

CONTENTS

Contentious Trade Mark Registry Proceedings Second Edition

*Michael Edenborough KC, Thomas Elias,
Adrian de Froment and Stephanie Wickenden*

FOREWARD TO THE SECOND EDITON	v
PREFACE TO THE SECOND EDITION	vi
CONTENTS	ix
TABLES OF CASES	
TABLES OF LEGISLATION	
TABLES OF TM FORMS and TPNs	

1. Introduction and General Matters

1.0	Introduction	1
1.1	Adversarial vs inquisitorial approach	4
1.2	The registrar and the registry	11
1.3	Governing provisions	16
1.3.1	UK legislation	16
1.3.2	EU legislation	20
1.3.3	Other UK and EU material	25
1.3.4	International instruments	26
1.4	Trade mark tribunals and courts	26
1.5	Judgments and decisions	31
1.6	Binding and persuasive precedent	32
1.6.1	Domestic decisions and judgments	32
1.6.2	Judgments of the Court of Justice and the General Court	37
1.6.3	The precedential status of judgments of the General Court	38
1.6.4	Decisions of the registrar and Appointed Person	42
1.6.5	Decisions of the EUIPO	43
1.6.6	Decisions and judgments of foreign tribunals and courts	43

1.7	Representation	44
	1.7.1 Professional representation.....	44
	1.7.2 Non-professional representation	46
1.8	Legal professional privilege	52
1.9	Numbering and type of marks.....	55
1.10	Latin terms.....	58

2. Statements of Case – Generalities

2.0	Introduction	61
2.1	Guiding principles	63
	2.1.1 The purpose of a statement of case	63
	2.1.2 General drafting principles	64
2.2	The principal TM forms.....	71
2.3	Statement of grounds	75
	2.3.1 General approach	75
	2.3.2 Headings	78
	2.3.3 Substance	81
2.4	Counter-statement.....	85
	2.4.1 Admissions.....	86
	2.4.2 Non-admissions.....	88
	2.4.3 Denials	90
	2.4.4 Advancing the respondent’s case	91
2.5	Response to a counter-statement.....	93

3. Statements of Case – Specifics

3.0	Introduction	95
3.1	Oppositions: general considerations.....	96
	3.1.1 Cooling-off period.....	102
3.2	Oppositions: absolute grounds	104
	3.2.1 Section 3(1)(a).....	104
	3.2.2 Sections 3(1)(b), (c) and (d).....	108
	3.2.3 The proviso to section 3(1).....	111
	3.2.4 Section 3(2)	112
	3.2.5 Section 3(3)	114
	3.2.6 Sections 3(4), (4A), (4B), (4C) and (4D).....	116
	3.2.7 Section 3(5)	118
	3.2.8 Section 3(6)	121
3.3	Oppositions: relative grounds.....	124
	3.3.1 Section 5(1)	133
	3.3.2 Section 5(2)	134

3.3.3	Section 5(3)	141
3.3.4	Sections 5(4), 5(4A) and 5(4B)	144
3.3.5	Section 5(6)	149
3.3.6	Well-known marks.....	149
3.3.7	Proof-of-use	150
3.3.8	Honest concurrent use.....	152
3.4	Revocation	153
3.4.1	Non-use	153
3.4.2	Other grounds.....	163
3.5	Invalidation.....	164
3.6	Rectification.....	167
3.7	Miscellaneous matters.....	171

4. Evidence

4.0	Introduction	173
4.1	Burden and standard of proof.....	178
4.1.1	Challenging evidence	181
4.2	Presentation of the evidence	185
4.2.1	Witness statements.....	187
4.2.2	Statutory declarations, affidavits and affirmations	191
4.2.3	Substantive content	192
4.2.4	Exhibits	196
4.2.5	Perjury and contempt	202
4.3	Evidence rounds.....	204
4.4	Direct factual evidence	207
4.5	Hearsay evidence	210
4.6	Opinion evidence.....	212
4.6.1	Expert opinion evidence.....	213
4.6.2	Difference between opinion evidence and evidence of fact.....	216
4.6.3	An expert's duties.....	220
4.7	Survey evidence.....	221
4.8	Similar fact evidence.....	227
4.9	Presumptions.....	230
4.10	Judicial notice	233
4.11	Proportionality of evidence	237
4.12	Correcting errors	239
4.13	Useless and inadmissible evidence	240

5. Applications

5.0	Introduction	246
5.1	Interim vs final decisions	249
5.2	Procedural hearings and case management conferences	250
5.3	Extension of time	253
5.3.1	Calculating time periods	255
5.3.2	Applications for an extension of time	258
5.4	Consolidation and separation of proceedings	259
5.5	Stays	263
5.5.1	Settlement proceedings.....	266
5.6	Change of parties	268
5.7	Intervention	270
5.8	Amendment.....	271
5.9	Applications relating to evidence	276
5.9.1	Confidential material	278
5.10	Disclosure and further information	282
5.10.1	Information on the register	285
5.11	Live examination of a witness	287
5.12	Security for costs.....	289
5.13	Striking out parts of statements of case	291
5.14	Correction of irregularities.....	298
5.15	Objection to an Appointed Person acting as an advocate	299
5.16	Recusal.....	302

