

Keep an Eye on Your Mailbox – Appoint a UK Representative for Trade Marks Filed Through WIPO

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A direct United Kingdom (UK) trade mark application to the UK Intellectual Property Office (UKIPO) contains a requirement to name a UK address for service. In contrast, it has been a standing practice of the UKIPO to process International Trade Mark Registrations via the Madrid Protocol designating the UK without requiring a UK service address. The UKIPO would only require to specify a UK service address in circumstances where objections or oppositions are raised in relation to the International Trade Mark Registrations during prosecution. However, the recent decision in [MARCO POLO \(O/681/22\)](#) has called this UKIPO's practice into question.

The Case

The proprietor of MARCO POLO mark, New Holland Ventures Pty Ltd, is an Australian company. The mark was entered into the International Register in 2020, and subsequently obtained a UK registration in 2021. Since no objections or oppositions in relation to the mark were raised upon registration, the UKIPO did not require the proprietor to provide a UK address for service. The only addresses available on the UKIPO records were of the proprietor and of the WIPO representative.

Tradeix Ltd filed invalidity proceedings against the designation of MARCO POLO in the UK. A notification of such action was sent by post to the proprietor's offices in Australia. However, due to COVID-19 lockdown in Australia, the offices of the mark holder were shut, and as such the notification was not received or responded to within the applicable two months' deadline. With no defence filed, the UKIPO issued a Declaration of Invalidity. It was again posted to the holder's Australian address, but not received by them, and also issued to the International Bureau, which informed the proprietor's WIPO representative. The mark holder then appointed a UK representative and appealed the UKIPO's decision of invalidity.

The Decision

The Appointed Person found that the application of invalidity was not appropriately served on the proprietor, because the UKIPO does not have authority to serve documents outside of the jurisdiction. The UKIPO could only validly serve a notification requesting to specify a UK address to

the Australian trade mark holder, which would attach a one month's deadline. As such, the Declaration of Invalidity was set aside, with the proceedings being forwarded for further processing.

Lessons to Learn

Following the decision in MARCO POLO it is highly likely that the UKIPO's practice may be revised. However, in the interim, we highly recommend to appoint a UK representative in relation to all International Trade Mark Registrations designating the UK as soon as possible.

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