

# brandprotect



## Fixed-fee trade mark protection from asb law

**Businesses often fail to adequately protect some of their most valuable assets: their business names, brands and logos. Brands and, trade marks and logos (or “intellectual property rights” as they are sometimes referred to) not only build and strengthen market share, they can also be sold, licensed, used to secure a loan or mortgage and give added protection to a business’ goodwill.**

**Common law, company registrations and domain name registrations offer some protection, but this is limited and can be hard to prove. For this reason, registered trade mark protection is often preferable.**

**Trade marks are words, names, signs or logos which businesses use to distinguish their goods and services from those of their competitors. It is possible to protect words, trading styles and logos, and also shapes (e.g. Coca-Cola bottle), colours (e.g. Orange for mobile phones), sounds (e.g. Directline jingle) and even smells (e.g. grass smell on tennis balls)!**

In the UK, there are two main routes to registration:

- a **UK trade mark application** through the Trade Marks Registry at the UK Intellectual Property Office, which gives you protection for your trade mark in the UK
- a **Community Trade Mark (CTM)**, which gives protection for your trade mark throughout the European Community (without having to make separate applications in each country) and is granted by the Office of Harmonisation (OHIM) which is based in Alicante, Spain.

It is also possible to register trade marks in other countries that may be of interest to you, or where your business is focused. We can advise you on these international processes and costs if you wish.

Registration gives the owner exclusive rights in the country of registration in relation to specified goods and services. There are 45 different classes of goods and services. If you wish to apply for a trade mark, you will be asked to select which classes of goods and/or services are relevant to your business.

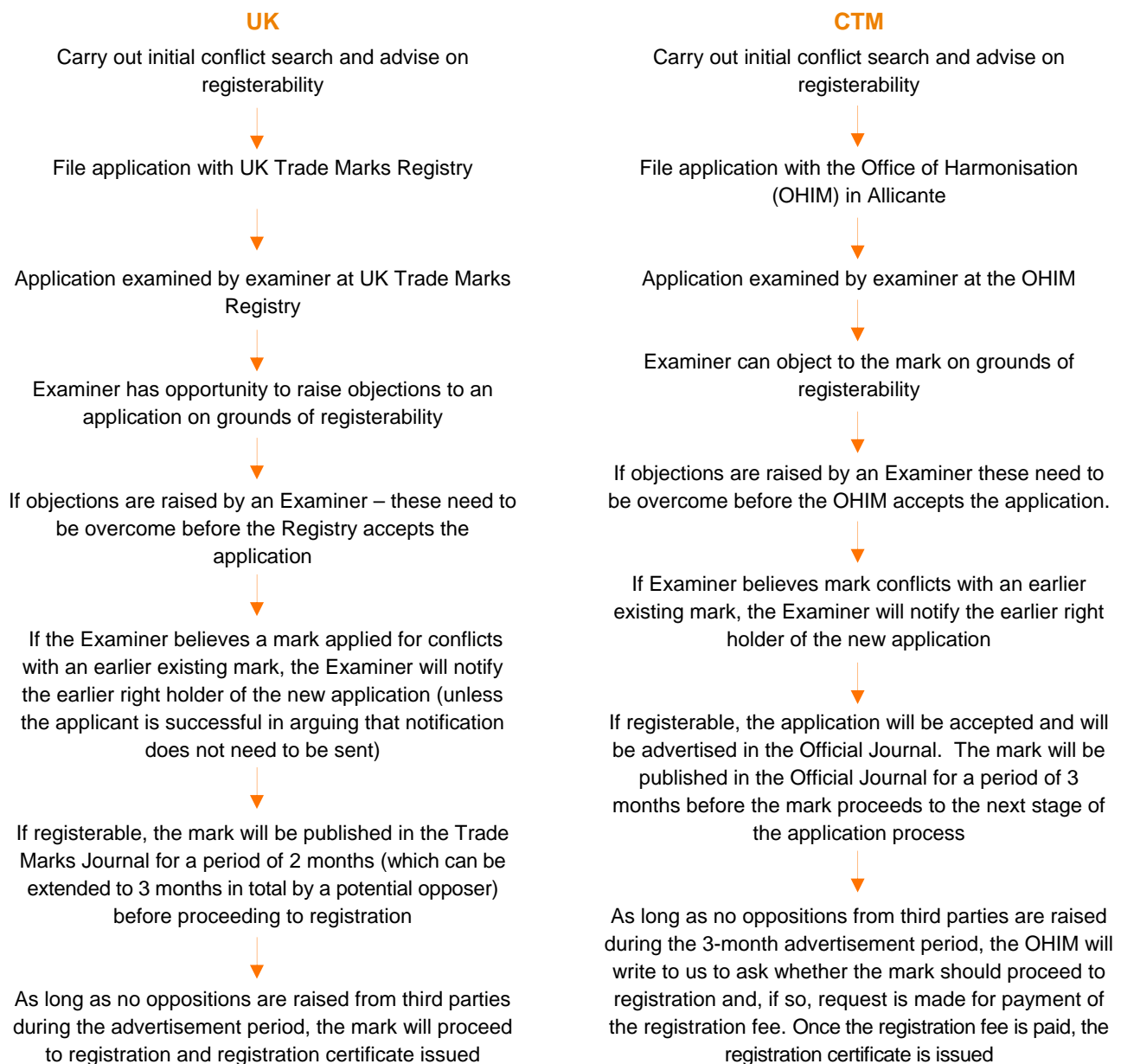
Registration lasts for an initial period of **ten years** after which the mark can be renewed for further periods of ten years on payment of the renewal fees, and can last indefinitely!

