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TRADEMARK OPPOSITION PROCEDURES

*Document prepared by the Secretariat*

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## I. INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 13 to 17, 2006, the SCT requested the Secretariat to prepare a working document on trademark opposition procedures on the basis of submissions by SCT Members (see document SCT/16/8, paragraph 13). Accordingly, the Secretariat has prepared the present document, which provides information about the relationship between examination and opposition procedures (Section II.), grounds for opposition (Section III.), opposition procedures (Section IV.), experiences with pre-registration and post-registration opposition (Section V.), and a summary (Section VI.).

2. This document is based on the Summary of Replies to the Questionnaire on Trademark Law and Practice (document WIPO/STrad/INF/1, hereinafter referred to as the “Questionnaire”) which includes the replies received from 73 Member States and three intergovernmental organizations<sup>1</sup>. It is also based on information submitted by the following members of the SCT, as agreed at the sixteenth session of the Standing Committee: Australia, Bulgaria, China, Croatia, Ecuador, Finland, France, Japan, Moldova, Morocco, Norway, Republic of Korea, Russian Federation, Slovakia, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, United Kingdom, United States of America, the European Community and the Benelux Organization for Intellectual Property (BOIP) on behalf of Belgium, Luxembourg and the Netherlands.

## II. RELATION BETWEEN OPPOSITION AND EXAMINATION PROCEDURES

### (a) Extent of Examination

3. The Office may examine an incoming trademark application with regard to compliance with

– formal requirements, absolute grounds for refusal and relative grounds for refusal (full examination);

– formal requirements and absolute grounds for refusal (partial examination)<sup>2</sup>.

4. In the course of the examination process, the applicant may be given the opportunity to present additional arguments in favor of the application, or to amend the application. This possibility may be offered, for instance, to avert an intended refusal or rebut a refusal that has already been issued<sup>3</sup>.

### (b) Examination and Grounds for Opposition

5. The relationship between a particular type of examination system and the related opposition procedure may be defined in different ways.

6. On the one hand, it may be possible that grounds of examination by the Office can be taken up again in the framework of opposition proceedings (parallel structure). An example would be a system in which a trademark application is examined as to formal, absolute and relative grounds for refusal by the Office. Opposition may also be based on formal, absolute

and relative grounds<sup>4</sup>. The parallel structure may be perceived as a means to reduce the number of oppositions. The examination by the Office as to relative grounds for refusal, for instance, may already exclude certain trademarks which conflict with earlier rights<sup>5</sup>.

7. On the other hand, the opposition procedure may be intended to complement the examination process. In this case, certain issues that are not examined by the Office can be raised within the framework of opposition proceedings (complementary structure). For instance, the Office may examine a trademark application as to formal and absolute grounds for refusal. Third parties may object to the trademark application on relative grounds in the framework of the opposition procedure<sup>6</sup>.

8. Finally, it may be felt that a full examination of trademark applications – as to formal requirements as well as absolute and relative grounds for refusal – reduces the need for opposition procedures. In such a system, the trademark registration is effected on the basis of the examination carried out by the Office. The examination process may be supplemented by an administrative cancellation procedure which permits to challenge a trademark on absolute and relative grounds after it has been registered<sup>7</sup>.

### (c) Interaction Between Examination and Opposition

9. In pre-registration opposition systems, oppositions that are brought against a trademark may influence the examination process by the Office. The trademark application may already be published for opposition at an early stage of the examination process – for instance, directly after the trademark application has been filed or after the formal examination. Further steps of the examination process may then be undertaken after the opposition period has expired or in parallel with the opposition procedure<sup>8</sup>. In addition, there may be a maximum time limit within which the Office has to examine the application as to substance irrespective of whether or not an opposition has been filed<sup>9</sup>.

10. An interaction between examination and opposition is also possible in case the opposition procedure begins after the Office has completed the examination process<sup>10</sup>. If, in the course of the subsequent opposition procedure, facts are disclosed which appear to render the trademark unregistrable, there may be a possibility for the opposition body to send the application back to the examiner for reexamination either *ex officio* or upon request of a party to the opposition procedure<sup>11</sup>.

## III. GROUNDS FOR OPPOSITION

### (a) Absolute Grounds

11. In trademark registration systems in which opposition can be based on absolute grounds for refusal, an opponent may be able to assert that the trademark concerned

- is not capable of distinguishing goods or services;
- is devoid of distinctive character;
- is descriptive or misdescriptive;

- has become generic (in current language or in the established trade practices);
- is contrary to morality or public order;
- may disrepute, disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols;
- is of such a nature as to deceive the public, for instance, with regard to the nature, quality or geographical origin of goods or services;
- conflicts with official signs or emblems protected under Article 6*ter* of the Paris Convention or according to national laws;
- conflicts with signs that have a high symbolic value, such as a religious symbol;
- conflicts with provisions prohibiting the re-registration of canceled trademarks;
- is functional;
- consists of or comprises a name, portrait or signature identifying a particular individual;
- is not intended for use by the applicant;
- has been registered in bad faith;
- has been obtained by fraud;
- has been abandoned;
- conflicts with provisions of international law, such as provisions of the Paris Convention for the Protection of Industrial Property<sup>12</sup>.

