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Everything you need to know about applying for a trade mark

A timeline showing the various stages of the application process can be found in the centre pages of this booklet. In the UK the body charged with granting UK trade marks is the Intellectual Property Office (IPO) www.ipo.gov.uk

Application checklist

1. Make sure you understand what can or cannot be trademarked.
   See page 1 of this guide.
2. Determine which classes of goods/services you need to register in. Make sure you have the right classes (if necessary contact the IPO to clarify).
   See page 2 of this guide.
3. Start to draft ideas for your trade mark. If it is a logo do not go beyond sketches at this point. You should not waste time producing a finished design, or, worse, commissioning someone else to do so, until you have thoroughly searched for existing trade marks.
4. Carry out a trade mark search. The databases you should use will be determined by where you wish to seek protection. See page 8 of this guide. You would be advised to employ a trade mark attorney if you wish to apply beyond the UK. See pages 8 to 13 of this guide for information on searching databases.
5. Make sure you are familiar with the application process
   See pages 4 to 5 of this guide and the timeline in the centre pages of this guide (pages 6 to 7).
6. File your online trade mark application.
7. Await the search report. Respond to any objections raised by the examiner.

What is a trade mark?

A trade mark is a sign which distinguishes your goods or services from those of your competitors.

The best trade marks often consist of invented words (e.g. Adidas), common words used in an unrelated context (e.g. Orange or Sky) and logos that allude to a particular quality, but only indirectly (e.g. Apple's logo refers to the apple that fell on Newton's head and therefore obliquely to inspiration and innovation). Read the **Trade marks: Protect Your Brand** guide on the IPO website before proceeding:
www.gov.uk/how-to-register-a-trade-mark/register-a-trade-mark

Exceptions

A trade mark must be distinctive. A trade mark **cannot** be registered if it:

- Describes your goods or services or any characteristics of them, e.g. Quality Furniture.
- Has become customary in your trade. A descriptive or customary term can be made distinctive by the addition of a name.
- Is a protected emblem (includes flags, state emblems, official signs and abbreviations and names of international inter-governmental organizations), e.g. the Olympic rings are protected and cannot be included in a trade mark.
- Is offensive, deceptive or promotes something which is illegal.

The most common mistake is trying to register a purely descriptive trade mark that has nothing to make it distinctive. Make sure you avoid this!

Trade mark classification

What is classification?

When you apply for a trade mark you must specify which classes of goods/services you wish to use your mark in conjunction with. This is called the **Nice** classification scheme and is an international standard, so these classes will apply no matter which country you apply to or which database you search.

If you find the same/similar marks in different classes and there is no likelihood that the goods/services provided by the owner of this mark will overlap with yours it may still be possible to have your mark registered. On the other hand your mark will have to be very different from an existing one in the same classes and where the owner trades in the same goods/services as you.

What online resources are available?

For an overview of the classification scheme go to the UK IPO website:
www.gov.uk/government/publications/how-to-classify-trade-marks

Click the **Trade mark classification list of goods and services** link to get a list of all the classes with a summary of the main goods/services in each class. Classes 1-34 relate to goods and 35-45 to services.

If you need to search for keyword terms to identify the class use **TM Class** (there is a link to this from the IPO web page above):
oami.europa.eu/ec2

Using the basic search facility you can only search for results that contain ANY of the search terms entered. Click the Advanced Criteria button to search using either:

- **Word prefix:** will only retrieve results containing all words that begin with

the terms entered (similar to wildcard searching)
- **Full phrase:** will retrieve results containing the exact phrase only (in this case wildcard searching does not apply)
- E.g. search for the words *social network* using Word prefix and you will discover that online social networking services fall in class 45; do the same search using Full phrase and you get no results (in this case you only get results when you enter *social networking*).

A full guide to the Nice classification can be found at:
www.wipo.int/classifications/nice/en/
Click the **Browse and search the NCL** link**.** There is a numerical list, an alphabetical list and a keyword search facility. The alphabetical list is very useful for browsing (and, interestingly, you can present this list in both English and French), however the keyword search is quite basic. In short, the above link is useful for browsing, whereas **TM Class** is better for keyword searching.

