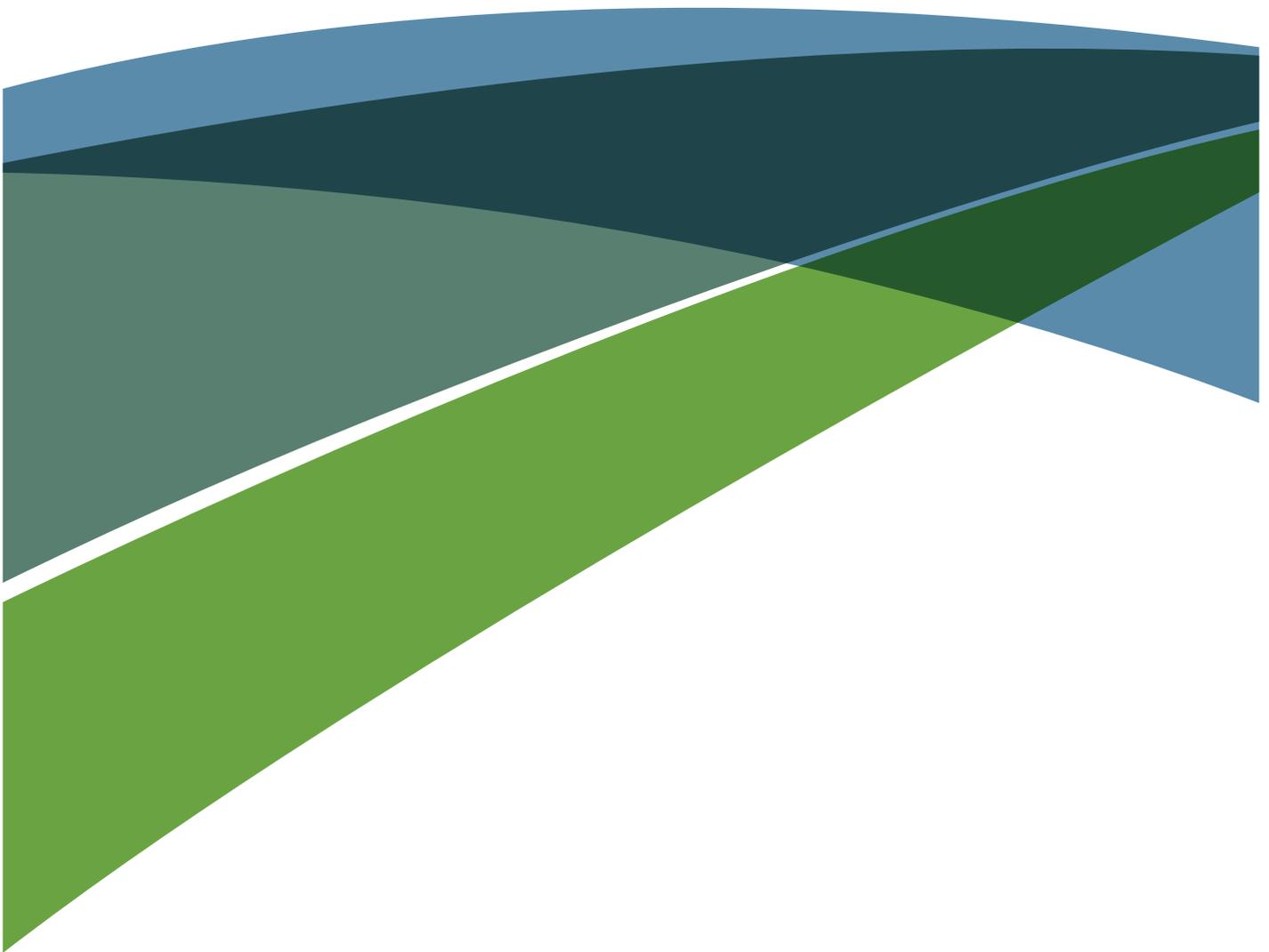




Intellectual  
Property  
Office

# Trade Mark Invalidation Guidance



## **INVALIDATION:** Guidance following the filing of a TM8 – Notice of Defence

A Form TM26(I) (Application to start invalidation proceedings) and Form TM8 (Notice of defence and counterstatement) have been filed. These are known as the **pleadings**. If, at any time, either party wishes to amend their pleadings, they can seek permission to do so.

