INTELLECTUAL PROPERTY OFFICE

Opposing a trade mark

Introduction

This booklet explains:

- how to oppose someone's application for a trade mark in the UK; and
- how to defend your application against anyone else opposing its registration.

We have done our best to make sure that the information in it is correct. However, the booklet does not set out to cover every part of trade mark law.

If you would like more information or help please:

- phone 0300 300 2000 (we may record or monitor calls for training purposes);
- minicom 0300 0200 015;
- fax 01633 811175;
- e-mail tribunalsection@ipo.gov.uk; or
- visit our website at www.ipo.gov.uk

Or you can write to us at:

Intellectual Property Office
Trade Marks Registry
Tribunal Section
Cardiff Road
Newport
South Wales
NP10 8QQ.

Professional help

A trade mark attorney is legally and professionally qualified in trade mark matters. You do not have to use one to act for you but you may find it helpful if you are involved in opposition proceedings. You can get the names of trade mark attorneys from:

- The Institute of Trade Mark Attorneys Canterbury House
  2-6 Sydenham Road
  Croydon
  Surrey
  CR0 9XE
  Phone: 020 8686 2052
  Fax: 020 8680 5723
  Website: www.itma.org.uk

- The Chartered Institute of Patent Agents
  95 Chancery Lane
  London
  WC2A 1DT
  Phone: 020 7405 9450
  Fax: 020 7430 0471
  Website: www.cipa.org.uk

This booklet has three separate sections

Section 1 provides information on:

- what is opposition;
- how to oppose an application; and
- how to defend an application.

Section 2 provides information on:

- cooling off periods which allow time to agree a settlement;
- our preliminary indication of the likely result of a case;
- how to give evidence to support your case; and
- how to ask for more time to prepare your evidence; and
- how someone else may apply to become involved in the proceedings.

Section 3 provides information on:

- trade marks hearings; and
- costs.

Annexes

- Annex A - section 3 grounds
- Annex B - section 5 grounds
- Annex C - list of costs
- Annex D – Evidence Fact Sheet

Questions about opposition

Our Information Centre

You can phone our Information Centre on 0300 300 2000 **before** you oppose an application for registration.

Staff in this unit are not in a position to say if you could win your case, but they will be pleased to answer any general questions you may have.

Trade Marks Tribunal Section

Our Tribunal Section manages opposition cases. We will not be able to say if you could win your case, because we have to remain impartial, but we will be pleased to answer any questions you may have about opposition procedures.

Before or during an opposition:
- phone 0300 300 2000.

For information about hearings:
- phone 01633 811035.

At any time:
- e-mail tribunalsection@ipo.gov.uk

Section 1

What is opposition?

Once we have accepted an application for a trade mark for registration, we will advertise it in the Trade Marks Journal which is published every Friday on our website www.ipo.gov.uk.

After the trade mark has been published there is a two month period in which third parties may oppose its registration. This period may be extended to three months for any party which files an electronic form TM7a 'Notice of threatened opposition' within the initial two months beginning with the date of publication of the application. This form can only be submitted on-line, and it can be found on our website at www.ipo.gov.uk Filing a form TM7a does not commit you to opposing the application. If you want to oppose the registration of the trade mark without any extension to the time period allowed, then you can file a form TM7 'Notice of opposition' at any time within the two month period beginning with the date of publication of the application.

Opposition is the legal procedure which allows anyone to try and stop the registration of a trade mark. They may only do this by sending us the correct form. If anyone starts opposition proceedings, they become the 'opponent' in the case.

The most common reasons for someone wanting to oppose the registration of a trade mark are:

- they think the trade mark is one which is not unique to the applicant and should be free for everyone in that line of trade to use; or
- they own a trade mark (which does not have to be registered itself) which is the same as, or similar to, the applicant's trade mark.

What may happen as a result of opposition?

Opposition proceedings can result in one of three ways:

1. the opposition fails and we will register the trade mark;
2. the opposition succeeds and we will refuse to register the trade mark; or
3. the opposition partly succeeds. We will register the trade mark for only some of the goods or services.

How to oppose an application

What should I do first?

Opposition actions are often started because of wide specifications in the trade mark applications. It may be that the applicant would be prepared to restrict the scope of goods and/or services that they have applied for or to withdraw their application altogether in order to avoid a legal dispute. If you are considering opposing a trade mark application, you should approach the applicant to see if they will amend their application. If you file an opposition without having done this, and the applicant withdraws his application before sending us notice of their defence, you will not be awarded any costs.

