

Trade marks and recent changes

The Trade Marks and Trade Marks (Fees) (Amendment) Rules 2008

These rules introduce a fast-track service which has been available since 7 April. The fast-track examination will cost an additional £300 in addition to the standard £200 fee plus £50 per extra class.

Provided the application is made electronically on Form TM3 the application will be examined and the examination report sent to the applicant (or its representative) within 10 business days beginning on the first business day after the filing date of the application. This usually takes over a month under the standard process. If the UKIPO does not respond in time the fast track fee is refunded.

Trade Marks (Relative Grounds) Order 2007

An important change in UKIPO practice came into effect in October last year. The UKIPO no longer refuses to register a new trade mark application because of an earlier conflicting trade mark, unless the owner of the earlier mark successfully opposes the new application.

Procedure

As before the change, when an application to register a UK trade mark is made to the UKIPO, it is first assessed to ensure that it is capable of being registered (the absolute grounds for refusal). Once this is established, the UKIPO still conducts a search against all trade marks protected in the UK to identify whether there are any previously registered marks which are confusingly similar or identical, under section 5 of the Trade Marks Act 1994 (1994 Act) (the relative grounds examination). However, the search is now carried out for the purpose of notifying the applicant and other parties of any earlier marks that may appear to provide a basis for opposition or subsequent invalidation of the new trade mark.

This has important ramifications because the onus is now on the owner of earlier marks to formally oppose a trade mark application because trade mark applications will no longer be refused on relative grounds. The UKIPO automatically notifies owners of earlier UK trade marks but will not notify owners of Community Trade Marks (“CTMs”) or international trade marks which designate the EU rather than the UK unless the latter have opted-in to the notification process.

Therefore, if you have registered a CTM and somebody seeks to register the same or confusingly similar UK trade mark, if you have not opted in to the notification system and do not have a watch service it is likely that you will miss the application which could have a detrimental impact on your CTM in the future.

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Why register a trade mark in the first place?

There are a number of good reasons why you should register a trade mark. A registered trade mark provides you with a property right and makes it more straightforward to assert your ownership of the mark and to stop others from infringing your trade mark. It also makes it easier to licence, sell or control the trade mark. If you wish to sell your business it is likely that the purchaser would prefer to know that the brand assets are protected and a registration goes a long way to proving this.

What can be registered?

A trade mark is defined as any “sign” which is capable of being represented graphically, including personal names, designs, letters, numerals, the shape of goods or their packaging, providing that the “sign” is capable of distinguishing your goods and services from those of other people’s goods and services.

In short, distinctive words, logos and shapes can be registered. Provided you can get over the “represented graphically” hurdle it is possible to register sounds and even smells. In a competitive market, trade mark practice law and practice has developed substantially over the last fifteen years and if you believe that you have a distinctive brand or logo or some other distinguishing trade feature it is likely that you will be able to protect it with a trade mark application. We can advise you in relation to the registrability of, and practice relating to, UK, Community and International applications.

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