

UK Trade Marks



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Why register a trade mark?



Introduction

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 trade mark. Whilst a trade mark might be capable of being protected through other areas of the law, such as passing off, copyright or design right, registering a trade mark has a number of important benefits.

Trade mark registration

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 for a trade mark can be obtained for a trade mark before it is used, provided that there is an actual intention to use the trade mark, therefore protecting a trade mark 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 an application means that the details of the trade mark are kept on a central register. Most businesses when assessing whether to adopt a new trade mark conduct trade mark 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, registered trade mark protection can last indefinitely provided renewal fees are paid.

Should I conduct a search?

As a matter of course, well-advised businesses conduct a number of searches before adopting a new trade mark. The purpose of a trade mark search is to ensure that there are no identical or similar trade marks already on the trade mark registers covering identical or similar goods or services to those of the trade mark ("Earlier Marks"). If there are, the proprietor of any such Earlier Mark 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.

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 trade mark 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 from those of other undertakings. This not only covers words, but also logos, 3D shapes, sounds, colours, images, moving images and smells.

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 27 EU Member States) and "international" applications under the Madrid Protocol. 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 UK Registry.

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 bona fide 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 Marks.

Once the application has been filed with the Registry, 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 Registry will then issue an Examination Report stating whether the application is acceptable or not. There are a number of grounds upon which the Registry will not accept an application, 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 Registry does not raise any objections in the Examination Report, or if the objections are overcome, then the trade mark will be advertised in the Trade Mark Journal for an initial two month period; this can be extended by one month. 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 within a little over six months in the UK. If objections are raised then it commonly takes 12 months or longer.

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

How long does a registration last?

A trade mark is initially valid for a period of ten years. However, provided 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 an EUTM will not protect the trade mark outside of the EU and it will no longer protect the trade mark in the UK. Should you require trade mark searches/applications for non EU countries, then these can be provided through our network of international contacts.

What is the cost?

The official fee for filing a UK trade mark application is £170 for the first Class and £50 per additional Class. Our fees are available on request.

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

If you would like further information on costs for EUTMs then please ask for a copy of our information sheet.

For further information on this subject please contact:

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UK Trade Mark application procedure

