

**Guidelines Concerning Proceedings Before the
United Kingdom Trade Marks Registry**

Opposition and Invalidation Practices and Procedures

1. Introduction

Absolute and relative grounds objections may be raised in examination, opposition and invalidation proceedings. The purpose of this paper is to provide an overview of the practices and procedures of the opposition and invalidation systems by:

indicating the Sections of the Trade Marks Act 1994 and the Trade Marks Rules 2000 (as amended) which regulate opposition and invalidation proceedings;

detailing the practices and procedures of the Trade Marks Registry Law Section;

setting out the requirements for the filing of documents;

setting out the avenues for appeal against decisions by the Trade Marks Registry;

setting out the relevant sections of the Trade Marks Act and Rules;

a listing of all the official forms.

2. Practice

The management of inter partes actions must be by reference to the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2000 (as amended) taking into account, where appropriate, existing practice as laid down or endorsed by the courts. Decisions in earlier cases are available in various ways including British Reference Library (BLs), Reports of Patent Cases (RPCs), European Trade Mark Reports (ETMRs), Fleet Street Reports (FSRs), Tribunal Practice Notices (TPNs) and Practice Directions & Law Practice Directions (PDN/LPDs).

The Registrar's decisions, also those of the Appointed Persons, and TPNs and PDN/LPDs are all reproduced on the Patent Office web site.

3 Procedures before the Registrar

3.1 Opposition

Relevant legislation (see Annex A)

Section 38 of the Trade Marks Act 1994

Rule 13 of the Trade Marks Rules 2000 (as amended)

Once an application for registration has been examined and accepted by the Registry, it is published in the Trade Marks Journal for the purpose of opposition. It is possible to oppose an application in respect of only some of the goods or services for which the trade mark is to be registered. Under the current legislation anyone can oppose an application, there is no

need to show commercial interest. Generally, oppositions are based on section 3 and/or section 5 of the Act which set out absolute and relative grounds for refusal of registration. Section 3 relates to absolute grounds, that is, something inherent in the mark itself which renders it unsuitable to be registered. Section 5 relates to relative grounds, that is, where registration of the trade mark would impinge upon another persons rights. Once an application is opposed, the role of the Registrar changes from administrative to that of a tribunal, acting in a quasi-judicial capacity.

Opposition proceedings can only be initiated before the Registrar and cannot be taken to the court. If the opposition succeeds the trade mark will be refused, if it fails the trade mark will be registered.

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

- a. Applications amended after publication (Rule 18(2)) (This applies to cases originally filed under the 1938 Trade Marks Act as well as the 1994 Trade Marks Act)
- b. Regulations for collective/certification marks applied for under the 1994 Trade Marks Act (Paragraph 8 schedule 1, Paragraph 9 schedule 2)
- c. Amendment of regulations of collective/certification marks (Rule 23(4))
- d. Amendments to registered marks (Rule 25(3))
- e. Removal of matter from the register (Rule 45(2))
- f. Reclassification of marks from schedule iii to schedule iv (Rule 47(1))

Any person who wishes to lodge opposition against any of the above should file Notice of Opposition on Form TM7 with the appropriate fee within the period allowed. For “b” “c” “d” “e ” and “f” above, and to oppose the registration of a trade mark, the period for lodging opposition is three months. For “a” above, the period is one month.

No extension of the opposition period is allowed for lodging opposition under Rules 13(1), 23(4), 25(3) and 47(1).

Under section 60 of the Act there are special provisions relating to opposition procedures where an agent or representative of a proprietor makes an application for, or is granted a registration of, the legitimate proprietor’s trade mark but in their own name. These provisions are to safeguard the rights of the proprietor and give them an avenue to remove the trade mark from the register. (It is also possible to have the registration rectified into the correct name).

3.1.1 Notice of Opposition

Notice of opposition must be filed at the registry on Form TM7 which will 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, the following must also be included:

a representation of that trade mark;

where the mark is registered and constitutes an earlier trade mark as defined in section 6(1)(a) and 6(1)(b); i.e. a registered trade mark, an international trade mark (UK) or a Community trade mark which has a date of application or seniority earlier than that of the application in question taking into account priority dates

the registry in which the mark is registered;

the registration number of the mark;

the classes in respect of which the earlier mark is registered;

the goods and services for which that mark is registered;

the statement of use, where necessary (see 3.1.6 below) the opponent will be required to state on what goods and services the mark has been used during the relevant period or detail the reasons for non-use during the relevant period;

where the mark is not registered the goods and services in respect of which it is used.

