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9. GLOSSARY OF TERMS

1. INTRODUCTION

1.1 Purpose of this chapter of the work manual

The purpose of this chapter of the manual is to outline procedures and give guidance on inter partes proceedings by:

- Clearly defining the different types of proceedings
- Indicating the sections of the Trade Marks Act 1994 (the Act) and the Trade Marks Rules 2008 (the Rules) which regulate each aspect of inter partes proceedings
- Setting out the requirements for the filing of documents, pleadings and evidence
- Detailing the practice of the Trade Marks Registry's Tribunal Section
- Detailing the activities of the Trade Marks Registry as a Tribunal
- Setting out the avenues for appeal against decisions by the Trade Marks Tribunal

1.2 Decisions of other Courts and Tribunals

The management of inter partes actions under the Act must be by reference to the provisions of that Act, taking account, where appropriate, of existing practice as laid down or endorsed by appellate bodies.

Court of Justice of the European Union (CJEU)

Decisions of the CJEU on points of law are binding on the Tribunal. They are usually cases referred to the Court by EU member states for a 'preliminary ruling' on a point of law or cases on appeal from the General Court (GC).

General Court (GC)

Decisions of the GC on points of law are binding on the Tribunal and decisions of fact are of persuasive value in cases where similar considerations apply. The GC is used for appeals involving Community institutions such as the OHIM. There is the right of appeal from the GC decision to the CJEU.

UK Courts

These decisions are binding on the Tribunal.

Appointed Person (AP)

Decisions are not binding on the Tribunal other than in the case being dealt with. However they are of persuasive value in considering similar cases. These decisions are published on the Office website under 'HEARINGS (Results of past decisions)'. Appointed Persons are experienced intellectual property law practitioners who are appointed by the Lord Chancellor. A decision of the Tribunal may be appealed to the Appointed Person (see section 7) but is not subject to further appeal.

1.3 Decisions of Tribunals/Courts in other Member States

Decisions of other national tribunals/courts within the EU may be of persuasive value in determining the meaning of the Directive based provisions of the Act, but they are not binding upon the Registrar. In *Wagamama* [1996] FSR 716, Laddie J. held that:

"It would not be right for an English Court, if it is firmly of a different view, to follow the route adopted by the courts of another Member State simply because the other courts expressed a view first. The scope of European legislation is too important to be decided on a 'first past the post' basis."

1.4 Accessing decisions

Decisions in earlier cases are available from several sources:

British Library (BLs) - all decisions of the Tribunal's Hearing Officers and the Appointed Persons are first published for dissemination through the British Library. Subsequently, and if they are of particular interest or importance, they may be republished in other legal reports such as RPCs, FSRs or ETMRs. Decisions are available from the IPO website at:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Reports of Patent, Design and Trade Mark Cases (RPCs) - these normally include reports of appeals to the courts and sometimes to the Appointed Person. They may also include decisions of the Tribunal where the decision contains statements of practice and interpretation of the law.

European Trade Mark Reports (ETMRs) - these contain reports from around the European Union (EU) by examination offices, tribunals & courts which bear upon the interpretation of the European Community Directive underlying all EU national and supranational trade mark law.

Fleet Street Reports (FSRs) - these also contain reports of intellectual property cases of interest and are published by Sweet and Maxwell.

1.5 Practice guidance

In addition to case law the Tribunal publishes the following practice guidelines:

Tribunal Practice Notices (TPNs) – these provide guidance for practitioners on how the Registrar is regulating tribunal activities and are incorporated within this chapter.

Law Practice Directions (LPDs)/Patent Directorate Notices (PDN) - LPDs and/or PDNs are published on the Intellectual Property Office website to notify practitioners and the public of any changes to, or clarification of, internal guidelines.

1.6 The role of the Tribunal and its inherent power to regulate procedures

The inherent jurisdictions of the Tribunal to act in inter partes matters are defined in *Pharmedica*¹, when Pumfrey J stated:

“Notwithstanding the fact that the Registrar is, like the County Court, a tribunal which is established by statute, I have no doubt that the Registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”

In inter partes proceedings the Tribunal is acting in a quasi-judicial capacity. Those who represent it must remain impartial at all times and are therefore unable to advise litigants on the strength or weakness of their cases.

The Tribunal can help on matters of procedure but not substance. This was made clear by the Appointed Person in the *Trocadero* case (BL O/440/99) in which it was held that it is not for those arbitrating these disputes to become involved in ‘debate’:

“10) Accordingly, in relation to opposition and revocation proceedings, the Registrar's officers cease to perform an administrative function and act solely in a judicial (or quasi judicial) capacity. The distinction is I believe an important one, particularly in the circumstances of the present case. When acting in an administrative capacity, the Registrar has to enter the debate with the applicant, has to reason with him and necessarily will engage in correspondence or in conversations with the applicant in order to seek to resolve any matters arising. If this can be done to the applicant's satisfaction, there is no need for a hearing.

11) Once the Registrar begins to perform his judicial function, the position is different. The Registrar or his officer is acting as a judge. The proceedings are adversarial, the issues are circumscribed by the pleadings and the parties are free to adduce the evidence and the arguments that they wish. It is the Registrar's duty to adjudicate upon the issues raised. It is not his duty and, indeed, it would be wrong for him, when exercising this function, to enter into a debate with either party as to the validity or otherwise of the contentions put forward on any of the issues raised in the proceedings.”

¹ [2000] RPC 536, page 541

In correspondence, initial views may be expressed by the Tribunal on the basis of what the parties have said up to a particular point. An example would be in relation to a request for an extension of time. It must be stressed that an initial view does **not** represent a final determination of the matter, which may come after a hearing or written submission.

1.7 The Civil Procedure Rules

In its role as a tribunal, the Tribunal adheres to the same overriding objective as the court for dealing with cases justly. This is set out in rule 1.1 of the Civil Procedure Rules 1998 (as amended) and includes, so far as is practicable:

- (2) (a) Ensuring that the parties are on an equal footing
- (b) Saving expense
- (c) Dealing with the case in ways which are proportionate –
 - (i) to the amount of money involved
 - (ii) to the importance of the case
 - (iii) to the complexity of the issues and
 - (iv) to the financial position of each party
- (d) Ensuring that it is dealt with expeditiously and fairly and
- (e) Allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases

1.8 Procedures before the Tribunal

- 1) Opposition
- 2) Revocation (on grounds of non-use)
- 3) Revocation (on grounds other than non-use)
- 4) Invalidation
- 5) Rectification

1.9 Responsibility of one party to another

The rules require the Tribunal to send copies of the forms commencing an action to the other party; the same is true of any defence filed. However, the Tribunal will not, as a matter of course, copy any other document. Disputes before the Tribunal are *inter partes*, which means that the Tribunal is acting as an impartial adjudicating body between two (or more) parties. To ensure fairness and transparency of proceedings, **it is imperative that any correspondence, including forms, sent to the Tribunal are copied to the other side and contain confirmation that it has been so copied.** Failure to indicate copying and failure to copy is detrimental to the other side and to the resources of the Tribunal and its ability to allot resources to other users fairly. Copying of correspondence also applies to statutory forms. In particular, failure to copy requests for extensions of time can create unnecessary complications if time is granted and the other side has hitherto been unaware of the

request. Similarly, failure to copy evidence to the other side, which is a requirement of rule 64(6)(b), results in the evidence not being considered filed.² If parties persistently fail to copy correspondence and documents to the other side, this will be regarded as unreasonable behaviour and there may be cost implications at the conclusion of the proceedings.

An increasing proportion of litigants using the Tribunal are without professional legal representation. The Tribunal provides information on its procedures on the IPO's website and would expect users to look at this information prior to contacting the Tribunal. However, the Tribunal recognises that unfamiliar legal territory sometimes gives rise to questions. We will give reasonable information about procedures and clarification of directions but all parties using the Tribunal have a duty to respect its inter partes nature. This means that the **Tribunal will not enter into telephone debates or give further reasons for a preliminary view (for example on extension of time requests) to just one party over the telephone**. Such calls will be terminated because the other side is not party to the discussion. If a party disagrees with the other side's/Tribunal's view on a particular procedural issue, then it must **put its comments in writing (either by letter or email), copied to the other side**. Both for reasons of fairness and efficient use of the Tribunal's resources, its officers will terminate telephone calls when their nature ceases to be appropriate, whether that is because of the content or the length of time the call is taking.

1.10 Right to Appeal

(Full details of appeal procedure can be found at section 7).

Under the Act any decision of the Tribunal can be appealed to the Court or to the Appointed Person.

1.11 Tribunal contact points

Inter partes proceedings are handled by the Tribunal Section. If you have a telephone query then you can expect a response within normal business hours - 9.00am - 5.00pm. The general enquiry number is: 0300 300 2000. Alternatively you can send an email to tribunalsection@ipo.gov.uk

2. FORMALITIES

2.1 Address for service

Rule 11 of the Trade Marks Rules 2008

For the purposes of any proceedings under the Act or Rules an address for service in the UK, Channel Islands, or another EEA state, must be filed.

Failure to file an address for service may result in a party being considered by the Tribunal as having not defended or withdrawn from the proceedings or may result in an opposition or cancellation action being struck out.

² TK PATROL, BLO/426/02, Paragraph 7

2.2 Hours of business and excluded days

Section 80 of the Trade Marks Act 1994

Rule 80 of the Trade Marks Rules 2008

Section 80 of the Act provides that the Tribunal may give directions specifying the hours of business and the days which are 'business days'.

Business done after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

Rule 80 requires the Registrar to publish, on the IPO website, any directions which may be given in relation to specified hours and business days.

The Registrar has made the following Directions³ under section 80(1) which came into force on 15 July 2011:

- Trade Mark applications which do not claim priority under section 35 or 36 can be filed at all times on every day of the week including weekends, public holidays and bank holidays
- All other forms, applications and other documents can be filed at all times from Monday to Friday
- The Office shall be open from Monday to Friday between 09:00 and 17:00 for all other types of business not detailed above
- For all purposes under the Act, other than the filing of new trade mark applications without a priority claim, the following shall be non-business days: All Saturdays and Sundays, Good Friday, Christmas Day and any day which is specified or proclaimed to be a bank holiday in or under section 1 of The Banking and Financial Dealings Act 1971⁴

2.3 Interruptions to the normal operation of the Office and/or the postal service

Rules 75 and 76 of the Trade Marks Rules 2008

³ In these Directions:

'the office' means the Patent Office;

'business' means business transacted by the public under the Act or any class of such business;

'non-business day' means a day excluded for any such business or class of business;

'applications' means applications for trademarks filed under the Act.

'forms' means documents containing the information required by the relevant Trade Marks Forms as set out in Directions under Section 66 of the Act.

The Directions of the same title which were given in November 1994 and came into force on 31 October 1994 are revoked.

⁴ Except for the filing of applications in respect of which no declaration for the purpose of sections 35 or 36 of the Act is made.

Rule 75 allows the Registrar to certify that a day or days have been subject to 'interruption' and accordingly, if any period of time specified in the Act or Rules expires on such a day, then that period shall be extended to the next following day not being an 'interrupted' or 'excluded' day⁵.

Rule 76 allows the Registrar to extend any time limit specified under the Rules where the Registrar is satisfied that the failure to do something was wholly or mainly attributable to a delay in, or failure of a communication service⁶. For example, if a person uses a postal service which guarantees next-day delivery but the documents do not actually arrive at the Office until a later date, the Registrar may invoke rule 76, if the person can provide proof of such postage. The effect of invoking rule 76 will mean that the documents will be deemed to have been filed on the date that the postal service had guaranteed.

2.4 Filing of documents

Rules 2(3), 78 and 79 of the Trade Marks Rules 2008

The terms 'to file' or 'filing' means to 'deliver to the Registry'.

- Documents can be filed by post, facsimile, email, in person or by courier to either, the London or Newport Offices
- The fax number recommended to be used for all **fee-bearing forms**, is 01633 817777
- The Trade Marks Tribunal Section fax number, 01633 811175 or e-mail address, tribunalsection@ipo.gov.uk, can also be used for all other **non-fee bearing** forms and documents in relation to trade marks inter partes proceedings
- Certain forms must be filed using the e-Form provided on the IPO website e.g. TM7A

Regardless of the method by which documents are filed, they will be dealt with in order of date of receipt.

Faxed documents in inter partes proceedings

Documents filed by facsimile in inter partes proceedings should not be supported by confirmation copies through the normal postal system, **unless specifically requested**. The Tribunal will assess whether the facsimile copies received are of good enough quality and only if they are not will the originals be requested.

⁵ 'excluded day' means any day which is not a business day as specified in a direction given by the registrar under Section 80; and

'interrupted day' means any day which has been certified as such under Rule 75(1).

⁶ 'communication service' means a service by which documents may be sent and delivered and includes post, facsimile, e-mail and courier.

Where a party wishes to file non-standard size items as exhibits, or where colour may be an important factor, filing facsimile documents is not appropriate and such evidence should be filed through the normal postal system or by hand/courier.

2.5 Use of email

The Tribunal has no objection to the use of email communication, provided it is copied to the other side and marked as such. The Tribunal will deal with all correspondence in date order regardless of the method of filing. Emailed correspondence will not be answered out of turn merely because it has been electronically mailed.

2.6 Forms and fees in inter partes proceedings

The following table lists the forms which are applicable in inter partes proceedings before the Tribunal Section. All fee-bearing forms must be accompanied by that fee at the time of filing. The forms, guidance notes and current fees can be accessed at the following link: <http://www.ipo.gov.uk/types/tm/t-formsfees.htm>

FORM	PURPOSE
TM7a- Notice of Threatened Opposition	The form filed by anyone seeking to extend the opposition period to three months beginning with the date of publication of the application. It must be filed on-line through the Office website.
TM7-Notice of Opposition	The form filed to launch opposition proceedings against a trade mark application.
TM8-Notice of defence and counterstatement	The form which must be filed by the applicant if they wish to defend their application from opposition proceedings. It must also be filed by the registered proprietor in invalidation, rectification and revocation (other than non-use) if they wish to defend their registration. In all cases, the form must include a counterstatement.
TM8(N)-Notice of defence and counterstatement in revocation (on the grounds of non-use)	The form which must be filed by the registered proprietor in revocation proceedings (on the grounds of non-use) if they wish to defend their registration. It must include a counterstatement.

Form TM9-Request for an extension of time	The form which must be filed by a party seeking to request an extension of time to a statutory period. However, parties should note that there are certain periods which cannot be extended (these are listed in Schedule 1 of the Trade Marks Rules 2008).
Form TM9C-Request to enter the cooling-off period	The form which must be filed in opposition proceedings if both parties wish to enter into the cooling-off period for the purpose of negotiating a settlement.
Form TM9E-Request to extend the cooling-off period	The form which must be filed in opposition proceedings if both parties wish to extend the cooling-off period for the purpose of negotiating a settlement.
Form TM9T-Request to terminate a cooling-off period	The form which must be filed by the Opponent in opposition proceedings to terminate the cooling-off period.
Form TM21-Request to change the details of an application	The form which must be used when the applicant for a trade mark wishes to amend their name or address or to amend the goods/services covered by their application.
Form TM22-Notice to surrender a registration	The form which must be used by the registered proprietor to surrender their registered mark in full.
Form TM23-Notice of partial surrender of a registration	The form which must be used by the registered proprietor to surrender only some of the goods/services covered by their registered mark.
Form TM26(I)-Application to declare invalid a registration or a protected international trade mark (designating the UK)	The form which must be used by an applicant for invalidity to apply to remove a trade mark from the register.
TM26(N)-Application to revoke a registration or a protected international	The form which must be used by an applicant for revocation to try and remove a trade mark from our register on the basis that it has not been used.

trade mark (designating the UK) for reasons of non-use	
TM26(O)-Application to revoke a registration or a protected international trade mark (designating the UK) for reasons other than non-use	The form which must be used by an applicant for revocation to remove a trade mark from our register on the basis that the mark has become common in trade, for the name for a good or service for which it is registered, or where it is likely to mislead the public.
TM26(R)-Application to rectify the register.	The form which can be used to rectify an error or an omission in the details of a registered mark. It can be filed by the registered proprietor or anyone who can show that they have a 'sufficient interest' in the mark.
TM27-Application to intervene in proceedings	The form which must be used by a party, other than the registered proprietor, who claims to have an interest in a registered trade mark and that party wishes to take part ('intervene') in those proceedings.
TM29-Application to set aside a decision	The form which must be used to apply to set aside a decision issued in inter partes proceedings.
Form TM53-Request to proceed to evidence rounds	The form which must be used in opposition proceedings to notify the Tribunal that one or more of the parties wishes to proceed to the evidential rounds, after the Tribunal has issued a preliminary indication.
Form TM55-Notice of Appeal to the Appointed Person	The form which must be used when a party wishes to appeal against a decision of the Tribunal to the Appointed Person . (This Form is not to be used if the party wishes to appeal to the Court.)

2.7 Payment of fees

Rule 2 of the Trade Marks (Fees) Rules 2008

Rule 2 of the Trade Marks (Fees) Rules 2008⁷ provides that forms requiring payment of a fee **must be accompanied by that fee**. The fee must be filed at the same time as the relevant form. The term 'accompany' does not allow for the fee to follow

⁷ The Trade Marks (Fees) Rules 2008 replaced and revoked the Trade Marks (Fees) Rules 2000. Rule 2 of the Trade Marks (Fees) Rules 2008 is equivalent to what was Rule 3 of the Trade Marks (Fees) Rules 2000.

shortly after the form is filed.⁸ The Tribunal will accept instructions such as, 'Please debit our deposit account, being account number x' however the party must ensure that the account contains sufficient funds, at the time of filing the form, to allow the fee to be taken. Payment can also be made by cheque, payable to 'The Patent Office', credit/debit card, bank transfer or other means acceptable to the Office.

PROCEDURES BEFORE THE TRIBUNAL

3.1 Opposition

Section 38 of the Trade Marks Act 1994

Rules 17, 18, 19, 20, 21 and 43 of the Trade Marks Rules 2008

Once an application for registration has been examined and accepted by the Registry, it is published in the Trade Marks Journal. Once published, an application is open to opposition. Opposition may be filed in respect of all, or only some, of the goods and/or services for which registration of the trade mark is sought. The opposition period is two months but may be extended to 3 months.

Generally, oppositions are based upon section 3 and/or section 5 of the Act which set out absolute and relative grounds for refusal of registration. These sections should not be confused.

Section 3 of the Act: relates to an *absolute ground*; that is, generally speaking, something inherent in the mark itself which prohibits it from being registered.

Section 5 of the Act: relates to *relative grounds*; that is, where registration of the trade marks would impinge upon another person's existing marks or rights.

Opposition based upon section 5 (relative grounds) can only be launched by the owner of the mark or right(s) on which the opposition is based. (Other parties who may have an interest in the proceedings, e.g. a licensee, would have to intervene after the proceedings were joined, (see section 4.10 for intervention).

The publication in the Trade Marks Journal of the following is also open to opposition:

- a. Applications amended after publication (rule 25(2))
- b. Regulations for collective/certification marks applied for under the 1994 Act (paragraph 8 schedule 1, paragraph 9 schedule 2)
- c. Amendment of regulations of collective/certification marks (rule 30(4))
- d. Amendments to registered marks (rule 32(3))

⁸ *TITAN* (BL O/460/01). This case related to the filing of a Form TM7 in opposition proceedings, where insufficient funds were present in the opponent's deposit account to pay the fee which must accompany the TM7.

