



Trade Marks

Patent and Trade Mark Attorneys

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What is a trade mark?

It's a way of identifying the services or products of a business. It doesn't have to be a word or logo – it might be the shape of a product's packaging, a sound, a colour, or even a gesture.

If your business doesn't already have a trade mark, it's a good idea to adopt one so that you stand apart from your competitors. Try to make it distinctive. It mustn't be too similar to an existing trade mark or to an ordinary word that competitors might reasonably want to use to describe their goods or service. Think of invented words (e.g. KODAK or GOOGLE) and words unrelated to the goods (e.g. APPLE for computers) – they are distinctive, memorable, different.

Do I get any rights simply by using a trade mark?

Yes, under certain circumstances. When a distinctive trade mark has been used enough to acquire goodwill in the UK, it may be capable of protection under the law of "passing off". However, it can be difficult and expensive to rely on these unregistered rights and for this reason it's preferable to register a trade mark as your own exclusive property.

Is a trade mark the same as a company name?

No, registered trade marks aren't the same as company names. When a company is set up, its name is recorded on a register (e.g., at Companies House) and no other company can have an identical name. But a company name registration doesn't prevent someone else from using the same word as a trade mark for their goods or services. Registering a company name also doesn't necessarily give the owner the right to use the name on their products if someone has already registered it as a trade mark.

What's the benefit of registering a trade mark?

Most importantly, it allows you to prevent the use of a confusingly similar trade mark for the same or similar goods or services since you, as the owner, have exclusive rights to use it in the territory where it's registered.

There are many benefits to registering your trade mark:

- A registered trade mark is easier to enforce against infringers in the civil courts.
- Trading Standards can take action against counterfeiters in the criminal courts.
- Other people can easily find out that the mark is registered and avoid using it.
- A registered trade mark strengthens a corresponding Internet domain name.
- You have rights without waiting until the mark has acquired the sort of goodwill that's needed to support a "passing off" claim.
- If you don't register your trade mark, somebody else might!

How do I file a trade mark application?

The good news is that you can file a trade mark application at the UK Intellectual Property Office (IPO) at any time: before or after use of the trade mark has started.

When you apply, you must specify the goods or services for which the mark will be used. There are 45 classes of goods and services and we can help you decide which ones you need to include in your application. The application should be in the name of the person or company who will use the mark or someone who can control the quality of the goods or services. We can prepare the application and file it for you at the IPO.

What happens to my trade mark application once it's been filed?

It could take four to six weeks for the IPO to examine whether the trade mark is inherently registrable and whether the goods and services included in the application are properly classified. We'll stay in correspondence with the IPO and keep you up to date. An examiner at the IPO will also search for existing applications/registrations that are similar to your application but will not make any objection on that ground. Instead the IPO will write to the owner of any existing applications/registrations that are found during the search to tell them about your application.

Once the IPO approves your application, it's published. Within a period of two months, anyone can oppose registration of the trade mark, usually on the ground that that person has earlier rights in a trade mark that's confusingly similar. If that happens then we can provide further advice and guide you through the opposition procedure.

If there's no opposition, a certificate of registration will be issued.

How much does a trade mark registration cost?

The cost of filing a trade mark application depends on how many classes of goods and services need to be covered. Once we know more about your business, we can tell you how many classes you should consider covering and provide more information about the costs involved.

How long does a trade mark registration last?

The trade mark is initially registered for 10 years from the application date and can be renewed for further periods of 10 years by the payment of renewal fees. If the trade mark is not used during any continuous period of 5 years, the registration can be revoked.

A word of warning...

A few days after a trade mark application has been filed, the details will be made public on the IPO website. Some organisations use these details to send out invoices directly to the trade mark applicant for unsolicited services, unnecessary registration fees etc. If we've been involved in your trade mark application and you receive an invoice like this, don't pay it! All correspondence should come from us. If you have doubts then check with us first.

How is a trade mark registration infringed?

A trade mark registered in the UK is infringed if a competitor uses a similar trade mark on goods or services similar to those specified in the registration. A trade mark registered as plain words gives protection against the use of those words in any typeface. Remember that a UK registration does not give any rights in foreign countries.

The trade mark registration may be enforced by applying to a Court for an injunction (to prevent further infringement) and for damages. For wilful infringement of a registered trade mark, criminal proceedings are also possible. It can get serious, so talk to us if you have any concerns.

Do you carry out a search before filing an application?

Not normally. However, we can carry out a search for conflicting earlier trade marks if you ask us to. For marks consisting of words only, the search should only take a couple of days and we charge a fixed price. If you need to be sure that the trade mark is clear of potential objections without waiting for the outcome of the application, then a search may be worthwhile. Please be aware that we can't guarantee a clear search will always lead to registration.

How do I monitor what trade marks others are trying to register?

Usually you'll want to know whether anyone else is trying to register a trade mark similar to yours. We can help by providing a "watching service" which lets you know about any potentially conflicting applications in time for you to file an opposition.

How can I protect my trade mark in other countries?

Trade marks can be registered in most countries but the application systems may differ so check with us about current requirements and costs. Two international systems are available: the EU trade mark and the Madrid Protocol. If the foreign trade mark application is filed within six months of the UK application, it can claim the original filing date (known as "claiming priority"). It's possible to carry out advance searches for foreign trade marks but the cost can be high.

An EU trade mark is a single trade mark registration effective throughout all member states of the European Union. Its advantages are that the application and renewal are simpler and cheaper than a large number of national applications would be, and that the trade mark only needs to be used in one EU country to avoid being revoked. The main disadvantage is that an objection arising anywhere in the EU can be a barrier to eventual registration.

The Madrid Protocol is a flexible system in which a single international application can be used to obtain registrations in selected member countries. It's useful for protecting your trade mark in non-EU countries such as the United States and China. The application procedure and the renewal procedure are centralized but the cost depends on the number and on the identities of countries selected. The international application must be based on an earlier application or registration in the 'home' country.

If you want to try and protect your trade mark in several different countries then we can work out the best filing strategy to fit your needs.