

# Revoking a trade mark for reasons of non-use

## Introduction

This booklet explains:

- how to apply to revoke someone's registered trade mark in the UK because it has not been used; and
- how to defend your registered trade mark against anyone else trying to revoke 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](mailto:tribunal.section@ipo.gov.uk)
- visit our website at [www.ipo.gov.uk](http://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 revocation 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](http://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](http://www.cipa.org.uk)

## This booklet has three separate sections

Section 1 provides information on:

- what is revocation for reasons of non-use;
- how to apply to revoke a registered trade mark because it has not been used; and
- how to defend your registration against an application for revocation.

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 – Tribunal Practice Notice 01/2007
- Annex B – list of costs

Questions about revocation for reasons of non-use

### **Our Central Enquiry Unit**

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

Before or during a revocation action:

- phone 01633 811011.

For information about hearings:

- phone 01633 811035.

At any time:

- e-mail [tribunal.section@ipo.gov.uk](mailto:tribunal.section@ipo.gov.uk)

## Section 1

### What is revocation for reasons of non-use?

Revocation for reasons of non-use is the legal procedure which allows anyone to try and remove a registered trade mark from the UK register because they think that the trade mark has not been used. They may apply to remove the entire registration, or only some of the goods or services it covers. If anyone starts revocation proceedings, they become the 'applicant' in the case.

There are two reasons why someone may want to revoke, or partly revoke, the registration of a trade mark for non-use. They think the trade mark has not been used in the UK on the goods or services for which it is registered, either by the proprietor or by someone else with the proprietor's agreement:

- in the five years since the trade mark was registered; or
- for any uninterrupted period of five years;

**and** there are no proper reasons why the trade mark has not been used.

### **When can someone apply to revoke a trade mark?**

You can do this any time after a trade mark has been registered for at least five years.

The earliest date of revocation is the day following the fifth anniversary of the registration date. Further information on the correct approach to take when calculating the date from which

revocation takes place is available to Annex A at the back of this booklet and on our website at [www.ipo.gov.uk](http://www.ipo.gov.uk)

### **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 revocation for reasons of non-use?**

Non-use revocation proceedings can result in one of three ways:

1. the non-use revocation action fails and we will leave the trade mark on the register;
2. the non-use revocation action succeeds and we will remove the trade mark from the register, with effect from the date of non-use stated in the application; or
3. the non-use revocation action partly succeeds, if we find that the trade mark has been used on only some of the goods and services for which it is registered. We will change the register to list only those goods or services.

## How to revoke a registration for reasons of non-use

### Contact the proprietor

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

It helps everyone if you can settle your differences in a friendly way before starting formal revocation proceedings. If you do not tell the proprietor that you are going to apply to have the registration revoked 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 non-use revocation proceedings

You should send us:

- an 'Application to revoke a registration or a protected international trade mark (UK) for reasons of non-use' (form TM26(N)) 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(N) from our website at [www.ipo.gov.uk](http://www.ipo.gov.uk)

### What does it cost?

You will have to pay a fee of £200 with your form to start non-use revocation proceedings.

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

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

### Where can I find out about the law on revocation proceedings?

This is set down in Section 46 of the Trade Marks Act 1994 and Rule 38 of the Trade Marks Rules 2008. You can find these on our website at [www.ipo.gov.uk](http://www.ipo.gov.uk)

### What must I put in the 'Application to revoke a registration or a protected international trade mark (UK) for reasons of non-use' (form TM26(N))?

You must say:

- what trade mark you want to revoke;
- who owns it;
- who you are;
- who is your agent (if you have one); and
- the dates when you think the trade mark was not used.
- the date(s) from which you want the trade mark revoked.

You must say in your statement of reasons:

- why you think the trade mark has not been used; and
- the dates when you think the trade mark was not used.

### 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 revocation 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 correct, we will send a copy to the proprietor of the trade mark.

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

**What must the proprietor do?**

If the proprietor does not reply, we will issue a decision to remove (revoke) the trade mark from the register, with effect from the date of non-use stated in your application.

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

The proprietor may decide to defend their registration.

## How to defend a registration

### **Tell us that you wish to challenge the revocation action, that is, to defend your registration**

If you want to challenge someone's revocation of your trade mark registration, you must send us:

- a 'Notice of defence and counter-statement' (form TM8N);

You must do this **within two months** of the date on which we sent you a copy of the application for revocation. **We cannot extend this two month deadline.**

You can get a copy of form TM8N from our website at [www.ipo.gov.uk](http://www.ipo.gov.uk)

### **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. If you do not send us a 'Notice of defence and counter-statement' (form TM8N) within the two month deadline, **we will revoke 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 B at the back of this booklet.

### **What does it cost?**

You do not have to pay any fee for sending us form TM8N and evidence of use.

