



RELATIVE GROUNDS OF REFUSAL: OPPOSITION

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- 1. Relative grounds for refusal: Art. 8 EUTMR**
- 2. Practical examples**
- 3. Perspective from an Opposition decision examiner**



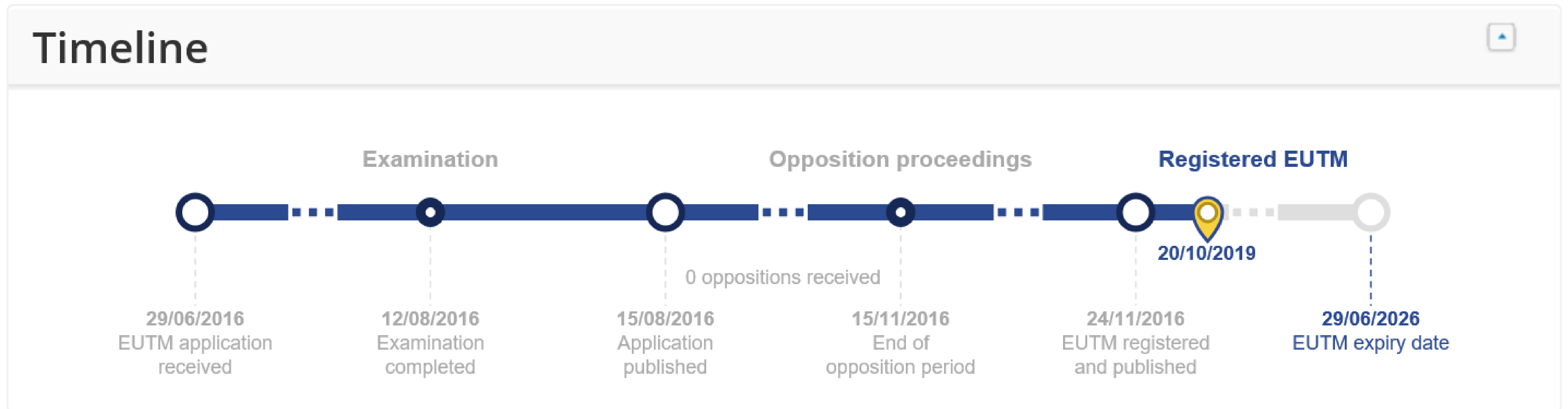
Relative grounds for refusal: Opposition

KEY ASPECTS

- **Pre-registration procedure**
- **Not ex officio**
 - ✓ **Upon request**
 - ✓ **Limited to facts, evidence and arguments**
- **Inter partes**
- **5 languages: DE, EN, ES, FR, IT**



Relative grounds for refusal: Opposition



Opposition

Relative grounds for refusal: Opposition

Article 8 EUTMR

- **Art. 8(1) EUTMR - Double identity / Likelihood of confusion**
Art. 8(2) EUTMR - Definition of “earlier marks”
- **Art. 8(3) EUTMR - Unauthorised filing by agent/representative**
- **Art. 8(4) EUTMR - Unregistered marks and other signs**
- **Art. 8(5) EUTMR - Marks with reputation**
- **Art. 8(6) EUTMR – Protected geographical indications**

Relative grounds for refusal: Opposition

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Relative grounds for refusal: Art. 8 EUTMR

ARTICLE 8(1) EUTMR DOUBLE IDENTITY/ LIKELIHOOD OF CONFUSION



ARTICLE 8(1) EUTMR

Article 8(1) EUTMR -

1. Upon opposition by the **proprietor** of an **earlier trade mark**, the trade mark applied for shall not be registered:

(a) if it is **identical** with the earlier trade mark and the goods or services for which registration is applied for are **identical** with the goods or services for which the earlier trade mark is protected;

(b) if, because of **its identity** with, or **similarity** to, the earlier trade mark and the **identity or similarity** of the goods or services covered by the trade marks there exists a **likelihood of confusion** on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.



ARTICLE 8(1) EUTMR

Article 8(2) EUTMR - Definition of 'earlier marks'

- **trade marks** with a date of application which is **earlier** than the date of **application** of the contested mark, taking account, where appropriate, of the **priorities**
- **applications for such marks** (subject to their registration)
- **well-known marks** (*Article 6bis of the Paris Convention*)

ARTICLE 8(1)(a) EUTMR

DOUBLE IDENTITY

Article 8 EUTMR: Relative grounds for refusal

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is **identical** with the earlier trade mark and the goods or services for which registration is applied for are **identical** with the goods or services for which the earlier trade mark is protected;

Identity of
the goods/services


Identity of
the signs

Absolute protection → *no need to demonstrate
Likelihood of Confusion*

ARTICLE 8(1)(a) or (b) EUTMR


Article 8 EUTMR: Relative grounds for refusal

Earlier mark:



Class 25: Clothing, headgear namely, shirts

Contested mark application:

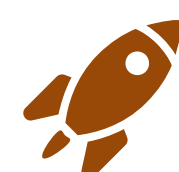


Class 25: Clothing, headgear namely, shirts

- Signs → Identical
- Goods → Identical
- Conclusion → DOUBLE IDENTITY – 8(1)(a)

ARTICLE 8(1)(a) or (b) EUTMR

Article 8 EUTMR: Relative grounds for refusal



01/02/2023, T-349/22, Hacker space / Hacker-pschorr *et al.* § 35

- Signs → (nearly) identical
- Goods → Dissimilar
- Conclusion → NO LOC – 8(1)(b)



ARTICLE 8(1)(b) EUTMR

LIKELIHOOD OF CONFUSION

Article 8 EUTMR: Relative grounds for refusal

(b) if, because of its **identity** with, or **similarity** to, the earlier trade mark and the **identity** or **similarity** of the goods or services covered by the trade marks there exists *a likelihood of confusion* on the part of the public in the territory in which the earlier trade mark is protected.



