

United Kingdom Trade Mark Protection

Why register your mark?

Registering your trade mark gives you the exclusive right to use your mark in the UK in relation to the goods/services covered by the registration. There are various remedies available to the owner of a UK Trade Mark registration where a third party uses the same or a similar mark on identical or similar goods without authorisation. A trade mark registration also provides the owner with grounds for preventing the registration of a later conflicting mark.

Trade Mark owners who have been using an unregistered trade mark for several years may have developed some rights at common law under the law of passing off, but the hurdles that need to be cleared to prove passing off are higher than for proving trade mark infringement.

Finally, a UK Trade Mark registration provides a statutory defence to infringement vis-à-vis other parties' marks.

Classification of goods and services

The UK is party to the Nice Agreement on the International Classification of Goods and Services, according to which goods and services are divided into 45 classes for trade mark registration purposes. We can advise you on the classification of your particular goods/services of interest, and put together an appropriate specification of goods/services for your trade mark application(s).

It is important to note that, under UK Trade Mark law, the applicant for trade mark registration must be using, or have a bona fide intention to use, the mark applied for in relation to all goods/services covered by the application.

Costs

Filing a United Kingdom Trade Mark Application for one mark covering one class of goods/services costs £465 plus VAT, including official fees and our charges. Each additional class included in the same application costs a further £155 plus VAT.

If no objections and/or opposition are encountered by an application, the only other predictable costs are our fees of £140 plus VAT, which are payable on registration.

If an application encounters objections and/or oppositions, the costs involved in dealing with these will depend on the amount of professional time spent on the matter and can range from anywhere between £100 - £200 in the case of a minor objections, and several thousands of pounds in the case of fully contested opposition proceedings.

The application process

We will file the application on your behalf at the United Kingdom Intellectual Property Office (UK IPO).

It is possible to request the fast track examination of an application, for an additional fee of £300. Under this system, the IPO guarantees to examine the application within ten working days.



We can also advise you on using the IPO's 'Right Start' system for new applications, whereby the applicant pays half the application fee, and half of any additional class fees, in return for which the IPO will issue the examination report. If, having reviewed the examination report, you decide to proceed with your application, the remainder of the fees are payable within 14 days of the examination report. If not, the application can simply be allowed to lapse, and no further fees will be payable.

Once an application has been filed, the IPO will examine it to ascertain, inter alia, whether the goods/services are correctly classified and whether, in the opinion of the IPO, the mark is capable of functioning as a trade mark (for example, that it is not descriptive of the goods/services, and not in common usage in the trade by other undertakings). The IPO will issue an examination report detailing any objections, and setting a deadline for responding (usually two months).

The IPO will not refuse an application ex officio on the basis of earlier conflicting marks held by third parties. Instead, the IPO will include, in its examination report, details of any earlier UK, Community and International Trade Mark (designating the UK) applications/registrations of marks which it considers might be in conflict with the mark applied for. You (the applicant) will then be given one opportunity to try to persuade the IPO not to notify the owners of these marks of your application. Unless persuaded otherwise, the IPO will notify the owners of any UK trade marks cited (and the owners of any CTMs if they have opted in to receive such notifications) of the publication of your application in case they should wish to consider opposing it.

Once any objections have been overcome, your application will be published in the UK Trade Marks Journal for opposition purposes. There is a two-month period (extendible to three months upon filing of a Notice of Threatened Opposition) within which third parties may object to the application.

If no oppositions are filed, or once any oppositions are resolved or overcome, your application will proceed to registration, and the IPO will issue a certificate of registration, which we will check and forward on to you.

Duration

A United Kingdom Trade Mark registration lasts for ten years from the date of application, and can be renewed for further ten year periods upon payment of the appropriate renewal fees.

Further advice

If you would like any further advice please contact us at Dehns using the details below.

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