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TRADEMARK OPPOSITION PROCEDURES

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I. INTRODUCTION

1. At the fifteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 28 to December 2, 2005, the SCT requested the Secretariat of WIPO to prepare an information document on trademark opposition procedures (see document SCT/15/4, paragraph 16). Accordingly, the Secretariat has prepared the present document, which provides an overview of opposition systems (chapter I.), grounds for opposition (chapter II.) and certain procedural aspects (chapter III.).

2. The information contained in this document is based on the summary of replies to the Questionnaire on Trademark Law and Practice (see document WIPO/STrad/INF/1, hereinafter referred to as the “Questionnaire”). It reflects the replies contained in about 60 returns, which indicated that the applicable trademark law provided for an opposition procedure¹.

II. OVERVIEW OF OPPOSITION PROCEDURES

(a) Definition

3. Opposition systems offer third parties the opportunity to oppose the registration of a trademark within a certain period of time provided by the applicable law. An opposition must allege at least one of the grounds for opposition – either absolute or relative – among those that are recognized under the applicable law. Opposition procedures are closely related to the registration procedure. They may be part of the initial registration procedure (pre-registration opposition) or directly follow the completion of the registration process (post-registration opposition).

(b) Opposition *fora*

4. Opposition proceedings may be held before the trademark office (more than 50 affirmative answers) or another *forum*, such as a judicial or an administrative appeal authority (about 15 affirmative answers).

(c) Pre-registration opposition

5. In pre-registration opposition systems, different stages at which an opposition may be lodged can be distinguished. It may be possible to launch an opposition already before any examination (about five affirmative answers) or during the examination of the trademark by the Office (about five affirmative answers)². More often, opposition will be allowed after the examination of formal registration requirements (more than 20 affirmative answers), absolute grounds for refusal (about 35 affirmative answers) or relative grounds for refusal (about 25 affirmative answers)³.

(d) Post-registration opposition

6. In post-registration systems, an opposition can be launched after the trademark has been registered (more than 10 affirmative answers). Opposition after the completion of the initial registration process, however, may also be available as an additional possibility in trademark registration systems, which provide for pre-registration opposition at an earlier stage of the registration procedure (about 10 affirmative answers)⁴.

(e) Alternative procedures

7. Besides or instead of opposition procedures, national trademark systems may offer third parties the opportunity to object to a trademark registration through cancellation or invalidation procedures. These procedures take place after the trademark has been registered. They may be available before the trademark office or a court⁵ and allow the assertion of absolute grounds for refusal, such as descriptiveness or genericness, as well as relative grounds for refusal, such as conflicts with prior trademarks or protected geographical indications⁶.

8. In trademark systems, which do not provide for opposition procedures, cancellation and invalidation procedures offer the possibility to object to the registration of a trademark. In systems, which offer both opposition and cancellation/invalidation procedures, similarities as regards permissible grounds for objection and ways of presenting evidence might be found in both types of procedure. However, they may serve distinct purposes. Opposition may be designed as a relatively quick, cursory procedure intended to allow the settlement of a large number of standard cases through summary judgement. Accordingly, the grounds for opposition and the ways of presenting arguments and evidence may be limited. Cancellation and invalidation proceedings, by contrast, may be more comprehensive procedures excluding neither certain grounds for objection, nor forms of evidence.

(f) Relation with appeal procedures

9. In general, trademark systems provide for an appeal procedure against decisions taken by the trademark office or another competent trademark registration authority⁷. Frequently, provision is made for a review of a decision by a higher administrative authority or by a judicial authority⁸. As the replies to the Questionnaire indicate, the circle of persons entitled to file an appeal may include the parties to an opposition procedure⁹. The decision resulting from opposition procedures may thus be subject to further control by an appeal body, such as a court.

III. GROUNDS FOR OPPOSITION

(a) Absolute grounds

(i) *Compliance with definition of trademark*

10. Article 15(1) of the TRIPS Agreement provides a now internationally accepted definition of trademark. It stipulates that “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.” The replies to the Questionnaire indicate that

compliance with this definition may be tested in the context of opposition proceedings (more than 40 affirmative answers)¹⁰. A failure to comply with other requirements of the definition of a trademark, such as the requirement of being visually perceptible or capable of graphic representation, form a possible ground for opposition in many systems (more than 40 affirmative answers)¹¹.