### **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.

### **You must give evidence of use of the trade mark in your defence.**

If you want to challenge the application for revocation you can send us your evidence of use with the form TM8N and the counter statement. However, if the counter statement is filed without your evidence, you will be allowed a period of not less than two months within which to file the evidence. You may do this by sending us, for example, brochures, catalogues, pamphlets, or advertisements, and some proof of sales of goods or the provision of services in the alleged period of non-use.

### **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 and evidence is acceptable?**

When we are satisfied that everything in the form and evidence of use 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 period for the applicant to give its 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 revoke 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 revoking 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 your trade mark has 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 revoke 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 through 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 a non-use revocation action at any time before a hearing is set up.

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

The proprietor may agree to 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](http://www.ipo.gov.uk)

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

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

## 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 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 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?**

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 revocation 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](http://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 revocation proceedings.

### **What happens after I have sent you my form?**

We will send a copy of your form to the applicant for revocation 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 revocation 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 B 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](http://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. 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](http://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 of 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 revocation 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](http://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](http://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](http://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 revocation 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 B 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 revocation without warning the proprietor

You should tell the proprietor that you intend to start revocation 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](http://www.courtservice.gov.uk)

## Annex A

### **Tribunal Practice Notice (TPN 1/2007)**

#### **Applications for revocation on the grounds of non-use: calculation of the date of revocation**

1. This practice notice is to clarify the calculation of the date from which revocation takes place under the grounds of sections 46(1)(a) and (b) of the Trade Marks Act (the non-use provisions). In box 7 of Form TM26(N), applicants for revocation on the grounds of non-use must specify the date (depending on whether section 46(1)(a) or (b) is invoked) on which the rights of the proprietor should be deemed to have ceased. Some applications received by the Trade Mark Registry's Law Section erroneously specify a date which is, in fact, often a day too early. The correct approach to calculating the date is explained below.

2. The Act says:

“46.— (1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

3. In *Philosophy di Alberta Ferretti Trade Mark* [2003] R.P.C. 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made, at the earliest, as soon as the initial five year period (following completion of the registration procedure) has ended. A successful application for revocation on the grounds of non-use, as provided for under section 46(6)(a) above will self-evidently mean that the date for revocation is the date that the application for revocation was made. However, that date must not be less than five years from the date the registration procedure was completed. In *WISI Trade Mark* [2006] RPC 17, Geoffrey Hobbs QC, sitting as the Appointed Person said, at paragraph 22:

“This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

4. For instance, if the registration procedure was completed on 18 March 2000, the five year period would expire on 18 March 2005. An application for revocation for non-use could only be made after the latter date. The earliest date that an application for revocation could be made would therefore be 19 March 2005.

5. Consequently, where an application for revocation on the grounds of non-use is made under section 46(1)(a), the applicant should ensure that it is made, at the earliest, on the day following the fifth

anniversary of completion of the registration procedure. If the revocation action is successful, rights in the registration (partial or full) will cease to exist, under section 46(6)(a), on the day following the fifth anniversary of the completion of the registration procedure.

<b>Completion of registration procedure</b>	<b>Five year period in which to commence use starts</b>	<b>Five year period in which to commence use ends</b>	<b>Earliest date the revocation application can be made</b>	<b>Successful revocation date</b>
18.3.2000	19.3.2000	18.3.2005	19.3.2005	19.3.2005

6. In the case of a revocation action founded upon section 46(1)(b) of the Act, where the applicant claims that the mark has not been used in the five years prior to the application, section 46(6)(a) of the Act will also apply to a successful revocation. In this instance, if the application is made on 18 March 2005 and this is the revocation date that is sought, the five year period during which there was no use will run from 18 March 2000 to 17 March 2005.

<b>Completion of registration procedure</b>	<b>Application for revocation filed</b>	<b>Revocation date sought</b>	<b>Five year period in which no use of mark</b>	<b>Successful revocation date</b>
2.4.1998	18.3.2005	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

7. Revocation actions may also be brought on the grounds of section 46(1)(b), but for a five year period which does not coincide with the date of the application (that is, that section 46(6)(b) will apply). For example, if the applicant claims a revocation date of 18 March 2005, this means that the five year period for which there has been no genuine use of the mark will run from 18 March 2000 until 17 March 2005, with the rights of the proprietor ceasing to exist on 18 March 2005: the revocation date.

<b>Application for revocation</b>	<b>Revocation date sought</b>	<b>Five year period in which no use of the mark</b>	<b>Successful revocation date</b>
1.12.2006	18.3.2005	18.3.2000 to 17.3.2005	18.3.2005

8. This notice confirms the correct approach and does not represent a new practice.

Raoul Colombo  
Head of Law Section  
Trade Marks Registry

Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

Phone +44(0)1633 811407  
Fax +44(0)1633 811175

## Annex B

### 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