

Invalidating a trade mark

Introduction

This booklet explains:

- how to apply for a declaration of invalidity of someone's registered trade mark in the UK; and
- how to defend your registered trade mark against anyone else trying to invalidate its registration.

We have done our best to make sure that the information in it is correct. However, the booklet does not set out to cover every part of trade mark law.

If you would like more information or help please:

- phone 08459 500 505 (we may record or monitor calls for training purposes);
- minicom 08459 222 250;
- fax 01633 811175;
- e-mail tribunal.section@ipo.gov.uk;

or

- visit our website at www.ipo.gov.uk

Or you can write to us at:

UK Intellectual Property Office
Trade Marks Registry
Tribunal Section
Cardiff Road
Newport
South Wales
NP10 8QQ.

Professional help

A trade mark attorney is legally and professionally qualified in trade mark matters. You do not have to use one to act for you but you may find it helpful if you are involved in invalidation proceedings. You can get the names of trade mark attorneys from:

- The Institute of Trade Mark Attorneys
Canterbury House
2-6 Sydenham Road
Croydon
Surrey
CR0 9XE
Phone: 020 8686 2052
Fax: 020 8680 5723
Website: www.itma.org.uk
- The Chartered Institute of Patent Agents
95 Chancery Lane
London
WC2A 1DT
Phone: 020 7405 9450
Fax: 020 7430 0471
Website: www.cipa.org.uk

This booklet has three separate sections

Section 1 provides information on:

- what is invalidation;
- how to apply to invalidate a registered trade mark; and
- how to defend your registration against an application for invalidation.

Section 2 provides information on:

- how to give evidence to support your case;
- how to ask for more time to prepare your evidence; and
- how someone else may apply to become involved in the proceedings.

Section 3 provides information on:

- trade marks hearings; and
- costs.

Annexes

- Annex A - section 3 grounds
- Annex B - section 5 grounds
- Annex C - list of costs.

Questions about invalidation

Our Central Enquiry Unit

You can phone our Central Enquiry Unit on 08459 500 505 **before** you apply to invalidate a registration.

Staff in this unit are not in a position to say if you could win your case, but they will be pleased to answer any general questions you may have.

Trade Marks Tribunal Section

Our Tribunal Section manages invalidation cases. We will not be able to say if you could win your case, because we have to remain impartial, but we will be pleased to answer any questions you may have about invalidation procedures.

Before or during an invalidation:

- phone 01633 814103.

For information about hearings:

- phone 01633 811035.

At any time:

- e-mail tribunal.section@ipo.gov.uk

Section 1

What is invalidation?

Invalidation is the legal procedure to try and remove a registered trade mark from the UK register. An application may seek to remove the entire registration, or only some of the goods or services it covers. If anyone starts invalidation proceedings, they become the 'applicant' in the case.

The most common reasons for someone wanting to invalidate, or partly invalidate, the registration of a trade mark are:

- they think the trade mark is one which is not unique to the proprietor and should be free for everyone in that line of trade to use; or
- they own a trade mark (which does not have to be registered itself) which is the same as, or similar to, the proprietor's trade mark, and they use it for the same or similar goods and services.

When can someone apply to invalidate a trade mark?

You can do this any time after a trade mark has been registered.

Who can apply for invalidation?

If a trade mark registration was published for opposition purposes in the Trade Marks Journal **prior** to 1 October 2007, then anyone can apply to have it declared invalid.

Any trade mark registration published **on or after**, 1 October 2007 can only be the subject of an application for invalidation by the proprietor or licensee of a trade

mark. The invalidation action can be made under the provisions of Section 3 and Sections 5 (1) (2) and (3) of the Trade Marks Act 1994.

Applications made under Section 5 (4) of the Trade Marks Act can only be brought by the proprietor of the trade mark.

Where do I apply?

You may apply to the Trade Marks Registry.

You may also apply to the High Court. If there are already court proceedings about the trade mark in being, you **must** apply to the High Court.

What may happen as a result of invalidation?

Invalidation proceedings can result in one of three ways:

1. the invalidation fails and we will leave the trade mark on the register;
2. the invalidation succeeds and we will remove the trade mark from the register and the registration is deemed never to have been made;
3. the invalidation partly succeeds. The proprietor may limit their list of goods or services to those which have not been objected to. We will change the register to list only those goods or services.