Tell us that you wish to start opposition proceedings

You should send us:

- a 'Notice of opposition and statement of grounds' (form TM7) by fax or post; and
- a fee of £200

within two months beginning with the date of publication if the application, or within the additional one month extension allowed if you have previously submitted an electronic form TM7a 'Notice of threatened opposition' in respect of the trade mark application.

If you do not send us the form and fee in time, we will automatically register the trade mark.

You can get a copy of form TM7 from our website at www.ipo.gov.uk

What does it cost?

You will have to pay a fee of £200 with your form to start opposition proceedings.

Whoever loses the case usually has to pay towards the other person's costs. We set the amount, which is listed in Annex C at the back of this booklet.

Where can I find out about the law on opposition proceedings?

This is set down in Section 38 of the Trade Marks Act 1994 and Rules 17 to 21 of the Trade Marks Rules 2008. You can find these on our website at www.ipo.gov.uk

Can I oppose anything else about a trade mark?

You may also oppose:

- an application to amend an application after it has been published;
- a request to amend the regulations for a certification or collective mark;
- an application to alter a registered trade mark;
- the removal of information from the register;

The deadline for opposing any of these is two months beginning with the date they are published in the Journal, or one month for applications to amend a published application.

What must I put in the 'Notice of opposition and statement of grounds' (form TM7)?

You must say:

- what trade mark you are opposing;
- who is applying for it;
- who you are;
- who is your agent (if you have one);
- why you are opposing the registration of the trade mark; and
- if you are opposing it because of your rights in any earlier trade marks (see below), you will have to give full details of those trade marks and what use is being made of them.

What reasons can I give for opposing a trade mark?

You can oppose a trade mark because you don't think it is a distinctive word, logo, picture or other sign that will clearly identify the applicant's goods or services from those of other traders.

These reasons are called 'absolute grounds' in legal words. There is an extract from the law about absolute grounds (Section 3 of the Trade Marks Act 1994) in Annex A at the back of this booklet.

You can oppose a trade mark because you have already registered or applied to register a trade mark which:

- looks the same as or similar to the applicant's for the same or similar goods or services; or
- sounds the same as or similar to the applicant's for the same or similar goods or services.

These reasons are called 'relative grounds' in legal words. There is an extract from the law about relative grounds (Section 5 of the Trade Marks Act 1994) in Annex B at the back of this booklet. Section 5 also includes other reasons based on non-registered rights that you can use as reasons for opposing a trade mark.

You can use either or both reasons for opposing a trade mark.

You have to be the owner of the earlier trade mark or marks to use them as your reasons for opposing a trade mark.

Can I change my reasons for opposing the trade mark?

You may ask to change your reasons for opposing a trade mark at any time during the proceedings. But if it means the applicant is put to extra expense you may have to pay towards those extra costs.

Do I have to show that an earlier trade mark is being used?

The applicant may ask you to prove use of your earlier trade mark. The earlier trade mark must be put into use during the 5 year period prior to the date of the publication of the trade mark application being opposed. You will have to give a 'statement of use' as part of form TM7.

If the earlier trade mark has not been registered for a period of 5 years prior to publication of the opposed mark, you do not have to give a 'statement of use'.

You must say in your statement:

- what goods or services the earlier trade mark has been used on in the five years before the publication of the trade mark you are opposing; or

- why the earlier trade mark has not been used in that time

What if the earlier trade mark has not been used?

If we find later in the proceedings that you, or a previous owner, have not used the earlier trade mark, we will not take it into account in the proceedings.

What happens after I have sent you my form?

We will check the form to make sure you have:

- sent it within the time period allowed;

- paid the right fee;

- filled it in correctly; and

- given enough information for the opposition to go ahead.

If we do not understand anything on the form, we will write to you and allow you 21 days to make it clear or put it right.

What happens when the form is acceptable?

When we are satisfied that everything in the form is alright, we will send a copy to the applicant for the trade mark. The date we do this is called the ‘notification date’.

We will also tell the applicant they have two months to defend their application.

What must the applicant do?

If the applicant does not reply or does not withdraw their application, we will not register the trade mark, in so far as it relates to the goods and services in respect of which the opposition is directed. We may order them to pay you something towards your costs. We set the amount, which is listed in Annex C at the back of this booklet.

The applicant may decide to defend their application.

