

## A year of marked change



**OVER THE past twelve months, the face of trade mark registration at the UK Intellectual Property Office (UK-IPO) has changed dramatically.**

In October 2007, we took the significant step of abolishing ex-officio refusal on relative grounds.

This means that we no longer refuse to register new trade mark application on the grounds of earlier conflicting trade marks.

Disputes relating to alleged similarities between trade mark applications and earlier registrations are now dealt with solely through opposition proceedings before the Trade Marks Tribunal.

Later this year, we expect to reduce the opposition period from three to two months as part of an extensive set of changes to the rules

governing trade mark registration.

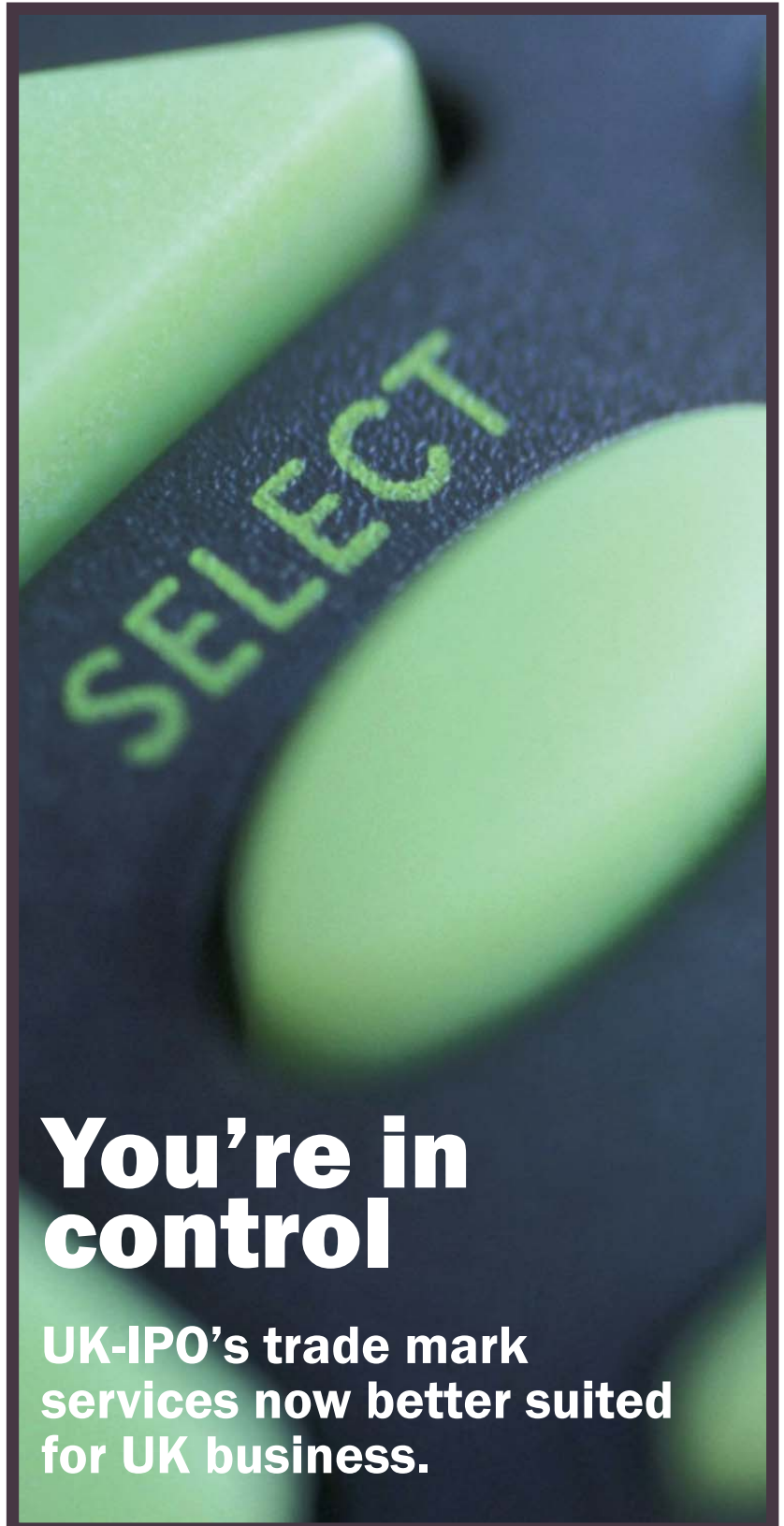
Meanwhile, early in 2008 we introduced a fast track examination service – offering a quicker route to registration for those who want it.

