



SHEPHERD+ WEDDERBURN



# TRADE MARK PROTECTION

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## Trade Mark Protection

Registered Trade Mark Protection provides the highest level of protection for the name of your business or product.

A Trade Mark Registration gives a statutory right to use your mark and to take action against misuse by other people.

The costs for obtaining a registered Trade Mark are outlined later. Registrations are “territorial” and a Registered Trade Mark only gives protection in those countries where protection has been obtained.

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## Registered Trade Mark Protection

Registering your business or product name as a Trade Mark gives you monopoly rights to use that name in connection with the goods and/or services in respect of which it is registered.

Taking action against third parties infringing the Registered Trade Mark is generally easier and more effective than an action based on unregistered rights.

Once registration is achieved you will also be able to use the ® symbol in conjunction with your Trade Mark. The ® symbol signifies that the mark is registered and as such should only be used in territories where registered protection has been achieved. Please note the ™ symbol may be used against a Trade Mark regardless of whether that mark is registered.

We can provide Trade Mark Registration services throughout the world.

## Searching

Before committing to a new name for a business or product you may wish to consider making checks to ensure your chosen name does not conflict with the rights of another business. If you proceed with your chosen name and do not firstly check that you are free to do so, you may be infringing pre-existing Trade Mark rights.

Obtaining a search of the UK and/or EU Trade Mark Registers (and the Trade Marks Register in such other territory as is relevant) will confirm whether there are any other businesses who have registered or applied for a similar or identical mark.

As well as registered rights, there may be businesses that have unregistered rights to a chosen name. There is no database of unregistered marks and therefore unregistered use is not always easy to identify.

General enquiries about your chosen name should be made and you should in particular be careful not to choose a name already in use by one of your competitors as this will present a real risk of a passing off claim (or indeed registered Trade Mark infringement) being raised against you.

## Searching costs

We can carry out clearance and diligence searches internally at a cost of £110 (exclusive of VAT) per search.

Our fees for carrying out clearance and diligence searches and providing a verbal opinion would likely be between £550 and £800 and, for providing a written analysis, would likely be between £1,500 and £2,000 per mark. These figures may increase depending on the number of classes and territories to be covered.

[Further details and costs of clearance and diligence searches can be provided on request.](#)

## Applying for a Registered Trade Mark

The process for registering a Trade Mark involves three stages:

1. Pre-application
2. Examination
3. Publication and Registration

An application for a Trade Mark must specify the goods and services in respect of which the Trade Mark is currently used or will be used. These goods and services must then be classified into the correct use class. There are 45 classes covering all conceivable goods and services such as clothing, food, paint, computer services, etc.

We would discuss with you the goods and services you intend to market under your chosen business or product name and create goods and services specifications.

A decision also needs to be made about where you want to protect your Trade Mark. This may be a decision on whether you wish to apply for an EU-wide Trade Mark or for UK protection only (although you may require to consider additional or alternative territories if you have plans to use the mark elsewhere). An EU registration is more expensive than a UK registration but is recommended if you are or intend to be trading in the EU.

You must have a genuine intention to use the mark in the relevant territory before you apply to register. In relation to an EU-wide mark, use can be in any country within the EU to qualify.

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## Applying for UK protection & costs

The UK Intellectual Property Office generally takes three to four weeks to carry out its initial examination of an application to register a Trade Mark. However this may take longer if any issues arise. Provided any issues that the UK Intellectual Property Office raises in its examination report can be dealt with, the application will be accepted and will proceed to the publication phase.

The UK Intellectual Property Office fee for an application is £170 including one goods/services class and a further £50 for each additional class thereafter (e.g. for a Trade Mark application in three classes the fee would be £270).\*

Once accepted, the Trade Mark application is published in the UK Trade Marks Journal for a period of two months, with an option to extend the publication period by one month on application, during which time third parties may raise an opposition against registration of the mark.

If no oppositions are raised (or if any made are overcome) the application will be registered following the end of the publication period.

## Applying for European protection & costs

Similar principles apply to European Union Trade Mark applications as to UK Trade Mark applications. However it does take slightly longer to register an EU Trade Mark application. This time can be reduced by opting to bypass the national search stage carried out by the European Union Intellectual Property Office. Doing this impacts on the commercial information you previously got from the national searches but if there is a particular member state you wish to search for conflicting marks we can do this directly.

The official fees for an EU Trade Mark application are €850 for one goods/services class and €900 for two goods/services classes. A further payment of €50 per class would be payable in respect of each additional class beyond two. \*These costs would be in addition to our fees.

“If no oppositions are raised the application will be registered following the end of the publication period”

\*The official fees referred to in this note are subject to change by the Trade Mark Registers from time to time and are correct at the time of printing.

## Applying for worldwide protection & costs

We can provide further information and costs for seeking international protection for your Trade Marks on request.

Depending on the territories involved, multiple territories can for instance be covered in one specific process that involves a series of applications. This will secure priority for the mark (thus ensuring that a competitor cannot register the mark in the meantime) and could save on costs.

## Our charges

Our fees for processing a Trade Mark application on your behalf can vary according to various factors, including whether there are any other similar marks already registered in the relevant Register or whether the relevant Registry, or indeed any other party, has any objections to registration of the mark. We would expect our fees for a straightforward UK application in up to three classes to be £1,375 plus VAT.

Similarly, our fees for an EU application in up to three classes would likely be £1,705 plus VAT. In each case there is normally a minimal additional fee for administration and issuing the registration certificate (approximately £150 - £200), which arises at the end of the process if successful. Quotes for applications involving more than three classes or for applications in other territories can be provided on request.

## Trade Mark Watching Service

One of the simplest ways in which to keep track of third party behaviour which may impact upon your branding is to place a “watch” on your important trade marks so that you can stay informed of any third party trade mark applications being made for similar marks and take action before a third party obtains registered rights. Once a similar third party trade mark gains registered status, it not only dilutes the value of your brand protection but it is also more difficult to challenge than at the application stage.

We can tailor our watching service to suit your individual needs. The standard watching service which most clients find to be of use includes:

- reviewing watch notices as they are received; and
- issuing a monthly report detailing any potentially similar trade mark applications and giving opinions on which applications are potential issues. The client can then contact us before the relevant opposition deadline to discuss the need for further investigation, co-existence agreements or oppositions.

For more information on Trade Mark Protection please contact:



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