Listing Your Goods/Services

In addition to selecting which classes you wish to register in you must also list all the goods/services you are providing or intend to provide. Although in some circumstances amendments may be possible you should consider carefully what you are intending to do or are likely to do in the future—try to think five years ahead!

Once your mark is registered you can effectively add more classes by later re-applying, which of course means paying the full application fee again. If you have wrongly classified the goods/services described on your application the examiner may give you the opportunity to add extra classes to accommodate this before it is examined.

There is no increase in cost to list more goods/services within the class, but you should not be listing items you are unlikely to provide. Your competitors can apply to have these revoked if you have not begun to provide them

Application process

A timeline summarizing the application process appears overleaf.

File your application

After you have carried out your searches and are satisfied that it is worthwhile applying you can file your application very quickly online: www.gov.uk/register-a-trademark

If your trade mark is a logo you will need to prepare a good quality digital copy.

For UK protection you will pay £200 for the first class and £50 for each additional class. You have two main choices:

- You can opt to pay the whole application fee up front and benefit from a £30 discount for applying online **or**
- Use the Right Start application and pay half the fees up front and the other half after you have received the search report. In this case you will not qualify for the £30 discount.

(You can still send your application in hardcopy but at full cost).

You can apply for a series of marks where there are slight variations on the mark. Limited to a maximum of 6, the first two are included in the application fee and from 3-6 at £50 each. Very strict rules apply, see the following document (the section on *Series* begins on page 214 of the pdf): www.gov.uk/government/publications/manual-of-trade-marks-practice

Respond to examiner's report

If there are any problems with your application, for example, the examiner is unhappy with the wording of your goods/services description, you will have the opportunity to respond to this. You will receive a search report within 20

working days and have up to two months to respond to it. If you used the Right Start application you will need to pay the other half of the fees to proceed with the application. The IPO will not refuse your mark if there are earlier conflicting marks, but the owners of these marks will be notified and the onus is on them to object.

Wait for the opposition period to elapse

Before your mark can be registered it must first pass the opposition period. This lasts 2-3 months and during this time your application details are advertised in the Trade Marks Journal which can be found online, on the IPO website,
www.gov.uk/check-trade-marks-journal
If no one objects within 2 months your mark can be passed for registration. However, if the owner of a conflicting mark wishes to object, but is unable to present their case within the 2 month time limit they can apply to extend this to 3 months.

Extending protection to Europe and other countries

You can achieve protection throughout the EU by applying for a European Community mark. If you wish to apply in other countries you can use an international system called the Madrid system. This is based on two treaties, the Madrid Agreement and the Madrid Protocol (states may be party to either one or both of the treaties). The UK and EU are members of only the Madrid Protocol, so your application must exclude states which are signatories of the Agreement alone. See:
www.wipo.int/madrid/en/members for lists of members.

If you apply within 6 months of your UK application you can claim priority, which means you will have precedence over any applications in those countries you are applying to which were filed after your UK application.

UK trade mark application timeline

0 Days

File trade mark application

Form TM3, £200 application fee for first class of goods/ services; £50 for each additional class (£30 discount for online filing)
Series of marks: two covered by application fee, 3-6 at £50 each

Right Start application: Pay half the fees now and the other half after receipt of examination report (but NO discount for online filing)

Receipt of application: You will receive notification that your application has been received with an application number and filing date allocated, usually within a week

20 Days

Examination report issued within 20 days. Any objections to your proposed mark are raised. You are notified of any conflicting marks

Before submitting application: Once you have submitted your application your fee will not be refunded for any reason and you cannot make substantial alterations to your application except correcting

2 Months

Respond to the examination report

Within 2mths. If using Right Start examination you must now pay other half of fees if you wish to proceed

Notification of opponents: You are notified in the examination report of similar marks. If you proceed with your application these opponents are notified and it is up to them to object to your application

3-6 Months

Opposition period. Your application is advertised in the Trade Marks Journal on the Intellectual Property Office website for 2mths to allow opposition (this can be extended to 3mths by anyone wishing to raise objections)

6 Months

Registration of trade mark

Final deadline for claiming priority when extending protection overseas

10 Years

Pay renewal fees

Form TM11 or renew online, £200 for first class of goods/ services; £50 for each additional class (no discounts). Subsequent renewals occur every 10 yrs (can be renewed indefinitely)

