



pure ideas 

Trademark Basics

What is a trade mark?

The legal definition of a trademark is “any sign which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and of distinguishing goods or services of one undertaking from those of other undertakings.” (Section 1 of the Trade Marks Act 1994)

Put simply, a **trademark is an identifying sign that helps to identify the source and distinguishes the goods of one business from those of another.**

A trademark is a valuable business asset in helping customers to identify your brand and help create brand awareness.

What is or is not a trademark?

A trademark must be unique and distinctive. Practically anything can be a trademark as long as it is distinctive and not descriptive .

A trademark can include:

- Words
- Images/Logos
- Colours
- Company Names
- Slogans
- Patterns
- Shapes
- Sounds
- Scents
- Or a combination of all.

Certain things cannot be registered for example if the mark is generic; if it is contrary to public morality, offensive or is misleading; if it contains a flag, coat of arms or state symbol; or most importantly, if the mark describes the goods or services it will relate to.

Famous trademarks

There are lots of famous examples of trademarks and we are surrounded by trademarks on a daily basis:

Word Marks

VOLVO

Figurative Marks



Figurative Mark containing word elements



Shape Mark



Shape Mark containing word elements



Position Mark



Pattern Mark



Colour Mark - single



Colour Mark - combination



Sound Mark

The Intel 'inside bong'

Motion Mark



Source: <https://euipo.europa.eu/ohimportal/en/trade-marks-examples>

What is the benefit of registering a trademark?

Registered trademark protection does not arise automatically and needs to be applied for. Having a registered right helps you to protect your brand and stop other people using, copying or stealing the same names of your products or brands or offering the same services as you under the same or a similar name.

Once you have registered your trade mark, you can:

- Use the ® symbol next to your mark to show that it is registered right and to deter others from using it.
- Take legal action against anyone who uses your exact mark or a confusingly similar mark without your permission.
- Legally protect your brand and prevent others from registering the same or confusingly similar mark as a trademark.
- Sell and license your brand

Requirements for filing

To apply for a trademark, there are certain details you will need:

- A representation of the mark (so the word or an image/logo)
- The applicants (owners) name and address
- Goods and services specification

Intellectual Property Offices around the world use a trademark classification system that categorizes goods or services into 45 different classes. This is also known as the 'Nice Classification.'

This system lists practically all goods and services into different classes (Classes 1 – 34 for goods and Class 35 – 45 for services. For examples, clothes are in Class 25).

It's important you choose the correct class and terms that you will be using your mark for, as your trademark will only be protected for the goods and / or services included in your application and you cannot add classes to the application after filing.

Where to file?

Depending on where you are based or where you are using your mark and intend to use your mark, there are lots of options and routes to registration and each country has their own peculiarities when filing.

You can have a national trademark, for example in the UK or in the US; or you can have a regional trademark for example in the EU or there is an international trademark route which allows you to designate numerous countries you would like protection in one application. Each route has its benefits and drawbacks.

We recommend conducting a trademark search before filing an application. A clearance search searches the relevant trade mark registers to see if a mark is available for use and for registration before filing.

How many applications?

In most countries, it is one application per mark.

In the UK, there is a unique application process for 'series applications' where up to 6 different variations of your mark can be applied for in the same application (provided they look, sound and mean the same) for example ZEBRA 1, ZEBRA 2, ZEBRA 3, ZEBRA 4, ZEBRA 5 and ZEBRA 6.

There is another unique benefit to the UK system. If you are unsure your application will be accepted, you can use the 'Right Start Application' filing route to test the waters. You can pay half of the filing fees upfront and an Examiner will examine the application before issuing their report. This allows you to consider any objections before deciding whether to proceed with the application or not.

Oppositions

An application is published so that third parties can challenge if they believe it is identical or confusingly similar to their own. If they do, a third party can file a 'Notice of Opposition' against your mark.

Sometimes oppositions can be avoided by entering into agreements, amending applications or by adding exclusions to application to avoid overlaps.

The process for oppositions if they occur can be lengthy and expensive.

Cancellation actions can also happen after a mark has been registered if the mark is not in continuous use.

You can also object to other peoples marks if you believe they are identical or confusingly similar to your own.

Post-registration requirements:

Once a trademark is registered, it lasts for 10 years (in most countries, the U.K. being one). It is renewable indefinitely subject to the payment of renewal fees every 10 years.

But be aware of non use! Once a mark has been registered for five years (in most countries like the UK, three years in others for example in the US), you need to make sure the mark is still in use for all of the registered goods and services. If not, it may be vulnerable to a non use cancellation action by a third party if they believe it is not still in use.

Some countries also have additional maintenance requirements post registration for example in the US, during the fifth and sixth anniversary of registration, a Declaration of Use needs to be filed attesting that the mark is still in use for all of the goods and services registered.

After a trademark is registered, it is also recommended to implement a trademark watch to monitor registers around the world for any third party attempts to register identical or confusingly similar marks.

Applying for a trademark can be a complicated and drawn out process. We can guide and help you through the process from drafting through to registration and beyond. We offer competitive and fixed priced services and we can also provide you with training and education on all things Intellectual Property.

The UK Intellectual Property Office (UKIPO) website also has a lot of useful information to help.

<https://www.gov.uk/government/organisations/intellectual-property-office>



www.pure-ideas.co.uk | mail@pure-ideas.co.uk | +44 (0)19 9256 1756

Disclaimer: This document is for general information only. Its content is not a statement of the law on any subject and does not constitute advice. Please contact Pure Ideas for advice before taking any action in reliance on it.