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*Disclaimer: This online publication describes the law in general terms. It is not intended to provide legal advice on specific situations and should not be relied upon as a source of legal advice. This publication is aimed to help small start-up businesses and entrepreneurs specifically.*

Date produced: 01.05.2020

## **qLegal Online Publication**

### **Protect Your Brand! Trade Marks Explained: Part 2 – Registered Trade Marks**

This publication is Part 2 of a series on trade marks. When read together, the series gives the reader a succinct yet clear understanding of trade marks from a business perspective. It is advisable to read *Part 1 – Introducing Trade Marks* before reading this publication.

#### **1. Application for/registration of trade marks**

##### **a. Geographical Scope**

If you want to protect your brand in the UK using a registered trade mark, you have to apply for, and successfully pass, a registration process at the UK Intellectual Property Office (“**UK IPO**”). Every jurisdiction has its own trade mark law and its own authorities dealing with this process, so you need to register the mark in every jurisdiction where you want to protect it.

However, if you want to register a mark in many European Union (“**EU**”) countries, you could also apply for an EU trade mark which then protects your mark across all countries of the EU. This will save you time, money and paperwork.

If you want to protect a mark in non-European countries, you could also apply for a trade mark in multiple countries by international registration under the Madrid System, on the condition that you already have a registered trade mark in one of the countries that are part of the Madrid System or an EU trade mark. This system allows you to seek protection in various countries while filing one single application at the World Intellectual Property Office (“**WIPO**”). Every application will then be independent from the others and will follow the rules of each specific country.



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## **b. Classification of Goods and Services**

When you apply to register a trade mark, you have to specify which type of trade mark you want to register and select which goods and/or services interest your business, by choosing descriptions of goods and services included in the Nice Classification (which is an internationally accepted classification). There are 45 classes in total (classes 1 to 34 concern goods; classes 35 to 45 concern services).

Filing an application in every class is expensive (currently, in April 2020, the fee for every additional class is £50) and your list of goods/services should not be too broad and should not include goods/services that you do not consider being part of your business. If your mark is not used for a specific good/service during a period of five years from the date of registration, your mark might be revoked for that specific good/service.

However, you do need to plan ahead and think about the possible areas of expansion of your business in the near future because you cannot add further good/services once you have applied for a trade mark (the fees are also non-refundable). If the application does not cover an important aspect of your business, you would need to file and pay for a new application.

## **2. Grounds to refuse a trade mark registration**

### **a. Absolute grounds**

The registration of a trade mark might be refused because of the absolute grounds for refusal set out in the Trade Mark Act 1994, which define a trade mark as (i) a sign (ii) capable of being represented and (iii) capable of distinguishing goods and services of a business from those of other businesses (this means that a mark has to function as a badge of origin).

If a mark does not fulfil these conditions, registration cannot be granted. Other requirements which a trade mark must meet before it can be registered include:

- Trade marks must not be customary in the course of a business, but they should be distinctive in connection to the goods and services listed in the application and to the way consumers perceive the mark;

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- It is worth noting that a mark might describe the goods or services for which registration is sought, but it might still be considered distinctive if, due to its use in commerce, consumers have started to identify that sign with the relevant goods or services over a period of time (i.e. 'secondary meaning'). For example, the descriptive sign "Holiday Inn" referred to hospitality services has acquired distinctive meaning after being used for many years in the marketplace;
- Trade marks must be sufficiently clear and precise, regardless of their means of representation. For example, the Scrabble playing tile was not considered a sign since the description and the graphical representation were not clear enough to identify one specific sign;
- Trade marks should not be deceptive or contrary to public policy or morality. For example, applications to register 'Jesus' for various classes or offensive words were not accepted.

### b. Relative grounds

A trade mark application can also be rejected on the basis of relative grounds for refusal when it conflicts with an earlier (registered or used) trade mark. A trade mark cannot be registered if it is identical or similar to a mark previously registered for identical or similar goods/services. The aim is to prevent registration for marks that are already registered by others so that earlier marks do not lose their protection and keep functioning as an indication of the origin of goods/services.

