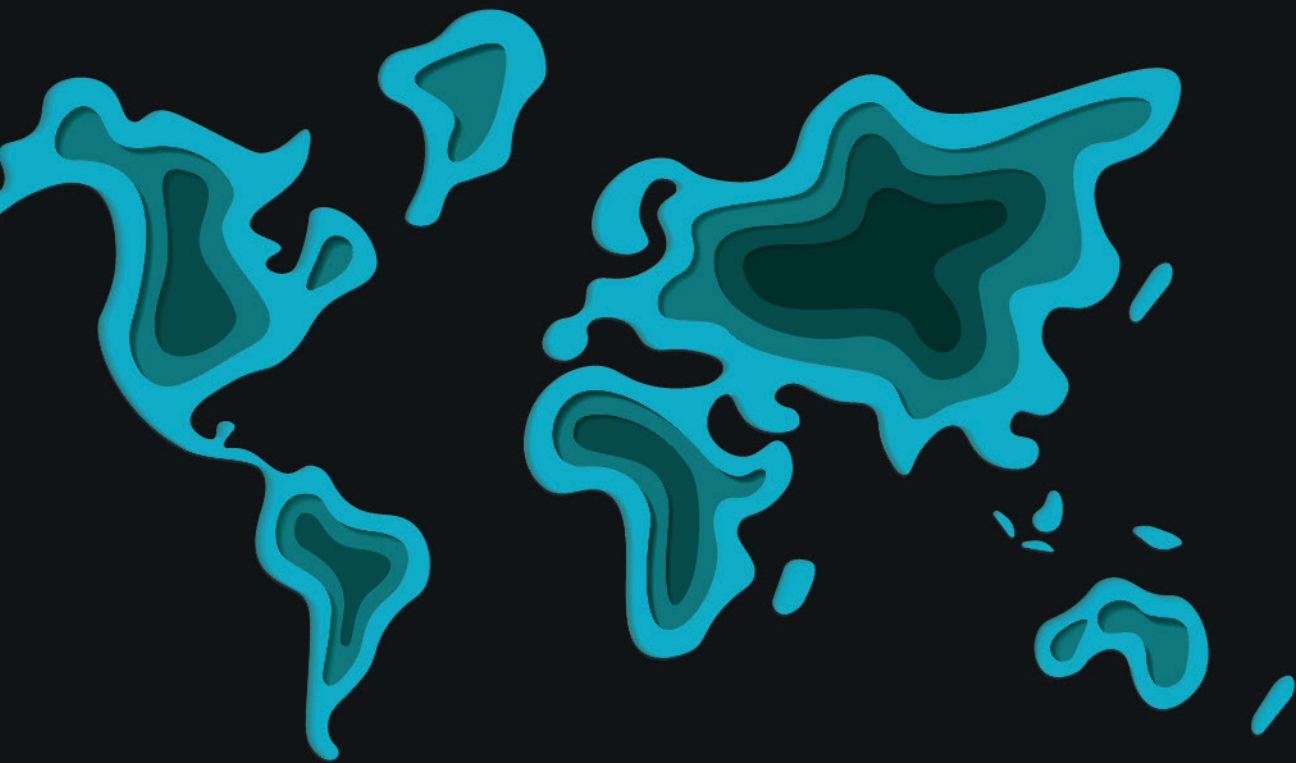


TRADE MARKS

A guide to EU and international
trade mark applications



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THE PROCESS

The process for securing registered trade mark protection is quite similar in many countries. Based on the UK and European Union (EU) trade mark systems the process is as follows:

File application

Include a representation of the mark. Define the scope of registration desired by the list of classes covered in the application and the specific goods and services in each class for which registration is sought. You must also specify the applicant, which will be the legal owner of the resulting registration.

Examination report

The relevant registry examines the application to ensure it is registrable per se and informs you of any similar prior marks which are already on the register. The European Union Intellectual Property Office (EUIPO) also issue a search report for existing registrations which may be considered similar to your mark. The proprietors of the trade marks listed in the search report are notified of your application and they can file an opposition to it after acceptance and publication.

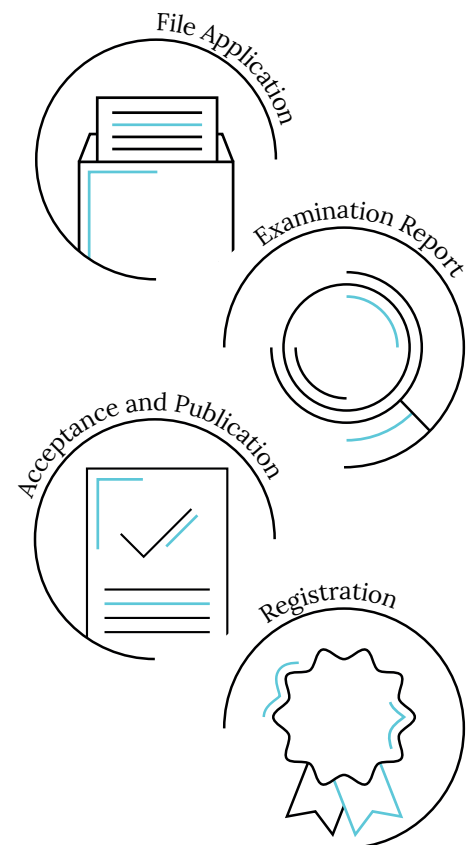
Acceptance and Publication

The application is published to allow any third parties to oppose your application if they feel there is conflict with their prior rights.