The notice of opposition, incorporating the statement of grounds, with fee and any other documents as above must be filed within 3 months from the date of the publication of the application. This period cannot be extended.

On receipt of the notice of opposition and other documents the Registry will scrutinise the statement of grounds and pleadings. The registry will, prior to formal serving of the documents, use appropriate powers to require a party to further explain its pleadings. If in the view of the registry, a particular ground of opposition is plainly unsustainable, objection may be raised. It is important to note, that the registry does not prejudge matters of substance, which should properly be decided once all the evidence and submissions have been made. Nor will the registry force parties to incur unnecessary cost at an early stage of the proceedings. There will be circumstances where the registry will step back and allow matters to continue, but serve notice that it would expect evidence later filed to support a particular claim or there may be a penalty in costs.

3.1.2 Serving the Notice and the Counter-statement

It is the responsibility of the Registry to send the TM7 with the statement of grounds and other documents to the applicants at their last recorded address for service. The date on which these are sent is known as the “notification date”.

The applicant has three months from the “notification date” to file a notice on Form TM8 (no fee required) which incorporates a counter-statement, the purpose of which is to admit, deny with explanation or require proof of any of the grounds set out by the opponent in his statement. The period for filing the Form TM8 cannot be extended. If no Form TM8 is filed and there is no request for a “cooling off” period (see 3.1.3 below) within this three month period, the applicant is deemed to have withdrawn his application for registration.

The Registry will send the Form TM8 incorporating the counter-statement to the opponent at their last recorded address for service, but this does not automatically trigger the evidential rounds. The registry will notify the parties of the “initiation date” which will be the date of commencement of the evidential rounds.

3.1.3 The Cooling Off Period

If the parties wish to take advantage of a *further* period of nine months to negotiate a settlement and avoid the need to prepare and file evidence, a request can be made on Form TM9C (by either party) to extend the period for filing the counterstatement. The form must be filed before expiry of the three month period for filing the counterstatement.

The three month period for filing the counterstatement or Form TM9C is non-extendible. If neither Form TM8 nor Form TM9C is filed within this three month period the applicant is deemed to have withdrawn his application for registration.

Both the applicant and opposing party(ies) must agree to the cooling off period.

Taking advantage of the cooling off period will give the parties twelve months, once proceedings have started, to negotiate towards a settlement. Failure to resolve matters in this period does not fetter settlement negotiations which may continue in parallel to the proceedings.

If the parties are unable to reach an agreement within this period of twelve months the applicant must file Form TM8 incorporating a counter-statement before the expiry of the cooling off period. The period cannot be extended. If the notice and counter-statement are not filed the applicant is deemed to have withdrawn his application.

3.1.4 Early Termination of the Cooling Off Period

If 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.

In the event that negotiations are terminated early the opponent should file form TM9T, copied to the other party, to notify the registry of that fact. The parties will be notified by facsimile transmission that the form TM9T has been filed and confirming the date by which the form TM8 must be filed by the applicant.

The applicant has a period of one month from the date of filing of form TM9T within which to file Form TM8 incorporating a counter-statement to clearly indicate that they also wish to continue the proceedings and are prepared to defend their application.

In the event that the applicant wishes to terminate the “cooling off” period early then they should file Form TM8 incorporating a counter-statement to clearly indicate that they also wish to continue the proceedings and are prepared to defend their application.

3.1.5 Preliminary indication

Where the basis of the opposition includes a ground based upon section 5(1) and/or 5(2) of the Act a Principal Hearing Officer will issue a preliminary indication, even if this is not the sole basis for the opposition, and the date of issue will be the “indication date”.

However, if the Principal Hearing Officer regards it as inappropriate to issue a preliminary indication then the parties will be notified and an “initiation date” set for the evidence rounds to commence.

In proceedings where neither section 5(1) nor section 5(2) form the basis for the opposition then no preliminary indication will be issued.

Section 5(1) concerns mandatory refusal where the trade marks and goods and/or services are identical. Section 5(2) involves a comparison between the earlier registered right(s) and the application to determine whether, because of the identity or similarity of the trade marks and goods and/or services, there is a likelihood of confusion. These issues can be judged on a prima facie basis taking into account the criteria identified in case law as relating to these sections of the Act.

