

HOW TO FILL IN YOUR NOTICE OF OPPOSITION AND STATEMENT OF GROUNDS (FORM TM7)

The Trade Marks Registry now provides the Form TM7 in Microsoft Word format. Unlike the existing form provided via our website in PDF format, this new Word version enables the user to complete the form electronically. The following guidance is intended to help you use the form effectively and efficiently. It also points out any relevant legislation, rules or procedural matters which you may wish to consider whilst completing the form.

Please note that where an action is based upon Sections 5(1), 5(2), 5(3) or 5(4)(a), the design of the new 8-page Microsoft Word Form TM7 makes it most suitable for oppositions based upon a *single* earlier right.

Where an opposition is based upon more than one earlier right, you will need to utilise and enclose additional relevant pages. To illustrate, an opposition filed under Section 5(2)(b) which is based on two or more earlier rights will require the completion of additional copies of page numbers 3 and 4; an opposition filed under Section 5(3) based on two or more earlier rights will require additional page numbers 5 and 6; and so on.

Please note that whilst we encourage completion of the form in Microsoft Word format, it cannot be submitted via email or any other electronic means. Once completed on-screen, the form should be printed on hard copy, and then posted or faxed to the UK-IPO in the conventional manner. It is also vital that you submit the new Form TM7 in its *entirety*, irrespective of how many pages you have actually completed. Your form should therefore include those (uncompleted) pages which cover grounds you are not utilising. This will help us to confirm the nature of your opposition, and to ensure that any additional grounds of your opposition have not been misplaced during transit.

The following notes should help you to identify what information needs to be entered into some sections of the form. Please note that as parts of the form are clearly self-explanatory, guidance notes have not been provided to accompany every section.

PAGE 1

This page is compulsory, and should therefore be completed in all cases

Section 1:
Trade mark number

Please enter the number of the trade mark you are opposing.

Section 2:
Full name of the applicant, International registration holder, or registered proprietor

Please enter the name of the applicant, International registration holder, or registered proprietor whose mark you are opposing.

Section 3:
Full name and address (including postcode) of the opponent

Please note that, following introduction of the Trade Marks (Relative Grounds) Order 2007 in October 2007, oppositions based on Sections 5(1), 5(2), 5(3) and 5(4) can only be brought by the proprietor of the earlier trade mark or other earlier right.

Section 6:
Have you notified the applicant that you intend to oppose the trade mark application?

Please note that an opposition launched without giving the applicant, international registration holder or the registered proprietor a reasonable opportunity to withdraw the application, international designation or amendment, may result in the opponent being ineligible for an award of costs.

Section 10:
Number of sheets attached to this form

Please number every extra sheet you use. It is important that you also tell us how many sheets in total you have used.

PAGE 2

Use this page only if you are basing your opposition on section 3 of the Trade Marks Act. Please tick the appropriate box and provide a full explanation to support the grounds of your opposition.

State which of the applicant's or services you oppose under Section 3.

If you are not opposing the full specification covered by the applicant's mark, please tick the box labelled "Some (please specify)" and clearly state which of the applicant's goods or services you are directing your opposition towards.

Section 3(6)

Any claim under Section 3(6) must be particularly focused. This is an allegation of dishonest activity, dealings, or at the very least, commercial behaviour or activity which is below the standard regarded as acceptable by the community at large. You will need to provide clear and concise reasons to justify your allegation under Section 3(6).

PAGES 3 AND 4

Use these pages only if you are basing your opposition on section 5(1) or 5(2) of the Trade Marks Act.

As stated on page 1 of these notes, you must use additional copies of pages 3 and 4 for every earlier right you are utilising under sections 5(1) or 5(2). Please ensure that any additional pages are suitably numbered.

