



Fact Sheet

Trade Mark Procedures & Costs

United Kingdom



What is a Trade Mark?

A trade mark is a “sign” which can distinguish your goods and services from those provided by your competitors. Commonly, a trade mark is a word, a picture (or logo), or a combination of the two, but other “signs” such as the shape of a product or its container, sounds or even smells may be registered as trade marks.

Rights Given by Registration

Registration of a trade mark gives the owner of the trade mark registration the exclusive right to use the trade mark in relation to the goods or services for which the trade mark is registered. Therefore, the owner of a trade mark registration can take legal action against competitors who might, inadvertently or otherwise, infringe the registered trade mark rights by using the same, or a similar, trade mark on goods or services identical or similar to the goods or services covered by the registration. Registration can be sought for a trade mark which is in use, or in respect of a new trade mark which is intended to be used.

The owner of a registration of a trade mark which has established a reputation in the UK can sometimes prevent use of the same or a similar mark, even if the goods or services on which the infringer is using the offending mark are not similar to those covered by the registration, if they can show an intent to take unfair advantage of the reputation established under the mark.

Common Law Rights

If a trade mark is used for a considerable time without being registered, then the user may still have some rights, known as “common law” rights, which may let the user protect his interest in the trade mark. However, a legal action based on such common law rights, generally known as a “passing-off” action, is much more difficult and costly to pursue than an action for infringement of a registered trade mark.

EU harmonisation of the law means that common law rights are limited, and the law favours the first to register a trade mark, and not the first to use a mark in the UK. A first user of an unregistered trade mark may have very limited rights, or none at all, if the same mark, or one similar, is registered by a competitor. It is therefore important to register your trade mark as the legal rights provided by registration have been made stronger at the expense of common law rights, which have been weakened.

Choosing and Using a New Trade Mark

When devising a new trade mark, the aim should be to find a mark which is capable of registration, and is not being used, or has not been registered, by others. To be registerable, ideally, the trade mark should not be directly descriptive of the goods or services for which it is to be registered, a geographical name, a laudatory expression, or a term which might be deceptive.

Once you have decided on a mark, the next step is to conduct a search of the UK Trade Marks Register. Once we have reviewed the results of the search, we can advise whether use of your proposed mark is likely to infringe an existing registration, and also whether your proposed mark is likely to be accepted for registration.

If the search of the Register is clear, there is still the possibility that a conflicting unregistered mark is in use, and may have acquired “common law” rights. We can, as an additional precaution, arrange common law searches through relevant trade and general directories. A search through an index of UK limited company names can also

be arranged, to establish whether or not there is a company with the same name as your proposed mark.

What is Involved in Applying for a Trade Mark Registration?

The procedure falls into four distinct stages -filing, examination, publication and potential opposition, and registration.

Filing

An application is filed at the Trade Marks Registry, specifying the goods or services for which the trade mark is to be registered and indicating the classes into which the various goods or services fall. We can advise on the most relevant classes in which you should seek registration, depending on your present and future business plans. Once the application has been received by the Trade Marks Registry, the application is allocated an application number and a filing date.

Examination

The application then undergoes examination by the Registry, to determine whether the trade mark is acceptable for registration. The examination report also includes details of earlier conflicting rights, which may form the basis for opposition, if the application proceeds. In most cases, a report on the examination is issued by the Registry within one or two months from the filing date. Once the examination report is received, we advise as to the next step to be taken. Matters arising from the report may be such that they can be dealt with in correspondence with the Registry. However, it may be necessary to attend a Hearing at the Trade Marks Registry in order to discuss the application with a senior examiner, particularly in a border-line case.

The Examiner will not refuse the trade mark application based upon a likely conflict with an earlier trade mark, but the owners of the earlier marks are notified of publication of your trade mark application, so they can decide whether to oppose. Marks referenced may be on the United

Kingdom, European Community or International Registers.

Publication and Potential Opposition

Once the examination has been completed successfully, the application is published by the Registry in the UK Trade Marks Journal. The published trade mark application is open to public inspection and it is possible for a third party to oppose registration of your mark during a period of two months from the date of publication, although this period can be extended by a further month upon request from the potential opponent.

If an opposition is filed by a third party against your application, then the matter has to be considered and appropriate action taken. It may be possible to deal with the opposition by an exchange of correspondence and /or by limiting the scope of the application, and /or by agreeing how the mark will actually be used. Otherwise, legal arguments and evidence are submitted by both parties and the Registry will decide whether to allow the mark to be registered.

Registration

If there is no opposition to the application, or once any opposition has been resolved, then the trade mark will be registered. A registration certificate is then issued and the trade mark is placed on the Register for a period of ten years from the date of application.

Renewals

The initial registration period for a trade mark is ten years from the filing date. At the expiry of the initial ten year period, the registration can be renewed for further periods of ten years on payment of the relevant renewal fee. Renewals can be handled by a specialist firm, CPA Global ("CPA") or by ourselves upon request.

Is it Necessary to Indicate that a Trade Mark is Registered?

In the UK, there is no obligation to indicate that

the trade mark being used is a registered trade mark, but it is good practice to do so. This can be done either by using the ® symbol adjacent the trade mark, or by placing an asterisk next to the mark, and using a footnote where convenient along the lines of "... is a trade mark of (insert proprietor's name) and is registered in the UK". You should not indicate that a trade mark is registered if the application is still pending, or if no application has been filed. You should not use the ® symbol if the product is to be sent to other countries where the mark has not also been registered. If in doubt, the TM symbol should be used. Further advice on the correct use of trade marks can be provided, if required.

Watching

The increased emphasis on rights being granted to the first to apply to register a trade mark, means that more responsibility is now placed upon trade mark owners to police their own trade marks. This requires you to be aware of the existence of subsequent trade mark applications which may conflict. We therefore strongly recommend establishing a watch for applications and registrations of trade marks similar to yours in countries relevant to your commercial activities. The watches can be supplemented with watches for similar domain names and company names. Please ask us about setting up a watching brief.

Consequences of Non-use

You should note that any UK registered trade mark which has not been used by the owner for a continuous period of five years can be attacked by third parties who may request that the mark be removed from the Register or the scope of registration limited.

What about Registering a Trade Mark Outside the UK?

The procedure for registering trade marks outside the UK is generally similar to that in the UK, with a separate application being filed in each country where a registration is required, unless the countries of interest can be covered

by one of the "collective" systems, such as the Madrid Protocol or the Community Trade Mark system. Details are available on request and a separate Fact Sheet has been produced to set out some initial procedures and costs.

Looking After Your Trade Mark

As well as maintaining a watch on your mark, as discussed above, you may wish to licence, assign or enter into commercial agreements involving your trade mark, now or in the future. It is essential in these matters to take advice on how these dealings may affect your rights. It is also important that you keep us informed of any changes in your activities, company name, address or status.

Costs

The cost of searching a mark will vary, depending on the products and services of interest, but will begin at about £300.

The cost of filing and obtaining registration of a mark will again depend on the products and services of interest, but for a simple mark covering one 'class', you should expect the total to be roughly £700.

For matters such as Oppositions or recording a licence, our professional fees are based upon time spent, and we can provide any estimate upon request.

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.

Urquhart-Dykes & Lord LLP is regulated by The Intellectual Property Regulation Board www.ipreg.org.uk

Contact Us

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 our offices:

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UDL represents clients of every size, from the individual to multi-national corporations. The protection and exploitation of your innovations and brands is at the core of our business. Our clients benefit from local services supported by the resources and expertise of a major intellectual property specialist firm.

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