

CHANGE IN UK TRADEMARK PRACTICE – RELATIVE GROUNDS

In January, we notified you of the proposed change in practice at the UK Intellectual Property Office (UK-IPO), from **1 October 2007**, with regard to how it will deal with relative grounds objections for UK trademark applications (and International Registrations – designating the UK).

In essence, UK-IPO will abolish its current practice of refusing registration *ex officio* based on earlier conflicting registrations/applications that exist on either the UK or Community Trade Marks (CTM) Registers (or the International Register designating either the UK or CTM Registers).

UK-IPO has now issued a further Notification on how it will deal with matters.

UK-IPO will still continue to conduct a search for any earlier conflicting applications/registrations, and will send the results of this search to the Applicant. The Applicant will then have to notify UK-IPO whether it wishes to continue with the application.

If the application is to be pursued, and the search contained details of UK applications/registrations (or International Registrations - designating the UK), UK-IPO will notify the owners (or their representatives) of such earlier marks of the publication of the later filed UK application. It will then be up to the owners of such earlier marks to decide whether to oppose the application.

If we are entered as the Address for Service/Authorised Representative for the earlier trademarks in respect of which UK-IPO issue their notifications, we should be sent these notifications, and obviously we will forward these on to you, with any relevant advice.

As regards any CTM applications/registrations (or International Registrations designating CTM) which feature in UK-IPO's search report, UK-IPO will **not** automatically notify the owners (or their representatives) of such CTMs of the publication of the UK application.

However, owners of such CTMs can request that UK-IPO notify them of such later filed UK applications by subscribing to its new "OPT-IN" service. This will result in UK-IPO sending such notifications whenever the CTM concerned features in a search report. The costs involved in subscribing to this OPT-IN service will be £100 (excl VAT) per CTM (for a renewable 3-year period).

By not using this OPT-IN service, any CTM registration/application that you (or your clients) own will not be the subject of prior notifications from UK-IPO, and third parties will, therefore, be able to register confusingly similar trademarks.

Recommendation

If you wish to be alerted to the publication of UK trademark applications that may conflict with any of your (or your clients') existing CTM applications/registrations (or International Registrations - designating CTM), we strongly recommend that you instruct us to subscribe to the OPT-IN service at UK-IPO.

As regards any future CTM applications that you may file through us, we will remind you of this possibility of receiving notifications in our standard letter reporting the filing of CTM applications.

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

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.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

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