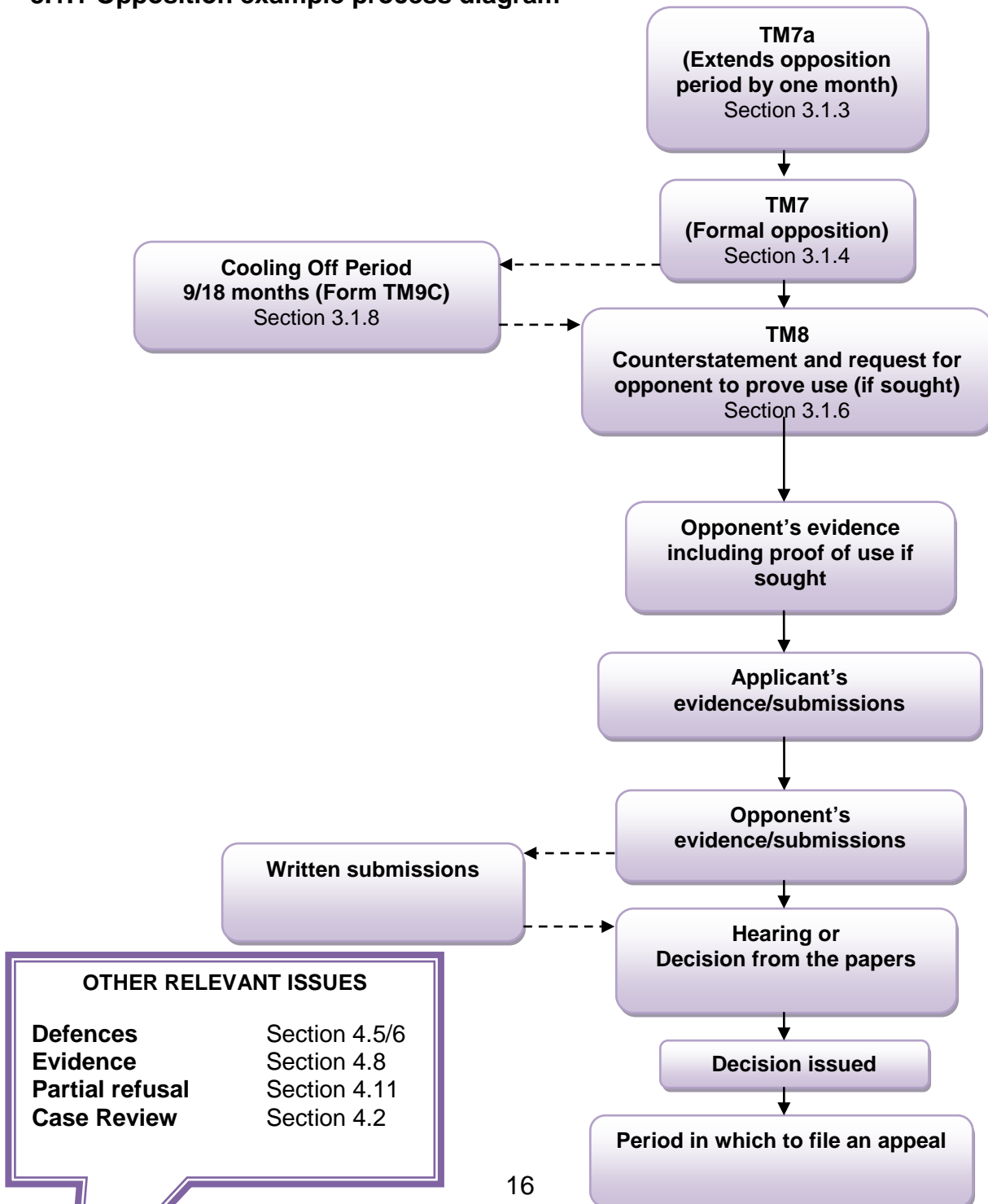
e. Removal of matter from the register (rule 53(2))

f. Reclassification of marks (rule 55(1))

Any person who wishes to lodge an opposition against any of the above should file Notice of Opposition on a TM7 with the appropriate fee within the period allowed. For "b" "c" "d" "e" and "f" above, the period for lodging opposition is two months. For "a" above, the period is one month.

It should be noted that under the provisions of rule 77(5), no extension of the opposition period is allowed for lodging opposition.

3.1.1 Opposition example process diagram



3.1.2 Notice of opposition

Rule 17 of the Trade Marks Rules 2008

Any party wishing to oppose a published mark has a period of two months beginning with the date of publication within which to indicate their intention to oppose the published mark on a TM7a or to launch a formal opposition on a TM7.

At the end of the two month period following publication in the trade mark journal every mark that has had neither a TM7a nor a TM7 filed against it will proceed to registration.

3.1.3 TM7a

The TM7a is, in effect, a request for an extension of the period for filing the TM7. It must be filed within the two month period allowed for opposition and must be filed electronically using the system provided on the IPO website. Upon acceptance of this form the party filing it has an additional one month in which to file the TM7 to formally commence opposition proceedings. Where the TM7a is filed by a company, the TM7 may be filed by a subsidiary or holding company of that company.

3.1.4 TM7

Where a TM7 is filed during the third month following the advertisement of the application a check is undertaken to ensure that the filer of the TM7 had previously filed a TM7a.

Formal notice of opposition must be filed at the Tribunal on a TM7 which should include a statement of grounds, setting out the basis of the opposition. The rules state that a fee is also required and must accompany the opposition documents.

Where the opposition is based on an earlier trade mark, a representation of that trade mark must be included.

In addition, if the mark relied on by the opponent constitutes an earlier trade mark as defined in section 6(1) and 6(2) of the Act; (i.e. a UK trade mark, an International trade mark (UK), a Community trade mark or an International trade mark (EC) which has a date of application or seniority earlier than that of the application in question taking into account priority dates) the following must also be provided:

- The jurisdiction in which the mark is registered or has been applied for
- The application or registration number of the mark
- The goods and services for which that mark is registered
- The goods and services on which the opposition is based and, where necessary

- A statement of use (if the opposition is based on an earlier registered mark, which has been registered for more than five years, the opponent will be required to state the goods and services for which the mark has been used during the relevant period or give any proper reasons for non-use during the relevant period)

or

- Where the mark is not registered and the opponent is utilising section 5(4)(a) of the Act, a representation of the mark must be provided with a list of the goods and services in respect of which protection is claimed together with details of when and where the earlier right was used including a date of first use

On receipt of the notice of opposition and other documents the Tribunal will scrutinise the statement of grounds in accordance with section 4.13.

THE PERIOD FOR FILING A TM7a AND/OR A TM7 CANNOT BE EXTENDED.

3.1.5 Serving the notice (TM7)

Rule 18 of the Trade Marks Rules 2008

The Tribunal will send the TM7 with the statement of grounds and any other documents to the applicant, by recorded delivery, at their last recorded address for service. The date on which these are sent is known as the “notification date”.

3.1.6 TM8

The applicant has two months from the “notification date” in which to file a TM8, notice of defence, (no fee required), which should incorporate a counter-statement. The purpose of the counter-statement is to admit, deny with explanation or indicate that proof is required of any of the grounds set out by the opponent in its statement of grounds. If no TM8 is filed and there is no request for a “cooling off” period (see section 3.1.7 below) within this two month period, the applicant is deemed to have abandoned his application for registration.

THE PERIOD FOR FILING A NOTICE OF DEFENCE ON A TM8 CANNOT BE EXTENDED.

The Tribunal will send the TM8, incorporating the counter-statement, to the opponent at their last recorded address for service. The Tribunal will also notify the parties of the timetable for filing evidence.

3.1.7 Failure to file a defence (TM8)

Rule 18 of the Trade Mark Rules 2008

Where an opposition is undefended and only some of the goods and/or services have been opposed, the Tribunal will notify both parties that the application will be

deemed to be abandoned in respect of the goods and/or services which were opposed on the TM7. The remainder of the application will proceed to registration. If all of the goods and/or services have been opposed, the entire application will be deemed abandoned.

Also see section 4.11 for full details of partial refusals.

3.1.8 The Cooling Off period

Rule 18 of the Trade Marks Rules 2008

If the parties wish to take advantage of a *further* period within which to negotiate a settlement, a request can be made on a TM9C (by either party) to extend the period for filing the counter-statement. The period allowed for filing a TM9C is two months from the “notification date”.

The cooling off period can only be initiated when both the applicant and the opponent(s) agree to it.

Taking advantage of the initial ‘cooling off’ period will give the parties nine months from the “notification date” to negotiate a settlement.

Extension to the initial Cooling Off period

Rule 18 of the Trade Marks Rules 2008

If the parties require additional time in ‘cooling off’, to continue negotiations, a TM9E can be filed to request a further extension of time for the filing of a TM8. This request can be filed by either party, but again, only if both parties agree to the further extension. Any request to extend a cooling off period must include a statement confirming that the parties are actively negotiating a settlement to the opposition proceedings.

This further extension of the ‘cooling off’ period will give the parties eighteen months from the “notification date” to negotiate a settlement. If the parties are unable to reach an agreement within the cooling off period (or extended cooling off period) and the applicant wishes to continue with its application it must file a TM8 incorporating a counter-statement before the expiry of the ‘cooling off’ period.

If the notice and counter-statement are not filed within the appropriate period, the applicant is deemed to have abandoned its application.

THE ‘COOLING OFF’ PERIOD CANNOT BE EXTENDED ANY FURTHER.

Failure to resolve matters in the cooling off period does not fetter settlement negotiations which may continue in parallel to the proceedings. It is unlikely, however, particularly where the parties have had a period of eighteen months for cooling off, that a stay of proceedings will be granted unless there are extremely compelling arguments to show that successful conclusion of the proceedings is imminent and both parties agree to it.

Early termination of the Cooling Off period

Rule 18 of the Trade Marks Rules 2008

When the cooling off period has been entered but negotiations break down before it comes to an end the cooling off period should not be continued.

Negotiations terminated by the opponent

The opponent should file a TM9T, copied to the other party, to notify the Tribunal of their wish to terminate the cooling off period. The parties will be notified that the TM9T has been filed and confirmation of the date by which the TM8 must be filed by the applicant will be issued. The applicant will have a period of one month from the date of filing the TM9T, (or two months from the “notification date”, whichever is the later), within which to file a TM8, incorporating a counter-statement, if they wish to continue with the proceedings.

Negotiations terminated by the applicant

In the event that the applicant wishes to terminate the cooling off period early they should file a TM8, incorporating a counter-statement.

3.1.9 Preliminary Indication

Rule 19 of the Trade Marks Rules 2008

Where the grounds of opposition include sections 5(1) or (2) of the Act, the Registrar has the power to issue a Preliminary Indication (PI). The purpose of the PI is to provide the parties with an indication on a prima facie basis as to the likely decision in respect of those grounds of opposition (based on information currently before the Tribunal).

In accordance with rule 19(2), following the receipt of a counter-statement, the Tribunal will consider whether a PI is appropriate and the parties will be notified by letter. Preliminary indications are only issued where the Tribunal has reason to believe that they will bring the proceedings to an early conclusion. They are usually an indication that one side’s case appears hopeless.

If a PI has been issued there are several ways in which the case may proceed:

Non-acceptance by the parties

If either party does not accept the PI it has the right to formally give notice to that effect. The parties have a period of one month from the “indication date” to file a TM53 to give notice of their intention to proceed to the evidence rounds.

Acceptance by the parties

If the parties accept the PI and it indicates total success to the opponent, the application will be refused. If the indication was that the opposition would fail in its

entirety then the application will proceed to registration. In both cases the proceedings will be closed. The PI will be considered the final decision with no right to subsequent appeal under section 76 of the Act.

Additional grounds

If no TM53 is filed by the opponent and the TM7 specifies grounds other than sections 5(1) and 5(2), then the opposition will proceed on the additional grounds with the 5(1)/(2) grounds being deemed to have been withdrawn.

Partial success/failure

Where the PI indicated partial success and no TM53 is filed by either party, how much of the application will proceed to registration will depend upon how much of the specification(s) was originally opposed on the TM7 and how much of the contested specification was liable to be refused according to the PI. Where straightforward deletion of goods/services overcomes the objection⁹ those goods/services which can be deleted simply will be removed and the application will be allowed to proceed to registration.

In some cases the amendment of the specification will not be able to be resolved by straightforward deletion of goods/services to overcome the objection. In these circumstances the applicant will be allowed a further period, of one month, within which to file a TM21 to restrict their goods and/or services to those for which it appeared the mark could be registered. Failure to file the TM21 within the time period specified will result in the application being refused for the entirety of the goods and/or services opposed.

In accordance with rule 19(7) the Tribunal need not give reasons for a PI, nor is it subject to appeal.

3.1.10 Proof of use in opposition proceedings

The period of five years during which use must be shown of the earlier trade mark is the five years ending on the date of publication of the application under opposition. This obligation only applies to registered marks and therefore proof of use may not be requested for unregistered rights claimed under section 5(4) of the Act or well known marks protected under article 6bis of the Paris Convention.

Section 100 of the Act states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

This establishes an obligation for the registered proprietor of a trade mark to show that it is using its mark in a genuine manner. Thus on the TM7 there is a section for the opponent, basing their action on marks registered for five years or more at the

⁹ *SENSORNET* (BL O/136/06) at paragraph 57

date of publication of the opposed mark to state on which goods and/or services their trade mark is used or, in the alternative, any proper reasons for non-use of the mark.

The statement may say *“To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”*. The party will be permitted to narrow the defence if it subsequently becomes clear that the mark has not been used on a good or service.

If evidence of use is required then this is **not** required immediately but should be filed with the opponents’ evidence in chief (See section 4.8).

The Tribunal does not inquire of its own volition as to whether the earlier trade mark has been used or not, it is a matter for the applicant to request proof if it is required by him.

On the counter-statement the applicant must accept or require proof of the opponent’s statement of use. If the applicant does not accept the statement of use, this will be taken as a requirement for the opponent to file evidence of use or evidence validating that there are proper reasons for non-use.

3.1.11 Evidence in opposition proceedings

Rule 20 of the Trade Marks Rules 2008

The Tribunal will specify the periods for each of the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

Failure to file evidence in respect of those grounds which are entirely dependent on evidence to support and substantiate the claims will result in the opponent being deemed to have withdrawn the opposition.

For full details of the procedure for filing evidence in proceedings before the registrar see section 4.8.2.1

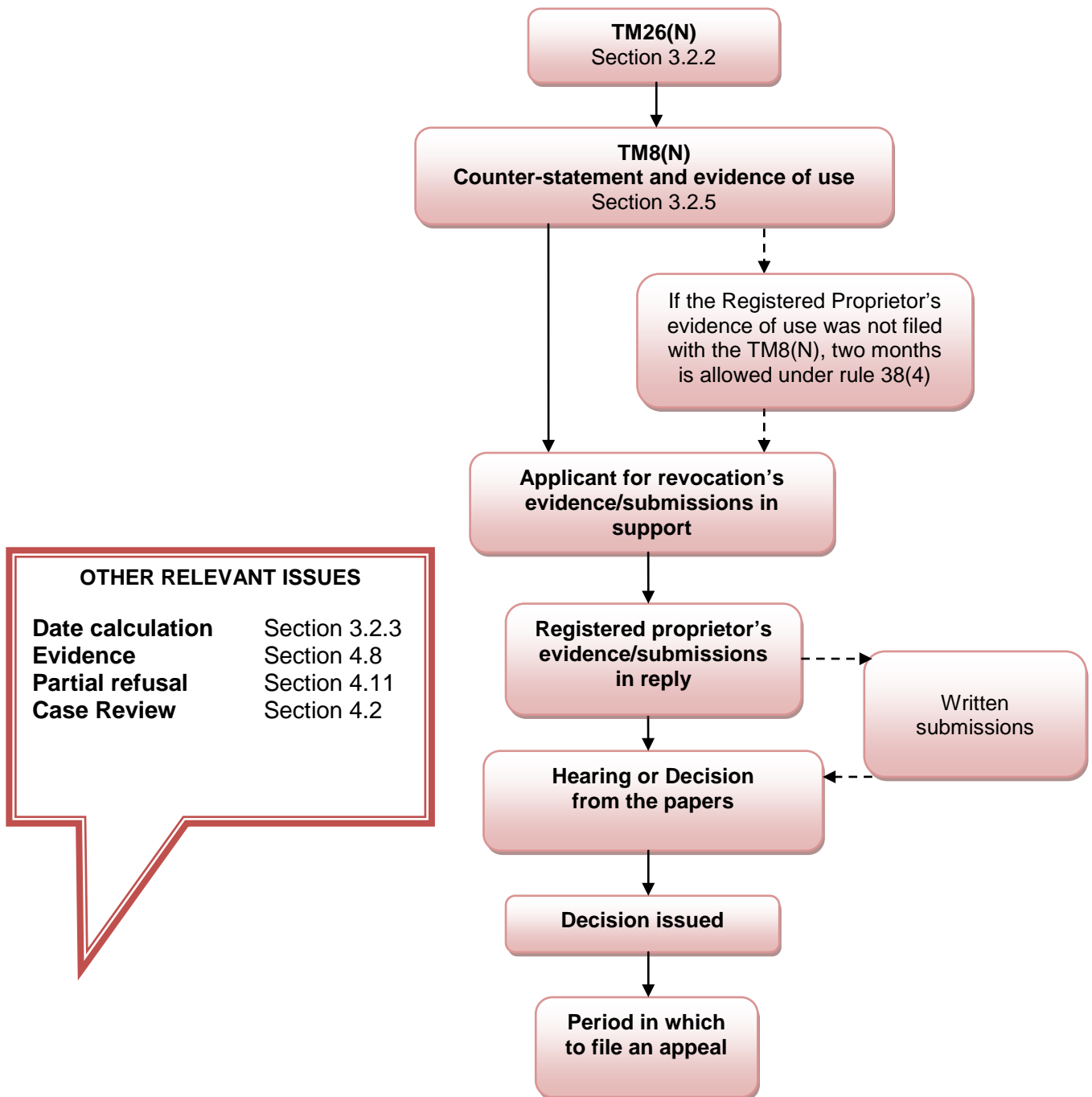
3.2 Revocation on grounds of non-use

Section 46 of the Trade Marks Act 1994

Rules 38, 43 and 45 of the Trade Marks Rules 2008

Revocation on grounds of non-use is the legal procedure which allows anyone to seek to remove a registered trade mark from the UK register because they think that the trade mark has not been used. It is possible to apply in respect of all or only some of the goods and/or services for which the trade mark is registered.

3.2.1 Revocation (on grounds of non-use) example process diagram (see 3.2.7)



OTHER RELEVANT ISSUES	
Date calculation	Section 3.2.3
Evidence	Section 4.8
Partial refusal	Section 4.11
Case Review	Section 4.2

3.2.2 Application for revocation (on grounds of non-use)

Rule 38 of the Trade Marks Rules 2008

An application for revocation on grounds of non-use may be made by anyone. It shall be made on a TM26(N). A fee is also required.

Boxes 5, 6, 7 and/or 8 establish the dates for which revocation is sought. Entering text such as “see attached statement of case” will be considered a failure to complete the application correctly and the form will be returned for correction.

3.2.3 Calculation of dates for revocation (on grounds of non-use)

The relevant sections of the Act are as follows:

46(1)(a) - The trade mark has not been used in the UK on the goods or services for which it is registered, either by the proprietor or by someone else with the proprietor's agreement in the five years since the trade mark was registered;

and there are no proper reasons why the trade mark has not been used.

46(1)(b) - The trade mark has not been used in the UK on the goods or services for which it is registered, either by the proprietor or by someone else with the proprietor's agreement for any uninterrupted period of five years after the completion of the registration procedure **and** there are no proper reasons why the trade mark has not been used.

By way of example, if the registration procedure was completed on 18 March 2000, the five year period would expire on 18 March 2005. An application for revocation for non-use could only be made after the latter date. The earliest date that an application for revocation could be made would therefore be 19 March 2005.¹⁰

Consequently, where an application for revocation on the grounds of non-use is made under section 46(1)(a), the applicant should ensure that it is made, at the earliest, on the day following the fifth anniversary of completion of the registration procedure. If the revocation action is successful, rights in the registration (partial or full) will cease to exist, under section 46(6)(a), on the day following the fifth anniversary of the completion of the registration procedure.

Completion of registration procedure	Five year period in which to commence use starts	Five year period in which to commence use ends	Earliest date the revocation application can be made	Successful revocation date
18.3.2000	19.3.2000	18.3.2005	19.3.2005	19.3.2005

In the case of a revocation action founded upon section 46(1)(b) of the Act, where the applicant claims that the mark has not been used in the five years prior to the application, section 46(6)(a) of the Act will also apply to a successful revocation. In this instance, if the application is made on 18 March 2005 and this is the revocation date that is sought, the five year period during which there was no use will run from 18 March 2000 to 17 March 2005.

¹⁰ See Philosophy di Alberta Ferretti Trade Mark [2003] R.P.C. 15 and WISI Trade Mark [2006] RPC 17, paragraph 22

Completion of registration procedure	Application for revocation filed	Revocation date sought	Five year period in which no use of the mark	Successful revocation date
2.4.1998	18.3.2005	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

Revocation actions may also be brought on the grounds of section 46(1)(b), but for a five year period which does not coincide with the date of the application (that is, that section 46(6)(b) will apply). For example, if the applicant claims a revocation date of 18 March 2005, this means that the five year period for which there has been no genuine use of the mark will run from 18 March 2000 until 17 March 2005, with the rights of the proprietor ceasing to exist on 18 March 2005: the revocation date.

Application for revocation filed	Revocation date sought	Five year period in which no use of the mark	Successful revocation date
1.12.2006	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

If the application is made in respect of more than one date, care should be taken to ensure that all of the relevant dates are clearly indicated on the TM26N.

3.2.4 Serving the application

Rule 38 of the Trade Marks Rules 2008

The Tribunal will send the TM26(N) to the registered proprietor in accordance with rule 38(2). It will be sent by recorded delivery to the last registered address for service.

The onus rests with the registered proprietor to ensure that the relevant details attached to their registration are correct, in particular the name and address details along with the details of their legal representation. If an old and incorrect address is recorded on the register this cannot be regarded as a defence in the event of the failure to file a TM8(N) and counter-statement. In the event that the package sent by recorded delivery is undeliverable for any reason and is returned to the Tribunal during the two month period for filing a defence it will be resent via normal mail. The date for filing the defence will not be reset.

3.2.5 The counter-statement (TM8(N)) and evidence of use

Rule 38 of the Trade Marks Rules 2008

The registered proprietor has a period of two months commencing on the date the TM26(N) is sent to them within which to file their defence.

A defence is filed on a TM8(N), which shall include a counter-statement, and may be accompanied by evidence of use or evidence supporting reasons for non-use.

THE PERIOD FOR FILING A NOTICE OF DEFENCE ON A TM8 (N) CANNOT BE EXTENDED.

If the TM8(N) is not received within the two month period the Tribunal may treat the proprietor as not opposing the application and issue a short, default decision revoking the registration.

