

Trade mark registration

Fact sheet



Territory

A UK trade mark gives the owner the exclusive right to use (or license the use of) the mark on the specified goods and/or services within the UK. It does not confer rights on the use of the mark elsewhere; to obtain protection in the USA, for example, requires separate registration in the USA. Each country has its own register of trade marks. However:

The **EU Intellectual Property Office** maintains a register of trade marks with EU-wide effect.

The **World Intellectual Property Organisation (WIPO)** operates the Madrid system, which allows trade mark applications to be filed in designated overseas countries (following this “international” phase, the applications are then examined by the local registries in a “national” phase).

Any filing strategy therefore needs to consider which countries **goods or services** bearing the marks will be supplied in. If EU or wider international protection is required, we can coordinate the necessary filings through our network of overseas associates and agents.

Goods and Services

The exclusive rights conferred by a trade mark registration are limited to the goods and services on which the mark is to be used. These are set out in a “**specification**” when an application is filed. All goods and services are classified by international agreement into **45 different classes**. The more classes you include in an application, the higher the filing fee will be (see following page).



Which classes do you need?

A trade mark application requires confirmation that the applicant has a legitimate intention to use the mark. This can clearly be provided where the mark is already in use on the specified goods or services. Goods or services on which the mark has not yet been used should only be included if there is a good faith intention to use the mark on them.

Goods or services cannot subsequently be added after an application has been filed. To obtain protection for new goods/services (even for exactly the same mark) a fresh application has to be made and paid for.

Once registered, if a trade mark is not used on goods or services for an uninterrupted period of five years, the registration can be revoked on application by a third party. Revocation can be total or (if it only relates to certain goods or services) partial.

The specification of the goods and/or services provided to the Registry is a critical part of any trade mark application. As a statement of the goods or services for which trade mark protection is sought, it needs to be sufficiently comprehensive to cover products of immediate interest and, provided that there is a good faith intention to use the mark on them, those of future interest.

Examiners look carefully at draft specifications and require them to be precise and clear enough for tribunals and others in the market to understand what is covered. Reference is often made to the internationally agreed “Nice Classification” whose use is mandatory by IP offices of signatory countries (including the UK), as well as by EU IPO and WIPO.

For these reasons, drafting trade mark specifications is an expert task for which professional assistance is strongly advised.



How much will registration cost?

In addition to our professional fees for advising on filing strategy and handling the application process, **official fees** are payable. As a general rule, the wider the territory and the greater the number of classes applied for, the more the application will cost. The table below summarises the official fees for a basic application in the UK and the EU.

Cost	UK	EU
Application fee	£170 (for one class only)	€850 (for the first class)
Each additional class	£50	€50 for the second class and €150 for three or more classes

The costs will increase with each separate application filed. Sometimes they can be managed, for example by applying for a combined word and logo mark but this usually entails some loss of overall protection.

We do not charge any annual “retainer” for managing our clients’ trade marks. Our charges are based on the amount of time that we spend on the task and not on any fixed rates which, in our experience, can result in higher charges. For example, renewing multiple UK trade marks simultaneously normally involves no more work than renewing just one registration, so a flat rate charged for each mark will lead to higher overall charges.

Prior rights and searches

If a trade mark identical or similar to your trade mark has previously been registered for identical or similar goods or services, the UK Trade Marks Registry will notify the owner of that earlier trade mark. By contrast the EU IPO leaves it up to the owner of any conflicting prior marks to object when the application is published.

We generally advise that a search of the Register is carried out before an application is filed. Identifying prior rights is especially important if you are already using the mark that you wish to register, because you may be at risk of infringing the earlier mark.

Registration does not afford a defence against a valid earlier mark.

We can carry out searches for you or arrange for them to be made in other territories.

That said, although a pre-application search is important, there is no guarantee that the Trade Marks Registry or a third party will not raise an objection through the course of the application.



Portfolio management

Farrer & Co uses a specialist intellectual property management system to monitor the progress of trade mark applications, generate reports and manage the renewal of registrations. Where clients have extensive trade mark portfolios we can arrange for them to have secure access to an online portal so that they can themselves monitor the progress of applications and generate reports.

Registered designs

A separate and distinct regime exists for the registration and protection of new aesthetic designs (the shape of products or devices). Like trade marks, registered design protection can be obtained from the UK or the EU Registries but unlike trade marks there is no “specification”, so the scope of protection conferred by a design registration is not limited to copies made in any particular areas of business. A registered design should not be considered as an alternative to a patent or a registered trade mark but in some circumstances it can provide helpful additional protection for your investment in a product or device.

If you would like to know more about applying for a trade mark or a registered design or if you have any further queries about the material set out in this note then please contact David Copping or Owen O'Rorke from Farrer & Co's Intellectual Property Team on 020 3375 7355 or by email at trademarks@farrer.co.uk.

*This fact sheet is a general summary of the law.
It should not replace legal advice tailored to your
specific circumstances.*

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