



## Trade Mark Guide

### Guidance on the procedure, processes and costs of trade mark applications

Almost without exception, all successful companies rely on registered trade marks as an essential means of protecting their brand. A trade mark registration for a brand or product name, logo, slogan or other trade mark is key to preventing competitors using identical or similar marks, and has other benefits too.

This guide is designed to give some basic information on the selection and registration of trade marks.

We look at:

- what a registered trade mark is;
- searches - selecting a mark that you are free to use;
- registering your mark;
- protecting your mark; and
- some FAQs.

#### 1. What is a trade mark?

A trade mark must be capable of distinguishing your goods and services from those of other businesses.

A trade mark can either be registered as a simple word or a figurative mark (a company logo e.g. the Nike 'tick' logo). Much more rarely, a trade mark can also be a colour, sound, shape, smell, motion hologram or a multimedia trade mark.

In order to register a trade mark, it must not describe the goods or services for which it is registered. So, for instance, the mark "*Diesel*" could never be registered for use as a mark for car fuel, but it is a great brand for clothing. Similarly, a manufacturer of speedometers for cars would never be able to register "*Speedo*". "*Apple*" is a good name for a computer company or record label, but would not be a good mark for a fruit wholesaler. We have considerable experience advising clients on what makes a strong brand and we can provide guidance on this as required.

Trade marks are registered in relation to specified goods and/or services for which the brand is used or will be used. That is why you can have Polo the car, Polo the mint and Polo the clothing company. Most countries divide the various goods and services by 'class' in accordance with the Nice classification system.

Trade marks are registered on a country by country basis. Registering a trade mark in the UK only will provide you with protection for the UK only. Most countries around the world will have their own trade mark registry and rules. It is possible to apply to register a trade mark covering the whole of the EU (an "EU Trade Mark") providing protection for the whole of the EU (but as a result of Brexit this will not cover the UK).

The cost of registering a mark globally is substantial and very few businesses will want to or are able to do this. However, we are very experienced in advising clients of ways of making foreign applications in the most cost effective way.

Once a trade mark is registered it makes it easier to prevent a competitor using an identical or similar mark. It does not just give you the right to sue people, but other benefits, such as the ability to prevent competitors from registering domain names or Twitter/Facebook handles which relate to your registered mark or to get Google to stop competitors from using your mark in AdWords. A registered trade mark is also an asset to a business and can be licensed to third parties and assigned.

## 2. Trade Mark Search Services

It is crucial to understand what other trade marks exist in the area which you want to make your application (please see below for details of trade mark searches), as in order to register a trade mark, it must also differ from pre-existing marks. In particular, an application may be rejected where someone has already registered:

- 1) an identical mark for identical goods/services;
- 2) a similar mark for identical goods/services and there is a likelihood of confusion/association;
- 3) an identical mark and similar goods/services and there is a likelihood of confusion/association;
- 4) a similar mark for similar goods/services and there is a likelihood of confusion/association; and
- 5) an identical or a similar mark for any goods or services and the earlier mark has a reputation which the later mark would take unfair advantage of or be detrimental to that reputation, for example attempting to register “Coca-Cola” for financial services.

Therefore it is advisable to undertake searches to gauge whether your planned use of your chosen mark(s) will infringe the rights of others, whether you decide to register it or not.

If searches are undertaken, then you decrease your chances of facing an expensive and disruptive trade mark infringement or passing off claim from a third party. Such actions might require you to change your branding immediately, deliver up or destroy all stock carrying the branding and pay damages for the losses incurred by the trade mark owner whose rights you infringe (including a high proportion of their legal fees). Searches also help us give you an indication on whether your application is likely to be successful or face further issues.

We can carry out registered UK trade mark searches on your behalf. We have use of a system called Marquesa, which is taken from the official records of the UK trade mark office (UKIPO). The Marquesa system is generally very reliable but does not guarantee that its results are 100% accurate. For instance, there is usually a delay of 3-4 days before a new application being made and being captured on the UKIPO.

We conduct searches and analyse the results with care and attention, using our many years' experience in this field and offering a professional opinion on the prospects of your application being opposed.

For searches outside of the UK we use our overseas associates to carry out such local searches. Please note that global searches can be very expensive!

Owners of ‘unregistered trade marks’ can assert their rights against another party who adopts and/or seeks to register the same or similar mark for the same or similar goods/services under the laws of ‘passing off’ under English law and under unfair competition laws in other jurisdictions. We therefore suggest that our clients carry out research using internet search engines and their knowledge of their market to investigate whether there are competitors with such ‘unregistered trade marks’. Alternatively we can perform these ‘common law’ searches if you would prefer.

