

Merging UK Trade Mark Registrations

The rules under which UK trade mark registrations may be merged are changing from October 01, 2012. In principle there will be **fewer opportunities to merge UK registrations**, but this is unlikely to be inconvenient in practice. Many users of the UK trade mark system may not even be aware of the possibilities and benefits of merging registrations.



Under the new rules:

- Multiple UK trade mark **registrations** may be merged into a single registration, if they cover **exactly** the same mark and have the **same** filing date.
- A registration currently subject to cancellation proceedings cannot be merged.
- A UK registration that is the base for an International registration cannot be merged within the initial five year dependency period.
- An expired registration cannot be merged (so cannot be revived by merging it with a “live” registration).
- It will **no longer** be possible to merge registrations covering the same mark, but having **different** filing dates.

Merging registrations reduces administration and renewal fees, and has been used in three situations:

1. The UK trade mark system once required a separate registration for each class of goods. An owner could thus have a portfolio of trade mark registrations covering the same mark, each attracting a full official renewal fee (currently £200). When registrations covering multiple classes became possible, it also became possible to merge single-class registrations into one multi-class registration. This reduces costs, since a multi-class renewal incurs official fees of only £50 for each additional class. This facility remains available.
2. Also, **it is possible to divide an application in two during examination**, for tactical reasons. These **divisional applications can be merged again**, if they both achieve registration. Since divisional applications have the same filing date, this facility should continue.
3. Until now, it has also been possible to merge multiple registrations for the same mark having **different** application dates. A trade mark owner might file a limited initial application, but later realise that the mark needs to be protected for further goods and/or services. These cannot be added to the existing registration, so a new application must be filed. Until October 01, 2012, it has been possible to merge two such registrations. This again saved administration and reduced costs. However, the merged registration only benefitted from the registration date of the most recent of the registrations. The Trade Marks Registry has now withdrawn this seldom-used option, **restricting mergers to marks having the same filing date**.

For most users, this change should raise no issues. However, it highlights the potential benefits of tidying-up any remaining portfolios of single-class UK trade mark registrations.

It also emphasises the **importance of considering brand extensions when filing a trade mark application, reducing the need to file additional applications as the commercial scope of the mark increases**. A wide initial specification may have drawbacks as well as benefits, however, so the advice of an experienced trade mark attorney will be invaluable in such situations.