



Earlier Rights

FACT SHEET

An applicant needs to consider whether to proceed with an application when earlier confusingly similar marks have been raised in an examination report. This Fact sheet gives an overview of the main considerations.

What we will do

When we receive your application, we examine it to ensure that the goods and services are correctly classified and that the trade mark is distinctive and not deceptive.

We will also search for any earlier conflicting UK trade marks, European Community trade marks (CTMs), or International trade marks that are protected in the UK or the EU as a whole.

We will send you an examination report identifying any potential conflicting marks and any other objections.

You decide

You have two months to respond to the examination report. If the **only** problem is that the search has revealed earlier apparently conflicting marks, it is up to you to decide if you want your application to proceed to publication. If you do not reply within two months we will assume that you want your application to be published.

Can the two month period be extended?

The period can be extended if you can show good reasons why it should be. For example, if you decide to seek the consent of the owner of an earlier trade mark identified in the search. However, you will need to satisfy the Examiner that you are actively pursuing the consent and, if you need further extensions, that there is a realistic possibility that consent will be given.

What sorts of things should I consider when making that decision?

Trade marks are often registered for a wider range of goods and services than the proprietor trades in. It is therefore often worth doing some research to see what the real scope of the owner of the earlier mark(s) business is. This can be significant in two ways. Firstly, even though the owner of the earlier mark may have the legal grounds to oppose your application it does not follow that they will do so. However, the closer your list of goods or services is to the actual business conducted under the earlier mark the greater the risk that your application will be opposed.

Secondly, trade marks may be legally protected throughout the European Community even though it is not used in the UK. The owner of a European Community trade mark is more likely to oppose your application if the CTM is used in the UK. If it is not used in the UK he may not oppose your application even though he may have a legal right to do so.

Thirdly, in order to remain enforceable, all trade marks must be used. The proprietor has five years from the completion of the registration procedure to put their mark into use. Trade marks which have been protected for five years by the time your mark is published can therefore only be used to oppose your application for the goods or services for which they have been put to genuine use in that period, unless there are proper reasons for non-use. Do bear in mind though, that in the case of European Community trade marks and International marks protected in the EU, the requirement for retaining legal protection is that the mark must be used in the area of the European Community, but not necessarily in the UK. National trade marks (and International trade marks protected specifically in the UK) must be used in the UK in order to remain enforceable.

Notifying Owners of Earlier Marks

If we publish your trade mark, we will notify the proprietors (or their representatives) of earlier UK national marks identified in the search, and the owners (or their representatives) of International marks which are specifically protected in the UK (as opposed to the European Community as a whole). We will also notify the owners (or their representatives) of any conflicting CTMs and international marks protected in the EU as a whole, but only if they have opted-in to receive such notifications. You will be able to tell whether the owners of such marks have opted-in by viewing the case enquiry record on our website.

How can I avoid these notifications being sent?

It may be possible to restrict your specification of goods or services before publication so as to remove the goods or services which are the same or too similar to those for which the earlier identical or similar mark is protected. If you believe that the examiner is wrong to think that the use of your mark will result in a likelihood of confusion with the earlier mark(s), you can explain why this is to the examiner. The examiners are very experienced at making these assessments but your views will be considered and the examiner may decide not to notify the owner of the earlier mark(s) identified in the search.

Alternatively, if you accept that there is a conflict and you do not want to take the chance that your application will be opposed, you could approach the owner(s) of the earlier mark(s) to see if they will consent to the registration of your mark. If you do this, you may find that they will want certain undertakings from you as to the future use of your mark, and they will probably expect you to cover the professional costs of dealing with your request. Nevertheless, this is likely to be less than the cost you could incur if the owner of the earlier mark successfully opposes your application after it is published. You can ask for your application to be suspended whilst you seek consent. The examiner will agree to this unless they think that your approach is hopeless (e.g. because there are just too many earlier conflicting marks in different ownerships) or if there are unresolved objections to your applications raised by the examiner, e.g. that your mark cannot be registered because it is not distinctive.

Finally, you could just withdraw your application and choose another trade mark.

You are only allowed one opportunity to decide how to respond if the search reveals what the examiner considers to be conflicting earlier trade marks. It therefore makes good sense to use that opportunity to lessen the conflict by restricting the goods/services in your application, rather than to argue against the examination result.

Can I appeal the examiner's decision to notify the owners of earlier marks about my application?

