

UK AND EUROPE: LOOK TO YOUR TRADE MARK RIGHTS

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Just a reminder that **examination practice in the UK** will come into line with practice at the Community Trade Marks Office (OHIM) on 1 October. Examiners will continue to assess distinctiveness of trade marks and object to registration if trade marks are descriptive, or otherwise lack distinctiveness. The Office will also continue to conduct searches against earlier trade marks but will issue these for information only, since examiners will no longer object to applications on the basis of conflict with earlier trade marks.

The owners of UK trade mark applications or registrations, or of International registrations designating the UK, that were listed in the search report provided to an applicant will be notified when the application is published.

The owners of Community trade marks listed in the search report will not receive notification from the UK Office unless they have "opted in" to receive notifications, and have paid the fee which is £50 to cover a three year period.

What this means for trade mark owners:

There will be fewer obstacles to registration of trade marks in the UK: a fair proportion of the earlier marks which formed the basis of examiners' objections would not have formed the basis of successful oppositions (for example, because such marks have not been used for 5 years and could not meet the proof of use requirements in opposition proceedings).

There will be more oppositions; the onus will shift to trade mark proprietors to prevent registration of similar trade marks. In some cases where there is clearly no likelihood of commercial conflict, the case may go no further than the "preliminary indication" stage or it may be possible to negotiate agreement at an early stage in the proceedings. At the other end of the spectrum will be full-scale opposition proceedings.

Brief outline of UK opposition procedure

After an opposition has been filed the applicant must either file a counterstatement, or obtain the opponent's agreement to enter into a one year cooling off period to allow for negotiations. After a counterstatement has been filed, the Office issues a "preliminary indication" stating either that the opposition should succeed, should succeed in part, or should not succeed. If neither party elects to file evidence in the proceedings, the preliminary indication becomes binding. This system works well in quite straightforward cases where similarity of trade marks and similarity of goods and services are to be assessed. It means that a UK opposition can in principle be conducted and finalised for about £1000 – though costs will be substantially more if the case goes on to the evidence rounds.

What Haseltine Lake will do:

When we are notified by the UK Office of a potentially conflicting trade mark application, we will forward details of it along with brief general comments, unless you inform us that you wish us to screen notified trade marks and only to report to you those we consider potentially significant. We will not make any charge for forwarding such notices, but will do so if you seek our advice on the prospects of success in an opposition.

Recommendations to trade mark owners

If you own any trade marks in force in the UK, you are now more likely to become involved in opposition proceedings. Your trade marks which have been registered for longer than 5 years can be subject to proof of use in opposition proceedings, which means that such trade marks will only be considered registered, for the purposes of the opposition, for those goods or services for which commercial use can be demonstrated. You should consider refiling unused trade marks if you have an intention to use them in the foreseeable future.

If you are the owner of a Community, but not a UK, registration, and if your commercial interests are limited to the UK, then we recommend that you “opt in” to receive notifications from the UK Office. We can arrange this for you.

Most **owners of Community trade marks** will have interests in EU member states beyond the UK. They are already notified by OHIM when conflicting Community trade mark applications are published, however this does not include notification of conflicting national trade mark applications in any of the EU member states. Rather than opting in to the UK Office's notification service we recommend that you **subscribe to a commercial trade mark watch service** which covers all the countries of the EU. We can arrange this for you, and can provide further information and costings on request. As a guideline, the cost of watching a trade mark in one class for a year, on an EU wide basis, is approximately £120 (ex VAT). This is a cost effective way of monitoring third party applications for conflicting trade marks in the EU.

Note, a trade mark watch of this type should be an adjunct to a marketplace watch for use of similar trade marks. Your own market intelligence network is vitally important, and regular monitoring of the internet is also advisable. If you prefer, we can **monitor the internet for use of your trade marks**, and we can advise further on request.

For assistance, please get in touch with your usual contact at Haseltine Lake.



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To view our trade mark team, please visit:

http://www.haseltinelake.com/people/search_results/trademark

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