

Marks&Clerk



A Short Guide

# Trade Marks

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## What is a trade mark?

A trade mark is a sign which identifies and distinguishes the goods or services of one business from those of another. Trade marks can be words, slogans or logos and can also include shapes, packaging, sounds and even smells. The Coca-Cola logo and bottle shape are both examples of trade marks.

## How do I know a trade mark is not already in use?

Before you make the final choice of your trade mark and start using it, you should carry out clearance searches. This is to ensure that the mark you have chosen is actually available for use and registration and is not already in use or registered by another company.

## How do I know my trade mark is registrable?

In order for your trade mark to be registrable it must be able to distinguish your goods or services from those of others.

## Why should I register my trade mark?

Trade mark registration entitles you to prevent competitors using or registering an identical or confusingly similar mark.

Once a mark is registered, you maintain your rights by paying renewal fees at the appropriate intervals and by using that trade mark. If a registered trade mark is not used for a 5 year period, it can become vulnerable to attack by a competitor. 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 secure your rights and to prevent competitors infringing those rights.

## How do I protect my trade mark rights?

It is advisable for trade mark owners to police their trade marks to ensure that their rights are protected against the actions of others. In particular since the introduction of the European Community Trade Mark a company 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 therefore that you keep a watch on any important trade marks that you own. This way you will be notified if another company is looking to register a conflicting trade mark and you will have the opportunity to object.

## What are the trade mark protection options available?

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

## UK trade mark registrations

If your company operates solely within the UK, the most cost-effective way of obtaining protection would be to file a trade mark application before the UK Intellectual Property Office (IPO).

The UK IPO will examine the application to assess whether the mark is sufficiently distinctive to be accepted for registration ("absolute grounds"). They will no longer refuse the application at the examination stage based on earlier rights of others. They may however send notifications to such rights holders, in case they wish to object at the opposition stage. If no objections are raised on absolute grounds then the application will proceed to publication in the Trade Marks Journal where it faces a statutory 2 month period (extendible to 3 months upon request) when any company may oppose

registration of the mark. If no oppositions are filed, the mark proceeds to registration and a certificate of registration will issue. The registration has a life of 10 years and is renewable for further 10 year periods upon payment of a renewal fee.

## Community Trade Marks

For businesses operating in Europe, the Community Trade Mark (CTM) system is a cost-effective way of securing registered protection for their trade marks. The advantage to this system is that you pay only one application and registration fee for the registered protection of your mark in all 27 member states of the European Union.

In the same way as a UK national registration, a CTM must fulfil certain distinctiveness requirements and will be examined on this basis (but not on the basis of conflict with existing earlier marks) by the Community Trade Marks Office. Once the CTM proceeds to registration, a certificate of registration will issue. The registration has a life of 10 years and is renewable indefinitely for further 10 year periods upon payment of the appropriate renewal fees.

A CTM is "unitary" in nature which means that if another trade mark owner has an earlier national right in one of the European Union member countries then they may be in a position to successfully oppose or invalidate a CTM in its entirety. However, there are provisions to convert CTM 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 protect their trade marks in any country which has signed up to the Madrid Agreement or Madrid Protocol. 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 if your business operates in several countries outside the UK and European Union as it offers a cost-effective way of achieving protection in a number of countries by way of one application.

To take advantage of this system, you must have an application or registration in your home country. Upon payment of an application fee and a fee for each designated country, the international application is first of all examined centrally at the World Intellectual Property Organisation (WIPO). It 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 notify WIPO of its acceptance or rejection of the application. If the application is rejected in one country, this does not affect the application in the other designated countries.

As the owner of an international registration you effectively have a bundle of separate national registered rights in all countries where the application has not been refused. This avoids the administrative burden of having to file numerous separate applications as well as more costly separate filing fees. An international registration lasts for 10 years, and is renewable indefinitely

for further 10 year periods upon payment of appropriate registration fees for all designated countries.

### **Overseas national trade marks**

If your business has an interest in only a small number of overseas countries, it may 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 for its registrability and for conflicts with existing marks. 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 but is typically 10 years.

### **How can Marks & Clerk help?**

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you register and protect your trade marks and manage your trade mark portfolio, contact your usual Marks & Clerk attorney or a member of our trade mark team at your nearest Marks & Clerk office. Full details are on our website [www.marks-clerk.com](http://www.marks-clerk.com).

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

