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Trade Marks 2025

14th Edition

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities are the UK Intellectual Property Office (the "UKIPO"), the High Court of England & Wales, the Court of Session in Scotland and the High Court of Northern Ireland.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Trade Marks Act 1994 (the "TMA").

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

The mark must be a sign capable of:

(1) being represented in a manner that enables competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor; and

(2) distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may consist of words (including personal names), designs, letters, numbers, colours, sounds or the shape of goods or their packaging.

2.2 What cannot be registered as a trade mark?

A trade mark may be refused registration on "absolute" or "relative" grounds (see sections 3 and 4 below).

2.3 What information is needed to register a trade mark?

The application must contain: a representation of the mark; the classes of goods and/or services for which the mark is being applied; and administrative details such as the name and address of the applicant.

2.4 What is the general procedure for trade mark registration?

An application must first be submitted to the UKIPO. The UKIPO will assess whether the mark fails on absolute grounds. If it does, the examiner will issue a report detailing the reasons why. Applicants have a period of not less than 14 days to resolve issues raised. Following examination, the mark is published for a two-month opposition period (extendable to three months) and may be opposed based on relative grounds at this stage. Once the opposition period expires (or opposition proceedings conclude), the application will proceed to registration.

2.5 How is a trade mark adequately represented?

See question 2.1 above.

2.6 How are goods and services described?

The UKIPO uses the Nice Classification system, which groups goods and services into 45 "classes", each of which contains a list of pre-approved terms. Although each class has its own heading, these headings should not be relied upon and applicants should list each good or service for which they wish to register the mark within each class.

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

In the case of unusual marks such as 3D marks, this could be by way of photograph or computer-generated image and generally multiple views of the mark will be expected to be provided. However, the maximum file size that may be uploaded to the UKIPO is 20MB.

Sound marks must be submitted by an audio file reproducing the sound unless they are simple melodies, in which case they may also be represented in musical notation. The maximum file size is 2MB.

Motion marks must be submitted as video files or a series of sequential still images. The maximum file size is 20MB.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required for a trade mark to be registered

or for renewal purposes in the UK. However, to file a UK trade mark application, the applicant must give a declaration that the trade mark is being used by the applicant, or with their consent, in relation to the goods or services applied for, or that there is a *bona fide* intention that it will be used in this way.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

UK trade marks cover England, Wales, Scotland, Northern Ireland and the Isle of Man.

2.10 Who can own a trade mark in your jurisdiction?

Any natural or legal person can own a trade mark in the UK.

2.11 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use.

2.12 How long on average does registration take?

If no objections or oppositions are raised, registration of a mark takes approximately four months. If objections or oppositions are raised, it can take considerably longer.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

At the UKIPO, a standard online application for registration of a mark in one class is £170. An additional £50 is charged per additional class in the application. This excludes associated professional fees of a law firm/trade mark attorney.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

There are currently two routes: a UK trade mark issued by the UKIPO; or an international registration obtained through the Madrid Protocol designating the UK.

2.15 Is a Power of Attorney needed?

No, a Power of Attorney is not required.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

2.17 How is priority claimed?

Priority is claimed at the application stage.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in the UK.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The following absolute grounds apply:

- the mark is not capable of distinguishing the goods and services of one undertaking from other undertakings, or the mark has not been represented in a clear and precise manner;
- the trade mark consists exclusively of a shape or other characteristic that:
  - results from the nature of the goods;
  - is necessary to obtain a technical function; or
  - gives substantial value to the goods in question;
- the mark is devoid of distinctive character;
- the mark is descriptive of the goods and services in question;
- the mark is customary in the relevant trade;
- the mark is contrary to public policy or principles of morality;
- the mark is deceptive;
- use of the mark is prohibited by law;
- the application has been made in bad faith; or
- the mark consists of or contains protected emblems.

3.2 What are the ways to overcome an absolute grounds objection?

A response to an absolute grounds objection must be filed within two months of receipt of the examination report. How the objection is overcome will depend on the objection that has been raised. Many objections focus on unclear trade mark specifications (i.e. the list of goods and services) and can be overcome by clarifying the terms included in the specification.