Whilst the TM8(N) period cannot be extended, if the registered proprietor fails to file evidence of use or evidence supporting proper reasons for non-use, with the TM8(N), a further period of not less than two months will be allowed for the filing of such evidence.

If, within the additional period allowed, the registered proprietor fails to file evidence of use, or evidence supporting proper reasons for non-use, the Tribunal may treat the opposition to the application for revocation as withdrawn and issue a short, default decision revoking the registration.

Proper reasons for non-use are reasons outside the control of the proprietor.

3.2.6 Failure to file a defence (TM8(N))

Rules 38(6) and 38(7) of the Trade Marks Rules 2008

If the registered proprietor fails to file a defence but opposes the application before the Tribunal has revoked the registration, there is a discretion vested in the Tribunal which allows for consideration of reasons for a defence not having been filed. In very limited circumstances the defence may be admitted into the proceedings late.

In the event that no defence is filed in cases of revocation on the grounds of non-use, the Tribunal will write to the parties giving them a period of 14 days within which to either request a hearing or to provide a submission stating why discretion should be exercised in proceedings.

The exercise of the discretion is a judicial function. It is anticipated that it will normally only be exercised by a Hearing Officer. In determining whether the proprietor will be treated as opposing the application, considerations of the sort outlined in *Music Choice*¹¹ will be taken into account. These include:

- The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed
- The nature of the applicant's allegations in its statement of grounds

¹¹ *Music Choice Limited v Target Brands, BL O/280/07*

- The consequences of treating the proprietor as opposing or not opposing the application
- Any prejudice caused by the delay
- Any other relevant considerations, such as the existence of related proceedings between the same parties

Also see section 4.11 for partial refusals.

3.2.7 Evidence in revocation non-use proceedings

Rule 40 of the Trade Marks Rules 2008

In the case of an application for revocation on grounds of non-use the registered proprietor is required to file evidence of use with their defence (TM8(N)), otherwise a further period, usually of two months will be allowed in order for it to be submitted to the Tribunal. Evidence filed at this stage in proceedings by the registered proprietor is effectively the first evidential round.

The Tribunal shall specify the further periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

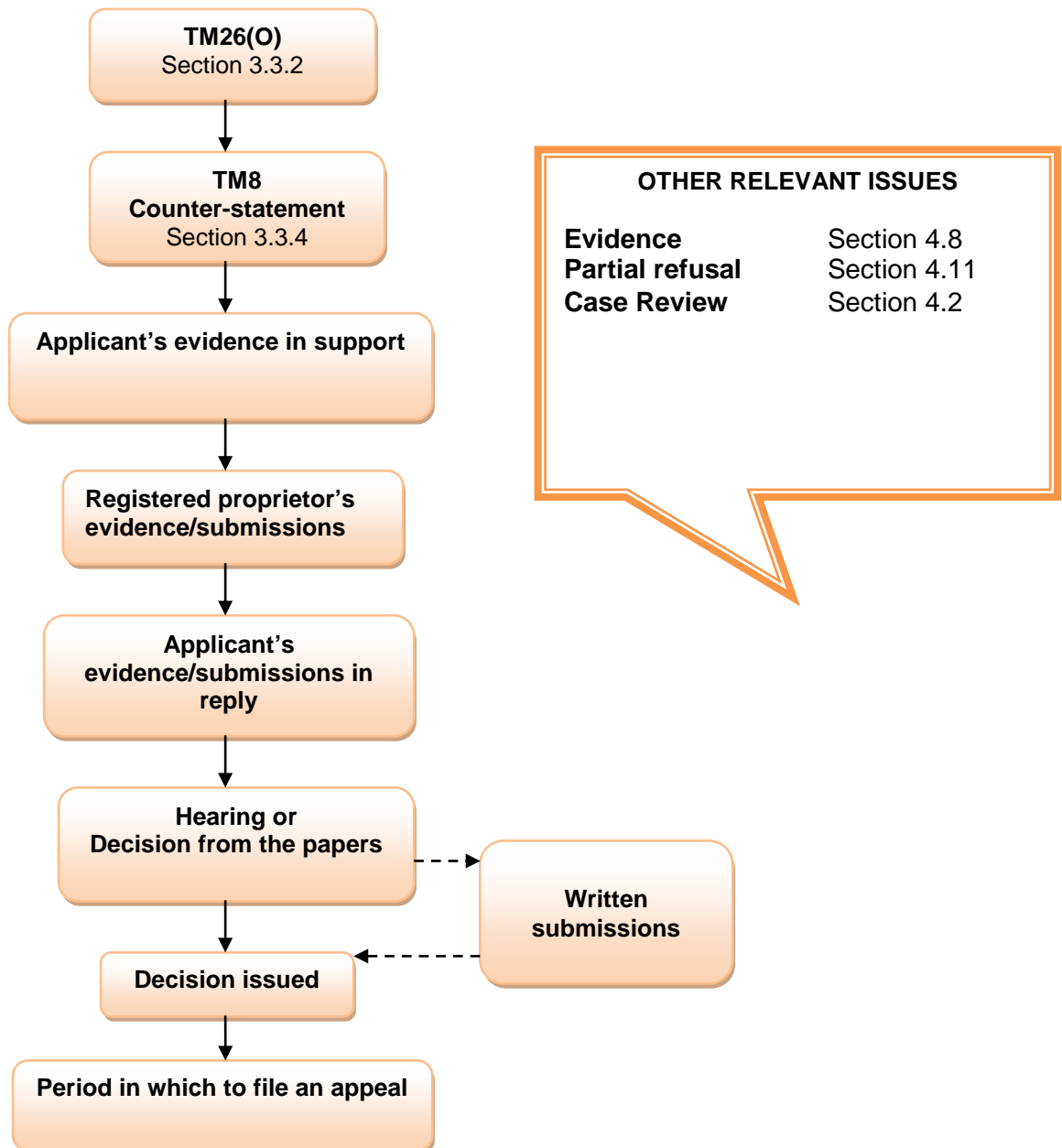
For full details of procedure for filing evidence in proceedings before the Tribunal see section 4.8.2.2

3.3 Revocation on grounds other than non-use

Section 46 of the Trade Marks Act 1994

Rule 39, 40, 43 and 45 of the Trade Marks Rules 2008

3.3.1 Revocation (on grounds other than non-use) example process diagram (see 3.3.6)



Revocation for reasons other than non-use allows anyone to try and remove a registered trade mark from the UK register because they consider that:

- the trade mark has become the common name in the trade for goods or services for which it is registered, due to the action or inaction of the registered proprietor, (we describe this as the trade mark becoming 'generic')

or

- because of the use of the trade mark, either by the proprietor or by someone else with the proprietor's consent, the mark is likely to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services on which it has been used

It is possible to apply to revoke the registration in respect of all or only some of the goods and/or services for which the trade mark is registered.

Registered marks which become 'generic' or 'misleading' due to the action, or inaction, of the proprietor are vulnerable to revocation. Proprietors need to police their marks to avoid them becoming used generically as a descriptive term by other people, but also they need to be careful how they use the mark themselves. By way of example words, such as 'Hoover' and 'Rollerblade' have been used by the proprietor purely in a trade mark sense and have been protected vigorously under the law to ensure that they are not used as generic titles for goods.

3.3.2 Application for revocation on grounds other than non-use

Rule 39 of the Trade Marks Rules 2008

An application for revocation to the Tribunal shall be made on a TM26(O) accompanied by a statement of grounds on which the application is made. A fee is also required.

3.3.3 Serving the application

Rule 39 of the Trade Marks Rules 2008

Once the Tribunal has accepted the application and statement, it will send the documents to the registered proprietor who will be given two months from the date of sending (the notification date) in which to file a TM8, incorporating a counter-statement.

3.3.4 TM8

A TM8 should incorporate a counter-statement. The purpose of the counter-statement is to admit, deny with explanation or require proof of any of the grounds set out by the applicant in its statement. If no TM8 is filed within this two month period, the period for filing cannot be extended, and if the documents are not received within the period the Tribunal may treat the opposition to the application as withdrawn.

3.3.5 Failure to file a defence (TM8)

Rule 39(3) of the Trade Marks Rules 2008

The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

In the event that no defence is filed in cases of revocation on grounds other than non-use, the Tribunal will write to the parties giving them a period of 14 days within which either to request a hearing or to provide a submission stating why discretion should be exercised in their favour and providing reasons in support.

3.3.6 Evidence in revocation on grounds other than non-use proceedings

Rule 40 of the Trade Marks Rules 2008

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

For full details of procedure for filing evidence in proceedings before the registrar see section 4.8.2.3

3.4 Invalidation

Sections 47 and 48 of the Trade Marks Act 1994
Rules 41, 42, 43 and 45 of the Trade Marks Rules 2008

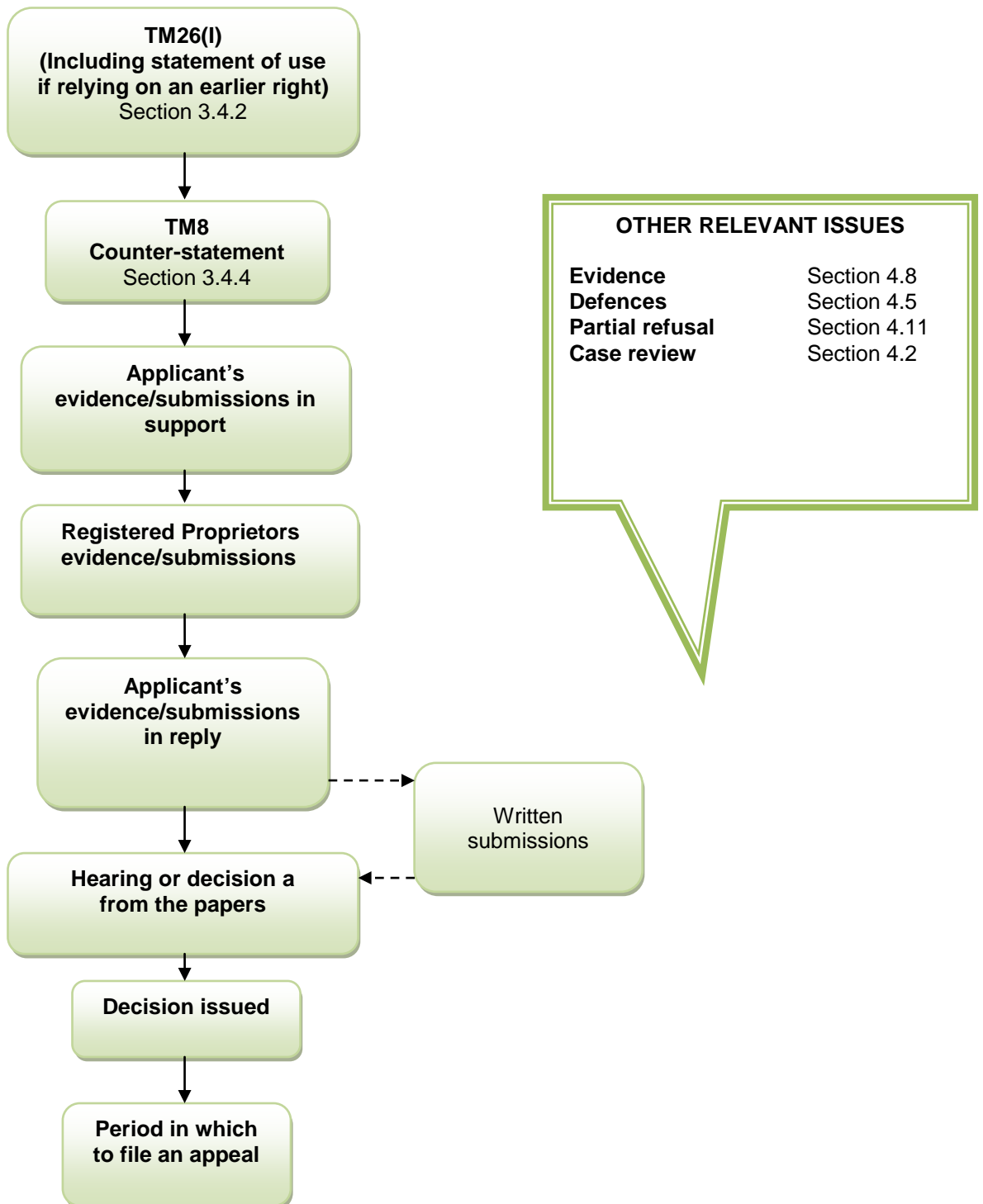
Invalidation is a procedure which enables a party to seek to remove a registered trade mark from the UK register and deem that registration never to have been made. An application may seek to remove the entire registration, or only some of the goods/services it covers.

Applications for invalidity are based on section 3 and/or section 5 of the Act which set out absolute and relative grounds for refusal of registration. These sections should not be confused.

Section 3 of the Act: relates to *absolute grounds* that is, generally, something inherent in the mark itself which renders it unsuitable to be registered as a trade mark.

Section 5 of the Act: relates to *relative grounds*, that is, where registration of the trade mark would impinge upon another person's existing marks or rights.

3.4.1 Invalidation example process diagram



3.4.2 Application for declaration of invalidity

Rule 41 of the Trade Marks Rules 2008

An application can be made at any time following the registration of the contested mark. In contrast to revocation, if a mark is declared invalid (for all or some of the goods or services specified) the registration is deemed never to have been made.

An application based upon section 5 (relative grounds) can only be launched by the owner of the mark or right on which the application is based or a licensee¹² (Other parties who may have an interest in the proceedings would have to intervene after the proceedings were joined, see section 4.10 below.)

An application to the Tribunal for a declaration of invalidity shall be made on a TM26(I) accompanied by a statement of grounds on which the application is made. A fee is also required.

Where the application is based on an earlier registered trade mark, the following must also be included:

- The jurisdiction in which the mark is registered
- The registration number of the mark
- The goods and services for which that mark is registered
- The goods and services on which the application is based

and, where necessary,

- A statement of use; (if the application is based on an earlier registered mark which has been registered for more than five years, at the date of the application for invalidity, the applicant will be required to state on what goods and services it has been used during the relevant period or give proper reasons for non-use during the relevant period)

or

- Where the mark is not registered and the applicant is utilising section 5(4)(a) of the Act, a representation of the mark must be provided with a list of the goods and services in respect of which protection is claimed together with details of when and where the earlier right was used including a date of first use

3.4.3 Serving the application

Rule 41 of the Trade Marks Rules 2008

Once the Tribunal has accepted the application and statement, it will send the TM26(I) with the statement of grounds and other documents to the registered proprietor at their last recorded address for service. The date on which these are sent is known as the “notification date”.

¹² The Trade Marks (Relative Grounds) Order 2007

3.4.4 TM8

The registered proprietor has a non-extendible two months from the “notification date” in which to file a TM8, which should incorporate a counter-statement. The purpose of the counterstatement is to admit, deny with explanation or require proof of any of the grounds set out by the applicant in its statement. If no TM8 is filed within this two month period, the Tribunal may treat the proprietor as not opposing the application and registration of the mark shall unless the Tribunal otherwise directs, be declared invalid.

The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

3.4.5 Acquiescence

Section 48 of the Trade Marks Act 1994

If the basis for the claim is relative grounds the registered proprietor may have a defence if the owner of the earlier marks or right has acquiesced in the use of the registered mark for a continuous period of 5 years. Section 48 of the Act makes it clear that the owner of the earlier mark or right must have been aware of and tolerated the use of the trade mark under attack for a continuous period of 5 years starting after it was registered. Further, the defence can only be relied upon if the trade mark under attack was not applied for in bad faith.

3.4.6 Proof of use in invalidation proceedings

Section 100 of the Act states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

This establishes an obligation for the registered proprietor of a trade mark to show that it is using its mark in a genuine manner or has proper reasons for its non-use. The obligation to demonstrate use of the trade mark is not applicable immediately after registration of the trade mark; instead the registered proprietor has five years following the completion of the registration procedure to put the trade mark into use on the goods and/or services for which the trade mark was registered. Before this period of five years expires the registration is protected for all the goods and/or services for which it is registered. Once the mark has been registered for five years proof of use may be required.

On the TM26(I), where applicable, for certain earlier marks claimed as the basis for the action, a statement of use is required. The statement may say *“To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”*.

If evidence of use is required then this is **not** filed immediately but is filed with the applicants’ first evidence round. See section 4.8.2.4

The Tribunal does not inquire of its own volition as to whether the earlier trade mark has been used or not. It is a matter for the registered proprietor to request if proof of use is required by him. On the counter-statement the registered proprietor must deny, require proof of or admit the applicants' statement of use.

If the proceedings progress into the evidence rounds then the Tribunal will then set a period for the applicant to file such evidence, which will run in parallel with the first evidence round.

3.4.7 Failure to file a defence (TM8)

Rule 41(6) of the Trade Marks Rules 2008

Under this rule there is a discretion vested in the Tribunal in the event that the registered proprietor fails to file a defence. The consequences of failure to file a defence in such proceedings is analogous to those dealt with under rule 38(6), see section 3.2.6 above for full explanation.

In the event that no defence is filed in cases of invalidation, the Tribunal will write to the parties giving them a period of 14 days within which to either request a hearing or to provide submissions stating why discretion should be exercised in these proceedings. See section 4.11 for partial refusals.

3.4.8 Evidence in invalidation proceedings

Rule 42 of the Trade Marks Rules 2008

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified and, in certain circumstances, it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

Failure to file evidence in respect of those grounds which are entirely dependent on evidence to support and substantiate the claims will result in the opponent being deemed to have withdrawn the invalidation.

For full details of procedure for filing evidence in proceedings before the Tribunal see paragraph 4.8.2.4

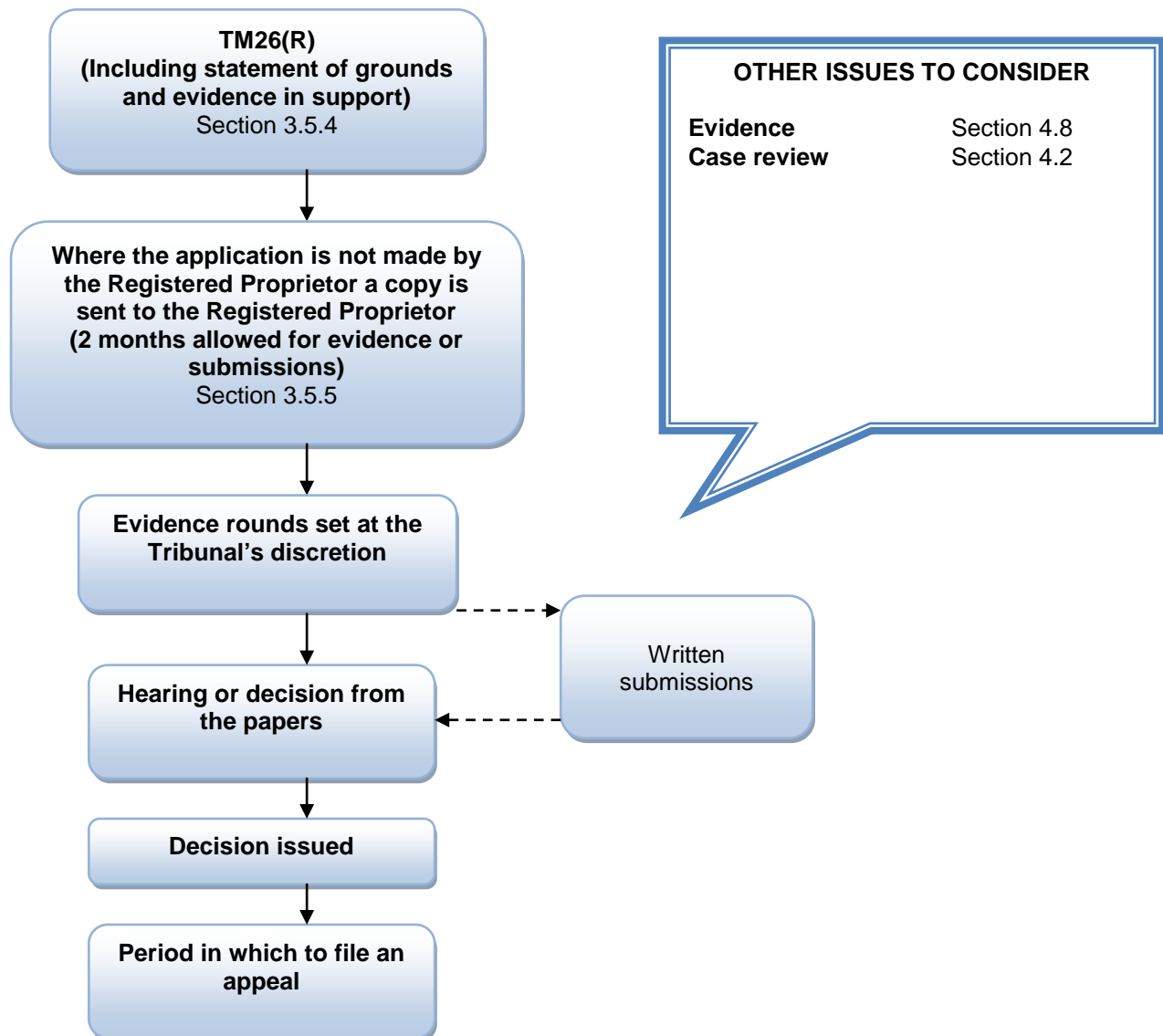
3.5 Rectification

*Sections 60 and 64 of the Trade Marks Act 1994
Rules 44 and 45 of the Trade Marks Rules 2008*

Rectification is the procedure which allows someone to apply to correct (rectify) an error or an omission that has been made in the details of a trade mark as recorded in the UK register of trade marks. Anyone can request rectification of a trade mark at

any time following its registration by submitting a TM26(R) for which no fee is required. However, section 64 requires that the person applying to rectify has 'sufficient interest' and this may have to be established where the applicant has no obvious interest: beneficial, registered or otherwise.¹³

3.5.1 Rectification example process diagram



3.5.2 Section 64 of the Act

Under this section any person having a sufficient interest may apply for the rectification of an error or omission in the register provided that the application for rectification is not be made in respect of a matter affecting the validity of the registration of a trade mark.

