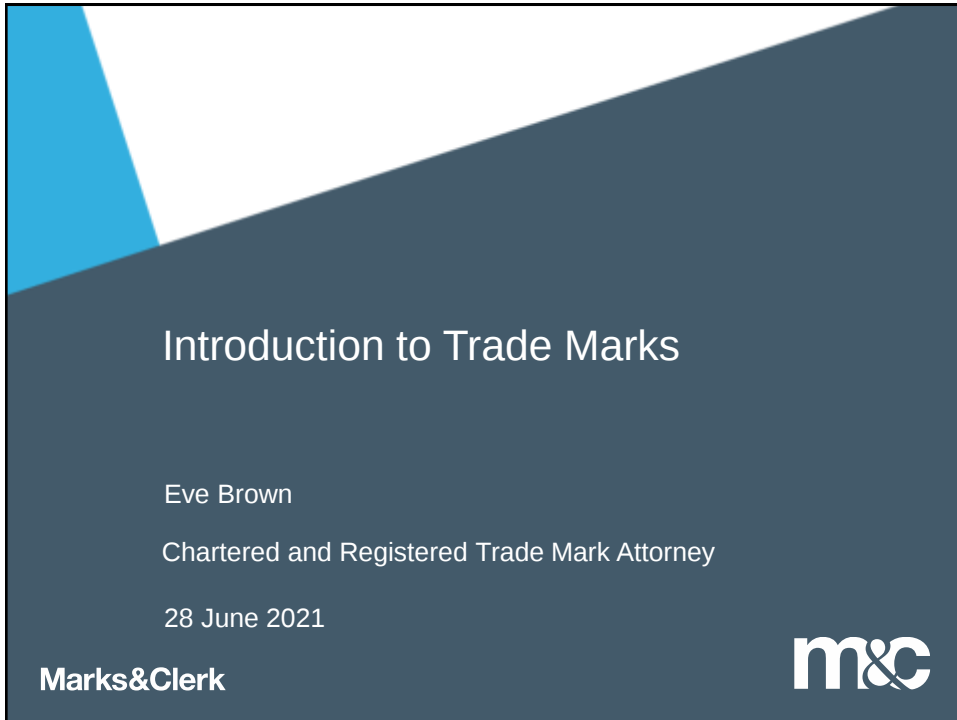




Introduction to Trade Marks

Eve Brown

Chartered and Registered Trade Mark Attorney

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Marks&Clerk



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Overview

- What a trade mark is
- The process for applying for a UK trade mark
- The requirements for registration in the UK
- Priority claims
- Duration of trade marks

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What is a Trade Mark?



- A "badge of origin"
- Anything used in relation to a product or service which communicates their commercial origin to customers
- Registered or unregistered
- A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging
 - ✓ Words
 - ✓ Slogans
 - ✓ Logos
 - ✓ Sounds
 - ✓ Colours
 - ✓ Shapes
- Definition of a Trade Mark under UK law

(1) In this Act "trade mark" means any sign which is capable—

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

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What is a registered trade mark?

- Definition of Registered UK Trade Marks

"A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act." (s. 2 of the Trade Marks Act 1994)
- Territorial - a registration in one country or region does **not** automatically give owner rights in another
- Once registered protection can be renewed **indefinitely!**
- A "monopoly right" granted by a government authority – in the UK this is the UKIPO it allows the owner to prevent use of identical or similar trade marks in relation to identical or similar goods covered by the scope of the right – for famous marks scope of protection can be broader

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Your trade mark protects you against use and registration of:

- Identical sign in relation to identical goods/services
- Identical sign in relation to similar goods/services and there is a likelihood of confusion
- Similar sign in relation to similar goods/services and there is a likelihood of confusion
- Identical or similar sign used in relation to dissimilar goods/services where the earlier mark has a reputation in the UK which is unfairly taken advantage of or is detrimental to the distinctive character of the mark

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In relation to particular goods and services

- UKTM no. 900751933 POLO covering, among others, 'vehicles' in class 12 owned by Volkswagen
- UKTM no. 478997 POLO covering, 'confectionary' in class 12 owned by Société des Produits Nestlé S.A.
- UKTM no. 1431976 POLO and owned by the Polo/Lauren Company, L.P. covering (broadly speaking) 'clothing' in class 25




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Examples of trade mark registrations



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Costs for filing a Trade Mark Application

- UK
- Paper filing
- £200 (includes one Class)
- + £50 for each additional Class

EUTM

- Online filing
- £170 (includes one Class)
- + £50 for each additional Class

Online filing
 €850 (includes one Class)
 + €50 for second class
 + €150 for each class after that

