

UK Trade Mark Opposition Procedure



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Introduction

The opposition procedure is a process that enables third parties to prevent trade mark applications from achieving registration in certain circumstances.

What is the UK Trade Mark opposition?

The opposition is commenced by filing a Notice of Opposition at the UK Intellectual Property Office "UKIPO".

Prior to filing a formal Notice of Opposition against the trade mark application, we recommend contacting the Applicant and attempt to resolve the issue. Many applications are drafted with broad specifications, therefore it is often possible to eliminate conflicts by requesting that the Applicant limit the specification or delete certain goods and services from the application. This is particularly important for opponents, as it means they will not be penalised as to costs when a decision is reached.

If the Applicant is unwilling to resolve the matter in this way, we recommend filing a Notice of Opposition.

Who can bring an Opposition?

Any natural or legal person may become an opponent by filing a Notice of Opposition against a UK trade mark application. The opposition must be based on the opponent's "Earlier Right", namely:

- its earlier trade mark application or registration;
- common law rights protectable by passing off; and
- other intellectual property rights such as copyright.

Earlier Rights can prevent registration of a subsequent third party application which conflicts with those Earlier Rights. A conflict may occur where the mark applied for is identical or similar to the Earlier Right and where the application covers identical and/or similar goods or services to those protected by the Earlier Right.

Alternatively, you may file an opposition challenging the registrability of the mark, or even the Applicant's entitlement to the mark on the grounds of bad faith. No Earlier Rights are required by the opponent on the ground of registrability.

What is the deadline to file an opposition?

When a trade mark is accepted by the UKIPO, it is published in the Trade Marks Journal.

The publication initiates a two month period during which third parties may oppose the application. The deadline to oppose can be extended by a further month by filing electronic form TM7a, Notice of Threatened Opposition, provided that this is filed within the original two month deadline.

It is not possible to oppose an application until it has been published. The official fees for filing the Notice of Opposition Form TM7 and Statement of Grounds is £200 which must be paid within the time limit to oppose.

There is an alternative to outright opposition in that third parties may file 'observations' on the application. The hope in filing observations is that these written submissions (for which there is no official fee), may persuade the examiner to withdraw or revise the acceptance of the application. The success rate is not high as really this is more suited to pointing out obvious mistakes to the Registrar. It should be noted that even if 'observations' are successful, there is no award of costs possible.

What happens once the Notice of Opposition has been filed?

Once the Notice of Opposition and the fee is received at the UKIPO, a copy of the opposition is sent to the Applicant. The UKIPO sets a deadline for the Applicant to respond by either withdrawing or limiting the application or by filing a Notice of Defence and Counterstatement to maintain their application.

When must a Notice of Defence and Counterstatement be filed?

Form TM8 is used for the Notice of Defence and Counterstatement, which must be filed by the Applicant within two months from the date it is first notified by the UKIPO. Alternatively, the



Applicant may wish to withdraw the application in which case they would need to tell the UKIPO, or do nothing further. In the event that both parties want to continue negotiations, they may ask for a “cooling off” period.

What is the “Cooling-Off” period?

The “cooling-off” period is intended to give the parties time to negotiate and settle the matter without the need to proceed to the adversarial stage of the opposition and incur extra costs. Either party can apply for the “cooling off” by submitting form TM9c to the UKIPO but only with the express agreement of both parties. Although the “cooling-off” period initially lasts for nine months, it is extendible for a further 9 months by submitting form TM9e, provided again that both parties jointly agree to the extension. The “cooling off” will end when the Applicant submits form TM8 Notice of Defence and Counterstatement, or if the opponent sends for TM9t Request to Terminate a Cooling Off Period to the UKIPO. If the “cooling off” period is terminated by the Opponent, then the Applicant will have two months in which to send the Notice of Defence and Counterstatement.

What is Proof of Use and what evidence can be submitted?

The Applicant may challenge the opposition on a number of grounds, including a) that there is no risk of confusion between the respective marks and, b) where the right on which the opposition is based has been registered for more than 5 years, demand that the Opponent provides proof that the mark has been use in relation to the relevant goods and services. If the Opponent fails to provide sufficient evidence, or fails to show genuine reasons for non-use, then the opposition may be rejected in part or in its entirety.

The opposition is only directed at some of the goods and services, therefore, can it proceed to registration for the unaffected goods and services?

If the opposition is only brought against part of the goods and services, then the Applicant may, provided that there is no overlap, divide the application into two separate trade mark applications. The part that has not been opposed will proceed to registration (upon payment of the appropriate fees), whilst the other goods and services remain subject to the opposition.

Will the UKIPO give a preliminary indication of their opinion?

If an application has been opposed on the basis of its similarity to an Earlier Right, then the Hearing Office will issue an opinion on whether the opposition will succeed or not. The date that this is sent to the parties is known as the ‘indication date’. The opinion has no legal status. If either party wishes to give evidence then they must send for TM53 Request to Proceed to Evidence Rounds one month after the indication date. The UKIPO then sends this to the other party which is known as the ‘initiation date’. If neither party responds the UKIPO actions the outcome stated in the preliminary indication.

In arguable cases it is possible that the Registrar will decline to give a preliminary indication and will simply request that further evidence is required before a decision can be made. In this case dates are then set for the filing of evidence.

What happens if the parties proceed to evidence rounds?

When the parties proceed to evidence rounds, they must provide as much evidence as possible that either supports the opposition in the case of the Opponent, or defends the application in the case of the Applicant. This is normally done in the form of a statutory declaration or witness statement.

How is a decision reached at the end of the evidence rounds?

If both parties elect a ‘decision from the papers’ the decision will be made by the UKIPO. Alternatively a party may request a hearing in which a Hearing Officer will also consider oral

submissions from both parties.

Can a decision be appealed?

If either party is unhappy with the decision and feels that the Hearing Officer made an error in a point of law, the decision may be appealed either to the High Court, or more usually to the ‘Appointed Person’ (an independent IP specialist).

What are the costs of proceedings?

The losing party will bear all costs of the opposition. The costs awarded do not relate to the professional cost actually incurred by the successful party but are awarded on a scale which is usually between £1,500 - £2,500. The UKIPO often decides that each party should bear their own costs if the opponent has only partially succeeded on some grounds of the opposition.

How does the owner of Earlier Rights find out if someone has filed for a conflicting mark?

The most effective way to monitor for conflicting marks is to set up an automated watch service. We routinely arrange these for clients and notify them of any conflicting marks that have been accepted for publication. We also provide our opinion on the chances of success and the likely costs and time scales involved.

For further information on this subject please contact:

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