In cases where the parties accept the preliminary indication expressed by the Principal Hearing Officer, where the indication is for either complete acceptance or complete refusal of the application, then the proceedings will be closed. The application will either proceed to registration or be refused. In this circumstance the preliminary indication will be regarded as the final decision. In the event that the preliminary indication is accepted by the parties there is no subsequent right to appeal under section 76 of the Act.

If either party does not wish to accept the preliminary indication they have the right to formally give notice to that effect and the proceedings will move into the evidence rounds and to a final decision. The parties have a period of one month from the indication date to file form TM53 to give notice of their intention to proceed. Failure to file this notice within the time period of one month implies that the parties are in agreement with the preliminary indication.

Where the preliminary indication states that the application should be registered for only some of the goods and/or services for which it was applied then both parties have a period of one month from the indication date to file form TM53 to give notice of their intention to proceed.

If no Form TM53 is filed by either party, how much, if any, of the application will proceed to registration will depend upon how much of the specification(s) was originally opposed on the Form TM7 and how much of the contested specification was liable to be refused according to the preliminary indication.

The application will proceed to registration to the extent that straightforward deletion of goods/services overcomes the objection. If a combination of partial attack and partial success exists, those goods which can be deleted simply will be removed and the application allowed to proceed to registration.

3.1.6 Proof of Use

On the Form TM7, where applicable, for certain earlier rights claimed as the basis for the action a statement of use is required. It is recognized that there will be occasions when the party filing the Form TM7 may not have the detail required to complete this statement fully. In these circumstances a neutral statement can be entered, e.g. “To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”, and the issue will be raised when the pleadings are examined. The party will then have an additional period of time within which to ascertain exactly those goods and/or services upon which the trade mark has been used and to file an amended Form TM7.

If evidence of use is required then this is **not** filed immediately but filed with the opponent’s first evidence round, the evidence in chief (see 3.1.7 below).

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 has established an obligation, when called upon in civil proceedings, for the registered proprietor of a trade mark to show that it is using its mark in a genuine manner. The reason for this is that only the position in the market place actually held by the trade mark should be protected, not merely a registered right that is not supported by any actual or potential goodwill. Thus on the Form TM7 there is a section for the opponent, basing their action on rights registered for more than five years, to state on which goods and/or services their trade mark is used or, in the alternative, the reasons for non-use of the mark.

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. This five year period was established under Article 10(1) of the Directive.

Article 10 Use of trade marks

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.

The period of five years during which proof of use must be shown for the earlier trade mark is the five years prior to 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.

The registry does not inquire of its own volition as to whether the earlier trade mark has been used or not.

On the counterstatement the applicant must either deny, require proof of or admit the opponents statement of use. If the applicant denies, requires proof of or does not admit the opponents statement of use this will be taken as a requirement for the opponent to file evidence of use or evidence validating the reasons for non-use.

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

Evidence of use should be filed as a witness statement, statutory declaration or affidavit separate from the evidence relating to the opposition proceedings in general. This is to ensure that parties to the proceedings and the Trade Marks Registry can clearly identify this evidence. Additionally, where more than one trade mark is relied upon and for which evidence of use is required, each trade mark should have a separate witness statement, statutory declaration or affidavit to clearly demonstrate the evidence of use supporting that trade mark.

If the opponents trade mark is defended by the filing of evidence of use or reasons for non-use the registry will take a prima facie view on the question of whether the evidence submitted is, in fact, evidence of use or a valid reason for non-use. Likewise an applicant may argue that the evidence is insufficient and seek summary judgment.

If the evidence submitted only shows use of the opponents trade mark on a limited range of goods and services then this more limited range of goods and services will be those used for the comparison of goods and services when deciding the case, rather than the entire registered specification.

3.1.7 Evidential rounds

If no preliminary indication is to be issued then the date of sending the TM8 to the opponent will be the initiation date.

If a preliminary indication is issued and a form TM53, request to proceed to evidence rounds in opposition proceedings, is filed by either party to the proceedings then the date on which the parties are notified becomes the initiation date.

Every time a party to the proceedings files evidence they must do so under cover of form TM54, notice of filing evidence. This covers all the evidence filed at that time and can therefore cover more than one witness statement, statutory declaration or affidavit. If evidence is filed in more than one batch then each must be accompanied by a form TM54.

