

Suspension of Opposition Proceedings Involving International Trade Mark Registrations at the UKIPO

The UK Intellectual Property Office (“IPO”) is currently suspending all *inter partes* proceedings involving International Registrations (“IRs”) designating the UK where no UK-based address for service has been specified, while it considers whether its practice must be changed following the decision of the Appointed Person (“AP”) in *Tradeix Ltd v New Holland Ventures Pty Ltd* BL O/681/22 (the “Marco Polo case”). We discuss the background to this case, and its potential impact on address for service requirements at the IPO, below.

Background

The Registrar sent a copy of the invalidity application to New Holland by post to its registered office in Melbourne on 26 May 2021 (New Holland did not have an “address for service” in the UK). In this letter, New Holland was directed to file a defence and counterstatement in respect of the application, and to provide an address for service of correspondence in the United Kingdom, Isle of Man, Channel Islands or Gibraltar. A subsequent notice of default of 12 August 2021 was sent by the IPO in the same way.

No response was filed by New Holland, and the UK designation of the IR was declared invalid due to its failure to file a defence and counterstatement in a decision of the IPO dated 29 March 2022. The IPO then notified New Holland of this decision by post to the address of its accountants in Australia, this being New Holland’s ‘dedicated communication channel’ specified at the time of filing the IR. This was received by New Holland’s accountants on 26 April 2022 and forwarded to New Holland on the same day.

New Holland appealed the UK IPO’s decision on the grounds that the Registrar was not “fully aware of all the facts and circumstances of the case”, which were that New Holland had not had any sight of the IPO’s previous correspondence until it was forwarded the IPO’s Notice of Default by its accountants. In his decision, the Appointed Person considered whether the Registrar had given New Holland a proper opportunity to defend the UK designation of its IR, and in particular whether the Registrar had complied with the requirement to direct New Holland to file an “address for service”.

Rules for filing an address for service and responding to an application for invalidation of a UK registered trade mark

Rule 11(1) of the Trade Marks Rules 2008 (“the Rules”) sets out a requirement for various parties to file an address for service for the purposes of “any proceedings under the [Trade Marks Act 1994] or these Rules”. Circumstances in which this requirement comes into effect are given at Rule 11(1)(a)-(e) and include proprietors whose registered trade marks are the subject of an application for invalidation. Rule 11(4) of the Rules provides that an “address for service” must be located in the UK, Gibraltar,

Channel Islands.

Rules 12(1) and 12(2) of the Rules provide that the registrar shall direct a person who fails to comply with the requirements of Rule 11(1) to file an address for service compliant with Rule 11(4), which must be filed within one month of the direction. Rule 12(4) sets out the consequences for failure to comply with a Rule 12 direction, which all result in the directed person withdrawing from any proceedings before the IPO with which they are involved.

Further, Rule 41(5) of the Rules requires the Registrar to send a copy of an application for invalidity to the registered proprietor of the trade mark registration in question. If a defence and counterstatement is not filed within two months of service of the application for invalidity to the registered proprietor, Rule 41(6) specifies that the registration will be declared invalid.

The decision

Allowing the appeal and setting aside the Hearing Officer’s decision, the AP held that New Holland had not at any time been directed by the IPO to provide an “address for service” compliant with Rule 11(4).

Moreover, the AP held that Registrar did not have the power to effect service of the application for invalidity outside of the jurisdiction (by post or otherwise). It was held that the Registrar should have directed New Holland to file an “address for service” compliant with Rule 11(4) which would then have enabled the UK IPO to properly serve the application for invalidity.

Notably, the AP held that the direction made by the Registrar in its letter of 26 May 2021 was not adequate to achieve a result whereby New Holland could either be served with the application for invalidity, or deemed to have failed to comply with a direction to provide an address for service.

Impact

In light of the Marco Polo case, the IPO is considering what changes (if any) need to be made to its practice to better comply with the requirements of Rule 11. One possible outcome is that holders of IRs designating the UK may be required to appoint a UK address for service before a request for extension to the UK can be examined. In his decision, the AP stated that he saw “no reason to doubt” that Rule 11(1)(a) applies to examination of a request for extension of protection of an IR.

Another potential outcome is that the IPO may begin to request that an address for service compliant with Rule 11(4) is filed in *inter partes* proceedings before any documents in the proceedings can be served on the relevant party.

It remains to be seen whether, in light of the Marco Polo case, the requirements associated with appointing a UK address for service

become stricter for holders of IRs designating the UK, or if a more moderate change is made.

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