

CLARIFICATION REGARDING PROOF OF USE IN OPPOSITION PROCEEDINGS

In a recent publication of the written grounds of an opposition decision (Lloyd & Price, issued 10 July, 2014) the Hearing Officer indicated that his conclusions would set a precedent for future opposition proceedings regarding proof of use of an earlier trade mark upon which the ground of opposition concerning Section 10(2) of the Trade Marks Act, 1996 was based.

However, the Controller decided to use the period in which an appeal to the Court was possible to reflect on the matter. Accordingly, during that period, no changes to existing procedures were introduced. Now that the period in which to appeal has lapsed, and with no appeal against the decision before the Court, the Controller is happy to clearly set out his position.

The Controller is of the view that 'Proof of Use' should, in appropriate cases, be a factor in opposition proceedings grounded on Section 10(2) of the Act. However, there is no specific legal basis at present which allows the Controller to dismiss an opposition based on Section 10(2) because of a lack of 'Proof of Use' of the earlier mark(s). It is the intention of the Controller to address this and to avail of the next revision of the Trade Marks Act to introduce legal provisions that will allow the Controller to have due regard to 'Proof of Use' in opposition proceedings before him.

In the meantime, the Controller will not be introducing any changes in practice or procedure, alluded to in the Lloyd & Price decision, until a legal basis for doing so has been clearly established. Accordingly, there are no implications for any cases currently before the Controller or for future cases, until such time as the current legislation is amended.