



ADAMSON JONES
part of Gateley

***UK Trade Marks
A Brief Guide***

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Introduction

This guide provides a basic overview of trade marks and covers the basics of selecting a trade mark and registering it in the United Kingdom. For information about protecting a trade mark outside the United Kingdom, please see our Basic Guide to Trade Marks (International).

1. The Basics

1.1 What is a trade mark?

A trade mark is anything that can distinguish the goods or services of one business from those of other businesses. A trade mark can be almost anything, from words and logos to more unusual things like sounds or the shape of goods or their packaging.

The real value of trade marks is their ability to enable customers to reliably identify goods or services as originating from a particular business and not from one of their competitors. It is therefore highly important for businesses to protect their trade marks to prevent them being misused.

1.2 How do I protect my trade marks?

By far the most effective means of protecting a trade mark is by obtaining a trade mark registration, which is a legal right that permits the owner to prevent anyone else from using their trade mark. However, some kinds of trade marks may be difficult or even impossible to protect in this way, and these are discussed further in **Section 2** below.

A trade mark registration may be obtained by filing an application at the trade mark office (in the United Kingdom, this is the United Kingdom Intellectual Property Office (UKIPO)) defining what the trade mark is and the goods and services for which it is to be protected. If the application is successful, the trade mark will become registered. The process of obtaining a trade mark registration is discussed in more detail in **Section 3** below.

1.3 What rights does a trade mark registration provide?

The owner of a trade mark registration has the right to prevent others from using the same or a similar trade mark in commerce, which includes things like selling or offering to sell goods or services, importing or exporting goods, or advertising goods or services. Any of these activities can constitute

“infringement” of a registered trade mark, and the owner of the trade mark registration is entitled to take legal action to stop others from doing anything that as an infringement of their registration.

The mere existence of a trade mark registration acts as a deterrent against infringement but, where infringement does take place, simply sending a Cease and Desist Letter to an infringer is often enough to put a stop to their infringing activity. However, in the case of persistent infringers, the owner of a trade mark registration can take legal action in the courts and obtain an injunction to stop the infringing activity, and may also be able to obtain damages for lost sales or damage to reputation.

1.4 For how long does a trade mark registration last?

A trade mark registration initially lasts for ten years, although registrations can be renewed for further ten year periods an unlimited number of times with the payment of renewal fees. There is therefore no limit to how long a trade mark registration can last. If the renewal fee is not paid at the end of any of the ten year periods, the registration will lapse and trade mark will cease to be protected.

2. What kinds of trade marks can be registered in the UK?

2.1 What kind of trade marks can be registered?

Although anything that is capable of identifying the commercial original of any goods or services can be a trade mark, there are some kinds of trade marks that cannot be registered. In particular, it is not permitted to register a trade mark in relation to any goods or services for which it is descriptive. The trade mark must not be even potentially descriptive of any characteristic of the goods or services, such as their quality, intended purpose or geographical origin. It is also not permitted to register trade marks in relation to any goods or services for which they have become the customary or generic name. The purpose of these exclusions is to ensure that descriptive and customary terms remain available for all traders to use to describe the goods and services that they offer.

Accordingly, it is highly advisable to select a trade mark that is not descriptive of any aspect of the goods of services for which it is intended to be used.

It may become possible to register a descriptive or customary trade mark after it has been used enough for the public to associate it more with the business that is using it than with its original descriptive or customary meaning. However, this typically requires many years of intensive and widespread use.

It is also not permitted to register trade marks for other reasons, such as if the trade mark is grossly offensive, potentially deceptive, or includes internationally protected symbols such as the Olympic rings.

2.2 What about other peoples' trade mark registrations?

If there is already a registration for a trade mark that is the same as or similar to your trade mark and which covers goods or services that are the same as or similar to the goods or services for which you intend to protect your trade mark, the owner of that registration may object to the registration of your trade mark, in particular by filing an opposition against your application to register your trade mark (see **Section 3.4.5** below).

In addition to preventing you from registering your trade mark, the use of your trade mark may also be an infringement of a registration for the same or a similar trade mark and hence the owner of that registration may be entitled to take legal action to prevent you from using it.

