



World Trademark Review Yearbook 2022/

2023

**United Kingdom: Trademark
procedures and strategies**


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A simple, easy-to-use digest of trademark regulations in key jurisdictions across the globe.

Generated: February 8, 2024

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United Kingdom: Trademark procedures and strategies

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LEGAL FRAMEWORK

UK trademark law is governed by the Trademarks Act 1994 and a number of statutory instruments containing certain Brexit-related legislation.

The United Kingdom is a member of the WIPO and a signatory to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, meaning that the United Kingdom can be designated under an international registration.

The United Kingdom is also a signatory to numerous international treaties relating to trademarks, including:

- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- the Nice Agreement Concerning the International Classification of Goods and Services; and
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks.

Unjustified threats provisions relating to trademarks and other forms of registered IP rights are prescribed under the Intellectual Property (Unjustified Threats) Act 2017. The provisions regarding trademarks are expressly covered by Sections 21 to 21F of the Trademarks Act.

UNREGISTERED MARKS

Unregistered trademarks can be protected through the common law tort of passing off.

In a typical claim for passing off, the claimant must establish the so-called classical trinity (*Reckitt & Colman Products Ltd v Borden Inc*), namely:

- goodwill in relation to the goods or services provided under the trademark;
- a misrepresentation by the defendant (whether intentional or innocent) that is likely to deceive the relevant public into believing that the defendant's goods or services originate from (or are associated with) the claimant (or vice versa); and
- damage, or a likelihood of damage, resulting from the defendant's actions.

Goodwill is assessed on a case-by-case basis and must be local to the United Kingdom. It is more than just mere reputation, although the trademark need not be well known and rights may be limited to a specific locality where there is no nationwide use.

The evidential burden on a claimant is generally higher in a claim for passing off than a claim for registered trademark infringement, although the two are often pursued together.

REGISTERED MARKS

Any natural or legal person can apply for a registered trademark in the United Kingdom. Applicants must declare that the mark is being used by them, or with their consent, or that there is a genuine bona fide intention to use the mark, for the specified goods or services.

Appointing a representative before the UK Intellectual Property Office (UKIPO) is not compulsory, and where one is appointed, no power of attorney is required. However, as of 1

January 2021, all new UK trademark applications (and oppositions) require a UK address for service.

The UK trademark register is publicly accessible online, free of charge.

To qualify for protection, a sign must be capable of:

- being represented in the register in a way that allows the “clear and precise subject matter of the protection afforded to the proprietor” (Trademarks Act 1994) to be determined; and
- distinguishing goods or services of one undertaking from those of other undertakings.

A trademark may, without limitation, consist of words (including personal names), designs, letters, numerals, colours, sounds, holograms, multimedia marks or the shape of goods or their packaging. Case law has also held that olfactory and taste marks are registrable in principle.

Up to six variants of a trademark may be covered under a single series application, provided that any variations do not affect the mark’s inherent distinctive character. Collective and certification marks can also be registered in the United Kingdom.

Signs cannot be registered in the United Kingdom if they:

- cannot be represented sufficiently clearly and precisely, or are incapable of distinguishing the goods or services of one undertaking from those of another;
- are devoid of distinctive character;
- consist exclusively of characteristics that describe the goods or services;
- have become generic or customary in the current language or genuine and established practices of the trade;
- consist exclusively of a shape or another characteristic that:
 - results from the nature of the goods themselves;
 - is necessary to obtain a technical result; or
 - gives substantial value to the goods;
- are contrary to public policy or accepted principles of morality;
- are deceptive;
- have been applied for in bad faith; and
- consist of or contain certain specially protected emblems, for example:
 - the royal arms or Olympic symbols (if applied for without authorisation); or
 - certain national flags (where use of the trademark would be misleading or grossly offensive).

These are referred to as absolute grounds for refusal.

COMPARABLE UK MARKS

The United Kingdom left the European Union on 31 January 2020, triggering a transition period that expired on 31 December 2020. As of 1 January 2021, the United Kingdom is no longer directly subject to EU rules and regulations, meaning that EU trademarks no longer have legal effect in the United Kingdom. All EU trademarks (including collective and certification marks) registered as at 31 December 2020 were automatically cloned on 1 January 2021 by the UKIPO to create comparable UK trademarks. A comparable UK mark has the same legal status as a mark registered under UK law, maintains the original EU trademark filing, priority or seniority dates, and is a fully independent UK trademark that can be challenged, assigned, licensed, enforced or renewed separately from the originating EU trademark. Under certain conditions, EU trademark holders may choose to opt out of obtaining a UK comparable mark.

