

An Introduction to Trade Marks

Marks & Clerk LLP

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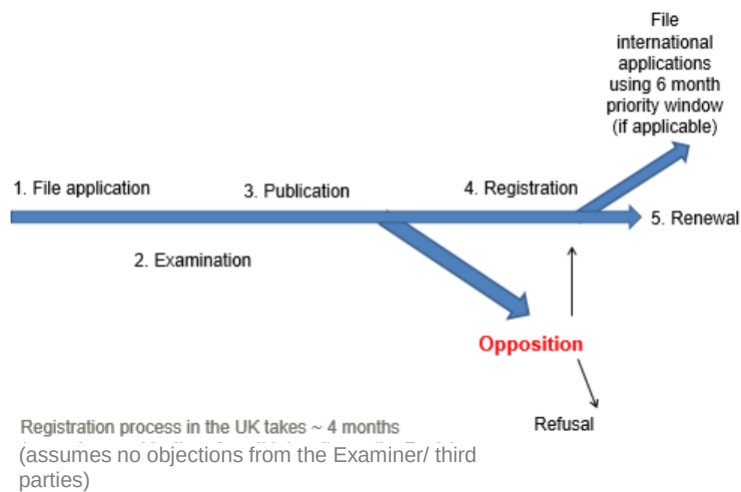
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Overview

UK Trade Mark Life Cycle



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What is a trade mark?



- Registered and unregistered trade marks
- Registered UK trade mark defined as:
“a property right obtained by the registration of the trade mark”
 (s. 2 Trade Marks Act 1994)

Registered Trade Mark	Unregistered Trade Mark
	

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Why have registered trade marks?

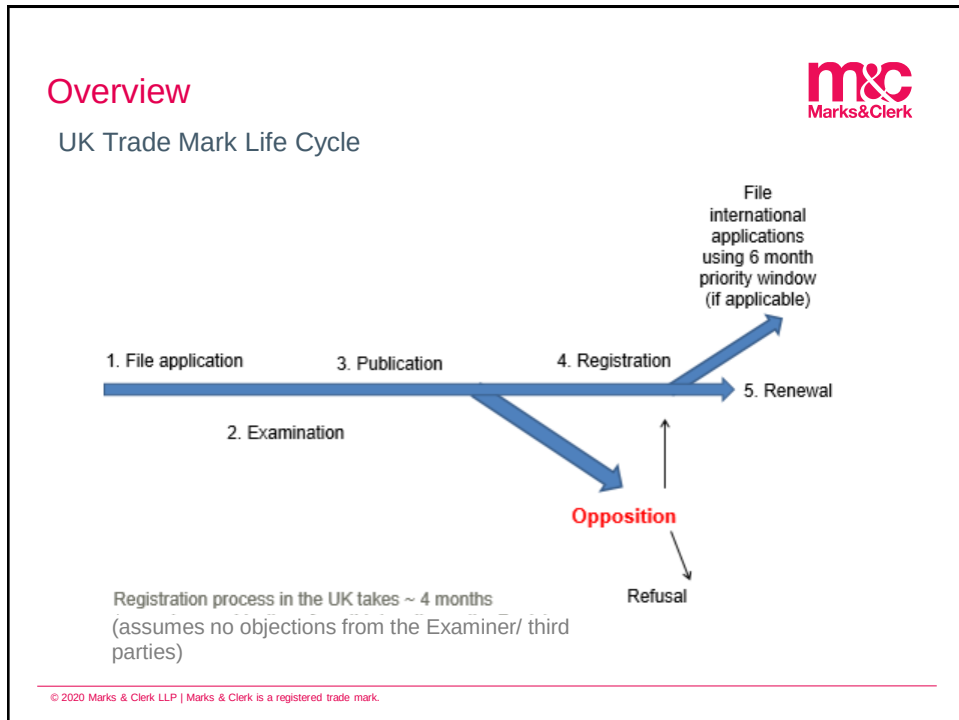


Trade Mark	Estimated Trade Mark value in 2011
GOOGLE	\$44.3 billion
MICROSOFT	\$42.8 billion
IBM	\$36.2 billion
VODAFONE	\$30.7 billion
GE	\$30.5 billion
APPLE	\$29.5 billion

