

# Differences between EU and US TM Oppositions

Once an EU trade mark is published the application is open to opposition for a period of 3 months which is non-extendible.

The EU trade mark opposition system is very different to the US system. Oppositions before the EUIPO are not court actions – they are procedural and far more low key than in the US. The table below sets out the key differences between EU and Us Trade Mark Oppositions.

## US TM Oppositions

- Similar to a court trial
- Schedule of Trial deadlines including Discovery and Disclosures:-
  1. Time to Answer
  2. Deadline for Discovery Conference
  3. Discover Opens
  4. Initial Disclosures Due
  5. Expert Disclosures Due
  6. Discovery Closes
  7. Plaintiff's Pretrial Disclosures
  8. Plaintiff's 30-day Trial Period Ends
  9. Defendant's Pretrial Disclosures
  10. Defendant's 30-day Trial Period Ends
  11. Plaintiff's Rebuttal Disclosures
  12. Plaintiff's 15-day Rebuttal Period Ends
- Separate deadlines for filing of evidence and submissions
- Documents filed at Trademark Trial and Appeal Board
- A Board of trademark judges decides the issues after reading submissions from both parties.
- Costs: each party bear their own.

## EU TM Oppositions

- Procedural and dealt with by EUIPO
- Only 3 main deadline dates to adhere to!

### 1. Initial Cooling Off Period

- Extendible by 22 months at request of both parties

*[Expiry of cooling off period]*

### 2. Opponent Deadline to File Evidence & Submissions to Support Opposition

*(extendible by 2 months only)*

### 3. Applicant Deadline to file Evidence & Submissions in Defence of Application

*(extendible by 2 months only)*



**3a.** Opponent has opportunity to file comments on Applicant's evidence & submissions

- The evidence rounds are **one window of opportunity** to file submissions & evidence together – no second chance!
- Documents filed at EUIPO
- EUIPO Opposition Division makes official decision on outcome and issue award of costs.
- Costs: Loser pays *BUT* scale costs, not fully recoverable costs.