How to invalidate a registration

Contact the proprietor

You should contact the proprietor, preferably in writing, and tell them why you are thinking of invalidating their registration.

It helps everyone if you can settle your differences in a friendly way before starting formal invalidation proceedings. If you do not tell the proprietor that you are going to have the registration declared invalid and they surrender the registration before sending us notice of their defence, you will not be awarded any costs.

Tell us that you wish to start invalidation proceedings

You should send us:

- an 'Application to declare invalid a registration' (form TM26(I)) by fax or post;
- a statement of your reasons for making the application; and
- a fee of £200.

You can get a copy of form TM26(I) from our website at www.ipo.gov.uk

What does it cost?

You will have to pay a fee of £200 with your form to start invalidation proceedings.

Whoever loses the case usually has to pay towards the other person's costs.

We set the amount, which is listed in Annex C at the back of this booklet.

Where can I find out about the law on invalidation proceedings?

This is set down in Section 47 of the Trade Marks Act 1994 and Rules 41 and 42 of the Trade Marks Rules 2008. You can find these on our website at www.ipo.gov.uk

What must I put in the 'Application to declare invalid a registration' (form TM26(I))?

You must say:

- what trade mark you want to invalidate;
- who owns it;
- who you are; and
- who is your agent (if you have one).

You must say in your statement of reasons:

- why you want to invalidate the registration of the trade mark; and
- if you want to invalidate it because of your rights in any earlier trade marks, you will have to give full details of those trade marks and what use is being made of them. You must be the owner or licensee of any earlier right(s) which you are relying upon. (Please see Who can apply for invalidation? on the previous page).

What reasons can I give for invalidating a trade mark?

- You can invalidate a trade mark because you don't think it is a distinctive word, logo, picture or other sign that will clearly identify the proprietor's goods or services from those of other traders.

These reasons are called 'absolute grounds' in legal words. There is an extract from the law about absolute grounds (Section 3 of the Trade Marks Act 1994) in Annex A at the back of this booklet.

- You can invalidate a trade mark because you have already registered, or are licensed to use, an earlier trade mark which you think:
 - looks the same as or similar to the proprietor's for the same or similar goods or services; or
 - sounds the same as or similar to the proprietor's for the same or similar goods or services.

These reasons are called 'relative grounds' in legal words. There is an extract from the law about relative grounds (Section 5 of the Trade Marks Act 1994) in Annex B at the back of this booklet. Section 5 also includes other reasons based on non-registered rights that you can use as reasons for invalidating a trade mark.

- You can use either or both reasons for invalidating a trade mark.
- You have to be the owner or licensee of the earlier trade mark or marks to use them as your reasons for invalidating a trade mark. (Please see Who can apply for invalidation?)

Can I change my reasons for invalidating the trade mark?

You may ask to change your reasons for invalidating a trade mark at any time during the proceedings. But if it means the proprietor is put to extra expense you may have to pay towards those extra costs.

Do I have to show that an earlier trade mark is being used?

You will have to give a "statement of use" with your form TM26(l).

You must say in your statement:

- what goods or services the earlier trade mark has been used on in the five years before the date when you applied to invalidate the registered trade mark; or
- why the earlier trade mark has not been used in that time.

What if the earlier trade mark has not been used?

If we find later in the proceedings that you cannot show that you, as the owner or licensee, or a previous owner, has used the earlier trade mark we will not take it into account in the proceedings.

What happens after I have sent you my form?

We will check the form to make sure you have:

- paid the right fee;
- filled it in correctly; and
- given enough information for the

invalidation to go ahead.

If we do not understand anything on the form, we will write to you and allow you 21 days to make it clear or put it right.

What happens when the form is acceptable?

When we are satisfied that everything in the form is correct, we will send a copy to the proprietor of the trade mark. The date we do this is called the 'notification date'.

We will also tell the proprietor they have two months to defend their registration.

What must the proprietor do?

The proprietor may decide to defend their registration.

However, if the proprietor does not reply, then we will take it to mean that the proprietor does not dispute the ground for invalidation. We will issue a letter notifying the proprietor that:

- the applicant's grounds for invalidation, if true, identify a basis in law for invalidating the registration.
- no defence to the application has been filed and the applicant's grounds do not therefore appear to be disputed;
- unless the Registrar receives, within fourteen days of the letter, either a request to be heard or written submissions on the matter, the registrar will treat the application as unopposed and will declare the registration invalid.

