

Opposition, Revocation, Invalidation and Litigation

UK opposition, revocation and invalidity proceedings

These are all ways of challenging UK trade mark applications and registrations.

Opposition occurs prior to registration of a trade mark. Revocation and invalidity are post-registration challenges. Invalidity is based on the premise that the mark should not have been registered in the first place, whereas revocation is based on the premise that the mark should no longer be registered because of the manner of use, or lack of use, of the mark post-registration.

Revocation and invalidation are alternative names for cancellation. You may see a “non-use revocation” commonly referred to as a “non-use cancellation”, for example.

Opposition	Revocation	Invalidation
Pre-registration	Post-registration	Post-registration
If successful then application rejected	If successful deemed cancelled from the date action filed	If successful application deemed never to have been filed
Anyone can file, depending on the grounds	Anyone can file	Anyone can file, depending on the grounds
Absolute grounds	Use related: Non-use, generic, likely to mislead the public	Absolute grounds
Relative grounds		Relative grounds

Background

Absolute grounds for refusal to register a trade mark

The absolute grounds for refusal of registration of a trade mark are set out in Section 3 of the Trade Marks Act 1994. Such grounds are said to be “absolute” because they relate to the mark or application itself and are not based on conflicts with the rights of third parties (“relative” grounds for refusal).

You will recall that Examiners examine trade mark applications on absolute grounds e.g. is the mark non-distinctive, descriptive, deceptive, contrary to public policy or accepted principles of morality. Nevertheless, oppositions and invalidation actions can be brought by third parties on absolute grounds.

Relative grounds for refusal to register a trade mark

Most oppositions and invalidation actions are brought under relative grounds by owners of prior rights.

Common grounds for opposition and invalidation actions

- Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services
- Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark
- Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off (i.e. an unregistered trade mark in use)
- Opposition can also be based on Section 3(6) where "The trade mark is excluded from registration because the application was made in bad faith". Although this is an absolute ground not a relative ground, it is very rarely raised during examination and is more often brought up by third parties in oppositions and invalidation actions.

UK Opposition

The UKIPO notifies proprietors of UK applications and registrations that a potentially similar mark has been accepted for registration. It is also common for companies to have trade mark watching services in place to monitor applications filed for similar marks covering similar goods and services. The UKIPO also offers an eAlerts service which allows you to track a trade mark application or registration and receive email notifications about specific events. This is useful if you spot a mark before it is accepted and published in the Trade Marks Journal.

When a trade mark application is published in the Trade Marks Journal, the application may be opposed on any of the absolute or relative grounds. Any opposition must be filed within the two-month period following publication of the application, unless a "Notice of Threatened Opposition" is filed. This must be done by filing the online TM7A form. There is no fee for filing this.

If an opposition deadline is extended by filing a TM7A, only the party filing the TM7A can then file opposition in the extended opposition period.

Anyone may oppose a UK application on absolute grounds, but only the proprietor of an earlier mark may oppose on relative grounds.

Oppositions can be partial and only against some of the goods and/or services covered in an application.

