



Intellectual  
Property  
Office



# Examination and Refusal process at the UK IPO

## Webinar

Gareth Woodman and Tina Byrne.  
UK IPO International trade marks examination team managers.

**Webinar**  
**11 October**  
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# Overview/agenda

- Examination at the UK IPO
- Territories and dependencies covered by a UK designation
- Mark types
- Absolute Grounds for refusal
- Relative Grounds
- Classification
- Refusal
- Oppositions
- Brexit

# Examination at the UK IPO

- Member of the Madrid Protocol as of December 1, 1995.
- Number 1 designated country for 2021 and 2022.
- UK IPO has 33 International trade mark examiners across 4 teams
- Each application is examined in relation to the [UK Trade Marks Act 1994](#) and the [The Trade Marks Rules 2008](#)
- The UK IPO has an [examination manual](#) and also an [international examination guide](#).
- Search the UK trade mark register: <https://www.gov.uk/search-for-trademark>

# POLL

What territories and dependencies do you get protection in when you designate the UK IPO?

- A: England, Scotland, Wales and Northern Ireland (UK)
- B: England, Wales, Scotland, Northern Ireland, the Falkland Islands and Gibraltar, as well as the two British Crown Dependencies of the Isle of Man and Jersey.
- C: England, Wales, Scotland, Northern Ireland, the British Overseas Territory of the Falkland Islands and Gibraltar, as well as the two British Crown Dependencies of the Isle of Man and Guernsey.

# Territories and Dependencies

The designation of the **United Kingdom** covers:

- England, Wales, Scotland, Northern Ireland, the British Overseas Territory of the Falkland Islands and Gibraltar, as well as the two British Crown Dependencies of the Isle of Man and Jersey
- The UK WIPO membership extends to Guernsey, but they're treated as a separate office of Origin and require a separate designation to gain protection.
- Registering a trade mark at the UK IPO only protects your brand in the UK and the Isle of Man.

# Mark types we accept

- words
- sounds
- logos
- colours
- 3D Shapes
- Holograms
- Motion
- Patterns
- Multimedia
- Certification/Collective

IKEA, APPLE, KODAK



# Section 3(1)(a)

Your trade mark must be capable:

- of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- of distinguishing goods or services of one undertaking from those of other undertakings.

# Section 3(1)(b)

Your trade mark cannot:

- be too common and non-distinctive, for example a statement like ‘we lead the way’
  - Promotional statements
  - Value Statements
  - Inspirational/Motivational statements
  - Customer Service statements
- Statement of or by the wearer





# Section 3(1)(b)&(c )

Your trade mark cannot:

- describe the goods or services it will relate to, for example the word 'cotton' cannot be a trade mark for a cotton textile company
- Kind
- Geographic
- Intended purpose
- Subject matter

# Section 3(1)(d)

Your trade mark cannot:

- consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade e.g.
- Red Lion for public houses



# Section 3(2)

Your trade mark cannot be registered if it consists exclusively of:

- Shape of the goods themselves:

3(2)(a)



- Shape of the goods necessary to obtain a technical result:

3(2)(b)



- Shape which gives substantial value to the goods:

3(2)(c)



- Other characteristics: Sound

3(2)(b)



# Section 3(3)(a)

Your trade mark cannot:

- be offensive, for example contain swear words or pornographic images
- Public policy
- morality

# Section 3(3)(b)

Your trade mark cannot:

- be misleading, for example use the word 'organic' for goods that are not organic or silk on goods that aren't made of silk.
- Geographical indications: PGIs/PDOs
- Scotch Whiskey [The Scotch Whisky Regulations 2009](#)

# Poll

Which of these emblems could you register as a trade mark in the UK?

■ 1.



■ 2.



■ 3



■ 4. none of the above

# Section 3(4) and Section 4

Your trade mark cannot:

- Include Royal emblems, the names or images of the royal family
- make use of national flags you do not have permission to use
- make use of official emblems or hallmarks, for example coats of arms
- Dairy Products on dairy substitutes



# Section 5

## Relative grounds for refusal of registration.

- A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- Notification System.
- 2 months to consider any earlier rights raised.
- Mark proceeds to publication and notifications are issued if no response.

<https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide> - **Part C Notification (Earlier rights)**



# Classification

When classifying your goods and services the main points to remember:

- Retail and wholesale services
- Wide terms and unclear terms
- Using the term "Providing a website" outside of classes 38 and 42
- Caught By Class

<https://www.gov.uk/guidance/how-to-classify-trade-marks>

# Extensions of time requests (EOT)

If your trade mark has not yet been registered, you can first speak with your examiner to discuss an extension of time.

