



BOULT WADE TENNANT

European Patent and Trade Mark Attorneys,  
Chartered Patent Attorneys and Chartered Trade Mark Attorneys

# Filing at the UKIPO

**Catherine Wolfe, 22 October 2020**





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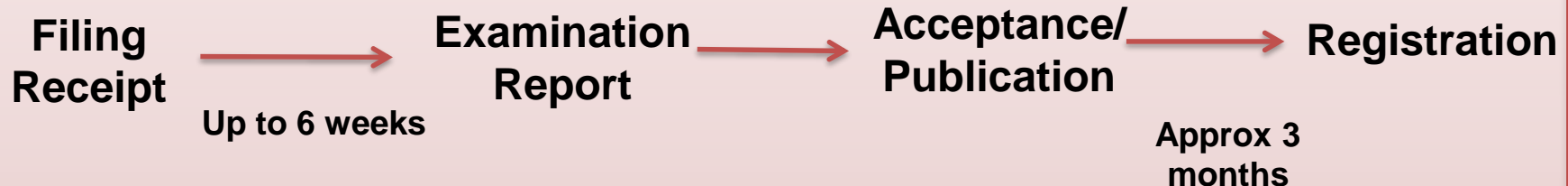
## Introduction

- Timeline from filing to registration
- Examination Process
- Absolute Grounds For Refusal
- Publication and Registration



## The Trade Mark Timeline

- Applications are filed online and the filing receipt is issued almost instantly
- If there are no objections or other issues, the mark will be accepted and subsequently published
- If no opposition is filed, the registration certificate will be issued approximately two weeks after the expiry of the two-month opposition period



## Trade Mark Examination

- Trade mark applicants will be provided with a single examination report
- During the examination process a search will be conducted for earlier rights and the Examiner will select those which seem to be of most relevance in his/her opinion
- The Examination Report might have:
  - 1) Inherent absolute grounds for refusal objections or specification objections
  - 2) “Informational report” – citations of earlier marks that are provided for information only. The Examiner does not refuse the application on this basis

## Classification Objections

- The Trade Mark Examiner can also raise objections to the application on the basis that the specification either lacks clarity or particular terms require transferring to a more relevant class
- Trade Mark applicants cannot widen the scope of protection once the application has been filed



## Absolute Grounds For Refusal

- The frequently encountered absolute grounds for refusal are:
  - 1) The trade mark does not fall within the **definition of a trade mark**
  - 2) The trade mark is **devoid of any distinctive character**
  - 3) The trade mark is purely **descriptive** of the goods or services for which it is being registered
  - 4) The trade mark is a term that is **generic** and commonly used in the relevant trade
- The last three grounds can be overcome by demonstrating acquired distinctiveness



## Publication and Registration

- Once the mark is accepted by the Examiner, the mark will be published on the UKIPO Trade Marks Journal for **two months** from the publication date (“opposition period”)
- Once the mark is published, the mark is available for third parties to oppose the mark within the opposition period
- A third party owner can extend the period by an additional month, making the opposition period up to **three months**
- If there are no oppositions within this period, there will be one further review: then the mark will be registered and the IPO will issue the Registration Certificate within about two weeks

# Questions

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