



# Opposition procedure at the UKIPO

## What is an opposition?

When a trade mark application has successfully completed the examination process it is accepted and published. When the mark has been published, a third party can oppose the acceptance of the mark for registration on either absolute and/or relative grounds.

## What are absolute grounds?

Absolute grounds relate to defects in the trade mark itself, for example, the mark is descriptive or it is generic and so should not be registered.

## What are relative grounds?

Relative grounds relate to when there is an earlier conflicting trade mark, whether registered or unregistered.

## Who can oppose a trade mark application?

Anyone can oppose an application on absolute grounds but only the proprietor of an earlier trade mark or earlier right may oppose on relative grounds.

## When should an opposition be filed?

Within two months of the application in question being published unless an extension of time is sought.

## Can the opposition period be extended?

The opposition period may be extended by one month, provided the necessary form is filed before the end of the initial two month publication period. No further extension is possible.

## What happens next?

The notice of opposition and any supporting evidence will be forwarded to the defendant, who is given two months to file a notice of defence.

## Is it possible to extend the deadline to file the notice of defence?

Yes – the parties may decide to enter the “cooling off” period to try and negotiate settlement to resolve their dispute. The first cooling off period is for an additional seven months from when the notice of defence was due and the second cooling off period is for a further nine months. To take advantage of the cooling off period, both parties have to agree to extend the same.

If the parties do not want to negotiate settlement of the opposition then the defendant will have two months to file their notice of defence and the deadline to attend to this is not extendible.

If the notice of defence is not filed on time, the opposed application will automatically be deemed withdrawn to the extent of which the opposition was directed.

## What happens next?

The notice of defence will be sent to the opponent and they will be given two months to file any evidence they have in support of their opposition, for example, to substantiate a claim of unregistered rights, evidence of confusion, evidence of their reputation in a mark etc.


The applicant will then be given two months from the date the opponent’s evidence is sent to them to comment on any evidence which is filed in support of the opposition.

The opponent will then be able to file comments in reply to any submissions filed by the applicant within two months of being notified of the same.

## Can I file arguments in support of the opposition?

Once the evidence has been filed and commented on, legal arguments can be filed by both parties in support of their case.

Submissions can be in writing or a hearing can be requested where oral submissions are made. If one party to the proceedings requests a hearing whilst the other does not, then a hearing will be appointed however, the other party is not obliged to attend the same and their submissions can be made in writing.



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## What if I do not like the decision?

*An appeal can be filed within 28 days from the issue of the decision to either the appointed person or to the High Court.*

*An appointed Person is a senior intellectual property lawyer appointed by the Ministry of Justice.*

*Appealing to the appointed person offers a low cost alternative to appealing to the High Court however, if you do not like the decision of the appointed person, there is no scope to appeal the same.*

*It is more expensive to appeal directly to the High Court but if you do not like the decision of the High Court, you have the option of appealing to the Court of Appeal.*

## Decision time

Once the written submissions have been filed or the hearing attended, the case will be ready for a written decision. A decision should be issued within nine to twelve months depending on the complexity of the matter.

When the decision is made, a copy will be sent to both parties to the dispute and will also include details of the award of costs. The amount awarded will be dependent upon conduct throughout the proceedings and what the successful party has had to do.

## Why do I need Barker Brettell's help?

Preparing and filing an opposition or responding to an opposition is a complicated task and a lot of factors have to be taken into account. There is no hard and fast rule as to what information and evidence should be filed in opposition proceedings as each case has to be decided on its merit and the evidence needed, will depend on the circumstances.

Our trade mark attorneys will collate the information into a suitable format for filing in support of your case. Our attorneys are here to make your life easier.

At Barker Brettell LLP, all our trade mark attorneys have many years' experience in handling oppositions before the UKIPO. Our attorneys will provide you with guidance from the outset as to what claims to make and what information will be needed, together with a strategy.

We can advise you more on these issues, as well as on any of the other aspects of intellectual property. Barker Brettell LLP offers a full range of intellectual property services, and we are always happy to take the time to tailor our services to your needs.