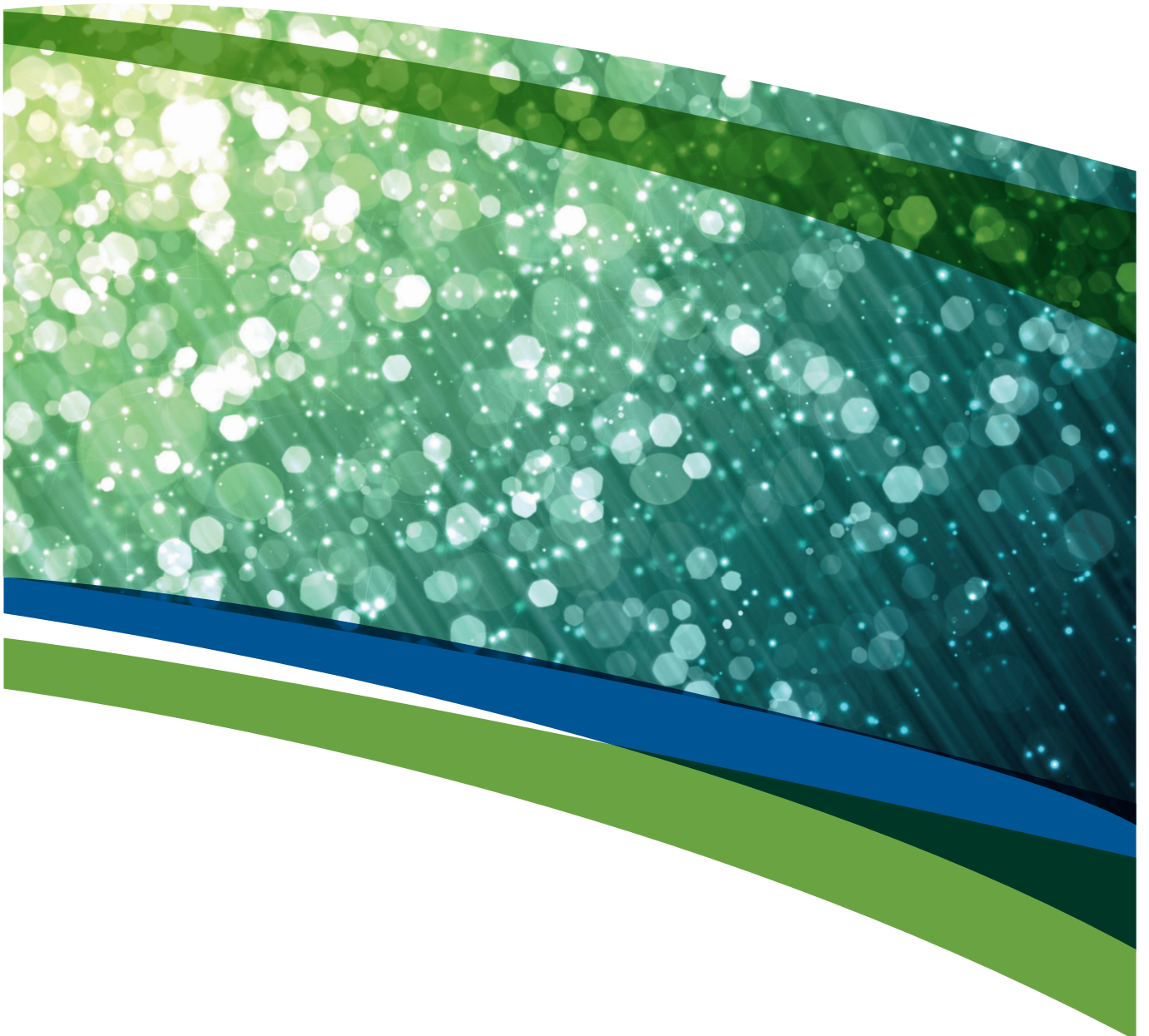




Intellectual
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Opposition: Guidance following the filing of a TM8 – Notice of Defence

