



Trademarks



A trade mark is a sign used to identify and distinguish the goods, services, intellectual property, or branding of one trading entity from that of any other.



What is a trade mark?

Trade marks can be registered or unregistered and can take the form of words (e.g. Tesco); designs (e.g. the Apple logo); the shape of goods or their packaging (e.g. the Coca Cola bottle); internet domain names (e.g. confused.com) and slogans (e.g. "I'm lovin' it").

Why register a trade mark?

Registration of trade marks is voluntary but strongly advisable as it gives the proprietor the exclusive right to use of the mark in connection with the goods or services in the territory of registration for a renewable period of 10 years.

The registered proprietor can authorise or license others to use the mark, and can sue any person for trade mark infringement where there is unauthorised usage of an identical or similar mark in connection with identical or similar goods, which has caused or is likely to cause confusion.

Conversely, if a mark is unregistered, the owner must rely on a passing off action to prevent infringement of the mark. These lawsuits are notoriously time-consuming, expensive, and difficult to prove.

What qualities must a trade mark possess to be registered?

In order to be registered in the UK, a mark must:

- be capable of graphic representation;
- have a distinctive character which is capable of distinguishing the goods or services of one entity from those of another; and
- not fall foul of the "absolute" and "relative" grounds for refusal.

The absolute grounds for refusal generally relate to the qualities or characteristics of the mark, and will be relevant where the mark:

- is descriptive, i.e. it consists exclusively of signs or indications which may designate the kind, quality, quantity, geographical origin or other characteristics of the goods or services (including phonetic equivalents such as 'Best Fone');

- has become customary in the current language or relevant trade practice;
- consists exclusively of a shape which results from the nature of the goods, or is necessary to obtain a technical result, or gives substantial value to the goods;
- is deceptive;
- is prohibited from use by any enactment or rule of law (i.e. is illegal); or
- is a protected emblem (e.g. royal coat of arms); or
- was applied for in bad faith (e.g. to prevent a legitimate party from registering a mark).

The relative grounds for refusal apply where an identical or similar mark has already been registered, if the mark is:

- identical to an earlier mark registered for identical goods or services;
- similar to an earlier trade mark registered for identical or similar goods or services and there is a likelihood of confusion with the earlier mark;
- identical with or similar to an earlier trade mark and the earlier mark has a reputation in the UK and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark; or
- if used would be liable to being prevented by any rule of law (in particular, passing off) or by virtue of another earlier right (in particular, copyright, design right or registered designs).

When to register a trade mark?

In order to register a trade mark, the mark must either be in use or there must be a genuine intention to use it. Accordingly, the best time to apply for registration is at the development stage of a new product prior to its launch. This ensures that the registration process is underway by the time the product is on the market, and also pre-empts any third party who may apply for the same or a similar mark, as the pending application will be cited against subsequent applications.

Where to register a trade mark?

Trade marks may be registered in a single jurisdiction with the relevant national trade mark registry, which for the UK is the Intellectual Property Office (UKIPO). However, businesses with international commercial interests beyond one jurisdiction should consider protecting their marks in all of the countries in which they exploit or are likely to exploit their marks, either by way of separate individual registrations, or by using one of the available collective marks.

Pan-EU protection can be achieved by registering a European Union trade mark (EUTM) via the European Union Intellectual Property Office (EUIPO). The EUTM system provides a means of obtaining a single registration covering the whole of the EU (27 territories). This is significantly cheaper and more efficient than applying for protection separately in every EU member state, but is harder to obtain and maintain due to the fact that it is vulnerable to attack from any holder of a similar mark in the EU.

Registration can also be achieved in multiple jurisdictions through the World Intellectual Property Organisation (WIPO) under the Madrid Protocol. Under this system, applicants must have a pre-existing “home” national application on which the application to the WIPO is based. The proprietor can then apply for coverage across all of the states designated who have signed up to the Madrid Protocol (including China, the USA, and the EU).

