

A BRIEF INTRODUCTION TO TRADE MARKS AND TRADE MARK SEARCHING

Updated June 2020



Intellectual Property consists of three types which you register

- **Patents** - How something works or the method of making it.
- **Designs** - Protects the overall visual appearance of a product or a part of a product.
- **Trade Marks** - The sign by which you distinguish your goods or services from those of your competitors.

and two which you don't

- **Copyright** - Artistic or literary expression.
- **Know How** - Valuable information not readily available to the public. Highly confidential Know How is known as a **Trade Secret** and should be protected by legal agreements.

What is a trade mark?

Trade marks, broadly speaking, indicate the origin of goods or services. Traditionally this was done by using words, logos, pictures or a combination of these elements, now trade marks can also be sounds and/or gestures. Shapes of products can also be registered. Registering a trademark allows you to stop others from using it without your permission.

Trade mark registration lasts 10 years and is only valid in the country of registration. However, trade mark registrations can be renewed every 10 years on payment of renewal fees and a trade mark can therefore last forever.

To register a trademark, it must be clearly different from any trademarks already registered for the same type of products or services. When choosing your trade mark don't use words that describe what you do as descriptive marks will be refused registration.

Company names and domain names aren't automatically trademarks. Company names, domain names and trade marks are three entirely separate things and that ownership of one does **not** automatically entitle you to ownership of the other two

You register:

- company names with Companies House
- domain names with domain name registrars

Once you've done that, you may be able to register company or domain names as trade marks.

Trade mark systems available to British Applicants

The UK National Trade Mark - only covers the UK (Great Britain and Northern Ireland).

The European Union trade mark or **EU trade mark** (abbreviated **EUTM**; currently covers the 28 countries of European Union (EU). The EUTM is a "unitary" right, if one EU country objects, the trade mark fails for the entire EU.

The Madrid Agreement Protocol - covers many countries around the world.

Madrid is not unitary, so if one member state objects the application fails only for that country.

You can apply to more than one of these offices, but can finally register in only one.

If you apply for foreign protection within six months of your application under the UK national system the foreign application is regarded as dating from the original application date. This allows you to claim the registration should anyone else apply for the same trade mark in the same office during the time between your UK national and any foreign application. You can apply later than six months, but in that case the first applicant wins.

Hints and tips

- Make up your trade mark – e.g. *Adidas, Kodak, Nike, Ohyo*.
- Do a thorough search – *Search all jurisdictions in which you wish to trade.*
- Think ahead – *a trade mark is renewed every ten years; where do you want your business to be in 12 months' time or in five years' time? Have you covered all relevant class of goods and services?*
- Enforce your rights – *there isn't much point in registering your intellectual property unless you are prepared to defend it.*

Searching for Trade marks

Before registering your trade mark you need to check firstly that your proposed trade mark qualifies as a trade mark as you cannot change your application once you have filed it. This can be done by speaking with a trade mark attorney or the national issuing office. In the case of the United Kingdom this is the IPO UK (*see below for contact details*).

You will also need to check if any identical or similar marks already exist in the country or countries you wish to register your trade mark in.

There are a number of free databases that can be used for trade mark searching, here are a few:

British national registrations via the Intellectual Property Office website at:

[gov.uk/topic/intellectual-property/trade-marks](https://www.gov.uk/topic/intellectual-property/trade-marks)

Select 'Search for trade mark', then 'Keyword, phrase or image'. A trade mark search guide can be found at trademarks.ipo.gov.uk/ipo-tmtext/page/guide

The European Union trade mark or EU trade mark (abbreviated EUTM)

tmdn.org/tmview/welcome

TMView is a database compiled by the EU Intellectual Property Office (EUIPO). The EUIPO is the official trade marks and designs registration office of the European Union.

Using this one single tool provides access to;

- all TMs - national, regional, international are available
- all languages available: upon integration of new data into TMview from a new official trade mark office or organization the respective language(s) will be made available
- all official trade mark offices accessible: upon integration of a new official trade mark office or organization there will be a direct link to this office and its data
- 24/7 availability
- broad search results
- daily up-dated information
- free of charge

The default search mode for this database is 'Quick search'. Enter the word or words that make up the proposed trade mark in the box, e.g. 'Harrods', and click on 'Search'. A list of the trade marks on the database that meet the search criteria entered will be displayed.

This database is useful for an initial check if international coverage is wanted.

Full instructions on using this database can be found via the 'Help' live link on the blue bar at the top of the home page.

1. **Madrid System** - wipo.int/madrid/monitor/en/index.jsp (From 1 Jan 2018)

This system is relatively little used by British applicants however it is worth checking if you are searching by name of applicant.

Madrid Monitor is a gateway through to the Madrid System and allows users to check the status of international trade mark applications or registrations. Offers access to all trade marks registered through the Madrid System.

Default search is 'Simple Search', but there is also 'Advanced' search and 'Image' search available.

Video Tutorials are available to view, but the 'Support' tab you will see on screen will take you to Madrid Monitor Help.

2. Global Brand database

Available via wipo.int/branddb/en/ this database provides brand information drawn from many national and international sources including WIPO's Madrid System. You can perform a trademark search by text or image for trade marks, appellations of origin and official emblems.

There is a "How to search" guide available under the 'Help' button at the top right of the home screen.

IP and Brexit

For further information regarding intellectual property during the transition period please see; gov.uk/government/news/intellectual-property-and-the-transition-period

Further Information

The Business & IP Centre Manchester

The BIPC Manchester holds a monthly IP Clinic & Commercial Legal Clinic, offers access to resources and regularly runs IP workshops.

T: +44(0)161 234 1990

E: patlib@manchester.gov.uk

The British Library Business & IP Centre

The Business & IP Centre has extensive collections of business and Intellectual property information, plus databases. Manuals on Intellectual Property law are on the open access shelves.

T. +44(0)20 7412 7454

E. bipc@bl.uk

W. bl.uk/bipc

The Intellectual Property Office

The IPO UK is the official government body responsible for granting intellectual property rights in the United Kingdom. The website of the IPO UK contains a vast amount of information on all forms of intellectual property including what the different types of intellectual property protect, how to apply for the various intellectual property rights and the necessary forms and lists of relevant fees.

T. 0300 300 2000 (Local rate number)

E. information@ipo.gov.uk

W. gov.uk/government/organisations/intellectual-property-office

Chartered Institute of Trade Mark Attorneys (CITMA)

To find a trade mark attorney in your local area please see the ITMA website at citma.org.uk/members/? The website can be searched by postcode. ITMA also offer free advice clinics and details can be found at citma.org.uk/trade_marks/free_advice_clinics

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