(ii) *Distinctiveness, descriptiveness, genericness*

11. A reference to trademarks “devoid of any distinctive character” can be found in Article 6*quinquies*(B)(2) of the Paris Convention. The provision concerns exceptions to the principle, established in Article 6*quinquies*(A)(1), that a trademark “duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the [Paris] Union.” If the trademark is devoid of any distinctive character, this principle of “as is” or “*telle quelle*” registration need not be applied. Instead, countries of the Paris Union in which protection is sought by virtue of Article 6*quinquies* may deny registration or invalidate the trademark on the basis of the exceptions recognized in that Article.

12. Although the provision concerns the registration of a trademark, duly registered in the country of origin, in another country of the Paris Union, the grounds for denying registration or invalidating a trademark reflected in Article 6*quinquies*(B)(2) are often taken up also in national trademark laws as absolute grounds for refusal. Under many trademark systems, the missing distinctive character of a trademark for which registration is sought, for instance, constitutes a possible ground for opposition (more than 40 affirmative answers)¹².

13. Article 6*quinquies*(B)(2) also refers to trademarks which are descriptive as to “the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production,” and trademarks which have become “customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.” Frequently, these further indications are also taken up in national (or regional) trademark legislation. The descriptiveness of a mark for which registration is sought may form a possible ground for opposition (more than 45 affirmative answers)¹³. Signs which have become generic may be opposed for this reason in many countries (more than 40 affirmative answers). Similarly, the use of generic terms constitutes a possible ground for opposition in many countries (about 40 affirmative answers)¹⁴.

(iii) *Functionality*

14. The question of the functionality of a mark for which registration is sought may arise in trademark systems, which allow for the registration of three-dimensional shapes as marks. The potential exclusion of functional shapes corresponds to the principle that, in respect of inventions, patent protection preempts any other form of protection under intellectual property (see document SCT/9/6, paragraphs 39 to 46). By way of comparison, reference can be made to the field of industrial design protection, for which the last sentence of Article 25(1) of the TRIPS Agreement reflects this principle. The provision allows WTO Members to provide that industrial design protection “shall not extend to designs dictated essentially by technical or functional considerations.”¹⁵

15. In order to prevent the bypassing of the preemption rule through the acquisition of trademark rights, several trademark laws mention the functional character of a shape as an absolute ground for refusal (see document SCT/9/6, paragraph 43 and footnote 33). The Questionnaire on Trademark Law and Practice does not specifically seek information on whether functionality constitutes a ground for opposition.

(iv) *Public order and morality*

16. Besides the exceptions to the principle of “*telle quelle*” registration – established under Article 6*quinquies*(A)(1) of the Paris Convention – which have already been discussed above (see subsection (ii)), Article 6*quinquies*(B)(3) of the Paris Convention stipulates that a trademark duly registered in the country of origin may be denied registration or invalidated in other countries of the Paris Union when it is contrary to morality or public order and, in particular, of such a nature as to deceive the public. As returns to the Questionnaire clearly indicate, many trademark systems foresee that opposition proceedings may be initiated on these grounds (more than 45 affirmative answers)¹⁶.

(v) *Official signs and emblems*

17. Official signs and emblems of States and international intergovernmental organizations enjoy protection against unauthorized use and registration as marks under Article 6*ter* of the Paris Convention (see document SCT/15/3). In many trademark systems, opposition may be based on a potential conflict with Article 6*ter* (more than 45 affirmative answers)¹⁷. The protection of official signs may also result from special treaties, such as the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces, of August 12, 1949 (protection of the Red Cross and analogous symbols), and the Nairobi Treaty on the Protection of the Olympic Symbol, of September 26, 1981. A conflict with signs enjoying protection under special international conventions may also be considered in the framework of opposition proceedings (more than 40 affirmative answers)¹⁸.