All of these changes have been introduced in order to make the national trade mark registration and litigation systems more effective for UK business.

Through this newsletter, we will reflect on the success of these new initiatives introduced over the past year.

We will also provide information to help you use the national and international trade mark systems more effectively, and dispel any of the myths that you may have encountered when considering applying for a UK trade mark.

**Andrew Layton**  
UK-IPO Director of  
Trade Marks and  
Designs



## You're in control

**UK-IPO's trade mark services now better suited for UK business.**

## The changes

### October 2007

Ex-officio refusal on relative grounds abolished.

### April 2008

Fast track examination service introduced.

### October 2008

Opposition period to be reduced from three to two months.

# More control given to trade mark owners and applicants

## **SINCE OCTOBER 2007, businesses applying for domestic trade mark protection through the UK-IPO have received a new type of examination service.**

Within a month of your application being made, we will provide an examination report indicating whether your trade mark is registrable and containing details of any earlier marks that are similar to your own.

We will also provide you with an opportunity to contest any potential conflict and amend your application. However, in the event of you being unable to overcome this conflict, the UK-IPO will no longer refuse your mark.

Ultimately, we now let the applicant decide whether to have its mark published and face the possibility of a potential opposition.

And for holders of those earlier UK trade marks identified as being similar to a mark applied for, the UK-IPO now automatically issues notification letters which will bring your attention to any relevant later-filed applications, allowing you to decide whether or not to oppose.

## **Trade mark examination still rigorous**

The UK-IPO has ensured that examination in 2008 is every bit as rigorous as it was before the introduction of an opposition-only system.

Our examiners utilise the same knowledge, the same

experience, and the same tools to perform a thorough search of the UK, Community and International trade mark registers. This means that our examination reports will present earlier marks only where an examiner feels there is a real risk of confusion in the marketplace, and where there is a genuine concern for the applicant.

## **Unparalleled access to examination staff**

Your examination report will contain a direct telephone number for the examiner dealing with your case, and we place great importance on ensuring that all letters and telephone enquiries are dealt with in minimal time. All of these factors have combined to create a process which is quick, accurate and good value.

## **Why register?**

Registration remains the surest way to protect your trade marks within the UK. It is much easier and cheaper to enforce a registered trade mark than to sue for passing off on the basis of an unregistered trade mark.

Further, registration is the most effective way to resist complaints and objections from other parties who may adopt and/or seek to register a mark which is the same or similar to your own.

For more information, visit our website at [www.ipo.gov.uk/tm](http://www.ipo.gov.uk/tm).

**Within a month of your application we will let you know if your mark is registrable.**

**We will tell you about any earlier marks that are similar to your own.**

**You decide how to proceed.**

**If you hold an earlier UK trade mark, we will tell you about any later-filed applications. You decide whether or not to oppose.**

# Opposition rate for 2008 lower than anticipated



**BY ABOLISHING ex-officio refusal on relative grounds and switching to an opposition-only system, the UK-IPO now provides a legislative framework that enables more trade marks to be both published and registered.**

During the consultation period in 2006, concerns were raised in respect of our ability to deal with the likely increases in oppositions filed.

In response to those concerns, the UK-IPO can confirm that it has successfully implemented the recent legislative changes, and is now able to provide examination and opposition services which are every bit as efficient as they were prior to October 2007.

## A clearer picture

So far in 2008, the UK-IPO has dealt with a trade mark opposition rate which has been lower than was anticipated.

