



# GUIDE TO TRADE MARK PROTECTION

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# TRADE MARKS PROTECT THE NAME OF A BUSINESS OR THE NAME OF A PRODUCT OR SERVICE

**Registered trade marks** are used to protect words, logos or a combination of both as part of your brand. A strong trade mark can be fundamental to ensuring that your USPs are unmistakably associated with your business, product or service. Protecting that trade mark from abuse by competitors and other businesses is vital. It is important to consider registering your trade marks as soon as possible to minimise the risk of others using your trade mark, or preventing you from using your trade mark.

A registered trade mark is obtained through an **application procedure**. To be registerable your trade mark must distinguish your business from other businesses and identify your business as the source of your particular goods and/or services. The trade mark must also be capable of being represented graphically.

A trade mark will not be registerable if it is descriptive of your goods and/or services, or consists of words or other

representations that traders in the same sector of business may legitimately wish to use to identify the origin of their own goods and/or services. However, since 'descriptiveness' of a trade mark is very subjective, if you are not sure you should seek advice on this point.

## **Geographical Coverage**

To obtain a registered trade mark in a particular country, a trade mark application will need to be filed in that country. Most individual countries operate a procedure for the registration of a trade mark which involves filing an application with the appropriate organisation. There are a number of application procedures that cover multiple countries. For example, the Community trade mark procedure and the International (Madrid) trade mark procedure can simplify matters and reduce costs in some cases, by allowing a single application to be made, which, if successful, will give rise to registrations in the countries required.

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## THE TRADE MARK PROCEDURE

### **A. Preparation**

We typically recommend that a search is performed before seeking protection to look for existing registrations that may present an infringement risk and a barrier to the registration of your trade mark.

The initial stage in the application process is the preparation of a specification of goods and services that are used with the trade mark. Each application must list the goods and services on which the mark is to be used by reference to a pre-defined classification system consisting of 45 different classes. It is not uncommon for applications to be incorrectly filed with the wrong goods or services or the wrong classification. Since it is generally not possible to add new goods and services to a trade mark application or to change the trade mark, it is important to get it right at the beginning to avoid unnecessary fees and disappointment.

### **B. Filing a Trade Mark Application (0 months)**

The additional documents that form a trade mark application along with the goods and services specification are prepared and filed at a Trade Mark Office. The application is given a filing date and a filing number.

We typically recommend that the trade mark application is first filed in the UK for cost and flexibility reasons.

In a number of countries, the filing date starts the clock for the 6 month deadline in Step G.

### **C. Receipt of the Search & Examination Report(s) (1 to 2 months)**

We will receive reports from each country where applications have been filed.

There are generally two types of objection raised in the reports. First, the reports will set out any objections that the Examiner

has to the trade mark, such as descriptiveness of the trade mark or the classification or breadth of the goods/services. Second, the reports will list any other trade mark registrations that the Examiners in those offices think are relevant to the registerability of your own trade mark, e.g. where the mark and the goods/ services are identical or too similar so as to cause confusion to a customer.

We are given a deadline by which to respond with changes to the specification and any arguments to convince the Examiner that the objections and/or the other trade mark registrations are not relevant. Please note that any changes made at this stage cannot involve the addition of features that are not in the application on file.

If the Examiner remains convinced that the first type of objections are still relevant, he will refuse to register the trade mark. However, if the first type of objections are addressed, but the Examiner remains convinced that the third party registrations are still relevant, he will not refuse to register the trade mark, but will inform the owners of the third party registrations of your application. It is up to the owners of those third party registrations (potential opponents) to take action to prevent registration if they are concerned about the conflict presented by your trade mark.

### **D. Publication (2 to 4 months)**

The trade mark application will usually be published after any issues have been overcome and the owners of any other registrations have been informed. The publication typically starts the clock for an opposition deadline by which it is necessary for any opponents to file an intention to oppose your application.

### **E. The Opposition Period (3 to 5 months)**

Your trade mark application can be opposed by any third party with an interest. For example, if a third party has an

identical or similar trade mark registered for identical or similar goods or services for which you are seeking registration, then they may be able to prevent your registration.