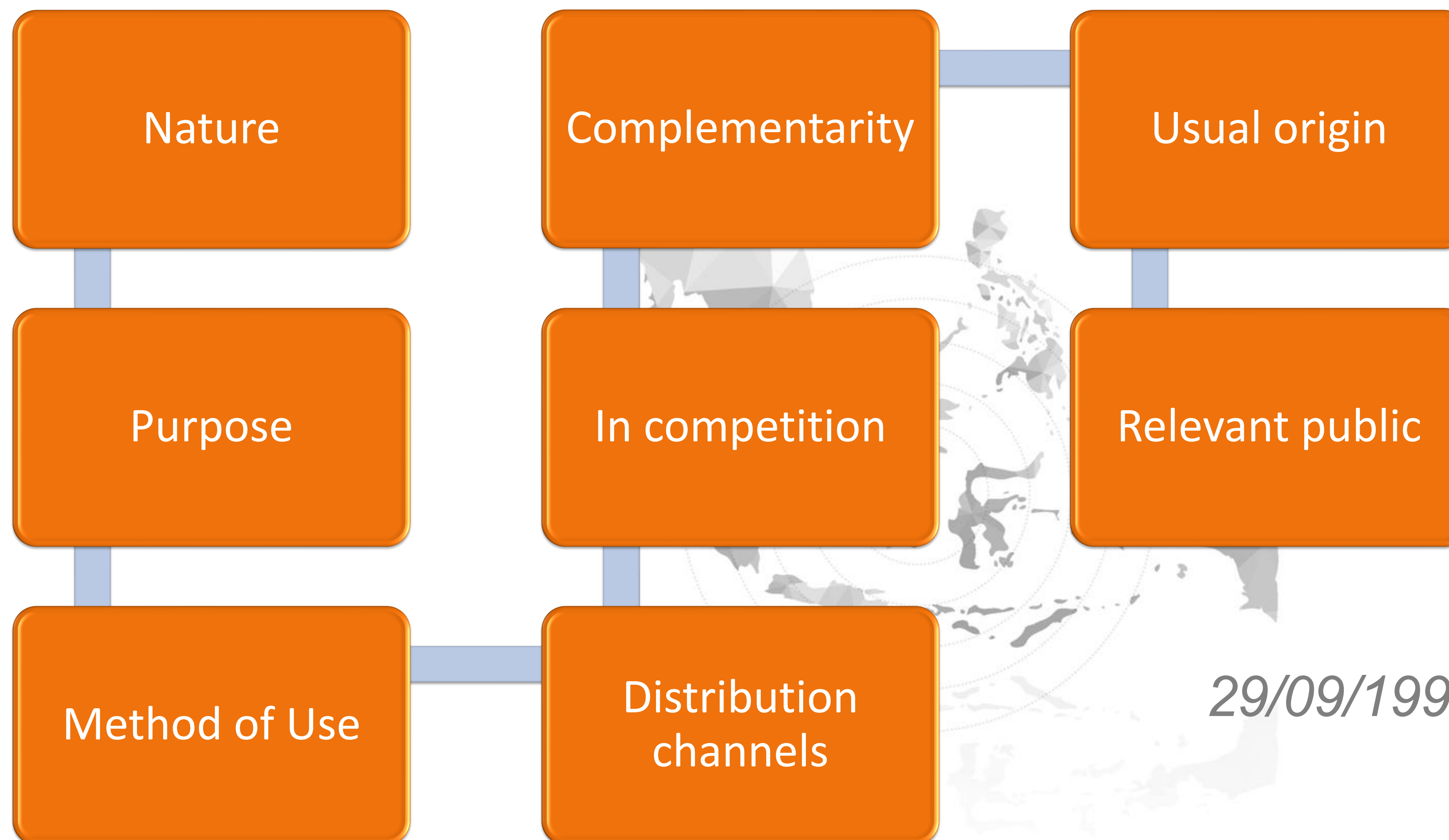
ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion



ARTICLE 8(1)(b) EUTMR

COMPARISON OF G&S



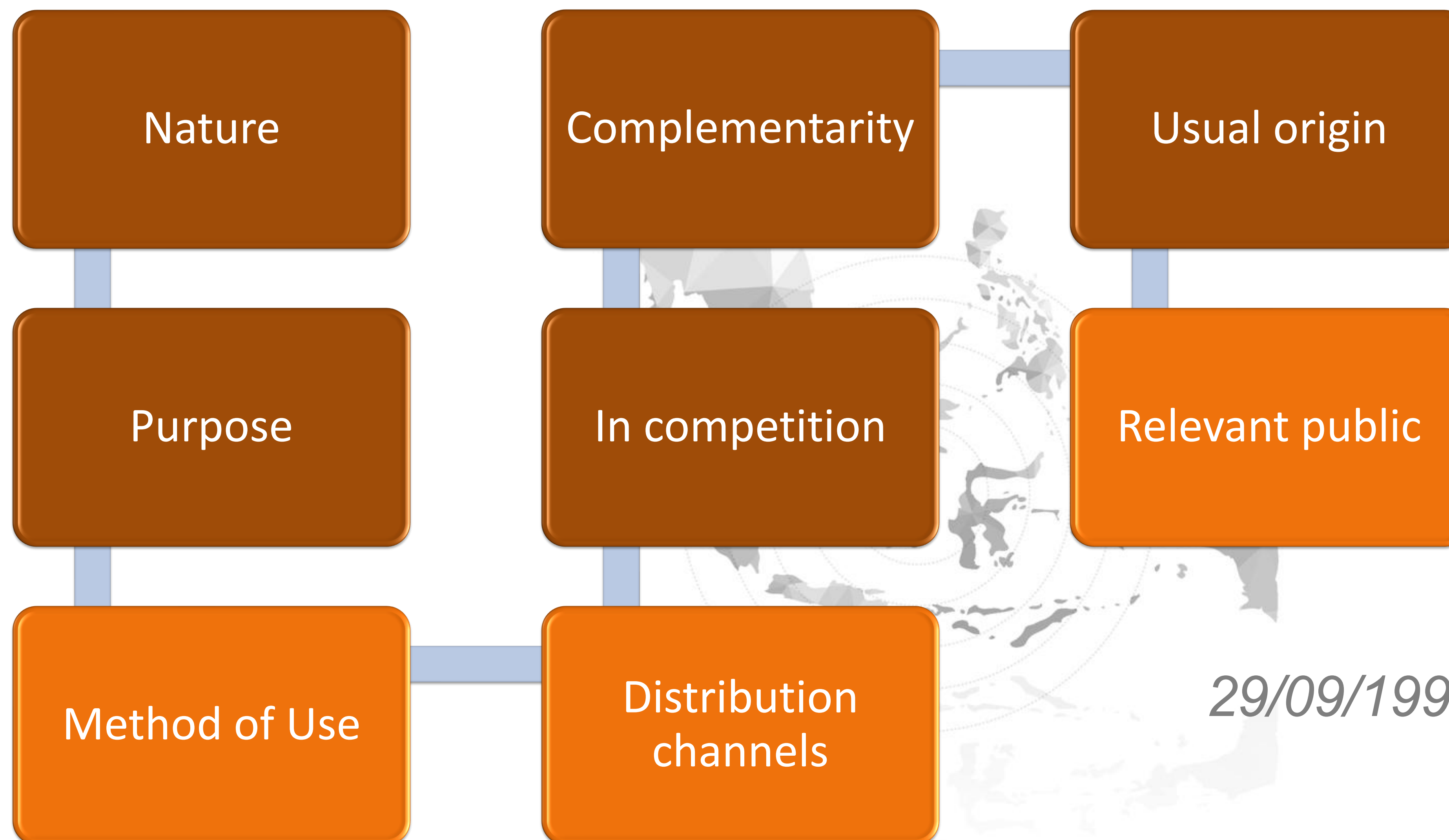
‘Canon Criteria’

