



Fact Sheet

Trade Mark Procedures & Costs

International



What do You Need to do Before Using a Trade Mark Outside the UK?

If you are considering using your trade mark in a foreign country for the first time, then we advise that you should first search the relevant foreign trade mark register, to identify any earlier rights which might prevent you from using and registering your mark in that country.

The charges for trade mark searches vary from country to country, and we can provide estimates for specific countries of interest.

How do you Obtain Trade Mark Rights Outside the UK?

While some countries acknowledge unregistered rights to an extent, other countries do not protect unregistered marks at all. In most countries, trade mark rights are granted to the first party to file an application for registration. Therefore, trade mark registration is the best way to protect your trade marks overseas.

If you have filed an application to register your trade mark in the UK, then any applications filed overseas within six months of the original UK filing date can claim “priority” from your UK application. This priority claim ensures that your earliest UK filing date is recognized abroad, should there be any conflict with other trade mark applications filed around the same time.

Filing Procedures

Most countries follow the same general application procedure. This generally requires identifying who is applying to register the trade mark, the trade mark to be registered, the goods or services for which the trade mark is to be registered, and the class or classes into which those goods or services fall (according to the International Classification System). Some countries permit a single application to cover more than one class of goods or services, upon payment of additional class fees. Other countries require a

separate application to be filed for each class of goods or services.

Do Separate Applications Have to be Filed for Each Country?

The number and type of applications required depends upon the countries in which your trade mark needs protecting. There are four different options which are normally available to a UK based trade mark owner: a separate national trade mark application in each country of interest; an EU-wide Community trade mark application; a Madrid Protocol application; or a combination of these. Basic information about each option is set out below. We can recommend how best to obtain protection in the countries of interest to you.

National Trade Mark Applications

These are applications filed on a country-by-country basis. For some countries, a national trade mark application is the only option. Some countries subject each application to a rigorous examination procedure to determine if the mark can be registered. Others do not examiner applications other than for compliance with formal requirements. Most countries publish details of the application to allow third parties to oppose registration of the trade mark. The time scale for obtaining registration varies from a few months to several years.

European Community Trade Mark Applications

A Community trade mark (CTM) application can provide protection in all of the European Union (EU) countries by a single application. This provides protection in Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and United Kingdom. The geographical scope of the Community trade mark extends as the EU enlarges.

A CTM application is filed at The Office for the Harmonisation of the Internal Market (Trade Marks & Designs) or “OHIM” in Alicante, Spain. Once filed, a CTM application is examined, and provided that the trade mark is sufficiently distinctive for all EU countries, the mark is accepted and published to allow third parties to oppose registration of the trade mark.

The examination process also includes a search of earlier CTMs and earlier marks on the national registers of most of the EU countries. The results of the search are sent to the owner. OHIM does not consider the results, and will not object to registration of the trade mark based upon a likely conflict with an earlier trade mark. The owners of the CTMs identified by the search are notified of publication of the mark, so they can decide whether to oppose. Owners of the national registrations identified are not notified in this way. If the CTM application is not opposed, or once any opposition is resolved, the mark is registered and becomes effective in all EU countries, upon payment of a registration fee.

If registration of the mark is refused because of an objection which is applicable in one or more of the EU states, then you have the option of converting the CTM application into separate national applications

in the remaining countries of the EU. The relevant national trade mark office(s) will then examine the application according to their usual practice, but the national applications will retain the original filing date of the CTM application.

A CTM registration may be entitled to claim seniority (i.e. the date and all other rights) from existing registrations for the same mark in any EU state. This may result in a saving of renewal fees on the existing registrations. You should seek further advice on this point before any national registrations are allowed to lapse.

International - Madrid Protocol

The Madrid Protocol is an international trade mark registration system which allows a single application to cover a large number of different countries. The charges for filing a Madrid Protocol application dependent greatly upon the number of countries to be covered and on the number of classes of goods or services required. An estimate can be provided once the countries in which protection is required are known. The countries which are signatories to the Madrid Protocol can be found on the WIPO website at www.wipo.int, and include the USA, Australia, China, Japan and the European Union via a CTM.

Under the Madrid Protocol there must be a “home” trade mark registration or application in one of the signatory countries, for example a UK or CTM application or registration. The application designates those signatory countries where protection is required. Once the application has been filed, the mark is registered on the International Register and details of the mark are sent to the national office in each of the designated countries. During the following 18 months, objections can be raised against the application in any designated country, either by the national office of that country or as a result of opposition.

If an objection is raised against the trade mark in a designated country, and you still want protection there, then we appoint a local trade mark attorney to handle the objection on your behalf. If the objection cannot be overcome, then the registration in that country will be refused, but this does not affect the registration in any of the other designated countries.

It is an essential feature of the Madrid Protocol that

the home trade mark application or registration survives for a period of at least five years after the date of registration of the International application. If the home rights are lost (for example if the validity of the registration is successfully challenged, or the trade mark rights are not renewed), then the Madrid Protocol registration can be transformed into separate national applications. The cost benefits and administrative convenience of the International registration system will then be lost.

Madrid Agreement

The Madrid Agreement is related to the Madrid Protocol. It is available to you if you are a national of, resident in, or have a genuine place of business in one of the Madrid Agreement countries. The UK is not a member country. A list of countries that are signatories to the Madrid Agreement can be found on the WIPO website. Specific advice is available on request.

Which System Should I Use for Protection in Europe?

