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Review

Commercial & Dispute Resolution



What a difference a day makes - UK Intellectual Property Office shortens trade mark opposition terms

In [Tribunal Practice Notice TPN 4/2010](#), the IPO has changed its practice to bring it into line with the Interpretation Act 1978. This means that whilst previously all terms have been calculated to comprise “full” months, eg 1st November 2010 to 1st December 2010, some will now comprise a calendar month, eg 1st November 2010 to 30th November 2010.

This means that for UK trade mark applications published, for example, in the Trade Marks Journal on Friday 22nd October 2010, it will be necessary to file opposition, or extend the opposition term by a further month, by Tuesday 21st December 2010.

By contrast, the term for filing a counterstatement in response to an opposition will still run for two full months from the date on which the IPO serves the opposition on the applicant or its representatives, eg 24th October 2010 to 24th December 2010. However, if the relevant deadline does not exist because the month is shorter than the month in which the opposition is served, the term will be reduced by a day, eg if the opposition was served on 31st July 2011, the counterstatement would be due by 30th September 2011.

With regard to the cooling off period, the initial term of nine months triggered by filing Form TM9c will remain at nine full months, eg 24th September 2011 to 24th June 2012, and the extension to the cooling off period triggered by filing Form TM9e will remain at nine full months. However, as with the counterstatement, if the relevant deadline does not exist because the month is shorter than the month in which the opposition is served, the term will be reduced by a day.

This change in practice means that some oppositions, and extensions of time for filing oppositions, with which the IPO is currently dealing were filed a day late. In order to work around this, the notice states that the IPO will deem that the late filing of any such oppositions or extensions of time is partly attributable to an error by the IPO. It will therefore retrospectively extend by a day any such deadlines.

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Whilst this change in practice means that the IPO complies with the Interpretation Act 1978, it is likely to be unpopular because it means that the two-month opposition term is now calendar and different from the full two-month counterstatement term and the full nine-month cooling off terms. It would have been more consistent to change all of the terms to calendar or confirm that all are full. This would have required amendment of the rules, which is presumably the reason why the user is given this less than satisfactory alternative.

The practical ramifications are clear. Opposition deadlines and deadlines for extending these are now a day shorter, so have to be diarised accordingly. There will rarely, if ever, be scope, for a retrospective extension of these terms. This is good news for applicants, because their applications can now be registered a day earlier, but less so for potential opponents, who have less time to consider whether to oppose, meaning that there could be more oppositions filed.

Further Information

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