In each instance, the cost, time and potential for opposition is increased with the scope of protection offered.

The application and registration procedure

Searches: When making an application to register a trade mark, searches should first be undertaken by the applicant’s legal representatives of the relevant registries and market, to ensure that the mark is not already registered or in use for the same, similar or related products.

Application: Subject to the results of the search, the application itself will need to be lodged, containing:

- details of the mark including a graphic representation;
- details of the applicant;
- a statement of the goods or services for which protection is sought from a total of 45 prescribed classes: 34 goods and 11 services classes; and
- confirmation as to whether priority is sought (please see below).

The application should be as specific as possible to cover the goods or services which the mark will actually be used to protect. A failure to demonstrate usage of a mark in any particular category for which it is registered may be used as grounds for later opposition, and de-registration.

It may be possible for the applicant to claim 'priority' where an earlier application has been made by the proprietor in a different jurisdiction in respect of the same mark, goods and/or services. The effect of claiming priority is to backdate the current application to the earlier one and provide protection from that earlier date accordingly.

In the UK only, it is possible to apply under an "early assist" system called RightStart, which defers payment of half of the application fee until such time as the application is accepted for publication, or the applicant challenges a rejection by the examiner

Examination: After an application has been made, there is a substantive examination of the proposed mark by an examiner to ensure that it meets the absolute and relative grounds of registrability. Where objections are raised by the examiner, these must be addressed by the applicant in order for the mark to advance to the next stage in the procedure.

Advertisement: Once any objections raised by the examiner have been overcome, the application must be advertised in the relevant periodic publication, which for the UK is the weekly online Trade Marks Journal. There is then a period beginning on the date of the advertisement (2 months for the UK), during which interested parties may object to the registration of the mark in relation to all or some of the goods and/or services listed in the application.

If an opposition is filed, the application will not proceed to registration until the opposition has either been withdrawn or lost. Please note that this process can be protracted, costly and involve multiple parties, so it is important to try to ensure that the application is drafted well to avoid potential oppositions.

Registration: If there is no opposition, or the opposition is lost, the mark will proceed to registration and an online certificate of registration will be issued. Registration lasts for ten years and can be renewed for further periods of ten years, subject to the payment of renewal fees. Registration will run from the date of filing of the application for registration, which is also the date as of which the eligibility for registration of the mark will be assessed if there are later invalidity proceedings.

Timeframe and cost

The amount of time and fees involved in a trade mark application will vary depending upon the type of application being made. There will also be legal fees payable which will differ depending upon the complexity of the application and the extent of negotiations with the relevant registry and opponents.

In the UK, the whole process usually takes between 3-4 months (inclusive of a 2-month publication period). The official fee payable to the UKIPO is £170 online (£200 paper) for a standard application in one class, with an additional £50 payable for each additional class under which protection is sought. Legal costs for each application are payable in addition to the official fees and will vary depending on the complexity of the application.

For a EUTM, the registration process typically takes around 6 months from start to finish. The application fee for a EUTM into one class of protection is €850. There is then a further €50 payable to add a second class, and the addition of further classes beyond two cost €150 each. Please note that these are separate and additional to the legal costs for each application.

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Disclaimer: This note does not contain a full statement of the law and it does not constitute legal advice. Please contact us if you have any questions about the information set out above.

The process for registration with WIPO for an application under the Madrid Protocol is more complex and will usually take around 2 years from the date of application (inclusive of a 12 to 18 month period in which existing holders in the designated countries may lodge an opposition). The home application must separately be made before the international application and may be challenged within the first 5 years of an international registration. If the challenge is successful, the entire international registration will fail.

The official fees for an application to WIPO are payable in Swiss francs and vary depending on the individual designation fee for each specified country (e.g. the USA designated fee is 279 Swiss francs per class registered). This is in addition to the basic fee payable for all applications which starts at 653 Swiss francs for a black and white mark and 76 Swiss francs payable per additional class registered. Legal costs will be also be payable.