



A guide to trade marks

Contents

General

What are trade marks and what do they do?	1
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Getting started

The trade mark application process.....	5
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Keeping a trade mark protected

The renewals process.....	9
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The purpose of this guide is to introduce you to the world of trade marks and to provide a basic outline of the key procedures involved. We will provide a brief overview of trade marks, including the trade mark application process and the ongoing protection of your marks.

Please note this guide is for reference purposes only and we recommend that you seek professional legal advice if you are considering filing a trade mark application.

General

What are trade marks and what do they do?

- What is Intellectual Property? 2
- What is a trade mark? 2
- What does a trade mark do? 2
- What are the benefits of registering a trade mark? 2
- Who owns the trade mark? 2
- Why are trade marks beneficial?..... 2
- What protection does registering a trade mark offer? 2
- How long does trade mark registration last?..... 2
- How are trade mark rights enforced? 3
- Are trade marks valid in every country? 3
- Do trade marks have to be registered? 3
- Why should I consider registering my trade mark? 3
- What can and cannot be registered as a trade mark? 3
- What is the difference between a registered and unregistered trade mark? 4
- Can I sell my trade mark? 4
- What is a trade mark license?..... 4



What is Intellectual Property?

Intellectual Property (IP) refers to something unique that has been created by the mind, such as inventions; designs and symbols, and names and images. Intellectual Property rights (IPR) are protected by law and include patents, trademarks, designs and copyright protection.

What is a trade mark?

A trade mark provides protection to the owner of the mark by granting them exclusive rights to use it to identify their goods or services, or to authorize another to use it in return for payment.

What does a trade mark do?

A trade mark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services, or to authorise another to use it in return for payment.

What are the benefits of registering a trade mark?

By registering for trade mark protection, you will be eligible for several benefits, including:

- Damages in some cases of infringement;
- The right to use the Registered (®) symbol with your trademark;
- An easy process to stop others from using your brand name for domains and usernames across social networking sites; and
- Significantly stronger protection than 'common law' marks making it easier to recover your property

Who owns the trade mark?

The person, company or organisation that uses and registers the trade mark owns it. In general the first person, company or organisation to use the trade mark owns it.

Why are trade marks beneficial?

Trade marks promote initiative and enterprise throughout the world, by giving owners recognition and the possibility of financial profit from their marks. Trade mark protection also hinders the efforts of counterfeiters who use similar marks and signs to market inferior products or services.

What protection does registering a trade mark offer?

A trade mark provides protection to the owner of the mark by giving them exclusive rights to the mark to identify their goods or services, or to authorise others to use it in return for payment. The period of protection varies, but a trade mark can be renewed indefinitely.

How long does trade mark registration last?

A trade mark will stay protected for an initial 10 years; you have the option to renew the registration for a further 10 years and continued to do so indefinitely if you chose to do so.

How are trade mark rights enforced?

Registering your trade mark offers protection, however it is the owner's responsibility to ensure that it is enforced. If someone is infringing our trade mark it is advisable to seek legal advice on how to proceed. If you are advised to take legal action, it can be taken to court where a judge will rule on the infringement case.

Are trade marks valid in every country?

A trade mark registration is only protected in the country, or region in which the application has been filed and granted, in accordance with the law of that country. If you want to use your trade mark in countries other than the UK, you can apply to the trade mark office in each country. However, European and international application systems also exist.

Do trade marks have to be registered?

In the UK you can get 'common law' rights just by using the trade mark; the mark does not need to be registered to be recognised. In order to ensure that your trade mark is legally protected and that you can bring legal action for any infringement, it is advised that you apply for a trade mark.

Why should I consider registering my trade mark?

A trade mark protects your brand name and image and allows you to take legal action against anyone who uses it without your permission. It allows you to include the Registered (®) symbol with your brand to show that it's legally yours.

What can and cannot be registered as a trade mark?

A trade mark must be unique and can include:

- Words
- Sounds
- Logos
- Colours
- A combination of any of these

A trade mark cannot:

- Be offensive, e.g. contain swear words
- Describe the goods or services it will relate to, e.g. 'cotton' can't be a trademark for a cotton textile company
- Be misleading
- Be a 3-dimensional shape associated with the trade mark
- Be too common and non-distinctive
- Look too similar to state symbols like flags or hallmarks

What is the difference between a registered and unregistered trade mark?

