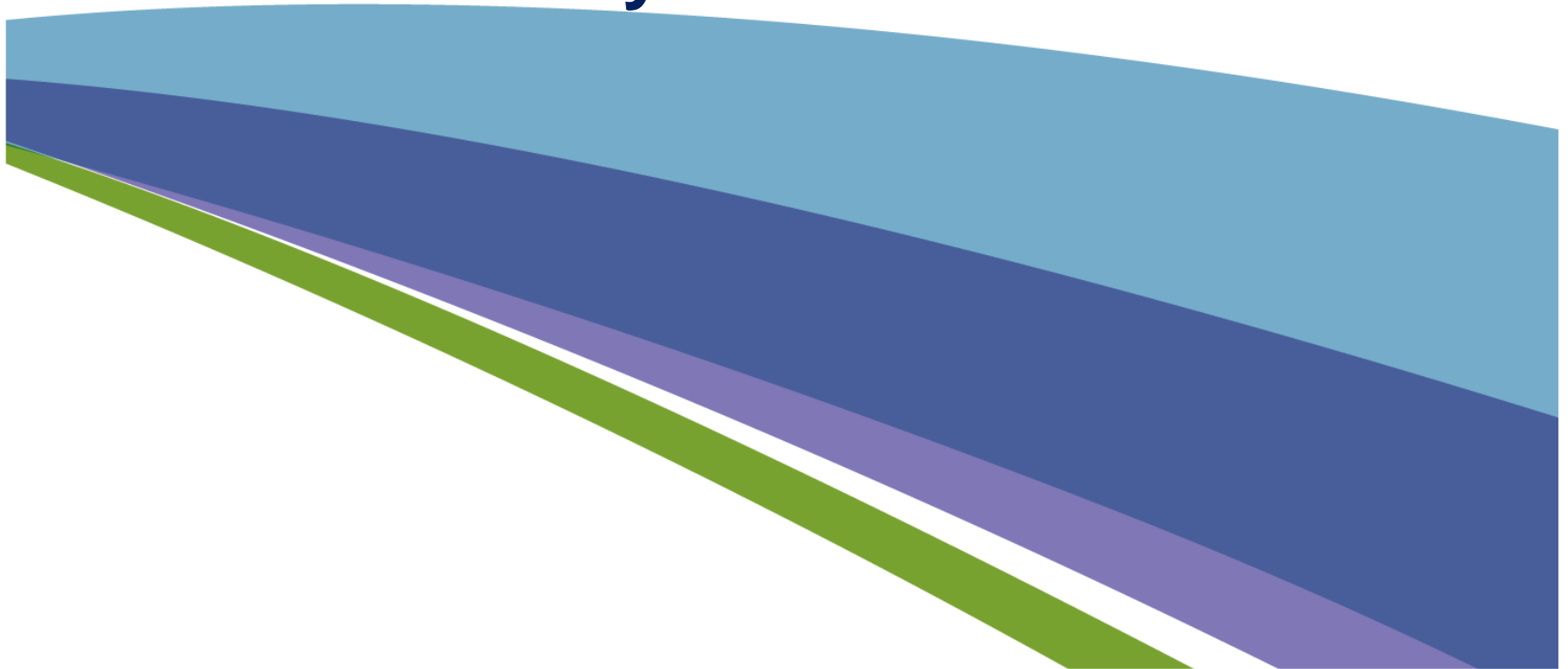




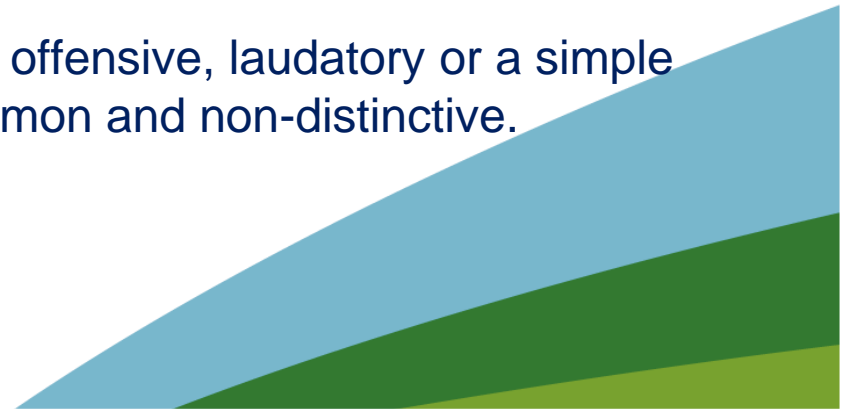
Intellectual
Property
Office

Trade mark Protection Strategy: National, Regional and International systems



What is a trade mark?

