

An introduction to trade marks in the UK



Why register a trade mark?

A trade mark registration provides the most effective form of protection against improper use of a business name, brand, logo or slogan by a competitor.



A trade mark registration for a business, brand or product name, a logo, slogan or other trade mark provides a business with the most effective form of protection against a competitor making improper use of its brand. Whilst a trade mark might be capable of being protected through other areas of the law, such as passing off, copyright or even design right, registering a trade mark has a number of important benefits.

Registration acts as prima facie proof of the proprietor's entitlement to the trade mark. If a third party believes that it has a better right to a trade mark than the proprietor, it will have to apply to the UK Intellectual Property office ("UKIPO") to have it declared invalid and will have a number of procedural and evidential hurdles to overcome.

The registered trade mark device ® indicates to the world at large that the trade mark has achieved registration and accordingly, the trade mark will be protected under the Trade Marks Act 1994. If a trade mark has not been registered, it is a criminal offence to use the ® device.

Importantly, registration can be obtained before the trade mark is used, provided that there is an actual intention to use the trade mark, therefore protecting a new brand pre-launch.

An action for trade mark infringement can be brought without proof that the proprietor has suffered any damage to the reputation in its trade mark.

Filing a trade mark application means that the details of the application are kept on a central register, which is a publicly accessible database. Most businesses, when assessing whether to adopt a new trade mark, conduct 'clearance' searches to ensure that no trade mark complications are likely to arise. Consequently, it is likely that any third parties which might otherwise unwittingly make use of the trade mark will be alerted to its existence.

Unlike other forms of intellectual property protection which 'expire' after varying terms, registered trade mark protection can last indefinitely provided renewal fees are paid at the relevant anniversary dates.

Should I conduct a search?

As a matter of course, well-advised businesses conduct a number of searches before adopting a new name or brand. The purpose of a trade mark search is to ensure that there are no identical or similar names already on the trade mark registers (covering identical or similar goods or services) to that of the name you have selected. If there are, the proprietor of any such earlier registrations may be able to bring proceedings for trade mark infringement and / or passing off. Searches should also be conducted for company names, domain names and in journals and trade directories in the relevant business sector – these are often referred to as Common Law searches.

If the trade mark search identifies a risk, then an assessment needs to be made as to whether such risk constitutes a serious

commercial threat. If so, an alternative name or brand may need to be sourced and the search procedure repeated.

What can be registered as a trade mark?

Under the Trade Marks Act 1994 a trade mark is any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking (business) from those of other undertakings (businesses). This not only covers words, but also logos, 3D shapes, sounds, colours, images, moving images and smells leaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Where should I register a trade mark?

As intellectual property rights are territorial in nature, it will be necessary to conduct searches and file applications in each country of interest. However, there are various international arrangements that can simplify this procedure. These include the European Union Trade Mark ("EUTM", a single application that covers the entire EU) and "international" applications under the Madrid Protocol (via which protection can be sought / "designated" in almost 100 countries). Also, if an application is filed in the UK, then you will usually have a period of 6 months to assess whether to file applications in other countries. If you do so, then your foreign applications could benefit from the same application date as the UK application.

What is the process?

In order to obtain a UK trade mark registration, an application has to be filed with the Registry or alternatively, an application can be made for an EU trade mark as this will also cover the UK.

For trade mark purposes all possible goods and services are sub-divided into 45 "classes". When an application is made for a trade mark, the Applicant must state which of these classes the trade mark is actually being used in, and / or those classes in which there is a genuine intention to use the trade mark. The higher the number of classes applied for, the greater the scope of protection afforded by registration. It should, however, be borne in mind that as there is an additional fee for each class, the cost of applying for the trade mark increases commensurately with the number of classes applied for. Also, a greater number of classes increases the likelihood of encountering problems with earlier registrations.

Once the application has been filed with the UKIPO, the applicant will be allocated an application number and date. The application date is of particular importance as this will act as the registration date once the trade mark achieves registration.

The UKIPO will then issue an Examination Report stating whether the application is acceptable or not. There are a number of grounds upon which the UKIPO will not accept a trade mark for registration, the main grounds being that the trade mark is not considered distinctive or is merely descriptive of the goods and / or services to be provided under the trade mark.

If the UKIPO does not raise any objections, or if the objections are overcome, then the trade mark will be advertised in the Trade Mark Journal. Once advertised, third parties have an opportunity to oppose to the application. If no oppositions are filed, or if any such opposition is overcome, then the trade mark will proceed to registration.



How long does the process take?

If there are no objections then registration can be achieved in the UK within a little under four months. If objections are raised, then registration can take up to 12 months or longer to achieve.

Whilst the process can be lengthy, the important date is often the date on which the application was made, not when registration is obtained ('granted'), as protection is 'backdated' to the application date.

How long does a registration last?

A UK trade mark is initially valid for a period of ten years. However, provided the renewal fees are paid every ten years, then a trade mark can provide perpetual protection.

International Dimension

Intellectual property rights are jurisdictional in nature and for instance a UK registration will not protect the trade mark in Ireland. Should you require trade mark searches / applications in countries outside the UK then we will work with our network of trusted overseas associates.

If you require more information on trade mark protection around the world please request our 'International Trade Marks' information sheet.

What is the cost?

The cost is made up of official fees paid to the UKIPO and also our own professional service fees.

The official fee for filing a UK trade mark application in one class is £170. Each additional class costs a further £50. Our fees are available on request.

There may be additional costs incurred after filing the application although these will largely depend on the extent of objections (if any) received from the UKIPO or third parties.

If you would like further information on our service fees, International or European Union trade marks then please ask for a copy of our information sheets.

For further information on this subject, please call your usual Lewis Silkin contact in the first instance or otherwise contact the following members of the Trade Mark and Portfolio Management team:



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