29/09/1998, C-39/97, Canon,
EU:C:1998:442



ARTICLE 8(1)(b) EUTMR

COMPARISON OF G&S



‘Canon Criteria’

29/09/1998, C-39/97, Canon,
EU:C:1998:442



ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion



ARTICLE 8(1)(b) EUTMR

COMPARISON OF G&S

Beer



STRONGER

WEAKER



nature



purpose



in competition



complementary



(usual) origin

methods of use

distribution channels

relevant public



Soft drinks

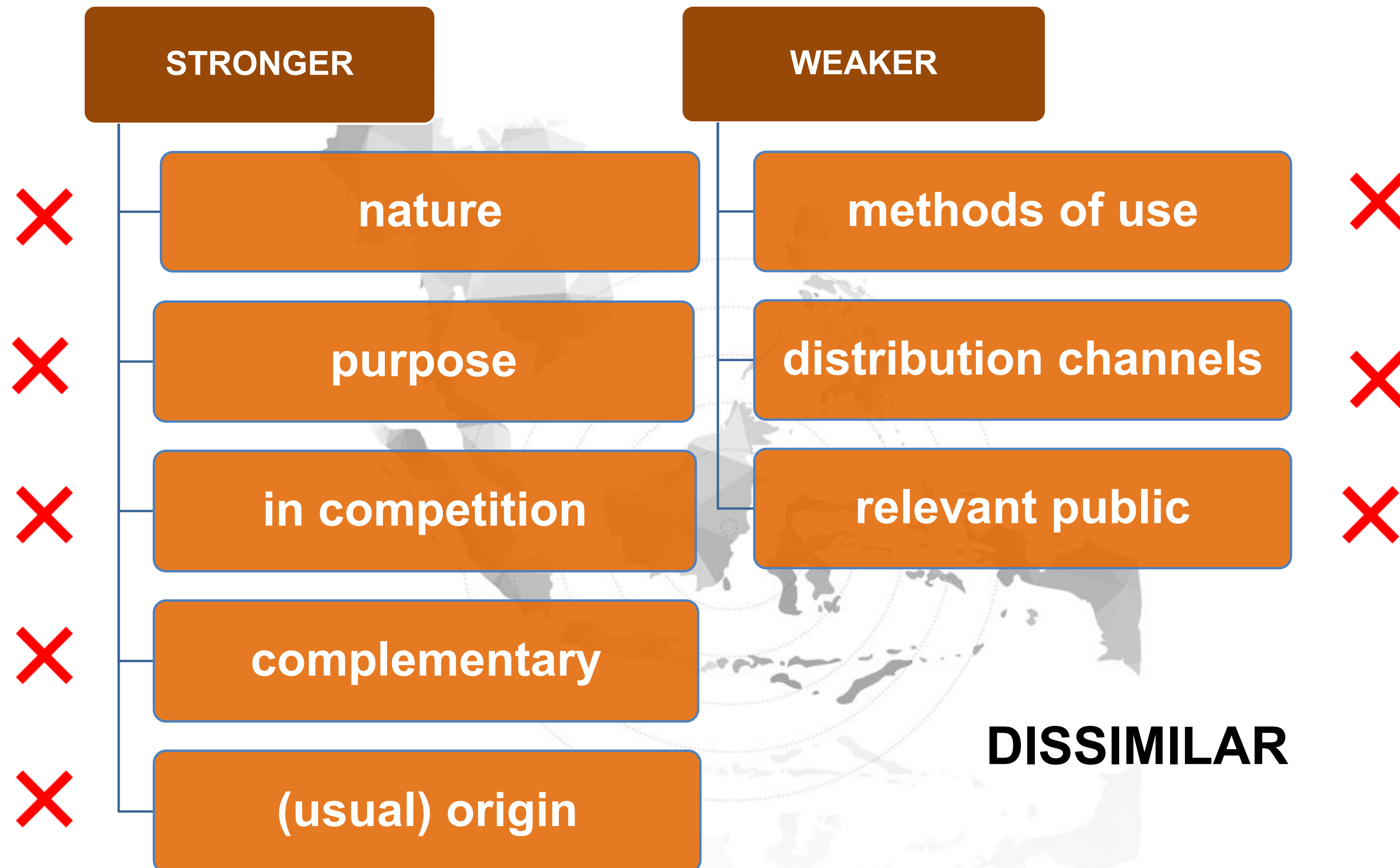


SIMILAR
(average degree)

ARTICLE 8(1)(b) EUTMR

COMPARISON OF G&S

Beer



Coffee



DISSIMILAR

ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion



ARTICLE 8(1)(b) EUTMR

SOURCES OF INFORMATION

The screenshot displays the EUIPO Trade mark guidelines website. The top navigation bar includes the EUIPO logo, a search bar with the text "Search trade mark guidelines", and dropdown menus for "Complete Edition", "Trade mark guidelines", and "Edition 2025". The left sidebar contains a table of contents with the following items:

- 1 Introduction
- + Editor's note and general introduction
- + Part A General rules
- + Part B Examination
- x **Part C Opposition**
 - + Section 0 Introduction
 - + Section 1 Opposition proceedings
 - x **Section 2 Double identity and likelihood of confusion**
 - + Chapter 1 General principles
 - + **Chapter 2 Comparison of goods and services**
 - + Chapter 3 Relevant public and degree of similarity
 - + Chapter 4 Comparison of signs
 - + Chapter 5 Distinctiveness of the earlier mark
 - + Chapter 6 Other factors
 - + Chapter 7 Global assessment
 - + Section 3 Unauthorised filing by agents
 - + Section 4 Non-registered trade marks

The main content area is titled "Trade mark guidelines" and shows the breadcrumb "Part C Opposition > Section 2 Double identity and likelihood of confusion". Below this, there is a "Show modifications" toggle switch and a list of sub-sections:

- 1 Introduction
- 2 Identity
- 3 Similarity of Goods and Services
- 4 Annex I: Specific Questions on the Similarity of Goods and Services
- 5 Annex II: Specific industries

At the bottom, the "Parent topic" is listed as "Section 2 Double identity and likelihood of confusion".



