

UK Trade Mark Process: A simplified overview




Mancunium IP

For a trade mark to be registrable, it must be *a sign capable of being represented graphically, which can distinguish the goods and services of one undertaking from those of another undertaking*. This means that the range of things that can be registered as trade marks is quite broad and includes words, colours, shapes, sounds and even scents, although these are quite rare.

However, before filing a trade mark, it is usually recommended to request a *trade mark search*, prior to developing a product idea or even affixing labels bearing your proposed mark, logo or symbol. This is because the results of the search could reveal whether the proposed trade mark is already registered by someone else for identical or similar goods or services in the jurisdiction (UK, Europe, US, etc) in which you wish to protect that trade mark. In addition it could have significant costs savings which would otherwise be incurred through re-branding or litigation if it later transpires that a proposed mark was already in use by someone else (unregistered common law user) for similar or identical goods or services.

At Mancunium IP, we use various databases covering the UK, US, Europe and other jurisdictions to conduct our trade mark searches and our fees begin at **£130**. In addition, we also conduct a registrability assessment to ensure your mark is registrable. Note that our search is not mandatory and we can file a mark without undertaking a search if a client wishes to do so or if they have conducted their own trade mark search.

If the search reveals no potential obstacles or dangerously similar marks in the class you choose to operate in, the next stage would usually be to draft a *goods and services specification* which will list in more detail the various goods /services the trade mark will be used for. Once a client approves of this, and on their instruction, we proceed and file the trade mark application with the UK Intellectual Property Office (UK IPO) or OHIM (The Community Trade Marks Office).

For UK trade marks, our cost for preparation and filing begin at **£450** (**£200** official fees payable at the UK Intellectual Property Office in respect of one class, and **£250** our professional service charge for one class). We have a **£75** fee for each additional class after 2 classes, but if you are filing more than a single mark, we will provide you with a cost effective quote covering all the marks in a single discounted price.

Once an application is filed, the UK IPO will conduct a search and examine your application, producing an examination report citing any trade marks they consider to be similar(or identical) to your trade mark for your goods / services. If your proposed mark is confusingly similar to another UK trade mark or community trade mark, the UK IPO may inform the owners of these marks, who may raise an opposition to your trade marks registration. Using written arguments, we will respond to the citations / arguments raised by the UK IPO, and if they are convinced of our responses, your mark will be published in their Official journal for third parties to make observations. After a period of about 2 months, and if no

third parties oppose your mark, it will be registered and you will get a registration Certificate. A registered trade mark is valid for an initial 10 years and renewable indefinitely every 10 years. Typical time periods of the whole registration process are around 4-6 months, although it can take longer if there are many objections to your mark.

If instead of a UK registration, you want a Community Trade Mark (CTM) which is valid in the whole EEA, the process is also similar, although we would have to file at OHIM, the office responsible to administering the registration for community trade marks. The advantage of a Community Trade mark is that your mark will be protected in the whole European Community. It is also possible to file an International trade mark using the World Intellectual Property Organization's Madrid system. Again, like the CTM, it is slightly more expensive and cost savings are only realised if you will be trading in the whole European Economic Area (or Internationally).

Although this is a simplistic description of the procedures involved, we hope this information will be useful, and shed some light to the overall process of registration. However if you would like further information on any matters discussed here please do not hesitate to contact us.

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