

Trademark Bulletin –January 2008

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## Change of Practice in OHIM Opposition Proceedings against Community Trademarks

In order to streamline opposition proceedings, the Office for Harmonization in the internal Market has made a number of changes to both the admissibility and the adversarial phases of the trade mark opposition procedure.

The main aims are to simplify the admissibility check process; provide clarity on the division of costs when either an opposition or a CTM application is withdrawn; and reduce the administrative burden associated with requests for repeated extensions of suspension periods.

The changes will be implemented as of 17/09/2007, and will apply to all oppositions, including pending oppositions, apart from the exception made in Paragraph 2 of this communication. All standard letters have been updated to reflect the changes so that the parties are informed in each case.

### I. Changes regarding the admissibility check

Two minor changes will be introduced in the admissibility check process. First of all, oppositions will be considered admissible if all absolute and relative requirements for admissibility are complied with for at least one of the earlier mentioned rights. The second change will consist in accepting the indication of the class number(s) as a sufficient indication of the goods and services of the earlier rights upon which the opposition is based.

Both changes enhance swift notification of almost all oppositions to the applicant, avoiding the submission of deficiency letters to the opponent that often cause a three months delay in the proceedings. These changes only affect oppositions against direct CTM applications. The changes will not apply to oppositions against designations of the EC under the Madrid Protocol.

### II. Changes regarding the adversarial part of proceedings

With the aim of dealing with the opposition files more diligently during the adversarial part of the proceedings, the following three further improvements will be made:

#### (1) Cost decisions

Cost decisions will be issued together with the confirmation of the withdrawal, either of the opposition, or of the CTM application itself. Until now, when one of the parties withdrew during the adversarial part of the proceedings, but no indication was given as to whether the parties had agreed on the costs, the Office would give the parties two months to confirm if a cost agreement had been reached.

Now, the decision on costs will be taken immediately, i.e. together with the confirmation of the withdrawal. Only if the parties inform the Office in advance of their agreement about the costs will no decision on costs be taken. While the Office's cost decisions, once taken, will not be revised, the parties remain free to respect any voluntary cost agreements that they

may reach. The implementation of this change will mean that parties will not have to wait for the cost decision anymore, and that the proceedings are closed immediately after the withdrawal.

## (2) Renewed requests for suspensions

In order to avoid repetitive joint requests to continue suspensions every two months if the parties have not finished their negotiations, the Office will now *ex officio* grant the second request for suspension for a period of one year, giving the parties the possibility to opt out. The process is the same as for the extension of the cooling off period.

## (3) Rule 79a CTM IR

Rule 79a sets out that in *inter partes* proceedings, the parties must provide a copy of the documents submitted unless these are submitted by fax. Now, evidence without a copy as mentioned above, will be rejected and not taken into account. No period of time will be given for providing a copy. (Standard letters have been updated and contain a warning that observations and evidence not sent by fax and not consisting of loose sheets must be sent together with a copy).

## New Handbook on Trademark Law published



International publisher Wolters Kluwer has launched a new Book of 1200 pages in German, edited by two partners of **Lippert, Stachow & Partner** (Members of World Link for Law & BrandVue). The work is a compilation of the most important forms and documents practitioners may require in trademark law in their daily work. It provides many ideas and commentary concerning the proceedings of German, European and International Trademark Law.

*Hoffmann / Kleespies / Adler (Hrsg.)*  
**Formularkommentar Markenrecht**  
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