



## Business value through Trade Mark registration

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# Benefits of filing a Trade Mark

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## Exclusive Rights

Registering a trade mark provides legal protection and exclusive rights to use the mark in relation to the goods and services for which it is registered. This means that trade mark proprietors can prevent others from using similar marks which could confuse consumers, damage the reputation of its brand or dilute the distinctiveness of its mark.

## Legal Protection

Obtaining trade mark protection allows trade mark proprietors to take legal action against third parties who infringe its registered trade mark, including counterfeiters.

## Commercialization

A registered trade mark can be licensed, sold or

assigned to others for use in their own products or services. This can allow for new business ventures and provide a valuable source of recurring revenue for a business owner.

## International expansion

Registering a UK trade mark can be a valuable step in obtaining international trade mark protection, allowing business owners to expand internationally. Once a UK trade mark application has been filed, there is a six month “priority period” during which the trade mark proprietor can file subsequent applications overseas, and backdate those applications to the UK filing date. It is still possible to file further applications overseas once the six month priority period expires, however the filing date will not be backdated.

# UK Specific Trade Mark Practice

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To register a trade mark in the UK, it is possible to file a national UK trade mark application through the UKIPO, or file an international application, designating the UK through WIPO.

## Low Official Fees

Filing a national UK trade mark application can be beneficial due to the low official fees. The cost for filing a UK trade mark application online is £170 for the first class, with £50 for each additional class.

## Costs

By filing a national UK trade mark application in accordance with UK law, this lowers the risk of specification objections and therefore reduces costs.

## Processing

National UK trade applications are processed quicker than international applications, with UK applications often proceeding to registration within four months.

## Central Attack

International applications are filed based on a “home” national application/registration. International applications and its designations are therefore reliant on the home application/registration for the first five years of its life. If the base application/registration is cancelled, the international application and all its designations would fall away – this is known as “central attack”. Filing a national UK application avoids this risk.



# Differences in law with Europe

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Following the UK's withdrawal from the European Union, an EU trade mark registration no longer extends protection to the UK, and applicants must file a separate UK trade mark application. On 1 January 2021, the UKIPO created a comparable (cloned) UK trade mark for every registered EU trade mark. Each of these UK rights:

- Are recorded on the UK trade mark register;
- Have the same legal status as if it had been applied for and registered under UK law;
- Have kept the original EU trade mark filing date;
- Have kept the original priority or UK seniority dates;
- Are fully independent UK trade marks that can be challenged, assigned, licensed or renewed separately from the original EU trade mark.

As a result of the UK's withdrawal from the European Union, UK trade mark law now operates independently from the EU trade mark system. While the legal framework and tests applied by the UKIPO and EUIPO are effectively the same, there are some differences in interpretation and procedure:

## **Scope of protection**

A UK trade mark provides protection in England, Wales, Scotland and Northern Ireland. An EU trade mark provides protection in all 27 member states of the European Union.

## **Intention to use**

When filing a UK trade mark, the applicant must have a bona fide (genuine intention) to use the trade mark in relation to the goods/services for which protection is sought. While a lack of use can be grounds for invalidation of an EU trade mark, the initial application does not require a stated intention to use.

## **Timeframes**

UK trade marks are published for a period of 2 months during which third parties can file an opposition against the application. This period can be extended by one month by filing a Notice of Threatened Opposition (TM7A). The opposition period will only be extended for the party that files the TM7A. EU trade marks are published for a period of 3 months, and this deadline cannot be extended.