How to defend an application

Tell us that you wish to challenge the opposition, that is, to defend your application

If you want to challenge someone's opposition to your trade mark application, you must send us a 'Notice of defence and counter-statement' (form TM8) **within two months** of the date when we sent you a copy of their notice of opposition (the notification date). You can get a copy of form TM8 from our website at www.ipo.gov.uk

If you do not wish to defend your application, you may write to tell us you want to withdraw it or you may do nothing. We may order you to pay something towards the other person's costs. We set the amount, which is listed in Annex C at the back of this booklet.

Can I delay sending my defence?

If you and your 'opponent' (see previous section) both think you would like more time to agree a settlement before starting formal opposition proceedings, you can apply for a cooling off period.

If you do this you have an initial period of 9 months which can be extended up to **18 months** from the date when we sent you notice of opposition to send us your defence. But if you do not reply within the deadline we will not register your trade mark and may order you to pay something towards the other person's costs.

What if I do not send you my defence?

If you do not send us your 'Notice of defence and counter-statement' (form TM8) within the two month deadline (or up to 18 months if you have entered a cooling off period), your application will be withdrawn, in so far as it relates to the goods and services in respect of which the opposition is directed.

What does it cost?

You do not have to pay any fee for sending us form TM8.

What should I say to defend my application?

If you agree with anything the opponent has said in their statement of reasons, you should say so.

If you do not agree with what the opponent has said, you should say why you disagree and give reasons to support your case.

Should I admit or deny the statement of use?

If the opponent has given a statement of use of any earlier trade marks in their form TM7, you will have to admit (that is, agree) or deny (that is, disagree with) this statement in your counter-statement (form TM8).

- if you agree the statement of use, your opponent does not have to give any evidence of their use.

- if you disagree with the statement of use and request proof of use in your notice of defence (form TM8), the opponent will have to give evidence to show that the earlier trade marks have been used by them or a previous owner/licensee if the dispute goes to the evidence rounds.

What happens after I have sent you my form?

We will check the form to make sure you have:

- sent it inside the deadline (two months from the notification date or up to eighteen months if there is a cooling off period); and

- given enough information for the case to be defended.

If we do not understand anything on the form, we will write to you and allow you 21 days to make it clear or put it right.

What happens when the form is acceptable?

When we are satisfied that everything in the form is correct, we will send a copy to the opponent. The date we do this is called the 'initiation date'.

We will inform the opponent that they have to give their evidence or that we are soon going to give our preliminary indication.

Section 2

The cooling off period

What is a cooling off period?

A cooling off period is extra time allowed for both sides in opposition proceedings to try to agree to settle their differences without the need to go through the full legal procedure.

How much time is allowed?

Nine months from the date we send the applicant a copy of the notice of opposition. This date is called the 'notification date'. This period can be extended by a further period of nine months up to a maximum period of eighteen months.

If both sides enter a cooling off period, the applicant must send us their notice of defence inside this **eighteen month** deadline or their application will be withdrawn.

Who can ask for cooling off period?

Either the applicant or the opponent can ask for a cooling off period, by sending us form TM9c, **but both sides must agree to it.**

You can print a copy of the form from our website, fill it in and send it to us.

When can someone ask for a cooling off period?

You must ask for a cooling off period inside the two month deadline for the applicant to send us their defence of their trade mark. You cannot ask for a cooling off period later in the proceedings.

What does it cost?

You do not have to pay any fee when sending us form TM9c or a form TM9e.

Can you end a cooling off period?

If negotiations break down, either side can end a cooling off period:

- the applicant does this by sending us their notice of defence (form TM8); or

- the opponent does so by sending us a 'Request to terminate a cooling off period' (form TM9t). In this case the applicant will have one month from when we get the form TM9t to send us their notice of defence (form TM8).

Even if the cooling off period is ended early the applicant will have at least two months from the notification date to send us their notice of defence.

Can you extend a cooling off period?

Yes. Either party can request an extension to the initial nine months cooling off period by submitting a form TM9e. This will extend the cooling off period by a further nine months to a maximum period of eighteen months. The request must include a statement confirming that the parties are seeking to negotiate a settlement of the opposition proceedings. **Both sides must agree to it.**

The preliminary indication

What is a preliminary indication?

If someone opposes an application for a trade mark and uses Section 5(1) or 5(2) of the Trade Marks Act 1994 as their reasons for doing so, we will give our first opinion on the likelihood of confusion of the trade marks based on:

- the list of goods or services for the earlier trade marks and the list of goods or services for the application; and
- the criteria identified in the case law relating to Section 5 (1) and 5 (2) of the act.

