

Registration of your Trade Mark

There are a number of steps involved ... here's how to do it

Expert knowledge means success

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Note: This publication has not been updated since it was last published. Some of the hyperlinks may have changed and may need updating. In addition, some of the information in this publication may be out of date.

Introduction

There are two main benefits in registering a trade mark. First, it confirms that the proprietor is free to use the mark and secondly – and perhaps more importantly it allows them to take action against third parties making unauthorised use of the identical or similar mark in the UK¹.

The Registration process

There are a number of steps involved in registering a trade mark. In order to register a trade mark in the UK, an application is filed at the UK Intellectual Property Office (IPO). IPO examines the application for inherent registrability (i.e. the distinctiveness of the trade mark in relation to the goods covered), and prior marks (i.e. any identical or similar marks registered or applied for in relation to identical or similar goods). If no objections are raised, or in the event that any objections raised are overcome, the application will be provisionally accepted and published in the Trade Marks Journal, whereupon third parties have a three-month period within which they may object. In the likely event that this period passes without opposition, the mark proceeds to registration.

Costs

The costs involved in filing a trade mark application will depend on the precise goods and services that you wish to cover. For the purposes of registration, the UK IPO and most other countries in the world divide goods and services into 45 classes. An application can be filed in the UK covering as many classes as required with an incremental fee payable in respect of the second and subsequent classes.

In the UK, an application to register a mark in one class incurs a fee of £200 payable to the IPO. Each additional class is charged by the IPO at £50. You should be aware that these figures are simply for filing the applications and further costs may be

incurred in relation to the prosecution of any applications filed. These are almost entirely dependent on the nature and extent of any objections raised and third party oppositions encountered.

For further details of fees, see:
<http://www.ipo.gov.uk/types/tm/t-formsfees.htm>

Taking precautions

It is recommended that a search be conducted as a preliminary measure in order to establish whether any existing registered or pending trade marks may threaten the freedom to use or register their mark.

Conducting a search of the Trade Mark Register will establish whether there are any identical or similar trade marks registered or to be registered in respect of any identical or similar goods and services.

Conducting a search is important because it will establish where there are any earlier rights, which an applicant may infringe, and therefore whether they are free to use their mark. This process is quite separate from filing an application to register a mark although it will also serve to indicate whether an application is likely to be successful as far as earlier marks are concerned.

If you want to do so, you can conduct your own search on the IPO website at <http://www.ipo.gov.uk/t-already.htm>. If you choose to conduct your own search using their word and/or logo/picture databases, you will need to consider what goods/services you need to search and what you need to look for.

You should be aware that carrying out trade mark searches is a skilled job and it is recommended that anyone who wants to apply for a new mark should first contact the Search and Advisory Service or a Trade Mark attorney for expert guidance.

It's important to realise that many words or phrases can never be registered as trade marks, for example because they are descriptive of the goods or services. So the fact that you do not find a conflict on the database does not mean your mark is registrable.

Retail Services Finally Allowed in the UK

The IPO has announced a change of practice which allows trade marks to be registered in class 35 in respect of a “retail service”. This includes the sale of goods through shops, catalogues, the Internet and over the television.

Whilst general terms such as “retail services”, “mail order services” and “electronic shopping services” are regarded as too vague, the IPO will accept a specification worded as follows:

“The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods in a [department store] [supermarket] [retail clothes store] [retail pharmacy] [retail furniture store]”.

In the cases of the sale of goods through a catalogue or through electronic media, the following specification is acceptable:

“The bringing together, for the benefit of others, of a variety of goods [e.g. clothing and accessories], enabling customers to conveniently view and purchase those goods from a catalogue mail order [or by means of telecommunications]”.

The IPO say that marks applied for in relation to retail style services are subject to the same standards of inherent registrability as all other applications, and will only be searched against prior rights in class 35 other than where there is an obvious link with certain goods. It is recommended that all marks are now searched against retail services in class 35.

The IPO has cautioned that practice relating to the registration of retail services may change over time.

Filing an application in Europe

If you are interested in filing an application in Europe, you may wish to consider filing a Community Trade Mark (CTM) application which would cover not only the UK but also the other countries in the European Union. This would be of particular interest if you were looking for a cost-effective way to protect your mark across Europe.

Filing a Community Trade Mark application in up to three classes incurs a fee from the Office for Harmonisation in the Internal Market (OHIM) of €750 for an online application and €900 for a paper application. €150 is charged for each additional class. If you wish the IPO to submit the application they will charge a £15 handling charge.

It is difficult to conduct cost effective searches across Europe and this may be best carried out by a professional European patent Attorney.

EC enlargement and Trademarks

Several new member states have joined the European Community (EC) as part of the “EU enlargement.

The effect that the EU enlargement has on trademarks is set out below:

Community Trade Mark (CTM) rights

There is an overriding principle of “Acquis communautaire”. This means that any Community Trade Mark (CTM) right established prior to the date of enlargement must be accepted as binding by new member states. This is subject to any transitional rules that may be negotiated between the Community and the new member states.

With effect from the date of enlargement there is an automatic extension of all CTM registrations and applications that have been granted or are pending. This includes those CTM applications which are filed after the date of enlargement, but which are claiming priority from an earlier application that was filed before the date of enlargement.

Is Your Business name at Risk?

“It is essential to protect the name that you trade under as a registered trademark. This gives you exclusive rights to use that name in your business area. Companies are potentially putting themselves at risk of legal action from another company if they haven't checked whether their name already belongs to someone else. It's not a risk worth taking.”

Lawrence Smith-Huggins, head of the IPO's intellectual property awareness campaign, 'What is the Key?'

