

Trade marks – frequently asked questions

A registered trade mark is an asset, which can be sold, licensed, and mortgaged. A trade mark registration gives a monopoly to stop certain use by others of similar marks on similar goods. It gives you more certainty that a trade mark is available for your use, as it has already been through an opposition stage.

What is a trade mark?

A trade mark is a distinctive sign that distinguishes your business' goods and services from those of other traders in the same market.

It will generally consist of words, or logos, however colours, slogans, sounds and shapes can also be protected by registration in certain circumstances.

A trade mark registration confers upon its owner the exclusive right to use the registered trade mark in respect of those goods, or services for which the trade mark is registered.

Why is a trade mark valuable?

A trade mark is the key means by which a business can distinguish its goods, or services from those of its competitors. Consumers rely on trade marks when making purchasing decisions. Trade marks can act as indications of origin, but also convey messages regarding the quality, reliability and prestige of the goods and services.

A trade mark is an extremely valuable asset that can be exploited commercially by way of licensing and franchise arrangements to generate revenue.

What trade marks can be protected?

Words, logos, numbers, letters, colours etc. or any combination of these elements can be protected by registration, provided they are distinctive. It is not possible to protect wholly descriptive, or generic names e.g. "soap" for toiletry products.

Trade marks have different levels of distinctiveness, or strength depending on whether they are descriptive (GORGEOUS HAIR for shampoo), suggestive (AIRBUS for airplanes), arbitrary (BLACKBERRY for mobile phones) or invented (XEROX for photocopiers).

The more distinctive, or unusual a trade mark is, the greater the scope of protection will be and the easier it will be to protect and enforce the rights against competitors.

How do I protect my trade mark?

Prior to adopting, or launching a new trade mark, it is advisable to conduct clearance searches to check that your trade mark can be safely used without infringing any earlier rights of others. It is better to find out about possible obstacles at an early stage and before significant time and resources have been invested.

Trade mark rights can generally be acquired either through use, or registration. It is, however, advisable to register your trade mark, as the evidential burden of proving rights acquired through use is high and very costly.

What information is in a trade mark application?

A trade mark application includes the mark, a list of goods and/or services for which protection is sought and the owner and address details.

Where do I file a trade mark application?

Trade marks are territorial. This means it is generally necessary to file trade mark applications in each country of interest. The notable exception is the EU trade mark application which covers the member states of the EU. It is also possible to use the Madrid filing system to designate various member countries in one go based on rights in your home territory.

How much does it cost?

The cost of protecting a trade mark depends on the country of interest.

The upfront costs relate to searching and filing the application, including the official fees. Further costs are incurred to progress the trade mark application and these costs will depend largely on whether, or not, objections are raised by others and/or by the trade mark office. Registration costs are normally spread out over several months/years, depending on the country of interest.

How long does it take to register a trade mark?

For straightforward applications it typically takes five months to register a UK or an EU trade mark. The time-frame in other countries will vary, depending on local practices.

Am I free to use my trade mark?

It is advisable to conduct clearance searches before adopting or launching a new brand to check that the trade mark can be safely used without infringing any earlier third party rights. The extent of searching that is necessary will vary depending on the nature of the mark, the goods or services for which it is to be used and the countries of interest. Basic searches usually focus on the specific mark and goods/services of interest only. More extensive searches could include other sources e.g. the Internet, domain names and company names, and focus on similar marks for a wider range of goods/services in trade mark registers.

How long does a trade mark last?

In most countries, a trade mark registration is for ten years and then it can be renewed every ten years.

For advice on our trade mark services, please contact us via our online enquiry form or telephone 0207 831 7929.

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