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from the IP and Technology Unit

UK Trade Marks - changes to examination procedure

Readers familiar with the process of obtaining a registered trade mark in the UK should note the UK Intellectual Property Office's ("IPO") decision to abandon the examination of new trade mark applications on "relative" grounds with effect from Monday 1 October 2007.

In this Brief Update we examine the implications for prospective trade mark proprietors of this change in Trade Mark Registry's practice which more closely aligns the UK with the current Community Trade Mark ("CTM") procedure.

Background

UK trade mark applications have traditionally been examined by Trade Marks Registry on two grounds. Firstly "absolute" grounds designed to ensure that a mark is distinctive, does not mis-describe the goods or services it seeks to cover and otherwise meets the statutory tests set out in the Trade Marks Act 1994. The second examination, on "relative" grounds, focuses on earlier registered marks including national marks, CTMs or international registrations (provided they designate the UK or the Community). If a conflicting earlier registration was found the Examiner would raise an objection and, unless overcome, this would lead to the later application being refused.

Advantages and disadvantages

Chief amongst the advantages of this system for existing trade mark proprietors was the fact that the IPO, in effect, was monitoring and policing your trade marks (at no cost to you) in order to prevent third parties subsequently filing for and obtaining conflicting rights.

The disadvantages in this approach only became apparent after the introduction, in 1996, of the CTM (covering all EU countries i.e. including the UK) because, although the European Trade Marks Office would examine an application on the same "absolute" grounds as the UK IPO, there was **no** equivalent examination on "relative" grounds. In effect therefore a trade mark applicant by choosing to file a CTM could avoid an examination on "relative grounds" at the UK Registry but nonetheless, via the CTM, obtain a registered mark having effect in the UK. We thus ended up in the anomalous situation in which it was easier to obtain protection throughout the whole of the Community (under a CTM) than it was in the UK alone (under a national application).

Move to search and notify procedure

In moving to a search and notify procedure the UK IPO will still continue to examine a mark on "relative" grounds (**but** will no longer refuse to register the mark on this basis) and will notify the **applicant** of the search results i.e. if any conflicting earlier marks are identified. If the applicant still wishes to proceed then the IPO will notify **holders** of earlier marks as follows:

- Proprietors of UK trade marks and international trade marks designating the UK - automatic notification.
- Proprietors of CTMs and international trade marks designating the Community - notification **only** if they have opted in to a notification system.

Analysis of new procedure

This new procedure takes us much more into a "market-placed" assessment of whether or not a conflict exists between a mark newly applied for and an existing prior registered one. The closer an applicant's list of goods or services is to the actual business conducted under the prior registered mark, the greater the risk that the application will be opposed. Each of the applicant and the holder of the prior mark will essentially have to make a commercial decision whether or not to proceed or oppose as the case may be.

Actions for business

- For owners of existing registered marks - consider subscribing to a trade mark watching service. This should give you the earliest possible advance notice of potentially conflicting applications and give you time to prepare for an opposition. Remember you can no longer rely on the Trade Mark Registry to resist and refuse new applications on your behalf.
- For applicants for new marks - make every effort to avoid the Examiner invoking the notification procedure (to earlier mark holders) - for example by restricting your specification of goods or services.
- For CTM proprietors and proprietors of international marks protected in the Community - take steps to opt in to the IPO's notification procedure by filing form TM6 (available on-line from 1 October).

For further information on trade mark filing or on any other aspect of intellectual property please contact Lester Cameron (LFCameron@paul-williamsons.co.uk)