

What's changing?

Applications to register trade marks are no longer refused at the examination stage because of earlier conflicting trade marks. We notify applicants at the time their application is examined if there are any earlier trade marks (whether pending or registered) with which the new trade mark may be confused. These earlier trade marks could be UK trade marks, European Community Trade Marks (CTMs) or International trade marks which designate (cover) the UK or the European Union (EU) as a whole. If the applicant for the new trade mark chooses to proceed with their application we publish it in the Trade Mark Journal. At that time we notify the owners (or their representatives) of any earlier UK trade marks or International marks protected specifically in the UK. We also notify owners (or their representatives) of any relevant International trade marks protected throughout the EU as a whole and European Community Trade Marks, but only if they have opted to receive our notifications.

What happens when a mark is published in the trade mark journal?

The Trade Marks Journal is a weekly electronic publication containing details of trade mark applications which are proposed to be registered. The owner of an earlier trade mark or right who objects to a new trade mark has three months starting from the date of publication in the Journal in which to lodge a formal objection to the registration of the new trade mark: **this is called opposition**. This period cannot be extended. If we do not receive any opposition, the trade mark will be registered.

If you file an opposition form (called a TM7) with the fee of £200 you are starting legal proceedings. The proceedings take place at the Intellectual Property Office. The opposition is a dispute between the opponent and the applicant, not between either of them and us. We must act impartially because we are running a tribunal.

When you and the applicant have set out your cases and submitted any evidence that you wish to rely upon, a Hearing Officer, acting on behalf of the registrar, makes a decision about what should happen to the new trade mark. This decision can be appealed to an independent judicial authority known as The Appointed Person, or to the High Court.

Who can oppose?

Opposition on relative grounds can only be made by the owner of an earlier trade mark or right. However, a person with a written licence to use an earlier trade mark can apply on Form TM27 to intervene in opposition proceedings brought by the owner of the earlier mark. There is no fee for filing this form but the intervener may become liable for costs if the opposition fails.

Are there any conditions?

Where the opposition is based upon the existence of an earlier trade mark which has been registered for 5 years at the date that the new mark was published in the Trade Mark Journal, the opponent is required to state whether, and for which goods or services, the earlier registered mark has been used in that period. The applicant has the right to require the opponent to prove that the earlier mark has been used for those goods and services. For the purposes of the opposition, you are not be allowed to rely upon the registration of an earlier mark for goods or services for which no genuine use of the mark can be shown in the 5 year period, unless there are proper reasons for non-use.

If I do not oppose, will I lose my right to object later?

Failure to oppose does not prevent you from applying to have the later registered trade mark declared to be invalid. So you could wait and see where and for which goods or services the later trade mark is actually used before deciding whether to take action. Invalidation applications can also be made to the Intellectual Property Office, and the cost of such an action is unlikely to be significantly more than the cost of an opposition.

However, if you become aware of the use of the later mark in the UK market for a continuous period of five years, without taking any action to object to that use, you may lose your right to object later.

Who will advise me?

We must remain impartial at all times because we are operating a tribunal. This means the advice we can give is mostly limited to general information about the opposition procedure. We cannot give advice on whether you should oppose a mark. It is for you as the potential opponent to decide how you wish to present your case, the grounds of your opposition, whether you should file evidence and what the content of your evidence should be.

We can advise you on which dates actions must be taken, the format of documents and evidence, and the next steps in the proceedings.

You may obtain details of where to get independent professional help and advice from either of the following:

The Institute of Trade Mark Attorneys, www.itma.org.uk

or

The Chartered Institute of Patent Agents, www.cipa.org.uk

The Registrar's Preliminary Indication

Where the opposition is because you claim that there is a likelihood of confusion with your earlier trade mark, it is our practice to issue a preliminary indication of the likely result of the opposition on that ground. However, we will not do this if both parties ask us not to or the Hearing Officer considers that the likely outcome is so difficult to predict that a preliminary indication would not be helpful. Where such an indication is given it is be issued after the applicant has filed his defence (in an opposition, called a counterstatement), but before either side has filed evidence. It is therefore important to note that the preliminary indication cannot take account of the effect of any failure on your part to show genuine use of the earlier trade mark(s) on which you have based your opposition.

The preliminary indication is not binding. If it is rejected and the opposition proceeds, the final decision will be taken by a different Hearing Officer, who could take a different view to that set out in the preliminary indication. Nevertheless, the preliminary indication should be taken seriously. Proceeding in the face of an adverse preliminary indication means that you stand a significant chance of losing and becoming liable for further costs.

What should I do first?

Opposition actions are often started because of wide specifications in 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 so as to avoid the goods and services of interest to you, or withdraw the application. If you file an opposition without having done this, and the applicant quickly withdraws his application in response to your opposition, you probably won't be awarded the usual costs that help to meet the cost of your filing the opposition.

What happens next?

The applicant has three months from the time that he receives your opposition to file a counterstatement giving his reasons why your opposition should be rejected. If both sides agree, this period may be extended to 12 months (called 'cooling off') so that the parties may negotiate a settlement. You should also consider mediation.

If a counterstatement is filed the registrar may issue a preliminary indication (see above). If he does, and the "losing" side accepts it, then the opposition will be concluded in favour of the "winning" side, unless there are further grounds of opposition in addition to your claim about a likelihood of confusion between the respective trade marks.

If the "losing" party rejects the preliminary indication by filing Form TM53, or no such indication is given, or there are further grounds of opposition, the parties will be given a chance to file evidence about facts which support their cases. Firstly, the opponent will be given up to three months to file such evidence. If the applicant has exercised their right to require you to show use of your earlier trade mark(s), your evidence should at least address this requirement. Secondly, the applicant will then be given up to three months in which to file any evidence about facts that they wish the Hearing Officer to take into account. Thirdly, and only if the applicant files evidence, you will be given up to three months within which to file further evidence strictly in reply to the applicant's evidence.

Once the parties have submitted evidence of relevant facts, the Registrar's Hearing Officer will give the parties a chance to request a face to face hearing or to file written arguments instead. After considering the evidence and the arguments made to him, the Hearing Officer will issue a decision about the outcome of the application and the opposition and decide who should pay any costs.

What are the risks?

Your opposition may not succeed and you will find that you are liable for costs.

How long will it take and how much will it cost?

Nearly three in five oppositions are concluded inside one year. However, some cases take longer. The costs that the unsuccessful party must bear also vary. The amount awarded relates to a published 'scale of costs'. As a guide, and provided that you gave the applicant reasonable notice before filing your opposition, the costs start at £500, even if the application is withdrawn without any further action on your part. If the proceedings go the full distance, it is not unusual to have to pay or receive £2000 in costs. Costs are awarded as a contribution to the other side's expenses, not as compensation and not as a penalty. The scale means that you know the level of risk you take when filing an opposition.

Where can I find out more?

Our website has more detailed information and downloadable booklets on trade mark dispute procedures, see www.ipo.gov.uk, including on-line opposition and defence forms. If you feel you would like professional advice from a trade mark attorney who can help you with your specific case, please contact either of the following:

The Institute of Trade Mark Attorneys, www.itma.org.uk

or

The Chartered Institute of Patent Agents, www.cipa.org.uk