We will write to the applicant and the opponent at the same time, giving them our first opinion. We will say if we think the applicant's trade mark should be registered for the goods or services they have listed, and give reasons for our opinion.

In legal words, our first opinion is called the 'preliminary indication' and the date we send it out is called the 'indication date'.

The law says we must not register trade marks which are:

- the same and for the same goods or services (Section 5(1));
- the same and for similar goods or services, and the public is likely to be confused by them (Section 5(2)(a)); or
- similar and for the same or similar goods or services, and the public is likely to be confused by them (Section 5(2)(b)).

Who decides your preliminary indication?

One of our senior officials called a 'Hearing Officer' will give our preliminary indication. If the case goes to the evidence rounds, a different hearing officer will be involved.

What happens after you have been given your preliminary indication?

Our preliminary indication has no legal status and either side may decide they wish to give evidence. In this case, they must send us a 'Request to proceed to the evidence rounds' (form TM53) within one month of getting our preliminary indication. We will send a copy of their request to the other side. The date we do this is called the 'initiation date' in legal words.

If no-one does this, we will take the action we put in our preliminary indication.

What may be the outcome of your preliminary indication?

Our preliminary indication can result in one of three ways:

1. the opposition fails;
2. the opposition succeeds;
3. the opposition partly succeeds and the goods and services of the application may be limited in line with the Hearing Officer's decision. We will register the trade mark only for those goods or services.

Sometimes we may decide not to give a preliminary indication.

What if I do not agree with your preliminary indication?

Both sides must accept our preliminary indication or send us a 'Request to proceed to the evidence rounds' (form TM53) within one month of getting our letter setting out our preliminary indication. There is no right of appeal against it.

Evidence rounds

Why must I give evidence?

You must give us evidence to back up anything you say in your reasons for opposing an application or for defending your application. You must also send a copy of your evidence to the other side in the proceedings.

What can I give as evidence?

We cannot tell you what to say. You must decide what information will help to support the reasons you have given for opposing or defending an application.

How should I present my evidence?

You should give your evidence in the form of a:

- witness statement;
- statutory declaration; or
- affidavit.

It helps if you can back up your evidence with examples of how any earlier trade marks have been used, such as packaging, advertising brochures or even samples of the product. We call these ‘exhibits’.

When must I give evidence?

We set the deadlines for both sides to give their evidence.

Is there a limit to how much evidence I can give?

You can give as much evidence as you wish to back up what you say in your notice of opposition or notice of defence.

Can I send samples of my products as evidence?

You may send samples of your products as exhibits to illustrate what you say in your evidence. But as you also have to send copies of your evidence to the other side in the proceedings, you may find it easier to send photographs of the product.

Can I give any more evidence?

Either side can ask us if they can give more evidence at any time during the proceedings. They must say:

- why they want to give more evidence;
- what the evidence will be about, or they may send a copy of the evidence; and
- why they could not give the evidence any earlier.

We will decide whether to allow the new evidence to be taken into account.

What happens after both sides have given all their evidence?

A decision can be made from the evidence and written submissions made by the parties. This ‘decision from the papers’ will involve a thorough analysis of all the evidence and full consideration of any written submissions made by the parties.

Alternatively a hearing can be requested at which the Hearing Officer will make a thorough analysis of all the evidence and any submissions will be oral rather than written.

Extensions of time

Can I have more time to give my evidence?

Anyone who needs more time to prepare their evidence may send us their ‘Request for an extension of time’ (form TM9) with a fee of £100.

You must say:

- how much more time you want;
- why you want more time;
- what you have already done to prepare your evidence;
- what else you have to do;
- why you have not been able to do this in the time you have already had.

We will write to tell you if our preliminary view is to agree your request, and send a copy of our reply to the other side in the proceedings.

You must send a copy of your request to the other side in the proceedings. If you do not do so, we will not agree your request.

What if I disagree with your preliminary view?

Either side has fourteen days to write to tell us if they do not agree with our view.

You can either send us your detailed reasons in writing, or ask for an ‘interlocutory hearing’ to put your case.

If neither side replies to our view within the fourteen day deadline, we will put it into action.

Intervention

What is intervention?

Only the owner of an earlier trade mark or right can oppose an application for registration. However a person with a written licence to use an earlier trade mark can apply to intervene in opposition proceedings brought by the owner of the earlier trade mark.