ARTICLE 8(1)(b) EUTMR

SOURCES OF INFORMATION

Similarity

HomeCompare termsCompare list of terms

My List: No pairs selected. [View](#)


▼ Similarity » Compare terms

Search language
English (en) ▼

Results language
English (en) ▼


⚙ Advanced criteria

Term
beer

Nice Class
32 

VS


Term
coffee

Nice Class
30 


Degree of Similarity
Any ▼

Pair ID
123-456

Select Offices
Office ▼

 EUIPO

Results

 Download as Excel file

Show 25 ▼ entries

Pair ID	Office	Class 1	Term 1	Similarity	Class 2	Term 2	Reasoning ⓘ
0047980-0047962	EM (EUIPO) (EM)	32	Beer and brewery products	Dissimilar	30	Coffee, teas and cocoa and substitutes therefor	
0040447-0031547	EM (EUIPO) (EM)	32	Beer	Dissimilar	30	Coffee	

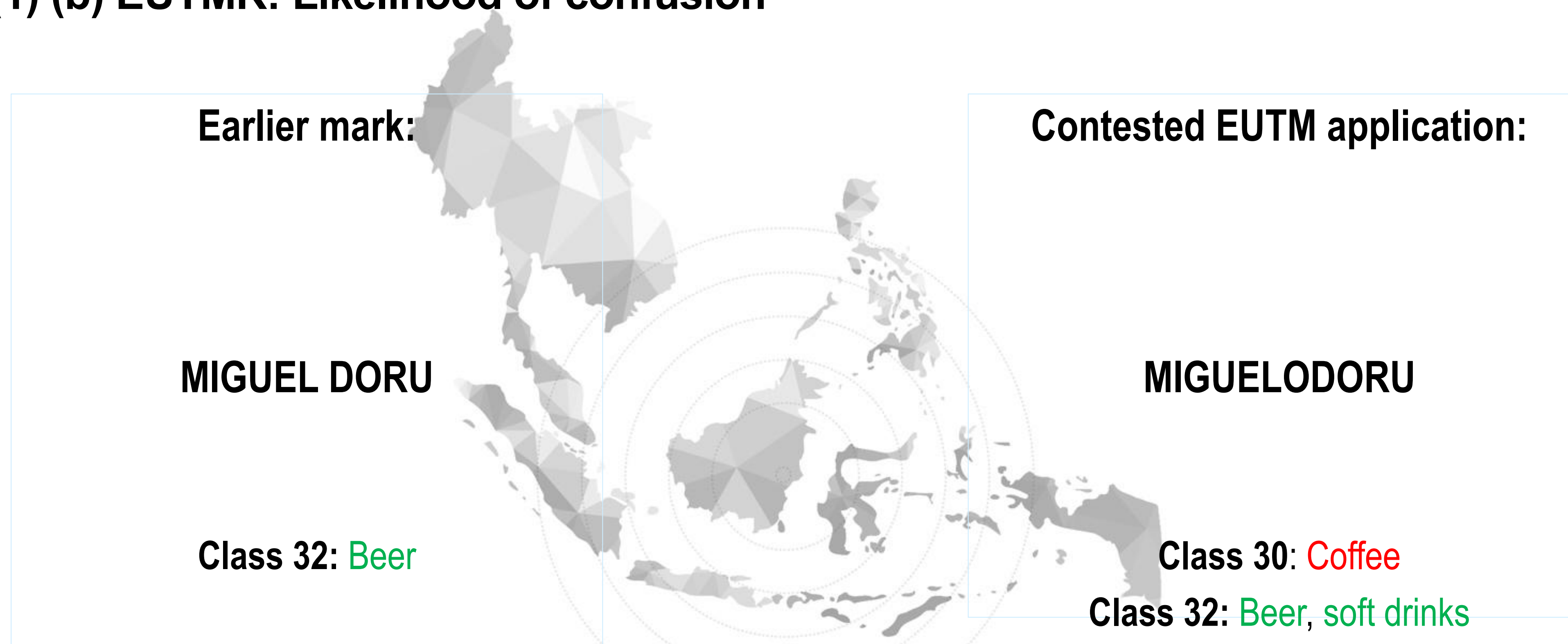
Coffee in Class 30 is/are dissimilar to a Beer in Class 32.

Showing 1 to 2 of 2 entries



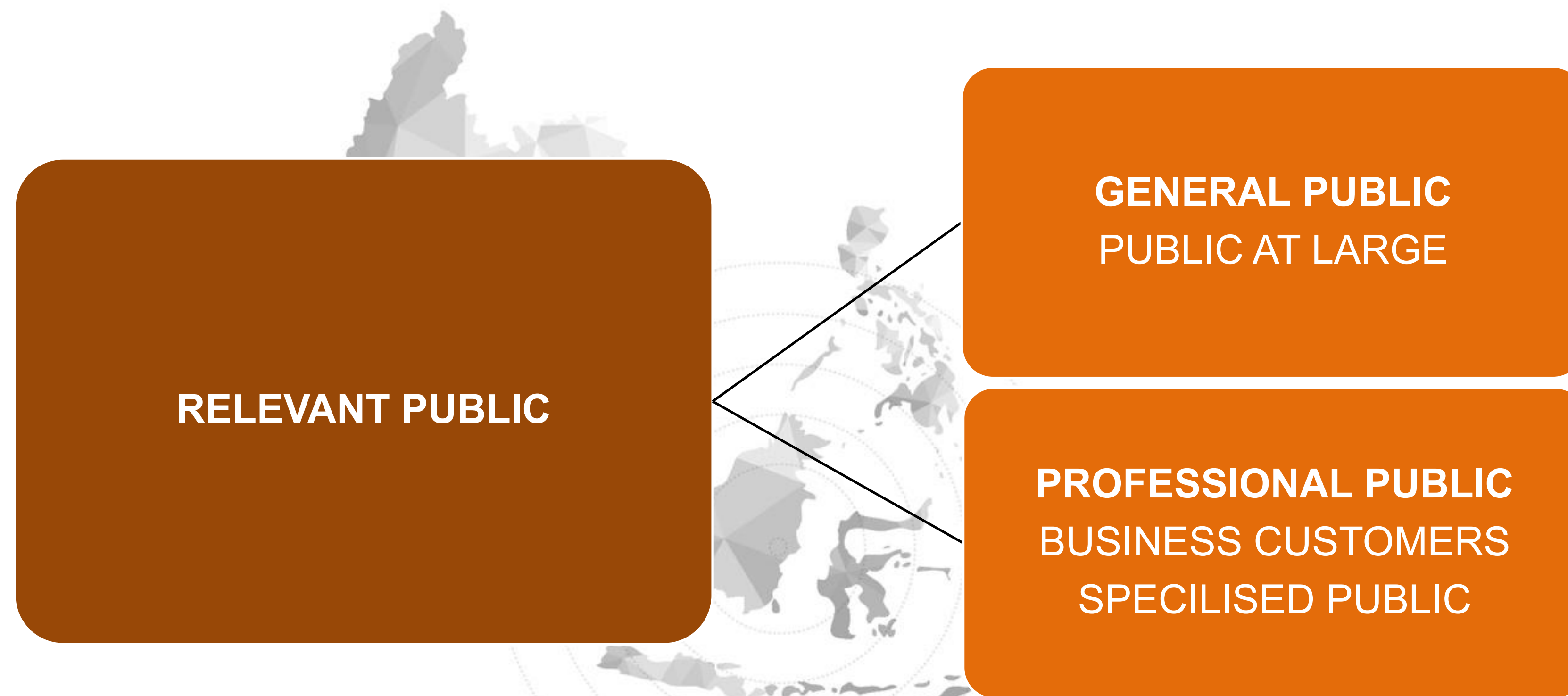
ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion



ARTICLE 8(1)(b) EUTMR

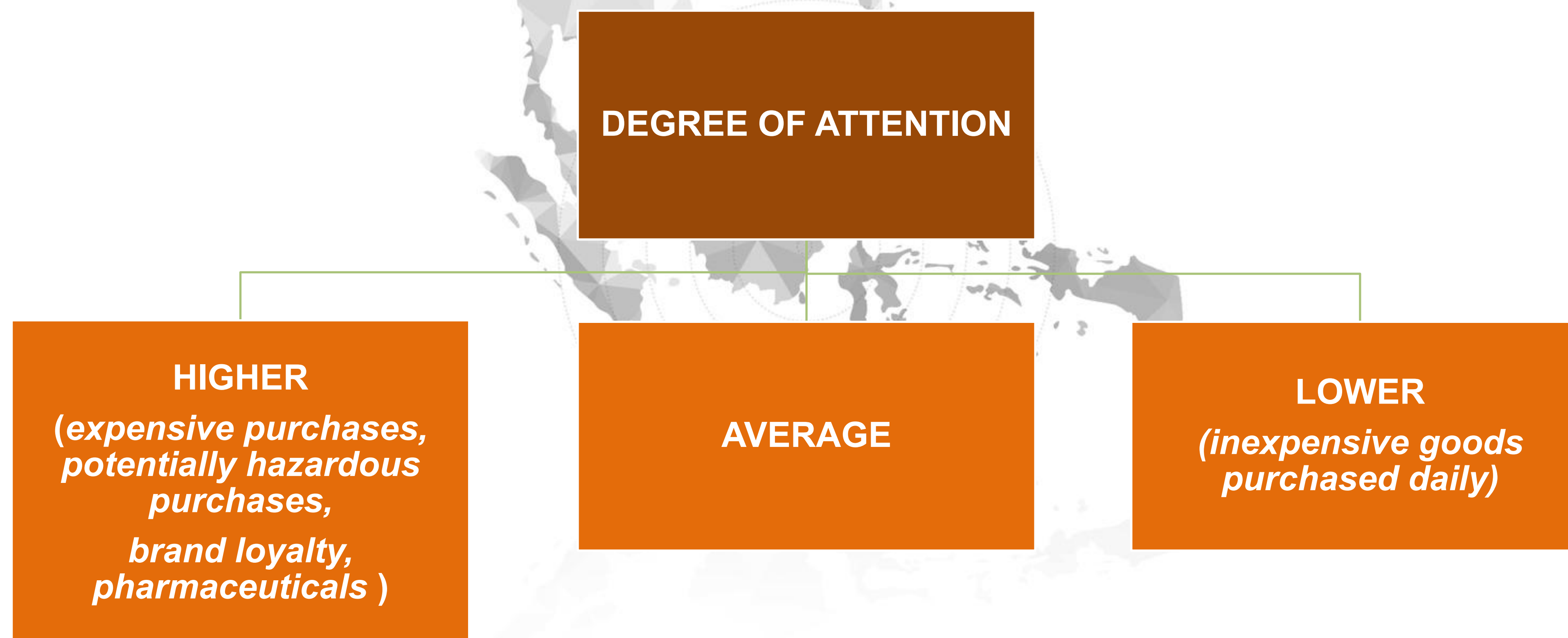
RELEVANT PUBLIC



ARTICLE 8(1)(b) EUTMR

RELEVANT PUBLIC

*The average consumer of the products concerned is deemed to be **reasonably well informed** and **reasonably observant and circumspect**, and that the relevant public's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26)*



