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**REPORT ON THE WORK OF THE STANDING COMMITTEE ON THE LAW OF
TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (SCT)
ON AREAS OF CONVERGENCE CONCERNING TRADEMARK OPPOSITION
PROCEDURES**

Document prepared by the Secretariat

INTRODUCTION

1. From its sixteenth session (November 13 to 17, 2006) to its nineteenth session (July 21 to 25, 2008), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered a series of working documents on trademark opposition procedures (see documents SCT/16/4, SCT/17/4, SCT/18/3 and SCT/19/3).
2. At its twentieth session (December 1 to 5, 2008), the SCT agreed on the areas of convergence concerning trademark opposition procedures reproduced in the Annex to this document.

3. Furthermore, the SCT agreed at that session that the Secretariat would publish this document in the WIPO/STrad/INF series of documents, and bring it to the attention of the relevant WIPO Assemblies.

4. The General Assembly is invited to take note of the areas of convergence concerning trademark opposition procedures reproduced in the Annex to this document.

[Annex follows]

ANNEX

TRADEMARK OPPOSITION PROCEDURES
AREAS OF CONVERGENCE

Area of Convergence No. 1

Third Party Intervention in Trademark Registration Procedures

The availability of opposition procedures (pre-registration or post-registration opposition) is a desirable feature in trademark registration procedures and the SCT considers the implementation of opposition procedures in national and regional trademark registration systems to be useful for applicants, right holders and other interested third parties, trademark administrations and the public at large.

Notes

1.01 Independently from the type of procedure that a country may have in place, opposition proceedings as part of the trademark registration system are widely regarded as a useful feature of trademark registration procedures. They provide an opportunity for third parties to prevent the registration of potentially conflicting marks. Moreover, where oppositions may be filed on absolute grounds of refusal, third parties may submit to the Office additional information that could prevent the registration of a particular mark.

1.02 Whether pre or post-registration, opposition systems can share common features, such as a relatively simple and low cost administrative procedure that takes into account a limited number of grounds, without requiring the submission of evidence. Also, oppositions can be easily directed to and be heard by a specialized body, such as a board of appeal that can ensure consistency in decision making. Systems may also resemble a court action implying notice, pleadings, counterstatement, opponent's evidence, applicant's evidence, evidence in reply, a hearing and the possibility of an appeal route.

1.03 Area of convergence No. 1 is not meant to create a presumption as to who has legal standing under a particular national or regional opposition procedure. This is dealt with under Area of Convergence No. 4.

Area of Convergence No. 2
Relation Between Opposition and Examination Procedures

The combination of various trademark examination and opposition procedures presents a variety of options that follow established legal traditions and administrative practices. The SCT does not consider any of the existing approaches to constitute a preferred model. However, the SCT considers that factors such as procedural economy, timeliness of decisions, transparency of the examination procedures, and the safeguarding of third party interests should be guidelines to be followed by trademark administrations in implementing opposition procedures.

Area of Convergence No. 3
Grounds for Opposition

Oppositions may be based on a variety of grounds, some systems using a distinction between absolute and relative grounds for opposition. The SCT considers that opposition procedures should allow oppositions to be raised at least on the basis of prior trademark rights in the jurisdiction concerned.

Notes

3.01 The nature of grounds upon which a trademark may be opposed can vary. National and regional trademark laws stipulate detailed and sometimes exhaustive lists of grounds for opposition. Nevertheless, more general references as to conflicts with provisions of national or international law can be found, such as those included in international conventions or treaties in force for the jurisdiction concerned.

3.02 While a distinction between absolute and relative grounds for opposition is widely accepted, not all systems do necessarily follow that categorization, and oppositions may also be raised on any ground provided by law. Absolute grounds usually refer to the innate characteristics of the sign to function as a mark, and relative grounds relate to conflicts with established third party rights.

3.03 The reference to prior trademark rights includes unregistered trademark rights where they exist.

Area of Convergence No. 4
Entitlement to File an Opposition

There is considerable variety among different trademark registration systems with respect to the question of who is entitled to file an opposition against the registration of a trademark. The SCT considers that at least owners of prior trademark rights in the jurisdiction concerned should be entitled to raise an opposition.