6. Hearings

6.0	Introduction	307
6.1	Preliminaries	310
6.1.1	Indices	313
6.1.2	Authorities.....	314
6.1.3	Bundles	318
6.2	Format of hearings.....	320
6.2.1	Hearings open to the public.....	322
6.2.2	Terms of address	323
6.2.3	Remote and in-person hearings	328
6.3	Written submissions and skeleton arguments.....	334
6.4	Oral evidence.....	341
6.4.1	Examination-in-chief.....	343
6.4.2	Cross-examination	346
6.4.3	Re-examination	352
6.4.4	Hostile witness.....	353
6.4.5	Interventions from the hearing officer	353

6.4.6	Privilege against self-incrimination	354
6.4.7	Releasing and recalling a witness	355
6.5	Oral submissions.....	356
6.6	Miscellaneous matters.....	362

7. Challenging a Decision

7.0	Introduction	365
7.1	Appeal or judicial review	368
7.2	General principles relating to appeals.....	370
7.2.1	The decision under appeal.....	371
7.2.2	The staying effect of an appeal.....	374
7.2.3	Security for costs on appeal.....	375
7.2.4	The powers of an appellate tribunal.....	375
7.2.5	Grounds of appeal.....	377
7.2.6	Review or rehearing	383
7.2.7	Approach of an appellate tribunal	390
7.2.8	New issues on appeal	395
7.2.9	New evidence on appeal	397
7.2.10	Representation by the registrar on appeals.....	399
7.2.11	Appellate advocacy.....	400
7.2.12	Appeal to the Appointed Person or the High Court.....	402
7.3	Appeals to the Appointed Person.....	403
7.3.1	Appointed Persons.....	404
7.3.2	Appeal procedure	405
7.3.3	Transfer to the High Court	409
7.3.4	Respondent's notice and cross-appeal.....	412
7.3.5	Hearings before the Appointed Person.....	416
7.4	Appeals to the High Court	417
7.5	Judicial review	421

8. Costs

8.0	Introduction	425
8.1	Costs in <i>ex parte</i> cases	429
8.2	Request for costs	429
8.3	Interim decision on costs.....	433
8.4	On-scale costs.....	436
8.5	Off-scale costs.....	440
8.5.1	Uplifted costs	442
8.5.2	Disallowed costs	449
8.6	Costs thrown away.....	450

8.7	Costs of parties not professionally represented.....	451
8.8	Costs against the professional representatives.....	454
8.9	Registrar’s costs.....	455
8.10	Costs against the registrar.....	456
8.11	Costs on appeal.....	457
	8.11.1 Before the Appointed Person.....	458
	8.11.2 Before the Court.....	459
8.12	<i>Pro bono</i> costs orders.....	463
8.13	Enforcement.....	464

9. Prematurely Ended Proceedings

9.0	Introduction.....	466
9.1	<i>Ex parte</i> cases.....	466
9.2	<i>Inter partes</i> proceedings.....	468
	9.2.1 Intentional failure to file TM8, &c.....	469
	9.2.2 Unintentional failure to file TM8, &c.....	474
	9.2.3 Withdrawal of the TM8 and counter-statement.....	481
	9.2.4 Cost consequences.....	484
	9.2.5 Setting aside.....	484
9.3	<i>Inter partes</i> appeals.....	485
9.4	Surrender.....	486
9.5	Abatement.....	486

10. Settled Proceedings

10.0	Introduction.....	488
10.1	Types of ADR.....	490
10.2	Arbitration.....	493
10.3	Mediation.....	495
	10.3.1 Evaluative vs facilitative approach.....	496
	10.3.2 Characteristics.....	497
	10.3.3 The IPO’s Mediation Service.....	500
10.4	Expert determination.....	501
10.5	Negotiation.....	502
	10.5.1 Without prejudice vs open negotiations.....	502
	10.5.2 Waiving without prejudice privilege.....	504
10.6	<i>Inter partes</i> proceedings.....	504
10.7	<i>Inter partes</i> appeals.....	508
10.8	Settlement agreements.....	510
	10.8.1 Differences between judicial relief and settlements.....	511
	10.8.2 General settlement terms.....	514

