

F R A N K S & C O

Patent & Trade Mark Attorneys

**DOMESTIC, FOREIGN AND INTERNATIONAL
TRADE MARK PROTECTION**

Trade Marks Protect Goods and Services

The definition of a registrable trade mark varies from country to country. In the UK the Registered Trade Marks Act defines a trade mark as being any sign capable of being represented graphically, which is capable of distinguishing goods or services of one undertaking from those of other undertakings. The definition of a registrable trade mark is the same throughout the European Community. In the UK a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging. A registered trade mark can consist of a smell or a sound, provided this is capable of graphical representation. However, there are certain classes of trade marks which are intrinsically unregistrable, for example trade marks which in their basic presentation are devoid of any distinctive character. Nevertheless, even such intrinsically unregistrable marks may still be registrable if the trade mark has in fact acquired a distinctive character as a result of use made of it.

Benefits of Registration

In the UK and in a large number of other countries, trade mark rights are accorded on a "first to file" system. The effect of a first to file system is that usage of a trade mark is not enough to secure rights in that trade mark. In the UK, whilst businesses or individuals who have been using a trade mark continuously for a significant number of years are likely to have built up common-law rights through the usage of their trade mark, the enforceability and transferability of those rights can be enhanced by registration, as well as creating new rights through the act of registration itself.

For individuals or businesses who are adopting new trade marks, securement of the rights in those trade marks is primarily through registration of the trade marks.

Prior Rights and Registrability Searches

Individuals or businesses who are contemplating using a new trade mark, or who are contemplating using an existing trade mark for a new range of goods or services may be moving into an area in which prior rights of other proprietors already exist. To avoid expensive mistakes, it is advisable, and often essential, to perform a search to see if the trade mark is free for use on the required range of goods or services. Once it has been established that a mark is free for use, rights in the trade mark can then be created by applying to register the trade marks. Where it is intended to use a new trade mark in a number of territories, it is important to ensure that there are no conflicting prior rights in any of the territories in which the trade mark is intended to be used.

Options for filing

For UK companies and individuals, there are several routes to obtaining protection in the UK and abroad. Companies and individuals may wish to obtain UK domestic protection only, or to protect a mark in a range of countries. UK registration can be obtained through a national UK registered trade mark application, a Community trade mark application covering all EC states, or via an international trade mark application filed in accordance with the Madrid Protocol. A UK or Community trade mark initial filing may be used as the basis for further foreign filings in due course by taking advantage of an international convention which stipulates that rights in a foreign trade mark application can be backdated to the original date of the first filing, providing the foreign trade mark is placed on file within six months of the first filing. For UK based clients, the first filing is likely to be a UK national trade mark application or a Community trade mark application. Further filings may take the form of a Madrid Protocol application and/or individual national trade mark applications. Although the filing strategy will vary for each particular case, depending upon the required countries, and the optimum cost, the following strategies are typical:

- **UK Application as first filing**

The initial outlay in filing for protection in a range of countries can be minimised by filing a UK registered trade mark application as the first filing, and then filing corresponding foreign trade mark applications within six months of the filing date of the UK application. This strategy has the advantage of delaying the decision on foreign filings for a few months, whilst maintaining the option of filing for priority protection in convention countries for a limited period.

Of course, if it is decided not to proceed with foreign trade mark applications, the UK trade mark application may proceed in its own right. Convention country trade mark applications can still be applied for, although if filed after the six month period they will not be entitled to the benefit of the earlier UK filing date, and it may be that competitors have filed competing applications abroad in the intervening period, giving rise to further problems.

- **Community Trade Mark Application as first filing**

Where goods and services fall into two or three classes, it will be more cost effective to apply to register the trade mark as a Community trade mark application as the first filing. On a per-country cost basis, the community system is highly cost effective. In a community application all EC countries must be covered together. Additional foreign trade mark applications for example Japan and the USA may be filed within six months of the Community trade mark application as priority filing, the original filing date of the community filing being retained for the foreign applications.