There is no fee for applying to intervene, but the intervener may become liable for costs if the opposition fails.

How do I apply to intervene?

You should send us:

- an 'Application to intervene in proceedings' (form TM27) by fax or post; and
- a statement of your reasons for making the application.

You can get a copy of form TM27 from our website at www.ipo.gov.uk

What does it cost?

You do not have to pay any fee for sending us form TM27.

When can I intervene?

There is no time limit for sending us your application, but ideally you should do so as soon as you know about the opposition proceedings.

What happens after I have sent you my form?

We will send a copy of your form to the applicant. We will ask what they think about your request.

We will decide your request, taking into account what the other sides involved may have told us.

What happens if you agree my request?

If we agree your request, you join the opponent for the rest of the proceedings. This means you may have to pay the costs if you lose the case.

What happens if you do not agree my request?

You may ask for an 'interlocutory hearing' to put your case.

Section 3

Hearings

What is a hearing?

A hearing is the opportunity for us to listen to what both sides in a trade mark dispute have to say about a case, and to decide who has the stronger case, based on trade mark law. Although it has proper legal status, it is not as formal as a trial in other courts.

The person who decides the case is one of our senior officials called a 'Hearing Officer'.

What does it cost?

There is no charge for a hearing, but the side which loses their case may have to pay something towards the other side's costs. We set the amount which is listed in Annex C at the back of this booklet.

Where are they held?

We regularly hold hearings in our London and Newport offices.

We can also arrange video or phone hearings between our London and Newport offices, or between either of those offices and some other location if we can set up a suitable link.

Who organises a hearing?

If both sides can agree a date, either of them may book a hearing through our website at www.ipo.gov.uk

This lists which dates are available up to about a month ahead.

Otherwise we will set a date and tell both sides when to attend. If this date is not suitable, you should arrange a suitable date with the other side and phone us so that we can set up the hearing.

What if I find I can't attend after a date has been arranged?

Phone our hearings clerk at once on 01633 811035. You may ask us to rearrange a date or agree to the hearing being held without you being there – see below.

Are hearings open to the public?

Generally all hearings involving disputes between two sides are open to the public, though we have the power to hold them in private if we think there are good reasons for doing so.

Do I have to attend?

You do not have to attend a hearing. If you tell us you are not going to attend, we will hold the hearing without you. We will take into account everything you have sent us in your written evidence. You may also set out your case in writing – what you would have said if you had attended – and send it to us and the other side at least a week before the date set for the hearing. We call this your 'written submission'.

What else should I do before a hearing?

You must send us and the other side a written outline of your case by 2pm at least two working days before the hearing. We call this a 'skeleton argument'. The other side must also send you their skeleton argument, so that everyone will be able to follow the case on the day.

Types of hearings

There are two types of hearings:

1. Interlocutory hearings

These are held to decide a point of procedure during the course of a dispute and not the main point at issue. They often deal with one side's disagreement with our decision about a request for an extension of time or costs.

The hearing will deal only with the disputed issue and nothing else.

How much notice will be given?

If both sides can agree a date, either of them may book a hearing through our website at www.ipo.gov.uk

This lists which dates are available up to about a month ahead.

Otherwise we will set a date and give both sides at least fourteen days' notice.

What happens at the hearing?

Each party attending the hearing will have the opportunity to put its case to the hearing officer.

When will we be told the result?

The hearing officer may give a decision at the hearing, or a written decision will be issued within 48 hours of the hearing.

2. Main hearings

These are held to decide the main point at issue, that is, the opposition to a trade mark being registered.

How much notice will be given?

If both sides can agree a date, either of them may book a hearing through our website at www.ipo.gov.uk

This lists which dates are available up to about a month ahead.

Otherwise we will set a date and give both sides at least one month's notice.

What happens at the hearing?

The order is as follows -

- the opponent puts their case;
- the applicant puts their case;
- the opponent may then reply to what the applicant has said; and
- the hearing officer may question either side at any time if it is not clear what they have said, either during the hearing or in their written evidence.

When will we be told the result?

The hearing officer will not be able to tell you their decision on the day. We will send both sides a copy of the hearing officer's written decision about four to six weeks after the hearing. Their decision will explain the background to the case, what they have decided and why they have reached their decision. It will refer to relevant trade mark law as laid down in Acts of Parliament and previously decided court cases. It may also include an order that one side should pay costs to the other.