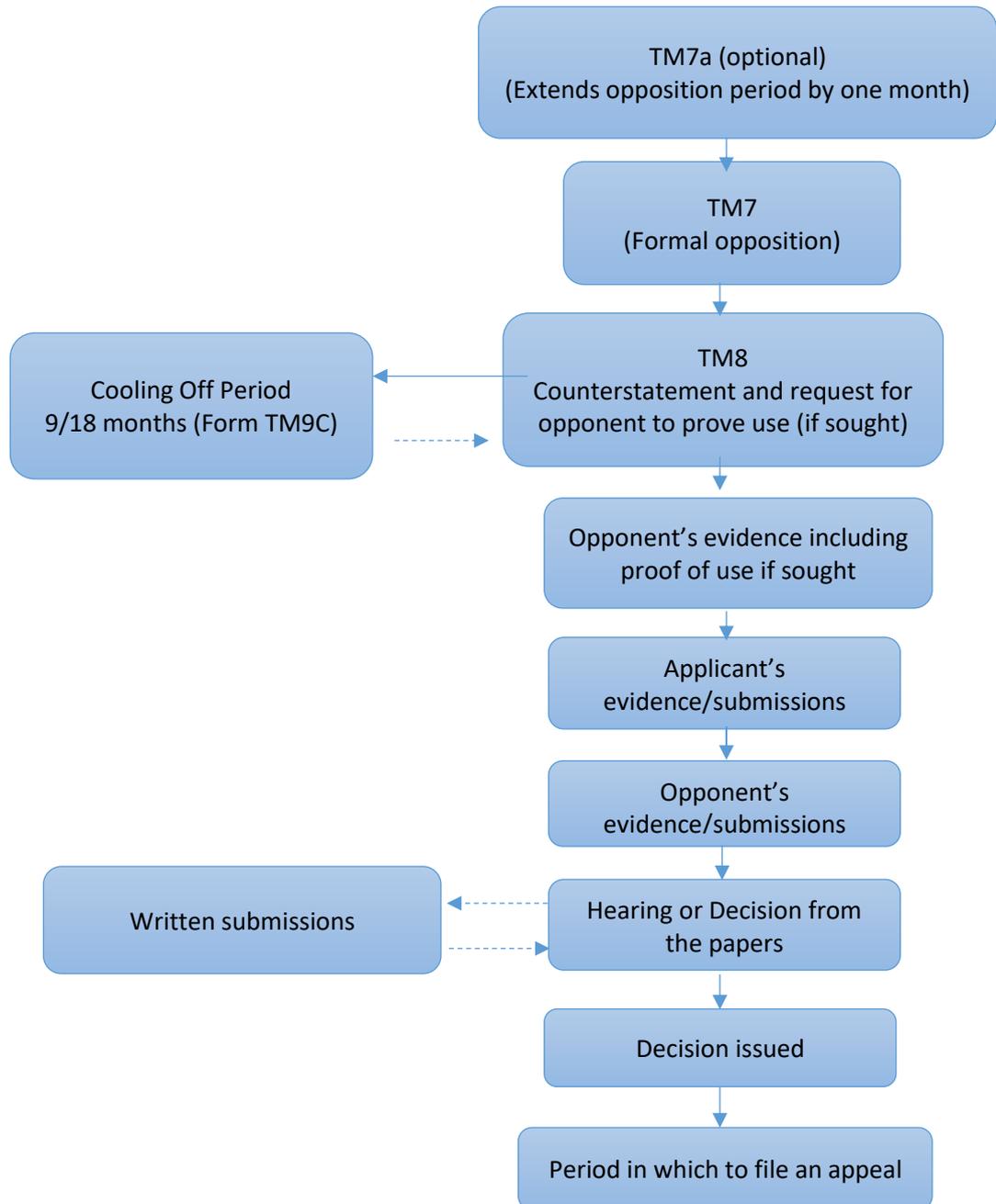
If the opponent is relying on an earlier registered mark as a basis for opposition, it must provide a statement of use in respect of that mark if it has been registered for five years or more before the date of application (or priority) of the opposed application. Such statement (which is part of the opposition form) must detail the goods and services on which the trade mark has been used in that five-year period (or must give proper reasons for non-use). This

is to ensure that opponents can only rely on marks that are genuinely in use, in line with the policies underpinning the non-use revocation procedure which is described more below.

UK Opposition – Procedure

- Initial two-month opposition period which can be extended by one month by filing a Form TM7A (no fee)
- After the expiry of the third month a Notice of Opposition must be filed on a **Form TM7** with an attached Statement of Grounds and a fee of either £100 or £200 depending on the grounds relied upon
- Two-month 'cooling off period' followed by either filing of **Form TM8** (no fee) Notice of Defence and Counterstatement by the Applicant or, if agreed by both parties, a request to extend the cooling off period made on a Form TM9C (no fee)
- This extends the cooling off period for a further seven months and this can be extended by a further nine months, if agreed by both parties, by filing a Form TM9E (no fee)
- The Form TM8 Notice of Defence and Counterstatement sets out to admit and/or deny the claims made by the opponent in the Form TM7
- The proceedings then move on to the evidence rounds
- There will then be three two month rounds of evidence/submissions (extendable with a Form TM9)
- Following the evidence rounds the parties have the option to request an oral Hearing or file written submissions
- A decision will then be issued
- N.B. After the filing of the opposition, all correspondence and any documents sent to the UKIPO must also be copied to the other party otherwise they are not considered to be filed

UK opposition procedure diagram



Form TM7A (extends the opposition deadline by one month)

The screenshot shows the Intellectual Property Office (IPO) website. The main heading is "File a notice of threatened opposition". Below this, there is a question: "Which trade mark application are you intending to oppose?". The form contains three input fields: "Trade mark number" (an empty text box), "Route of protection" (a dropdown menu currently showing "National UK"), and "Select a class" (an empty dropdown menu). Below these fields is a green "Continue" button. At the bottom of the page, there is a footer with "Cookies", "Privacy", and "Built by the Intellectual Property Office" links, an "OGL" logo, and the text "All content is available under the Open Government Licence v3.0, except where otherwise stated". The Royal Coat of Arms and "© Crown copyright" are also visible.