ARTICLE 8(1)(b) EUTMR

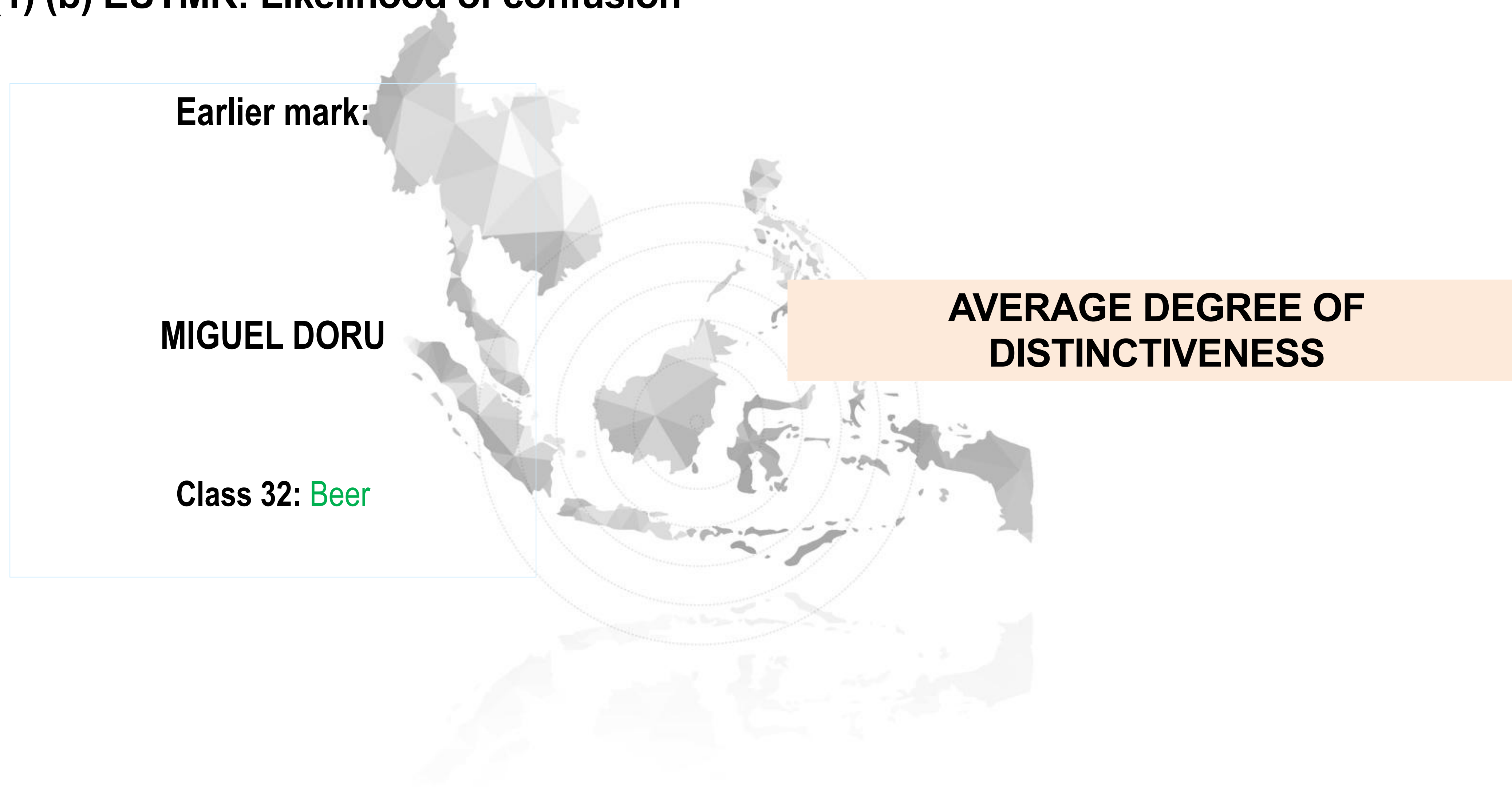
DISTINCTIVENESS OF THE EARLIER MARK



ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion

DISTINCTIVENESS OF THE EARLIER MARK



ARTICLE 8(1)(b) EUTMR

COMPARISON OF SIGNS



ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion

COMPARISON OF SIGNS



1) Weak or non-distinctive elements

2) Dominant = visually outstanding

ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion

COMPARISON OF SIGNS

Earlier mark:

MIGUEL DORU

Contested EUTM application:

MIGUELODORU



VISUALLY - SIMILAR (AVERAGE)



AURALLY - SIMILAR (AVERAGE)



CONCEPTUALLY - SIMILAR (AVERAGE)



ARTICLE 8(1)(b) EUTMR

OVERALL ASSESSMENT

*The Court has also held that the global appreciation of the **visual, aural and conceptual similarity of the marks** in question must be based on the **overall impression**, given by the marks, bearing in mind in particular, their **distinctive and dominant components**. ('Sabèl', § 23)*

*Account is taken of the fact that the **average consumer only rarely has the chance to make a direct comparison** between the different marks and must place trust in the **imperfect picture** of them that he or she has kept in mind...(judgment of 22/06/1999, C-342/97, 'Lloyd Schuhfabrik Meyer', § 26).*

*Even consumers who **pay a high degree of attention need to rely on their imperfect recollection** of trade marks (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).*

ARTICLE 8(1)(b) EUTMR

OVERALL ASSESSMENT

The likelihood of confusion on the part of the public must be assessed **globally**, according to the **relevant public's perception** of the signs and of the goods and services in question, and taking into account all factors relevant to the circumstances of the case, in particular the similarity of the marks and the similarity of the goods and services, which are interdependent criteria in the sense that **a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks**, and vice versa.

The **category** of goods or services and the way they are **marketed** (22/09/1999, C-342/97, *Lloyd Schuhfabrik*, EU:C:1999:323, § 27).



ARTICLE 8(1)(b) EUTMR

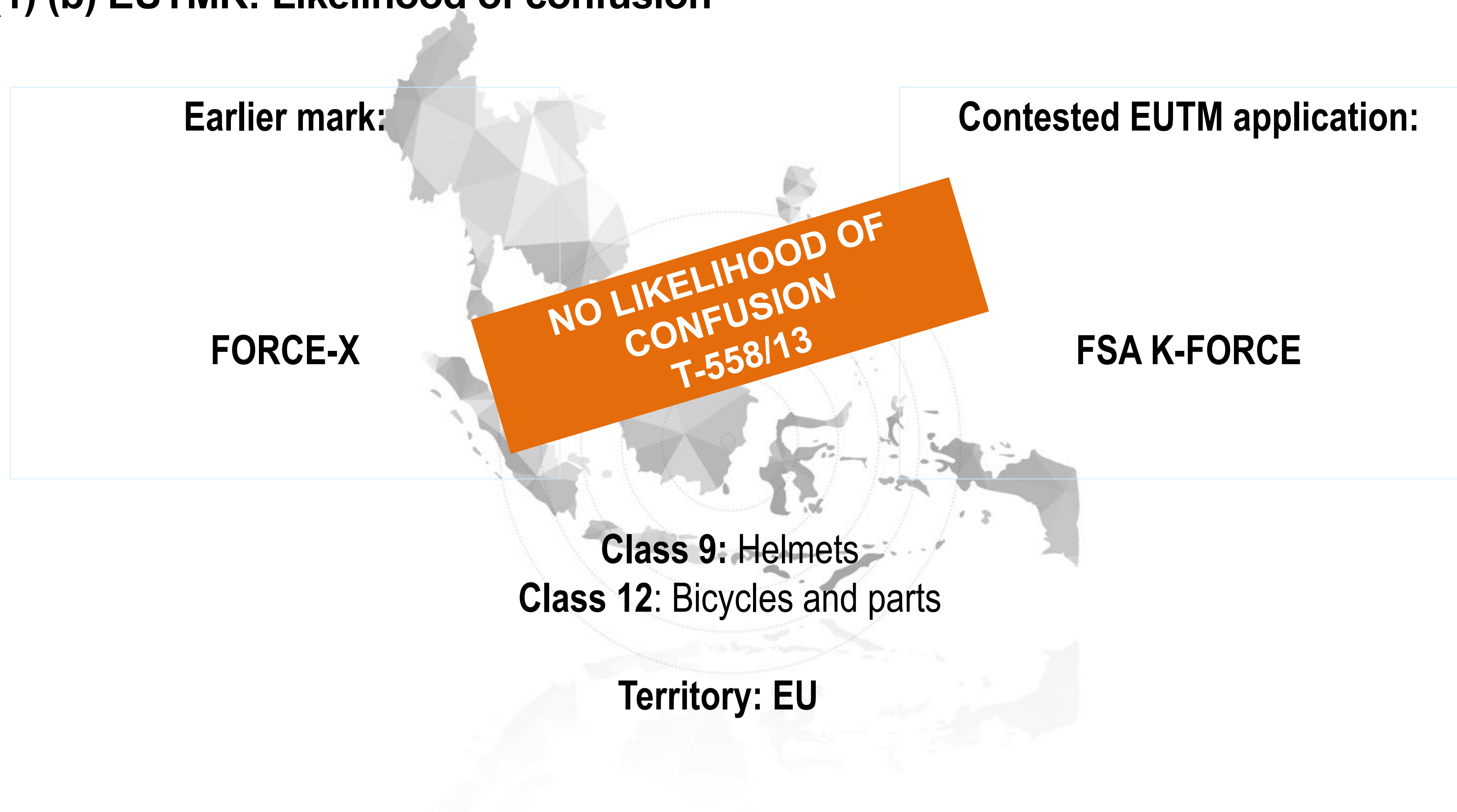
Article 8 (1) (b) EUTMR: Likelihood of confusion



ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion

PRACTICAL EXAMPLES



ARTICLE 8(1)(b) EUTMR

Article 8 (1) (b) EUTMR: Likelihood of confusion

PRACTICAL EXAMPLES

Earlier mark:

Contested EUTM application:

NO LIKELIHOOD OF CONFUSION T-402/14

Classes 35, 37, 39, 40 and 42 (e.g. water treatment in Cl 40)

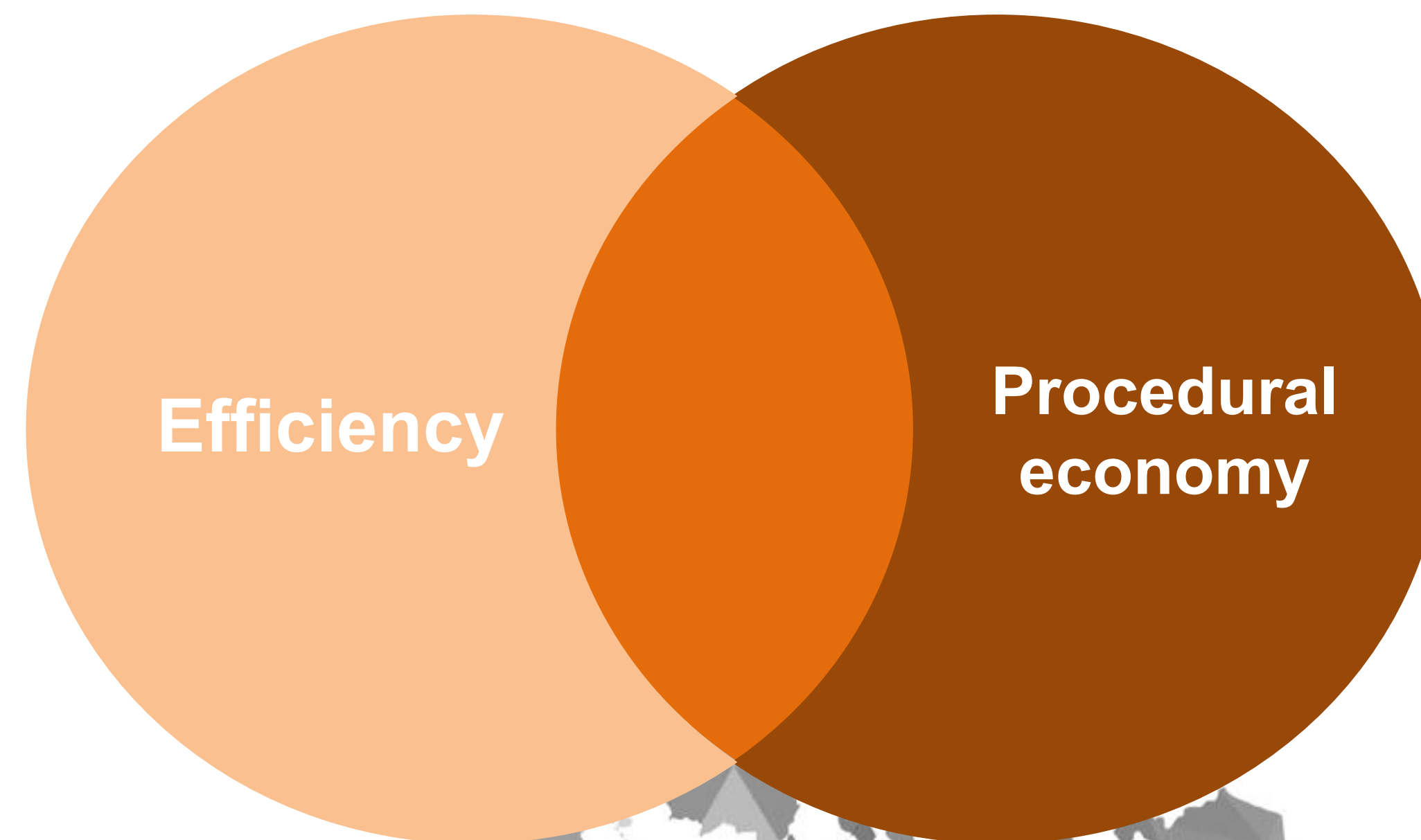
Territory: EU

Relative grounds for refusal: Opposition

PERSPECTIVE FROM AN OPPOSITION DECISION EXAMINER



Relative grounds for refusal: Opposition



The EUIPO has **no obligation** to:

- Examine **all** the oppositions, earlier rights or grounds
- Choose the earlier right with the **widest territorial scope** to prevent eventual conversion of the application in as many territories as possible (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, T-194/05, TeleTech International, EU:T:2006:124)



Relative grounds for refusal: Opposition

The most effective*

Multiple oppositions

- Will take the case which allows to refuse contested EUTM application to broadest successful extent