(b) Relative Grounds

12. In trademark systems in which opposition can be based on relative grounds for refusal, an opponent may be able to assert that the trademark concerned conflicts with
- a prior trademark;
  - a prior trademark application;
  - a well-known mark (including dilution of the mark's distinctive character or repute);
  - a registered defensive trademark;
  - a trade name;
  - a person's real or assumed name, likeness or portrait;

- the name of a famous person;
- the name of a plant variety;
- a protected geographical indication or appellation of origin;
- an industrial design;
- the title of a protected literary or artistic work;
- the copyright in a literary or artistic work<sup>13</sup>.

#### IV. OPPOSITION PROCEDURE

##### (a) Publication

13. The publication of a trademark application or registration constitutes the starting point of the opposition procedure<sup>14</sup>. In opposition systems in which the examination and the opposition procedure are carried out in parallel, the Office may be obliged to publish the trademark application within a certain time limit running from the filing of the trademark application<sup>15</sup>.

14. In systems where the opposition procedure follows the examination process, the publication takes place after the trademark application has been examined and accepted by the Office<sup>16</sup>. The applicable national law may provide for publication within a specific time limit, such as a time limit of one month running from the end of the formal examination of the application. The time limit may be supplemented by a maximum time limit for publication, such as a time limit of four months running from the filing date<sup>17</sup>.

15. In addition to a publication in paper form, the Office may provide for publication on its website<sup>18</sup>. In case of an international trademark registration, the publication in the *WIPO Gazette of International Marks* may be decisive<sup>19</sup>.

16. The publication may contain

- the number of the trademark;
- the filing or priority date;
- data identifying the applicant;
- an indication of the kind of mark;
- a representation of the mark;
- a claim of a color or several colors;
- an indication of the classes of goods and services concerned;

- a list of these goods and services;
- dates of use relating to the trademark concerned<sup>20</sup>.

(b) Opposition *Fora*

17. Opposition proceedings may be held before the Office or another *forum*, such as a judicial or administrative appeal authority<sup>21</sup>. The opposition body may consist of examination officers or be a specific opposition board composed of trademark judges, attorneys, paralegals and administrative clerks. A further example would be a collegial body of either three or five trial appeal examiners<sup>22</sup>. It is also conceivable that different Office departments be involved in the opposition procedure<sup>23</sup>. The role of the Office may change from administrative to that of a tribunal, acting in a quasi-judicial capacity<sup>24</sup>.

(c) Entitlement to File an Opposition

18. The circle of persons that can bring an opposition need not necessarily be limited. In certain trademark registration systems, any person can file an opposition<sup>25</sup>.

19. The entitlement to file an opposition may also require that the opposing party have a legitimate interest<sup>26</sup>. Standing in opposition procedures, for instance, may be limited to persons who believe that they would be damaged by the registration of the trademark concerned. In this case, a proof of standing may depend on the grounds asserted in the opposition. An opponent asserting that a trademark is descriptive, for instance, may be required to show that he or she is a competitor of the applicant and that the terms used by the applicant are needed by other competitors to describe the products concerned<sup>27</sup>.

20. The applicable law may also define the circle of persons who are entitled to bring an opposition. The circle may include:

- owners of trademarks that have been registered or protected earlier;
- trademark applicants that have filed an earlier application or benefit from an earlier priority date;
- owners of trademarks that have become well-known prior to the filing of the trademark application;
- holders of an exclusive trademark license;
- owners of protected geographical indications or appellations of origin, and holders of exclusive licenses;
- holders of rights in a name or personal portrayal;
- owners of other earlier industrial property rights, such as rights in trade names or plant varieties;
- owners of copyright in a work which is identical with or similar to the trademark for which registration is sought<sup>28</sup>.

21. A pre-registration opposition system limiting the circle of entitled persons may be supplemented by post-registration cancellation procedures that can be based on additional absolute or relative grounds for cancellation<sup>29</sup>.

22. National law may stipulate that the person filing an opposition does not become a party to the application proceedings. Nevertheless, the person may be entitled to receive, on request, information concerning the outcome of the objections raised<sup>30</sup>.

(d) Opposition Period

23. An opposition period of two or three months, running from the date of publication, can be found in several trademark registration systems<sup>31</sup>.

24. The opposition period may consist of several parts, such as an initial opposition period and extensions. The initial period, for instance, may be 30 days counted from the day of publication. The grant of extensions may depend on a showing of “good cause”, such as a statement that the potential opponent is investigating whether or not to file an opposition. It may also depend on whether the opponent has a legitimate interest in lodging the opposition. Consent of the applicant or a showing of extraordinary circumstances may constitute further criteria. Through requests for extension, the initial period may be prolonged for a period between one and six months<sup>32</sup>.

25. The opposition may also be submitted in stages. The opponent may be required to send a notice of opposition that contains a brief statement indicating the grounds for opposition, within an initial, not extendable period of two months. In a second step, the opponent can amend or supplement the grounds for opposition, or add further grounds, within a second period of 30 days running from the expiration of the initial period<sup>33</sup>.