¹³ *Commercial Power Solutions Ltd v Turbo Chip UK Ltd & Specialist Autosports Ltd* BL O/112/09

The term 'validity', as it appears in the proviso, is to be interpreted quite broadly. The section cannot be used for example to:

- Alter the identity of the mark itself
 - Increase the breadth of the specification
- or
- Any other matter which might otherwise be more properly dealt with under another section of the Act, or which might involve circumvention of statutory requirements

Clerical errors and mistakes in the register are generally considered to be covered by the section, as are more substantive questions like the correct ownership of a mark, but, only if another, purpose-made, section of the Act does not cover the relief being sought.

Examples of rectifications which the Tribunal would accept are:

- Terms used in the specification which are self-evidently erroneous and no other party could possibly be disadvantaged by their correction¹⁴
- Applicant's or proprietor's name and/or address, which appears on the register incorrectly and, on the basis of evidence provided, is incorrect¹⁵
- Cases of genuine mistaken identity where the person filing the original forms was unaware of the correct ownership position in law. The Tribunal has held that section 64 was available to those who were unaware of the true position in law as to ownership but who, much later, realised their error¹⁶

3.5.3 Section 60(3)(b)

Specific provision is made in section 60(3)(b) for an application for rectification to be made where an agent or representative has 'taken' a mark belonging to a person who is the proprietor of the mark in a convention country, that is, by virtue of section 55, a country other than the UK. Section 60 enacts Article 6^{septies} of the Paris Convention.

3.5.4 Application for rectification

Rule 44 of the Trade Marks Rules 2008

¹⁴ *Andreas Stihl* [2001] RPC 12, the rectification allowed 'hard' operated hedge clippers in the specification to be changed to 'hand' operated hedge clippers.

¹⁵ The section should not be used to record changes of name or corporate identity for which there is specific provision under section 64(4) of the Act and rule 52.

¹⁶ However, this was in circumstances where the rightful owner, capable of holding the property, existed at the time the application was made and the facts were not disputed.

An application to rectify the register shall be made on a TM26R. A statement of grounds on which the application is made and any evidence to support those grounds is also required. If an application lacks a statement and/or evidence the Tribunal may write to the applicant asking for the requisite documents within a specified period. Similarly, if the grounds are unclear or do not appear to support the request, the registry will ask for clarification prior to a decision being taken.

The following information should be included:

- What trade mark you want to rectify
- Who owns it
- Who you are
- Who is your representative (if you have one)

and

- What is the error or omission you want to correct

Details must be given in the statement of reasons of why the rectification is wanted and how the error or omission occurred.

3.5.5 Serving the notice and filing the counter-statement where the applicant is not the proprietor

Rule 44 of the Trade Marks Rules 2008

Where an application is made by someone other than the proprietor, rule 44(2) applies. The Tribunal will send a copy of the application, statement and evidence to the registered proprietor and may give such direction with regard to the filing of subsequent evidence upon such terms as it sees fit. A direction under this rule will most likely entail setting a period for filing a counter-statement and giving both sides opportunity to file evidence to support their respective contentions.

3.5.6 Evidence in rectification proceedings

Rule 44 of the Trade Marks Rules 2008

The Tribunal shall specify the periods for the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified. In certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.

For full details of procedure for the filing evidence in proceedings before the Tribunal see section 4.8.2.5

4. ISSUES COMMON TO PROCEEDINGS BEFORE THE TRIBUNAL

4.1 Amendment of pleadings

As parties will, as first instance, be expected to file focused statements of case and counter-statements, the Tribunal will consider requests to amend these documents later in the proceedings.

Amendments may include:

- Adding or removing a ground of opposition/revocation/invalidity
- Adding or removing an earlier mark or right
or
- Correcting, clarifying or supplementing information contained therein.

If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend, full details of the amendment together with the reasons for the amendment should be submitted.

Whilst each request to amend will be considered on its merits, the Tribunal will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties more quickly and at less cost. Whether to allow the amendment is matter of discretion. In making its decision the Tribunal will consider, in particular, any inconvenience or prejudice suffered by the other side, and whether the party seeking amendment could reasonably have been expected to have fully particularised their case at an earlier stage. In other words, a party seeking amendment will have to dispel any suspicion of abuse of process.

If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.

4.2 Case review

When the evidential rounds have been completed a letter will be issued to the parties listing the evidence filed and stating that the case is ready for a decision. From the date of this letter the parties will have 14 days within which to request a hearing. If no hearing is requested, they have a period of 28 days from the date of the letter to file written submissions in lieu of a hearing.

If a hearing is not requested a decision will be taken 'from the papers', i.e. from the documents, evidence and submissions on file, a decision from the papers filed may well be quicker and less costly for the parties.

4.3 Confidentiality

*Section 67 of the Trade Marks Act 1994
Rule 59 of the Trade Marks Rules 2008*

Section 67 of the Act states:

67. - (1) After publication of an application for registration of a trade mark, the registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.

Under these provisions, documents filed are available for public inspection. It should be noted that there is an obligation on the Tribunal to permit documents to be made available for public inspection, subject to the exclusions and conditions set out in rule 59.

Any request for confidentiality will therefore, prima facie, be taken to be a request for a direction to withhold the document from inspection by the public. If it is intended to seek to withhold the document from the other party or parties to the proceedings (or made available only to their legal representatives), then the request that evidence be treated as confidential under the provisions of rule 59 of the Rules must make it clear that this is the case.

Confidential from the public at large

In relation to the general public's access to the file, a request for confidentiality must be made at the time of filing of the document. Reasons for the request must be given, along with a clear statement of the extent of the confidentiality request.

This will be examined by the Tribunal and, if it is granted, a direction given. If a direction is given, no details pertaining to the relevant evidence can be given in any decision, but may instead form the subject of a redacted public version of the decision or a confidential annex to the decision.

Confidential from another party to the proceedings

A party may ask to make the document available to the other party's legal representative or agent on the condition that the evidence is not disclosed to the party themselves or the public. However, this should be avoided unless the circumstances are considered exceptional, as the other side can reasonably expect to see the extent of the case against them.

If possible the evidence can be re-filed in more general terms, e.g. turnover in excess of X or, between Y and Z, and sales according to geographical areas or customer type rather than specific details.

It may be possible to come to a less restrictive agreement whereby nominated people on the other side are allowed to see the evidence under strict terms.

In all cases the parties are encouraged to explore all possibilities but if an agreement cannot be reached the Tribunal will determine the matter (following a procedural hearing if necessary).

Orders for confidentiality will not be issued as a matter of course. Requests must be supported by full and detailed reasons in each case. In considering requests the Tribunal will bear in mind the comments of Upjohn LJ in *Re K (Infants)* [1963] Ch 381; where he stated:

"It seems to be fundamental to any judicial enquiry that a person or other properly interested party must have the right to see all the information put before the Judge, to comment on it, to challenge it and if needs be to combat it, and to try to establish by contrary evidence that it is wrong. It cannot be withheld from him in whole or in part. If it is so withheld and yet the Judge takes such information into account in reaching his conclusion without disclosure to those parties who are properly and naturally vitally concerned, the proceedings cannot be described as judicial."

Also the comments of Whitford J in *Diamond Shamrock Technologies SA's Patent* [1987] RPC 91; where he states:

"It is commonplace with a variety of proceedings, and patent proceedings are no exception, that the parties to the proceedings want material to be kept confidential. There are matters which they do not want to be disclosed to the public at large. What is said in these letters is that this, that or the other information contained in the declarations or exhibits should be kept confidential because "it contains sensitive commercial information".

I think it is desirable that a more exact indication should be given as to the reasons why in truth the document ought not to be disclosed because it is easy enough to talk about the material being of commercial interest and to talk of it being sensitive. That fact in itself does not necessarily mean that the material, which would otherwise become public property because it was included in the documents which are going to be open to public inspection, is to be excluded from public inspection."

Where confidentiality is not granted the filer will be allowed the opportunity to withdraw the disputed document/s.

4.4 Consolidation of proceedings

Consolidation is an administrative procedure which aims to reduce costs and the work involved in dealing with two or more sets of related proceedings. It means the proceedings are combined, with each side in the dispute filing one set of evidence headed for, and covering, all of the consolidated proceedings.

Consolidation can be requested by any party; but in most cases will be raised by the Tribunal.

Opposition and Invalidation proceedings

In opposition and invalidity proceedings consolidation will not be allowed until after the defence (TM8) is filed.

Revocation on grounds of non-use

In revocation proceedings based upon non-use under section 46(1)(a) or 46(1)(b), consolidation may be allowed prior to the filing of the defence (TM8(N)) and evidence of use, if the Tribunal is satisfied that the issues raised are identical (or substantially identical) in all proceedings.

The reason for the different treatment of non-use revocation proceedings is that evidence of use is required from the proprietor at an earlier stage than in other proceedings. Even where consolidation is allowed, separate TM8(N)s and counter-statements will be required for each set of proceedings, although only one set of evidence of use will be required.

Instances of where consolidation may occur are:

- Cross-opposition, where the applicant in one case is the opponent in another and the marks are related
- Cross-opposition/revocation/invalidation, where the proprietor of one mark opposes a mark he believes to be too close to his own mark and the applicant has applied to revoke or invalidate that mark

In ordering consolidation, the Tribunal will take into account the following:

- Whether the parties are the same or economically connected
- Whether the 'legal basis' on which the cases are founded are connected
- Whether the marks are the same for each case or whether they share the same objection
- The stages of the respective proceedings and whether it will save cost to consolidate the proceedings or lead to unacceptable delay
- Whether a single decision covering all proceedings can be issued or whether it would cause complications in the event of an appeal

Even if consolidation is not considered appropriate by the Tribunal, they may proceed in tandem through the evidence stages and be heard on the same day, one following the other, and by the same Hearing Officer.

4.5 Defences in opposition and invalidation proceedings

Claims that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

A counter-statements in opposition and invalidation actions may seek to introduce, as a defence, a claim that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application), for the same, or, a highly similar trade mark, to that which is the subject of the proceedings and which predates the earlier mark upon which the attacker relies.

Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) T-269/02:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

Parties are reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.

4.6 Defences – Absence of confusion in the marketplace

Claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

In *Rousselon Frères et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

*"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says..."*

In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

4.7 Disclosure

Rule 65 of the Trade Marks Rules 2008

Rule 65 gives the Tribunal the power of an official referee of the Supreme Court in respect of the discovery¹⁷ and production of documents.

In the first instance one party should make the request for the disclosure of documents to the other party to the proceedings. If the other party refuses to disclose documents, then the matter can be referred to the Tribunal. If a party is to disclose documents it will normally supply a list of the documents which relate to the matter in question to the other party, it will then advise which documents it wishes to have supplied to it.

Disclosure is a matter between the parties, even though the Tribunal may have ordered it. If a party wishes to use evidence that has been disclosed, it will need to be introduced into the proceedings as evidence. The disclosing party may make a request to the Tribunal for the reasonable cost of copying documents at the end of proceedings (even if the documents have not been adduced into the proceedings).

Disclosure should only be ordered by the Tribunal insofar as the documents relate to matters in question in the proceedings.¹⁸ There will be no order for disclosure in relation to matters that will not affect the outcome of the case.¹⁹

4.8 Evidence

Section 69 of the Trade Marks Act 1994

Rules 20, 62, 64 and 65 of the Trade Marks Rules 2008

The general rule is that it is for the parties to decide what evidence they wish to file. The Tribunal will not normally provide advice on the content of evidence as this is essentially a matter for the parties, these being quasi-judicial proceedings.

"Judicial evidence is used to prove either facts in issue, or facts from which facts in issue may properly be inferred. It comprises the testimony of witnesses, documents and things."

"The main facts in issue are all those facts which the plaintiff in a civil action, or the prosecutor in criminal proceedings, must prove in order to succeed, together with any further facts that the defendant or accused must prove in order to establish a defence."²⁰

¹⁷ 'Discovery' was the term used for 'disclosure' prior to the introduction of the Civil Procedure Rules 1999.

¹⁸ *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent* [1991] RPC 221

¹⁹ *Gracey v Unilever Plc* BL O/475/99

²⁰ Cross & Tapper on Evidence, at Section 3

The Tribunal has the power under rules 62(1)(a), 62(2) and 62(3) of the Rules to require parties to submit evidence or information covering particular issues. The Hearing Officer may also require the production of particular documents if this appears necessary to enable him or her to reach a fair and properly informed decision on a matter that the parties have raised.

4.8.1 Submissions are not evidence

To be relevant, evidence must provide the facts which clearly relate to the issues raised in the case. Submissions per se are not debarred but if a party wishes only to comment on the other side's evidence or make submissions about the truth of it, written submissions are the more appropriate vehicle.

4.8.2 Time periods for filing evidence

The Rules require the Tribunal to specify the time periods for filing evidence or written submissions in inter partes proceedings. It is desirable and possible to determine trade mark inter partes cases within 12 months of the filing of a defence.

The period specified by the Tribunal for the parties to file evidence and submissions should normally be two months. More time will be provided where the grounds of opposition appear to merit it. In respect of evidence in reply, the relevant party will normally be given one month in which to notify the Tribunal of their intention to file further evidence of fact and, where this is the case, the party will be set a one month period in which to file such evidence.

The Tribunal routinely consolidates related proceedings. Where the proceedings have been consolidated, the Tribunal will usually set a common timeframe for the filing of evidence and written submissions. The time periods permitted will be determined on a case by case basis and will therefore not necessarily follow the time periods described below. However, as a general rule the periods for filing evidence/submissions in contested trade mark proceedings are as follows:

4.8.2.1 Opposition proceedings

Rule 20 of the Trade Marks Rules 2008

Evidence and submission rounds:

The opponent - Following the serving of the counterstatement, the opponent will normally be allowed **two months** to file any evidence or written submissions in support of its case. In cases where the opponent has been required to provide proof of use of one or more of the earlier trade mark(s), the evidence should be filed in this period.

The applicant - The period permitted for the applicant to file evidence or written submissions on the opponent's evidence will normally be **two months**.

The opponent - If the applicant files evidence, the opponent will be given **one month** from receipt of the applicant's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for filing the evidence will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or
- The applicant has filed evidence of fact and the period has passed for the opponent to file evidence in reply

4.8.2.2 Revocation (on the grounds of non use)

Rule 38 of the Trade Marks Rules 2008

Evidence and submission rounds:

The registered proprietor - Having been served with the applicant's TM26(N), the registered proprietor will be allowed **two months** to file a TM8(N) together with the evidence of use (or proper reasons for non-use) it intends to rely upon in order to defend the registration. If a counterstatement is filed without evidence (as the rules permit), the Tribunal will specify a further period, normally of **two months**, within which any evidence in support of the trade mark registration may be filed.

The applicant for revocation - Following the serving of the counterstatement, the applicant will normally be permitted **two months** to file any evidence or written submissions in response to the registered proprietor's counterstatement and evidence of use of the trade mark (or proper reasons for non-use).

The registered proprietor - If the applicant files evidence of fact, the registered proprietor will be given **one month** from receipt of the applicant's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for filing evidence in reply will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or
- The applicant has filed evidence of fact and the period has passed for the registered proprietor to file evidence in reply

4.8.2.3 Revocation (on grounds other than non-use)

Rules 39 and 40 of the Trade Marks Rules

Evidence and submission rounds:

The applicant for revocation - The period permitted for the applicant to file evidence in response to the TM8 will usually be **two months**.

The registered proprietor - The time allowed for the registered proprietor to file evidence or written submissions on the applicant's evidence will usually be **two months**.

The applicant for revocation - If the registered proprietor files evidence of fact, the applicant will be given **one month** from receipt of the registered proprietor's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply. The period for filing evidence in reply will then be set; normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the registered proprietor to file evidence of fact/submissions has passed and the registered proprietor has filed no evidence of fact; or
- The registered proprietor has filed evidence of fact and the period has passed for the applicant to file evidence in reply

4.8.2.4 Invalidation

Rule 42 of the Trade Marks Rules 2008

Evidence and submission rounds:

The applicant for invalidation - Following the serving of the counterstatement, the applicant will normally be allowed **two months** to file any evidence or written submissions in support of its case. In cases where the applicant has been required to provide proof of use of one or more of the earlier trade mark(s), the evidence should be filed in this period.

The registered proprietor - The registered proprietor will usually be given two months to file evidence or written submissions on the applicant's evidence.

The applicant for invalidation - If the registered proprietor files evidence, the applicant will be given **one month** from receipt of the registered proprietor's evidence, in which to notify the Tribunal of their intention to file evidence of fact in reply, then the period for filing evidence in reply will be set, normally to **one month** (i.e. one further month will be allowed).

The evidence rounds will be regarded as complete when:

- The period for the registered proprietor to file evidence of fact/submissions has passed and the registered proprietor has filed no evidence of fact, or

- The registered proprietor has filed evidence of fact and the period has passed for the applicant to file evidence in reply

4.8.2.5 Rule 44 Rectification

Rule 44 of the Trade Marks Rules 2008

Evidence and submission rounds:

The registered proprietor - Where an application to rectify the register is made by a party other than the proprietor of the registered trade mark, the Tribunal will send a copy of the TM26(R) to the registered proprietor who will be allowed **two months** to file evidence or written submissions.

The applicant for rectification - If the registered proprietor submits evidence or written submissions in response to the TM26(R), the applicant will, at the Registrar's discretion, be permitted a further period of time within which to respond to the registered proprietor's evidence or written submissions.

The above practice will not prevent the Tribunal from using his powers to set different arrangements for the filing of evidence/submissions in any other case where the situation justifies it. Nor will it prevent the parties from making a request at any time for leave to file further evidence.

For details on how to request an extension of time in which to file evidence see section 4.9.

4.8.3 Types of evidence

Rules 62 and 64 of the Trade Marks Rules 2008

Rule 64 prescribes the form in which written evidence must be filed as follows:

64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

(a) by witness statement, affidavit, statutory declaration; or

(b) in any other form which would be admissible as evidence in proceedings before the court.

4.8.3.1 Witness Statement

Evidence will normally be in the form of a witness statement unless the Tribunal directs otherwise. Instructions as to the correct form of a witness statement can be found in Part 32 Practice Direction 32 paragraph 17.1 *et seq* of the Civil Procedure Rules, which can be found on the website of the Ministry of Justice here:

http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part32.htm

A witness statement may only be given in evidence if it includes a statement of truth.

The Tribunal may require evidence to be filed by way of affidavit or statutory declaration rather than by witness statement.

4.8.3.2 Affidavit

Instructions as to the correct form of an affidavit can be found in Part 32 Practice Direction 32 paragraph 2 et seq of the Civil Procedure Rules, which can be found on the website of the Ministry of Justice at:

http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part32.htm

4.8.3.3 Statutory Declaration

Section 5 and the First Schedule to the Interpretation Act 1978 provide that “A *Statutory Declaration means a declaration made by virtue of the Statutory Declarations Act 1835*”. It is a written statement of facts which is signed by the declarant and which is solemnly declared to be true before a solicitor or magisterial officer. In the United Kingdom²¹ the declaration should be witnessed by a solicitor, justice of the peace, commissioner for oaths or an officer authorised by law to administer oaths. The correct form for a statutory declaration is provided below.

It must be correctly headed for the proceedings for which it has been filed. Statutory declarations may relate to more than one set of proceedings for example, where cases have been consolidated, in which case the evidence should be headed to refer to all of the proceedings to which it relates. Any defect may attract adverse comments from the Court or Appointed Person if used in a later appeal. The exact wording of the heading may differ from case to case but should include sufficient details to identify the proceedings:

Trade Marks Act 1994

In the matter of application
No. 2999999 in Class 29 in the
name of Gingerfred Foods Ltd
and opposition thereto under No. 65432
in the name of Bowen & Jones Luxury Organics Inc.

A statutory declaration must be made by a person or persons so it cannot be made in the name of a company but can be made by two or more people. In such a case the names of each person must be included, e.g. ‘We, Joe Smith and Fred Brown . . .’ If such a declaration is made then the declarants must all be conversant with all of the facts of which the declaration speaks. A statutory declaration should begin ‘I (name) of (address) hereby solemnly and sincerely declare that.....’ **and end** ‘And I make this declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act 1835.’ Statutory declarations must always be signed by the declarant and the authorised person before whom the declaration is made.

²¹ England, Scotland, Wales and Northern Ireland but not the Isle of Man or the Channel Islands

The statement of belief and all signatures should be on the same page as the last page of written evidence. A fundamental defect such as lack of signature will mean that a statutory declaration cannot be taken into account when making a decision on the case as it is not considered to be 'evidence'. The signature and/or seal of the declarant must also appear at the end of the document.