Alternatively, if refusal is based on the mark being devoid of distinctive character or being descriptive of the goods or services in question, the applicant may file arguments as to the inherent distinctiveness of the mark and/or seek to prove that the mark has acquired distinctiveness over time through use of the mark alongside the relevant goods or services.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any decision from the UKIPO can be appealed to either the Appointed Person or the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

3.4 What is the route of appeal?

There are two routes: (1) to an Appointed Person; or (2) to the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The following relative grounds apply:

(1) The sign being applied for is identical to an earlier trade mark registered for identical goods or services.
(2) The sign is identical or similar to an earlier trade mark registered for identical or similar goods or services and there is a likelihood of confusion with the earlier mark on the part of the average consumer.
(3) The sign is identical or similar to an earlier trade mark and the earlier mark has a reputation in the UK, and the 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 trade mark.
(4) The use of the sign could be prevented in the UK by virtue of any rule of law, in particular due to unregistered trade mark rights or other signs used in the course of trade in the UK, protection of designations of origin/geographical indicators or the laws of copyright or industrial property rights.

4.2 Are there ways to overcome a relative grounds objection?

It is possible to overcome relative grounds arguments by successfully defending the opposition raised, or reaching a compromise with the opponent; for example, by amending the specification of the trade mark application so that it does not conflict with the third party's earlier rights. Note that the UKIPO does not *ex officio* raise relative grounds objections; it is down to third parties to oppose the application in question.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

4.4 What is the route of appeal?

See question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and/or relative grounds.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone may oppose a trade mark application on the basis of absolute grounds but only owners of earlier rights may oppose an application on the basis of relative grounds.

5.3 What is the procedure for opposition?

A third party may oppose a trade mark application within two months of its publication in the Trade Marks Journal. It is possible to extend this period by a further month by filing a "Notice of threatened opposition".

The applicant is given two months from the date of notification of the opposition to file their defence.

The opponent and applicant may then submit further evidence in turn and submissions (either in written or oral form) before the hearing officer issues their decision.

Cooling-off periods and suspensions of the proceedings for the discussion of settlement are available on joint request of the parties.

In most instances, a hearing officer will give their decision on the opposition based on written submissions alone, but sometimes an oral hearing will be held.

6 Registration

6.1 What happens when a trade mark is granted registration?

A registration certificate is issued.

6.2 From which date following application do an applicant's trade mark rights commence?

UK registered trade mark rights take effect from the date of filing or the date of filing of a trade mark registration from which priority is claimed.

6.3 What is the term of a trade mark?

UK trade marks are valid for 10 years from the date of filing but can be renewed indefinitely.

6.4 How is a trade mark renewed?

A trade mark may be renewed online by submitting a TM11 form at the UKIPO up to six months before or six months after the expiry date of the registration.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, such registration is possible.

7.2 Are there different types of assignment?

Assignments may be for the entire trade mark registration, i.e. for all goods/services for which the mark is registered; or assignments may be partial, i.e. for some but not all goods/services.

7.3 Can an individual register the licensing of a trade mark?

Yes, such registration is possible.

7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive. Exclusive licences give the licensee an exclusive right to use the trade mark registration to the exclusion of all others, including the trade mark proprietor. A non-exclusive licence can be granted to any number of licensees.

7.5 Can a trade mark licensee sue for infringement?

Yes, where the licence provides for this, or if the trade mark owner otherwise consents. In addition, where an exclusive UKTM licence contains a provision granting the licensee the same rights and remedies as if it had been an assignment, the exclusive licensee can bring infringement proceedings in their own name.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are necessary to prevent licensees from using marks in such a way that might make them vulnerable to revocation.

7.7 Can an individual register a security interest under a trade mark?

Yes, such registration is possible.

7.8 Are there different types of security interest?

As trade marks are considered intangible property, security usually takes the form of a mortgage or charge.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The following grounds apply:

(1) No genuine use of the trade mark has been made by the trade mark owner or with its consent for five years following registration in relation to the goods/services for which the trade mark was registered, or there has been an interruption of such use for a consecutive period of five years, and in each case no proper reason for non-use.

