

## Guide to TM opposition procedure at the UKIPO

### Opposition period

UK TM applications are open to opposition for **2 months** from publication.

This period may be extended by **1 month** by filing a “Notice of threatened opposition.”

### Requirements to file an opposition:

- Name of the Opponent (not possible to file an opposition in the name of more than one opponent but see “Multiple proceedings” further below).
- Mark(s) involved
- Grounds of opposition – e.g. earlier TM registrations (likelihood of confusion and/or reputation), unregistered trade mark rights (“Passing Off”) in the UK, bad faith etc. Grounds can be added later but only at **discretion of UKIPO**.
- Date of first use of the mark in the UK if relying on Passing Off.

No Power of Attorney is required to file an opposition.

### Procedure after filing opposition

- UKIPO checks for formal objections – e.g. may request Opponent to amend opposition
- Once opposition is admitted UKIPO confirms 2 month deadline for Applicant to submit a defence **or** for parties to request cooling off period – this must be agreed by both parties.
- If cooling off is requested this suspends proceedings for 7 months (but either party can terminate suspension unilaterally on request). This period can either be extended by a further 9 months or applicant must submit a defence.
- If no cooling off is requested or no defence submitted the application would provisionally be deemed abandoned by the UKIPO unless exceptional justification is provided by applicant. **NB accordingly if applicants do not respond the proceedings end.**
- If defence is submitted it must address all points raised in notice of opposition and must request proof of use of any of Opponent’s earlier TM registrations which have been registered for more than 5 years.

### Procedure after filing a defence – evidence rounds

1. Once defence is submitted UKIPO sets timetable for evidence rounds.
2. 2 months will be granted for Opponent to file evidence in support of opposition (including “proof of use” of earlier TMs over 5 years old if requested) – this is “evidence of fact”, **there is no requirement to file legal arguments at this stage**. It may not be necessary to submit any evidence, we can advise if this is necessary
3. After 2) the Applicant has 2 months to file “evidence in reply”. This is “evidence of fact” not legal arguments and should be in reply to the Opponent’s evidence. It may not be necessary to file evidence in reply and it would allow Opponent to file further evidence – we can advise on whether this is necessary.
4. If evidence in reply is submitted at 3), Opponent has 1 month to confirm if it wishes to file evidence in reply and then 1 month to submit evidence in reply.
5. If no evidence is submitted at points 3) and 4) above the evidence rounds are completed.

### Procedure after evidence rounds

- After evidence rounds are complete UKIPO will allow **14 days** for parties to request a hearing or **28 days** in which to submit legal arguments in the event there is no hearing.
- If a hearing is arranged the parties must file legal arguments in 2 working days in advance of the hearing date.
- After final written submissions are provided and/or a hearing takes place the UKIPO issues a decision (normally at least 2-3 months from submissions/hearing)
- Once a decision is reached parties may appeal to the Appointed Person or the High Court **within 30 days** of the decision being communicated – we can advise on which route to proceed with if necessary

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### Miscellaneous practice points:

#### Multiple proceedings

Where there are multiple proceedings involving the same or related parties – e.g. multiple applications opposed or related cancellation proceedings - the parties or UKIPO may request they be **consolidated**. This combines all proceedings into one with the same evidence deadlines etc. This reduces overall costs of preparing evidence etc. for multiple actions.

#### Extensions and suspensions

It is possible to request extensions for deadlines unilaterally, it is also possible for parties to jointly request suspension of proceedings. However, the UKIPO does not grant such requests automatically and justification is needed.

#### Evidence page limits

The UKIPO sets default page limits for evidence to avoid cost of reviewing irrelevant evidence. Normal limits are **300 pages** for Opponent's initial evidence and **150 pages** for evidence in reply of the Applicant and further evidence in reply of the Opponent. Limits may be extended on request but only at the discretion of the UKIPO.

#### Case management conferences

If points of evidence or procedure (e.g. extensions of time) are contested by the parties or the UKIPO the UKIPO will arrange a telephone hearing or "Case Management Conference" to decide how to proceed.