The opponent has three months from the initiation date within which to file evidence in support of his grounds of opposition and evidence of use, if required. The evidence must be copied by the opponents to the applicants.

If no evidence is filed, the opponent will be deemed to have withdrawn their opposition unless the Registrar otherwise directs upon application by the opponent. Where an opponent does not file evidence in support of his opposition the Registrar has a discretionary power to allow the proceedings to continue, rather than deem the opposition abandoned.

The Registrar will generally allow the proceedings to continue if the opponent:

- a. has based at least part of his opposition on an existing registration (Section 5 of the 1994 Act) and
- b. states that he intends to rely on submission at a hearing.

Experience has shown that the Registrar's practice in such cases does not cover situations in which the opponent later changes his mind as to the subsequent conduct of proceedings. In order to reduce the risk of unnecessary expense and waste of time, the Registrar will ask for a full statement of an opponent's intentions in the matter of the conduct of his opposition, before taking a decision on continuation of the proceedings and issuing a direction, under Rule 13C of the Trade Marks Rules 2000 (as amended). He will also consider making his decision provisional, conditional upon the opponent's compliance with the procedure agreed. Subsequently, if a hearing is not sought by the opponents, or if the agreed procedure is not complied with, the opposition may be deemed abandoned as at the original date for the filing of evidence. The applicants, however, will be free to seek an appropriate award of costs, in the usual way.

The period for filing evidence can be extended by exercise of the Registrars discretion, subject to filing Form TM9 and fee and setting out detailed reasons for the extension. A copy of Form TM9 must be sent to the applicant by the opponent and a failure to do so will result in the request not being considered. An indication that the request has been copied should be given on the Form TM9 or accompanying documents.

A request to extend the period for filing evidence should be made on Form TM9 before the period expires, but it is possible to make the request to extend the evidence period on Form TM9 **after** expiry. The Registrar will, however, need to be satisfied with the reasons for the delay as well as that it is just and equitable to extend the period for making the request.

Within three months from the date on which the opponents evidence is received in the registry, or a direction is made by the Registrar that the opposition may continue without evidence from the opponent, the applicant may file any evidence he sees fit and must copy it to the opponent. The same conditions in relation to an extension of time apply as above.

If the applicant files no evidence then the case is in order to be heard. If the applicant files evidence, the opponent may file evidence in reply to the applicants evidence which must be confined strictly to matters in reply. A period of three months from the date on which the applicants evidence is received in the registry will be allowed for the filing of evidence in reply. The opponent must send a copy to the applicant. The same conditions in relation to an extension of time apply as above.

No further evidence can be filed except by leave of the Registrar and on such terms as she thinks fit.

3.1.8 Decision

Following the completion of the final round of evidence the parties will have a choice as to how the final decision should be reached by the hearing officer.

A decision can be made from the evidence and any written submissions made by the parties. This is referred to as a “decision from the papers” and it will involve a thorough analysis of all the evidence and full consideration of any submissions made by the parties. The parties may still request an oral hearing however, a decision from the papers is usually quicker and less costly for the parties.

3.1.9 Application to withdraw or amend the application

In accordance with section 39, an applicant may apply at any time to withdraw his application or restrict the goods or services covered by the application. Such an application should be made under rule 17 on Form TM21 and is subject to advertisement for opposition (see rule 18). The Registry will also enquire of the opponents whether any restriction offered disposes of the opposition.

4. Procedures before the Registrar

4.1 Declaration of Invalidity

Relevant legislation (see Annex A)

Section 47 and 48 of the Trade Marks Act 1994

Rule 33 of the Trade Marks Rules 2000(as amended)

After the trade mark has been registered it is possible to remove or limit the registration by means of invalidation.

The provision allows an applicant to assert that a trade mark is invalid on any of the grounds (absolute or relative) specified in the section.

Absolute grounds is an assertion by the applicant for invalidation that for a specified reason, within their statement of case and within the terms of Section 3 of the Act, the registered trade mark cannot fulfil the role and function of a trade mark.

Relative grounds is an assertion by the applicant for invalidation that under the terms of Section 5 of the Act there exists an earlier right that would have barred the registration of the trade mark in suit.

Any person can apply for such a declaration and such an application can be made at any time after registration.

The procedure of invalidation can with certain provisos, be initiated either before the Registrar or before the court.