(e) Arguments and Evidence

(i) *Notice of opposition*

26. The applicable law may require that, to commence the opposition procedure, a notice of opposition be submitted in writing or via fax, or filed electronically. The notice of opposition may contain

- information identifying the opponent;
- allegations as to the opponent’s entitlement to file an opposition;
- a representation of the opposed trademark;
- the number of the opposed trademark application;
- the issue number of the official publication in which the opposed trademark has been published;
- a representation of the earlier mark on which the opposition is based;



- an indication of the registry in which the earlier mark is registered (in case the mark has been registered internationally or under a regional trademark system);
- the registration number of the earlier mark;
- the classes in respect of which the earlier mark is registered;
- the goods and services for which the earlier mark is registered;
- information on changes in ownership concerning the earlier mark;
- information on limitations of the registration of the earlier mark, for instance, with regard to goods or services;
- a statement of use or details concerning reasons for non-use of the earlier mark (which may require to specify relevant goods and services);
- a statement of grounds and arguments containing, for instance, a comparison of goods and services and a comparison of the signs concerned<sup>34</sup>.

27. The payment of a fee may be necessary<sup>35</sup>. In certain trademark systems, the opposing party may be required to enclose, with the notice of opposition, evidence of the asserted grounds for opposition<sup>36</sup>. In other systems, evidence need not be offered at this initial stage of the opposition procedure<sup>37</sup>.

28. Once the notice of opposition has been filed, changes to the opposition may be limited to amendments of the grounds indicated in the notice of opposition and the means of proof<sup>38</sup>. It may be necessary to limit the notice of opposition to one ground for opposition. In case the opponent wishes to object to a trademark application on the basis of several prior trademarks, he or she may be obliged to file an individual notice of opposition for each earlier trademark<sup>39</sup>.

*(ii) Examination by the Office*

29. On receipt of the notice of opposition, the Office may examine the opposition as to formal requirements, such as

- the observation of the prescribed time limit;
- the entitlement of the opposing party to file an opposition;
- requirements relating to a power of attorney;
- the payment of opposition fees<sup>40</sup>.

30. The opposition body may also scrutinize the statement of grounds and require the opposing party to further explain its pleadings. If, without prejudging matters of substance, a particular ground of opposition is plainly unsustainable in the view of the opposition body, it may be in a position to object to this ground. The Office may also signal that it would expect

evidence later filed to support a particular claim<sup>41</sup>. Where two or more oppositions against a trademark are filed, the examination of the oppositions may be combined<sup>42</sup>.

31. In certain systems, an opposition may generally allow the Office to reassess the decision taken on a trademark application, irrespective of the grounds asserted by the opponent. This possibility may be limited to the goods and services affected by the opposition. If there are special reasons, the Office may have the authority to complete the opposition procedure even if it has been withdrawn by the opponent<sup>43</sup>.

*(iii) Notification to the applicant or holder*

32. The opposition will be communicated to the applicant who may answer to the notification within a certain time limit, such as a period between one and three months<sup>44</sup>. The applicable law may specify that the opposition shall be notified to the applicant without delay<sup>45</sup>.

33. The applicant's answer may contain affirmative defenses, such as acquiescence, fraud or prior registration. It may include counterclaims or a counter-statement admitting, denying with explanation or requiring proof of any of the grounds set out by the opponent<sup>46</sup>. The applicant may also be offered the opportunity to request a cooling-off period (see section (f), below)<sup>47</sup>. If the applicant does not react to the notification of opposition, he or she may be deemed to have withdrawn the trademark application. The Office will notify all answers and observations it receives from the applicant to the other party<sup>48</sup>.

34. In certain post-registration opposition systems, a reply to the notification of an opposition is required only upon receipt of a further notification from the Office containing reasons for the revocation of the trademark registration. With regard to this additional notification, the parties to the opposition procedure will be given the opportunity to submit a statement of their arguments within an adequate period of time<sup>49</sup>.

*(iv) Consideration by the Office*

35. The opposition body may take a decision on the trademark application or registration on the basis of the information submitted by the opponent and the answer given by the trademark applicant or holder<sup>50</sup>. If the applicant does not react to the opposition, the Office may base its decision on an assessment of the arguments and evidence presented by the opposing party<sup>51</sup>. The applicable law may also allow the Office to suspend the application procedure with regard to the objections raised in the opposition without verifying the allegations of the opponent<sup>52</sup>.

36. The opposition body may judge the issues raised by the parties and issue a draft decision or preliminary indication. In case the parties accept the proposal by the opposition body, it will be regarded as the final decision and the proceedings will be closed. If either party does not wish to accept the proposal, the continuation of the proceedings may be requested. There may be a time limit, such as a time limit of 15 days or one month, within which the parties must give notice of their intention to proceed. The notice may require a written request or a request for oral hearings. If no such notice is received within the prescribed time limit, the parties' agreement with the preliminary indication may be presumed<sup>53</sup>.