Form TM7A tips

- The details of the potential opponent must be correct – opposition must be filed in same name as the party filing the request for an extension of the opposition deadline
- Ensure the details of the published mark are correct
- No need to state which grounds of opposition will be relied upon
- Filing this form is considered notification to the Applicant that an opposition might be filed – use this date on TM7
- Providing notification means if you win the opposition, you are likely to be receive an Award of Costs in your favour, where the losing party is ordered to contribute to your legal costs
- No fee
- Immediate confirmation.
- Details published
- **1ST IMPORTANT POINT** – by filing a Form TM7A there is no obligation for that party to then file an opposition. The additional month can be useful i.e. to provide additional time to negotiate a settlement with the applicant or simply to come to a decision on whether they wish to formally oppose the application
- **2ND IMPORTANT POINT** – The correlation between the later grounds and TM7A. For example, if the goodwill is held by a different entity to the registered proprietor (even if within the same group), then two TM7A forms will have to be filed in order to rely on both registered and unregistered earlier rights

Form TM7 tips

- Fee of £100 for grounds under Section 5 (1) or (2) (identical marks or similar marks with likelihood of confusion)
- Fee of £200 if any other grounds (reputation, unregistered rights, etc.)
- Form must be signed
- Opponent details must match TM7A
- Identify grounds and earlier rights
- If relying on unregistered rights then date and place of first use required
- Statement of Grounds must be included, either as a separate document or as answers to the questions on the form (example page below). If referring to an attached Statement of Grounds in the form, opponent must specify exactly where the relevant answer is to be found in the document, i.e. 'see paragraph 4(a) of the attached Statement of Grounds'. It is not sufficient to simply state 'see attached Statement of Grounds'.

Fast Track opposition procedure

As opposition proceedings can drag out, a Fast Track opposition procedure was introduced.

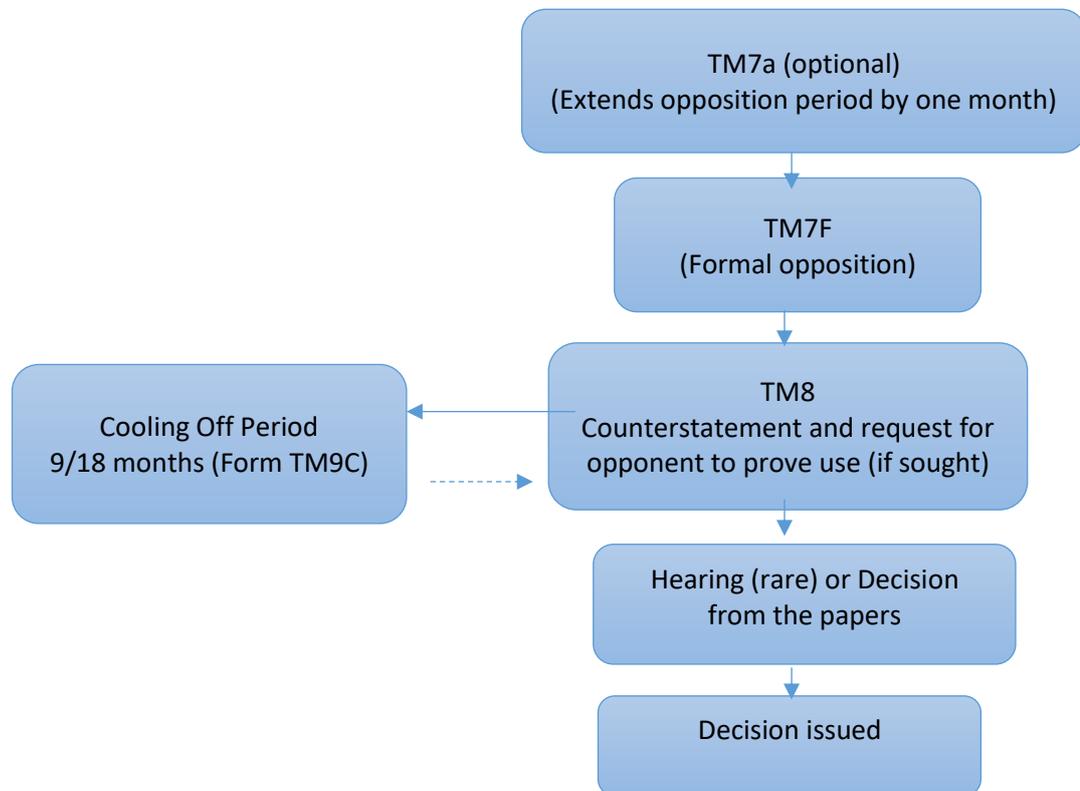
It is a faster, cheaper and less complicated option for opponent's wishing to rely on Section 5 (1) and 5 (2) grounds only.

