

TRADE MARK NOTICE OF THREATENED OPPOSITION – Form TM7A

What do you need to do if you have filed a trade mark application at the United Kingdom intellectual property office and you have received a form TM7A - notice of threatened opposition?

Why have you been sent the TM7A letter?

When you file a UK trade mark application, the UK intellectual property office compares your trade mark with other trade marks already on the UK register to see if it is identical or similar to any existing marks. If the trade marks registry consider that your mark is similar to an existing registered trade mark, they will automatically send a copy of your application to the owner of that existing registered trade mark. This gives the owner of that mark a chance to file an opposition against your application. The first stage of this is often for the owner of the third party mark to file a form TM7A, notice of threatened opposition.

Also, many trade mark owners have independent third-party computer-based search services in operation to protect their trade mark portfolios. When your UK trade mark application is published by the UK trade marks registry it can be picked up by computerised searches and will show up in routine search reports. That may prompt an owner of an identical or similar third party mark to file a notice of threatened opposition.

What is a notice of threatened opposition?

When the UK trade marks registry publishes your trade mark application, as part of the application procedure there is a two-month period in which interested third parties may file an opposition to the registration of your mark. The effect of a third party filing a notice of threatened opposition is to extend the opposition period by an extra month, so the period in which to file an opposition lasts three months from the date of official publication of your application.

A notice of threatened opposition is not a formal opposition to your registration, but it is an indication that someone may file an opposition before the end of the extended 3 month opposition period. It gives the interested third party more time to prepare their opposition.

Sometimes, but not always, you may receive a letter from the third party or their legal representative 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 trade marks registry. Only when a third party files an actual opposition (usually on form TM7) and pays the opposition fee is a formal opposition commenced.

The UK registry letter says that my mark is identical or similar to another mark

The letters generated by the UK intellectual property office to owners of earlier registered trade marks alert them that the UK office have found an identical or similar mark. However sometimes the marks cited against each other, when considered in detail, turn out not to be identical or similar and perhaps should not have been cited. The trade mark notification letters issued by the trade marks registry to existing trade mark owners are not infallible, and a detailed assessment of similarity has not yet taken place. Deciding whether the marks are similar or not is part of the formal opposition procedure.

What to do

When receiving a notice of threatened opposition from a third party, what should you do?

The options include:

- Do nothing. Ignore the notice of threatened opposition and wait until the end of the 3 month extended opposition period to see if a formal opposition is filed. 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.
- Contact the person who filed the notice of threatened opposition and ask them if they would desist from filing an opposition if you deleted some of the goods or services in your application. This may be able to resolve the matter in some

cases where there is no underlying commercial conflict between the businesses owning the marks on each side.

- If the notice of threatened opposition is based upon an earlier registered trade mark, it is prudent to assess whether you may be infringing that earlier registered trade mark. A person infringes a UK registered trade mark if he uses a sign which is identical to an existing registered trade mark for identical goods or services. A person also infringes a UK registered trade mark if he uses in the course of trade a sign where because
 - a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
 - b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.
- If an earlier third party trade mark is being infringed by your use of your mark, then unless you can come to an agreement with the owner of the mark there will remain the risk that you could need to pay damages or an account of profits, and rebrand altogether. If you have significant stock of goods already branded with your mark there is the possibility that you could have to destroy that stock, unless the trade mark can be removed.
- Do a trade mark search to see if the owner of the other mark has any other registrations for the same mark or for a similar mark. Their opposition might not be just based on one single prior trade mark right, if they have other similar marks which are similar to yours.
- Do an Internet search to see if the person who has filed a notice of opposition is actually using their registered trade mark. If the other person has not made significant use of their trade mark for a continuous five-year period, then their own trade mark registration is vulnerable to being revoked. You may be able to successfully fully or partially revoke their pre-existing registered trade mark. If so, that could also act as a defence to any infringement of their registered trade mark, and could also undermine the basis of their threatened opposition to your trade mark application.

Do not automatically assume that the person filing the notice of threatened opposition actually knows what they are doing. A large proportion of UK trade mark applications are filed directly online at the UK trade marks registry by individuals and businesses as

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applicant in person without professional representation. The information provided on the UK intellectual property office website is clear and comprehensive, but as with any procedure, if a person is unfamiliar with it or if it is the first time that they are following a procedure, then it is not always simple or straightforward and mistakes can be made.

Decide whether you can handle the matter yourself or whether you need professional advice. If you need professional advice then please contact us and we would be happy to help.

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