This is significant for

two reasons. Firstly, it means that the UK-IPO has been able to maintain the established high standards and fast turnaround time in respect of opposition proceedings.

More significantly, it also indicates that the UK-IPO's previous level of ex-officio refusal on relative grounds was not a true reflection of actual conflict between proprietors of trade marks in the marketplace.

## Oppositions at 7.25%

Prior to October 2007, the UK-IPO was raising relative grounds objections on around 30% of all applications filed.

A further 2.85% were opposed by third parties.

Although not all of these cases were ultimately refused, the ever-increasing size of the Community and International trade mark registers inevitably raised the potential for conflict between UK applications and earlier marks.

With the introduction of new relative grounds

legislation, the UK-IPO expected at least a threefold increase in oppositions.

However, over the first six months of 2008, the opposition rate has risen to only 7.25% (about a 2.5 times increase).

Added to that, the number of Community Trade Mark owners choosing to use our notification system has been smaller than anticipated, with only 1.4% of all live Community Trade Marks currently opted-in.

Although still early days, these figures indicate that UK-IPO-initiated relative grounds objections were clearly impeding the effectiveness of the UK trade mark registration process.

As the identification of earlier marks no longer prevents publication in the Trade Marks Journal, the UK-IPO is now able to publish a much higher percentage of applications.

Furthermore, the percentage of published marks which currently go on to face opposition

proceedings bears no relation to the 30% official relative grounds objection rate seen prior to October 2007.

## Fewer disputes than in competing systems

For potential filers of domestic trade mark applications, this is all good news.

The opposition rate of 7.25% is significantly lower than competing systems: for example, about 20% of Community trade marks applications are opposed.

The reductions in examination turnaround times, along with the introduction of a designated fast-track service, means that, for marks not facing objections under absolute grounds, publication in the Trade Marks Journal is now both quicker and more likely than ever.

And for those marks which are published, the current opposition rate of 7.25% indicates that there remains a relatively low risk of opposition proceedings.

**Our services are as efficient as under the old system**

# International applications unaffected by legislative change

**Through its membership of the Madrid Protocol, the UK-IPO continues to offer trade mark owners an effective route to registration abroad, and dealt with over 6,500 UK designations in 2007.**

If you already own a trade mark in the UK, you can protect it in other countries party to the Madrid Protocol by filing a single International application at the UK-IPO.

**UK examination provides a solid foundation for international legislation**

By designating those countries in which you seek protection and paying the appropriate fee, we will forward your application to the World Intellectual Property Office (WIPO) in Geneva, who will then pass

your International application to all the national offices you have designated.

In 2007, the UK-IPO forwarded to WIPO over 1100 International Registrations based on UK trade marks. Since introducing the opposition-only relative grounds framework, demand for the International system has continued apace with over 600 registrations based on UK marks having been processed so far in 2008.

At the time of our consultation on relative grounds changes, some suggested that UK applications and registrations might not be as suitable a base for an international trade mark because the ending of the "search-and-cite" examination system might leave international trade marks based on UK marks more susceptible to

central attack at a later stage.

However, as noted elsewhere in this edition, the current notification levels, the high numbers of marks being published, and the relatively low opposition rate all point to a UK registration which is as effective as it was prior to the changes.

Further, contrary to some fears, the change has not, so far, had any significant effect on the number of invalidation actions being filed.

**Most UK designations are based on applications not registrations**

It is important to note that the majority of UK international designations are based on UK applications rather than registrations (and always have been).

To some extent, this makes

those concerns regarding the strength of a UK registration somewhat academic.

You do not have to wait until your UK base application has been registered before submitting an International application.

And the likelihood of a UK application being cut down because of a relative grounds objection is actually a lot lower than before the change.

From the perspective of a UK business seeking trade mark protection in overseas jurisdictions, the Madrid Protocol continues to offer an effective means of applying to a number of countries by making a single application in English, and by paying one fee.

More details on the Madrid Protocol and the UK-IPO's International trade mark service can be found on our website at [www.ipo.gov.uk](http://www.ipo.gov.uk).



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