

## New Costs Cap Relating to UK Fast Track Opposition Process

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On 1 October 2013 the UK IPO introduced a Fast Track Opposition process relating to trade marks. The purpose of the new process was to provide SMEs with a quicker, cheaper means of enforcing their registered trade marks against later filed applications to register conflicting marks. In the first twelve months around 7% of oppositions filed at the UK IPO, 139 in total, were filed using the Fast Track process. Further, 232 Fast Track oppositions were filed between 1 October 2014 and 31 April 2015 bringing the percentage of oppositions using the Fast Track route up to around 10%.

The Office issued decisions in around 15% of Fast Track opposition cases, the rest of the cases result in withdrawal of the trade mark (around 60%) and withdrawal of the opposition (around 25%) (sometimes withdrawal occurs after an amendment has been made to the scope of protection requested by the applicant).

The figures relating to the outcome of Fast Track oppositions are comparable to regular opposition proceedings filed at the UK IPO. That said, the time taken to issue the decision relating to a Fast Track opposition is much less than the time taken to issue a decision resulting from a Regular opposition. In fact the average time taken is 3 months from the filing of the defence (and ranges usually from 1 to 7 months). Further, the average costs awarded in a Fast Track opposition is around £460 which compares favourably to the average costs award of £1235 relating to Regular opposition proceedings.

Since the potential for a costs award being made against a losing party is likely to act as a disincentive to SMEs who wish to bring or defend opposition proceedings, the UK IPO has introduced a cost cap. The new practice will apply to Fast Track oppositions only filed on or after 1 October 2015 and intends to bring greater certainty to opposition proceedings and therefore encourage SMEs to protect their IP.

The cost cap has been introduced at £500, excluding official fees. This will be made up of £200 for filing a notice of opposition or filing a counterstatement and up to £300 for filing written submissions. Of course, since this is a cap, costs awards can be made for less, and it is envisaged that most awards will be for less. There is one safe guard that has been introduced relating to possible abuse of the cost cap. Thus, the cost cap will not apply where a party is found to have acted unreasonably when conducting proceedings. In such cases costs will be awarded at an appropriate level.

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If you would like further information relating to the Fast Track opposition service at the UK IPO, please contact your usual Forresters' trade mark attorney who will be happy to advise you.