
Our patent and trade mark attorneys are here to help you protect and profit from your ideas, making sure they're working every bit as hard as you do.

Our people work with everyone from multi-nationals to start-ups, delivering jargon-free advice that tells our clients exactly where they stand. From day-to-day filing through to advising on IP strategy and due diligence, we offer a complete patent and trade mark service.

Whether you'd like a quick chat about what we do or you have a specific IP project to discuss, please get in touch.

Trade Mark Registrations

A trade mark registration protects your brand from unauthorised use and guarantees your freedom to continue using your trade mark. Most countries have a recognised trade mark registration system and we are experienced in obtaining registrations worldwide.

What is a trade mark

A trade mark is a sign which, when used in the course of trade in the provision of goods or services, can serve to distinguish one trader's goods or services from those of other traders. Commonly, a trade mark is a word, a picture (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 exclusive rights to the proprietor to use the trade mark in relation to the goods or services for which it is registered. It also gives the right to take legal action against competitors who might, inadvertently or otherwise, infringe the proprietor's 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.

Also, the owner of a trade mark registration comprising a mark having a 'reputation' in the UK, for example, can sue for trade mark infringement even if the goods or services on which the infringer is using the offending mark are not similar to those covered by the registration.

Choosing a new trade mark

When thinking of a new trade mark to use, the aim should be to find a mark which is both protectable, i.e. capable of registration, and not used or registered by others. To be registrable, a trade mark should ideally be:

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- not already registered by a third party
 - not directly descriptive of the goods or services
 - not a surname or a geographical name
 - not laudatory
 - not deceptive

We can assist you in this process by searching the trade mark databases and providing advice. 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 mark in the UK.

What is involved in applying for a trade mark registration?

The procedure in the UK, EU and most other jurisdictions falls into four distinct stages: filing; examination, publication, and registration.

1) Filing

An application is filed at the Trade Marks Registry, specifying the goods or services for which registration is sought and indicating the classes into which the various goods or services fall.

2) Examination

Once filed, the application is examined by the Registry, in order to ascertain whether the trade mark is acceptable for registration. The Registry will not refuse registration on the basis of a potential conflict with an earlier trade mark, but will notify the owner of any earlier application or registration of your application. In most cases the official examination results are issued by the Registry within one to two months from filing the application. This is a variable matter which depends upon the Examiner's report. It may sometimes be necessary to attend a Hearing at the UK Trade Marks Registry in order to discuss the application with a Senior Examiner, particularly in a border-line case.

3) Publication

Once the examination has been successfully completed, the application is published in a Trade Marks Journal. The trade mark application is then open

to public inspection and possible opposition for a period of up to three months from the date of publication. If an opposition is raised by a third party against the application, then the matter has to be considered and appropriate action taken.

It may be possible to deal with the opposition in a relatively simple exchange of correspondence. Again, this area is difficult to define precisely, as much depends upon the individual case. We can advise further at the time if it should arise.

4) Registration

If there is no opposition, or any opposition has been resolved, then the application can proceed to registration on completion of certain formalities at the Trade Mark Registry. 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

Trade mark registrations normally need to be renewed every 10 years. We, or our renewal associates, can remind you of this deadline if you wish.

Consequences of non-use

A registered trade mark needs to be used to ensure it is not at risk of being attacked by a third party or removed from the Register.

Is it necessary to indicate that a trade mark is registered?

In some countries it is advisable, and in others obligatory, to indicate that the trade mark is registered, and the way in which this should be done varies from country to country. Where a single mark is used in a number of countries, labels, packaging, sales literature etc. are often printed centrally in one country, and in this case it would be good practice to place an asterisk next to the mark wherever it appears, and use a foot note where convenient along the lines of:

“.....(insert trade mark) is a trade mark of(insert Proprietor’s name) and is registered in the following countries: - (list countries where registered).

You should not represent the mark as registered in a particular country where it is not, in fact, registered, and this can occur inadvertently when the designation ® is used. If in doubt, the letters “TM” can be used to denote trade mark. Further advice relating to the use of trade marks is available on request.

Watching

Due to the increased emphasis on rights being granted to the first to apply to register a trade mark, there is now more responsibility on trade mark owners to police their mark and to be aware of the existence of any subsequent applications which may be in conflict. We therefore strongly recommend placing a watch over trade marks in countries of interest. We can supply information on request.

What about registering a trade mark abroad?

With regard to the registration of trade marks abroad, the procedure is in general similar to that in the UK, with a separate application being filed in each country where a registration is required (although there are two “collective” systems described briefly below). There is some variation in the requirements of different countries, and in respect of costs which in general are higher than in the UK.

European trade mark applications

It is possible to file a Community Trade Mark Application covering all of the countries in the European Union.

International trade mark applications

The Madrid Protocol system enables the filing of a single application designating a number of member countries (member states listed on next page).

Members of the Madrid Protocol

Albania	Italy
Algeria	Japan
Antigua and Barbuda	Kazakhstan
Armenia	Kenya
Australia	Kyrgyzstan
Austria	Latvia
Azerbaijan	Lesotho
Bahrain	Liberia
Belarus	Liechtenstein
Belgium	Lithuania
Bhutan	Luxembourg
Bosnia and Herzegovina	Madagascar
Botswana	Mexico
Bulgaria	Monaco
China	Mongolia
Colombia	Montenegro
Croatia	Morocco
Cuba	Mozambique
Cyprus	Morocco
Czech Republic	Mozambique
Democratic People's Rep. of Korea	Namibia
Denmark	Netherlands
Egypt	New Zealand
Estonia	Norway
European Union	Oman
Finland	Philippines
France	Portugal
Georgia	Republic of Korea
Germany	Republic of Moldova
Ghana	Romania
Greece	Russian Federation
Hungary	Rwanda
Iceland	San Marino
India	Sao Tome and Principe
Iran (Islamic Republic of)	Serbia
Ireland	Sierra Leone

Slovenkia
Slovenia
Spain
Sudan
Swaziland
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
The Former Yugoslav
Republic of Macedonia Tunisia
Turkey
Turkmenistan
Ukraine
United Kingdom
United States of America
Uzbekistan
Vietnam
Zambia