

EXAMINATION OF UK TRADE MARK APPLICATIONS

A number of changes to UK Trade Mark Registry practice have come into effect over the last few months. One of the substantial changes relates to the examination of trade mark applications.

The Current System

Under the previous system of examination, the UK Trade Mark Registry undertakes a search for conflicting prior registrations and applications. It then refuses to accept applications on the basis of such conflicting prior marks.

The New Regime

The new examination regime came into effect on 1 October 2007. Under the new regime, the UKIPO still conducts a search for prior marks but will not itself refuse an application as a result. This is consistent with the practice of the OHIM in relation to European Community trade marks. Instead, the search will be used to inform owners of any conflicting prior marks of the existence of the new application.

Under the new system:

1. The owners of earlier UK marks revealed in the search will be notified of the existence of the new application, unless they have opted out of the system. The owners of CTMs and International registrations designating the UK will not be notified unless they have opted in to the system (on payment of a fee); and
2. There will be least a two month delay between the search report being issued to the applicant and publication and notification to owners of prior marks. The applicant will, in that period, be able to amend the application and/or argue against notification.
3. The new system applies to all pending applications which had not been accepted for advertisement at the date the new system came into force.

What do these changes mean for you?

1. Trade mark owners who have CTMs and UK designations of International registrations will need to decide whether to opt in to the new system to receive notification from UKIPO of later filed applications. This is likely to be advisable even where a watch system for conflicting UK applications is currently in place; and
2. Trade mark owners who have existing UK application(s) that were objected to on the basis of prior marks can consider trying to keep the application(s) pending in the hope that, under the new system, the objections will be waived and owners of prior marks will not oppose the application; or
3. Where an objection has previously been raised to a UK application on the basis of a prior trade mark, it may be worthwhile to consider re-filing.

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