(v) *Filing of evidence*

37. In opposition systems where evidence need not be enclosed with the initial notice of opposition or the applicant's response, the parties may be required to file evidence in support of their case within a certain time limit, such as a time limit of three months. It may also be possible to supplement evidence that has been filed earlier<sup>54</sup>. If the opponent does not file evidence, the opposition may be deemed to be withdrawn<sup>55</sup>.

38. The disclosure of information may improve the chances of settlement negotiations and an early resolution of the case. There may also be a possibility of the parties requesting and receiving relevant information from each other to evaluate their claims and defenses. For this purpose, the parties may be permitted to submit questions to the other party that must be answered within a certain time limit. A further possibility would be a request for documents or deposition before a court reporter<sup>56</sup>.

39. It may also be stipulated that, after the initial notification of the opposition to the applicant, the exchange of briefs between the parties shall continue until the case is adequately examined. In this case, evidence may be limited to written material, objects or sound recordings. The Office would act primarily as an intermediary transmitting material from one party to the other<sup>57</sup>.

40. There may also be a specific system of evidential rounds. In reply to the filing of evidence by one party, the other party, in turn, may be allowed to file evidence which, however, must be confined strictly to matters in reply. A party filing evidence may be obliged to send a copy of the submission to the other party. The number of evidential rounds may be limited. Following the final round of evidence, the parties may have a choice as to how the final decision should be reached by the opposition body. Besides a decision based on all the evidence and submissions, it may be possible to request an oral hearing<sup>58</sup>.

41. In opposition systems that are similar to court proceedings, the initial exchange of information may be followed by a testimony period allowing for oral examination, written questions, testimony of witnesses and the introduction of written evidence, such as official records or printed publications. In case of insufficient cooperation of one of the parties with regard to the exchange of information and testimony, the opposition system may provide that motions can be filed with the opposition body in order to obtain the necessary information or testimony<sup>59</sup>.

(vi) *Oral hearings*

42. In certain opposition systems, the opposition body may hold oral hearings to ask questions about facts and arguments presented by the parties. According to the applicable law, oral hearings may be held only if requested by one of the parties. For this purpose, a specific commission may be established at the Office. The hearings may be conducted with the parties in person, via telephone or through a video conference. After the final hearing, the opposition system may allow for requests for rehearing, reconsideration, or modification of a decision taken by the opposition body on the basis of the evidence provided by the parties and the outcome of the hearings<sup>60</sup>.

(f) Settlement and “Cooling-off” Period

43. The opposition system may offer room for settlement talks<sup>61</sup>. An example would be a system in which the opponent, instead of directly filing the opposition, may first request several extensions of the opposition period. During the additional time periods resulting from extensions, the parties can determine whether their dispute can be resolved before officially submitting an opposition<sup>62</sup>. After the opposition is filed, it may be possible for the parties to request the suspension of the opposition procedure in order to enter into settlement discussions (see section (h), below).

44. The applicable law may also provide for a so-called “cooling-off” period. In this case, the parties to the opposition are given a certain period, ranging from two to twelve months, to exchange arguments or ask for proof of facts, such as proof for the use of a trademark. The cooling-off period may start after the opposition has been notified to the applicant. For instance, there may be a possibility of either party making a request for an extension of the period within which the applicant has to submit the counter-statement. Both parties may be required to agree on the cooling-off period. At the joint request of both parties, it may be extended. In case no settlement can be reached, the cooling-off period may be terminated early. Failure to resolve matters during the cooling-off period need not necessarily exclude later settlement negotiations in the course of the opposition proceedings<sup>63</sup>.

(g) Extension of Time Limits

45. While the initial opposition period may not be extendable<sup>64</sup>, an extension of time limits may be available during the opposition proceedings for several procedural acts, such as

- amendments to the notice of opposition in the case of foreign opponents;
- the submission of a reply to the other party;
- the filing or service of evidence<sup>65</sup>.

46. It may be possible to file a request for the extension of a time limit even after the time limit has expired. The request, however, may require the indication of satisfactory reasons for the delay<sup>66</sup>.

(h) Suspension of Proceedings

47. Opposition proceedings may be suspended in the following cases:

- opposition based on a pending prior trademark application;
- pending court decision that may have a bearing on the decision of the opposition body, such as a court decision concerning the annulment or invalidation of a trademark;
- joint request of the parties for suspension (for instance, to allow settlement negotiations);
- during the process of examining the application as to absolute grounds for refusal<sup>67</sup>.

48. The suspension of opposition proceedings because of a pending court decision may require that the parties to the opposition procedure be involved in the court proceedings<sup>68</sup>. In certain systems, the examination of the opposition, in principle, may take precedence. In this case, the suspension of the opposition procedure may require that the court proceedings start prior to the examination and be concluded quickly<sup>69</sup>.

(i) Final Decision

49. Based on all available evidence, a board including administrative trademark judges or consisting of opposition examining officers may take a final decision. The decision may be published in the official gazette of the Office and/or on the web site of the Office.