Earlier rights

- May examine only the most similar sign with broadest scope of goods/services

Legal grounds

- Will choose the ground presenting the simplest manner to refuse the application



Relative grounds for refusal: Opposition

Opposition based on articles:



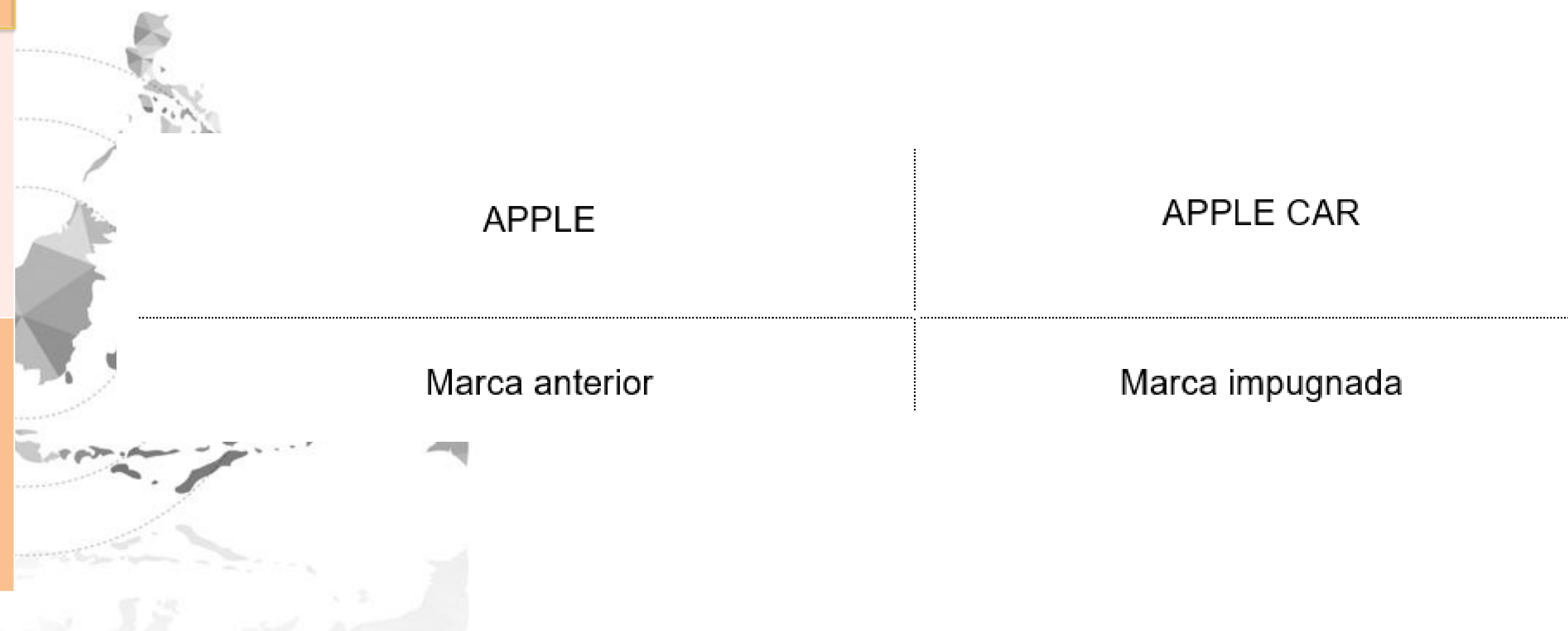
8(1)(b) – covering e.g. *carpets* in Class 27 – *not under proof of use*

8(5) – reputation for e.g. electronic consumer goods in Class 9 – *approx. 2000 pages of evidence*

8(4) – non-registered marks - *no national laws submitted*

Contested mark covers the following goods:

Automobile carpets in Class 27



- Earlier mark covers **identical** goods
- Coinciding element is **identical** and the additional element is **descriptive**
- Clear risk of likelihood of confusion under **Article 8(1)(b)**



Relative grounds for refusal: Opposition

Opposition based on earlier marks:

1) PRUX

Class 16: *printed matter*

2) Prux Casinos

Classes 16, 25, 35, 43 and 41, including
entertainment services

3) PRUX TV

Classes 35, 38 and Class 41 including
entertainment services

Contested mark covers the following goods:

PRUX DISK

Class 9: *gaming software*

Class 28: *slot machines; gaming machines and poker machines*

- Earlier mark 'PRUX' covers **dissimilar** goods
- But **all other** earlier marks cover services **similar** to contested goods

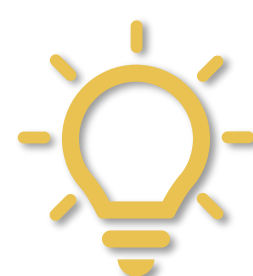


Relative grounds for refusal: Opposition

Opposition based on earlier marks:

8(1)(b) – covering e.g. *vehicles* in Class 12 –
not under proof of use

8(5) – **reputation** shown for *motor coaches, buses and trailers* in Class 12



- Partial LoC
- But ‘link’ and risk of injury for all goods under **Article 8(5)**

Contested mark covers the following goods:

Class 7: *automotive exhaust pipes; brake shoes*
other than for vehicles



Earlier trade mark

VANHOOOL

Contested sign



Relative grounds for refusal: Opposition

The Office **only examines proof of use**, to a greater or lesser extent, where it is **relevant to the outcome** of the case

Proof of use is **not relevant** where e.g.

- Opposition can be fully upheld based on **another** earlier mark **not subject to** the requirement to prove use
- **No likelihood of confusion** even for identical goods/services

May also apply in relation to **other grounds where **use** of the earlier mark/sign is an **indispensable condition***



Relative grounds for refusal: Opposition

The Office may proceed on the **assumption** that all the goods and/or services at issue are **identical** where - after evaluating all other relevant factors - any likelihood of confusion can be ruled out (20/09/2019, T-367/18, UKIO / <IO)

The degree of similarity of the goods/services is a **matter of law**, which **must be assessed** by the Office even if the parties do not comment on it (16/01/2007, T-53/05, Calvo)

However, the Office's examination is **restricted to well-known facts** → what is not commonly known should not be speculated on or extensively investigated *ex officio* (03/07/2013, T-106/12, Alpharen)





How do you do efficient decision making?





THANK YOU

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Presentation			
Status	DRAFT / APPROVED		
Approved by owner	-		
Authors	-		
	-		
	-		
Contributors	-		
	-		

Revision history			
Version	Date	Author	Description
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		
0.1	DD/MM/YYYY		