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# A quick guide to trade mark protection in the UK and EU

## **What is a trade mark?**

A trade mark is a way of distinguishing the goods/services of one trader from those of other traders. As such, a mark must be distinctive to be registrable; descriptive and generic terms generally cannot be registered and must be left free for all traders to use.

## **What types of trade mark are registrable?**

A variety of marks can be registered including words, logos, a combination of words and logos, patterns, 2D and 3D shapes, sounds, colours, holograms, moving digital images, positions and (potentially also) smells, tastes and gestures.

## **What protection is given to unregistered trade marks?**

In the UK, the law of passing off protects the goodwill generated through the use of a sign (whether registered or not) and other indicia by a trader over time. Damage to that goodwill as a result of a misrepresentation is actionable (although proving the necessary level of goodwill/use can be difficult and expensive). The law of unfair competition can also be used to protect some unregistered rights in EU member states such as France and Germany.

## **What are the options for registering a trade mark in the UK?**

An application for a UK national mark can be filed at the UK IP Office (UKIPO). It is also possible to protect a mark in the UK through the International trade mark system administered by WIPO. Using the International system can save time and cost if registered protection is required in more than one country/region worldwide.

## **What are the options for registering a trade mark in the EU?**

An application for an EU trade mark (EUTM) can be filed at the EU IP Office (EUIPO). EUTMs have a unitary character, meaning that a single application is filed and results in a single right that covers all 27 EU member states. An EUTM can also be obtained using the WIPO international system, although this is rarely advisable. An alternative to an EUTM is to file separate national trade mark applications in each EU member state of interest, either through the relevant national IP Office or using the WIPO international system.

### **What are the benefits of an EUTM?**

An EUTM is generally cheaper and easier to obtain and manage than separate marks in several/all EU member states. An additional benefit of the EUTM is that it can confer protection in all EU Member States without having to use the mark in all of them – use in even one country is potentially sufficient to stave off a revocation action and satisfy the proof of use requirements for enforcement.

### **What are the downsides of an EUTM?**

An EUTM is a unitary right and so it can be refused registration (or invalidated once registered) if it does not satisfy the requirements for registration – or if there is a conflicting prior right – in at least one EU member state. This means that an EUTM can be refused registration on the grounds of eg a prior conflicting unregistered right in Italy alone (more [here](#)). It is sometimes possible to convert an EUTM into separate national applications/registrations in those jurisdictions where no objection or conflict arises, which can mitigate these risks.

### **Do EUTMs cover the UK?**

Now that the UK has left the EU, EUTMs no longer cover the UK. This applies to all existing EUTMs as well as any EUTMs that are filed in future. However, the owners of EUTM registrations in existence as at 31 December 2020 were given a separate national trade mark registration in the UK (called a comparable trade mark (EU)) automatically and for free. These sit alongside normal UK trade mark registrations. There are various consequences of the new regime (more [here](#)).

### **Is trade mark law in the UK and EU the same?**

With one or two exceptions, UK and EU trade mark laws are currently the same. However, there is scope for the law to diverge over time now that the UK is no longer part of the EU.

### **Is prior use necessary for trade mark registration?**

Unlike some jurisdictions around the world, registration of a trade mark in the UK and EU is not dependent on first having used the mark; a mark can be registered in the UK and EU even if it has never been used anywhere in the world (but see the proof of use section below).

### **Are the UK and EU 'first to file' or 'first to use' systems?**

The UK and EU largely operate 'first to file' trade mark systems. Getting in first with an application is usually essential. However, prior unregistered rights can (in certain circumstances) pose a bar to the use and registration of UK trade marks and EUTMs (more [here](#)). The protection afforded to unregistered rights differs across the EU on a national member state basis.

### **What are the advantages of registering a trade mark?**

A registered trade mark is almost always easier (and cheaper) to enforce than passing off rights. In particular, a registration confers a greater scope of protection and can (at least for a period of time) be enforced even if the mark has not yet been used. Conversely, the law of passing off only protects signs that have been used (and the right can be limited, geographically). A registration also puts third parties on notice of its owner's rights and is easier to exploit (eg by licensing).

### **When should a trade mark application be filed?**

Applications should be filed at an early stage of planning, and preferably in advance of any market launch (to ensure third parties do not file blocking applications).

### **What else should be done before launching or updating a trade mark?**

Clearance searches should be conducted in each jurisdiction of interest to make sure that the mark is free to use and register (and, in particular, that its use will not infringe any third-party rights). Failure to do so can result in a costly and embarrassing rebrand and compensation claim. These searches are particularly important for EUTMs since a prior right in only one EU member state can potentially pose a bar to the use/registration of an EUTM.