50. The time needed by the Office for issuing the final decision may vary depending on the resources and current case load of the Office<sup>70</sup>. However, once the case is adequately examined, the parties may be notified that the final decision can be expected within a certain period of time<sup>71</sup>.

51. In case the opposition procedure has to be concluded in a specific time limit, such as a time limit of six months, extensions may be possible on request of one of the parties, on joint request of both parties or on the initiative of the opposition board. A request submitted by only one of the parties or an Office decision may require the indication of reasons for the extension<sup>72</sup>.

(j) Appeal

52. Against the final decision of the opposition body, an appeal to a specific board of appeals at the Office, a specific government commission, an appointed person acting as an appellate tribunal, the courts in general or to a specific trade or patent court may be possible within a specific time limit, such as a time limit of one or two months. In case of foreign applicants, a longer time limit may be offered. Against the appeal decision of an appeal board, a further appeal to the courts may be possible. An appeal to an appointed person may exclude further rights of appeal. Against the appeal decision of a court, an appeal to a higher court may be possible<sup>73</sup>.

53. In respect of appeal to the courts, the parties to the opposition procedure may have different options, such as a request for new trial to a district court, or an appeal to an appeal court based on the closed record of the opposition procedure. In the latter case, the appeal court will not accept the introduction of new evidence<sup>74</sup>.

(k) Fees and Costs

54. In case the filing of an opposition requires the payment of a fee, the losing party to the opposition may be obliged to pay the opposition fee<sup>75</sup>. The amount may depend on the number of classes of goods and services which the opposition concerns<sup>76</sup>.

55. Opposition procedures may imply further costs for the parties, such as the cost of legal advice, for compilation of evidence, for research and investigation, for letters and for representation at hearings<sup>77</sup>. Each party to the opposition procedure may be obliged to bear

its own cost of the proceedings<sup>78</sup>. In this case, the opposition body is exempted from the potentially complex task of awarding costs. Unlike the courts, the Office may not have the power of awarding costs to the winning party<sup>79</sup>.

56. It is also conceivable that costs will be awarded at the termination of opposition proceedings. The award may be made from a scale of costs which is regarded as contributory rather than compensatory in order not to deter anyone from seeking protection for intellectual property rights. Accordingly, the losing party will be unlikely to reimburse the total cost of the proceedings to the other parties<sup>80</sup>.

#### (l) Related Procedures

57. In certain countries, the opposition procedure is supplemented with a related procedure that also offers the opportunity to raise objections against the registration of a trademark.

58. An example would be a system in which anyone, prior to the registration of the trademark concerned, can submit written observations at any stage of the registration procedure. An objection that is raised in this framework will not be treated as a formal opposition. The person submitting observations does not become a party to the proceedings before the Office. Instead, the Office will take observations into account when deciding on the registration of the trademark. The applicant may be given the opportunity to file a counter-statement. Both the applicant and the person who made observations may be informed about the results of the submission<sup>81</sup>.

59. A pre-registration opposition system may also be accompanied by invalidation proceedings that, after the registration of a trademark, can be initiated either before the Office or before the courts. If the trademark is declared invalid in the course of the invalidation procedure, the registration may be deemed never to have been made. The different stages of invalidation procedures held before the Office may be similar to the steps taken in the course of pre-registration opposition proceedings<sup>82</sup>.

60. In systems which do not provide for opposition procedures, an administrative cancellation procedure before a specific body, such as a chamber of disputes, may offer the possibility to challenge a trademark after it has been registered on the basis of the examination undertaken by the Office<sup>83</sup>.

61. A combination of different procedures may result from the fact that the opposition body only has limited jurisdiction related to the registrability of a trademark. In certain cases, such as the issuing of injunctions against the use of a trademark, a combination with court proceedings may be possible under national law<sup>84</sup>.

## V. EXPERIENCES

### (a) General

62. Opposition procedures may be considered a relatively fast and cost-efficient way of preventing the registration of signs that do not comply with the applicable law. They may require less time than court proceedings. They may be regarded as a means to avoid the potentially high costs associated with court action. Further cost savings may be realized in

opposition systems that do not require the parties to be represented by an attorney or other representative<sup>85</sup>.

63. As to the work of trademark Offices, opposition procedures may imply certain organizational difficulties with regard to staff and the reduction of a potential backlog<sup>86</sup>.

(b) Pre-registration Opposition

64. The establishment of a pre-registration opposition system may underlie the consideration that it is better to prevent the acquisition of trademark rights rather than to bestow rights only later to extinguish them. The core benefit of the system can be seen in the fact that it allows a determination as to whether an applicant has the right to register a given sign, as against any third party, prior to the acquisition of rights resulting from registration<sup>87</sup>.

65. Pre-registration opposition may be intended to avoid the uncertainty of untested registrations on the register. It may be regarded as a means to protect the rights of third parties and respond to the applicant's interest in legal certainty<sup>88</sup>.

66. On the other hand, the opposition procedure may prolong the registration process substantially. For a pre-registration system to fulfil its functions, business circles must be aware of the necessity to follow the publication of trademark applications<sup>89</sup>.