Trade marks do not necessarily have to be registered with the UK Intellectual Patent Office (UK IPO). If you create a logo or name that you want to use but not register, you can attach the Trade mark symbol (™) which gives you 'common law' rights. However trade marks that are registered have stronger legal brand protection.

Can I sell my trade mark?

As a trade mark is classed as Intellectual Property, it is therefore similar to any other property you may own. This means that you are free to sell your trade mark at any stage if you wish to do so.

What is a trade mark license?

A license is a written agreement between the owner and another party which allows them to use the trade mark. The agreement defines the scope with which the third party can use the license. A trade mark license does not have to be recorded in the UK or US; this varies with other countries as some require the license to be recorded in order to be effective.

If you have any questions, don't hesitate to contact the Envoy team:

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Getting started

The trade mark application process

- Who do you register a trade mark with? 6
- How is a trade mark registration granted?..... 6
- How do I register a trade mark? 6
- Can I search for trade marks that have already been registered?..... 6
- How much does it cost to apply for a trade mark application in the UK? 6
- What are the steps involved in applying for trade mark protection? 7
- How long does the trade mark application process take?..... 7
- How do I protect my trade mark abroad? 7
- Do I need a trade mark attorney/agent to prepare and file a trade mark registration? 8
- Does getting a trade mark registration in one country affect its grant or refusal in another country? 8



Who do you register a trade mark with?

A trade mark is registered with the national trade mark office; you will usually need to apply in each country you want protection in. However, European and international application systems do exist. These are:

- The European Union (EU) trade mark
- The Madrid Protocol (see [How do I protect my trade mark abroad?](#))

How is a trade mark registration granted?

In order for a trade mark to be registered an application must be filed at a national trade mark office or regional body such as the [European Intellectual Property Office \(EUIPO\)](#) or [World Intellectual Property Organisation \(WIPO\)](#) for International protection. Once the relevant searches and examinations have been carried out and the trade mark application meets all the requirements of the relevant trade mark office, the trade mark will be registered. The first step to getting a trade mark registered is filing the application.

How do I register a trade mark?

An application for registration of a trademark must be filled with the appropriate national or regional trade mark office. The application must include a graphical representation of the sign, including any colours, forms or three-dimensional features. The application must also contain a list of goods or services to which the sign would apply.

Can I search for trade marks that have already been registered?

Yes. Trade mark searches can be carried out using the trade mark offices databases. You can search the databases online via the trade mark offices website such as the [USPTO](#) or the [UK IPO](#) websites.

How much does it cost to apply for a trade mark application in the UK?

The cost of registering a trade mark will depend on how you apply for protection. If you work with a trademark attorney or advisor, they will help you through the application process and charge a fee for this service. The cost* of submitting the trade mark application to the UK IPO is as follows:

Application for trade mark:	Online	Post
1 class	£170	£200
2 classes	£220	£250
3 classes	£270	£300
4 classes	£320	£350
Each additional class	£50	

* *Fees listed are sourced from the [UK IPO website](#) and are correct at the time of publication.

What are the steps involved in applying for trade mark protection?

The basic steps involved in obtaining a trade mark include:

1. **Confirmation** - check if your brand qualifies as a trade mark.
2. **Research** - search for any trade mark registrations similar to yours and if they are being used and to what extent.
3. **Application** - apply to register your trade mark by completing the trade mark registration application form and paying the appropriate fees.
4. **Examination** - after the application is submitted the examiner will review it and determine whether the mark may be registered. If the examiner has any objections they will issue an "Office Action" letter to which the applicant has six months to respond or the application will be abandoned.
5. **Publication** - if the examiner doesn't raise any objections the mark will be published in the Trade Marks Journal, any one that has any opposition to the mark they must register it with the trade mark office.
6. **Grant** - if no objections are received the trade mark registration will be granted and a registration certificate will be issued.

How long does the trade mark application process take?

Applications to register a trade mark in the UK take approximately 4 months if no-one objects. Applications with objections can take up to an additional six months to complete, depending on the proceedings, as this may take longer if there are objections.

How do I protect my trade mark abroad?

There are two options for protecting your trademark abroad. You can do this via a European Union Trade Mark (EUTM) or through the 'Madrid Protocol'.

