

United Kingdom Trade Mark Oppositions - A Summary

Outline of Procedure

Opposition must be filed at the UK Intellectual Property Office (IPO) within 3 months of publication of the application; this period is not extensible. If based on earlier registrations over 5 years old, the opponent must indicate the products/services on which the marks have been used.

Within 3 months of being notified of the opposition, the applicant has to file their counterstatement in response. If both parties agree, this deadline can be extended once by 9 months, by way of a “cooling off period” so as to allow time for negotiations. Either party can terminate the “cooling off period” early.

If the grounds of opposition include the ground that the mark applied for is the same as or confusingly similar to an earlier mark that is for the same or related goods/services, then the IPO may give a preliminary indication as to whether they think the opposition will be completely successful, partially successful or not successful, on those grounds. If the preliminary indication is accepted, then the opposition does not proceed further.

If the preliminary indication is not accepted, or if the opposition is one where a preliminary indication is not issued, the opposition proceeds to the evidence stage, with the opponent almost certainly needing to prove use of registrations that have been registered for more than five years.

The opponent files evidence first, the applicant responds and the opponent can reply. Each evidence round last 3 months; extensions may be available. Once all the evidence has been filed, the opposition is decided either at a Hearing, or purely based on the papers filed. An award of costs is usually made in favour of the winning side. This is based on an official scale, intended as a contribution to, rather than compensation for, actual costs. There is some flexibility.

There is the possibility of an appeal within 28 days. This can be to the courts or the “Appointed Person”, usually a senior barrister or academic. A decision of the Appointed Person is final; court proceedings can be appealed.

Who can oppose?

1. **Absolute grounds:** anyone
2. **Earlier rights:** the owner, not even a licensee.

(Once the opposition is filed the licensee can in effect take over the opposition as an intervenor.)

How long will it take?

An opposition which goes no further than the preliminary indication, can be over in around 7 months. A case which uses the cooling off period, and in which evidence is filed, with the opposition being decided after a hearing, can take a couple of years.

Possible grounds of opposition

1. Absolute grounds

Trade mark application made in bad faith or mark inherently unregistrable because it is:

- descriptive, i.e. describes the goods/services;
- deceptive, i.e. it gives a false impression as to the type or quality of the goods or services;
- generic, i.e. a general expression used in the particular trade or business;
- contrary to public policy or to accepted principles of morality;
- a specifically protected emblem.

In certain circumstances if substantial use has been made of the mark, so that it has become distinctive of the applicant's goods or services, then an opposition on absolute grounds may possibly be defeated.

2. Relative grounds i.e. earlier rights, namely:

- trade mark applications/registrations;
- rights built up through use of an earlier mark (passing off rights);
- designs/copyright.

How does the opponent, or potential opponent, become aware of the application?

- a) Watching search in place to detect the publication of potentially conflicting applications.
- b) Notification by the IPO of the publication of the later application, if the examiner considers it might be confused with an earlier mark.
- c) Contact e.g. if applicant has approached the opponent for consent to use and/or register the mark.

Importance of use of opponent's registrations over 5 years old

If the opposition is based on marks registered for 5 years or more, as at the publication date of the application being opposed, a statement of use must be given. If the applicant does not accept the statement of use, the opponent will need to prove, in the evidence stage of the opposition, that during the 5 years preceding the date of publication of the opposed mark, there has been genuine use of the registered mark in the United Kingdom, or in at least one member state of the European Union in the case of Community Trade Mark, in connection with the goods or services for which it is registered.

A registration over 5 years old will only remain a valid ground of opposition, to the extent that use of it has been shown. This could be for a much narrower range of products/services than those covered by the registration.

There is an exception if there are justifiable reasons for non-use, but this is extremely rare. An example might be a trade embargo affecting the whole business sector.

If it is apparent that use of a registration cannot be proved, or not proved satisfactorily, the other side might commence a non-use cancellation action against the registration concerned.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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