

BRAND PROTECTION



The RM Brand Management Solution

Our experienced trade mark professionals will assist you with every step of the Brand Management process:

- ✓ **Advising on the correct requirements for the registration of brands as trade marks**
- ✓ **Trade mark creation process, guidance and legal advice**
- ✓ **Worldwide trade mark, logo and company name searches**
- ✓ **Trade mark registrations in all countries worldwide**
- ✓ **Design and logo registrations**
- ✓ **Dealing with objections raised by Trade Mark Registration authorities or by third parties**
- ✓ **Advising on questions of infringement, passing off and potential litigation**
- ✓ **Advising on and arranging for the assignment and licensing of marks**
- ✓ **Brand audit:**
 - **advising on the correct use of trade marks as marketing tools and in advertising and promotion**
 - **reviewing trade mark portfolios in association with products, packaging and marketing**
 - **advising on design rights**
 - **advising on patent rights**
 - **advising on the building of capital value of registered trade marks**
- ✓ **Maintaining trade mark, design and patent registrations**
- ✓ **Trade mark monitoring**

RM Brand Management

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BRAND PROTECTION



With continuous growth of international trade and the use of the Internet, trade mark protection becomes increasingly important.

Registration of a brand as a trade mark grants the owner a *statutory monopoly* in the mark, which means they would have the right to sue for infringement, when another party uses the same or a confusingly similar brand relating to the same or similar goods/services to those covered by your registration.

Registered trade marks are a transferable property right which add value to a balance sheet and can substantially contribute to the success of a business as well as a strong marketing tool used to attract customers.

A trade mark readily distinguishes a product or service from that of its competitors. It may consist of a word or words, letters, numerals, a slogan, shape or any other sign capable of distinguishing the goods or services of one entity from others.

There is a formal record of registered marks, making their existence and ownership more certain. It is estimated that in the region of 30% of research and development conducted in Europe is wasted on products, which already exist. Early filing of a brand deters competitors from adopting the same or a closely similar Mark. It is still possible to rely on the law of 'passing off' in order to implement rights in brands in the UK, although this is not possible in all other countries. However, actions for passing off are complex and extremely costly and owners require a substantial and exclusive reputation in order to succeed – and usually the first action that will be taken will be to file a trade mark application.

The product or a service name, company name, slogan and even a domain name can be registered as trade marks as long as they fulfil the required criteria. Most domain names have a trade mark element to them and whilst it is possible to register many variations of a domain name with the Domain Registrars, it doesn't mean that they are actually free for use and may infringe earlier trade mark rights resulting in costly and damaging action being taken against the domain owner. It is therefore important to check out trade mark rights before using a domain name.

Advantages of registering a brand:

- *Registration acts as proof of ownership and entitlement to the trade mark.*
- *Registration grants a statutory monopoly in the mark. Even if a competitor comes to the idea totally independently at a later date, the owner of the trade mark registration has the right to take action for infringement, even without proof of actual damage*
- *Registration can be obtained up to 5 years before the brand is to be used.*
- *Registration gives 'security of mind' to the owners of the registered mark. Owners of similar but unregistered brands cannot claim infringement but have to rely upon common-law rights which is much more difficult in some countries of the EU.*
- *Registered brands are classed as intellectual property and ownership, can have value, be transferred, or the rights to use the mark can be licensed for financial gain.*
- *Unlike patents and designs, Trade Marks remain registered as long as the renewal fees are paid every 10 years.*
- *Any individual or corporate body may register a trade mark.*

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PROTECTING YOUR BRAND - THE PROCESS

Consider filing in countries:

- *Where you advertise*
- *Where you have sales*
- *Where your company has offices*
- *Where your licenses/licensees are located*
- *Where you manufacture or distribute your products*
- *Countries with notorious counterfeiting problems*

There are different levels of initial registration, eg. in the EU as a Community wide registration, or at national level. With the current EU law it is important to understand that businesses do not just have to worry about local firms but also competitors in places like Milan, Riga, or Seville.

Please find below the processes for covering the whole EU (25 countries) and the UK as the national sample.

THE EUROPEAN COMMUNITY applications

Europe is a natural market for companies or individuals based in the UK. If you intend to trade in the future in other EU countries, it is important and cheaper to register from the start in the European Community.

- ❖ Cost effective (in the region of £3,800 to register an uncomplicated Community trade mark)
- ❖ Filing fees cover up to three classes of goods or services
- ❖ Additional classes of goods or services only attract a small additional fee
- ❖ Applications are not examined on prior rights
- ❖ Rights come from the date of filing
- ❖ It takes an average of 18 months for an uncomplicated Community mark to be registered
- ❖ Protection in all 25 EU countries by a single registration
- ❖ Rights equal to national registrations
- ❖ Renewal every ten years
- ❖ Preferred choice of many companies and individuals with an eye for the future

UK applications

- ❖ It takes four to nine months to register an uncomplicated trade mark in the UK
- ❖ The registration date is backdated to the date of application
- ❖ Costs vary, but on average are approximately £1000 per mark in a single class
- ❖ This reduces for additional classes filed at the same time and increases where there is objection or opposition
- ❖ Trade mark applications are dealt with on a 'first filed' basis. It is therefore prudent for an owner of a mark to file as soon as possible
- ❖ Renewal is every 10 years