If the basis for the claim is relative grounds the proprietor may have a defence of acquiescence (under section 48) if the owner of the earlier right has acquiesced in the use of the registered trade mark for a continuous period of 5 years. Section 48 of the Act makes it clear that the owner of the earlier right must be aware of the use of the trade mark in suit and that the defence can only be relied upon if the trade mark in suit was not applied for in bad faith.

Under section 60 of the Act there are special provisions relating to invalidation procedures where an agent or representative of a proprietor makes an application for, or is granted a registration of, the legitimate proprietor's trade mark but in their own name. These provisions are to safeguard the rights of the proprietor and give them an avenue to remove the trade mark from the register. (It is also possible to have the registration rectified into the correct name).

If a trade mark is declared invalid (for all or some of the goods or services specified) the entire registration is deemed never to have been made.

4.1.1. Application for Declaration of Invalidity

An application for a declaration of invalidity to the Registrar shall be made on Form 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 trade mark, the following must also be included:

a representation of that trade mark;

where the mark is registered -

the registry in which the mark is registered;

the registration number of the mark

the classes in respect of which the earlier mark is registered;

the goods and services for which that mark is registered;

the statement of use, where necessary (see 4.1.3 below) the opponent will be required to state on what goods and services the mark has been used during the relevant period or detail the reasons for non-use during the relevant period;

where the mark is not registered the goods and services in respect of which it is used.

4.1.2 Serving the Application and the Counter-statement

Once the Registry has accepted the application and statement, it will send the documents to the proprietor who is given six weeks from the date of sending in which to file a Form TM8, incorporating a counter-statement.

The period for filing the documents above cannot be extended, and if the documents are not received within the period the Registrar may treat the opposition to the application as withdrawn. The case of *Firetrace* [2002] RPC 15 is an example where the registered proprietor was allowed to defend their registration, even though the TM8 and counterstatement were out of time. On the facts, the proprietors had clearly always intended to defend their mark but they were hindered by circumstances outside their control. The case also makes clear that default decisions, declaring the registration invalid where there is no defence, should not automatically follow: an applicant would be required to make out a prima facie case at the least. This is because a statutory presumption of validity exists.

Section 72 reads:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

4.1.3 Proof of use

On the Form TM26(I), where applicable, for certain earlier rights claimed as the basis for the action a statement of use is required. A neutral statement, e.g. “To the best of my knowledge the trade mark has been used on all the goods and/or services for which it is registered”, **cannot** be entered. The applicant has had time to prepare their case and should have this information ready before preparing and filing the Form TM26(I) to commence the proceedings.

If evidence of use is required then this is **not** filed immediately but filed with the applicant’s first evidence round, the evidence in chief (see 4.1.4 below).

UK Trade Mark legislation places an obligation on the applicant, the owner of a registered trade mark used as a basis for the action, to show that it is using its trade mark in a genuine manner where the basis for the invalidity action is Section 5 of the Act. This is because the registered proprietor of the trade mark is best placed to show what use they have made of the trade mark.

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 prima facie valid for all the goods and/or services for which it is registered.

The period of five years during which proof must be shown for the earlier right is the five years prior to the application for invalidity being filed.

The registry does not inquire of its own volition as to whether the earlier trade mark has been used or not.

On the counterstatement the registered proprietor must either deny, require proof of or admit the applicant’s statement of use. If the registered proprietor denies, requires proof of or does not admit the applicant’s statement of use this will be taken as a requirement for the applicant to file evidence of use or evidence validating the reasons for non-use.

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

If the applicant’s trade mark is defended by the filing of evidence of proof of use or reasons for non-use the registry will take a prima facie view on the question of whether the evidence submitted is, in fact, evidence of use or a valid reason for non-use. Likewise a registered proprietor may argue that the evidence is insufficient and seek summary judgment.

If the evidence submitted only shows use of the applicant's trade mark on a limited range of goods and services then this more limited range of goods and services will be those used for the comparison of goods and services when deciding the case, rather than the entire registered specification.

4.1.4 Evidential rounds

The Registry will send the Form TM8 incorporating the counter-statement to the applicant who is given six weeks from the date they are sent in which to file evidence in support of his case and evidence of use, if required. The evidence must be copied by the applicant to the proprietor. If no evidence is filed, the applicant will be deemed to have withdrawn their application unless the Registrar otherwise directs.

