

HINDLES

Patent & Trade Mark Attorneys

THE UK TRADE MARK APPLICATION PROCEDURE

In order to obtain a UK trade mark registration, it is necessary to make an application to the UK Trade Mark Registry, which is part of the UK Intellectual Property Office. There are no nationality restrictions concerning who may apply for or own a UK registration.

Application Content

An application should include information about the applicant, a representation of the mark and a list of the goods/services for which registration is sought. An official fee must also be paid. Goods and services are classified into forty-five classes and the cost of an application will depend upon the number of classes into which the applicant's goods/services fall.

The Trade Marks Registry will consider whether an application meets formal filing requirements and, if so, will then carry out a substantive examination to assess whether the application meets the criteria for registration. In particular, the Registry will consider whether there are any "absolute grounds" or "relative grounds" for refusal.

Absolute Grounds for Refusal

The Trade Mark Registry will assess whether the sign for which protection is sought is a trade mark and, if so, whether it is the type of trade mark that should be registered.

A trade mark registration gives the proprietor exclusive rights and there is a general principle that one trader should not be able to monopolise any mark that other traders should be free to use. Accordingly, the Registry will object to the registration of marks which (1) describe the characteristics of the goods or services for which protection is sought (e.g. the word ORANGE for fruit), (2) are devoid of distinctive character (e.g. common geographical names or surnames, or laudatory terms such as FIRST CLASS), or (3) are customary in common language or in trade.

Other marks which may be refused under absolute grounds include those which are contrary to public policy or accepted principles of morality, or those which are of such a nature as to deceive the public (e.g. SILKY for cotton garments).

Relative Grounds for Refusal

The Registry will only be able to refuse an application on “relative grounds” if opposition is successfully raised by the owner of any earlier trade mark. This means that earlier trade marks do not constitute a barrier to the acceptance of an application at the examination stage. Accordingly, the onus is on the owners of the earlier marks to decide whether they wish to challenge the acceptance of the application through the opposition procedure.

Nevertheless, the Registry will search for earlier marks at the examination stage and the results will be conveyed to the applicant for registration so that they can make an informed choice as to whether or not to proceed. Should the applicant decide to continue with the application, the registry will notify the owners of any earlier marks identified in the search about the existence of the new application when it is subsequently published in the Trade Mark Journal. The test applied by the registry is whether the similarities between the respective trade marks and the goods or services to which they relate would lead to a likelihood of consumer confusion. Where the goods and/or services and the trade marks are identical, it is not necessary to show confusion.

Registration and Renewal

If no opposition(s) are filed (or the application is not successfully opposed in its entirety), then the application will proceed to grant and a certificate of registration will be issued. A UK trade mark application can be granted in as little as six months if no objections are raised by the Registry on examination and no oppositions are filed.

A UK registration lasts initially for ten years from the filing date. Provided that renewal fees are paid every ten years, the duration of the registration may be extended indefinitely, although a registration would become vulnerable to revocation, in whole or in part, if the mark is not used on the goods or services specified in the registration for a continuous period of five years.

For more information:

- ❖ Visit our website
- ❖ Contact one of our attorneys directly
- ❖ Call 0131 243 0660

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