

Trade Marks

a short guide

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What is a Trade Mark?

A trade mark is any sign which identifies the goods or services of a business, and may consist of words, slogans or logos and could also include packaging, sounds and even smells. For many companies their trade marks define their image and are therefore valuable assets and powerful marketing tools.

What should I do first?

Great thought and effort goes into selecting the right trade mark to ensure adoption of a sign that will create the right image. It is important after selecting a trade mark and before launching a product under the mark, that appropriate searches are undertaken to make sure that the mark is available for registration and will not infringe any existing third party rights. Once appropriate checks have been made to confirm that the chosen mark is available for use and registration there are significant advantages to seeking registered protection for that trade mark.

How do I go about registering my Trade Mark?

Trade mark registration provides the exclusive right to use the mark for the goods or services covered by the registration and entitles the owner to prevent third parties using an identical or confusingly similar mark.

In order for a trade mark to be registrable it must have some distinctive character so that it can fulfil the function of identifying the goods or services of one business from those of others, indicating the origin of the goods to the buying public. Once a mark is registered, the owner maintains his rights by paying renewal fees at the appropriate intervals and ensuring that the mark does not fall into disuse. Where a registered trade mark is not used for a 5 year period, it becomes vulnerable to revocation should a third party attack the registration.

In the UK, you are not required to register your trade mark before you can use it, but it is advisable to do so in order to clarify your rights and to assist in stopping third parties infringing those rights.

Keep watch on your Trade Mark

It is also important for trade mark owners to ensure that they adequately police their trade marks to ensure that their rights are not eroded by the actions of third parties. In particular since the introduction of the European Community Trade Mark, where a third party can register a relevant mark via the Community Trade Mark System without the knowledge of the owner of an identical or similar UK trade mark, it is imperative that any business with an important trade mark should keep a watch for that brand so that they are notified if any third party seeks to register a conflicting trade mark and are afforded the opportunity to oppose.

Trade marks are generally national in jurisdiction but there are a number of systems available to assist in protecting trade marks.

UK Trade Mark registrations

If a company operates solely within the United Kingdom the most cost effective way of obtaining protection would be to file a trade mark application before the UK Trade Marks Registry. A trade mark application must be based upon a real intention to use the trade mark in the UK and must give a clear representation of the trade mark to be protected along with a listing of the goods or services for which protection is sought.

The UK Trade Marks Registry will examine an application to assess whether the mark is sufficiently distinctive to be accepted for registration and to check whether there is a conflict with any earlier registered marks or earlier held applications. If no objections are raised when the application is examined, then it will proceed to publication in the Trade Marks

Journal where it faces a statutory three month period during which any third party may oppose registration of the mark if they have a basis for doing so. If no oppositions are filed, the mark proceeds to registration and a certificate of registration will issue. The registration has a life of ten years and is renewable for further 10 year periods upon payment of a renewal fee.

Community Trade Marks

For businesses operating throughout Europe, the Community Trade Mark system is a cost effective way of securing registered protection for their trade marks. The advantage to this system of registration is that an applicant must pay only one application and registration fee, but gains registered protection for its mark in all 15 member states of the European Union.

In the same way as a UK national registration, a Community Trade Mark must fulfil certain distinctiveness requirements and will be examined on this basis by the Community Trade Marks Office. Whilst a Community Trade Mark is not examined on the basis of conflict with existing earlier marks, third parties still have the opportunity to oppose a Community Trade Mark if they have a basis upon which to do so. Once the Community Trade Mark proceeds to registration, a certificate of registration will issue. The Registration has a life of ten years and is renewable indefinitely for further 10 year periods upon payment of the appropriate renewal fees.

A European Community Trade Mark is unitary in nature being effective throughout all member countries of the European Union. This also means that if a third party has an earlier national right in one of the member countries then they may be in a position to successfully oppose or invalidate a Community Trade Mark in its entirety (although there are provisions to convert Community Trade Mark applications to national applications in those countries where a prior right does not exist).



International Trade Marks

The International Trade Mark system enables businesses to gain registered protection for their trade marks in any country which is party to the Madrid Agreement or Madrid Protocol. Countries sign up to the Madrid Agreement or the Madrid Protocol, or both. The UK belongs to the Madrid Protocol and so UK companies can use the system to obtain protection in other countries that have also implemented the Protocol.

This system of registration is ideal for businesses operating in several countries further a field than the UK and European Union, as it offers a cost effective way of achieving protection in any number of designated countries under one application. The International system allows the applicant to pick and choose those countries throughout the world under the Madrid Agreement or Protocol which are of interest to them.

To take advantage of this system the owner must have an application or registration in its home country. Upon payment of an application fee and a fee for each designated state (which in most cases is nominal), the International application is examined centrally at the World Intellectual Property Organisation (WIPO) for basic formalities. The application is then forwarded to the national office of each designated country where it is examined according to the relevant national laws. Each national office will then notify WIPO of its acceptance or rejection of the application. If the application is rejected in one designated country, this does not affect the remaining specified countries.

For the first five years of the life of an International registration it is dependent upon the "home application or registration" so that if the home application does not go through to registration or if the home registration is invalidated within 5 years of the application for

the International Trade Mark, the International registration will also be lost – after this 5 year period the International mark becomes independent.

The owner of an International Trade Mark Registration effectively ends up with a bundle of separate national registered rights in all of those countries in which the application has been accepted, without the administrative burden of having to file numerous separate applications, and without the burden of costly separate filing fees. An International Registration lasts for ten years, and is renewable indefinitely for further 10 year periods upon payment of appropriate registration fees for those country designations that are still of interest.

Overseas National Trade Marks

Where a business has an interest in only a small number of overseas countries, it can be more cost effective to file separate national applications in those countries. An overseas national application must be filed through the relevant national office, and filing costs vary greatly between different countries.

Examination procedures will also differ depending on the laws and procedures of the relevant country. However it is common in most countries for an application to be examined with regard to its registrability and for conflicts with existing marks. Most countries also operate a system whereby third parties may oppose registration of a mark if they have a basis upon which to do so.

Most countries will issue a trade mark registration certificate once a mark has been accepted for registration. The life of the registration may vary from country to country.

How Marks & Clerk Can Help?

With over fifty partners and 300 staff, we serve a client base ranging from the private individual to the largest multi-national corporations. Voted the UK's No. 1 firm of both trade mark and patent attorneys* for 6 years in succession, we have the experience and expertise to assist you in obtaining, maintaining and exploiting your trade marks.

We can:

- Advise on whether a trade mark can be registered
- Carry out searches to establish the availability of marks and possible infringement
- Handle applications through to registration via any of the systems outlined above
- Handle oppositions either filed against your applications or that you want to file against third party applications
- Advise on issues such as amendment, validity and infringement
- Advise on licensing matters
- Advise on transfer of ownership of trade marks
- Assist you to police your trade marks by using appropriate trade mark watching services

* *Managing Intellectual Property* magazine surveys over 3000 intellectual property professionals worldwide.

MARKS & CLERK

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For a free no obligation discussion about how we can help, please contact us at one of our offices: -

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