

Trademarks, Patents and Designs A Guide to Applications and Costs

Trade mark registration summary Procedure

A trade mark is essentially a monopoly right over a name. It is intended to make sure that consumers are aware of the origin of a product from its name and therefore can be confident that when they use that product they are getting exactly what they want.

We can register two types of trade mark:

- A UK trade mark that applies only to the marketing of products within the UK.
- A European Community trade mark (CTM) which provides unitary trade mark protection in all countries in the European Community. The application and ensuing registration extends automatically to all Member States.

Which trade mark is most appropriate for a product depends on where you intend to market the product. This is a point we can advise on.

The CTM cannot be limited geographically in scope. Accordingly, even if the trade mark would be accepted in all but one Member State and you have no intention of using the mark in that particular state the application will fail. There are, of course, a large number of trade marks (registered and unregistered) being used in the area covered by a CTM and consequently there is a greater possibility that somebody will be using the trade mark, or something very similar, already and oppose the application (see below) than there is with UK applications.

In both the UK and Europe the application procedure is essentially the same.

1 Application

The initial application can be made on paper or online. The application will set out a large amount of information relating to the trade mark, including your details, a representation of the trade mark being applied for and a description of the goods the trade mark is to be registered against (all possible goods and services are divided into related groups, known as "classes". An application is made in relation to the specific classes within which the goods you intend to market under the trade mark exist. All fees are dependent on the number of classes the application relates to).

When making a CTM application a non-English language must be chosen as the "second" language that anyone who opposes the application may choose to use instead of the applicant's first choice language. This language must be French, German, Italian or Spanish. We suggest selecting Italian for this because it tends to be the least used "main" European language and so opponents are more likely to correspond in English. However, should an opponent wish to use Italian to correspond there will be translation costs. Accordingly if you are fluent in a particular language or, for any other reason would prefer the second language not to be Italian, please let us know.

If you decide to proceed the first step will be to discuss your work and plans in more detail so we can advise on what classes you should apply for.

2 Inspection

Once it is received by the appropriate Trade Mark Office the Application is inspected and any problems they identify will need to be corrected (these may be, for example, that they think the trade mark is descriptive of the goods and so should not be registered or one of the goods the trade mark is registered against is in the wrong class).

The timing of this period is dictated by the trade mark office and varies considerably.

In the UK the trade mark office also looks at potentially conflicting marks and will not allow the application to go to the next stage if they think a conflict exists (a conflict essentially arises if there is a trade mark already in existence that may cause confusion in the mind of the public). If they raise an objection action can be taken to remove it. The appropriate action depends on the circumstances and we will advise on this if the issue should arise.

In Europe this conflict check does not happen but instead a list of potentially conflicting trade marks from each Member State's respective Trade Mark Office is sent so that we can inspect them and see if a potential conflict arises.

3 Publication

When the trade mark office agrees that the Application complies with the various regulations they publish it for a period of 3 months. At this stage any person can see the application and can oppose it if they believe there is a reason it should not be registered (usually because it conflicts with their own trade mark).

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4 Opposition

Where an opposition is filed the application is postponed while a resolution is searched for. It is impossible to predict the attitude the opponent will take and each case is different. Various ways to resolve the matter are available however there are occasions when the application cannot proceed because of the opposition.

It is possible for a person to oppose a trade mark because they run a company under the trade mark name but have not registered the trade mark. You are in a better position to assess this than we are.

5 Registration

If there is no opposition at the end of the 3 month Publication period the Application is registered. The Registration date is back dated to the date of the Application.

Even after a trade mark is registered third parties can apply for it to be removed from the register for a number of reasons, most notably if it is not actually being used.

Time

It is impossible to predict how long it takes to register a trade mark. If the process is entirely unopposed one would hope it will take no more than 6-8 months but if it is opposed the procedure can take years. It is sensible to expect the procedure to take between one year and eighteen months.

Applications for non-UK or CTM trade marks

We are not able to directly apply for trade marks that are not either the UK or CTM because there needs to be a contact address in that country for correspondence purposes. We have contacts in all of the major trade mark areas, including the USA, Canada, Australia, Japan and UAE. If you intend to launch your brand in any of these countries it is important that they are co-ordinated so you have the same products (or as near as possible) protected in each country.