In the UK, the publication date starts the clock for a 2 month deadline by which it is necessary for any opponents to file an intention to oppose your application. In the first instance, an opponent must file either a Notice of Opposition, or a one month Extension Request within 2 months of publication. If an extension is requested at the two month deadline, this must be followed by a Notice of Opposition within the one month extension. In other countries, the opposition deadline may be longer or activated after registration.

#### **F. Opposition ( 6 months to 2 ½ years)**

If a valid opposition is filed within the designated time periods, then the opposition procedure will likely delay, or even prevent registration of your trade mark. During opposition, the opponent must show good reasons and evidence for either restricting the scope of your goods/services to remove any conflict with their registration, or for completely preventing your registration from proceeding.

There are often opportunities to defend any of these reasons and the procedure also encourages the parties to

mediate and settle. In the UK, a lengthy 'cooling-off' period commences early in the process.

Opposition may delay registration for months or years.

#### **G. Foreign Protection (6 months)**

Within 6 months of filing the initial application it is possible to file foreign trade mark applications for the same trade mark and goods/services. These applications benefit from being treated as having been filed on the same day as the initial application (referred to as claiming priority). If you require protection abroad, we can advise you of the best filing strategy, arrange for the applications to be filed in the geographical locations of your choice and manage the portfolio and further deadlines for you.

We will remind you of this important date well in advance and prepare any necessary documentation on your instruction.

#### **H. Registration (6 to 9 months)**

In the event of an opposition-free process, registration will usually be achieved within 6 to 9 months of the date of filing.

**Please refer to our timelines over the page for more information about the stages and costs.**

#### **Renewal Fees (every ten years)**

Renewal fees are payable on every registered trade mark in every country. There is no maximum term. In most countries the renewal fees are paid every ten years on the anniversary of the filing date.

#### **Enforcement & Exploitation**

The right to **enforce** a Registered Trade Mark begins after the registration has been confirmed: It is not possible to sue for infringement until it has been confirmed.

It is possible to **exploit** a trade mark during the application process by granting licences or otherwise commercially using the trade mark.

#### **Using the Multiple-Country Procedures to Obtain Foreign Protection**

##### **International system (Madrid)**

The Madrid system enables a single International trade mark application to be filed for seeking foreign protection. It is necessary for an applicant to specifically designate WHICH COUNTRIES they want to seek protection in at the outset. The application will eventually be granted as an international registration, but is then subject to an examination by each of the foreign Trade Mark Offices. If a particular Office ultimately refuses to uphold the International Registration in their country then the International Registration is amended to remove that country.

The system provides an easy way to file and process foreign trade mark applications for most countries of the world at a time-critical stage (Step G). It also makes it easy to maintain the registration by allowing renewal fees to be paid to a central organisation. The alternative is to file individual applications in each country at Step G.

The Madrid system does have many advantages and some disadvantages. It is worth seeking advice as to where the balance may lie for your situation.

##### **Community Trade Mark (CTM)**

The Community Trade Mark system enables a single trade mark application to be filed. Unlike the International procedure, the entire application procedure is based at the Community Trade Mark Office (OHIM) and if successful results in a Community Trade Mark Registration. The Registration is maintained as a single unified entity effective in all of the countries in the system. The Community system is a cost effective way to seek trade mark protection in a number of European countries. The alternative is to file individual applications in each country. Advantageously, the Community system can be used following the International system if designated in the International application.

The unified nature of a Community Registration does have many advantages and some disadvantages. It is worth seeking advice to take your individual circumstances into account.

##### **Post-grant Procedures**

A registration can be challenged at any time on the basis that it is not 'valid', i.e. should not have been registered. This typically involves National Courts.

## TYPICAL TRADE MARK PROCEDURES

We have shown the timings and costs for a typical case starting with a UK trade mark application. They are intended as guidelines only and may differ as Trade Mark Office fees, exchange rates and Foreign Associates charges change. Where we are able to anticipate that there may be higher charges than those shown, we will make every effort to advise you in advance. The information provided is for general information only and is not legal advice. Brooke-Jones LTD does not accept any liability for any loss or harm arising from your reliance on this general information. You must seek appropriate advice. Please note that all estimates shown are exclusive of VAT.

