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## New United Kingdom Intellectual Property Office Rules Affect Owners of European Community and Certain International Trademark Applications and Registrations

Beginning October 1, 2007, the United Kingdom Intellectual Property Office (UKIPO), which covers the countries of England, Scotland, Wales and Northern Ireland, will change its trademark examination practice with regard to prior-filed trademark applications and registrations. For trademark owners that own European Community Trademark (CTM) applications and/or registrations or International applications and/or registrations filed pursuant to the Madrid Protocol that designate the European Community, special action is required between October 1, 2007 and October 20, 2007 as a result of these changes.

### Existing United Kingdom Law

Under the existing Trade Marks Act 1994, the UKIPO will not register a trademark that is identical or similar to an earlier filed trademark for identical or similar goods and/or services. Currently, the UKIPO will issue refusals of registration if it believes there is a likelihood of confusion between an applied for mark and an earlier filed or registered mark. Currently, CTM applications and registrations and International applications and registrations designating the European Community are considered in issuing such refusals.

### New Changes to the United Kingdom Examination Process

After October 1, 2007, the UKIPO will no longer refuse registration of U.K. trademark applications based on likelihood of confusion with

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an earlier mark. Although it will still conduct a search for identical or confusingly similar marks during the examination of an application, it will now simply notify the applicant in a report of potentially conflicting marks. The applicant can then decide whether it wishes to proceed with its application despite the existence of these earlier rights. If the applicant decides to proceed with its application, the UKIPO will then inform the owners of certain of the prior marks of the existence of the applicant's application.

There is no need for owners of national U.K. applications and registrations to take any special action since the UKIPO will automatically notify all national U.K. owners of conflicting marks. However, the UKIPO will not notify the owners of CTM and International applications and registrations designating the European Community unless the owners of those applications and registrations have expressly opted in to the new notification process and paid the appropriate fee of £50 per mark (approximately \$100 U.S.), which covers a notification period of three years. The first opportunity to opt in begins October 1, 2007 and ends October 20, 2007.

### **Practical Applications of the New Rules**

A U.K. applicant has two months to respond to a UKIPO report, which issues and cites the potentially conflicting marks. The owners of these marks will not be notified of the existence of the applicant's application if the applicant takes one of the following actions in that two-month period:

- deletes conflicting goods and/or services from the specification of goods and/or services of the application;
- successfully argues that the application does not conflict with the identified marks and the citation is withdrawn;
- obtains consent to register from the owners of the identified earlier trademarks; or
- withdraws the application.

If no appropriate response is submitted, the owners of the potentially conflicting marks will be notified by the UKIPO, providing them with sufficient notice to take any action deemed appropriate and necessary.

Owners of CTM and/or International trademark applications and/or registrations that designate the European Community should be prepared to oppose applications filed by a third party that may conflict with their prior existing rights. The UKIPO will no longer police the U.K. trademark registry on behalf of such trademark owners. Thus, owners should very seriously consider opting in to the new notification procedures if they own a CTM trademark or

International trademark that designates the European Community. Trademark watch services will be even more important now, and can either be a substitute for opting in to the notification process or can serve as a valuable supplement thereto.

Trademark owners who do not opt in by October 20, 2007 may still opt in at a later time. However, notification of potentially conflicting marks will begin only after the UKIPO has received your request to opt in to the process.

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*For more information on this or any other trademark matter, please contact one of the attorneys listed below or the Mintz Levin attorney who ordinarily handles your legal affairs.*

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