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Keltie



Focus on UK/OHIM opposition
procedures, similarities and differences

Sean Cummings

Partner, Keltie

UK and European Patent and Trade Mark Attorney

The significance of opposition

- From the beginning, OHIM has never had examination on relative grounds
 - CTM is an opposition-based system
 - circa 20% of CTM applications are opposed
- Forced to emulate OHIM, UKIPO abolished examination on relative grounds in 2007
 - UK also now has an opposition-based system
 - inevitable increase in UK oppositions

Opposition stages

- Opposition period
 - when must an opposition be filed?
- Setting out the case
 - notice of opposition; cooling-off; suspension; defence
- Evidence rounds
- Reaching a decision
- Appeal
- Other issues

Opposition period

- Two months in UK
 - extensible by one month to three months
 - extension must be requested within two months
 - i.e. no retrospective extension
 - no extension is possible beyond three months
- Three months in CTM
 - no possibility of extension

Setting out the case - UK

- Notify Applicant of intention to oppose
 - gives Applicant a chance to limit or withdraw
 - costs penalty likely if you don't notify in good time
- Notice of Opposition
- Cooling-off
- Counterstatement

Setting out the case - CTM

- Notice of opposition
 - admissibility checks
 - need for representation
- Languages and translations
- Cooling-off
- Adversarial stage when cooling-off period expires or either party opts out of cooling-off

Cooling-off period - UK

- Applicant has two months to file its counterstatement
- Cooling-off period is, in effect, an extension to file the counterstatement
 - must be requested within the initial two-month period
 - request can be filed by either party but requires mutual agreement
 - initial cooling-off period is nine months
 - cooling-off period is extensible by a further nine months to a maximum of eighteen months if the parties state that they are in active negotiations

Cooling-off period - CTM

- Adversarial proceedings deemed to begin two months from notice of admissibility
 - i.e. automatic two-month cooling-off period
- Cooling-off period may be extended up to a total of 24 months if both parties sign requests
 - OHIM will grant an extension of 22 months, irrespective of length of extension requested
 - no reason required
 - must be requested before end of initial period

Suspension - UK

- Suspension is possible at any stage
 - discretionary; needs compelling reasons
 - always requires mutual agreement
- No specific limit on the length of suspension
 - typically involves repeated three-month periods

Suspension - CTM

- OHIM “may” suspend opposition proceedings
 - suspension therefore discretionary; needs reasons unless by mutual agreement
- Suspension is possible on request of one of the parties before adversarial proceedings
- Suspension is possible during cooling-off period in limited circumstances
 - e.g. earlier mark is a pending application whose outcome is uncertain
- Suspension is not possible during cooling-off period on the basis of ongoing negotiations

Refunds during cooling-off

- If the application is restricted or withdrawn during the cooling-off period:
- OHIM will refund the opposition fee...
- ... but the UKIPO will not

Proof of use - UK

- The Notice of Opposition requires a statement of use:
 - i.e. that any earlier trade mark(s) relied on in the opposition have been used - and for which goods/services - if they have been registered for more than five years
- In its Counterstatement, the Applicant may deny, require proof or admit to this use
 - evidence of Opponent's use of earlier mark(s) - if necessary - is filed in the Opponent's first evidence round

Proof of use - CTM

- Applicant may request proof of use of the earlier trade mark(s) relied on in opposition, if registered for more than five years
- The request must be made within the period set by OHIM for the Applicant to file its observations on the opposition
- Opponent's evidence must then prove the use

‘Preliminary indication’ - UK

- Where opposition is based upon an earlier conflicting mark, UKIPO may issue a preliminary indication – a *prima facie* view
- Aim is to narrow the issues at an early stage; may even bring proceedings to a close
- Various provisions apply depending upon whether the preliminary indication is for complete acceptance or complete refusal of the application, or for partial success

Evidence rounds - UK

- Opponent's evidence
- Applicant's evidence
- Opponent's evidence strictly in reply
- Each round of evidence involves extensible three-month periods
 - extension if demonstrably reasonable; other party's objection/agreement taken into account

Evidence rounds - CTM

- Opponent's observations/evidence
 - two months from the end of the cooling-off period
- Applicant's observations/evidence
 - two months from service of opponent's evidence
- Optional further round(s)
 - opponent may comment on applicant's submissions
- Deadlines extensible in two-month periods with good reasons or by mutual agreement

Reaching a decision - UK

- Some cases are decided on the papers...
 - if the parties request/agree
- ... but most cases are decided at a Hearing
 - most Hearings in UKIPO London or Newport, some elsewhere in UK if convenient for the parties
- Hearings allow evidence to be tested
 - limited cross-examination, e.g. if conflict of evidence
- Hearings can be costly
 - common for Counsel to represent the parties

Reaching a decision - CTM

- Oral proceedings (a Hearing) theoretically possible before OHIM...
- ... but OHIM's policy is to decide cases on the papers, so Hearings are practically unknown

Appeal - UK

- Two appeal routes, mutually exclusive:
- Appeal to the 'Appointed Person' (senior counsel appointed by the UKIPO)
 - no further appeal possible by this route
- OR
- Appeal to the High Court
 - further appeal possible to Court of Appeal and Supreme Court (with leave)

Appeal - CTM

- Appeals are decided in the first instance by OHIM's Boards of Appeal
 - file Notice of Appeal within two months of decision
 - file Grounds of Appeal within four months of decision
- Further appeal possible to the Court of First Instance of the European Communities (CFI)
- Ultimate appeal to the Court of Justice of the European Communities (ECJ)

Conversion of a CTM

- The Applicant may withdraw a CTM application and then request its conversion into separate applications for national trade marks
- Where the CTM is designated in an IR, the Applicant may convert it into separate designations of the EU states that belong to the IR system
- Allows the Applicant to obtain protection in EU countries where there is no earlier national right

Costs

- In principle, the losing party bears the costs incurred by the winner in addition to its own costs...
- ... but UKIPO and OHIM use set scales
 - the costs awarded are usually much less than the actual costs incurred, particularly if the winner did not succeed on all points
- OHIM costs orders are difficult to enforce; but UKIPO may issue an unpaid costs order

Conclusions

- UK and CTM procedures have more similarities than differences, as the UKIPO has emulated OHIM practice in many ways...
- ... but UKIPO procedures are also influenced by the flexible and proactive approach of the English courts
- UKIPO has a distinctive approach that allows a thorough court-like examination of the issues

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Thank you