4.8.3.4 Oral evidence

Most evidence in inter partes proceedings before the Tribunal is in writing, in the form of a witness statement, statutory declaration or affidavit. However, in any particular case the Tribunal may allow oral evidence to be given instead of, or in addition to, written evidence. For example, oral evidence may be given if a witness is unable to read or write or it has not been possible to obtain written evidence within the relevant period. A party wishing to rely on oral *rather* than written evidence must give at least one month's notice prior to any hearing and copy the request to the other party who will be invited to comment on the request.

4.8.4 Exhibits

Evidence may refer to exhibits to support the case. These are usually referenced by the initials of the declarant, deponent or witness and numbered sequentially, e.g. a document filed by Frederic John Butler may have three exhibits, which would be referred to in the evidence as FJB1, FJB2, and FJB3.

Exhibits consisting of a bundle of papers should have a header sheet as its top document. The header sheet should identify the exhibit, e.g. 'This is exhibit FJB1 referred to in the statutory declaration made by Frederick John Butler this.....day of..... 2011'. The date on the header sheet should be the same as the date when the evidence was signed.

Where the exhibits are bulky and are placed in a container, the header sheet may be firmly attached to the container. Where the exhibit is merely a single sample e.g. a bottle, the header sheet may take the form of a tag attached to the sample either by sticky tape or elastic band etc. The Tribunal encourages use of photographs rather than bulky exhibits wherever possible, but the original may be required for viewing prior to or at the hearing.

All individual exhibits of more than 4 pages are to be paginated. Where the pages have not been paginated, the evidence will be returned to the party which has adduced the evidence, for pagination to be applied. The page number should be applied to the bottom right hand corner of each page. The Tribunal is happy for parties to paginate the entirety of their evidence, regardless of the size of individual exhibits.

Lengthy documents that already bear page numbers, e.g. magazines and annual reports, can be the subject of single exhibits and the existing page numbering can be relied upon, as long as it is clearly visible on each page; parties must make sure that the page numbering is clear, particularly where the material has been photocopied.

4.8.4.1 Evidence filed in the form of electronic media

Evidence supplied in this form must be copied to the other party or parties at the same time as the evidence to which it is exhibited. No copyright infringement will occur as proceedings before the Tribunal constitute legal proceedings for the purposes of section 45(1) of the Copyright Designs and Patents Act 1988.

Furnishing such evidence in an electronic format gives rise to various considerations:

- The ability of the other party to access it
- The compatibility of the media with the systems used by the IPO and the other party
- The compatibility of the media with the systems used by the appellate bodies, e.g. the High Court and the Appointed Persons
- The potential for corruption of data
- The possibility that, unknown to the supplier of the media, it carries a virus
- For the purpose of a hearing, the contents might have to be printed for both the Hearing Officer and the other party

Where evidence is filed in the form of electronic media it should be in a standard, easily accessible format e.g. Windows® Media compatible

4.8.4.2 Statements in foreign languages

Statements made in foreign languages will normally be accepted as being valid under local law unless successfully challenged by the other party. If a challenge is made it should be supported with the reasons to explain the basis of the challenge. Any challenge should be made as soon as possible. Unless the person making the declaration has a good command of the English language, they will be unable to testify in English. In such cases, the declaration may be filed in their mother tongue accompanied by a certified translation prepared by a competent translator. Exhibits must similarly be translated if they are to be relied upon.²² The translator should prepare their own witness statement, statutory declaration or affidavit stating that they are (at least) familiar with English and the other language. As an exhibit to the declaration, the translator should file copies of the foreign declaration and its translation.

4.8.4.3 Evidence filed in earlier proceedings

Evidence filed in earlier proceedings may be taken into account in a later case if a party considers it to be relevant. But it may be necessary to file such evidence as an exhibit to a further statutory declaration, affidavit or witness statement, particularly where the original witness is no longer available.

²² *Pollini* (BL O/146/02)

Evidence filed at examination stage to secure acceptance of an application may be used in later, inter partes, proceedings. But the person filing it must serve a copy of it and any supporting exhibits on the other party.

Evidence filed by a party in earlier inter partes proceedings may also be adopted into later proceedings on the basis of a request made in correspondence. This is of course subject to the evidence being available in the Tribunal. It should be noted that papers from inter partes proceedings are normally destroyed two years after the completion of the proceedings. Further, if the other party has not been served with the evidence in on-going proceedings between the parties, a copy of it should be served on the other side when the request is made to the Tribunal to adopt the earlier filed evidence into the proceedings.

4.8.4.4 Function and weight of expert evidence

An expert witness instructs the judge in those matters he would not otherwise know but which are material for him to know in order to give an informed decision.²³ It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge might otherwise be ignorant and which may be relevant to the likelihood of confusion.

It is **not** legitimate to call such witnesses merely in order to give their opinions as to whether or not two marks are similar. The question of similarity, confusion and other detriment to the earlier mark is normally one for the judge not the witnesses.²⁴

In any event, if the opinion of an expert is to be relied upon then weight can only be attached to that opinion if it is an opinion based on experience and is explained in sufficient detail so that the Tribunal can comprehend why the expert holds that opinion.²⁵

4.8.4.5 Survey evidence

Survey evidence is regularly filed in proceedings and is regularly deeply flawed. The basic parameters for the conduct of a survey were set out in the head note of *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the

²³ *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283

²⁴ *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842

²⁵ *Valucci Designs Ltd t/a Hugo Hogs v IPC Magazines Ltd* BL O/455/00

survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

If a party wishes to file survey evidence then it may seek directions from the Tribunal as to the form and conduct of the survey. This will not bind the Tribunal to accept the results but may at least prevent obvious errors and the associated wasted time and cost.

4.8.5 Additional evidence

A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence the Tribunal will primarily consider the following²⁶:

- The materiality of the evidence to the question needed to be determined
- The justice and fairness of subjecting the opposite party to the burden of evidence in question at that stage of the registry proceedings, including the reasons why the evidence was not filed earlier
- Whether the admission of the additional evidence would prejudice the other party in ways that cannot be compensated for in costs (e.g. excessive delay)

4.8.6 Defective evidence

On receipt, the Tribunal will scrutinise the evidence for defects in its format. Defects may arise in the heading, content itself, exhibits or attestation. The defect(s) will be brought to the attention of the filer and an opportunity will be given to put matters in order. Under no circumstances will the Tribunal correct evidence on behalf of the filer; to do so may bring the admissibility of the evidence, particularly if it goes to appeal, into question.

A copy of the evidence will be kept on the dispute file by the Tribunal and the original evidence will be returned to the filer who will be invited to remedy matters within a specified period. Generally this will result in a suspension of the proceedings. Any amendments to the text of the evidence must be initialled by the declarant or deponent and the witness and returned to the Tribunal.

Ultimately the admissibility of evidence or otherwise will be a matter for the Tribunal and any appellate body. Where defects are minor, the Tribunal may accept the evidence as filed, but caution the filer that his evidence may be considered inadmissible at a later stage.

²⁶ *Lappet Manufacturing Co Ltd v Yosif Abdulrahman Al-Bassam Trading Establishment* BL O/467/02

4.8.7 Evidence in reply

The aim of 'evidence in reply' is to achieve finality in the proceedings; evidence in reply must not involve a departure from a case put in chief, but may include comment on the other side's evidence. It should not '*seek to adduce additional evidence...*'²⁷ However, it should be noted that this is no longer a requirement of the Rules. The Tribunal has the power to direct what evidence should be filed and may specify that the evidence should be limited to evidence in reply. If the evidence is not in reply it may still be admissible as additional evidence.

4.8.8 Objections to evidence by the other party

In addition to formal defects raised by the Tribunal, the other party may also object to evidence and argue that it should be struck out. The following reasons may be put forward for evidence (or parts of evidence) to be struck out:

- The evidence comprises 'without prejudice' material and therefore should not be put before a Hearing Officer or appeal authority
- The evidence is vexatious and discloses no bona fide case
- The evidence is illegible
- The evidence is of questionable relevance and so voluminous as to be oppressive

This is a non-exhaustive list.

Any such objections to evidence ought to be raised at the earliest opportunity. A procedural hearing/CMC may be appointed, if necessary, to resolve the matter.

4.8.9 Challenging evidence

It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or, by answering the challenge that his or her evidence is untrue in cross-examination.²⁸

Normally, this will mean the opposing party making written observations within the period allowed for filing its evidence in response to the witness's evidence explaining why the witness should not be believed. Alternatively, the opposing party can file factual evidence in reply of its own which shows why the evidence in question should not be believed. In the further alternative, the opposing party can ask to cross-examine the witness in question at a hearing.

However, requesting cross-examination may be disproportionate and unnecessarily costly and burdensome, since in trade mark proceedings the evidence stages are

²⁷ *Ernest Scragg & Sons Ltd's Application* [1972] RPC 679

²⁸ *EXTREME Trade Mark* BL O/161/07

sequential, providing opportunities to deal with points during the proceedings.²⁹ In addition, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case.

Written submissions, or evidence which contradicts the witness's evidence, are therefore likely to be the most satisfactory ways to dispute the factual evidence of the other side in the majority of cases.

For full details of the cross-examination procedure see section 6.8.3.

4.8.10 Hearsay

Hearsay evidence is oral or written statements made by someone who is not a witness in the case but which the Court or Tribunal is asked to accept as evidence for the truth of what is stated.

If a witness statement, affidavit or statutory declaration contains hearsay evidence, it should be filed in sufficient time and it should contain sufficient particulars to enable the other party or parties to deal with the matters arising out of its containing such evidence. If the provision of further particulars of or relating to the evidence is reasonable and practicable in the circumstances for that purpose, they should be given on request.

It is also to be borne in mind that in estimating the weight (if any) to be given to hearsay evidence in proceedings before the Tribunal, the Tribunal and those acting on its behalf shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In estimating the weight, if any, to be given to hearsay evidence attention is drawn to the provisions of section 4 of the Civil Evidence Act 1995, which states:-

4.—(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

²⁹ *BRUTT Trade Marks* [2007] RPC 19

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

Parties to proceedings have on occasions solicited letters from third parties for the purposes of the proceedings, rather than getting the third party to file evidence by witness statement, affidavit or statutory declaration. These are often headed 'to whom it may concern', or, in some cases, are addressed directly to the Tribunal. Such letters will be treated as hearsay evidence. Parties are encouraged to present such evidence in the form of a witness statement rather than in the form of a letter if they wish to rely on it. A signatory to a witness statement, who can be cross-examined, is likely to exercise greater care and precision than a signatory to a letter.

4.8.11 Withdrawal of evidence

A party may apply to withdraw evidence already filed and any such request will be considered in the light of comments from the other party.

4.8.12 Ownership of evidence

At the conclusion of proceedings, all evidence, including statutory declarations, affidavits and exhibits will be retained for two years. The evidence must be kept because it is part of the case which is, under the Act, open to public inspection, subject to various qualifications, under rule 59.

If the filer wants an exhibit returned within this period because of, for example, its value etc, consideration will be given to the request. In both cases, alternative methods of meeting the Tribunal's obligation to the public will be considered, such as retaining a photograph of the evidence, or the filer providing an undertaking that, in the event that a third party wishes to inspect the evidence, the evidence will be made available within a specified time.

4.9 Extensions of time and stays in proceedings

Rule 77 of the Trade Marks Rules 2008

As the rule states, some time limits can be extended but some cannot. In relation to inter partes proceedings, the following periods cannot be extended:

- Time for filing opposition, (except as allowed in the relevant rule with regard to the extension of the opposition period by filing a TM7A)
- Time for filing counter-statement in oppositions, (except as allowed in the relevant rule with regard to the cooling off period)
- Time for responding to a preliminary indication by filing a TM53

- Time for filing counter-statement in revocation (non-use and other grounds) and invalidity proceedings
- Time for setting aside a decision of cancellation of an application, or of the revocation or invalidation of a registration

All other periods, whether prescribed by the rules or specified by the Tribunal, can be extended by successful application in the appropriate manner.

4.9.1 Extensions of time

Tribunal procedure

Following the filing of a defence, the Tribunal sets and notifies the parties of the timetable for filing evidence and/or submissions.

The timetable is to be adhered to. It provides more than enough time, in the vast majority of cases, for facts or submissions pertinent to the pleaded grounds to be gathered and presented to the Tribunal. Parties should not regard this timetable as a 'starter for ten', to be varied at a later date. The Tribunal will, **in exceptional cases**, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. The Tribunal will also need to be satisfied that the extra time is warranted in the context of the pleaded grounds and what is necessary to determine the case efficiently and fairly.

Further, the Tribunal will use its discretion to set time periods as it sees necessary, which may be less than the further time which the party has requested. Parties should particularly note that, if they have specified a time when the evidence will be ready and been allowed that further period of time, the Tribunal will look unfavourably upon further extension requests.

On receipt of a properly filed TM9 the Tribunal will make a preliminary decision on its grant or refusal and notify the parties accordingly, in writing. A period of fourteen days from the date of the letter will be allowed for either party to the proceedings to provide full written arguments against the decision and to request a hearing. If no such response is received within the time allowed, the decision will automatically be confirmed.

When filing a TM9 the requester must confirm the form (and any attachment) has been copied to every other party to the proceedings in accordance with rule 77(3) of the Rules.

An application to extend any prescribed period must be made in writing, before the relevant period expires, and is subject to the filing of a TM9 and payment of the fee. If an application to extend is made outside the relevant period it must be accompanied by an explanation for the delay. In deciding whether to allow the extension, the Tribunal will need to be satisfied that it is just and equitable to do so.

Several decided cases have provided guidance in respect of extension of time requests. The following paragraphs only set out to summarise salient points in relevant decisions. Each case will depend on individual circumstances and it is advisable to read each decision referred to in greater depth.

Key points from decided cases

The party seeking the extension has the evidential burden of justifying it. The reasons for the extension should be ‘strong and compelling’.³⁰

It is for the party in default to satisfy the Court that despite his default, discretion should be exercised.³¹

The fact that evidence is available at the time a Hearing/CMC on a contested extension of time takes place is not determinative, though it is an important factor.³²

While ongoing negotiations do not relieve a party of its obligation to file evidence they could still be a relevant factor in exercising discretion.³³

In *Siddiqui’s Application*³⁴ the Appointed Person said that it was incumbent on the party requesting the extension to put forward facts which merited the extension. The Appointed Person said:

“In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”

The applicant for an extension (and the opposer) must, therefore make a full disclosure of the relevant facts in writing prior to the hearing.³⁵

FAILURE TO COPY TO THE OTHER SIDE OR TO PROVIDE DETAILED REASONS WILL RESULT IN REFUSAL OF THE EXTENSION.

4.9.2 Stay of proceedings

Following the *Liquid Force* decision, the Tribunal makes a clear distinction between an extension of time to file evidence and a stay or suspension, jointly requested by

³⁰ *A.J and M.A Levy’s Trade Mark* [1999] RPC 292

³¹ *Liquid Force* [1999] RPC 429

³² *Ibid*

³³ *Ibid*

³⁴ BL O/481/00

³⁵ *Style Holdings Plc’s application* BL O/464/01 and *Ministry of Sound* BL O/136/03

the parties, in which they can negotiate. If granted, the Tribunal may impose conditions in respect of any stay or suspension.

The Tribunal does not intend to force parties into the filing of evidence where parties can ultimately reach a negotiated settlement. Nevertheless, the Tribunal has an overriding objective to ensure that all proceedings are completed within a reasonable time and avoiding unnecessary expense. There is a clear public interest that third parties should have certainty as to the outcome of proceedings.

Consequently, there may come a point where the Tribunal directs the parties to file evidence or face their case being struck out, despite the fact that they are still in long running discussions.

Rules 18(4) and (5) allow parties to enter a cooling-off period to attempt to resolve their dispute by negotiation. The period of time is generous, particularly if the option to extend the initial cooling-off period is used. The Rules expressly limit the length of the cooling-off period to a maximum of 18 months. Staying proceedings for further negotiations at the end of the cooling-off period effectively circumvents the maximum period allowed for cooling off. Consequently, once parties have exited cooling-off and the proceedings have been joined (by the filing of the defence), **the Tribunal will not permit an immediate stay of proceedings for further negotiations unless:**

a) The parties can state a date, within the next month or so, by which time agreement is expected, or

b) The parties have agreed to mediation

Where, following the cooling off period, proceedings are stayed until a date provided by the parties (as in a) above), the Tribunal will look unfavourably upon further stay requests. A stay request for further negotiations made after the parties have seen each other's evidence will be at the discretion of the Hearing Officer responsible for the case and may form the subject of a CMC (see section 6.6).

Procedure

Where a stay is requested on the basis that the parties are trying to negotiate an amicable settlement, the parties will need to show what they have done in their negotiations in the period prior to the request. Consequently, it will be expected that details of the dates of the actions that they have taken and the nature of those actions will be included in the statement. The statement will not need to go into confidential or without prejudice details but it will need to show that there has been serious and continuing work towards a settlement going on prior to the request. As well as listing communications between the representatives it should also show any communications with instructing clients.

A list of actions might be something like this:

- **3 September 2011**
letter to representative of x re settlement conditions
- **13 September 2011**
letter from representative of y
- **13 September 2011**
letter to client re proposal from y

The parties will also need to make a statement of the progress to date and give an indication as to whether outstanding issues are merely minor issues of clarification or whether they represent potentially significant barriers to a resolution of the matter. The parties will be expected to state realistically and clearly when they expect the negotiations to be completed and the proceedings concluded.

If the request for a stay or suspension follows immediately after a counterstatement has been received and where there has been no cooling off period, it is possible that all the parties will have been able to achieve is an agreement to start negotiations. In such cases the Tribunal will look sympathetically at the first request to stay the proceedings. However, repeat requests will be looked at more critically and the Tribunal will need to be reassured that real progress is being made towards a negotiated settlement.

4.10 Intervention

Rule 45 of the Trade Marks Rules 2008

This rule allows any person, other than the registered proprietor, claiming to have an interest in proceedings on an application for:

- Revocation on grounds of non-use
- Revocation on grounds other than non-use
- Invalidation

or

- Rectification

to file an application on a TM27 for leave to intervene, stating the nature of its interest.

The Tribunal may grant or refuse leave to intervene and if leave to intervene is granted conditions may be attached, e.g. undertaking as to costs. The intervener is treated as a party to proceedings.

4.11 Partial refusals

4.11.1 The Law

Article 13 of the First Council Directive 89/104 of December 21, 1988, to approximate the laws of the Member States relating to trade marks, states:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

In *Sensornet Trade Mark*,³⁶ Mr Richard Arnold Q.C., sitting as the Appointed Person stated that:

"50....if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder. I consider that this is equally true during examination and during opposition.

52. Suppose, for example, that an applicant applies to register a mark in respect of "motor cars; motor cycles; bicycles" and that, for whatever reason, the Registrar concludes that the requirements for registration are met so far as the application relates to "motor cars; motor cycles" but that they are not met so far as the application relates to "bicycles". In those circumstances I consider that the Registrar can and should decide to refuse the application so far as it relates to "bicycles" but accept it so far as it relates to "motor cars; motor cycles".

53. Furthermore, I do not consider that in such circumstances it is necessary for the applicant to amend the specification under section 39 in order for the acceptable part to be accepted and published for opposition. All that is needed is to identify which part of the specification is acceptable and which is not, and the Registrar's decision can and should do this. To my mind, section 39 has a different function, which is to enable applicants to make voluntary restrictions to specifications, whether in the hope of side-stepping a ground of objection or for other reasons... I consider that it is possible that section 39 enables applicants to make amendments to the wording of the specification and that this is not a power which the Registrar has...

...57. Thus if the hypothetical case considered in paragraph 52 arose in opposition proceedings, I consider that the result should be the same. The hearing officer could and should decide to refuse the application so far as it related to "bicycles" but accept it so far as it related to "motor cars; motor cycles". Again it would be unnecessary for the applicant to request amendment of the specification under section 39...

...59. It will be seen that the situations discussed above all involve taking the specification as it stands and, in the event that it is decided that grounds for refusal exist in respect of certain of the goods or services specified but not

³⁶ BL O/136/06

others, deleting the objectionable goods or services from the specification i.e. applying a blue pencil approach."

In *Giorgio Armani SpA v Sunrich Clothing Ltd*³⁷ Mann J considered the correct approach to arriving at a fair specification in opposition proceedings where there were grounds for partial refusal and where he had concluded that the application of the metaphorical "blue pencil" by the Hearing Officer was not appropriate and no unconditional restriction had been offered by the applicant. He considered the application of the principles applied by Mr Arnold in *SENSORNET* and said:

"52. [...] there is no case law binding on me which deals with the point I have to decide, and I have to decide it on the footing of the statutory provisions as to applications and amendment, such rules of procedure as govern the proceedings, and on the footing of normal requirements of procedural and substantive fairness. Mr Arnold's views do not really deal with this sort of situation [...]. So far as they indicate that the Hearing Officer has to take the specification as he or she finds it, he is not dealing with a case where there needs to be a debate in inter partes proceedings about the scope of the permitted registration. If applied too literally the concept would prevent the proper resolution of part of the real dispute.

