

Unregistered and Registered Trade Marks



There is no legal requirement to obtain a registered trade mark as common law trade marks can arise through use. To establish a common law trade mark it is necessary to show goodwill and reputation in the mark in question. This is often very difficult, particularly if the mark is in the early stages of use. If a third party uses your company's common law trade mark it is possible to raise what is known as a "passing off" action.

The amount of use required depends to a certain extent on the mark in question, in that, if the name or mark is common or consists of ordinary language, a greater degree of use would be required before you could raise a "passing off" action and be successful. In addition, proving the confusion and damage to the mark through use of the mark by a third party can also prove difficult, and would have to be addressed on each occasion that a potential infringement came to light.

Why Register a Trade Mark?

The UK Trade Marks Act 1994 applies to the Isle of Man and therefore UK trade marks extend to the Island.

- i). If registered, a trade mark provides a statutory monopoly to use the mark which is obtained in connection with the goods and/or services in respect of which it is registered. As the registered owner of the trade mark, the mark can be protected where protection is needed most. i.e. against rivals offering similar goods/services.

- (ii) Formal trade mark registration provides more immediate protection than passing off, and has the benefit that there is no need to prove reputation in the mark in order to prevent a rival from using it. It is enough to show that someone is using the mark which is the same or similar to your registered mark in the course of trade. Generally speaking, taking action against third parties infringing a registered mark is easier and more effective than under the law of passing off.

Applying for a UK Trade Mark

A trade mark is a sign which distinguishes the goods and services of one trader from another. In essence, a trade mark is a "badge of origin" used so that customers can recognise the product of a particular trader.

To be registerable, a trade mark must:

- be distinctive for the goods or services which it applies to; and;
- not be deceptive or contrary to law or morality; and,
- not be similar or identical to earlier marks for the same goods or services.

When an application is made for trade mark registration, the application must specify the goods or services in respect of which the mark will be used. These are known as "Use Classes" and, depending upon the Use Classes chosen, the application itself will vary.

The Trade Marks Registry in the UK (which is part of the UK Intellectual Property Office) administers the process.

The official fees payable to the Trade Marks Registry are £200.00 for one Use Class and £50.00 for each additional Use Class. However, from 1 October 2009 for applications made online there will be a £30.00 reduction.

The Trade Marks Registry in the UK has also just introduced a new service called “Right Start” that allows only half of the application fee to be paid at the outset and only once the examination report has been received and the applicant decides to proceed is the remainder of the fee payable.

If an application is unopposed by the examiner or third parties then the application process takes about 6 months.

Applying for a Community Trade Mark (CTM)

A CTM registration provides a route to obtaining protection of a trade mark throughout the EU in a single procedure. CTMs have the same Use Classes as UK marks.

The minimum official fees payable to the Registry responsible for Community Trade Marks (office for Harmonization in the Internal Market) is 900 euros to file online or 1050 euros if a paper form is submitted.

Unopposed Community Trade Mark applications take between 12—18 months to be registered.

The Process

The main process for both a UK and a Community Trade Mark are:

- preparation of application form;
- submission of application form and payment of relevant fee;
- examination by relevant Trade Mark Registry and issuing of report;
- once examination has been completed successfully, the application is published for opposition by third parties;

- if there is no third party opposition, the application will be granted. Thereafter, the Registration Certificate will be issued.

Should you have any questions or requests for further information please contact:

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