Source: <https://www.forbes.com/sites/seanstonefield/2011/06/15/the-10-most-valuable-trademarks/?sh=6af3561b36b8>

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Trade Mark Filing Process



Intellectual
Property
Office

Form TM3

Application to register a trade mark

**Fee £200 [Includes one class of goods or services]
£50 [for each additional class]**

Use this form to file your application to register a trade mark.
Do not use this form if you wish to pay a reduced fee, you can **save £30** by filing your application online.

††NOTE: The details indicated with †† will be published on our website shortly after receipt and may appear in external search engine results. You should provide a business or PO Box Address if you do not want your home address published.

Failure to reply to the examination report within the time allowed may result in the application being withdrawn/refused.

1. †† Full name
Proposed owner.

Owner type

Specify whether Person, Registered Company/LLP,
Partnership, Trust or Other.

Source: https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/1020488/tm3.pdf

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Trade Mark Filing Process



Who can own a trade mark?

- Registered trade marks (and applications for registration of a trade mark) are personal property (see ss. 22 and 27 TMA 1994)
- The Applicant must be either a natural person (an individual) or a legal person (law speak for an entity capable of owning property in their own name). Examples of legal persons are:
 - Companies
 - Trustees
 - Registered Charities
 - Partnerships (includes LLPs, partnerships by agreement and partnerships at will)
 - if the applicant/owner is a partnership at will – must list all partners as, in the absence of an agreement, the legal personality of the proprietor will change with the departure/addition of a partner

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Trade Mark Filing Process



What is the type of trade mark being applied for?

3. Trade mark type

99% of applications are Trade Marks.
 Certification Marks – indicate that goods or services meet a defined quality standard.
 Collective – indicate the goods or services of a member of a trade association.

Trade Mark
Certification Mark
Collective Mark

- Trade Mark = a sign used to indicate the origin of the goods/services of a particular undertaking
- Certification Mark = a sign used to indicate that the goods or services meet a defined quality standard
- Collective Mark = a sign that indicates the goods or services of a member of a trade association



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Trade Mark Filing Process



Definition of a UK trade mark

- Any sign which is capable of:
 - (a) Being represented on 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
 - (a) of distinguishing goods or services of one undertaking from those of other undertakings.

s.1(1) of the Trade Marks Act 1994

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Trade Mark Filing Process



Examples of trade marks

- Words (including personal names)
- Logos
- Letters
- Numerals
- Colours
- Sounds
- Shape of goods
- Packaging

Not an closed list!

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Trade Mark Filing Process



What is the type of trade mark being applied for?

4. Number of trade marks in series

Enter number only if applying for a series of trade marks (Max. 6 trade marks).

NOTE: 'Series' is a number of marks with very small differences e.g. 'danryvol', 'DANRYVOL', 'Danryvol'.

££ More than 2 marks are subject to an additional fee of £50 per mark.

- Series = a number of trade marks which resemble each other as to their material particulars and differ only as a matter of non-distinctive character which would not affect the identity of the trade mark
- Maximum of 6 marks
- Must look the same, sound the same, mean the same

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Trade Mark Filing Process



List of Goods/Services

6. Trade mark classification

You need to tell us which goods and services you are going to use your trade mark for. Goods and Services are classified in an internationally agreed list of classes.

For information on how we classify: visit www.ipo.gov.uk/types/tm/t-applying/t-class.htm

You must tell us which class your goods and services belong in e.g. Class 25, Clothes. You can search and classify goods and services using the classification search tool 'TMCLASS'. Visit <http://oami.europa.eu/ec2/>

££ Applications with more than one class of goods or services are subject to an additional fee of £50 for each additional class – use continuation sheet if necessary.