10.8.3 Transfer of property.....	518
APPENDIX 1 – Schedule of Trade Mark Forms	525
Arranged in numerical order.....	525
UK trade mark forms	525
International trade mark forms	526
Other forms	526
Arranged by topic.....	526
Trade mark applications.....	526
Oppositions	527
Other contentious proceedings.....	527
Procedural steps.....	527
Actions involving registered trade marks.....	527
Administrative matters	528
APPENDIX 2 – Tribunal Practice Notices.....	529
Schedule of TPNs 2000 to 2023.....	529
Edited texts of selected TPNs 2000 to 2023	531
TPN 1/2000 Practice in Proceedings Before the Comptroller	531
TPN 2/2000 Costs in Proceedings Before the Comptroller.....	536
TPN 3/2000 Requests for extensions of time in which to appeal decisions	538
TPN 4/2000 Statements of case and counter-statements in opposition, revocation and invalidity proceedings before the registrar of Trade Marks	539
TPN 5/2000 Hearings before the Registrar of Trade Marks under Rule 54 of the Trade Marks Rules 2000	543
TPN 1/2001 Requests to Postpone or Rearrange the Date of Appointed Trade Mark Hearings	544
TPN 1/2002 Trade Mark Hearings	545
TPN 1/2003 Appeals to the Court from the Comptroller (Revised).....	548
TPN 2/2004 New trade mark opposition and other inter partes procedures ..	549
TPN 3/2004 Treatment of decision pending earlier trade marks under Sections 5(1) & 5(2) in Opposition and Invalidation proceedings	550
TPN 5/2004 Evidence in <i>inter partes</i> proceedings before the Registrar of Trade Marks: submission and argument.....	551
TPN 1/2005 Revocation (non-use) procedures, Section 46 of the Trade Marks Act 1994 (as amended)	552
TPN 1/2007 Applications for revocation on the grounds of non-use: calculation of the date of revocation	554

TPN 2/2007	Undefended applications for a declaration of invalidity (trade mark registrations).....	557
TPN 3/2007	Preliminary Indications in trade mark opposition proceedings: circumstances when they will not be used.....	558
TPN 4/2007	Costs in proceedings before the Comptroller	559
TPN 5/2007	Procedure for parties to challenge evidence filed in inter partes trade mark disputes	561
TPN 2/2008	Appeals to the Appointed Person in Inter Partes proceedings....	563
TPN 4/2008	Filing documents by facsimile in Inter Partes proceedings	565
TPN 5/2008	Page numbering of evidence in Inter partes proceedings in trade marks and designs cases.....	566
TPN 6/2008	Costs in proceedings before the Comptroller	567
TPN 1/2009	Requests for stays or suspensions in inter partes proceedings	568
TPN 2/2009	Opposition proceedings Preliminary Indications Rule 19 Trade Marks Rules 2008.....	569
TPN 4/2009	Trade mark opposition and invalidation proceedings – defences	569
TPN 5/2009	Correspondence solicited for proceedings	572
TPN 6/2009	Requirement to attend hearings in relation to applications for invalidation where there are grounds of invalidation under sections 5(1), 5(2), 5(3) and/or 5(4) of the Trade Marks Act 1994.....	574
TPN 1/2010	Pleadings in opposition and invalidation proceedings relying on section 5(4)(b) of the Trade Marks Act 1994 in relation to copyright, design right and registered designs	575
TPN 2/2010	Time periods for the submission of evidence and submissions in inter partes trade mark proceedings.....	578
TPN 3/2010	Requests for cross-examination	583
TPN 2/2011	Case management of inter partes proceedings: efficient, fair and less costly resolution of disputes before the Trade Marks Tribunal	584
TPN 3/2011	Requirement to attend hearings in relation to applications for invalidation on relative grounds.....	588
TPN 1/2012	Partial Refusal.....	588
TPN 2/2012	Survey and Expert Witness Evidence.....	594
TPN 1/2013	Calculation of time periods.....	595
TPN 2/2013	Fast Track Oppositions	597
TPN 1/2014	The relevance of colour to a mark registered in black and white but used extensively in a particular colour or colours.....	599
TPN 1/2015	Restriction on filing evidence in opposition and cancellation proceedings	601
TPN 2/2015	Fast track opposition costs cap.....	604
TPN 1/2016	Skeleton arguments and attendance in trade mark proceedings.	605

TPN 2/2016	Costs in proceedings before the Comptroller	607
TPN 3/2016	The use of statements of case.....	608
TPN 1/2018	Trade mark opposition and invalidation proceedings.....	610
TPN 1/2020	Disclaimers/Limitations of marks	612
TPN 2/2020	End of Transition Period - impact on tribunal proceedings.....	614
TPN 1/2021	Legal changes to the end of Transition Period transitional arrangements	622
TPN 1/2023	Costs in proceedings before the Comptroller	626
TPN 2/2023	Effective service in proceedings against trade marks and registered designs without a valid UK address for service	630
APPENDIX 3 – Latin Terms		637
INDEX		680