

## UK Trade Marks Overview

### Why Register a Trade Mark in the UK?

At some point you may have considered registering the trading name of your business, or perhaps the name of a good or service that your business sells, or your logo, as a trademark. You may have decided not to pursue registration because of other priorities or you may have felt that the cost would outweigh the benefits.

Increasingly, small and medium-sized enterprises as well as established brands are protecting their goodwill by registering trademarks. A registered trademark is no longer the preserve of 'household names'.

The benefits of registering your trading name include:

- Adding value to your business. Registering a trademark will in itself increase the value of your goodwill. This value can be realised if you come to sell or float the business in the future.
- Making the business a more attractive prospect for investors and lenders. Many investors and lenders will be reassured that a business has taken steps to protect its goodwill by registering a trademark.
- Ensuring that no one else will be able to prevent you from using your trading name. This will be especially relevant if you plan to expand in the future.
- Ensuring that you will be able to prevent others from using an identical or similar name and/or logo.

In addition obtaining a trademark registration also makes it easier and less expensive to licence the use of the trademark to other businesses. This may produce a future source of income for the business.

Russell-Cooke would be happy to assist you in protecting the goodwill of your business by registering your trademarks, and we will usually provide you with initial advice, and make the application on your behalf for a fixed fee.

Before applying to register a mark you will need to choose, what you want to register, and for which goods and services.

### What should I register as a trademark?

In order to register a trademark, you will first need to decide what the registered mark will be. Most businesses will have a trading name which is used in a particular typeface or font together with a logo or design. There may also be a strap line or other elements.

You may choose to register your business name alone text-only mark – this will give you much more flexibility in changing the design of the mark in the future. However the downside is that this does not protect your logo or design and if someone uses a similar logo or design for a different name then you may not be able to prevent them from doing so, and a text-only mark may be more difficult to register in some circumstances.

Alternatively you can protect your name as it is used in a particular typeface or with a given logo, this is usually easier to register and protects the design but you may find that you are unable to prevent someone from using a similar name with a very different design.

Often you would choose to register both your name and your design and logo, subject to your budget. We can advise you as to what to register.

### **What Goods and Services should I register the trademark against?**

When applying to register a trademark you must include a list of all of the goods and services for which you wish to use the mark. This list is known as a 'trademark specification'.

The applicant must list those goods or services in 45 'classes' which are specified by international treaty our website contains a list of the 45 classes.

We would recommend that the specification includes all of the goods or services which you intend to provide over the next 5 years. If the specification is too wide then the application is more likely to meet objections from the registrar or holders of earlier marks.

If you do not use any of the goods or services you have listed after 5 years then an application may be made to remove these goods from your registration.

### **Objections**

There are several grounds on which objections may be made to the registration of the mark.

Objections to registration may be made by the trademarks examiner or by organisations or individuals who own other similar or identical registered or unregistered marks. If objections cannot be overcome by agreement with the examiner or the other parties then the application will fail unless you are able to succeed at a trademark hearing.

Objections can be made on 'absolute' or 'relative' grounds, or in plain English, on the basis that the mark is not sufficiently distinctive or is too descriptive or on the basis that it would be confusingly similar to an earlier registered or unregistered mark.

### **Can you register the proposed mark as a trade mark?**

The first type of objection which may be made in relation to the trade mark is an objection on one of the 'absolute grounds'.

The application may fail on the absolute grounds if the proposed mark is not 'distinctive' enough to be capable of being a trade mark or if the mark is too 'descriptive'.

'Distinctive' – the examiner will look into whether the proposed mark is distinguishable from other signs or words which other traders may wish to use in the ordinary course of business.

'Descriptive' – the examiner will object to the registration of a mark which merely describes what an organisation or business does, where it does it, or describes some aspect of the goods or services provided.

A question to ask is whether the average consumer would recognise the mark as a trade mark.

### **Relative Grounds for refusal of registration.**

As well as the absolute grounds there are relative grounds for the refusal of registration of the proposed mark. The relative grounds relate to earlier trade marks.

An application can be refused on the relative grounds if there is an earlier trade mark and there is a likelihood of confusion on the part of the public between the your business and that of the owners of the earlier mark.

Even if there is no likelihood of confusion the application can be refused if the use of the mark by yourselves would take unfair advantage of the reputation of the earlier mark.

If your mark is:

- Identical to an existing registered mark and is used in relation to the same goods or services, or
- Identical to an existing registered mark and is used in relation to such similar goods and services that there is likely to be confusion on the part of the public, or
- Similar to an existing registered mark and is used in relation to the same or such similar goods and services that there is likely to be confusion, or
- Identical or similar to an existing registered mark which is well-known and your mark is used in relation to dissimilar goods where your use will take unfair advantage of or be detrimental to the existing mark's reputation.

Then registration will not be permitted, unless the owner of the existing mark consents.

Objections made on the basis of dissimilar earlier marks would normally fail.

### **Procedure**

The trademarks application procedure is relatively straightforward.

An application must be prepared on paper and sent to the Intellectual Property Office or using the online system at [www.ipo.gov.uk](http://www.ipo.gov.uk) the application must include a copy of the mark together with a specification of the goods and services for which it will be used. The application may be for a 'series' of marks and may claim colours as part of the mark (for more information please contact us).

The trade marks examiner will then review the application and the existing trademarks register to ascertain:

- a) Whether the mark is capable of registration (i.e. that it is distinctive and not descriptive);
- b) Whether there are any earlier marks whose owners should be notified of the application.

Once the initial examination process has been completed and the examiner agrees that the mark is on the face of it fit to be registered, the mark will then be published in the Trade Marks Journal and there will be a two month "opposition" period (which can be extended to three months) during which it is open to anyone to object to the registration of the mark. If that period elapses without any objections being lodged then the mark will proceed to registration.

If the examiner has identified any similar or identical earlier marks which may cause confusion then they will notify the holders of those marks that the application has been made and they will be invited to object if they wish to do so.

## **Opposition**

The procedure for an opposition to a trademark application is as follows:

The person wishing to object must pay a fee to lodge their objection and file a Notice of Objection. In many cases the opposing party will approach the applicant first to seek a negotiated settlement.

The Trade Marks Registry will send a copy of the Notice of Opposition to the applicant and the applicant may then send the Trade Marks Registry a counter-statement in defence of the application.

Each party will be asked in turn, to give evidence to support their respective cases. Once both sides have given evidence, the Registry will either:

- decide the matter based on the evidence provided; or
- arrange and hold a hearing if either side asks for one - this gives both sides the chance to speak in support of their case.

In either case the Registry will decide whether to allow the opposition and issue a written statement of its decision. The decision will usually include an award of costs to the successful side. The level of costs awarded is based on a statutory scale.

## **Contact Details**

If you have any queries about trade marks or the trade mark procedure please contact Guy Wilmot on 0208 394 6531 or [guy.wilmot@russell-cooke.co.uk](mailto:guy.wilmot@russell-cooke.co.uk)

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