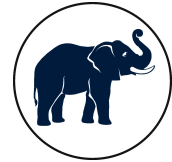


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TRADE MARK NOTICE OF THREATENED OPPOSITION– Form TM7A

What should you do if you have filed a trade mark application at the United Kingdom Intellectual Property Office and then receive a Form TM7A - Notice of Threatened Opposition?

What is a Notice of Threatened Opposition (Form TM7A)?

Having applied for a UK trade mark registration, the UK Intellectual Property Office examines your application against other trade marks already on its register of trade marks to assess whether your application is identical or similar to any existing marks on its register. If the Trade Marks Registry considers that your application is similar to an existing registered trade mark or trade mark application, it will send a copy of your application to the owner of that existing earlier trade mark registration or trade mark application, giving that owner the opportunity to oppose your application for trade mark registration.

An owner of an earlier trade mark registration or trade mark application can notify the UK Intellectual Property Office of his intention to oppose the registration of your application for trade mark registration by sending to the UK Intellectual Property Office a form TM7A, Notice of Threatened Opposition. The process is done using the UK Intellectual Property Office's website.

Additionally, some trade mark owners of registered trade marks "watch" their brands and registered trade marks using computer-based 'watching' services to protect their trade mark portfolios.

If your application for a registered trade mark passes the examination procedure of the UK Intellectual Property Office, the UK Intellectual Property Office will publish your UK trade mark application. The UK Intellectual Property Office will advise earlier registered trade mark owners when the trade mark application is published that it considers that an earlier trade mark is confusingly similar to your application and your application can be opposed by a prior rights owner.

The receipt of a notification that the UK Intellectual Property Office considers that your application for trade mark registration is similar to a registered trade mark already on the trade marks register may prompt an owner of an identical or similar third party mark to send a "Notice of Threatened Opposition" on Form TM7A.

Once the UK Intellectual Property Office has accepted your application for a registered trade mark, it publishes your trade mark application in the Trade Marks Journal. According to the Trade Marks Act 1994, as amended, once the examination of the trade mark application has been completed, the trade mark

application must be allowed to be considered by members of the public, and perhaps interested third parties, for a period of two calendar months, so anyone can apply to oppose the registration of your trade mark. The outcome of sending the “Notice of Threatened Opposition”, sent on Form TM7A to the UK Intellectual Property Office, is to extend the period by one month, thus extending the opposition period to three months.

The sending of a Notice of Threatened Opposition is not a formal opposition to your trade mark application. Its reception by the UK Intellectual Property Office is merely an indication that someone may file an opposition before the end of the extended 3 month opposition period. The sending of the Notice of Threatened Opposition on Form TM7A allows the interested third party more time to prepare their opposition. The UK Intellectual Property Office does not charge for sending a Notice of Threatened Opposition on form TM7A, but it insists that this notification is completed on its website.

You could additionally receive a letter lawyers asking you to withdraw your trade mark application or asking you to limit the goods or services of your application. Receiving such a letter does not commence any formal opposition proceedings at the UK Intellectual Property Office. Receiving a letter, such as that described, gives you the opportunity to enter into dialogue with the earlier rights owner and investigate their concerns.

Only when a member of the public applies to oppose your application for trade mark registration (using on Form TM7), and only after they have paid the appropriate opposition fee, is a formal opposition commenced in the UK Intellectual Property Office.

The UK Intellectual Property Office may send you a letter which says that your application for trade mark registration may be identical or similar to another mark already on the trade marks register. The letters written by the UK Intellectual Property Office to owners of earlier registered trade marks alert those owners that the UK Intellectual Property Office have found an identical or similar mark to the application applied for by you. However sometimes the earlier registrations quoted by the UK Intellectual Property Office may not be confusingly similar when properly analysed by a trade mark professional and, perhaps, should not have been cited. In other words, simply because a third party is notified by the UK Intellectual Property Office of your trade mark application does not necessarily mean that your trade mark application is confusingly similar to the third party’s earlier trade mark.

What to do if you receive a Notice of Threatened Opposition (Form TM7A) from a third party?

Your options include:

1. Taking no action;
2. Ignoring the Notice of Threatened Opposition (Form TM7A) and waiting until the end of the 3 month extended opposition period to see if an opposition is filed by the party who filed the Form TM7A. If no formal opposition as filed, then your mark will proceed through to registration automatically. Otherwise, if a full opposition is received, then you can decide whether to defend the opposition or not.

3. Contacting the person who filed the Form TM7A (Notice of Threatened Opposition) requesting that they do not oppose your trade mark application because you intend to allay their concerns by perhaps reducing the scope of your trade mark application in some way to allay their concerns.

If the Notice of Threatened Opposition on Form TM7A is based upon an earlier registered trade mark, it is advisable to compare their trade mark with your application in order to consider your use of your trade mark application would potentially infringe their earlier trade mark rights. If you think your mark is identical or similar to the earlier rights owned by the person who sent you the Form TM7A, then this is a potentially very serious matter, and we suggest that you seek professional advice as soon as possible.

Some of the pre-emptive operations that you can perform if you receive a Form TM7A (Notice of Threatened Opposition) include:

1. Conducting a trade mark search to ascertain if the person responsible for sending you the Form TM7A (Notice of Threatened Opposition) owns similar registrations to sign that you have applied for.
2. Conducting an internet search ("Google" search) in order to understand if the person responsible for sending you the Form TM7A (Notice of Threatened Opposition) appears to be using their registered trade mark. An unused registered trade mark vulnerable to revocation on grounds of non-use.
3. Remaining very sceptical of any claims by lawyers acting on behalf of their clients that your application is similar to their client's registration. The test is not 'similarity' but 'likelihood of confusion', and this is a concept frequently ignored or misapplied by lawyers or trade mark owners.
4. Consulting the UK Intellectual Property Office's website. It contains clear and comprehensive information about your rights and the opposition process.

All that having been said, there are many aspects of this law that are not transparent, making positive steps challenging to navigate. Should you wish to obtain professional legal advice, please feel free to contact us via email or telephone.

Contact us for a free consultation:

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Telephone: 01869 369701
Visit: Rowood House,
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