

Tech Sector Tool Kit: Registering a Trademark



Trade mark registration protects any sign or symbol that allows your customers to tell you apart from your competitors. You can register a name, logo, slogan, domain name, shape, colour or sound.

Preliminary Matters

In the UK the Intellectual Property Office (IPO) will not register marks which:

- describe your goods/services or any characteristics of them – for example, marks which show the purpose, value or geographical origin of your goods/services;
- have become customary in your line of trade;
- are not distinctive;
- are three dimensional shapes, if the shape is typical of the goods you are interested in, has a function or adds value to the goods;
- are specially protected emblems;
- are offensive or contrary to law; or
- are deceptive – there should be nothing in your trade mark which would lead the public to think that your goods/services have a quality which they do not have.

Best advice is to engage a search agent to undertake searches prior to filing an application. This helps determine availability and identify the extent of any possible objections to the application. If you have this information before filing the application, you'll be better equipped to:

- make an informed decision as to whether or not you want to proceed with your application and incur the costs associated with addressing any issues raised by the Examiner or a prior rights holder; or
- scope the description of the goods/services to be supplied under the trade mark so as to avoid issues being raised by the Examiner or any prior rights holders.

The Application Process

Thereafter the process in the UK is relatively straightforward:

- First you complete and file an application at the Intellectual Property Office (IPO) together with the requisite filing fees.
- Initially the IPO will issue a receipt confirming the details submitted and will then (within 2 – 4 months) issue an Examination Report.
- If the application is rejected the Examination Report will detail objections in which case you'll have 6 months to contact the Examiner and either persuade him that his objections are not justified or establish ways of overcoming them.
- If the application is accepted (or you are successful in overcoming any objections) it is then advertised in the trade marks journal.
- A period of 3 months is allowed for anyone to oppose the registration of the trademark and if no objections are received the application (or you overcome any challenges raised) the trademark is registered and a certificate issued.
- Once your trade mark has been granted, you can claim rights in relation to it dating back to the date of filing of your application (rather than the later date of actual grant) although you can't take action to enforce those rights until the trade mark has actually been granted.

Contact:



Dawn McKnight
Partner
+44 (0)28 9034 8917
dawn.mcknight@carson-mcdowell.com