(2) As a result of acts or omissions by the trade mark owner, the mark has become the common name in the trade for goods/services for which it is registered.

(3) As a result of the use made of it, the trade mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services.

8.2 What is the procedure for revocation of a trade mark?

The applicant of the revocation action must submit a TM26(N) form (non-use grounds) or a TM26(O) form (other grounds) to the UKIPO. The UKIPO will serve this on the trade mark owner who will have two months to file a defence and counterstatement, which will in turn be served on the applicant.

Submissions and the filing of evidence will be timetabled subsequently.

Once a hearing has taken place or the submissions have been filed and reviewed, a hearing officer will issue a decision in writing.

8.3 Who can commence revocation proceedings?

Any natural or legal person may commence revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

Where an action on the grounds of non-use has been filed, the burden of proof rests with the owner to demonstrate genuine use or show that there are proper reasons for non-use.

Additionally, where the five-year non-use period has expired, but use of a trade mark resumes at least three months before an application for revocation is made, the registration shall not be revoked. This exception will not apply to any commencement of use that occurs within three months of an application for revocation, unless there is evidence that preparations for commencement of use began before the proprietor became aware of the application.

For other grounds of revocation beyond non-use, the defence consists of arguing that the ground has not been established.

8.5 What is the route of appeal from a decision of revocation?

Appeal may be made either to the Appointed Person or to the High Court.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Registration of a mark in breach of absolute or relative grounds for refusal.

9.2 What is the procedure for invalidation of a trade mark?

A TM26(I) form should be filed to begin invalidity proceedings. Both parties will then be given opportunities to submit evidence. A hearing may be requested, following which the hearing officer will issue a decision.

9.3 Who can commence invalidation proceedings?

Any person can bring invalidity proceedings based on absolute grounds for refusal, but only a proprietor or licensee of an earlier mark can bring proceedings on relative grounds.

9.4 What grounds of defence can be raised to an invalidation action?

Acquiescence (for relative grounds) or acquired distinctiveness (for certain absolute grounds) can be raised. For other grounds of invalidity, the defence consists of arguing that the ground has not been established.

9.5 What is the route of appeal from a decision of invalidity?

Appeal may be made either to an Appointed Person or to the High Court.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A UK trade mark may be enforced against an alleged infringer of the mark in the High Court, the Intellectual Property Enterprise Court (the "IPEC") or in certain County Courts.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial steps may include:

- exchange of pleadings;
- attending a Case Management Conference to determine the timetable and any evidential issues;
- disclosure; and
- exchange of evidence and any expert reports. The Civil Procedure Rules Directive on Pre-Action Conduct sets out guidance for the parties, which includes ensuring that they understand each other's positions, and making reasonable attempts to settle the proceedings.

On average, proceedings in the Chancery Division of the High Court will reach trial between 18 months and two years from commencement, though there is a shorter trial scheme that can take around 10 months. The timetable in the IPEC is usually quicker.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so, on what basis in each case?

Preliminary (or "interim") and final injunctions are available.

Preliminary injunctions require there to be a serious question to be tried, that the balance of convenience favours the claimant, and that the claimant will suffer irreparable harm to their business if the defendant's activities continue (or commence). The claimant must also act with urgency.

A Court will typically award a final injunction if infringement is established, but the Court exercises its discretion in each case.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so, how?

Yes, assuming those documents/materials fall within the scope of the "disclosure" that the Court has directed. Disclosure varies depending on whether proceedings are issued in the IPEC or the High Court and what form of disclosure the Court has ordered. E.g., if the Court orders standard disclosure, a party must disclose documents that support or adversely affect his or another party's case, and which have been retrieved following a proportionate search. A party may also apply to the Court for specific disclosure of relevant documents, where it believes that the current disclosure is inadequate.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Written submissions are made in the form of a skeleton argument. These are supplemented by oral submissions. Written evidence is provided to the Court, and will not be presented orally unless a witness is called for cross-examination.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In theory, yes, but in practice the Court is reasonably unlikely to do so.

