

## **CHANGES TO UK OPPOSITION PROCEDURE**

With effect from **5 May 2004**, the trademark opposition procedure in the UK will be changed.

While the non-extendible 3-months opposition period remains the same, detailed below are some of the more noteworthy changes:-

- The opposition papers have been altered to a more focused format, which now contain a “Statement of Use”. If the earlier trademark(s) upon which the opposition is based have been registered for 5 years or more (at the date of publication of the opposed application), the opponent will be required to indicate the goods/services upon which the earlier trademark(s) have been used during this 5-year period, or provide good reasons for non-use.

This requirement, together with the more focused format of the opposition papers, could make it more difficult to file oppositions at the last minute. You should therefore advise us, at the earliest opportunity, of an intention to lodge an opposition in the UK.

- The applicant will still have to file a Counterstatement, which is now incorporated within the official form. If a Statement of Use is made in the opposition, and this is challenged by the applicant in its Counterstatement, the opponent will be required to prove use of its registration(s) at the first round of evidence. Failure to prove use will result in the earlier trademark(s) being excluded from the proceedings.
- The present “cooling-off” period, available before filing the Counterstatement, still exists, although it is now one single period. In effect, the Counterstatement will be due 12 months from the serving of the opposition papers by the Trade Marks Registry, provided that the “cooling off” period has been agreed by both parties. The “cooling-off” period can be terminated at any time by the opponent, and the Counterstatement will have to be filed within one month of such termination.

- For oppositions based on earlier identical or similar trademarks, covering identical or similar goods/services, the Registry will issue a Preliminary Indication. This will be a judgment, based on the opposition papers and the Counterstatement, of the merits of the case. If either party does not accept the Preliminary Indication, they can notify the Registry to allow the proceedings to progress to the evidence rounds. If neither party objects to the Preliminary Indication, it will be implemented automatically by the Registry.

This provision should substantially shorten opposition proceedings. The Registry have found that 80-90% of their present decisions based on these grounds are not affected by the evidence actually filed.

- The evidence rounds still remain the same, with each party being given an initial 3-month period to file their evidence (which can be extended if justifiable reasons are provided).
- On completion of the evidence rounds, the Registry will hold a Case Review, and an indication will be given of whether or not a hearing is deemed necessary. Any party wishing to be heard can still request a hearing. It is hoped that parties might take up the opportunity of allowing the Registry to decide the case without a hearing.
- Oppositions filed prior to the new rules coming into force continue to be dealt with under the old rules until a Counterstatement is filed. After the Counterstatement has been filed, the new rules shall apply.

Oppositions filed prior to the new rules coming into force, for which a Counterstatement had already been filed, shall be dealt with under the new rules as soon as the next new stage in the proceedings takes place (e.g. an evidence round).

It is hoped that the introduction of these new rules will substantially reduce the amount of time that most oppositions take to be completed.

If you require any further information on these changes, please contact Ian Buchan, Sanjay Kapur or John Peacock in our Nottingham office.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at [www.eric-potter.com](http://www.eric-potter.com).

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