

Your Guide to Trade Marks



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Section 1

General Guide to Trade Marks

What is a trade mark?

A trade mark is something that distinguishes your product or service from those of your competitors: it is your identity in the marketplace. A trade mark may consist, in particular, of words (including personal names), logos, designs, letters, numerals, colours, sounds or the shape of goods or their packaging (or a combination of those things).

Why should I register my trade mark?

There are many benefits of registration. The most important benefit is that registering a trade mark gives legal rights that allow you to prevent others from using and/or registering the same or a confusingly similar mark. In many countries, including the UK, rights in a trade mark can be accrued through use of the mark. However such use must be significant and it is generally more difficult and costly to enforce unregistered rights.

How do I register my trade mark?

Trade mark protection is territorial. In order to obtain a trade mark registration, you make an application to the official body responsible for granting intellectual property rights in the particular territory of interest. Trade mark protection in the UK may be secured through registration at the UK Intellectual Property Office (“UK IPO”).

Once your application has been filed at the UK IPO, it will be examined to determine whether or not it meets all the requirements of the law. If the requirements are met, your application will be accepted for registration and published for opposition purposes in the Trade Marks Journal. If no oppositions are filed (or the application is not successfully opposed in its entirety), your application will proceed to grant and a certificate of registration will be issued.

What makes a trade mark registrable?

In order to be registrable, your trade mark must be distinctive. Your trade mark may allude to aspects of the product or service that you provide, but not describe them. Descriptive or non-distinctive marks do not often effectively indicate the commercial origin of a product or service, which is the purpose of a registered trade mark.

When should I register my trade mark?

You can apply to register your trade mark at any time, i.e. before or after you commence use of the mark. It is advisable to apply to register your trade mark as soon as possible. However, we recognise that the individual needs of each of our clients need to be carefully considered and the decision regarding when (and where) to seek registered trade mark protection requires a cost/benefit analysis.

Should we search for other trade marks before filing a trade mark application?

There is no obligation to conduct searches prior to filing a trade mark application. As part of the trade mark application process, both the UK and European Union Offices will conduct a search for potentially relevant earlier registrations and applications having effect in the UK/European Union respectively.

However, it is generally advisable to carry out trade mark searches before adopting a new mark, firstly to determine with greater legal certainty that you are free to use your trade mark without infringing third party rights, and secondly to check whether third party rights are likely to prevent registration of your own mark.

If you are interested in having trade mark searches conducted, we suggest that you discuss this with your attorney so that you can weigh up the pros and cons of doing so.

What do I need to tell you in order to file a trade mark application?

In order to prepare a trade mark application, we will need the following:

- + The name and address of the applicant (i.e. the person or entity which will own the right);
- + Details of the trade mark to be filed;
- + A representation of the trade mark if it is a figurative mark, preferably in .jpeg format;
- + A list of the goods and /or services that are to be covered by the application; and
- + Details of any earlier foreign rights for the same mark from which priority may be claimed, if appropriate.

How much will it cost?

It is difficult to predict with any certainty how much any particular trade mark application will cost. Costs are very much dependent upon the countries in which protection is sought, and the range of products and/or services for which the trade mark will be protected.

While our charge for preparing and filing a trade mark application is fixed, costs after filing can vary from a few to several hundred pounds and will be higher if your application encounters an official objection or third party opposition. However, we can give indications of what costs will be, and approximately when they will be incurred. Your attorney will provide you with cost indications when you apply for a trade mark, and will keep you up to date with potential future costs as and when appropriate.

How long will it take?

Assuming there are no official objections or third party oppositions, both UK and European Union Trade Mark Applications currently take around 4–6 months to achieve registration. If there are objections from the Registry or a third party files an opposition, the process can take much longer. Time scales in other countries can vary considerably.

What happens if someone copies my trade mark after I have filed a trade mark application?

Trade mark infringement proceedings based on a UK trade mark cannot be brought until your trade mark application has proceeded to registration, but all rights in the registration date back to the date of filing the application. If you do have a registered trade mark, you can launch legal action through the courts, seeking an injunction to stop another party's activity, and damages or account of profits to compensate you for their infringement. Due to the cost and complexity of legal action, this is usually a last resort.

A first step is often your attorney making your competitor aware of your rights. This may result in the infringing activity stopping without the need for legal action. We do not recommend approaching an alleged infringer yourself without first speaking to us. Among a number of reasons for this, in the UK there are "groundless threats" provisions. If it is later proved that infringement is not taking place, you may have to pay the alleged infringer damages. Your attorney can advise further in the event of any potential infringement dispute.

