

TRADE MARK OPPOSITION PRACTICES / OUTCOMES

9th FICPI

OPEN FORUM

LISBON - PORTUGAL

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TO OPPOSE OR NOT TO OPPOSE



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OUTSIDE COUNSEL PERSPECTIVE



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OPPOSITION

- IS IT POSSIBLE ?
- WHEN ?
- WHERE ?
- ON WHICH GROUNDS ?
- MAY WE LATER SETTLE ?

ARE OPPOSITIONS ALLOWED ?

- YES

- Most Countries

- NO

- Austria
- Mexico

WHEN ?

- **BEFORE REGIST.**

- AUSTRALIA
- CANADA
- USA
- SPAIN
- EU
- BRASIL
- PORTUGAL

- **AFTER REGIST.**

- DENMARK
- ITALY
- GERMANY
- JAPAN
- RUSSIAN FED.
- UK
- FINLAND

WHERE ?

- **BEFORE IP OFFICE**
- UK
- CHINA
- SPAIN
- GERMANY
- PORTUGAL
- EU
- USA
- **BEFORE JUDICIAL BODY**
- ESTONIA
- GEORGIA
- PANAMA

WHICH GROUNDS ?

- **Relative grounds only**
 - France
 - Italy
 - Germany
 - Hungary
- **Absolute grounds only**
 - Swaziland

WHICH GROUNDS ?

- **Absolute and Relative grounds**

- PORTUGAL
- USA
- BRASIL
- CHINA

AUSTRALIA
EU
JAPAN

OTHER GROUNDS FOR OPPOSITION

- NAMES OF FAMOUS PEOPLE
- FOREIGN WORDS AND EXPRESSIONS
- COPYRIGHTS
- UNREGISTERED MARKS

AGREEMENT IN OPPOSITION PROCEEDINGS

- YES

- ALMOST ALL COUNTRIES

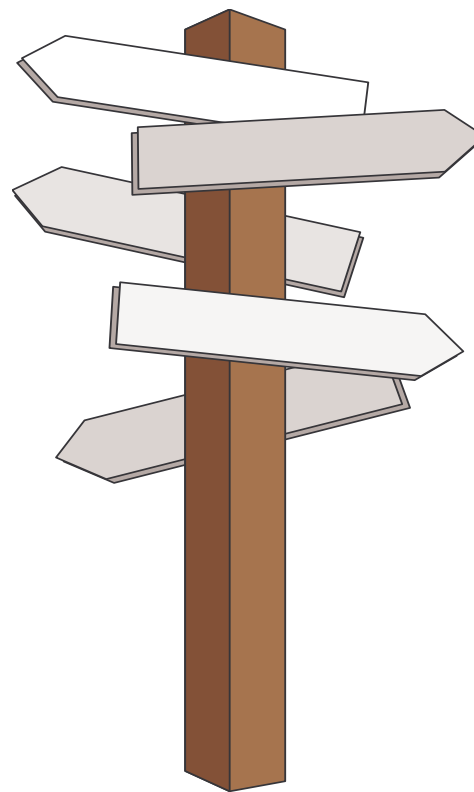
- NO

- VERY FEW COUNTRIES

SETTLEMENT / NEGOTIATE

- SUGGEST RESTRICTION OF LIST OF GOODS/SERVICES
- COEXISTENCE OF MARKS WITH PARALELL AGREEMENT
- NEGOTIATE *AND* OPPOSE

HARMONIZATION ?



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MAIN QUESTIONS

- Pre / Post registration opposition
- Time limit for opposition
- Standard grounds
- Proof of use
- Settlement

PRE / POST REGISTRATION OPPOSITION

- Does it matter ?
Probably not !
 - the possibility to oppose.
 - significant number of countries.

DEADLINE TO OPPOSE

- Is there an ideal time period to oppose ?

Time limits vary from 30 days to 3 months.

Time to investigate vs fast resolution.

Are limited extensions of time the answer ?

STANDARD GROUNDS

- One common ground – prior rights
- What about “absolute grounds” ?

PROOF OF USE

- Should opposition proceedings include a requirement whereby opponent must prove **use** of the right invoked ?
- It would clearly have an impact on filing of oppositions.

SETTLEMENT

- Is it important to encourage settlement in opposition proceedings?
- Are parties allowed time to discuss it ?

MAIN GOAL



- A HAPPY AND WINNING CLIENT

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