CITMA The Chartered Institute of Trade Mark Attorneys

CITMA response to draft Tribunal Practice Notice /18

CITMA welcomes the opportunity to provide comments in relation to the draft TPN. Our comments below follow the numbering of the draft TPN.

1. CITMA agrees with the principle of making disputes more manageable. However, a party which has acquired and paid for registrations, giving it rights, should surely be able to rely on those, appropriately, in a dispute. The premise that there may be an intention to overwhelm the other side is both subjective and unprovable, and unfair to parties who have established portfolios.

   Accordingly, CITMA believes that introducing this level of scrutiny before the requirement of a defence on the part of the applicant is inappropriate because it will place an unnecessary and disproportionate burden on the opponent/application for revocation/applicant for a declaration of invalidity in cases where the applicant/proprietor does not intend to respond, by contrast with corresponding disputes at the EUIPO. We therefore suggest that the IPO deals with this issue, when appropriate in a specific case, after the filing of a defence or indeed after the evidence rounds. In summary, CITMA considers that the draft TPN is too heavily weighted against the opponent/application for revocation/applicant for a declaration of invalidity.

2. CITMA agrees with this in principle. However, in the experience of our members, unrepresented applicants tend to file applications for marks which directly conflict with prior rights, so are more likely to receive oppositions.

3. (i) The limit of 5 marks appears far too low, based on the experience of our members, considering that many trade mark owners have large portfolios and 5 marks may not give a sufficient basis for opposition, notably if the earlier marks cover different classes of goods and services and different goods and services within those classes, for example, in a portfolio which has been built up over time. For this reason, we would strongly suggest 10 marks as a maximum, please. (ii) This proposal appears to be likely to be counter-productive because it could give rise to an official objection that identity or similarity are not obvious, without justification, thus leading to increased delays and an increased burden on the opponent. CITMA does not therefore agree with this proposal in its current form and considers that the existing IPO forms are fit for purpose.

4. As set out above, CITMA does not agree with this proposal in its current form.

5. Subject to the comments above, CITMA does not object to this in principle, if the Opponent is allowed to list ten marks rather than five, provided that the IPO spells out in each case why it considers that there is no apparent and justifiable reason.

6. Subject to the comments above, CITMA does not object to this in principle.

7. CITMA has no objection to this proposal in principle, but as set out above, considers that the level of detail is appropriate to a later stage in a dispute of this nature.

8. CITMA again has no objection to this principle, but believes that the level of detail is appropriate to a later stage in a dispute of this nature.

9. CITMA agrees with the principle of changes to make proceedings fairer. However, as set out in our comments above, the onus which the draft TPN will place on owners of prior rights and the timing of that increased burden, most especially in oppositions where there is urgency because the deadline is fixed, is truly disproportionate.

10. CITMA agrees with a deterrent in principle.

11. CITMA has no objection to this because it is in line with current practice in relation to procedural hearings.

In summary, CITMA's primary position is that it is not appropriate to require parties so greatly to limit the basis of their case as proposed or to provide the proposed level of detail at the outset. However, if the IPO nonetheless proposes to implement the TPN, CITMA suggests that the IPO incorporates the detailed proposals set out above.

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