18. In several trademark systems, opposition proceedings may also follow from a potential conflict with signs protected by national laws, such as royal emblems (more than 30 affirmative answers), signs of indigenous peoples and local communities (about 25 affirmative answers), or other signs (more than 25 affirmative answers)¹⁹.

(b) Relative grounds

(i) *Trademarks and other industrial property rights in signs*

19. The refusal of trademark registration on grounds that relate to prior acquired rights of third parties is generally illustrated by Article 6*quinquies*(B)(1) of the Paris Convention, albeit within the specific boundaries of that provision (see subsections (a)(i) and (iii)). Thus the denial of registration or the invalidation of trademarks is contemplated when they are “of such a nature as to infringe rights acquired by third parties in the country where protection is claimed.”

20. The provision in Article 6*quinquies*(B)(1) reflects the basic function of opposition proceedings, namely to offer third parties an opportunity, based on existing prior rights, to prevent the registration of a trademark. The consideration of prior trademarks in the framework of opposition proceedings is widespread, in particular as regards identical marks

registered or applied for by another person in respect of identical or similar goods or services (more than 55 affirmative answers), and similar marks registered or applied for by another person in respect of identical goods or services (more than 55 affirmative answers). Consideration is also given to similar marks registered or applied for by another person in respect of similar goods or services (about 55 affirmative answers)²⁰.

21. Prior well-known marks may also constitute a relative ground for refusal (about 55 affirmative answers)²¹. In many trademark systems, opposition proceedings can also be based on collective, guarantee or certification marks (more than 50 affirmative answers)²². Frequently, unregistered trademarks may be asserted in the context of opposition proceedings (about 40 affirmative answers)²³.

22. In addition to trademarks, prior rights in appellations of origin or geographical indications (more than 50 affirmative answers) as well as business names and business identifiers (about 45 affirmative answers) may constitute grounds for opposition in many trademark systems²⁴.

(ii) Other intellectual property rights

23. With regard to other intellectual property rights, the replies to the Questionnaire indicate that industrial designs and copyrights may constitute relative grounds for opposition in many trademark systems (more than 40 affirmative answers)²⁵.

(iii) Personality rights

24. In the field of personality rights, names of famous people and personal names frequently constitute grounds for opposition (about 45 affirmative answers)²⁶.

(c) Other absolute or relative grounds

25. The Questionnaire also deals with foreign words or expressions, which may constitute a ground for opposition in several trademark systems (22 affirmative answers)²⁷. It does not contain information on further grounds for refusal. Several respondents indicated that other grounds than those reflected in the Questionnaire may be accepted under their trademark systems (more than 20 affirmative answers) without specifying additional grounds²⁸. It seems that, for instance, international nonproprietary names of pharmaceutical substances (INNs) may be considered in the context of opposition proceedings (see document SCT/3/7).

IV. PROCEDURAL ASPECTS

(a) Publication

26. In almost all trademark systems providing for opposition proceedings, the publication of the mark for which protection is sought constitutes the starting point for opposition proceedings²⁹. Publication offers third parties the opportunity to take note of the registration process and decide on the assertion of earlier rights.

27. In most opposition systems, publication takes place in an official gazette, IP bulletin or other official journal. A publication in paper form may be supplemented by a publication on the web site of the IP Office. Some trademark systems provide for exclusive publication on the Internet³⁰.

28. The frequency of the publication seems to be weekly or monthly in the majority of trademark systems. However, other solutions, ranging from a daily update to a quarterly publication, can also be found in trademark law and practice³¹.

(b) Entitlement to file an opposition

29. In several trademark systems, an opposition may be filed by any person. Frequently, the showing of a legitimate interest is a prerequisite for the entitlement to file an opposition. Competent authorities, such as interested governmental bodies and authorities may be included in the circle of entitled persons. Some national systems specify that holders of prior rights or persons whose interests might be damaged by registration of the proposed trademark are entitled to file an opposition³².

(c) Opposition period

30. In trademark systems, which provide for pre-registration opposition, the date on which the application for registration is published, most often, is the starting date of the opposition period. Under post-registration opposition systems, the opposition period, predominantly, runs from the date on which the registration is published³³.

