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The United Kingdom Intellectual Property Office Announces Significant Changes in Trademark Examination Procedure

The United Kingdom Intellectual Property Office (UK IPO) recently announced significant changes in the way it examines U.K. trademark applications putting the burden on owners of existing trademarks rights in the United Kingdom to safeguard their registrations. Many U.K. trademark owners must now take affirmative action in order to ensure that their registered trademark rights are not compromised or eroded through the registration of conflicting, junior trademarks. The purpose of this notice is to outline these changes and provide recommendations for responding to them.

Changes in U.K. Trademark Examination

Historically, the UK IPO would conduct a substantive analysis of newly filed trademark registration applications (hereinafter the "junior application") and reject any junior application that was potentially confusingly similar to a mark previously registered with the UK IPO. The rejection could be based upon a U.K. national registration or a Community Trademark (CTM) registration. However, as of **October 1, 2007**, the UK IPO no longer refuses registration of junior applications based upon previously registered identical or similar marks. Instead, the UK IPO has adopted a "search and notify" procedure in which it will conduct a search of prior marks and then **notify the applicant** for the junior application of any prior potentially conflicting rights. If the junior applicant chooses to proceed after it has been notified of prior conflicting rights, the UK IPO will, in some cases, automatically notify the owner of the conflicting senior applications or registrations. Once notified, the burden shifts to the owner of the senior application or registration to oppose the junior application. This new procedure shifts the burden of safeguarding trademark rights in the United Kingdom to the owners of existing registrations.

The procedure adopted by the UK IPO for notifying owners of existing applications and registrations is somewhat complicated. As indicated earlier, the UK IPO will automatically notify the owner of a conflicting registration only in certain cases. If the owner of a junior application

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chooses to proceed after being notified of prior conflicting rights, the UK IPO will automatically notify the owners of senior U.K. national trademark registrations (whether filed directly with the UK IPO or through the Madrid Protocol). However, the UK IPO will **not** automatically notify owners of senior applications or registrations in the European Community. The owners of senior CTM rights will only be notified by the UK IPO if they take the affirmative action to "opt-in" to the notification system and pay a service fee of £50 for a three-year period.

Implications

Because the UK IPO no longer refuses registration of marks based upon senior applications or registrations, this effectively shifts the entire burden of safeguarding prior rights in the United Kingdom to the trademark owners. Under this new regime, the owners of senior applications and registrations must expend the time and effort to formally oppose the junior application.

Owners of trademark rights in the United Kingdom need to evaluate their portfolios and decide what, if any, action to take in light of this potentially significant change in the U.K. examination system. Some of the available options include (a) initiating a watch system through a commercial vendor to identify all newly filed, potentially conflicting marks in the U.K. and CTM systems; (b) registering CTM rights with the UK IPO through the "opt-in" notification system; or (c) do nothing in response to this change, recognizing that this action could have a dramatic, negative impact on the strength of the owner's U.K. trademark rights. The circumstances and strategic considerations of each client and each mark will determine the most appropriate course of action.

Recommendations

We recommend that owners of trademark rights in the United Kingdom (either through national and/or CTM registrations) review their portfolios and consider the potential impact of these significant changes by the UK IPO on each mark. For strategically important marks, CTM owners should either 1) opt-in to the UK IPO notification system or 2) elect to set up a watch service that would provide notice of potentially conflicting trademark applications at least in the United Kingdom, and potentially worldwide.