

Appleyard Lees[®]

Rachel Garrod | Senior Associate

Rachel.Garrod@appleyardlees.com



An Introduction to Trade Marks

Rachel Garrod, Senior Associate, Appleyard Lees IP LLP

13 June 2023

Innovation | Branding | Strategy | Solutions

1

Trade Mark Basics

Appleyard Lees[®]

Innovation | Branding | Strategy | Solutions

2



What is a trade mark?

- A “Trade Mark” is a sign used in the course of trade which helps to distinguish the products / services of one business from the products / services of another business. Section 1(1) TMA 1994 provides the full definition.
- Trade Marks can include the following:
 - A word / string of words / stylised words
 - Logos
 - Shapes
 - Sounds
 - Colours
 - Smells
 - Holograms
 - Musical notations



What is a trade mark?

- Brand lifecycle... search, register, watch, renew
- Trade Mark protection can last indefinitely
- Trade Mark rights can be either registered or unregistered...registered rights are usually much easier and cheaper to enforce
- You can use the ® symbol next to registered trade marks. Use the ™ symbol next to unregistered trade marks.
- Trade mark rights are intangible assets – they can be sold, licensed etc.



What is a trade mark?

- Trade Mark rights are territorial. Trade Mark protection can be obtained throughout the world including the UK, EU, International via Madrid System and Foreign Nationals
- Relevant Laws:
 - UK – Trade Marks Act (TMA) 1994
<https://www.gov.uk/government/publications/trade-marks-act-1994>
 - EU – European Union Trade Mark Regulation (EUTMR) 2017/1001
<https://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1506417891296&uri=CELEX:32017R1001>
 - WIPO – Madrid Agreement / Madrid Protocol
https://www.wipo.int/treaties/en/registration/madrid_protocol/

UK Trade Mark Rights



Unregistered Rights

- You can obtain unregistered trade mark rights in the UK simply by using a trade mark
- A trade mark application can be refused by virtue of Section 5(4)(a) TMA 1994 - Passing-off
- Unregistered rights are usually more difficult and costly to enforce



Registered Rights

- Trade Mark Applications are filed at the UKIPO using a Form TM3 - https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/1151984/TM3.pdf
- Once an application has been filed, it is examined by the Trade Mark Examiner. If objections are raised, the Applicant will have two months in which to overcome such objections. If no objections are raised, the application will proceed to publication
- Publication – 2 month opposition period
- Registration – Provided no oppositions are filed, the application will proceed to registration
- Registration usually takes 3-4 months from the date of filing provided no issues with the application



Who can file Applications?

- The Applicant must either be a natural person (i.e. an individual) or a legal person (i.e. an entity capable of owning property in their own right).
- Examples of legal persons are:
 - Companies
 - Trustees
 - Registered Charities
 - Partnerships (including LLPs)



Series of Marks

- In the UK, you can file up to 6 trade marks in one application as a “series” application
- For a series to be acceptable, the marks should:
 - look the same
 - sound the same
 - mean the same
- Any differences between the trade marks must be minor
- The UKIPO provides guidance on marks which will be acceptable as a series <https://www.gov.uk/guidance/trade-mark-series-applications>



Classes

- A trade mark is applied for and registered in relation to categories of goods and services, these categories being called “Classes”
- When you file a trade mark application, you need to specify which goods and services you are going to use your trade mark for
- There are 45 Classes – Classes 1-34 cover goods and Classes 35-45 cover services
- You can use an online tool to determine which Classes your goods / services fall into - <https://euipo.europa.eu/ec2/>



Priority

- Within 6 months of filing a trade mark application, you can file further applications and back date them to have the same filing date as the original application – this is known as “claiming priority”
- Section 35 TMA 1994 states the following:
 - (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.



Declaration

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

This can be typed or handwritten

Name

(BLOCK CAPITALS)

Date

Number of sheets attached to this form



Examination – Section 3 TMA 1994

- A trade mark application can be refused by a Trade Mark Examiner on absolute grounds under Section 3 TMA 1994
- For a trade mark to be registrable it must meet the following criteria:
 - Capable of being represented in a clear and precise manner that enables the relevant public to determine what is protected
 - Distinctive enough for registration
 - Not descriptive
 - Not exclusively be a term that has become customary in the trade
 - Not contrary to public policy
- A trade mark application can also be refused if the application is found to have been made in “bad faith”



Relative Grounds – Section 5 TMA 1994

- A trade mark application can be refused by on relative grounds under Section 5 TMA 1994.
- The main grounds for Opposition are:
 - Double identity
Identical sign in relation to identical goods/services (Section 5(1) TMA1994)
 - Likelihood of confusion
Identical sign in relation to similar goods/services and there is a likelihood of confusion (Section 5(2)(a) TMA1994)
Similar sign in relation to similar goods/services and there is a likelihood of confusion (Section 5(2)(b)1994)
 - 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 (Section 5(3) TMA 1994)