10.7 After what period is a claim for trade mark infringement time-barred?

After the expiry of six years from the date of the last infringement unless there has been deliberate concealment, fraud, or a procedural mistake.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities exist. In general, these offences relate to dealing in counterfeit and "grey market" goods.

10.9 If so, who can pursue a criminal prosecution?

The Crown Prosecution Service or Trading Standards most commonly pursue such actions, but individual trade mark owners may also do so.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

A person aggrieved by an unjustified threat of trade mark infringement proceedings may initiate proceedings seeking a declaration that the threat was unjustified, an injunction preventing the threats from being continued, and damages in respect of any losses resulting from the threat. It is a defence to show that the threat was justified, i.e. that the acts alleged do in fact constitute infringement.

A communication contains a "threat" if a reasonable person would understand that a registered trade mark exists and there is an intention to bring infringement proceedings in relation to an act done in the UK.

Threats made about use in relation to services, rather than goods, are not actionable.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defendants can argue that the conditions for establishing liability are not present, e.g.: use was with consent; is not liable to affect the functions of the trade mark; is not "in the course of trade"; is not in relation to goods/services; and no likelihood of confusion, etc.

11.2 What grounds of defence can be raised in addition to non-infringement?

There are various grounds of defence, contained within sections 11, 11A and 12 of the TMA, including but not limited to:

use of indications as to the characteristics of goods/services; use that is necessary to indicate the intended purpose of a product or service; use of an individual's own name or address, in each case in accordance with honest practices; use of a later registered trade mark that would not be declared invalid in invalidity proceedings; use where the mark asserted is liable to revocation for non-use; and use in relation to goods already placed on the EEA with the trade mark owner's consent (exhaustion). Other grounds include honest concurrent use and acquiescence/delay/estoppel.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available: declarations; injunctions; damages or an account of profits; delivery up and destruction of goods; or publication of the judgment.

12.2 Are costs recoverable from the losing party and if so, how are they determined and what proportion of the costs can usually be recovered?

Normally, the unsuccessful party will be ordered to pay the successful party's costs. These costs are usually assessed after the trial and can be subject to a detailed assessment by the Court if the parties do not agree on an amount to be paid. In a case where Court-approved costs budgets are in place and not exceeded, the successful party can expect to recover the vast majority of its costs. Note that cost recovery in the IPEC is capped at set levels.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeals are only on a point of law. Permission is required from either the first instance judge or Court of Appeal. Such permission will be given where the Court considers that there is a real prospect of success or another compelling reason for the appeal to be heard.

13.2 In what circumstances can new evidence be added at the appeal stage?

The circumstances are very limited and normally limited to where the evidence could not have reasonably been obtained for use in the lower Court, and where the use of such evidence would have had a real impact on the result of the case.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and if so, how quickly are such measures resolved?

Yes, by filing a Customs notice. The mechanism usually resolves issues very quickly unless the importer objects to the destruction of the goods (fairly rare), in which case the trade mark owner may be required to bring Court proceedings for a declaration of infringement, which will slow the process down.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable in the UK through "passing-off" actions. The claimant must establish that: it owns "goodwill" in the mark; there has been a misrepresentation leading to deception of the public; and this has caused or is likely to cause the claimant damage.

15.2 To what extent does a company name offer protection from use by a third party?

Company names offer protection against third parties using the same or similar names, if the criteria for a passing-off claim are met (see question 15.1 above). A company can also raise a dispute with the Company Names Tribunal about a similar third-party company name.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not unless the title is registered as a trade mark, meets the conditions for a passing-off claim, or is itself protected by copyright (unlikely). There is no separate statutory regime.

16 Domain Names

16.1 Who can own a domain name?

Any legal or natural person.

16.2 How is a domain name registered?

A domain name may be registered via accredited registrars or registration service providers.

16.3 What protection does a domain name afford *per se*?

Unless passing off can be established, having a domain name itself offers very little protection against third-party use of a similar name, other than preventing others from registering the same domain name.