Notes

4.01 There are essentially two positions with regard to the issue of standing to file an opposition. A liberal view, according to which standing to oppose extends to any person (natural or legal) who believes that it has valid grounds for raising an opposition. A more restricted approach requires that the opponent have a legitimate interest, which follows either from an application for registration or the registration of a potentially conflicting mark.

4.02 Experiences in relation to the issue of standing to file an opposition are contrasted and generally reflect different procedural options and legal perceptions. Entitlement to raise an opposition may be limited in order to discourage, for example, reckless oppositions which may work against efficient trademark administration. However, it is generally accepted that at least owners of prior trademark rights –including unregistered trademark rights where they exist– should be entitled to raise oppositions against potentially conflicting trademark registrations.

Area of Convergence No. 5
Opposition Period

Trademark registration systems provide for different initial opposition time limits. The SCT considers that initial opposition periods should provide a sufficient time frame for potentially opposing parties to obtain information about a particular application and to take the necessary steps to obtain advice and raise an opposition. The minimum initial time period available should at least be one month from the date of the publication of the application/registration or equivalent office action. Ideally, an initial opposition period would be two months and in any case not more than six months.

Notes

5.01 Depending on whether the system in place provides for pre-registration or post-registration opposition, the initial time limit may be calculated from the date of publication of the application or the registration of the mark. In some systems, the initial time limit might be calculated from the date of acceptance of the application.

5.02 Extensions of the initial time limit may either be granted or statutorily precluded. In some cases, a first extension may be granted upon request of the opponent, but a further extension may require the consent of the applicant and/or a showing of good cause. There may be a requirement that the request for extension should be filed before the expiration of the initial or previously extended opposition period.

5.03 There is a marked tendency of not allowing extensions of the initial opposition period, and even jurisdictions which had a generous practice of allowing such extensions have changed their laws to restrict that possibility. In some systems, however, it is perceived that once an opposition procedure is engaged, it is up to the parties to settle the matter, the trademark administration having only an obligation to oversee the procedures.

Area of Convergence No. 6
Observations

The SCT considers that the raising of observations constitutes a useful means of bringing facts to the attention of the examining Office, which could have a bearing on the decision of whether or not to register a given sign as a trademark, and which otherwise could remain unnoticed. Nevertheless, observations would not have to engage any obligation on the part of the Office.

Notes

6.01 Where observation procedures are available, observations or letters of protest may be presented by third parties in connection with or in parallel to opposition procedures. The person filing the observation does not become a party to the proceedings and should not expect an official reply. Systems that provide for observations to be made, may limit them to absolute grounds only or may allow them also on relative grounds.

6.02 Informal observations may be helpful and effective where the issue raised is not known to the examiner, for example, because a descriptive term would be known only to a specialized sector of the public. A letter of protest regarding, for example, the ownership of the relevant registration could result in the citation by an examiner, of an existing registration or prior-filed application.

Area of Convergence No. 7
“Cooling-off” Period

The SCT considers that cooling-off periods in opposition procedures or the extension of time limits to the same effect are a useful means of encouraging the settlement of cases, which, otherwise, would go to administrative or judicial decision making. Nevertheless, the implementation of such procedures should occur within carefully managed time frames so as to avoid their potential abuse.

Notes

7.01 A “cooling-off” period as part of an opposition procedure is, generally speaking, a single additional time limit, which is granted in addition to the initial opposition period upon request from one of the parties. During this period, applicant and opponent may engage in informal consultations and evaluate their positions with a view to reaching a settlement of the case.

7.02 Since the cooling-off period may also be extended, it could prolong opposition and therefore registration procedures. This could be considered a positive or negative feature, depending on the case and the overall design and management of each specific trademark system. There are different perceptions of the role that Offices and trademark administrations in general are expected to play.

7.03 The presence of cooling off periods in trademark opposition procedures is recent and also geographically restricted. Nevertheless, the preliminary evaluation is encouraging as shown by the percentages of oppositions settled during the cooling-off period.

[End of Annex and of document]