Protection overseas: A European Community Trade Mark will protect you in all EU countries. You can apply internationally via the Madrid Protocol (to do this you must make a UK or European Community trade mark application first). You can still apply overseas after the 6mths have elapsed, but cannot claim

Late renewal: You can still renew your trade mark within 6mths of the renewal date by paying an additional £50 fee

Further information: www.ipo.gov.uk

Restoration: Within 6-12mths of the renewal date you can still apply to restore the trade mark by paying an additional £100. This is subject to approval - you must have a very good reason for not renewing on time! Use **form TM13**

Typical time to registration is 4 to 6 months

The databases you need to search will depend on the intended scope of your trade mark:

- For UK only use the UK IPO site and the OHIM.
- For European protection use the OHIM site and TM View for national European trade marks.
- For international protection use Romarin for trade marks applied for under the Madrid system and also national trade marks for the countries you intend to include. National trade marks can sometimes be searched via the national Intellectual Property Office of the country.
- For US only searches try tmQuest, www.tmquest.com , a free user-friendly US search facility, better than the US Patent & Trademark Office site.

We provide a paid trade mark search service suitable for anyone wishing to apply only for a UK trade mark. Please contact us for further details:
E: reference.library@hcandl.co.uk or T +44 (0)1482 223344

Searching: UK only

IPO (UK trade marks)

The database can be found at (click the **keyword, phrase or image** link):
www.gov.uk/search-for-trademark

Wordmark search

The **Type of Search** will show as **Word** by default. The **Search Type** is set to **Similar** by default. Click the drop-down box and you will see other options. If you use the Similar option you are relying on the software to interpret all possible similar words and this might not be satisfactory. You need to stay in control of your search and you do this by using the **Contains String** option. In this case the search will pick up the words you enter wherever they occur even when surrounded by other text. The drawback is you can only string search one word at a time as the database considers everything you enter in

the box as the string to search.

You need to look at the words you are using and consider all possible similarities: similar spellings, phonetically similar words. Anything that could be confused with an existing mark could be opposed. Start looking for exact matches in all classes, then look for very similar marks, then focus on distinctive elements of the mark in the relevant classes (you can restrict your search to specific classes by clicking the appropriate buttons under Refine Search).

Most characters (e.g. apostrophes, hyphens, full stops) should be ignored when searching (the search engine will ignore them anyway, but inserting them may break up a word and affect your results). The only characters which can be searched are pound (£), euro (€), dollar ($) and 'commercial at' (@ - if you find the English word for this symbol too drab simply insert your own language's word for it here).

ALL/ANY words radio buttons toggle between AND and OR functions.

Image search

Visual trade marks are commonly known as logos, but you will see them referred to as **Devices** in intellectual property literature. Another classification scheme, the **Vienna Classification** is used to describe the constituent elements of a logo.

Change the **Type of Search** to **Image**
You should first select a Category, then Division, then Selection.
E.g. for the Apple logo the Vienna classification would be: 05 Plants; 05.07 Grains, Seeds, Fruit; 05.07.13 Apples. Make a note of the class numbers: you will need to use them when searching other databases.

If your logo contains constituent elements in more than one class you can click the **Add Image Class** button.

Do not confuse this class with the Nice Classification: the Vienna class refers to the actual pictorial elements in the logo and **not** the goods/services you provide. Note that you cannot search in the classes 26 (Geometrical Figures) and 27 (Forms of Writing) on the UK IPO site.

A full listing of the Vienna Classification can be found at:
www.wipo.int/classifications/vienna/en/
Click the **Browse and search the VCL** link.

Some searches can yield too many results; only 1000 can be viewed so you may need to break down your search into chunks by using class and date range

Combined Wordmark and Image Search

You can also combine searches using the option **Word and Image**. However, even if you intend to apply for a word and logo in a single trade mark you should still search separately for word and logo elements. This combined search may be useful in some cases, for example where your logo consists of a cartoon character in the shape of a letter. Searching for a single letter by itself would be pointless, but when combined with the image search it should quickly reveal anything too close to your intended mark.