Accordingly, before adopting a trade mark, it is highly advisable to check whether anyone else already has a registration for the same or a similar trade mark in relation to the same or similar goods or services, in particular by carrying out a trade mark availability search, as discussed in **Subsection 2.3** below.

2.3 How do I check for other people's trade mark registrations?

It is possible to check for any trade mark registrations that are sufficiently similar to your proposed trade mark to cause a potential conflict by performing a trade mark availability search. We may perform a trade mark availability search and report the results to you along with some preliminary advice about the relevance of the trade marks that have been identified by the search and an indication of whether we would recommend proceeding with the trade mark or selecting an alternative.

The costs of performing a trade mark availability search and providing preliminary advice starts at around £400 + VAT, although the cost may be higher depending on the subject matter of the search. In particular, searching for logos is typically more expensive than searching for words and the cost is typically higher for searching a wider range of goods and services. We can give a precise quote for performing a trade mark search and reporting the results to you with some preliminary advice once we have settled on which trade mark and goods and services are to be searched.

In some cases, where the search identifies a potentially conflicting trade mark registration, we can investigate whether it can be overcome by applying to invalidate or revoke the registration. However,

this would involve incurring additional costs and hence a judgement must be made about whether it is worthwhile to do this rather than select an alternative trade mark. In any case, the approach taken to dealing with potentially conflicting trade marks will vary depending on the particular circumstances of each individual case.

3. How do I get a trade mark registration?

3.1 Choosing a trade mark

We recommend choosing a trade mark that is not descriptive of any aspects of the goods or services for which you intend to use and register it (see **Subsection 2.1** above) and that is not similar to any trade marks that have already registered by anybody else (see **Subsection 2.2** above), as this will make the process of applying to register the trade mark considerably easier and will improve the chances of successfully obtaining a registration.

3.2 Deciding what goods and services to cover

When applying to register a trade mark, it is necessary to define the particular goods and services for which it is to be protected. It is not possible to add goods or services to an application after it has been filed and hence it would be necessary to file a new separate application in order to cover additional goods or services after filing your initial application. Accordingly, we recommend giving careful consideration to the range of goods and services for which you intend to protect your trade mark, and in particular we recommend covering all goods and services that you are currently providing under your trade mark, as well as any goods or services that you expect to begin providing in the foreseeable future. However, it is not permitted to apply to register a trade mark in relation to goods or services for which you have no *bona fide* intention to use the trade mark.

All goods and services for which it is possible to protect a trade mark are divided into a total of 45 classes according to the [Nice Classification](#). The cost of filing a trade mark application and renewing a trade mark registration, and also the cost of performing a trade mark availability search, increases with the number of these classes that are covered. Accordingly, it may be necessary to be selective when choosing what classes to cover in order to manage the cost of protecting a trade mark.

3.3 Deciding where to apply

Trade marks are registered by the intellectual property offices of individual countries, or specific groups of countries, such as the European Union, and only protect the trade mark in those particular countries (ie United Kingdom trade mark registration would not provide any protection for a trade mark outside the United Kingdom). Accordingly, for any trade marks that are going to be used outside the United Kingdom, it is important to consider protecting the trade mark internationally, and in particular to ensure that the trade mark is also protected in any important markets outside the United Kingdom.

For information about protecting a trade mark outside the United Kingdom, please see our [Basic Guide to Trade Marks \(International\)](#).

3.4 What is the process for registering a trade mark in the United Kingdom?

In addition to the typical process for obtaining a trade mark registration in the United Kingdom set out below, a brief summary of this process is also provided in in the **Timeline** on the final page of this document.

3.4.1 Filing a trade mark application

Once a trade mark and the goods and services that are to be covered have been chosen, we may proceed with filing an application at the [United Kingdom Intellectual Property Office \(UKIPO\)](#).

Our total charges for preparing and filing an application to register a trade mark in the United Kingdom in relation to one class of goods or services is £680 + VAT, and a further £110 + VAT for each additional class of goods or services. However, in cases where an unusually large amount of work is required to select your trade mark or prepare the list of goods or services, there may be additional charges of a few hundred pounds.