We will also publish the decision on our website at www.ipo.gov.uk

As the website has details of recent cases you may find it useful to see the sorts of issues which we have decided.

Appealing the final decision

What if I do not agree with the decision?

If you feel that, in researching his decision, the hearing officer, made an error on a point of law, then you can appeal the decision. An appellate tribunal will not substitute their own view unless it finds that the hearing officer has made an error in their legal approach to the facts of the case.

Information on how to appeal is available on our website at www.ipo.gov.uk or by phoning us on 0300 300 2000.

What if both sides agree with the decision?

We will put the decision into action as soon as the deadline for any appeal has passed.

What does it cost?

It costs £200 to start opposition proceedings, but you do not have to pay anything to defend your application or to go to a hearing.

The hearing officer will usually order that the side which loses the case should pay something towards the other side's legal expenses. The amount to be paid is shown in Annex C at the back of this booklet, but in some cases the hearing officer may award more or less than the amounts listed.

Deciding the amount

- if you withdraw your application or your opposition before we take a final decision, the other side may still ask us to award them something towards their costs. We will write to ask for your views and give you fourteen days to reply.
- we will send both sides our view of the amount we are thinking of awarding, if any, and allow fourteen days for a reply. If either side does not agree with our view they may ask for an interlocutory hearing on the issue; and
- if neither side replies by the deadline, we will confirm our view and issue an order for costs against the side which has withdrawn or lost the case.

What if we settle without the need for a hearing?

We would expect the agreement you make to cover the matter of costs, but we do not usually get involved in such issues.

Starting an opposition without warning the applicant

You should tell the applicant that you intend to start opposition proceedings and give them a chance to withdraw their application or to limit the list of goods or services in their application.

If you do not do so and they withdraw their application before sending us notice of their defence, you will not be awarded any costs.

Making sure costs are paid

We have no power to make the side which loses pay the other side their costs, although we publish on our website a list of those who have not paid their costs. You can get advice about recovering your costs from the Small Claims Court Service. Their website is at www.courtservice.gov.uk

Annex A

Trade Marks Act 1994

Section 3 – Absolute grounds for refusal of registration:

Grounds for refusal of registration

3. - (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade: Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of –

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is -

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Annex B

Trade Marks Act 1994

Section 5 – Relative grounds for refusal of registration:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -
(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and
(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Annex C

Our costs

Preparing a statement and considering the other side's statement

From £200 to £600 depending on the nature of the statements, for example their complexity and relevance

Preparing evidence and considering and commenting on the other side's evidence

From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

Preparing for and attending a hearing

Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

Expenses

(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time)

(b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross exam

Annex D

What is evidence?

1 You have claimed in your 'statement of case' or 'counter-statement' that such-and-such happened, and your opponent has claimed that something different happened. You must now provide factual material to show that your claim is right or that your opponent's claim or denial is wrong. That material is your 'evidence'.

Example: You claim that you have used an unregistered mark since January 2000. To prove it, you might include in your evidence a statement as to where, when, how and on what scale the mark was used, and the goods or services for which it was used. Such a statement is usually supported by dated invoices for sales of products showing the mark in use and dated advertising material you used to market your goods under the mark.

What should my evidence be about?

2 You only need to provide evidence to support facts that are in dispute. You do not need to provide evidence to prove facts that the other side has already admitted to.

3 Your evidence should be concerned with proving facts, and not with the argument about what can be concluded from those facts. However, if your evidence is in response to evidence filed by the other party, you should identify any statements made in their evidence that you want the Hearing Officer to disbelieve. You can include such challenges in your evidence or in a covering letter.

What period in time should my evidence be directed at?

4. Evidence should be directed at establishing the factual position at the relevant date. In most cases this is the date of the application. However, where the dispute is about whether there has been genuine use of an already registered trade mark, the relevant period may be earlier than the date of the application. This will be clear from the other side's statement of grounds or counterstatement.

What form does evidence take?

5 Evidence must be in the form of written statements about the facts by individual people. These are known as 'witness statements'. A document such as the invoices mentioned in the Example in paragraph 1 can't be put in as evidence on their own because they need a statement from someone to explain what the documents are supposed to be. The invoices would be put in as an 'exhibit' to the statement.

Example: The witness statement might say: "On 8 January 2000 I commenced trading in clothing and to demonstrate this I refer to the invoices for January 2000 for the sale of clothing to independent retailers, marked exhibit AA1."