53. What the present situation involves is the proper identification and resolution of the dispute arising out of the opposition, and the following points apply:

(i) Since this case was one of partial opposition (in terms of the goods covered), Article 13 requires that there be registration of the mark in relation to goods in relation to which the mark was not opposed. The available procedures should enable that to be done fairly and efficiently.

(ii) [...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities.

Mann J went on to consider the range of procedures that could be adopted in which a dispute as to residual wording could be determined, as referred to by Mr Geoffrey Hobbs, sitting as the Appointed Person in *Citybond Trade Mark* [2007] RPC 13. The range of procedures identified range from the applicant deciding to limit its application to some different specified wording in an unconditional amendment

³⁷ [2010] EWHC 2939 (Ch)

application, to a deferment of the question of alternative wording to the stage after consideration of the formulated objection, with other possibilities in between. He concluded by stating that the Hearing Officer should provide a mechanism for ensuring that he/she is able to give a ruling as to what was left of the registration after a successful opposition.

4.11.2 Practice

Undefended opposition/invalidation/revocation ("the proceedings")

In a case where amendment to the specification(s) of goods/services is required because the proceedings are undefended, the Tribunal will, where appropriate, adopt one or a combination of the following approaches:

- a) Where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Tribunal will take a "blue pencil" approach to remove the offending descriptions of goods/services. The application will be deemed to be abandoned in respect of the goods and/or services specified in the TM7 or TM26 and the remainder of the application will proceed to registration
- b) Where the extent of the opposition cannot be easily reflected through simple deletion, the Tribunal can add a "save for" type exclusion to the existing descriptions of goods/services that reflects the goods/services specified in the TM7 or TM26 and leaves a comprehensible list of goods/services. The application will proceed to registration (or remain registered) with a "save for" type exclusion
- c) Where there is uncertainty regarding the suitability of either of the first two approaches, the case will be considered by a Hearing Officer who will indicate in their own words, the extent to which the proceedings succeed and invite the parties to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings. After considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services

Defended proceedings

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings, the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

- a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of

goods/services. This will not require the filing of a TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that proposed rewording into account subject to it being sanctioned as acceptable from a classification perspective

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that proposed rewording into account subject to it being sanctioned as acceptable from a classification perspective

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly be reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services

4.12 Pleadings

The rules make no mention of the word 'pleadings' which is an alternative term for statements and counter-statements. Pleadings serve a simple function: to identify the issues between the parties which will then be the subject of evidence. Evidence and pleadings are quite different and should not be confused. Unless there is express provision in the rules, the Tribunal does not expect evidence to be filed at the pleadings stage. Pleadings should contain:

- The facts to be relied upon
- The basis in law for the action, and
- The relief being sought and whether costs are requested

Parties to Tribunal proceedings should, in order to avoid wasted time and costs, provide fully focussed and particularised pleadings. Mere recitation of various sections of the Act will not suffice; parties must know in detail the case they have to answer or the basis on which an attack is defended/accepted.³⁸

³⁸ NASA [2000] RPC 21

The Tribunal, prior to formal serving of pleadings, will use appropriate powers to require a party to better particularise, or explain, its pleadings. Further, if in the view of the Tribunal, a particular ground of attack is plainly unsustainable, objection may also be raised. It is important to note, however, that the Tribunal does not intend to prejudge matters of substance, which should properly be decided once all the evidence and submissions have been made. Nor will the Tribunal force parties to incur unnecessary cost at an early stage of proceedings. There will be circumstances where the Tribunal will allow matters to continue but serve notice that it would expect evidence later filed to support a particular claim or indicate that there may be a penalty in costs.

Section 5(3) Grounds pleaded in opposition/invalidation

Section 5(3) reads as follows:

“A trade mark which—

is identical with or similar to an earlier trade mark 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 or international trade mark (EC) 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.”

Section 5(3) can be pleaded in relation to identical, similar and/or dissimilar goods and/or services on the basis that there will be unfair advantage to the junior mark or detriment to the distinctive character or repute of the earlier mark.

THE OPPONENT/APPLICANT FOR INVALIDITY MUST STATE WHAT THE OBJECTION IS AND WHY.

The claim could be particularised in the following ways (where relevant):

- "It will take unfair advantage of our reputation by....."
- "It will tarnish our reputation because...."
- "It will be detrimental to the distinctive character of our trade mark because.... and will affect the economic behaviour of consumers by causing them to....."

The other side must know the scope of the claim against them. If the opponent/applicant for invalidity has simply quoted the text of the Act they will be required to particularise the claim by reference to the specific damage and basis of the claim for that damage.

Section 5(4)(b) Grounds pleaded in opposition/invalidation

Section 5(4)(b) prohibits the registration of a trade mark if its use in the United Kingdom is liable to be prevented by virtue of an earlier right (other than earlier rights

under sections 5(1)(3) and 5(4)(a)) but "*in particular by virtue of the law of copyright, design right or registered designs*".

The requirement that the applicant for invalidation or opponent be the owner of the right relied upon applies and is defined in section 5(4) of the Trade Marks Act as a person who is entitled to take legal action under copyright or design law in order to prevent the use of the trade mark.

Copyright

The law of copyright in the United Kingdom is governed by the Copyright, Designs and Patents Act 1988 (CDPA). There is a qualification requirement as to the nationality (which extends to domicile/residence) by reference to the author of the copyright work (section 154 of the CDPA) or, alternatively, by reference to the country of first publication (section 155 of the CDPA). The pleadings must identify the **author** of the work and the manner in which the work meets these nationality based requirements. Furthermore, as copyright is limited in duration, the date at which the work was created must also be provided.

The owner (proprietor) of the copyright must be identified in the pleadings. The author and the owner may be one and the same, but the position claimed must be clearly stated. If the owner is not the author then the method by which they became the owner should be detailed. It should be noted the first owner of a copyright work is its author unless (in the case of a literary, dramatic, musical or artistic work, or a film) the work is created by an employee in the course of employment (in which case the employer is the first owner of any copyright in the work). This can vary by agreement and the copyright may be assigned to a different party, be it upon creation or later. Any assignment must, though, be in writing for it to be effective (section 90(3) of the CDPA).

The pleadings should set out:

- What the work relied on is, including a representation of it.
- Who created the work and when it was created
- The nationality of the author (or, if the author of the work is a corporate body where the corporate body is incorporated) at the time the work was created
- If domicile/residence of the author is relied upon, where the author was domiciled/resident at the time the work was created
- If the publication of the work is relied on, where the first publication of the work took place and when

- Who the current owner of the work is and, if such a person is not the author, by what method was ownership transferred

There is no requirement for proof of the above to be filed at the pleadings stage.

Design right

The unregistered United Kingdom design right is also governed by the CDPA. There is a qualification requirement by reference to the designer (section 218 CDPA), by reference to a commissioner or employer (section 219 CDPA) or by reference to the person who first marketed the design (section 220 CDPA). The requirement is met by citizens/subjects/people (including legal persons) of, or incorporated in or habitually resident in, the United Kingdom, the European Economic Area or other qualifying countries (mainly Commonwealth countries) at the time that the design was created. Furthermore, as design right is limited in duration, the date at which the work was created must also be provided.

The owner of the design right is the only person able to oppose. As per section 215 CDPA, the first owner of a design right is the designer, unless the design was produced in the course of employment or by way of a commission (in which case the employer/commissioner is the first owner). This can vary by agreement and the design assigned to a different party, be it upon creation or later. Any assignment must, though, be in writing for it to be effective (section 222(3) CDPA).

The pleadings should set out:

- A representation of the design relied upon
- Who designed the design and when this took place
- The nationality of the designer at the time the design was created or, if domicile/residence is relied upon, where the designer was domiciled/resident at the time the design was created
- If qualification is by reference to an employer or a commissioner, the nationality of the employer/commissioner (or if the employer/commissioner is a legal person where it was incorporated), or if domicile/residence is relied upon, where the employer/commissioner was domiciled/resident at the time the design was created (or in the case of a legal person where it has a place of business conducting a substantial business activity)
- If qualification is by reference to the first marketing of the design relied upon, who the first marketer was (and that they were authorised to market the design in the United Kingdom), that persons

nationality/domicile/place of business, and where and when the design was first marketed

- Who the current owner of the design right is and, if such a person is not the designer/commissioner/employer, by what method was ownership transferred

The unregistered Community Design Right

The unregistered Community Design Right is governed by the Community Design Regulation 6/2002 ("CDR"), (particularly Articles 11, 85(2) and 110a (5)). The right arises following a publication of the type described in those Articles. The owner of the design right is the only person able to oppose. The first owner of a design right is the designer; unless the design was produced in the course of employment in which case the employer is the first owner (a commissioner does not do so unless this is provided by contract). This can vary by agreement and the design can be assigned to a different party, be it upon creation or later. The validity of an assignment is governed by the national law applicable under CDR Article 27.

The pleadings should set out:

- A representation of the design relied upon, together with an indication, if it is not evident, of what constitutes its individual character
- Who designed the design, when this took place, and whether he/she was an employee acting in the course of duties as such or under instructions from the employer
- Where and when the design was first disclosed (other than in confidence), and all the circumstances of the disclosure
- Who the current owner of the design right is and, if such a person is not the designer/employer, by what method was ownership transferred

Registered designs

All that is required is the respective number of the registered design in question and a print from the relevant database showing the details of the design in question. The owner of the registered design is the only party entitled to oppose the registration of a trade mark based on such a right.

4.13 Procedural irregularity

In addition to an inherent jurisdiction to regulate proceedings, the Tribunal has a rule-based power, under rule 74, to rectify any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the Office. This can be raised by the parties or by the Tribunal.

If a party wishes to raise the issue of procedural irregularity they should do so in writing. A decision of the Tribunal under rule 74 will be issued to the parties in writing, normally as a preliminary view, with a period set in which to request a hearing if either of the parties should disagree with the Tribunal's decision.

4.14 Publication of amendments

Rule 25 of the Trade Mark Rules 2008

Amendments to the list of goods/services made by the applicant (on a TM21) after publication will continue to be published and the amendment open to opposition for a period of one month as required by rule 25. However, deletion of particular descriptions of goods/services, whether by 'blue pencilling' or through the addition of 'save for' type qualifications, will not be regarded as an amendment under s.39 and therefore will not be subject to the further one month opposition period specified in rule 25.

4.15 Representation before the Tribunal

In inter partes proceedings before the Tribunal, litigants based in the UK, EEA and the Channel Islands can prosecute the matter themselves; there is no requirement to have a solicitor, trade mark attorney or other representative.

That said the Tribunal invites those involved, or likely to become involved, in disputes, to consider appointing a legal representative. This is because, unlike applying for registration of a trade mark which is an administrative procedure, becoming engaged in a dispute involves the parties and the Tribunal in judicial or quasi-judicial proceedings. The Tribunal is in the position of a judge with some of the powers of the court. The proceedings can be complex, for example, they may involve competing rights and/or may impact upon a party's business.

A TM33 will be required if a new agent is appointed. No fee is required.

If a representative is appointed, it is possible to appoint for limited duties, for example, to represent the client at any hearing or to deal only with certain matters. The need for an address for service in the UK, EEA and the Channel Islands still applies. It is the applicant/opponent or registered proprietor's responsibility to notify the Tribunal of any changes to their address for service.

The Tribunal has the power to refuse to deal with certain agents if:

- They have been struck off the Register of Trade Mark Attorneys
- They have been found guilty of an offence such as would render them liable to have been struck off (section 88 of the Act)

If a representative is appointed, they do not have to be on the Register of Trade Mark Attorneys to act before the Tribunal.

4.16 Setting aside cancellation of an application or setting aside revocation/invalidation of a registration

Rule 43 of the Trade Marks Rules 2008

This rule applies where:

- An application for registration is treated as abandoned under rule 18(2)
- The registration of a mark is revoked under rule 38(6) or rule 39(3) or
- The registration of a mark is declared invalid under rule 41(6)

If the applicant or proprietor wishes to request a decision be set aside under this rule they must, within a period of six months beginning with the date the application was refused, (or the mark was invalidated or revoked, as the case may be), file a TM29 requesting that the decision be set aside. This request must be accompanied by evidence in support of the application. The form and evidence must be copied to the other party to the original proceedings.

In considering whether to set aside the original decision the Tribunal must consider the following:

- Whether the person seeking to set aside the decision made an application, promptly upon becoming aware of the original decision
- Any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside

The evidence filed must demonstrate that the failure to file a defence on a TM8 within the time specified was due to a failure to receive the TM7 (or TM26(N)/TM26(O)/TM26(I), as the case may be). If this can be established to the satisfaction of the Tribunal then the original decision may be set aside.

4.17 Substitution of parties

Whilst the rules make no express provision, it has been held that parties can be substituted in proceedings.³⁹ For example, where an interest in a mark or marks forming the basis of an opposition is assigned to another party, that party, may apply to the Tribunal to be substituted for the original opponent or applicant. It should be

³⁹ *Pharmedica* [2000] RPC 536

noted that this only applies if the transfer takes place after the proceedings have commenced, whether or not any inextensible periods for filing pleadings have expired.⁴⁰ Once such a substitution takes place however, this does not give the new party a right to recommence proceedings based on fresh pleadings and/or evidence. There is discretion to amend pleadings, withdraw evidence or file fresh evidence, but the substitution of an opponent/applicant gives no additional right to revisit the pleadings and/or evidence.

Any application to substitute a party must be made in writing, supported by copies of any transfer document (e.g. an assignment). The other party will be invited to comment before any determination is made. If substitution is allowed, the new party will be asked to provide written confirmation that they:

- Have had sight of any forms and evidence already filed and if not suitable arrangements will have to be made
- Stand by the grounds of the original pleading and evidence and confirm that where the name of the original opponent/applicant appears this should be read as if it is their own name
- Are aware of and accept their liability for costs for the whole of the proceedings

Where the Tribunal is asked to allow a new party to be added or substituted in place of the opponent and that request is not due to a transfer of the rights to a pending application or a registered mark, the request may not be allowed.

4.18 Suspension

Suspension is generally requested when there are other proceedings, either before the Tribunal or in another jurisdiction, which will have a bearing on the outcome of the proceedings at issue. If the other proceedings are in the Tribunal, then the Tribunal will normally propose consolidation rather than suspension of the later proceedings.

4.18 Summary judgment and striking out

Although there is no mention in the rules of 'summary judgment' it is considered, in appropriate circumstances, to be within the Tribunal's inherent jurisdiction - both on application by one of the parties and of its own volition.

The CPR gives the general basis for striking out at part 3.4 and summary judgment at part 24.2. Rule 3.4 makes provision for the court to strike out a statement of case or part of a statement of case if it appears that it discloses no reasonable grounds for bringing or defending a claim.

⁴⁰ In cases where proceedings have been launched in the wrong name, the ability to correct the misnomer will depend on the intention of the people responsible for filing the forms which commenced proceedings: *Caswick Ltd v The Thompson Minwax Company* BL O/197/00.

A party may seek summary judgment on a case, i.e. have the entire case thrown out, because the other party is estopped from its action or, because its action is an abuse of process. In cases of estoppel and abuse of process it is for one party to raise the issue, the hearing officer will not raise the matter of his/her own motion.

In other cases it may be appropriate when scrutinising the statement and counterstatement for the Tribunal to consider striking out a ground of objection or a ground of defence. A ground of objection may be struck out as it has no chance of success e.g. relying on a trade mark that has a later date of filing for an action under section 5(2) of the Act.

Case law

The considerations that are to be made in relation to striking out/summary judgment have been the subject of a number of judgments of the courts.

For the principles of summary judgment see *Three Rivers District Council v Bank of England (No 3)* [2001] 2 All ER 513 at [94] and *Swain v Hillman* [2001] 1 All ER 91 at [92].

For abuse of process and multiple proceedings see *Walbrook Trustees (Jersey) Ltd & Others v William Simon Fattal & Others* [2009] EWCA Civ 297

For analysis of a 'real' chance of success see *William Evans and Susan Mary Evens (a partnership trading together as Firecraft) v Focal Point Fires Plc* [2009] EWHC 2784 (Ch) and *Franbar Holdings Limited v Casualty Plus Limited* [2011] EWHC 1161 (Ch) Proudman J

4.19 Without prejudice and privileged correspondence

In general, the principles of without prejudice correspondence applicable in the court will likewise be applied before the Tribunal. The public interest justification for without prejudice communications not being used as evidence is that parties should be at liberty to pursue negotiations and settlement without running a risk that documents relating to such discussions will be put forward in relation to the strengths or weaknesses of their substantive cases.

A useful definition of the 'without prejudice' rule is provided by the following cases:

In *Unilever PLC v The Procter & Gamble Company*⁴¹ (hereafter 'Unilever'), Walker LJ quoted Lord Griffiths as stating in *Rush & Tompkins v Greater London Council*⁴²:

"The 'without prejudice' rule is a rule governing the admissibility of evidence and is founded upon the public policy of encouraging litigants to settle their differences rather than litigate them to a finish. It is nowhere more clearly expressed than in the judgment of Oliver LJ in *Cutts v Head*⁴³:

⁴¹ [2001] 1 All ER 783

⁴² [1989] AC 1280 at 1299

⁴³ [1984] Ch. 290 at 306

*‘That the rule rests, at least in part, upon public policy is clear from many authorities, and the convenient starting point of the inquiry is the nature of the underlying policy. It is that parties should be encouraged as far as possible to settle their disputes without resort to litigation and should not be discouraged by the knowledge that anything that is said in the course of such negotiations **(and that includes of course, as much the failure to reply to an offer as an actual reply)** (my emphasis) may be used to their prejudice in the course of the proceedings.’”*

Documents do not have to be marked “without prejudice” to be such.⁴⁴ It was held in *Chocoladefabriken Lindt & Sprungli AG v Nestle Co. Ltd*⁴⁵ that:

“Any discussions between the parties for the purpose of resolving the dispute between them are not admissible, even if the words “without prejudice” or their equivalent are not expressly used.”

Any communications between a party and their trade mark attorney (being a registered trade mark attorney) is privileged or protected from disclosure in legal proceedings.⁴⁶

The phrase without prejudice is also used in letters to the Tribunal meaning that the writer is preserving their position, e.g. they withdraw the application without prejudice to their clients’ rights. In this instance the wording is part of an open statement and is not afforded any protection.

The without prejudice rule can be excluded in very limited circumstances which are set out in *Unilever* and the CPR. They are as follows:

- Where the issue is whether a concluded compromise agreement was reached
- Where the issue is whether an agreement between the parties should be set aside on grounds of misrepresentation, fraud or undue influence
- Where a statement made might give rise to an estoppel
- Where the exclusion of evidence would act as a cloak for perjury, blackmail or other ambiguous impropriety
- Where the statement made would explain delay or apparent acquiescence

In Tribunal proceedings, for example, evidence of the fact that negotiations have taken place (and their state of play, insofar as this may be relevant to an application for an extension of time) would be admissible.

⁴⁴ *Prudential Assurance Co Ltd v Prudential Insurance Co. of America* [2004] ETMR 29

⁴⁵ [1978] RPC 287

⁴⁶ S.87 of the Trade Marks Act 1994

Where inadmissible documents are filed with the Tribunal, the Tribunal will return the documents and/or state that they cannot be taken into account in determining the substantive matters.

5. COSTS

Section 68 of the Trade Marks Act 1994
Rules 67 and 68 of the Trade Marks Rules 2008

5.1 Liability for costs

A party to proceedings before the Tribunal may incur a liability for costs. It is impossible to give precise guidelines on an exact award of costs as this will be dependent on the circumstances. It is established practice that the Tribunal uses an official scale. The scale reflects a variable amount for the preparation, filing and examination of forms; compilation of evidence; research and investigation; letters and for representation at hearings. In the evidence stages the scale gives a range for the award, which will depend on the amount and relevance of the evidence filed.

If resulting decisions are appealed then further costs may be incurred.

Any award is unlikely to reimburse the total cost of the proceedings as the award is regarded as contributory rather than compensatory. This is in line with the policy objective to provide a low-cost Tribunal by which no-one should be deterred from seeking, protecting or defending their intellectual property rights.

5.2 Unrepresented parties

Any cost awards made in favour of an unrepresented party will include the full cost of any official fees, but will only cover 50% of the amount from the published scale. This ensures that the unrepresented party is not overcompensated for the cost of the proceedings.

When an award is given by the Hearing Officer either with, or after, the issue of the substantive written decision, the unrepresented party will be invited to provide a breakdown of the costs incurred. This itemised account will include the number of hours spent on the proceedings including travel costs.

The Litigants in Person (Costs and Expenses) Act 1975 sets the minimum level of compensation for litigants in person in Court proceedings at £9.25 per hour.

5.3 The current scale is as follows:

Task	Cost
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 examination.

This scale also now takes into account the requirement on a party to give reasonable notice that they intend to proceed with a legal remedy and allows the other party to take appropriate action to avoid this if they wish.

See section 5.8 regarding the requirement to notify.

5.4 The request for costs

A statement or counter-statement will usually include a claim for an award of costs. Nevertheless, if the statement or counter-statement does not include a claim the Tribunal will still consider making an award to the successful party. However, in proceedings concluded without reaching a final decision, the Tribunal will only consider making an award if a specific request is made to it within a reasonable time. Costs will not usually be awarded until both parties have had the opportunity to comment. If a request for costs is received, within a reasonable time, the other party in the dispute will be sent a letter informing them of the claim and inviting comments. They will be allowed 14 days from the date that notification of the claim is sent to them by Tribunal Section. If by this date a response has not been received the award will be decided from the papers on file.