## **Bad faith**

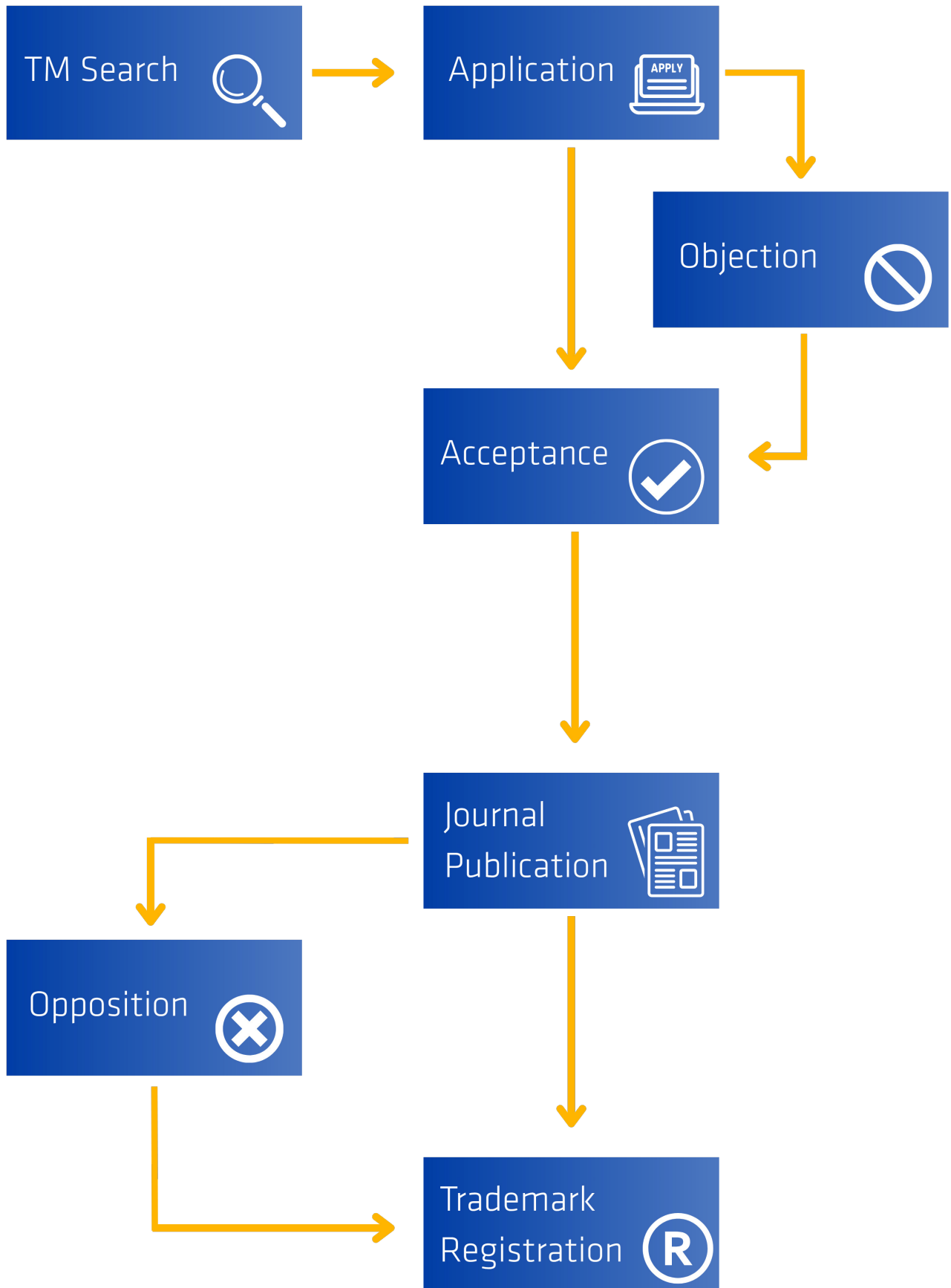
Prior to the *Sky v Skykick* case, the substantive law on bad faith was largely harmonized between the UK and EU. However following the decision of *Sky v Skykick*, the UKIPO has significantly changed its trade mark examination practice, particularly regarding overly broad specifications. Examiners will now actively consider whether specifications are "manifestly and self-evidently broad", and may raise bad faith objections during the examination process.

# Timeline of Prosecution

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1. Undertake trade mark search to ensure the mark is free to use and register. This step is not required, however not conducting a search carries significant risk.
2. File UK trade mark application.
3. The application is examined in accordance with the Trade Marks Act 1994.
4. If the application meets the requirements, it is published for opposition purposes. If the application does not meet the requirements, the UKIPO will issue an examination report, and provide the applicant two months to file a response to overcome the objection.
5. Once the application has been published, there is a two month opposition period in which third parties can file an opposition against the application.
6. If an application receives a Notice of Threatened Opposition (TM7A), the opposition period will be extended by one month for that particular party.
7. If no oppositions are filed, the application will proceed to registration shortly after expiry of the opposition deadline.
8. If an opposition is filed, the applicant will have two months from admittance of the opposition to file its defence and counterstatement.
9. If the parties wish to negotiate a possible settlement, the parties may jointly agree to enter a nine-month cooling off period. A request to enter the cooling off period must be submitted within two months from admittance of the notice of opposition. The cooling off period may be extended by a further nine months, up to a maximum of 18 months in total, with the agreement of both parties. Either party may terminate the cooling off period, if negotiations do not progress satisfactorily.
10. If a defence and counterstatement are filed, the opponent will be set a two month term to file its evidence in chief in support of the opposition. The applicant is allowed two months within which to file its own evidence in chief; the opponent is then allowed a further two months to file evidence strictly in reply.
11. Once the evidence rounds are complete, the parties have the option of filing written submissions or attending an oral hearing.
12. The UKIPO's decision may be appealed up to the Appointed Person or the High Court, within a period of twenty eight days.

The below diagram shows a basic UK trade mark application timeline:



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