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## The process

The application process can take between 6-12 months for an uncontested mark and differs slightly for UK and CTM marks – a brief guideline to these processes is as follows:



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## Fixed fees for uncontested trade marks

Type	Fees
<b>UK MARKS</b>	<b>£850 + VAT + registry fees</b>
<b>COMMUNITY MARKS</b>	<b>£1,250 + VAT + registry fees</b>

The fixed fee includes:

- providing initial advice on registerability and protection strategy, including a brief conflict search of the UK and CTM Registers
- preparing and filing a trade mark application including drafting the specification of goods/services
- reporting on filing
- noting and reporting publication of the application in the Trade Marks Journal to advertise the mark to the public
- noting and reporting the registration, including checking and forwarding the certificate
- entering the registration into renewal records and providing renewal reminders
- providing an address for service in the United Kingdom.

### Additional information regarding fees

- If you decide not to file an application after taking our advice on registerability and/or after we have carried out the conflict searches mentioned above we will charge a fixed fee of £450 plus VAT to cover our costs and time. This does not include the cost of any additional searches you ask us to carry out (see below).
- Our fixed fee does not include the Trade Marks Registry fees which would be payable in addition to our fixed fee. At time of publication, the **Trade Marks Registry fees** are:
  - **UK trade marks** £200 filing fee
  - **Community trade marks** €975 +£15 filing fee + €1,100 registration fee

- The conflict searches we carry out will be brief, identical word or device searches (for example, we would not search for phonetic variations or similar marks). It is possible to commission more comprehensive searches; quotations are available on request.
- Our fixed fee covers one class of goods/services for UK applications and three classes of goods/services for CTM applications. If you would like protection in more classes the following fees are payable for each additional class:
  - **UK trade marks** £80 +VAT + £50 Trade marks Registry fee
  - **Community trade marks** £80 +VAT + €200 Trade marks Registry fee.
- Although the conflict search we carry out as part of our fixed fee should help us to advise you on certain aspects of the registerability of your proposed mark, it is not possible to predict whether or not an application will cause the Examiner at the Registry to raise objections. If the Examiner does raise substantive objections to your application (for example, objections that the trade mark is not distinctive or that it conflicts with an existing mark), we will charge a fixed fee of £300 plus VAT for reporting the objections, noting due dates, issuing reminders to you and obtaining time extensions from the Registry where necessary. The time required to deal with and respond to such objections depends on the type and scope of the objections raised (for example, it can involve putting together evidence of use of the mark). For this reason the costs of dealing with any objections are not included in our fixed fee. We can give you an estimate of likely additional costs of dealing with objections at the time they are raised.
- Renewal fees are payable every ten years to keep a registration in force. These are not included in our fixed fee. We will advise you of the cost of the renewal fees when we receive the renewal notice from the Registry.
- All prices are exclusive of VAT and payable in advance.
- Fees are subject to review on 1 May 2012.

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## Specialist intellectual property advisers



### Debbie Venn

Associate, Commercial & Brandprotect contact

Debbie joined the firm in 2001 and trained with asb, qualifying in 2004. She is a central member of the TeC and Travel sector teams, and the first point of call for **Brandprotect**

and all non-contentious trade mark queries.

Debbie's main areas of expertise are intellectual property rights (copyright, trade marks, patents and designs), intellectual property licensing and assignment arrangements, information technology (particularly software licensing, support, maintenance and hosting) and e-commerce (trading online, data protection and terms of use).

Debbie also advises clients on general terms of business, agency and distribution arrangements, data protection and privacy. She is recognised by Chambers & Partners 2011 as "incredibly responsive and excellent in negotiations".



### Margaret Craton

Partner, Head of Commercial

A senior partner in our commercial department, Margaret specialises in drafting a range of commercial contracts including joint ventures, agency and distribution agreements, outsourcing, data protection and the

licensing, assignment and exploitation of intellectual property rights, the supply and sale of goods and services and public sector procurement agreements.



### Lyndsey Ratcliffe

Partner, Commercial Litigation & Head of asb's TeC team

Lyndsey qualified as a solicitor in March 2005, having trained with the firm.

Lyndsey has experience in dealing with a broad range of commercial disputes, primarily on high value and complex matters. She has particular expertise in intellectual property disputes including actions for theft of confidential information, infringement of copyright, infringement of database rights, trademark infringement and passing off.

She has experience of fraud actions and international asset recovery and has enforced Judgments in a number of foreign jurisdictions.

Lyndsey is recommended by Chambers & Partners UK 2011 and is highly regarded for her "unflustered, hard-working, detail-driven" style.

**"This team has great industry knowledge and provides good value for money"**

Chambers & Partners UK 2011  
on asb's IP team

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