(c) Post-registration Opposition

67. It may be felt that trademark applications can be dealt with faster in post-registration opposition systems. After the examination of an application by the Office, the trademark registration can directly be effected, published in the official gazette and notified to the applicant. Applicants can quickly obtain a right without being obliged to wait for the expiry of the opposition period<sup>90</sup>.

68. As to Office procedures, a post-registration system may be seen as a means to simplify the registration procedure and render it more efficient. Advantages may be derived from the fact that the Office need not take any further measures after registration if no opposition is lodged. The post-registration system requires only one publication of the trademark whereas, under a pre-registration system, both the trademark application and the final trademark registration are published – regardless of whether an opposition is raised<sup>91</sup>.

69. In case of successful opposition, the trademark registration will be revoked. A public notice of the revocation may be given<sup>92</sup>. The registration fee will not necessarily be returned to the applicant<sup>93</sup>.

70. It may be regarded as a disadvantage of post-registration opposition systems that the Office cannot use the opposition period to review its own examination of the trademark application<sup>94</sup>.

## VI. SUMMARY

71. The information on trademark opposition procedures presented in this document and compiled on the basis of submissions transmitted by members of the SCT, can be summarized as follows:

72. As to the relationship between opposition and examination procedures, certain national systems allow an opposition to be based on all issues that are also examined by the Office (parallel structure). In other systems, opposition procedures are limited to issues that are not part of the examination by the Office (complementary structure) (see Section II.).

73. The grounds for opposition depend on the relationship between opposition and examination procedures. In a national system establishing a parallel structure, it may be possible to assert formal, absolute and relative grounds for opposition. In a national system establishing a complementary structure, the grounds for opposition may be limited to relative grounds. The specific grounds to be found in a given national or regional system reflect different legal traditions and approaches to trademark registration (see Section III.).

74. As to the opposition procedure, the following observations can be made:

- in addition to the publication of a trademark application or a trademark registration in paper form, the application may be published in electronic form;
- the opposition may be examined by an examination officer, a collegial body of examiners or a board including a trademark judge;
- the opposition system may permit *any* person to lodge an opposition, limit the entitlement to file an opposition to persons having a legitimate interest, or specifically define the circle of persons entitled to bring an opposition;
- the opposition period may consist of one single, non-extendable term, or of an initial term and several extensions;
- the different procedural steps may be as follows:
  - notice of opposition submitted by the opponent;
  - formal examination of the notice of opposition by the Office;
  - notification of the opposition to the applicant or holder;
  - exchange of further evidence;
  - final decision by the Office;
- settlement negotiations may take place between the parties during the time the initial opposition period is extended, while the opposition proceedings are suspended on joint request of both parties, or during a so-called “cooling-off” period starting after the opposition has been notified to the applicant or holder;



– an extension of time limits may particularly be available in the period during which the parties exchange arguments and evidence;

– against the final decision of the opposition body, an appeal to a specific board of appeals at the Office, a specific government commission, an appointed appellate tribunal, the courts in general, or a specific trade or patent court may be possible (see Section IV.).

75. A pre-registration opposition system may be established to avoid the uncertainty of untested registrations on the register. It may substantially prolong the registration procedure. A post-registration opposition system may be established to allow applicants to obtain trademark rights quickly without being obliged to wait for the expiry of the opposition period. If no opposition is lodged, the Office need not take any further steps (see Section V.).

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<sup>1</sup> In the submissions by the Delegations of Sweden (p. 1) and Switzerland (p. 5), reference is made to the replies to the Questionnaire on Trademark Law and Practice.

<sup>2</sup> See Questionnaire, *ibid.*, replies to IV.1.A. (pp. 51-52).

<sup>3</sup> See submissions by the Delegations of the Republic of Korea (pp. 1-2) and the United States of America (p. 4).

<sup>4</sup> See submissions by the Delegations of Finland (p. 3), the United Kingdom (pp. 1-2) and the United States of America (p. 6).

<sup>5</sup> See submissions by the Delegations of Australia (p. 4) and the United States of America (p. 13).

<sup>6</sup> See submissions by the Delegations of Croatia (p. 3) and Slovakia (pp. 1-2), and the Representative of the European Community (p. 2).

<sup>7</sup> See submission by the Delegation of the Russian Federation (p. 1). Cf. Questionnaire, *ibid.*, replies to X.1.C. and F. (pp. 164-169) and X.2.A. to I. (pp. 173-179).

<sup>8</sup> See Questionnaire, *ibid.*, replies to V.1.A. (iv)(a), (b) and (c) (pp. 85-86).

<sup>9</sup> See submissions by the Delegations of Bulgaria (p. 2), Ecuador (pp. 8-9) and France (p. 1).

<sup>10</sup> See Questionnaire, *ibid.*, replies to V.1.A. (iv)(d) and (e) (pp. 87-88).

<sup>11</sup> See submission by the Delegation of the United States of America (p. 10).