### **What goods/services should an application cover?**

Trade marks must be registered for specific goods and/or services, which are organised into classes. An application should generally cover the goods and/or services currently offered under the mark and any that might reasonably be offered in future (bearing in mind costs, proof of use requirements, bad faith issues and future plans) (more on what goods/services to cover [here](#) and on bad faith [here](#)). A trade mark registered for one area of use will not necessarily allow the owner to prohibit third party use in other areas.

### **What criteria does a trade mark need to satisfy to be registrable?**

To be registrable, a trade mark must meet various 'absolute grounds' of registration including that it must (a) be distinctive (see below), (b) be non-descriptive (eg soapy for soap), (c) not consist of a prohibited shape of other characteristic (eg a purely functional shape), (d) not be contrary to public policy or accepted principles of morality (more [here](#)), (e) not be deceptive (more [here](#)), (f) not contravene other laws or be too similar to state and other symbols like flags and hallmarks.

### **When is a trade mark 'distinctive'?**

'Distinctiveness' refers to a sign's ability to be recognised by consumers as a sign differentiating the goods/services of one trader from those of other traders. Whether a sign is sufficiently distinctive for registration will depend on the goods/services covered. Common words can be distinctive if used for certain goods (eg Apple for computers). Some signs – such as invented words and fanciful logos – are 'inherently' distinctive. Others 'acquire' distinctiveness through the extensive use made of them in the marketplace. The more distinctive a mark (inherently and/or through use), the greater its scope of protection.

### **What are the options for registering marks that are not sufficiently distinctive?**

There are a number of potential options including adding a distinctive logo to non-distinctive word elements or submitting evidence of acquired distinctiveness through use.

### **Who can raise 'absolute grounds' of objection?**

The UKIPO and EUIPO examine all trade mark applications to check that the mark is distinctive and meets the other absolute grounds for registration. If a mark does not satisfy the criteria, then the application will be refused, although the applicant will be given an opportunity to argue that the mark is registrable (including to submit evidence that it has acquired distinctiveness through use). Third parties can also oppose the registration of trade mark applications based on absolute grounds at the UKIPO (but not the EUIPO) and apply to invalidate registrations based on absolute grounds (at both the UKIPO and EUIPO) (more on oppositions [here](#) and [here](#)).

## **How are conflicts with earlier rights dealt with?**

A trade mark application can be refused (or a registration invalidated) if it conflicts with an earlier right – so-called 'relative' grounds of refusal. However, this only occurs if the owner of the earlier right files a successful opposition to the application or invalidity action against the registration; the UKIPO and EUIPO will not raise this ground of its own volition. This is why it is important for the owners of earlier rights to have watching services in place to spot conflicting applications and act quickly to oppose them. Earlier rights that can be relied upon in opposition and invalidity actions include trade mark applications and registrations, passing off rights, copyright and designs.

## **What rights does a trade mark registration confer?**

Broadly, a valid trade registration allows the owner to prevent third parties from using in the course of trade and registering identical and similar marks in relation identical or similar goods/services provided certain conditions are met (usually where there is a likelihood of confusion). Where the mark in question has a reputation (meaning it is well known in the relevant market

place), the owner may also be able to prevent the use and registration of such marks in relation to dissimilar goods/services. There are various defences to infringement. More on enforcement [here](#) and our Trade Mark Litigation Guide [here](#).

## **Can a sign be tested in the market before committing to registration?**

The best way to do this is to file a single application for the sign and claim priority from it. If the application is the first worldwide for that particular sign (and for the particular goods/services covered), it usually triggers a six-month priority period. This means that any further applications (for the same sign and the same goods/services) filed within that six-month period are back dated to the date of the first application. In other words, the owner can test the market for up to six months before committing to further applications.

## **How long does the application process take?**

In the UK, applications generally take about 4 months to register (assuming there are no objections or oppositions). The process is slightly longer for EUTMs. In some countries (such as Germany), registrations can be obtained in a matter of days.

### **How long does a trade mark registration last?**

Trade mark registrations must be renewed every 10 years from registration (on payment of a fee) and can potentially be renewed indefinitely.

### **When is proof of use required?**

Unlike various other countries, there is no requirement to prove use on the filing of a trade mark application, on renewal of a registration or periodically following registration. However, a trade mark registration can be revoked on the application of a third party on the ground that within any continuous period of five years from registration it has not been put to genuine use in the UK or EU (as appropriate) and there are no proper reasons for non-use. Proof of use (for various time periods) can also be requested by the other side where a trade mark registration that is more than five years old is relied on in an opposition, invalidity or infringement action.