If your application is still pending, you are not able to launch court action. However, you can take steps to put the alleged infringer on notice, so that if and when your trade mark is registered, you can clearly show the alleged infringer was aware of your rights. Again, we recommend that any contact you have with an alleged infringer is via your attorney.

Once I file my trade mark application, am I free to use it?

A trade mark registration is a “negative” right, in that if you have a registered trade mark, you are able to prevent others from doing things. A trade mark registration does not give you the right to do anything yourself. Your trade mark may still infringe someone else’s trade mark rights.

How can I be sure I am not infringing any other trade marks?

Whether or not you are infringing other trade mark rights can be a difficult question to answer. Whilst you may be able to reduce the risk of infringing other trade mark rights by having considered and directed trade mark searches conducted, there are of course limitations inherent in trade mark searching.

What is the difference between™ and ®?

The ™ symbol has no legal significance; the letters ™ simply mean you claim a mark as your trade mark, whether it is registered or not.

The ® symbol strictly means that a trade mark is registered. In certain jurisdictions, including in the UK, it is an offence falsely to represent that a trade mark is registered. If your trade mark is not registered, you should not use the ® symbol, or any other words or symbols which suggest that your mark is registered.

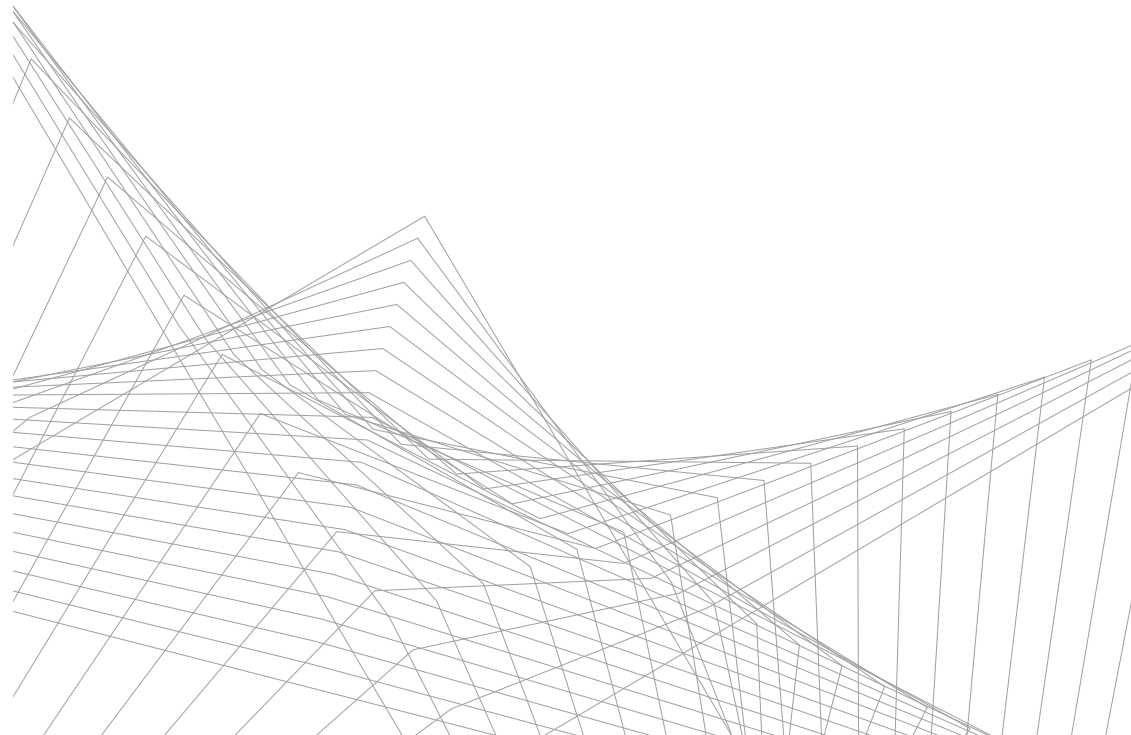
Can I sell my trade mark?

Yes. A registered trade mark, or an application for registration of a trade mark, is an asset and can be sold in the same way as any other piece of property. You may also license the rights in your trade mark, and even use your trade mark as security for a loan. If you are interested in any commercial transactions involving your trade mark rights, we suggest you contact your attorney in order to seek further advice.

Section 2

Structure of a Trade Mark Application

The three most essential parts of a trade mark application relate to the (i) applicant, (ii) mark itself, and (iii) list of goods and/or services.



