

EIP

Quicker, cheaper, easier!

Two sets of changes to the framework for proceedings between parties in intellectual property (IP) disputes in the UK were both introduced on 1 October 2013. One concerns the procedure for opposing someone else's application to register a trade mark before the UK Intellectual Property Office (UKIPO). The other concerns the forum, formerly known as the Patents County Court, for resolving simpler or lower value disputes involving subsisting UK intellectual property rights. Although otherwise unrelated, the two sets of changes are designed to improve speed, efficiency and access to justice for IP rights holders.

I – Introduction of a Fast-Track Procedure for UK Trade Mark Oppositions

Whenever an application to register a trade mark is filed in the UK, once the UKIPO has accepted the mark for registration, it then publishes details of that application to give third parties an opportunity to oppose the registration. The previously existing opposition procedure allowed for the registration to be opposed on any of the grounds specified in the 1994 UK Trade Marks Act. It also provided for the possibility of the opponent subsequently filing evidence in support of the opposition, and for a hearing between the parties.

Under a new fast-track procedure which will now be available to opponents alongside the existing standard procedure, the opposition can only be based on the grounds that the opposed mark is the same as or similar to one or more earlier marks of the opponent which have been previously registered for the same or similar goods or services, and in the case that the earlier and later marks are not the same as each other, there is a risk of confusion between the two marks on the part of the public (Sections 5(1) and 5(2) of the 1994 Act). The new fast-track procedure also requires that any evidence which is needed to support these grounds (and in particular, evidence of use of the earlier mark, if it was registered more than five years previously) must be filed at the same time as the

opposition itself, with any further evidence only being admitted to the opposition subsequently in exceptional circumstances. Any exhibits filed as evidence must be restricted to fewer than 100 pages in total and must be clearly and sequentially numbered. To speed the process up further, the opponent is also restricted to basing his opposition on a maximum of three earlier trade mark registrations. Failure to comply with any of these constraints can – and in some cases, will – result in the opposition dropping out of the fast-track procedure and following the standard procedure. If, however, the constraints are met, the opposition should be decided quickly on the basis of the written documentation alone, meaning that a hearing between the parties will only take place in exceptional circumstances too, and that if it does, it will be via telepresence.

In spite of these constraints, the new fast-track procedure still allows for a “cooling-off” period, for an amicable solution to be reached between the parties before a decision is given. The deadline for filing the opposition under the fast-track procedure remains the same as under the existing procedure too: two months after the application is published, including the possibility of a one-month extension. To reflect the streamlined nature of the proceedings, the costs which can be recovered by the winning party will only be up to around £600 if no evidence of use of a mark has to be collected, and around £800-£1,000 if evidence is required.

II – The Intellectual Property Enterprise Court

Previously known as the Patents County Court, the Intellectual Property Enterprise Court (IPEC) is the new name given by the Department for Business, Innovation and Skills to the venue for resolving simpler and lower value disputes involving UK IP rights. The court’s procedure remains much as before, with a limit of £50,000 on the costs which can be recovered by a winning party and £500,000 as the maximum award for damages. However, the IPEC ceases to be a specialist county court, and instead becomes part of the High Court, even if its location remains in the Rolls Building on London’s Fetter Lane.

The court’s new name is designed to reflect the broader compass which the Patents County Court has enjoyed in recent years as a forum for litigating other types of IP than just patents, including trade marks, designs and copyright. Following the elevation of the last Patents County Court judge (Colin Birss), to the High Court this summer, no single judge has yet been appointed as his replacement. The IPEC will instead be presided over by one of several IP specialists, who will take the same active role in managing cases as their predecessor.

Comments

Both changes are to be welcomed. The fast-track trade mark opposition procedure

provides an effective route for commercially astute IP rights holders to move quickly against perceived threats to their UK trade mark rights. However, the stringent constraints on evidence will require careful and rapid case preparation before an opposition is filed to make sure that these constraints are met. Combined with the other restrictions placed on the grounds of opposition, it therefore remains to be seen what percentage of oppositions will actually be decided under the new procedure, rather than being launched under the surviving standard procedure or falling out of the fast-track into the standard procedure before a final decision is reached. The renaming of the Patents County Court not only reflects the broader remit of this court as a venue for all IP rights, but also avoids the potentially misleading impression that its jurisdiction was limited in some way to a particular county, when in fact, it has always had jurisdiction across the whole UK. We shall only have to get used to calling it IPEC instead of the PCC!

By Marcus Cavalier