We may order the proprietor to pay you something towards your costs. We set the amount, which is listed in Annex C at the back of this booklet.

How to defend a registration

Tell us that you wish to challenge the invalidation, that is, to defend your registration

If you want to challenge someone's invalidation of your trade mark registration, you must send us a 'Notice of defence and counter-statement' (form TM8) **within two months** of the date when we sent you a copy of their application to invalidate (the notification date). You can get a copy of form TM8 from our website at www.ipo.gov.uk

What does it cost?

You do not have to pay any fee for sending us form TM8.

What should I say to defend my registration?

If you agree with anything the applicant has said in their statement of reasons, you should say so.

If you do not agree with what the applicant has said, you should say why you disagree and give reasons to support your case.

Should I admit or deny the statement of use?

If the applicant has given a statement of use of any earlier trade marks with their form TM26(1), you will have to admit (that is, agree) or deny (that is, disagree with) this statement in your counter-statement (form TM8).

- If you agree the statement of use, the applicant does not have to give any evidence of their use.
- If you disagree with the statement of use and request in your notice of defence (form TM8), the applicant will have to give evidence to show that the earlier trade marks have been used by them or a previous owner/licensee if the dispute goes to the evidence rounds.

What happens after I have sent you my form?

We will check the form to make sure you have:

- sent it inside the two month deadline; and
- given enough information for the case to be defended.

If we do not understand anything on the form, we will write to you and allow you 21 days to make it clear or put it right.

What happens when the form is acceptable?

When we are satisfied that everything in the form is correct, we will send a copy to the applicant. The date we do this is called the 'initiation date'.

We will then get the time periods for both sides to give their evidence.

Section 2

Evidence rounds

Why must I give evidence?

You must give us evidence to back up anything you say in your reasons for wanting to invalidate a registration or for defending your registration. You must also send a copy of your evidence to the other side in the proceedings.

What can I give as evidence?

We cannot tell you what to say. You must decide what information will help to support the reasons you have given for invalidating or defending a registration.

How should I present my evidence?

You should give your evidence in the form of a:

- witness statement;
- statutory declaration; or
- affidavit.

It helps if you can back up your evidence with examples of how any earlier trade marks have been used, such as packaging, advertising brochures or even samples of the product. We call these 'exhibits'.

When must I give evidence?

We set the deadlines for both sides to give their evidence.

Is there a limit to how much evidence I can give?

You can give as much evidence as you wish to back up what you say in your application to invalidate or your notice of defence.

Can I send samples of my products as evidence?

You may send samples of your products as exhibits to illustrate what you say in your evidence. But as you also have to send copies of your evidence to the other side in the proceedings, you may find it easier to send photographs of the product.

Can I give any more evidence?

Either side can ask us if they can give more evidence at any time during the proceedings. They must say:

- why they want to give more evidence;
- what the evidence will be about, or they may send a copy of the evidence; and
- why they could not give the evidence any earlier.

We will decide whether to allow the new evidence to be taken into account.

What happens after both sides have given all their evidence?

A decision can be made from the evidence and written submissions made by the parties. This “decision from the papers” will involve a thorough analysis of all the evidence and full consideration of any written submissions made by the parties.

Alternatively a hearing can be requested at which the hearing officer will make a thorough analysis of all the evidence and any submissions will be oral rather than written.

Can we settle without having a hearing?

Both sides may agree to settle an invalidation action at any time before a hearing date is set.

The applicant may agree to withdraw their application to invalidate. We will then leave the trade mark on the register

The proprietor may agree to fully give up (in legal words ‘surrender’) their registration in full. They do this by sending us a ‘Notice to surrender a registration’ (form TM22). We will action this and remove the trade mark from the register.

The proprietor may agree to give up their registration just for some goods or services. They do this by sending us a ‘Notice of partial surrender of a registration’ (form TM23). We will action the partial surrender and remove the

appropriate goods or services from the register.

You can get copies of forms TM22 and TM23 from our website at www.ipo.gov.uk

You do not have to pay anything when you send them to us.

