

Registration of Trade Marks

## **REGISTRATION OF TRADE MARKS IN UK**

DMH  
BRIGHTON

The law relating to trade marks in the UK is regulated by the Trade Marks Act 1994 and the Trade Mark Rules 1994. The Act enabled ratification of the Protocol to the Madrid Agreement about the International Registration of Trade Marks and implemented EC Directive 89/104 which required the approximation of the laws of EC Member States with regard to trade marks.

Section 1 (1) defines a trade mark as "any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings". Such a wide definition covers words (including personal names), designs, colours sounds and even smells.

A search for any existing marks can be made using the UK Patent Office website at [www.patent.gov.uk](http://www.patent.gov.uk).

Registration of a UK trade mark requires an application to the Trade Marks Registry. In almost every case it is advisable to engage a trade mark agent to assist in drafting the application. They will also be able to conduct a more detailed search for any conflicting marks already in existence.

Applications are made for the under the 42 different classes under which marks can be registered. The application must demonstrate a bon fide intent to use the mark in relation to specified goods or services.

The cost of registration depends on the number of classes under which the mark should be registered. It costs GB£200 to make and application in one class and GB£50 for each additional class.

The application is made to the Registrar at the Patent Office in Newport, South Wales. The date of receipt of the application by the Registrar is usually regarded as the priority date.

The Registrar will examine all applications to ascertain whether the mark is distinctive and will search the register for any existing marks which are conflicting with the one applied for. The application should be examined within two months of receipt after which an examination report is sent to the applicant detailing any objections against the application. If there are any objections the applicant is allowed time to try and overcome those objections.

There are two groups of grounds for the refusal of registration. Absolute grounds for refusal includes cases where the mark is devoid of any distinctive character or it is contrary to public policy or principles of accepted morality or is likely to mislead the public. Relative grounds for refusal of registration are when the mark is identical or similar to existing marks and there is a likelihood of confusion.

If the application is accepted it will then be published. This gives the public at large an opportunity to object to the registration of the mark. If no notification of any opposition is received within three months of publication the application will be registered.

The registration must be renewed every ten years.

#### Industry Sectors that DMH Assists

IT and Communications

Hotel & Leisure

Writers, musicians, film makers and artists

Manufacturers

Retailers

Local government

Waste management

Education establishments

Banks

Designers

Housing Associations