National trade marks as “earlier rights”

The concept of automatic extension of CTMs obviously raises issues of what the position is in relation to “earlier” national rights in the new member states, because it is conceivable that some may conflict with an automatically extended CTM.

For community purposes an “earlier right” is any national trade mark registration /application, Madrid Agreement and Madrid protocol application/resignation, well-known mark or unregistered mark with a right that existed prior to the date of enlargement (such as use or recognition in the trade). It is worth noting that applications are still considered “earlier” if they were applied for after the date of enlargement but claim the priority of an earlier application with a filing date before the date of enlargement.

The proprietors of an “earlier right” in a Member State have a right to exclude the use of an automatically extended CTM in their territory subject to the applicable national law.

However, the “earlier right” does not give the proprietor the right to oppose an automatically extended pending CTM application or to request the invalidation of any automatically extended CTM registration. Neither can the proprietor of an “earlier right” exclude the use of an automatically extended CTM if the earlier right itself is subject to attack, invalid or has been acquired in “bad faith”. The exception to the principle that the proprietor of an “earlier right” cannot oppose the registration of a pending CTM is where the filing date of the application falls within a period of six months prior to the effective date of enlargement. The “filing date” is either the actual CTM filing date or any earlier priority date. This right of opposition does not exist if the earlier right was acquired in bad faith in relation to the automatically extended CTM application.

Bad faith applications

The Office for Harmonisation in the Internal Market (OHIM) has defined “bad faith” applications as “those filing marks in order to obtain trade mark registrations which are identical or confusingly similar to trade marks registered in other jurisdictions, with a view to prevent market access, to claim pecuniary compensation or to take profit from the reputation of another’s trade mark”.

CTMs as “earlier rights”

Automatically extended CTM registrations and applications became “earlier rights” in the new member states with effect from the date of enlargement. They apply as an “earlier right” against any trade mark registration or application with a filing or priority date on or after the date of enlargement and must be cited in proceedings such as refusal, opposition or invalidation.

The effect of “absolute grounds” after enlargement

It is acknowledged by OHIM that there are “absolute grounds” for refusing the registration of a CTM that apply even before the enlargement. An example would be marks that have geographical indications. However, OHIM has also recognised that there may be “new” absolute grounds that only come into effect once a new Member State has joined the EC, for example, a mark may be descriptive in the language of one of the new Member States.

Where there is a “new” absolute ground OHIM intends that it will not give the Member State a ground for refusing any pending and automatically extended application, nor will it constitute a ground for taking invalidation or revocation proceedings against any registered CTM (whether the CTM is registered before or after the effective date of enlargement).

The effect that this has depends on the type of “new” absolute ground. If the ground for refusing a CTM is due to the mark being descriptive, non-distinctive or generic in the new Member State then anyone in that member state is free to invoke the “fair use” exception and as such can use the mark in that particular Member State despite the existence of the CTM. Where the “new” absolute ground is based on the CTM being deceptive or against public policy or morality then the use of the CTM in that Member State can be prohibited.

Filing an International Application

You can also apply to register your trade mark in countries which have signed-up to an agreement, known as 'The Madrid Protocol'.

The Madrid Protocol is controlled by the World Intellectual Property Organisation (WIPO), which is based in Geneva, Switzerland. Some of the countries who are party to the Madrid Protocol are also members of the European Union.

A full list of member countries that an International application can cover can be found at WIPO's web site at www.wipo.int/madrid/en

The cost to apply depends on which or how many countries you want your trade mark to be protected in. For any international application you will have to pay a basic fee plus a fee for each country you want protection in (fees vary between countries). An additional fee is payable if the mark is in colour or if the application is for more than one class of goods or services.

To help you work out the cost, there is a Fee Calculator on WIPO's website. If you wish the IPO to submit the application they will charge a handling fee.

An International application made through the IPO must be based on a UK trade mark application or registration. You can apply for the International mark at the same time as you make your UK application, or later if you wish.

Modernisation of Trade Mark rules

From 1 October 2008, new rules modernise and replace certain processes and administrative requirements applying to trade marks and trade mark applications.

The new rules change the opposition period from a fixed three-month period to two months, with a free extension to three months on request by a party considering opposition.

The "cooling-off" period after opposition has begun is reduced from 12 months to an initial period of nine months. It can be extended to 18 months if both parties request it and make certain statements.

The rules also standardise at two months the time period in which you can take actions - e.g.:

- Alter a registered mark.
- Remove matter from the register.
- Make a classification change.
- File a counterstatement to oppose registration of a trade mark.
- File a counterstatement for a revocation on grounds of non-use. The proprietor of the trade mark will have a single opportunity to file evidence of use - or the proper reasons for non-use - on which they intend to rely to defend the registration.
- File a counterstatement for a revocation on grounds other than non-use and invalidation of a trade mark.

The Registrar has wider powers and greater flexibility – e.g. in setting a timetable for the filing of evidence based on the particular circumstances of each case, giving preliminary indications, case management, and other areas of opposition and invalidation. For example, the Registrar has the power to:

- accept late defences where someone applying to register a trade mark fails to file a counterstatement on time in response to an opposition; and
- set aside decisions within six months of their making when the proprietor can prove they were unaware that their mark or application to register a mark was under attack.

Further Information

This guide is for general interest - it is always essential to take advice on specific issues.

We believe that the facts are correct as at the date of publication, but there may be certain errors and omissions for which we cannot be responsible.

References

¹ This publication was inspired by information provided by FJ Cleveland, European Patent Attorneys, Chartered Patent Agents and Registered Trade Mark Agents – their co-ordinates are:

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