

UK Trade Mark Guide

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A Trade Mark is any sign used to distinguish the goods or services of one business from those of another. A Trade Mark registration gives the owner exclusivity and enables it to prevent a competitor from using the same or confusingly similar Trade Mark. Trade Marks help customers identify the origin of the goods/services and lets them know what level of quality they can expect. Properly used and promoted, a Trade Mark may become the most valuable asset of a business.

Types of Trade Marks

A Trade Mark can be many things e.g.

- Word/combination of words
- Logo
- Shape of goods or packaging
- Colour
- Sound
- Motion
- Hologram

The important thing is that your Trade Mark should be distinctive. The law only protects distinctive Trade Marks. Some examples of distinctive Trade Marks include the mark 'Holy Smoke' for a barbeque restaurant, 'Google' for software and 'Spotify' for music streaming technology. Invented terms like 'Spotify' are generally considered the most distinctive.

You should avoid the temptation to pick a Trade Mark that describes your goods or services. Trade Marks which describe your goods or services cannot be registered. Remember, a Trade Mark registration gives you the exclusive right to use a certain brand which means you can stop others from using that same brand. Therefore, descriptive Trade Marks are refused registration because these terms should be left available for other traders to use and should not be monopolised by one party. For example, if you tried to register 'Apple' as a Trade Mark for fruit, it would be refused because it describes the goods you are selling. But it was fine for the technology company Apple Inc. to register 'Apple' for computers because the term "Apple" doesn't describe computers or have anything to do with computers.

Furthermore, your Trade Mark should not be:

- Offensive – e.g. it should not contain swear words.

- Deceptive e.g. using the term 'organic' in your mark for goods that are not organic would be considered deceptive.
- Generic – i.e. it should not be the common name in the trade for your product or service. Examples of terms which were originally Trade Marks but became generic over time are "Aspirin" and "Escalator".

Trade Mark Searching

Before you apply to register your Trade Mark, you should search the Trade Mark register to check if anybody else has already registered an identical or similar Trade Mark for similar goods or services. Conducting a Trade Mark search will help determine whether there are any prior conflicting Trade Marks that could prevent you from using or registering your Trade Mark. FRKelly can conduct your Trade Mark search and advise whether your proposed Trade Mark is available.

The UKIPO

The Intellectual Property Office of the United Kingdom (UKIPO) is located in Newport, Wales, and serves all four jurisdictions of the UK: England, Wales, Scotland, and Northern Ireland. The UKIPO is responsible for examining and registering Trade Marks in the UK.

UK Trade Mark Application Process

The UKIPO will examine the application to ensure the Trade Mark is sufficiently distinctive for registration and that the goods and services listed in the application have been correctly classified in accordance with the International Nice Classification. Goods and services are broken down into 45 different 'classes' and FRKelly can advise on the correct classes to register in. The UKIPO will search the Trade Mark register and if it identifies any earlier conflicting marks, it will notify the Applicant. The Applicant is then given the opportunity to limit the goods and services so as to avoid conflict or to proceed without making any changes to the application. However, if the Applicant does not make any amendments to the application despite the UKIPO considering there to be a conflict, the UKIPO will notify the owner of the earlier conflicting mark and they may oppose the application. The opposition period is two months from the date the application is published in the online journal and may be extended by one more month by a potential opponent. If no opposition is filed, the application will proceed to registration and a Certificate of Registration will issue. The entire process can take as little as four months. The registration lasts for an initial period of 10 years and can be renewed for further 10 year periods indefinitely. There are trade mark registrations on the UK register which have been in existence for several hundred years.

Brexit and the EUTM

As the UK was part of the European Union for 47 years, the European Union Trade Mark (EUTM) had effect in the UK until Brexit. However, any EUTMs which were registered as of 1 January 2021 were automatically cloned into UK national registrations (these are called comparable UK Trade Marks). This prevented a loss of UK Trade Mark rights for EUTM owners. Now, if you want EU and UK protection, you must register your Trade Mark separately in the EU and UK.



Strategy

We would be delighted to discuss and help prepare a Trade Mark strategy which best fits your business. Our firm has a wealth of experience in UK Trade Mark matters and many of our attorneys are UK qualified and act directly before the UKIPO. We handle all aspects of the trade mark registration process from searching through to registration. We look forward to working with you.