

Changes affecting a small number of trade mark tribunal proceedings

News story

Changes are being made to address an issue which affects a very small number of trade mark tribunal proceedings.



Background

Trade mark owners can challenge a later filed trade mark that they think conflicts with their existing trade mark.

Before the end of the Brexit Transition Period, this challenge (by way of opposition or invalidation proceedings) could be based on an existing EU trade mark. When this happened, it was possible to counter challenge the EU mark by questioning its validity at the European Union Intellectual Property Office (EUIPO). This counter challenge could be based on the existence of an earlier UK trade mark.

Since the end of the Transition Period, existing EU trade marks may still be relied upon in certain pre-transition period proceedings in the UK. However, the EUIPO has now prevented counter challenges if they are based on earlier UK trade mark rights. In very rare cases, this means that an EU trade mark could be used to successfully oppose or invalidate a later UK trade mark in a potentially unfair way (because the EU mark may not itself have been valid).

The changes

To address this, a new route to counter challenge will be available at the IPO. This will ensure that applicants (and owners) of UK trade marks are able to counter challenge an earlier trade mark which is being used against them, by tying the enforceability of the EU mark to the outcome of any challenge (or registration process) to a comparable or re-filed mark deriving from the EU mark.

The change can only apply to IPO tribunal proceedings, based on an EU trade

mark, that are

- oppositions and invalidations which were ongoing at the end of the transition period (on 31 December 2020), and are not yet concluded, or
- oppositions started after the end of the transition period, but only those made against trade mark applications filed before the end of the transition period, and not yet concluded

We expect the number of cases affected by this change to be low.

Action to take

The new route to counter challenge will be available in December 2021. In the meantime, affected parties may request a stay of any relevant tribunal proceedings. Detailed guidance will be made available through a [tribunal practice notice](#) at least three weeks before the changes apply.

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