

CHANGE IN UK REGISTRY PRACTICE – RELATIVE GROUNDS

After an extensive consultation, the UK Trade Marks Registry has announced that from **1 October 2007** it will abolish its current practice of refusing UK trademark applications based on earlier conflicting registrations or applications on the UK or CTM Registers

This is a fundamental change in the UK's practice, as the Registry has always considered itself to be the "guardian" of the Register. The Registry will continue at examination to conduct a search of the UK and CTM Registers, and will identify any potentially conflicting earlier registrations or applications, but it will not now raise these as a formal objection. The onus will now be on the owners of these earlier trademarks to oppose an application.

The Registry will notify the applicant of the results of the search and, if the applicant elects to continue with the application, the Registry will then notify the owners of any earlier marks that they have identified in the search. Notifying both parties means that both will have the same information.

This new practice mirrors the current practice adopted by the Community Trademark (CTM) Office in relation to citation of prior Community Trademark rights in the searches carried out by the CTM Office.

This new practice is also more likely to reflect the actual position in the market place, as opposed to the Registry deciding matters on a notional (paper based) assessment. It is, however, likely to increase the number of oppositions filed.

Although this high level decision has been made, the procedural rules that will need to be implemented have yet to be finalised. We will notify you of any relevant changes.

Recommendation

Although, as stated, the Registry will notify the owners of earlier trademarks that seem to conflict with a continuing application, this is still dependant on the Registry finding your mark in the search. It is therefore our strong recommendation that you place your trademarks on a watch service, to identify any conflicting trademarks that may proceed to publication and thereby determine the need for an opposition.

If you would like further details on this, please contact Ian Buchan, Sanjay Kapur, John Peacock or Cathy Ayers.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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