Every time a party to the proceedings files evidence they must do so under cover of form TM54, notice of filing evidence. This covers all the evidence filed at that time and can therefore cover more than one witness statement, statutory declaration or affidavit. If evidence is filed in more than one batch then each must be accompanied by a form TM54.

The period for filing evidence can be extended by exercise of the Registrar's discretion, subject to filing Form TM9 and fee and setting out detailed reasons for the extension. A copy of Form TM9 must be sent by the applicant to the registered proprietor and a failure to do so will result in the request not being considered. An indication that the request has been copied should be given on the Form TM9 or accompanying documents.

Within six weeks from the date that the evidence is received in the registry, or a direction is made by the Registrar that the proceedings may continue without evidence from the applicant, the proprietor may file evidence to support his counter-statement. The proprietor shall copy any evidence to the applicants. The same conditions in relation to an extension of time apply.

If the proprietor files evidence then, within six weeks from the date on which that is received in the registry, the applicant may file evidence in reply to the proprietor's evidence which must be confined strictly to matters in reply. The applicant must send a copy to the proprietor. The same conditions in relation to an extension of time apply.

No further evidence can be filed except by leave of the Registrar, and on such terms as she thinks fit.

4.1.5 Decision

Following the completion of the final round of evidence the parties will have a choice as to how the final decision should be reached by the hearing officer.

A decision can be made from the evidence and any written submissions made by the parties. This is referred to as a "decision from the papers" and it will involve a thorough analysis of all the evidence and full consideration of any submissions made by the parties. The parties may still request an oral hearing; however, a decision from the papers is usually quicker and less costly for the parties.

5. International Registrations

5.1 UK legislation governing International Registrations

The detailed rules governing international registrations are covered by *both* the Trade Marks Rules and a Statutory Order, The Trade Marks (International Registration) Order 1996 (the Order) and subsequent amendments. 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 registry, in its inter partes proceedings, handles these cases.

5.1.1 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 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.

5.1.2 Opposition to an International Registration

This is covered by Article 10 of the Order, which says that notice of opposition must be given in the same way as a national application, within 3 months of publication in the UK Journal, and as provided for in rule 13. Within 4 months from the date of publication the Registry must send a notice of refusal to the International Bureau.

It is the International Bureaus responsibility to send the notice of opposition to the holder of the international registration for the purpose of inviting a counterstatement.

Under the Order, the holder has 3 months from the date that the notice of refusal is sent to the International Bureau in which to file a Form TM8 and counterstatement, as under rule 13 of the Trade Marks Rules, together with an address for service in the UK. The consequence of failure to file an address for service in the UK is set out in rule 10 of the Trade Marks Rules. The provisions under the Order, which to some extent are governed by the Common Regulations, have necessitated adaptations in Registry practice as between international registrations and domestic applications.

The Registry will, separately and directly, notify the holder of the international registration that an opposition has been filed as soon as possible following receipt of the notice of opposition. Also, the Registry will not examine the pleadings until both the statement and counterstatement have been received.

Once the counterstatement is filed and scrutiny of the pleadings has been completed by the Registry the remaining stages of the proceedings are as governed by rule 13.

5.1.3 Revocation or Declaration of Invalidity of an International Registration

These proceedings are covered by Article 13 of the Order which adapts provisions in the Act itself to international registrations protected in the UK. The Order also says that rules 31 to 31B, 32 to 32B, 33 to 33B, 35, 36 and 37 shall apply, with necessary modifications, to the procedure for applying for declarations of invalidity or revocation. To date the Registry has not considered that necessary modifications have been required.

6. Cost implications of legal actions

Any action taken as a consequence of opposition or invalidation proceedings is liable for costs. This can cover the cost of legal advice, for compilation of evidence, for research and investigation, for letters and for representation at hearings. If such actions are appealed then further costs will be incurred.

At the termination of proceedings a costs award is likely to be made against the losing party in the proceedings but this is unlikely to reimburse the total cost of the proceedings to the other parties as the award will be made from a scale of costs which is regarded as contributory rather than compensatory. This is in line with the policy objective that no one should be deterred from seeking protection for their intellectual property rights, or defending them.