3.4.2 Examination of the application

The UKIPO examines trade mark application to determine whether the trade mark is eligible for registration, and especially whether it is potentially descriptive of any of the goods or services that are covered by the application (see **Subsection 2.1** above), as well as whether goods and services defined in the application are specified clearly enough and included in the correct classes.

Where the UKIPO does not raise any objections, the application proceeds without us having to take any further action and at no further cost.

However, where objections are raised, the UKIPO will issue an examination report setting out the reasons for the objections, and it will be necessary to overcome these objections before the application can proceed. Dealing with objections typically costs in the region of £200 to £400 + VAT for relatively simple objections, and £400 to £800 + VAT for more substantial objections and may delay the application process by several months. In particular, responding to an objection that the trade mark is descriptive can incur significant cost and may still result in the application being refused either entirely or in part. Accordingly, we recommend selecting a trade mark that is not descriptive of any of the goods or services for which you wish to protect it, as discussed in **Subsection 2.1** above, in order to reduce the risk of such an objection being raised.

3.4.3 Search of the application

The UKIPO will also perform a search for existing trade mark registrations that it considered to be similar to the trade mark application, and will issue a search report identifying any relevant registrations that it finds. The UKIPO notifies the owners of any existing registrations identified by the search of the existence of the application in order to give them the opportunity to oppose it.

3.4.4 Publication of the application

Once examination and search has been completed and any objections have been overcome, the UKIPO will publish the application. Publication initiates a two-month period in which anyone may file an Opposition against the application in an attempt to prevent it from becoming registered.

3.4.5 Opposition to the application

Anyone may file an opposition against a trade mark application that they believe is too similar to an existing trade mark right that they own. In the event that anyone files an opposition, the application process is paused and the oppositions must be overcome before the application can proceed to registration.

It is possible to overcome an opposition by establishing that the opponent's earlier trade mark rights are either invalid or not sufficiently similar to the application to prevent its registration. Alternatively, it is possible to overcome an opposition by settlement if the applicant and the opponent are able to agree to

coexist on certain terms. In either case, the cost of dealing with an opposition is typically in the range of £1,500 to £3,000 + VAT and opposition proceedings typically last from 12 to 18 months.

It is not possible to predict with certainty whether or not anyone will oppose a trade mark application. However, it is possible to get a preliminary indication of the risk of an application being opposed by performing an availability search before filing an application (see **Subsection 2.3** above).

3.4.6 Registration of the trade mark

If no oppositions are filed within two months from publication, or once any oppositions have been overcome, the application will become registered. The owner of the registration then has the right to commence legal proceedings against anyone misusing the trade mark, and the trade mark may be marked with the ® symbol.

The whole process from filing to registration generally takes around 5 months, but can take significantly longer if the process is delayed by objections or oppositions.

4. My trade mark is registered. What now?

4.1 How should I use my trade mark?

It is possible for a trade mark registration to become invalid because of the way in which the owner uses, or fails to use, the trade mark.

In particular, a trade mark registration may become invalid if the way the registration owner uses the trade mark, or allows the trade mark to be used, results in the trade mark becoming the generic name for the goods or services for which it is registered. Aspirin, Escalator and Sellotape are examples of names that started out as trade marks but became the generic name of the goods for which they were used. Accordingly, the owner of a trade mark registration must take care to ensure their trade mark is used in a way that makes it clear that the trade mark is an indication of the commercial origin of the goods or services in question and not merely a generic name for those goods or services.

In addition, a trade mark registration may become invalid in relation to any goods or services for which the trade mark has not been used for any continuous period of five years following registration. It is therefore important for registration owners to ensure that they do not cease use of a trade mark in

relation to any goods or services for more than five years, especially if they intend to recommence use of the trade mark in relation to those goods in the future.

The owner of a trade mark registration may give their permission to someone else to use the registered trade mark on mutually agreed terms, possibly in exchange for a royalty. This is called “licensing” the trade mark registration. The licensing agreement should include terms that ensure the licensee does not use the trade mark in a way that may jeopardise the validity of the trade mark registration, as discussed above.