<sup>12</sup> See submissions by the Delegations of Australia (p. 1), Finland (p. 3), Japan (p. 1), Slovakia (p. 1), the United Kingdom (pp. 14-16) and the United States of America (pp. 3-4 and 6). Cf. Questionnaire, *ibid.*, replies to V.5.A. to K. (pp. 99-108) and document SCT/16/4, paragraphs 10-18.

<sup>13</sup> See submissions by the Delegations of Australia (p. 1), Croatia (p. 3), Finland (pp. 3-4), France (p. 2), Japan (pp. 1-2), Slovakia (p. 2) and Slovenia (p. 2-3). Cf. Questionnaire, *ibid.*, replies to V.5.L. to Z. (pp. 107-116) and document SCT/16/4, paragraphs 19-24.

<sup>14</sup> See Questionnaire, *ibid.*, replies to V.3.D. (pp. 95-96).

<sup>15</sup> See submission by the Delegation of France (p. 2).

<sup>16</sup> See submission by the Delegation of the United Kingdom (p. 1).

<sup>17</sup> See submission by the Delegation of Bulgaria (p. 2).

<sup>18</sup> See submissions by the Delegations of the Republic of Korea (pp. 1-2) and Norway (p. 2). Cf. Questionnaire, *ibid.*, replies to V.3.A. and C. (pp. 91-94).

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- 19 See submission by the Delegation of France (p. 2).  
20 See submissions by the Delegations of Bulgaria (p.2) and the United States of  
America (pp. 1-2).  
21 See Questionnaire, *ibid.*, replies to V.1.A. (i), (ii) and (iii) (pp. 83-84).  
22 See submissions by the Delegations of Japan (p. 2), Moldova (p. 2), Norway (p. 1) and the  
United States of America (p. 10).  
23 See submission by the Delegation of Moldova (p. 2).  
24 See submission by the Delegation of the United Kingdom (p. 2).  
25 See submissions by the Delegations of Australia (p. 1), Bulgaria (p. 2), China (pp. 4-5),  
Japan (p. 1), Norway (p. 1), Moldova (p. 2), Sweden (p. 1) and the United Kingdom (pp. 1-2).  
Cf. Questionnaire, *ibid.*, replies to V.4.A.(i) (pp. 97-98).  
26 See submission by the Delegation of Ecuador (pp. 8-9). Cf. Questionnaire, *ibid.*, replies to  
V.4.A.(ii) (pp. 97-98) and document SCT/16/4, paragraph 29.  
27 See submission by the Delegation of the United States of America (p. 6).  
28 See submissions by the Delegations of France (p. 3), Morocco (p. 2), Slovenia (pp. 1-2) and  
The former Yugoslav Republic of Macedonia (pp. 1-2), and the Representatives of the Benelux  
Organization for Intellectual Property (BOIP) (pp. 3-4) and the European Community (p. 2).  
29 See submission by the Representative of the European Community (p. 2).  
30 See submission by the Delegation of Bulgaria (p. 2).  
31 See Questionnaire, *ibid.*, replies to V.2.A. (pp. 89-90) and V.3.D. (pp. 95-96).  
Cf. document SCT/16/4, paragraphs 30-31.  
32 See submissions by the Delegations of Ecuador (pp. 8-9) and the United States of  
America (p. 5).  
33 See submissions by the Delegations of Japan (p. 1) and the Republic of Korea (pp. 1-2).  
34 See submissions by the Delegations of Bulgaria (p. 2), China (pp. 4-5), France (p. 3), the  
Republic of Korea (pp. 1-2), Sweden (p. 1), the United Kingdom (pp. 2-3) and the United States  
of America (p. 7).  
35 See submissions by the Delegations of Australia (p. 1), Ecuador (pp. 8-9), France (p. 3) and the  
United Kingdom (p. 3).  
36 See submissions by the Delegations of Australia (pp. 1-2), China (pp. 4-5), Slovenia (pp. 1-2)  
and The former Yugoslav Republic of Macedonia (p. 2).  
37 See submissions by the Delegations of Norway (p. 2), the Republic of Korea (pp. 1-2), the  
United Kingdom (pp. 3 and 7), the United States of America (pp. 7-8 and 12).  
38 See submission by the Delegation of Japan (p. 1).  
39 See submission by the Delegation of France (p. 3).  
40 See submissions by the Delegations of Slovenia (pp. 1-2) and The former Yugoslav Republic of  
Macedonia (p. 2).  
41 See submission by the Delegation of the United Kingdom (p. 3).  
42 See submission by the Delegation of Japan (p. 2).  
43 See submissions by the Delegations of Japan (p. 2) and Sweden (p. 1).  
44 See submissions by the Delegations of China (pp. 4-5), Ecuador (pp. 8-9), Norway (p. 2),  
Slovenia (pp. 1-2), The former Yugoslav Republic of Macedonia (p. 2) and the United States of  
America (p. 7).  
45 See submissions by the Delegations of France (p. 4) and Morocco (p. 2).  
46 See submissions by the Delegations of the United Kingdom (pp. 3-4) and the United States of  
America (p. 7).  
47 See submission by the Delegation of the United Kingdom (p. 4).  
48 See submissions by the Delegations of Morocco (p. 2) and the United Kingdom (p. 3).  
49 See submission by the Delegation of Japan (p. 2).

