

# *Trade Marks UK Opposition Guidance Note*

## ***Stage 1***

Pre-opposition



## ***Stage 2***

Notice of Opposition filed



## ***Stage 3***

Counter-statement filed



## ***Stage 4***

Evidence stages (if needed)



## ***Stage 5***

Filing of legal submissions/arguments or attendance at hearing



## ***Stage 6***

Decision (including decision on costs)



## ***Stage 7***

Appeal (if needed)

## ***Stage 1***

At this point we will need information from you to enable us to formulate the grounds of opposition. We will also discuss the possibility of settling the matter by agreement. The opposition deadline is 2 months from publication, but this can be extended by 1 month by filing a Notice of Threatened Opposition, so there is sometimes sufficient time to reach a settlement before any opposition is filed.

## ***Stage 2***

The Notice of Opposition (which must be filed no later than 2 months from publication of the application, or 3 months from publication if a Notice of Threatened Opposition is filed) is a comprehensive form setting out the objections to the opposed application in detail. If any registration relied upon had been registered for over five years at the priority date of the application, it will be subject to proof of use requirements and we will need to know, in general terms, the goods/service for which the trade mark in question has been used in the UK. The Notice of Opposition does not have to be copied to the applicant when it is filed as the UKIPO are responsible for sending the form to the applicant.

## ***Stage 3***

The Counter-statement is a comprehensive form setting out the applicant's position in relation to the points raised on the Notice of Opposition. It must be filed no later than 2 months from the date on which UKIPO send the applicant a copy of the Notice of Opposition unless the applicant and opponent agree to enter into a 'cooling-off period' to allow for negotiations. The Counter-statement does not have to be copied to the applicant when it is filed as the UKIPO are responsible for sending the form to the opponent.

## ***Stage 4***

The UKIPO will set the timetable for both sides to file evidence when they send the Counter-statement to the opponent. Usually, the opponent has 2 months to file evidence, as a first step, then the applicant has two months to file evidence. The opponent then has a further 2 months to file evidence in reply to the applicant's evidence. All the evidence filed must be copied to the other side, and deadlines to file the second and third sets of evidence will run from the date on which the previous set of evidence is sent to the applicant/opponent. Further evidence can be filed with the leave of the UKIPO, and disclosure (discovery) and cross examination of witnesses can be requested. Evidence may not be necessary, depending on the nature of the case. The evidence submissions should not include any legal arguments.

## ***Stage 5***

After the evidence stages are complete, the UKIPO will provide a short 2-week deadline for a hearing to be requested. A hearing allows both sides to present legal arguments in support of their case in person or via Teams but can take several months to be appointed. If no hearing is requested by either party a further 2 weeks is allowed to file written arguments, which is a very short deadline, so we have to work quickly if we are in that situation. As legal arguments should not be included in the evidence filed, it is usually advisable to request a hearing or to file legal arguments regarding the case.

## ***Stage 6***

UKIPO decisions are long but include a lot of information regarding previously decided cases the UKIPO have considered in reaching their decision. Decisions usually issue around 3-5 months after legal arguments are filed or presented at a hearing. If there are clear errors in the decision, it is often possible for these to be corrected.

## ***Stage 7***

Appeals against a UKIPO opposition decision must be filed within 28 days of being notified of the decision and can be submitted to the 'Appointed Person' (usually a barrister or another experienced trade mark specialist who is appointed by the Ministry of Justice) or the High Court. The grounds of appeal must be submitted with the appeal form. It is sometimes possible to extend the deadline to file an appeal, but very good reasons must be given. The other party will be given the chance to reply to the appeal and both parties will be offered the chance to attend a further hearing before the appeal decision is given.