Interpreting Your Results

After you click **Search** you will get a list of results providing mark text, image and Nice classes. To see full details for a mark click on the blue Trade Mark Number. This will itemize details of the mark such as current status and a full list of all the good/services the owner provides within the classes they are registered in. This could be very useful as a potentially conflicting mark even within the same class may be restricted to goods/services that do not overlap with your own. You may wish to seek the advice of a patent or trade mark attorney to interpret the results.

Searching: European marks

OHIM (European Community trade marks)

oami.europa.eu/eSearch/

The Office for Harmonization in the Internal Market (OHIM) is the body charged with granting European Community trade marks. The database is called **eSearch Plus**. Click the **Advanced Search** link.

There are a number of tabs in the centre of the page; the first, Trade Marks, should be active. Use the **Trade Mark Name** field to begin your search. You can search for words using the options: Contains, Is, Begins With, Ends with (their effects should be self-explanatory). For a more controlled search you can use Wildcards (*) and Jokers (?), placing them anywhere within the search string. To search for more than one word or string you can use Boolean operators (AND, OR, NOT). Click **Trade Mark Name** in the **Add search criteria from below** list to add a new search box and select the operator from the drop-down list (it's AND by default). Use quotation marks for phrase searching.

If you wish to search using Vienna classification you will need to know the numbers for the classes of interest; fortunately these are given in the drop-down menus on the UK IPO search screen, so you should search there first and make a note of the relevant classes. Click **Vienna Classification** in the left hand list and a search box will be added. You can type the class number in the box and a suggestions list will pop up (you can also type keywords in the box for suggestions but this can be confusing). Input a complete class in the format: **nn.nn.nn** or use wildcards, e.g **nn.nn***

The results list shows trade mark, device and some details in a well-presented list. Click on the trade mark name for further useful details such as a timeline of the application and access to correspondence filed. For help use this link: https://oami.europa.eu/ohimportal/en/esearch

Searching: EU national marks

TM View (European national trade marks)

www.tmview.europa.eu

This database covers European Community trade marks as well as national trade marks from all EU countries and international marks under the Madrid system. It's coverage seems to be expanding as it now also includes data for Russian, US and Korean marks. Each country supplies its own data, so coverage is not consistent. For example, you cannot search Vienna classes at all for the UK.

Click the **Advanced Search** button. You can specify which offices you wish to search. For words you can use Wildcards (*), before as well as after the word. The search will be for all words/strings entered (you will see the word AND entered for you in the top search box). You can use the OR operator but only by entering it manually in the top search box (it must also be in capitals). To do this: enter your search terms in the Advanced Search Trade Mark Name field, run the search, then in the top search box change AND to OR and run the search again.

Note that the results appear at the bottom of the screen, so you can modify the search by going back to the top of the page.

Add Vienna classes in the same way as for OHIM (see previous page). You can also use wildcards with Vienna classes, e.g. nn.nn.* . Use the magnifying glass icon to the right of the search box to bring up the Vienna selector.

Searching: international marks

Romarin (international trade marks)

www.wipo.int/romarin

To search for words type in the field headed **Mark.** By default any words added will show in the results. Use **+** before word to include or **-** before word to exclude. Use quotation marks to search for a phrase. You can use Boolean searching (AND, OR, AND NOT), **w/n** (where **n** is an integer) shows results where the second word occurs within **n** words of the first, Wildcards (*****) can be used before, after or within a word string, and also Jokers (**?**). Also supported are Phonic searching (**#** before word) and Synonym searching (**&** before word).

To use Vienna classification enter class numbers in the form **nnnnnn.** You must know the number; there is no lookup table. There is a link to the full Nice and Vienna classifications in the left hand menu (referred to on pages 3 and 10 of this booklet). You can limit searching by **Nice** classification and by keywords in the goods/services descriptions.

When viewing the results screen use the left hand menu to take you back to the search screen. If you wish to view the details of a particular mark open it in a new window or tab as there is no route back to the results list and hitting the back button will result in an annoying “Webpage has expired” message. Use the **MRS** button (Madrid Real-time Status) to get the current status of the mark. A nice feature is the ability to download a results list or individual mark details.

Global Brand Database

www.wipo.int/madrid/en

A growing resource for searching international brands. Has a nice feature allowing you to upload an image to search for devices, but this should be used with caution.

Every effort has been made to ensure this information is accurate. Please inform us if you are aware of any errors or omissions.

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