### **Amendment of pleadings**

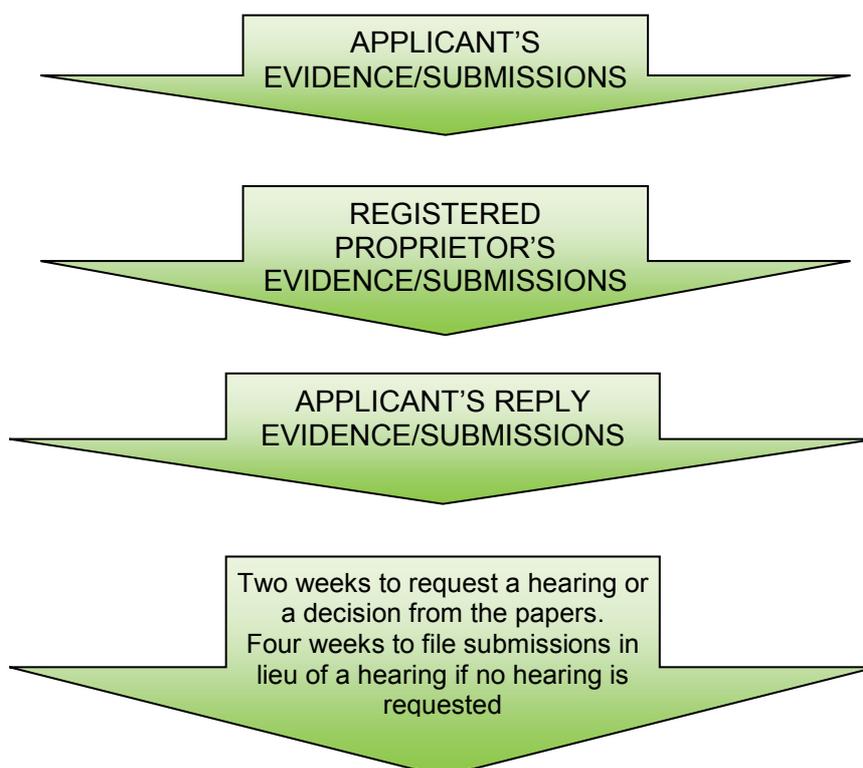
If you wish to **add or amend a ground of invalidity** it is essential you ask permission to do so at the earliest opportunity. The request should be made in writing and should set out in full the addition or amendment sought and, if appropriate, the reasons why it is being made after completion of the pleadings stages. This will help ensure that proceedings continue promptly and costs are kept to a minimum for all involved.

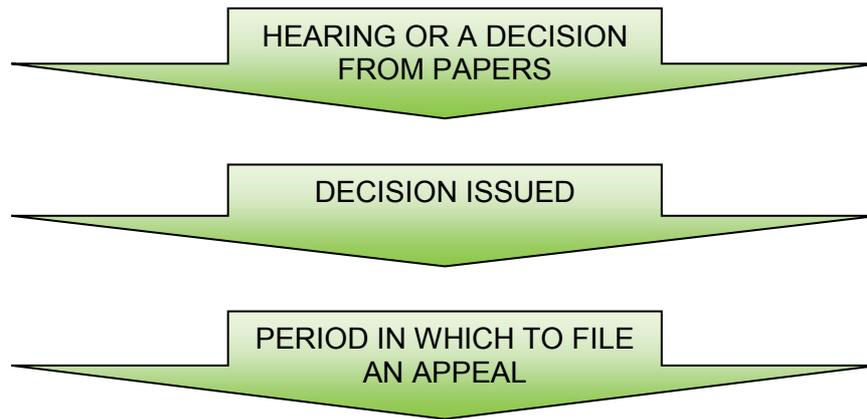
If you wish to **withdraw a ground of invalidity** you do not need permission but should notify the registrar and the other party as soon as possible. Again this will help ensure that delays and costs are kept to a minimum and that the parties' focus is directed towards issues in dispute.

### **What happens next?**

The proceedings now move on to the **evidence rounds**. With this guidance you will have received a letter from us setting dates by which the applicant and the registered proprietor may file evidence and/or submissions. Once the evidence rounds are complete, the proceedings will be ready for determination, either from the papers on file or following a hearing, and this will be notified to the parties by way of a **decision**.

The following diagram shows the remaining steps in these proceedings, which will be explained in more detail below:





During this process any documents you send to the Registry **MUST** also be sent to the other party in the proceedings (through their legal representatives if they have appointed any). If you fail to copy them to the other party, they will not be considered as having been filed and will not be admitted into the proceedings.

### **What are the evidence rounds?**

Once the pleadings have been filed, the parties are each given an opportunity, in turn, to file **evidence** and/or **submissions** in support of their cases. It is important to note that **Evidence** and **Submissions** are not the same thing.