Applicant

The trade mark applicant is the person or entity which will own the right. A registered trade mark and an application for registration are both personal property. Accordingly, the applicant for registration must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Representation of the mark

It is important to apply for your mark exactly as you use, or intend to use, it. In the UK, once an application for registration has been made, the trade mark may only be altered if the trade mark includes the proprietor's name or address, and the alteration is limited to that name or address and the alteration does not substantially change the mark.

List of goods and/or services

When you apply to register your trade mark, you must provide a description of the goods and/or services on which your mark is used, or intended to be used. These goods and/or services need to be identified from one or more classes in an international system of classification known as the 'Nice Classification System'. Goods and services within this system are currently divided into 45 classes – 1 to 34 for goods and 35 to 45 for services.

Your eventual rights in your trade mark will depend heavily on the specification of goods and/or services. Therefore, you should think carefully about the range of goods and/or services you claim. You should think not only about all goods and/or services of current interest, but also all goods and/or services of potential future interest. Care needs to be taken as a specification that is drafted too narrowly can be worthless, whereas a specification that is drafted too broadly could well invite unnecessary challenges from third parties.

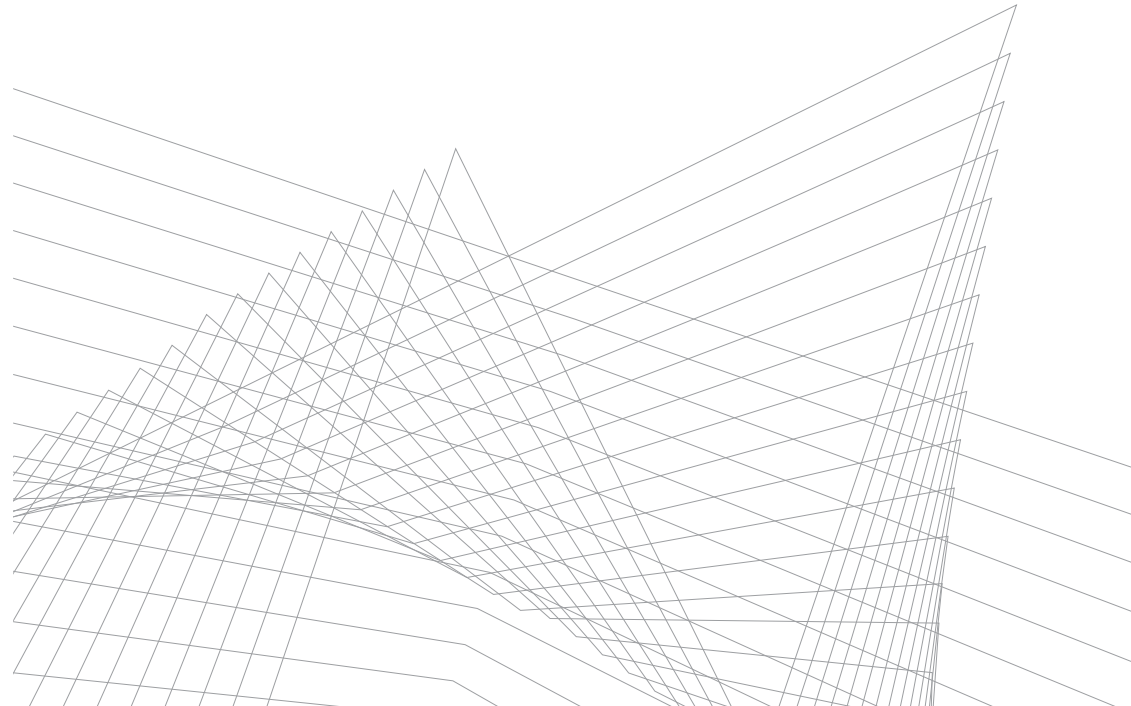
Once your application for registration has been filed, you cannot expand your list of goods/services, only narrow it. Accordingly, if you wish to cover additional goods/services in a given territory, it will be necessary to file an additional application.

Section 3

Trade Mark

Application

Procedure



Trade Mark Application Procedure

It is not possible to obtain a worldwide registration, but there are ways of registering a mark in more than one country in a cost-effective manner. A European Union trade mark registration gives protection in all countries in the EU. The Madrid Protocol allow you to file one application which at least initially covers lots of different countries, enabling considerable cost savings. This single application can lead to a separate registration in each country included in the initial single application.

What is a European Union Trade Mark?

A European Union Trade Mark (commonly referred to as a “EUTM”) is a single registration that protects your trade mark in all 27 member states of the EU, namely: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, and Sweden.

The system is administered by the European Union Intellectual Property Office (“EUIPO”), based in Alicante, Spain.