- Number:** Please provide the relevant number of the earlier UK, Community or International mark on which you are basing your opposition.
- Representation of the mark:** If it contains any figurative or stylised elements, you may wish to copy an electronic representation of the mark into this section of the form TM7. Alternatively, you can simply attach a paper copy of the mark on an additional sheet.
- Questions 2, 3(a) and 3(b):
Statement of use provision** These sections of the form all relate to the statement of use provision. As the form states, if the registration or protection process for the earlier trade mark was completed 5 years or more before the publication date of the opposed application (or request for protection in the case of an international registration), you are required to make a statement of use. Therefore, you need only answer sections 3(a) and 3(b) if you have answered “yes” to section 2.
- Question 4:** You must state which of the *applicant's* goods or services you claim are identical or similar to those of your earlier right (as identified in response to either Question 1 or Question 3(a) depending on whether the statement of use provision applies.
Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

PAGES 5 AND 6

Use these pages only if you are basing your opposition on section 5(3) of the Trade Marks Act.

As stated on page 1 of these notes, you must use additional copies of pages 5 and 6 for every earlier right you are utilising under section 5(3). Please ensure that any additional pages are suitably numbered.

Number: Please provide the relevant number of the earlier UK, Community or International mark on which you are basing your opposition.

Representation of the mark: If it contains any figurative or stylised elements, you may wish to copy an electronic representation of the mark into this section of the form TM7. Alternatively, you can simply attach a paper copy of the mark on an additional sheet.

**Question 3:
What do you say the unfair advantage or detriment would be?** You must be able to substantiate your claim that unfair advantage or detriment would occur.

**Questions 4, 5(a) and 5(b):
Statement of use provision** These sections of the form all relate to the statement of use provision. As the form states, if the registration or protection process for the earlier trade mark was completed 5 years or more before the publication date of the opposed application (or request for protection in the case of an international registration), you are required to make a statement of use. Therefore, you need only answer questions 5(a) and 5(b) if you have answered "yes" to question 4.

PAGE 7

Use this page only if you are basing your opposition on section 5(4)(a) of the Trade Marks Act. This section is normally pleaded where the claimant believes he or she has a mark, registered or unregistered, that should enjoy protection under the common law tort of Passing Off.

As stated on page 1 of these notes, you must use additional copies of page 7 for every earlier right you are utilising under section 5(4)(a). Please ensure that any additional pages are suitably numbered.

Representation of the earlier mark, sign or right:

If it contains any figurative or stylised elements, you may wish to copy an electronic representation of the mark into this section of the form TM7. Alternatively, you can simply attach a paper copy of the mark on an additional sheet.

**Question 1:
When and where was the earlier right first used in the UK?**

You must include details of when and where the earlier right was used, including a date of first use and details of the geographical extent of the use within the UK.

**Question 2:
State in relation to which goods and services the earlier right has been used.**

You must include details of all goods and/or services for which the earlier right has been used in respect of.

**Question 4:
Now state why you consider use of the applicant's mark would be contrary to law, particularly the law of passing off.**

In this section you should provide some substantiation for your claim. This can be in the form of a short paragraph setting out your main arguments as to why use of the applicant's mark would be contrary to law.

Use this page only if you are basing your opposition on any other grounds not covered by other sections of this form. As the majority of grounds specified in this section of the Form TM7 are self-explanatory, guidance notes have only been presented in respect of Sections 5(1),(2) and (3), and Section 5(4)(b).

Section 5(1), (2), (3)

Tick this box if you are opposing under Sections 5(1), 5(2) or 5(3) on the basis of a well known trade mark as defined in Section 56(1).

If you are basing your opposition on such grounds, you may wish to adapt pages 3 and 4 of the form, or you may choose to provide all relevant information in the blank lower-half of the page.

You will need to submit a representation of the mark, along with details of any reference number and related jurisdiction only if relevant. You will also need to identify those goods or services covered by the earlier trade mark which are relied upon, and indicate which goods or services in the application you are claiming to be similar or identical to those covered by the earlier mark.

Section 5(4)(b)

This section is normally pleaded where the claimant believes that he or she has a mark that should enjoy protection under another form of intellectual property right. The basis for this section of the Act is Articles 4(4)(c)(iii) and (iv) of the Directive which specifically refer to copyright and industrial property right.