

# Navigating UK Trade Mark oppositions post-Brexit

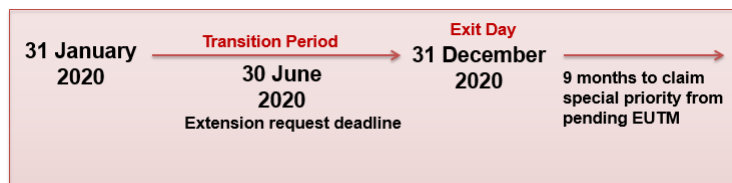
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## Introduction

- Overview of UK grounds of opposition
- Effect of Brexit on earlier EU rights
- Practical implications for UK opposition proceedings

## Key dates

- The transition period is currently due to come to an end on **31 December 2020**
- The UK-EU Joint Committee can request an extension of this by **30 June 2020**



## Grounds for UK trade mark oppositions

### Relative grounds (earlier rights)

- Sections 5(1) or 5(2) – double identity, similarity
- Section 5(3) – unfair advantage, detriment to distinctive character/reputation
- Section 5(4)(a) – unregistered trade mark rights, passing off
- Section 5(4)(b) – copyright, other industrial property rights, e.g. UK registered designs, Registered Community Designs (RCDs)

## Registered EU Trade Marks

- EUTMs, and EU(IR) designations, which are in “registered” or “protected” status before exit day will automatically be cloned into national UK trade mark registrations, at no extra charge, through the creation of “**comparable rights**” on **1 January 2021**
- The comparable UK mark becomes fully independent and keeps EUTM original filing, priority dates and UK seniority dates
- May opt-out after 1 January 2021 if you do not wish ever to have had a right in the UK (e.g. due to co-existence agreement)

## Pending EU Trade Marks

- There will be a **nine-month “special priority period”** for any marks **pending (including under opposition)** before exit day to claim the EUTM date for a UK application
- Usual UK filing fees will apply if the nine-month special priority period is to be used
- EUTMs eligible for conversion 3 months prior to 31 December 2020

## Renewal dates post Brexit

- Separate UK renewal will be required for comparable right
- Keep an eye on renewal date – if it is soon after exit day, the UKIPO may not have time to send you renewal reminders so check with your adviser
- Caution: renewal dates for clones resulting from subsequent EUTM designations will be different to the IR itself
- Non-renewed EUTMs within 6 month grace period on 1 Jan 2021 will still receive comparable UK right
- Possible to late-renew UK comparable marks within 6 month grace period

## Practical implications for UK oppositions

### Timing is key

- Earlier rights on opposition deadline
- **“Resurrected rights”**
  - Late renewal of comparable UK rights
  - Comparable UK rights derived from converted EUTMs
  - Comparable UK rights derived from reinstated EUTMs

## Evidence of Use

- TMs are vulnerable to non-use revocation where use is interrupted for a **continuous 5 year period**
- **Comparable UK registrations**
  - Use in relevant period **prior** to 1 January 2021 – EU use applies
  - Use in relevant period **after** 1 January 2021 – only UK use relevant
- **Context is key:** time, place, extent and nature of use
- **Types of evidence:** invoices, sales data, advertising material, awards, press clippings, trade publications etc.

## Evidence of reputation

- Opposition based on 5(3) grounds: unfair advantage or detriment to distinctive character and/or repute of earlier mark
- Relevant timeframe for evidence: 5 year period preceding priority date of application at issue
- **Reputation for comparable UK registrations**
  - If relevant period **prior** to 1 January 2021 – EU reputation
  - If relevant period **after** 1 January 2021 – UK reputation

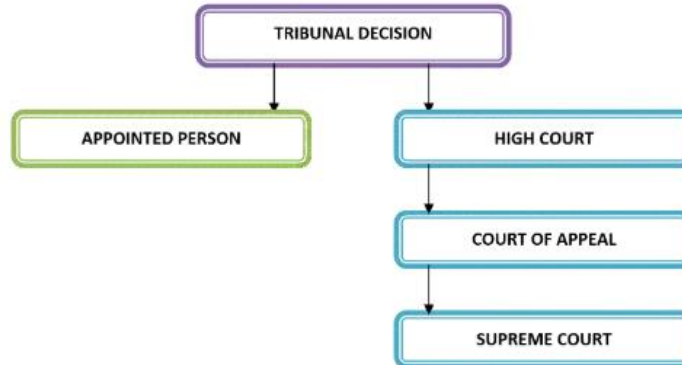
## UKIPO vs EUIPO

- **Language:** English vs EUIPO official languages
- **Surveys:** difficult to admit at UKIPO
- **Witness statements:** UKIPO more receptive to sworn statements of truth provided by proprietor/business
- **Right to be heard:** hearings, CMCs

## Costs awards at the UKIPO

Task	Cost
Preparing a statement and considering the other side's statement:	From £200 to £650 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 £2200 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 £1600 per day of hearing, capped at £3300 for the full hearing unless one side has behaved unreasonably. From £300 to £550 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.

## Routes of appeal from UKIPO



## Conclusion

- No changes to grounds of opposition and UK opposition procedure
- Timelines
- Evidence
- Costs
- Appeals