

Trade Mark Management



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Introduction

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

Our services

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

The group acts for all brand owner businesses brands, names and designs that require protection in a wide range of sectors including marketing, retail, fashion, media, entertainment, sports, finances services, technology and leisure. We represent many clients on a worldwide basis.

Many overseas law firms entrust us with their clients' trade mark work in the UK and across Europe.

Whilst we advise on all aspects of intellectual property, from a purely trade marks perspective the following services are commonly provided to both UK and overseas clients:

- Conduct and advise on trade mark and common law searches
- Advising on filing strategy
- File and prosecute UK, European Union and Madrid Protocol trade mark applications
- IP portfolio management
- 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 United Kingdom Intellectual Property Offices
- IP actions before the UK Courts and the Court of Justice of the European Union
- Anti-counterfeiting and trading standards/ customs liaison
- IP dispute settlement negotiation and mediation services

- Domain name management
- Domain name disputes
- Social media takedowns

International reach

Where trade mark services are required outside of the UK we liaise with our network of trusted international contacts. We select the firm we believe best matches a client's needs in terms of legal skills, industry experience and cost. We also commonly project manage overseas trade mark proceedings and litigation for our clients.

Disputes

Our IP litigation team has advised on some of the highest profile recent UK and European trade mark cases including; *Lush v. Amazon*; *Enterprise v. Europcar*; and *Jack Wills v. House of Frazer*.

Memberships

We are members of the International Trademark Association, the Institute of Trade Mark Attorneys, British Brands Group, Global Advertising Lawyers Alliance, Marques and the Chartered European Communities Trade Mark Association.

What others say about us

Shortlisted for The Lawyer Awards 'IP Team of the Year' for two years in a row

Ranked Band 1 by Chambers UK, 2016 for Intellectual Property: Law Firms With Patent & Trade Mark Attorneys

Ranked Tier 1 by Legal 500 UK, 2015 for Brand management

Steven Jennings has been ranked by WTR amongst the very exclusive 'gold' tier for "individuals - prosecution and strategy" portfolio management professionals in the United Kingdom.

Dominic Farnsworth has been ranked as an "IP Star" by Managing Intellectual Property

Ranked in Silver category in World Trade Mark Review's WTR 1000 2016 publication

Listed #2 law firm for UK law firms for number of EUTM filings by ITMA Review (May 2015)



“Dominic Farnsworth captains the trade marks sub team; his dual qualification as both trade mark attorney and solicitor gives him a panoramic view of the trade mark horizon”

[World Trade Mark Review: WTR 1000 2015](#)

“One of the best brands practices in the business....involved in many of the most closely-followed trade mark cases in the market”

[Chambers UK, 2015 — Intellectual Property](#)

“Giles Crown runs the show, with a string of commercially important verdicts to his name all the way up to European Court of Justice level”

[World Trade Mark Review: WTR 1000 2015](#)

“Prosecution-focused Steven Jennings has “enormous industry experience”

[World Trade Mark Review: WTR 1000 2015](#)

“We’ve stayed with Lewis Silkin because of the consistently high standard of work that has been produced.”

[Chambers UK, 2015 — Intellectual Property](#)

“The firm has a top-rate IP and media practice and client base.”

[Chambers UK, 2015 — Intellectual Property](#)

Costs

We are committed to providing straightforward and cost effective advice.

Our services are priced competitively and we commonly agree fixed costs for discrete projects. Set out below are headline rates which are subject to Euro fluctuations in currency value. The application fee covers all fees through to registration assuming no objections are received. Please contact us should you wish to discuss fees in greater depth or discuss our other services.

UK and EUTM applications: Scale of fees

European Union Trade Mark	Disbs.	Service fee	Total *
Application in one class	850€*	£800	£1,450*
Application in two classes	900€*	No extra charge	£1,500*
Application in three classes	1050€*	No extra charge	£1,615*
Each additional class beyond the third	150€*	£75	£190*
Reporting publication and registration	No extra charge		
Renewal in one class	850€*	£300	£960*
Renewal in two classes	900€*	No extra charge	£1,010*
Renewal in each additional class after the second	150€*	No extra charge	£120*

United Kingdom	Official fee	Service fee	Total
Application in one class	£170	£400	£570
Application in two classes	£220	No extra charge	£620
Application in three classes	£270	No extra charge	£670
Each additional class beyond the third	£50	£50	£100
Reporting publication and registration	No extra charge		
Renewal in one class	£200	£200	£400
Renewal in each additional class	£50	No extra charge	£50

Foreign trade mark	Official fee	First class	Each additional class
Application	Varies	£400	£200
Renewal	Varies	£200	No extra charge

* Subject to fluctuations in currency value



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Dominic provides commercially driven intellectual property advice. Particular areas of expertise include trade marks, advertising, IP-rich commercial contracts, IP disputes, sponsorship and sports rights exploitation.

Dominic is one of the few practitioners jointly qualified as both a Solicitor and a Trade Mark Attorney. He heads up our Trade Mark Team which manages tens of thousands of trade marks, designs and other IP for clients around the world. He is equally at home whether assisting a private individual to acquire a UK trade mark, coordinating trade mark proceedings on a pan-European basis, conducting global searches, acting on brand securitisation transactions, licensing programmes or advising a major corporate on a global re-branding exercise.



Steven Jennings Trade Mark Counsel

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Steven specialises in trade mark and design law and has extensive private practice and in-house IP experience in working with brand owners on a global basis. Steven was formerly an examiner at the UKIPO before managing the Gillette brands in 160 countries. He subsequently held positions at Clifford Chance and Cadbury before joining Lewis Silkin.

Steven regularly acts for leading brand owners, marketing services agencies and their networks, overseas law firms, trade bodies and associations and governmental departments. Steven has lectured at QMW on trade mark searching including searching more challenging marks like shape marks, colour marks and multi jurisdictional searches.



Ian Collier IP Analyst

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Ian has more than 20 years experience working for several of London's leading law firm trade mark filing and brand protection practices. Ian has a keen interest in data and the usability of data which he has found to be a key ingredient for a successful trade mark filing practice.



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