

OPPOSING A EUROPEAN UNION TRADE MARK

Opposition Period

As part of the application process all European Union trade mark (EUTM) applications are advertised for opposition purposes in the Trade Mark Journal of the European Union Trade Mark Office (EUTMO). The Trade Mark Journal is published online on the EUTMO website and appears a number of times during the week, apart from on national holidays.

A EUTM application is open to opposition for three months from the date of advertisement of the application.

Once the opposition period has expired, the opposition deadline cannot be extended.

Grounds of Opposition and Filing Observations in Reply

To file an opposition, the Opponent must file a Statement of grounds of opposition, together with payment of the official opposition fee. The Opponent does not need to file evidence in support of the opposition at this stage of the proceedings.

Oppositions cannot be based on so-called absolute grounds of opposition, for example the mark concerned is not distinctive. However, it is possible to file observations on such grounds (essentially seeking to provide the Registry with evidence as to why the application should not have been accepted) and an application for invalidity can be filed on such grounds once the application is registered.

A EUTM application can be opposed on the basis of relative grounds of opposition, for example the mark concerned conflicts with an existing application or registration or earlier common law rights.

Once the opposition is filed, it is examined to determine whether it is admissible, essentially a formalities examination.

A cooling off period then begins of two months. If the opposition is settled in the two month period, then the Opponent can obtain a refund of the official opposition fee. The cooling period can be extended for another period of twenty two months if both parties consent. At any time during the extended cooling off period either party can opt out the period and the proceedings continue. Once the cooling off period has expired, the Opponent is given two months to complete the filing of arguments and evidence in support of the opposition.

The applicant then has two months to file observations in reply to the opposition. In relation to trade mark registrations which are used as a ground of opposition and over five years has passed since the date of registration, the applicant can request proof of use that the mark covered by the registration is still in use.

Proof of Use

The Opponent will be given a further two months within which to file observations in reply to the applicant's submissions.

At this time, it is up to the Opponent to submit any proof of use of trade mark registrations, where the applicant has made a proof of use request. If proof of use cannot be submitted for any of the goods and services covered by the registration, it will fail as a ground of opposition. If only partial evidence of use can be submitted, the scope of this ground of opposition will be correspondingly restricted. The deadline for filing observations and evidence can be extended.

Decision and Appeals

Once the evidence rounds are completed, the EUTMO will make a decision on the opposition on the papers as filed. No oral hearings usually take place with EUTM Oppositions. An award of costs is usually granted to the winning party, but this is unlikely to cover all the costs of the proceedings.

A decision can be appealed either to the Boards of Appeal of the EUTMO and then up to the Courts of Justice.

How can HGF help?

We have extensive experience of prosecuting and defending trade mark oppositions. We are more than happy to assume responsibility for trade mark applications which have been opposed and provide cost effective advice.