In both these situations, the invalidation action will continue unless the applicant writes to us to withdraw the application for invalidation.

Extensions of time

Can I have more time to give my evidence?

Anyone who needs more time to prepare their evidence may send us a 'Request for an extension of time' (form TM9) with a fee of £50.

You must say:

- how much more time you want;
- why you want more time:
- what you have already done to prepare your evidence;
- what else you have to do;
- why you have not been able to do this in the time you have already had.

We will write to tell you if our preliminary view is to agree your request, and send a copy of our reply to the other side in the proceedings.

You must send a copy of your request to the other side in the proceedings. If you do not do so we will not agree to your request.

What if I disagree with your preliminary view?

Either side has fourteen days to write to tell us if they do not agree with our view.

You can either send us your detailed reasons in writing, or ask for an 'interlocutory hearing' to put your case.

If neither side replies to our view within the fourteen day deadline, we will put it into action.

Intervention

What is intervention?

The owner of an earlier trade mark or right, or a person with a written licence to use an earlier trade mark, may apply for invalidation. However, anyone other than the proprietor, or licensee, who claims to have an interest in a registered trade mark, may apply to intervene in invalidation proceedings.

Who can have an 'interest' in a registered trade mark?

This usually means:

- a subsidiary or related company of the proprietor or licensee of the trade mark which uses the mark itself; or
- a new owner of the trade mark who has not yet recorded their ownership in the register.

How do I apply to intervene?

You should send us:

- an 'Application to intervene in proceedings' (form TM27) by fax or post; and
- a statement of your reasons for making the application.

You can get a copy of form TM27 from our website at www.ipo.gov.uk

What does it cost?

You do not have to pay any fee for sending us form TM27.

When can I intervene?

There is no time limit for sending us your application, but ideally you should do so as soon as you know about the invalidation proceedings.

What happens after I have sent you my form?

We will send a copy of your form to the applicant for invalidation and, if we think it appropriate, to the registered proprietor of the trade mark. We will ask what they think about your request.

We will decide your request, taking into account what the other sides involved may have told us.

What happens if you agree my request?

If we agree your request, you take the place of the proprietor for the rest of the invalidation proceedings. This means you have to take on the proprietor's counterstatement and evidence, and pay the costs if you lose the case.

What happens if you do not agree my request?

You may ask for an 'interlocutory hearing' to put your case.

Section 3

Hearings

What is a hearing?

A hearing is the opportunity for us to listen to what both sides in a trade mark dispute have to say about a case, and to decide who has the stronger case, based on trade mark law. Although it has proper legal status, it is not as formal as a trial in other courts.

The person who decides the case is one of our senior officials called a 'Hearing Officer'.

What does it cost?

There is no charge for a hearing, but the side which loses their case may have to pay something towards the other side's costs. We set the amount which is listed in Annex C at the back of this booklet.

Where are they held?

We regularly hold hearings in our London and Newport offices.

We can also arrange video or phone hearings between our London and Newport offices, or between either of those offices and some other location if we can set up a suitable link.

Who organises a hearing?

If both sides can agree a date, either of them may book a hearing through our website at www.ipa.gov.uk

This lists which dates are available up to about a month ahead.

Otherwise we will set a date and tell both sides when to attend. If this date is not suitable, you should arrange a suitable date with the other side and phone us so that we can set up the hearing.

What if I find I can't attend after a date has been arranged?

Phone our hearings clerk at once on 01633 811035. You may ask us to rearrange a date or agree to the hearing being held without you being there – see below.

Are hearings open to the public?

Generally all hearings involving disputes between two sides are open to the public, though we have the power to hold them in private if we think there are good reasons for doing so.

Do I have to attend?

You do not have to attend a hearing. If you tell us you are not going to attend, we will hold the hearing without you. We will take into account everything you have sent us in your written evidence. You may also set out your case in writing – what you would have said if you had attended – and send it to us and the other side at least a week before the date set for the hearing. We call this your 'written submission'.

What else should I do before a hearing?

You must send us and the other side a written outline of your case by 2pm at least two working days before the hearing. We call this a 'skeleton argument'. The other side must also send you their skeleton argument, so that everyone will be able to follow the case on the day.

