyttämisajan alkamisaika)<br>**Trade marks whose registration procedure was completed before 01/05/2019:**<br>(a) where no opposition was filed: First day after the date under 'Opposition end date' ('Väiteajan päättymispäivä')<br>(b) where an opposition was filed:<br>See section 'Applications, appeals and oppositions relating to the trade mark' / 'Event: Opposition' / 'Status: Closed' / 'Status date' ('Tavaramerkkiin liittyvät hakemukset, valitukset, väitteet' / Tapahtuma': 'Väite' / 'Tila': Loppuunkäsitelty' / Tapahtumapäivä) | |
| **France** | Article R 712-23 FR-IPL<br>'The date on which a mark is deemed to be registered, in particular for the purposes of applying Articles … L. 714-5, is, for French marks, **the date of the 'Bulletin officiel de la propriété industrielle' in which the registration has been published.'** | History / Registration without modification (Historique / Enregistrement sans modification) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Germany** | Article 26(5) DE-TMA<br>**Where no opposition has been filed:**<br>'… 5 years from **the date when the mark can no longer be opposed**.'<br>**Where opposition has been filed:**<br>'… 5 years from **the date when the decision terminating the opposition proceedings became final** or **the opposition was withdrawn**.' | **Trade marks filed as of 14/01/2019:**<br>Start of grace period for use (Beginn der Benutzungsschonfrist)<br>**Trade marks filed before 14/01/2019:**<br>(a) where no opposition against the earlier mark was filed and the **opposition against the EUTM based on that earlier mark was filed before 14/01/2019:**<br>Date of entry into register (Tag der Eintragung im Register) (INID code 151)<br>(b) where no opposition against the earlier mark was filed and the **opposition against the EUTM based on that earlier mark was filed on or after 14/01/2019:**<br>First day after the date of the 'End of opposition period' (EWT) ('Ablauf der Widerspruchsfrist')<br>(c) where an opposition against the earlier mark was filed:<br>'Date of conclusion' ('Abschlussdatum') in details for the section 'Opposition proceedings'* ('Widerspruchsverfahren') | * See section 'Kind of procedure' / 'Opposition proceedings' – 'Display details' ('Verfahrensart' / 'Widerspruchsverfahren' – 'Details anzeigen') (line with the entry related to the closure of the opposition proceedings, e.g. 'Opposition proceedings' – 'Trade mark cancelled in part' ('Widerspruchsverfahren' – 'Marke teilweise gelöscht')) / 'Date of conclusion' ('Datum des Abschlusses')<br>Article 158 DE-TMA<br>Transitional provisions<br>'…<br>(5) If use of a trade mark on which an opposition is based is contested in opposition proceedings lodged prior to 14/01/2019, Article 26 and Article 43(1) in the version in force until 13/01/2019 shall apply.'<br>Article 26(5) DE-TMA (in the version in force until 13/01/2019):<br>'Insofar as use within 5 years from the point in time of the registration is necessary, in cases in which an opposition has been lodged against the registration, the time of the registration shall be substituted by the point in time of the conclusion of the opposition proceedings.' |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Greece** | Article 28(1) GR-TMA:<br>'… provided that the earlier trade mark **has been registered** for at least 5 years …' | N/A | No official public online trade mark database exists in Greece. Official information on trade marks protected in Greece is accessible online only through TMview. The relevant information may be found in TMview under the heading 'Registration date'. |
| **Hungary** | Article 18(1) HU-TMA<br>'... within a period of 5 years following **the date of registration** …'<br>Article 64(1) HU-TMA<br>' **The date of the decision on registration** shall be the date of registration of the trade mark.'<br>Article 18(2) HU-TMA<br>'… in the case of a trade mark registered in 'special expedited procedure' [Article 64/A(7)], the date of registration shall be the date:<br>a) following **the expiry of the** period pursuant to Article 61/B(1) [**3-month opposition period**]; or<br>b) in the case of an opposition, when **the decision on the opposition becomes final**.' | Starting date of the 5-year period within which the trade mark must be put to use (Védjegyhasználat megkezdésére nyitva álló ötéves időszak kezdő időpontja) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Ireland** | Article 16A(1) IE-TMA<br>'… within the period of 5 years following **the date of completion of the registration procedure** …'<br>Article 45(5) IE-TMA<br>'The registration procedure shall be regarded as completed **on the date of publication** under subsection (4); and that date shall be entered in the register.' | Date of publication of registration | The relevant date can be found in TMview under the headings 'Publication' / 'Publication section: Registration' / 'Publication date' (i.e. not under 'Registration date'). |
| **Italy** | Article 24(1) IT-IPL<br>'… within 5 years from **the registration**.' | Registration date (Data registrazione) | The relevant date of registration is that of the **original** registration of the mark. |
| **Latvia** | Article 26 LV-TMA<br>'(1) ... within 5 years from the completion of the registration procedure …'<br>(2) The period of 5 years … shall run **from the date on which the opposition to the trade mark in question is no longer available** or, **if an opposition has been received, of the decision closing the opposition proceedings or withdrawn**.' | **Trade marks filed as of 06/03/2020 and those filed before that date and registered as of 20/09/2020:**<br>First day after the date under 'Registration finish date' (Reģ. procedūras pabeigšanas datums) (INID code 451)<br>**Trade marks filed before 06/03/2020 and registered before 20/09/2020:**<br>Registration date (Reģistrācijas datums) (INID code 151) | |
