

## UK trademark opposition proceedings - important changes proposed

The IPO proposals would see a simplified “fast track” opposition procedure run alongside the existing evidence based opposition process, which the IPO has identified as a possible source of perceived cost and time delay, leading to potential opponents being discouraged from using the system.

### When would the fast track apply?

Opponents would be able to elect the fast track route in certain circumstances, where the opposition is based on:

- a simple comparison of the marks and the goods / services covered, with no evidence required;
- no more than two earlier marks;
- registered UK or CTM trademark rights only, rather than pending applications.

### When would ordinary proceedings still be used?

Oppositions based upon defects in the mark itself, on earlier non-registered rights (including pending applications) or on bad faith, copyright or registered design infringement, would still be required to use the traditional opposition procedures, as all of these grounds require supporting evidence.

Equally, even if an opposition qualified for the fast track, an opponent could still elect to use the normal procedures, if they felt that their case was materially improved with evidence of the reputation of their earlier registered mark.

### What would the fast track involve

An opposition admitted into the fast track process would then proceed according to a separate procedure:

- A lower opposition fee (current proposals £50-£100);
- Where any registration relied upon is more than five years old, proof of use evidence will automatically be required;
- Proof of use evidence must be filed with the notice of opposition in a standard short-form witness statement;
- The applicant will then have two months to consider the case and file a counterstatement;
- If no counterstatement is filed the opposition will be successful, providing that credible legal grounds for rejection are presented in the notice of opposition;
- If a counterstatement is filed, both parties have the opportunity to provide written legal submissions in support of their case.
- No evidence will be admitted into proceedings unless leave is granted by the IPO;
- A final decision will be made from the papers without a hearing;
- This decision is still subject to appeal.

The IPO would be able to consolidate multiple cases under the fast track system using broad case management powers. In certain circumstances this might include cases not originally filed under the fast-track procedure.

Once a case had been started under the fast track it would not be possible to add further grounds and move back into the original opposition system.