In *KILLER CHORUS* (BL O/431/12), a decision issued by Mr Geoffrey Hobbs QC, acting as the Appointed Person, the difference was explained. He stated:

“The reference in Rule 20(1) to ‘**evidence and submissions**’ maintains the legally and procedurally important distinction between filing ‘**evidence**’ i.e. information introduced into the proceedings under the provisions of Rules 62 and/or 64 for the purpose of substantiating the facts and matters to which it relates; and filing ‘**submissions**’ i.e. representations made by the party putting them forward as to the position and approach which the Registrar should adopt in relation to the matters addressed.”

This was further commented on, again by Mr Hobbs, in Telegu NRI Forum (BL O/210/18).

### **How do I file evidence?**

Evidence may be filed in the form of a witness statement, an affidavit or a statutory declaration. A witness statement is normally sufficient and is generally a simpler, cheaper option to prepare. It should be headed up to refer to the proceedings by setting out names of the parties and the application and invalidation case number. An example of how to present a witness statement may be found at <https://www.gov.uk/government/publications/evidence-of-use-witness-statement> but it is important to note that a witness statement must include a statement of truth signed by the person making the statement. That person should be the person with direct, first-hand knowledge of the **facts** they are providing and/or who has access to the records or documents from which the facts have been taken. This means that it is rarely appropriate for evidence of fact

to be given by your legal representative. Evidence which relies on something that the witness has been told by someone else is hearsay evidence and may be given reduced or no weight.

Anyone who makes a witness statement, affidavit or statutory declaration may be called to be cross-examined on their evidence.

As **evidence** a witness statement should not be filed to give legal argument or opinion. For example, if you are providing evidence of the use made of your mark, you should provide the following facts which should relate to the use made of the mark during the relevant period:

- The date the mark was first used in the UK;
- The form in which the mark has been used;
- Where, specifically, the mark has been used;
- On which goods and/or services the mark has been used;
- The turnover or sales volumes of goods or services sold under the mark (or a reliable estimate of the same);
- Details of advertising and marketing e.g. how much has been spent on advertising the goods or services under the mark, where and when it took place and what form it took.

The witness statement may be accompanied by **exhibits**.

### **What are exhibits?**

If you have documentation which supports the facts you have given in your evidence, you may file them as exhibits to your witness statement. Examples of such documentation are:

- Invoices for goods or services supplied under the relevant mark;
- Turnover or advertising spend as shown in company records;
- Advertising or marketing literature showing the relevant mark;
- Photographs or printouts showing the goods or services being offered for sale under the relevant mark.

Such documents should be included as separate exhibits which should accompany, and which should be referred to in, the witness statement. Normal practice is to use the initials of the person making the witness statement. For example, three exhibits referred to in a witness statement made by John Butler would be numbered JB1, JB2 and JB3.

Witness statements and exhibits should be clear and easy to read and the pages should be numbered. There is a limit to the number of pages of evidence that may be filed. Further information can be found in the Tribunal Practice Notice 1/2015 available from the IPO website at <https://www.gov.uk/government/publications/tribunal-practice-notice-12015>

### **When do I file written submissions?**

**Submissions** are a method of presenting your **legal argument and opinion** rather than facts. Submissions filed during the evidence rounds may be used to explain the purpose of any evidence you have filed. They may also set out your views on the other party's case and/or set out specific challenges to (parts of) their evidence.

Submissions which set out why the law and facts mean that a party should succeed or fail on the particular grounds raised in the pleadings are ones that should be provided as final written submissions which you may file as an alternative to attending a hearing. If you attend a hearing, your final submissions can be made orally at that hearing.

### **What happens when the evidence rounds are completed?**

Once the evidence rounds have been completed, the proceedings move forward for a **decision**. There are two routes to a decision. The parties will be invited to either:

- Ask to be heard (in which case an oral hearing will be arranged even if only one party seeks a hearing); or
- Make final written submissions in lieu of a hearing (in which case the decision will be made from the papers already on file).

If either party asks and is given permission to cross-examine any witness who has given evidence, the case will proceed to an oral hearing.

### **The decision**

Following either an oral hearing or a decision from the papers, the Hearing Officer will issue a decision which will include the reasons for reaching that decision. The parties will be sent a copy of the decision and it will be published on our website. The decision will be open to **appeal**.

### **Appeals**

Either party may appeal the decision. Further details on how to appeal and the date by which an appeal should be made, will be sent to you with the decision.

Concept House  
Cardiff Road  
Newport  
NP10 8QQ

**Tel:** 0300 300 2000  
**Fax:** 01633 817 777  
**Email:** [information@ipo.gov.uk](mailto:information@ipo.gov.uk)  
**Web:** [www.gov.uk/ipo](http://www.gov.uk/ipo)

**Facebook:** TheIPO.UK  
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