It requires a Form TM7F plus Statement of Grounds and £100 fee.

The opponent can only rely on a maximum of three earlier rights and, if any are over five years old then they must file proof of use with the opposition.

It then largely follows the usual opposition procedure, but they rarely hold Hearings under this procedure and Cost awards are capped at £500.

UK Fast Track Opposition Procedure Flowchart



Useful table from the UKIPO Trade Marks Manual listing relevant forms to UK oppositions

FORM	PURPOSE
TM7a - Notice of Threatened Opposition	The form filed by anyone seeking to extend the opposition period to three months beginning immediately after the date of publication of the application. It must be filed on-line through the Office website.
TM7 - Notice of Opposition TM7F - Notice of Fast Track Opposition TM7G - Request to add grounds to a notice of opposition	The forms filed to launch opposition proceedings against a trade mark application. The form which must be used to make a request to add grounds other than 5(1)/5(2) to an existing opposition.
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.
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).
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.
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.
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.
TM21B - Request to change the details of an application	The form which must be used when the applicant for a trade mark wishes to amend the goods/ services covered by their application.
TM22 - Notice to surrender a registration	The form which must be used by the registered proprietor to surrender their registered mark in full.
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.

UK Revocation

According to Section 46 of the Trade Marks Act the registration of a trade mark may be revoked on any of the following grounds:

- (1)(a) *that within the period of 5 years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;*
- (b) *that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;*
- (c) *that in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered (e.g. has become generic);*
- (d) *that in consequence of the use made of it by the proprietor or with his consent in relation to goods or services for which it registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.*

The “genuine use” under section 46(1)(a) must be real commercial use; if the use is not, for example, intended to continue once the threat of revocation has receded, it is unlikely to be regarded as “genuine”. Use includes use of the mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. There is no particular quantitative or qualitative threshold of use. The UKIPO considers the overall circumstances when assessing whether use is genuine, including the nature of the relevant goods and services and the characteristics of the market in which they are sold.

The onus of proof is on the proprietor to show that there has been use or proper reasons for non-use.

If use is commenced or resumed after the expiry of the five-year period but within a period of three months before the making of the revocation application this shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the revocation might be filed.