7. Appeals

All decisions by the Registrar can be appealed, section 76 of the Act, and there are two avenues of appeal, either to the Appointed Person or to the courts. The Appointed Person is normally a senior barrister or solicitor, experienced in intellectual property law, selected by the Lord Chancellor under section 77 of the Trade Marks Act and acts as an appellate tribunal. Whilst this route of appeal is normally quicker, and less costly, there is no further right of appeal.

If the parties appeal to the court then the full range of the legal process is open to them, including appeal to the House of Lords and even, when the issues relate to the underlying European Union Directive, that is First Council Directive 89/104 of December 21, 1988 to approximate the laws of the Member States relating to trade marks (the Directive) (the basis for the Trade Marks Act 1994), to the European Courts.

Annex A

Introductory

Section 1. - (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see section 49) or certification mark (see section 50).

Grounds for refusal of registration

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

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

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

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

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

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

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

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

Section 4. - (1) A trade mark which consists of or contains -

- (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them, or it,
- (b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of-

(a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man, shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in - section 57 (national emblems, &c. of Convention countries), or section 58 (emblems, &c. of certain international organisations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains -

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or

(b) insignia so nearly resembling such arms as to be likely to be mistaken for them, unless it appears to the registrar that consent has been given by or on behalf of that person.

Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to the laws of arms.

(5)* A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995 shall not be registered unless it appears to the registrar -

(a) that the application is made by the person for the time being appointed under Section 1(2) of the Olympic Symbol etc (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics Association Right), or

(b) that consent has been given by or on behalf of the person mentioned in paragraph

(a) above.

** Note: This subsection is an addition to the original Act, by virtue of Section 13 of the Olympic Symbol etc (Protection) Act 1995 which came into force 21st September 1995.*

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

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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

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

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

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

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

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

Section 6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after

the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

Section 6A * Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects -

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).

** Note: This section is an addition to the original Act, by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force 5th May 2004.*

Section 38.-(1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

Rule 13. – (1) Any person may, within three months of the date on which the application was published, give notice to the registrar of opposition to the registration on Form TM7 which shall include a statement of grounds of opposition.

(2) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and –

(a) the details of the authority with which the mark is registered;

(b) the registration number of that mark;

(c) the classes in respect of which that mark is registered;

(d) the goods and services in respect of which –

(i) that mark is registered; and

(ii) the opposition is based; and

(e) where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use (for the purposes of rule 13C this is the “statement of use”).

(3) Where the opposition is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of grounds of opposition a representation of that mark and those matters set out in paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.

(4) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is done shall, for the purposes of rule 13A, be the “notification date”.

Section 47. –(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground –

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that –

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

Section 48. – (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right –

- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

Rule 33. – (1) An application to the registrar for a declaration of invalidity under section 47 shall be made on Form TM26(I) and be accompanied by a statement of the grounds on which the application is made.

(2) Where the application is based on a trade mark which has been registered, there shall be included in the statement of the grounds on which the application is made a representation of that mark and –

(a) the details of the authority with which the mark is registered;

(b) the registration number of that mark;

(c) the classes in respect of which that mark is registered;

(d) the goods and services in respect of which –

(i) that mark is registered; and

(ii) the application is based; and

(e) where neither section 47(2A)(a) nor (b) applies to the mark, a statement detailing during the period referred to in section 47(2B)(a) it has been put to genuine use in relation to each of the goods and services in respect of which the application is based or whether there are proper reasons for non-use (for the purposes of rule 33A this is the “statement of use”).

(3) Where the application is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds on which the application is made a representation of that mark and those matters set out in paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.

(4) Where the application is based on an unregistered trade mark or other sign which the applicant claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds on which the application is made a representation of that mark or sign and the goods and services in respect of which such protection is claimed.

(5) The registrar shall send a copy of Form TM26(I) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within six weeks of the date on which he was sent a copy of Form TM26(I) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat him as not opposing the application.

(7) The registrar shall send a copy of Form TM8 to the applicant and the date upon which this is sent shall, for the purposes of rule 33A, be the “initiation date”.

Annex B

TM7 Notice of opposition and statement of grounds

TM8 Notice of defence and counterstatement

TM9 Request for an extension of time

TM9c Request for cooling off period

TM9t Request to terminate a cooling off period

TM21 Change of proprietor’s name or address or other changes to an application

TM26(1) Application to declare invalid a registration or a protected international trade mark

TM53 Request to proceed to evidence rounds

TM54 Notice of giving evidence