Registration

Registration certificate issues. In the UK, EU (and many territories) the mark is due for renewal in 10 years time and can be renewed every 10 years.

The usual time frame from application to registration for UKTM and EUTM's is approx. 4-6 months.



EUROPEAN TRADE MARKS

Two systems are in place to protect your trade marks in European Countries, the uniform EU Trade Mark (EUTM), and the individual national trade mark laws and registration system in each individual country. Both of these systems are also further supported by the WIPO Madrid International system.

Protection in an EU Member State can be obtained by 4 possible routes:

- » A direct national trade mark registration in each individual EU country
- » A uniform European Trade Mark (EUTM)
- » WIPO International Registration designating the relevant individual country
- » WIPO International Registration designating the uniform European Trade Mark (EUTM)

What is the EU Trade Mark (EUTM) System?

The EU trade mark system is a procedure by which a single trade mark application may be filed at the EU Intellectual Property Office (EUIPO), affording protection in all EU member states as a unitary right.



WHAT ARE THE ADVANTAGES OF THE EUTM?

- » The main reason to file an EU Trade Mark application is to obtain trade mark protection in all EU member states by means of a single application, without having to file separate national trade mark applications in each individual member state.
- » It is significantly cheaper to seek protection in all EU member states utilising the EUTM system, over individual national applications.
- » Renewals, assignments and changes to proprietor details are carried out centrally for the EUTM at EUIPO. A single renewal is paid every 10 years.
- » EU-wide injunctions and damages can be obtained through one court and protection automatically extends to new countries joining the EU.

Advantages

- » single application
- » cost savings
- » central administration
- » single renewal fee
- » EU-wide injunctions and damages

WHAT ARE THE DISADVANTAGES OF THE EUTM?

- » National registrations in individual EU countries are considered earlier rights, so a single registration of a conflicting mark in a single EU country could jeopardise the entire EUTM (there are mechanisms to 'convert' the EUTM to individual national registrations but the process can be time consuming and expensive).
- » Your mark will be unregistrable if it is descriptive in any EU language.
- » It can be difficult to prove acquired distinctiveness across the entire EU to support registration of a mark.
- » Providing proof of use of your trade mark across all relevant EU countries to support maintenance of your mark on the register can be difficult.

Disadvantages

- » national registrations are earlier rights
- » potential for language conflicts
- » difficult to prove acquired distinctiveness
- » difficult to provide proof of use across EU

INTERNATIONAL TRADE MARK PROTECTION

Trade Mark registration is territorial, and therefore separate applications must be filed in each country you wish to protect your mark (unless unitary system such as EUTM is used).

In most countries a local attorney is required to file an application and correspond with the national Intellectual Property Office on your behalf.

However, some systems are in place which can offer cost and administrative savings in securing protection overseas.



WHAT IS THE WIPO INTERNATIONAL TRADE MARK SYSTEM?

The WIPO (World Intellectual Property Office) International Trade Mark Registration system (the Madrid System) allows for registration of a trade mark in a number of countries, administered centrally .

You effectively end up with a ‘bundle’ of registrations in different countries, through a single registration system which acts like a wrapper around the national registrations.

You must have a ‘home’ or ‘base’ registration (typically a UKTM or EUTM for UK/EU residents and businesses) to have access to the system. You then choose which countries you wish to cover in the application and pay individual fees per country designated. You can also designate the entire EU as an EUTM in a WIPO International registration.

This system is useful in achieving overseas applications at less upfront cost than filing individual nation applications, but the trade mark application is examined by each national Intellectual Property Office and if an objection or opposition is encountered during the examination, you must still appoint a local attorney to represent you before the national office in question.

As the WIPO International system is purely administrative, national examination requirements must be met in each country individually and enforcement must still be carried out at a national level.

You can also ‘add’ countries (subsequent designation) to an existing International registration, but your application date for later filed applications will be the date you designate the country (not your original filing date)

“REGISTRATION
OF A TRADE MARK
IN A NUMBER
OF COUNTRIES,
ADMINISTERED
CENTRALLY”

WHAT ARE THE ADVANTAGES OF THE WIPO SYSTEM?

- » The main reason to use the WIPO International system is to obtain trade mark protection in a range of countries world wide, by means of a single application, in a single language without having to file separate national trade mark applications directly in each participating country.
- » There can be and usually are cost savings over direct national applications in each country of interest.
- » Subsequent designations of other countries can be added at a later date.
- » Renewals, assignments and changes to proprietor details are carried out centrally at WIPO. A single renewal is paid every 10 years although national requirements, such as USA Declaration of Use must still be met directly with the national Intellectual Property Office.