In General

- ❖ We recommend that applications are filed at the conception stage of a product or service, allowing time for them to be registered before a product launch. Changing a mark after use has commenced can be a very expensive exercise in commercial terms and can result in the loss of valuable goodwill established in the original name.
- ❖ The first step toward registering your mark is to conduct an identical word search of the relevant Registers to see if there are any existing marks, which may conflict with your proposed name or logo. A trademark has to be distinctive and non-descriptive. It should not theoretically consist of words which are commonly used/needed in the trade that is being carried out

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- ❖ If an identical search is clear we recommend conducting a full search. The information provided in the full search includes the specifications and status of each mark displayed. If you require a written opinion in respect of the acceptability of the mark for registration then a further pro rata charge is made for providing this service. Full word searches conducted in three or more classes are charged at a *discounted* price.
- ❖ We also need to know if there are any logos associated with your trade mark or if you intend to use the mark in any particular stylisation (color / font). Logo searches have to be conducted separately. As previously, we would be pleased to cap the cost of logo searches in three or more classes. We recommend that a trade mark is filed exactly as it is intended to be used. If color is involved, we recommend filing a series of marks in the UK to include the color version as well as in monochrome. In other countries this means either filing more than one application or choosing one color or monochrome version. Should the version in monochrome achieve registered status, this should allow use of the mark in any color. A small charge is made for each additional style.
- ❖ Once a Community Trade mark application is filed it is examined to ensure it fulfils the acceptance criteria as a trade mark whereas in UK trade mark an application is also examined to determine whether there are conflicting earlier trade marks on the Registers. If the mark is acceptable it is advertised in the respective Trade Marks Journal for a 3 month period during which interested parties are entitled to object to its registration. If it is not opposed then the mark is registered.

THE MADRID PROTOCOL applications

The Madrid Protocol, provides a system for international registration of trade marks. The trade marks that are registered via this system enjoy equal rights at a national level as other trade marks filed in the specified countries. Registrations through this systems cost significantly less than individual national registrations and currently there are 66 jurisdictional members of the Protocol.

Advantages to Protocol in comparison to filing an application in each country nationally:

- The owner of an international registration is granted the same protection as the owner of a national mark
- It is cost effective
- It is possible to cover all 66 members by a single application
- Uniform protection of goods and services in all designated countries
- One renewal with one office (WIPO/International Bureau)
- Central assignment recordation/address change
- Set examination period: 18 months
- Challengers must bring infringement actions/oppositions separately in each country (no centralized, single procedure)

Full quotes for any country can be supplied on request.

BRANDS – AFTER REGISTRATION

Once a trade mark is registered there are no guarantees that a conflicting trade mark will not also be entered on the trade mark registers, bearing in mind that some systems such as the Community Trade Mark system do not take earlier trade mark rights into consideration. In reality it is very important for brand owners to monitor the trade mark registers as well as to be alert for any common law usage of their trade marks that might occur, in order to maintain the exclusivity and value of their brand. The best way of doing this is to subscribe to our name watching service which can be tailored to the your needs in any jurisdiction.

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RM[®] TRADE MARKS PRICE LIST – MAY 2005

UK Trade Mark Registration

RM[®] In-House Searching UK and Community Trade Mark (CTM) Registers

All searches are conducted of the UK & CTM Registers

Identical word search of UK & CTM Registers	£80
Full word search of UK & CTM Registers	£180 per class
Unless in:	
▪ Classes 6, 9, 16, 25, 37, 39, 40, 42	£225 per class
Full word search in 3 or more classes	Maximum £500
Logo search of UK & CTM Registers	£250 per class
Unless in:	
▪ Classes 6, 9, 16, 25, 37, 39, 40, 42	£310 per class
Logo search in 3 or more classes	Maximum £700
Advice work charged pro-rata	£175 - £225 per hour

Application to register a UK Trade Mark

Government filing fees for first class filed	£200
Each additional class filed at the same time	£50
RM [®] 's fees for first class filed	£200
Each additional class filed at the same time	£50
Examination stage – Single Class application pro rata	£175 per hour
Examination stage – Multi-class applications	£150 per class
Advertisement	£120 per class
Registration	£120 per class
Work charged – pro rata includes:	
▪ Overcoming sustained objections	£175 - £225
▪ Oppositions advice	per hour

Community Trade Mark Registration

Community Trade Mark (CTM) Fees

The CTM system allows a single application to be made for 25 countries.

Inclusive filing fees in up to three classes	£1,500
Each additional class filed at that time	£265
Examination and Advertisement as UK	
Registration fee in up to three classes	£1,500
Further work conducted in respect of objections, oppositions, infringements etc., are charged on a pro-rata basis of:	£175 - £225 per hour

Renewal of Trade Mark Registration

RM [®] fees (excluding Government charges)	
- first class	£200
- each additional class	£50

Online TM Searching

UK & CTMs including those filed via The Madrid Protocol designating these territories.

Standard Search	£ 3.50
Intellisearch [®]	£40.00
Mark details:	
▪ Medium Format	£ 2.00
▪ Full Format	£ 2.50

Worldwide Trade Mark Search & Registration

RM[®] provide search and registration services worldwide. For a comprehensive quote contact RM[®] on 01763 247030 or email rmtm@rmonline.com

For information and pricing on International trade mark matters please contact 01763 247030 or email rmtm@rmonline.com

RM[®] Trade Mark Name Monitoring Service

UK TM Register monitoring service	per annum £300
CTM Register monitoring service	per annum £300

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