### **3. Registering Your Marks**

At the back of this guide there is a flow diagram of the procedure applying to register a trade mark in the UK. Giving time estimates for the process is impossible, as it will depend on how quickly the trade mark office processes the application and whether your application is opposed. You should leave a minimum of 6 months for a UK application.

Before you apply to register a UK trade mark we will give you a fixed price, which includes the government filing fees and our costs for drafting and submitting the application(s). If there are no objections from the UKIPO or from third parties there will be nothing further to pay through to registration. For applications outside the UK we will provide you with detailed costs for the application.

If a trade mark office or third party raises any refusals or oppositions in relation to your application, our time in relation to dealing with such matters will be charged at our normal hourly rates.

The issues decided by the trade mark office on an application can often be very subjective. One trade mark officer might come to a different conclusion to another. Indeed, different trade mark offices can also take different approaches. Therefore, there is no guarantee that an application will lead to a registration.

### **4. Protecting Your Registered Mark**

Once you have a registered mark you should be aware of the “Use it or lose it” mantra of registered trade mark owners. In the UK, if a mark is not in use during a continuous five-year period, then a competitor might seek to have it revoked. Other countries will have different periods, and in some, the USA being one, you will have to intermittently file proof of use. So, you must keep your mark in use in relation to the goods and/or services it is registered for.

We provide a variety of ‘watch services’ to check whether third parties are registering similar or identical marks that you might look to oppose. Where you find your rights are being infringed, we have a great track record in enforcing our clients’ existing trade mark rights.

A registered trade mark needs to be renewed. Most trade mark systems require trade marks to be renewed every 10 years.

### **5. Applying Internationally**

To apply for truly ‘global trade mark protection’ is prohibitively expensive for all but a very few number of companies. However, we do recommend that you consider applying for trade mark protection in your key markets or the countries where your goods are manufactured. For some countries, especially China, we recommend you apply for trade mark protection before launching or publicising your goods or services. This is to reduce your risk of having your trade mark hijacked by a third party, which can have significant and expensive implications.

Where you are looking for wider protection than the UK, such applications can be done via local trade mark registries around the world or through the ‘Madrid Protocol’ (if the country is a party to the Madrid Protocol). We will advise you on which method would be most cost effective for you.

It may also be an option to take advantage of what is known as the “priority period”. This allows trade mark applications that are filed within six months of your first filing to effectively be back-dated to that first filing date. This can be very advantageous to stake out your rights in countries that you may have plans to launch into within the next year or so, whilst spreading the cost of trade mark applications

### **6. Relevant Protection**

Businesses are constantly expanding, changing and adapting to new technological advances. We ask that you tell us about changes, developments and new/potential markets to your business. This will enable us to ensure your trade mark protection is adequate for your needs.

## 7. Some FAQs

- Is it worth my while delaying registering my mark? No – we strongly recommend that you register any mark that you intend to use, as soon as possible. This is to prevent third parties from registering marks in the meantime. Trade marks are granted on a first come first served basis.
- Is a trade mark the same as a brand? No - the word “brand” has a wider, essentially non-legal, meaning and links to the concept of the “brand experience”. A registered trade mark is a legally protected facet of a brand.
- Will registering a company name at Companies House show I am free to use my chosen brand name and protect my brand? No - Companies House will register a company name without checking whether it will infringe a trade mark.
- Can I change my trade mark application or registration? No – once you have filed a trade mark application you cannot change the mark applied for or add to the goods and services. Therefore, it is very important you review the specification we have prepared for you before we file the application. You can however limit or remove the claimed goods/services.
- How can I show that I own a trade mark? The ™ symbol can be used next to any trade mark (whether registered or not), whilst ® symbol can be used to indicate a registered trade mark. Use of the ® symbol without a registered trade mark is a criminal offence.
- Where can I find further information on trade marks? The UK IPO site at <http://www.ipo.gov.uk/tm.htm> has some further information on the subject.
- How do registered rights relate to uses as domain names and on Facebook, Google AdWords and other digital media? Most media platforms allow registered rights holders to enforce their rights within their platform, for example by allowing the owner of a registered mark to request the removal of any handles or infringing use of their registered right on that platform.

## Appendix – Flow diagram of the trade mark application process