For EU trademark applications pending as at 31 December 2020, rights holders had until 30 September 2021 to apply to register the same mark in respect of the same goods or services as a UK trademark. Such applications retained the earlier filing date of the pending EU trademark application and benefitted from any valid priority or seniority claims.

PROCEDURES

EXAMINATION

The UKIPO initially examines all trademark applications to ensure that they meet the formal filing requirements. It then undertakes a substantive examination to ensure that the specification of goods and services is sufficiently clear and correctly classified, and registration of the sign is not prohibited by any absolute grounds (other than bad faith). If objections are raised, applicants initially have two months to respond.

The UKIPO also undertakes a search for earlier conflicting UK marks. Where conflicting rights are identified, these are listed in the examination report and the applicant may amend the specification, withdraw the application or (once any other objections have been addressed) proceed with the application. If the application is published for any conflicting goods and services, the UKIPO will notify the holders of earlier UK rights. It is then for the earlier rights holders to decide whether to oppose.

OPPOSITION

Once any objections raised during examination have been resolved, applications are published for opposition purposes. The opposition period is initially two months from the date of publication. Potential opponents may file a notice of threatened opposition during that period to extend the opposition period by an additional month.

An opposition may be based on any absolute or relative grounds (or both), including where there exists:

- an earlier identical trademark for identical goods or services;
- a likelihood of confusion with an earlier (identical or similar) trademark covering identical or similar goods or services (including a likelihood of association);
- an earlier trademark with a reputation in the United Kingdom where use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark;
- an earlier unregistered trademark or other sign used in the course of trade;

- an earlier conflicting geographical indication or designation of origin; and
- earlier conflicting copyright, design rights or registered designs.

An 'earlier trademark' is defined as:

- an earlier UK trademark application or registration;
- an earlier international application or registration designating the United Kingdom; or
- an earlier trademark entitled to protection in the United Kingdom under the Paris Convention or the TRIPs Agreement.

Where an application is opposed, the applicant has two months to either file a defence or enter into a cooling-off period. If the applicant does not respond to the opposition, the application will be deemed abandoned in respect of the opposed goods or services.

To enter into a cooling-off period, both parties must consent. The cooling-off period initially lasts for seven months and may be extended by the parties for a further nine-month period. Either party may terminate a cooling-off period unilaterally without notice. If the dispute is unresolved at the end of the cooling-off periods, the applicant must file a defence to avoid the application becoming abandoned.

The opponent has two months from receipt of the notice of defence to file its submissions and evidence in support of the opposition. The applicant then has two months to file its own submissions and evidence, and the opponent has a further two months to reply. On completion of the evidence rounds, the hearing officer will make a decision based on the parties' written submissions and evidence or after a formal hearing (if requested by either party).

Where an opposition is based on an earlier trademark that has been registered for five years or more as at the filing date of the opposed application (or, where applicable, its priority date), the applicant may put the opponent to proof of use of the earlier mark. Where use cannot be established, the earlier mark in question will not be considered in the proceedings.

In respect of comparable UK trademarks, any use made of the originating EU mark in the European Union before 1 January 2021, whether inside or outside the United Kingdom, will count as use of the comparable UK mark. Similarly, where an originating EU mark enjoyed a reputation before 1 January 2021 in the European Union but not the United Kingdom, such reputation will also be considered for the purposes of the comparable UK mark.

Cost awards in proceedings are generally issued to the successful party and are calculated using a published scale of costs. Exceptionally, the UKIPO can award off-the-scale costs to address parties' unreasonable behaviour.

A standard opposition is likely to take in the region of 12 to 18 months to reach a decision (subject to appeal).

REGISTRATION

Absent any opposition, or once any opposition proceedings have been overcome, the application will proceed to registration. An application that encounters no objections or oppositions may be registered within four months of filing.

Once registered, a trademark is protected for 10 years from its filing date and may be renewed indefinitely provided the appropriate fee is paid every 10 years (subject to a standard six-month, and exceptional 12-month, grace renewal period).

Comparable UK trademarks retain the renewal date of their originating EU mark and are subject to standard UK renewal fees and procedure.

REMOVAL FROM REGISTER

INVALIDATION

A registration may be declared invalid at any time following registration based on absolute or relative grounds. Anyone can file an invalidation application based on absolute grounds, but only prior rights holders may file invalidation applications based on relative grounds.

If an earlier rights holder acquiesces in the use of a registered trademark for a continuous five-year period, it may lose the right to file an invalidation action, unless the later trademark was registered in bad faith.

Following a declaration of invalidity, the affected registration is deemed never to have been registered in respect of the affected goods or services.