| **Lithuania** | Article 20 LT-TMA<br>'… within a period of 5 years following **registration** …' | Registration date (Registracijos data) (INID code 151) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Malta** | Article 26(1) MT-TMA<br>'… within a period of 5 years following **the date of completion of the registration procedure** ...'<br>Article 56(4) MT-TMA<br>'On the registration of a trademark the Comptroller shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.' | Registration date (Data tar-Reġistrazzjoni)<br>(INID code 151) | |
| **Poland** | Article 169(1)(i) PL-IPL<br>'… for a period of five consecutive years after **the decision on the grant of a right of protection has been taken** …' | Date of grant (Data udzielenia prawa) | |
| **Portugal** | Article 268(1) PT-IPL<br>'... the registration shall lapse if the trade mark is not put to genuine use over a period of five consecutive years.'<br>Article 268(5) PT-IPL<br>'The 5-year period starts running as from **the date of registration**.' | Date of the decision (Data do Despacho) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Romania** | Article 55(1)(a) RO-TMA<br>'… within a continuous 5-year period calculated from **the date of completion of the registration procedure** …'<br>Article 32 RO-TMA<br>'(1) OSIM shall enter in the trade marks register those marks admitted for registration for which the registration procedure has been completed … The date of completion of the registration procedure shall be entered in the register.<br>(2) The procedure for registration of a trade mark shall be deemed to be completed **on the date on which the trade mark application admitted to registration may no longer be the subject of an opposition or, in the case where an opposition has been filed, on the date on which the opposition decision became final or opposition has been withdrawn**.' | **For marks filed as of 13/07/2020:**<br>Date of completion of the registration procedure (Data inchidere procedura)<br>**For marks filed before 13/07/2020:**<br>Granting date (Data acordare) | The implementation of the new heading 'Date of completion of the registration procedure' still pending at the time of the last general update of this table. |
| **Slovakia** | Article 7c(1) SK-TMA<br>*'… within a period of 5 years from **the date of registration** of the trade mark…'* | Registration date (Dátum zápisu)<br>(INID code 151) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Slovenia** | Article 52.b(1) SI-IPL<br>'... within 5 years from **the date of entry of the mark in the register** …' | Registration date (Datum registracije)<br>(INID code 151) | |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
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| **Spain** | Article 39(1) ES-TMA<br>'… within a period of 5 years from **the date of registration** …'<br>Article 39(2) ES-TMA<br>'The 5-year date referred to in the previous paragraph shall begin on **the day on which the registration of the trade mark becomes final**. This date shall be entered in the Register of Marks.' | **If the opposition against the EUTM application was filed on or after 14/01/2019:**<br>(a) Where **no appeal** against the first instance decision concerning the registration of the earlier mark was filed:<br>**1 month** counted from the day following the date indicated in the **left-column** 'Date' ('Fecha') in section 'Acts of processing' ('Actos de tramitación') / 'Act performed' ('Acto de tramitación') / 'PUBLIC. CONCESION DE F. RESOL. [DATE]'.<br>(b) Where an **appeal** was filed against the first instance decision concerning the registration of the earlier mark, as a result of which the mark is granted:<br>2 months counted from the day following the date indicated in the **left-column** 'Date' ('Fecha') in section 'Acts of processing' ('Actos de tramitación') / 'Act performed' ('Acto de tramitación') / 'PUBL. ESTIMAC. RECURSO DE FECHA [DATE]' or 'PUBL. DESESTIM. RECURSO DE FECHA [DATE]' or 'PUBL. INADMIS. RECURSO DE FECHA [DATE]'.<br>(c) Where an **appeal** was filed before the Court against the second instance decision of the Spanish national office (OEPM) concerning the registration of the earlier mark, as a result of which the mark is granted:<br>Unless the opponent proves a later date, **30 business days after** the date indicated in section 'Acts of processing' ('Actos de tramitación'), in the **right-column** 'Act performed' ('Acto de tramitación') / 'PUBL. | Further scenarios are possible. The respective party may claim and prove a different relevant date, provided that it affects the obligation to prove genuine use. |

| Member State | Relevant legal provisions | Relevant heading in the official database extract | Comments |
|---|---|---|---|
| **Sweden** | Chapter 3, Article 2 SE-TMA<br>'… within a period of 5 years following **the date of the completion of the registration procedure**.' | Legal effect date (Dag för laga kraft) | **Where no opposition has been filed:**<br>First day after the 3-month opposition period lapsed (the information on the lapse of the opposition period may be found in TMview under the heading 'Opposition period end date').<br>**Where an opposition has been filed:**<br>The date when the decision on the opposition has become final. |