Registered Trade Mark Application Filing Procedure

Firstly, we need to know

- *the mark (including a copy of the logo if there is one)*
- *the goods/services on which you wish to use the mark*
- *the countries in which you are interested*

Then, after carrying out the relevant and required searches, advising on the registrability of the trade mark, and discussing the exact goods and services for which the trade mark is to be registered the filing strategy needs to be finalised. If the trade mark is a logo mark, we would need three good quality copies of the logo together with your instructions. Otherwise, we can proceed on receipt of your instructions.

- **UK Registered Trade Mark Application Prosecution Procedure**

Once an application to register has been filed, the Trade Marks Registry will perform a search of UK, Community and International registered trade marks and applications and issue a Search and Examination Report. The Trade Marks Registry may raise substantive points based on absolute grounds relating to the distinctive character of the trade mark, or on relative grounds wherein an earlier application or registration may be cited against the current application. If such substantive points are raised a detailed response will be required to be filed and the outstanding objections must be overcome before the application can proceed. If a written response to the Trade Marks Registry is not successful in progressing an application, the option of a hearing with a Senior Trade Marks Official is available to discuss the application. In many cases the application will not attract substantive objections and may proceed straight to advertisement. In such cases, the trade mark will become advertised following which it is open to third parties to oppose the registration within a period of three months from the date of advertisement. Third parties may oppose registration of the trade mark, providing they have grounds to do so. However, there are limited grounds upon which an opposition can be filed. UK registered trade mark applications progressing without significant problems and not attracting any oppositions are currently proceeding to registration within a period of 6 to 12 months from filing the application. Once registered, the registration is effective for a period of 10 years following which the registration must be renewed.

- **Community Trade Mark Application Prosecution Procedure**

Following the initial application to register a mark as a community trade mark, the Community Trade Marks Office will arrange for search reports from the Community Trade Marks Office and a number of national trade mark offices in the EC. Whilst the Community Trade Marks Office can raise objections to applications based on absolute grounds of registrability, it is not the practice of the Community Trade Marks Office to raise applications on relative grounds based on prior registered trade marks or applications. If objections on absolute grounds are raised then these will need to be overcome before the application can progress to advertisement. Once advertised the application will be open to opposition for a period of 3 months. If no oppositions are filed then it will be necessary to pay the registration fee in order to progress the application to registration. Once registered, the mark is effective in all 25 member states of the European Community for a 10 year period. Community trade mark registrations are centrally renewable for continuous 10 year periods. Community trade mark applications progressing without significant problems, and where no oppositions are filed, tend to progress to registration within 18 to 24 months of filing the application.

- **International Trade Mark Procedure - Madrid Protocol Application**

Trade mark rights may be secured under a number of national trade mark systems by means of a single application filed under the Madrid Protocol. To date, the following countries and regions have ratified the Protocol: Antigua and Barbuda, Armenia, Austria, Belgium, Bhutan, People's Republic of China, Cuba, Czech Republic, Democratic People's Republic of Korea, Denmark, Estonia, European Union, Finland, France, Georgia, Germany, Greece, Hungary, Iceland, Italy, Japan, Kenya, Latvia, Lesotho, Liechtenstein, Lithuania, Luxembourg, Monaco, Morocco, Mozambique, Netherlands, Norway, Poland, Portugal, Republic of Moldova, Romania, The Russian Federation, Sierra Leone, Singapore, Slovakia, Slovenia, Spain, Swaziland, Sweden, Switzerland, Turkey, Turkmenistan, Ukraine, The United Kingdom, the United states, and Yugoslavia. Other major industrial countries are expected to follow suit. The European Union itself, in addition to all its individual member states, is likely to become a party to the Protocol, making it possible to obtain a Community trade mark using the Madrid route. A Madrid application needs to be based on an existing UK application or registration.

- **Individual Foreign Filings on a Country by Country Basis**

For normal foreign trade mark filings, the costs vary on a country by country basis and we recommend you contact us to discuss the likely costs and application procedure.

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