



# Trade Mark and Design Services



The IP, brand, trade mark and portfolio management team at Lewis Silkin comprises more than 50 lawyers and trade mark attorneys along with specialist support personnel.

It continues to be acknowledged by clients and leading legal directories for its expertise in many IP-related fields including trade marks, advertising, IP disputes, sports and IP-rich commercial work. The breadth of our knowledge enables us to view our client's brand issues in a wider context.

Unlike many law firms where trade mark and design searches and applications are subcontracted to trade mark or patent agents, this firm has remained a 'one stop shop'. We believe it essential that our lawyers are familiar with every facet of law and practice relating to trade marks and are involved at each stage of the lifecycle of our clients' brands, from checking the availability of names and securing trade mark registrations, to pursuing infringers and the provision of transactional advice on the disposal of a brand.

We act for businesses in a wide range of industries including marketing, retail, fashion, media, entertainment, sports, financial services, technology and leisure and are instructed by a number of clients solely on the basis of our trade mark and design expertise. We are retained by many overseas law firms to conduct trade mark and design work for their clients in the UK and Europe.

We are members of the International Trademark Association ("INTA"), the Global Advertising Lawyers Alliance ("GALA"), the Institute of Trade Mark Agents ("ITMA"), the British Brands Group and the European Sponsorship Association ("ESA"). Many members of the Department have post graduate qualifications in intellectual property law.

### **Trade Marks**

Whilst we advise on all aspects of intellectual property, from a purely trade marks perspective we commonly provide the following services:

- Assistance with brand creation/generation through screening searches
- Conduct and advise on trade mark and common law searches
- Advise on filing strategy
- File and prosecute UK, Community and Madrid Protocol trade mark applications
- International IP portfolio management
- Trade mark watch services and competitor monitoring
- IP licensing and assignments
- Competition issues and parallel imports
- Transactional advice, including due diligence
- Trade mark proceedings (such as oppositions, revocations and appeals) before the European Union and UK Intellectual Property Offices
- IP actions before the European and UK Courts
- IP dispute settlement negotiation and mediation services

### **Registered Design Services**

Registered designs have become an often overlooked tool in creating and defending enforceable rights. It should be borne in mind that registered designs can also be used to obtain protection for descriptive or non-distinctive marks which would be rejected as trade mark applications and can be used to protect logos.

The following design services are commonly provided to both UK and overseas clients:

- Conduct and advice on design searches
- Advice on filing strategy
- Filing and prosecuting UK and Registered Community Design applications
- International Design portfolio management
- Design licensing and assignments
- Transactional advice, including due diligence
- Registered Design and Unregistered Design Right proceedings before the UK Courts
- Design dispute settlement negotiation and mediation services

## **Portfolio Audit**

The starting point of our relationship with a client is a healthcheck of their current portfolio.

With your assistance we can audit your portfolio to establish whether you have the correct rights in all your countries of interest, whether new applications need to be made to cover new trade marks or new classes of goods / services, and whether the correct business entity holds the rights. We can locate and iron out administrative inconsistencies and establish whether old registrations should be allowed to lapse or merged to save on renewal costs.

We have advised clients on portfolio restructurings that demonstrably deliver savings worth tens of thousands of pounds.

## **IP Portfolio Management**

If you are managing an IP portfolio, perhaps containing a mixture of trade marks, registered designs and domain names, what are your major concerns?

The first is likely to be keeping track of all the various rights which your business owns or controls. In order to achieve this effectively larger businesses usually incur the cost of specialist software together with the overheads of the staff required to manage the data entry and keep the records up to date. Less sophisticated operations often have to manage with simple spreadsheets which do not benefit from integrated diary and reminder functions. Dealing with the continuous stream of diary dates, prompts, deadlines and reminders generated by a portfolio, can cause administrative headaches and there is always the risk that an overlooked action point may have major ramifications for the business.

It is difficult to find an external adviser capable of managing your IP portfolio in a manner that fits with your requirements. Where advisers are entrusted with looking after a business' assets they often have to be specifically instructed to provide you with data regarding your intellectual property rights. Indeed many will charge you for the privilege of accessing your own information.

At Lewis Silkin we have put a lot of time and effort into analysing what our clients want and what they need. We understand the budgetary and performance pressures that our clients live under. That is why we know that our portfolio management services will help by keeping track of your vital data, giving you instant report availability and also helping to reduce overall costs. Initiatives such as the free portfolio audit for new clients and the ability to provide clients with online access to their portfolio delivers the added value that many clients seek.

## **Client Access**

If your company possesses any trade marks, copyrights or designs, then you will know that keeping track of these rights is not only very time consuming, but it also requires specialist knowledge and software.

This is where we can help. We have the software and the experts who can maintain these records for you. When we manage your portfolio, our resources can be placed at your disposal, leaving you the time and budget to focus on business critical issues.

If you need to continually check your portfolio, or produce reports to satisfy different business requirements, then we can give you direct access to our record of your IP rights. You will find that our records are comprehensive, including full colour images of trade marks and designs as well as details of related disputes, agreements, licenses etc. The database also contains electronic copies of key documents such as filing, receipts, publication notices, registration certificates, settlement agreements, and other contracts.

The system is browser based and very easy to use; most people become proficient in a matter of minutes. It comes with a wide range of standard reports. There is also a flexible report creation tool which is particularly useful for portfolio analysis and research purposes. Even the most complex of reports are easy to produce using the wide range of searchable fields and useful features.

The database has of course been subjected to extensive security testing.

If we manage your portfolio then you will have the benefit of online access to your full portfolio 365 days a year. No special hardware or software is required, just an internet connection.

## **Watching Services**

The clearance, searching, filing and launch of a new brand or product is a very exciting time but obtaining certificates of registration and then safely storing these away is not where our relationship ends. We aim to ensure that your IP rights enjoy a long and healthy life. This requires continued maintenance, care and attention.

One of the most important aspects of this ongoing care is the 'Watch service'.

Should a third party attempt to register trade marks that are identical / similar to yours anywhere in the world we would be notified and thereby give you the opportunity to oppose the application before it achieves registration. Watch services can also provide vital information of competitor activity. We can arrange for competitors to be monitored so that a notification will be received should any new trade mark applications be filed by those competitors. This can provide a useful early warning as trade mark applications are often filed many months prior to the launch of a new brand or business.

## Overseas Intellectual Property

Should you require trade mark, design or other intellectual property services outside of the UK, then we can liaise with our network of trusted international contacts to obtain these services. We also commonly project manage overseas intellectual property proceedings and litigation for our clients.

## Anti-Counterfeiting

Members of the team have extensive experience in anti-counterfeiting matters across many jurisdictions and for a variety of brand owners and regularly liaises with investigators, Customs and Trading Standard officers.

## Seminars

We can help build the awareness of IP within your company by giving presentations or talks on the various types of Intellectual Property and how they may be relevant to your business. If there is a particular topic which you'd like more detailed information on please do not hesitate to contact us.

## Rates

We know that in all of the best run businesses there is continual pressure to improve the quality of service whilst lowering the overall costs. From experience we know that one of the most difficult tasks in the management of a portfolio is planning a budget forecast and then managing that budget.

This is where we can help in a number of different ways. From assisting and advising on the process of cost estimation, to delivering a wide range of service options tailored to meet your needs, all the way through to an annual fixed cost service package where the only extras are disbursements.

## For more information contact:



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