Advantages

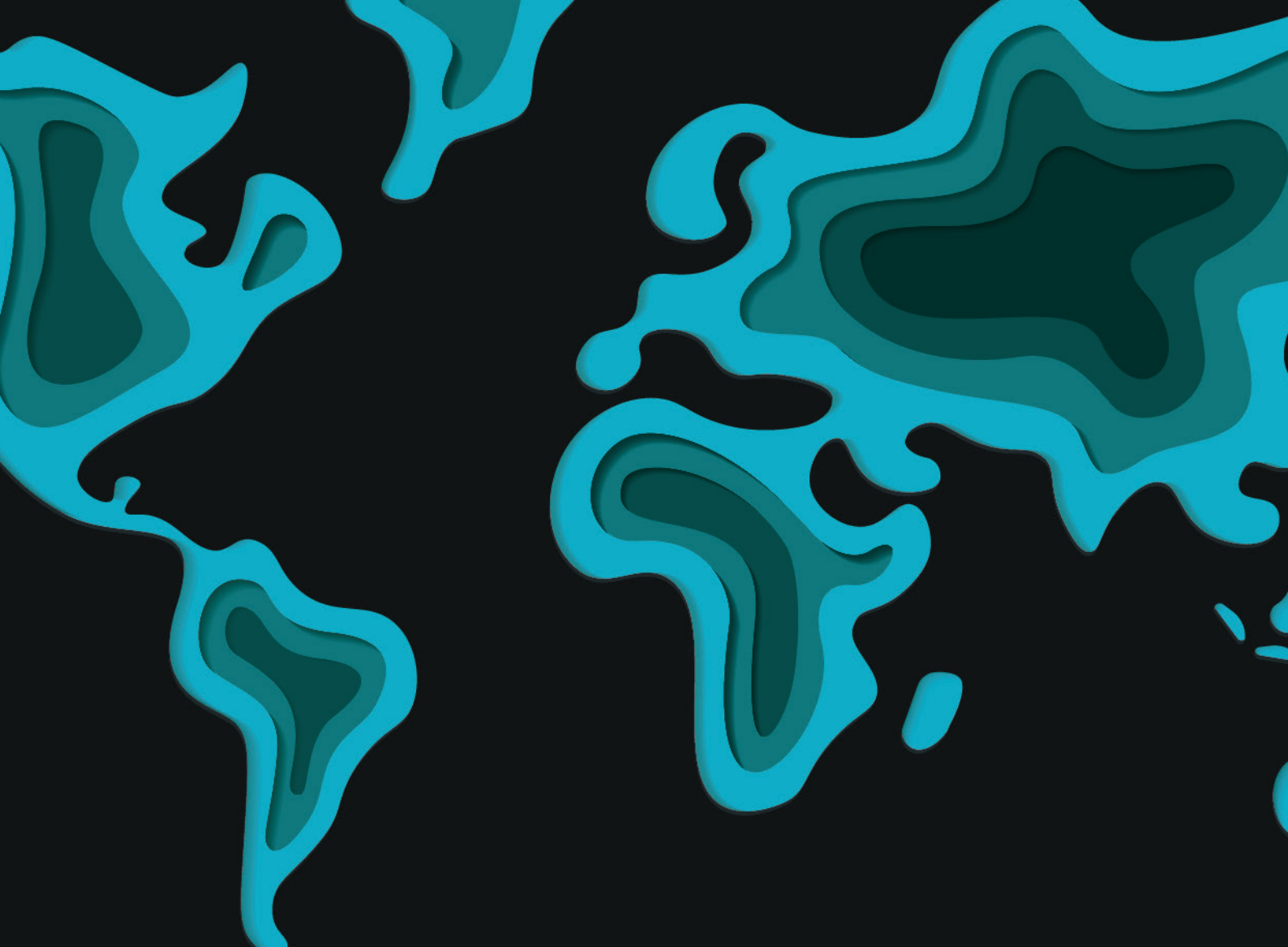
- » single application
- » single language
- » cost savings
- » adding subsequent designations later
- » central administration
- » single renewal fee

WHAT ARE THE DISADVANTAGES OF THE WIPO SYSTEM?

- » The main downside of the WIPO International Registration is 'central attack' whereby if the 'home' registration is successfully attacked and cancelled within the first five years the entire WIPO International Registration will also fall.
- » You can only cover the same goods/services as specified in the 'home' registration.
- » The trade mark owner must be a national of, domiciled in, or have business in a signatory country of the Madrid System.
- » There are certain jurisdictions, such as USA and China, where there are advantages in filing directly at a national level, rather than using the WIPO International System.

Disadvantages

- » open to central attack
- » same goods/services as 'home' registration
- » must be a signatory to the Madrid System
- » lose advantages of filing directly in some countries (US/China)



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CONTACT DETAILS

Phone: +44 (0)141 5856472

Fax: +44 (0)141 8465399

Email: mailbox@creationip.com

GLASGOW OFFICE

Hillington Park Innovation Centre

1 Ainslie Road

Glasgow

G52 4RU

United Kingdom

LONDON OFFICE

New London House

6 London Street

London

WC3R 7LP

United Kingdom