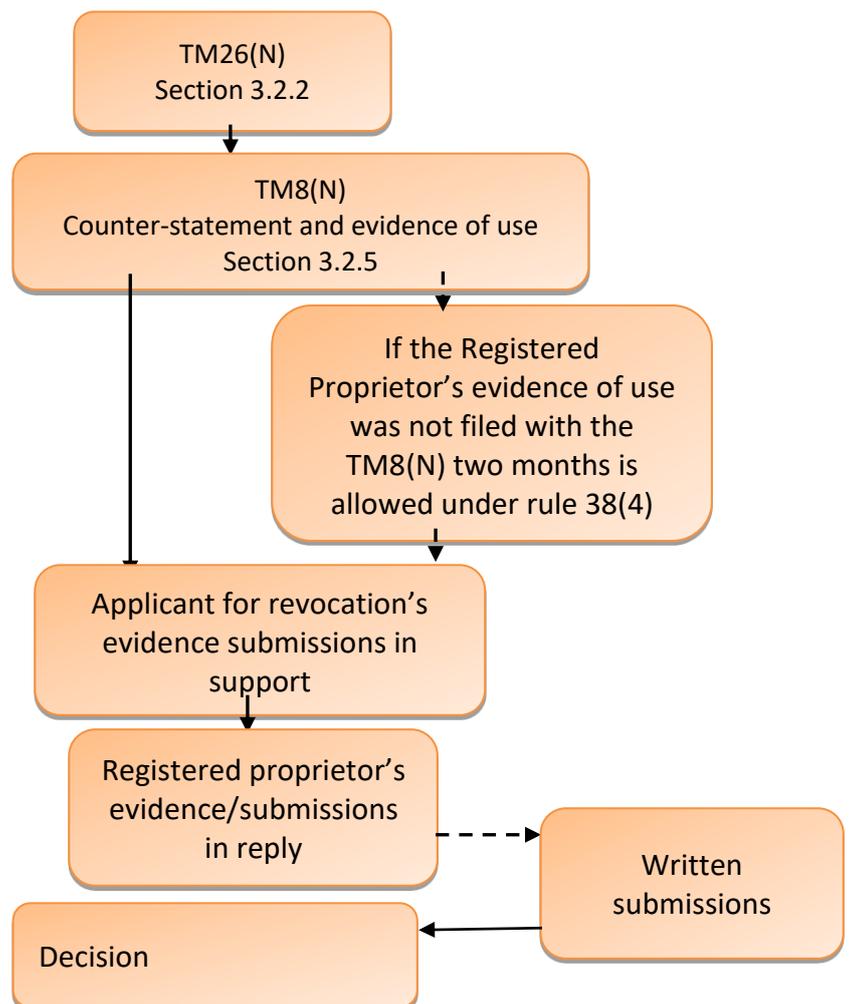
Where grounds of revocation exist in respect of only some of the goods/services for which the trade mark is registered, revocation can be partial and against those goods/services only.

Where the registration of a trade mark is revoked to any extent, the rights of the proprietor are deemed to have ceased at the date of the application for revocation, or at an earlier date if the Registrar or Court is satisfied that the grounds for revocation existed at that date.

UK Revocation Procedure (Non-use)

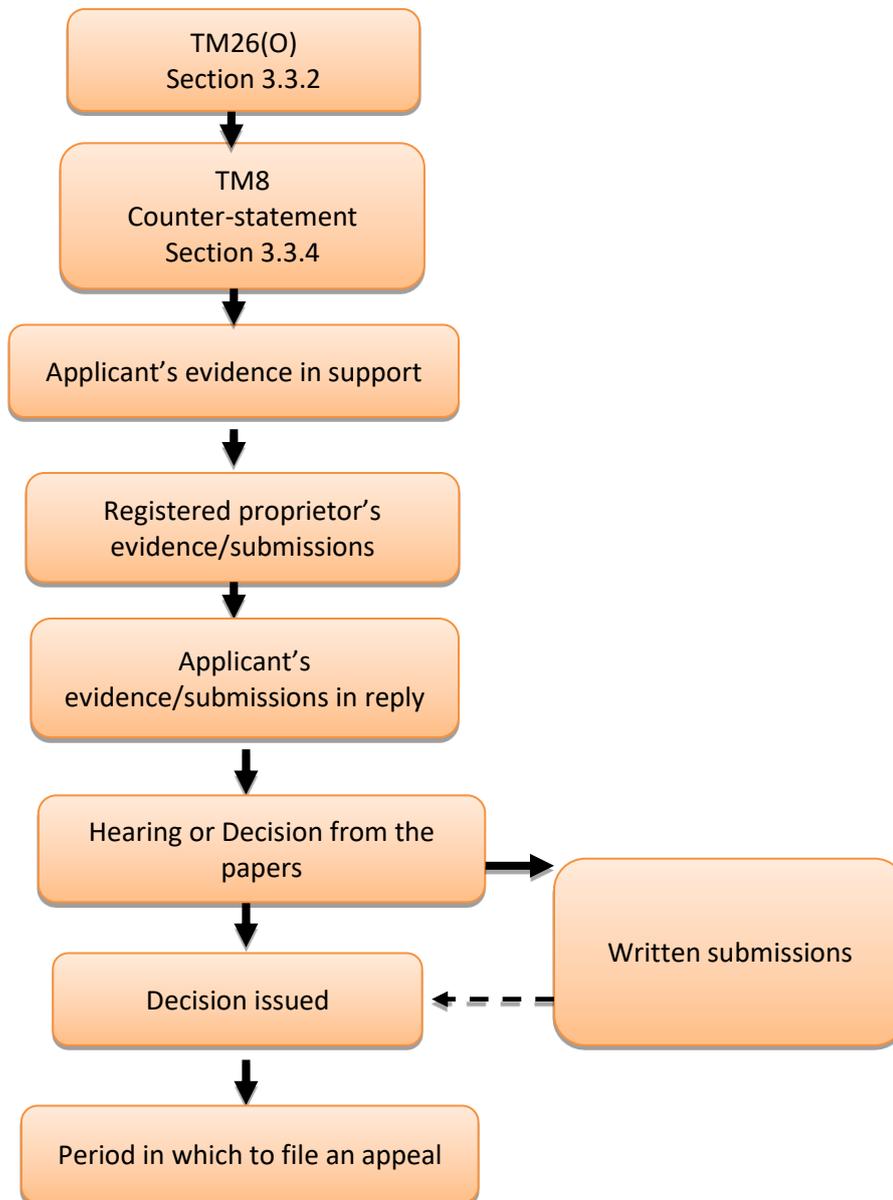
- Most common ground of revocation
- Form TM26N - £200 fee