- Protection in UK only

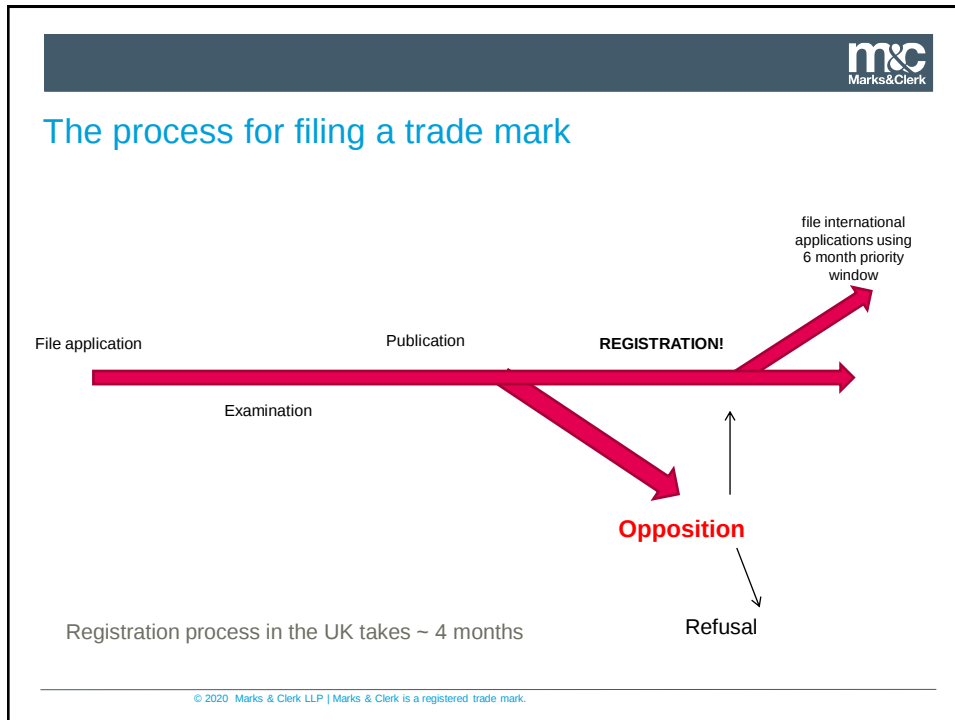


Protection EU27 (not the UK)



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The diagram illustrates the process for filing a trade mark. It begins with 'File application', followed by 'Examination'. After 'Publication', the process reaches 'REGISTRATION!'. From 'REGISTRATION!', an arrow points to 'file international applications using 6 month priority window'. A downward arrow from the 'REGISTRATION!' stage leads to 'Opposition', which then leads to 'Refusal'. A horizontal arrow spans from 'File application' to 'REGISTRATION!', with 'Examination' and 'Publication' labeled along its path. Below the diagram, it states 'Registration process in the UK takes ~ 4 months'.

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Examination: What cannot be registered?

- Contrary to public policy (e.g. BIN LADEN)
- Deceptive signs (e.g. FILLET-O-FISH)
- Descriptive signs (e.g. SOAP for 'soap' cl. 3)
- No distinctive character (e.g. THE CHEESE FACTORY for cheese)

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Publication

- Application is published for a period of two months (extendable by one month where a third party files a form TM7A – Notice of Threatened Opposition)
- If no objections are received during the publication period, the mark will be registered for a period of 10 years from the date of filing. Registration is renewed for as long as the Proprietor wants the mark.

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Filing Date



- The date that an application for trade mark registration is received, assuming all the necessary documentation is there (see s.33 of the Trade Marks Act 1994)
- The filing date is a trade mark owner's 'flag in the sand'
- *Inter alia*, the filing date may determine:
 - ✓ Whether or not a trade mark infringes, or is infringed by, another trade mark
 - ✓ Whether or not an owner can "claim priority" (priority claims are limited by time)

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Claiming Priority

Trade Marks Act 1994

s.35 Claim to priority of Convention application

Allows you to get an earlier filing date than would otherwise be achieved

- (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a "Convention application"), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.
- (2) If the application for registration under this Act is made within that six-month period—
 - (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of **filing of the first Convention application**, and;
 - (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

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Withdrawal, Restriction or Amendment of a Trade Mark Application: UK

Trade Marks Act 1994

s.39 Withdrawal, restriction or amendment of application.

- (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

- (2) In other respects, an application may be amended, at the request of the applicant, only by correcting

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

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Duration of a Trade Mark Registration and Renewal: UK

Trade Marks Act 1994

s.43 - Renewal of registration

- 10 years from date of filing - may be renewed every 10 years ad infinitum.
- Must be renewed on the tenth anniversary of the filing date, not registration date.

e.g. a trade mark filed on 10 January 2005 and registered on 15 June 2005 will be due for renewal on 10 January 2015.

- Possible to file a renewal request up to six months in advance of the renewal date.
- A six month grace period also allows trade marks to be renewed up to six months after the renewal date – subject to payment of an additional late payment fee (s. 43(3) Trade Marks Act 1994).

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- Any questions?

Contact details:

Eve Brown

E: Ebrown@marks-clerk.com

T: +44 20 7420 0000

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