What is an International/Madrid Protocol Registration?

The Madrid Protocol allows you to file a single trade mark application designating one or more countries that are members of the system. The rights obtained under the Madrid Protocol are a bundle of national trade mark rights which are examined and subsequently administered under the national law of each of the designated countries. An International trade mark application can designate more than 120 countries worldwide including, for example, the EU as a whole, all EU countries separately, the US, China, Australia and Japan.

The system is administered by the World Intellectual Property Organization (WIPO), based in Geneva, Switzerland.

What is Priority?

There is a mechanism called priority, which means that after you have filed your first application for a given trade mark, you then have a period of six months in which to file further applications for the same mark in other countries, and each of those applications is effectively treated as having been filed on the same date as the first application. In this way you can defer the cost of filing in several countries for a few months if necessary.

Can anything go wrong after registration?

Yes. The validity of your trade mark can be challenged at any time, including after registration. In particular, a third party can apply to revoke or invalidate your registered trade mark.

In the UK and the EU, failure to use your mark for a continuous period of 5 years from the date the trade mark was registered can result in your trade mark being revoked. Your trade mark can also be revoked if it has become misleading, or generic (i.e. the common name in the trade for the goods and/or services for which it is registered). Further, if a third party can prove that your mark should not have been registered in the first place, e.g. on the grounds that your mark is descriptive of the goods and/or services for which it is registered, they may apply for it to be invalidated.

What are renewal fees and when do I have to pay them?

In most countries, renewal fees must be paid for a trade mark to remain in force. In the UK and the EU, a trade mark registration lasts for 10 years from the date of application, and can be renewed indefinitely, on payment of fees, for successive periods of 10 years.

Who is Clarivate (formerly CPA Global)?

Abel + Imray do not offer a renewals payment service for routine renewals. Since it is vital that you have reliable renewal arrangements in place to avoid inadvertent loss of rights through failure to pay renewal fees, we will supply details of your cases to Clarivate (a specialist trade mark renewals reminder and payment service, formerly CPA Global) unless we know you have made provision with another specialist renewals provider. Once Clarivate has your details, they will send you reminders regarding any renewals due, together with details of their renewals payment service.

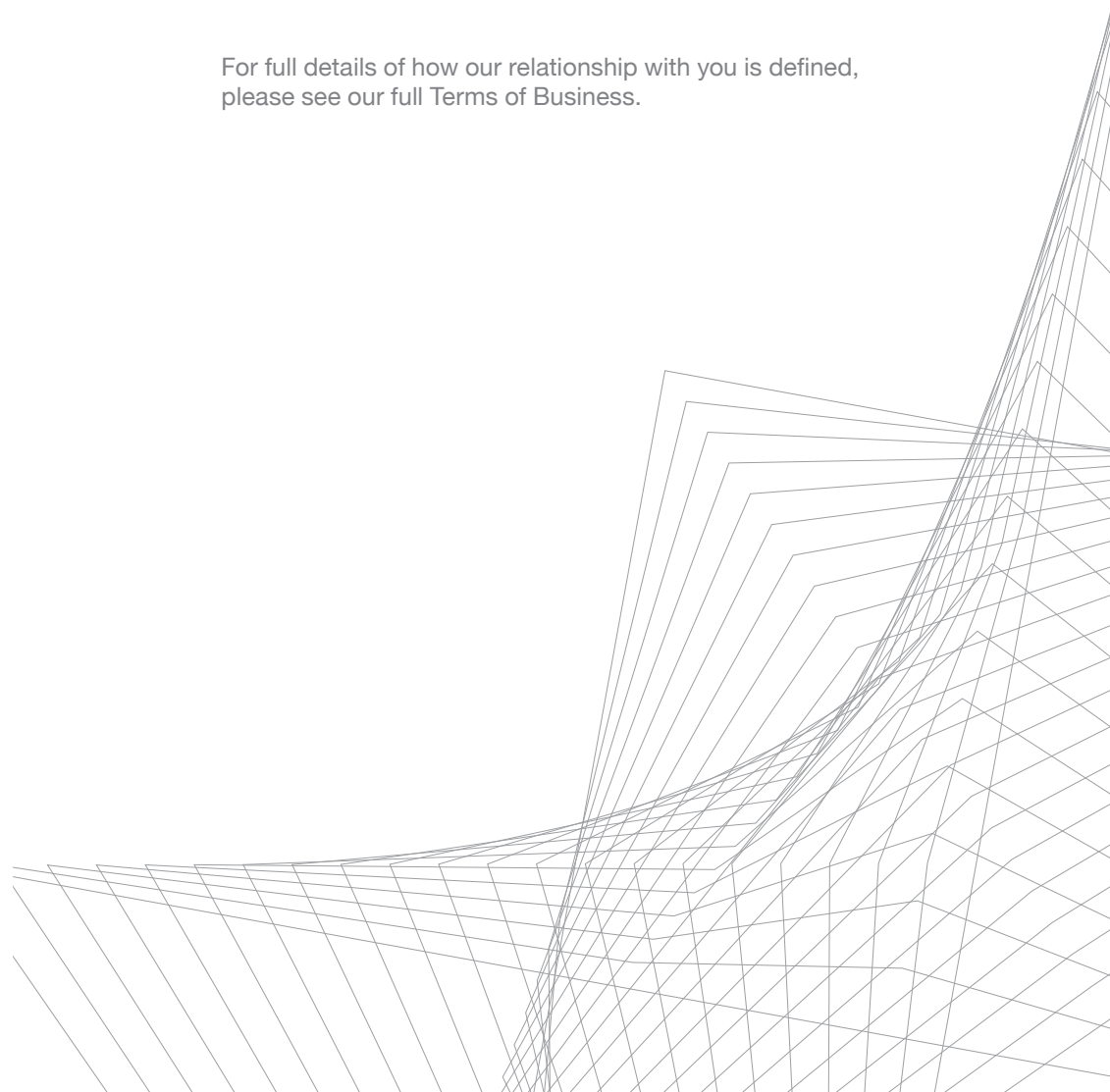
Who else keeps sending me invoices and renewal fee reminders?