There is no right of appeal and you are not entitled to ask to be heard before the examiner acts on their decision. Therefore whatever you decide to do you must do it within the period the examiner allows (two months).

What you can no longer do to overcome notifications

You are not entitled to request a hearing to argue against the issuing of a notification to an earlier right holder. This is because new rules state that no party is entitled to be heard in respect of any decision to notify either party of the earlier right. Therefore, hearings will not be held in respect of notifications raised on relative grounds.

You can no longer file evidence of Honest Concurrent Use at examination stage to avoid the need for a notification to be issued. This is because Section 8 is now in force which repeals Section 7 of the Act which catered for the filing of Honest Concurrent Use.

Potential Opposition

When we publish your mark, in the Trade Marks Journal owners of earlier marks, including those not notified, will have the opportunity to oppose it. Opposition may result in costs being incurred.

What options do I have if I am opposed?

If, once your application has been published in the Trade Marks Journal, someone objects to your trade mark by filing an opposition with us, we will inform you. You will then have three months in which to file your defence to the opposition. The opponent, before launching their action against you, should have contacted you to give you the opportunity to withdraw your application or to amend your goods and/or services so as to avoid the conflict with their earlier right. You may decide that either of these are viable options and so avoid the dispute between you going any further. If the opponent files an opposition and you decide to withdraw your application straightaway, you will avoid having to pay the usual costs to the opponent, unless you were given the opportunity to withdraw your application before the opposition was filed.

If you decide to defend your trade mark application, you must file the defence (called a Form TM8 and counterstatement) within three months of us notifying you that there is an opposition against your trade mark. However, if you and the opponent both agree, this nine month period can be extended to eighteen months (called 'cooling off') in order for negotiation or mediation to take place to try to resolve the dispute and thereby reduce the costs involved.

If you decide to defend your trade mark you must file a Form TM8 and a counterstatement, for which there is no fee. If the opponent has relied upon an earlier trade mark which has been registered for five years or more at the time your trade mark application was published, you have the right to request that they prove genuine use of the trade mark in respect of the goods and/or services for which they have brought their opposition against your mark. If they cannot do that, or show proper reasons for non-use, the opposition will be rejected insofar as it is based upon the earlier trade mark.

If you file a Form TM8 we may issue a preliminary indication. This gives an indication of the likely success or failure of the opposition if it is brought against your trade mark because the opponent claims that there is a likelihood of confusion amongst consumers between your mark and their earlier trade mark. However, we will not issue a preliminary indication if both parties ask us not to or the Hearing Officer considers that the likely outcome is so difficult to predict that a preliminary indication will be unhelpful.

The preliminary indication is not binding, but should be taken seriously. Proceeding in the face of an adverse preliminary indication means that you stand a significant chance of losing and becoming liable for costs.

If a preliminary indication is issued and the 'losing' side accepts it, then the opposition will be concluded in favour of the 'winning' side (unless the opponent has brought other grounds against you, e.g. the distinctiveness of your mark, and they wish to continue with those grounds). If the 'losing' party rejects the preliminary indication by filing a Form TM53 (or no such indication is given), the parties will be given a chance to file evidence about facts which support their cases.

The opponent will have three months to file their evidence. Once the opponent has filed their evidence, you will be given three months in which to file your evidence of facts to support your application. Finally, if you have filed evidence, the opponent will be allowed to file further evidence of fact but only strictly in reply to the facts in your evidence.

After these evidence rounds have been completed, a Hearing Officer will give you and the opponent a chance to request a face to face hearing or to file written arguments instead. After considering the evidence and the arguments made, the Hearing Officer will issue a decision about the outcome of the application and the opposition and decide who should pay costs. If a preliminary indication was given (see above), the Hearing Officer who ultimately decides the case will be a different Hearing Officer from the one who gave the preliminary indication. The final outcome may differ from that predicted in the preliminary indication.

If the owner of an earlier mark does not oppose my application can they complain later?

If you are not opposed and your mark becomes registered, it is possible that at a future date someone with an earlier trade mark or right may apply to have your trade mark declared invalid. This could be because they were waiting to see where and for which goods or services your trade mark was actually used before deciding whether to take action. However, if they had become aware of the use of your trade mark in the UK market for a continuous period of five years, without taking any action to object to that use, they will lose their right to object to your trade mark.