

A BRIEF INTRODUCTION TO TRADE MARKS AND TRADE MARK SEARCHING

Updated February 2015



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.

Company names and domain names aren't automatically trademarks. 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 trademarks.

Trade mark systems available to British Applicants

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

The Community Trade Mark (CTM) - covers the 28 countries of European Union (EU). The CTM 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 6 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 6 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 – *IPO UK database first, then all the other 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 5 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:

1. **British national registrations** via the Intellectual Property Office website at: <https://www.gov.uk/intellectual-property/trade-marks>

Select 'Search for trade mark, then 'Keyword, phrase or image'. Full information on how to use this database can be found using the 'Help' boxes to the right of the screen.

2. Community Trade Mark - <https://www.tmdn.org/tmview/welcome>

TMView is a relatively new database compiled by the Office for the Harmonisation of the Internal Market (OHIM), OHIM (the Office of Harmonization in the Internal Market) is the official trade marks and designs registration office of the European Union.

Most of the 27 EU states including Britain, plus Madrid Agreement registrations and the Community registrations are included on this database. All 27 EU member states are gradually being added. The National Offices currently participating in TMview are marked with the green spot in the list displayed on the home page of the database. If the icon is grey, that means that the designs from that National Office are not available at present. In total the database contains around 8.5m trade marks, but please note TMview is a new database in a state of constant evolution with new trade mark registrations being added on a regular basis.

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

3. Madrid Agreement - <http://www.wipo.int/romarin>

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

Many of the registrations are not valid for the UK so to limit to only those valid for the UK, select "Designated Contracting Parties" and then insert 'GB' as the office.

Search hints are given next to each of the search boxes showing in what format to enter the information into the relevant box. However, full instructions on how to use the database can be found via the 'Help' live link on the left hand side of the page in the list headed 'Romarin'

Further Information

The British Library Business & IP Centre

The British Library holds the national collection of intellectual property not only from the United Kingdom but also from a large number of countries throughout the World

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.

Contact details

T. +44(0)20 7412 7454

E. bipc@bl.uk

Web <http://www.bl.uk/bipc/>

Workshops

The Business & IP Centre runs regular workshops on intellectual property and business. A full list can be found, and bookings made via the British Library website at <http://www.bl.uk/bipc> under the heading 'Workshops and events'

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.

They can be contacted by phone – 0300 300 2000 or by email - information@ipo.gov.uk.

Contact details

T. 0300 300 2000 (Local rate number)

E. information@ipo.gov.uk

Web. <https://www.gov.uk/government/organisations/intellectual-property-office>

Institute of Trade Mark Attorneys

Free advice clinics can be booked using the application for form downloadable via the ITMA website at <http://www.itma.org.uk/trademarks/clinics>

Contact details

ITMA Office
5th Floor
Outer Temple
222-225 Strand
London,
WC2R 1BA

T: + 44 (0) 20 7101 6090

F: + 44 (0) 20 7101 6099

E: tm@itma.org.uk

Web: <http://www.itma.org.uk>



Images by [iko](#), [Fred Armitage](#), [Dave Shaw](#) under a [Creative Commons license](#)