31. The opposition period frequently consists of two or three months. A shorter period of 30 days or longer periods of up to six months can be found in some trademark laws. Frequently, extensions of the initial opposition period are possible. An extension will often depend on a showing of proof of a good cause or legitimate reason for the requested extension³⁴.

(d) Arguments and evidence

32. The presentation of arguments and evidence in the framework of opposition proceedings may depend on the overall conception of the opposition system and the grounds invoked by the opposing party. If national law provides for a cursory procedure aiming at a summary judgment, the launching of an opposition need not necessarily require a detailed submission of the grounds for opposition but rather the submission of a standardized form. Evidence may be limited to written material, e.g. where the opposition is based on a prior registration recorded with the same office.

33. More comprehensive opposition systems may require that the grounds for opposition be described in detail. If written evidence gives rise to a need for further inquiry, witnesses may be heard or expert submissions received.

34. As to the sequence of the presentation of arguments and evidence, the launching of an opposition may first require the submission of arguments and information concerning the alleged prior rights. The opposition may then be communicated to the applicant for his or her information and the potential filing of a reply or counter-statement. Eventually, both parties may be given the opportunity to file evidence.

35. With regard to the factors which, in the course of opposition proceedings, are considered in determining a likelihood of confusion, replies to the Questionnaire seem to indicate that an analysis of the sound, appearance and meaning of the marks, the similarity of the goods and services, the use of the mark on the goods and services and the channels of trade may play a role³⁵.

(e) Settlement agreements

36. In the case of trademark systems providing for opposition procedures, the possibility to reach settlement agreements is frequently offered³⁶. The Questionnaire does not contain information on the way in which settlement talks between the parties or more formal settlement procedures are structured or taken into account in the opposition proceeding or in the final decision by the competent authority.

(f) Costs

37. In some trademark systems, the losing party bears a share, or the entire cost, of the opposition procedure. The competent authority may have the power to award costs. Most often, however, each party takes up the costs of its intervention in the procedure³⁷.

(g) Final decision

38. After the termination of opposition proceedings, a decision will be issued in three months or less than three months in many trademark systems. Often, a decision can be expected within six months or between six and eight months. Other opposition systems require a period of up to one year once an opposition procedure is finished. In some trademark systems, longer periods are needed for issuing a decision³⁸.

V. CONCLUSION

39. The information on trademark opposition procedures presented in this document can be summarized as follows:

40. The following features of opposition proceedings seem to be widespread among respondents to the Questionnaire:

- publication of the mark for which registration is sought in an official gazette, IP bulletin or other official journal as the starting point of the opposition procedure (see IV (a));
- an entitlement to file an opposition for persons showing a legitimate interest, such as ownership of relevant earlier rights (see IV (b));
- an opposition period of two or three months (see IV (c));
- the possibility of reaching settlement agreements in the framework of opposition proceedings (see IV (e));
- the division of costs between the parties to the opposition proceeding (see IV (f)).

41. In respect of the following elements of the opposition procedure, the replies to the Questionnaire point towards different approaches:

- the frequency of the publication of marks for which registration is sought (see IV (a));
- the average time it takes to issue a decision after the termination of an opposition proceeding (see IV (g)).

42. Areas in which a variety of different approaches exist include:

- the different absolute and relative grounds for refusal that may be asserted in the framework of opposition proceedings (see chapter III.);
- arguments and evidence that may be presented in the framework of opposition proceedings, including the form of presenting them (see IV (d));
- the way in which settlement talks or a more formal settlement procedure are included in the opposition procedure (see IV (e)).

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¹ See Summary of Replies to the Questionnaire on Trademark Law and Practice (SCT/11/6), document WIPO/STrad/INF/1, replies to V.1.A., A.(i), A.(ii) and A.(iii) (pp. 83-84).

² See Questionnaire, *ibid.*, replies to V.1.A(iv)(a) and (b) (pp. 85-86).

³ See Questionnaire, *ibid.*, replies to V.1.A(iv)(c), (d) and (e) (pp. 85-88).

