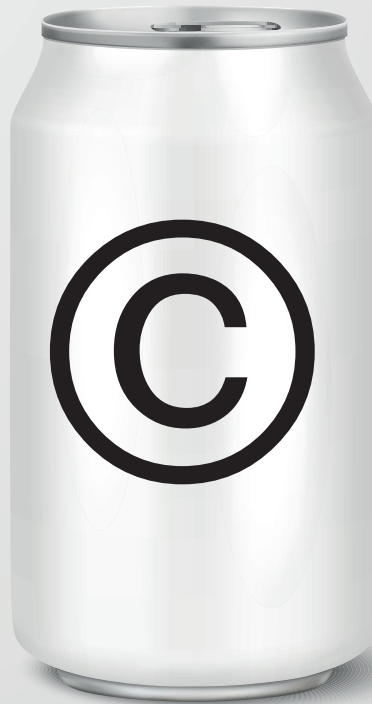




How to file a trade mark

In the first of a series of articles examining the ins and outs of intellectual property law and how it relates to small brewers and their brands, Chris Baume and Cameron Malone-Brown, trade mark attorneys at leading European IP law firm Potter Clarkson, take a look at how you file a trade mark and what protection and value it can bring to your brand...

Without trade mark protection, your brand is vulnerable to copycat competitors stealing a slice of the market you have worked so hard to establish. In this series, we will look at some of the key ways in which trade marks can help to create value and support the growth of your brand.

To kick off, we will look at filing a trade mark. The physical act of doing this is relatively straightforward but there can be pitfalls along the way. Here, we provide five key takeaways to help prepare for filing a trade mark and navigating your way to registered protection.



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1. Starting with a search

Unfortunately, it is a tale too often told that a business is wedded to a trade mark only to discover that it cannot use or register the trade mark. Dealing with searches at the concept stage of a trade mark can help avoid becoming too invested, commercially and financially, so that efforts can be directed to investigate more viable alternatives if needed. These searches help to establish your freedom to use a trade mark and your ability to register a trade mark in view of any potentially conflicting trade mark rights owned by third parties. We will cover trade mark searching and freedom to use issues later in this series, but for now we will assume that your mark has been cleared for use and registration.

2. What to protect?

Trade marks can be words, or logos or even packaging, get up colours or even sounds and smells! A trade mark can be simple or complex, but must not be descriptive (AMBER ALE), laudatory (THE BEST BEER), or against public morality/decency (BEER BA****DS). It must give the consumer certainty as to who owns the trade mark (CRAFTS). The latter is what is known as “distinctiveness”.

A business may have several trade marks that they want to register, including the name of the brewery, brands, logos, etc. Assessing which will provide the most robust protection for a business and how those could be combined can help to reduce exposure to costs. Knowing what should be or can be registered as a trade mark can be complicated and checking with a qualified attorney could help in avoiding formal objections.

3. Determining scope of protection

To secure registered protection, you must specify what types of products or services you want the registration to cover, which are categorised into 45 separate classes. For an independent brewer, it may include merchandising goods, brewery services or events hosting.

Covering too few goods and services may mean the registration provides insufficient coverage for the needs of the business. However, covering too many can increase the likelihood of attracting third party conflicts. Each class requires payment of an official fee, so be mindful of what is genuinely important to the business now and in the near future so as not to pay for more than you may realistically need. It is vital to get this balance right because you can't change the goods/services after filing the application. Checking the register for what other similar parties have filed in their specifications may be useful.

4. Ownership

This may seem obvious, but details of who will own, maintain and enforce the resulting registration are required at the time of filing. This can be the business itself or a named Director, for example.

5. Examination

All applications are examined to ensure that the mark meets the requirements for registration, and to check the specification is acceptable. If there are any problems with the application a notice of refusal will be sent out, giving you an opportunity to respond and attempt to address the issues. If the issues cannot be remedied, the application could be refused entirely or in part. However, assuming that the requirements for registration have been met, the examiner will accept the application for advertisement purposes.

Accepted applications are published to allow third parties to raise concerns or oppose the trade mark. In the UK, the advertisement period is two months but can be extended to three months on request. At the EUIPO, the advertisement period is three months.

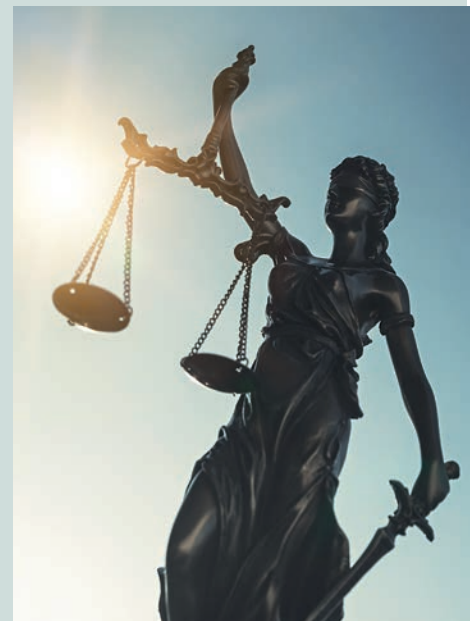
If this window passes without contest the UKIPO or EUIPO will issue a certificate of registration, which should take pride of place on your wall! The registration is initially protected for 10 years and is renewable for further 10-year periods, indefinitely.

The UK and the European Union benefit from some of the fastest trade mark registration procedures in the world (usually 3-5 months in the UK and 4-6 months in the European Union), assuming that the process is smooth sailing. It is important to get the filing right from the start because refusals may result in having to start the process all over again, increasing costs and time until protection is obtained.

Next steps

We hope this guide will be useful in preparing for venturing down the path of filing a trade mark application.

To better understand the potential pitfalls of filing and handling a trade mark application through to registration, it can be useful to have an initial conversation with a qualified professional. There is also further information related to the application process available via the UKIPO (<https://www.gov.uk/how-to-register-a-trade-mark/apply>) and the EUIPO (<https://euipo.europa.eu/tm/efiling/wizard.htm?execution=c1s1>).



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As a full-service intellectual property law firm with expertise in patents, trade marks, designs, litigation, licensing and consultancy, the firm can provide specialist support in all areas of IP.

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