



"Relative Grounds" to disappear from UK Trade Marks Practice ?

Currently, when examining a new trade mark application the UK Registry carries out a search and, if it finds an earlier mark that it considers likely to be confused with the new trade mark, it raises an objection. Registration may be refused unless the applicant successfully argues that the objection is unjustified (ie if the likelihood of confusion has been overestimated) or finds some other way to overcome the objection, such as by acquiring the earlier trade mark or obtaining the consent of its owner.

It seems likely that such "relative" grounds of refusal will soon be a thing of the past in UK trade marks practice. In February 2006, the UK Trade Marks Registry published a consultation paper on this subject, and on 2 August 2006 it announced that:

"The next steps will be to flesh out Option 5 in more detail and to introduce the legislative and administrative changes to bring it to fruition. This will involve further consultation with our users on the procedural rules we intend to introduce, which will cover the procedures for notifying the applicant of any relevant marks identified in the official search, how long the applicant will have to withdraw or restrict his application before it is published, and the circumstances in which owners of earlier trade marks will be notified of later conflicting marks. We anticipate that this process and the necessary changes to the internal systems of the Trade Mark Registry of the Patent Office will take some time to complete and, therefore, we expect the new regime to come into force in October 2007."

Under the proposed Option 5, the search results will be communicated to the applicant without comment by the Registry, and the applicant will then have to make an informed judgement as to whether to proceed with the application. However, the Registry will have the option of notifying the existence of the pending application to the owner of the earlier mark, thereby prompting them to file an opposition if they object to the later mark being registered.

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