- A trade mark is a brand which indicates to consumers who the goods/services come from.
- A brand could be words, sounds, logos, colours or a combination of these.
- A trade mark is important if you wish to protect your business's reputation and to stop others from others using your brand.
- Trade marks are territorial e.g. a UK trade mark will only protect your brand in the UK.
- Your trade mark must be unique and meet the requirements of the 1994 Trade Marks Act.
- Your trade mark cannot be descriptive, offensive, laudatory or a simple statement which could be seen as common and non-distinctive.



Examples of trade marks



Filing a UK Trade Mark application

- You can file a UK application online or by post using the form TM3.
- The cost for a standard application starts from £200.
- A £30 discount is applied for filing online.
- You must select the goods and services your brand will be used on which will affect the cost.
- You should carry out a search of the register prior to filing.
- You should also read the application requirements prior to filing.
- You should receive a report within 20 working days



The UK process

- If there are any objections from the examiner you must overcome them or the application will be refused.
- An examiner is available to discuss any issues in writing or via telephone.
- You have a right to a hearing or an appeal if objections cannot be overcome at examination stage.
- If there are no objections from the examiner your application will be published in the online UK trade mark journal for two months for third party objections.
- If no objection is received by the end of this period the application is registered.
- An application is usually registered within 4 months if no objections occur.



Trade mark protection abroad



Plan a strategy for protecting your brand prior to filing.



What are my options?

- There is no option to apply for a worldwide trade mark registration in a single application.
- You can file an International application via the Madrid Protocol which covers approximately 117 countries (80% of world trade).
- You can apply for a European trade mark for protection in the European Union.
- You can also file directly to individual countries via their national or regional offices.
- Some UK territories may allow you to extend your UK trade mark protection so that your rights are accepted as being protected in that country.
- Be aware that different laws and practices may apply to different countries.
- An application acceptable in one country may not be successful in another.



European Trade Mark Protection

- A European Union trade mark or EU trade mark is a trade mark which is pending registration or has been registered in the European Union as a whole (rather than on a national level within the EU).
- The EU trade mark system creates a unified trade mark registration system in Europe, whereby one registration provides protection in all member states of the EU.
- The European Union consists of 28 member states.
- The EU trade mark system is administered by the European Union Intellectual Property Office, which is located in Alicante, Spain.
- The basic cost of filing an application online is 850 Euros.
- The application requirements and process is similar to the UK process.
- If it fails in one country the whole application fails in all. However, the application can be converted to national trade marks.



International application via the Madrid Protocol

- The application must be based on a previous application/registration e.g. UK or EU.
- You can file an application by using the WIPO's form MM2 (the UK IPO has an adapted the form to suit their requirements).
- You must file the form via the UKIPO or the EUIPO if basing on a UK or EU trade applicant/registration.
- The cost of an international application depends on how many classes you wish to protect the brand in relation to and in how many countries you wish to have protection in.
- The international registration is dependent upon the base mark for a period of 5 years from the date of filing the application form MM2.

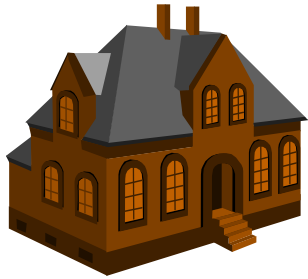


The UK as the base application/registration

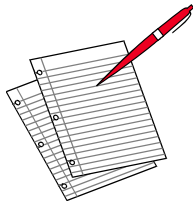
- The application via the UK can be filed via email international.trademarks@ipo.gov.uk , fax and post.
- A certification examination will be carried out at a cost of £40 which should be paid to the UK IPO.
- If there are no issues the application will be transmitted to WIPO for their examination and you will receive a letter of certification from the UK office.
- If an issue is found with any section of the form a deficiency letter is issued to the applicant or their representative with a deadline of a month to respond.
- Responses can be sent via email to trademark.examination@ipo.gov.uk
- The application must be transmitted to the WIPO within two months of filing
- If the WIPO find any issues they will issue you or your representative with an irregularity notice.



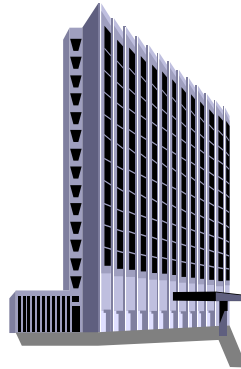
Progress of an International Trade Mark Application (IA)



**Base mark in
country of
origin**



**International
Application
(English
language)**



**Certified by Office of
Origin(OO)**



**Forwarded to
WIPO**



International registrations received in the UK via the WIPO

- The registrations are filed at a national or regional office (other than the UK) and start as an international application.
- They are certified by the national or regional office (office of origin) and transmitted to the WIPO.
- The UK is designated in the list of countries and the WIPO will transmit the application to the UK IPO to examine within 18 months.
- They are examined under UK Law, the same as our domestic applications.
- If any objections are raised, then you must respond directly to the UK.
- The processes and time lines are mainly the same as a domestic application.
- Corrections, limitations or withdrawals must be made through the WIPO. We cannot carry out these amendments without notification from the WIPO.



Any questions?