Trade Mark Infringement – Section 10 TMA 1994

- Section 10 TMA 1994
- The main grounds for Infringement are:
 - Double identity
Identical sign in relation to identical goods/services (Section 10(1) TMA1994)
 - Likelihood of confusion
Identical sign in relation to similar goods/services and there is a likelihood of confusion (Section 10(2)(a) TMA1994)
Similar sign in relation to similar goods/services and there is a likelihood of confusion (Section 10(2)(b)1994) –
 - 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 (Section 10(3) TMA 1994)



Registration

- Once a trade mark has proceeded to registration, it is protected for 10 years from the date of filing and can be renewed indefinitely by payment of renewal fees every 10 years
- It is possible for a trade mark registration to be cancelled 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 ground requirements discussed earlier)
- A third party cannot challenge a trade mark registration on the basis of non-use where the trade mark has been registered for less than 5 years. This 5-year period runs from the date of registration



Renewal

- Section 43 TMA 1994 covers renewal of a trade mark registration
- Renewal fees must be paid 10 years from the date of filing – not the registration date
- It is possible to file a renewal request up to six months in advance of the renewal date
- There is also a six month grace period whereby trade marks can be renewed up to six months after the renewal date has passed. It is possible to “restore” a trade mark up to twelve months after the renewal deadline has passed provided certain requirements are met. This is not an easy hurdle to overcome!

EU Trade Mark Rights



Registered Rights

- Trade Mark Applications are filed at the EUIPO and cover all 27 countries in the EU
- Once the Application has been filed it is searched and examined by the Trade Mark Examiner. If objections are raised, the Applicant will have two months in which to overcome such objections. If no objections are raised, the application will proceed to publication
- Publication – 3 month opposition period
- Registration – Provided no oppositions filed, the application will proceed to registration
- Registration usually takes 5-6 months provided no issues
- Registrations last for 10 years when the renewal fee will become payable
- An EU representative must be appointed at the EUIPO

Madrid Trade Mark Rights

21



Registered Rights

- Trade Mark Applications are filed at WIPO (via the “home” office) and designate individual territories. These territories must be members of the Madrid System
- The Madrid application is examined by WIPO to make sure it meets formal requirements and, provided it does, it will then be registered at WIPO
- Once registered at WIPO, it will be examined in each of the designated territories
- Once approved in the designated territory, it will then receive a separate Statement of Grant for that territory

22



Registered Rights

- Madrid registrations have exactly the same effect as national trade mark registrations
- Renewal fees must be paid every 10 years – this is done centrally at WIPO
- Madrid applications can be a very cost-effective route to obtaining trade mark protection in several countries of interest via a single International application
- It is possible to add further countries to an existing International Madrid registration (subsequent designations)

Foreign National Trade Mark Rights



Registered Rights

- All countries have their own trade mark registration systems
- Thus, one option is to file national trade mark applications in each country of interest
- It is beneficial to use multi-country systems where available (e.g. European Union, Africa)
- It is also beneficial to use re-registration systems where available (e.g. Channel Islands, Caribbean (parts of))
- Foreign Attorneys are appointed to assist with filing applications in foreign territories. Each country varies in their requirements and the foreign attorney will advise accordingly

Useful Links



Useful Links

- UKIPO – <https://www.gov.uk/topic/intellectual-property/trade-marks>
<https://www.gov.uk/government/publications/manual-of-trade-marks-practice>
- EUIPO – <https://euipo.europa.eu/ohimportal/en/web/guest/home>
<https://guidelines.euipo.europa.eu/2058843/2199801/trade-mark-guidelines/1-introduction>
- WIPO - <https://www.wipo.int/portal/en/index.html>

Any Questions?



Manchester

The Lexicon
Mount Street
Manchester, M2 5NT
United Kingdom

T: +44 (0)161 835 9655
F: +44 (0)161 835 9654

Leeds

1 East Parade
Leeds, LS1 2AD
United Kingdom

T: +44 (0)113 246 5353
F: +44 (0)113 246 5472

Halifax

15 Clare Road
Halifax, HX1 2HY
United Kingdom

T: +44 (0)1422 330 110
F: +44 (0)1422 330 090

Cambridge

Godwin House
Castle Park
Cambridge, CB3 0RA
United Kingdom

T: +44 (0)1223 675 283
F: +44 (0)1223 675 288

BioHub at
Alderley Park

Mereside
Alderley Park
Alderley Edge, SK10 4TG
United Kingdom

T: +44 (0)1625 881 089
F: +44 (0)1625 881 117

Appleyard Lees[®]