### **Should the TM and ® symbols be used?**

There is no requirement to use the TM and ® symbols in the UK. However, doing so can help to put third parties on notice of the trade mark owner's rights. The law varies from jurisdiction to jurisdiction in the EU, but it is a criminal offence in the UK to use the ® symbol in relation to a mark that is not registered. The TM symbol should be used in this scenario instead. It indicates that the owner considers that the sign has brand significance (even though not registered).

### **What other issues should be borne in mind when using a mark?**

A trade mark application can be refused (or registration revoked) if the mark is or has become the customary or common name (ie generic name) in the trade for the goods/services in question. Making sure that marks are not used as nouns or verbs or to describe product or service categories can help ensure that they do not fall foul of these provisions.



### **Do dealings with trade marks have to be recorded?**

It is highly recommended that any transactions (such as assignments, licences, or charges) involving registered trade marks are recorded promptly at the UKIPO or EUIPO (as appropriate). There are various consequences of failing to do so including that a third party who acquires a conflicting interest in a mark unaware of the earlier transaction can take priority.

### **What are the alternatives to trade mark registration?**

The alternatives include relying on registered or unregistered design protection, copyright and passing off/unfair competition rights. For our quick guide to design protection, see [here](#).

### **Does the registration of company names, domain names and social media handles confer trade mark rights?**

No. Just because a registration for one of the above has been obtained, does not mean that it is free to use. The relevant authorities do not check whether the names they register infringe any third party trade mark (or other) rights. It is for the person acquiring the registration and/or proposing to use the name to undertake relevant checks. If a name conflicts with a prior trade mark (or other) right, it may have to be given up.



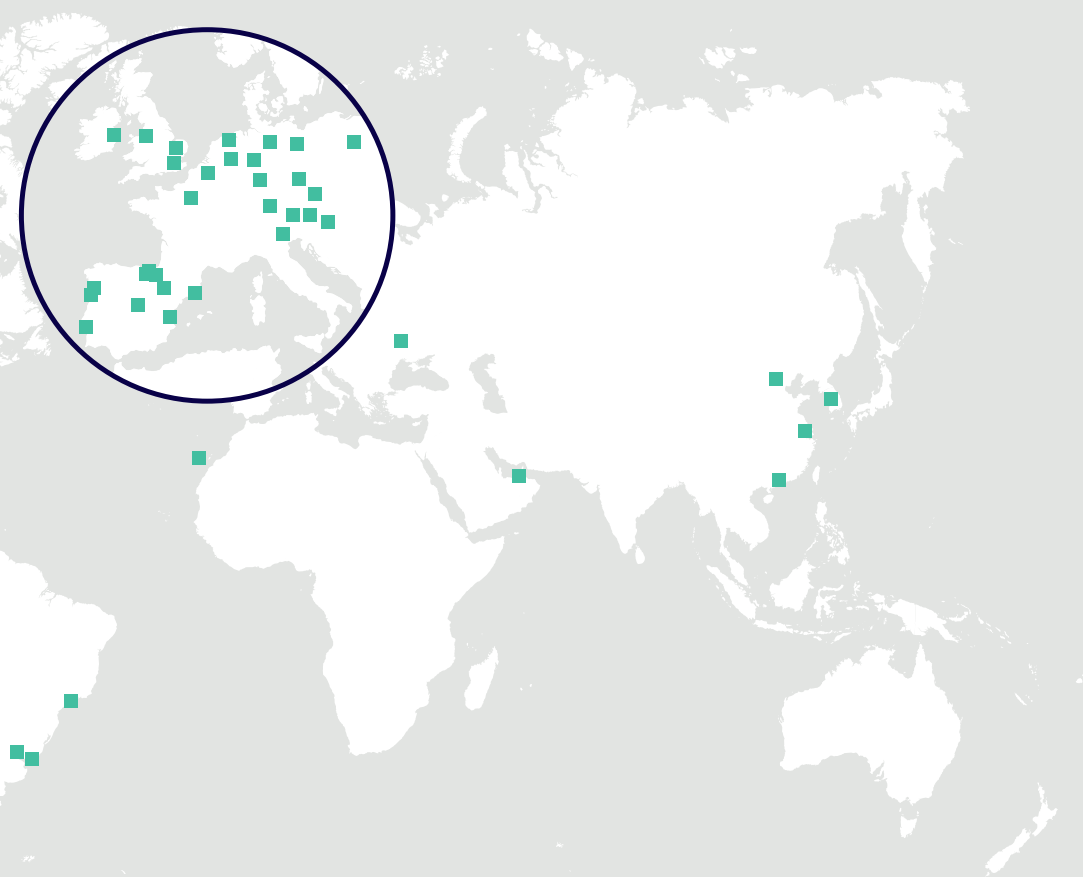




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