WARNING – There are a number of companies that send out unsolicited mail to applicants following publication of their trade mark application, typically requesting payment in order to maintain the trade mark application or include it on a register. If you receive unsolicited requests for payment, it may be a scam. If you have any doubts regarding the credibility of correspondence you receive, please contact your attorney. Your attorney will then advise on whether or not the payment reminder/request is genuine and if any action is required.

Section 4

Your Relationship with Abel + Imray

For full details of how our relationship with you is defined, please see our full Terms of Business.



Why should I use a trade mark attorney?

You do not have to use a trade mark attorney in the UK (unless you are based outside the UK). If you are based outside the EEA, you would have to use an authorised representative for most actions before the EUIPO (and we have a Dutch office for that purpose). However, the protection and use of trade marks is a complex area of law, and there are therefore distinct advantages in using a professional. If your trade mark is a valuable asset in which you have invested significant time and money, we highly recommend that you engage a Registered Trade Mark Attorney.

How are my bills worked out?

+ Fixed Charge Work

This relates to the more administrative aspects of our work, for example, the completion of a new application form together with entering the new application details onto our records and docketing system.

+ Professional time

Professional time spent by our attorneys is charged at an hourly rate. An example of professional time is the time spent reviewing an examination report and preparing and filing a response. It also includes time spent in meetings and on telephone calls and emails. We may be able to answer some of your queries quickly and without sending you a bill. However, if we are required to spend professional time in order to provide you with an answer, this time will be invoiced.

+ Disbursements

This includes official fees payable to Intellectual Property Offices and also payment of the charges of foreign attorneys if you have trade mark applications pending overseas.

How can I reduce my bills?

One way to reduce your bills is to ensure that you provide instructions in good time when asked. Time spent chasing instructions may be charged and also late responses can often incur official penalty or extension fees.

We also recommend that you perform a regular review of your trade mark rights to ensure that they are still commercially relevant to you. If not, you may decide to abandon a pending application, or not pay a renewal fee and allow a registration to lapse. If you are minded to abandon an application, it will also help avoid unnecessary costs if you let us know as soon as possible. We may then ensure that no additional cost incurring actions are taken on a case.

Can you give me a fixed price?

We appreciate that it is difficult to budget for the costs incurred when seeking trade mark protection. There are a number of reasons why it is challenging to give you a definite fixed price schedule.

How much professional time we spend on a case depends very much on whether the application encounters any problems (i.e. official objections and/or third party oppositions). Where problems arise, costs will be higher, perhaps very significantly, than a straightforward case where the application proceeds to grant without objection. If we were to provide you with a fixed price, in order to allow for the potential difficulties, it may be a significantly higher price than if we simply address the difficulties if and when they arise.

We do however provide a number of flow charts setting out some typical costs of obtaining trade mark protection which can be viewed as a guide to the sort of figures and timescales involved. Also, prior to undertaking any action which will incur a significant charge, we will aim to provide an estimate and seek confirmation we should proceed with the work.