⁴ See Questionnaire, *ibid.*, replies to V.1.A(v) (pp. 87-88) on the one hand and replies to V.1.A.(iv) (pp. 85-88) on the other hand.

⁵ See Questionnaire, *ibid.*, replies to X.1.C. and F. (pp. 164-169).

⁶ See Questionnaire, *ibid.*, replies to X.2.A. to I. (pp. 173-179).

⁷ See Questionnaire, *ibid.*, replies to VI.1.A. (pp. 122-123).

⁸ See Questionnaire, *ibid.*, replies to VI.1.A(iii) (pp. 122-123).

⁹ See Questionnaire, *ibid.*, replies to VI.3. (pp. 128-130).

[Endnote continued from previous page]

- ¹⁰ See Questionnaire, *ibid.*, replies to I.1.A. (pp. 6-7) and V.5.A. (pp. 99-100).
- ¹¹ See Questionnaire, *ibid.*, replies to I.1.B. and C. (pp. 6-7) and V.5.B. (pp. 99-100).
- ¹² See Questionnaire, *ibid.*, replies to V.5.C. (pp. 99-100).
- ¹³ See Questionnaire, *ibid.*, replies to V.5.D. (pp. 101-102).
- ¹⁴ See Questionnaire, *ibid.*, replies to V.5.E. and F. (pp. 101-102).
- ¹⁵ The full text of Article 25(1) of the TRIPS Agreement reads as follows: “Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.”
- ¹⁶ See Questionnaire, *ibid.*, replies to V.5.G. and H. (pp. 103-104).
- ¹⁷ See Questionnaire, *ibid.*, replies to V.5.I. (pp. 103-104).
- ¹⁸ See Questionnaire, *ibid.*, replies to V.5.J. (pp. 105-106).
- ¹⁹ See Questionnaire, *ibid.*, replies to V.5.K(i), (ii) and (iii) (pp. 105-108).
- ²⁰ See Questionnaire, *ibid.*, replies to V.5.Q., R., S. and T. (pp. 111-114).
- ²¹ See Questionnaire, *ibid.*, replies to V.5.L. (pp. 107-108).
- ²² See Questionnaire, *ibid.*, replies to V.5.X. (pp. 115-116).
- ²³ See Questionnaire, *ibid.*, replies to V.5.Y. (pp. 115-116).
- ²⁴ See Questionnaire, *ibid.*, replies to V.5.M. and N. (pp. 107-110).
- ²⁵ See Questionnaire, *ibid.*, replies to V.5.U. and V. (pp. 113-114).
- ²⁶ See Questionnaire, *ibid.*, replies to V.5.O. and W. (pp. 109-110 and 115-116).
- ²⁷ See Questionnaire, *ibid.*, replies to V.5.P. (pp. 109-110).
- ²⁸ See Questionnaire, *ibid.*, replies to V.5.Z. (pp. 115-116).
- ²⁹ See Questionnaire, *ibid.*, replies to V.1.A. and V.1.A.(iv) and (v) (pp. 83-88) on the one hand, and replies to V.3.D. (pp. 95-96) on the other hand.
- ³⁰ See Questionnaire, *ibid.*, replies to V.3.A. and V.3.C. (pp. 91-94).

[Endnote continued on next page]

[Endnote continued from previous page]

- ³¹ See Questionnaire, *ibid.*, replies to V.3.B. (pp. 93-94).
- ³² See Questionnaire, *ibid.*, replies to V.4.A. (pp. 97-98).
- ³³ See Questionnaire, *ibid.*, replies to V.3.D. (pp. 95-96).
- ³⁴ See Questionnaire, *ibid.*, replies to V.2.A. (pp. 89-90).
- ³⁵ See Questionnaire, *ibid.*, summary of replies to V.6.A. (p. 118).
- ³⁶ See Questionnaire, *ibid.*, replies to V.6.B. (pp. 117-118).
- ³⁷ See Questionnaire, *ibid.*, replies to V.6.C. and D. (pp. 117-121).
- ³⁸ See Questionnaire, *ibid.*, replies to V.6.E. (pp. 120-121).