Types of hearings

There are two types of hearings:

1. Interlocutory hearings

These are held to decide a point of procedure during the course of a dispute and not the main point at issue. They often deal with one side's disagreement with our decision about a request for an extension of time or costs. The hearing will deal only with the disputed issue and nothing else.

How much notice will be given?

If both sides can agree a date, either of them may book a hearing through our website at www.ipo.gov.uk. This lists which dates are available up to about a month ahead. Otherwise we will set a date and give both sides at least fourteen days' notice.

What happens at the hearing?

Each party attending the hearing will have the opportunity to put its case to the hearing officer.

When will we be told the result?

The hearing officer may give a decision at the hearing, or a written decision will be issued within 48 hours of the hearing.

2. Main hearings

These are held to decide the main point at issue, that is, the invalidation of a registered trade mark.

How much notice will be given?

If both sides can agree a date, either of them may book a hearing through our website at www.ipo.gov.uk. This lists which dates are available up to about a month ahead. Otherwise we will set a date and give both sides at least one month's notice.

What happens at the hearing?

The order is as follows:

- the applicant puts their case;
- the proprietor puts their case;
- the applicant may then reply to what the proprietor has said; and
- The hearing officer may question either side at any time if it is not clear what they have said, either during the hearing or in their written evidence.

When will we be told the result?

The hearing officer will not be able to tell you their decision on the day. We will send both sides a copy of the hearing officer's written decision about four to six weeks after the hearing. Their decision will explain the background to the case, what they have decided and why they have reached their decision. It will refer to relevant trade mark law as laid down in Acts of Parliament and previously decided court cases. It may also include an order that one side should pay costs to the other.

We will also publish the decision on our website at www.ipo.gov.uk. As the website has details of recent cases you may find it useful to see the sorts of issues which we have decided.

Appealing the final decision

What if I do not agree with the decision?

If you feel that, in reaching his decision, the hearing officer, has made an error on a point of law, then you can appeal the decision. An appellate tribunal will not substitute their own view unless it finds that the hearing officer has made an error in their legal approach to the facts of the case. We have a separate booklet 'How to appeal against a decision made by the Trade Marks Registry' which explains this. You can get a copy from our website at www.ipo.gov.uk or by phoning us on 08459 500 505. There are strict deadlines for putting in an appeal (only 14 days in some cases), so please do not delay.

What if both sides agree with the decision?

We will put the decision into action as soon as the deadline for any appeal has passed.

What does it cost?

It costs £200 to start invalidation proceedings, but you do not have to pay anything to defend your registration or to go to a hearing.

The hearing officer will usually order that the side which loses the case should pay something towards the other side's legal expenses. The amount to be paid is shown in Annex C at the back of this booklet, but in some cases the hearing officer may award more or less than the amounts listed.

Deciding the amount

- If you surrender your registration before we take a final decision, the other side may still ask us to award them something towards their costs. We will write to ask for your views and give you fourteen days to reply.
- We will send both sides our view of the amount we are thinking of awarding, if any, and allow fourteen days for a reply. If either side does not agree with our view they may ask for an interlocutory hearing on the issue.
- If neither side replies by the deadline, we will confirm our view and issue an order for costs against the side which has withdrawn or lost the case.

What if we settle without the need for a hearing?

We would expect the agreement you make to cover the matter of costs, but we do not usually get involved in such issues.

Starting an invalidation without warning the proprietor

You should tell the proprietor that you intend to start invalidation proceedings and give them a chance to surrender their registration or to limit the list of goods or services in their registration.

If you do not do so and they surrender their registration before sending us notice of their defence, you will not be awarded any costs.

Making sure costs are paid

We have no power to make the side which loses pay the other side their costs, although we publish on our website a list of those who have not paid their costs. You can get advice about recovering your costs from the Small Claims Court Service. Their website is at www.courtservice.gov.uk

Annex A

Trade Marks Act 1994

Section 3 – Absolute grounds for refusal of registration:

Grounds for refusal of registration

3. - (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of –

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is –

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Annex B

Trade Marks Act 1994

Section 5 – Relative grounds for refusal of registration:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Annex C

Our costs

Preparing a statement and considering the other side's statement

From £200 to £600 depending on the nature of the statements, for example their complexity and relevance

Preparing evidence and considering and commenting on the other side's evidence

From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

Preparing for and attending a hearing

Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

Expenses

(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time)

(b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross exam