16.4 What types of country code top-level domain names (ccTLDs) are available in your jurisdiction?

.co.uk and .uk ccTLDs are the most commonly used ccTLDs in the UK. However, others such as .org.uk, .cymru and .wales are also available.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Nominet is the registry for .uk domains. Nominet operates an online dispute resolution service in the event of a dispute relating to a .uk domain. If the case cannot be settled by mediation, an expert independent adjudicator will make a binding decision on the dispute.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

Restricting specifications of applications and registrations subject to UKIPO proceedings

A Tribunal Practice Notice ("TPN") published on 17 July 2024 introduced new guidance for the restriction of goods and/or services specifications of applications and registrations subject to UKIPO proceedings (see Tribunal Practice Notice 1/2024: Restricting specifications of applications and registrations subject to Tribunal proceedings here: https://www.gov.uk/government/publications/tribunal-practice-notice-12024-restricting-specifications-subject-to-tribunal-proceedings/tribunal-practice-notice-12024-restricting-specifications-of-applications-and-registrations-subject-to-tribunal-proceedings). The TPN was effective immediately and the key takeaways from the new guidance are that restrictions must be clear and precise, should identify subcategories of goods/services and not a characteristic, and must make sense within the context of the specification.

Legislative amendment to international trade mark rules to allow partial replacement

The UK has amended the Trade Marks (International Registration) Order 2008 to implement changes to Rule 21 of the Madrid Protocol Regulations. These changes relate to requests for the replacement of UK trade mark registrations with international registrations. The amendment means that trade mark owners can now replace their UK trade mark registration with an international registration that covers some or all of the goods and/or services covered by their UK trade mark registration. Owners can also maintain protection for goods and/or services not covered by the international registration through their existing UK trade mark registration.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

***SkyKick UK Ltd v Sky Ltd* [2024] UKSC 36**

The Supreme Court unanimously allowed the appeal in part against the Court of Appeal's decision (*Sky v SkyKick* [2021] EWCA Civ 1121) and held that a trade mark can in certain circumstances be revoked for bad faith if there is no intention, or reasonable prospect, of using the mark for all the goods and services for which it has been applied. This is especially the case if the intention at the date of filing was simply to use the mark as legal weapon against other traders. Bad faith is to be measured by assessing the objective circumstances at the time of filing and where a good/service is deemed to have been filed in bad faith that good/service can be severed from the application, leaving those goods/services that have been filed in good faith to remain.

***Lidl Great Britain v Tesco Stores* [2024] EWCA Civ 262**

The Court of Appeal upheld the findings of the High Court (*Lidl Great Britain v Tesco Stores* [2023] EWHC 873 (Ch) and [2023] EWHC 1517 (Ch)) where it had ruled that Tesco infringed Lidl's trade mark rights in its Lidl logo. Arnold LJ concluded that the trial judge had evaluated each piece of evidence with care and without treating any one piece of evidence as determinative of any issue that the Court had to decide. As such, the trial judge was entitled to reach their view that consumers would link Tesco's roundel Clubcard prices signs with Lidl's brand and reputation, believing that Tesco prices are comparable or price-matched with Lidl's, giving Tesco an unfair advantage and being detrimental to the distinctive character of Lidl's mark.

At first instance, the High Court declared that various of Lidl's wordless marks were invalid on grounds of bad faith on the basis of a lack of genuine intention to use the mark, evergreening and insufficient evidence to prove good faith. Lidl appealed on this point but the Court of Appeal dismissed the appeal for the same reasons.

***Thatchers Cider Company Limited v Aldi Stores Limited* [2025] EWCA Civ 5**

The Court of Appeal overturned the High Court's decision and held that Aldi's use of its lemon cider packaging sign infringed Thatchers' trade mark registration for its cloudy lemon cider packaging. Arnold LJ found that Aldi intended its sign to remind consumers of Thatchers' trade mark as: (i) faint horizontal lines in Aldi's sign, not found in the rest of its in-house Taurus branded range, were present in Thatchers' mark; (ii) Aldi departed from its house style when producing the sign; and (iii) the design process showed that Aldi had specifically benchmarked against Thatchers' product. The Court found that in the absence of any marketing by Aldi, there was a legitimate inference that Aldi's high sales figures showed that it had obtained an unfair advantage.

