

OPPOSING A TRADE MARK IN THE UNITED KINGDOM

Opposition Period

As part of the application process all trade mark applications in the United Kingdom are advertised for opposition purposes in the Trade Mark Journal of the United Kingdom Intellectual Property Office (UKIPO). The Trade Mark Journal is published online on the UKIPO website and appears every Friday, apart from national holidays.

A trade mark application in the United Kingdom is open to opposition for two months from the date of advertisement of the application in the Trade Mark Journal.

The opposition period can be extended by a further one month by filing a so-called 'notice of threatened opposition' by a potential opponent. Thus the maximum period an application can be open to opposition in the United Kingdom is three months minus one day from the actual date of advertisement of the application.

Once the initial extended opposition period has expired, the opposition deadline cannot be extended.

Grounds of Opposition and Filing Counter-statement

To file an opposition, the Opponent must file a so-called Form TM7 detailing the opposition grounds, together with payment of the official opposition fee. The Form TM7 which may include a more formal statement of grounds lists the grounds upon which the opposition is based. The Opponent does not need to file evidence in support of the opposition at this stage of the proceedings.

Oppositions can be based on so-called absolute grounds of opposition, for example the mark concerned is not distinctive or on the basis of relative grounds of opposition, for example the mark concerned conflicts with an existing application or registration or earlier common law rights.

The applicant has two months to file a counter-statement to an opposition. The counter-statement consists of any admissions or denials of any of the grounds of opposition. No evidence has to be submitted with the counter-statement. In relation to trade mark registrations which are used as a ground of opposition and over five years has passed since the date of registration, the applicant can request proof of use that the mark covered by the registration is still in use.

If the counter-statement is not filed, the application is automatically rejected.

Evidence and Proof of Use

Once the counter-statement has been filed and processed, the Opponent usually has two months within which to file evidence in support of the opposition, for example evidence of use to support a ground of opposition based on prior common law rights. In the case of marks with repute, a three month period may be given.

At this time, it is up to the Opponent to submit any proof of use of trade mark registrations, where the applicant has made a proof of use request. If proof of use cannot be submitted for any of the goods and services covered by the registration, it will fail as a ground of opposition. If only partial evidence of use can be submitted, the scope of this ground of opposition will be correspondingly restricted. The deadline for filing evidence can be extended.

Once the Opponent has filed his/her evidence in chief, the applicants will have two months to file their evidence in support of the opposition. The applicant may decide not to file evidence and the deadline for filing evidence can be extended.

If the applicant files evidence, the Opponent will be given one month to file evidence strictly in reply to the applicant's evidence. The deadline for filing evidence in reply can be extended.

Decision and Appeals

Once the evidence rounds are completed, the UKIPO will make a decision on the opposition. A decision can be made on the basis of the papers as filed. In such a situation, each party will be given the opportunity to file written arguments in support of their positions. Alternatively, an oral hearing can take place. An award of costs is usually granted to the winning party, but this is unlikely to cover all the costs of the proceedings.

A decision can be appealed either to the High Court or to the Appointed Person. If a decision is appealed to the Appointed Person, the decision of the Appointed Person cannot be appealed, although a High Court decision can be appealed onto to the Court of Appeal. Appeals to the Appointed Person are generally much cheaper than appeals filed before the courts.

How can HGF help?

We have extensive experience of prosecuting and defending trade mark oppositions. We are more than happy to assume responsibility for trade mark applications which have been opposed and provide cost effective advice.