REVOCACTION

The grounds for revocation are:

- non-use – where a mark has not been put to genuine use in the United Kingdom within five years of registration or if such use has been suspended for an uninterrupted five-year period and there are no proper reasons for non-use;
- loss of distinctiveness – where a mark has become the common name in trade for the goods or services for which it is registered as a consequence of the acts or inactivity of the rights holder; and
- deceptiveness – where a mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services for which it is registered as a consequence of the acts or inactivity of the rights holder.

Following an order for revocation, the holder's rights are deemed to have ceased as of the date of the application for revocation or an earlier date if the grounds for revocation existed at that date.

For EU trademarks that were subject to ongoing cancellation proceedings on 31 December 2020 and are subsequently cancelled, the EU cancellation decision will be applied automatically to the UK comparable trademark except where the grounds for cancellation do not apply in the United Kingdom.

SURRENDER

A registration can be surrendered (partially or entirely) at any time. Surrender takes effect from the date of publication of the surrender in the UKIPO Trademarks Journal.

ENFORCEMENT

It is possible to bring an infringement or passing-off action in respect of unauthorised use of a registered or unregistered mark.

PRE-ACTION STEPS

Before bringing an infringement or passing-off claim, potential claimants are expected to make reasonable efforts to settle the dispute. Failure to do so may affect the available remedies (in particular, liability for costs).

It is common practice to send a cease and desist letter to the infringer prior to issuing proceedings, having due regard to unjustified threats legislation.

Unjustified threats legislation does not apply to acts of primary infringement such as applying a mark to goods or their packaging, importing such goods or supplying services under the mark.

For secondary acts (eg, selling infringing goods), a threat will be justified if the communication is necessary for the purpose of:

- giving notice that an IP right exists;
- discovering whether, or by whom, a right is being infringed;
- giving notice that a person has an interest in an IP right where that is relevant to any proceedings; or
- any other purpose that a court deems to be in the interests of justice.

A threat is also justified if it is shown that the act to which the threat relates was or would be infringing.

Unregistered trademark rights are not subject to unjustified threats legislation.

CIVIL PROCEEDINGS

Both infringement and passing-off actions can be brought in the High Court (Chancery Division), including the separate IP Enterprise Court (IPEC), as well as in a designated county court.

The remedies available depend on the court and route chosen. The IPEC is intended to manage lower value and less complex actions than the High Court and can therefore be cheaper and quicker for rights holders. Proceedings in the IPEC are subject to costs caps and caps on the amounts recoverable in damages.

Remedies available to a successful rights holder may include:

- an interim injunction (not available in the IPEC small-claims track);
- a permanent injunction;
- delivery up or destruction of infringing goods;
- removal of marks from infringing goods;
- an account of profits or damages;
- a declaration of validity and/or infringement; and/or
- payment of legal costs.

An interim injunction is a discretionary remedy and an applicant must show that it would suffer irreparable harm if an injunction were not granted until the end of a full trial. When

seeking an interim injunction, it is important that the rights holder acts immediately on learning of the infringement, as any delay may prejudice its position.

In respect of proceedings commenced after 31 December 2020, UK courts cannot sit as EU trademark courts and cannot grant pan-EU injunctions. Where a UK court was hearing a case as an EU trademark court on 31 December 2020, it will continue to do so. Actions and remedies taken or granted by the court in such cases continue to apply to EU rights, and the IPEC and the High Court may decide on infringement, revocation and invalidity, and to issue pan-EU injunctions.

Injunctions that are in force on 1 January 2021 that prohibit acts of infringement of an EU trademark in the United Kingdom give rise to an equivalent injunction that has effect in respect of the corresponding comparable mark, subject to any court order to the contrary. Any EU-wide injunction issued by a court of an EU member state on or after 1 January 2021 will not apply in the United Kingdom.

CRIMINAL PROCEEDINGS

The unauthorised use of a trademark can also constitute a criminal offence – for example, applying identical or highly similar signs to goods or their packaging, or selling, distributing or possessing such goods. To commit an offence, a person must act without the owner's authorisation, with a view to gain or with an intention to cause loss. The goods must be covered by the registered trademark and the trademark must be reputed in the United Kingdom, such that the use of the sign takes unfair advantage of, or is detrimental to, its distinctive character or repute.

It is a defence to criminal infringement proceedings for the defendant to establish that they believed on reasonable grounds that the use of the mark in the manner in which it was used, or was to be used, was not an infringement of the registered trademark.

A person guilty of an offence may receive a fine or be sentenced to up to six months' imprisonment on summary conviction (or both), and up to 10 years on conviction on indictment.

