

## Overview of the UK Trade Mark Opposition Process

This guide sets out the key steps in the UK trade mark opposition process and how Ionic Legal can help you throughout. Similar procedures are available in other jurisdictions, and we have many years of experience in assisting clients in this regard through our network of correspondent law firms.

### Step 1: Discovering a conflicting mark

Where the Registry believes a new UK trade mark application conflicts with an existing trade mark application or registration, it will notify both the applicant and the earlier rights holder before the applicant's mark is advertised in the Trade Marks Journal. The applicant will then have an opportunity to consider if it wishes to continue with the application.

As mentioned above, it is advisable to have a watch notice in place to inform you of such applications rather than relying on the UK Intellectual Property Office's service.

### Step 2: Considering whether to take action

Before taking action, it is advisable to review the strength of the opposition and if there are any potential counterclaims which can be made.

In some cases, it may not be necessary to take action, for example if the goods and services covered by the new application are completely different to the goods and services to which your trade mark relates.

Another relevant point is that, if you wish to oppose an application and your registered trade mark has been registered for over five years old on the date of the application, you must confirm use of your trade mark when filing the opposition. During proceedings, the applicant can request evidence of use, and, if you have not used the trade mark within the past five years, it will be vulnerable to cancellation. If you have not used your mark, it will therefore be very difficult to rely on it, and you are unlikely to be able to prevent the new application from being registered.

Finally, if you registered your earlier trade mark right with no intention to use, or your trade mark specification covers a broad range of goods and services which you had no intention to offer, you may face a counterclaim that your trade mark was filed in "bad faith". Ionic Legal will advise you on whether or not to bring opposition proceedings in light of all relevant considerations. Before filing an opposition, it is advisable to send a letter before action to the applicant to try to resolve the matter. In most cases, it is possible to resolve a dispute without launching a full-blown opposition.

### Step 3: Filing opposition proceedings

You will have two months from the date of the trade mark being advertised to file opposition proceedings. If necessary, this period can be extended by a month by filing a notice of threatened opposition. Note that filing a notice of threatened opposition does not commit you to filing an opposition. Ionic Legal will keep track of these deadlines and file a notice of threatened opposition if necessary.

An opposition can be filed on absolute and/or relative grounds, but while anyone can file an opposition on the basis of absolute grounds (i.e. the mark cannot function as a trade mark), only the owner of an existing trade mark can file an opposition on the basis of relative grounds (i.e. an earlier registered or unregistered trade mark). The opposition can relate to all the goods and services covered by the application, or only some of them. We will advise you on the best approach before drafting and submitting the notice of opposition and statement of grounds on your behalf.

### Step 4: What happens next?

Once opposition proceedings have been brought, the trade mark application cannot proceed to registration until the opposition is either defeated or withdrawn. After you have filed the notice of opposition and statement of grounds, the applicant will have the opportunity to file a defence and counterstatement. If the defence is not filed, the opposition will succeed. If the defence is filed, both parties can then file one or more rounds of evidence in the form of witness statements and legal submissions. Once the evidence rounds are complete, the parties will file final submissions in support of their positions or can request a hearing. We assist throughout by reporting and advising upon the third party's submissions and making submissions on your behalf.

One alternative option is for the parties to agree a 'cooling-off' period, which suspends proceedings to allow for negotiation of an amicable resolution. Such a request must be filed during the two-month period the applicant is given to file a defence to the proceedings. The cooling-off period lasts nine months, extendable by a further nine months at the parties' request. Ionic Legal can assist with filing the request for a cooling-off period and undertake negotiations on your behalf during this period.

### Step 5: Decision and appeal

If the proceedings are not resolved amicably, there will be either a decision on the papers or a hearing, although hearings are rarer and more expensive. A decision will then usually be issued around two months from close of proceedings. Costs are awarded against the unsuccessful party, but they will likely not cover the cost of bringing proceedings.

The entire process generally takes up to a year from commencement to a final decision if there are no extensions granted. Should you wish to appeal, there are two options:

- a) appeal to the Appointed Person – this decision cannot be appealed further; or
- b) appeal to the High Court – this decision can be appealed to the Court of Appeal and beyond.

Each option has benefits and drawbacks, and Ionic Legal can advise you on the best approach.