- **EUTM** - if you want to protect your mark in countries which are members of the European Union (EU), you can apply for a European Union Trade Mark (EUTM) through the [European Union Intellectual Property Office \(EUIPO\)](#). This application may take nine to twelve months to complete.
- **Madrid Protocol** - you can apply to register your trade mark in countries which have signed-up to an agreement called the 'Madrid Protocol'. This is controlled by the [World Intellectual Property Organisation \(WIPO\)](#) and this application may take three to eighteen months to complete.

Do I need a trade mark attorney/ agent to prepare and file a trade mark registration?

No. Applicants can prepare their trade mark applications and file them without the assistance of a trademark attorney. However it is advisable to seek legal advice when drafting an application. It can also be useful to have an attorney when responding to any objections, and if you have any difficulties with the trade mark prosecution process.

Does getting a trade mark registration in one country affect its grant or refusal in another country?

Each country has the power to grant or refuse a trade mark application independently determined by its own trade mark office. Therefore granting or refusing a trademark in one country does not automatically mean that other countries are bound to grant or refuse that same trade mark.

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Keeping a trade mark protected

The renewals process

- How long will the trade mark stay protected for?10
- Once I have a trade mark registration can I add other goods or services at a later date?10
- What are trade mark renewal fees?10
- Do you need to pay trade mark renewal fees?10
- When are renewals due for a trade mark?10
- When can I pay trade mark renewal fees?10
- What if the trade mark renewal fees are not paid by the renewal date?10
- How do I pay trade mark renewal fees?10
- Do I need to inform the patent office of changes to my IP right and ownership details?11
- How do I go about making changes to my IP rights? 11



How long will the trade mark stay protected for?

A trade mark will stay protected for an initial 10 years; you have the option to renew the registration for a further 10 years and continued to do so indefinitely if you chose to do so.

Once I have a trade mark registration can I add other goods or services at a later date?

It is not possible to extend a registration to cover more goods or services after the initial application, a further application would be necessary to cover them. When you apply for the registration you should advise of the likely future scope of the business so that the application adequately covers such extra goods or service.

What are trade mark renewal fees?

Renewal fees are payments that must be made to the trade mark office in order to keep a trade mark registration in force. In the UK renewals are due after 10 years, and every 10 years after that as long as you want the trade mark to remain protected.

Do you need to pay trade mark renewal fees?

Non-payment of renewal fees will result in the trade mark expiring and the owner losing their rights to it which means someone else could take advantage of it.

When are renewals due for a trade mark?

Once a trade mark has been registered it is protected for 10 years from the date it was filed. Registration periods vary by country, but in most it will be due for renewal every 10 years, and there is no limit as to how long a trade mark can be registered if renewals continue to be paid. Canada is the exception with a registration period of 15 years.

When can I pay trade mark renewal fees?

You can pay a trade mark renewal in the 6 months before it expires and up to 6 months afterwards.

What if the trade mark renewal fees are not paid by the renewal date?

If an owner fails to renew a trade mark on time then the trade mark will expire. You have a 6 month grace period after the renewal date to make payment if this is also missed the trade mark will expire. You can apply for the trade mark to be restored within 6 months, but this does not guarantee that it will be restored.

How do I pay trade mark renewal fees?

There are a few different ways to pay for trade mark renewal fees:

- Pay directly to the trade mark offices in the territories where you would like to maintain protection of your trade mark, paying each one individually;

- Use a service provider such as Envoy who will renew your trade mark and make payment to all trade mark offices around the world on your behalf; or
- Instruct your patent attorney to renew your trade mark on your behalf.

Do I need to inform the patent office of changes to my IP right and ownership details?

Yes. If any circumstances change in terms of your IP rights these need to be registered with the trade mark office in order for the trade mark to remain in force. Failure to do this could result in you not being able to enforce the rights should any infringement occur .

How do I go about making changes to my IP rights?

IP recordals can be carried out in a few ways:

- Complete the required forms and submit them together with the required fee to the IPO where the rights are protected;
- Instruct a renewals service provider such as Envoy to carry out the work on your behalf, taking care of all the paperwork and filing required; or
- Instruct your trademark attorney to file and pay for the recordal with the IPO.

It is important to note that the process of reassigning and recording IP rights is complex and if any errors are made this could affect your protection and your ability to enforce it.

Any questions?

If you're looking at patent or trade mark renewals, feel free to get in touch for a quote. Or, if you'd like to try our online renewals system, we can set up a trial account for you.

Simply contact

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Publication date: December 2015.