

## New Procedure for Opposing UK Trade Mark Applications as from 5 May

In an attempt to streamline UK opposition procedures, the UK government has brought into force its reforms under the Trade Marks (Amendment) Rules 2004 and The Trade Marks (Proof of Use, etc) Regulations 2004. These should make oppositions, especially those based on registrations which are less than five years old, easier, quicker and cheaper. **Key points are:**

- It applies to all oppositions filed from **5 May 2004**
- Oppositions based on marks which have been on the register for five years as of the date the opposed mark is published will need to contain **at the time the opposition is filed a “statement of truth” that** there has been genuine use of the marks in the UK (or the EU if the mark is a CTM) during those five years, and this statement **must identify the goods and services for which use is claimed**
- If exact information regarding use is not available at the time the opposition deadline arises, the statement of truth can be drafted loosely, **but** the Patent Office will require the exact information within the first few weeks after the opposition is filed
- Proof of that use will not need to be filed until such time as a) the applicant calls for it and b) the opposition has reached the evidence stage
- Before the evidence stage, the parties have up to **a year’s worth of “cooling off “ time** within which to attempt a settlement
- Once the cooling off period is terminated, the Registry will issue its **preliminary indication** on whether it considers that the case for refusing the opposed mark based on earlier registrations and applications is made out. Parties cannot influence this decision; no arguments can be filed. There is no provision to dispense with the preliminary indication; the Registry will issue it even if the parties do not want it.
- Preliminary indications are only issued when the opposition is based on rights in a registration or application for a mark. There is no preliminary indication if the opposition is based on other grounds, such as unregistered trade marks protected under the law of passing off, copyright, or bad faith or that the mark is not distinctive.

## Transitional Provisions for Ongoing Oppositions

- These are **not** subject to the new proof of use requirements
- But the new longer cooling off period and the preliminary indication will apply to all ongoing oppositions if the applicant files his counter statement *after* 5 May.

## Miscellaneous Notes

The law remains that opponents (unlike the CTM opposition procedure) do not need to be the owner of the marks on which the opposition is based.

Rules on discovery are unamended: discovery will be ordered only when justification for it has been made out.

## May 2004