Owners of prior registered trade marks or holders of unregistered trade marks (see Part 3 of this series about unregistered trade marks) can prevent registration of identical or confusingly similar trade marks, in order to protect their monopoly. It is therefore crucial that applicants research which signs are used by other businesses in connection to similar goods or services.



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### 3. The application process at the UK IPO

#### a. Method of application

Businesses can file a UK trade mark application with the UK IPO online<sup>1</sup> or by post<sup>2</sup>. As an indication only, currently (April 2020) the online filing fee is £170 (£200 by post) in one class, plus £50 per each additional class.

In order to provide further assistance for non-professional applicants, the UK IPO offers the 'Right Start' service<sup>3</sup>.

#### b. Examination

Once the application is filed, the UK IPO will issue an Examination Report giving you feedback on your application, usually within 15 days.

The UK IPO will examine your application according to the absolute grounds for refusal and will check whether the specifications are appropriate. If the application does not comply with those grounds, the UK IPO will raise objections. You then have two months to respond and overcome the objections. Depending on the type of objection raised, you can contact the examiner and may want to adopt the following strategies:

- If the mark is considered to be descriptive of a part of the specification of goods/services, you can delete, limit or exclude the goods/services.
- If your mark consists of or includes protected words or emblems, you can obtain consent to register it by the relevant responsible body;
- If the mark is considered to be devoid of distinctive character, descriptive or customary in the language, you can provide evidence that the mark has become recognised as a badge of origin on which consumers rely on to identify the origin of

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<sup>1</sup> <https://trademarks.ipo.gov.uk/ipo-apply>

<sup>2</sup>

[https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment\\_data/file/819114/tm3.pdf](https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/819114/tm3.pdf)

<sup>3</sup> <https://www.gov.uk/how-to-register-a-trade-mark/apply>



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the goods/services, by the date of application. This means that the mark has acquired distinctive character;

- If an objection was issued with reference to only parts of goods/services claimed in the application, you can agree to proceed for those goods/services that are acceptable and withdraw the others;
- You can request a hearing if you think your application has been dealt with unfairly or if you disagree with the decision about your application.

The UK IPO will also conduct a search for earlier registered trade marks that might be confusingly similar to your application. This list will be part of the Examination Report and the UK IPO will notify the owners of the earlier trade marks if you decide to proceed with the registration process. You will be able to respond in order to avoid the identified earlier marks' owner being notified.

If there are no objections or objections are waived, the mark will be published in the Trade Mark Journal.

### **c. Opposition**

Publication of the trade mark application in the Trade Mark Journal allows third parties to oppose the application on the basis of absolute grounds and/or their earlier rights (i.e. relative grounds for refusal). A third party (including those not notified) might contact you directly in order to find a solution without legal proceedings, or might file an opposition with the UK IPO. The period of publication lasts two months, but if someone challenges your application via the UK IPO the period is extended by one month.

If someone opposes your application, you can:

- Withdraw the application in writing;
- Contact the party who is opposing your application and try to find an agreement;
- Defend your application and go through the opposition process, which is usually carried out on paper and does not require you to attend a hearing.



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#### **d. Registration**

If no objections and oppositions are raised, the application is normally granted within six to eight months. The trade mark is registered approximately two weeks after the end of the opposition period. If objections and opposition were raised, it will take longer.

When a mark is registered, the UK IPO will issue a certificate stating the details of the registration. The trade mark is added in the register and can be seen by third parties.

A registration lasts ten years from the date of initial filing and it can be renewed indefinitely every ten years by paying the standard fee.

#### **Conclusion**

The benefits of registering a trade mark are numerous but one of the foremost benefits is that it provides the owner with the automatic right to prevent third parties from using a confusingly similar sign. Registration also allows the owner to gain protection for a trade mark prior to their own use of it. The registration process is relatively inexpensive, but it is important to do your research into existing marks which may be confusingly similar to your trade mark to ensure that your registration application has the best chances of success.

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