



Form TM 10

Notice of Opposition and Statement of Grounds

Fee: \$185.00 for each notice

\$38.00 for each additional mark in series (opposition to proposal for change of classification)

Use **this form** to provide notice of opposition to a trade mark application (or a proposal for change of classification) and to set out the grounds on which you are basing this opposition.

1. Trade Mark Number Number of trade mark you are opposing	
2. Full name of applicant Whose trade mark are you opposing	
3. Full name of opponent	
Address	<div></div> <div></div> <div></div> <div>Postcode</div>
Email address	<div></div>
4. Trade mark agent of opponent	
Address This address must be within Bermuda	<div></div> <div></div> <div></div> <div>Postcode</div>

5. Related proceedings

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings

	Bermuda IPO		BDA Courts		Overseas Court
Number					

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)

Opposition is based on Section 7(1) or 7(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the ‘proprietor’ (owner) of the earlier trade mark.

>COMPLETE SECTION A

Opposition is based on Section 7(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the ‘proprietor’ (owner) of the earlier trade mark.

>COMPLETE SECTION B

Opposition is based on Section 7(5)(a): Where the use of the applicant’s trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the ‘proprietor’ (owner) of the earlier right.

>COMPLETE SECTION C

Opposition is based on Section 5: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

>COMPLETE SECTION D

Opposition is based on other grounds.

>COMPLETE SECTION E

SECTION A: Opposition is based on Sections 7(1) or 7(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply

	7(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
	7(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.

	7(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.
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You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark number

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Type of mark
Please tick

	BDA		Re-registration UK		Other
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Representation of your trade mark

Enter your trade mark in the space provided – use a continuation sheet if necessary.

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Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

	All goods and services
	Some goods and services (<i>please specify below, use a continuation sheet if necessary</i>)

Q2. STATEMENT OF USE – Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☐

Yes

☐

No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐

Yes

☐

No > GO TO Q3b

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

>GO TO Q4

Q3b. Please state any proper reason for non-use.

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DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.

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SECTION B: Opposition is based on Section 7(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark number

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Type of mark
Please tick

<input type="checkbox"/>	BDA	<input type="checkbox"/>	Re-registration UK	<input type="checkbox"/>	Other
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Representation of your trade mark

Enter your trade mark in the space provided – use a continuation sheet if necessary.

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Q1. For which goods or services covered by your earlier trade mark does it have a reputation?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?

☐

Yes

☐

No

Use this space to supply any further information

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QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN YOUR ANSWER TO Q.3.

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Q7. STATEMENT OF USE – Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☐

Yes

☐

No > GO TO Q10

Q8. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐

Yes

☐

No > GO TO Q10

Q9a. For which goods or services listed at Q1 is trade mark use being claimed?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

>GO TO Q10

Q9b. Please state any proper reasons for non-use.

Q10. Use this space to give any further information to explain why you are opposing the application on this ground.

SECTION C: Opposition is based on Section 7(5)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided – use a continuation sheet if necessary.

Q1. When and where was the earlier right first used in Bermuda?

Date used:
Enter date of first use.

Where used:
Enter name of parish or specify ‘throughout Bermuda’ if used locally.

Q2. On which goods or services has the earlier right been used?

Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant's mark would amount to passing off?

	All goods and services
	Some goods and services (<i>please specify below, use a continuation sheet if necessary</i>)

Q4. Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?

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SECTION D: Opposition is based on Section 5 of the Trade Marks Act on the basis that the trade mark fails to satisfy certain requirements of a trade mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Please tick and complete the relevant section(s) that apply. (Use a continuation sheet if necessary)

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5(1)(a) It is a sign that does not satisfy the requirements of Section 3(1) because:

5(1)(b) It is a trade mark which is devoid of any distinctive character because:

5(1)(c) It is a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services because:

5(1)(d) It is a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade because:

5(10) It is a trade mark which should not be registered for some or all of the goods and services in the application as the application was made in bad faith:

Other State any other part of Section 5 you rely on and give your grounds:

State which of the applicant’s goods or services you oppose under Section 5 grounds

All goods and services

Some goods and services *(please specify below, use a continuation sheet if necessary)*

SECTION E: Opposition is based on any other grounds

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

	Section 7(1),(2),(3)	If the opponent is claiming protection for an earlier trade mark under Section 9(1)(b) which is a well known trade mark as defined in Section 97(1). See ++ Note below.
	Section 7(5)(c)	An earlier right by virtue of the law of copyright or the law relating to industrial property rights.
	Section 7(10)	Registered in the name of an agent or representative.
	Regulation 24(2)	Opposition to amendment after publication.
	Regulation 29	Regulations for collective or certification marks.
	Regulation 30(3)	Amendment of regulations for collective or certification marks.
	Regulation 32(4)	Alteration of registered mark.
	Regulation 53(2)	Removal of matter from the register.
	Others	Others

Others & ++ -- For opposition on these grounds the following details should be supplied in the area below:

- Representation of the mark
- Details of any reference number and related jurisdiction if relevant
- Details of goods and services covered by the earlier mark
- Details of goods and services (in the application) which you consider to be similar identical to those covered by the earlier mark.

Alternatively you may wish to adapt Section A and Section B of this form.

Give details (including details of any right relied upon) to support the application under these grounds

(Use a continuation sheet if necessary)

[CONTINUED] Details to support your opposition under these grounds

Declaration

I believe the facts stated in this form and the attached statement of grounds are true.

Signature

Name

(BLOCK CAPITALS)

Date

Your Reference

Complete if you would like us to quote this in communications with you, otherwise leave blank

Your Contact details should we have a query

Name

Email

Phone

Checklist

Please make sure you have remembered to:

☐ Provide the trade mark number(s)

☐ Sign and date the form

Email submissions with direct deposits to:

rgintellectualproperty@gov.bm

Post forms with cheques only to:

Intellectual Property Office
% Registry General
Government Administration Building, 4th Floor
30 Parliament Street
Hamilton HM 12
Bermuda

Fees and Payment Method

We will only process the form with this section completed (one form per payment)

Total fee paying (\$)

Your payment reference

☐ Payments by cheque, cash, debit or credit cards or revenue stamps can be made in office by **3:15PM**.

☐ **Cheque** – make payable to ‘Accountant General’

☐ **Bank Transfer / Direct Deposit**

Beneficiary Bank: **HSBC Bank of Bermuda Limited**, 37 Front Street, Hamilton 11, Bermuda

Beneficiary Name: **GOVERNMENT OF BERMUDA** – Registry General

Beneficiary Account Number: **010-125250-001** Bermuda Dollar Account

Beneficiary Account Number: **010-125250-501** US Dollar Account

Reference – Trade Mark name or number(s) or your name and reference number(s)