Class Number	List of goods and services

- **Nice Classification:**
https://www.wipo.int/classifications/nice/nclpub/en/fr/?explanatory_notes=show&lang=en&menulang=en¬ion=class_headings&version=20220101

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Trade Mark Filing Process



List of Goods/Services

UKTM no. 900751933 POLO covering, among others, 'vehicles' in class 12 owned by Volkswagen



UKTM no. 478997 POLO covering, 'confectionary' in class 30 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



- **Nice Classification:**
https://www.wipo.int/classifications/nice/nclpub/en/fr/?explanatory_notes=show&lang=en&menulang=en¬ion=class_headings&version=20220101

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Trade Mark Filing Process



Priority claims

11. Priority claim (Optional)

If you have applied for this trade mark outside the UK in the last six months, you can claim priority by entering the details here.

Priority Claim Country

Application/
Registration Number

Priority Claim Date

Priority claim type

You must tick only one of the priority claim type options.

For All Goods and Services

☐

For Some of the Goods and Services

☐

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

S.35 of the Trade Marks Act 1994

- (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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Trade Mark Filing Process



Bona Fide Intention to Use

13. Declaration

Warning! You cannot make any changes to the trade mark(s) applied for or add more goods or services to your application once it has been submitted. The application fee is non-refundable (even if the application is not acceptable).

I confirm that:

The applicant is entitled to hold property.

The terms used to describe the goods and/or services listed in this application should be given their ordinary and natural meaning.

The trade mark is being used by the applicant, or with his or her consent, in relation to the goods or services shown, or there is a bona fide intention that it will be used in this way.

I understand and accept that I cannot make any changes to the trade mark(s) applied for or add more goods or services once the application is submitted. I also accept that any application fees paid are non-refundable (even if the application is not acceptable).

Signature

Name

(BLOCK CAPITALS)

Date

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2. Examination

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Trade Mark Examination Process

Trade Mark Checklist

A trade mark must be the following to get through the examination process (not an exhaustive list!):

- ✓ Capable of being represented in a clear and precise manner that enables the relevant public to determine what is protected
- ✓ Distinctive
- ✓ Not exclusively indicate the kind, quality, intended purpose, value, geographical origin, quality, intended purpose, value, geographical origin, the time of production of goods or of the rendering of services, or other characteristics of goods/services
- ✓ Not exclusively be a term that has become customary in the trade
- ✓ Not contrary to public policy

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Trade Mark Examination Process



Representation Objection: Case Example

Ralf Sieckmann v Deutsches Patent-und Markenamt, C-273/00

- Facts: Mr Sieckmann applied for a German national trade mark for a smell mark in relation to, among others, 'advertising' in class 35. The description included the following:
 - "the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester)"
 - The chemical formula: $C_6H_5-CH=CHCOOCH_3$
 - A list of the laboratories that a sample can be obtained from
 - A written description of the scent: balsamically fruity with a slight hint of cinnamon

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Trade Mark Examination Process



Representation Objection: Case Example

Ralf Sieckmann v Deutsches Patent-und Markenamt, C-273/00

- Decision: the representation requirement was not met for a smell mark where the representation consisted of a chemical formula, a description in written words, a deposit of the odour sample or by a combination of these elements.
- Reasons:
 - Chemical formula: represents the substance, not the odour (it is graphic but it is not a representation of the mark); not sufficiently intelligible
 - Written description: representation is graphic but not sufficiently clear and precise. It is subjective.
 - Odour sample: not sufficiently durable

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Trade Mark Examination Process



Non-distinctiveness objection

Rewe Zentral v OHIM, Case T-79/00

- Facts: trade mark application for the word 'LITE' for, among others, 'edible oils and fats' in cl. 29
- Legal test: does the sign ('LITE') enable the section of the public targeted to distinguish the goods and services at issue from goods and services of a different commercial origin?
- Underlying public policy goal: to enable consumers to identify the origin of the goods so as to repeat or avoid previous purchases (essential function of a trade mark)

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Trade Mark Examination Process



