

Guide to UK trade marks practice

Documentary/formal requirements needed to file application

- Details of mark, specification of goods/services and applicant, including entity type
- No Power of Attorney needed
- Applicant must **declare an intention to use the mark for subject goods and services** (does not have to be signed by the applicant directly)
- Simple copy of priority document if applicable

Examination process

Examination report is issued with comments on any absolute grounds issues, formalities issues as well as an official search report designed to identify earlier conflicting marks. This report is normally issued within 2-3 weeks – there have been recent delays at the UKIPO such that timeframes have increased to 6-12 weeks though the UKIPO hopes to return to normal processing times soon. If absolute grounds objections are raised, it is possible to take the following steps – generally, UK examiners allow multiple rounds of arguments and evidence before issuing a final refusal:

- file written arguments and/or evidence in response to refusal; and/or
- request a telephone hearing with senior trade mark examiner

If the application is, accepted owners of conflicting marks identified in the official search report are notified of the application, which can prompt oppositions. A period of 2 months is allowed to respond to examination report (but, where objections are raised, this may be extended at least 1-2 times).

Opposition period

After examination the application is published for 2 months – **this period is extendible by one month.**

Key differences from EUIPO practice

- Possible to file “series” applications to protect up to 6 variants of the same mark under 1 trade mark application. This can be used for slight logo variations or colour differences. **N.B. Objections can be raised if marks are not sufficiently similar to constitute a “series,”** this may mean deleting certain variants but this could still allow greater flexibility in the event of objections.

- More options and rounds of arguments/evidence available (hearings, discussions etc.) to overcome objections based on absolute grounds and generally the threshold for acquired distinctiveness evidence is lower
- Generally greater likelihood of overcoming objections to registration of trade marks at UKIPO through arguments and evidence than EUIPO
- Official search is generally a **more comprehensive indication** of opposition risk than that from EUIPO

Tips on filing strategy

- Often easier to overcome absolute grounds objections at UKIPO than EUIPO so can be greater likelihood of registration of marks, which are allusive or somewhat descriptive
- “Series” application option can be used **to save cost** for colour variants and allow more flexibility in attempting to register marks where there is a risk of absolute grounds objection
- In light of intention to use requirement and more rigorous comparison of goods and services at opposition by the UKIPO than EUIPO we recommend applicants **cover broad AND narrower descriptions** of goods and services
- **Review official search report** to determine possible risk of opposition and pre-emptive action to take before publication (e.g. specification amendment)

Guide to UK designs practice

Documentary/formal requirements needed to file application

- Representation of design, indication of nature of the design (product) and applicant, including entity type
- No Power of Attorney needed
- Simple copy of priority document if applicable

Examination

Examination issues would typically be raised by the UKIPO within 2-4 weeks. Examination is slightly broader than at the EUIPO and objections can be raised if:

- the representation(s) submitted does not correspond to the definition of a design (Section 1 RDA)
- the design is solely dictated by technical function (Section 1C RDA)
- the design is contrary to public policy and/or accepted principles of morality (Section 1D RDA)
- the design consists of a protected emblem (Schedule A1 RDA)

Novelty and individual character

Just as with the EUIPO there is no examination of applications on this basis and no searches are conducted by the UKIPO but post registration cancellation actions can be instigated if designs are not novel and do not possess individual character. Just as with Registered Community Designs here is a 12 month grace period for disclosure of designs by the Applicant.

Formalities

- Multiple Applications – up to 50 designs can be covered in an online application and there is no limit on numbers if using the paper filing form.
Multiple designs need not fall under the same Locarno class
- Representations – up to 12 design representations may be filed using the online form, for paper forms there is no limit on the number of representations
- There is a need to indicate what the design is (usually the nature of the product in question) but this does not define scope of protection and

while it is possible to indicate a Locarno class in the application this is not compulsory

Disclaimers

- It is possible to disclaim elements of designs using dotted lines or other amendments to the representation
- It is also possible to use a written description to clarify and describe which elements of design are disclaimed
- Deferred publication Possible to defer publication of UK designs for 12 months from filing date

Key differences from EUIPO practice

- More representations of design can be included
- Requirement to provide “indication of design” but no need to specify Locarno class
- Possible to use verbal descriptions to define disclaimers
- Deferment period for UK designs (12 months from filing date) is shorter than Community designs (30 months from filing)
- Multiple design applications are not limited by Locarno class and official fees are much lower (£20 for each additional set of 10 after the first 10)

Tips on filing strategy

- Consider use of written disclaimer requirement to assist in definition of design and enforcement
- Consider use of greater number of representations of the design to assist in defining protection
- Consider wider use of multiple design applications since official fees are lower and there is no restriction based on Locarno class
- Where deferred publication of designs is important consider timing of filing of UK application to maximise shorter deferment period e.g. from priority application at EUIPO

For more information: Please contact your usual Marks & Clerk Attorney or email beyondbrexit@marks-clerk.com