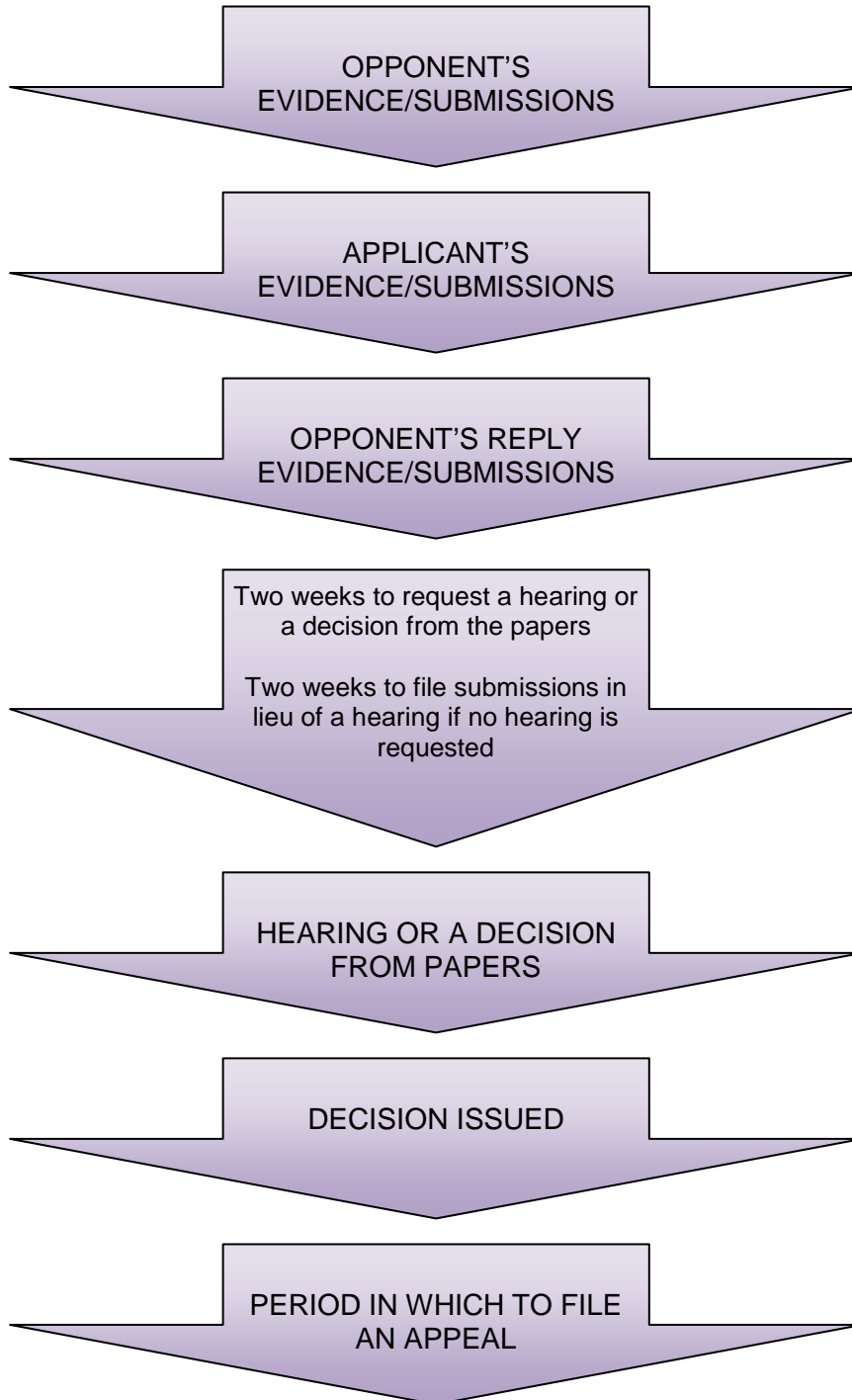


OPPOSITION: Guidance following the filing of a TM8 – Notice of Defence

1. What happens next?

With this guidance you will have received a letter from the trade mark registry setting dates by which the opponent and the applicant may file evidence and/or submissions.

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. If you send evidence to the Registry and not to the other party, the evidence will not be considered as filed.

Once the trade mark applicant has filed its TM8 and Notice of Defence, the parties are each given an opportunity to file evidence and/or submissions in support of their case. This guidance seeks to clarify the differences between evidence and submissions and how these can best be utilised by the parties.

2. What is evidence?

Evidence is a document, which is sometimes accompanied by supporting documents, containing facts relating to the case. Evidence does not include legal argument.

3. How do I file evidence?

Evidence must be headed with the name and number of the proceedings. It should be made up only of relevant facts and must be presented in the form of a witness statement, affidavit or statutory declaration. A witness statement is normally sufficient and must include a signed statement of truth. An example of how to present a witness statement can be found at the following link:

<http://www.ipo.gov.uk/hearings-ch3annex1.pdf>

Documents mentioned in the statement should normally be attached to the statement as exhibits (which are explained at question 6 below).

Statements and exhibits should be clear and easy to read and should have the pages numbered. They will need to be referred to later, so proper numbering is important.

4. What should be included in the witness statement?

A witness statement should contain facts that relate to your case. For example, if you need to show that your trade mark has been used you should, where possible, include at least the following information:

- the date on which the mark was first used in the UK and how it has been used,
- where it has been used and for which products and/or services,
- The number of goods and/or services which have been sold under the trade mark or a reliable estimate of the same,
- How much has been spent advertising the goods/services sold under the trade mark.

5. Who can make a witness statement?

A witness should be someone with firsthand knowledge of the facts they are providing or with access to the records or documents from which the evidence is taken. They need to say who they are, what their position is, and explain the source of their knowledge.

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.

Evidence of fact should not normally be given by your legal representative. Where a legal representative does give evidence of fact they may be called for cross examination like any other witness.

6. What are exhibits?

Exhibits are documents which you refer to in your statement which support your case. They may include invoices, advertising literature, photographs, etc. showing the mark in use.

Exhibits should be referred to by number in your statement. Normal practice is to use the initials of the person making the witness statement. For example, three documents referred to in a witness statement made by John Butler would be numbered JB1, JB2 and JB3.

7. What are submissions?

Submissions are opinion and legal argument rather than facts. Submissions filed during the evidence stages should normally be challenges to, or criticisms of, the other side's evidence.

Arguments about why the law and facts mean that a party should win or lose on the main matters in the dispute are submissions but should be saved for the oral hearing or final written submissions instead of a hearing. Legal arguments are best presented by your legal representative, if you have one.

8. How can I add or remove a legal ground in these proceedings?

If you wish to add a ground it is essential to notify the Registry as soon as the need to add it becomes apparent.

Grounds which are no longer being pursued should be removed as soon as possible so that both sides are focused on the legal grounds that are still in dispute.

9. What happens at the end of the evidence rounds?

Once the evidence rounds have been completed the parties will be invited to:

Make final written submissions in lieu of a hearing (in which case a decision will be made from the papers on file) OR

Ask to be heard (in which case an oral hearing will be arranged)

It is during this period that the parties may ask to cross-examine one or more of the other side's witnesses.

10. The decision

Following either an oral hearing or a decision from the papers, the Hearing Officer will issue a decision which will include reasons for that decision. The Registry will tell you what the deadline is to appeal the decision.