17.3 Are there any significant developments expected in the next year?

There is a trade mark-related Supreme Court decision to be expected on post-sale confusion. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2024] EWCA Civ 29, the Court of Appeal overturned the High Court's ruling and held that Dream Pairs' logo mark infringed Iconix's Umbro sportswear brand logo as there was a likelihood of confusion based on post-sale confusion. In particular, Arnold LJ found that there would exist a likelihood of confusion in circumstances whereby a consumer might only see the Dream Pairs logo on the football boot when looking down at an angle or from the front or the rear. The appeal is expected to be heard in early 2025.

The High Court will hear the *Getty Images (US) Inc v Stability AI Limited* case in June 2025. Getty claims that Stability AI has scraped millions of images from its website, without consent, and used those images to train and develop a generative AI model known as Stable Diffusion. Getty's claims include a claim for trade mark infringement and passing off.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There have been a few practice developments over the last year or so that are worth noting:

- Following Tribunal Practice Notice 2/2023 (see https://www.gov.uk/government/publications/tribunal-practice-notice-22023-effective-service-in-proceedings-against-trade-marks-and-registered-designs-without-a-valid-uk-address-for-service/tribunal-practice-notice-22023-effective-service-in-proceedings-against-trade-marks-and-registered-designs-without-a-valid-uk-address-for-service), the UKIPO has enlisted a team to scrutinise addresses for service and strictly followed the procedure set out in Tribunal Practice Notice 2/2023 for requesting a UK address for service where the applicant or owner

has an address outside of the jurisdiction. This has led to applications being withdrawn (where the address requirements have not been remedied) and delay in certain proceedings before the UKIPO where the other party has an address outside of the UK.

- There has been an increase in the number of oppositions filed by owners of registrations for physical goods and services against applications consisting of virtual goods and services. The UKIPO's position on this point will likely be decided on through decisions issued in 2025.
- Following the *SkyKick* decision (see question 17.2 above), trade mark owners have been reviewing their trade mark portfolios to ascertain vulnerabilities to potential invalidity attacks from third parties. An increase in invalidity actions and oppositions brought on the grounds of bad faith is to be expected in 2025.

Robert Milligan is a Senior Associate in Bird & Bird's Intellectual Property department, specialising in all aspects of brand management and product design.
Robert's experience includes advising on international brand protection and portfolio management. He works with a range of clients from start-ups to well-established international brands, across a variety of sectors, including media, entertainment and sport, retail and leisure, food and beverage, financial services, energy, automotive, aviation and defence. His practice entails advising on global trade mark and design clearance and protection strategies, trade mark opposition and cancellation proceedings before the UK Intellectual Property Office, and domain name and company name disputes.
Robert also advises on the commercial and transactional aspects of IP, encompassing restructuring, assignments and licensing.
He has been a contributor to the *Chartered Institute of Trade Mark Attorneys Review* and the *Chartered Institute of Patent Attorneys Journal* commenting on up-to-date case law and is also the editor of Bird & Bird's international brands publication, *BrandWrites*.

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Nick Aries is a Partner in the firm's London office and specialises in IP disputes and advice.
Nick is adept at identifying and advising on IP issues in the digital economy, including copyright and trade mark questions raised by a multitude of online services and social media. He also advises on multi-jurisdictional IP litigation and strategy and represents clients in UK litigation. Alongside this, his practice covers transactional IP work such as licensing (particularly, brand licensing arrangements).
Nick has been recognised by *World Trademark Review* as one of the World's Leading Trademark Professionals.
Nick's UK litigation experience covers copyright infringement, trade mark infringement and passing off, breach of licence/coexistence agreement, trade secrets, and designs. Example UK cases include *Getty Images v Stability AI*, *Merck KGaA v MSD*, *Maier v Asos*, *Kenexa v Alberg*, *Codemasters Software v ACO* and *Daimler v Sany*.

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- Application for a Trade Mark
- Absolute Grounds for Refusal
- Relative Grounds for Refusal
- Opposition
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