5.5 Joint opponents and cross-proceedings

Where two or more parties have joined to oppose an application and the opposition is successful, any costs awarded to the opponents are calculated as being for one opponent only. If the opposition is not successful, the amount which each is to pay may be specified unless it is considered that the joint opponents are jointly and severally liable. The same principle applies in respect of joint applicants for invalidation/revocation/rectification, the Tribunal will award one payment and it is for the parties to agree their respective shares.

In cross-proceedings the award is usually against the same party in both proceedings. Unless the proceedings were consolidated a separate calculation is made in each proceeding. These must be capable of independent justification in case of appeal.

5.6 Costs off the scale

It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In *Rizla Ltd's application* [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derived from section 107 of the Patents Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in *Rizla's* application apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes; it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour. Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.

Depending on the circumstances, the Tribunal may also award costs below the minimum indicated by the standard scale. For example, the Tribunal will not normally award costs which appear to exceed the reasonable costs incurred by a party.

5.7 Security for costs

Security for costs is the provision of an amount of money by one party sufficient to cover that party's liability for costs in proceedings should they lose. Under section 68 and rule 68 the Tribunal has the discretion to make an order for security to be granted. Where the circumstances justify the granting of an order, the Tribunal may do so against any party in proceedings before it. This includes:

- A person making an application for a trade mark which has come under opposition
- A person opposing an application for a trade mark
- An applicant for revocation, invalidation or rectification or the proprietor of the mark under attack

In proceedings before the Tribunal it is usually requested where a party does not carry on business in the United Kingdom or does not appear to have any, or sufficient, assets in the United Kingdom to cover any award of costs made against them, or has not paid previous costs ordered by the Tribunal, OHIM or a Court. Where security is agreed between the parties, appropriate sums of money are deposited or undertakings agreed by third parties such as trade mark agents, solicitors or banks. If there is no agreement that security should be paid, the Tribunal can be asked to intervene and determine the matter.

Requests by UK parties for security for costs from a party which is a national or resident in another member state party to the Brussels or Lugano Conventions may not be granted, unless very cogent evidence of substantial difficulty is provided.⁴⁷ In the case of *Sun Microsystems Inc v Viglen*⁴⁸ the Appointed Person held, following *Nasser v United Bank of Kuwait*,⁴⁹ that security for costs applications needed to be determined on their own merits; simply because a party was resident abroad outside a Brussels or Lugano Convention country would not automatically result in security being ordered. Whether to order security is an act of discretion.

A failure to pay previous costs awards will usually be accepted as good evidence of a difficulty in recovering costs.

5.8 Notification of intention to commence proceedings

If the first a party receives of the action against their mark is the receipt of the notification that proceedings have been launched and the application is subsequently withdrawn, or the mark surrendered, before a counter-statement is filed, the Tribunal will decline to make any award at all.

However, if the applicant files a counter-statement this will be taken as an intention to defend the attack. If the application is then withdrawn or the registration is voluntarily cancelled a deduction will not usually be made to any costs award. If as a result of a failure to maintain a current address with the Tribunal a party does not receive a communication from a prospective adversary and an attack is then launched without warning and disposed of other than by a hearing, the Tribunal is likely to consider that there should be an award of costs.

Where an award of costs is to be decided without a hearing on the question, the parties may provide examples of correspondence, evidence or other matter to support their position (such as a letter proving that warning was given of the impending action).

⁴⁷ This is because the Civil Jurisdiction and Judgments Act 1982, clarified by a decision in the Court of Appeal (*Fitzgerald v Williams*, *The Times*, January 3, 1996, C.A.), determines that the Registrar does not have the power to automatically award costs against such a party, as the Conventions introduced an effective means by which a successful defendant resident in the UK can enforce an order for costs against an unsuccessful plaintiff in another contracting state.

⁴⁸ BL O/585/01

⁴⁹ [2001] EWCA Civ 556

5.9 Consolidation

If the proceedings were consolidated before any evidence had been filed, the cost calculation should normally award the amount for each stage of the evidence as if it was a single set of proceedings. However, if the consolidation had been ordered after evidence had been filed, the calculation should normally award costs separately for each set of proceedings up to the stage when consolidation was requested, and as though they were one set of proceedings thereafter.

5.10 Negotiations and an award of costs

Parties in proceedings often reach an agreement which enables the action to be settled without the need for a decision. This can result in an applicant or registered proprietor agreeing to limit their application or registration in some way, most usually in relation to the goods or services. It can also result in the application being withdrawn or the registration surrendered. Where the proceedings are settled by negotiation, the Tribunal would expect the agreement to cover the question of costs and for the parties to make their own settlement. Where the request is made following a negotiated settlement, the Tribunal is unlikely to deem an award to either party to be appropriate.

An applicant or proprietor may request an amendment other than as the result of negotiations. This may remove the basis for the proceedings and result in the opponent, applicant for revocation, invalidation or rectification withdrawing them. The withdrawal of a party from proceedings is usually taken as a success for the other side but, where an application or registration has been amended this should be considered as a partial success for the party that launched the proceedings. Where an action is partially successful the Tribunal may award costs which reflect the extent to which it succeeded.

Where an award of costs is made following abortive negotiations, the usual principle of the court applies, namely, that no party will have to pay any costs incurred in the proceedings after an offer by him of as much as the decision gives to the other party. If, on the other hand the offer was only less than the eventual award, he may expect to have to pay all the usual costs.

5.11 Discretionary items affecting an award of costs

Discretionary items are not added to the award of costs unless evidence has been filed. Consular and other stamps on declarations sworn abroad can be considered. When the cost award is to take this expense into account, the calculations and total amount awarded must be shown separately in the costs estimate. They are, however, included as part of the total of the Order. Declarations which are completely disregarded by the Hearing Officer will not usually be included in any cost calculation. There may be exceptions to this where, for example, the declarations or affidavits were filed to meet a challenge that was subsequently abandoned.

5.12 Enforcement of an award of costs

The enforcement of an award is a matter for the party in whose favour the award was made. Section 68(2) of the Trade Marks Act 1994 provides that an order for costs may be enforced in the same way as an order of the High Court. To enforce an order, an application must be made to the Court, but it is not necessary to obtain a judgment. This is done by filing a N322A to the High Court.

Application can also be made to the Court of Session in Scotland or the High Court of Justice in Northern Ireland as appropriate. To enforce an award of costs in a Brussels or Lugano Convention country the application needs to be made through the appropriate national court; these are detailed in the Conventions.

Failure to pay an award may also have a consequence in relation to subsequent proceedings as it is likely to be a factor should security for costs be required.

5.13 Enforcement of Community Judgments

Statutory Instrument (SI) 1998 No 1259 (the European Communities (Enforcement of Community Judgments) (Amendment) Order 1998) was laid before Parliament on 1 June 1998 and came into force on 22 June 1998. This SI amended SI 1972 No 1590 (the European Communities (Enforcement of Community Judgments) Order 1972) which provided for the registration and enforcement in the United Kingdom of certain decisions, judgments and orders of Community institutions which Member States are required to make enforceable in accordance with natural law.

The amendment provides that decisions made under Article 82 of Council Regulation 40/94 (the Community trade mark regulation) by the OHIM shall be registrable and enforceable in the United Kingdom in addition to all those decisions, judgments and orders for which provision is already made under SI 1972 No 1590. Decisions made by the OHIM under Article 82 only relate to the fixing of awards of costs.

Upon request the Tribunal will verify the authenticity of a decision fixing costs made by the OHIM for this to then be enforced in the UK.

5.14 Non- payments of costs

It is assumed that parties to proceedings, having an award of costs in their favour, will pursue all the normal avenues to enforce the award. In the event that the award remains unpaid they may then approach the Tribunal.

The Tribunal will then write to the party against whom the award was made reminding them of their obligation, giving them an additional period within which to pay the sum due and stating that if they do not notify the Tribunal that the costs have been paid the details of the failure to pay the costs will be published on the IPO website here: <http://www.ipo.gov.uk/pro-types/pro-tm/pro-t-dispute/t-unpaid-details.htm>

Our aim in publishing these details is to provide an incentive for parties who owe the sums covered by cost orders to settle matters without the need for the successful party to incur further legal costs enforcing the order. Although the Tribunal has no

power directly to enforce the order, the rules provide that it may require security for costs from a party engaged in proceedings. If there is reason to doubt that an award of costs outstanding against a party would be honoured, this is a factor which may be taken into account by a Hearing Officer in exercising discretion in terms of considering a request for security for costs.

If the Tribunal is notified that the award of costs has been paid, the details will be removed.

6. HEARINGS, CASE MANAGEMENT CONFERENCES AND DECISIONS

Rules 62, 63 and 66 of the Trade Marks Rules 2008

6.1 The right to be heard

Rule 63 of the Trade Marks Rules 2008

Where the Tribunal takes a decision under the Act or Rules, which is, or may be adverse to any party to the proceedings, that party has the right to be heard (or to make oral submissions) on the matter before the decision is made. This is a right which can be waived. For example, if the parties would rather file written submissions on the matter, and the Hearing Officer considers it appropriate, the decision may be made from the papers on the case-file instead.

There are three types of hearing which may occur during the course of proceedings. These are a Procedural Hearing⁵⁰, Case Management Conference (CMC)/Pre Hearing Review and Main (or Substantive) Hearing.

Procedural Hearings and Case Management Conferences will deal with procedural issues and disagreements, usually after a party has objected to a preliminary view. Main Hearings will deal with the substantive issues of the case and complete proceedings. Further details of the different types of hearing and when they arise are given below at sections 6.6, 6.7 and 6.8.

6.2 Preliminary view

If a dispute arises during the course of the proceedings over a procedural issue, which may either be between the parties or the Tribunal and party/parties, the Tribunal will issue a preliminary view on the matter. Parties should note that, in relation to procedural issues that come before it, the Tribunal will not usually ask the other side for comments before it issues its preliminary view in writing. The Tribunal's preliminary view will become final unless a party objects to it and provides written reasons for doing so (copied to the other side). If that happens, a CMC or Procedural Hearing will usually be appointed.

6.3 Representative for the Tribunal

⁵⁰ Procedural hearings are also referred to as Interlocutory or Joint hearings. See the glossary for full explanation of these terms.

All Hearings and CMCs are conducted by senior officers of the Tribunal who have delegated powers to act on behalf of the Registrar. Hearing Officers may have an assistant or observer who does not generally take an active part in the proceedings.

In addressing the Hearing Officer, parties may use either his or her normal address e.g. Mr X/Mrs Y, but Sir/Madam will be acceptable.

The Tribunal may also make arrangements for a shorthand writer to be present, if appropriate, or in the case of video conference Hearings, for an audio recording. Where a record is being taken the parties will be told and entitled to ask for a copy of the record.

6.4 Representative for the parties

A person can represent themselves or appoint a representative. It should be noted that there is no requirement for any person or appointed representative to be legally qualified. In the case of *Denis McCourt and Darren Chapman's Application (BL O/299/02)* the Hearing Officer stated:

'The Trade Mark Tribunal is intended to be a relatively informal, low cost, easy access alternative and to make it compulsory for representation to be legally qualified persons is inconsistent with these objectives'.

A party is also not obliged to attend any hearing and, if they choose not to attend, they may instead wish to rely on written submissions made beforehand and copied to the other party.

6.5 Oral submissions (and the order in which they are given) by the parties

The Hearing Officer will first introduce the proceedings and indicate any preliminary issues that need addressing. The party on whom the onus rests or, in other words, the party on whom the 'burden of proof' lies will then be invited to commence oral submissions.

For example, at a main hearing in an opposition case, the opponent will provide their submissions first. Once the opponent has finished making his submissions, the applicant will be invited to make his. The opponent will then have an opportunity to make final submissions in reply to those of the applicant.

An example with regards to the right to begin submissions at a procedural hearing would be where a party is seeking amendment of pleadings. In this instance, the party seeking the amendment would speak first, followed by the other party. The party seeking amendment would then be given the opportunity to reply to the other party.

It is ultimately for the Hearing Officer to determine the manner in which a Hearing will be conducted and the order in which parties will make submissions. If the right to begin is disputed, this must be resolved as a preliminary issue at the direction of the Hearing Officer.

6.6 Case Management Conference

Rule 62 of the Trade Marks Rules 2008

Rule 62 empowers the Tribunal to give case management directions. There is a public interest in resolving disputes before the Tribunal efficiently and within a predictable timescale. Swift and effective determination of cases not only reduces the burden of litigation and the accompanying costs for the parties involved but creates certainty for third parties. Furthermore, drawn-out proceedings which become unnecessarily complicated or sidetracked, affect the resources which the Tribunal is able to fairly allocate to other users.

If procedural disagreements arise during the evidential time periods or later, the matter will usually be resolved through appointment of a Case Management Conference. Examples of matters resolved at such a hearing would be extension of time requests, whether cases should be consolidated, issuing of confidentiality orders, suspension of proceedings and the granting/refusal of requests to cross-examine witnesses. This is not an exhaustive list.

Hearing Officers will use their wide case management powers to make appropriate directions to the parties covering all aspects of the future management of the case in order to meet the overriding objectives of the Tribunal. For example, it is currently not uncommon for parties pleading a section 5(2) (b) ground to rely upon several earlier marks, including a mark which is subject to proof of use for a narrower specification of goods and services than another earlier registration of the same mark for a wider specification, but which is not subject to proof of use. In such a case, the Hearing Officer may refuse further time to file evidence of genuine use because it will not assist the determination of the case, instead only adding unnecessary time and cost to the proceedings, and ultimately cost for the parties concerned (rule 62(2)). Similarly, rule 62(h) allows for part of any proceedings to be dealt with as separate proceedings. For example, a case may be potentially resolved by a relatively simply pleaded section 5(2) ground rather than by a contentious bad faith ground (section 3(6)) with attendant complicated evidential issues. In such a scenario, the Hearing Officer may direct that the proceedings be separated so that evidence on the 3(6) ground will only be necessary if the case cannot be resolved on the simpler section 5(2) grounds.

Parties should also note that rule 62 allows the Tribunal to direct the parties to attend a case management conference, even if the parties have not requested to be heard on a matter. Such direction will be given where the Tribunal considers it is necessary in order to meet the overriding objectives. For example, if there are a number of ongoing cases between the same parties with numerous and complex overlapping issues, the Tribunal may appoint a Case Management Conference in order that directions can be given on the future conduct of the cases. Such directions may include the setting of a timetable and structured framework to ensure that the proceedings are concluded within a timely manner whilst keeping costs to a minimum.

6.6.1 Appointment of the date and location

Where a Case Management Conference is due to be held, the Tribunal will notify the parties of the date and time it will take place, giving **14 days notice** from the date on which notice is sent unless the parties agree to a shorter timescale.

If within 5 days of the date of the notice either party provides the Tribunal with exceptional reasons as to why it cannot make the appointed date, or arrange representation for that date, then another date may be appointed which will be within 7 days of the first date. No party will be permitted to reject two dates/times.

Case Management Conferences will normally take place by telephone conference.

6.6.2 Skeleton arguments

Skeleton arguments are not required prior to a Case Management Conference but parties should be prepared to deal with all matters relevant to the future management of the case.

6.6.3 Decision and directions

The Hearing Officer will give directions at the Case Management Conference with regards to the future conduct of the case. Directions will be confirmed with a confirmatory letter to both parties.

6.7 Procedural Hearing

Where procedural disagreements arise, whether between the parties or between the Tribunal and a party/parties, and where a party/parties are not content to accept the Tribunal's preliminary view on the matter, a Procedural Hearing may be requested to resolve the issue. Such a hearing will normally deal with matters arising during the pleadings stage (before the parties have filed evidence). Examples of matters which are resolved at such a hearing are the admissibility of pleadings and the striking out of grounds. This is not an exhaustive list.

6.7.1 Appointment of the date and location

Where a Procedural Hearing is due to be held, the Tribunal will notify the parties of the date and time it will take place, giving **14 days notice** from the date on which notice is sent.

If within 5 days of the date of the notice either party provides the Hearings Clerk with exceptional reasons as to why it cannot make the appointed date, or arrange representation for that date, then another date may be appointed which will be within 7 days of the first date. No party will be permitted to reject two dates/times.

Procedural Hearings and Case Management Conferences will normally take place via telephone conference.

6.7.2 Skeleton arguments

Skeleton arguments are not normally required prior to a procedural hearing.

Where skeleton arguments are required, or filed, they must be received by the Tribunal by **14:00** two working days before the hearing, regardless of the start time of the hearing. For example, for any hearing due to take place on a Thursday, the skeleton arguments must be filed by 14:00 the previous Tuesday. As with all other correspondence, a copy must also be sent to the other party. If the parties wish to arrange a simultaneous exchange, then they should contact each other to arrange this.

6.7.3 The decision

Decisions on procedural matters will often be given at the hearing itself and will be followed with a letter to both parties confirming the decision and reasons. **Parties should note that, in accordance with rule 70, any decision made after a procedural hearing which does not terminate the proceedings or make an award of costs can only be appealed independently of the final substantive decision with the leave of the Tribunal.**

6.8 Substantive (Main) Hearing

Once the periods for the parties to file evidence have been concluded, either party may request the appointment of a main hearing to make oral submissions to the Hearing Officer on substantive matters. Further, in cases of invalidation based on relative grounds, the Hearing Officer may direct that the parties attend a hearing.

6.8.1 Appointment of the date and location

At the conclusion of the evidence periods, the parties will be provided with a period of 14 days from the date of the Tribunal's letter to notify the Tribunal if they wish to be heard and, in the event that a hearing is requested, the Tribunal will appoint a time and date.

When the date for the Main Hearing is decided, the Tribunal will send notice to the parties of the date and time it will take place, giving **at least 14 days notice** from the date on which notice is sent unless otherwise agreed.

Any request made by party/parties to postpone or rearrange an appointed date for a Main Hearing must be made within a reasonable time period and be supported by full and precise reasons. In the case of a request to rearrange, the Tribunal would expect the parties to agree a list of other dates suitable to both parties which can be put forward for the consideration of the Hearing Officer.

PARTIES SHOULD BE AWARE THAT WHETHER AN APPOINTED DATE CAN BE CHANGED OR POSTPONED IS ULTIMATELY AT THE DISCRETION OF THE HEARING OFFICER. THIS APPLIES TO ALL TYPES OF HEARINGS AND CMCs.

Main Hearings will normally take place via video conference with the Hearing Officer sitting in the Newport Office and the parties sitting in the London Office. The parties can also elect to attend the hearing in person at the Newport Office. However, if cross-examination is to take place, the hearing will normally be in person and will take place either in London or Newport.

6.8.2 Skeleton arguments

Parties with legally qualified representatives are required to submit skeleton arguments in advance of a Substantive Hearing. Where parties intend to rely on authorities (other precedent cases) then details of these should be included within the skeleton arguments.

Parties who do not have a legally qualified representative are not required to provide skeleton arguments, although they may do so if they wish.

Where skeleton arguments are required, or filed, they must be received by the Tribunal by **14:00** two working days before the hearing, regardless of the start time of the hearing. For example, for any hearing due to take place on a Thursday, the skeleton arguments must be filed by 14:00 on the Tuesday before. As with all other correspondence, a copy must also be sent to the other party. If the parties wish to arrange a simultaneous exchange, then they should contact each other to arrange this.

6.8.3 Cross-examination

Section 69 of the Trade Marks Act 1994
Rule 65 of the Trade Marks Rules 2008

Where a party wishes to cross-examine any witness on his written evidence, the request to cross-examine must be made at the earliest opportunity (preferably at the same time as the request to appoint a Main Hearing) to ensure reasonable notice is given.

If a request to cross-examine is received, the Tribunal will need to be satisfied that it is appropriate in all the circumstances. To ensure that the Tribunal has the necessary information on which to base his decision and to ensure the effective conduct of proceedings, all parties making a request for cross-examination should:

- Make the request at the earliest opportunity
- Give the name of the witness they wish to cross-examine
- Give reasons why cross-examination of each witness is requested
- Set out the specific issues to which cross-examination would, if allowed, be directed
- Explain the relevance of those issues to the matters to be decided

- Give an estimate of the time any cross-examination is expected to take
- Copy the request to any other party to the proceedings

For clarification, as regards bullet-point 4 above, the Tribunal does not expect parties to provide a list of the questions to be asked.

The Hearing Officer responsible for the case will then issue directions indicating whether cross-examination is to be permitted and, if so, setting out the scope for its conduct (this may form the subject of a Case Management Conference prior to the Main Hearing).

If cross examination takes place, the witness will be sworn in and his written statement will be taken as his evidence in chief - assuming he is not *only* giving oral evidence. General legal principles of cross examination will apply, such as:

- Cross-examination questions can be leading, re-examination cannot be
- There is nothing to stop a witness being questioned on relevant matters put in evidence by the other side's witnesses, even though the person being cross-examined had said nothing in his own written evidence about the matters in question
- New documents can be introduced which challenge the credibility of a witness
- Admission of new evidence will be limited

This is not an exhaustive list.