The main drawback of the CTM is its unitary nature: if the application fails in one EU state, it fails in its entirety. It is not possible to limit the application to cover selected EU countries only, or to limit the specification of goods or services covered in only some of the countries. However, it offers cost advantages on filing, infringement and maintenance. An example of this is that use of the mark in one EU state is likely to maintain the validity of the registration in all EU states.

The Madrid Protocol system on the other hand, is more like a bundle of national registrations, which are linked for administrative purposes. Therefore, the Madrid Protocol would be appropriate if you know there are likely to be difficulties registering the

mark in some EU countries, or if you wish to vary the scope of the registration from county to country. The Madrid Protocol offers protection for countries outside the EU too.

A CTM can be designated in a Madrid Protocol application, so that the benefits of both systems can be combined. We can advise which system best suits your requirements, once we have an idea of the countries of interest to you.

Renewals

The initial registration period for a trade mark for a CTM registration or an International registration is ten years from the filing date. For national registrations, the initial registration period varies but is typically seven or ten years. If the mark is still of interest, the registration can be renewed for further periods by paying a renewal fee. Renewals may be handled by Computer Patent Annuities Limited (CPA), a specialist renewals firm, or by ourselves.

In most countries, registered marks which have not been used by the owner within a specified period are open to challenge by others who may request that the registration be removed from the register, or limited in scope. In some countries (e.g. USA) the registration will be automatically struck off unless a sworn statement is filed by the proprietor at set intervals, stating that the mark is being used.

It is possible that you may wish to licence, assign or enter in commercial agreements involving your trade mark in the future. It is essential in these matters to take advice on how that might affect your rights. It is also important that you keep us advised of any changes in your activities, company name, address or status.

Watching

Registration of a trade mark is no guarantee that competitors will not try to register similar marks. In many countries, it is the trade mark owner's responsibility to police their own trade marks, and object to later applications which are likely to conflict. UDL therefore strongly recommends establishing a trade mark watch in the countries of interest. We can supply further information on request.

Costs

Searching a mark - £300 per country upwards (depending upon countries and number of classes).

CTM Applications

- Filing an application for a mark in up to three classes - £1200
- Each additional class covered by the same application - £250
- Prosecution (search and examination) - variable, but typically £125 to £750
- Publication and registration (assuming no opposition) for a trade mark in up to three classes - £1100
- Each additional class covered by the same application - £250.

Madrid Protocol Applications

- Filing an application based upon an existing UK registration - £850
- Filing an application based upon an existing CTM registration - £950
- Each class above three - £95
- Each designated country - variable, but from £95 to £700 for an application in one class
- Reporting registration on International Register - £125
- Prosecution costs at national offices, if objections are raised - variable, but from £450

National Applications

- Filing costs - variable, but typically between £700 to £1350 for an application in one class
- Prosecution - variable, but from £200
- Registration - variable, but from £125.

You need to bear in mind that many countries require documents which support an application, such as Powers of Attorney, to be signed before a Notary Public, and legalised at the relevant consulate. This increases the overall cost in obtaining registration, and may delay the filing of the application, while these documents are obtained.

All amounts indicated are in Pounds Sterling and

include any official fees payable. The amounts are exclusive of VAT, which is usually recoverable if you are VAT registered. Costs are approximate, and will vary depending upon the complexity of the case.

Our Services

Services are provided to you by Urquhart-Dykes & Lord LLP, and the contract under which those services are provided is with Urquhart-Dykes & Lord LLP and not with any individual member, employee or agent of Urquhart-Dykes & Lord LLP. Acceptance of our commencement of the provision of services to you shall be deemed to be acceptance of our Terms of Engagement (a copy of which can be provided on request, or can be viewed on our website at www.udl.co.uk).

During our work for you we may need to instruct third parties (for example, patent and trade mark attorneys in other countries, or searchers) to act on your behalf. We might instruct such parties directly on your behalf. Alternatively you might need to sign a power of attorney or similar appointment to engage such third party. Any such party is not part of Urquhart-Dykes & Lord LLP. While we shall endeavour to select third parties of appropriate good standing, we shall not be responsible for any default or negligence by such third parties.

Our charges are based principally on the amount of our professional time spent on the matter. Our hourly rates are determined with reference to the seniority and experience of the professional staff involved. These rates are reviewed periodically. Charges are calculated at hourly rates which apply when the work is carried out. There may be additional charges where a matter is complex or urgent or is one for which highly specialised knowledge is required. We might apply tariff charges to specific tasks such as the filing of a patent or trade mark application.

In appointing us to act on your behalf, you are also authorising us to incur such expenses as we consider necessary to carry out your instructions properly and agreeing that you will reimburse us in respect of those expenses. Examples of such expenses are Patent Office fees, fees of Counsel and other experts, Court fees, and the costs of third parties (for example patent attorneys in other countries, experts, searchers and translators) who we instruct on your

behalf. They might also include such items as photocopying costs, courier charges, travel, accommodation and meeting expenses, telephone and fax charges. While our fixed charges and hourly rates are predictable, you should appreciate that many expenses are outside our control since they might be changed without notice and (in the case of foreign matters) vary with exchange rate fluctuations.

Any estimate of likely costs we provide (whether included in this sheet or in response to a request) is given only as a guide to assist you in budgeting, and should not be regarded as a firm quotation or a fixed or capped fee unless otherwise agreed in writing. Any costs given by us are net of VAT which will be charged as applicable on our fees and those expenses that are liable for VAT.

These notes are provided for guidance only, and do not deal with specific problems. For further information, please visit our website at www.udl.co.uk or contact one of the following offices :

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