The owner of a trade mark registration may also sell the registration to someone else. This is called “assigning” the trade mark registration.

4.2 How should I enforce my trade marks?

The owner of a trade mark registration has the right to prevent others from using the same or a similar trade mark in commerce (see **Section 1.3** above). Accordingly, the owner of a trade mark registration should keep watch for anyone else using the same or a similar trade mark in a way that infringes their trade mark registration, and seek legal advice if any such use is identified. It may then be appropriate to send a Cease and Desist Letter to the infringer or to commence legal proceedings in the courts in order to prevent the infringement.

Registration owners should also take action to prevent anyone else from registering the same or a similar trade mark, in particular by opposing any applications for such trade marks to prevent them from becoming registered. We provide an ongoing **Trade Mark Watch** service to trade mark registration owners, which provides a timely notification of any new trade mark applications that conflict with their registrations and hence provides the opportunity to oppose the application before it becomes registered.

The cost of a basic watch for one trade mark is approximately £100 + VAT per year for the United Kingdom, £250 + VAT for the European Union, or £300 for worldwide coverage. Additional costs would then only arise if we are to take action to prevent any of the new applications identified by the watch from becoming registered.

5. Is there anything else I should know about?

5.1 How do I protect my trade mark overseas?

Trade mark protection outside the United Kingdom should always be considered for any trade mark that may be used overseas (see **Subsection 3.3** above). There are two main options for obtaining trade mark protection outside the United Kingdom, namely:

- 1) filing separate trade mark applications in each overseas jurisdiction of interest; or
- 2) filing a single International trade mark application designating all jurisdictions of interest using the Madrid Protocol.

In either case, the European Union may be covered as a single jurisdiction by filing a single European Union Trade Mark (EUTM) application or designating the European Union in an International application.

There is no particular time limit by which overseas trade mark protection must be applied for, and indeed many trade mark applications are filed after many years of commercial use. However, it is preferable to file overseas applications within 6 months from the initial United Kingdom application, as this enables them to claim “priority” from the initial application, which effectively gives the overseas applications the earlier filing date of the initial application.

For information about protecting a trade mark outside the United Kingdom, please see our Basic Guide to Trade Marks (International).

5.2 What is the difference between “TM” and “®”?

The “TM” symbol can be used after your trade mark whether the trade mark is registered or not. We advise doing this for any trade marks that are being used but have not yet been registered in order to clearly notify others that you consider the trade mark to identify goods and services as being those of your business.

The “®” symbol can only be used after a trade mark that is registered. We recommend marking all registered trade marks with this symbol in order to notify others that your mark is registered and hence deter infringing activity. However, it is an offence to falsely claim that a trade mark is registered, so it is important to ensure that any trade marks that are marked with “®” are indeed registered.

5.3 Can my trade mark be protected without a registration?

In the United Kingdom, trade marks that are not registered may still have protection under the law of **Passing Off** if they have been used sufficiently for the public to recognise the trade mark and associate it the business that is using it.

In order to prevent misuse of a trade mark under the law of Passing Off, it is necessary to prove that (1) the trade mark has been used sufficiently for the public to recognise the trade mark and associate it with your business; (2) the infringer has misrepresented themselves as your business using the trade mark; and (3) the misrepresentation has damaged, or is likely to damage, your business.

Preventing the misuse of a trade mark under the law of Passing Off is considerably more difficult and less reliable than with a trade mark registration, particularly because a substantial amount of evidence is typically required to demonstrate the requisite level of public recognition of the trade mark. We therefore always recommend protecting a trade mark with a trade mark registration.

6. How can Adamson Jones help?

Adamson Jones is a firm of patent and trade mark attorneys with extensive experience in all aspects of intellectual property. We would be happy to help you with all of your trade mark needs, from selecting a trade mark, to protecting your trade marks in the United Kingdom and overseas and enforcing them against infringers.

Please feel free to contact us on the details given below to arrange a meeting.

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Timeline of a UK Trade Mark Application

