

Rectifying an error or omission in a trade mark in the UK register

Introduction

This booklet explains:

- how to apply to rectify an error or omission in someone's trade mark in the UK register of trade marks; and
- how to defend your registered trade mark against anyone else trying to rectify its details in the register.

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 want to rectify an error or omission in your own trade mark, you should read our shorter leaflet 'Rectifying an error or omission in **your** trade mark in the UK register'.

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
- 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 rectification 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 rectification;
- how to apply to rectify an error or omission in the register; and
- how to defend your registration against an application for rectification.

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 - list of costs

Questions about rectification

Our Central Enquiry Unit

You can phone our Central Enquiry Unit on 08459 500 505 **before** you apply to rectify 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 rectification 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 rectification procedures.

Before or during a rectification action:

- phone 01633 811011.

For information about hearings:

- phone 01633 811035.

At any time:

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

Section 1

What is rectification?

Rectification is the legal procedure which allows someone to apply to correct (rectify) an error or an omission that has been made in the details of a trade mark recorded in the UK register of trade marks.

If anyone starts rectification proceedings, they become the 'applicant' in the case.

Common reasons why someone may want to rectify the trade mark register include:

- spelling errors in the name or address of the trade mark owner; or
- the wrong trade mark owner is shown in the register.

You may not apply to rectify an error or omission if the change would affect the validity of the trade mark, for example, asking to change the spelling of the words in a trade mark.

Can someone who is not the owner of the trade mark apply to rectify it?

Anyone may apply to rectify a registered trade mark, but they must show that they have sufficient 'interest' in the trade mark in order to seek rectification.

When can someone apply to rectify a trade mark?

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

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 ongoing, you **must** apply to the High Court.

What may happen as a result of rectification?

An application to rectify can result in either:

1. we refuse your request and will leave the details as they are in the register; or
2. we agree your request and change the register of trade marks to show the details as you have asked for. This means the register will show the details of the mark as if the error or omission had never been made.

How to rectify a registration

Contact the proprietor

You should contact the proprietor, preferably in writing, and tell them why you are thinking of rectifying their registration. It helps everyone if you can settle your differences in a friendly way before starting formal rectification proceedings. If you do not tell the proprietor that you are going to apply to have the registration rectified 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 rectification proceedings

You should send us:

- an 'Application to rectify the register' (form TM26(R)) by fax or post;
- a statement of your reasons for making the application; and
- any evidence you wish to give in support of your application.

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

You may send just one form to cover a number of different registrations, where your reasons for applying are the same.

What does it cost?

There is no fee to start rectification proceedings.

However, if there are two sides involved in a dispute, whoever loses the case usually has to pay towards the other person's costs.

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

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

This is set down in Sections 60 and 64 of the Trade Marks Act 1994 and Rule 44 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 rectify the register' (form TM26(R))?

You must say:

- what trade mark you want to rectify;
- who owns it;
- who you are;
- who is your agent (if you have one); and
- what is the error or omission you want to correct.

You must give details in your statement of reasons:

- why you want to rectify the register; and
- how the error or omission occurred.

You may send in any evidence you wish to support the information given in your statement of reasons.

What happens after I have sent you my form?

We will check the form to make sure you have:

- filled it in correctly; and
- given enough information for the rectification action 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 alright, we will send a copy to the proprietor of the trade mark.

We will also set a deadline for the proprietor to defend their registration.

How to defend a registration

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

If you want to challenge someone's rectification of your trade mark registration, you must do this **within the deadline we set you.**

What if I do not send you my defence?

If you do not wish to defend your registration, you may write to tell us or you may do nothing and **we will decide whether to allow or refuse the application for rectification of your registered trade mark.** We may order you to pay something towards the other person's costs. We set the amount, which is listed in Annex A at the back of this booklet.

What does it cost?

You do not have to pay any fee to defend your registration.

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.

We will send a copy of your letter to the applicant and tell them if we need any more evidence.

Section 2

Evidence

Why must I give evidence?

You must give us evidence to back up anything you say in your reasons for wanting to rectify 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 rectifying 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.

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 rectify or your notice of defence.

Can I fax my evidence to you?

You may fax us your evidence to meet any deadlines we have set as long as you send us the originals within the next few days. We will check the originals to make sure they are the same as the faxed version.

Our fax number is 01633 811175.

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.

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; and
- 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 with 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 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?

Anyone other than the proprietor who claims to have an interest in a registered trade mark may apply to become involved (in legal words 'intervene') in rectification proceedings. This person is called the 'intervener'.

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 rectification proceedings.

What happens after I have sent you my form?

We will send a copy of your form to the applicant for rectification 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 rectification 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 A 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.ipso.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. 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 will usually tell you their decision as soon as both sides have stated their case. We will write to both sides to confirm the decision soon after.

2. Main hearings

These are held to decide the main point at issue, that is, the rectification 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.patent.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; and
- the applicant may then reply to what the proprietor has said.
- 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?

There is no fee to start rectification proceedings, or 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 A 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 a rectification without warning the proprietor

You should tell the proprietor that you intend to start rectification 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

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 examination.