Non-distinctiveness objection

Rewe Zentral v OHIM, Case T-79/00

- Decision: trade mark rejected under s.3(1)(b) of the Trade Marks Act 1994 on the basis that it is devoid of any distinctive character
- Reasons:
 - Assessment of the distinctive character of the mark is in relation to the goods/services applied for (i.e. foodstuffs)
 - Assessment to be carried out from the perspective of the average consumer, who is reasonably well-informed, observant and circumspect. The relevant public in this case is the public at large.
 - 'LITE' corresponds phonetically to the English word 'light', a general name for foodstuffs whose undesirable ingredients have been partially removed to appeal to health conscious consumers. It is commonly used in the trade to designate the quality of the goods applied for (descriptive) and will therefore not enable the public concerned to distinguish the goods from those of another undertaking.

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Trade Mark Examination Process



Descriptiveness objection



OHIM v Wm. Wrigley Jr. Co., Case C-191/01 P

- Facts: Wrigley sought to protect the word 'DOUBLEMINT' as an EU-wide trade mark for, among others, 'chewing gum' (cl.30).
- Application initially refused by the EUIPO because it described certain characteristics of the goods, namely their mint-based composition and flavour, therefore could not be registered.
- Wrigley appealed the decision. The Court of First Instance held 'double' could take on various meanings ('much', 'strong', 'extra', 'best' or 'finest') as such the sign as a whole was sufficiently vague to be eligible for protection.
- The EUIPO appealed to the CJEU who held that a sign must therefore be refused registration on the basis that it is descriptive if at least one of its possible meanings designates a characteristic of the goods or services concerned.

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Trade Mark Examination Process



Customary in the trade objection



- Trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade
- E.g. SELLOTAPE - still a UK registered trade mark for, among others, 'adhesive tape' (cl.17) but is considered to have become generic (link to UKTM details here: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00000686626>)
- E.g. ESCALATOR – once a registered US trade mark that was used as the brand name of a moving stairway sold by Otis Elevator Co. The general public came to regard the name as descriptive for a moving stairway and not as designating one brand alone (see *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (1950))

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Trade Mark Examination Process



Contrary to public policy or accepted principles of morality
objection

- Legal test: Whether use of the mark would justifiably cause outrage. Mere offence is not enough.

Scranage's UK Trade Mark Application (0/182/05) Appointed Person

- - Facts: 'FOOK' for 'clothing', 'footwear' and 'headgear' in class 25
 - decision: refused under s.3(3)(a) TMA 1994 because contrary to public policy & morality
 - Reason: misspelling of swear word that is deeply offensive. Could be used in contexts where children may be exposed to them.
- In contrast, 'FCUK' for clothing did not contravene s.3(3)(a) TMA 1994. FCUK was found to not be phonetically or visually similar to swear word (see
- FCUK Trade Mark, App Person, (Richard Arnold Q.C.) [2007] R.P.C. 1)

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3. Publication

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Trade Mark Publication Process



- 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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4. Opposition

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Trade Mark Opposition



Main Grounds of Opposition

Double identity

- Identical sign in relation to identical goods/services (s. 5(1) Trade Marks Act 1994) – *see LTJ Diffusion SA v Sadas Vertbaudet SA. (C-291/00)*

Likelihood of confusion

- Identical sign in relation to similar goods/services and there is a likelihood of confusion (s.5(2)(a) Trade Marks Act 1994)
- Similar sign in relation to similar goods/services and there is a likelihood of confusion (s.5(2)(b) Trade Marks Act 1994) – *see SABEL BV v Puma AG, Rudolf Dassler Sport (C-251/95)*

Reputation

- 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 (s.5(3) Trade Marks Act 1994) – *see Intel Corporation Inc. v CPM United Kingdom Ltd. (C-252/07)*

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5. Registration

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Trade Mark Registration



- Protected for 10 years from the date of filing and can be renewed indefinitely
- Possible for a trade mark to be cancelled post-filing either through a revocation action (e.g. it has not been used for a continuous period of 5 years) or through invalidity proceedings (the trade mark should never have been registered as it does not meet the absolute or relative grounds requirements discussed earlier)
- It is not possible for a third party to challenge the trade mark on the basis of a non-use revocation action where the trade mark has been registered for less than 5 years (time period runs from the registration date)

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5. Renewal

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Trade Mark Renewal



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 deadline. It is possible to 'restore' a trade mark up to twelve months after the renewal deadline provided that certain requirements are met.
- renewal date – subject to payment of an additional late payment fee (s. 43(3) Trade Marks Act 1994).