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- 50 See submissions by the Delegations of Ecuador (pp. 8-9), Slovakia (p. 3), Slovenia (pp. 1-2),  
Sweden (p. 1) and The former Yugoslav Republic of Macedonia (p. 2).
- 51 See submissions by the Delegations of China (pp. 4-5) and The former Yugoslav Republic of  
Macedonia (p. 2).
- 52 See submission by the Delegation of Slovakia (p. 3).
- 53 See submissions by the Delegations of France (p. 4), Morocco (p. 3) and the United  
Kingdom (p. 5).
- 54 See submission by the Delegation of China (pp. 4-5).
- 55 See submission by the Delegation of the United Kingdom (p. 7).
- 56 See submission by the Delegation of the United States of America (pp. 8-9).
- 57 See submission by the Delegation of Norway (p. 2).
- 58 See submissions by the Delegations of Australia (p. 3) and the United Kingdom (pp. 7-8).
- 59 See submission by the Delegation of the United States of America (pp. 11-12).
- 60 See submissions by the Delegations of Australia (p. 3), China (pp. 4-5), France (p. 4),  
Japan (p. 2), the United Kingdom (p. 8) and the United States of America (p. 10).
- 61 See Questionnaire, *ibid.*, replies to V.6.B. (pp. 117-118).
- 62 See submission by the Delegation of the United States of America (p. 5).
- 63 See submissions by the Delegation of the United Kingdom (p. 4) and the Representative of the  
Benelux Organization for Intellectual Property (BOIP) (pp. 3-4).
- 64 See submissions by the Delegations of Croatia (p. 3), France (p. 2) and the United  
Kingdom (p. 8), and the Representative of the European Community (p. 2).
- 65 See submissions by the Delegations of Australia (p. 3), Ecuador (pp. 8-9), Japan (p. 1),  
Norway (p. 2), Slovenia (pp. 1-2), and the United States of America (pp. 11-12).
- 66 See submission by the Delegation of the United Kingdom (p. 8).
- 67 See submissions by the Delegations of Australia (p. 3), France (p. 4), Morocco (p. 2) and the  
United States of America (pp. 11-13), and the Representative of the Benelux Organization for  
Intellectual Property (BOIP) (pp. 3-4).
- 68 See submission by the Delegation of the United States of America (p. 12).
- 69 See submission by the Delegation of Japan (p. 4).
- 70 See Questionnaire, *ibid.*, replies to V.6.E. (pp. 120-121).
- 71 See submission by the Delegation of Norway (p. 3).
- 72 See submissions by the Delegation of Morocco (p. 3).
- 73 See submissions by the Delegations of Croatia (p. 3), France (p. 2), Japan (pp. 3-4),  
Norway (p. 3), Slovenia (pp. 1-2), Sweden (p. 1), The former Yugoslav Republic of  
Macedonia (p. 2), the United Kingdom (p. 14) and the United States of America (p. 10),  
and the Representative of the Benelux Organization for Intellectual Property (BOIP) (pp. 3-4).  
Cf. Questionnaire, *ibid.*, replies to VI.1.A. (pp. 122-123) and VI.3. (pp. 128-130).
- 74 See submission by the Delegation of the United States of America (p. 10).
- 75 See submission by the Representative of the Benelux Organization for Intellectual  
Property (BOIP) (pp. 3-4).
- 76 See submission by the Delegation of the United States of America (p. 5).
- 77 See submission by the Delegation of the United Kingdom (p. 14).
- 78 See Questionnaire, *ibid.*, replies to V.6.C. (pp. 117-118).
- 79 See submissions by the Delegations of Norway (p. 3) and the United States of America (p. 11).
- 80 See submission by the Delegation of the United Kingdom (p. 14).
- 81 See submissions by the Delegations of Norway (p. 1) and Slovakia (p. 3).
- 82 See submission by the Delegation of the United Kingdom (pp. 9-12).
- 83 See submission by the Delegation of the Russian Federation (p. 1).
- 84 See submission by the Delegation of the United States of America (p. 6).

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- 85 See submissions by the Delegations of Australia (p. 4), France (p. 1), Slovenia (pp. 1-2) and  
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- 86 See submission by the Delegation of Slovenia (pp. 1-2).
- 87 See submission by the Delegation of the United States of America (p. 1).
- 88 See submissions by the Delegations of Australia (pp. 4-5), China (pp. 4-5), Slovakia (p. 3),  
Slovenia (pp. 1-2) and the United States of America (p. 1).
- 89 See submissions by the Delegations of Slovenia (pp. 1-2) and The former Yugoslav Republic of  
Macedonia (p. 2).
- 90 See submissions by the Delegations of Finland (p. 3) and Japan (p. 5).
- 91 See submissions by the Delegations of Finland (p. 3), Japan (p. 5) and Sweden (p. 1).
- 92 See submission by the Delegation of Finland (p. 3).
- 93 See submission by the Delegation of Japan (p. 8).
- 94 See submission by the Delegation of Japan (p. 5).