Who should make witness statements?

6. You will usually want to make a witness statement yourself. You may, though, strengthen your case if you can also supply witness statements from other people who can confirm that the facts you claim are true, preferably people who do not have a personal interest in your case.

7 A witness statement will be most convincing if the person concerned has direct experience of what they are writing about, for example, things they have seen, or documents they have written. Evidence about what someone else has seen, said or written will always tend to carry less weight.

How should I write a witness statement?

8 You should start with a title which identifies the proceedings. You should then give your name, address and occupation. If you are giving evidence in a professional or business role, you can give your working address, your position and the name of your firm or employer instead of giving your home address. Your evidence should be written in the first person (for example, 'I') and each paragraph should be numbered. It also helps if the evidence is written in the date sequence in which events happened.

9 The statement must be signed and dated by the witness themselves and contain a statement of truth, for example, "I believe that the facts stated in this witness statement are true." The witness must also sign a sheet of paper which identifies each exhibit as being the one mentioned in the statement.

You can find an example of a witness statement at the end of this fact sheet.

Are there any more rules about how I must present my evidence?

10 You should present your evidence on good-quality A4 paper, typed on one side of the paper only, and it should be easy to read. If possible, you should bind the evidence securely in a way which does not make it difficult to file, otherwise each page should have on it your initials. You should number the pages in order, and all numbers including dates should be in figures. The evidence should follow the sequence of events in date order as far as possible, with each paragraph just dealing with a different part of the subject. Any exhibits should be numbered. If at a later stage you file a second witness statement with more exhibits, continue the numbering where you left off so that you don't end up having two exhibits with the same number.

Does evidence have to be written in English?

11 If you want to file evidence in a foreign language, you may do so though you may also need to file a translation into English.

Can I ask for the documents I've presented to be treated as confidential?

12 Our files are open to public inspection and normally we don't treat documents as confidential. However, if you want us to keep any documents confidential, you must ask us to do this within 14 days of filing it. You must also say why you want us to keep the documents confidential.

13 If we agree, we will not make the documents available to the public. However, we will still have to send a copy to anyone else who is involved with the proceedings, or to their legal representative.

What happens after the evidence is complete?

14 When both sides have filed any evidence they want considered the case is ready for a decision. This will be taken from the documents and evidence on file. A decision will be made from the papers or, if the parties request one, following an oral hearing.

Jones Junk Foods Ltd
F J Brown
Statement Number 2
FJB4, FJB5, FJB6
01/01/2008

Trade Marks Act 1994

In the matter of application
No. 1234123 in Class 29 in the
name of Jones Junk Foods Ltd
and opposition thereto under No. 65432
in the name of Dickinson Dairy Delights Inc.

Witness statement of Fred John Brown

I, Fred John Brown of 9 Railway Terrace, Fazakerley, Liverpool, Merseyside, an independent retailer, state the following.

1. The trade mark . . . . was first used in the United Kingdom in the year . . . . by . . . . . .

2. The goods/services on which the mark has been used, and the date of first use, are as follows:-

3. I refer to . . . ., marked exhibit FJB4 showing indicative use of the mark in relation to these goods/services prior to [the relevant date in the proceedings].

4. Annual sales of the goods/services before the date of application were as follows:-

Dates Amounts (£'2)

5. I refer to . . . ., marked exhibit FJB5 consisting of invoices showing sales of [relevant] goods/services under the mark prior to [the relevant date in the proceedings].

6. Annual amounts spent on promoting the goods/services before the date of application were as follows:-

Dates Amounts (£'2)

7. I refer to . . . ., marked exhibit FJB6 consisting of advertising material showing how and where the mark was promoted prior to [the relevant date in the proceedings].

8. The mark has been used in relation to [relevant] goods/services in the following areas of the United Kingdom:-

9. Other information.

I believe that the facts stated in this witness statement are true.

Signature . . . . Date . . . .

Jones Junk Foods Ltd
F J Brown
Statement Number 2
FJB4, FJB5, FJB6
01/01/2008

Trade Marks Act 1994

In the matter of application
No. 1234123 in Class 29 in the
name of Jones Junk Foods Ltd
and opposition thereto under No. 65432
in the name of Dickinson Dairy Delights Inc.

Witness statement of Fred John Brown

This is exhibit FJB4 referred to in the witness statement of Fred John Butler dated
1 January 2008.

Signature . . . . Date . . . .