It is also a criminal offence to knowingly or recklessly misrepresent that a trademark is registered (eg, by using the ® symbol) if this is not the case. If desired, the ™ symbol may be used in respect of unregistered marks.

EXHAUSTION

The United Kingdom currently operates exhaustion for trademarks across the European Economic Area (EEA). Consequently, with some limited exceptions, if goods are placed on the market anywhere in the EEA with the consent of the rights holder, the rights holder is unable to assert their trademark rights to prevent the subsequent export of those goods into the United Kingdom. By contrast, goods placed on the United Kingdom market by, or with the consent of, the rights holder are not considered exhausted in the EEA and will require additional consent for export to the EEA.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

A registered trademark is a property right that can be transferred, licensed, mortgaged and otherwise exploited like any other form of property. As well as a complete transfer, it is possible to partially assign or license a trademark in respect of certain goods or services for which the mark is registered, as well as for use in a particular manner, field or locality.

While such changes and transfers must be made in writing and signed on behalf of the assignor or licensor, the assignee's or licensee's signature is not required (although it is recommended to avoid disputes). If a trademark is jointly owned, all owners must consent to any assignment or licence.

For a licensee to assert its statutory rights and remedies in relation to infringement, the licence must be recorded at the UKIPO. Once recorded (subject to any express derogations contained in the licence itself), an exclusive licensee may call on the trademark owner to initiate infringement proceedings in respect of any infringing activity affecting the licensee's interests. If the owner refuses or fails to do so within two months, the licensee may bring proceedings in its own name.

A non-exclusive licensee may take infringement proceedings only with the consent of the owner (unless stated otherwise in the licence).

Failure to record an assignment or licence with the UKIPO within six months of its effective date can have adverse costs consequences for the new owner or licensee in any subsequent infringement proceedings.

Subject to any specific conditions that it may prescribe, a licence or security interest recorded against an EU trademark continues to have legal effect in the United Kingdom against the comparable UK mark. Any licence or security interest that refers to an EU trademark and authorises acts in the United Kingdom is treated as if it applies to the comparable UK mark.

RELATED RIGHTS

Copyright, registered designs and unregistered designs can complement (and overlap with) trademark rights, particularly in the field of figurative and three-dimensional trademarks. For example, copyright in artistic works arises automatically and subsists for 70 years from the end of the calendar year in which the author dies.

New product get-up and designs that possess individual character can also be protected in the United Kingdom. Unlike a trademark registration, a design registration does not have use requirements. A registered design is renewable every five years, up to a maximum of 25 years. Unregistered UK design rights protect designs for a period of 15 years from their creation date or for 10 years after the product is first sold, whichever is earlier. Designs that were protected in the United Kingdom before 1 January 2021 as unregistered community designs are protected as UK continuing unregistered designs for the remainder of their three-year term of protection. A new Supplementary Unregistered Design provides three years' protection in the United Kingdom for new designs first disclosed in the United Kingdom after 31 December 2020. Community Registered Designs in force as at 31 December 2020 have been cloned automatically into corresponding UK Registered Designs, except where publication has been deferred, in which case a new UK Registered Design application had to be filed by 30 September 2021 in order to secure equivalent protection in the United Kingdom.

COMPANY NAMES TRIBUNAL

The Company Names Tribunal adjudicates complaints involving company names registered for the primary purpose of preventing someone else with a legitimate interest from registering the names or demanding payment to release a name. It is a relatively straightforward and inexpensive process.

ONLINE ISSUES

The dispute resolution service for '.uk' domains is operated by Nominet, the '.uk' domain name registry.

Any legal or natural person can bring a claim. To succeed, the complainant must establish that the domain name complained of is an abusive registration – meaning that it was registered (or acquired) or is being used in a way that takes unfair advantage of, or is unfairly detrimental to, the complainant's rights.

If a complaint is defended, it automatically enters a voluntary mediation stage. A Nominet mediator will contact both parties and try to resolve the dispute. If mediation is unsuccessful, the complainant must pay a fee to receive a decision on the matter by a Nominet expert. Appeals are available to a panel of three experts.

If the complainant succeeds, the domain name registration may be cancelled, suspended or transferred to the complainant.

No	No: but the UKIPO conducts searches for prior conflicting marks and notifies UK trademark owners.	Yes: sound; colour; smell/olfactory; taste; movement/hologram; multimedia; 3D.
Yes	Yes	Yes: initially two months from publication, extendable by one month.
Yes: continuous period of five years' non-use at any time after registration.	Yes	Yes
Yes	No	Yes: should be applied for without delay.
No: but it is strongly recommended.	No: but common law remedies available.	Yes: operated by Nominet for all '.uk' domains.



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