- Form TM8N – no fee and within two months including evidence of use (or reasons for non-use)
- Further two-month period to file evidence of use if not attached to TM8N
- Tribunal will set further periods for parties to file evidence and submissions – discretionary and no fixed periods or sequences
- Usual sequence –
 - 1) Proprietor files evidence of use
 - 2) Revocation applicant files evidence/submissions
 - 3) Proprietor files evidence/submissions in reply
 - 4) Hearing or written submissions



UK Revocation Procedure (other than non-use)

This is slightly different to revocation on the grounds of non-use.

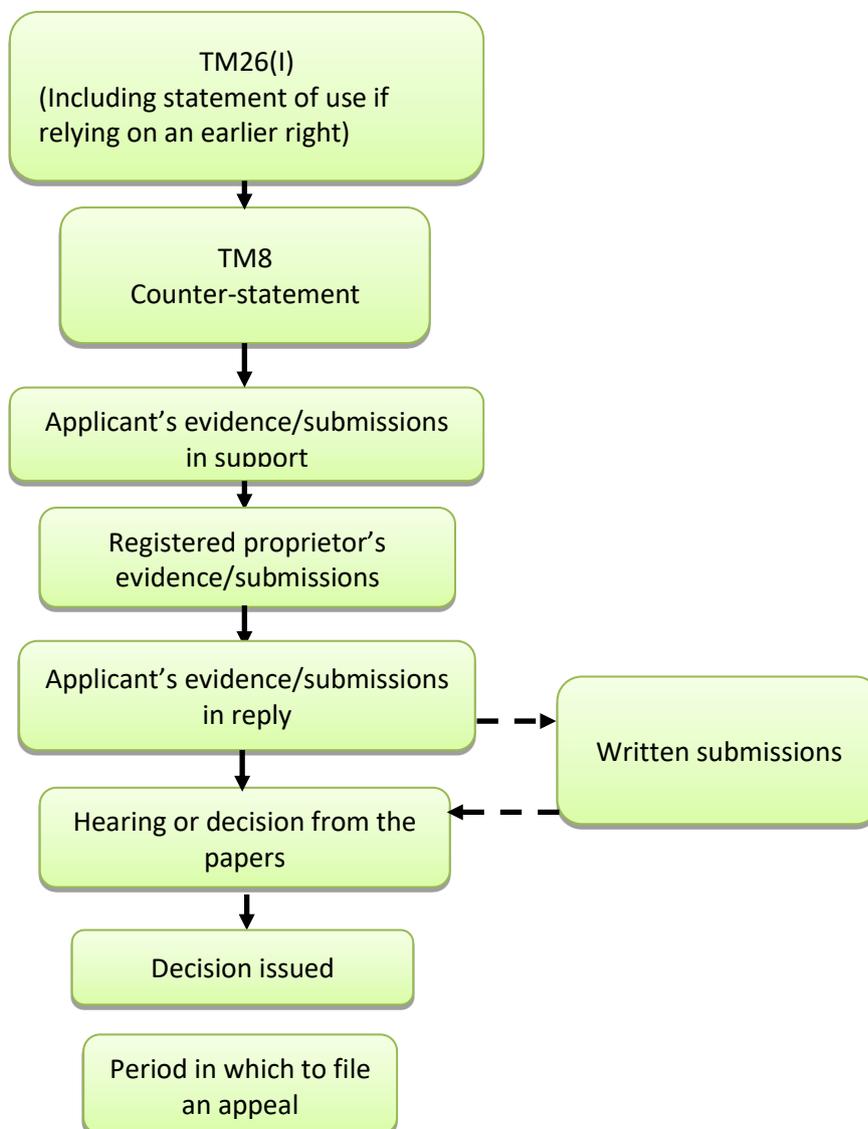


UK Invalidity

The grounds on which the registration of a trade mark may be declared invalid are the same as the grounds of opposition. However, that in relation to the relative grounds, a declaration of invalidity can be defeated if the earlier right owner consented to the registration or, in certain circumstances, acquiesced to use of the mark in the UK for a continuous period of five years, being aware of that use.

Put simply, invalidation is a post-registration opposition procedure. It can be made at any time after registration. If successful the registration is deemed never to have been made.

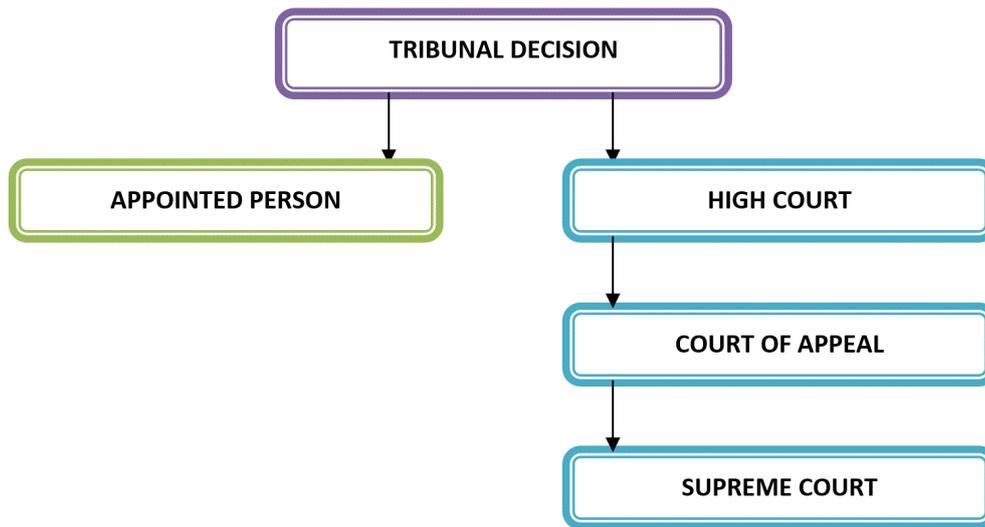
UK Invalidation Procedure diagram



Appeal Process in the UK

If you lose or partially lose an oppositions, revocation or invalidity action then it is possible to appeal.

An appeal can be either to the Appointed Person or to the High Court:



An appeal to the Appointed Person must be made within **28 days** from the date of the issuance of the decision.

An Appointed Person is a senior intellectual property lawyer appointed by the Ministry of Justice and wholly independent of the Tribunal of the UKIPO.

The Appointed Person offers a low-cost alternative to appealing to the High Court. An appeal to the Appointed Person is made by filing a TM55P ‘Notice of appeal to the Appointed Person’ and paying the official fee of £250. The notice of appeal must include the grounds of the appeal together with any relevant trade mark law and legal authorities relied upon in support of each of the grounds of appeal.

Oppositions overseas

The most typical trade mark process timeline around the world involves: examination – publication – opposition – registration - revocation or invalidity. However, there are some exceptions.

Post-registration opposition procedure

Applications are examined and once accepted, are registered. Third parties can then bring opposition post-registration and, if successful, the registration is cancelled e.g. Germany, Japan, Switzerland.

Pre-examination opposition procedures

Following formalities examination, applications are published. Any oppositions filed may then be decided alongside the examination of the application e.g. Spain and Latin American countries.

Extendable opposition deadlines

Like the UK and the US, it is possible to request an extension of the opposition deadline e.g. Singapore.