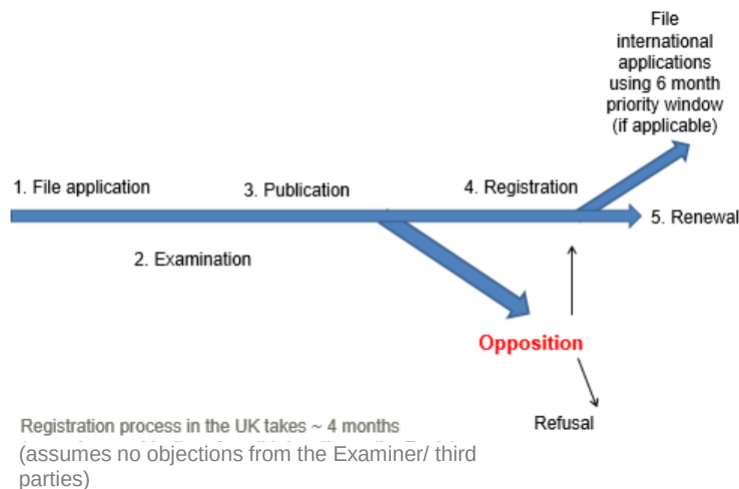
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Recap: Overview

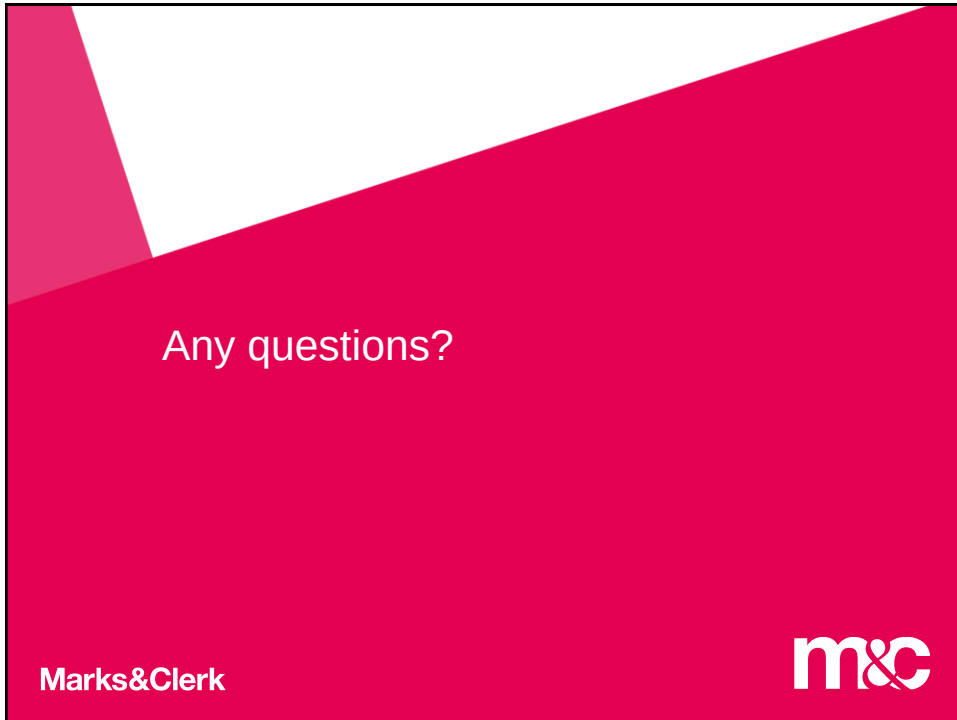


UK Trade Mark Life Cycle



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