As a rule, persons will usually be required to attend the hearing in person if they are to be cross-examined however by using a video conference facility it might be possible to cross - examine persons without requiring their attendance at the hearing. This applies in particular to persons outside the UK, but there are a number of factors to consider. For guidance refer to Civil Procedure Rules, Part 32 Evidence, Practice Direction Annex 3 at:

http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedurerules/civil/contents/practice_directions/pd_part32.htm#IDA53UIC

When used for cross examination or the taking of oral evidence, the objective should be to make the video conference facility session as close as possible to the usual practice at a hearing. To gain the maximum benefit, several differences have to be taken into account.

Some matters, which are taken for granted when cross examination or oral evidence is undertaken in the conventional way, have a different dimension when it is undertaken by video conference facility: for example, the administration of the oath, ensuring that the witness understands who is at the local site and what their various roles are, the raising of any objections to the evidence and the use of documents.

This is further complicated when the witness under examination is a foreign national giving their evidence from outside the UK. It should not be presumed that all foreign governments are willing to allow their nationals or others within their jurisdiction to be examined before a court in England or Wales by means of video conference facility.

If there is any doubt about this, enquiries should be directed to the Foreign and Commonwealth Office (International Legal Matters Unit, Consular Division) with a view to ensuring that the country from which the evidence is to be taken raises no objection to it at a diplomatic level. The party who is directed to be responsible for arranging the attendance of the witness will be required to make all necessary inquiries about this well in advance of the hearing and must be able to inform the Tribunal what those inquiries were and of their outcome.

Time zone differences need to be considered when a witness abroad is to be examined in England or Wales by video conference facility. The convenience of the witness, the parties, their representatives and the Hearing Officer must all be taken into account. The cost of the use of a commercial studio is usually greater outside normal business hours. There is also the issue of the capability of the witness to understand proceedings in English and respond accurately to questioning, or whether this might require a translator to act with the witness.

6.8.4 The decision

At the completion of the parties' submissions at a hearing, the Hearing Officer may give their decision straightaway or may reserve it for later issue. In other cases, the Hearing Officer may suspend their decision pending a subsequent event, such as registration of a material earlier right. There is generally a tendency to reserve Main Hearing decisions.

Following the Hearing, the Hearing Officer will issue a decision which will include full reasons in support of that decision. This decision can be appealed either to the Appointed Person or to the High Court. Please see the 'Appeals' section for details on how to appeal against the decision at section 7.

6.8.5 The role of the Hearing Officer after the Hearing

Once the Hearing Officer has given their decision in writing and provided a full statement of reasons for that decision, they become *'functus officio'*, that is, their role is complete and they can take no further action in the matter adjudicated upon.

Queries or explanations in relation to the decision reached cannot be entertained and must be pursued through appeal mechanisms. Likewise, it is not possible to pursue substantive issues through channels such as office complaints procedures, (although a complaint about the handling of the case may be considered).

The Hearing Officer may however issue a supplementary decision to clarify his original intention or to correct clerical errors or to deal with costs.

6.9 Abatement

The common law principle of abatement would apply where the Tribunal has issued a decision which, had it known of circumstances completely disposing of the issue (e.g. an assignment of the mark in suit to an applicant for revocation) it would not have issued it. In such circumstances the Appointed Persons have held that they have the power to set aside the Tribunal's decision.

6.10 Withdrawal of the action after the Tribunal's decision

Once a decision has been issued by the Tribunal it is not possible for a party to withdraw an action e.g. as a result of settlement, thus 'setting aside' or nullifying the effect of the Tribunal's decision. Parties must instead apply to the Court or Appointed Person to obtain a consent order.

7. APPEALS

Section 76 and 77 of the Trade Marks Act 1994
Rules 71, 72 and 73 of the Trade Marks Rules 2008

Any decision made by the Tribunal under the Act ('decision' includes an exercise of discretion) can be appealed. An appeal seeks to have the Tribunal's decision reversed, set aside or varied. A party who files an appeal will become the 'appellant' in the ensuing appeal and the other party becomes the 'respondent' to that appeal. If both parties file appeals, this will give rise to cross-appeals in which each party becomes the appellant in relation to their own appeal and the respondent in relation to the appeal of the other party.

There are two possible routes of appeal which are:

- To the 'Appointed Person' (a person appointed by the Lord Chancellor to hear and decide appeals, and who meets the eligibility set out in the Act) or
- To the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland

If a decision of the Tribunal is appealed, the implementation of the decision will be suspended until the appeal process has been concluded.⁵¹

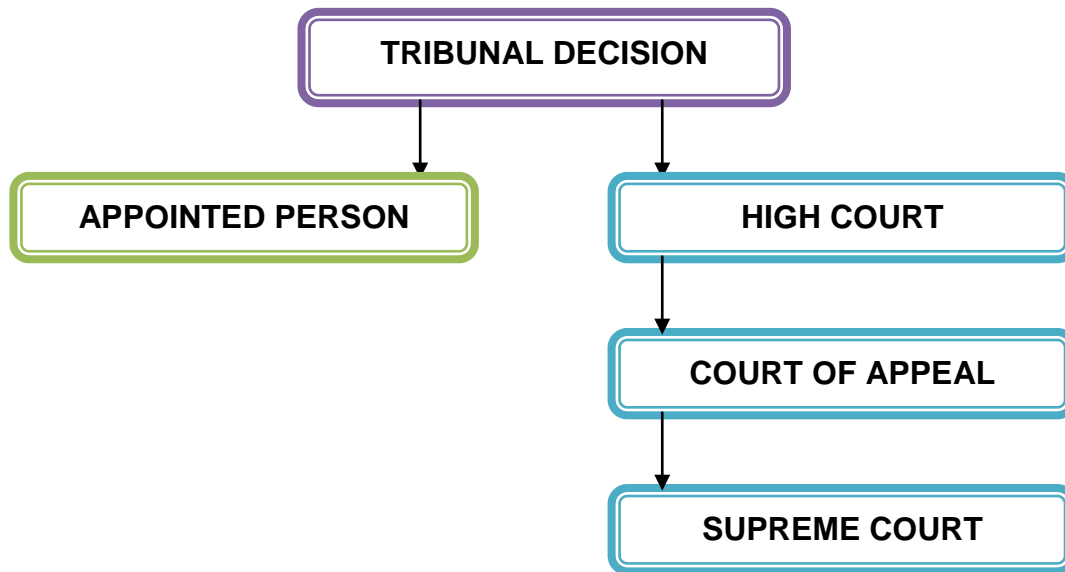
7.1 Appeal routes

The route of appeal is a matter for the parties to decide. However, relevant factors that parties may wish to consider are the costs involved and length of time the appeal may take. An appeal to the Court can be a long and costly process whereas an appeal to the Appointed Person is a relatively inexpensive process.

The decision of the Appointed Person is final: it cannot be appealed to any higher body. Conversely, the decision of the High Court may be further appealed to the

⁵¹ *POINT FOUR Trade Mark* BL O/373/02

Court of Appeal, The Supreme Court and, ultimately, the Court of Justice of the European Union (CJEU).



7.2 How to appeal to the Court

If a party wishes to appeal to the Court, rather than to the Appointed Person, the procedure involved is set out in the detailed rules of procedure applicable to the court. Please refer to the Civil Procedure Rules (Part 52 for Appeals here

http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part52.htm and Part 63 here http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_part63.htm which relates to Patents and other Intellectual Property claims)

7.3 How to appeal to the Appointed Person

Rule 71 of the Trade Marks Rules 2008

Notice of appeal to the Appointed Person must be filed with the Tribunal on a TM55 within **28 days**, beginning with the date of the Tribunal's decision which is the subject of that appeal. The TM55 must include the appellant's statement of grounds of appeal. It must specify whether, and in which respects, the appellant wishes the Appointed Person to reverse, set aside or vary the Tribunal's decision.

There is no fee required to file a notice of appeal to the Appointed Person.

7.3.1 Extension of the period for filing an appeal to the Appointed Person

The period for filing an appeal may be extended, by the filing of a TM9 which must be accompanied by a fee. However, parties should note that strong and compelling reasons are required to support such a request.⁵²

Each request for an extension of time will be considered on its own merits.

7.3.2 After a party files a notice of appeal

The Tribunal will send the notice of appeal and statement to the Appointed Person and to the respondent. Treasury Solicitors are responsible for the arrangement of appeals before the Appointed Person.

7.3.3 The respondent

If the respondent is content with the Hearing Officer's decision they need do nothing in response to the notice of appeal.

If, on the other hand, the respondent to an appeal wishes the Tribunal's decision to be upheld in its totality, **but for additional or different reasons from those given in the decision**, then it should file a respondent's notice with the Tribunal setting out their reasons. The respondent's notice must be filed within **21 days** beginning with the date on which the notice of appeal and statement was sent to the respondent. The notice must specify any grounds on which the respondent considers the original decision should be maintained where these differ from or are additional to the grounds given by the Tribunal in the original decision.

The Registrar will then send a copy of the respondent's notice to the Appointed Person and a copy to the appellant.

7.3.4 Referral of an appeal to the Court after an appeal has been filed to the Appointed Person

Rule 72 of the Trade Marks Rules 2008

Within 28 days of the date on which the notice of appeal is sent to the respondent by the Tribunal, either the Tribunal or any party to the original proceedings may request that the Appointed Person refer the appeal to the Court.

If the Tribunal makes the request, a copy shall be sent to the parties to the proceedings.

If one of the parties makes the request, they must send it to the Tribunal who will then send it to the other party and to the Appointed Person.

⁵² *Whiteline Windows Ltd v Brugmann Frisoplast GmbH BL O/120/99*

Within a further 28 days (from the date that the Tribunal sent a copy of the request to the party/parties), any party who is sent a copy of the request can make representations as to whether the appeal should be referred to the Court. The Appointed Person will then decide whether to agree or decline the request to refer.

It should be noted that, even if the Tribunal and the parties have not requested referral to the Court, the Appointed Person may still refer the matter if it appears to them that a point of general legal importance is involved. In such circumstances, the Appointed Person will send notice to the Registrar and to every party to the proceedings that the matter should be referred to the Court.

Where the Appointed Person does not refer the matter to the Court, they will determine the matter and his decision will be final.

7.3.5 Appointment of the Oral Hearing before the Appointed Person

Rule 73 of the Trade Marks Rules 2008

Where the Appointed Person does not refer the matter to the Court, they will send written notice to the Tribunal and every party to the proceedings, of the time and place which has been appointed for the oral hearing of the appeal. Notice will be sent **at least 14 days** before the oral hearing is due to take place.

Any party to an appeal may decide not to attend the oral hearing and may make written representations instead. If all parties take this option, the Appointed Person may determine the case on the basis of any written representations and the hearing may be cancelled.

The decision of the Appointed Person will be sent, with a statement of reasons for the decision, to the Tribunal and to each person who was a party to the appeal.

8. INTERNATIONAL REGISTRATIONS

The Trade Marks (International Registration) Order 2008
The Trade Marks Rules 2008

8.1 Legislation governing International Registrations (UK)

The detailed rules governing International Registrations (UK) are covered by *both* the Trade Marks Rules 2008 and a Statutory Order, The Trade Marks (International Registration) Order 2008 (the Order). Precisely how the two pieces of legislation interrelate is made clear in the Order. A brief explanation of the Madrid Protocol governing international registration is required before examination in detail as to how the Tribunal, in inter partes proceedings, handles these cases.

8.2 The Madrid Protocol

The Protocol allows a proprietor of, or an applicant for, a national registration to apply through their national office for registration of a national mark in the International Register of the International Bureau of the World Intellectual Property

Organisation (WIPO). Protection can be sought in any country party to the Protocol. The designated country is not bound to grant protection and could refuse it on the grounds which would apply under the International Convention for the Protection of Industrial Property (Cmnd 4431). However, if no notice of refusal has been sent to the International Bureau, States are required to accord the same protection to an international registration designating their territory as they would a national registration. The detailed rules on international registration are set out in the Common Regulations adopted under the Protocol but certain matters have nevertheless been made subject to national provisions - the Act, Rules and the Order.

An international registration designating the UK is referred to as an International Registration (UK).

8.3 Opposition to an International Registration (UK)

Rules 12, 17, 18, 19, 20 and 21 of the Trade Marks Rules 2008

The Order states which specific rules do not apply to International Registrations (UK). With regard to opposition, these are to be treated in the same way as a national application, as provided for in rule 17 of the Rules. However, within 4 months from the date of publication, the Tribunal must send a notice of refusal to the International Bureau.

In addition to sending the notice of refusal to the International Bureau, the Tribunal will serve the notice of opposition to the holder's address for service. The holder has two months from the date that the notice of opposition is served to them within which to file a TM8, under rule 18 of the Trade Marks Rules 2008, together with an address for service in the United Kingdom, another EEA state or the Channel Islands. The consequence of failure to file an address for service is set out in rule 12 of the Rules. The Tribunal will not examine the pleadings until both the statement and counterstatement have been received.

Once the TM8 is filed and scrutiny of the pleadings has been completed by the Registry, the remaining stages of the proceedings are governed by rules 19, 20 and 21 of the Trade Marks Rules 2008.

8.4 Revocation or declaration of invalidity of an International Registration (UK)

Rules 12, 38, 39, 40, 41, 42, 43 and 45 of the Trade Marks Rules 2008

These proceedings are covered by the Order in exactly the same way as are opposed International Registrations (UK), i.e. the relevant rules from the Trade Marks Rules 2008 apply to these proceedings. Particular attention should be paid to the provisions of an address for service in the EEA.

8.5 Rectification of an International Registration (UK)

An International Registration (UK) is only protected in the UK; the actual registration is held and maintained by the International Bureau. Therefore there can be no actions for rectification of the registration before the Tribunal; any action for the

correction of errors which would normally fall under the heading of rectification will need to be raised with the International Bureau.

However, where an international registration is based on a UK application or registration any rectification action taken during the period of dependency, normally the first five years of the international registration, will impact on that registration and the International Bureau, will need to be informed by the Tribunal.

GLOSSARY

Abatement:

A common law principle which applies where the Tribunal has issued a decision which had it known of circumstances completely disposing of the dispute (e.g. an assignment of the mark in suit to an applicant for revocation) it would not have issued.

Absolute grounds:

These are grounds for objecting to a trade mark arising from the trade mark itself.

Acquiescence:

Describes a period of 5 years where the owner of an earlier right has known about the use of a registered trade Mark by another but taken no action to prevent that use. This usually results in a loss of certain rights associated with ownership of a registered trade mark.

Address for service:

An address within the UK, EEA or Channel Islands which must be filed by all parties to proceedings and to which all correspondence relating to proceedings will be sent by the Tribunal.

Affidavit:

Formal written statement testifying on oath that a specified fact or account is true. Countersigned (usually with an official seal) by a witness of juridical authority, affidavits may be used as evidence in court and tribunal proceedings

Appellant:

A person who makes an appeal to a Court or other authorised body with the jurisdiction to hear appeals.

Appellate bodies:

Other Tribunals/Courts with the jurisdiction to hear an appeal from a decision of a lower Tribunal/Court

Appointed Person:

A senior independent intellectual property lawyer appointed to hear appeals from decisions of the IPO. The Appointed Person offers a cost effective alternative to appealing to the courts.

Assignment:

The document used to transfer a trade mark or other intellectual property right from one party to another. Assignment of registered trademarks should be promptly recorded at the IPO.

Bad faith:

Conduct before the IPO or in relation to a trade mark that indicates behaviour or practices that is questionable. It covers obvious conduct like dishonesty but can be more subtle and cover conduct that might be generally considered sharp practice.

Bona fide:

This relates to good faith and implies that in certain dealings with trade marks a party acts without any knowledge or information which is contrary to or undermines their position. i.e. without fraud, collusion or participation in wrongdoing.

Case Management Conference (CMC):

In accordance with rule 62(4) the Tribunal may, at any time, direct that the parties attend a Case Management Conference. This will be conducted by a Hearing Officer and will, as a general rule, result in directions being given in respect of the timetable and future conduct of the proceedings.

Cooling-off period:

A period allowed in opposition proceedings before the Tribunal, within which parties may negotiate a settlement.

Earlier right:

This is a term used to describe a pre-existing right that may form a barrier to subsequent trade mark application.

Earlier trade mark:

This is a term used to describe a pre-existing trade mark which may form a barrier to a subsequent trade mark application. These trademarks may be Domestic, Community trademarks and/or International trade marks.

EEA:

European Economic Area, a free-trade zone created in 1994, composed of the states of the European Union together with Iceland, Norway, and Liechtenstein.

Ex parte:

Refers to administrative proceedings involving only one party, e.g. between the applicant for registration and the Registrar.

Functus Officio:

Describing a person who has discharged his duty and whose office or authority in a particular matter is at an end. Once a judgment has been given, the HO is *functus officio* : he has no power to revisit his decision.

Hearing:

An open attendance before a Hearing Officer at the Tribunal, which is normally open to the public.

Hearing Officer:

A senior official of the Tribunal responsible for conducting hearings and making decisions on proceedings pending before the IPO.

Inter alia:

[*Latin: Among other things*]

Used, primarily, to introduce a non-exhaustive list.

Inter Partes:

[*Between the parties*]

Is used to refer to legal proceedings of an adversarial nature between two or more parties, e.g. in opposition proceedings between the application for registration and the opponent.

Invalidity/invalid:

A decision that a registered trade mark should not have been granted due to grounds that subsisted at the time of the grant of the application. Once declared invalid, such a trade mark will be deemed never to have been registered.

IPO:

The Intellectual Property Office.

Joint hearing:

A hearing, on preliminary matters, prior to the parties being in formal proceedings. (Once parties are in formal proceedings this becomes known as a Procedural Hearing).

Licensee:

The party authorised by the owner to use the trade mark or other intellectual property rights.

Madrid Agreement:

A procedure for obtaining an International registration through WIPO.

Madrid Protocol:

A procedure for obtaining an International Registration through WIPO.

OHIM (sometimes referred to as OAMI):

This is the EU's Office for Harmonisation of the Internal Market and is responsible for the registration of Community trademarks and Community designs.

Opponent:

The party objecting to an applicant's application for a trade mark.

Opposition:

The procedure where a third party may formally object to an application for registration of a trade mark.

Notification date:

The date on which the Tribunal serves proceedings on the other side.

Passing off:

A cause of action that seeks to prevent unregistered trademarks with a sufficient goodwill from being misappropriated by a third party.

Pleadings:

Is an alternative, technical term for statements and counter-statements. Pleadings serve a simple function by identifying the issues between the parties which may later be the subject of evidence.

Prima facie:

[*Latin: On the first appearance.*]

In common parlance the term *prima facie* is used to describe the apparent nature of something upon initial observation.

Preliminary view:

Issued by the Tribunal, to the parties, to indicate its view on a particular matter, for example, refusal of an extension of time or a view that consolidation is appropriate. A period is given for the parties to contest such a decision.

Procedural Hearing:

IA hearing held in respect of preliminary matters between two or more parties which need to be resolved prior to the substantive hearing.

Publication:

All trade mark applications and registrable transactions are published in the Trade Mark Journal.

Quasi-judicial:

Refers to a decision made by an administrative tribunal or government official which resembles a judicial function in that it involves deciding a dispute and ascertaining relevant facts and law.

Register:

The record kept by the IPO of all registered trademarks and registrable transactions.

Register of Trade Mark Attorneys:

The official register of professionals entitled to use the designation trade mark attorney, entry to which is subject to passing rigorous examinations in trade mark law and practice and associated intellectual property rights.

Relative grounds:

Grounds for objecting to a trade mark application or applying for a declaration of invalidity due to the existence of earlier trademarks or rights.

Respondent:

The defending party to an appeal.

Revocation/revoke:

An action to remove a registered trade mark for certain reasons that have arisen since the trade mark was registered and include that it has not been used for a period of 5 years since its registration and that it is misleading or become the common name for the goods or services for which it is registered.

Skeleton argument:

A document prepared by a party (or its legal representative) that sets out the basis of the party's argument. These should always be copied to all other parties to the proceedings and should be filed no later than 14.00 two days prior to the hearing date.

Statutory Declaration:

A document used to provide the evidence of a party in relation to proceedings before the IPO and authenticated before a notary public or other qualified person.

Specification:

Another name for the classification of goods or services covered by a trade mark.

Substantive Hearing:

The main hearing to determine the outcome of proceedings.

Supranational law:

Is a form of international law, based on the limitation of the rights of sovereign nations between one another. Members transcend national boundaries or interests to share in the decision-making and vote on issues pertaining to the wider grouping.

Surrender:

A voluntary step the owner of a registered trade mark may take to either remove his trade mark registration in full or in relation to certain goods or services in the specification. Often occurs when a registered trade mark is threatened with revocation.

Trade Mark Attorney:

A professional intellectual property practitioner specialising in trade mark law and practice who is entered on the Register of Trade Mark Attorneys.

Tribunal:

Refers to the Registrar, Hearing Officers and the Tribunal's other officers.

Unregistered trade mark:

A trade mark which denotes the goods or services of a particular undertaking but is not registered. Such unregistered trademarks may be used to prevent others from using the same or confusing trademarks under passing off.

WIPO:

The World Intellectual Property Organisation based in Geneva which administers the Madrid Protocol and Madrid Agreement for the international registration of trade marks.

Witness Statement:

This is a document used to provide the evidence of a party in relation to proceedings before the IPO. It does not need to be authenticated by a notary public.