Cooling off periods

The EU provides for a cooling off period of initially two months, extendable by up to 22 months by joint request.

No opposition procedure

An example is Russia. However, you can file observations during an application's examination (a 'soft' opposition) or an invalidation post-registration.

International Registrations

When opposing designations of International Registrations, the procedures and timelines can differ from national oppositions.

Litigation

What is it?

In its simplest form, litigation is the process of bringing to a court to enforce a particular right. It's the act of bringing in a lawsuit to resolve any disputes that may arrive before a court.

Litigation allows a party to:

- **STOP** an infringing act, i.e. an injunction
- **DAMAGES** i.e. obtain some sort of compensation for the infringing activity

In the context of trade marks/intellectual property, litigation is a means for taking action against **infringement** of an entity's right.

Trade mark infringement is the unauthorised use of a trade mark which is identical or confusingly similar to a registered trade mark used by another party.

The Courts

The UK contains three separate judicial systems:

- **England and Wales**
- **Scotland**, and
- **Northern Ireland**

All courts within the UK are bound by the decisions of the **Supreme Court**.

England and Wales, given its size and population, is where most trade mark litigation occurs in the UK. Trade mark infringement proceedings are typically brought before either the High Court or the Intellectual Property Enterprise Court (IPEC).

The High Court is the premier venue in the United Kingdom for large and complex litigation:

- There's no limit (in theory) on how much a claimant may claim in damages
- There's no limit (in theory) on the amount of costs which may be recovered by the successful party

However, the High Court will play an active role in managing costs and parties are likely to be subject to costs-management orders relating to approved cost budgets. These may be compulsory or – if discretionary – ordered at the request of one of the parties. Costs recoverable by the successful party, not subject to a costs-management order, will typically be between 60% to 70% of the costs actually incurred.

IPEC (Intellectual Property Enterprise Court)

The IPEC is a specialist court within the Chancery Division of the High Court. The court handles cases relating to IP disputes, including registered designs, patents, registered trade marks and copyright.

There are two options, multi-track (with a damages cap of £500,000) and small claims track (for claims of value up to £10,000).

All the same remedies as in the High Court are available in the multi-track: preliminary and final injunctions, damages, accounts of profits, delivery up and disclosure, search and seizure and asset freezing. Options are more limited in the small claims track.

The IPEC is designed to handle smaller, shorter, less complex, less important, lower value actions. The idea is to encourage small and medium sized enterprises and private individuals to safeguard their rights without the enforcement options being cost prohibitive. Parties in the small claims track, in particular, are often self-represented ("litigants in person") – think of a photographer who is seeking damages for the unauthorised use of a photograph.

Chartered Trade Mark Attorney litigation rights

Chartered Trade Mark Attorneys have certain litigation rights. As and when these rights are exercised more, the more likely it is that paralegals will be providing support.

There are three levels of litigation rights.

The Intellectual Property Litigation Certificate

This is the basic level of rights all Chartered Trade Mark Attorneys hold. It allows them to conduct appeals in the High Court, litigation in the Intellectual Property Enterprise Court (IPEC) and appeals of the aforementioned cases in the Court of Appeal and Supreme Court.

It also grants a right of audience in the IPEC and, on appeals from the IPO, in the High Court.

The Certificate in Intellectual Property Basic Litigation Skills must be taken within three years of qualifying. In practice, this is a module included in the Nottingham Law School Professional Certificate in Trade Mark Practice (the final course to qualify as a Trade Mark Attorney).

Higher Courts Litigation Certificate

This gives holders the ability to commence and conduct litigation in the High Court. This is gained by completing an Advanced Litigation Skills Course.

Higher Courts Advocacy Certificate

This is equivalent to the combined rights of a barrister and solicitor in IP cases. It gives the holder full rights of audience in IP cases in all English courts. This is gained by after completing an Advocacy Skills Course.

Activities

1. Map out the processes for UK oppositions, invalidations and revocations so you can see them side-by-side and note where proceedings are similar.
2. Go to the UKIPO website and familiarise yourself with Forms TM7 and TM8.
3. Go the latest Trade Marks Journal, <https://www.gov.uk/check-trade-marks-journal>, and find an application open for opposition. Prepare a Notice of Threatened Opposition (just don't submit this!), if you are not familiar with this online form.