- The registry can grant an extension of time for as long as they see fit. However, UK IPO examination practice is to provide 2 months at a time.
- The request must be submitted in writing, and only where the application has not been published.
- Extensions requests from a WIPO representative.
- TM9R – if a deadline has been missed.

<https://www.gov.uk/government/publications/request-for-a-retrospective-extension-of-time>

# Refusals

Following the examination, if you are unable to find a way to overcome the objection:

- Refusal letter (Total/Partial)
- Evidence of Acquired distinctiveness
- Peer Review Group
- Request for a statement of grounds for refusal
- Divisions

<https://www.gov.uk/guidance/options-following-an-objection-to-a-trade-mark-examination>

# Poll

- Which of the following IP rights do you need to hold to oppose a trade mark?
  1. A Trade mark (registered or unregistered)
  2. A Design
  3. Copyright
  4. Any of the above

# Opposition & Cancellations

Once an application has been accepted by the Registry it must be published for a period of two months. This period allows any third party the opportunity to oppose the acceptance of the mark if they have an issue with it:

- Threatened opposition (TM7a)
- Filing an opposition (TM7)
- Requesting a Fast Track opposition (TM7F)
- Cancellation of a registered Trade mark
  - Invalidation (TM26I)
  - Revocation (TM26N)

<https://www.gov.uk/guidance/objecting-to-other-peoples-trade-marks-and-the-legal-costs>

# Brexit

After 1<sup>st</sup> January 2021:

- We created a comparable UK trade mark for International registrations designating the EU that were protected in the EU prior to 1<sup>st</sup> January 2021.
- Subsequent designation dates may differ from the international registration.
- We created recognisable Number formats to allow users to easily identify these marks on our register. UK008/UK0081
- Changes to address for service rules as of January 2024.
- Replacements – form TM28.

<https://www.gov.uk/guidance/changes-to-international-trade-mark-registrations>

# Any Questions?

## Useful links:

- <https://www.gov.uk/government/organisations/intellectual-property-office>
- <https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide>
- <https://www.gov.uk/guidance/trade-marks-manual/international-examination-guide>
- [https://twitter.com/The\\_IPO](https://twitter.com/The_IPO)
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## When?

November 2 and 3, 2025



## Where?

WIPO Headquarters,  
Geneva, Switzerland



## Who should attend?

Advanced users (holders and representatives); not for IP Office staff

## Why attend?

- **Gain Insightful tips** from WIPO experts and guest speakers from **Australia, China, Republic of Korea and the USA** about examination procedures in these IP Offices
- **Master Madrid System online tools and procedures**
- **Increase your global network**



## Hear from a past attendee!



“It was a very good combination of **presentations** and **case studies**.

The format made it much more **interesting, informative and entertaining**.

The low number of participants greatly helped the **discussion and interaction** among them.”

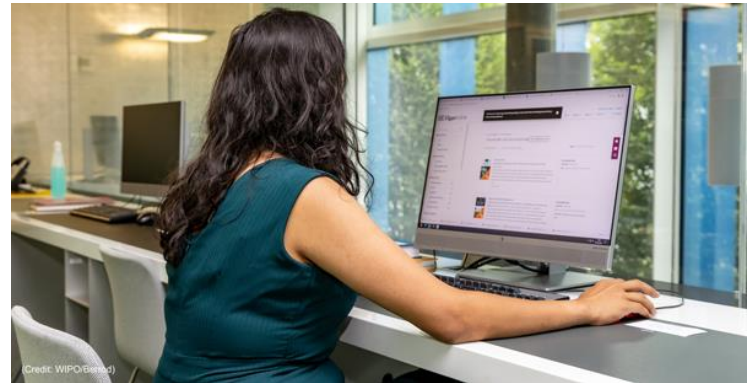
**Michael Best**, Partner/Attorney-at-law | BEST Rechtsanwaelte, Germany

Registration fee: 600 Swiss francs

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October 5, 2021

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Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

Discover how, with such a varied portfolio and an expansion strategy geared internationally, Panasonic uses the Madrid System to simplify the administrative procedures and greatly reduce costs.

[Read the full Panasonic case study](#)



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World Intellectual Property Organization – WIPO



### MixMediaWorx on the Benefits of Using the Madrid System

World Intellectual Property Organization – WIPO

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