The application procedure is essentially the same throughout the world and the same classes apply in virtually every country in the world. However, each country's registration office has its own quirks and preferences. Most notably the USA requires very precise descriptions of the goods being protected.

If you have any thoughts about applying to other countries we should discuss these at the start so that the application can be drafted appropriately. In the long term this will save money on the other applications. We will also be able to advise on approximate fees for other countries. We will then co-ordinate the applications throughout the world and be your one contact for all of them. The rate for doing this is the hourly rate set out above.

Design Registration

We are also able to obtain the quicker and cheaper design registration and will advise on whether this is an option for you. However, we do not carry out patent registration because we recognise that you need a specialist in your industry for this. We can, however, suggest appropriate contacts for this.

Commercial Exploitation

Like with copyright your trade marks, patents and designs are valuable assets to your commercial interests. People tend to think of them as things you want to keep and prevent others from using but as with most assets you can sell or licence them. We can advise on the best way to do this and assist with negotiating the deal. We will also, if required, draft the appropriate agreement and deal with the necessary administrative work at the relevant registry.

Protection

Even when your right has been registered the management of your trade mark, design or patent is not finished. People will still try to take advantage of your brand, innocently use a similar image or name or even remove you from the relevant register if they have a similar identifier. In these situations we will advise you on and take for you, the appropriate action to ensure your brand is not exploited by others. It is, of course, always important to be precise in any legal action but this is particularly the case with trade mark and design rights where the law is particularly strict on people who take action when they should not. Whilst it is easier to act in relation to a registered identifier, even if you have a design or trade mark that has not or cannot be registered legal action can be taken. We have successfully prevented our clients marks, registered and unregistered, from being used without permission throughout the world. We have prevented inferior copies of unique designs being sold in high street shops. It is important to act quickly but properly and so call us to discuss any problems you are having and how we can help.

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Costs

The CTM is, of course, a more expensive option as it covers more countries than a UK only application. As a rule of thumb it tends to be cheaper to make one CTM application than 3 individual national applications. Once payment is made to OHIM of any of these fees it is not refundable in any circumstances. All payments must be sent to Atkins, and cleared in our account, prior to either (a) making the Application or (b) in the case of the Registration fee, 2 weeks before the end of the Publication period.

UK Fees

Stage	Fee	Time for Payment
Filing a paper application in 1 class	£200	With the Application
Filing additional classes	£50 per class	With the Application
Other fees	To be advised if they arise	To be advised if they arise

The UK is fairly unique in that, at the moment, it does not charge for the registration of a trade mark.

CTM Fees

Stage	Fee	Time for Payment
Filing a paper application in 3 classes or less	€900	Within 1 month of application
Filing an online application in 3 classes or less	€750	Within 1 month of application
Filing additional classes	€150 per class	Within 1 month of application
Registering an application in 3 classes or less	€800	Within 2 months of the end of the publication period
Registering Additional Classes	€150 per class	Within 2 months of the end of the publication period
Other fees	To be advised if they arise	To be advised if they arise

Once payment is made to OHIM of any of these fees it is not refundable in any circumstances. Please note the Office Fees (i.e. the fees charged by the OHIM) are given in Euros. Owing to exchange rate fluctuations a sterling figure for the Fee is not given.

Legal Fees

Stage	Fee (exclusive of VAT)	Time for Payment
Initial review as to likelihood of registering the trade mark**	£350	On Instruction
Filing an application in 1 class and monitoring progress of Application where no issues arise.	£500	Prior to making application
Filing additional classes	£175 per class	On instruction
Other fees incurred in dealing with any non-standard issues after the application is filed	Charged on a time basis at £220 per hour	Upon being invoiced

**This review simply assesses whether the mark is registered with the UK and CTM (and not in the individual Member States), whether there are any readily obvious unregistered trade marks in existence and a view as to whether the mark is capable of being registered in accordance with the law. It is intended to identify any immediate issues that may arise to help you make an informed judgment as to whether to proceed with the application. It does not guarantee that registration will be successful.